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## PERSONAL NAMES AS TRADE SYMBOLS

JAMES A. PIKE†

A personal name is the most natural and obvious way for the vendor of goods or services to identify his product. In the early stages of his business a rather direct relation with customers brings about the adoption of his own name as the *indicium* of his output. Thus, the hats made by a John B. Stetson, known in the local community as a hatter, would naturally be called *Stetson* hats. As the business grows and expands and this personal relationship gradually disappears, the name begins to serve a different function. While it once indicated a known source, it now indicates an anonymous one: it merely tells the consumer that the present article is from the same source—whatever it may be—as other goods, similarly identified, with which he has had experience. But when the business has achieved this state of importance it is unlikely that, for example, the hatter—now become the hat manufacturer—would wish to change his brand-name to one more in accord with its anonymous function, such as *Fashion* or *Gold Medal*. Even if a certain measure of human vanity did not enter the picture such a change would usually result in serious loss of custom, since the thoughtways of the buying public are rather static.

Yet as natural as is the adoption and retention of the personal name, there is no type of trade symbols which, under the existing state of the law, is more difficult to protect against invasion by others. Vice-Chancellor Wood in *Ainsworth v. Walmsley*,<sup>1</sup> after mentioning the appropriateness of

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\*The author prepared this article while Legal Assistant to the Reporter for Unfair Competition, American Law Institute's Restatement of Torts, and wishes to express his indebtedness for the analysis of the Reporter, Professor Harry Shulman of the Yale Law School.

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1. L. R. 1 Eq. 518 (1866).

such names was careful to add: "subject only to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name."<sup>2</sup>

In fact there are few problems in the field of unfair competition in which there is greater conflict of worthwhile interests. Of course if a descriptive or geographical name be adopted as a trade symbol there also may be present the desire and need of others to use the same word on competing goods or services, but there is not in the nature of things any particular necessity or advantage in their using it denominatively, *i. e.*, as the *name* of the goods or services. There is usually little reason why, apart from the desire to profit from the confusion of the public, that the defendant need use *Yorkshire Relish* rather than *Ideal Relish, Made at Yorkshire, Eng.*,<sup>3</sup> or *Dyanshine Polish* rather than *Star Polish—It Dyes and Shines*.<sup>4</sup> But there is considerable reason, entirely apart from the desire for confusion, that a man named Rogers might like to have his silverware known by his own name.<sup>5</sup> Neither local pride nor the desire to be accurately descriptive is as strong a motive as personal pride in one's handiwork. In balancing the desires and needs of plaintiff and defendant in such cases the courts have a delicate task indeed.

## I

### WHY PERSONAL NAMES USUALLY MAY NOT BE TRADE-MARKS

First, what is the nature of the plaintiff's legal right in a personal name adopted as a trade symbol? The answer to this question involves some digression into the development of the law of trade-marks and unfair competition.<sup>6</sup>

It was not until late in the last century that trade-marks or trade

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2. *Id.* at 525.

3. *Cf.* Birmingham Vinegar Brewery Co. v. Powell, [1897] A. C. 710.

4. *Cf.* Barton v. Rex-Oil Co., 29 F. (2d) 474 (C. C. A. 3d, 1928), *mod.* 2 F. (2d) 402 (C. C. A. 3d, 1924).

5. The so-called "right" to use one's own name in business is discussed more fully at p. 108 *et seq.*, *infra*.

6. For the early history of trade-marks and "gild marks" see SCHECHTER, HISTORICAL FOUNDATION OF TRADE-MARK LAW (Columbia Legal Studies, 1925) cc. II-VI.

names were viewed as "property" interest.<sup>7</sup> Traditionally any liability that existed for infringement was based upon the fact that the defendant has "passed off" his goods as those of the plaintiff.<sup>8</sup> This action for "passing off" was not, strictly speaking, an action of deceit, because the plaintiff's customers rather than the plaintiff had been deceived.<sup>9</sup> But it was regarded as an action in the nature of deceit and an extension of the action of deceit.<sup>10</sup> The adoption by the defendant of a mark or name similar to the plaintiff's was the means by which the deceit was accomplished and was the evidence of the intent to accomplish it. The thought that a "property right" of the plaintiff in the mark was being protected never occurred to the courts.<sup>11</sup>

Since the essence of the action was the defendant's palming off his goods as those of another particular known person the best evidence was that he had simulated a mark which pointed distinctly to that known source. The most obvious designation of this kind was the personal name. Thus Vice-Chancellor Wood said in 1857, "The simplest case is, where a man puts his name and address on the goods which he manufactures."<sup>12</sup> And as late as 1866 it was asked: ". . . is not a man's name as strong as an instance of trade-mark as can be suggested?"<sup>13</sup>

7. On the "property" concept see note 26 and pp. 116-118, *infra*.

8. Thus in the earliest case squarely protecting a trade-mark the word "trade-mark" was not mentioned. Rather the court asked the jury to find whether or not there was an intent to pass off. *Sykes v. Sykes*, 3 B. & C. 541 (K. B. 1824). See also *Knott v. Morgan*, 2 Keen 213 (Ch. 1836); *Crawshay v. Thompson*, 4 Man. & G. 357 (C. P. 1842); *Perry v. Truefitt*, 6 Beav. 66 (Ch. 1842); *Croft v. Day*, 7 Beav. 84 (Ch. 1843).

9. However, the case of *Southern v. How*, Poph. 143 (K. B. 1618), in which there was a much cited *dictum* on the protection of trade-marks, was classified in the early digests as an action of deceit. References are collected in SCHECHTER, *op. cit. supra* note 6, at 9, n. 1.

10. *Crawshay v. Thompson*, 4 Man. & G. 357, 385 (C. P. 1842) ("This is in the nature of an action for deceit. . . ."); *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De. G. J. & S. 137, 139 (Ch. 1863) ("an action on the case in the nature of a writ of deceit").

11. "There was no property in any trade-mark or trade name which the (common) law recognized. . . . The ground of the court's interference to prevent such fraudulent use was to save the public from a fraud." 2 STEPHENS, COMMENTARIES ON THE LAW OF ENGLAND (16th ed. 1914) 58.

12. *Collins Co. v. Brown*, 3 K. & J. 423, 427 (1857). See also *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. Cas. 523, 538 (1865).

13. L. R. 1 Eq. 518, 525 (1866). See also *Burke v. Cassin*, 45 Cal. 467, 480 (1873): "The name of the manufacturer or seller of goods may, of course, be used as a trade-mark. . . ." And even in 1922 a text-writer said: "A surname is, within limits, a most effective trade-mark, its very purpose being to distinguish . . ." SEBASTIAN, TRADE-MARK REGISTRATION (2d ed. 1922) 22.

The simulation of other types of designations adopted by plaintiff might also show "passing off". The Rhode Island court said, "Trade-marks may be, first, the name of the maker; second, symbolical; third, the name of the compound."<sup>14</sup> But when designations other than personal names were used the courts were concerned that the symbol *in fact* be one which pointed to the plaintiff.<sup>15</sup> Thus the United States Supreme Court said in *Canal Co. v. Clark*,<sup>16</sup> ". . . the trade-mark must either by itself, or by association, point distinctively to the origin or ownership of the article to which it is applied. The reason of this is that unless it does, neither can he who first adopted it be injured by any appropriation or imitation of it by others, nor can the public be deceived. . . . The trade-mark must therefore be distinctive in its original signification, pointing to the origin of the article, or it must have become such by association."

Of course such notions were based on an economy in which personal business relations were predominant. The purchaser did not necessarily *know* the manufacturer or seller; but certainly he knew who he was, and in large measure relied on his personal reputation.<sup>17</sup> The expansion of business and the extension of marketing channels through improvement in transportation has reduced to anonymity the manufacturers of most of the products we use. Few people could tell you what manufacturer is represented by the names *Coca-Cola* or *Listerine*. However, this does not mean that these names indicate nothing to the consumer. They serve the very important function of guaranteeing that the particular bottle now being purchased comes from the same source—whatever it may be—as

14. *Davis v. Kendall*, 2 R. I. 566, 569 (1850).

15. In *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. Cas. 523, 538 (1865), Lord Kingsdown said: "A man may mark his own manufacture, either by his name, or by using for the purpose any symbol or emblem, however unmeaning in itself, and if such *symbol* or *emblem* comes by use to be recognized in trade as the mark of a particular person, no other trader has a right, to stamp it upon his goods of a similar description. This is what I apprehend is usually meant by a trade mark . . ." (italics the author's).

16. 80 U. S. 311, 323 (1871).

17. It became recognized that the mark did not have necessarily to indicate the manufacturer. Thus middle men or retailers might have trade-marks. *Menezes v. Holt*, 128 U. S. 514 (1888) (selector of flour); *Nelson v. Winchell & Co.*, 203 Mass. 75, 89 N. E. 180 (1909) (jobber); *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151 (N. Y. 1869) (printer of fabrics made by another); *In re Australian Wine Importers*, 41 Ch. D. 278 (1889) (selector and retailer of wines). Nevertheless someone's reputation was being relied on. In *Menezes v. Holt*, *supra*, at 520, the court pointed out that the mark "evidenced . . . the skill, knowledge and judgment of [the plaintiff] . . ."

the bottle, with the same label, which was purchased last week.<sup>18</sup> Thus Mr. Justice Holmes said of Coca-Cola, "It means a single thing coming from a single source, and well known to the community."<sup>19</sup> Even today in many instances the mark may indicate known source;<sup>20</sup> as we have seen, most trade names in their genesis serve this function.<sup>21</sup> But they *need* not indicate known source and in most cases do not.<sup>22</sup>

However, entirely apart from indication of source—known or unknown—trade symbols have come to serve other important functions. Most important is the function of the trade symbol in demand-creation. The mark itself may have an emotional, or even intellectual, appeal which sells goods or services. The more often it is imprinted upon the mind of the public the more likely it is that consumers will think of the particular brand when in need of the product. This aspect of trade designations was recognized as early as 1860—and decried:

"The injury to the public, by the mysterious fascination of far-fetched or high-sounding names, and strange devices, investing a worthless commodity with the charm of an unknown origin and pompous title is, generally, greater than any benefit to those who first adopt it. It is somewhat singular, that an article only known as the product of a particular person's skill and labor, and for its excellence as such, rises more slowly in popular favor than those dignified by fanciful names, suggested by a capricious fancy or barbarous taste . . . ."<sup>23</sup>

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18. In *In re McDowell's Application*, 43 Rep. Pat. Cas. 313 (C. A. 1926), it was urged that since *Nujol* was not sold in the plaintiff's name but under the importer's name the public did not know the source of the product. Lord Justice Warrington said: "The deception which I think the registration would be calculated to produce is that the two products emanate from the same source, and for the purposes of the present question it does not, in my opinion matter whether the public do, or do not, know what that source is." *Id.* at 337. Also see opinion of Judge Learned Hand in *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 Fed. 960, 963 (C. C. A. 2d, 1918), and *Bayer Co. v. United Drug Co.*, 272 Fed. 505, 509 (S. D. N. Y. 1921).

19. *Coca-Cola Co. v. Koke Co.*, 254 U. S. 143, 146 (1920).

20. This is particularly true of trade names for businesses. The name of a business not attached to goods may not be a trade-mark. See p. 107 and note 83, *infra*.

21. See p. 1, *supra*.

22. See Schechter, *The Rational Basis of Trademark Protection* (1927) 40 HARV. L. REV. 813, 814-15. In *Walter Baker & Co. v. Slack*, 130 Fed. 514, 518 (C. C. A. 7th, 1904), the court conceded that "not one in a thousand knowing of or desiring to purchase 'Baker's Cocoa' or 'Baker's Chocolate' know of Walter Baker & Co., Limited." Also see *Birmingham Vinegar Brewery Co. v. Powell*, [1897] A. C. 710, 715; *Rouss v. Winchester Co.*, 300 Fed. 706, 722-23 (C. C. A. 2d, 1924), *cert. denied*, 266 U. S. 607 (1924). The speculations of these cases are confirmed by tests that have been made. See the experiment reported in Schechter, *loc. cit. supra*, and the later one discussed at pp. 111-112, *infra*.

23. *Corwin v. Daly*, 7 Bos. 222, 227 (N. Y. 1860).

With the increasing complication of the marketing process this function, instead of being less usual and a "mysterious" one, is now the usual and obvious one. And it is no longer the object of condemnation. The late Dr. Frank I. Schechter felt that

"... the following principles necessarily emerge: (1) that the value of the modern trademark lies in its selling power; (2) that this selling power depends for its psychological hold . . . upon the merit of the goods upon which it is used, but equally upon its own uniqueness and singularity . . . that the preservation of the uniqueness of a trademark should constitute the only rational basis for its protection. . . ."<sup>24</sup>

What is the effect of this rationale upon the appropriateness of personal names as trade-marks? We have seen that as indicia of a known source they were regarded the most appropriate type of mark.<sup>25</sup> But as indicia of an unknown source they are certainly no more appropriate than arbitrary marks or meaningless symbols; and as "unique" selling factors they are not appropriate at all. Consistent with the growth of the notion that a trade-mark constitutes a form of "property"<sup>26</sup>—valuable in itself and protectable as property—rather than merely the means and evidence of passing off, is the theory that nothing is a trade-mark that cannot be exclusively appropriated. We shall see that, contrary to the usual assumption, even the most unique trade-marks cannot *always* be exclusively appropriated.<sup>27</sup> But due to their uniqueness it is more likely that they may be; and, *e converso*, due to their non-uniqueness it is very likely that personal names may not be. Hence they are not, in general, regarded as trade-marks.<sup>28</sup> The Vice-Chancellor saw nothing inconsistent in his state-

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24. Schechter, *supra* note 22, at 830-31. Particularly able, also, is the analysis of Professor Isaacs in *Traffic in Trade-Symbols* (1931) 44 HARV. L. REV. 1210, 1220.

25. See pp. 95-96, *supra*.

26. Trade-Mark Cases, 100 U. S. 82, 92 (1879); *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137, 139 *et seq.* (Ch. 1863); 2 POMEROY, *EQUITABLE REMEDIES* (1905) § 577; SALMOND, *TORTS* (6th ed. 1924) 565-66. For a full discussion of the views on this problem, see SCHECHTER, *op. cit. supra* note 6, at 150 *et seq.* Also see DERENBERG, *TRADE MARK PROTECTION AND UNFAIR TRADING* (1936) § 5, and SEBASTIAN, *loc. cit. supra* note 13.

27. See pp. 116 and 117, *infra*.

28. *Rouss Inc. v. Winchester Co.*, 300 Fed. 706 (C. C. A. 2d, 1924), *cert. denied*, 266 U. S. 607 (1924); *Drake Medicine Co. v. Glessner*, 68 Ohio St. 337, 67 N. E. 722 (1903); see *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U. S. 461, 464 (1914). See cases and patent office rulings collected in 1 SHOEMAKER, *TRADE-MARKS* (1931) §§ 101, 103; DERENBERG, *op. cit. supra* note 26, at 279, n. 44.

ment that a personal name was the most suitable trade-mark, subject only to the "inconvenience" that others of the same name could also use the mark.<sup>29</sup> But under the present-day attitude toward the function of trade-marks—whether it be phrased in terms of "property" or guaranty, or demand-creation—it is inappropriate to regard a personal name as a trade-mark.

That the designation cannot be exclusively appropriated is the reason also why descriptive<sup>30</sup> or geographical<sup>31</sup> terms may not be trade-marks.<sup>32</sup> Words which may be trade-marks are those which are arbitrary or fanciful. The theory is that they may be "exclusively" appropriated because *ex hypothesi* there is no need for their use by others. And for the same reason if a so-called "composite trade-mark" is in total effect arbitrary it will be protected even though individual elements of it may be descriptive, geographical or personal.<sup>33</sup> This rule has application in the personal name field especially with regard to names distinctively written or used in connection with portraits.<sup>34</sup>

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As to personal names the Trade-Mark Act of 1905 (§ 5) provides that ". . . no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual . . . ." may be a trade-mark. 15 U. S. C., § 85 (1927).

29. *Ainsworth v. Walmsley*, L. R. 1 Eq. 518, 525 (1866); see pp. 93 and 95, *supra*. For a similar attitude see *SEBASTIAN*, *loc. cit. supra* note 13, where the trade-mark right in a personal name and the inconvenience of use by others are urged in the same breath.

30. *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. 599 (N. Y. 1849); see *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U. S. 526 (1924). Numerous cases are collected in *NIMS, LAW OF UNFAIR COMPETITION AND TRADE-MARKS* (3d ed. 1929) 526-28; *HOPKINS, TRADE-MARKS, TRADE NAMES AND UNFAIR COMPETITION* (4th ed. 1924) 98a-131; *OFFENHEIM, CASES ON TRADE REGULATION* (1936) 103-105. This limitation was made part of the Trade-Mark Act of 1905, 15 U. S. C., § 85 (1927).

31. *Columbia Mill Co. v. Alcorn*, 150 U. S. 460 (1893). See cases and rulings collected in 1 *SHOEMAKER*, *op. cit. supra* note 28, § 90; and *DERENBERG*, *op. cit. supra* note 26, 257, n. 89. The rule that geographical names may not be trade-marks was made part of the Trade-Mark Act of 1905, 15 U. S. C., § 85 (1927).

32. Descriptive and geographical words which are invalid as trade-marks but which have acquired a "secondary meaning" (see p. 104 *et seq.*, *infra*) may be protected as trade names.

33. *Estate of Beckwith v. Commissioner of Patents*, 252 U. S. 538 (1920); *Ostermoor & Co. v. Rose Spring & Mattress Co.*, 5 F. (2d) 268 (App. D. C. 1925), *aff'd*, 12 F. (2d) 847 (App. D. C. 1926); *Ex parte Pittsburg Flour Mills*, 450 Off. Gaz. 3 (1934).

34. *Fahey Tobacco Co. v. Senior*, 252 Fed. 579 (C. C. A. 3d, 1918); *Ex parte Forhan*, 8 T. M. Rep. 231 (C. P. 1918). See cases collected in 1 *SHOEMAKER*, *op. cit. supra* note 28, §§ 104-105. The Trade-Mark Act specifically provides for registration of composite marks of these types. See the second paragraph of note 28, *supra*.



## II

## NAMES OF NOTABLES AS TRADE-MARKS

Since the arbitrary character of a designation is the criterion of its availability as a trade-mark, a particular personal, geographical, or descriptive name which is in fact arbitrary when used on the particular goods may be a trade-mark. Thus, while *California* would not be a good trade-mark for oranges, it would be a valid one for sun-lamps made in Brooklyn.<sup>35</sup> And while *Cream* would not be a good trade-mark for cheese it would be a good trade-mark for baking powder.<sup>36</sup> There is a similar exception with regard to personal names. The names of notable historical or literary characters may be trade-marks. Thus such assorted names as Napoleon,<sup>37</sup> Delsarte,<sup>38</sup> Ramases,<sup>39</sup> Aladdin,<sup>40</sup> Roger Williams,<sup>41</sup> Livingstone,<sup>42</sup> and Lamartine<sup>43</sup> have been upheld as trade-marks.

None of these characters were living at the time their name was being so used. Would the rule be different where the notable person is still alive? The authorities are somewhat meagre on this point. In the *Roger*

35. *E. g.*, *In re Alpine Trade-Mark*, 53 L. T. (N. S.) 79 (1885) (*Alpine* for cotton embroidery); *Colgate v. Adams*, 88 Fed. 899 (C. C. N. D. Ill. 1898) (*Cashmere Bouquet* for soap); *Ex parte Tietgens & Robertson*, 87 Off. Gaz. 2113 (1899) (*Hansa* for lard and sausages).

A geographical name may also be a trade-mark if the user is the sole owner of the place where the goods are produced [*Manitou Springs Mineral Water Co. v. Schueler*, 239 Fed. 593 (C. C. A. 8th, 1917), *cert. denied*, 243 U. S. 645 (1917); *Dunbar v. Glenn*, 42 Wis. 118 (1877)], or of the only source of production in the locality [*Braham v. Beachim*, 7 Ch. D. 848 (1878)], or if the user has the exclusive right of importation from the place [*Radde v. Norman*, L. R. 14 Eq. 348 (1872)].

36. Registration was allowed in *International Food Co. v. Price*, 150 Off. Gaz. 827 (1910). See also *De Voe Snuff Co. v. Wolff*, 206 Fed. 420 (C. C. A. 6th, 1913) (*Eagle* for snuff); *Heublein v. Adams*, 125 Fed. 782 (C. C. Mass. 1903) (*Club Cocktails*); *Hughes v. Alfred H. Smith Co.*, 205 Fed. 302 (S. D. N. Y. 1913), *aff'd*, 209 Fed. 37 (C. C. A. 2d, 1913) (*Ideal* for hair brushes).

Descriptive words not in general use may also be trade-marks. *Le Blume Import Co. v. Coty*, 293 Fed. 344 (C. C. A. 2d, 1923) (*L'Origan* for perfume made from the origan flower).

37. *Goldstein v. Whelan*, 62 Fed. 124 (C. C. N. D. N. Y. 1894).

38. *Medlar & Holmes Shoe Co. v. Delsarte Mfg. Co.*, 68 N. J. Eq. 706, 61 Atl. 410 (1905).

39. *Stephano Bros. v. Stamatopoulos*, 238 Fed. 89 (C. C. A. 2d, 1916).

40. *Mantle Lamp Co. of America v. Aladdin Mfg. Co.*, 9 F. Supp. 930 (N. D. Ill. 1934), *rev'd*, 78 F. (2d) 426 (C. C. A. 7th, 1935).

41. *Barrows v. Knight*, 6 R. I. 434 (1860).

42. *National Distilling Co. v. Century Liquor & Cigar Co.*, 183 Fed. 206 (C. C. A. 6th, 1910).

43. *Dalbanne & Petit v. Colleuille & Co.*, 7 *Annales de la Propriete Industrielle* 414 (Ct. of Paris, 1861).

*Williams* case the Rhode Island court gratuitously said that one could have a trade-mark in the name of "any hero, living or dead."<sup>44</sup> The exclusive right to grace paper collars with Bismarck's name was granted while he was still alive,<sup>45</sup> and in 1918 Pasteur's name was held a proper trade-mark for sterilizing filters.<sup>46</sup> But a contrary position has been taken by a number of patent office rulings. During the Spanish-American war registration was sought for the name *Dewey* to be used for candy, but it was denied because "a living celebrity is entitled to protection from the ordinary trader."<sup>47</sup> Likewise registration was denied to *The Gibson Girl* for shoes,<sup>48</sup> and *Roosevelt Rose* for groceries<sup>49</sup>—in the latter instance because it would be against public policy to allow commercial use of the name of the chief executive.<sup>50</sup>

In both the *Dewey* and *Roosevelt* rulings stress was placed upon the lack of the consent of the bearer of the name; and it has been ruled that the personal name of a notable character may be a trade-mark where his consent is procured.<sup>51</sup> This approach seems much sounder than that of the decisions allowing free appropriation of the name of a living dignitary. Certainly there should be a public policy against such an invasion of another's interests; and there is some authority tending to show that such a public policy exists.<sup>52</sup> In several cases the use of a personal name in trade was enjoined at the instance of bearers of the name.<sup>53</sup> In one such case the court said:

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44. *Barrows v. Knight*, 6 R. I. 434, 438 (1860).

45. *Merserole v. Tynberg*, 36 How. Pr. 14 (N. Y. 1868).

46. *Societe Anonyme v. Pasteur Chamberland Co.*, 8 T. M. Rep. 298 (S. D. Ohio, 1918).

47. *Ex parte McInnerney*, 85 Off. Gaz. 148 (1898).

48. *Ex parte Bishop*, 107 Off. Gaz. 1973 (1903).

49. *Cf. Ex parte John Dewar & Sons*, 98 Off. Gaz. 1037 (1902) (copyright case decided on analogy to trade-marks).

50. *Ex parte R. I. Sherman Mfg. Co.*, 101 Off. Gaz. 3105 (1902).

51. *Ex parte Sullivan & Burke*, 16 Off. Gaz. 765 (1879). Consent had been procured in the Pasteur case (see note 46, *supra*).

52. In addition to the cases and statutes here discussed bearing directly on the use of another's name as a trade-mark or trade name, there is general indication of a public policy in the cases involving invasion of the "right of privacy". Cases recognizing this right are collected in *SELECTED ESSAYS ON THE LAW OF TORTS* (1924) 122, and Note (1929) 43 *HARV. L. REV.* 297. The landmark article on the subject is Warren and Brandeis, *The Right to Privacy* (1890) 4 *HARV. L. REV.* 193. Also see Ragland, *The Right of Privacy* (1929) 17 *KY. L. J.* 85.

53. In a recent Illinois case the plaintiff who had retired from the millinery business secured an injunction against continued use of her name after the license which she had given the defendants expired. *Minton v. Smith*, 276 Ill.

“It would seem to be a proposition hardly requiring argument that every man is the custodian of his own reputation, and is entitled to say who shall do business, and what business shall be done, under his name.”<sup>54</sup>

The well-known *Edison Polyform* case<sup>55</sup> is really an indication of judicial aversion to the appropriation of another's name, even though the decision was put on the more artificial ground of protection to Edison's business interests.<sup>56</sup>

Also indicative of a public policy are the statutes of Massachusetts and New York. While the Massachusetts prohibition against the continuance in the partnership name of the name of any person who is deceased or who has withdrawn from the partnership without the consent of such person or his legal representative<sup>57</sup> is somewhat limited,<sup>58</sup> the New York law broadly provides civil and criminal remedies against the use for purposes of advertising or trade of any name without the consent of the owner.<sup>59</sup> It would seem that the courts should have no difficulty in

App. 128 (1934). The court mentioned the fact that she might wish to re-engage in the business. *Id.* at 31-32. In *Christy v. Murphy*, 12 How. Pr. 77 (1856), the plaintiff intended to resume performances of his *Christy's Minstrels*. However, in *Scheer v. American Ice Co.*, 32 Misc. 351, 66 N. Y. Supp. 3 (Sup. Ct. 1900), where the plaintiff had agreed *not* to resume business for a number of years, an injunction was issued against continued use of his name by the purchasers of his business. And in *Ohlbaum v. Correa*, 178 App. Div. 838, 66 N. Y. Supp. 3 (1st Dep't 1917), a plaintiff who had surrendered his right to the name to his brother upon the dissolution of their partnership was given relief against a stranger who appropriated the name. The court made no mention of the plaintiff's possible resumption of business.

54. *Scheer v. American Ice Co.*, 32 Misc. 351, 352, 66 N. Y. Supp. 3 (Sup. Ct. 1900).

55. *Edison v. Edison Polyform & Mfg. Co.*, 73 N. J. Eq. 136, 67 Atl. 392 (1907).

56. See also the make-weight argument advanced in *Scheer v. American Ice Co.*, 32 Misc. 351, 352-53, 66 N. Y. Supp. 3 (1900): “If it were necessary, however, [and, fortunately, the court did not regard it as necessary] to point out specific and substantial injuries which the plaintiff is exposed to by reason of the unauthorized acts complained of, it would not be difficult to do so. He is, for example, subject to the cost and vexation of suits that might be brought against him by reason of things that may happen in the business carried on in his name.” This same specious argument is advanced in *Walter v. Ashton*, [1902] 2 Ch. 282, where the use of “The Times” on bicycles was enjoined at the instance of the London Times.

57. MASS. GEN. LAWS (Terc. ed. 1936) c. 110, §§ 4, 7.

58. While the name may not be continued as a trade name for the business the statute has been construed as not prohibiting continued use of the name as a trade-mark for goods. *Bowman v. Floyd*, 3 Allen 76, 78 (Mass. 1861).

59. Use “for advertising purposes, or for purposes of trade” of “the name, portrait or picture of any living person” without his consent (or if a minor, the consent of his parent or guardian) is a misdemeanor. N. Y. CONS. LAWS

refusing trade-mark protection to the use of another's name without his consent. The patent office seems to have followed a fairer course in this regard than the few courts which have passed over the matter.<sup>60</sup>

Some difficulty arises where the name of the notable is also one in common use. Obviously *John Smith* is not subject to appropriation as a trade-mark even if the user has named his product in honor of the distinguished Virginia settler. The use of the name must be such that it will be generally understood to be arbitrary or fanciful. *Capt. John Smith* would be a valid trade-mark; so also would be *Henry W. Longfellow*, but not *Longfellow*.<sup>61</sup> A similar limitation arises where the name has a geographical as well as a personal significance. Thus the United States Supreme Court held that *Pocahontas* could not be a trade-mark for coal, since there was a well-known Pocahontas coal region.<sup>62</sup> For the same reasons *Columbus* or *Washington* would not be valid as trade-marks. However, *Christopher Columbus* or *George Washington* would be valid.<sup>63</sup> If the geographical aspect of the word is little known it may be a trade-mark. Thus trade-mark protection was given to the name *Ramases* even though the defendant claimed that there was a village in Egypt by that name.<sup>64</sup>

### III

#### PERSONAL NAMES AS TRADE NAMES

With the exception of the limited situation just discussed personal names may not be trade-marks. Does this mean that a person who has

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(1930) c. 8, § 50. In a civil action an injunction may issue and damages may be awarded. If the name or picture was used "knowingly" the jury may award exemplary damages. *Id.* § 51.

Recovery was allowed in, *e. g.*, *Riddle v. MacFadden*, 201 N. Y. 215, 94 N. E. 644 (1911); *Binns v. Vitagraph Co. of America*, 210 N. Y. 51, 103 N. E. 1108 (1913); *Almind v. Sea Beach Ry.*, 157 App. Div. 230, 141 N. Y. Supp. 842 (2d Dep't 1913), *rev'g* 78 Misc. 445, 139 N. Y. Supp. 559 (Sup. Ct. 1912). The use of a person's name and portrait as part of the news section of a newspaper is not a use "in trade". *Moser v. Press Pub. Co.*, 59 Misc. 78, 109 N. Y. Supp. 963 (Sup. Ct. 1908).

A more restricted California statute, providing criminal remedies, was repealed in 1915. See CAL. PENAL CODE (Deering, 1937) § 258.

60. See p. 101, *supra*.

61. *Ex parte Mills & Gibbs*, 192 Off. Gaz. 990 (1913). *Accord: Ex parte Blair Co.*, 188 Off. Gaz. 808 (1913) (registration of name *Webster* denied).

62. *Castner v. Coffman*, 178 U. S. 168 (1900).

63. See 1 SHOEMAKER, *op. cit. supra* note 28, at 305.

64. *Stephano Bros. v. Stamatopoulos*, 238 Fed. 89, 93 (C. C. A. 2d, 1916).

built up a promising business must suffer in silence its appropriation by another using the same name?

With the growth of the property concept of trade-marks and the consequent limitation of the trade-mark rubric to arbitrary or fanciful names, the courts have had to resort to the more basic doctrine of passing off for the protection of other types of symbols. If the defendant is selling his goods as those of the plaintiff he will be stopped regardless of what means he uses. The passing off is the essence of the wrong, the appropriation of the trade symbol the means and evidence of the wrong.<sup>65</sup> The humbler doctrines that served to protect trade-marks before they achieved the elevated status of "property" are called upon to prevent unfair inroads upon another's business.<sup>66</sup> This is in essence the modern law of unfair competition as it relates to trade names.<sup>67</sup>

But the changing conditions which brought about the categorization of trade-mark law gave birth to a new factor in the trade name field—the doctrine of "secondary meaning".<sup>68</sup> In a time when producer and con-

65. See pp. 95-96, *supra*.

66. The conventional bifurcation is expressed in STREET, FOUNDATIONS OF LEGAL LIABILITY (1906) 421: "Though the law concerning infringement of trade-marks and that concerning unfair competition have a common conception at their root, namely, the idea that one shall not represent that his goods or his business is the goods or the business of another, the law concerning trade-marks occupies in a way a somewhat higher plane. The infringement of a trade-mark, for instance, is conceived as an invasion of property. . . . Unfair competition, on the other hand, cannot be placed on the plane of invasion of property right."

67. See NIMS, *op. cit. supra* note 30, at 13-14. The term "unfair competition" may be properly used in both a narrow and a broad sense. In the narrow sense it consists of acts which are analogous to trade-mark infringement—more specifically, the simulation of trade names and the imitation of the appearance of goods. See PAUL, THE LAW OF TRADE-MARKS (1903) § 22; NIMS, *loc. cit. supra*; Haines, *Efforts to Define Unfair Competition* (1919) 29 YALE L. J. 1, 9; *e. g.*, see Hanover Star Milling Co. v. Metcalf, 240 U. S. 403, 414 (1916). Unfair competition in the broader sense includes all unfair competitive practices, such as appropriation of trade values [*e. g.*, International News Service v. Associated Press, 248 U. S. 215 (1918), (1919) 28 YALE L. J. 387], false advertising [*e. g.*, Ely-Norris Safe Co. v. Mosler Safe Co., 7 F. (2d) 603 (C. C. A. 2d, 1925), *rev'd*, 273 U. S. 132 (1927)], obstruction to marketing [*e. g.*, Evenson v. Spaulding, 150 Fed. 517 (C. C. A. 9th, 1907)], simulated competition [*e. g.*, Tuttle v. Buck, 107 Minn. 145, 119 N. W. 946 (1909)], misrepresentation, trade boycott, etc. The scope of the term, when viewed broadly, can be gathered from Professor Milton Handler's definitive essay, *Unfair Competition* (1936) 21 IOWA L. REV. 175. Note also the variety of topics discussed in NIMS, *op. cit. supra*. The term has been used to embrace not only common law efforts toward business fairness but statutory efforts as well. See Handler, *supra*, at 213 *et seq.*; Fathchild, *Static and Dynamic Concepts of the Law of Unfair Competition* (1936) 1 MO. L. REV. 299; *Statutory Unfair Competition, id.* at 20.

68. For a full discussion of the doctrine of "secondary meaning" as applied to descriptive, geographical and personal names see DERENBERG, *op. cit. supra* note 26, c. V; also see NIMS, *op. cit. supra* note 30, c. IV and § 72.

sumer customarily dealt over the counter or at least lived in the same locality, the very use of the personal name, *eo instanti*, signified the producer. Thus as we have seen, the personal name was subject to protection upon its adoption and use; but an arbitrary symbol was subject to protection only after it had achieved a special significance as indicating the user's goods,<sup>69</sup> since it was only then that passing off was likely. But when the concept of exclusive appropriation developed, the arbitrary mark, so eminently suited to exclusive appropriation, became property upon its adoption and use.<sup>70</sup> Meanwhile with the growing impersonalization of business transactions the prior use of a personal name, now outside the area of trade-mark protection, was not even good evidence that use by another was likely to result in passing-off—*unless* in fact the name had gained a special significance, *i. e.*, as indicating a common source—known or unknown.<sup>71</sup> Change in economic affairs often brings about legal anomalies: the burden of establishing a special significance, once incident to arbitrary marks, has been cast off and now falls upon the shoulders of users of personal names.

The term "secondary meaning" is misleading. Since the Waltham watch had become well-known, the primary meaning of the name *Waltham* when used in connection with time pieces has been not a product of Waltham, Massachusetts, but this particular make of watch.<sup>72</sup> The primary meaning of *Swift's* when used in connection with ham or bacon is the particular brand, not a product made by some Mr. Swift. Thus when a word has acquired a so-called "secondary meaning", in the particular market it really has acquired a new *primary* meaning.<sup>73</sup> This new meaning need not have been acquired everywhere: protection will be afforded

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69. See p. 96, *supra*.

70. *Kathreiner's Malzkaffee v. Pastor Kneipp Med. Co.*, 82 Fed. 321 (C. C. A. 7th, 1897); *Wallace & Co. v. Repetti*, 266 Fed. 307 (C. C. A. 2d, 1920). But the older theory that the validity of the mark depended upon public familiarity was rather slow in dying out. See cases cited in NIMS, *op. cit. supra* note 30, § 218a.

71. *Landreth v. Landreth*, 22 Fed. 41 (C. C. E. D. Wis. 1884); *Garrett v. T. H. Garrett & Co.*, 78 Fed. 472 (C. C. A. 6th, 1896); *Westphal v. Westphal's World's Best Corp.*, 216 App. Div. 53, 215 N. Y. Supp. 4 (1st Dep't 1926), *aff'd*, 243 N. Y. 639; *Matter of an Application by Burford & Co.*, 36 Rep. Pat. Cas. 139 (C. A. 1919); see *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U. S. 461, 470 (1914).

72. *Cf. American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, 53 N. E. 141 (1899).

73. See opinion of Judge Denison in *G. & C. Merriam Co. v. Saalfield*, 198 Fed. 369, 373 (C. C. A. 6th, 1912).

at least in those localities where the meaning exists.<sup>74</sup> Nor need it be apparent to a majority of the persons in the locality;<sup>75</sup> that to a considerable number of persons the name signifies particular goods or services is sufficient. No particular time is required for a special significance to be recognized. It may take years where promotion of the product is gradual; it may take but a few weeks under the stimulus of a persistent advertising campaign.<sup>76</sup>

Naturally the better known a designation is the more likely it is that the court will find a "secondary meaning" and the more commercially advantageous the mark will be. But when the designation becomes *very* well known there is the danger that it will become in the eyes of the public the generic name for the product, and will be no longer afforded judicial protection.<sup>77</sup> Thus people begin to refer to all brands of a particular meat sauce as *Worcestershire sauce*, all sewing machines as *Singers*. It is one of the anomalies of this branch of the law that it is publicity which creates the right, and publicity which destroys it. Obviously however, the courts would exhibit considerable reluctance in holding that what was once a protected trade name had become generic;<sup>78</sup> and in fact this has not often been the result in personal names cases. And too the user can to a certain extent avert this unhappy result by giving prominence to

74. *Terminal Barber Shops v. Zoberg*, 28 F. (2d) 807 (C. C. A. 2d, 1928); *Hub Clothing Co. v. Cohen*, 270 Pa. 487, 113 Atl. 677 (1921). Even broader protection has been granted in some cases; e. g., *Prunier v. Prunier's Restaurant*, 159 Misc. 551, 288 N. Y. Supp. 529 (Sup. Ct. 1936), and *Sweet Sixteen Co. v. Sweet "16" Shop*, 15 F. (2d) 920 (C. C. A. 8th, 1926), where the likelihood of the plaintiff's expansion was viewed as a factor. See the articles cited in note 141, *supra*.

75. *Faulder & Co. v. O. & G. Rushton, Ltd.*, 20 Rep. Pat. Cas. 477 (Ch. 1902).

76. See the discussion by Judge Wooley in *Barton v. Rex-Oil Co.*, 2 F. (2d) 402, 405 (C. C. A. 3d, 1924).

77. In the following cases personal names were held to have become the generic name of the article: *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169 (1896) (*Singer* for sewing machines); *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598 (1888) (*Goodyear* for treated rubber); *Hostetter v. Fries*, 17 Fed. 620 (C. C. S. D. N. Y. 1883), (*Hostetter's* for bitters); see *Liebig's Extract of Meat Co. v. Walker*, 115 Fed. 822 (C. C. S. D. N. Y. 1902). Accord: *Ford v. Foster, L. R. 7 Ch. App. 611* (1872) (*Eureka* for shirts); *Lea v. Deakin, Fed. Cas. No. 8154* (C. C. N. D. Ill. 1879) (*Worcestershire* for sauce); *Brooten v. Oregon Kelp Ore Products Co.*, 24 F. (2d) 496 (C. C. A. 9th, 1928). Cf. *B. V. D. Co. v. Montgomery Ward & Co.*, 16 T. M. Rep. 423 (N. D. Ill. 1925), where it was held that *B. V. D.* had not become generic. Also see the recent comment on this subject by Professor Grismore, *Effect of Word-Mark Acquiring a Descriptive Connotation* (1937) 35 MICH. L. REV. 989.

78. See DERENBERG, *op. cit. supra* note 26, at 615-16; HOPKINS, *op. cit. supra* note 30, § 60.

the real generic name of the product in the course of publicizing the personal name.<sup>79</sup>

We have seen that personal names may be trade-marks in but few instances; that they are protected if at all, as trade names. But it may be asked, if they are protected, what difference does it make which rubric is attached to the plaintiff's right? The dichotomy is significant in a number of respects.<sup>80</sup> First, as we have seen, a person gains a trade-mark upon adoption and use; trade name protection is afforded only after a "secondary meaning" is acquired.<sup>81</sup> Second, while one may gain trade name protection without affixation, a trade-mark must be affixed to goods.<sup>82</sup> Arising from the requirement of affixation is the third difference: a trade-mark must be used in the sale of goods;<sup>83</sup> a trade name may be used for goods, services, or as the name of a business. There is some doubt as to whether a designation attached to goods and indicating a service performed to goods by one not in the chain of commerce may be a trade-mark. A bleacher's mark on linen sold by others has been upheld in England as a valid trade-mark,<sup>84</sup> but in an American case it has been held that a mark denoting a particular enamel finish put on goods of several manufacturers may not be a trade-mark.<sup>85</sup> Of course such designations may be trade names, and so may designations entirely dissociated from the sale of goods.

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79. Also an effort is usually made to avoid use of the trade-mark or trade name in dictionaries in such a way as would indicate that it is generic. See Rogers, *Trade-Marks and Dictionaries* (1934) BULL. U. S. T. M. ASS'N. 10. However, presence in a dictionary is not conclusive as to the character of the mark. *H. A. Metz Laboratories, Inc. v. Blackman*, 153 Misc. 171, 275 N. Y. Supp. 407 (Sup. Ct. 1934).

80. For a comprehensive survey of the general problem of the distinction between trade-marks and trade names see Handler and Pickett, *Trade-Marks and Trade Names—An Analysis and Synthesis* (1930) 30 COL. L. REV. 168, 759. For a briefer discussion of the same problem see Handler, *supra* note 67, 182-87.

81. See pp. 104-106, *supra*.

82. *Maxwell v. Hogg*, 2 Ch. App. 307 (1867); *Oakes v. St. Louis Candy Co.*, 146 Mo. 391, 48 S. W. 467 (1898). See Handler and Pickett, *supra* note, 80, at 759. As to the supposed requirement of affixation by the defendant see *id.* at 762.

83. So-called "service marks" were held not to be trade-marks in *Yellow Cab Mfg. Co. v. Checker Cab Mfg. Corp.*, 206 App. Div. 8, 200 N. Y. Supp. 232 (1923) (*Yellow Cab*); *Ex parte Western Union Tel. Co.*, 15 T. M. Rep. 139 (1924) (*Western Union*); *Diederich v. Schneider Wholesale Wine & Liquor Co.*, 195 Fed. 35 (C. C. A. 8th, 1912).

84. *Re Sykes & Company's Trade-Mark*, 43 L. T. (N. S.) 626 (1881).

85. *In re Toledo Porcelain Enamel Products Co.*, 58 F. (2d) 423 (C. C. P. A. 1932).



Fourth, trade-marks may be registered;<sup>86</sup> with the exception of names used for trade-marks years prior to 1905,<sup>87</sup> trade names may not.<sup>88</sup> While registration does not enlarge the registrant's common law substantive rights in the trade-mark,<sup>89</sup> it confers upon him certain procedural advantages. For example, registration affords "prima facie evidence of ownership." In practice this presumption is easily rebutted, and by no passage of time can it, as in England, become conclusive; but it does have the beneficial effect of shifting the burden of proof. Too, registration makes possible the award of treble damages, but such a sanction is rarely awarded or even sought. Of some importance is the fact upon registration of the mark the owner may file a certificate with the customs department in order to prevent importation of articles with infringing marks. And of greatest importance is the fact that registration confers jurisdiction upon the federal courts, entirely apart from diversity of citizenship.<sup>90</sup>

Finally, the distinction between trade-marks and trade names has long been viewed as important in determining the scope of preventative relief. Since this problem is of peculiar significance where personal names are involved it deserves rather full consideration.

#### IV

##### "THE RIGHT TO USE ONE'S OWN NAME" AND THE QUALIFIED INJUNCTION

It is commonly assumed that for the protection of trade-marks an absolute injunction is proper; for the protection of trade names a "qualified" injunction. The theory is that since a trade-mark is a property right<sup>91</sup> trespass upon it should be absolutely prevented—no quarter should be given to thieves; but since a trade name may not be exclusively appro-

86. See the Trade-Mark Act of 1905, as amended, 15 U. S. C. §§ 81 *et seq.*; see generally NIMS, *op. cit. supra* note 30, c. XVII; HOPKINS, *op. cit. supra* note 30, c. IX.

87. See DERENBERG, *op. cit. supra* note 26, at 325 *et seq.* A personal name which is registerable under the Act and is registered is, for practical purposes, a trade-mark. Thaddeus Davids Co. v. Davids Mfg. Co., 233 U. S. 461 (1914).

88. See notes 28, 30, and 31, *supra*.

89. Carroll v. McIlvaine, 171 Fed. 125 (C. C. S. D. N. Y. 1909).

90. These effects are discussed fully in DERENBERG, *op. cit. supra* note 26, c. XII; also see NIMS, *op. cit. supra* note 30, at 591-92.

91. See p. 116 *et seq.*, *infra*.

priated, the defendant cannot be absolutely enjoined from its use.<sup>92</sup> Particularly is this true in the instant field, since it is felt that every man has a "right to use his own name."

This "right" finds its support entirely in judicial promulgation. It is an admirable example of the type of circularities often occurring in the law: a thing is protected because it is a right; and why is it a right?—because it is protected.<sup>93</sup> But as is often the case the tautology is somewhat disguised by imploring such symbols as the "rights of Englishmen" and "inalienable Constitutional rights."<sup>94</sup> Thus in *Turton v. Turton*<sup>95</sup> the court insisted that the defendant was "doing what he has an absolute right by the law of *England* to do, and you cannot restrain a man from doing that which he has an absolute right by the law of *England* to do." And in *Hilton v. Hilton*:<sup>96</sup> "The right of a man to use his own name in his own business is part of the natural and inalienable rights guaranteed by the very first clause of our constitution, without which the right to acquire, possess and protect property would be of little worth." In the earlier English case of *Burgess v. Burgess*<sup>97</sup> the plaintiff and his father had sold *Burgess's Essence of Anchovies* since 1880. The son, with striking lack of originality, called his competing product *Burgess's Essence of Anchovies*. In refusing an injunction Lord Justice Bruce said:

"All the Queen's subjects have a right, if they will, to manufacture and sell pickles and sauces, and not the less that their fathers have done so before them. All the Queen's subjects have a right to sell these articles in their own names, and not the less so that they bear the same name as their fathers . . . ."<sup>98</sup>

The obvious confusion to the public and harm to established businesses which such an attitude would engender gradually brought about a will-

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92. This dogmatic approach is well presented in Treadway, *Personal Trade Names* (1897) 6 YALE L. J. 141, 145 *et seq.*; and Putnam, *Unfair Competition by Deceptive Use of One's Own Name* (1898) 12 HARV. L. REV. 243.

93. See Felix S. Cohen's analysis in *Transcendental Nonsense and the Functional Approach* (1935) 35 COL. L. REV. 809, especially at 814-17.

94. As to the use of such symbols in legal and economic thinking see the excellent studies of Professor Thurman W. Arnold, *THE SYMBOLS OF GOVERNMENT* (1935) and *THE FOLKLORE OF CAPITALISM* (1937) *passim*.

95. 42 Ch. D. 128, 136 (1889).

96. 89 N. J. Eq. 182, 104 Atl. 375 (1918).

97. 3 De G. M. & G. 896 (1853).

98. *Id.* at 904-905. Accord: *Meneely v. Meneely*, 62 N. Y. 427 (1875); *Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462, 39 N. E. 490 (1895); *Rodgers v. Nowill*, 6 Hare 325 (1846); *Jamieson & Co. v. Jamieson*, 14 T. L. R. 160 (1898).

ingness at least to attempt an adjustment of the conflicting rights of the parties.<sup>99</sup> This attempt has in general taken three forms: (1) a requirement of prefixes, suffixes or explanatory phrases; (2) a prohibition against denominative use; and (3) prohibition against any use.

In giving relief of the first type a variety of measures have been adopted. Quite common is the requirement that the defendant use his entire name,<sup>100</sup> eliminate *Co.* or *& Co.*<sup>101</sup> or add the place of manufacture.<sup>102</sup> But the courts have gone further and required, as in the famous *Waterman Pen* case,<sup>103</sup> that the defendant add a phrase indicating that he is "not connected with" the plaintiff.<sup>104</sup> Some cases have gone still further and directed that the label indicate that the plaintiff is the original manufacturer<sup>105</sup>—even over the protest that such characterization of the plaintiff is derogatory to the defendant's product.<sup>106</sup> To avoid circumven-

99. Thus in 1880 it was said: "Now *Burgess v. Burgess* [note 95, *supra*] has been very much misunderstood if it has been understood to decide that anybody can always use his own name, as a description of an article, whatever may be the consequence of it, or whatever may be the motive for doing it, or whatever may be the result of it."

100. *E. g.*, *Tarrant & Co. v. Johann Hoff*, 76 Fed. 959 (C. C. A. 2d, 1896); *Walter Baker & Co. v. Baker*, 77 Fed. 181 (C. C. W. D. Va. 1896).

101. *E. g.*, *Walter Baker & Co. v. Baker*, 77 Fed. 181 (C. C. W. D. Va. 1896).

102. *Stark v. Stark Bros. Nurseries & Orchards Co.*, 257 Fed. 9 (C. C. A. 8th, 1919); *Baker v. Sanders*, 97 Fed. 948 (C. C. E. D. Pa. 1899); *John B. Stetson Co. v. Stephen L. Stetson Co.*, 14 F. Supp. 74 (S. D. N. Y. 1936), note 109, *supra*.

103. *L. E. Waterman Co. v. Modern Pen Co.*, 235 U. S. 88 (1914), *aff'g* 197 Fed. 534 (C. C. A. 2d, 1912).

104. *E. g.*, *J. F. Rowley Co. v. Rowley*, 18 F. (2d) 700 (C. C. A. 3d, 1927); *Jergens Co. v. Bonded Products Corp.*, 21 F. (2d) 419 (C. C. A. 2d, 1927), *mod.* 13 F. (2d) 417 (E. D. N. Y. 1926). But *cf.* the *Rogers* case discussed in note 106, *infra*.

105. *Gleaves v. W. B. Fishburn Co.*, 82 F. (2d) 627 (C. C. A. 5th, 1936); *John B. Stetson Co. v. Stephen L. Stetson Co.*, 14 F. Supp. 74 (S. D. N. Y. 1936); *Coty, Inc. v. Parfums de Grande Luxe*, 298 Fed. 865 (C. C. A. 2d, 1924); *Stark v. Stark Bros. Nurseries & Orchards Co.*, 257 Fed. 9 (C. C. A. 8th, 1919); *Walter Baker & Co. v. Sanders*, 80 Fed. 889 (C. C. A. 2d, 1897); *International Silver Co. v. Rogers*, 72 N. J. Eq. 933, 67 Atl. 105 (1907). In the latter case the defendant had already marked the goods "not connected with any other Rogers", but it was held that this was not a sufficient differentiation and that the silver should be stamped "not connected with the original Rogers". A particularly stringent requirement was made in the *Stark* case, the court specifying an explanation 93 words in length. For the form of label required in the *Stetson* case see note 109, *infra*. For the phrase required in the *Baker* case see p. 112, *infra*, and as to the *Coty* case see note 106, *infra*.

106. *Coty, Inc. v. Parfums de Grande Luxe*, 298 Fed. 865, 869 (C. C. A. 2d, 1924): "The word 'original' does not in itself imply quality, but origin. . . ." *Contra*: *L. E. Waterman Co. v. Modern Pen Co.*, 197 Fed. 534 (C. C. A. 2d, 1912), modifying, on petition for rehearing, a decree (183 Fed. 118) which required the word "original". The court felt that this suffix tended "to characterize the defendant's product as inferior to that of the complainant and is unduly prejudicial to it."

tion of the decree the courts have often specified that the phrase appear in "prominent" type,<sup>107</sup> or in type as large as that of the trade name<sup>108</sup> or even larger.<sup>109</sup>

But how effective are such half-way measures? It is obvious that the mere addition of first names or the place of manufacture will not distinguish the goods in the mind of the average consumer. Convincing in this regard are the psychological tests which have been conducted in this field.<sup>110</sup> Especially worthwhile is the recent study made in connection with the *Stetson Hat* litigation<sup>111</sup> by Professor Neil H. Borden.<sup>112</sup> A number of brands of hats were presented to over 400 business men and graduate students. Only 38% recognized as imitative the *Stephen L. Stetson* brand, although the latter has a label strikingly different from that of the original Stetson hat.<sup>113</sup> In another test only 24% of the business men and 21% of the students were able to recall that "John B." was the given name and initial on the original Stetson.<sup>114</sup> Interesting also is the low percentage of correct or approximately correct recall of given names or initials of other well-known trade names. For example:

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107. *E. g.*, *Baker v. Sanders*, 97 Fed. 948 (C. C. E. D. Pa. 1899).

108. *E. g.*, *Coty, Inc. v. Parfums de Grande Luxe*, 298 Fed. 865 (C. C. A. 2d, 1924).

109. In the recent case of *John B. Stetson Co. v. Stephen L. Stetson Co.*, 14 F. Supp. 74 (S. D. N. Y. 1936), the court indicated the following label: "Stephen L. Stetson | New York | By Stephen L. Stetson Co., Ltd. | Incorporated 1933 | NEVER CONNECTED IN ANY WAY | with | John B. Stetson Company | Or Predecessors | Hat Makers in Philadelphia | Since 1865." *Id.* at 87-88. The other words were to be smaller than "never connected" phrase, except the name Stephen L. Stetson at the top which could be the same size if curved.

110. The use of psychology in the measurement of trade-mark confusion was first suggested by Prof. Hugo Munsterberg [*Psychology and the Market* (1909) 34 *McCLURE'S* 87] and was also urged by Mr. Rogers [*The Unwary Purchaser: A Study in the Psychology of Trade-Mark Infringement* (1910) 8 *MICH. L. REV.* 613]. Several actual experiments have been conducted. See, *e. g.*, *A Psychological Investigation of the Likelihood of Confusion Between the Words Coca-Cola and Chero-Cola* (1919) 14 *BULL. U. S. T. M. ASS'N.* 147]; Burt, *Measurement of Confusion between Similar Trade Names* (1925) 19 *ILL. L. REV.* 335; also see note 112, *infra*.

111. See note 107, *supra*. The court refused, however, to admit the results of the tests as evidence. *Cf.* the statement of Judge Hincks in *Hat Corporation of America v. D. L. Davis Corp.*, 4 F. Supp. 613, 622 (D. Conn. 1933): "The efficacy of such prefixes obviously is affected by psychological considerations, a surer understanding of which is much to be desired." Also see *Citizens' Wholesale Supply Co. v. Downing*, 107 Ohio St. 422, 140 N. E. 683 (1923).

112. BORDEN, DETERMINATION OF CONFUSION IN TRADE-MARK CONFLICT CASES (Harv. Grad. School of Bus. Adm., Bus. Research Studies, No. 16).

113. *Id.* at 25 (Table 11).

114. *Id.* at 24 (Table 9).

J. B. Williams shaving cream .....	6%
L. E. Waterman fountain pens .....	15%
Walter Baker chocolate .....	17%
E. R. Squibb tooth paste .....	15%
William K. Kellogg corn flakes .....	18% <sup>115</sup>

Thus it would seem that the addition of distinguishing given names or initials will aid the plaintiff little and since the public is not familiar with such initials phrases like that required in the *Waterman* case<sup>116</sup> are equally ineffective.<sup>117</sup>

Handler and Pickett have suggested that it may even add to the confusion:

“Now when a court requires the words ‘not connected with the L. E. Waterman Co.’ to be juxtaposed to defendant’s full name ‘Arthur A. Waterman & Co.’, permitting the name *Waterman* to be marked upon defendant’s pens, unless the public knows that the L. E. Waterman Co. is the producer of the original pen [and from the recent Borden study it would seem that they do not], may it not labor under the impression, of which the defendant will promptly take advantage, that Arthur A. Waterman is the original producer and L. E. Waterman, the pirate?”<sup>118</sup>

An illustration of the interesting turn events may take when such a phrase is required is afforded by *Baker v. Sanders*.<sup>119</sup> William H. Baker had been ordered to mark his packages clearly with the words “W. H. Baker is distinct from the old chocolate manufactory of Walter Baker & Company”.<sup>120</sup> The defendant in this case conformed to the decree and built up a considerable business reputation. Soon another William H. Baker began using this same explanatory phrase on his packages of chocolate, making it appear that he was the same as the older William H.

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115. *Id.* at 23 (Table 8).

116. See note 103, *supra*.

117. In *Hat Corporation of America v. D. L. Davis Corp.*, 4 F. Supp. 613, 622 (D. Conn. 1933), Judge Hincks said: “. . . surely a reading of the long and widespread litigation that has grown out of the use of such names as ‘Baker’ and ‘Rogers’ . . . leads one to question the efficacy of such limitations. And, obviously, halfway limitations inadequate to prevent confusion, propagate litigation devastating uncertainty in business, and a cynical reaction to the administration of law. Such results cannot be justified by a false tenderness for the rights of the individual.”

118. Handler and Pickett, *supra* note 80, at 184, n. 48; see also *Hat Corporation of America v. D. L. Davis Corp.*, 4 F. Supp. 613, 622 (D. Conn. 1933): “Confusion is created by the very explanation intended to avert confusion.”

119. 97 Fed. 948 (C. C. E. D. Pa. 1899).

120. *Walter Baker & Co. v. Sanders*, 80 Fed. 889 (C. C. A. 2d, 1897).

Baker. At the instance of the first William H. Baker the second was enjoined from using the explanatory phrase which in the earlier case had been deemed so salutary for the protection of Walter Baker's rights.

## V

## THE GREATER EFFICACY OF THE INJUNCTION AGAINST DENOMINATIVE USE

A few courts have avoided the confusion which these makeshift decrees cause by allowing the defendant to use his name—but not *denominatively*. In the *Chickering Piano* case<sup>121</sup> the defendant was required to adopt an arbitrary name such as *Acoustigrande* and indicate inconspicuously beneath it his full name and his address. And in the more recent case of *Jergens Co. v. Bonded Products Corp.*,<sup>122</sup> the court enjoined use of the name *Woodbury* as the name of the defendant's soap, even though the managing director of the company was named Woodbury. The court saw no necessity for any use of the name beyond an inconspicuous statement and said that "if any relief is to be given against unfair trading, it should be such as will be effective."<sup>123</sup>

The more drastic remedy of an absolute injunction has been granted only under peculiar circumstances. Thus where the defendant has changed his name to that of the plaintiff<sup>124</sup> or where the connection between the defendant's business and the bearer of the name is slight or spurious,<sup>125</sup> the "right" to use one's own name sounds rather hollow. Likewise the courts have sometimes been willing to prohibit all use where the defend-

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121. *Chickering v. Chickering & Sons*, 215 Fed. 490 (C. C. A. 7th, 1914).

122. 21 F. (2d) 419 (C. C. A. 2d, 1927), *mod.* 13 F. (2d) 417 (E. D. N. Y. 1926).

123. *Id.* at 424. Accord: *Royal Baking Powder Co. v. Davis*, 26 Fed. 293 (C. C. E. D. Mich. 1885), see p. 116, *infra*; *Henry Perkins Co. v. Perkins*, 246 Mass. 96, 140 N. E. 461 (1923). In the latter case the court enjoined use of the name Perkins on tack machines, but allowed the use of the personal name in the firm name.

124. *F. Pinet & Cie v. Maison Louis Pinet, Ltd.*, [1897], 1 Ch. 179; *Paul Poirot et Cie v. Nash*, 37 Rep. Pat. Cas. 177 (Ch. D. 1920); *Sage Foundation Homes Co. v. Sage-Forest Hills Associates*, 119 Misc. 669, 197 N. Y. Supp. 877 (Sup. Ct. 1922).

125. *R. W. Rogers Co. v. Wm. Rogers Mfg. Co.*, 70 Fed. 1017 (C. C. A. 2d, 1895); *International Silver Co. v. Simeon L. & George H. Rogers Co.*, 110 Fed. 955 (C. C. Conn. 1901); *L. E. Waterman & Co. v. A. A. Waterman & Co.*, 229 Ill. App. 630 (1923), discussed in Comment (1924) 72 U. OF PA. L. REV. 300; *International Silver Co. v. Wm. H. Rogers Corp.*, 67 N. J. Eq. 646, 60 Atl. 187 (1905).

ant has deliberately sought confusion;<sup>126</sup> and of course, this is the result where none connected with defendant bears the name.<sup>127</sup> The courts have been especially willing to enjoin absolutely the use by corporations of personal names likely to cause confusion.<sup>128</sup>

Do not these last two groups of cases furnish the sound solution of the problem? There is no "right", regardless of the harm to competitors and the public, to use a personal name.<sup>129</sup> Rather the interest in the use of one's own name should be recognized as *one* of the interests which the court should consider in its adjudication of the conflict.

It is too easily forgotten that the plaintiff has an interest in the use of his name without subjecting himself to the inroads of others, and that this interest is one which has the importance that public association can afford it. And it is too easily forgotten that the public has an interest in being able to rely upon a trade name with which it has become familiar.<sup>130</sup> These latter two interests—that of the plaintiff and that of the public—are the more important, the more worthy of protection. In fact if

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126. *International Silver Co. v. Rodgers Bros. Cutlery Co.*, 136 Fed. 1019 (C. C. W. D. Mich. 1905); *Westphal v. Westphal's World's Best Corporation*, 216 App. Div. 53, 215 N. Y. Supp. 4 (1st Dep't 1926); see *Hat Corporation of America v. D. L. Davis Corp.*, 4 F. Supp. 613 (D. Conn. 1933); *Goldberg v. Goldberg*, 159 Ga. 761, 126 S. E. 823 (1925) *semble*.

127. *Dobbs & Co. v. Cobbs Haberdasher, Inc.*, 226 App. Div. 372, 235 N. Y. Supp. 422 (1st Dep't 1929).

128. In *De Nobili Cigar Co. v. F. G. Nobile Cigar Co.*, 56 F. (2d) 324, 328 (C. C. A. 1st, 1932), the court pointed out that corporations "do not inherit their names, but assume them voluntarily." See DERENBERG, *op. cit. supra* note 26, at 378 *et seq.* But "there is no distinction between corporations and natural persons in the principle. . . ." *L. E. Waterman Co. v. Modern Pen Co.*, 235 U. S. 88, 94 (1914).

129. In 1914 Edward S. Rogers wrote: "It is always argued by defendants in opposition to attempts to limit or restrict the use of personal names, that the name is the defendant's own and from this premise it is sought to draw the conclusion that every consequence arising from the use of the name is lawful. The fallacy involved in this conclusion has been exposed in these cases time and time again. Of course, the defendant's name is his own. This ought not to give him any more right to perpetrate a fraud by means of it than to perpetrate a fraud in any other way. The fact that it is his own name makes no difference; ownership is not a license unnecessarily to injure another. Blackbeard was not the less a pirate because he owned the ship in which he made his cruises along the Spanish main." ROGERS, *GOOD WILL, TRADE-MARKS AND UNFAIR TRADING* (1914). Mr. Nims says: ". . . it is doubtful if, as we now conceive of the duty of man to his fellows, he has no greater right to inflict unnecessary injury and hardship on his neighbor by the use of his own name than he has by use of a common word of the language." NIMS, *op. cit. supra* note 30 at 172. Also see Professor Wigmore's incisive criticism of the Waterman case in *Justice, Commercial Morality, and The Federal Supreme Court* (1915) 10 ILL. L. REV. 178.

130. As to the growing inclination of the courts to decide the public interest in *inter partes* litigation as to trade symbols see SCHECHTER, *op. cit. supra* note 6, at 162 *et seq.*; DERENBERG, *op. cit. supra* note 26, 166.

the defendant has acted fraudulently or the connection between the business and the bearer of the name is specious, the defendant's interest is not worthy of protection at all. So far as an innocent defendant's interest in the use of his own name can also be preserved it is worthy of protection. Thus, it is submitted that the most practical means of adjusting the conflict is to enjoin the defendant from denominative use, allowing a reasonable non-denominative use.<sup>131</sup> He will not be barred from enjoying the credit incident to the merit of his goods; at the same time his opportunity to profit from confusion of the public will be minimized. This opportunity to profit from the confusion is the only business advantage he will lose. That he will have to use for his goods an arbitrary designation instead of his own name is no penalty: from both the legal and business points of view the arbitrary mark is now regarded as the best type of designation;<sup>132</sup> in fact it is the only type which, in general, can receive trade-mark protection.<sup>133</sup>

But what about the fact that the personal name is, as pointed out earlier,<sup>134</sup> the natural and obvious designation, especially in businesses which have risen from small beginnings? This is doubtless true of the plaintiff's interest. But where the name is already being used in the same market and has acquired a special significance in the minds of the public the use of the name by another is *not* the natural course of events. In fact an honest trader would deliberately choose a different designation in order that the plaintiff's goods might not be confused with his. If he or his customers—both of whom are responsible for the natural development—are not aware of the plaintiff's prior use then it is unlikely that the name has acquired a special significance in his favor; and as to trade names it is priority of secondary meaning rather than priority of use that prevails.<sup>135</sup>

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131. The views of Handler and Pickett [*supra* note 80, at 199-200] are in accord. Also see NIMS, *op. cit. supra* note 30, § 68.

132. See p. 98, *supra*, and Hat Corporation of America v. D. L. Davis Corp., 4 F. Supp. 613, 623 (D. Conn. 1933). This generalization may not apply to a few lines of business. As Handler and Pickett have pointed out [*supra* note 80, at 199] there is greater need for personal names in, *e. g.*, the men's clothing business. In these cases the court might well give the defendant's interest greater weight.

133. See pp. 98-99, *supra*.

134. See p. 93, *supra*.

135. Jenney Mfg. Co. v. Leader Filling Stations Corp., 196 N. E. 852 (Mass. 1935); see Cohen v. Nagle, 190 Mass. 4, 14, 76 N. E. 276 (1906).



## VI

THE TRADE-MARK—TRADE NAME DICHOTOMY AND THE QUALIFIED  
INJUNCTION

It is assumed that the qualified injunction is the appropriate protection for personal names because this form of relief is the consequence of determining that the designation is a trade name, just as the absolute injunction is the consequence of determining that the designation is a trade-mark. But is it really the nature of the *plaintiff's* right that determines the scope of the injunction?

It is true that absolute injunctions have been more often given in trade-mark cases and qualified injunctions in trade name cases, but this is due to the fact that the defendant has an interest worthy of consideration more often in trade name cases than in trade-mark cases, not because the plaintiff has a trade-mark rather than a trade name. Since *ex hypothesi* a trade-mark is arbitrary or merely fanciful the defendant will rarely need to use the word for purposes of characterizing the goods or indicating their source. But where the name is not arbitrary, *i. e.*, a trade name, the likelihood is that others also may have an interest in using the word. Thus it is really the nature of the defendant's interest rather than the nature of the plaintiff's which determines the scope of relief.

Suppose a person named Gem decided, in good faith, to enter the safety razor business under his own name. A prediction as to how the case would be decided would not be safe, but it is submitted that the decision would not turn upon the fact that the plaintiff has a trade-mark rather than a trade name. Thus in the *Royal Baking Powder* case,<sup>136</sup> even though the plaintiff had a trade-mark, the defendant, whose name was Royal, was allowed to use his name non-denominatively—just as he should have if the plaintiff had a trade name.<sup>137</sup> But an absolute injunction would have surely issued if the defendant's name had not been Royal—again just as it would have if the plaintiff had a trade name.<sup>138</sup> This too has been the result in the descriptive word field in the few cases where

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136. *Royal Baking Powder Co. v. Royal*, 122 Fed. 337 (C. C. A. 6th, 1903).

137. See cases cited in notes 121-123, *supra*.

138. See cases cited in note 124, *supra*.

this interesting type of conflict has arisen.<sup>139</sup> Although the plaintiff had a trade-mark in the word *Mufflet* the court refused to enjoin the defendant's use of the word *Muffler*.<sup>140</sup> Yet if the defendant had adopted the name *Muffet* an injunction would have surely issued. The plaintiff's interest is the same in both instances; the likelihood of confusion arising from similarity is as great; but the difference in result would be due to the difference in the defendant's interest in the two words: he needs *Muffler* to describe his product; he has no need for *Muffet*.

Unfortunately considerations of this sort make it impossible to view a trade-mark as an absolute property right. But other and better known limitations have had the same result: the right to trade-mark protection is limited as to markets—territorial<sup>141</sup> and functional<sup>142</sup>—and as to kind of goods.<sup>143</sup> However, the role that trade-marks play in present-day marketing—whether we think it desirable or not<sup>144</sup>—is such that the trade-mark right has many of the aspects of other things called property,<sup>145</sup> and can

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139. *Clotworthy v. Schepp*, 42 Fed. 62 (C. C. S. D. N. Y. 1890) (*Pudding and Pudding*); *Sterling Remedy Co. v. Gorey*, 110 Fed. 372 (C. C. Ohio, 1901) (*Cascarets and Cascara*); *Upjohn Co. v. Merrell Chem. Co.*, 269 Fed. 209 (C. C. A. 6th, 1920) (*Phenolax and Phenolphthelein Wafers*). The defendants were allowed to continue their use of the generic word even though the plaintiffs had a trade-mark and the likelihood of confusion was obvious. These and other such cases are discussed in *Handler and Pickett*, *supra* note 80, at 171-72, 177-79.

140. *Hygienic Fleeced Underwear Co. v. Way*, 137 Fed. 592 (C. C. A. 3d, 1905).

141. *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 403 (1916). The cases are collected in DERENBERG, *op. cit. supra* note 26, c. VIII. See generally Goble, *Where and What a Trade-Mark Protects* (1927) 22 ILL. L. REV. 379; Willcox, *Territorial Extent of Trade-Mark Rights and the Partial Sale of a Business* (1931) 25 ILL. L. REV. 485.

142. In *Bayer Co. v. United Drug Co.*, 272 Fed. 505 (S. D. N. Y. 1921) the court enjoined the defendant from the use of the word *Aspirin* in sales to druggists, but allowed its use in sales to consumers because as to them the name had become generic (see p. 106 *supra*). Also see *Du Pont Cellophane Co. v. Waxed Products Co.*, 6 F. Supp. 859 (E. D. N. Y. 1934), discussed in Note (1937) 35 MICH. L. REV. 989.

143. See Wolf, *Non-Competing Goods in Trademark Law* (1937) 37 COL. L. REV. 582; Goble, *supra* note 135; Schechter, *supra* note 22. Cases are collected in DERENBERG, *op. cit. supra* note 26, c. VII.

144. Cf. CHAMBERLIN, *THE THEORY OF MONOPOLISTIC COMPETITION* (1935) App. E; CHASE AND SCHINK, *YOUR MONEY'S WORTH* (1927) *passim*. See HANDLER, *CASES ON TRADE REGULATION* (1937) 555-56.

145. The fact that the right is qualified does not render the term inappropriate: all property rights are qualified. For example, the restrictions on assignment of trade-marks [See Grismore, *The Assignment of Trade Marks and Trade Names* (1932) 30 MICH. L. REV. 489] are paralleled by common law rules limiting the assignability of certain future interests and servitudes.

Plausible conceptual support for classifying trade symbols as property is available. See, e. g., the interesting analysis of Langdell in *A BRIEF SURVEY OF EQUITY JURISDICTION* (2d ed. 1908) 250, and authorities cited in note 26, *supra*. However, in the view of the author the term is valid simply if it is useful and effective in attaining a proper protection of worthwhile interests.

conveniently be called property.<sup>146</sup> Fully aware of its limitations Mr. Justice Holmes so classified it: “. . . in a qualified sense the mark is property, protected and alienable, although as with other property its outline is shown only by the law of torts, of which the right is a prophetic summary.”<sup>147</sup> Even Felix Cohen, who regards the reification of rights in trade symbols as the result of circular reasoning (property because protected, protected because property),<sup>148</sup> concedes that the courts are not creating property *ex nihilo*, but “out of the materials of social fact, commercial custom, and popular moral faiths and prejudices.”<sup>149</sup>

The property concept (viewed in this qualified sense), which is a convenient approach to trade-marks, is equally appropriate for trade names.<sup>150</sup> And the use of “property” terminology in this connection would place an appropriate emphasis upon the rights of the plaintiff.<sup>151</sup> When because of the reputation of his goods or services the plaintiff’s name has in the public mind become associated with those goods or services he should be afforded protection qualified only by the defendant’s proper needs. The defendant does not *need* to use his name denominatively—the credit for the merit of his goods will not be denied him if accompanying the much more suitable arbitrary mark he indicates their source. And if he has acted fraudulently or his right to use the name is specious, he has no proper need for using the name at all.

146. See SCHECHTER, *op. cit. supra* note 6, at 156 *et seq.*

147. Beech-nut Packing Co. v. P. Lorillard Co., 273 U. S. 629, 632 (1927).

148. Cohen, *loc. cit. supra* note 93.

149. *Id.* at 816.

150. In a trade name case before the English Court of Appeals in 1923 Lord Justice Sargant said: “I think that under the word ‘property’ may well be included the trade reputation of the Plaintiff’s and that, if tangible injury is shown to the trade reputation of the Plaintiff’s, that is enough.” Harrods, Ltd. v. R. Harrod, Ltd., 41 Rep. Pat. Cas. 74, 87 (C. A. 1923). In 1911 Judge Hough said: “It is to be regretted that sharp distinction was ever drawn between that trespass on property rights called trade-mark infringement, and the exactly similar trespass commonly spoken of as unfair competition. . . .” Thaddeus Davids Co. v. Davids, 190 Fed. 285, 287 (C. C. S. D. N. Y. 1911). Also see Fathchild, *Statutory Unfair Competition* (1936) 1 Mo. L. Rev. 20, 23.

151. The use of the term “property” has so operated in the protection of other interests. Professor Chafee has said: “The extension of equitable jurisdiction for the protection of human dignity and peace of mind has been made much easier through the ever widening meaning attached to the conception of property. The gulf between an acre of land and the right of privacy may have been too broad for equity to bridge, but its jurisdiction over property has now extended from land and chattels to far more intangible human interests”. Chafee, *The Progress of the Law, 1919-1920; Equitable Relief against Torts* (1921) 34 HARV. L. REV. 388, 407-08. See also the second paragraph in note 145, *supra*.

Fairness among competitors demands such an approach. But, even more, fairness to the public demands it. While the Supreme Court may know the difference between Arthur A. Waterman and L. E. Waterman, the purchasers of fountain pens do not.<sup>152</sup>

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152. "The law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions." Judge Coxe in *Florence Mfg. Co. v. J. C. Dowd & Co.*, 178 Fed. 73, 75 (C. C. A. 2d, 1910). In issuing an absolute rather than a qualified injunction in the famous Stone Ale case (*Montgomery v. Thompson*, [1891] A. C. 217), Lord Macnaghten said: "*Thirsty folk want beer, not explanations.*"