

to state mental hospitals, in which case the State will be required to support them.<sup>11</sup>

The result could have been reached on a narrower ground and there is language in the opinion which supports that narrower holding notwithstanding the *Hawley* extension. Statutes requiring relatives to support adult indigent persons and adult indigent persons in mental hospitals have been generally upheld against constitutional attacks on various grounds.<sup>12</sup> The general argument made in support of the statute under attack is that there is a moral obligation on the relative and the statute merely turns this moral obligation into a legal one. It follows that the moral obligation argument can be used to meet the rational basis test for classification under an equal protection clause of the particular constitution in question.<sup>13</sup> However, there is no moral obligation to support an adult relative who has assets of his own with which to draw his support. Section 6650 of the California Welfare and Institutions Code imposes joint and several liability and the fact the patient has assets of his own becomes completely immaterial.<sup>14</sup> Under a narrower holding the Court in the *Kirchner* case could have stated that when the patient has assets of his own with which to provide his support, there is no rational basis for taxing a relative for the cost of care and support.<sup>15</sup>

<sup>11</sup> CAL. WELFARE & INST'NS CODE ANN. § 2576 (West 1956) states: "All aid rendered by the county under this chapter shall be a charge against the spouse, parent and adult child of the recipient thereof and the county rendering aid shall be entitled to reimbursement thereof." CAL. CIVIL CODE § 206 (West 1954) provides: "It is the duty of the father, the mother, and the children of any poor person who is unable to maintain himself by work, to maintain such person to the extent of their ability." See Comment, 14 So. CAL. L. REV. 481 (1941), and *San Bernardino County v. Simmons*, 46 Cal. 2d 394, 296 P.2d 329 (1956). The California court, in *Kirchner*, did not state whether the cost of certain items such as meals may be charged to the relative of the patient. In *Kough v. Hohler*, 413 Ill. 409, 109 N.E.2d 204 (1952), that court held the state need not concern itself with the actual costs of caring for the particular patient, but may assess a per capita share of the costs of operating the institution against the relatives. For an annotation on "Labor or services performed by one while inmate of a government institution as basis of deduction or setoff in respect of the liability of his estate or his relatives", see 114 A.L.R. 981 (1938).

<sup>12</sup> Attacks based on denial of Equal Protection under the Fourteenth Amendment were unsuccessful in *Kough v. Hohler*, *supra*, note 11, which was followed in *Department of Public Welfare v. Hass*, 15 Ill. 2d 2044, 154 N.E.2d 265 (1958). Attacks based on other constitutional grounds have failed, in *People v. Hill*, 163 Ill. 186, 46 N.E.796 (1896); *State v. Bateman*, 110 Kan. 546, 204 Pac. 682 (1922), and *Mallatt v. Luhn*, 206 Ore. 678, 294 P.2d 871 (1956). See also 29 AM. JUR., *Insane Persons* § 59 (1960); Annot., 48 A.L.R. 733 (1927); Annot., 4 A.L.R. 1109 (1919). One case, *Baldwin v. Douglas County*, 108 Neb. 816, 55 N.W. 875 (1893), has held such a statute unconstitutional, on a double taxation theory, where the action was against the husband for costs of care given his insane wife. The *Baldwin* decision was later expressly overruled, in *State v. Heupel*, 114 Neb. 797, 210 N.W. 275 (1926), although this action was clearly dictum since the suit was against the estate of the incompetent rather than against some relative of the incompetent.

<sup>13</sup> "The [constitutional provision for the] equal protection of laws requires laws of like application to all similarly situated, . . . [but] the legislature is permitted to make a reasonable classification and before a court can interfere with the exercise of its judgment it must be able to say 'that there is no fair reason for the law that would require with equal force its extension to others whom it leaves untouched'." *Barrett v. Indiana*, 229 U.S. 26, 29-30 (1913).

<sup>14</sup> See note 4, *supra*.

<sup>15</sup> The court commented on the fact that although the statute evidences concern that the committed patient shall not become a burden on the community in the

Iowa has a statute which gives the State the right to assess the cost of supporting inmates of state mental institutions against the relatives of such inmates.<sup>16</sup> The original statute had been construed to impose liability upon the relative only when the inmate had not the means for his support.<sup>17</sup> After the 1939 amendment, the statute appears to impose the same liability that the California statute imposed prior to the Kirchner case. No Iowa case has specifically ruled on the statute's constitutionality since the 1939 amendment. In the most recent Iowa case involving the statute,<sup>18</sup> the Court held that insane parents were liable for the support of a blind, insane adult son in a state mental hospital. There was no indication that the son had assets of his own with which to provide his support and the constitutional issue was not discussed. If even the narrowest interpretation of the California view as to the unconstitutionality of its statute should be persuasive to the Iowa Court, the Iowa statute may be unconstitutional whether the patient is in fact indigent or not, because the statute fails by its terms to limit the liability of relatives to support and care of indigent patients.

JOHN W. HERRON (January, 1966)

**TRADE MARKS AND TRADE NAMES**—Can an individual be enjoined from the use of his own name in his own business operations, where the same or a similar name has been used as a trade name by another for many years?

Plaintiff corporation, Max Factor of Hollywood, sought to enjoin defendant, Max Factor, from the use of the name "Max Factor" in connection with the sale of hosiery. Plaintiff manufactures and sells cosmetics, and has spent some \$31,000,000 in the last five years advertising its products. Plaintiff has not and does not now manufacture women's hosiery. Defendant's name is, and since birth has been, Max Factor. He is sole owner of the business "Max Factor of Beverly Hills", which distributes women's hosiery. Evidence suggested that he may have represented to his customers that he was Max Factor, Jr., or the nephew of Max Factor, or that the "Max Factor people" had investigated and approved his product. *Held*, injunction granted. Applying 15 U.S.C. § 1114 (1958), which provides substantially that it is a violation to use in commerce a reproduction, copy or colorable imitation of a registered trademark, without the consent of the registrant, in connection with the sale of goods in a manner which is likely to deceive,

event of his discharge from the hospital, no provisions were made for similar protection for the relative's assets. In addition, the court seemed displeased with the fact that § 6550 by its terms imposes absolute liability upon the servient relative, and does not give him any right to recoup from the assets of the patient.

<sup>16</sup> IOWA CODE § 230.15 (1962): "Mentally ill persons and persons legally liable for their support shall remain liable for the support of such mentally ill. Persons legally liable for the support of a mentally ill or mentally retarded person shall include the spouse, father, mother, and adult children of such mentally ill or mentally retarded person, and any person, firm or corporation bound by contract hereafter made for support . . ."

<sup>17</sup> *Lyons v. Lyons*, 195 Iowa 1183, 193 N.W. 444 (1923) (stepmother and half-brother of adult of unsound mind under no legal obligation for his support when he has property); 1930 OP. ATTY. GEN. 356. The 1939 amendment added the second sentence of the section, quoted in note 16, *supra*.

<sup>18</sup> *Michel v. State Board of Social Welfare*, 245 Iowa 961, 65 N.W.2d 89 (1954).

the court found that defendant intended to deceive and did deceive the buying public, and further found that plaintiff's name had acquired a secondary meaning, through long and continued use in connection with beauty aids, so was entitled to protection. *Max Factor & Co. v. Max Factor*, 226 F. Supp. 120 (S.D. Cal. 1963).

This case is unique in that it embodies all of the elements generally found by the courts to justify an injunction preventing an individual from using his own name in his own business. Those elements are: (1) fraud;<sup>1</sup> (2) intent to deceive;<sup>2</sup> (3) deceit in fact;<sup>3</sup> (4) the concept of secondary meaning;<sup>4</sup> and (5) registration of the tradename in question.<sup>5</sup>

The earliest case to recognize that it might be possible for someone to use his own name fraudulently was *Burgess v. Burgess*,<sup>6</sup> decided in 1853. The defendant in that case was not enjoined, but was ordered to refrain from causing unnecessary confusion by using his former address.

The next step taken by courts was to find that a newcomer has a "duty to distinguish" his products from those of an older, established firm of the same name.<sup>7</sup> Modern decisions often use this device to avoid the necessity of totally enjoining someone from the use of his own name.<sup>8</sup> Such phrases as "not connected in any way with"<sup>9</sup> are often required by decisions, often

<sup>1</sup> *J. & P. Coats v. John Coates Thread Co.*, 135 Fed. 177 (C.C.D. Minn. 1905); *Visser v. Macres*, 214 Cal. App. 2d 249, 29 Cal. Rptr. 367 (1963); *May v. May*, 45 So. 2d 494 (Fla. 1950); *Chas. S. Higgins Co v. Higgins Soap Co.*, 144 N.Y. 462, 39 N.E. 490 (1895); *Knox Hat Co. v. Self-Service Millinery Stores*, 138 Misc. 426, 245 N.Y. Supp. 11 (Sup. Ct. 1929), *aff'd* without opinion, 227 App. Div. 716, 236 N.Y. Supp. 832 (1st Dept. 1929), final decree in 138 Misc. 124, 245 N.Y. Supp. 124 (Sup. Ct. 1930).

<sup>2</sup> *Royal Baking Powder Co v. Royal*, 122 Fed. 337 (6th Cir. 1903); *Petition of Swedish Produce Co.*, 84 F. Supp. 600 (N.D. Ill. 1949); *Gamlen Chemical Co. v. Gamlen*, 79 F. Supp. 622 (W.D. Pa. 1948); *Schwarz v. Schwarz*, 93 Cal. App. 252 269 Pac. 755 (1928); *Flora v. Flora* 72 N.Y.S.2d 879 (Sup. Ct. 1947); *Montalti v. Montellone Shirt Co.*, 141 Okla. 58, 283 Pac. 1013 (1930).

<sup>3</sup> *Winfield v. Charles*, 77 Cal. App. 2d 64, 175 P.2d 69 (1946); *Burke v. Cassin*, 45 Cal. 467 (1873); *Macfadden Publications v. B. L. McFadden, Inc.*, 224 App. Div. 374, 231 N.Y. Supp. 185 (1st Dept. 1928); *P. J. Tierney Sons v. Tierney Bros.*, 130 Misc. 428, 224 N.Y. Supp. 144 (Sup. Ct. 1927); *Madison v. La Sene*, 44 Wash. 2d 546, 268 P.2d 1006, 44 A.L.R.2d 1145 (1954).

<sup>4</sup> *Chickering v. Chickering & Sons*, 215 Fed. 490 (7th Cir. 1914).

<sup>5</sup> *Henderson v. Peter Henderson & Co.*, 9 F.2d 787 (7th Cir. 1925).

<sup>6</sup> *De G. M. & G.* 896, 43 Eng. Rep. 351, 25 Eng. Rul. Cas. 186 (Ch. 1853).

<sup>7</sup> *Donnell v. Herring-Hall-Marvin Safe Co.*, 208 U.S. 267 (1908); *Coty v. Parfums De Grande Luxe*, 298 Fed. 865 (2d Cir. 1924); *Goldwyn Pictures Corp. v. Goldwyn*, 296 Fed. 391 (2d Cir. 1924); *Allegretti Chocolate Cream Co. v. Keller*, 85 Fed. 643 (C.C. S.D. N.Y. 1898); *Deister Concentrator Co v. Deister Machine Co.*, 63 Ind. App. 422, 112 N.E. 906 (1916); *Gordon Hollow Blast Grate Co. v. Gordon*, 142 Mich. 488, 105 N.W. 1118 (1905); *Bernhard v. Bernhard*, 156 App. Div. 739, 142 N.Y. Supp. 94 (1st Dept. 1913).

<sup>8</sup> *Fuller Products Co. v. Fuller Brush Co.*, 299 F.2d 772 (7th Cir. 1962); *Industrial Photo Service v. Kelley*, 198 Cal. App. 2d 665, 17 Cal. Rptr. 907 (1962); *Harvey Machine Co. v. Harvey Aluminum Corp.*, 9 Misc. 2d 1078, 175 N.Y.S.2d 288 (Sup. Ct. 1957); *Friedman Transfer & Constr. Co. v. Friedman*, 76 Ohio L. Abs. 486, 146 N.E.2d 886 (Ohio App. 1956).

<sup>9</sup> *W. R. Speare Co. v. Speare*, 265 Fed. 876 (D.C. Cir. 1920); *Stark v. Stark Bros. Nurseries & Orchards Co.*, 257 Fed. 9 (8th Cir. 1919); *J. F. Rowley Co v. Rowley*, 154 Fed. 744 (C.C. W.D. Pa. 1907); *Swift & Co. v. T. W. Swift & Co.*, 124 F. Supp. 434 (M.D. N.C. 1954); *Meriden Britannia Co. v. Parker*, 39 Conn. 450 (1872); *Nestor Johnson Mfg. Co. v. Alfred Johnson Skate Co.*, 313 Ill. 106, 144 N.E. 787 (1924); *Neubert v. Neubert*, 163 Md. 172, 161 Atl. 16 (1932).

with an order to use the full name rather than only that part of it which resembles that of the established business.<sup>10</sup>

For a number of years, however, some courts continued to hold that damage from the use of a similar name by another caused to a firm using a personal name as a trademark was "damnum absque injuria."<sup>11</sup> Contract limitations, estoppel, and fraud, were the only recognized exceptions to this rule,<sup>12</sup> and the proof required to establish these exceptions was most strict.<sup>13</sup> The reluctance to substantially restrict an individual's use of his name in his business, or to deprive him of that right, began to recede in the early 1900's. At that time a California court said that: "while a person undoubtedly has the right to engage in business in his own name, he will not be allowed to resort to any artifice or contrivance in the use of that name for the purpose of deceiving . . . ."<sup>14</sup> In cases since that time, lettering,<sup>15</sup> labels,<sup>16</sup> packaging,<sup>17</sup> even trucks used for delivery,<sup>18</sup> have been found to so imitate those of the older firm that the newer firm is held to have intentionally caused confusion and to have deceived the public.<sup>19</sup> As in most areas of the law, bad faith is a strong factor against the offending party, and intent to deceive was the first clearly delineated ground for enjoining the use of a personal name as a tradename.<sup>20</sup>

<sup>10</sup> Horlick's Malted Milk Co. v. Horluck's Inc., 51 F.2d 357 (W.D. Wash. 1931); Henderson v. Henderson Funeral Home Corp., 320 S.W.2d 113 (Ky. 1959); A. Hollander & Son v. Jos. Hollander, Inc., 118 N.J. Eq. 262, 178 Atl. 786 (Ct. Err. & App. 1935); World's Dispensary Medical Ass'n v. Pierce, 203 N.Y. 419, 96 N.E. 738 (1911); Clark v. Clark, 25 Barb. 76 (N.Y. 1857); Fite v. Dorman, 57 S.W. 129 (Tenn. 1900).

<sup>11</sup> Brown Chemical Co. v. Meyer, 139 U.S. 540 (1891); M. B. Fahey Tobacco Co. v. Senior 247 Fed. 809 (E.D. Pa. 1917); W. F. & John Barnes Co. v. Vanduyck-Churchill Co., 207 Fed 855 (S.D. N.Y. 1913); Yale & Towne Mfg. Co. v. Rose, 120 Conn. 373, 181 Atl. 8 (1935); Brown Garage Co v. Brown Auto & Supply Co., 196 Iowa 823, 195 N.W. 514 (1923); Hilton v. Hilton, 89 N.J. Eq. 182, 104 Atl. 375 (1918); Bingham School v. Gray, 122 N.C. 699, 30 S.E. 304 (1898); Goidl v. Advance Neckwear, 132 Tex. 308, 123 S.W.2d 865 (1939).

<sup>12</sup> Carter v. Carter Elec. Co., 156 Ga. 297, 119 S.E. 737 (1923); Young & Chaffee Furniture Co. v. Chaffee Bros. Furniture Co., 204 Mich. 293, 170 N.W. 48 (1918).

<sup>13</sup> R. W. Rogers Co. v. Wm. Rogers Mfg. Co., 70 Fed. 1017 (2d Cir. 1895); Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494, 30 N.E. 339 (1892); Williams v. Farrand, 88 Mich. 473, 50 N.W. 446 (1891); Harson v. Halkyard, 22 R.I. 102, 46 Atl. 271 (1900); F. T. Blanchard Co. v. Simon, 104 Va. 209, 51 S.E. (1905); Wright Restaurant Co v. Wright, 74 Wash. 230, 133 Pac. 464 (1913).

<sup>14</sup> Morton v. Morton, 148 Cal. 142, 146, 82 Pac. 664, 666 (1905).

<sup>15</sup> R. B. Davis Co v. Davis, 8 F. Supp. 905 (E.D. N.Y. 1934); E. H. Taylor, Jr., & Sons Co. v. Taylor, 124 Ky. 173, 85 S.W. 1085 (1905); Devlin v. Devlin, 69 N.Y. 212 (1877); Lerner Stores Corp. v. Lerner Ladies' Apparel Shop, 218 App. Div. 427, 218 N.Y. Supp. 442 (1st Dept. 1926).

<sup>16</sup> Thaddeus Davids Co v. Davids Mfg. Co., 233 U.S. 461 (1914) (ink labels); Drake Medicine Co. v. Glessner, 68 Ohio St. 337, 67 N.E. 722 (1903) (cough medicine).

<sup>17</sup> El Modelo Cigar Mfg Co. v. Gato, 25 Fla. 886, 7 So. 23 (1890) (cigar boxes); Schinasi v. Schinasi, 169 App. Div. 887, 155 N.Y. Supp. 867 (1st Dept. 1915) (cigarette packages); Hires v. Hires, 6 Pa. Dist. Rep. 285 (C.P. 1897), appeal dismissed, 182 Pa. 346, 37 Atl. 1117 (1897) (beverage bottles).

<sup>18</sup> Carter Transfer & Storage Co. v. Carter, 106 Neb. 531, 184 N.W. 113 (1921).

<sup>19</sup> Ball v. Best, 135 Fed. 434 (C.C. N.D. Ill. 1905); Sullivan v. Ed Sullivan Radio & T.V., Inc., 1 App. Div. 2d 609, 152 N.Y.S.2d 227 (1st Dept. 1956).

<sup>20</sup> Sykes v. Sykes, 3 Barn. & C. 541, 107 Eng. Rep. 834 (K.B. 1824); Shaver v. Shaver, 54 Iowa 208, 6 N.W. 188 (1880); Robinson v. Storm, 103 Tenn. 40, 52 S.W. 880 (1899).

After this trend began, the United States Supreme Court held that even though no subjective intent is found, the mere use of a personal name in connection with a particular product may work a fraud on the public, and justify injunction.<sup>21</sup> Here, it was the consequence of the act, rather than the intent of the actor, which was controlling. This case also slightly broadened the very old "secondary meaning" concept, which encompasses both fraud and intent to deceive.<sup>22</sup> As the Court said, in *International Silver Co. v. Rodgers*:

While a personal name may not constitute a technical trademark, yet where the article has come to be known by that personal name, one may not use that name, even though it be his own, to palm off his goods as the goods of another who has first adopted it, and by which appellation the goods have come to be known, when the use of his own name for such a purpose works a fraud.<sup>23</sup>

Registration of a trademark or a trade name, though it may make for a stronger case, is not necessary.<sup>24</sup> Even those cases where the name is registered are generally decided on the basis of intent to deceive or secondary meaning concepts.<sup>25</sup>

Obviously this is an old problem, and one that courts have dealt with in a variety of ways. Yet, from the oldest to the latest case, the one here reviewed, the controlling principles are those of old-fashioned honesty. One may not reap where another has sown. One who has made a name valuable may not be deprived of the fruits of his labor by another who, by chance, has the same or a similar name.<sup>26</sup>

ROXANNE B. CONLIN (June, 1966)

<sup>21</sup> *Herring-Hall-Marvin Safe Co. v. Hall's Safe Co.*, 208 U.S. 554 (1908). *Accord*: *Lane Bryant, Inc. v. Maternity Lane, Ltd., of Calif.*, 173 F.2d 559 (9th Cir. 1949); *J. B. Liebman & Co. v. Liebman*, 135 N.J. Eq. 288, 38 A.2d 187 (Ch. 1944).

<sup>22</sup> *Cook Chemical Co. v. Cook Paint & Varnish Co.*, 185 F.2d 365 (8th Cir. 1950); *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. 841 (7th Cir. 1894); *J. A. Dougherty's Sons v. Dougherty*, 36 F. Supp. 149 (E.D. Pa. 1940); *Tanqueray Gordon & Co. v. Gordon*, 10 F. Supp. 852 (D. N.J. 1935); *Vick Chemical Co. v. Vick Medicine Co.*, 8 F.2d 49 (S.D. Ga. 1925); *Williams v. Brooks*, 50 Conn. 278 (1882); *Hunt Potato Chip Co v. Hunt*, 340 Mass. 371, 164 N.E.2d 335 (1960); *Compania "Ron Bacardi" S. A. v. American Bacardi Rum Corp.*, 63 N.Y.S.2d 610 (Sup. Ct. 1934); *Charles J. Donnelly, Inc. v. Donnelly Bros.*, 191 A.2d 143 (R.I.1963).

<sup>23</sup> 72 N.J. Eq. 933, 936, 67 Atl. 105, 106 (1907).

<sup>24</sup> *Stout v. Laws*, 37 Hawaii 382 (1946).

<sup>25</sup> *American Trading Co. v. H. E. Heacock Co.*, 285 U.S. 247 (1932); *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118 (1905); *Champion Spark Plug Co. v. Champion*, 23 F. Supp. 638 (E.D. Mich. 1938).

<sup>26</sup> *J. I. Case Plow Works v. J. I. Case Threshing Machine Co.*, 162 Wis. 185, 155 N.W. 128 (1916).

