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Trademarks—Assignability—Necessity of Disclosure of Secret Process

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The contention of the defendant in the principal case is that since the statute abolishing tenancy by the curtesy gives the widower the same right in real estate as his wife would have had in his estate, and since the wife's right cannot be affected by a conveyance of the husband alone, R. S. Mo. (1929) sec. 318, it necessarily follows that the husband's right cannot be prejudiced by a conveyance of the wife alone. To hold otherwise would be to assert in the wife a greater estate in the husband's realty than he would have in the wife's realty. But the court held that the only effect of the statute was to change the character and quantum of interest a husband takes in the lands which his wife owned at the date of her death, and that it does not attempt to modify or take away the right given a married woman by the Married Woman's Act to dispose of the whole title to her separate real estate without joinder of her husband in the deed of conveyance. But the Married Woman's Act did not expressly give the right to the wife to convey her property without joinder. *Brook v. Barker*, above. The net effect, therefore, is that the decision in the principal case is reached by building an assumption on an assumption.

Kentucky, Iowa and Illinois have statutes similar to the one here in issue. *Combs v. Ezell* (Ky. 1930) 24 S. W. (2d) 301, holds that the husband's joinder is necessary, but the decision is predicated upon an express statute to that effect. Ky. Stat. (Carroll, 1922) sec. 2128. In Illinois, the issue is settled also by an additional statute requiring such joinder. R. S. Ill. (Cahill, 1929) c. 41 sec. 16. In Iowa the point does not seem to have been settled by an adjudicated case. H. K. M., '33.

TRADEMARKS—ASSIGNABILITY—NECESSITY OF DISCLOSURE OF SECRET PROCESS.—The question of whether the assignment of a trademark is valid when the secret process of manufacture is not also assigned was decided for the first time in this country in *Mulhens & Kropff, Inc. v. Ferd. Muelhens, Inc.* (C. C. A. 2, 1930) 43 F. (2d) 937, *rev'g* (D. C. S. D. N. Y. 1929) 38 F. (2d) 287; motion to make more specific denied (C. C. A. 2, 1931) 48 F. (2d) 206; *certiorari* denied (1931) 51 S. Ct. 84.

Kropff and Ferd. Muelhens had been partners in selling in this country products manufactured by Muelhens in Germany, in accordance with a secret recipe known only to Muelhens, and sold under the trademark "4711." A dissolution of the partnership was occasioned by the World War, and the Alien Property Custodian, under authority of the *Trading With the Enemy Act* [40 Stat. 411 (1917) 50 U. S. C. A. sec. 30, 6] sold the interest of Ferd. Muelhens to Kropff, who manufactured very similar products under the old name of Mulhens & Kropff, now a corporation, and sold them under the mark "4711" with the statement that they were made according to the secret process. After the War, Ferd. Muelhens, Inc., was organized as selling agent of the German house, and it, too, sold its products in this country under the mark "4711," advertising Mulhens & Kropff's claim to the formula to be false. In an action by Mulhens & Kropff, Inc.,

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to restrain the use of the mark, it was held by the Court of Appeals, reversing the District Court, that the assignment was not valid as to those products previously manufactured according to the secret recipe.

Courts have repeatedly held that a trademark is not assignable in gross. *Kidd v. Johnson* (1879) 100 U. S. 617; *Bulte v. Igleheart Bros.* (C. C. A. 7, 1905) 137 F. 492; *Spiegel v. Zuckerman* (D. C. S. D. N. Y. 1910) 175 F. 978. The reason is that a trademark has no existence apart from the business and good will to which it is appurtenant. *Kidd v. Johnson,* above; *Storm Waterproofing Corp. v. L. Sonneborn Sons, Inc.* (D. C. Del. 1929) 31 F. (2d) 992. The present case in effect extends the doctrine to hold that where a secret recipe has played an important part in building a business, the recipe is a necessary part of the good will. This is in line with an English decision in a very similar case. *Le Couturier v. Rey* (1910) A. C. 262.

In some instances the function of a trademark has been held to be that of identifying the origin or ownership or place of manufacture or sale of the product to which it is attached. *Hanover Mill Co. v. Metcalf* (1916) 240 U. S. 403. Apparently the District Court granted the injunction on this theory, stating that the petitioners were known as selling agents of "4711" products and that it was no deception for them to sell similar products under the mark so long as they abandoned false advertising. The Court of Appeals pointed out, however, that the mark indicated something more than place of origin. It indicated also manufacture according to the secret process. The use of the mark in this sense was barred to the petitioners. The recipe had not been passed to them. It was not part of the partnership assets, but belonged solely to the German house of Ferd. Muelhens, Inc. In deciding which meaning of the mark was the more significant, the court held that its use in the second sense would the more adequately protect the public from deception and insure its obtaining the product it thought it was buying. W. E. S., '33.

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