A Case of Prejudice?
The uncertain development of collective and certification marks

Paul Duguid*
School of Information, University of California, Berkeley
School of Business & Management, Queen Mary, University of London

Abstract
The Lanham Act (1946) introduced collective and certification marks to US law. So doing, it has generally been regarded as innovative and forward looking. Yet collective and certification marks had been widely used individual states since the previous century and international conventions had long been pushing the federal government to protect them. Indeed, it may be stranger that the US trademark law of 1905 did not include protection for such marks than that, forty years later, the Lanham Act did. In exploring why the law of 1905 failed to respond to innovation all around it and why the Lanham Act was celebrated for fulfilling such long-overdue obligations, this article questions conventionally linear accounts of the development of trademark law and practice.

*Paul Duguid is adjunct professor at the School of Information, University of California, Berkeley, and Professorial Research Fellow in the School of Business and Management, Queen Mary, University of London. Recent publications include "French Connections: The propagation of trade marks in the nineteenth century" (2009) and the co-edited collection, *Trade Marks, Brands, and Competitiveness* (2010).
A Case of Prejudice?
The uncertain development of collective and certification marks
Paul Duguid

The first US federal trademark law (1870) lasted under 10 years. By contrast, the 1946 Lanham Trademark Act has regulated US trademarking for 75 and is recognized as "the foundation of trademark law today." With Lanham, US federal law deliberately and unambiguously embraced collective and certification marks for the first time. Today, such marks offer protection to a range of goods from Girl Scout cookies and Fair Trade coffee to Underwriters' Laboratory certified computers and cell phones. So doing, these marks reflect what Mira Wilkins calls "the trademark's functions relative to the modern company." Innovative as law and a spur to innovations in modern business, the Lanham Act, one commentator claimed, took trademark law into "unfamiliar territory" developing aspects of marks that had "never been dealt with before." Even those who dislike the act

1 I am grateful to the Economic and Social Research Council (UK) for funds in support of, and to archivists at the California State Archives, Oregon State Archives, and St Louis City Archives for help with this research; also to Teresa da Silva Lopes and David Higgins for reading and responding to earlier versions of this article.


3 60 US Stat 1943-1946, sections 3 and 4. The US Patent and Trademark Office defines a collective mark as one which indicates that "the user of the mark is a member of a particular organization" and a certification mark as one that "certifies the goods and services of others when they meet certain standards." (http://www.uspto.gov/faq/trademarks.jsp; visited April 15, 2011). Standards Standard certification marks include the "wool mark," used to indicate the content of material. Standard collective marks include the "CA" used by the Institute of Chartered Accountants. Collective marks differ from certification marks primarily in that the former may be used only with the assent of members of a collective, while the latter may be used by anyone who meets the specified standards. There are large areas of overlap between the two, particularly in geographical collective marks, which often set standards for use.

tend to dislike it for these supposedly radical innovations. In general, Lanham seems to endorse linear evolutionary accounts of trademarking offered by economic theorists and espoused by some business historians. With regard to the introduction of collective and certification marks, one of the act's most determined achievements, however, Lanham actually challenges such accounts. These marks had been widely protected not only outside the US but also within the several states for more than 50 years. For all the applause, with Lanham the federal government was not setting the pace, but merely catching up.

Among US trading partners, collective marks had had explicit statutory protection in Germany from 1872, France from 1873, and Britain from 1883. In 1905 new British law also gave protection to certification marks. The United States revised its trademark law the same year and yet ignored such marks. Contemporaries noted the omission:

It is the general opinion ... of trade-mark authorities that the lack of provision in our law for association marks is a defect that should be remedied as soon as possible. It is a noteworthy fact that most of the other great nations recognize association marks.

---


7 Hearings in 1954 noted that "one of the principal objectives of the Lanham Act is to induce lawful users of trade-marks, service marks, collective marks and certification marks to register under the act."

Registration and Protection of Trademarks: Hearing before a Subcommittee of the Committee on the Judiciary (Washington, DC, 1954), 37.

8 US Commissioners, Report of the Commissioners Appointed to Revise the Statutes Relating to Patents, Trade and Other marks, and Trade and Commercial Names (Washington DC, 1900) [hereinafter, Report], 349-51.

9 Trade Marks Act, 7 Ed VII 15 § 62. What are now called collective and certification marks were then often called "association" andor "standardization" marks.

10 33 US Stat 724.

11 [Anon.], Trade Marks, Trade Names: For the Businessman (New York, 1912), 10. In 1905, James
The writer adds that, while the 1905 federal statute gave no reliable protection to collective (or "association") marks, many of the several states did. By 1905, at least 40 US states had relevant law. Yet these state innovations had to wait until 1946 to be fully recognized in federal law. They were, furthermore, sufficiently forgotten that by 1946 Lanham could be embraced as innovative in this regard. The omission and amnesia may become explicable if we note that within the United States innovation in this area was led by trade unions in the development of the "union label." The federal law of 1905 was written at a time of increasing antipathy of both courts and legislature towards union activity. This may be, then, a story of innovation, resistance, and labor unions. Yet it is not the well-known standard in which business innovates and unions resist. Rather, it was unions that innovated and business and the federal courts and legislature that resisted.

To make this argument, this article begins with a brief account of US federal trademark legislation up to the Lanham Act. It then turns to a history of the "union label" and its development as a collective, certification, and sometimes service mark, suggesting that, in its general innovative implications, the label may be of interest beyond the union historians that have been its principal chroniclers. The article then asks why, though widespread, these collective and certification marks were generally overlooked in 1905, forgotten by 1946, and missing from subsequent celebratory accounts of trademark law.

Hopkins, one of the major legal commentators noted that in principle, "trademark need neither indicate the manufacturer or the place ... but may indicate either the ... handling or selection or some labor that has been performed in connection therewith," but conceded that federal law did not provide this. James Love Hopkins, The Law of Trademarks, Trade Names, and Unfair Competition 2d ed. (Chicago, 1905), 15-16; in England, Lewis Sebastian noted that "In America, the question [of association marks] has been much discussed" but remains unresolved. Lewis Sebastian, The Law of Trademarks 5th ed. (London, 1911), 100.

The road to Lanham

Looking back from 1946 to hearings in the House of Representatives in 1938, the New York Times described the path to Lanham as an "eight-year struggle." In fact, 1938 merely "marked a continuation of trademark law revision efforts which began as far back as the year 1920." The law of 1920 was in turn, as its title noted, an attempt "to give effect to certain provisions of the convention ... of Buenos Aires ... 1910." Despite accounts of the United States leading the way in trademark legislation, such timelines argue that development was circuitous and the country forever behind.

Its lagging is evident from the first US federal law of 1870. This was preceded by law not only in numerous countries, but also in a handful of states, most notably that of California. It took treaties with Russia and then France to push the United States to write federal trademark law. This law and another of 1875 (which introduced criminal penalties for deliberate trademark infringement) were both abrogated by the U.S. Supreme Court in 1879, which held that Congress had unjustifiably invoked the "progress clause" of the Constitution in making trademark law. As that clause did not, in the Court's view, extend to trademarks, the country was left without federal trademark law. It still, however, had treaty obligations. Consequently, Congress passed law under the treaty provisions of the Constitution, but with that justification, such law could only apply to firms from, or doing business, with US treaty partners or "Indian nations." Thus from 1879 to 1905 federal law did not protect firms trading only within the country.

21 Depending on the state, such firms might have been covered by fragmented state and common law.
Limited federal jurisdiction didn't prevent the country from taking on more international obligations. In 1887, it belatedly signed the 1883 Paris Convention for Protection of Industrial Property. It then sent delegates to supplemental conferences held under that Convention, the first in Madrid (1891) and the second in Brussels (1897). Both pushed for collective marks. The US delegates at Madrid noted in their report, that the Madrid agreement

authorizes the protection of municipal and collective marks in the same way as those of individuals. There is no doubt of the equity of this provision but its strict enforcement in the United States will require some modifications of existing law ... since as now interpreted ... it does not include the class of marks indicated. Apart from statutory provisions the Federal and State courts recognize these marks as entitled to protection. ... [A] bill now pending before the House of Reps ... will, if enacted, substantially provide for their registration.22

No relevant law was enacted. The subject came up again in Brussels. Here France introduced a rather sharp resolution calling on the United States to bring federal law into line with its treaty obligations. The US delegates pleaded their problems with federal jurisdiction. Nonetheless, the delegates reported that "the desirability of the protection of marks indicating collections of individuals was universally conceded." And the conference passed a resolution expressing "the desire that collective marks shall be protected in the same manner as individual marks in the countries of the union."23

In 1898, in the wake of the Brussels conference, President McKinley appointed a commission to "revise the statutes relating to patents, trade and other marks and trade and commercial names."24 The committee had three members. At its head was Francis Forbes, founder, the first secretary, and later the president of the Trade Mark Association. Having written about French trademark law, Forbes was well aware of the international pressures and, given that he had represented the United States in both Madrid and Brussels, committed to responding.25 The two other commissioners were Arthur Greeley

22 Report, 249.
23 Report, 120, 206.
24 Report, 529.
25 Forbes wrote the sections on French law and legal decisions in Charles E. Coddington, A Digest of the...
and Peter Grosscup. Greeley was formerly the Assistant Commissioner of Patents in the US Patent Office. Like Forbes, Greeley had written on international comparative law. Grosscup was a US District Court judge. Before 1898, he appears to have sat on only two trademark cases, though intriguingly in 1898, as if to catch up, he sat on three. As we shall see, Grosscup's judicial expertise lay elsewhere.

McKinley's commission failed to agree. Forbes and Grosscup issued a majority report, and Greeley a minority one. Both reports proposed justifying new law under the "commerce clause" of the Constitution, thus overcoming the Supreme Court's objections. The majority also proposed a fairly extensive revision of trademark law, while Greeley stayed as close as possible to the law of 1881, and thus to common law. Despite being a minority report, it was primarily Greeley's proposal that was enacted in 1905.

Both the majority and minority reports acknowledged the pressure to toe the international line and suggested that their proposals would. Greeley, in particular noted that his "satisfied ... the present needs of our trademark interests." Writing in anticipation of the law, Greeley had argued that one "important" feature of the coming act was "the inclusion of associations." This might suggest that he believed the law would protect collective marks. But in a longer exegesis published after the act was passed, Greeley remarkably makes no mention of this "important" aspect of the law. The section on definitions and clarifications in the 1905 law did note that "'person' and 'owner,' and any other word or term used to designate the applicant . . . include[s] a firm, corporation, or association" without further comment. But no-one seems to have assumed that "association" covered owners of collective or certification marks. Thus, where the

---


28 Report, 61.


British register accepted more than 60 collective and certification applications the year after its law of 1905, the US trademark registers did not accept any.\textsuperscript{31} Furthermore, in 1914, almost a quarter century after commitments made in Madrid, the Patent Office still argued that an "'association' that neither produces the goods nor trades in them cannot be the owner of any technical mark," thus definitively ruling out the idea that "association" in 1905 encompassed collective or certification marks.\textsuperscript{32}

Yet more evidence that the 1905 law did not encompass associations comes from the next major legislative intervention in 1920. As we have seen, this was a belated response to the Buenos Aires convention of 1910, and sought, almost in the tradition of 1881, minimal compliance with US treaty obligations. It thus extended rights in collective and certification marks only to businesses from or dealing with treaty partners.\textsuperscript{33} This restrictive application was finally fixed in 1938 in the run up to Lanham.\textsuperscript{34} Thus, as Daphne Robert argued in her commentary on Lanham, the mention of "association" in 1905 notwithstanding,

> The right of domestic associations or other organizations to register collective marks was first recognized in our law in the Act of June 10, 1938, which amended the Act of Feb 20, 1905. .... Prior to that time [i.e., 1938], collective marks were only registrable by associations in foreign countries.\textsuperscript{35}

We can look on 1838 as progress, then. But it was only progress towards fulfilling a 40-year-old commitment. Lanham took one step beyond 1938. In Title X of the law, "Construction and Definitions," it notes

> The term "person" ... under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other

\textsuperscript{31} Duncan Kerly, \textit{The Law of Trade Marks and Trade Names} ... 3d ed. (London, 1908), 84.

\textsuperscript{32} \textit{Ex Parte, Brockton Chamber of Commerce, Inc.} \textit{Patent and Trade Mark Review} 13 (1915): 221-2, quotation at 222.

\textsuperscript{33} 41 \textit{US Stat} 533, 1914-1921.

\textsuperscript{34} 52 \textit{US Stat} 638, 1937-1938.

organization capable of suing or being sued in a court of law.\textsuperscript{36}

**Internal pressure**

Finally, then, 46 years into the new century, the Lanham Act acknowledged international obligations stemming from the old. But the pressure for change was not only international. Strong pressure had been exerted within the country and to a significant degree from unions, whose rights were finally acknowledged in Title X of Lanham.

**Early US collective and certification marks**

Before 1905, collective and certification marks in the United States were represented primarily—though not solely—by the "union label." This survives today, if at all, in the minuscule printers' "bug" at the edges of union-printed documents, in memories of International Ladies Garment Workers' marks, or on eBay. Yet at their height, more than 60 US unions deployed labels and most states recognized them.\textsuperscript{37} In 1900, the Cigar Makers' International Union (CMIU) gave out more than one billion and spent over $30 million on "label agitation." No private mark that was so widespread or well supported. As Justice Holmes observed at the time, the label "was of far more economic importance to the union than are many or most of the trade-marks strictly so called."\textsuperscript{38}

That unions might have a significant role in the history of trademarks is not surprising. Unions are successors to guilds and guilds were historical repositories of early kinds of marking.\textsuperscript{39} That the United States, with a historically ambivalent view of union activity, should be the prime site of union marks, rather than, for example, the UK (where they were tried) may seem odd. But the label was particularly well suited to US

\textsuperscript{36} 60 US Stat 1943-1946, §45.


\textsuperscript{38} Spedden, Union Label, 46; Holmes in Tracy v. Banker 49 NE Reporter 308 [1898], quotation at 308.

unions. For them the boycott was as, if not more, important than the strike, and the label was particularly effective in boycotts. Moreover, the confrontations in which the label was used were distinct. The UK unions engaged in classic confrontations between labor and employers. In the United States, alliances between the two were more common. Cooperation was essential for the label: a union had to agree to have its label used while employers had to agree to associate it with their goods or services. Firms like the clothing maker Carhartt and the drinks maker Horlicks, among many others, willingly applied a union label to their product as a way to advertise cooperative relationships with their employees. With the same goal in view but less cooperative relations, others faked or forged the label. The label was a particularly US development, moreover, because the first fight in which it was deployed was a particularly US fight. From the 1860s a wave of potent anti-Chinese tribalism united many Americans across other racial boundaries as well as across the division between employee and employer. "No single factor," a contemporary commentator, put it, was "so powerful" in the label's genesis.

The "gold rush" was the earliest major draw for Chinese immigrants; the Central Pacific Railroad the next. Construction work on the railroad ended in 1869 and the laid-off Chinese moved to the cities, particularly San Francisco. With few resources, they sought, as workers, relatively low-skill businesses, and as fledgling entrepreneurs, low-capital ones. Cigar and shoe making thus offered themselves as arenas for anti-immigrant tension, involving both employees and small employers. Chinese labor was both far from the only union concern and far from a concern of unions only. Cigar unions, for example, also fought child and tenement labor as did many others. Scientific


For Carhartt, see Report of the Industrial Commission on the Relations and Conditions of Capital and Labor Employed in Manufactures and General Business. vol. 7 (Washington, DC, 1901), 190; Horlicks registered a series of trademarks with union endorsement. See, for example, Oregon State Archives, Trademark Register 1900-1907, p. 234.

Brooks, "Trade-Union Label," 197.

By 1870, 91.5% of San Francisco's cigar workforce was Chinese and wages were 55% of white males'. Martin Brown & Peter Philips, "Competition, Racism, and Hiring Practices among California Manufacturers, 1860-1882," Industrial and Labor Relations Review 40(1)(1986): 61-76.
American inveighed against "the tenement horror" that employed "women, girls, and small children" in "working a fourteen hour daily average." Cigars made in tenements became a particular concern. "I have visited these pest holes personally," Theodore Roosevelt reported, "and I can assure you if smokers could only see how these cigars are made we should not need any legislative action against this system." From here it is only a short step to the Chinese and insinuations of the sort made by one (anti-union) contemporary, "A smoker may prefer his cigar very full-flavoured, but his taste in this respect is not likely to be sufficiently strong to lead him to appreciate an aroma the outcome of dirt and squalid... an element of danger in smoking Chinese-made cigars." By similar processes of elision, the Chinese soon provided ready scapegoats for all labor's ills. "Ah, the Chinese cigar-makers," a character in Frank Norris's *McTeague* exclaims, "It's them as is ruining the cause of white labor."

Amidst such sentiments both unions and manufacturers developed "white labor" labels. While the manufacturers' marks were conventional, if reprehensible, the union's initiated collective and certification marking.

**Trademark registrations**

One union historian sees the genesis of such union labels in a carpenter's stamp used in 1869 to distinguish union-made lumber during a fight for an eight-hour day. The next manifestation is usually thought to be a label of the California cigarmakers. If, however, we look at trademark registrations, the story is a little more complex. In California, which began trademark registration in 1863, the first union-like mark registered is for "The United Workingmen's Cooperative Boots and Shoes" in 1873. The mark itself indicates no particular cause. Another mark that year is also significant.

---


45 Lucile Eaves, *A History of California Labor Legislation* (Berkeley, CA, 1910), 385. Trademarks on lumber appear in California in 1866. California State Archives, 8297 "Trademark Applications (Claims), Registrations, and Renewals," registration 59. (Hereafter, state registrations are identified by state initials and registration number or, in the case of St Louis, page number in the register.)


47 California State Archives, 8297 "Trademark Applications (Claims), Registrations, and Renewals," registration CA 250. (Hereafter, state registrations are identified by state initials and registration
This was registered by Julius Morris. Morris seems to have been an unpleasant manufacturer, less resistant to employing Chinese workers than to paying them: in 1864 he was convicted of beating a Chinese worker requesting wages due. By 1873, however, Morris renounced any association with the Chinese by registering "White Men's Labor Cigars" as a trademark.\(^4\) Morris was a cigar manufacturer, which in the language of the day needs to be distinguished from cigarmaker, the designation used by journeymen in the trade. It was a combination of journeymen as the Cigar Makers Association of the Pacific Coast (CMAPC) that, perhaps taking inspiration from Morris, registered what is generally recognized as the first union label in 1876. This was a white paper label maintaining

The Cigars herein contained are made by White Men. This label is issued by authority of the Cigar Makers' Association of the Pacific Coast and adopted by Law.\(^4\)

The CMAPC label was given to authorized manufacturers to certify the cigars were union made. Thus we might trace the seeds of US collective and certification marks to a cooperative with a neutral label, a private company with an implicitly racist label, and an unaffiliated union, who imitated the first two and offered its label to approved employers to certify the source of their goods, fulfilling criteria that would be recognized in Lanham 70 years later.

The two distinct ideas behind the label--union certification and anti-Chinese racism--spread at times together and at times a part. A St Louis local of the Cigar Makers' International Union (CMIU) took up the idea of certification to persuade firms to pay union rates. It registered a red label to endorse union-made goods (without a hint of xenophobia) in 1879.\(^5\) After endorsement by the international union's convention in Chicago in 1880, both white and red labels were used to oppose outsourcing in New

\(^4\) "Abusing a Chinaman," Daily Alta California (1864) September 27, p. 1; CA 260.
\(^5\) CA 354.  
St Louis City Archives, "Trade Mark Record 1," p. 90.
York. The CMIU label made the Chinese (or "coolies") only one among various anathemas in its claim that the cigars it marked had been made by cigarmakers "opposed to inferior rat shop, coolie, prison, or filthy tenement-house workmanship." This label was distributed in 1881 and apparently received with enthusiasm.51

California registrations show that unions were not alone adopting racist marks. In 1878, John Shaeffer, once a union member but by 1878 a cigar manufacturer and in 1884 president of the manufacturers association, registered a "white labor" label. Numerous other manufacturers soon followed.52 These marks probably reflect the success of earlier labels and a need to avoid any taint implied by the absence of "white labor" certification. As these trademarks spread, they became more aggressive. In 1882, the Boot and Shoemakers' White Labor League tried to register a label that showed a white hand around the throat of a pigtailed head. The California Secretary of State voided this label (a rare occurrence), probably as an affront to public decency.53 Cigar manufacturers were not so restrained. As racial tensions in the business grew, Adolph Stone registered pictures of a woman on horseback slaying multiple dragons with the copy "abajo los Chinos," "anti monopoly," and "white labor."54 These images seem to have set the tone for the Cigar Makers' International Union (CMIU), whose San Francisco local (228) registered its version of the national label in 1886. This omitted mention of "coolies" but used the phrase "white labor" beside a muscled hand plunging a dagger into a snarling dragon. Manufacturers used variations on this dragon-slaying image, including Shaeffer, who registered the same image with the line "Boycott 'em."55

51 Spedden, Union Label, 13 passim; Brooks, "Trade-Union Label," 190.
52 CA 416, 417, 430, 886, 894, 905, 1261, 1282. For Shaeffer, see Daily Alta California, 1884, December 28.
53 CA 800, 811, 894. So virulent was the League's xenophobia that, at the height of agitation against prison labor, it accepted shoes made by prisoners as long as these carried "white labor" certification. "Shoemakers' League," Daily Alta California 1886, June 19.
54 CA 894.
55 CA 1451, 1480. Dragon-slaying images were perhaps adapted from the trademark of the popular bitters made by Hostetter & Smith (CA 14), where the speared dragon suggests the slaying of digestive demons. Perhaps to avoid rejection by the Secretary of State, the image was used to denounce the Chinese without naming them. In 1895, for example, Mysell & Rollins registered a label for stationery in which putti throttle a dragon with a belt alongside the copy "We are not the advocates of cheap and
The other aspect of the union label—the idea of collective certification marks—also spread quickly, travelling well beyond unions and beyond racism. By the middle of the 1880s, viniculturalists and fruit growers had registered collective marks, as had the Trades Assembly Hall, the Board of Pork Packers, the Farmers Union, and the Butcher's Protective Union.56

To understand where such collective enthusiasm met its limits, it helps to turn from state to federal trademarks and look at US trademark registers. In the first decade of federal registrations, several shoe- and cigar-making unions registered marks, as did members of the growing cooperative movement. Then, in 1879, the Patent Office rejected an application by the CMAPC, the independent California cigarmakers' union, on two grounds. On the one hand, it ruled that "it does not appear that the members of this association all manufacture the same goods" but only that "those who employ [the label] are members of a certain association." On the other hand, the Patent Office ruled that the label's "avowed object is to discourage the Chinese from manufacturing cigars" which the registrar saw as a "restraint of trade ... opposed to public policy."57 Consequently, while in California the marks of unions and other associations continued to be registered, in the federal register they are harder to find. Some union and cooperative marks do appear in the federal register after 1879, but it is not always clear whether this involved lack of attention on the part of the registrar or subterfuge on behalf of the union.58

56 CA 252, 1127, 844, 1387, 838, 839, 1451. In all, of the approximately 5500 marks registered in California by 1905, some 60 were union labels and another 50 cooperatives and associations. While the proportion may seem low, the register includes a large number of ephemeral firms and marks. Those of unions, cooperatives, and associations tend to endure.

57 Ex parte CMAPC. Official Gazette of the United States Patent Office 16(1879), 958.

58 For example, in 1885, during a period of intense industrial confrontation among the hatters in Connecticut, a union-formed company, the South Norwalk Hat Company, registered its mark followed by the Knights of Labor hatters and the Cooperative Hat Company of South Norwalk. These were registered with the encouragement of the national Hatters' Association, which then distributed the South Norwalk union label nationally while claiming protection as a federally registered mark. (See Hatter & Furrier 14 (11)(1885), 11, and later issues.) In 1888, marks of the UK Cooperative Wholesale Society (US 15882) and the Commission de Surveillance et de Controle de la Marque Municipale pour les Soieries Tissées à Lyon (US 16190) were registered. Here, the registrar might have been trying to
**Weighing the results**

Trademark law often appears "chaotic" and trademark judges' decisions capricious.\(^{59}\) Registration can be no less confusing. Though banned by *ex parte CMAPC* and attributed to the Lanham Act, various kinds of collective and certification marks do appear in the federal register from the 1870s. These suggest that union actions did push US innovation in this regard. But, we might ask, was the union label anything more than an obscure sideshow in the history of trademarks, something it would be easy for the President's commission of 1898 to overlook? One way to explore the label's influence is to examine the extent to which it was taken up. Here evidence comes primarily from union records and press. Such partial evidence can be weighed more dispassionately from a second line of enquiry: exploring the extent to which the label was imitated and more directly forged. These trends take us from the trade press into the courts, contemporary testing ground not only for the influence, but also for the validity of these kinds of collective and certification marks. This exploration, first of influence and then of legitimacy, will look primarily, though not exclusively, at the cigarmakers. As they had taken the lead in the development of the union label, so they also took the lead in its initial defence.\(^{60}\)

Within two years of launching its label, the CMIU had issued 8 million and 50 firms were cooperating with the union to use them. The annual total rose to 31 million by 1888 and, as noted above, 1 billion by the end of the century.\(^{61}\) Meanwhile, between 1870 and 1890, the proportion of Chinese in cigar production in California, dropped from almost 90 percent to 72.5.\(^{62}\) Similarly, the hatters claimed 13 million labels issued comply with the Paris Convention, which the United States had signed the year before.


\(^{60}\) As racism remained endemic in their label campaigns, however, they are not necessarily the best representatives of more general trends in label content.

\(^{61}\) Spedden, *Union Label*, 11 and 46.

\(^{62}\) Brown & Philips, "Competition, Racism, and Hiring Practices," table 3. At least some of this decline can be attributed to label agitation, which by favoring closed shops and denouncing tenement labor affected Chinese rates of employment indirectly as well as directly. East reports a five-month label campaign to turn an anti-union employer into a union shop. Dennis East,"Union Labels and Boycotts: Cooperation of the Knights of Labor and the Cigar Makers International Union, 1885-6," *Labor History* 16(2) (1975): 266-271.
between 1885, the year of registration, and 1887 and 95 million by 1898. Such figures indicate significant interest in the label, significant cooperation between labor and management, and measured against their goals, significant success.

As unlabelled goods could be deprecated as the product of "coolie," prison, or child labor, labelled goods commanded a premium. Thus, inevitably, imitation labels appeared. As noted above, private "white labor" labels preceded and accompanied union registrations in California. But a remarkable range of infringers, from small producers (including the Chinese) to the tobacco trusts, flattered the CMIU with passable imitations; others simply stole or forged union labels and stuck them on nonunion cigars. As a judge in one case noted, such behavior "demonstrated the label is at all events worth stealing." With billions, both genuine and imitation, in circulation, it would be hard to argue that by 1900 such labels were unknown to a commission investigating trademarks.

The cigarmakers claimed to have "never missed an opportunity to take infringement cases to court." Courts, however, did not always respond favorably. The tussles were widely reported. In 1889, the New York Times commented that many

63


64 Monroe M. Bird & James W. Robinson, "The Effectiveness of the Union Label and 'Buy Union' Campaigns," Industrial and Labor Relations Review 25(4)(1972): 512-523. Apart from the specific goals (child labor, the eight-hour day, and so on), the label was undoubtedly also a means to raise both the profile and the membership of unions.


67 CMIU v Link, see Cigar Makers' Official Journal [hereafter CMOJ] (1886) November, p. 81. The appeal of the CMIU blue label is suggested in the prosecution of a Chinese cigarmaker Get Fong (the "blue-label felon") accused of stealing CMIU labels to put on Chinese-made cigars. "Held for a Felony," Daily Alta California (1886) July 31, p.1. He was also accused of stealing white labels from the CMAPC. ibid., (1886) Dec 19, p.4.
"judges agree ... [union] labels are defective in nearly every requisite of a legal trade mark." In fact, lack of agreement is more evident, best summed up in a trademark manual which noted how in some cases the union label's "right ... as a trade mark has been denied, while in others the right is affirmed"; among these cases the author was "unable to find a consistent pattern." Another commentary noted tactfully that "courts have not always been in entire accord" while a judge looking over preceding decisions could make little of the "divergent propositions" they put forth. Overall, case law suggests a slow movement from unpredictability to increasing scepticism in a series of high-profile cases.\(^\text{68}\)

Initially, courts were affronted by the brazen imitators. The first sign that such sentiment was shifting came in 1887 when a lower-court decision in the cigarmakers' favor prevailed only because the Minnesota Supreme Court split evenly over the right of an association to own a mark. The following year a group of New York manufacturers, the union believed, deliberately provoked a suit hoping a favourable judgement would overthrow the union's right. (This alone might indicate the efficacy of the label.) The court ruled, however, that the union member had as "valuable interest in the good will of his labor" as the manufacturer had an interest "in the good will of his trade."\(^\text{69}\)

The same year, nonetheless, the union met its first major defeat. The *New York Times* headline reflects the force of this judgement by the New Jersey Vice-Chancellor Van Fleet: "Their label worthless."\(^\text{70}\) This case and a growing number of decisions against union labels were summed up in the case of *McVey v. Brendel* [1891]. The Pennsylvania court, echoing the 1879 ruling of the Patent Office, held first that as a collective the union had no right to a mark and second that marking cigars as not made by "inferior rat-shop, coolie, prison, or filthy tenement house workmanship" defamed those who did not carry the label. For the latter reason, the court held, the union failed the

---


"clean hands" test for coming into an equity court.\textsuperscript{71}

In the eyes of some jurists, such decisions were Canute like in their attempts to restrain both law and practice. Times, they argued, had changed and common law judgements should too. Some criticized the \textit{McVey} decision for its logic, others criticized its detachment from the realities of a marketplace where "certain manufacturers had trademarks placed on goods by their order" in a similar process of certification.\textsuperscript{72} In this vein, the Kentucky Court of Appeals ruled that the union mark is a kind of "certificate of good workmanship" and that such marks of certification were neither unknown nor objectionable.\textsuperscript{73} A similar view had already been accepted in the nonunion, federal case of \textit{Menendez v. Holt} [1885, 1888], where the lower court ruled that Holt & Co had the right to register the mark "La Favorita" to certify flour manufactured by others but selected by Holt. The US Supreme Court accepted that such marks were equivalent to a "certificate that the flour was genuine" and reflected "skill, judgment, and expert knowledge, and add[ed] value and reputation ... when made by those in whom purchasers have confidence."\textsuperscript{74} As, at this times, numerous importers and stores (including Bloomingdale, Lord & Taylor, Macy, Sears, and Wanamaker) let alone retail cigar dealers who sold the output from tenement houses were registering marks to put on goods that they did not make, it took a certain determination to rule against such marks. Most of this resistance arose when it was an association not a corporation doing the certifying, that is when the matter involved a collective as well as a certification mark, but even this, it was noted at the time, took a certain stubbornness. As one judge wrote:

\begin{quote}
I cannot see why ... an association whose members are engaged in the same trade ... may not adopt a label ... it shows that it was made by a member of the union ...

The whole system of labor or trades unions is comparatively modern, and perhaps
\end{quote}

\textsuperscript{71} \textit{McVey v. Brendel} 22 Atl Rep 912 [1891]; the test holds that, whatever their grievance, no one who is guilty of improper conduct can find relief in equity. I have no evidence of private racist labels failing this test.

\textsuperscript{72} For the logic, see \textit{Cohn v. People} 37 NE 60; for the marketplace, \textit{CMIU v. Haak}, see "An Interesting Decision," \textit{CMOJ} 14(5)(1889): 9.

\textsuperscript{73} \textit{Hetterman et al. v. Powers et al.} 43 SW Rep 180 [1897], quotation at 181. Also \textit{CMPU v. Linder} 3 Ohio Dec 244. The CMPU was the Cigar Makers' Progressive Union, which, backed by the Knights of Labor, broke from the CMIU in the 1880s.

\textsuperscript{74} 128 US 514, quotations at 520.
no case can be found in the books ... But it is one of the chief excellencies of the common law that its principle are capable of application to new conditions. 75

This view came, however, from a dissenting opinion. In general, judges increasingly ruled against collective ownership and against certification. The force of all these judgements suggests that judges objected less to the collective or certification character than to the fact that the collective attempting the certifying was a union: it was not the practice but a particular kind of owner that was objectionable. 76 Nonetheless, decisions involving unions influenced cases without unions and thus undermined businesses trying to innovate with collective and certification marks more generally. Hence the Commissioner of Patents, despite the ruling in Menendez v. Holt, refused a "league" of flour dealers a trademark to certify pure flour on the grounds that a league was similar to "a union of workingmen." 77 The Commissioner of Patents' decision, delivered while the Presidential commission to reform the trademark laws sat, noted,

many States have statutes under which collective labels or trade-marks may be protected. It seems to me that there is an equal necessity for ... such a statute on the part of the United States. ... I do not question the propriety of ... such a statute, but in its absence I find no authority ... to register such marks. 78

Despite such comments and the attendant pressures, as we have seen, the President's commission and the federal law of 1905 remained silent, even though, as the Commissioner of Patents noted, several state laws had embraced them. 79 It is to these

75 CMPU v Conhaim 49 MN 243, 943-4 [1989].
77 For their part, unions started sending union members who were also business owners into court, where, standing as a business rather than a union, they found common law protection for the label. See People v. Fisher 50 Hun 552 [1899].
79 As Forbath puts it, "Nowhere else [in the world] did trade unionists contend so constantly for so many decades with judge-made law"; he notes in general the "austere liberal social vision that [courts] identified with the common law." Forbath, "Shaping of the American Labor Movement," 1114. See
laws, as more evidence of the prevalence of collective and certification marks in the nineteenth century, that we now turn.

_Litigation to legislation_

With the courts uncertain, unions changed strategy from litigation to legislation. They first sought laws to prevent the grievances against which the label campaigned. Here they continued to beleaguer the Chinese, lending their help to legislators over the various "Exclusion Acts" of the 1880s and 1890s. But they also fought to outlaw tenement, child, and prison labor (or, at a minimum, require prison-made goods be branded as such). **80** Success in such campaigns made unions aware of their power in state legislatures, which they increasingly pressured to support the label. In 1887, California passed a law explicitly permitting a "trade union, labor association, or labor organization ... [to] adopt and use a trademark." **81** By 1890, some 20 states had similar laws and the 1900 report of the Industrial Commission on Labor Legislation noted that "nearly all the States have now adopted a statute" allowing such labels. **82** Most of these laws mentioned unions specifically; some came closer to general collective-mark legislation, with as in Lanham unions only one among many associations allowed to register marks and pursue injunctions without necessarily meeting the standards for common law or equity courts.

Rather, then, rather than assert their ability to meet such standards--which would have opened federal as well as state courts to them--the unions negotiated a right to be heard in state courts. This right expanded the scope of marking in ways that long anticipated Lanham, but it left the question of federal law on collective marks unresolved. In 1890, the Knights of Labor, the Hatters, and the Cigarmakers all petitioned Congress for federal law, but to no effect. Seven years later Sydney Mudd, a Maryland

---


**82** US Industrial Commission, _Report of the Industrial Commission on Labor Legislation_ vol. 5 (Washington, 1900), 129, which noted 10 states allowing any "person, association, or corporation," to adopt collective marks.
congressman, attempted a law "to protect labour unions and others in the use of trademarks." That too failed.\(^8^3\) Again, as with the international treaties, some of the difficulty reflected the unresolved status of federal trademark law since 1879. Consequently, when the major push for federal trademark reform pulled congress and administration together in the effort that led ultimately to the law of 1905, it seems fair to say, from any reading of the international pressure discussed in the previous section or of the national pressure discussed in this, that it would have been hard to avoid the interest in collective and certification marks. Yet, to repeat, nothing happened. To understand the absence of action is rarely easy. The historian is faced, as in this case, with the awkward world of conjecture and counterfactuals. The best I can hope to offer is context for conjecture.

**Context for conjecture**

When the unions initially developed their collective and certification marks, many of the causes they fought enjoyed, as we have seen, both popular support and the cooperation of employers.\(^8^4\) A writer in *American Federationist* wrote of the label, "As a preventative of strikes and lockouts, and a preserver of friendly relations between the manufacturer and those employed, no other agency has, as yet, manifested so potent an influence."\(^8^5\) This was both a little over sanguine and, in 1897, a little late. By the time the President's commission convened the following year, "friendly relations" were turning hostile.

Where once firms had unionised to gain access to the label, firms now publicly refused to have anything to do with it.\(^8^6\) By the time the law of 1905 was under discussion, the president of Harvard was arguing apocalyptically that "the union label will never give us peace with liberty, never."\(^8^7\)

Formed amid this changing mood, it might not seem odd for President McKinley's commission to have opposed union interests instinctively. Such instincts, however, would have had to overcome the fairly ardent internationalism of at least two members. Forbes and Greeley. Both, as we have seen, were aware of the international

---

\(^8^3\) *Report*, 519.

\(^8^4\) See, for example, Hattan, *Labor Visions*.

\(^8^5\) E. Lewis Evans, "The Union Label," *American Federationist* 4(1897): 142-144, quotation at 143.

\(^8^6\) Mabel Hurd Willett, "Women in the Clothing Trade" pp 390-411 in J.R. Commons, ed., *Trade Unionism and Labor Problems* (Boston, 1905).

\(^8^7\) "Capital and Labor In America," *CMOJ*, 1904, December 17.
commitments that pledged the US to comply with international obligations to accommodate collective marks. There is, by contrast, less evidence that Grosscup had much interest in trademarks at all. He did, however, have strong opinions on unions. His sympathies are evident in both his legal and non-legal writings. In the early 1890s, he grappled with two of the country's most prominent labor leaders, Eugene Debs, of the American Railroad Union [ARU], and Samuel Gompers, president of the American Federation of Labor and former leader of the CMIU. Calling for federal troops to be used against railway strikers and introducing terms like "insurrection," "conspiracy," and "illegal combination" into his judgements, Grosscup helped open the way for the Sherman Anti-Trust Act to be invoked against unions for using the label.\textsuperscript{88} Gompers and Grosscup, moreover, exchanged antagonistic letters that quickly became public.\textsuperscript{89} The depth of Grosscup's antipathy might best be measured from a piece he wrote more than 20 years later, in which his utter distaste for Gompers, unions, and collective action, all of which Grosscup associated with "Sovietism" and "irresponsible radical leadership... trying to undermine the concept of law and order," endures.\textsuperscript{90} Gompers was vice-president of the cigarmakers' union, when the President's commission was formed, and as the cigarmakers' union was the dominant force behind the early union label, Grosscup's appointment was, at best, unlikely to favor union interests and likely to oppose anything they supported, even if others supported it too.

The commission's failure to address union labels directly and to call no union witnesses (though one, as noted, had a billion collective marks in circulation) is remarkable.\textsuperscript{91} But there is no need to lay responsibility on one figure. Had the commission ruled in favor of collective and commercial labels and the international obligations they represented, suitable law would have faced a difficult passage through

\textsuperscript{88} For conspiracy charges, and the \textit{Debs Case} see Frankfurter & Greene, \textit{Labor Injunction}, 17ff; Marot, \textit{American Labor Unions}.


\textsuperscript{91} It might seem possible to argue that the commission was simply unaware of the prevalence of collective and certification marks at the time. To counter this idea that I have, wherever possible, cited the commissioners' \textit{Report} for evidence of international commitments, national law, and the union label.
Congress as anti-label sentiment was growing. In 1903, the National Association of Manufacturers, one of the Commission's principal witnesses, declared forthright opposition to the union label. The same year, the Citizens' Alliance (or Citizen's Industrial Association) took an anti-label fight against the unions across the country. The Alliance sought, in particular, to end cooperation between unions and small business owners over the label. Enigmatically, the Alliance issued its own nonunion certification label in California (drawing in response a suit for infringement from unions). Meanwhile, D.E. Loewe, with the help of the American Anti-Boycott Association and building on opinions like Grosscup's, was starting twelve years of litigation against the hatters of Danbury for conspiracy to destroy interstate commerce with the help of their labels.

In this period, too, ideas about intellectual property were changing. As Catherine Fisk has shown, courts increasingly rejected workers' rights to intellectual property. In this vein, the defence in one union label case argued that union members were not "manufacturers of cigars, but merely laborers employed to convert the material provided into the article of trade" (though, as James Duke acknowledged, his employees "knew more about manufacturing tobacco than the man that owned the business and sold it"). This was the case in which the lower court in this case had held that the "laborer has the same valuable interest in the good will of his labor as the manufacturer has in the good will of his trade." But Vice-Chancellor Van Fleet denied anything accrued to making per se--arguing that the journeymen were "skilled workmen and nothing more." Ownership in a mark for Van Fleet had nothing to do with labor or good will, but with a "vendible commodity" and that belonged to the manufacturer or retailer. Once again, it

---

92 The commission also "took into consideration the views expressed by the American Bar Association, the Manufacturers Association of America, the Pharmaceutical Association, the US Trade-Mark Association, and the Association of Retail Druggists." Report, 5. None was likely to support the union label.


seems that anti-labor antagonism overruled all other arguments for collective and certification marks.

Van Fleet's argument is simultaneously both forward looking and highly conservative. It appears forward-looking in comparison, for instance, to Lord Westbury, the UK Lord Chancellor from 1863-5. Westbury "held that if a man had a particular emblem by which he denoted the results of his own labour, the law protected him in the exclusive use of that emblem, and to that extent, [the emblem] became his property." For Westbury the property test turns not on the "vendible commodity" but on the mark, and the right to such a mark vests in the person whose labor is at issue. Westbury's labor theory of property argues in a tradition extending back at least to Locke. Van Fleet, in contrast, reflects the late-nineteenth-century shift away from such a view of property towards one in which work for hire implicitly surrendered any claims in labor or rights of ownership to the person hiring. In England, Communists and Chartists had been fighting (and losing) fights over rights in labor for many years, and Marx had argued that under capitalism, in return for a subsistence wage laborers surrendered "noble reproductive power." In Van Fleet's view, they also surrendered the right to "denote the result of their own labour" in a label.

Courts that rejected unions' rights to use an emblem or mark to certify their collective labor rejected the Lockean tradition of labor and value and pushed into the new territory of the marginalists. Paradoxically they simultaneously claimed for themselves a traditionalist's position, invoking common law and rejecting "new" practices of collective and certification marking, even when these were not union related. Hence, by ignoring tradition in labor, they managed also to ignore innovation in marks. In the end, the fight towards collective and certification marks within the United States, then, might best be understood as a struggle between the international development of collective and certification marks.

Schneider v. Williams, 814, 815.


certification marks and the national anti-labor enclosure movement that Fisk describes encircling intellectual property during the Second Industrial Revolution.\textsuperscript{100}

Paradoxically, the need for innovation provides the best justification for that enclosure. In the case of trademarks, however, in order to deny ownership to employees, enclosure specifically turned its back on innovation.

\textbf{Conclusion}

By the end of the nineteenth century, business practice in the area of trademarks was changing. Firms, cooperatives, and associations, both within the United States and outside were using collective, certification, and service marks. Courts and legislatures struggled to keep up. As countries passed relevant law, they pushed their trading partners through treaties and conventions to stay abreast. And as some of the several states passed relevant law, that too directly and indirectly put pressure on the US federal government. And yet, when in the midst of all this the US government had the opportunity to revise its law, it acted as if there were no issue to address. It remains hard to understand why, but as this paper has sought to show, one plausible reason is that collective and certification marks were, in the United States, primarily the product of unions and when the law was rewritten in 1905 anti-unionism was growing. Innovation from that direction was not admissible.

Not only did nothing happen in 1905, but when US law finally caught up in 1946, 50 years of US obfuscation and fudges around treaties and commitments were forgotten. Commentators celebrated the Lanham Act as if it were an unprecedented stride into the future rather than a tacit apology to for the past. In the acknowledged absence of hard evidence, this paper has attempted to suggest that the omissions of 1905 were the result of prejudice. Not the racial prejudice of the early California labels, but prejudice against the unions themselves and the innovative rights of certification they were trying to claim. What then of the purblindness of 1946 and after when Lanham has been proclaimed as innovative and forward looking and assimilated into evolutionary accounts of trademark law and practice? The reason historians overlook the omissions of 1905 and celebrate the innovation of Lanham may be much the same as the reason those omissions occurred. A while ago, Philip Scranton suggested that business history tends to find the labor process uninteresting.\textsuperscript{101} By extension, business, legal, and marketing history can seem unaware

\begin{footnotesize}
\begin{enumerate}
\item Fisk, \textit{Working Knowledge}.
\item Philip Scranton, \textit{Figured Tapestry: Production, Markets, and Power in Philadelphia Textiles, 1885-}
\end{enumerate}
\end{footnotesize}
of the possibility of innovation by organized labor. Thus, the goal of this article is not necessarily to extol the unions. Indeed, to tell this tale has required revisiting some thoroughly unpleasant aspects of union history. But the history of trademarks and brands, which has flourished in recent years, has been primarily Whiggish, celebrating the achievements of big brands, forward-looking entrepreneurs, and canny marketing men. It has also looked to new laws as determinants of innovative change. Such work is unquestionably important. Occasionally, however, it may be turning a blind eye to history—though turning it not, as in Nelson's paradigmatic case, to the signal for retreat, but rather to signs of progress.\textsuperscript{102}

\textsuperscript{102} In 1958 articles on certification marks still portrayed unions as parvenus. See Donald A Taylor, "Certification Marks--Success or Failure?" \textit{Journal of Marketing} 23(1)(1958): 39-46.