TRADEMARKS: REGISTRATION UNDER FEDERAL LAW

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When the National Broadcasting Company and the Nebraska Educational Television Network selected the same "N" as their respective logos, the resulting controversy and ultimate settlement1 emphasized the importance of trademarks to commercial enterprises and the necessity for protecting and policing them. Unfortunately, in the many cases when a business will adopt and use a mark, the business will give only the slightest consideration to such matters as its potential value, the steps necessary to protect it, and the possible infringements of other similar marks.

There is no better example of recognizing the true value of a trademark than that of Coca-Cola Company. Between 1923 and 1970, Coca-Cola spent $850 million on advertising its soft drink. This investment has resulted in immense sales volumes for Coca-Cola over the years and the estimated value of its trademark "Coca-Cola" is $3 billion.2

Although most marks will never attain the exalted status which "Coca-Cola" has, nevertheless the development, use, and protection of a mark should be of extreme importance to a commercial entity in the sale of its goods or services. Recognizing this, one must conclude that the mark, if used in interstate or foreign commerce, should be registered under federal law.

TYPES OF MARKS

The term "trademark" is something of a misnomer in that it is generally used to refer to four different types of "marks":

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1. NBC first used its new logo, a red and blue design in the shape of the letter "N", on January 1, 1976. NETV had apparently been using the same design (though completely red) for at least six months previous to this. Suit was filed by NETV for trademark infringement resulting in a settlement of over $500,000 for NETV. Interestingly, NBC had filed an application to register the "N" with the Patent Office before NETV did. However, since NETV had first use of the mark, it was entitled to exclusive appropriation of the design.

2. Figures from a speech by Julius R. Lumsford, trademark attorney for Coca-Cola Company, in March 1974 before members of the trademark examining staff of the U.S. Patent Office.
trademarks, service marks, certification marks, and collective marks.

The Trademark Act of 1946 defines a "trademark" as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." A trademark is distinguishable from a trade name or a commercial name in that the latter two are business names used by manufacturers, merchants, and others to identify their businesses or occupations. A trademark identifies a product, and a trade name identifies a producer.

A "service mark" is defined as "a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." A good example of a service mark is the "N" used by the National Broadcasting Company for telecommunication services. However, it is sometimes difficult to determine whether a mark is a trademark or a service mark. For instance, suppose an automobile manufacturer contracts with a gasket producer for a supply of gaskets to be used in automobile production. The gasket maker will probably stamp his mark on his product. Is this a trademark for goods or a service mark for goods made to the order and specifications of the auto manufacturer? For our purposes, it should suffice to say that an item of goods is what may be termed "shelf stock" and that a service is a performance to the order and/or specifications of others.

A "certification mark" is defined as a mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacturer, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The distinction between a certification mark and trade or service marks is that the owner may not use the certification mark in connection with his own goods or services. It can be used only to certify the goods or services of others. The certifier is the owner of the mark and he uses it to indicate to a purchaser that

4. Id.
5. Id.
6. Id.
7. Id.
the goods or services meet certain criteria established by him. Most certification marks contain a word or words which indicate that it is a certification mark, e.g., "Certified", "Approved", "Inspected."

A "collective mark" is defined as "a trademark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization."8 A collective mark is distinguishable from a trademark or a service mark in that it is used only to indicate membership in an association or organization, e.g., on such things as letterheads, pins, patches. Trademarks or service marks, on the other hand, are used in connection with the goods or services that the association or organization provides.

For a word, name, symbol, or device to function as a trademark it must be in some manner placed on the goods, their containers or displays, or on tags or labels attached to the goods.9 Written advertising does not constitute trademark use unless it is directly associated with the goods.

MARK FUNCTIONS

Although the main function of a mark10 is to indicate the origin of the goods or services for sale, the mark also serves to guarantee the quality of the goods bearing the mark and, through advertising, serves to create and maintain a demand for the product.

A mark provides the owner with a symbol.

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising shortcut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the

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8. Id.
9. Id.
10. The term "mark" is used here to refer only to trademarks and service marks.
commercial magnetism of the symbol he has created, the owner can obtain legal redress.\[11\]

**COMMON LAW RIGHTS**

Trademark rights developed at common law. These rights are still created solely by the adoption and use of the mark rather than by state or federal registration. Registration does not create trademark rights, but simply recognizes pre-existing common law rights and provides procedural rights in addition thereto. That common law rights in trademarks exist irrespective of statutory enactments was recognized in *The Trade-mark Cases*\[12\] where the court held:

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the states. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress [Trademark Act of 1870] and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.\[13\]

The first user of a particular trademark is rewarded with common law rights in the mark which afford him protection from use of his symbol in connection with another's goods or services. Obviously, the seller who identifies his product


\[12\] United States v. Steffens (*The Trade-mark Cases*), 100 U.S. 82 (1879).

\[13\] *Id.* at 92. See also *In re* Plymouth Motor, 46 F.2d 211 (C.C.P.A. 1931), where the court states:

It is elemental legal doctrine that the Federal Trade-Mark Registration Act (15 U.S.C.A. §§ 81-109) subtracts nothing from, and makes no addition to, the common-law rights relating to trade-mark ownership and use, except as it furnishes an official forum where owners of marks may have them registered and made public, the machinery for such registration being provided. The act also contains provisions which affect the remedies of an owner in enforcing his or its rights, but, in so far as actual ownership of, or rights in, a mark are concerned, these are determined wholly by common-law principles.... The weight of authority is to the effect that the statute makes no effort to set up a right of ownership, or use, which the common law does not or may not recognize.

*Id.* at 212.
through the use of a trademark has an interest, from a purely economic standpoint, in prohibiting competitors from palming off their product as his. The courts will protect this interest with both injunctive relief and monetary damages.

Although common law rights attach at the first use of a trademark, statutory registration, especially federal registration, must not be overlooked. It is through registration that the federal and state governments recognize the right of the owner to use the mark and provide him with certain procedural rights which can be extremely important.

**The Dual System of Registration**

The trademark system in the United States is actually comprised of a separate state and federal system. This duality exists because our Federal Constitution, although providing for a patent and copyright system, makes no mention of trademarks. Irrespective of this, Congress, in its first attempt to legislate in the area of trademarks, passed the Trademark Act of 1870 based upon the constitutional grant to regulate patents and copyrights. However, in 1879, this Act was held unconstitutional in *The Trade-mark Cases*. The Court said:

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act . . . . At common law the exclusive right to it grows out of its use, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend on novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.

The Supreme Court, in *The Trade-mark Cases*, went on to state that congressional regulation of trademark registration must be based upon the commerce clause of the United States

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14. U.S. Const. art. I, § 8, cl. 8, provides: "The Congress shall have Power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

15. Ch. CCXXX, §§ 77-84, 16 Stat. 198, 210, 212 (1870).

16. 100 U.S. at 94.
Constitution.\textsuperscript{17} Congress' power under this clause is restricted to interstate and foreign commerce. As the Court said:

The other clause of the Constitution supposed to confer the requisite authority on Congress is the third of the same section, which, read in connection with the granting clause, is as follows: "The Congress shall have power to regulate commerce with foreign nations, and among the several States and with Indian tribes."

When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress.\textsuperscript{18}

As a result of the decision in \textit{The Trade-mark Cases}, a dual system of trademark regulation developed. Marks used in connection with goods or services in interstate or foreign commerce are regulated by federal law and those in intrastate commerce are regulated by state law.

\textbf{STATE REGISTRATION}

Each state has its own trademark statute which provides for trademark registration.\textsuperscript{19} Generally, applications for trademark registration are handled by the office of the Secretary of State. Unfortunately, these applications are often examined only for formal compliance requirements without conducting a proper search for similar prior registered marks.

Many states, including Nebraska, have adopted the same registration system embodied in the federal law.\textsuperscript{20} Although a few states have actually gone so far as to regard trademark infringement as a criminal act,\textsuperscript{21} the relief afforded by state registration does not compare with the protection provided by registration under federal law. The most obvious disadvantage of state registration, as opposed to federal, is that the mark owner is protected only within the state in which he registers.

\begin{itemize}
\item \textsuperscript{17} U.S. Const. art. I \S 8, cl. 3.
\item \textsuperscript{18} 100 U.S. at 94-96.
\item \textsuperscript{19} See, e.g., Neb. Rev. Stat. §§ 87-111 to -125 (Reissue 1976) which sets forth the Nebraska trademark statute.
\item \textsuperscript{20} Nebraska's registration system, although in abbreviated form, is nearly identical to the federal system.
\item \textsuperscript{21} Trademark infringement is not a criminal act under federal or Nebraska law. Both, however, recognize civil actions for infringement. 15 U.S.C. \S 1114(1) (1970); Neb. Rev. Stat. §§ 87-121 to -124 (Reissue 1976).
\end{itemize}
Federal registration, on the other hand, provides national protection.

**FEDERAL REGISTRATION**

The owner of a mark used in interstate or foreign commerce may register it under the Lanham Act on the Principal Register or the Supplemental Register. The advantages of federal Principal Register registration are many, including: (1) providing national constructive notice of the registrant's claim of ownership of the mark; (2) the creation of certain presumptions, not only of ownerships, but of validity with the exclusive right to use the mark on the goods or services recited in the registration; (3) the right to bring suit in federal courts, regardless of the diversity of citizenship or the amount in controversy; (4) the right to file the federal trademark registration with the Treasury Department thus creating the right to prevent the importation of foreign goods carrying an infringing mark; and (5) the right to register the mark in many foreign countries.

**THE APPLICATION**

A federal registration may be acquired by filing a written application with the United States Patent Office. The applicant must specify his domicile and citizenship, the date of his first use of the mark, and the date of its first use in interstate or foreign commerce. He must also specify "the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person" believes himself to be the owner of the mark. He must state that the mark is in use in commerce, and that no other person or entity, "to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion," mistake, or deception.

24. See 15 U.S.C. § 1091 (1920) which provides for the registration of "marks capable of distinguishing applicant's goods or services and not registrable on the principal register... except those declared to be unregistrable under subsections (a), (b), (c), and (d) of section 1052 of this Title..." Id.
26. Id.§ 1057(b).
27. Id.§ 1121.
28. Id.§ 1526.
29. Id.§ 1128.
30. Id.§ 1151(a)(1).
The applicant must also file with the Patent Office a drawing of the mark and five specimens or facsimiles of the mark as actually used. If the applicant is of foreign nationality, he must designate by written document, filed in the Patent Office, the name and address of a United States resident on whom process may be served in actions affecting the mark.

The owner of a mark may file the application himself or it may be done by his attorney. A filing fee of $35.00 is required for each classification in which the mark is to be registered.

Classification

Goods and services are divided into various classifications for convenience in administering registration. The United States used its own classification system until 1973, when the international classification system went into effect pursuant to the Trademark Registration Treaty signed in Vienna, Austria, on June 12, 1973.

Under this system of classification, it is possible for identical or similar marks to obtain registration. For example, the hypothetical mark “Happy Date” used by a manufacturer of paint (International Class 2) is capable of registration along with the identical mark “Happy Date” used by a manufacturer of jewelry (International Class 14). The reasoning behind this is that the mark, when applied to such dissimilar goods as paint and jewelry, would not confuse the buying public into thinking their origins were the same. Of course, there are classes which are so closely related that a registered mark in one may preclude registration of the identical or similar mark in the other. An example of this is International Class 32 (beer) and International Class 33 (wines).

Examination of Application

Applications for mark registration are docketed and examined by the Patent Office in the order in which they are...
received. An applicant can expect to wait approximately one year from the date of the application until receipt of the certificate of registration. If for any reason the mark is not entitled to registration, the applicant will be notified and advised of the reasons therefor and of any formal requirements or objections. The applicant has six months to respond with or without amendment to the application—and the trademark examiner will then reexamine or reconsider the application.  

If after re-examination or reconsideration the registration is still refused, appeal may be taken to the Trademark Trial and Appeal Board.  

If at this level it appears that the applicant is entitled to registration, the mark will be published in the Official Gazette (a Patent Office weekly publication) and is then subject to opposition. Any person who believes he would be damaged by registration of the mark may oppose registration within thirty days after publication. Oppositions are heard by the Trademark Trial and Appeal Board and are subject to the rules applicable to adversary proceedings.  

If a conflict is discovered between two co-pending applications and the date of the first use alleged in the application last filed is at least as early as the filing date of the conflicting application, a procedure known as an “interference” is instituted to determine which applicant is entitled to register.

If no oppositions are filed and no interferences are instituted, the certificate of registration will be issued. In order to give notice of registration, the mark should be accompanied by the words “Registered in the U.S. Patent Office,” or “Reg. U.S. Pat. Off.,” or the letter “R” enclosed within a circle. This notice must never be given before the actual issuance of a certificate or registration. Instead, the letters “TM” may accompany the mark which is notice that the symbol is used as a trademark and/or that an application for registration is pending in the Patent Office.

under the U.S. classification system, application must be made under the international system. The international system has 34 separate classes for goods and eight for services.

41. Id. § 1063.
42. Id. § 1067.
44. See generally id. § 2.91-.98.
45. Id. § 2.81.
AFTER REGISTRATION

Registrations issued under the Lanham Act remain in force for twenty years and can be renewed for additional twenty year periods unless previously cancelled or surrendered. A registration will be cancelled after a six year period unless the registrant, within one year before the expiration of six years, files in the Patent Office an affidavit or declaration showing that the mark is still in use in commerce or that its nonuse is due to special circumstances rather than an intent to abandon the mark.

A mark is also subject to cancellation upon application to the Commissioner of Patents by those who believe they may be damaged by the registration. After five years (but before the sixth year) from the date of registration a registrant may obtain some protection from cancellation by acquiring incontestable status. This is done by filing an affidavit with the Patent Office stating that the mark has been in continuous use for five years subsequent to the date of registration and that there has not been, nor are there pending, any decisions adverse to the registrant's claim of ownership.

MARKS REGISTRABLE UNDER FEDERAL LAW

Any mark, the use of which distinguishes the applicant's goods or services from those of others, is registrable under federal law, on the Principal Register, unless it:

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.
(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the

47. Id. § 1058.
48. Id. § 1059.
49. Id. § 1058(b).
50. Id. §§ 1063-1064.
51. Id. § 1065.
52. Id.
53. For registration of a container or product shape as a trademark, see Comment, Lanham Act Registration of a Container or Product Shape as a Trademark, 3 U.S.E. L. REV. 327 (1969).
life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable [as collective or certification marks] . . . , or (3) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce . . . .”

IMMORAL OR SCANDALOUS MARKS [15 U.S.C. § 1052(a)]

The criterion as to what constitutes scandalous or immoral matter is the connotation understood by the general public in light of current attitudes. Thus the word or mark cannot be registered if its meaning or association would be shocking to the public sense of truth, decency or propriety, or if it is either in bad taste or offensive to the general morality.

The meaning of a word may be scandalous per se. However, many normally inoffensive words may become scandalous because of the associations conveyed when used in conjunction with the goods which they identify.

The commissioner applied this rationale in refusing registration of a mark identifying a prophylactic preparation preventing venereal disease as “Dough Boy” and in denying registration of the mark “Bubby Trap” for brassieres. Marks with

55. To date there have been no cases in which a mark has been found scandalous per se. In Ex parte Parfum L’Orle, Inc., 93 USPQ 481 (Commr. 1952), the examiner maintained that “Libido” was indicative of sexual desire and refused registration. However, the Commissioner of Patents reversed the examiner holding that the word has meaning other than sexual desire, i.e., psychoanalytic meaning, and when used in ordinary writing or speech would not be considered shocking, offensive, or obscene.
religious connotations may be deemed offensive when used in some commercial contexts; for example, the use of “Madonna” as a mark for wine or “Agnus Dei” in connection with a tabernacle safe. To commercialize matter of such highly sacred religious significance would be offensive to most individuals of the Christian faith. Likewise, the use of “Messias” as a mark for wine and brandy and “Senussi” for cigarettes may be highly offensive to a particular group of people because the combination of mark and goods represents a violation of their religious practice.

**DECEPTIVE MARKS [15 U.S.C. § 1052(a)]**

A deceptive mark not only constitutes matter which is in and of itself clearly deceptive, but also matter which makes an obvious suggestion upon which the public could rely and thereby be deceived. In *Gold Seal Co. v. Weeks* the court decided whether or not “Glass Wax”, a liquid composition used to clean glass and metal, was deceptive. The court found that this mark was not deceptive because the evidence of record failed to show that the public had been induced to purchase the product because of a belief that it contained wax. To the contrary, it appeared that the product satisfied the needs of customers and that they did not know and cared even less about the scientific composition of the product. Consequently, deception exists only when an essential and material element is misrepresented, is distinctly false, and is the very element upon which the customer relies when purchasing the product. When, as in *Gold Seal*, the product contains an element which can only be known exactly through rigid scientific analysis, if such element is misrepresented by use of the mark but does not appear to be determinative in leading customers to buy the product, the product is not deceptive under the Lanham Act.

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58. *In re P.J. Valckenberg, RmbH., 122 USPQ 334 (TTAB 1959). See also Ex parte Riverback Canning Co., 30 USPQ 374 (Commr. 1936), aff’d, 95 F.2d 327 (CCPA 1938).*

59. *Ex parte Summit Brass & Bronze Works, Inc., 59 USPQ 22 (Commr. 1943).*

60. *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, 159 USPQ 275 (TTAB 1968).*

61. *In re Reemtsma CigarettenFabriken, GmbH, 122 USPQ 339 (TTAB 1959). But see In re Waughtel, 138 USPQ 594 (TTAB 1963), where the appeal board held the word “Amish” with the representation of a man in Amish clothing smoking a cigar is not scandalous as applied to cigars and thus is entitled to registration. The Amish, as a group, do not forbid the use of cigars.*


63. *Id. at 410-11.*

64. *Id.*
An example of marks which are generally held to be deceptive are those which include the words "Hide" or "Hyde" used in connection with non-leather goods which can be made of leather and simulate leather in appearance. Marks with geographic significance may also be held deceptive. In the case of *In re Amerise*, the Trademark Trial and Appeal Board set up guidelines to be followed in determining whether registration of a mark having geographic significance is prohibited under section 2(a) of the Lanham Act. The Board held that a mark consisting of or comprising a geographic term is not deceptive unless it involves a false assertion calculated, either planned, designed, or implied, to deceive the public as to the geographic origin of the goods bearing the mark. This contemplates situations where a party applies a geographic designation to a particular product not possessing an appearance of greater quality or saleability with the intent thereby of inducing or misleading a particular class of consumers into purchasing the product. Intent has been inferred under circumstances where a geographic area or place is well-known for the particular product, e.g., France for perfumes, Switzerland for watches, Denmark for cheese.

**DISPARAGING OR FALSELY SUGGESTIVE MARKS**

[15 U.S.C. § 1052(a)]

Registration of a mark can also be refused because it falsely suggests a connection with a natural person. However, whether or not such false suggestion is found, depends upon a

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65. *See* Caldwell Lace Leather Co., Inc. v. Western Filament, Inc., 173 USPQ 695 (TTAB 1972) ("Neohide" held deceptive and deceptively misdescriptive as applied to non-leather shoe laces); Steinberg Bros., Inc. v. J.P. Stevens & Co., 156 USPQ 574 (TTAB 1967) ("Fawnskin" held not deceptive or deceptively misdescriptive as applied to piece goods); W.D. Byron & Sons v. Stein Bros. Mfg. Co., 146 USPQ 313 (TTAB 1965) ("Tufide" held not deceptive as applied to business and carrying cases made of plastic material).


67. *Id.* at 691.

68. *See In re* The Salem China Co., 157 USPQ 600 (TTAB 1968) (the use of "Limoges" was held to be deceptive when connected with the sale of dinnerware not made in Limoges, France, or from clay indigenous to that area); *In re Richemond*, 131 USPQ 441 (TTAB 1961) (the phrase "Made in Paris" was held deceptive as applied to perfume manufactured in the United States). *See also In re Sweden Freezer Mfg. Co.*, 159 USPQ 246 (TTAB 1968) (the word "Sweden" was held not deceptive as applied to external artificial kidney units of domestic origin); Mem Co. v. The Hes Co., 149 USPQ 8 (D. Cal. 1966) ("English Leather" held not geographically misdescriptive of men's toiletries).

determination of whether the person is well known in the field relating to the goods concerned. For instance, “Fanta” for soft drinks did not falsely suggest a connection with Robert D. Fanta who has never used his name in connection with soft drinks and has never gained any recognition in this field.70 Likewise, “Arnold Brand” for fresh tomatoes did not falsely suggest a connection with Mr. Arnold Brand since he was not in the business of selling fresh tomatoes.71 On the other hand, the name “Laub” for a product, that was developed in part by Mr. John H. Laub, was held to be utilization of his name without his consent.72

A mark does not have to be the full or correct name of a person to falsely suggest a connection. It may be a nickname or other designation or term by which the person is generally known to the public at large.

A mark may also falsely suggest a connection with a national symbol. Such marks, including those falsely suggesting a connection with symbols of foreign countries, are denied registration under section 1052(a). A national symbol can be anything which because of its appearance and sound immediately suggests the country for which the symbol stands, such as the Statue of Liberty.73 However, names of reigning families (House of Windsor74) and of countries (Sweden75) are not national symbols.

70. See Fanta v. Coca-Cola Co., 140 USPQ 674 (TTAB 1964).
73. See also John Walker & Sons v. American Tobacco Co., 110 USPQ 249 (Commr. 1956) (the name “Johnnie Walker” held unregistrable as applied to cigarettes as it falsely suggests a connection with the producer of “Johnnie Walker” whiskey); Copacabana, Inc. v. Breslauer, 101 USPQ 467 (Commr. 1954) (the mark “Copacabana” as applied to cosmetics and perfumes was held to falsely suggest a connection with the owner of the “Copacabana” restaurant); Ex parte Sylvan Sweets Co., 94 USPQ 9 (Commr. 1952) (the words “Lucky Camel” as applied to candy cigarettes held to imitate “Camel” cigarettes). But see Sales v. Christy, 168 USPQ 62 (TTAB 1970) (the purchasers of “Soapy Sales” floor wax, soap, detergent, and cleaner were held not likely to associate these goods with the entertainer, “Soupy Sales”).
76. See In re Sweden Freezer Mfg. Co., 159 USPQ 246 (TTAB 1968). See also In re General Mills, Inc., 169 USPQ 244 (TTAB 1971) where the words “Union Jack” as applied to frozen fish and for restaurant services were held not falsely suggestive of a connection with a national symbol because “Union Jack”
MARKS COMPRISING FLAGS, COATS OF ARMS, OR INSIGNIA OF GOVERNMENTS [15 U.S.C. § 1052(b)]

While section 1052(a) bars registration only of marks which may disparage or falsely suggest a connection with institutions or national symbols, section 1052(b) is an absolute bar and does not permit registration of marks comprising flags, coats of arms, or other insignia of governments.

Flags and coats of arms of governments are specific designs formally adopted to serve as emblems of governmental authority. The phrase "other insignia" in section 1052(b) is limited to those emblems and devices which are used to represent national authority and are of the same general class and character as flags and coats of arms. In this country this would include the Great Seal of the United States, the Presidential Seal, and the seals of governmental departments (but not department insignia used merely to identify a service or a facility of government, such as the National Park Service). 76

Simulations of flags, coats of arms, and other insignia are also refused registration. A simulation is a likeness so close in nature that it would create the impression of being the same as the correct form of the insignia. 77

MARKS COMPRISING NAMES, PORTRAITS, OR SIGNATURES OF LIVING INDIVIDUALS [15 U.S.C. § 1052(c)]

Section 1052(c) prohibits registration of marks which consist of or comprise a name, portrait, or signature identifying a particular living individual unless the individual's written consent is given. This applies only to living persons with the exception of a deceased President of the United States during the life of his widow. 78

is a generic term for a type of flag rather than the name of a flag of a particular country.

76. See National Van Lines, Inc. v. Dean, 237 F.2d 688 (9th Cir. 1956) where the court held that a shield with vertical stripes does not comprise an official coat of arms or other insignia of the United States.

77. See In re Waltham Watch Co., 179 USPQ 59 (TTAB 1973) where the board held that a mark including the design of multiple flags does not constitute a simulation of flags of foreign nations because the flags in the mark are readily distinguishable from national flags; In re American Box Board Co., 123 USPQ 508 (TTAB 1959) where the applicant's eagle design was held to differ sufficiently from the Great Seal of the United States so that it does not involve a simulation thereof.

78. See In re Masucci, 179 USPQ 829 (TTAB 1973) where the board held the name "Eisenhower" and portrait of President Eisenhower were not registrable during the life of his widow in the absence of her written consent.
rights of privacy and proprietorship in the designations which identify them, which is not necessarily true of deceased persons.\textsuperscript{79}

This prohibition applies to any name, whether a full name, shortened name, nickname, portrait, or signature which identifies a particular individual. Section 1052(c) applies not only to marks which consist solely of such identifying matter but also to those marks which have other matter in them.\textsuperscript{80}

Written consent under section 1052(c) must be consent to register and not just consent to use the matter. If the matter involved identifies the individual who is the applicant and who signed the application, it will be assumed that by doing so consent was given. If the matter involves an individual who is an officer of a corporation or other company which is the applicant, and such individual executed the application as an officer, his consent will be implied.\textsuperscript{81}

If a mark or part of a mark gives the appearance of identifying a particular individual, but it was devised by the applicant as fanciful (not having any particular individual in mind) and the applicant believes it is fanciful, it may be that consent would not be required. The requirement for consent depends upon a determination of whether the mark would be recognized and understood by the general public as identifying that particular person. If the person is not generally known, nor well-known in the field relating to the goods concerned, the mark user would probably not be required to obtain consent.

**CONFUSINGLY SIMILAR MARKS [15 U.S.C. § 1052(d)]**

The majority of registration refusals are based upon sections 1052(d) and (e) of the Lanham Act. Section 1052(d) precludes registration of a mark if it so resembles a mark registered in the Patent Office or a mark or a trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause

\textsuperscript{79} See McGraw-Edison Co. v. Thomas Edison Life Ins. Co., 160 USPQ 685 (TTAB 1968) where the board held that 15 U.S.C. § 1052(c) provides by implication for registration of the name of a deceased person (Thomas Edison) since it specifically prohibits registration of matter relating to "living individuals."

\textsuperscript{80} See Reed v. Bakers Eng'r. & Equip. Co., 100 USPQ 196 (Commr. 1954) in which the name "Reed Reel Oven" was held to identify a particular living individual.

\textsuperscript{81} See Ex parte Dallioux, 83 USPQ 262 (Commr. 1949) where the mark "Andre Dallioux" was not denied registration since it was the applicant's name and by signing the application he consented to registration.
confusion, mistake, or deception. The purpose here is to prevent the likelihood of confusion as to the origin of the goods or services. The test is: would the purchaser be likely to believe he is getting one product when in fact he is getting another—or to believe that the products are produced by the same producer when, in fact, they are not?

Generally, there are three forms of mark similarity: appearance, sound, and significance. Regarding appearance, the test is not a side by side comparison of the marks, but rather the total impression created in the mind of the purchaser. For instance, two design type marks might appear quite dissimilar when analyzed side by side. But the purchasing public is not always able to make such comparisons and the fallibility of the average person's memory, particularly to coined or arbitrary marks, must be considered. The focus must be on the general recollection reasonably produced by the registered mark and then comparing that recollection with the applicant's mark.

Similarity in sound alone is a sufficient basis to support a finding of likelihood of confusion, especially where the mark is applied to related goods or services. For example, "Plum" and "Plum's" has been held confusingly similar to "Blum's."

The significance or connotation of marks can also be a basis for refusing registration because of similarity. "Trash-Master" (a mark used for refuse spreading equipment), for example, was refused registration on the basis of being confusingly similar to "Dumpmaster" (for garbage collection equipment) already registered. Irrespective of the identical portions (Master), the terms Trash and Dump connote the same thing: garbage. Likewise, "Climate Command" was held to have the same significance as "Air Command."

82. An exception to this is the provision of 15 U.S.C. § 1052(d) (1970) wherein the Commissioner of Patents may grant concurrent registration after he has determined that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar mark under the conditions and limitations as to the mode or place of use of the marks or the goods in connection with which the marks are used. For example, a mark the use of which is restricted to Maine would probably not create confusion with an identical mark used in California.


86. Amana Refrigeration, Inc. v. Slant/Fin Corp., 166 USPQ 159 (TTAB
Registration is possible for similar marks if the goods on which they are used are so unrelated that the possibility of confusion does not exist. The tests are: Are the goods of the same descriptive properties? Are they produced together? Are they used together? Are they used by the same class of purchasers? Are they sold through the same channels? Are the methods of distribution the same? The decision denying registration based on similarity depends to a large degree on the answers to these questions.

DESCRIPTIVE OR DECEPTIVELY MISDESCRIPTIVE MARKS
[15 U.S.C. § 1052(e)]

Fanciful, coined, or arbitrary marks (meaningless words or symbols employed specifically to serve as trademarks) are entitled to a wide range of protection. Conversely, marks which merely describe the goods or services they are connected with are not entitled to registration under section 1052(e) unless they have become distinctive of the applicant's goods in commerce under section 1052(f). For example, "pasteurized" for milk would be unregistrable because it merely describes a process related to milk and is incapable of distinguishing one milk producer's product from another's.77

Phonetically misspelled and foreign term marks can be denied registration on the basis of descriptiveness. For example, "Kwix-Tart" for electric storage batteries was held descriptive as being merely the phonetic equivalent of quick start;88 and "Pizze Fritte" for fried dough was denied registration since it is merely the Italian equivalent of the words "fried buns."89

Deceptively misdescriptive marks are generally refused registration under section 1052(e). An important distinction between section 1052(e) deceptively misdescriptive marks and sec-

1970). See also London Dry, Ltd. v. A.J. Canfield Co., 170 USPQ 430 (TTAB 1971) where the board held the use of "Olde London" and "London Dry" on carbonated beverages is likely to cause confusion; Acushnet Co. v. Automatic Sprinkler Corp. of America, 165 USPQ 638 (TTAB 1970) where the board held that applied to golf balls, "Medalist" is confusingly similar to "Titleist."

87. See In re Allen Hollander Co., 170 USPQ 422 (TTAB 1971) where the board held that the term "Easy-Peel" for labels and tags is descriptive because it possesses a desirable characteristic; In re American Soc'y of Clinical Pathologists, Inc., 169 USPQ 800 (CCPA 1971) where the phrase "Registry of Medical Technologists" was held descriptive by the board because the mark describes the fact that the applicant maintains a registry of medical technologists for use by medical and hospital groups.


89. In re Zazzara, 156 USPQ 548 (TTAB 1967).
tion 1052(a) deceptive marks is that the former (but not the latter) is capable of registration under section 1052(f) so long as the mark has become distinctive of the applicant’s goods. For example, in the Glass Wax Case,\(^9\) even though the mark was found not to be deceptive, it was held to be deceptively misdescriptive because the product contained either no wax or an insufficient amount to justify the use of the word and customers might justifiably believe that the product did contain wax. A consideration here is that the product was sold in association with other wax products and other glass and metal cleaners do contain wax. But this finding of deceptive misdescription did not necessarily preclude “Glass Wax” from registration as a finding of deception would have. If the applicant can show that even though the mark is misdescriptive, the public has come to identify his goods by use of the mark, he would then be entitled to registration. The reason for this is probably that deceptively misdescriptive marks really do no harm—if the purchaser of the product does not rely on the source of the deception in buying. It may be that the mark improperly describes the product, but if that description does not move the purchaser to purchase, then the untruth is harmless. The test is the degree of untruth.\(^9\)

Surname Marks [15 U.S.C. § 1052(e)]

Marks which are “primarily merely surnames” are unregistrable under section 1052(e) unless the applicant can show that his mark has become distinctive of his goods. The reasoning here is that no one should be able to appropriate a surname—something which everyone possesses.

There are tests used by the Patent Office in determining whether or not a mark is primarily merely a surname. For instance: Is the name rare?\(^9\) Is the mark in fact the name of the applicant or someone in the applicant’s organization? Does the term have significance other than as a surname?\(^9\) Is it a compo-


\(^9\) See In re George Washington Ate Here, Inc., 167 USPQ 702 (TTAB 1970) where the court held that the phrase “George Washington Ate Here” for restaurant services was not deceptive or deceptively misdescriptive because it was historically impossible.

\(^9\) See Fisher Radio Corp. v. Bird Elec. Corp., 162 USPQ 265 (TTAB 1969) where the court held that the name “Bird” was not primarily merely a surname because it has other meanings.

\(^9\) See Ex parte Omaha Cold Storage, 111 USPQ 189 (Commr. 1956) where the commissioner held the name “Douglas” was not merely a surname because it has significance other than as a surname.
SOME FINAL COMMENTS ON DEVELOPMENT AND USE OF A MARK

The key to proper trademark protection, as we have seen, is registration under federal law. However, before registration can be obtained, the mark must be used on the goods or services. Consequently, another important aspect of trademarks involves the selection process. Obviously, a commercial enterprise will want to avoid investing a large amount of money in the development of a trademark only to discover that the mark has already been appropriated by another. Thus, a proper search of the Patent Office files of registered trademarks (including pending applications) should be conducted, before the mark is used, to determine if a confusingly similar mark has already been registered. It may also be necessary to search state registrations and conduct whatever investigations are needed to locate confusingly similar unregistered marks where common law rights are involved.

Of course, trademark development is more of an advertising function than a legal one. Therefore, the major consideration in mark development may be that of consumer appeal as opposed to capability of federal registration. Nevertheless, the development process should include the consideration as to whether or not the mark would be denied registration under federal law, not only on the basis of confusing similarity but also under the other provisions of section 1052 of the Lanham Act.

Even after a trademark is developed and registered, it may still be necessary for the owner to take steps to insure that the mark's integrity is upheld. Registration alone will not prevent use of the mark by others. Private policing of the mark may be necessary. Coca-Cola Company, for instance, is extremely active in policing its trademark. Its trade research department is constantly checking retail outlets to insure that "Coca-Cola" is indeed "Coca-Cola," i.e., that no substitutes are being served under its name. Newspaper ads are also checked to determine if a competitor is palming off its soft drink under the name of "Coca-Cola" or "Coke."

Nor will registration prevent a trademark from becoming

94. See In re Hale Co., Inc., 158 USPQ 171 (TTAB 1968) where the board held that the phrase "Hale of Vermont" was not merely a surname because it is a composite mark made up of a surname.
generic. A great fear of some of our more famous mark owners (such as "Coke" and "Xerox") is that their marks will become
generic due to public usage. However, this might be prevented if
the mark owner properly uses the mark in connection with his
goods or services. There are five basic rules regarding proper
usage of a mark: (1) accompany the mark with the generic
name; (2) always use the correct typographical treatment; (3)
always use correct grammar—avoid additions, prefixes, and
suffixes; (4) always use the mark as it is registered; and (5)
accompany the mark with the trademark registration notice.
Effective adherence to these rules will impress upon the con-
suming public that the coined term functions as a trademark—
and only that.