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## TRADE MARKS- USE OF SAME MARK ON DISSIMILAR GOODS

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TRADE MARKS — USE OF SAME MARK ON DISSIMILAR GOODS — The defendant began to manufacture and sell mechanic's hand soap, adopting the word "Par" as a trade-mark. Within the same year the plaintiff corporation, ignorant of the defendant's prior use of the word "Par," adopted the same trade-mark for its granulated laundry soap. Thereafter the defendant, assuming the name "Par Soap Co.," began to market a granulated laundry soap under the same trade-mark, "Par." Each party prayed for an injunction against infringement by the other. *Held*, the defendant acquired a common-law trade-mark as applied to mechanics' hand soap but not the right to extend it to the whole field of soap products. His use of the word on granulated laundry soap infringed the rights of the plaintiff. *Treager v. Gordon-Allen, Ltd.*, (C. C. A. 9th, 1934) 71 F. (2d) 766.

Early courts offered protection to the original user of a mark or name upon certain goods on the theory that "a man is not to sell his own goods under the pretence that they are the goods of another man."<sup>1</sup> The owner of a trade-mark in reality does not have any rights in the name itself, but is entitled to protection only in connection with the articles upon which it is used.<sup>2</sup> To infringe upon the rights of the owner of a trade-mark, however, it is not necessary, according to the view generally accepted today, that the goods of another be identical with those of the owner, but it is enough if the goods are similar, so that they are within the same class.<sup>3</sup> The basic theory underlying this wider pro-

tection seems to be that the use of a trade-mark by another upon similar goods will confuse and deceive the public as to the source of the goods,<sup>4</sup> or that the owner is entitled to the exclusive use of his own trade-mark within the natural expansion of his business.<sup>5</sup> It has been held that goods are of the same class when an unscrupulous dealer would be readily able to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trade-mark.<sup>6</sup> The more extreme decisions, in extending the protection of the owner "outside the field of his own exploitation," seem to overrun the limits of a rational classification in an effort to prevent damage to the good will and reputation of the owner of the trade-mark.<sup>7</sup> The instant case, however, in making the distinction that a name of self-praise and of common usage entitles the owner to a narrower field of exclusiveness than a coined or fanciful name, is representative of a recently urged limitation on the scope of trade-mark protection.<sup>8</sup> But rights in a trade-mark are created by prior usage rather than invention,<sup>9</sup> and it would seem that the courts, in placing such a premium upon originality in the choice of a name, are sacrificing what they have hitherto deemed so important, namely, the good will and reputation of the owner.<sup>10</sup> The result reached in the principal case, however, seems just on its facts, since it appears that the defendant acted in bad faith in attempting to derive unearned benefits from the extensive advertising and selling campaign of the plaintiff.

C. P. H.

<sup>4</sup> *Coca-Cola Co. v. J. G. Butler & Sons*, (D. C. Ark. 1916) 229 Fed. 224; *Rupert, Inc. v. Knickerbocker Food Specialty Co.*, (D. C. N. Y. 1923) 295 Fed. 381; *Rosenberg Bros. & Co. v. Elliott*, (C. C. A. 3d, 1925) 7 F. (2d) 962; 10 N. Y. UNIV. L. Q. REV. 554 (1933).

<sup>5</sup> *Finchley v. Finchly Co.*, (D. C. Md. 1929) 40 F. (2d) 736.

<sup>6</sup> *Church & Dwight v. Russ*, (C. C. Ind. 1900) 99 Fed. 276; *Simplex Automobile Co. v. Kahnweiler*, 162 App. Div. 480, 147 N. Y. S. 617 (1914).

<sup>7</sup> *Yale Electric Corp. v. Robertson*, (C. C. A. 2d, 1928) 26 F. (2d) 972, noted 23 ILL. L. REV. 835 (1929); *Wall v. Rolls-Royce of America*, (C. C. A. 3d, 1925) 4 F. (2d) 333; *Vogue Co. v. Thompson-Hudson Co.*, (C. C. A. 6th, 1924) 300 Fed. 509; *Akron-Overland Tire Co. v. Willys-Overland Co.*, (C. C. A. 3d, 1921) 273 Fed. 674.

<sup>8</sup> *Pabst Brewing Co. v. Decatur Brewing Co.*, (C. C. A. 7th, 1922) 284 Fed. 110; *France Milling Co. v. Washburn-Crosby Co.*, (C. C. A. 2d, 1925) 7 F. (2d) 304; Schechter, "The Rational Basis of Trademark Protection," 40 HARV. L. REV. 813 at 826 (1927). Cf. *Victor Radio Corp. v. Radio-Victor Corp. of America*, 140 Misc. 198, 250 N. Y. S. 204 (1931).

<sup>9</sup> *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 14 Sup. Ct. 151 (1893); *Welsbach Light Co. v. Adam*, (C. C. N. Y. 1901) 107 Fed. 463; NIMS, UNFAIR COMPETITION AND TRADE-MARKS, 3d ed., sec. 214a (1929).

<sup>10</sup> *The Collins Co. v. Oliver Ames & Sons Corp.*, (C. C. N. Y. 1882) 18 Fed. 561; *Aunt Jemima Mills Co. v. Rigney & Co.*, (C. C. A. 2d, 1917) 247 Fed. 407; *Victor Radio Corp. v. Radio-Victor Corp. of America*, 140 Misc. 198, 250 N. Y. S. 204 (1931); Goble, "Where and What a Trade-Mark Protects," 22 ILL. L. REV. 379 (1927); NIMS, UNFAIR COMPETITION AND TRADE MARKS, 3rd ed., sec. 221 (1929); 35 YALE L. J. 115 (1925).