

1941

TRADE MARKS AND TRADE NAMES - UNFAIR COMPETITION - RESTRICTIONS ON USE OF PERSONAL NAME

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Recommended Citation

Reed T. Phalan, *TRADE MARKS AND TRADE NAMES - UNFAIR COMPETITION - RESTRICTIONS ON USE OF PERSONAL NAME*, 39 MICH. L. REV. 1047 (1941).

Available at: <https://repository.law.umich.edu/mlr/vol39/iss6/26>

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TRADE MARKS AND TRADE NAMES — UNFAIR COMPETITION — RESTRICTIONS ON USE OF PERSONAL NAME — For many years plaintiff and its predecessors used the name "Dougherty's" in marketing straight whiskey throughout the United States. In 1939 defendant, Edwin L. Dougherty, began selling blended whiskey in Pennsylvania, likewise using the name "Dougherty's," to dominate his labels, and in 1940, pursuant to a previously formed intention, plaintiff began selling blended whiskey under the same name. Plaintiff brought an action to enjoin defendant's use of the name "Dougherty's." *Held*, through plaintiff's prior use, the name "Dougherty's" had come to be associated by the purchasing public with plaintiff's whiskey; therefore defendant's use of the same name to dominate his labels tended to confuse the public, and although defendant did not intend the confusion, he should be enjoined from using his name in a dominating position on his labels. However, he might announce himself on the label as the distributor with the words "blended and bottled for Edwin L. Dougherty" in small type. *J. A. Dougherty's Sons v. Dougherty*, (D. C. Pa. 1940) 36 F. Supp. 149.

When a particular name is used by a business in manufacturing or marketing a product, frequently the name, through substantial use, advertising, quality of product, and fair dealing, becomes associated by the purchasing public with that business and its product. Such significance and good will attached to a trade name are valuable assets. A subsequent use of the same or similar name by another similar business generally leads to confusion—to the detriment (1) of the purchasing public, which is misled into believing the product of the subsequent business to be that of the prior one and (2) of the prior business through the appropriation by the subsequent business of a portion of the commercial significance and good will attached to its name. This confusion may in some cases be avoided by requiring the subsequent user to accompany his use of the name with other words distinguishing it from the name of the prior user. In many cases adequate protection will demand that the subsequent use of the name be restricted to a subordinate rather than dominant association with the subsequent product, and sometimes complete prohibition of the subsequent use will be necessary.¹ When the name is a personal one, the problem is complicated by the position of the courts that a human being has a substantial right to a free use of his own name in his business.² Even when a defendant is using his own name with an intent to cause confusion in order to profit from another's good will, some courts refuse an absolute injunction.³ On the other hand, when there is this intent to confuse, some courts restrict defendant's use of his name to

¹ See 63 C. J. 561 (1933).

² See generally annotations in 47 A. L. R. 1186 at 1189 (1927) and 107 A. L. R. 1276 at 1279 (1937); NIMS, UNFAIR COMPETITION AND TRADE MARKS, § 67 et seq. (1929); Handler and Pickett, "Trade-Marks and Trade Names—An Analysis and Synthesis," 30 COL. L. REV. 168 at 196, 759 (1930).

³ *Waterman Co. v. Modern Pen Co.*, 235 U. S. 88, 35 S. Ct. 91 (1914); *Rowley v. J. F. Rowley Co.*, (C. C. A. 3d, 1908) 161 F. 94; *National Distillers Products Corp. v. K. Taylor Distilling Co.*, (D. C. Ky. 1940) 31 F. Supp. 611. This view is criticized by Wigmore, "Justice, Commercial Morality, and the Federal Supreme Court; The Waterman Pen Case," 10 ILL. L. REV. 178 (1915).

a subordinate use⁴ or prohibit it altogether.⁵ When defendant acts without fraudulent intent, most courts enforce a duty to distinguish but restrict defendant no further,⁶ while some courts relegate his use to a subordinate position in association with his product.⁷ The decree in the principal case is of the latter type, and is as restrictive of the use of a personal name as any the writer has found. There is nothing in the opinion of the principal case from which it can be inferred that the decree does not adequately protect the public and the plaintiff. However, it is conceivable that there might be instances in which some confusion of products would result, even though the subsequent use is subordinate and accompanied by distinguishing words. If the law will put no greater restrictions than these on the honest use of personal names in business, then there may be some confusion of products which is "*damnum absque injuria*"—a maxim frequently found in personal name cases.⁸ Several reasons are advanced for holding the right to use a personal name honestly to be absolute: one's name is his property;⁹ his right is both a natural and a constitutional one;¹⁰ there is public interest in everyone's following the business for which his training and ability fit him;¹¹ and interference with use of a personal name would be an undue restraint of trade.¹² On analysis, these arguments seem nominal and do not give consideration to the real issues involved. The better policy from the standpoint of fairness to all the parties would seem to be to consider a personal trade name no differently from an impersonal trade name or a trade mark.¹³ It is possible that the trend of modern decisions is in this direction.¹⁴

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⁴ *Tanqueray Gordon & Co. v. Gordon*, (D. C. N. J. 1935) 10 F. Supp. 852, appeal dismissed sub nom. *Gordon v. Tanqueray Gordon & Co.*, (C. C. A. 3d, 1935) 77 F. (2d) 998; *R. B. Davis Co. v. Davis*, (D. C. N. Y. 1935) 11 F. Supp. 269.

⁵ *Westphal v. Westphal's World's Best Corp.*, 216 App. Div. 53, 215 N. Y. S. 4 (1926), affd. without opinion, 243 N. Y. 639, 154 N. E. 638 (1926); *Riggs Optical Co. v. Riggs*, 132 Neb. 26, 270 N. W. 667 (1937).

⁶ *Gleaves v. W. B. Fishburn Co.*, (C. C. A. 5th, 1936) 82 F. (2d) 627.

⁷ *S. C. Johnson & Son v. Johnson*, (D. C. N. Y. 1939) 28 F. Supp. 744. Also see *Hanser v. Hanser*, 229 Wis. 21, 281 N. W. 675 (1938).

⁸ *Seligman v. Fenton*, 286 Pa. 372, 133 A. 561 (1926); *Goidl v. Advance Neckwear Co.*, 132 Tex. 308, 123 S. W. (2d) 865 (1939). Also see *Ida May Co. v. Ensign*, 20 Cal. App. (2d) 339, 66 P. (2d) 727 (1937); *J. V. Boudrias Fils Ltee. v. Boudrias Freres Ltee.*, (Exch. Ct. of Canada) [1934] 4 Dom. L. R. 328.

⁹ *Brown Chemical Co. v. Meyer*, 139 U. S. 540, 11 S. Ct. 625 (1891).

¹⁰ *Hilton v. Hilton*, 89 N. J. Eq. 182, 104 A. 375 (1918).

¹¹ *Id.*

¹² For example, see *Rogers v. Rogers*, 53 Conn. 121, 1 A. 807 (dissent 5 A. 675) (1885).

¹³ NIMS, UNFAIR COMPETITION AND TRADE MARKS, § 68 (1929). "The maxim *sic utere tuo ut alienum non laedas* applies to everything that a man has, including his name." *Martin Co. v. Martin & Wilckes Co.*, 75 N. J. Eq. 39 at 50, 71 A. 409 (1908).

¹⁴ 39 YALE L. J. 297 (1929) (book review); 72 UNIV. PA. L. REV. 300 (1924). But see 26 COL. L. REV. 870 (1926).