

Summer 1949

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Recommended Citation

(1949) "The Extension of Trade Name Protection to Non-Competitive Areas," *Indiana Law Journal*: Vol. 24 : Iss. 4 , Article 5.

Available at: <https://www.repository.law.indiana.edu/ilj/vol24/iss4/5>

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TRADE MARKS AND TRADE NAMES

THE EXTENSION OF TRADE NAME PROTECTION TO NON-COMPETITIVE AREAS

Triangle Publications held a registered trade-mark "Seventeen" under which it published a fashion magazine appealing to teen-age girls. Shortly after this name was registered, Rohrllich and others began marketing girdles under the trade-name "Miss Seventeen." Triangle Publications sought to enjoin the use of the word "Seventeen" and asked for an accounting, alleging both statutory trade-mark infringement and unfair competition. The federal district court enjoined the use of the word "Seventeen" on the ground that such use constituted unfair competition and allowed an accounting. In so ruling, the court found that "Seventeen" had acquired secondary meaning through Triangle's advertis-

43. "In the past generation and especially in a few Courts, this practical difference of effect is plainly apparent; for, under the guise of reasoning and interpretation, the privilege has by them, in a spirit of implicit favor, been so extended in application beyond its previous limits as almost to be incredible, certainly to defy common sense." 8 WIGMORE, EVIDENCE § 2251 (3d ed. 1940); See also 7 BENTHAM, RATIONALE OF JUDICIAL EVIDENCE 452 (Bowring ed. 1843); STEPHEN, HISTORY OF THE CRIMINAL LAW 342, 441, 535, 542, 565 (1883); Wigmore, *Nemo Tenetur Seipsum Prodere*, 5 HARV. L. REV. 71, 86 (1891).

44. See, Davis, *The Administrative Power of Investigation*, 56 YALE L. J. 1111 (1947).

45. 8 WIGMORE, EVIDENCE § 2251 (3d ed. 1940).

ing and publication and was thereby entitled to protection.¹ The Second Circuit Court of Appeals affirmed the injunction but denied the accounting since Triangle was unable to prove any damage. Judge Frank dissented. *Triangle Publications v. Rohrlisch*, 167 F.2d 969 (2d Cir. 1948).

This holding appears to be the second in which a federal court of appeals has granted trade-mark protection under the unfair competition doctrine because consumers may possibly believe that the trade-mark owner endorsed the product of the subsequent user.²

An appreciation of the function of the trade-mark is essential to an evaluation of the need for protection.³ The primary function of the mark is to identify a product and designate it as from a particular source.⁴ While serving this purpose the mark assumes secondary significance as a symbol

1. Judicial protection of a trade-mark is not dependent upon the fact of registration, for registration does not itself confer title upon the registrant if some other person by prior adoption and use has acquired a common law interest in the same mark. *Delbeck & Die, Societe A Responsibilite Limites v. Monica*, 10 F. Supp. 1013 (E. D. N. Y. 1935); *Thomas G. Carroll & Son Co. v. McIlvaine & Baldwin*, 171 Fed. 125 (C. C. S. D. N. Y. 1909), *aff'd*, 183 F.2d 22 (2d Cir. 1910). Common law protection on theory of unfair competition is merited only if the mark is "fanciful" or "suggestive," not "descriptive." *Skinner Mfg. Co. v. Kellogg Sales Co.*, 143 F.2d 895 (8th Cir. 1944), *cert. denied*, 323 U. S. 766 (1944); *Lusta-Foame Co. v. William Filene's Sons Co.*, 66 F. Supp. 517 (D. Mass. 1946); *Pennzoil Co. v. Crown Central Petroleum Corp.*, 50 F. Supp. 891 (D. Md. 1943), *aff'd*, 140 F.2d 387 (4th Cir. 1944). Courts will also afford protection when they consider the mark to have acquired a secondary meaning. *N. S. W. Co. v. Wholesale Lumber & Millwork, Inc.*, 123 F.2d 38 (6th Cir. 1941). The court in the present case found the word "Seventeen" had not only acquired a secondary meaning with respect to Triangle's magazine, but that it was a "fanciful" word such as would merit common law protection. 167 F.2d 969, 972 (2d Cir. 1948).

2. The first case so held was *Hanson v. Triangle Publications, Inc.*, 163 F.2d 74 (8th Cir. 1947), *cert. denied*, 332 U. S. 855 (1948) in which the trade-mark "Seventeen" was first protected from appropriation. In an earlier case the manufacturer of pocket knives was enjoined from using the word "Scout" to identify his product since consumers might be led to believe that the knives were endorsed by the Boy Scouts of America. That organization, however, unlike Triangle Publications, was in the habit of endorsing knives, thus giving additional grounds for confusion. *Adolph Kastor and Bros., Inc. v. Federal Trade Comm.*, 138 F.2d 824 (2d Cir. 1943).

3. For a comprehensive treatment of this subject see Callmann, *Unfair Competition Without Competition*, 95 U. OF PA. L. REV. 443 (1947); Goble, *Where and What a Trade-Mark Protects*, 22 ILL. L. REV. 379 (1927).

4. *J. S. Tyree, Chemist v. Thymo Borine Laboratory*, 151 F.2d 621 (7th Cir. 1945); *American Broadcasting Co. v. Wahl Co.*, 121 F.2d 412 (2d Cir. 1941).

of the manufacturer's good will.⁵ In protecting the trade-mark in its identification capacity the courts have long recognized the desirability of enabling the consumer to distinguish between products and to rely upon their source. Only in recent years, however, has there been any indication that the good will of the manufacturer is entitled to protection.

Recognizing that the public interest controls the application of the unfair competition doctrine, the courts have required that consumer confusion result from the unfair activities of the subsequent trade-mark user if the owner is to be entitled to protection. In judging whether confusion between products existed, the courts have had difficulty establishing workable standards because the concept of "confusion" has expanded with changes in commercial practices.⁶ At the turn of the century when communication facilities were limited, trade-marks had only local significance because the buyer was in a position personally to ascertain the identity and source of his purchases. The improbability of confusion confined trade-mark protection to instances where the subsequent user manufactured goods which were in direct competition with those of the owner.⁷ As the means of communication were improved and extended, and there arose the phenomenon of nation-wide advertising and selling, the consumer could no longer rely upon personal knowledge in determining the character of goods purchased. The increased dependence of the consumer upon advertising brought to the courts a realization that the former limits of protection were insufficient to fulfill trade-mark purposes. At this point the "confusion of source" doctrine made its appearance. In its origin this concept encompassed only goods with similar physical properties. Thus, shovels were held to be of the same descriptive class

5. *Mishawaka Rubber & Woolen Co. v. S. S. Kresge Co.*, 316 U. S. 203 (1942). See Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L. J.* 1165 (1948).

6. "There is no part of the law which is more plastic than unfair competition." *Ely-Norris Safe Co. v. Mosler Safe Co.*, 7 F.2d 603, 604 (2d Cir. 1925).

7. "The phrase 'unfair competition' presupposes competition of some sort. In the absence of competition the doctrine cannot be invoked." *Borden Ice Cream Co. v. Borden's Condensed Milk Co.*, 201 Fed. 510, 514 (7th Cir. 1912).

as hatchets.⁸ The next step was to embrace dissimilar goods which nevertheless suggested each other. Since automobiles and tires, though not of the same descriptive class, suggested one another, trade-names identifying automobiles were protected from tire manufacturers.⁹ Further judicial expansion led to the modern view of "confusion of source," under which the test is: Are the subsequent user's goods of such a nature as would reasonably lead the public to believe they were manufactured or distributed by the trade-mark owner.¹⁰ Applying this test, the courts have found likelihood of such confusion between refrigerators and electrical household appliances,¹¹ clocks and electric razors,¹² and fountain pens and razor blades.¹³ Under these decisions the underlying requirement for protection has been probable consumer confusion.

The growth of trade-mark protection, then, may be diagrammed as four concentric circles, the innermost circle representing the area of direct competition and the outer fringe illustrating the inclusion of products which might reasonably relate back to the same source. Very recently,

8. *The Collins Co. v. Oliver Ames & Sons Corp.*, 18 Fed. 561 (1882). The following cases held certain products to be in the same descriptive class: *Carroll v. Ertheiler*, 1 Fed. 688 (1880) (cigarettes and pipe tobacco); *American Tobacco Co. v. Polacek*, 170 Fed. 117 (1909) (cigarettes and chewing tobacco); *Anheuser-Busch, Inc. v. Budweiser Malt Products Corp.*, 295 Fed. 306 (2d Cir. 1943) (beer and malt extract). The following held the designated products not to be of the same class: *Dwinell-Wright Co. v. White House Mills Co.*, 132 F.2d 822 (2d Cir. 1943) (milk and tea or coffee); *Consumers Petroleum Co. v. Consumers Co. of Illinois*, 169 F.2d 153 (7th Cir. 1948) (fuel oil and coal).

9. *Hudson Motor Car Co. v. Hudson Tire Co.*, 21 F.2d 453 (1927); *Akron-Overland Tire Co. v. Willys-Overland Co.*, 273 Fed. 674 (3d Cir. 1921). Similarly, in the following cases one product was held to suggest the other: *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 Fed. 407 (2d Cir. 1917) (pancakes and syrup); *William A. Rogers, Ltd. v. Majestic Products Corp.*, 23 F.2d 219 (1927) (silverware and silver polish); *Rosenberg Bros. & Co. v. Elliot*, 7 F.2d 962 (3d Cir. 1925) (men's suits and men's hats).

10. *L. E. Waterman Co. v. Gordon*, 72 F.2d 272 (2d Cir. 1934). "It is confusion of origin, not confusion of goods, which controls." *Vick Chemical Co. v. Vick Medicine Co.*, 8 F.2d 49, 52 (S. D. Ga. 1924), *aff'd*, 11 F.2d 33 (5th Cir. 1926). See DERENBERG, TRADE-MARK PROTECTION AND UNFAIR TRADING § 34 (1936); NIMS, UNFAIR COMPETITION AND TRADE-MARKS § 221h (4th ed. 1947).

11. *Landers, Frary & Clark v. Universal Cooler Corporation*, 85 F.2d 46 (2d Cir. 1936).

12. *Elgin Nat. Watch Co. v. Elgin Razor Corporation*, 25 F. Supp. 886 (N. D. Ill. 1938).

13. *L. E. Waterman Co. v. Gordon*, 72 F.2d 272 (2d Cir. 1934).

however, there has been a break away from the traditional "confusion" theory of protection. Some jurisdictions seem to recognize as an additional ground for this protection the interest of the manufacturer in the good will he has gained through use of the trade-mark.¹⁴ The injury which the courts here undertake to alleviate is the decreased value of advertising, identification, and reputation to one manufacturer when a second adopts a similar trade-mark and capitalizes on its previously established merit.¹⁵ This view has been referred to as the concept of "dilution."¹⁶ If this has been the real basis for protection in these cases, however, the courts have been hesitant so to declare, as is evidenced by a continued reliance in their opinions upon notions of confusion. Where the confusion is thus rendered less than substantial by the remote relation between the old and new products, the protection has been justified on extraneous grounds, as by emphasizing the fraudulent or unfair intention of the newcomer in adopting the trade-mark.¹⁷ As confusion has become increasingly improbable, the courts and judges have experienced proportionally greater difficulty in achieving agreement.¹⁸ In opposition to the extension of trade-mark protection to areas of improbable consumer confusion it is argued that the doctrines of trade mark protection, though directed toward public benefit, have inherent within them seeds of economic monopoly.¹⁹ It is said that where pro-

14. *Kay Jewelry Co. v. Kapiloff*, 49 S. E.2d 19 (Ga. 1948); *Lady Esther v. Lady Esther Corset Shoppe*, 317 Ill. App. 451 (1943); *Tiffany & Co. v. Tiffany Productions, Inc.*, 264 N. Y. S. 459 (1923).

15. "The real injury . . . 'is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods.'" *Tiffany & Co. v. Tiffany Productions, Inc.*, 264 N. Y. S. 459, 462 (1923), *aff'd*, 262 N. Y. 482, 188 N. E. 30 (1933).

16. 44 ILL. L. REV. 182, 185 (1949).

17. *Vogue Co. v. Thompson-Hudson Co.*, 300 Fed. 509 (6th Cir. 1924), *cert. denied*, 273 U. S. 706 (1926). The court stressed the obvious fraudulent intent of the defendant which manifested itself when he appropriated not only the name "Vogue," but also the peculiar "V-Girl" mark which identified the magazine. Similar findings of fraudulent intent prompted the court to give injunctive relief to the publishers of *Esquire* magazine when the defendant tavern owner, in addition to naming his bar "Esquire," decorated the walls with drawings of Esqy, a cartoon character used to identify *Esquire* magazine, and reproduced the magazine cover in his decorations. *Esquire, Inc. v. Esquire Bar*, 37 F. Supp. 875 (S. D. Fla. 1941).

18. Judge Frank, in his dissent, suggests that the Supreme Court should review the decision because of a disagreement among the Courts of Appeal, 167 F.2d 969, 974 (1948).

19. "But the legal protection of trade-names does not engender competition; on the contrary, it creates lawful monopolies, immunities

tection is conferred the association of the mark with the product of the owner becomes more indelibly impressed on the consumer's mind and the manufacturer's position in the industry is thereby strengthened. If protection is extended beyond the limits of probable confusion the mark comes to symbolize only one product, giving to the manufacturer a great economic advantage in both advertising and expansion.²⁰ When a prospective producer is confronted with such a situation, he is usually discouraged from entering the industry and the original manufacturer may gain virtually complete control over the business he selects, subject only to the antitrust laws.²¹ The validity of this argument has not been successfully refuted, but its significance in the *Seventeen* type case may be doubted. The real encouragement to monopoly is given when protection is afforded against directly competing products.²² The trade-mark "Lucky Strike" discourages any prospective cigarette manufacturer, but future automobile or processed foods producers are little influenced in their course of action by the pre-eminence of "Lucky Strike." As the relation between the products becomes more remote, the protection given the trade-mark becomes less a menace to a competitive economy. Though its tendency to foster monopoly presents the strongest obstruction to trade-mark protection in the area of directly competing goods, it is in this area that the courts have

from competition. And the legally forbidden invasions of those monopolies might often benefit consumers." Judge Frank, dissenting in *Eastern Wine Corp. v. Winslow-Warren, Ltd.*, 137 F.2d 955, 957 (2d Cir. 1943), *cert. denied*, 320 U. S. 758 (1943). See Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L. J.* 1165 (1948); Borchard, *Are Trade-Marks an Anti-Trust Problem?* 31 *GEO. L. J.* 245 (1943).

20. "The art of advertising spuriously reinforced a genuine demand by the power of reiterated suggestion." *Learned Hand*, in *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 Fed. 960, 962 (2d Cir. 1918). Also see Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L. J.* 1165, 1183 (1948): "For the individual firm, however, it is a potent device to distinguish a product from its competitors, and to create a partial immunity from the chills and fevers of competition. The result of successful differentiation is higher prices than would otherwise prevail. The aim, not always achieved, is higher profits."

21. Taggart, *Trade-Marks: Monopoly or Competition?*, 43 *MICH. L. REV.* 659, 661 (1945). Borchard, *Are Trade-Marks an Anti-Trust Problem?*, 31 *GEO. L. J.* 245 (1943).

22. Judge Frank, concurring in *Standard Brands v. Smidler*, 151 F.2d 34 (2d Cir. 1945), presents a strong argument against any type of trade-mark protection.

unanimously found the public interest in prevention of confusion to outweigh the threat to a competitive economy. In the *Seventeen* type case the danger of monopoly inducement is as remote as the possibility of confusion, and the questionable conduct of the subsequent registrant, as well as the desirability of fair business practices, may be of sufficient weight to throw the balance in favor of protection.

Another objection to these recent extensions, one which is particularly pertinent where the trade-mark owner is unable to show damage,²³ is that once the element of probable consumer confusion is absent, protection represents a paternalistic attitude toward business on the part of the judiciary.²⁴ It is contended that there is no injustice in allowing a newcomer to take advantage of the good will of an already established product where there is no possibility of confusion.²⁵ But even where no injury can be shown, this argument does not seem sufficiently persuasive to compel a denial of protection. One may question whether the newcomer will gain any benefit from using a similar trade-mark in the absence of some confusion between the two products. Though it is apparent that the prior registrant has been required to prove less to be entitled to protection, this does not seem unjust in the absence of a corresponding increase in the risks of monopoly. It is rational that the self-developed interest of the original manufacturer in his good will should be given preference over the unfair and unethical intentions and practices of the newcomer in usurping the benefits of such reputation.²⁶ And it is not unreasonable to assume that

23. The inability of *Triangle* to show actual or probable injury is stressed by Judge Frank in his dissent. 167 F.2d 969, 981 (2d Cir. 1948).

24. "Since the present-day rationale of trade-name protection is such actual or probable confusion of source as to injure . . . plaintiff's good will, then, . . . a plaintiff seeking such protection should always be required to prove that defendant's product is so substandard that, if . . . associated by consumers with plaintiff, impairment of plaintiff's good will is a likely result. As yet courts have not imposed such a requirement. . . . But, if the frontiers of trade-name protection are to be enlarged to include an extraordinary case like this, then, at a minimum, such proof should be exacted." 167 F.2d 969, 981 (2d Cir. 1948), Judge Frank, dissenting.

25. Judge Frank, dissenting in the present case, said: "Nor would the automobile manufacturer be entitled to an injunction against the candy-maker merely because the latter deliberately chose the name, intending to acquire advantages accruing to him from the elaborate advertising of the Cadillac." 167 F.2d 969, 978 (2d Cir. 1948).

26. "It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select from the entire material universe,

the desire for a competitive economy carries within it an idea of fair competition.²⁷

which is before him, symbols, marks, and coverings which by no possibility can cause confusion between his goods and those of competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them." *Florence Mfg. Co. v. J. C. Dowd Co.*, 178 Fed. 73, 75 (2d Cir. 1910). This passage is quoted in *Vick Chemical Co. v. Vick Medicine Co.*, 8 F.2d 49, 52 (S. D. Ga. 1925).

27. "... there is no fetish in the word 'competition.' The invocation of equity rests more vitally on the unfairness." *Vogue Co. v. Thompson-Hudson Co.*, 300 Fed. 509, 513 (6th Cir. 1924), *cert. denied*, 273 U. S. 706 (1926).