

SUPREME COURT OF THE UNITED STATES

Saxlehner v. Eisner & Mendelson Co.

179 U.S. 19 (1900) · No. No. 29 · Decided October 15, 1900

SUMMARY

The Supreme Court considers claims concerning the exclusive use of the name "Hunyadi" and the distinctive bottles and labels used for Hungarian bitter waters. It holds that laches barred relief concerning the word "Hunyadi" because the term had become public property and generic in the United States, but that the defendant's simulated bottles and red-and-blue labels constituted an infringing and fraudulent imitation. The Court reverses the decree of the Circuit Court of Appeals and remands for reinstatement of the lower court's decree, with additional relief concerning the defendant's Seal brand labels.

CASE DETAILS

COURT	Supreme Court of the United States
WRITING FOR THE COURT	Justice Brown
JURISDICTION	Federal
DECIDED	October 15, 1900
DOCKET	No. 29
DISPOSITION	reversed_and_remanded
PROCEDURAL POSTURE	Certiorari review of a decision of the Circuit Court of Appeals for the Second Circuit in a trademark and unfair competition suit involving the use of the word "Hunyadi" and imitation bottles and labels.
STANDARD OF REVIEW	De novo review of the legal and equitable issues presented on certiorari, including abandonment, laches, trademark infringement, and the propriety of injunctive relief.
PRECEDENTIAL VALUE	Published Supreme Court of the United States opinion; precedential.
PARTIES	Saxlehner v. Eisner & Mendelson Company

TOPICS

- trademark infringement
- trade dress
- trademark law
- equitable relief
- remedies

PRACTICE AREAS

QUESTIONS PRESENTED

1. Whether the plaintiff abandoned or lost through laches the right to enforce the word "Hunyadi" as an exclusive trademark.
2. Whether registration of "Hunyadi Janos" prevented later registration or enforcement of "Hunyadi" alone.
3. Whether the defendant's bottles and red-and-blue labels infringed the plaintiff's protected trade dress notwithstanding the common use of the word "Hunyadi."
4. Whether the defendant's additional Seal brand label avoided infringement or justified denial of injunctive relief.

HOLDINGS

1. The plaintiff could not obtain exclusive protection for the word "Hunyadi" because the word had become public property and generic for Hungarian bitter waters in the relevant markets, and the plaintiff's prolonged failure to assert the right in the United States independently established laches.
2. Abandonment requires both conduct indicating practical abandonment and an actual intent to abandon; the evidence did not establish abandonment of the name or distinctive bottles and labels.
3. Registration of the composite mark "Hunyadi Janos" did not estop the plaintiff from subsequently registering or asserting rights in the word "Hunyadi" alone.
4. The defendant's intentional simulation of the plaintiff's distinctive bottles and red-and-blue labels constituted trademark or unfair competition infringement, and the plaintiff was entitled to an injunction and monetary relief notwithstanding delay.
5. The defendant's additional Seal brand label did not cure the infringement or prevent an injunction because the bottle and principal label remained a clear simulation likely to deceive ordinary purchasers.

KEY QUOTATIONS

"The right to individual appropriation once lost is gone forever." (36)

"Indeed, in a case of an active and continuing fraud like this we should be satisfied with no evidence of laches that did not amount to proof of assent or acquiescence." (39)

"We are of opinion, however, that as defendant's bottle and label are a clear infringement upon those of the plaintiff, it would be destructive to her just rights to permit the use of such bottles and labels by the defendant, notwithstanding the affixing of the Seal brand, which is a mere private mark of the importer." (41)

FACTUAL BACKGROUND

Andreas Saxlehner developed and sold Hungarian bitter water under the name "Hunyadi Janos" and used distinctive straight bottles, capsules, and red-and-white or red-and-blue labels. The defendant sold "Hunyadi Matyas" water in bottles and labels substantially similar in size, shape, color, and overall design to Saxlehner's, and the trial court found that the simulation was intended to capture the goodwill of the plaintiff's product and

deceive purchasers. Although the word "Hunyadi" had become commonly used for Hungarian bitter waters, the defendant had no governmental authorization to use the plaintiff's distinctive label.

PROCEDURAL HISTORY

The Circuit Court for the Southern District of New York enjoined the defendant from selling bitter water in bottles and labels closely imitating the plaintiff's, but permitted use of "Hunyadi" with a different suffix and denied an injunction against use of the word itself. The Circuit Court of Appeals affirmed as to the word but reversed as to the label and dismissed the bill. The Supreme Court reversed the appellate decree and remanded with directions to reinstate the district court's decree, except as to the Seal brand labels and damages associated with their use.

DISPOSITION

reversed_and_remanded

REMAND INSTRUCTIONS

Reverse the decree of the Circuit Court of Appeals and remand to the Circuit Court for the Southern District of New York with directions to reinstate its decree of April 29, 1898, except insofar as that decree denied an injunction against use of the Seal brand labels and denied damages sustained by such use, and conduct further proceedings consistent with the opinion.

CASES CITED

- Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 186
- Moore v. Stevenson, 27 Conn. 13
- Livermore v. White, 74 Maine 452
- Judson v. Malloy, 40 California 299
- Hickman v. Link, 116 Missouri 123
- Mouson v. Boehm, 26 Ch. Div. 398
- Guinness v. Ullmer, 10 Law Times 127
- Shrimpton v. Laight, 18 Beav. 164
- Clement v. Maddick, 1 Giff. 98
- Hostetter v. Vonwinkle, 1 Dill. 329
- Morse v. Worrell, 9 Am. Law Review 368
- Grillon v. Guenin, Weekly Notes (1877), 14
- American Grocer Publishing Association v. Grocer Publishing Co., 25 Hun 398
- McIntyre v. Pryor, 173 U.S. 38
- McLean v. Fleming, 96 U.S. 245
- Menendez v. Holt, 128 U.S. 514
- Fullwood v. Fullwood, 9 Ch. Div. 176

- Scherer, 27 Fed. Rep. 18

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