

DEPARTMENT OF COMMERCIAL LAW.

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 PARKLAND HILLS BLUE LICK WATER CO. *v.* HAWKINS.¹ COURT
OF APPEALS OF KENTUCKY.

The name "Blue Lick Water," having been notoriously used for more than a century to designate the water of certain springs known by that name since their first discovery, is a good trade-name, in the hands of lessees of said spring, as against the owners of an artesian well in another locality, who have given the name "Blue Lick" to the water of their well, with a view to deceive the public into a belief that it came from the Blue Lick Springs.

GEOGRAPHICAL NAMES AS TRADE-NAMES.

The terms "trade-mark" and "trade-name" are frequently used indiscriminately to denote the same thing; but in strict usage the trade-mark is the brand put upon the goods, including both the name and the sign usually joined therewith, while the trade-name is the designation given to the goods, without reference to the other signs used on the brand. In this correct sense the trade-name is only a part of the trade-mark, and the two terms cannot, with propriety, be used interchangeably. For example, in the principal case, the trade-name was "Blue Lick Water," while the trade-mark consisted of a figure of Daniel Boone, with the date of his discovery of the springs, the trade-name and the name of the proprietor, the trade-name thus forming but a comparatively small part of the trade-mark.

I. A trade-name must necessarily be more or less unique, in order to entitle its owner to its exclusive use. "Smith's"

¹ Reported in 26 S. W. Rep. 389.

Hair Tonic" may be manufactured by any man named Smith, and none of the family can lay claim to the exclusive use of that name to denote his hair tonic. But if he choose to call it "Smith's Excelsior Hair Tonic," he may prevent any other Smith from copying that title as a whole; and so if he call it "John Smith's Hair Tonic," as against Thomas, Henry, William, Peter, or any other Smith except another John. The reason of this is, that any man has a right to use his own name in his business, so long as he does not deceive others into the belief that that business is identical with someone's else, and therefore no one can prevent his so using it in good faith; but if he invents an arbitrary or fanciful name or combination of names not used before, he has a right to use it to the exclusion of others.

II. Applying these principles to the use of geographical names, it is plain that, as a general rule, the use of the name of a locality as a trade-name confers no proprietary right upon the user, as against others doing business or manufacturing in the same place, even though he be the first in the field. "When a name is used by a manufacturer in a purely geographical sense, as indicating that his goods are manufactured there, any one may also use it in that sense, provided he does not so use it as to induce the belief that his goods are the goods of manufacturers previously established there;" *Ld. Hannen, in Montgomery v. Thompson* [1891], App. Cas. 217. "No one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district or dealing in similar articles coming from the district from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it. True, it may be that the use by a second producer in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product, but if it is just as true in its application to his

goods as it is to those of another who first applied it, and who therefore claims an exclusive right to use it, there is no legal or moral wrong done:" *Canal Co. v. Clark*, 13 Wall. 311; *Evans v. Von Laer*, 32 Fed. Rep. 153; *Brooklyn White Lead Co. v. Masury*, 25 Barb. (N. Y.) 416; *Candee, Swan & Co. v. Deere*, 54 Ill. 439; *Glendon Iron Co. v. Uhler*, 75 Pa. 467; *Siegert v. Abbott*, 61 Md. 276; S. C. 48 Am. Rep. 101; *Laughman's App.*, 24 W. N. C. 465; S. C., 18 Atl. Rep. 415; *Am. Brewing Co. v. St. L. Brewing Co.*, 47 Mo. App. 14.

III. This rule, however, is subject to several qualifications. Though, as we have seen, the mere fact that the use of the name by another may mislead the public into a belief that his product is the same as that of the first user of the name, is no reason for prohibiting such use, yet that use must be in good faith, not with *the intent to so mislead purchasers*. Any fraudulent use of the name will be enjoined: *Siegert v. Abbott*, 61 Md. 276; S. C., 48 Am. Rep. 101; *Evans v. Von Laer*, 32 Fed. Rep. 153; *Siegert v. Findlater*, 7 Ch. D. 801. Accordingly, when a geographical name has, by long usage, acquired a secondary meaning, as denoting a particular product, such as "Worcestershire Sauce," a use of that name to induce the belief that the article was the same, and not merely to denote the place of manufacture, will be enjoined: *Lea v. Wolff, I Thomp., & C.*, 626; S. C., 46 How. Pr. 157; 15 Abb. Pr. N. S. 1, reversing on this point S. C., 13 Abb. Pr. N. S. 389.

A curious instance of mental perversion on this point is to be found in another "Worcestershire Sauce" case: *Lea v. Deakin*, 11 Biss. C. Ct. 23. There the court held that when a name has become generic in meaning as "Worcestershire" in this case, and denotes a special kind of product, it cannot be appropriated as a trade-mark. The confusion rises from the use of the word "generic." Words denoting a special quality of goods, which anyone may manufacture, such as "four-ply" collars, "lager" or "bock" beer, "rye" whisky, etc., cannot be appropriated by anyone. But the very essence of a trade-mark or trade-name is that it denotes something that no one else can manufacture, as in this case, the principal case, and others to be mentioned hereafter.

IV. The intent to deceive may be inferred, and in fact taken as an irrefutable presumption, from the fact that the goods of the second user of the name are not manufactured at the place in question, or do not come from it. It is the very nature of a lie to deceive. *M'Andrew v. Bassett*, 10 Jur. N. S. 492; *Braham v. Beachim*, 7 Ch. D. 848; *Blackwell v. Dibrell*, 3 Hughes C. Ct. 151; *Anheuser-Busch Brewing Assn. v. Piza*, 24 Fed. Rep. 149; *Southern White Lead Co. v. Cary*, 39 Fed. Rep. 492; *A. F. Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896; *Newman v. Alvord*, 51 N. Y. 189; aff. S. C., 49 Barb. (N. Y.) 588; *El. Modello Mfg. Co. v. Gato*, 25 Fla. 886; S. C., 7 So. Rep. 23; *Parkland Hills Blue Lick Water Co. v. Hawkins*, the principal case (Ky.), 26 S. W. Rep. 389.

There is but one case in opposition to this current of authority: *N. Y. & R. Cement Co. v. Copley Cement Co.*, 44 Fed. Rep. 277; aff. 45 Fed. Rep. 212; in which the plaintiff, a manufacturer of "Rosendale" cement, at that place, sought to enjoin the use of the term "Rosendale" by the defendant, whose place of manufacture was elsewhere. The court refused the injunction, on the ground that such a doctrine would permit any actual manufacturer of or dealer in "Dresden" china or "Irish" linen, to bring suit against all those who falsely called their products or wares by such names; in the second place, that the wrong was against the public, rather than against the manufacturers; and in the third place, that if any private wrong was done, all manufacturers at Rosendale were injured alike, and the plaintiff could not support its case without showing an exclusive right to the name. But when there is a clear injury, and an equally clear remedy, the courts have no business with possible consequences (to say nothing of the fact that courts of deeper wisdom and sounder judgment have failed to perceive these direful bugaboos); there is a clear private wrong in deluding the public into a belief that one man's goods are those of another, and so lessening the sales of the latter; and the question of right, as between one who has a right, though partial, and one who has none, is not affected by the rights of third parties. On every ground, the ruling in the Rosendale case is wholly wrong.

V. It does not matter that the goods or products of the second user of the name are the same in quality as those of the first. If they do not in fact come from the same locality he has no right to represent them as such. Thus, when the plaintiff owned nearly all the coal lands in Radstock parish, and sold it herself as the product of the "Radstock Collieries;" and the defendants, who had previously been coal merchants in Radstock, under the title of the Radstock Coal Company, bought a colliery outside of that parish, which nevertheless produced the same grade of coal, known to the trade as Radstock coal, and began to sell it under the name of "Radstock Colliery Proprietors, &c.," they were enjoined from using that name until they should own a colliery in Radstock, or secure the right to handle coal mined in the parish: *Braham v. Beachim*, 7 Ch. D. 848. So, where coal from the Lochgelly collieries had been known for many years as "Lochgelly Coal," and was the only coal so known in the market, though a seam known as the Lochgelly splint seam extended under other estates as well, the lessees of the mineral rights of an adjoining estate were enjoined from advertising their coal as Lochgelly Splint Coal, though the name was true enough, and were ordered to advertise it only as Lumphinnans Splint Coal, Lochgelly seam (presumably to avoid any possible risk of deception): *Lochgelly Iron & Coal Co. v. Christie*, 6 Ct. of Session Cas. (4th Ser.) 482. This case goes farther than any other on the subject, but no one can deny that it did exact justice, with a more scrupulous regard than usual for the rights of the parties.

VI. Even when the goods are manufactured or produced at the place in question, if the name of the place is used fraudulently, or if the manufactory has been located with a view to obtaining the advantage of the name to the detriment of the other, the use of the name will be enjoined. In *Seixo v. Provezende*, 1 L. R. Ch. 192, the name of a district in Spain had long been used to denote the wines grown on one estate in that district; and it was ruled that the name could not be applied to wines from another estate of the same district, so as to mislead the purchasers. In *Wotherspoon v. Currie*,

5 L. R. H. L. 508, the plaintiff, who had originally carried on the manufacture of "Glenfield" starch at Glenfield, a little place of some sixty inhabitants, had removed his factory, retaining the name. The defendant had purchased a small lot at Glenfield, and carried on the manufacture of starch there, also using the name "Glenfield" to denote his starch. But, in view of the fact that the whole scheme was intended to induce people to believe that the defendant's starch was the plaintiff's, an injunction against the use of the name was held proper.

So, in *Thompson v. Montgomery*, 41 Ch. D. 35, the plaintiffs below and their predecessors had carried on a brewery in Stone (a town of Staffordshire of about six thousand inhabitants) since 1780, using the name "Stone Ales" to designate their product. The defendant, who had previously sold their product, put up a brewery at Stone, and used the word "Stone" in connection with liquor of his own manufacture, with a view, in the opinion of the trial judge, to lead the public to the belief that the ales he was then selling were those of the former firm. An injunction was accordingly granted, and affirmed on appeal. The case was then carried to the House of Lords, and there the decision was reaffirmed, though there was a doubt in the minds of some of the Lords as to the question of the use of the name "Stone:" *Montgomery v. Thompson* [1891], App. Cas. 217. This precise question has not yet risen in the United States; but it is to be hoped that when it does it will be decided in accordance with the just doctrine laid down above.

VII. There is another class of cases to which the foregoing reasoning applies with special force—where the goods to which the trade-name is attached are the products of only the one locality, and the plaintiff has the exclusive right to manufacture or deal there; or where the name of the locality is an arbitrary and fanciful one, as that of a mineral spring. In these cases there is every reason for holding that he has an exclusive right to the name of the locality as a trade-name. "A trade-mark may be a name adopted and used by a merchant or dealer, in order to designate the goods that he sells,

and distinguish them from those sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from the celebrity of his wares, or a reputation for superior skill, industry, or enterprise, in handling the articles put on the market. Any name may be so used that he may deem appropriate, as designating the true origin or ownership of the article to which it is affixed, though he may not appropriate a name indicative of the quality of his goods, which others may employ with equal truth for the same purpose. There is no conceivable reason why the name of a place may not be selected as a trade-mark, or a natural product of a spring be the subject of the protection afforded by it:" *Parkland Hills Blue Lick Water Co. v. Hawkins*, the principal case (Ky.), 26 S. W. Rep. 389. Accordingly the name Congress: *Congress Spring Co. v. High Rock Spring Co.*, 45 N. Y. 291; aff. S. C., 10 Abb. Pr. N. S. (N. Y.) 348; *Bethesda: Dunbar v. Glenn*, 42 Wis. 118; and *Blue Lick: Parkland Hills Blue Lick Water Co. v. Hawkins*, *supra*, have been held valid trade-names, and protection granted against others who attempted to use them, to the injury of the owners of the springs. In these cases, as in the "Worcestershire Sauce" case; *Lea v. Wolff*, 1 Thomp. & C., (N. Y.) 626; S. C., 46 How. Pr. (N. Y.) 157; 15 Abb. Pr. N. S. 1. And the "Stone Ales" case: *Thompson v. Montgomery*, 41 Ch. D. 35; *Montgomery v. Thompson* [1891], App. Cas. 217; the use of the place name has become secondary, and denotes the product itself, rather than the place of its production.

VIII. But while the name of a place may not be used singly as a trade-name, to the exclusion of others doing business there, it may be so used in connection with other words, either the name of the dealer or manufacturer: *Candee, Swan & Co. v. Deere*, 54 Ill. 439; or an arbitrary word or combination of words, as "Maryland Club:" *Cahn v. Göttshalk*, 2 N. Y. Suppl. 13. And in the same way an arbitrary use of a geographical term, to denote an article that is not in reality, nor in the nature of things could be manufactured there and sold at the place of sale, will make it a valid trade-name, as

“Vienna” bread: *Fleishmann v. Schuckmann*, 62 How. (N. Y.) Pr. 92.

IX. The results of the preceding discussion may be thus summarized: 1. A geographical term cannot be used as a trade-name to the exclusion of others doing business in the same place, and using it in good faith to designate the place of manufacture of their goods or their place of business. 2. But it may be so used as against any one who attempts to make a fraudulent use of it to the injury of the first user, whether he be an outsider or be engaged in business at the place in question. 3. When the name of the place has become so associated with the product as to lose its local force and acquire a secondary meaning denoting the special product, it will be considered a valid trade-name. 4. When so associated with other words or combinations of words, as to acquire a fanciful or arbitrary meaning, it is a good trade-name. 5. When used arbitrarily, without any possible reference to locality, it is also a good trade-name.

R. D. S.