PERSONAL TRADE-NAMES.

"A trade-name is a name which by use and reputation has acquired the property of indicating that a certain trade or occupation is carried on by a particular person. The name may be that of a person, place or thing, or it may be what is called a 'fancy name,' or word invented for the occasion and having no sense at all." Trade names are treated in most text-books under the general subject of trade-marks, which are defined as "a distinctive mark, device or emblem which a manufacturer stamps, prints or otherwise affixes to the goods he produces, so that they may be identified in the market and their origin be vouched for." This difference between the two must be noted, that whereas the trade-mark is stamped, printed or otherwise affixed to the goods to act as a passport accompanying the goods and vouching for them, and the trade-name may be so used, the latter has the additional and more general use of a name under which business is conducted. It may be that of an individual, firm or corporation not engaged in manufacture of goods at all, but engaged in mercantile trade, wholesale or retail, handling no goods of their own make; a banking institution, publishing house or, in general, anyone engaged in trade or business, and to whom a recognized and distinctive name is valuable.

In general it may be said that when a person bearing a particular name or having adopted a particular distinguishing mark or device, is engaged in business and uses such name or device to distinguish himself and his wares from all other parties engaged in a similar business, and such name or device becomes recognized as such, the law recognizes in him a valuable right in such name or device and will protect him in its exclusive use. Thus broadly stated, the principle has not always been recognized, but like many another thing, has been slowly worked out by the courts, and I cannot do better on this point than to quote at length from the opinion in Singer Manufacturing Co. v. Wilson. "All actions of this sort must be founded on false representation. Originally I apprehend, the right to bring an action in respect of the improper use of a trade-mark arose out of the

1 Defs., Black's Law Dictionary.
2 2 Ch D. 453.
common-law right to bring an action for false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in that an action for false representation is generally brought by the person to whom it is made; but in the case of an improper use of a trade-mark the common-law courts noticed that the false representation which is made by putting another man's trade-mark on the goods which the wrong-doer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturers whose trade-mark is imitated, and, therefore, the common-law courts held that such a manufacturer has a right of action for the improper use of his trade-mark. Then the common-law courts extended that doctrine one step further in the case of Sykes v. Sykes. There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing he had bought goods manufactured by another person, yet if the trade-mark were put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking he was purchasing the goods of the manufacturer to whom the trade-mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade-mark a right of action. Then in Millington v. Fox the Court of Chancery extended the doctrine still further. To give an action at common law, the thing must have been done fraudulently, it must have been intended to deceive. But the courts of equity said, if you have purchased goods with another man's trade-mark upon them, although you have done it perfectly honestly, not knowing that it was another's trade-mark, or if you have manufactured goods for somebody else, who has ordered you to manufacture them with a certain trade-mark upon them, perfectly honestly, and not knowing you were doing anything wrong in putting that trade-mark upon them, yet nevertheless you cannot be allowed to put the goods into the market with that trade-mark upon them, because the effect of it will be that the goods will pass from hand to hand as being goods manufactured by the person whose trade-mark it is, and therefore you shall

---

3 B. & C. 541.
4 M. & C. 338.
be restrained from doing that. The courts of equity having taken that step trade-marks began to be considered as property, and no doubt there is, in a certain sense, a property in a trade-mark and equally in a trade-name, because a trade-name may be used and is very commonly used, as a trade-mark properly so-called, that is a mark put upon the goods themselves."

Misrepresentation or deceit, therefore, is the basis for the relief sought for violation of a trade-mark or name, whether it be an action at law for damages, or in equity by means of injunction against future injuries from a continued use. In the case of a trade-mark or a mere fanciful name, this is not difficult to prove, since it is a mere arbitrary device, sign or symbol, originated by the party using it. It is in a real sense property and its use by any other person can only be to gain the advantage to be had from the reputation of the goods or business of the first maker or trader, since presumptively there is no merit in the trade-mark itself, aside from the goods it is intended to distinguish. Given, therefore, identity or close similarity of trade-marks, and you have made out your case for the relief sought.

The case is different, however, with a personal trade-name. It is in no sense an arbitrary sign or symbol and generally the person using it has had no choice in its selection, as applied to him. As a heritage of birth man comes into life with a surname already destined to his use, and the use of the family name is a natural right. It becomes valuable to him just in proportion as he makes it so, and yet it is apparent that no man has an exclusive property right in his name, even in a particular business, as against others bearing the same name. As against one not bearing the name, a trade-name can undoubtedly be protected upon the same showing as in case of a trade-mark and upon the same principle of property right. But against one bearing the same name, the action must be sustained not on the ground of any property in the words used, but because the words are used for the purpose of passing off the goods of the maker or trader as the goods of another and thus perpetrating a fraud upon the original party. It becomes then not a question of trade-mark at all but what "Browne on Trade-Marks" styles "Unfair Competition in Trade," and is grounded in fraud upon the plaintiff, and, also, upon the public, as will more fully appear.

It may be considered an elementary principle that every man

---

* Higgins v. Higgins, 144 N. Y. 462.
* Browne on Trade-Marks, § 43; 26 Am. and Eng. Enc. of Law, 434.
is entitled to the use of his own name in his own business; and it makes no difference how many Smiths are making and selling "Smith’s Soap" or "Smith’s Hats," if my name be Smith I have a right to engage in a similar business and sell my wares under the same name—provided I resort to no artifice or other means calculated to deceive purchasers into believing they are purchasing the goods of one of the other makers; that is, no deception other than that which may exist out of the confusion caused by similarity of name. For "in absence of fraud or deceit, where two parties have the same surname, equity will not enjoin defendant from using his name in pursuit of his lawful business, even though such use by defendant results in injury to plaintiff; since there cannot under such circumstances be a trade-mark in the surname which will prevent defendant from its use." It was thus held in Meneely v. Meneely above cited, a leading case in this country, wherein certain sons of one Meneely deceased succeeded to their father’s name and business in the operation of a bell foundry at Troy, N. Y., which had obtained a high reputation for its products. Another son started the same business in the same place using his own name, and the brothers, succeeding to the use of the father’s business, sought to restrain the use of the name. The court, however, said:

"The Court will not absolutely restrain the defendant Meneely from the use of his own name in any way or form, but simply from using it in such a way as to deceive the public and injure plaintiffs. The manner of using the name is all that would be enjoined, not the simple use of it, for every man has the absolute right to use his own name in his own business, even though he may thereby interfere with, or injure the business of another person bearing the same name, provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead. A person cannot make a trade-mark of his own name and thus obtain a monopoly of it, which will debar other persons of the same name from using their own names in their own business."

And in Croft v. Day, where two persons bearing name of Day and Martin respectively, began the manufacture of shoe blacking and polish under the firm name of "Day & Martin,"
PERSONAL TRADE-NAMES.

whereas there had been a previous firm bearing the same name, of established reputation for the quality of their output, whose business was being carried on by the administrator of Day's estate, the Court used the following language:

"It is a person's right to be protected against fraud, and fraud may be practiced against him by means of a name, though the person practicing it, may have a perfect right to the use of that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud on others. * * *

Relief is granted not on the basis of an exclusive right in plaintiff to the name 'Day & Martin,' but on the fact that defendants are using those names in connection with certain circumstances and in a manner calculated to mislead the public and to enable defendants to obtain at expense of Day's estate a benefit to themselves to which they are not in fair and honest dealing entitled. They have the right to carry on the business of blacking manufacturers honestly and fairly; they have a right to use of their own names; but they must not use them in such manner or way as to deceive and defraud the public and obtain for themselves at expense of plaintiff an undue and improper advantage."

And in this case relief was granted not against the use of the name but against further imitation by defendants of bottles, labels, etc., used by plaintiff, and to same effect are cases cited below.

It must be observed that it is not the mere tendency to deceive, nor the probability to effect an injury, that governs the relief in such cases, as is the case in a trade-mark no matter how innocent its use, but the intentional employment of other means calculated to deceive. And that even though there is a strong probability that the public will be excessively misled by the similarity of names, or that the original user of the name will be injured in his business, yet in absence of such means of deception relief will not be granted. But it must be a true use of the name; the person whose name is used must be a real party to the business. Thus where one Devlin was doing business as "Devlin & Co.," whereas he had no partner or other party interested with him in the business, an injunction was allowed against the use of the "& Co." at the instance of another Devlin

---

& Co., where there was a true partnership. But this rule does not apply to cases of partnership names where the name originally was properly used, for the name may be, and often is, used a long time after parties have deceased or lost their interest in the business. In such case it is merely an equivalent to the statement that certain parties have succeeded to and are continuing the business of the old firm. So the sale of one's interest in a co-partnership together with the good-will of the business, carries with it all advantages that may pertain to the firm name, and such retiring partner will not afterward be permitted to renew the business under such a name as will imply that he is the successor to the old firm.

As a person may use his own name in his own business, so a person may permit a corporation to use his name in its own title and such corporation will not be enjoined at instance of another, if the name is used in such manner as not to lead the public to believe that they are dealing with such other or are buying the article manufactured by it under the same name, no fraud or deceit being shown. And where a corporation with the consent of its stockholders has embodied one or more of their names in the corporate name, the right to use the name so adopted will continue during the existence of the corporation. The person so giving the use of his name parts with the right to its personal use in the same or similar business, during the life of the corporation. Thus in Holmes, Booth & Hayden v. Holmes, Booth & Atwood Co., cited, where Messrs. Holmes and Booth retired from the first company and organized the second company for the purpose of engaging in the same line of business in competition with the first company, the Court held that when they gave their names to the first company they gave it the right to the exclusive use of its name, so far as they were concerned, so long as it might survive, and the Court enjoined them from the use of their own names in the competitive business, when it was shown that great confusion would result and the plaintiff corporation be seriously injured in its business.

But there cannot be said to be the same merit in a corporate name as in an individual's, since the corporation has no name

---

10 Devlin v. Devlin, 69 N. Y. 212.
until christened by its incorporators. The name chosen may be valuable as indicating the men back of it, but in the end it is a mere fanciful name—a chosen name. A company therefore employing a name—even of one or more of its stockholders—similar to name of a corporation or co-partnership previously in existence will receive less consideration from the courts than an individual under similar circumstances and in some States recent statutes prohibiting the selection of a name similar to any name theretofore in use, have been enacted.13

There remains one class of cases to be mentioned where the long-continued use of a personal name in connection with a given article has caused the name to attach to the article as descriptive of it. This is the case frequently with patented articles where during the monopoly given by law the article comes to be called and generally known as “Blank’s Patent.” Thus in Cheavin v. Walker,14 the defendant manufactured and sold a water filter under the name of “Cheavin’s patent filter,” it being, in fact, the same article made by plaintiff, but on which the patent had expired, and the Court held that defendant had the right to make same and to sell them as “Cheavin’s patent filter,” provided he resorted to no means to cause the public to believe they were purchasing Cheavin’s own product. Likewise in Singer Mfg. Co. v. Wilson,15 where the Singer sewing machine had acquired a great reputation during the life of certain patents, it was held after their expiration that defendant was entitled to manufacture the same machine and to advertise his machines for sale as “Singer” machines, his advertisements always stating that the machines he sold were manufactured by him and in no manner indicating them to be the product of the Singer Mfg. Co.

A few words only as to the remedy—and here the practice varies immaterially from that in trade-mark cases in general. As previously stated, it may be an action for damages at law, or by injunction with an accounting for profits. In the action at law, actual injury must be shown, but to support an injunction it is only necessary to show that an injury is threatened and that it will follow as a natural consequence of the acts complained of. The complainant must not sleep upon his rights, or long continued use with the knowledge of complainant, especially where defendant has been permitted to spend time, labor and money in

14 5 Ch. Div. 850.
15 2 Ch. Div. 434.
building up a business, may be read into an acquiescence on the part of complainant in its use. And a less lapse of time will be a defense against an accounting for profits. As to the degree of similarity necessary to warrant relief, the rule is well stated that "if the similarity would not probably deceive the ordinary mass of purchasers, an injunction will not be granted. It is not those who give the matter no attention, for they cannot be said to be misled. The similarity must be such as is calculated to mislead those in the use of ordinary caution. We must assume that consumers and dealers of a commodity have ordinary intelligence, and adopt ordinary precaution against imposition and fraud." This principle will also be found running through all the cases heretofore cited and, in other words, must be such similarity as is "calculated to deceive" and so to gain an unjust advantage over the rightful user of the name.

Francis W. Treadway.

---

17 Blackwell v. Wright, 73 N. C. 313.