

The Historical Foundations of the Law Relating to Trademarks

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This six century survey of the uses and piracies of trade symbols was written by Schechter in partial fulfillment of his Doctor of Law (JD) at Columbia University where he earned an A.B. (1912), LL.B. and A.M. (1914). His master's thesis was published in the American Political Science Review (vol9). Admitted to the New York Bar 1915, in 1923 he registered under the faculties of law and political science for a JD to illumine "dim historic trails" to the sources of trademark law & to analyze critically the present state and tendencies of it in the light of its history.

Extensive referencing and impressive bibliography is used e.g. Coca Cola v Koke Co. 254 US 143; Treasury Dept. BIR Cumulative Bulletin no.2 1920 p292; W. Holdsworth History of English Law ii 3rd ed. pp407-8; J.M. Lambert 200yrs of guild life p305. Seven chapters describe – the problem and the sources; merchants' personal and proprietary marks in the Middle Ages; production marks in the regulation of trade by the Guilds and Companies; trademarks and the national regulation of industry; development of trademark law in the cutlery trades; the genesis of the modern law relating to trade-marks; and the problems of the modern law historically considered.

Ruins from Koraku near Corinth yielded caucers/bowls bearing potters' marks at least 4000yrs old. Potters' factory marks from Greece/Rome date to the 5th/4th centuries BC. The most typical regulatory mark of the Middle Ages was that in baking – preservation of standards and prices. National regulations of bread in England trace back to Anglo-Saxon times, ordinances of the 8th & 12th century on the subject, with the earliest (penal) statutory requirement being the Assize of Bread 1266. A statute of 27 Edward-III (1351) established merchant's marks prime facie – conclusive evidence of ownership for the goods to which they were affixed. *Cigninota* (swan marks), one of the oldest English proprietary marks signifying Crown ownership (royal bird), were registered in the King's swan-herd book (1483). Enforcement was patchy, with some places rigorous leaving it to the Guild Courts (usually serious), whereas others (in the public interest) left it to the Leet Courts (usually not so serious). An integral part was prevention of litigation among guildsmen in any tribunal save that of the Misteries – despite a 1504 Act of Parliament prohibiting such non-litigation ordinances they continued for over the next century. Printer's/stationers' devices'/marks' primary function was decorative, not regulatory. France was first to require every printer/bookseller to have his own mark (1539 Francois-I), likely intended to aid in the suppression of heresy as well as trade piracy. Recognized by courts from Florentine, Danzig, Riga, Calais, London, Holland & Flanders, also involving Cretan, Spanish & Venetian goods with such *cause célèbre* as the case of the ship *Ugiera Savagina* (1590-3) before the Privy Council, or in other cases the Admiralty Court. The Leet Courts were more preoccupied with compulsory affixing or imprinting of marks by bakers & coopers, except the granting of marks to Hallamshire cutlers by the Manor Court of the Earl of Salop 1564. Considerable printing infringement occurred in the 16th/17th centuries in France. Indeed until end of 17th century infringement was not litigated in England. The 2nd Star Chamber decree regulating printing 1637 made specific reference prohibiting mark infringement, and in 1662 the printing trade became regulated by Parliament, though neither made mark registration compulsory. Within guilds there was no competition, but cooperation. It took the Pewters of London until 1747 to recognize the right of individuality in the sense of permitting the actual name of the maker to be made known to the consumer, distinct from just that of the guild itself.

The concept of modern trademark as an asset arrived in 15th & 16th centuries and more especially the 17th via the cloth trades. In the later Middle Ages wool/woolen goods were England's main export, by 17th century end 2/3 of the total. The Guild system broke down earlier in the weaving industry than any other. Rivalry was not just between individuals but collectives, so development of trademark law there concerned national expansion of the industry. A statute of 15 Richard-II 1391 related to the "Cloths of Guilford" "which were of good value, and did bear a great name...". By early 14th century Colchester was an important centre of the clothing (baize) industry, however by 1588 they were counterfeited by Bay-makers at Halstead & London. The Privy Council acted requiring separate different trademarks to distinguish the goods' sources between these two places. Charles-I proclamation "against frauds and deceits used in Drapery" saw arrival amongst lawyers, though not yet judges, of trademark as an asset – capturing goodwill of the capitalist who furnishes the material/tools of production, rather than just the actual craftsman of the

goods. However there is no evidence of “property in trademarks as a legal possession which can be bought and sold and transmitted”. This link between the modern concept and Middle Ages’ regulatory & liability mark lay in the cutlery trade. That industry was widely dispersed (London, Sheffield, ...) involving three phases of medieval craftsmanship (bladsmithes for the blade, cutlers for the handle and other fitting, and sheathers for the sheath) before amalgamation into the Cutlers’ Company mid-15th century. It began as obligatory marks for weaponry whose quality requirements were paramount for the Realm’s defense, moving to the Articles of the Mistery of Bladesmiths. A 1452 case, the “Double Crescent”, arising before the Mayor and Aldermen of London broke the traditional view of these marks as merely regulatory. Registration was at the Company Hall and cases 1612, 1607, 1650 and 1677 showed marks as assets transmitted via marriage and sellable. Ephraim How, a cutler, was amongst the first to use newspaper advertising to repress piracy of his mark in the London Gazette May24-7 1703, and again in the Daily Courant 1712. Evolution of mark from regulatory compulsory in the Middle Ages to sense of property 15th century to qualified system of ownership (buy, sell, transmit) 17th century crystallized in the 1801 Cutlers’ Company Act.

Guild disintegration had begun mid-15th century while common law in 16th/17th was beginning to take cognizance of such laws and regulations as then existed with regard to trademarks. Guild jurisprudence, statute law, and conciliar law (that developed by the King’s Council & the Star Chamber) – all three sources contributed to modern trademark law. First reference to trademarks in the King’s Courts is an “irrelevant reminiscent dictum” first mentioned in Popham Report’s 1656 referring to the case of *Southern v How* by Common Pleas judge Dodderidge in 1618 concerning the infringement of a clothier’s mark in the reign of Elizabeth. Giles Jacob in *Lex Mercatoria* (1718) spoke of marks as regulatory (infringement would bring trouble/damage to owner of mark), also proprietary mark (for “which both Common Law and Civil Law hath great respect”). Silence followed in the King’s Courts until 1742 when for first time injunctive relief against trademark infringement was sought from a very learned Lord Chancellor who in *Blanchard v Hill* denied that relief on the ground that the protection of trademarks would create/protect monopolies. Blackstone Commentaries (1766) made no reference whatsoever to trademarks in his discussion of “Titles to things personal by occupancy” (bk2 ch26), although it enumerated patents & copyrights. Trademarks did not develop so long as producer & consumer were in close contact, i.e. until the coming of the Industrial Revolution.

In America trademarks did not acquire importance as assets of value in commerce of the nation v local trade until the 2nd half 19th century. 1788 General Court of Massachusetts offered bounty for sail cloth with triple damages penalty for infringement. Thomas Jefferson’s report recommended State protection for internal commerce, Federal protection for Indian & external, with local registration. The first reported case of trademark infringement came before a State court 1837, US court 1844. Up to 1870 only 62 trademark cases were decided before American courts in which year only 121 trademarks were registered under the Trademark Act (re-enacted 1876). By 1923 ~15,000 were registered. British and American registration laws only came about to obtain advantages of reciprocal statutes in foreign countries, e.g. France, Belgium & Russia. In Britain argument against recognition was driven by fear of monopolization growth, in the US consideration of States rights. *Southern v Hill* uniformly classified trademark infringement as an action in deceit, not one of property. In America by comparison protection was based upon the same equitable grounds expressed 1842 in England by the oft quoted dictum of Lord Langdale. 1915 US Supreme Court ruling outlined the general principles of “the redress that is accorded in trade-mark cases”, similar as in England, that “a man is not to sell his own goods under the pretence that they are the goods of another man”. Text writers on equity and on the general principles of the law of torts usually speak of trademark infringement as “the violation of a property right of one kind or another”. In 1923 Mr. Justice Holmes wrote for the US Supreme Court “the monopoly in that case (of a patent) is more extensive, but we see no sufficient reason for holding that the monopoly of trademarks, so far as it goes, is less complete. It deals with the delicate matter that may be of great value but that easily is destroyed, and therefore should be protected with corresponding care”. Sound basis of repression of trademark piracy is the protection of a merchant from interference with “his reasonable expectation of future patronage”. The Federal Trade Commission is charged with prevention of unfair methods of competition as they affect public welfare, including the misbranding of goods, thus holds jurisdiction over trademark infringement.

There is a lot of Ye Olde Englishe in the book which makes for difficult reading, e.g. Nov10 1612 “Tho. Hyden was Committed to prison vpon my Lord Maiors Commaundement for he wold strick a marke not allowed him w^{ch} on parte doth Counterfeyct other mens marks”. Detailed Ancient/Classic, Continental European & Asian historical perspectives minimally are missing. Completing the 20th century evolution and a compare/contrast with civil law jurisdictions would also be welcome.

Overall – deservedly acclaimed as a classic and recently reprinted in paperback form. Fascinating.