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THE TRADEMARK CONFUSION TEST—GOOD OR BAD; WEAK OR STRONG?

Long before the more sophisticated problems of Trademark Law had taken root, man impressed various symbols upon the work of his hands,¹ as a means of identifying its source. These symbols stood in place of the maker's name, and served as a guide for consumers, both those who were satisfied with the goods and now knew where they could purchase more of like quality, and those who were dissatisfied, who now knew how to avoid the product, and more particularly, its producer.² While this basic function of the trademark has remained relatively constant throughout the years, its legal status has not been so static. This article will be devoted primarily to the standards which the Lanham Act of 1946³ and a segment of the present common law of unfair competition apply to the protection of trademarks.⁴ Such an objective, however, necessitates some analysis of history and terminology before entering the uncertain terrain bounded by post-Lanham trademark decisions.

COMMON LAW

Fundamentally, the American law of trademarks "is still a creature of the common law."⁵ At the outset, it would be wise then to inquire into the kinds of words⁶ and symbols accorded trademark status at common law, and the scope of protection provided them thereunder.

The mere fact that a manufacturer employed a word or symbol as his mark did not automatically preclude another's use of the same. An immediate distinction came to be drawn between a mark which was coined or arbitrary as applied, and one which identified the product by describing its properties, indicating its geographical origin, or using its maker's name. The former type of mark, which shall be referred to hereafter as strong, was considered protectable since it was "specially and peculiarly significant and suggestive of one man's goods."⁷ Also, owing to the fact that it was invented, a limitation on its use would in no way deplete the reservoir of language. On the other hand, the latter or weak mark, possessing neither of these attributes, received no common law protection at the time of its

¹ "Symbols have been used to identify the ownership or origin of articles for at least 4,000 years." I Nims, *The Law of Unfair Competition and Trade Marks* 509 (4th ed. 1947), citing Schecter, *The Historical Foundation of the Law Relating to Trade Marks* (1925).

² "The primary and proper function of the trademark is to identify origin of ownership of the goods to which it is affixed." *Hanover Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916).

³ 60 Stat. 509 (1946), 15 U.S.C. §§ 1051-1127 (1958), amending, 60 Stat. 426 (1946).

⁴ The common law of unfair competition as spoken of in this article will be limited solely to its trademark implications. While in broader form unfair competition can encompass such unethical practices as trade disparagement and commercial bribery, these activities are beyond the scope of this paper.

⁵ Restatement, Torts § 715, comment (f), at 558 (1938).

⁶ The first use of words and names as trademarks is dated back to at least the early nineteenth century. I Nims, *supra* note 1, at 510-511.

⁷ *France Milling Co. v. Washburn-Crosby Co.*, 7 F.2d 304, 306 (2d Cir. 1925).

adoption.⁸ If however at some later date it could be shown to have acquired a "secondary meaning," i.e., a peculiar significance in the mind of the buyer relating the marked good to its specific source, then the weak mark, despite its more plebian past, could be successfully defended.⁹

The common law trademark protection given to both strong and weak marks was founded on, and limited by, the "passing off" doctrine of unfair competition. This view took the position that since a mark was used to identify the producer of goods, another maker should not be allowed to appropriate the same mark to take advantage of the first user's reputation and good will and thus be in a position to fool the public.¹⁰ A person could not ". . . therefore be allowed to use names, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another. . . ."¹¹ The courts sought to protect the consumer from having one producer's goods "palmed off" upon him as those of another whose goods the consumer had purchased before. Until at least the end of the nineteenth century, trademark protection *via* unfair competition was restricted to situations involving directly competitive goods.¹² This limitation was founded on an acceptance to the semantical tautology that unfair competition must imply competition, without consideration of whether the deception itself could occur only in that circumstance.

ACT OF 1905

The first significant attempt at a codification of standards to protect trademarks from infringement took the form of the federal Trade-Mark Act of 1905.¹³ This statute provided that no marks "which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered. . . ."¹⁴ The mark differentiation formula initiated under the common law was thereby incorporated into the Act, and immediate statutory sanction was given to only the strong trademark. Some acknowledgement though, was also

⁸ "Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, [or its geographical origin] be employed as a trade mark. . . ." *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871).

⁹ "It [secondary meaning theory] contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark." *G. & C. Merriam Co. v. Saalfeld*, 198 Fed. 369, 373 (6th Cir. 1912).

¹⁰ "[T]he law has always forbidden one trader to pass off his article of trade as that of a rival trader." *Midwest Plastics Corp. v. Protective Closures Co.*, 285 F.2d 747, 750 (10th Cir. 1960).

¹¹ *James Heddon's Sons v. Millsite Steel & Wire Works, Inc.*, 128 F.2d 6, 9 (6th Cir. 1942).

¹² *Developments in the Law, Trade-Marks and Unfair Competition*, 68 Harv. L. Rev. 814, 844 (1954-55). [Hereinafter cited as *Developments*.]

¹³ Act of Feb. 20, 1905, ch. 592, 33 Stat. 724.

¹⁴ Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 726.

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made of the common law doctrine of "secondary meaning" relative to a weak mark. Any mark which had been in "actual and exclusive use" for the ten years preceeding the Act's adoption could be registered, regardless of whether it would be otherwise subject to the exclusion tests of the Act.¹⁵ The controlling assumption was that such use must *a priori* have produced a special significance in the mark. Unfortunately the Act made no reference to marks which might acquire such meaning after its passage.

As to the infringement test itself, the owner of a registered mark was given a right of action against "any person who shall . . . reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration. . . ."¹⁶ Under the common law the crucial factor in establishing trade mark infringement was deceptive use on competitive products;¹⁷ under the statute it was imitative use on "merchandise of substantially the same descriptive properties."¹⁸ The latter test itself proved deceptive in interpretation and application. It has been suggested that the 1905 Act simply codified the law of unfair competition of the time.¹⁹ If so, then a "descriptive properties" requirement was but another way of protecting only marks on competitive goods. While in a literal sense this position seems quite reasonable, it was not always substantiated in cases decided under the 1905 Act. Similarly, weak marks were not offered a uniform level of protection under the Act, nor under the subsequent common law. These developments are our next concern.

A leading decision on the "descriptive properties" test, limiting the Act's application to competitive products, was handed down by the Sixth Circuit in *Peninsular Chemical Co. v. Levinson*.²⁰ The plaintiff had a strong registered trademark on pharmaceutical preparations. Defendant began to put out an inferior cigar under the same mark and sold it to drug stores which patronized plaintiff's products, on the representation that it was a new product made by plaintiff. While the court did enjoin defendant on the common law unfair competition doctrine of "passing off," it could not find for plaintiff under the statute even though the buying public had been deceived, and were confused as to the origin of the goods.²¹ This was due to the fact that cigars did not have the same "descriptive properties" as medicines.

There were, however, few similar cases in which confusion of origin existed and statutory relief was denied because of the absence of goods

¹⁵ *Ibid.*

¹⁶ Act of Feb. 20, 1905, ch. 592, § 16, 33 Stat. 724, 728.

¹⁷ *Supra* note 12.

¹⁸ *Supra* note 17.

¹⁹ *S.C. Johnson & Son v. Johnson*, 175 F.2d 176, 179 (2d Cir. 1949).

²⁰ 247 Fed. 658 (6th Cir. 1917).

²¹ The standard tests for whether the public is likely to be confused are set out in *Triumph Mills Inc. v. Triumph Int'l. Corp.*, 308 F.2d 196 (2d Cir. 1962), considered later in the text. They are the similarity of the marks, proximity of the products, sophistication of the buyers, strength of the mark and actual confusion. Actual confusion, if found, is of course determinative of its likelihood.

of the same descriptive properties.²² Significant in this regard was the decision of *Yale Elec. Corp. v. Robertson*.²³ The plaintiff sought registration of the trademark "Yale" for his flashlights. Defendant counterclaimed on the ground that it was a prior user of the mark on many kinds of hardware, especially locks, and that plaintiff's use of the mark was confusing defendant's buyers. Judge Learned Hand accepted the defendant's proposition, reasoning that defendant had an action in unfair competition founded upon the confusion, and the 1905 Act could not be interpreted to allow registration of a mark which could then be immediately enjoined from use. This the court admitted, did "some violence to the language"²⁴ of descriptive properties, since locks and flashlights were of substantially different construction. More important the test became one of whether confusion would result from the dual use, regardless of the lack of competition between the products.

UNFAIR COMPETITION—1905-1946

A contemporaneous development in the common law of unfair competition must now be considered. As noted previously, at the time the 1905 Act was passed all unfair competition trademark actions involved instances of direct competition. Yet in both *Peninsular* and *Yale* the observation was made that the common law would enjoin a confusing use in a non-competitive situation, and in *Yale* this was critical to the interpretation of the statute itself. The dilemma is partially resolved in *Vogue Co. v. Thompson-Hudson Co.*,²⁵ in which a magazine sued a hat manufacturer for infringement of its trademark. The court did not protect plaintiff on his statutory trade mark rights, seemingly because the two goods were not of the same "descriptive properties," as in *Peninsular*. But it did find unfair competition, explaining that:

This rule is usually invoked when there is an actual market competition between the analogous products of the plaintiff and the defendants, and so it has been natural enough to speak of it as the doctrine of unfair competition; but there is no fetish in the word "competition." The invocation of equity rests more vitally upon the unfairness.²⁶

The unfairness referred to is the confusion which may occur whether the products are competitive or not. Since confusion has become of such significance both under the Act and the common law, it is necessary to reconsider strong and weak marks, relative to this issue.

STRENGTH OF MARK—CONFUSION

In the case of *Pabst Brewing Co. v. Decatur Brewing Co.*,²⁷ the Seventh Circuit held that the validly registered weak mark "Blue Ribbon," first

²² *Supra Developments*, note 12, at 845, n.235.

²³ 26 F.2d 972 (2d Cir. 1928).

²⁴ *Id.* at 974.

²⁵ 300 Fed. 509 (6th Cir. 1924).

²⁶ *Id.* at 512.

²⁷ 284 Fed. 110 (7th Cir. 1922).

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used on beer, was not infringed by its subsequent use on malt extract or syrup. The basis for the decision was not that the two goods were of different "descriptive properties." It was rather the fact that "Blue Ribbon" was a term of very wide and general employment; that it had been used many times as a trademark on diverse kinds of goods; that it was a quality term indicating high merit; and that therefore "there was no likelihood of any confusion of its (appellee's) product with that of appellant."²⁸ There can be no question that it is legitimate to consider the strength of the mark as one factor in determining whether there is likely to be confusion. Thus if the public was so accustomed to the encomium "Blue Ribbon" as to be aware that its use on beer and malt extract did not signify a single source for both products, there would be no infringement. But what remains determinative is the confusion, and the strength of the mark serves only a subsidiary evidentiary function.

Unfortunately as the courts continued to grade the marks in reaching their decisions, they became so enamoured of the distinction that cases were decided solely on the issue of the trademark's strength, with a descriptive mark being given narrow protection due to its weakness alone, and not because its descriptiveness had narrowed the area of confusion.²⁹ Thus the means had become the end, the servant the master. An extreme example of this point of view is the case of *Pease v. Scott County Milling Co.*³⁰ Here the court held, in finding no infringement of the weak mark Noxall:

A distinctive name, such as "Kodak," "Budweiser," "Ford," "Aunt Jemima," "Penslar" and "Delmonte," will be broadly protected in all cases where damage [confusion] will be inflicted by unauthorized use; while words like "Blue Ribbon," "Star," and "Noxall," and other words of like character, will be protected only within the range of use upon similar goods.³¹

The import of this rule of law seems inescapable. While a strong mark like Penslar will be protected upon a showing of confusion both under the common law and the 1905 Act, if the "descriptive properties" test is not literally applied, a valid weak mark will be protected "only within the range of use upon similar goods," regardless of whether confusion would result from its use on dissimilar ones. While the *Pease* court had earlier in its decision concluded that there was no likelihood of confusion, its rule has been given effect in confusion situations.³² It in fact subtly changed the "descriptive properties" test to a test of descriptiveness of the mark itself.

Thus, by the year 1946, when the present federal Trademark Statute, the Lanham Act, was passed, common and statutory law were again on the

²⁸ *Id.* at 113.

²⁹ "Most . . . cases narrow rights on the ground of descriptiveness and third party usage, but without stating that this narrowing of rights actually narrows the area of confusion, much less explaining *why* it would." Garner, *Narrow and Weak Trade Marks*, 22 *Geo. Wash. L. Rev.* 40, 42 (1953).

³⁰ 5 F.2d 524 (E.D. Mo. 1925).

³¹ *Id.* at 526.

³² *Cf.* text accompanying note 49 *infra*.

same level, though having sought it in different ways. With the exception of the courts still strictly construing "descriptive properties" under the Act of 1905,³³ confusion was the universal trademark test, and similar overemphasis was given the mark's strength both under the statute and the common law.

THE LANHAM ACT

The Lanham Act of 1946 allowed the registration of a number of weak marks which would not have been accepted under the terms of the 1905 Act. Thus where the prior Act denied registration of marks which were descriptive of goods, or of their character or quality,³⁴ Lanham denies registration only to a mark which "when applied to the goods of the applicant is *merely* descriptive . . . of them."³⁵ (Emphasis added.) The phrase barring marks which were "*merely* a geographic name or term"³⁶ (emphasis added) was reworded to exclude only those marks which were "*primarily* geographically descriptive"³⁷ (emphasis added) when applied to the applicant's goods. The section prohibiting registration of a mark which consisted "*merely* in the name of any individual"³⁸ was changed to bar only a mark "*primarily* merely a surname."³⁹ (Emphasis added.) While this new phraseology should of itself allow some weak marks to gain initial statutory protection impossible before, more important is Section 2(f) of Lanham which provides that, with a few irrelevant exceptions, "nothing herein shall prevent registration of a mark . . . which has become distinctive of the applicant's goods in commerce."⁴⁰ This adoption of the common law "secondary meaning" doctrine should accord all weak marks, once they have attained a significance of their own, the statutory benefits of registration.⁴¹

The test of infringement of a registered mark is contained in section 32(1)(a), providing the owner of a registered mark a remedy by way of an infringement action from any use by another which "is likely to cause confusion, or to cause mistake, or to deceive."⁴² This confusion test in the 1946 Act replaced formally the "descriptive properties" test of the 1905 Act, if it had not already replaced it in substance. On its face, it is to be applicable to all registered marks, weak and strong. Lending credence to this conclusion that confusion is the sole applicable standard is the following statement of the Congressional Committee which sponsored the Lanham Act:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing

³³ Cf. text accompanying note 21 supra.

³⁴ Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 726 (1905).

³⁵ 60 Stat. 429 (1946), 15 U.S.C. § 1052(e) (1958).

³⁶ Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 726 (1905).

³⁷ 60 Stat. 429, § 2(e) (1946), 15 U.S.C. § 1052(e) (1958).

³⁸ Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 726 (1905).

³⁹ 60 Stat. 429, § 2(e) (1946), 15 U.S.C. § 1052(e) (1958).

⁴⁰ 60 Stat. 429 (1946), 15 U.S.C. § 1052(f) (1958).

⁴¹ For a more expansive treatment of Lanham registration provisions, see *Developments*, supra note 12, at 825-36.

⁴² 60 Stat. 429 (1946), 15 U.S.C. § 1052(f) (1958).

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a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner. . . . Your committee believes the proposed bill accomplishes these two broad basic principles.⁴³

It is obvious that unless a validly registered weak mark is protected in a confusion situation, the first objective mentioned by the Committee can not be achieved, since it is precisely in a confusion situation that the public is denied what it asks for and needs. Since the owner of a weak mark must of necessity spend energy, time and money in building up a "secondary meaning," his investment and the second interest of the Committee will both be defeated, if a second and confusing use were to be permitted.

POST-LANHAM: STRENGTH OF MARK-CONFUSION

Within three years after the passage of the Lanham Act however, the Second Circuit in *S. C. Johnson & Son Inc. v. Johnson*⁴⁴ refused to apply the confusion test in the same manner to a weak mark as to a strong, and in so doing limited the accomplishments which the Lanham committee could justifiably claim. The plaintiff, a maker of waxes and polishes, was the first user and valid registrant of the mark Johnson. Its subsequent use on defendant's non-competitive cleaning fluid had caused confusion. While these facts would have been sufficient to call for an injunction had the mark been strong, it was graded weak, and as such the plaintiff had "two, but only two" interests in it.

- (1) The possibility that the trade practices of the second user may stain the owner's reputation in the minds of his customers;
- and (2) the possibility that at some time in the future he may wish to extend his business into that market which the second user had begun to exploit.⁴⁵

These interests would allow plaintiff exclusive use of the mark only if they outweighed the right of the second user to employ it—defendant's interest here being the "customary and innocent identification of his goods with himself."⁴⁶ Judge Hand, coincidentally the writer of the *Yale* opinion, founded this result upon his belief that the Lanham Act merely codified the law of unfair competition as it existed in 1946. Thus the elusive "descriptive properties" test was now confusion, but the strength of the mark was also determinative of the scope of protection afforded. True, the com-

⁴³ S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946).

⁴⁴ *Supra* note 20.

⁴⁵ *Id.* at 180. These interests depend on such factors as the quality of defendant's product, the likelihood that the quality, if high, will not diminish in the future and the probabilities of plaintiff's entering the defendant's field.

⁴⁶ *Id.* at 180.

mon law had treated it in like manner, but only because of a failure to correctly apply the strength of the mark as a factual issue in determining confusion.⁴⁷ There is little reason why common law errors should be codified, when they can as easily be eliminated. Yet in *Johnson*, despite a finding of confusion which the court readily makes, the plaintiff was denied relief because his mark was weak.

The following year the Ninth Circuit took a parallel position in *Sunbeam Lighting Co. v. Sunbeam Corp.*⁴⁸ The plaintiff held a registered weak trademark (Sunbeam) on electric flatirons, machines and supplies. The court held that it was not infringed by its subsequent use on fluorescent electric fixtures. If this decision departed in any way from the *Johnson* rationale, it was only to narrow further the protection of a weak mark. The first legitimate interest acknowledged a senior user in *Johnson*, that of preservation of reputation, is characterized by the *Sunbeam* court as an occupational hazard,⁴⁹ and not a protectable interest. More important the court adopts the language of the *Pease* case, limiting the protection of a weak mark "within the range of use on similar goods."⁵⁰ It is quite possible that this restriction is even more severe than the *Johnson* balance test, since there plaintiff could at least attempt to demonstrate that his equities outweighed defendant's, though the goods were dissimilar. But the "similar goods" test makes actionable only competitive or quasi-competitive uses.⁵¹

Under the above theories, the strength of the mark is as critical to the decision as confusion. For if confusion is found, a strong mark is immediately protected but a weak one is not, unless, depending on the circuit in which the issue is raised, either plaintiff's interests prevail over defendant's or the use is on similar goods.

Yet even these two circuits have wavered in their adherence to this philosophy. The Ninth Circuit in the case of *Fleishmann Distilling Corp. v. Maier Brewing Co.*⁵² was able to suggest, if inferentially, that no distinction need be made as to the strength of the mark. The plaintiff held a registered trademark "Black and White" on scotch whiskey and the defendant had begun to use the same mark on beer. Confusion was found but on the *Sunbeam* theory, plaintiff's mark, if weak, would prevail only if scotch and beer could be considered similar goods. Needless to say, the court could not go

⁴⁷ *Supra* note 30.

⁴⁸ 183 F.2d 969 (9th Cir. 1950).

⁴⁹ If plaintiff's goods are so good that the mere mention of their trade-name or mark would be sufficient for a reasonable person to select an article bearing it, no matter how unrelated plaintiff's goods are to the article, then, as it seems to us, plaintiff must suffer the price of virtue. If in course of our free enterprise, someone would market an unworthy article outside plaintiff's field bearing the name Sunbeam it must be borne as not an unlikely circumstance following plaintiff's selection of a non-fanciful word popular with commercial concerns.

Id. at 972.

⁵⁰ *Supra* note 32 and accompanying text.

⁵¹ "Similar goods" as a phrase is reminiscent of "descriptive properties." But as applied by the *Pease* and *Sunbeam* courts, it never means just confusion, as in *Yale*.

⁵² 314 F.2d 149 (9th Cir. 1963).

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this far, but instead labelled the mark strong. The result then is consistent with both *Johnson* and *Sunbeam*, but the reluctance of the court to grade the mark gives an indication that confusion is regarded as the vital issue, whether the mark be strong or weak. This of course would be antithetical to both earlier holdings, but also a more accurate interpretation of the Lanham Act.

The Second Circuit, the leading circuit in the trademark area, at least in the number of cases decided, has a more speckled history. To return a few years to 1953, the court in *Admiral Corp. v. Penco, Inc.*⁵³ repudiated the very strong-weak distinction which it had so carefully laid out in *Johnson*. In the lower court⁵⁴ defendant had argued that plaintiff's trademark "Admiral," on radios and televisions, was not infringed by its later use on sewing machines and vacuum cleaners, since the mark was weak and not subject to protection. While this argument is probably more precisely directed to a *Sunbeam* circuit, the court's answer is applicable to any attack mounted on a mark's strength. "What is important, is not whether the mark is a coined one or not but what the proof establishes as to what the mark has come to mean in the trade"⁵⁵—whether it has acquired a "secondary meaning." Seemingly then where secondary meaning can be proven, a weak mark is on a par with a strong one. The Second Circuit in upholding the trial court, noted that the mark "Admiral" was technically weak, but still found that "the fact that the products are not identical does not excuse if they are sufficiently similar to make *confusion likely*."⁵⁶ (Emphasis added.) This is an application of the confusion test to a weak mark under Lanham as it should be made, without limitation or the need for additional inquiry.

Any fond hopes that the Second Circuit had abandoned more than temporarily the *Johnson* rule were, however, to be denied. It made its re-appearance in the case of *Avon Shoe Co. v. David Crystal Inc.*⁵⁷ in 1960 and, perhaps refreshed by the slumber of its inactivity, returned in dimension larger than it had at its departure. The plaintiff had adopted the strong trademark "Haymaker"⁵⁸ and first used it on a line of women's shoes in 1941, finally registering it in 1952. The defendant began to employ the same trademark on sporting apparel, such as dresses and skirts, in the year 1945, "without knowledge of the plaintiff's prior use."⁵⁹ This resulted in confusion. The court, citing *Johnson*, decided that even though the mark was strong, plaintiff had only two interests in it; protecting his reputation and his possibility of extending his line into the market taken by defendant. *Johnson* is dubious authority for a court which obliterates the strong-weak distinction, whether it be done by making both type of marks infringed on a showing of confusion, as in *Admiral*, or neither type infringed until a balance test is

⁵³ 203 F.2d 517 (2d Cir. 1953).

⁵⁴ *Admiral Corp. v. Penco, Inc.*, 106 F. Supp. 1015 (W.D.N.Y. 1952).

⁵⁵ *Id.* at 1021.

⁵⁶ *Supra* note 54, at 520.

⁵⁷ 279 F.2d 607 (2d Cir. 1960).

⁵⁸ "The 'Haymaker' mark, which as applied to women's shoes, is fanciful and arbitrary. . . ." *Id.* at 610.

⁵⁹ *Id.* at 611.

passed, as here. Still, the defendant's interest built up by fifteen years of good faith use was sufficient to decide the case in his favor.

The good faith considered here revolves around defendant's lack of knowledge of plaintiff's prior use of the mark. Even though the constructive notice provision of Lanham is inapplicable in view of defendant's adoption of the mark preceding registration by plaintiff,⁶⁰ there seems no reason for allowing defendant's good faith to give him an interest in the mark. The United States Supreme Court in *Thaddeus Davids Co. v. Davids Mfg. Co.*,⁶¹ interpreting the Act of 1905, which was without a constructive notice clause argued:

[I]n view of this statutory right, it could not be considered necessary that the complainant in order to establish infringement should show wrongful intent on the part of the defendant, or facts justifying the inference of such an intent. . . . Having duly registered under the act, the complainant would be entitled to protection against any infringing use. . . .⁶²

Indeed the Second Circuit in *La Touraine Coffee Co. v. Lorraine Coffee Co.*,⁶³ citing *Thaddeus Davids*, refused to decide whether defendant's conduct was innocent since "when similarity is established, good faith—even if proven—is no defense"⁶⁴ under Lanham. And since the infringement test in the Lanham Act is confusion, it can make no difference whether the goods be competitive, as in *La Touraine*, or simply confusing as to origin, as in *Avon*. Be that as it may, after the *Avon* decision all marks were subject to an interest analysis before being afforded protection. The Lanham committee, the buying public and the trademark owner might well admit to confusion.

The Lanham test by now had been so mutated, if not mutilated, that a clear, concise restatement of the rule was certainly in order. Thus the same Second Circuit in *Triumph Mills Inc. v. Triumph Int'l. Corp.*,⁶⁵ recognizing that it was "difficult to reconcile all the decisions . . . dealing with this problem"⁶⁶ set out to fill the need. "The full bench would now accept" the following propositions set out in *Polaroid Corp. v. Polerad Electronics Corp.*⁶⁷

Where the products are different, the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of the defendant's good faith

⁶⁰ It is true that the Lanham Act indeed prevents a junior user from claiming good faith when his use begins subsequent to a prior user's registration under the Act. But that provision is inapplicable here. For the defendant's use commenced more than two years prior to the effective date of the Act.

Id. at 611.

⁶¹ 233 U.S. 461 (1914).

⁶² *Id.* at 471.

⁶³ 157 F.2d 115 (2d Cir. 1946).

⁶⁴ *Id.* at 118.

⁶⁵ 308 F.2d 196 (2d Cir. 1962).

⁶⁶ *Id.* at 198.

⁶⁷ 287 F.2d 492 (2d Cir. 1961).

in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers. Even this extensive catalogue does not exhaust the possibilities—the court may have to take still other variables into account.⁶⁸

This rule of law, with its potpourri of variables may in its unexhausted state raise more problems than it solves. It must first be broken down into its components, however, before any fair criticism can be levied.

The degree of mark similarity, product proximity, sophistication of the buyers and actual confusion are all factual considerations which should have no independent significance but rather relate to the decisive question as to whether confusion of origin is likely to result from the two uses. Thus if the marks are so similar that confusion is likely to result, it should not aid defendant in any way that the buyers are sophisticated, and the products remote. On the other hand, a naive clientele should not benefit plaintiff's cause of action, if due to differences in the marks, they are not likely to be confused. All these elements are but means to an end, the determination of confusion, and once the end is achieved, the means should be disregarded.

The quality of defendant's products and the likelihood that the prior owner will bridge the gap are restatements of the legitimate interests given recognition for the benefit of the weak trademark owner in *Johnson*. They are not considered only when the mark is weak though, as in *Johnson*. This court recognizes that strength of the mark aids plaintiff's cause of action, but the *Johnson* interests must under all circumstances be considered independently, as further strengthening, or perhaps weakening, his claim.

As contrasted with the possible interests of the first user above, the defendant must rely on his good faith in adopting the mark. In *Avon* you will recall, defendant's good faith was grounded on his appropriation of the mark without knowledge of its earlier use, and before it was registered. In the instant case plaintiff held a registered trademark "Triumph" on women's stockings. Defendant sought to register "Triumph of Europe" for use on women's foundation garments, and the application was refused. Later when defendant began to use the mark "Distinction by Triumph of Europe" on its product, this action was precipitated. The court suggests that a bona fide junior user is one "whose use is not attributable to intent to obtain a free ride on the reputation of the owner of the trade-mark."⁶⁹ This position is immediately open to the same objections advanced to the "good faith" interest in *Avon*.⁷⁰ It suffers one additional handicap. In *Avon*, as mentioned, the constructive notice provision of Lanham could not be applied since the adoption preceded registration. Here not only did defendant possess this constructive notice,⁷¹ but he had actual notice of plain-

⁶⁸ Id. at 495.

⁶⁹ Supra note 66, at 199.

⁷⁰ Good faith was not a legitimate interest under the 1905 Act, and in no way negates the existence of confusion.

⁷¹ "Registration of a mark on the principal register provided by this Act or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership." 60 Stat. 427, § 23. (1946), 15 U.S.C. 1072 (1958).

tiff's prior use of the mark. This court is in effect saying that the constructive notice provision of Lanham, which of its nature is designed to increase registrant's rights in his trademark, affords less protection than the 1905 Act, which is silent as to good faith. Such reasoning must be rejected.

It is no easier to determine the statutory trademark test after *Triumph* than it was before. It is clearer what the test is not. "Confusion indeed is a factor to consider. But it is not conclusive. . . ."⁷² It should be, if only because defendant can summon up no legitimate interest in the mark, once confusion is shown. But even if the possibility of a good faith defense were conceded, the rationale could not be.

The *Triumph* test sets up eight variable factual considerations, and suggests that even others may have to be considered. Any and all of these interests may strengthen the position of either the first or second user, and weights are assigned to none. Plaintiff may prevail despite the absence of the *Johnson* interests,⁷³ likewise defendant might triumph even if "non-innocent."⁷⁴ Anything is possible in between. Somewhere within this plethora of "propositions" trademark infringement will be adjudged, but temporarily at least, the trees loom large, the forest obscure.

LANHAM AND UNFAIR COMPETITION

Some comparison can now be made between statutory trademark protection and the present common law variety. A focal point is the case of *Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Co.*,⁷⁵ recently decided by the District Court of Wisconsin. There an unusual fact situation was presented to the court. The junior user of the mark "Land O'Lakes," the strength of which was not expressly determined, sued the senior user for cancellation of the trademark registration, on ground of abandonment. Confusion was present, but the court concluded, citing *Avon*, that this would not be enough in itself to support a Lanham action; since, if a senior user must bear in some instances the consequences of a later use, a junior user must in similar circumstances be forced to tolerate an earlier one. The *Johnson* interests test was also tacitly adopted. "[T]he likelihood of confusion as to the source of origin of goods . . . has not been shown to cause or threaten to cause injury to plaintiff's economic status, its reputation and good will, or to any other lawful interest in the mark."⁷⁶ On this basis plaintiff was denied statutory relief.

As to unfair competition, the *Land O'Lakes* court finds against plaintiff primarily because he was the latecomer in the mark, and the confusion resulted from the legitimate natural expansion of the mark by both parties.

⁷² Supra note 66, at 200.

⁷³ "We agree that it would not necessarily be fatal to the grant of an injunction that neither of two "Aunt Jemima" [*Johnson*] conditions existed." Supra note 66, at 199.

⁷⁴ "Even if the [trial] judge below was right in finding that the defendants were not 'innocent junior users' it was erroneous to hold that this fact of itself justified the injunction." Supra note 66, at 199.

⁷⁵ 221 F. Supp. 576 (E.D. Wis. 1963).

⁷⁶ Id. at 583.

STUDENT COMMENTS

But the decision does infer that circumstances could exist whereby an action in unfair competition would be sustained, although the Lanham Act could offer no protection. These circumstances, the court contends, did exist in *Polaroid Corporation v. Polaroid Inc.*,⁷⁷ decided by the Seventh Circuit.

In this *Polaroid* case, the plaintiff had a very strong registered trademark on photographic equipment, and the defendant's use of an imitative mark in his refrigeration and heating business had resulted in confusion. The good faith of the defendant was in serious doubt. Plaintiff brought his action in three counts: statutory trade-mark infringement, unfair competition and dilution. The court found in his favor on the second and third causes of action, but did not decide whether Lanham applied, although noting it was the weakest of the causes of action.

It is now imperative to discern the elements in *Polaroid* which sustain an unfair competition suit. Competition between the goods is not required, particularly where the trademark is "invented and coined."⁷⁸ This is the common law confusion test of 1946, and it is not likely that overemphasis as to the strength of the mark will limit its application since "equity will enjoin the appropriation . . . where the resemblance is so close that it is likely to produce confusion to the injury of . . . the name. . . ."⁷⁹ But confusion, if and when it is found, is itself the injury to the mark.

If another uses it, he borrows the owner's reputation whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask. And so it has come to be recognized that unless the borrower's use is so foreign to the owner's as to insure against any identification of the two, it is unlawful.⁸⁰

Determination of injury then is the dividing line between the present statutory and common law. The *Polaroid* test allows an injunction wherever confusion results in injury, and since confusion *a priori* results in injury, both strong and weak marks are protected on a showing of confusion. On the other hand, the *Johnson, Avon* and *Triumph* interpretations of Lanham view injury as a factual consideration distinct from confusion. It is to be determined by an investigation of the *Johnson* interests, whether plaintiff's reputation is endangered by the second use, whether plaintiff would possibly produce the product now the defendant's line. The good faith interest which the above statutory decisions have afforded the second user, is denied him at common law. Thus it is clear why *Polaroid* considered it more difficult to prove statutory infringement, since it would be necessary to evaluate all these interests, over and above the crucial common law question of confusion.

⁷⁷ 319 F.2d 830 (7th Cir. 1963).

⁷⁸ Id. at 835.

⁷⁹ Id. at 836, paraphrasing the language in *American Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1925).

⁸⁰ Id. at 835 quoting *Yale v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928).

CONCLUSION

Trademark protection has come a long way since the time it protected only against competitive use. But it has yet to complete its journey. The common law, unless it again becomes bogged on fruitless considerations of the strength of the mark for its own sake, seems to have found the most sensible solution in the confusion test. Lanham Act interpretations do not have so much to recommend them. Until both strong and weak mark owners are protected in their trademark on a confusion test alone, the public will not get what it wants, and the time and effort of the mark's registrant will be partly in vain. The interest test of *Johnson* and the "relative variables" of *Triumph* have irresistably led to confusion. It would be far better to simply make confusion the test. Since, despite their separate courses the common and statutory law have come in the past to apply the same test, there is room for hope that they will do so again, and, that they will choose wisely.

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