UNITED STATES PRINTING & LITHOGRAPH COMPANY *v.* GRIGGS, COOPER & COMPANY.

CERTIORARI TO THE SUPREME COURT OF OHIO.

No. 372. Argued March 6, 1929.—Decided April 8, 1929.

The Trade Mark Act of 1905 provides no remedy where the infringement of a trade mark registered under it is within the limits of a State and does not interfere with interstate or foreign commerce, nor does it enlarge common law rights within a State where the mark has not been used. P. 158.

119 Oh. St. 151, reversed.

CERTIORARI, 278 U. S. 592, to the Supreme Court of Ohio to review a judgment affirming a decree which enjoined petitioner from the printing and selling of labels alleged to infringe respondent's trade mark.

Mr. Walter F. Murray, with whom *Mr. Frank F. Dinsmore* was on the brief, for petitioner.

Trade-mark rights, resting on the laws of the States, are limited to States in which the trade-marks are used. *Hanover Star Milling Co.* v. *Metcalf,* 240 U. S. 425; *United Drug Co.* v. *Rectanus Co.,* 248 U. S. 100.

Congress has no right to legislate upon the substantive law of trade-marks. *Trade-Mark Cases,* 100 U. S. 93; *Hanover Star Milling Co.* v. *Metcalf,* 240 U. S. 416.

Registration under the Trade-Mark Act does not extend the rights of the registrant into States in which he has done no business. *General Baking Co.* v. *Gorman,* 3 F. (2d) 893. It confers no rights that the registrant did not have under the common law. *Waldes* v. *International Mfrs. Agency,* 237 Fed. 502; *Robertson* v. *U. S. ex rel. Baldwin Co.,* 287 Fed. 943; *Andrew Jergens Co.* v. *Woodbury,* 273 Fed. 952; *Ammon & Person* v. *Narragansett Dairy Co.,* 262 Fed. 880.

Messrs. E. Howard Morphy and *Carl W. Cummins,* with whom *Messrs. Orris P. Cobb* and *Oliver G. Bailey* were on the brief, for respondent.

The Trade-Mark Act projects the protection afforded by the Act to the owner of registered trade-marks throughout the entire United States in all of the channels of interstate commerce in advance of the sale of merchandise bearing the registered trade-mark. *Standard Brewing Co.* v. *Interboro Brewing Co.*, 229 Fed. 543.

A registered trade-mark owner actually using the mark in interstate commerce is entitled to protection in interstate commerce against any infringer or contributing infringer where it appears that goods bearing the infringing labels move in the channels of interstate commerce.

The common law has no application to the facts in this case, for the reason that the registered trade-mark of respondent was projected by trade into a certain territory in which the customers of petitioner thereafter engaged in business. The petitioner was a common law contributing infringer. *Colman* v. *Crump,* 40 N. Y. Supp. 584, affirmed, 70 N. Y. 573; *Carson* v. *Urg,* 39 Fed. 777; *Hennessy* v. *Herrman,* 89 Fed. 669.

Mr. Justice Holmes delivered the opinion of the Court.

This is a suit brought by the respondent, a corporation of Minnesota, against the petitioner, a corporation of Ohio, alleging that the plaintiff has a trade mark 'Home Brand', registered in the Patent Office for various grocers' goods which it sells at wholesale in certain named States of the northwest; and that the defendant is printing and selling labels for similar grocers' goods, containing the word 'Home', which labels are used by the purchasers in States other than those in which the plaintiff has established a market. No interference with interstate or foreign commerce is alleged. The bill seeks an injunction against

printing and selling such labels for any groceries that the plaintiff sells. The trial court found the facts to be as above stated and the Supreme Court held that the "purpose and effect of the [Trade Mark Act of February 20, 1905, c. 592, § 16; 33 Stat. 728, (C., Tit. 15, § 96)] was to project the trade mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." It affirmed a judgment for the plaintiff giving the relief prayed and a writ of certiorari was granted by this Court.

In the *Trade Mark Cases,* 100 U. S. 82, it was held that the earlier acts attempting to give these unlimited rights were beyond the power of Congress. Soon after that decision, an Act of March 3, 1881, gave remedies for the wrongful use of a registered trade mark in foreign commerce or commerce with Indian Tribes. It was said that obviously the Act was passed in view of the above mentioned case, that only the trade mark used in such commerce was admitted to registry and that the registered mark could only be infringed when used in that commerce, *Warren* v. *Searle & Hereth Co.,* 191 U. S. 195, 204, (see *United Drug Co.* v. *Theodore Rectanus Co.,* 248 U. S. 90, 99,) and the constitutionality of the Act even when so limited was left open. 191 U. S. 206. The Act of 1905 goes a little farther and gives remedies against reproduction, &c., of the registered trade mark 'in commerce among the several States' as well as in commerce with foreign nations, &c., § 16, *supra.* A remedy for such infringement was given in *Thaddeus Davids Co.* v. *Davids Manufacturing Co.,* 233 U. S. 461, see also *American Steel Foundries* v. *Robertson,* 262 U. S. 209. *Baldwin Co.* v. *Robertson,* 265 U. S. 168. But neither authority nor the plain words of the Act allow a remedy upon it for infringing a trade mark registered under it, within the limits of a State and not affecting the commerce named. More obviously still

it does not enlarge common law rights within a State where the mark has not been used. *General Baking Co.* v. *Gorman,* 3 F. (2d) 891, 894. Some attempt was made to support the decision upon other grounds, but we do not think them presented by the record, and they are not mentioned by the Ohio Court.

Judgment reversed.

GILCHRIST ET AL., CONSTITUTING THE TRANSIT COMMISSION, ET AL. *v.* INTERBOROUGH RAPID TRANSIT COMPANY ET AL.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

No. 159. Argued October 16, 17, 18, 1928. Reargued January 14, 15, 16, 1929.—Decided April 8, 1929.

A New York street railway corporation, operating in the City of New York (1) subway lines belonging to and leased from the city, and which were part of the city streets, in connection with (2) elevated lines belonging to and leased from another corporation, and (3) extensions of such elevated lines, sought to increase the rate of fare, which had been fixed at five cents for all the lines by the leases and by the agreement under which the extensions had been constructed, and to that end proposed a seven cent fare and applied to the Transit Commission of New York to sanction the change, on the ground that the existing rate was confiscatory. The commission, acting within the time allowed it by statute, made an order denying the application for want of power to change the rate fixed by the subway contracts, and brought proceedings in a state court, as did also the city, to compel the company to observe that rate. On the same day when this formal action was taken, but earlier and when there was merely a consensus among the commission's members that it should be taken, the company filed its original bill in the federal court alleging that the five cent rate had become confiscatory and that the commission had failed to grant relief, and praying an injunction against any attempt on the part of the commission or the city to enforce that rate, or to interfere with the establishment of the one proposed; and thereafter it filed a sup-