

EVOLUTION OF THE PERSONAL TRADE NAME.

The law of trade marks and unfair competition with reference to the use of personal names or descriptive terms has undergone an important change within late years owing, first, to the disposition of the courts to cast upon the new comer a distinct duty and burden of affirmative differentiation, and second, to the Act of Congress of February, 1905,¹ enacted under the Commerce clause of the Constitution providing for the registration of trade-marks in interstate and foreign commerce, and which is construed to permit the registration of a personal name or descriptive term as a valid trade mark.²

Under the early common law the owner of a trade name could obtain no relief against the unfair use of his trade name by a second comer unless the complainant could assert an exclusive right to the name, that is, unless he had a technical trade mark in the name.^{2-a} This was tantamount to protection of the unfair trader and gradually gave rise to the doctrine of unfair competition under which relief is afforded not in protection of the trade name, but against the fraudulent use of a trade name, or unfair competition.

The perception of this broader doctrine has been termed the genesis of the law of unfair competition, and while not designed to protect the name itself, recognizes the value of a

1. c. 592, 33 Stat. 724, the original Trade Mark Acts of Congress of July, 1870, and August, 1876 (19 Stat. L. 142), were declared unconstitutional in Trade Mark Cases, 100 U. S. 82, as a trade-mark was neither an invention, a discovery nor a writing within the eighth clause of the eighth section of the first article of the Constitution; and the power of Congress was limited to the use of trade-marks "in commerce with foreign nations, and among the several states and with the Indian tribes." Congress then passed the Act of March 3, 1883, limiting the act as above pointed out. (21 Stat. I 502.) This act was construed in *Howe Scale Co. v. Wycoff, etc.* 198 U. S. 118, as not giving validity as a trade-mark to the personal name registered thereunder. Thereupon the Act of Feb. 20, 1905, was enacted providing that any mark used exclusively as a trade-mark in commerce with foreign nations, etc., for a period of ten years preceding the passage of the Act, might be registered thereunder. Amended March 19, 1920, to permit registration after one year's use.

2. *Thaddeus Davids Co. v. Davids*, 233 U. S. 645.

2-a. *Blanchard v. Hill*, 2 Atk. 484, 26 Eng. Reprint 692.

good will attaching to a trade name and protects the good will as a property right independent of the question of trade mark by preventing unfair competition.³ The doctrine recognizes the fact that where a trade name has been used so long as a designation of a product that the name or mark itself has come to denote the goods of the manufacturer, the mark in addition to its primary meaning as a personal name or descriptive term, has acquired a secondary meaning in the trade as a designation of the product. The owner of the name which has thus acquired a secondary meaning has a right to demand of the second comer, who uses the same name, that he take such precautions as will unmistakably inform the public that his product is not the product of the first name trader.⁴ The original owner, though not having an exclusive right to the name itself by reason of its primary meaning, which is *publici juris*, possesses the exclusive right to the good will which has been acquired in the name, and is entitled to protection therein against interference.⁵ In the light of this principle it will be seen that it is incorrect to assume that one has the absolute right to use even his own name in business to identify his product. The right is qualified by or dependent upon the obligation to explain the use in such a way as to distinguish his from the other product and prevent the deception that would normally result in the use of the term without the explanation.⁶ The right of course may be further qualified by contract, fraud or estoppel.^{6-a} Indeed, if one greatly offend, he may be strictly enjoined, and even prohibited from using his own name in ways ordinarily open to him.^{6-b} It follows that under the modern doctrine the inquiry in this class of cases

3. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 41 L. Ed. 118. *McLean v. Fleming*, 96 U. S. 245, 24 L. Ed. 828.

4. *Merriman v. Saalfield*, 198 Fed. 369. *Stix Baer & Fuller Co. v. American Piano Co.*, 211 Fed. 276.

5. 38 Cyc. 770; *Merriam v. Ogilvie*, 159 Fed. 638. *Amoskeag Co. v. Trainer*, 101 U. S. 51, 25 L. Ed. 993. *McLean v. Fleming*, *supra*.

6. *Meriam v. Saalfield*, *supra*.

6-a. *Herring Co. v. Hall*, 208 U. S. 559; *Guth Choc. Co. v. Guth*, 215 Fed. 766.

6-b. *Guth Choc. Co. v. Guth*, 215 Fed. 1. c. 766, and cases cited. *Chickering v. Chickering*, 215 Fed. 490.

is not primarily whether the second comer is practicing any deception in the use of the name in the sale of a product, but whether he is faithfully discharging his obligation to explain or undeceive, so to speak.

It is obvious that there is a vast distinction between this doctrine and the doctrine which required as a prerequisite to relief, either the establishment of a technical trade mark, or, a showing that the second comer is using the name for the purpose of deceiving.

It has been complained that the modern doctrine virtually requires the new comer to advertise his competitor's goods, but it has been well answered that this is the necessary result of the deliberate choice of a name which had already acquired a good will or secondary meaning in the particular trade.^{6-c}

Although this doctrine of *affirmative differentiation* is well established, its application is troublesome. The difficulty arises because of the necessity of protecting two apparently conflicting fundamental rights, namely, the good will of complainant in a name, and the general right to the same name by persons of similar names after differentiation. It is well settled that neither prefixes nor suffixes to a name alone, constitute a sufficient differentiation.^{6-d} The public cannot be presumed to know, for instance, that Steinway pianos are made by Steinway & Son, or Steinway & Brother, nor whether Waterman pens are made by L. E. Waterman Co. or A. A. Waterman Co. Consequently the courts have generally required an explanatory phrase such as "not the original Steinway" or "not connected with the L. E. Waterman Co." Neither does the use of the place of manufacture, though dissimilar, suffice. Each case must rest upon its own facts. Courts have used different phrases in announcing the test of differentiation. One court says the second comer must

6-c. Stix, Baer & Fuller Co. v. American Piano Co., 211 Fed. 276. But see Guth Choc. Co. v. Guth, *supra*, l. c. 765.

6d. Stark Bros. etc. v. Stark. 248 Fed. 154. Thaddeus Davids Co. v. Davids Mfg. Co., 233 U. S. 461.

7. L. E. Waterman Co. v. Modern Pen Co., 191 Fed. 534. Guth Choc. Co. v. Guth, 215 Fed. 763. Chickering v Chickering, *supra*.

“unmistakably inform” the public, etc.;⁸ another requires him to “accentuate difference”;⁹ he must not “exploit resemblances”; he must so distinguish that no one with the exercise of ordinary care can mistake”;¹⁰ he must “give the antidote with the bane.”¹¹

In their efforts to outline specifically the action which should be taken to distinguish the product and at the same time give effect to the unquestioned though qualified right to the use of personal names or descriptive terms, the courts have frequently failed to grant substantial relief to complainants. For instance a decree requiring the use of the explanatory phrase “not connected with the original Waterman pen” was amended to read “not connected with L. E. Waterman Co.” on the ground that the use of the word “original” tended to characterize defendant’s goods as inferior.¹² It may be well contended that the latter phrase leaves the public as much at sea and falls as far short of differentiation as the use of the suffix “A. A.” to the word Waterman, because the public cannot know whether the company which is the owner of the good will is the A. A. Waterman Co. or the L. E. Waterman Co. Indeed such a phrase having the sanction of a court of equity, would seem to aggravate the confusion which it is designed to prevent. It must be borne in mind that the public have rights which must be protected as well as the right attaching to the good will, and they have the right to know which article is the one that has acquired the good will, because the reputation is valuable both to the owner and the purchaser.¹³

Qualifying phrases which convey the impression that there are now two products bearing substantially the same name on the market are of course misleading. As pointed out in the Baker and Knabe cases there are not two Baker’s chocolates

8. Singer Mfg. Co. v. June Mfg. Co., *supra*.

9. Walter Baker & Co. v. Sanders, 80 Fed. 889.

10. Saxlehner vs. Eisner, 179 U. S. 19.

11. Herring Co. vs. Hall Co., 208 U. S. 559.

12. L. E. Waterman Co. v. Modern Pen Co., 197 Fed. 534.

13. Pillsbury v. Pillsbury-Washburn Co., 164 Fed. 841.

or two Knabe pianos as those names are understood in the trade.¹⁴

When the principle of affirmative differentiation was conceived and the duty case upon the second comer it was thought that a way out of trade name dilemmas was discovered, but human ingenuity could not be so readily throttled. Unfair traders have converted the burden into an opportunity.

For instance, in the Knabe case the original Knabe piano was made by William Knabe & Co. Subsequently two grandsons manufactured a piano and printed on the fall-board "The Knabe Bros. Co." and to simulate compliance with the rule of law on the subject of differentiation, they inserted in advertisements that "Knabe Bros. Co. pianos are distinctly high art products made by William and Ernest Knabe, grandsons of the original William Knabe who made the first Knabe piano. This genuine art product must not therefore be confused with a certain piano made at Baltimore still called the 'original Knabe' but with the making of which no Knabe is connected. William and Ernest Knabe are makers of the Knabe Bros. piano."

A similar situation arose in the Stark Nursery case.^{14-a} The defendants in that case went so far in their advertisements as to warn the public to look out for frauds in the use of the name Stark and the court observed that the advertisements "so far from absolving defendants from the charge of unwarranted encroachment, in point of fact, under the circumstances revealed by this record really invite the public to regard the defendants as the original Stark and all others of similar name as interlopers in the Nursery business in Missouri." In both cases the duty of differentiating was seized upon as an opportunity to lead the public to believe that the second comer's products were the only genuine articles.

The troublesome questions presented under the common law doctrine of unfair competition will probably not arise in

14. *Walter Baker Co. v. Slack*, 130 Fed. 514.
14-a. 248 Fed. 154.

the future as frequently as they have in the past owing to the Act of Congress of 1905 pertaining to the registration of trademarks, and under which it is held that personal names and descriptive terms used as trade names in commerce for a period of ten years are entitled to registration and protection as technical trademarks under the Act. Although permitting their registration the courts have until very recently been unwilling to concede that such trademarks are entitled to the same degree of protection accorded to trademarks in arbitrary terms.

The effect of registration under the Act was considered by the United States Circuit Court of Appeals in the case of *Thaddeus Davids vs. Davids et al.*,¹⁵ the Court holding that the personal name Davids was entitled to registration and protection as a trademark, but refused to enjoin the use of the words "C. I. Davids" and "Davids Manufacturing Co." on the ground that one could not be enjoined from using his own name in business unless its use was fraudulent. The Supreme Court on appeal¹⁶ held that the personal name was entitled to registration as a trademark, and to protection as such, and enjoined the use of the words above mentioned as infringements. Thus, in effect at least, the Supreme Court seemed to accord full protection to a personal name trademark. The language used by the Court, however, materially militates against this conclusion. Indeed it seems to lay down substantially the common law rule on the subject. The Court says:

"It is apparent that with respect to names or terms coming within this class there may be proper uses by others than the registrant even in connection with trade in similar goods. It would seem to be clear for example that the registration for which the statute provides was not designated to confer a monopoly of the use of surnames or geographical names as such. It is not to be supposed that Congress intended to prevent one from using his own name in trade, etc. * * * It

15. *Thaddeus Davids Co. vs. Davids*, 192 Fed. 915.

16. *T. Davids vs. Davids*, 233 U. S. 646, 58 L. Ed. 1046.

follows that where the mark consists of a surname a person having the same name and using it in his own business although dealing in similar goods would not be an infringer, provided that the name was not used in a manner tending to mislead, and it was clearly made to appear that the goods were his own and not those of the registrant.”

The Court virtually admits that this language is a reiteration of the common law, but contents itself by pointing out to litigants that the jurisdiction of the Federal courts is enlarged by the Act. Whether this will be a balm or bomb to litigants, owners of personal trade names, is left open.

The decree of the court could be reconciled with the language used, however, by interpreting it as meaning that although one may use his own name in business, he may not now use it as the trade-name or catchword of his product, as was done by defendants in this case.

This interpretation of the decision in the Davids case finds support in the case of Warner Bros. vs. Wiener.¹⁷ When this case first came before the Circuit Court of Appeals it was held that Wiener was not an infringement of the registered name Warner as applied to corsets. Justice Lacombe dissented, citing the Davids case which had just been handed down by the United States Circuit Court of Appeals,^{17a} saying that another Davids was not cut off from using his own surname provided he differentiated it from the Davids trademark, and holding that Wiener could not use his name as a trademark unless he added the name David or Wiener Manufacturing Company. When the Davids decision was handed down by the United States Supreme Court the Warner case was pending on a motion for rehearing, and the court thereupon held that under the Davids decision the personal name was entitled to be treated as an arbitrary word, and to be protected as such, and that therefore the word Wiener stand-

17. 218 Fed. 635.

17-a. (citing 214 Fed.)

ing alone was a colorable imitation of the word Warner, and that the defendant must be enjoined, although it is his own surname, from using it in business alone, or in any manner amounting to a colorable imitation of the word "Warner."

A more recent Federal decision, although not so explicit as the decision in the Wiener case seems to adhere to this view of the law. Thus the Court in Stark Bros. Nursery Co. vs. Stark¹⁸ enjoined defendant from using the words "Stark City" and "from using the name 'Stark' prominently at the top of its labels or elsewhere in such manner as will not unmistakably differentiate their goods from those of complainants"; thus requiring the differentiation in the use of the name itself. The Appellate Court in considering this decree seemed to lean back somewhat to the common law and at first blush appears not to give full effect to registration of a personal name under the Act, the Court saying:¹⁹

"While it is true that a person *has a right to use his surname as a mark without being guilty of an infringement*, there is a limitation to that right. * * * The decree complained of only enjoined appellants from using labels with their name Stark in such a manner as will not unmistakably differentiate their goods and advertisements from those of complainant. * * * *There is nothing in the decree to prevent appellants from using their surnames, etc.*"

In line with this statement of the law the Court added a new paragraph to the decree below which specifically authorized defendants to use their surnames on circulars, catalogues, advertisements, etc. provided they used an accompanying explanation which sufficiently distinguished the products of the two parties. But the Court did not disturb the paragraph of the decree of the Court below expressly prohibiting the use of the name "Stark" *prominently* at the top of its labels, unless used in such a manner as to differentiate the goods. A close analysis of this case, therefore, seems to harmonize the de-

18. 248 Fed. 154.

19. 257 Fed. l. c. 13.

cision with that in the Wiener case in prohibiting the use of a personal name when already registered, as a trademark or name except with distinguishing modifications. The remarks of the Court and the paragraph added thereon evidently apply to the use of the name otherwise than as the trade name or catchword of the product.

It seems, therefore, reasonably clear that under the Act of 1905 and its amendment the personal name registered as a trademark or trade name has finally been accorded the protection formerly given arbitrary words under the Trademark Law, although it must not be supposed that a personal name cannot be used in a similar business otherwise than as a trademark or name, or even as a trade name if sufficiently differentiated from the trademark so as not to be a colorable imitation thereof.

J. PORTER HENRY.