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## How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum

Keith M. Stolte

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## ARTICLES

# How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum

Keith M. Stolte\*

*It is possible that some day in some moldering mass of unpublished records of the common law may be found a report of a case in the reign of Elizabeth by a clothier for infringement of his trademark that will justify the authority with which Southern v. How has been so unanimously endowed.*

—Frank I. Schechter<sup>1</sup>

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\* Associate, Brinks Hofer Gilson & Lione, Chicago, Ill. University of Chicago, B.A. 1987; John Marshall Law School, J.D., *magna cum laude*, 1998. This Article is dedicated to the memory of Howard Mayer Brown, late distinguished Service Professor at the University of Chicago, and renowned Medieval and Renaissance scholar.

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## INTRODUCTION

There is a new entry in the law books as the oldest reported trademark case in Anglo-American law. It is known as *Sandforth's Case*.<sup>2</sup> Ironically, it was discovered through an obscure ref-

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2. *Sandforth's Case*, *Cory's Entries*, BL MS. Hargrave 123, fo. 168 (1584) (providing a fairly complete portion of the complaint), reprinted in J.H. BAKER & S.F.C. MILSOM, *SOURCES OF ENGLISH LEGAL HISTORY—PRIVATE LAW TO 1750* 615-18 (1986); HLS MS. 2071, fo. 86 (providing a brief abstract of the case), reprinted in BAKER & MILSOM, *supra*, at 615-18; HLS MS. 5048 fo. 118v. (formerly catalogued as HLS MS. Acc. 704755, fo 118v.) (providing another brief abstract of the case), reprinted in BAKER & MILSOM, *supra*, at 615. Other unpublished references to the case are found in CUL MS. li 5. 38, fo. 132; HLS MS. 2074, fo. 84v.; and BL MS. Lansdowne 1086, fo. 74v. There is a discrepancy among the six sources as to the name of the case. For example, in BL MS. Hargrave 123, fo. 168v. the name of the case is apparently *Sandford's Case*. J.H. BAKER, *INTRODUCTION TO ENGLISH HISTORY* 385 n.45 (2d ed. 1979) [hereinafter *ENGLISH HISTORY I*]. In CUL MS. li. 5. 38, fo. 132, the case name is *Samforde*, and in HLS MS. 2074, fo. 84v, it is *Sandforth's Case*. In view of this conflict, and intending to modernize the name of the case, Professor Baker chose to name the case *J.G. v. Samford* in the 1990 edition of his book *Introduction to English History*. J.H. BAKER, *INTRODUCTION TO ENGLISH HISTORY* 522 n.68 (3d ed. 1990) [hereinafter *ENGLISH*

reference in a seventeenth century lawsuit that previously claimed the title of oldest trademark case.

History has generally honored *Southern v. How*,<sup>3</sup> decided in 1618, as the first reported trademark case in Anglo-American law<sup>4</sup>—despite the fact it was not a trademark case at all, but one that involved the sale of counterfeit jewels.<sup>5</sup> Its connection with trademark law arose out of Judge Dodderidge's dictum in that case, wherein the learned judge made a brief reference to an earlier, unnamed and apparently unreported case that involved a suit brought against a cloth maker who used another cloth maker's mark.<sup>6</sup> That lawsuit—published as *Sandforth's Case*—may now be declared the earliest reported trademark case in Anglo-American law.

For four centuries, the obscure reference made in *Southern v. How* served as the foundation for all subsequent trademark law and, more broadly, the law of unfair competition.<sup>7</sup> But *Southern v. How* provides a feeble and problematic basis for the development of the law of trademarks and unfair competition in England, the British Commonwealth, and the United States. For example, some prominent scholars, particularly Frank Schechter,<sup>8</sup> argue that the

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HISTORY II]. To preserve the historical quality of the case, this Article uses the name designated in HLS MS. 2074, fo. 84., that is, *Sandforth's Case*.

3. *Popham's Reports* 143 (1618), 79 Eng. Rep. 1243 (K.B. 1907); *J. Bridgeman's Reports* 125 (1659), 123 Eng. Rep. 1248 (K.B. 1912); *Cro. Jac.* 468 (1659), 79 Eng. Rep. 400 (K.B. 1907); *2 Rolle's Reports* 5 (1676), 81 Eng. Rep. 621 (K.B. 1908); *2 Rolle's Reports* 26 (1676), 81 Eng. Rep. 635 (K.B. 1908).

4. See JEROME GILSON & JEFFREY M. SAMUELS, TRADEMARK PROTECTION AND PRACTICE § 1.01[1] (1997); JAMES LOVE HOPKINS, THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION 15-16 (4th ed. 1924); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:2 (1996); EDWARD S. ROGERS, GOOD WILL, TRADE-MARKS AND UNFAIR TRADING 34 (1914); SCHECHTER, *supra* note 1, at 6-9.

5. *Southern v. How*, *Popham's Reports* at 143, 79 Eng. Rep. at 1243-44.

6. *Id.* at 144, 79 Eng. Rep. at 1244.

7. See GILSON, *supra* note 4, at § 1.01[1]; MCCARTHY, *supra* note 4, at § 5:2; SCHECHTER, *supra* note 1, at 5-6, 9, 123.

8. The scholarly contributions made by Frank Schechter during the 1920's have significantly influenced the law of trademarks during the twentieth century, especially in the United States. Most trademark practitioners know of Schechter as the father of the doctrine of trademark dilution. His 1927 law review article, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927), was the first to propose the dilution the-

case is practically worthless in demonstrating that the common law of trademarks developed any earlier than the advent of the Industrial Revolution.<sup>9</sup> Schechter has declared *Sykes v. Sykes*,<sup>10</sup> decided in 1824, to be “the first reported case squarely involving the protection of trade-marks by an English common law court.”<sup>11</sup> Many other scholars and the courts are less assertive; they simply tend to avoid the question as to the availability of relief for trademark infringement or unfair competition prior to the nineteenth century.<sup>12</sup>

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ory that has occupied so much of the scholarly literature on trademark law in the last 40 years. Less known is Schechter’s seminal work on the history of trademarks, *The Historical Foundations of the Law Relating to Trade-Marks*, *supra* note 1, which is still unsurpassed as the most comprehensive and reliable authority on the subject.

The following anecdote serves as a testament to the importance of Schechter’s historical work in the area of trademark scholarship and demonstrates that even Oliver Wendell Holmes recognized Schechter’s contribution:

Though the Court was in recess, Holmes was formally attired in the cutaway, striped trousers, and stiff bosom shirt with a winged collar. He sat at his desk on the fourth floor of his home overlooking the garden. The two justices [Holmes and Justice Stone] did most of the talking . . . . Turning to Stone, Holmes observed that in the course of writing an opinion in a trademark case, he had occasion to read a fascinating book on the history of the law and usage of trademarks. Stone inquired whether Holmes was referring to a doctoral dissertation by Frank Schechter on the historical foundations of the law of trademarks. Holmes responded that that was the book he had in mind. Stone then told him that he had persuaded Schechter, who was trademark counsel for the BVD company, to take a year off from his practice and to be the first candidate for a doctoral degree in law at Columbia. When Holmes learned that Stone had inspired the writing of this book, he rose, walked across the room, shook Stone’s hand and said, “I congratulate you on one of the great acts of your life.”

Milton W. Handler, *Are the State Antidilution Laws Compatible with the National Protection of Trademarks*, 75 TRADEMARK REP. 269, 270-71 (1985) (citation omitted). Even Milton Handler, who has severely criticized Schechter’s theory of trademark dilution, acknowledged that Schechter’s book on the history of trademarks inspired his own impressive career in the trademark field from 1927 to the present. *Id.* at 271.

9. See SCHECHTER, *supra* note 1, at 8-10, 123 (criticizing the reliance of courts and legal commentators on *Southern v. How* as the initial basis for Anglo-American trademark law and the law of unfair competition due to the unavailing mysteries created by differing reports of the case).

10. 107 Eng. Rep. 834 (K.B. 1824).

11. SCHECHTER, *supra* note 1, at 137.

12. See SCHECHTER, *supra* note 1, at 6-10, 123; see also discussion *infra* notes 50-75 and accompanying text (providing a historical demonstration of how the courts and trademark scholars have treated the case). Schechter, who argued that the usage and regulation of trademarks by medieval and renaissance guilds established the antiquity of trademark law in England and throughout Europe, nevertheless stated that most commen-

We can now dispense altogether with *Southern v. How*, in favor of *Sandforth's Case*. There is now little doubt that *Sandforth's Case* was the very case to which Judge Dodderidge made brief reference in *Southern v. How*.<sup>13</sup> *Sandforth's Case* conclusively demonstrates that the English courts recognized a common law right against trademark infringement as early as 1584, some two hundred and fifty years before the Industrial Revolution caused a surge in the development of this area of the law on both sides of the Atlantic.<sup>14</sup> Ironically, like *Southern v. How*, one of the two extant abstracts of *Sandforth* makes brief reference to an unreported case involving counterfeiting activity, apparently heard in the House of Commons in 1558.<sup>15</sup> While it may be another four hundred years before this even earlier case surfaces, the brief treatment of the parliamentary action in *Sandforth's Case* strengthens the conclusion that trademark infringement and unfair competition was a violation of English law as early as the mid-sixteenth century.

This Article introduces *Sandforth's Case* to practitioners and trademark scholars and provides a brief analysis of the case, particularly in the contexts of sixteenth century commerce and law reporting. Part I explores the problems posed by, and the historical treatment accorded to, the brief reference of the case that appeared in *Southern v. How*. Part II introduces *Sandforth's Case* as the true

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tators assign the origin of the common law protection of trademarks to the early nineteenth century. SCHECHTER, *supra* note 1, at 11, 16. According to Schechter:

[T]hose who have attained pre-eminence either as practitioners or as text-writers of trade-mark law have with few exceptions been quite content to regard that law as practically the creation of the nineteenth century, without attempting in any way to ascertain the extent to which trade-marks had been used prior to the nineteenth century, the functions or purposes which these trade-marks had served and the methods, if any, by which they came under any form of legal protection or surveillance.

*Id.*; see also DUNCAN MACKENZIE KERLY, LAW OF TRADE MARKS AND TRADE NAMES 2 (5th ed. 1923) (stating that “[t]he law on this subject cannot be traced back further than the nineteenth century”); SEBASTIAN, TRADE MARK REGISTRATION 3 (2d ed. 1922) (stating that “it is possible that this right [to trademark protection] was recognized as early as the reign of Queen Elizabeth; it was at any rate established in 1833”).

13. See BAKER & MILSOM, *supra* note 2, at 617 n.18.

14. See *infra* notes 101-142 and accompanying text (providing a comprehensive analysis of *Sandforth's Case*).

15. *Sandforth's Case*, *Cory's Entries*, HLS MS. 5048, fo. 118v, reprinted in BAKER & MILSOM, *supra* note 2, at 615.

foundation of Anglo-American trademark law, yet never cited by any English or American court. Part III explores the impact of *Sandforth's Case* and demonstrates that it clearly established trademark infringement as a violation of sixteenth century common law. This Article concludes that *Sandforth's Case* is the bridge, sought by legal scholars, between trademark regulation by the medieval English trade guilds and the birth of modern trademark jurisprudence in the common law courts of the nineteenth century.

I. *SOUTHERN V. HOW*: THE BASIS OF TRADEMARK LAW OR “AN IRRELEVANT DICTUM OF A REMINISCENT JUDGE”?

For centuries, the case of *Southern v. How* has been subject to significant controversy.<sup>16</sup> The question at the center of this unending debate is whether the case demonstrates that the English common law of the sixteenth and seventeenth centuries cultivated a tort of trademark infringement and unfair competition, or whether the case should be discarded as nothing more than a vehicle for an irrelevant, highly ambiguous piece of legal gossip.<sup>17</sup> Whatever the answer was during the 380 year period since the case was first heard, there is no question that, until now, *Southern v. How* has been universally regarded as the first to make reference to an action at law involving what we would call trademark infringement.<sup>18</sup>

A. *The Reporting of Southern v. How*

*Southern v. How* has historically engendered controversy as to its value in the development of Anglo-American trademark law because the case was reported in at least five abstracts by four different chroniclers at five different times.<sup>19</sup> As one may expect, each of the five versions of the case differs in its treatment of an

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16. See discussion *infra* notes 51-76 and accompanying text (analyzing the continuing controversy on the relevance of the case to origins of trademark law).

17. See SCHECHTER, *supra* note 1, at 7-12, 123-26 (characterizing the import of the case in the development of Anglo-American law of trademarks as “an irrelevant dictum of a reminiscent judge”).

18. See GILSON, *supra* note 4, at § 1.01[1]; see also MCCARTHY, *supra* note 4, at § 5:2; SCHECHTER, *supra* note 1, at 9-11.

19. See discussion *infra* notes 21-48 and accompanying text (examining the five reported versions of the case); see also *supra* note 3 (citing the five versions of *Sandforth's Case*).

earlier, unnamed, unreported case during the reign of Elizabeth I. Two of the versions do not even mention the earlier case; of the three that do make reference to the earlier case, one indicates that the senior user of the infringed mark was the plaintiff in the case, while two state that the plaintiff was a purchaser of the infringing goods. The differing versions do not even agree on the year the case was decided.<sup>20</sup>

The first published abstract of *Southern v. How* appeared in *Popham's Reports* in 1656.<sup>21</sup> That report assigns the decision to Trinity term, 15 Jac. I,<sup>22</sup> that is, 1618. The case was a suit heard by the King's Bench involving a civil charge of deceit. The plaintiff alleged that the defendant, through his servant, sold him counterfeit jewels.

Although *Southern v. How* was not in any sense a case involving trademarks, Judge Dodderidge recalled in dicta an earlier case, which he assumed to be an action heard on the tort of deceit.<sup>23</sup> According to the abstract in *Popham's Report*, that earlier action was brought in the Court of Common Pleas by a "clothier," who (1) had gained a "great reputation" as a skilled clothier, (2) "had

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20. In fact, there is a discrepancy between the five abstracts even as to the year that *Southern v. How* was heard.

21. *Popham's Reports* 143, 79 Eng. Rep. 1243. *Popham's Reports* is an important collection of numerous abstracts of early common law cases. But the author, Popham, did not report the case of *Southern v. How*, which was actually published after his death. The abstract had been reported presumably by successors of Popham's enterprise and included in the book under a section entitled "Some Remarkable Cases Reported by Other Learned Pens Since His Death."

22. The term "15 Jac. I" refers to the 15th year of the reign of James I.

23. See *infra* notes 27-28 and accompanying text (discussing the nature of the common law tort of deceit during the sixteenth century). According to the opinion reported in *Popham's Reports*:

Dod[d]eridge said, that 22 Eliz., the action upon the case was brought in the [Court of] Common Pleas by a clothier, that whereas he had gained great reputation for his making of his cloth by reason whereof he had great utterance to his benefit and profit, and that he used to set his mark on his cloth whereby it should be known to be his cloth; and another clothier, observing it, used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie.

*Southern v. How*, *Popham's Reports*, at 144, 79 Eng. Rep. at 1244. The term "22 Eliz." refers to the twenty-second year of the reign of Elizabeth I, that is, 1580.



great utterance to his benefit and profit,”<sup>24</sup> and (3) affixed “his mark on his cloth whereby it should be known to be his cloth,” against another clothier who, upon “observing [the other clothier’s mark], used the same mark to his ill-made cloth on purpose to deceive him.”<sup>25</sup> In that case, “it was resolved that the action did well lie.”<sup>26</sup>

The abstract of *Southern v. How* in *Popham’s Reports* makes clear that the plaintiff in the earlier, unnamed case is the senior trademark user and not a consumer, but the reference appears to state that the action was one that fit into the developing doctrine of tortious deceit.<sup>27</sup> There is no indication in the abstract that the case occupied a new cause of action for trademark infringement or unfair competition, though this is a possibility.<sup>28</sup> Nevertheless, Dod-

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24. *Id.* The phrase “great utterance” undoubtedly means the clothier attained a high level of fame for his cloths and success in his business. See WEBSTER’S THIRD NEW INT’L DICTIONARY 2526 (1986) (defining utterance as “the sale or disposal (as of goods or commodities) to the public”).

25. *Popham’s Reports*, at 144, 79 Eng. Rep. at 1244.

26. *Id.*

27. The tort of deceit has a long and meandering history. Over time, a line of cases generated a doctrine that an action for deceit would lie where a seller of merchandise warranted the quality or character of his merchandise, but later delivered goods of lesser quality. Some early cases also required privity, or a relation of trust, between the parties at suit. See, e.g., BAKER & MILSOM, *supra* note 2, at 506-23.

28. At this period of English legal history, a warranty of quality and some form of privity between the parties were usually required before an action for deceit would lie. See *supra* note 27 (discussing prior and contemporaneous cases that require a warranty and privity for the tort of deceit in commercial transactions); see also Paula J. Dalley, *The Law of Deceit, 1790-1860: Continuity Amidst Change*, 39 AM. J. LEGAL HIST. 405, 412-13 (1995) (stating that during the Medieval and Renaissance periods, the tort of deceit required proof of a warranty). According to Dalley, *Southern v. How* was the only reported case of the period in which an action laid for deceit, merely on the basis of the defendant’s scienter, without any showing of a warranty. *Id.* at 412-13. Some cases, however, appear to have sounded in deceit where no warranty existed but where the defendant had actual knowledge that the merchandise sold contained a defect. See *Caryll’s Reports*, Keil 91, pl. 16 (1505). Despite this anomaly, ordinarily the cases of the period required a warranty. The account in *Popham’s* indicates that the plaintiff was the senior user of the mark and makes no mention of any warranty made by either party or any prior relationship of trust or privity. *Southern v. How*, *Popham’s Reports* 144, 79 Eng. Rep. 1244. It may be that the common law tort of commercial deceit was expanding at this time to include cases where no warranty or privity needed to exist between the parties. Alternatively, the unnamed case *Dodderidge* cited may have recognized a new cause of action, beyond the established common law tort of deceit. See discussion *infra* notes 143-151 and accompanying text for an analysis of this possibility.

deridge appears to characterize the action as an intentional deceit on the senior trademark user by the defendant.

The second report of *Southern v. How* appeared in *J. Bridgeman's Reports*, published in 1659, four years after the *Popham's* version appeared.<sup>29</sup> The *Bridgeman's* abstract cites *Southern v. How* as decided in 1616,<sup>30</sup> two years before the date ascribed by the abstract in *Popham's Reports*. This report of the case makes no reference to Judge Dodderidge's discussion of the earlier clothier's case, and is therefore of little use except to demonstrate the inconsistencies in the five reports of *Southern v. How*.

The third abstract of the case was published in *Croke's Reports*, also in 1659.<sup>31</sup> The *Croke's* version, like that in *Popham's*, indicates that *Southern v. How* was heard in the year 1618 and, like the abstract in *Popham's*, it included a reference to Judge Dodderidge's discussion in dicta of an earlier clothier's case. The *Croke's* version of the earlier clothier's case, however, contains striking inconsistencies with the *Popham's* version.

According to the version in *Croke's Reports*, Judge Dodderidge referred to a case from the Court of Common Pleas, in which (1) "a clothier of Gloucestershire sold very good cloth, so that in London if they saw any cloth of his mark they would buy it without searching thereof;"<sup>32</sup> (2) "another who made ill cloth put his

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29. *Southern v. How*, *J. Bridgeman's Reports*, 125, 123 Eng. Rep. 1248.

30. The abstract indicates that the case was heard during the Hilary Term, "13 Jac. I," that is, during the thirteenth year of the reign of James I.

31. *Southern v. How*, *Cro. Jac.* 468, 79 Eng. Rep. 400. According to *Croke's Reports*:

Dodderidge cited a case to be adjudged 33 Eliz. in the [Court of] Common Pleas: a clothier of Gloucestershire sold very good cloth, so that in London if they saw any cloth of his mark they would buy it without searching thereof; and another who made ill cloth put his mark upon it without his [the senior user's] privity; and an action upon the case was brought by him who bought the cloth, for this deceit; and adjudged maintainable.

*Id.* at 471, 79 Eng. Rep. at 402. The term "33 Eliz." indicates that the case was heard during the thirty-third year of the reign of Elizabeth I, that is, in 1591.

32. *Id.* Presumably the term "they" means consumers or retailers of cloth. As a whole, this statement probably means that prospective consumers or retailers relied on the trademark appearing on the cloth to signify the quality of the cloth, thereby alleviating the need to diligently inspect the goods to assure themselves of the quality of each individual article.

mark upon it without his [the senior user's] privity;"<sup>33</sup> and (3)"an action upon the case was brought by him who bought the cloth, for this deceit."<sup>34</sup> Also, as in the *Popham's* abstract, the case was "adjudged maintainable."<sup>35</sup>

*Croke's* abstract of *Southern v. How* includes certain details of the earlier clothier's case which the *Popham's* version did not provide. For example, a more definite picture of the plaintiff in that case has emerged, to wit, that (1) he was a clothier from Gloucestershire, (2) he sold his goods beyond his locale—specifically in London, (3) he had a considerable reputation for the quality of his cloths, and (4) he used his mark to embody the good-will and fame of his business.<sup>36</sup> Another very interesting difference between *Croke's* version and that of *Popham* is that *Croke's* report identifies the plaintiff as the *purchaser* of the infringing cloths, not the senior user of the mark. This version of the unnamed clothier's case, therefore, found that consumers of infringing goods could have an action for deceit against the infringer, although it is not clear from *Croke's* account whether the senior user of the mark could likewise find relief at law.<sup>37</sup> Unsurprisingly, the discrepancy between the versions as to the identity of the plaintiff became the most contentious aspect of the controversy surrounding *Southern v. How*.<sup>38</sup> Be that as it may, we know that Anglo-American trademark law certainly did not develop in accordance with *Croke's* version.<sup>39</sup>

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33. *Id.* In other words, without authorization. This language may offer a slight hint that it was commonplace for manufacturers of cloths to contract with others regarding the use of their trademarks.

34. *Id.*

35. *Id.*

36. *Id.*

37. Allowing a purchaser of inferior merchandise an action for deceit against an infringer who uses a mark, known to convey a reputation of quality, seems to fit better within the doctrine of the tort of deceit as developed by the seventeenth century. In such a case, the trademark could be viewed as serving as an acceptable type of warranty and there would be privity between the infringer and the purchaser. See *supra* note 27 (discussing cases requiring the existence of a warranty and privity in cases involving deceit).

38. See GILSON, *supra* note 4, at § 1.01[1]; see also SCHECHTER, *supra* note 1, at 8-10.

39. See generally *Colligan v. Activities Club of New York, Ltd.*, 442 F.2d 686, 170 U.S.P.Q. 113 (2d Cir.), *cert. denied*, 404 U.S. 1004 (1971) (holding that consumers have no standing to bring an action for trademark infringement); GILSON, *supra* note 4, §

The last two abstracts of *Southern v. How* appeared in *Rolle's Reports*, which was published in 1676. The two reports are not consistent. The first of the two abstracts agrees with *Popham's* version, which stated that *Southern v. How* was heard in 1618, but like the abstract published in *J. Bridgeman's Reports*, this report fails to mention Judge Dodderidge's dictum about the earlier clothier's case.<sup>40</sup> The second *Rolle's* abstract, however, assigns the date of *Southern v. How* as 1619,<sup>41</sup> and does in fact refer to Dodderidge's comments on the earlier case.<sup>42</sup>

As reported in the second *Rolle's* abstract, Justice Dodderidge referred to a case in the Court of Common Pleas involving "a clothier of Gloucester [who] made cloths which were more expensive and more saleable than the cloths of any other, and he put a special mark on them which no other clothier had before that."<sup>43</sup> Subsequently, "[another] clothier had counterfeited said mark and placed it on his cloths, which were not as good but which he sold at the same price as the other by this deceit."<sup>44</sup> The second *Rolle's* abstract concluded, likewise to the abstracts in *Popham's* and *Croke's*, that an action "was deemed . . . against" the defendant "in this case," but, unlike the *Popham's* and *Croke's* abstracts, Judge Dodderidge "did not say by which of the two the action was

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1.01[1] (noting that courts have not yet recognized a consumer's action for trademark infringement). Gilson states that the idea of permitting consumers to sue for trademark infringement is "a concept so advanced that even today in the age of consumerism the courts have not yet come to recognize it." GILSON, *supra* note 4, at § 1.01[1].

40. *Southern v. How*, 2 *Rolle's Reports* 5, 81 Eng. Rep. 621.

41. This abstract indicates that the case was heard during the Trinity Term, "16 Jac. I," that is, during the sixteenth year of the reign of James I.

42. *Southern v. How*, 2 *Rolle's Reports* 26, 81 Eng. Rep. 635. According to the second abstract in *Rolle's Reports*:

Justice Dod[d]eridge in 23 Eliz. in the [Court of] Common Pleas; the case was that a clothier of Gloucester made cloths which were more expensive and more saleable than the cloths of any other, and he put a special mark on them which no other clothier had before that; and after a [another] clothier had counterfeited said mark and placed it on his cloths, which were not as good but which he sold at the same price as the other by this deceit; [it] was deemed that the action was against him in this case, but Mr. Justice Dod[d]eridge did not say by which of the two the action was brought, i.e. by the clothier who first had the mark, or by the purchaser, although it seems to have been by the purchaser.

*Id.* This abstract reports that the earlier case was heard in 1581.

43. *Id.*

44. *Id.*

brought, i.e., by the clothier who first had the mark, or by the purchaser, although it seems to have been by the purchaser.”<sup>45</sup>

The second *Rolle's* abstract points to two further aspects of the senior trademark user: (1) his cloths were reputed to be the most expensive and famous in the region, and (2) he apparently had the exclusive use of his mark as applied to cloths. That report also suggests that the defendant passed-off his inferior infringing cloths at the same price as the senior user's cloths. It seems clear that Rolle was familiar with the previously reported abstracts because he specifically highlighted the discrepancy between the report in *Popham* and the abstract in *Croke's* on the issue of who the plaintiff was.<sup>46</sup> Rolle awkwardly posited that Dodderidge failed to indicate whether the plaintiff in the earlier case was the senior trademark user or a duped purchaser, although he proffered his own opinion that it was the purchaser.<sup>47</sup>

As demonstrated above, the five extant abstracts of *Southern v. How* are rife with inconsistencies. Despite the conflicting reports, the case has been universally cited as the foundation for the development of the Anglo-American law of trademarks and unfair competition.<sup>48</sup> In response, Frank Schechter and other commentators have pointed out that the conflicting accounts of *Southern v. How* render the case an enfeebled and worthless precedent on which to

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45. *Id.*

46. The publication of *Rolle's Reports* was pre-dated by *Popham's Reports* by 20 years and *Croke's Reports* by 15 years.

47. Rolle may have favored *Croke's* view that the purchaser was the plaintiff because such a view would fit better within the action for deceit as developed by 1676. See *supra* notes 27, 28, 37 (discussing the general requirements of a warranty and privity between the parties for an action in deceit to lie).

48. See, e.g., SCHECHTER, *supra* note 1, at 9. Schechter, who apparently had grave misgivings about assigning an important historical role to *Southern v. How* because of the mass of inconsistencies appearing between the five different reports, lamented:

Despite the fact that Dodderidge's reminiscence,—whatever it was—was pure dictum, and despite the conflict of evidence as to what the dictum was, *Southern v. How* appears to have acquired considerable weight as authority for the proposition that the unauthorized use of a trade-mark is unlawful and may be the subject of an action in deceit.

*Id.* Schechter added that “[t]he English Courts have unequivocally relied upon the authority in *Southern v. How* to establish the antiquity of their jurisdiction to prevent trade-mark piracy.” *Id.*

lay the foundation of trademark law.<sup>49</sup>

B. *The Historical Treatment of Southern v. How By Courts and Legal Scholars*

The earliest court decisions bearing on the law of trademarks and unfair competition make copious references to *Southern v. How* as primary authority to grant legal and equitable relief for an infringer's misappropriation of another's trade identity.<sup>50</sup> The case of *Blanchard v. Hill*,<sup>51</sup> the first case to cite *Southern v. How*, is generally regarded as the second English case on trademarks to be reported.<sup>52</sup> That case, dated 1742, involved a suit for an injunction by a playing card merchant against another for use of the mark "GREAT MOGUL" on playing cards.<sup>53</sup>

In denying the injunction, Lord Chancellor Hardwicke declared, "I do not know of any instance of granting an injunction here, to restrain one trader from using the same mark with another; and I think it would be of mischievous consequence to do it."<sup>54</sup> The plaintiff's attorney, in support of the injunction, cited the unnamed reference in *Southern v. How*, to which the Lord Chancellor

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49. *Id.* at 8-9; see *infra* notes 66-76 and accompanying text (discussing the hostility by some commentators to *Southern v. How*).

50. See SCHECHTER, *supra* note 1, at 9-12 (discussing nineteenth century English cases declaring that *Southern v. How* is the starting point for the law of trademarks).

51. 26 Eng. Rep. 692 (Ch. 1742).

52. *Id.* The case was dismissed by a court of equity for lack of jurisdiction.

53. *Id.* at 693. The senior user of the mark claimed a privilege of monopoly to the use of the mark by virtue of the grant of a royal charter bestowed during the seventeenth century upon his company, which apparently provided for the exclusive use of the "GREAT MOGUL" mark on playing cards. *Id.* Although Lord Chancellor Hardwicke found that the charter was valid insofar as the creation of the company, he emphatically denied that a royal grant of monopoly to a trademark was legal. *Id.*

54. *Id.* Some commentators suggest that Lord Chancellor Hardwicke's denial of an injunction demonstrated that an action for trademark infringement was essentially legal during this early period and not susceptible to the courts of equity. See, e.g., Gary M. Ropski, *The Federal Trademark Jury Trial—Awakening of a Dormant Constitutional Right*, 70 TRADEMARK REP. 177, 179-80 (1980). Such a claim overstates the significance of Lord Chancellor Hardwicke's comments. By the time that *Blanchard v. Hill* was heard, the courts, both legal and chancery, became quite hostile to any past monopolies granted by the monarchy and not granted by a statute of Parliament. See *Motte v. Bennett*, 17 F. Cas. 909, 913-14 (D.S.C. 1849) (discussing the hostility in the English courts of equity to any royal grants of monopoly rights). In some senses, *Blanchard v. Hill* is as much a political decision as one based on the principles of equity.

Hardwicke commented, “[b]ut it was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier.”<sup>55</sup> By thus distinguishing the circumstances of the unnamed case discussed in Dodderidge’s dictum in *Southern v. How* from the facts of *Blanchard v. Hill*, Lord Chancellor Hardwicke suggested that had the defendant playing card merchant used the “GREAT MOGUL” mark to pass off his cards as those of the plaintiff, then an action at law, if not in equity, could indeed lie.<sup>56</sup> If this is the case, Lord Chancellor Hardwicke recognized *Southern v. How* as valid precedent for an action of unfair competition.

The third reported action for trademark infringement, *Singleton v. Bolton*,<sup>57</sup> was heard in 1783. Although the abstract does not mention *Southern v. How*, Lord Mansfield stated that “if the defendant had sold a medicine of his own under the plaintiff’s name or mark, that would be a fraud for which an action would lie.”<sup>58</sup> The next six English cases bearing on the law of trademarks or unfair competition seem to display a judicial ambivalence to the value of *Southern v. How*; most fail to cite it at all, and the two that do reference the case cite it in passing and attach no significance to it.<sup>59</sup>

By the 1840s, the courts in both Great Britain and the United States, finding a need to establish “the antiquity of their jurisdiction to prevent trade-mark piracy,”<sup>60</sup> began paying homage to *Southern v. How* as the foundation for granting relief against

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55. *Blanchard*, 26 Eng. Rep. at 693.

56. See D.M. KERLY, LAW OF TRADE MARKS AND TRADE NAMES 2 (T.A. Blanco White & Robin Jacobs eds., 12th ed. 1986).

57. 99 Eng. Rep. 661 (K.B. 1783).

58. *Id.* (footnote omitted).

59. See *Blofeld v. Payne*, 110 Eng. Rep. 509 (K.B. 1833) (failing to mention *Southern v. How*); *Sykes v. Sykes*, 107 Eng. Rep. 834 (K.B. 1824) (failing to mention *Southern v. How*); *Seddon v. Senate*, 104 Eng. Rep. 290 (K.B. 1810) (failing to mention *Southern v. How*); *Motley v. Downman*, 40 Eng. Rep. 824 (Ch. 1837) (citing and providing details of *Southern v. How*); *Canham v. Jones*, 35 Eng. Rep. 302 (Ch. 1813) (declaring the argument made by the defendant’s attorney that *Southern v. How* requires that the infringing goods be inferior and not merely bear a spurious mark); *Hogg v. Kirby*, 32 Eng. Rep. 336 (Ch. 1803) (failing to mention *Southern v. How*).

60. SCHECHTER, *supra* note 1, at 9.

trademark infringement or unfair competition.<sup>61</sup> During the twentieth century, the courts continued to cite *Southern v. How* as the starting point of common law recognition of trademark rights.<sup>62</sup> Even in the 1990s, judicial recognition of *Southern v. How* as the foundation for Anglo-American trademark rights apparently still has significant impetus.<sup>63</sup>

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61. See *Fowle v. Spear*, 9 F. Cas. 611, 612 (C.C.E.D. Penn. 1847) (No. 4,996); *Taylor v. Carpenter*, 23 F. Cas. 744, 748 (C.C.D. Mass. 1846) (No. 13,785); *Taylor v. Carpenter*, 23 F. Cas. 742 (C.C.D. Mass. 1844) (No. 13,784) (Storey, J.); *Clinton Metallic Paint Co. v. New York Metallic Paint Co.*, 50 N.Y.S. 437, 442 (N.Y. Sup. Ct. 1898) (declaring that the common law of trademark infringement dates back “as early as 1590” to the *Southern v. How* case, as reported in *Popham’s Reports*); *Crawshay v. Thompson*, 134 Eng. Rep. 146, 157-58 (C.P. 1842); *Hall v. Barrows*, 32 L.J.K.B. 548, 551 (Ch. 1863) (stating that “[i]t was established as early as *Popham’s Reports* that an action at law would lie for the piracy of a trade-mark”); *Burgess v. Burgess*, 43 Eng. Rep. 351, 353 (Ch. 1853) (declaring that the “law on the subject [of trademark infringement] is as old as *Southern v. How* in *Popham’s Reports*”); *Hirst v. Denham*, 14 L.R.-Eq. 542, 549 (M.R. 1872). Some attorneys during this period thought the case could be used in fields beyond mere trademark law. In 1839, the plaintiff in a case involving the fraudulent sale of a human slave in Washington, D.C., apparently found something in *Southern v. How* to support his argument that the buyer of the slave deceived the plaintiff into under-pricing the slave. See *Fenwick v. Grimes*, 8 F. Cas. 1144, 1145 (C.C.D.C. 1839) (No. 4,734).

62. See *Magnolia Metal Co. v. Tandem Smelting Synd., Ltd.*, 17 R.P.C. 477, 483-84 (1900). In this case, Lord Halsbury, citing *Southern v. How*, waxes poetic, if somewhat ineloquently, on the antiquity of the British common law of trademarks stating:

[T]hat cause of action is, as I have said, a very old and a familiar one . . . . Going back, therefore, as far as the reign of Elizabeth the form of action which the Statement of Claim adopts has undoubtedly been a form of action in which if the right of a man to have the reputation of selling that which is his manufacture as his manufacture, the right to prevent other people [from] fraudulently stating that it is their manufacture when it is not—if that right is infringed there is a remedy. That has, as I have said, ever since the reign of Elizabeth, been established in our Courts as being a right of action upon which anybody may sue who has a ground for doing so.

*Id.* at 484; see also *Stephano Bros., Inc. v. Stamatopoulos*, 238 F. 89, 91 (2d Cir. 1916) (“The right to an exclusive trade-mark is not one created by act of Congress. It is a right which the common-law courts recognized at an early day.” (citing *Southern v. How*, *Popham’s Reports* 143 (1582))); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 520 F. Supp. 395, 397 (D. Utah 1981) (citing *Southern v. How* to establish the root of the common law prohibition against passing-off).

63. See *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 354 n.1 (Fed. Cir. 1992). Judge Rader stated:

In this earliest reference to trademarks in the King’s courts, the Judge sustained the action of a high-quality clothier against a maker of ill-made cloth who affixed the mark of the high-grade clothier to inferior products. This early case illustrates that trademarks function as guarantors of quality, suppliers of infor-



Although some trademark scholars have slavishly followed the view of the courts that *Southern v. How* has significant value in establishing the earliest common law of trademarks and unfair competition,<sup>64</sup> others have merely cited the case as a potential starting point for the law.<sup>65</sup> Still other scholars have been even more ambivalent about the import of the case and have been skeptical to assigning it much value at all. The most hostile treatment of the case comes from Frank Schechter's book *The Historical Foundations of the Law Relating to Trade-Marks*,<sup>66</sup> which, after almost seventy-five years, remains the most comprehensive and reliable source on the subject. Assigning the case to the trash bin of irrelevancy, Schechter devoted more than seven pages of his book to discredit-

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mation to consumers seeking a reliable source of products, insurers of proper allocation of reward to investors in the good will and reputation of a trade name, in short, preservers of property rights and responsibilities.

*Id.* It is unlikely that anyone anticipated in 1618, when *Southern v. How* was heard, that Judge Dodderidge's dictum could amount to so much. The musical group New Kids on the Block would probably hope that the case provided even greater scope than that accorded to it by Judge Rader. See *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992) (citing *Southern v. How* and stating that "[t]he law has protected trademarks since the early seventeenth century, and the primary focus of trademark law has been misappropriation—the problem of one producer's placing his rival's mark on his own goods"). Unfortunately for the New Kids on the Block, the courts have never declared *Southern v. How* to prohibit non-trademark use of someone else's mark. *Id.*

64. See HOPKINS, *supra* note 4, at 12-13; Kenneth R. Pierce, *The Trademark Law Revision Act: Origins of the Use Requirement and an Overview of the New Federal Trademark Law*, 64 FLA. B.J. 35, 36 (1990); Kenneth L. Port, *Foreword to Symposium on Intellectual Property Law Theory*, 68 CHI.-KENT L. REV. 585, 595 (1993) (erroneously stating that the judgment of the unnamed case cited by Judge Dodderidge in *Southern v. How* was decided in the defendant's favor); Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519, 522 (1993) (repeating the same error); Andrew Ruff, Comment, *Releasing the Grays: In Support of Legalizing Parallel Imports*, 11 U.C.L.A. PAC. BASIN L.J. 119, 129 n.66 (1992).

65. See GILSON, *supra* note 4, at § 1.01[1]; MCCARTHY, *supra* note 4, at § 5:2; BEVERLY W. PATTISHALL ET AL., TRADEMARKS AND UNFAIR COMPETITION 2 (2d ed. 1994); EDWARD S. ROGERS, GOOD WILL TRADE-MARKS AND UNFAIR TRADING 34 (1914); Sidney A. Diamond, *The Historical Developments of Trademarks*, 65 TRADEMARK REP. 265, 287 n.63 (1975); James M. Koelemay, Jr., *Monetary Relief for Trademark Infringement Under the Lanham Act*, 72 TRADEMARK REP. 458, 460 n.7 (1982); Rembert Meyer-Rochow, *Passing Off—Past, Present and Future*, 84 TRADEMARK REP. 38 (1994); Beverly W. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 TRADEMARK REP. 456, 457 (1988); Ropski, *supra* note 54, at 179.

66. SCHECHTER, *supra* note 1.

ing *Southern v. How* as a reliable foundation of Anglo-American trademark law.<sup>67</sup> He emphatically stated that “the sole contribution of that case was at best an irrelevant dictum of a reminiscent judge . . . .”<sup>68</sup>

Much of Schechter’s hostility to the level of authority *Southern v. How* has traditionally enjoyed is apparently the result of his frustration with the inconsistencies of the five accounts of the case.<sup>69</sup> Schechter summarized “the remarkable discrepancies occurring in the reports of this case” in four points. First, Schechter noted that “[t]hree of the five reports contain no reference whatsoever to the clothier’s case in Elizabeth[’s reign].”<sup>70</sup> Second, of those three reports, although the *Popham*’s abstract “definitely states the action to have been by the clothier whose mark had been infringed,” Schechter highlighted that the *Croke*’s abstract “is equally definite that the action was by the defrauded purchaser,” and the second *Rolle*’s abstract, “while not perhaps so positive in this regard, like-

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67. *Id.* at 9-12, 123-26. Other commentators have agreed with this analysis. See DUNCAN MACKENZIE KERLY, KERLY’S LAW OF TRADE MARKS AND TRADE NAMES 2 (7th ed. 1951); Benjamin G. Paster, *Trademark’s—Their Early History*, 59 TRADEMARK REP. 551, 562-63 (1969) (closely following Schechter’s analysis of the case); Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 9 MICH. L.R. 29 (1910), reprinted in 62 TRADEMARK REP. 239, 251 n.30 (1972).

68. SCHECHTER, *supra* note 1, at 123.

69. *Id.* at 9-10, 123. In regard to the inconsistencies between the five accounts of *Southern v. How*, Schechter stated:

To sum up the remarkable discrepancies occurring in the reports of this case:

(1) Three of the five reports contain no reference whatsoever to the clothier’s case in Elizabeth[’s reign]. (2) Of these three reports only one (*Popham*) definitely states the action to have been by the clothier whose mark had been infringed. Of the two others, one (*Croke*) is equally definite that the action was by the defrauded purchaser, and the other (*2 Rolle* 26), while not perhaps so positive in this regard, like-wise believes that the action was made by the vendee. (3) *Popham* reports Dodderidge to have remembered that the clothier’s action occurred in 22 Elizabeth, *2 Rolle* says 23 Elizabeth, while *Croke*’s report states 33 Elizabeth. (4) Only two of the five reports (*Popham* and *2 Rolle* 5) agree that *Southern v. How* was decided in 15 Jac. I, the other three reports giving other and different dates for the decision.

*Id.* at 8-9.

70. *Id.* Only two abstracts of the case fail to mention Dodderidge’s dictum of the earlier unnamed clothier’s case. See *supra* notes 19-47 and accompanying text (providing a discussion of the five accounts of the case). It is fairly clear from this passage that Schechter meant to say that only three of the cases *did* mention the earlier case.

wise believes that the action was made by the vendee.”<sup>71</sup> Third, Schechter took offense to the discrepancies between the timing of the action, that is, whether “the clothier’s action occurred in 22 Elizabeth, . . . 23 Elizabeth, . . . [or] 33 Elizabeth.”<sup>72</sup> Finally, Schechter observed that “[o]nly two of the five reports (*Popham* and 2 *Rolle* 5) agree that *Southern v. How* was decided in 15 Jac. I, the other three reports giving . . . different dates for the decision.”<sup>73</sup>

Although Schechter’s frustration is justified, it is far from clear why he devoted so much effort to dislodge the case from its precedential pedestal. Because the three versions of *Southern v. How* only included a very brief, ambiguous account of the earlier unnamed action, the case could not help being what Schechter called “a most fragile link between the Middle Ages and the modern commercial law of trade-marks.” Discrediting *Southern v. How* could not change this fact. True to his progressive nature, however, Schechter ended his treatment of *Southern v. How* on a positive, hopeful note.<sup>74</sup> Referring to the missing bridge between the guild jurisprudence of trademark law<sup>75</sup> and common law protection, Schechter predicted that “[f]urther researches into the history of the clothier’s case mentioned in *Southern v. How* on the one hand, and into the contemporaneous activity of the councilor courts in the protection of trade-marks on the other, may possibly ultimately furnish a satisfactory solution of our problem.”<sup>76</sup>

Research during the late 1970s and early 1980s did exactly what Schechter had anticipated. Like a phoenix, rising out of some “moldering mass of unpublished records of the common law” the

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71. SCHECHTER, *supra* note 1, at 8-9.

72. *Id.*

73. *Id.*

74. *Id.* at 123. Schechter appeared sincere in stating that he hoped that the unnamed clothier’s case made reference to by Judge Dodderidge in *Southern v. How* would be unearthed sometime in the future. Along these lines, Schechter stated that:

It is possible that some day in some moldering mass of unpublished records of the common law may be found a report of a case in the reign of Elizabeth by a clothier for infringement of his trade-mark that will justify the authority with which *Southern v. How* has been so unanimously endowed.

*Id.*

75. *See id.* at 38-77 (discussing the use and protection of marks within individual guilds during early English history).

76. *Id.* at 126.

case of *Sandforth* slipped into the hands of an enterprising legal history scholar who translated the documents and published them for posterity. Frank Schechter, in the end, shall have his way. *Southern v. How* finally can be supplanted in the annals of trademark law by the case to which it so ambiguously referred: *Sandforth's Case*.

## II. INTRODUCING *SANDFORTH'S CASE*: THE FIRST REPORTED TRADEMARK CASE IN ANGLO-AMERICAN LEGAL HISTORY

This Article embodies the first comprehensive analysis of the "lost" case that Judge Dodderidge referred to in *Southern v. How*. No English or American court has ever cited to it and the case has been ignored altogether by the mass of textbooks, treatises, law review articles, and other scholarly works in the field of trademark and unfair competition law. The emergence of *Sandforth's Case* raises questions as to why the case lay dormant from 1584 to the late 1970s and, more strikingly, why courts and trademark scholars have generally failed to take notice of the discovery of this true foundation of Anglo-American trademark law.

### A. *Explaining the Dormancy of Sandforth's Case*

In 1972, the British Legal History Conference ("Conference") was held at Aberystwyth, in Wales, to discuss the problems and progress in the scholarship of British legal history.<sup>77</sup> Since then the Conference has met at least twelve times and has generated a number of valuable collections of essays devoted to the mysteries of the history of the law in Great Britain.<sup>78</sup> Many of those essays

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77. See LAW REPORTING IN BRITAIN ix. (Chantal Stebbings ed. 1995) (reporting the proceedings of the British Legal History Conference). The British Legal History Conference ("Conference") has become the pre-eminent forum of discussion of all aspects of the history of British law. *Id.*

78. In addition to *Law Reporting in Britain*, *supra* note 77, the Conference has generated many other proceedings. See, e.g., THE LIFE OF THE LAW (Peter Birks ed. 1993) (prepared by the Conference); LEGAL HISTORY IN THE MAKING (W.M. Gordon & T.D. Fergus eds., 1991) (same); LEGAL RECORD AND HISTORICAL REALITY (Thomas G. Watkin ed. 1989) (same); THE POLITICAL CONTEXT OF LAW (Richard Eales & David Sullivan eds., 1987) (same); CUSTOMS, COURTS AND COUNSEL (A. Kiralfy et al. eds. 1985) (same); LAW, LITIGANTS AND THE LEGAL PROFESSION (E.W. Ives & A.H. Manchester eds., 1983) (same); LEGAL RECORD AND THE HISTORIAN (J.H. Baker ed. 1978) (same); LEGAL

are designed to introduce the modern legal practitioner and scholar to the earliest law reports and their importance in the development of statutory and common law over twelve centuries. Unfortunately, early English law case-reporting deficiencies, particularly during the Elizabethan period, have had a significant impact on “lost” cases, such as *Sandforth’s Case*.

### 1. The General Problem of Reporting Early Case Law

The most significant difficulty facing British legal historians is the sheer volume of unpublished accounts of early case law.<sup>79</sup> A significant amount of early legal history has never been printed and lacks an exhaustive catalogue of sources.<sup>80</sup> The next nagging problem is the discovery and collection of early reports that do exist in a plethora of institutions and private collections.<sup>81</sup>

Although the great libraries, archives, and other institutions

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HISTORY STUDIES (D. Jenkins ed. 1975) (same).

79. See PERCY H. WINFIELD, *THE CHIEF SOURCES OF ENGLISH LEGAL HISTORY* 23 (1925). Professor Winfield was one of the most respected legal historians of this century and his volume remains one of the best, most readable texts on early British law reporting. The first efforts in this area of scholarship were made between 1863 and 1879 by Alfred John Horwood who translated and published five volumes of case reports during the reign of Edward I. See Paul Brand, *The Beginnings of English Law Reporting*, in *LAW REPORTING IN BRITAIN I* (Chantal Stebbings ed. 1995). Shortly afterwards, the Selden Society was formed and began publishing translations of previously unpublished primary source materials. From the 1880s until the present, the Selden Society has presented posterity with over 100 massive volumes incorporating tens of thousands of MSS (primary legal accounts by the earliest law reporters) occupying over 100,000 pages. Many of the early cases cited in this Article were obtained from the Selden Society series, the author having perused the indices of all available volumes for relevant case materials. Despite the present availability of thousands of early case reports, an untold quantity have yet to be discovered, translated, and published. See WINFIELD, *supra*, at 23-30; Brand, *supra*, at 1.

80. The author of the present Article can personally attest that, even 70 years after Winfield lamented the absence of useful indices, the Selden Society has unfortunately failed to provide a comprehensive index of the sources published in its hundred-plus series of volumes.

81. See WINFIELD, *supra* note 79, at 23-26. Although the great British universities, namely, Oxford, Cambridge, Cantabury, etc., the British Library, the Inns of Court, and national archives hold much of the known MSS (primary legal accounts by the earliest law reporters), it is currently impossible to estimate the number of early sources that are in the possession of local institutions, ancient private library collections, which exist in large part in the manor houses of Great Britain, and foreign entities. See *id.* at 24.

probably have improved the organization and accessibility of the earliest legal records in their possession, problems still exist. Difficulties remain regarding the competent translation of legal materials.<sup>82</sup> Also of great significance are the issues associated with prioritizing the treatment of the tremendous number of unpublished materials known to exist.<sup>83</sup> Finally, injudicious editing of early reports over the past 150 years also has taken its toll on the legal history available. For example, Professor Baker, who discovered and translated *Sandforth's Case*, has criticized some editors for such unintended censorship, stating, "Unconscious censorship by printers and editors, including even Selden Society editors, has kept [some primary case reports] largely from sight."<sup>84</sup> Baker presumed that reports "seemed superfluous to the Year Books, as later understood, and so they were treated as if they were not there."<sup>85</sup>

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82. See WINFIELD, *supra* note 79, at 7-13 (discussing the language problems posed by many of the early case reports).

83. Indeed, significant problems are posed by the frequent discovery of what purports to be the same case accounts published in volumes of vastly different dates and containing varying content. Already we have seen how the five different treatments of *Southern v. How* created confusion that lasted 350 years. The severe difficulty, and resulting frustration, of getting to the core of a particular series of case reports has plagued even the most respected and competent of British legal historians. See J.H. Baker, *Some Early Newgate Reports (1315-28)*, in LAW REPORTING IN BRITAIN 35 (Chantal Stebbings ed. 1995). Using wit to conceal his frustration, Professor Baker, who incidentally is the discoverer and translator of *Sandforth's Case*, explained as follows:

I should like to dedicate this essay to the Goddess Serendipitas, who has invisibly regulated so much of my research in manuscript law reports. Twenty years ago I published a series of Newgate reports from 1616, which I had recently stumbled upon at Harvard, thinking they were the earliest of their kind. Sometime later, I found in the same remarkable Treasure Room a much shorter series of two centuries older, from 1421. I thought these were unprinted until I acquired a copy of the very rare Year Book of 9-10 Henry V published privately by Rogers in 1948; they are printed there, but I suspect they are still not widely known. More recently, while searching through manuscript Year Books in the British Library, looking for moots, I found several series from the reign of Edward II and the first year of Edward III. These, I hope and believe, are not known at all. It was quite a startling find for me, because the cases are three hundred years earlier than I began with.

*Id.*

84. *Id.* at 35.

85. *Id.*

## 2. Law Reporting During the Elizabethan Era

*Sandforth's Case* was heard during the middle of Queen Elizabeth's reign. It is true that the English common law had developed considerably during the six hundred years before Elizabeth ascended the throne in 1558. Nevertheless, the record of the law thus developed created what one scholar termed "something of a crisis" by the 1590s.<sup>86</sup> Much of the early British legal record was collected in a series of volumes called the Year Books.<sup>87</sup> One scholar, Percy Winfield,<sup>88</sup> suggests that the Year Books began coverage by 1270.<sup>89</sup> Although far from complete in their present form, those Year Books provide an indispensable chronicle of British case law for more than 250 years. The Year Books suddenly ceased, however, in 1535—twenty-three years before Elizabeth became monarch.<sup>90</sup> Ten years after the demise of the Year Books, the thirteen

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86. David Ibbetson, *Law Reporting in the 1590s*, in *LAW REPORTING IN BRITAIN 73* (Chantal Stebbings ed. 1995). Demonstrating the difficulties faced by Elizabethan lawyers and judges, Ibbetson explains:

From the point of view of those studying law, there were hardly any didactic treatises; apart from Littleton's *Tenures*, already well over a century old, and St. Germain's discursive *Doctor and Student*, the few texts which did exist were little more than collections of relevant statutes and cases. There had been no attempt to reduce the law to anything like order, so that even the best-equipped student might be well advised simply to digest anything he had read under alphabetical headings, in the hope that genuine understanding might flow from this garnering of information.

*Id.*

87. The Year Books basically incorporate abstracts and reports of varying completeness and scope of most law cases heard during each year of the reign of the sitting monarch. See WINFIELD, *supra* note 79, at 158-75 (discussing the apparent purposes and uses of the Year Books). According to Winfield:

On the whole, the contents of the Year-Books are of an intensely practical character. They take us into the law courts and keep us there. They do not impart elementary instruction, they tell us practically nothing of the theoretical foundations of the law. They record all procedural moves made in an action, and they assume a complete familiarity with the procedure on the part of the men likely to use them.

*Id.* at 161.

88. See Winfield, *supra* note 79

89. *Id.* at 158-59.

90. See *id.* at 171. Ibbetson states that, even until close to the sixteenth century, the Year Books had been published; but after 1535, they ceased to include any new case reports. Ibbetson, *supra* note 86, at 74. There was apparently a half-hearted, and ultimately unsuccessful, effort made to rejuvenate publication of the Year Books in 1679.

judges of the realm apparently lamented the void in legal reporting caused thereby.<sup>91</sup>

While the Year Books disappeared during the early sixteenth century, a series of case reports emerged and continued until the nineteenth century.<sup>92</sup> Typically, they were compiled and made available by individual legal practitioners and scholars.<sup>93</sup> Although they emerged during the sixteenth century, it was not until the seventeenth century that these new types of published case reports were able to satisfactorily replace the Year Books. Records and abstracts of law cases continued to be written in manuscript form, but not many were published in the new reporters until after the sixteenth century.<sup>94</sup> Only two volumes of reports were generated during the period between 1535 and 1590.

It is certainly not a foregone conclusion that *Sandforth's Case* would have been brought to light and used by succeeding generations had the Year Books continued to incorporate contemporaneous case reports until the end of the sixteenth century. But it can be said accurately that the decline of the Year Books fifty years before the case was heard and the paucity of the new type of case reporters in the intervening period assuredly consigned *Sandforth's Case* to oblivion for 420 years. Thus, in *Southern v. How*, Judge Dodderidge had no other alternative but to rely on his imperfect memory to invoke *Sandforth's Case* thirty-four years after it was

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See WINFIELD, *supra* note 79, at 171; 2 THE REPORTS OF SIR JOHN SPELMAN 164-78 (J.H. Baker ed. 1977) [hereinafter SPELMAN REPORTS].

91. See JOHN W. WALLACE, THE REPORTERS 78 n.2 (4th ed. 1882).

92. See WINFIELD, *supra* note 79, at 171-72 (ascribing the substitution of those series of case reports for the Year Books to the former's superior reporting and treatment of the cases heard by the courts during the mid-sixteenth century).

93. See *id.*

94. See Ibbetson, *supra* note 86, at 73-79. According to Ibbetson:

While the old Year Books continued to be produced in many editions during the rest of the century, there was very little modern material in print. Plowden's *Commentaries* had appeared in 1571 and Dyer's *Reports* in 1585, but although these were welcome additions to the canon they merely scratched the surface. The absence of recent case reports must—at the least—have inconvenienced practitioners who would have been forced to place greater reliance on the fickleness of memory.

*Id.* at 73. Winfield suggests that reliance on memory in recalling precedent was paramount even during the Year Book period because the Year Books' versions of cases suffered varying degrees of inconsistency. See WINFIELD, *supra* note 79, at 149-50.



decided.

### 3. A Problem in Modern Legal Scholarship

Although it is easy to understand how *Sandforth's Case* was lost for more than 400 years, it is more difficult to explain why the case continued to slumber twenty years after it was first discovered and identified. The first published reference to the case occurred in 1979 in J.H. Baker's survey text, *An Introduction to English Legal History*.<sup>95</sup> Professor Baker, while citing the case, provided no translation and only a scant detail of the abstract.<sup>96</sup> There was no further reference to the case until Baker, together with S.F.C. Milson, published their *Sources of English Legal History—Private Law to 1750*<sup>97</sup> seven years after Baker's prior book.

In that second book, Baker provided a complete translation of three documents that report *Sandforth's Case*. In a footnote he once again identified the case as the one referred to in *Southern v. How*.<sup>98</sup> Since 1986, however, when the second book was published, only one reference has been made to the case, and even that reference was relegated to a law review footnote.<sup>99</sup> To explain the silence surrounding *Sandforth's Case* for almost twenty years since its discovery, this Essay suggests that trademark scholars do not ordinarily peruse books on general British legal history to find support for their own literary enterprises. Moreover, as one law student once mused, trademark scholars do not possess the motivation to scour law review footnotes.<sup>100</sup>

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95. ENGLISH HISTORY I, *supra* note 2, at 385 n.45. Professor Baker identified the case as the same one cited in *Southern v. How* and recognized the case to be the first account involving trademark infringement and unfair competition. *Id.*

96. *Id.*

97. BAKER & MILSON, *supra* note 2, at 615-18.

98. *Id.* at 617 n.18.

99. See Timothy H. Hiebert, *Foundations of the Law of Parallel Importation: Duality and Universality in Nineteenth Century Trademark Law*, 80 TRADEMARK REP. 483, 492 n.45 (1990). Although Hiebert recognized that, as of 1990, "trademark historians generally have been unaware of [Baker's] significant discovery," he himself was not inclined to call much attention to that discovery. See *id.* While somewhat dismayed by Hiebert's reticence, the present author heartily thanks him for it.

100. See Phil Nichols, Note, *A Student Defense of Student Edited Journals: In Response to Professor Roger Cramton*, 1987 DUKE L.J. 1122, 1131 (1987) (confessing that "a common joke among law review editors is that no one reads footnotes anyway").

## B. *The Text of Sandforth's Case*

In his publication of the case, Professor Baker includes three extant reports that he discovered in manuscript form. He also referred to two additional manuscripts, which he did not furnish, that cite or explain the case.<sup>101</sup> Of the three documents provided by Baker, one appears to be what is considered a complaint in the United States or a statement of claim in Great Britain and Canada.<sup>102</sup> The two other documents are abstracts of the trial.

### 1. *The Sandforth Complaint*

The complaint is important in the history of trademark law.<sup>103</sup> It states that the plaintiff in *Sandforth's Case* was a "clothier" who for twelve years, manufactured "woollen cloths called Reading kerseys, 'halfes' cloths and Bridgewater,"<sup>104</sup> which "were good and substantial without any fraud or deception in that behalf . . . ."<sup>105</sup> The complaint further stated that the plaintiff "was accustomed to mark such cloths with the letters 'J.G.' and with a sign called a tucker's handle . . . ."<sup>106</sup> According to the complaint,

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101. See BAKER & MILSOM, *supra* note 2, at 615 n.13. Baker cites a case entitled *Samforde*, CUL MS. II 5. 38, fo. 132, and another entitled *Sandforth's Case*, HLS MS. 2074, fo. 84v. Since publication of his 1986 book, Professor Baker has discovered yet another brief reference to the case in BL MS. Lansdowne 1086, fo. 74v. This last reference apparently indicates that the action was heard during the Easter term, 1585, rather than in 1584, the year other sources give.

102. BAKER & MILSOM, *supra* note 2, at 615-17 (citing *Cory's Entries*, BL MS. Hargrave 123, fo. 168v. (British Library) (1584)).

103. Although the complaint in *Sandforth's Case* is lengthy, its importance to trademark law makes it worthy of review. See Appendix, *infra* pp. 545-47 for the full text of the complaint.

104. *Id.* at 615. A "kersey" is defined as a "coarse ribbed woolen cloth for hose and work clothes woven first in medieval England." WEBSTER'S THIRD NEW INT'L DICTIONARY, *supra* note 24, at 1238. The author could not locate an appropriate definition for the two other types of garments or cloths.

105. BAKER & MILSOM, *supra* note 2, at 615.

106. *Id.* at 616. The author could find no definition for a "tucker's handle." Nevertheless, potentially relevant definitions for "tucker" are (1) "an attachment on a sewing machine for making tucks," and (2) "a piece of lace or cloth used to fill in the low neck line of a dress." WEBSTER'S THIRD NEW INT'L DICTIONARY, *supra* note 24, at 2460. The latter definition asks to compare the word to the use in the phrase "bib and tucker." *Id.* Most likely, the noun "tuck," as identified in the first definition of "tucker," refers to "a fold stitched or woven into cloth for the purpose of shortening, decorating or controlling

the plaintiff sold the same cloths at home and overseas.<sup>107</sup>

The complaint asserted that the plaintiffs customers had become “accustomed” to buying “those cloths well and substantially made and from wool marked as above said,” by paying the same for those “cloths as for good and substantial cloths . . . upon the affirmation of the same plaintiff and his servants and factors that the same cloths were good and substantial, without any inspection or contradiction of the same cloths . . . .”<sup>108</sup> The complaint stated that the plaintiff had “lawfully and honestly obtained and acquired much gain and profit from the making and selling of such cloths, for the further support and living of the same plaintiff and his whole family.”<sup>109</sup>

The complaint alleged that the defendant willfully schemed and plotted “to hinder the same plaintiff in selling such cloths of his and to take away and worsen the opinion and esteem which the aforesaid merchants and subjects had concerning the cloths of the same plaintiff.”<sup>110</sup> The complaint specifically alleged that, for two years, the defendant “made various woollen cloths . . . which were ill, insufficient and unmerchantable; and deceitfully marked the same cloths with the aforesaid letters ‘J.G.’ and with the aforesaid

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fullness.” *Id.* A “tucker’s handle” could have been a tool of a clothier’s trade. Also potentially relevant is that, during the Medieval and Renaissance periods, a “tuck” was a slender sword or rapier. AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1923 (3rd ed. 1992). It is possible that the device used as part of the plaintiff’s trademark was the handle of a sword. The author leaves it to experts in the field of medieval languages to offer a reasonable semblance of what the plaintiff’s “tucker’s handle” mark may have looked like.

107. The complaints states:

[T]he same plaintiff sold the same cloths, thus made and marked, through the whole of the aforesaid time, at T. aforesaid and at C. in the aforesaid county and in various other places within this realm of England, and likewise at M. in Wales and in various other places in parts beyond the seas, as well to various merchants and other subjects of this realm of England as to various other merchants and foreigners . . . .

BAKER & MILSOM, *supra* note 2, at 616.

108. *Id.* This seems to indicate that the plaintiff argued for the inherent “informational” value his mark had in relation to consumers. In this way, the plaintiff’s customers did not need to spend time and effort inspecting the nature and quality of each cloth because the customers associated the plaintiff’s trademark with high quality goods.

109. *Id.*

110. *Id.* Thus, our first recorded infringer was allegedly willful.

mark called a tucker's handle; and exposed for sale the same cloths . . . as the cloths of the same plaintiff."<sup>111</sup>

As a result of the defendant's actions, "various merchants and other subjects who were buyers and had previously been accustomed to buy[ing] the same plaintiff's cloths," relying on the letters 'J.G.' and the tucker's handle mark to identify the plaintiff's cloths, bought the defendant's cloths after seeing the "cloths marked with the aforesaid letters 'J.G.' and the aforesaid mark called a tucker's handle."<sup>112</sup> Those buyers, who bought the defendant's cloths "without further inspection or contradiction of the same cloths, as being good and substantial cloths such as the cloths of the same plaintiff had used to be, and as being the same plaintiff's cloths," changed their opinion of the plaintiff's cloths after inspecting the cloths purchased from the defendant and finding that the cloths were "deceitful, insufficient and unmerchantable, both in length and width and in quality and substance of the same cloths."<sup>113</sup> Those purchasers "not only completely reversed the opinion and esteem which they had previously had of the same cloths but also gave notice to many other merchants and subjects of the deceitful and insufficient making of the aforesaid cloths."<sup>114</sup> Consequently, when the plaintiff attempted to sell "cloths of his (marked in form aforesaid)" he was unable to sell those "cloths (marked in form aforesaid) by reason of the deceit committed and used by the aforesaid defendant as set out above."<sup>115</sup> Thus, the plaintiff alleged that he was damaged because "the merchants and subjects aforesaid who previously used to buy such cloths from the same plaintiff refused to buy the same cloths from him by reason of the aforesaid deceit."<sup>116</sup>

Assuming that all allegations of the *Sandforth's* complaint were true, what modern trademark attorney would not welcome the opportunity to prosecute a case with such a mass of advantageous

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111. *Id.* This suggests that the defendant posed as the plaintiff when actually making sales, or stated that he was an agent of the plaintiff with authority to make sales.

112. *Id.* at 617.

113. *Id.*

114. *Id.*

115. *Id.*

116. *Id.*

facts? The complaint furnishes all the perks that attorneys look for in a trademark infringement and unfair competition suit: (1) wide distribution of the plaintiff's goods, (2) an apparently distinctive trademark, (3) a long period of use of the mark, (4) considerable fame in the mark (both in the plaintiff's own region and in other regions and abroad), (5) actual confusion, (6) the apparent availability of consumer witnesses that can attest to their confusion, (7) proof of damages, (8) the unjust enrichment of the defendant, (9) willful conduct on the defendant's part, (10) passing off, (11) loss of reputation and good will in the plaintiff's business, and (12) finally a poor, honest, hard working small businessman whose family may have to sacrifice during the next winter on account of the defendant's egregious conduct. The facts as alleged in *Sandforth's Case* provide an almost perfect plaintiff's case, incorporating more useful nuggets than are generally found in modern pleadings.

The plaintiff's attorney seems to have framed the issues and facts in the complaint of *Sandforth's Case* in a manner that is remarkably modern, albeit too reliant on the now-discarded word "aforesaid" or its Latin counterpart. Can it be a mere coincidence that a practitioner of the mid-Elizabethan age had the tools and presence of mind to draft a complaint that, if the pleaded facts were found to be true, would sail to a summary judgment, complete with a grant of increased damages, attorney's fees and costs? While this question calls for wild and unnecessary speculation, it highlights the possibility that actions of the sort found in *Sandforth's Case* may not have been uncommon during the sixteenth century, and that the plaintiff's attorney may have had doctrinal resources at hand to assist him in drafting his complaint. After all, contemporaneous case reports during the reigns of Edward VI, Mary, and Elizabeth were not collected and published in an appreciable degree, but were left to languish as unnoticed and long forgotten manuscripts, as *Sandforth's Case* had been. In the meantime, we must simply encourage Professor Baker, his colleagues, and their successors to keep digging among the massive body of unpublished manuscripts for additional cases of this species.

## 2. The *Sandforth* Decision

Now that we are aware of the pleaded facts of *Sandforth's Case*, we must turn to the two extant records of the court's decision in the case. These abstracts are considerably less detailed than the complaint. According to the text of the first abstract,<sup>117</sup> the action was brought by "J.S.,"<sup>118</sup> a clothier known for making "good cloth" who used a mark, against "J.D.,"<sup>119</sup> a different clothier known for making "bad cloth" who used another mark.<sup>120</sup> "J.S. brought an action on the case against J.D." because "J.D. set J.S.'s mark on his [own cloth], and by means thereof obtained good business (utterance)."<sup>121</sup> At trial, "[J.D.'s] cloth was found . . . to be bad, and by reason thereof J.S.'s cloth was discredited and he could not have as good business afterwards as he had before."<sup>122</sup>

Chief Judge Anderson<sup>123</sup> noted that "[i]t seems the action lies,

117. The text of the first abstract is as follows:

J.S., being a clothier who made good cloth, used a mark; and J.D., being also a clothier but who made bad cloth, used another mark; then J.D. set J.S.'s mark on his [own cloth], and by means thereof obtained good business (utterance); but [J.D.'s] cloth was found upon trial to be bad, and by reason thereof J.S.'s cloth was discredited and he could not have as good business afterwards as he had before. Upon all this matter J.S. brought an action on the case against J.D.

Anderson C.J. said it seems the action lies, because J.S. is damaged by J.D. using his mark.

Peryam J. said there was no law against anyone using whatever mark he wished; and when J.D. used the mark which J.S. used he did no wrong to J.S., it being a lawful act. And even though J.S. was thereby damaged, he shall not have an action on the case for it, because it is *damnum absque injuria*.

Anderson C.J. said if someone has a house he may lawfully burn it if he wishes; but if by its being burned someone else's house is burned, the latter shall have an action on the case; and yet it was a lawful act.

*Id.* (citing the manuscript denoted as HLS MS. 2071, fo. 86).

118. There is a discrepancy between this abstract and the complaint. In the complaint, the plaintiff's initials (and mark) are "J.G.," but in the abstract, the initials are "J.S."

119. Based on the manuscripts, Baker identifies the defendant as some variation of Samford, Sandforde, or Sandforth. *Id.* at 615 n.13. The text of this abstract identifies him as "J.D."

120. *Id.* at 617.

121. *Id.* The same term was used in the Popham version of *Southern v. How*.

122. *Id.*

123. The Chief Judge, Sir Edmund Anderson, was known to be a very independent and efficient jurist. See A.L. ROWSE, *THE ENGLAND OF ELIZABETH—THE STRUCTURE OF*

because J.S. is damaged by J.D. using his mark.”<sup>124</sup> Judge Peryam, however, disagreed, finding that “there was no law against anyone using whatever mark he wished; and when J.D. used the mark which J.S. used he did no wrong to J.S., it being a lawful act.”<sup>125</sup> Peryam added that “even though J.S. was thereby damaged, he shall not have an action on the case for it, because it is *damnum absque injuria*.”<sup>126</sup> Chief Judge Anderson responded by ruling that “if someone has a house he may lawfully burn it if he wishes; but if by its being burned someone else’s house is burned, the latter shall have an action on the case; and yet it was a lawful act.”<sup>127</sup>

In this abstract of the case, the Chief Judge recognized the damage sustained by the senior user and declared that relief is available under the common law.<sup>128</sup> Judge Peryam disagreed, stating that he was not aware of any action at law that would justify relief, even if the plaintiff had been damaged.<sup>129</sup> The most interesting aspect of the abstract, however, is Anderson’s analogous reply that the action constituted a trespass, regardless of whether the defendant’s conduct had theretofore been assumed lawful. In other words, a merchant may choose to apply any mark he wishes to his

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SOCIETY 374 (1961). The English Historian, Professor A.L. Rowse characterized Anderson thus:

Anderson, C.J., who was of Scots descent, was a quick worker, but harsh and brutal in manner . . . [H]e had certain qualities of a great judge: he was even more independent than Coke [the sixteenth century’s most famous jurist]; it was he who stood up to Leicester over the Cavendish case and drew up the protest of the judges against arbitrary imprisonment. He came down strongly against a Puritan mayor of Leicester for imprisoning a man for setting up may-poles: the Puritans considered this a pagan survival. One finds the judge’s action congenial. At the age of seventy-two, while on circuit in Somerville, confronted with a disturbance, he snatched a sword from a man-at-arms, laid about him, and quelled it. A man of spirit, he gave judgement according to reason; if he considered there was no reason in the old books, he threw them over.

*Id.*

124. BAKER & MILSOM, *supra* note 2, at 617.

125. *Id.*

126. *Id.* The term “*damnum absque injuria*” refers to an injury for which there is no legal remedy. See BLACK’S LAW DICTIONARY 393 (6th ed. 1990) (defining *damnum absque injuria* as a harm or loss “which does not give rise to an action for damages against the person causing it”).

127. BAKER & MILSOM, *supra* note 2, at 617.

128. *See id.*

129. *See id.*

goods—that is his right—but once his choice of a mark results in quantifiable damage to another merchant who had previously chosen and used the mark, the former's choice becomes actionable.

Baker's second abstract of *Sandforth's Case* is much more interesting than the first report.<sup>130</sup> The second abstract contains a note by "Fletewoode,"<sup>131</sup> stating "that an action on the case lies by the custom of London for counterfeiting another's mark."<sup>132</sup> The second abstract also includes language that suggests that "Fenner"<sup>133</sup> informed the court that "'a clothier did give the mark of another clothier, but with a little difference hardly to be perceived, and set that on bad and false cloths, whereby the cloths of the other

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130. The second abstract of *Sandforth's Case* reads as follows:

Note, by *Fletewoode*, that an action on the case lies by the custom of London for counterfeiting another's mark. And he put this case when the following matter was moved by *Fenner*: 'a clothier did give the mark of another clothier, but with a little difference hardly to be perceived, and set that on bad and false cloths, whereby the cloths of the other (which made good) were after discredited.' And it was demanded whether an action on the case lay.

Anderson C.J. said it did.

Wyndham J. agreed, if the statute enacted that no clothier shall give the mark of another.

*Fletewoode*. In 5 Mar. it was adjudged in one Longe's case accordingly in parliament, and the counterfeiter was [a member] of the house and for this reason was put out and paid the other 300 pounds.

Peryam and Mead JJ. said that anyone may give what mark he will, and it is *damnum absque injuria* to the other; and deceit does not lie against him who does a wholly lawful act for his own profit.

*Id.* at 617-18 (citing manuscript HLS MS. 5048, fo. 118v. (formerly HLS MS. Acc. 704755, fo. 118v.)).

131. Winfield identifies William Fletewoode as "at one time Recorder of London" and the indexer of the Year Book series for the reigns of Edward V, Richard III, Henry VII, and Henry VIII. WINFIELD, *supra* note 79, at 181. Fletewoode was also a member of the Middle Temple and represented parties at court at least during the 1560s. *See* BAKER & MILSOM, *supra* note 2, at 488 (presenting a case heard in 1565 at which Fletewoode acted as plaintiff's counsel). In their index, Baker and Milsom also characterize Fletewoode as acting as a Sargent of Law in *Sandforth's Case*. As a Sargent of Law, Fletewoode could have been present at the hearing and voiced his views without necessarily acting as either of the party's counsel. Telephone Interview with J.H. Baker (Oct. 21, 1997).

132. BAKER & MILSOM, *supra* note 2, at 617-18.

133. Edward Fenner acted as counsel during the later part of the sixteenth century and was later appointed as a justice to the King's Bench sometime during the reign of James I. He died in 1612.



(which made good) were after discredited.”<sup>134</sup> Furthermore, “it was demanded whether an action on the case lay.”<sup>135</sup>

As in the first abstract, Chief Judge Anderson “said it did.”<sup>136</sup> Judge Wyndham “agreed, if the statute enacted that no clothier shall give the mark of another.”<sup>137</sup> Fletewoode informed the court that, in “5 Mar.,”<sup>138</sup> the matter “was adjudged in one Longe’s case accordingly in parliament, and the counterfeiter was [a member] of the house and for this reason was put out and paid the other 300 pounds.”<sup>139</sup> Judges Peryam and Mead said, however, “that anyone may give what mark he will, and it is *damnum absque injuria* to the other; and deceit does not lie against him who does a wholly lawful act for his own profit.”<sup>140</sup>

As the construction of the abstract is ambiguous, it is not entirely clear whether Fletewoode and Fenner represented the parties in *Sandforth’s case* in opposition to each other, jointly represented just the plaintiff, or acted as counsel at all. The language, “Note, by *Fletewoode*,” might mean that the court was presented by a written record penned by Fletewoode relating to an earlier trademark counterfeiting case heard in the House of Commons in 1558. Perhaps the language indicates that Fletewoode authored the abstract itself or a previous version of it. Alternatively, and more likely, the phrase should have read, “By *Fletewoode*, note that an action on the case lies . . . .” If that is the correct interpretation, then Fletewoode could have acted as counsel in the case. According to the gist of his comments, Fletewoode likely acted as plaintiff’s counsel; he cited an earlier precedent where an action for trademark counterfeiting was recognized by the House of Commons.

On the other hand, if Fletewoode acted as defendants’ counsel,

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134. *Id.* Baker indicates that the passage in internal quotation marks was originally in English, indicating that the other portions of the abstract were either in Latin or French. *Id.* at 618 n.19.

135. *Id.* at 618

136. *Id.*

137. *Id.*

138. During the fifth year of the reign of Mary: 1558.

139. *Id.* The best interpretation of this phrase is that the counterfeiter was expelled from the House of Commons for his conduct and was forced to pay damages.

140. *Id.*

his comments may be a badly edited effort at distinguishing the facts in *Sandforth* from the earlier case. It would appear, by the language of the abstract, that Fenner probably did act as counsel for the plaintiff because the record states that he “moved” the matter in *Sandforth*. It also is possible that both Fletwoode and Fenner appeared on behalf of the plaintiff, and the silence of the defendant’s counsel could be explained away by a speculation that he had nothing memorable to add to the proceeding. Finally, because Fletwoode was a “sargent of law,” he simply could have been present and pointed out the prior parliamentary action to the court in his official position, without having represented either party.

The jewel, and inevitably a nagging annoyance, of this abstract is the reference to *Longe’s Case*, an earlier case—reportedly heard in parliament and not at the Queen’s Bench—involving trademark infringement. That brief citation, if ever discovered and published, could authoritatively push back the date of the earliest British trademark law to 1558—prior to the reign of Elizabeth. Baker states that no record exists in the Journal of the House of Commons for that year.<sup>141</sup>

Another interesting point is that Fletwoode characterized an action for trademark counterfeiting as a “custom of London.”<sup>142</sup> That characterization, which demonstrates that trademark infringement violated local London law at the time, together with the

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141. *Id.* at 618 n.1.

142. A “custom” was a type of legal action heard by local or municipal courts, as opposed to common law courts. Telephone Interview with Professor J.H. Baker (Oct. 21, 1997). Professor Baker indicated that Fletwoode, who had served as Recorder of London and would therefore have been quite knowledgeable about the actions that would lie in a London municipal court, characterized the action in *Sandforth’s Case* as one which would ordinarily lie in a London court. *Id.* Common law courts frequently adopted the “customs” of important municipalities, such as London, and incorporated them into the common law of the realm. *Id.*; see Andrea C. Loux, Note, *The Persistence of the Ancient Regime: Custom, Utility, and the Common Law of the Nineteenth Century*, 79 CORNELL L. REV. 183, 185-201 (1993) (providing a thorough discussion of the history and importance of legal customs and their impact on the development of the English common law); see also CARLETON KEMP ALLEN, *LAW IN THE MAKING* 85-88 (1927) (stating that “if a custom is proved in an English Court by satisfactory evidence to exist and to be observed, the function of the Court is merely to recognize the custom as operative law”). See generally Albert Kiralfy, *Custom in Mediaeval English Law*, 9 J. LEGAL HIST. 26 (1988) (discussing differences in customs based on geography, as well as the various customs in specific areas of the law).

fact that in *Sandforth's Case* and possibly in an even earlier, pre-Elizabethan parliamentary case, trademark infringement was actionable, would strengthen the contention that the origins of the common law of trademarks should be securely assigned to the sixteenth century and not, as historically argued, the nineteenth.

### III. THE IMPACT OF *SANDFORTH'S CASE*

Although the reports of *Sandforth's Case* undoubtedly will pose more questions than they answer, one question that should be addressed now is whether the case represents the old action for the tort of deceit or an entirely new type of action, theretofore unrecognized and uncategorized. Certainly, if the case was an action for deceit, it is a hybrid. Ultimately, the answer to this question will not detract from the newly established authority of *Sandforth's Case* as the first reported action for trademark infringement. But it may support the argument that in Elizabethan England, the common law courts, responding to a quickly changing and expanding mercantile economy, promulgated a new tort, separate from that of deceit, and in later cases in later centuries, reverted back to the nomenclature of deceit. There is not enough in *Sandforth's Case* to justify the viability of such an argument, but any attempt to fit the case into the tort of deceit poses significant difficulties.

#### A. *Categorizing Sandforth's Case*

In his assertion that a case did not lie, Justice Peryam specifically identified the tort doctrine he thought was being invoked as deceit. At the time *Sandforth's Case* was decided, Peryam's position appears to have been the stronger one; it was supported by the common law of the day. Even though Peryam's position appears to be correct, his rationale was not. Peryam reasoned that a merchant could use any trademark he fancied, including the famous and successful marks of competitors. The actual reason that *Sandforth's Case* should not have been actionable in deceit is that at least one—and possibly two—elements normally required under the sixteenth century common law of deceit were missing: a warranty by the defendant and a relationship of privity, or at least a re-

lationship of trust, between the parties.<sup>143</sup>

The requirement of a warranty in cases involving deceit was firmly established within the common law between the fourteenth and sixteenth centuries. Essentially, an action for deceit would lie only if the plaintiff could establish that the defendant warranted goods or services and subsequently breached his warranty.<sup>144</sup> In 1604, the Court of the Exchequer confirmed that the warranty rule prevailed in the British common law.<sup>145</sup> A few years later, however, in another case involving the same parties, the court of the King's Bench relieved the plaintiff from the burden of showing that a warranty existed, relying instead on the defendant's fraudulent intent as an alternative.<sup>146</sup> Other cases required privity or some relationship of trust between the parties as well.<sup>147</sup> In *Sandforth's Case*, there is no warranty made by the defendant, at least not made to the plaintiff. Furthermore, it seems clear that there was no relationship between the parties, either in privity or in trust. Therefore, *Sandforth's Case* does not appear to fit into the common law action for deceit.

Nevertheless, some legal historians have depicted the action for

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143. See *supra* note 27 (discussing reported cases in deceit arising during the fourteenth, fifteenth, and sixteenth centuries).

144. See S.F.C. MILSOM, *STUDIES IN THE HISTORY OF THE COMMON LAW* 105, 126-30 (1985) (discussing the warranty requirement as applied to the sale of goods in the fifteenth century); S.F.C. MILSOM, *HISTORICAL FOUNDATIONS OF THE COMMON LAW* 276-77, 316-21 (1969) (examining the requisite of a warranty in actions for deceit).

145. *Chandelor v. Lopus*, 79 ENG. REP. 3, 3-4 (Ex. 1604). Here the Court of Exchequer stated that:

[T]he bear affirmation that it was a bezar-stone, without warranting it to be so, is no cause of action; and although he knew it to be no bezar-stone, it is not material; for every one in selling his wares will affirm that his wares are good, or the horse which he sells is sound; yet if he does not warrant them to be so, it is no cause of action.

*Id.* The author could find only one case sounding in deceit before the seventeenth century where a court may have relaxed the warranty rule. Commentator's Note, *Caryll's Reports*, Keil 91, pl 16 (1505), reprinted in BAKER & MILSOM, *supra* note 2, at 516.

146. *Lopus v. Chandler*, YLS M.S. G.R. 29.17, fo. 157v; YLS M.S. G.R. 29.18, fo. 123v; HLS M.S. 118, fo. 114v (1606), reprinted in BAKER & MILSOM, *supra* note 2, at 520-22.

147. See, e.g., *Lord Mouteagle v. Countess of Worcester*, *Dyer's Reports*, 121, BL M.S. Harley 1691, fo. 94 (1555) (requiring privity or a relationship of trust between the parties); *Anon*, *Year Book*, Trinity Term, 11 Edw. IV, fo. 6, pl. 10 (1471); *Anon*, *Year Book*, Michealmas Term, 9 Hen. VI, fo. 53v, pl. 37 (1430).

deceit as evolving as early as the sixteenth century.<sup>148</sup> For example, Professor Baker contends that the term deceit, or its Latin or French equivalents, were invoked to characterize all kinds of cases of trespass, devoid of any true basis in the old common law tort of deceit.<sup>149</sup> According to Baker, “[d]eceit [was] featured at one stage or another in most other actions on the case for wrongs.<sup>150</sup> Conversion was a ‘plea of trespass and deceit’ or ‘deceit on the case’; but here again the deceit was to become, probably by the mid-sixteenth century, a meaningless allegation.”<sup>151</sup>

*Sandforth’s Case* may be an example of the abuse—alluded to by Baker—of attaching the nomenclature of an established tort to an action where the facts of the case do not fit the tort’s parameters. The *Sandforth* court, looking for the nearest analogous doctrine of tort to fit the facts, may have simply settled for deceit. We will never know this. Moreover, it is unknown whether the action for deceit had expanded by the time of *Sandforth’s Case* to ease the requirements of warranty and privity. Whatever the ultimate answers to those questions, *Sandforth’s Case* clearly establishes trademark infringement as a violation of sixteenth century common law.

B. *Placing Sandforth’s Case in the Commercial and Economic Context of Sixteenth Century England*

Whether the court in *Sandforth’s Case* created a new tort or expanded the scope of an action for deceit to encompass trademark infringement and unfair competition is, at this point, of little consequence. Regardless of its doctrinal basis, the court recognized that the prevailing economic and commercial realities of the realm required the promulgation or expansion of the common law to protect merchants against trademark piracy and unfair methods of competition in the marketplace. Anticipating the substantial development of the law during the Industrial Revolution 250 years later, the courts of the Elizabethan era witnessed extraordinary

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148. See SPELMAN REPORTS, *supra* note 90, at 230-32.

149. *Id.*

150. *Id.* at 232 (citations omitted).

151. *Id.* (citations omitted).

economic and commercial growth throughout England and probably had little alternative but to fashion the common law to meet the exigencies of the times.

With the advent of the Tudor Monarchy,<sup>152</sup> the English Middle Ages came to an end.<sup>153</sup> The sixteenth century brought to England a tremendous growth in commerce and the economy.<sup>154</sup> In fact, during this period, England experienced so much progress in its internal economy as well as its development of external markets that the century “amounted to a sort of Industrial Revolution.”<sup>155</sup>

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152. The House of Tudor, which assumed hold of the British throne in 1485, produced three of the most dynamic monarchs in English history. The Tudor Monarchy was ushered in after the bloody Battle of Bosworth Field, when Henry Tudor, a bastard pretender to the throne, vanquished Richard III, thus putting an end to the War of the Roses, which disrupted English commerce and society for thirty years. *See generally* J.R. LANDER, *THE WARS OF THE ROSES* (1965); JOSEPH R. STRAYER & DANA C. MUNRO, *THE MIDDLE AGES 395-1500*, at 500-06 (5th ed. 1970). Henry Tudor was coronated as Henry VII and his direct future lineage included Henry VIII, Edward VI, Mary, and Elizabeth I, the death of the latter in 1603 extinguishing the Tudor hold on the British throne.

153. *See generally* JACOB BURCKHARDT, *THE CIVILIZATION OF THE RENAISSANCE IN ITALY* (1860) (expressing the view that the late Middle Ages was a period of economic and cultural decline); F.R.H. DU BOULAY, *AN AGE OF AMBITION: ENGLISH SOCIETY IN THE LATE MIDDLE AGES* (1970) (exploring the transformation of social, economic, cultural, and religious forces and institutions at the close of the fifteenth century); J. HUISZINGA, *THE WANING OF THE MIDDLE AGES* (1955) (sharing Burckhardt's views of the late Medieval period in England); PERCIVAL HUNT, *FIFTEENTH-CENTURY ENGLAND* (1962) (offering the view that the late Middle Ages was less a period of stagnancy and decline and more a bridge to the Renaissance than generally supposed).

154. *See* EDWARD P. CHEYNEY, *AN INTRODUCTION TO THE INDUSTRIAL AND SOCIAL HISTORY OF ENGLAND* 116-51 (1937). Focusing on the notable distinction of the sixteenth century as a passing of one era to another, from the Middle Ages to what we like to refer to as “modern times,” Professor Cheyney opined that:

The century and a half which extends from the middle years of the fifteenth century to the close of the sixteenth was, as has been shown, a period remarkable for the extent and variety of its changes in almost every aspect of society. In the political, intellectual, and religious world the sixteenth century seemed far removed from the fifteenth. It is not therefore a matter of surprise that economic changes were numerous and fundamental, and that social organization in town and country alike was completely transformed.

*Id.* at 120-21; *see also* GEORGE CLARK, *THE WEALTH OF ENGLAND 1496-1760*, at 57-89 (1961) (arguing that mercantile enterprise and the development of a money economy resulted in the wide availability and significant surpluses of raw materials and finished goods during the sixteenth century).

155. J.U. Nef, *War and Economic Progress, 1540-1640*, *ECON. HIST. REV.* 25 (1942). England, more than any other country of Europe, tied its economic advancement to the new science and technology ushered in during the Renaissance. ROWSE, *supra*

While land was still the economic basis for making and maintaining family fortunes during the period, the century saw a rise in local markets, the increasing availability of consumable goods, and a significant escalation of exports to the continent and other parts of the world.<sup>156</sup> New inventions and technological advances vastly expanded Britain's industrial capabilities, thereby increasing the production and distribution of goods throughout the realm and beyond.<sup>157</sup> Moreover, the recent discovery and colonization of North and South America, and the colonization of parts of India, Asia,

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note 123, at 112. According to Professor Rowse:

England achieved the position of leadership in industrial technology and heavy industry she held till the late nineteenth century largely during the century between the Dissolution and the Civil War [1540-1640]; that Elizabeth's reign saw a shift in the centre of progress in both science and technology from the continent to [England], where more fresh industries were started and more new kinds of machinery and furnaces were developed than in any other country. The Renaissance impulse signalled itself in a host of new inventions: the printing press, the blast furnace, furnaces for separating silver from copper ore, for using coal in glass making, steel and brick-making for drying malt in brewing, boring rods for exploring underground strata, horse and water driven engines for draining mines—an immense field of development [in England] as new mines were opened up and old workings deepened; the stocking knitting frame, the Dutch loom for knitting small wares, besides more specialized scientific devices.

*Id.* Many historians believe that the seeds of the later Industrial Revolution of the nineteenth century were sown during the Elizabethan era. "The rise of industrialism in Great Britain can be more properly regarded as a long process stretching back to the middle of the sixteenth century . . . than as a sudden phenomenon associated with the 18th and 19th centuries." J.U. Nef, *The Progress of Technology and the Growth of Large-Scale Industry in Great Britain, 1540-1640*, *ECON. HIST. REV.* 22 (1934).

156. See CHEYNEY, *supra* 154, at 136-50; CLARK, *supra* note 154, at 176-87. In explaining the economic progress that occurred in England during the reign of Elizabeth, Professor Rowse states:

There were the striking improvements in industrial and financial technique; the increased mobility of labour, particularly in the iron, coal and glass industries, special fields for the new capitalist; the growth of investment in new enterprises, the opening up of markets in America, Asia [and] Africa. In all these things, England, at length, caught up and went ahead.

ROWSE, *supra* note 123, at 109.

157. See CHEYNEY, *supra* note 154, at 138-42. For example, during the middle of the fourteenth century, the longest list of merchants engaged in any appreciable degree of commerce contained only 169 names. See *id.* at 139. By 1500, however, over 3,000 merchants engaged in foreign trade and many thousands more engaged in the native commerce of England. See *id.* By the end of the sixteenth century, over 3,500 merchants traded with the Netherlands alone. See *id.*

and Africa during the century, made no small impact on the growth of British industry.

Local craftsmen and artisans made way for a new class of businessmen, the merchant-adventurers.<sup>158</sup> As a result of this and the vast expansion of industry and foreign trade in general, the guilds, which had theretofore dominated as the regulating force in the English economy, began to decline in membership and influence.<sup>159</sup> Schechter demonstrated that it was the guilds that regulated the earliest form of “trademark law” in Great Britain.<sup>160</sup> It is highly probable that the decline of the guilds, the escalation of the powers of the general government, and the growing influence of the merchant-adventurers in the English economy converged at this period in removing the regulation of trademarks from the “guild jurisprudence” to the common law courts.<sup>161</sup>

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158. *See id.* at 139-43. There was such a surplus of new finished goods during this period that England’s export trade flourished. *See id.* The new wealth also resulted in the greater desire for foreign luxury items and other types of imports. *See id.* During the sixteenth century, Britain’s import-export business was booming. According to Cheyney:

These merchants exported the old articles of English production and to a still greater extent textile goods, the manufacture of which was growing so rapidly in England. The export of [raw] wool came to an end during the reign of Queen Elizabeth, but the export of woven cloth was more than enough to take its place. There was not so much cloth now imported, but a much greater variety of foodstuffs and wines, of articles of fine manufacture, and of the special products of the countries to which English trade extended.

*Id.* at 139. In fact, the merchant-adventurers had become so numerous, wealthy, and influential during the century that they furnished 10 out of the 16 London ships sent to assist the British fleet in destroying the Spanish Armada. *See id.* at 142.

159. *See id.* at 135-38.

160. SCHECHTER, *supra* note 1, at 38-77.

161. CHEYNEY, *supra* note 154, at 136-38. According to Cheyney:

Thus the guilds lost the unity of their membership, were weakened by the growth of industry outside of their sphere of control, superseded by the government in many of their economic functions, deprived of their administrative, legislative and jurisdictional freedom, robbed of their religious duties and of the property which had enabled them to fulfil them, and no longer possessed even the bond of their dramatic interests. So the fraternities which had embodied so much of the life of the people of the towns during the thirteenth, fourteenth, and fifteenth centuries now came to include within their organization fewer and fewer persons and to affect a smaller and smaller part of their interests. Although the companies continued to exist into later times, yet long before the close of the period . . . they had become relatively inconspicuous and insignificant.

*Id.* at 137.



With the guilds in decline, the plaintiff in *Sandforth's Case*, and potentially others like him during the sixteenth century, probably viewed the common law courts as a more appropriate forum for obtaining relief against a trademark pirate. "J.G.," or whatever his name may have been, could expect the courts of that period to render a judgment that made sense in light of the economic and commercial context of that time. As the Industrial Revolution of the nineteenth century made it imperative to extend substantial legal protection against trademark infringement and unfair competition, so too did the earlier, more contained "Industrial Revolution" of the sixteenth century.

#### CONCLUSION

More than seventy years ago, the legal scholar Frank Schechter challenged other legal scholars and historians to find a bridge linking the regulation of trademark usage by the medieval English trade guilds to the later assumption of trademark jurisprudence by the common law courts of the nineteenth century. Schechter fully discounted the case of *Southern v. How* as providing such a bridge. The recent discovery of *Sandforth's Case* now allows us to disregard *Southern v. How* as the earliest basis for trademark and unfair competition law in English legal history. Moreover, *Sandforth's Case*, together with the unreported parliamentary action in *Longe's Case*, provide the historical bridge linking guild regulation of trademarks to the development of trademark jurisprudence by the common law courts as early as the mid-sixteenth century, 250 years before *Sykes v. Sykes*, the case that Schechter declared to be "the first reported case squarely involving the protection of trademarks by an English common law court."

## APPENDIX

THE COMPLAINT IN *SANDFORTH'S CASE*

Although the complaint in *Sandforth's Case* is somewhat lengthy, its importance in the history of trademark law makes it worthy of full review. Accordingly, an annotated version of the complaint is provided in its entirety as follows:

[The plaintiff, by his attorney, complains]<sup>162</sup> that, whereas the same plaintiff is a clothier, and for 12 years past at T.<sup>163</sup> in the county aforesaid used the art and mystery [of making]<sup>164</sup> woollen cloths called Reading kerseys, "halfes" cloths and Bridgewater, <sup>165</sup> and during all that time all such cloths as he made at T. aforesaid were good and substantial without any fraud or deception in that behalf; and for the whole of the aforesaid time he was accustomed to mark such cloths with the letters 'J.G.' and with a sign called a tucker's handle;<sup>166</sup> and the same plaintiff sold the same cloths, thus made and marked, through the whole of the aforesaid time, at T. aforesaid and at C.<sup>167</sup> in the aforesaid county and in various other places within this realm of Eng-

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162. See BAKER & MILSOM, *supra* note 2 (providing the bracketed text).

163. Location unknown. Some versions of *Southern v. Hall* indicated that the plaintiff operated his business out of Gloucester or somewhere in Gloucestershire.

164. See BAKER & MILSOM, *supra* note 2 (providing the bracketed text).

165. A "kersey" is defined as a "course ribbed woollen cloth for hose and work clothes woven first in medieval England." WEBSTER'S THIRD NEW INT'L DICTIONARY 1238 (1986). The author could not locate an appropriate definition for the two other types of garments or cloths.

166. The author could find no definition for a "tucker's handle." However, during the Medieval and Renaissance periods, a "tuck" was a slender sword or rapier. AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1923 (3rd ed. 1992). It is possible that the device used as part of the plaintiff's trademark was the handle of a sword. Other potentially relevant definitions for "tucker" are (1) "an attachment on a sewing machine for making tucks" and (2) a piece of lace or cloth used to fill in the low neck line of a dress." WEBSTER'S DICTIONARY, *supra* note 100, at 2460. The latter definition asks to compare the word to the use in the phrase "bib and tucker." *Id.* The definition for the most likely noun "tuck" identified in the first definition of "tucker" is "a fold stitched or woven into cloth for the purpose of shortening, decorating or controlling fullness." *Id.* A "tucker's handle" could have been a tool of a clothier's trade.

167. Location unknown.

land, and likewise at M.<sup>168</sup> in Wales and in various other places in parts beyond the seas, as well to various merchants and other subjects of this realm of England as to various other merchants and foreigners; and the buyers thereof were accustomed for eight years<sup>169</sup> last past to buy those cloths well and substantially made and from wool marked as above said, from the same J.G.<sup>170</sup> at all the aforesaid several places, and to pay for the same cloths as for good and substantial cloths (the same cloths in truth being good and substantial), upon the affirmation of the same plaintiff and his servants and factors that the same cloths were good and substantial, without any inspection or contradiction of the same cloths;<sup>171</sup> and by reason thereof the same plaintiff throughout the aforesaid time lawfully and honestly obtained and acquired much gain and profit from the making and selling of such cloths, for the further support and living of the same plaintiff and his whole family: [nevertheless]<sup>172</sup> the defendant, being not unaware of the foregoing, scheming and plotting to hinder the same plaintiff in selling such cloths of his and to take away and worsen the opinion and esteem which the aforesaid merchants and subjects had concerning the cloths of the same plaintiff, for the space of two years now past at T. aforesaid made various woollen cloths called etc. which were ill, insufficient and unmerchantable; and deceitfully marked the same cloths with the aforesaid letters 'J.G.' and with the aforesaid mark called a tucker's handle; and exposed for sale the same cloths, so insufficiently and deceitfully made and marked as aforesaid, in the aforesaid several places, as the cloths of the same plaintiff and under the aforesaid

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168. Location unknown.

169. The document previously states that the plaintiff had manufactured and marketed his cloths for twelve years, not eight.

170. Only the initials of the plaintiff are given.

171. This would seem to indicate that the plaintiff argued for the inherent "informational" value his mark had to consumers. The plaintiff's customers need not spend time and effort inspecting the nature and quality of each cloth since the customers' association of the plaintiff's trademark with high quality goods had already been established.

172. See BAKER & MILSOM, *supra* note 2 (providing the bracketed text).

mark and letters, in the name of the selfsame plaintiff,<sup>173</sup> whereupon various merchants and other subjects who were buyers and had previously been accustomed to buy the same plaintiff's cloths, trusting to the aforesaid words and [seeing] the aforesaid cloths marked with the aforesaid letters 'J.G.' and the aforesaid mark called a tucker's handle, bought the same cloths (deceitfully and insufficiently made by the defendant aforesaid) from the same defendant, without further inspection or contradiction of the same cloths, as being good and substantial cloths such as the cloths of the same plaintiff had used to be, and as being the same plaintiff's cloths; and the aforesaid buyers, when they later inspected the aforesaid cloths deceitfully sold by the aforesaid defendant as aforesaid, and found the aforesaid cloths to be deceitful, insufficient and unmerchantable, both in length and width and in quality and substance of the same cloths, not only completely reversed the opinion and esteem which they had previously had of the same cloths but also gave notice to many other merchants and subjects of the deceitful and insufficient making of the aforesaid cloths; and as a result of this same plaintiff, when he recently desired to sell certain good and substantial cloths of his (marked in form aforesaid) at the aforesaid places, and there exposed the same cloths for sale, could not sell those good and substantial cloths (marked in form aforesaid) by reason of the deceit committed and used by the aforesaid defendant as set out above, but the merchants and subjects aforesaid who previously used to buy such cloths from the same plaintiff refused to buy the same cloths from him by reason of the aforesaid deceit; to the damage etc.<sup>174</sup>

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173. This may mean that the defendant assumed the imposture of the plaintiff himself when actually making his sales, or that he stated himself to be the latter's agent, and therefore authorized by the plaintiff to make the sales.

174. Sandforth's Case, BAKER & MILSOM, *supra* note 2, at 615-17 (citing *Cory's Entries*, BL MS. Hargrave 123, fo. 168v. (British Library) (1584)) (alterations in original) (citations omitted) (footnotes added).