

# Torts - Unfair Competition - Trade Marks and Trade Names - Appropriating Another's Trade Name for a Non-Competing Product

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going forward with the proofs, nor a shifting burden, but a burden of establishing before the jury by a preponderance of the evidence that its negligence did not cause the loss. *Huel v. Flour City Fuel and Transfer Co.*, 144 Minn. 280, 175 N.W. 300 (1919).

However, it must be noted in all these cases that if the bailor himself accounts for the loss and charges it to the bailee's negligence, he has lifted from the bailee any burden the latter may have had, and until negligence is proved the bailee need say nothing. *Glover v. Spraker*, 50 Idaho 16, 292 Pac. 613 (1930).

WILLIAM C. ANTOINE.

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**Torts—Unfair Competition—Trade Marks and Trade Names—Appropriating Another's Trade Name for a Non-Competing Product.**—*S. C. Johnson & Son, Inc.*, a large Wisconsin corporation, which originally manufactured only floor wax, but later added floor cleaners, varnishes, fillers, brushes, enamels, lacquers, waxes for motors and the like, to its line of preparations, sold its goods nationally under the registered trade-mark "Johnson's," which was conspicuously marked on all of its products. The corporation had never manufactured any sort of fabric cleaner. In 1932 the defendant Johnson Products Company began selling a fabric cleaning fluid and household cleaner. Defendant's product bore a yellow label, similar to that used on plaintiff's goods, with the word "Johnson's" in large red letters and below it the word "Cleaner" in letters half the size. The legend "Copyright 1933, by Johnson Products Co., Buffalo, N. Y.," appeared at the bottom of the label in small type. The products of the two organizations, though closely related, were not competing. Plaintiff, invoking the doctrine that when a good will is established under the owner's name, given or assumed, he may protect it not only against the competition of those who invade his market, but also against those who use the name to sell goods nearly enough alike to confuse his customers, secured an injunction prohibiting defendant from using the word "Johnson's" in connection with its product. *Held* on appeal that the owner of the registered trade-mark "Johnson's" for floor wax and similar products was not entitled to an absolute injunction against the continued use of the word for a household cleaner manufactured by the defendant Johnson which did not compete with the trade-mark owner's products, but was entitled to an injunction against such use except in combination with the word "Cleaner" and the legend giving the manufacturer's name in equally conspicuous type. *S. C. Johnson & Son, Inc. v. Johnson*, 9 U.S.L. Week 2410, 116 F. (2d) 427 (C.C.A. 3rd, 1940).

It is generally held that where a personal name has become the trade-mark for particular goods, that name may not be used as the trade-mark for the same or similar goods in such a way as to confuse ordinarily prudent purchasers as to the source of the goods. *K. Taylor Distilling Co. v. Food Center of St. Louis, Inc.*, 31 F. Supp. 460 (E.D. Mo. 1940); *Pro-Phy-Lac-Tic Brush Co. v. Abraham and Strauss, Inc.*, 11 F. Supp. 660 (E.D. N.Y. 1935); *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 Fed. 407 (C.C.A. 2nd 1917); certiorari denied, 245 U.S. 672, 38 S.Ct. 222. A manufacturer is not allowed to palm off his product, either directly or indirectly, as that of another. *Socony-Vacuum Oil Co., Inc. v. Rosen*, 108 F. (2d) 124 (C.C.A. 3rd, 1939). He may not trade on another person's goodwill, nor take advantage of his advertising; nor in any way commercially use as his own, the name which has become the commercial asset of another. *Great Atlantic & Pacific Tea Co. v. A. & P. Cleaners & Dyers, Inc., of Washington, Pa.*, 104 F. Supp. 450 (W.D. Pa. 1934). A merchant's name, when used as a trade-mark,

is his seal by which he vouches for the goods which bear it. If another uses it, he borrows the owner's reputation. This is an injury even though the borrower does not tarnish that reputation. *Armour & Co. v. Master Tire & Rubber Co. et al.*, 34 F. (2d) 201 (S.D. Ohio 1925). One who uses the trade name of another in such a manner that the goods are apt to be confused, is committing a fraud, both upon the public and upon the owner of the trade name. *Yale Electric Corporation v. Robertson, Commissioner of Patents et al.*, 26 F. (2d) 972 (C.C.A. 2nd, 1928). Therefore, when a merchant or manufacturer uses a name on his label which has become the trade-mark of another, that name must be used in such a way that the purchasing public may know the source of the goods. Distinguishing words must be added to the name, and in order that the public may have a fair chance to read the entire label, all the words are required to be in letters of the same size, color, type, and general distinctiveness. *Vogue Co. v. Thompson-Hudson Co. et al.*, 300 Fed. 509 (C.C.A. 6th, 1924); *Bayer Co. v. Shoyer et al.*, 27 F. Supp. 633 (E.D. Pa. 1939). The second user of a trade-name is required to mark or designate his merchandise in such a manner that purchasers exercising ordinary care to discover whose product they are buying will not be confused. It is not necessary that he so designate his product that careless or indifferent buyers will not fail to know its source. *Reynolds & Reynolds Co. v. Norick et al.*, 114 F. (2d) 278 (C.C.A. 10th, 1940).

A trade-mark protects the owner against not only its use upon articles to which he has applied it, but upon such other goods as might naturally be supposed to come from him. He is protected against its use by another on any article that is of the same general class as his own. *L. E. Waterman Co. v. Gordon*, 72 F. (2d) 272 (C.C.A. 2nd, 1934). Goods are of the "same general class" as regards liability for trade-mark infringement when their general and essential characteristics are the same, or when they are so related that a common trade-mark would probably lead purchasers to conclude that the articles have a common origin. *Standard Oil Co. v. California Peach & Fig Growers, Inc.*, 28 F. (2d) 283 (D. Del. 1928). Thus a toothbrush manufacturer was held entitled to an injunction restraining a maker of tooth powder from using his trade name. *Pro-Phy-Lac-Tic Brush Co. v. Abraham & Strauss, Inc.*, *supra*. A syrup distributor was enjoined from using the name of a nationally advertised pancake flour. *Aunt Jemima Mills Co. v. Rigney & Co.*, *supra*. A tire manufacturer was forbidden to use the trade-mark of a large automobile company. *Hudson Motor Car Co. v. Hudson Tire Co.*, 21 F. (2d) 453 (D. N.J. 1927).

Trade names need not be identical, but it is sufficient to entitle a plaintiff to an injunction if the names are sufficiently similar to cause confusion and injury. *Academy of Motion Picture Arts and Sciences v. Benson*, 104 P. (2d) 650 (Cal. 1940). But a name or trade-mark is not a right in gross or at large like a copyright or patent, and it exists only as appurtenant to an existing business. *Golenpaul et al. v. Rosett et al.*, 174 Misc. 114, 18 N.Y.S. (2d) 889 (1940). It gives the owner a right to prohibit its use so far as to protect his good will against the sale of another's product as his, but it does not confer an absolute right to the use of the word, or words, since it is not a copyright. *L. E. Waterman Co. v. Gordon*, *supra*. So where the products sold or services rendered by two companies are so dissimilar that there is no danger of confusion, some courts have refused to enjoin the use of even an identical name. *Alhambra Transfer & Storage Co. v. Muse*, 106 P. (2d) 63 (Cal. App. 1940); *Lawyers Title Ins. Co. v. Lawyers Title Ins. Corporation*, 109 F. (2d) 35 (App. D.C. 1939). The goods upon which a supposed infringer puts the name may be so remote from any that the owner would be likely to sell that there is no dan-

ger of confusion. Thus it would be hard, for the seller of a steam shovel to find ground for complaint in the use of his trade-mark on a lipstick. *L. E. Waterman Co. v. Gordon, supra.*

Some courts have determined trade name disputes on the basis that a name or descriptive word, though not originally capable of exclusive appropriation, may by association with a commodity, obtain a "secondary meaning," denoting origin of goods from a single source, and a superior right to their use may thus be acquired by the person who first adopts them. *Socony-Vacuum Oil Co., Inc., v. Rosen, supra; Academy of Motion Picture Arts and Sciences v. Benson, supra.* Where words have acquired a secondary meaning, an injunction against their use by other parties will be granted if it can be shown that their use will confuse the public as to the source of the goods, and it is not necessary that the plaintiff and the defendant be in competing businesses. *Academy of Motion Picture Arts and Sciences v. Benson, supra.*

Fraud is the basis on which most of the recent trade-name actions have been decided. *Armour & Co. v. Master Tire & Rubber Co. et al., supra; General Shoe Corporation v. Rosen, 111 F. (2d) 95 (C.C.A. 4th, 1940); Del Monte Special Food Co. v. California Packing Corporation, 34 F. (2d) 774 (C.C.A. 9th, 1929).* Courts will restrain attempts to take fraudulent advantage of another merchant by diverting part of his trade, *Aunt Jemima Mills Co. v. Rigney & Co., supra;* by taking advantage of his advertising, *Great Atlantic & Pacific Tea Co. v. A. & P. Cleaners & Dyers, Inc., of Washington, Pa., supra;* by trading on his reputation and good will, *Alfred Dunhill of London, Inc. v. Dunhill Shirt Shop, Inc., 3 F. Supp. 487 (S.D. N.Y. 1929);* or by doing anything that will damage his credit or his reputation for integrity and fair dealing, *Lawyers Title Ins. Co. v. Lawyers Title Ins. Corporation, supra.* They likewise will enjoin attempts to confuse the public as to the source of goods by appropriating a particular name, *K. Taylor Distilling Co. v. Food Center of St. Louis, Inc., supra;* or by using a misleading phrase, *Time, Inc. v. Barshay, 27 F. Supp. 870 (S.D. N.Y. 1939);* or imitating a particular script, *L. E. Waterman Co. v. Gordon, supra;* or copying a distinctive initial, *Great Atlantic and Pacific Tea Co. v. A. & P. Radio Stores, 20 F. Supp. 703 (E.D. Pa. 1937);* or using an unusual manner of printing, *Vogue Co. v. Thompson-Hudson Co. et al., supra;* or imitating the color of a package, *Pro-Phy-Lac-Tic Brush Co. v. Abraham & Strauss, Inc., supra;* or appropriating a picture long associated with a certain product, *Aunt Jemima Mills Co. v. Rigney & Co., supra;* or adopting a particular identifying mark, *Hudson Motor Car Co. v. Hudson Tire Co., supra,* or using any other means to deceive the purchasing public.

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