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UNFAIR TRADE-RIGHT OF PRIVACY-RIGHT OF MANUFACTURER WHO HAS CONTRACTED FOR USE OF CELEBRITY'S NAME TO INJUNCTION AGAINST COMPETITOR USING SUCH NAME

UNFAIR TRADE—RIGHT OF PRIVACY—RIGHT OF MANUFACTURER WHO HAS CONTRACTED FOR USE OF CELEBRITY'S NAME TO INJUNCTION AGAINST COMPETITOR USING SUCH NAME—Plaintiff, a baseball bat manufacturer, had obtained by contract with famous ball players a grant of the exclusive right to use their autographs on the style bats which the plaintiff company had developed for them. Defendant, a competing bat manufacturer, made bats in these same unpatented shapes and to designate the style of the bats placed the respective players' surnames on them in block letters. Plaintiff seeks to enjoin this practice of the defendant on the theory: (1) of unfair competition, and (2) of protection of the property right which the ball players had in the use of their names. *Held*, injunction refused, since there was no evidence that defendant's bats were being passed off as plaintiff's bats, and since the ball players had no property right in their names which could have been passed to plaintiff by assignment. However, since the evidence tended to show that defendant's use of the names might induce some people to buy defendant's bats thinking the players were using bats made by defendant, the defendant was ordered to put the word "style" after the players' surnames in the same size type. *Hanna Mfg. Co. v. Hillerich & Bradsby Co.*, (C. C. A. 5th, 1935) 78 F. (2d) 763.

The right of a person to prohibit others from using his name or likeness publicly without his consent depends on the willingness of courts to recognize the relatively new "right of privacy,"[1] or upon an extension of the law of unfair competition. When injunctive relief is sought, the situation is complicated by the traditional requirement in nineteenth century cases of some "property" in the plaintiff as a basis for equitable relief.[2] It has usually been held that a person has no abstract right in a name which entitles him to an injunction against its use by another.[3] Where such relief has been given, the use of the name has been associated with other elements which supply an independent basis for equitable

[1] See Warren and Brandeis, "The Right to Privacy," 4 HARV. L. REV. 193 (1890), which first suggested and formulated this theory. See also annotations in 31 L. R. A. 283 (1896); 24 L. R. A. (N. S.) 991 (1910); 34 L. R. A. (N. S.) 1137 (1911); and cases collected in 54 C. J. 816 (1931); HARPER, A TREATISE ON THE LAW OF TORTS, § 277 (1933).

For discussion of the right see 43 HARV. L. REV. 297 (1929); Green, "The Right of Privacy," 27 ILL. L. REV. 237 (1932); 81 UNIV. PA. L. REV. 324 (1933).

[2] See 37 L. R. A. 783 (1897); 14 A. L. R. 295 (1921). The requirement of a property right seems to have originated in misunderstanding Lord Eldon's decision in Gee v. Pritchard, 2 Swans. 402, 36 Eng. Rep. 670 (1818). See analysis of this case in 25 MICH. L. REV. 889 (1927).

[3] Vassar College v. Loose-Wiles Biscuit Co., (C. C. Mo. 1912) 197 F. 982; Olin v. Bate, 98 Ill. 53, 38 Am. Rep. 78 (1880); Roberson v. Rochester Folding-Box Co., 171 N. Y. 538, 64 N. E. 442 (1902); Clark v. Freeman, 11 Beav. 112, 50 Eng. Rep. 759 (1848).

But see dictum in Schuyler v. Curtis, 147 N. Y. 434, 42 N. E. 22 (1895), to the effect that if a proposed bust furnished sufficient mental distress to relatives of the subject, injunction would have been granted, the right to privacy not being regarded as merely a personal right. In Munden v. Harris, 153 Mo. App. 652, 134 S. W. 1076 (1911), though the suit was at law for damages, the court said that the right to privacy was a property right which equity would protect by injunctive relief. See also State

relief, such as protection of good will in trade names,[4] defamation where the use of the name is the wrongful act,[5] and possible exposure of plaintiff to financial loss.[6] Even if the baseball players in the principal case were held to be entitled to prevent unauthorized use of their names, the question would still remain whether an assignment could transfer their rights to the plaintiff.[7] This question the court answers in the negative, concluding that plaintiff's right must be confined to the prevention of unfair competition. Proceeding on this theory, the court inquired whether or not plaintiff's custom, acquired by prior use of the names, has been injured by the later use of the names by defendant. The court refused injunction on these grounds on well-established authority,[8] since no "passing off" or confusion of the source of the goods was proved. When, as here, the evidence tends to show that the defendant's use of the name might divert trade otherwise going to the plaintiff, the qualified injunction, in which defendant is made to distinguish himself, is freely given, though its use is of doubtful efficacy.[9] The fact that baseball bat manufacturers are willing to pay for the right to use the players' names

ex rel. La Follette v. Hinkle, 131 Wash. 86, 229 P. 317 (1924), where unauthorized use of a name for a political party was enjoined without discussion of authorities.

For discussion of problem see 11 MICH. L. REV. 391 (1913).

[4] Waterman Co. v. Modern Pen Co., 235 U. S. 88, 35 S. Ct. 91 (1914); Stix, Baer, & Fuller Dry Goods Co. v. American Piano Co., (C. C. A. 8th, 1913) 211 F. 271; Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 S. Ct. 625 (1890); De Nobili Cigar Co. v. Nobile Cigar Co., (C. C. A. 1st, 1932) 56 F. (2d) 324, noted in 31 MICH. L. REV. 292 (1932). Vogue Co. v. Thompson-Hudson Co., (C. C. A. 6th, 1924) 300 F. 509; 25 COL. L. REV. 199 (1925); 38 HARV. L. REV. 370 (1925).

[5] Peck v. Tribune Co., 214 U. S. 185, 29 S. Ct. 554 (1908).

[6] In the following cases the court was willing to grant injunctive relief, giving as a basis the prevention of possible financial loss to the plaintiff. Vanderbilt v. Mitchell, 72 N. J. Eq. 910, 67 A. 97 (1907); Edison v. Edison Polyform & Mfg. Co., 73 N. J. Eq. 136, 67 A. 392 (1907); Routh v. Webster, 10 Beav. 561, 50 Eng. Rep. 698 (1847). It may be doubted, however, whether this element was decisive, as the courts in question declared it to be.

[7] For discussion of the doctrine that trade marks cannot be assigned in gross, see Grismore, "The Assignment of Trade Marks and Trade Names," 30 MICH. L. REV. 489 (1932).

[8] Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118, 25 S. Ct. 609 (1904). But see McLean v. Fleming, 96 U. S. 245 (1877).

NIMS, UNFAIR COMPETITION, 3d ed., c. 2 (1929), speaking of the basis of the action for unfair competition, says at p. 36: "It is no longer true that there is no cause of action unless passing off is present. Passing off is but one of various practices that are actionable as unfair competition."

See also Handler and Pickett, "Trade-Marks and Trade Names—An Analysis and Synthesis," 30 COL. L. REV. 759 (1930).

[9] Walter Baker & Co. v. Slack, (C. C. A. 7th, 1904) 130 F. 514; Walter Baker & Co. v. Gray, (C. C. A. 8th, 1911) 192 F. 921; International Silver Co. v. Rodgers Bros. Cutlery Co., (C. C. Mich. 1905) 136 F. 1019; Neubert v. Neubert, 163 Md. 172, 161 A. 16 (1932); Horlick's Malted Milk Corp. v. Horluck's, Inc., (C. C. A. 9th, 1932) 59 F. (2d) 13; Waterman Co. v. Modern Pen Co., 235 U. S. 88, 35 S. Ct. 91 (1914).

The ineffectiveness of the qualified injunction in personal name cases has been frequently pointed out. See NIMS, UNFAIR COMPETITION, 3d ed., 185-195 (1929).

shows that they as a class regard the right to use the names as having economic value. That fact might also be used to show that a rule of law prohibiting the unauthorized use of such names would not be out of accord with general business practices. But it cannot be used as a basis for such a rule without the use of circular reasoning, since they have paid for a thing of economic value only if the courts will protect the use of the names.[10] Whether or not the courts should create this new economic wealth or "property" is a serious question of social and economic policy. Even though some legal protection might be given the original "owner" of the name, a court can with perfect consistency refuse to recognize an assignment to another as an effective substitution of the assignee in the place of the assignor. R. F. K.

[10] For discussion of the circularity of legal reasoning found in the field of unfair competition, see Cohen, "Transcendental Nonsense and the Functional Approach," 35 COL. L. REV. 809 at 814 (1935).