

THE NATURE OF THE TRADE-MARK

W. L. P. A. MOLENGRAAFF

Rotterdam, Holland

An inquiry into the nature of the trade-mark is of considerable interest, because there is a tendency to extend the notion of the trade-mark beyond its proper and original limits. Thus, things which do not constitute trade-marks are protected as if they were trade-marks. This tendency is observed principally but not solely in those countries where an action for unfair competition is not allowed, as has been the case in Holland.¹ Hence it is of some importance to circumscribe with precision the concept of a trade-mark, and the interest protected under that name.

The statutes concerning trade-marks disclose the conception that a trade-mark is a symbol applied or attached to an article of manufacture, trade, or merchandise or to the covering in which it is sold in order to distinguish it from similar articles and to identify it with a particular manufacturer or trader.² Thus the trade-mark has an existence of its own, independently of the article or the goods to which it is applied or attached so as to indicate the relation of the article or goods to a particular person, manufacturer or trader. It is connected with the article or the goods only for the purpose of this identification. As soon as the relation of the article to the person who hitherto lawfully used the mark to indicate this relation, ceases, the trade-mark not being assigned and transferred, the connection between the mark and the goods is broken; the mark regains its separate existence.

The connection between the mark and an article of manufacture or trade is not the effect of a natural cause but of an act of man. It is clear from this reflection that, although every kind or class of symbols can be adopted as a trade-mark, properties and qualities of the article, its distinguishing characteristics, attributes and peculiarities, for

¹ Some uniform rules for the protection of industrial property were laid down in the International Convention at Paris in 1883 and were revised at Washington in 1911. The scheme of elaborating a more complete and ample international code has been discussed.

² Kerly, *Trade Marks* (4th ed. 1913) 24; Great Britain, Trade Marks Act, 1905, ch. 15, sec. 3 ("A mark used or proposed to be used upon or in connection with goods"); Kohler, *Warenzeichenrecht*, 72 ("*Das Warenzeichen ist etwas was auf der Ware angebracht wird*"); Act of Cong. Feb. 20, 1905, 33 Stat. L. 731, sec. 29.

example, its weight, color, shape, size, and character, cannot be used as a trade-mark.³ These properties are not applied or attached to the goods to distinguish them from similar goods, they form part of the goods and generally make them unlike other goods. Whatever may be the essence of these properties, they do not partake of the nature of the trade-mark, a symbol extrinsic to the article itself.

"Rights" of the nature of property in the character, the color, the shape or the size of a particular article may exist in some manner and degree; they may be protected by law, but such rights nevertheless are not trade-mark rights. The law of trade-marks does not extend to them; the protection of trade-marks cannot be claimed.

This is not a question of pure theory, for it has a practical significance. It is apparent that the character, the weight, the color, the shape of an article are not capable of being registered as a trade-mark, or of forming the principal part of a trade-mark. Their registration as trade-marks cannot produce any effect. No one is deprived by the mere fact of this registration of the privilege and power to give a similar article of his own manufacture the character, the weight, the color, the shape or the size he chooses.

Perhaps the character, the color, the shape or the size the manufacturer gives to his article may be the subject-matter for an application for a patent or an industrial design or model; perhaps the imitation of one of the properties of an article may give rise to an action for unfair competition or for "passing off";⁴ but in no case does the quality, the color, the shape or the size constitute a trade-mark of which the essence is that it be a symbol not inherent in the article but applied or attached to it.

This may be obvious, and yet it is sometimes forgotten, for it has been contended that the color or the shape of an article may constitute a trade-mark. To give an example, it is said that the manufacturer of cakes, who obtains the registration of the image of a die-stone or of an animal, like a lion or an eagle, as a trade-mark for cakes or biscuits, gets an "exclusive right" to make cakes or biscuits in the shape of the die-stone or the animal, represented by the image registered.

³ Act of Cong. Feb. 20, 1905, 33 Stat. L. 731, sec. 29; Great Britain, Trade Marks Act, 1905, sec. 9, sub-sec. 1 (4); Germany, *Gesetz zum Schutz der Warenzeichnungen*, May 12, 1894, sec. 4.

⁴ The action for infringement of a trade-mark is based upon the plaintiff's "title" to the exclusive use of the mark and the use of this mark by the defendant; the action for "passing off" on the fact that the defendant has been using some means, such as the imitation of the "get-up" of the plaintiff's goods, which are calculated to pass off the goods of the defendant as those of the plaintiff and that the plaintiff thereby sustained injury. In an action of the first class the plaintiff need merely prove the registration of the trade-mark in his name and the use of the mark by the defendant; in an action of the second class he must prove that the defendant has been using means which constitute a case of "passing off" as well as his injury thereby.

This is an erroneous view. It arises from a confusion of trade-mark rights and patent rights.⁵

The covering or envelope in which an article is sold also forms a part of it. There are many articles, for example, liquids, powders and others which cannot be manipulated without a covering; there are others for which a covering is not quite indispensable but very desirable. Many articles are not complete without a covering, and therefore are not sold without covering. This explains why the trade-mark laws do not require the application of the trade-mark to the article itself, but allow it to be attached to the covering. To some goods the trade-mark cannot be applied otherwise, viz., the goods for which a covering is indispensable. It is not feasible to attach a trade-mark to wine and other liquids, to powders, or to most foodstuffs, if they are not put in a covering. Consequently the covering itself cannot constitute the trade-mark which by most laws is distinguished from the article. For the same reason the substance, the color, the shape of the covering cannot be used as a trade-mark.⁶

It is not to be concluded from this, that the covering is not protected at all. The imitation of a covering may give rise to an action for "passing off." The covering is part of the get-up and protected as such. My proposition implies only that the nature of the trade-mark as a symbol, applied or attached to an article or its covering to indicate the connection that exists between the article and a particular person, excludes the possibility that the covering itself may be used as a trade-mark.

The French statute of June 23, 1857 on trade-marks states, however, in Article 1, subsection 2:

"sont considérées comme marques de fabrique et de commerce les noms sous une forme distinctive, les dénominations . . . enveloppes et tous autres signes servant à distinguer les produits d'une fabrique ou les objets d'un commerce."

It seems that the notion of the trade-mark is extended by this clause beyond its proper limits. For the purpose of protecting the property in coverings, like bottles, barrels, cases, etc., in which articles of manufacture or trade are sold, it is not necessary to assimilate these coverings with trade-marks. If the protection which gives rise to the action for "passing off" does not suffice, the registration of coverings, as distinct from trade-marks, could be introduced by statute.

⁵ A trade-mark "right" is the privilege to use a mark upon or in connection with a certain class of goods together with multital rights that others do not use this mark; a patent "right" is the privilege to manufacture and sell a specific article or to use a specific method of construction or fabrication together with multital rights that others do not do likewise. Of course, the possessor of either of these "rights" has, in addition to the above mentioned legal relations, other and different legal relations, including the power to alienate, etc.

⁶ Kohler, *op. cit.*

The label or ticket gives rise to the same question. The label or ticket should not be confounded with the trade-mark.⁷ The notion of the label is a notion more comprehensive than that of the trade-mark. The label may consist not merely of the trade-mark alone, but also of the trade-mark combined with a description of the qualities of the article, a direction for use or some other phrases or ornaments. The trade-mark may be printed on the label or be affixed to the article separate from the label. Therefore the label or ticket should be distinguished from the trade-mark and the protection of the label from the protection of the trade-mark. Independently of the trade-mark, even when a trade-mark is not impressed on the label, the label is protected by the action for "passing off." It is one of the elements of the get-up of the article.

More importance is attached to the distinction between the trade-mark as the symbol, indicating the connection which exists between certain merchandise and a particular manufacturer or trader, and the name of the article or merchandise. I do not mean the special names, which are used by a particular manufacturer or trader to distinguish similar articles made or sold by him, but the common names in use to denote all articles of a certain class by whomsoever made or sold.

The common names have not the distinctive force of the trade-mark.⁸ For this reason common names, like words merely descriptive of the goods themselves or of some quality or attribute which they possess or are supposed to possess or of the use that can be made of them, cannot be used and registered as trade-marks. Therefore the words "tobacco" and "cigars," "claro" and "amarillo," "strong" and "light," "cuba" and "sumatra" cannot be registered as trade-marks for tobacco or cigars. They certainly have an element of distinctiveness so as to indicate the character, the quality, the color or the place of origin of these articles, but they are not designed to connote also the maker or seller of the article.

As to existing common names of the trade there is no dissension. On the other hand a difficulty arises as to those names which have been invented for the purpose of distinctive reference to a particular trader and afterwards have fallen into common use. The trade-mark as a distinctive symbol is not limited to a geometrical figure or pictorial device. Words also are allowed as marks by nearly all statute laws on the subject.⁹

There are different opinions as to the essence of the word-mark.

⁷ The label is expressly distinguished from the trade-mark under the federal statutes. Act of Cong. June 18, 1874, sec. 3, 18 Stat. L. 79, sec. 3.

⁸ See Steiner, *Trade Names* (1910) 20 YALE LAW JOURNAL, 44.

⁹ Great Britain, Trade Marks Act, 1905, sec. 9, sub-sec. 1 (3) ("An invented word or invented words"); Germany *Gesetz zum Schutz der Warenzeichnungen*, sec. 4. "But no mark which consists . . . merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, . . . shall be registered under the terms of this Act." Act of Cong. Feb. 20, 1905, 33 Stat. L. 726, sec. 5 (b).

The essence of a word-mark may be found in the figurative aspect of the mark, the word being considered as a device composed of a particular succession of characters in a distinct form; the essence may be found in the representation of the word, the word being considered as a particular combination of characters, whatsoever be the form of the characters used; the essence may be found in the sense of the word, the word being considered as the expression of the idea it suggests; the essence may also be found in the sound of the word, the word being considered as the expression of the sound uttered by the human voice in pronouncing the word.

It is evident that what is protected by registration of the word-mark and what constitutes an infringement of the rights of the registered owner depends wholly on what is regarded as the essence of this mark. If the object of protection is the image of the successive characters in a distinct form, infringement will be the use of the same succession of letters in an identical or similar configuration.¹⁰

In the decisions of the courts there is a tendency to accept a very broad conception of the word-mark; it is considered to cover not alone the word itself but also the idea it suggests and the sound that is created by its pronunciation. Whatever may be the correct decision of this point, it must be remembered that the trade-mark in its essence is a symbol to distinguish an article of merchandise from similar merchandise of different origin, to denote the merchandise of a particular manufacturer or trader.

Registration confers only the exclusive privilege to use the mark for this purpose. The word-mark constitutes no exception. It does not confer and cannot confer a privilege and power to monopolize the word as the trade name of the merchandise. Therefore the registration of a word-mark does not interfere with the privilege or liberty every one enjoys to use the same word, not as a symbol of the origin of the merchandise, but simply as the name of it. The use of the word as the name of the merchandise, however, should not be ambiguous; precaution must be taken that the word does not create in the

¹⁰ If the object of protection is the image of the word, irrespective of the figurative aspect of the characters employed, infringement will be the use of an identical or similar combination of characters, i. e., a combination that produces on the public the same impression as the registered word, e. g., "sodex," "sodox," "sodaex," "sodes"; "victoria," "vittoria," "vitoria." If the object of protection is the image of the idea, expressed by the word, infringement will be the use of a device representing an identical or similar idea, even when the mode of expression is not a verbal one, e. g., "emperor" and "kaiser," "soleil" and "helios," "zero" and "null," "L," "fifty" and "50," "sun" and the picture of the sun, "lion" and the picture of a lion. If the object of protection is the image of the sound, uttered in pronouncing the word, infringement will be the use of a device representing a word of which the pronunciation produces an identical or similar sound, e. g., "zero" and "O," "knight" and "night," "bat" and "bed."

buying public the impression of indicating the origin of the merchandise, the impression that it is being used as a trade-mark.¹¹

The distinction between the trade-mark and the name is of singular importance as to word-marks, registered for articles for which a common trade name does not exist at the moment of registration.

New chemical compositions furnish a good illustration. The manufacturers of chemical preparations have a predilection for word-marks, the scientific names of these compounds not being adapted to current use. On the other hand, the adoption of a word-mark occasionally has undesired consequences. Soon after registration as a trade-mark the invented word may become the common trade name of the composition, because it is easily pronounced and kept in mind; henceforward it is used by the public to denote the article without any reference to its maker. The right that all others do not use the word-mark as a trade-mark is not lost in consequence, unless the law of trade-marks so provides. The word-mark privilege, however, does not cover the use of the word as the common trade name of the article, namely, the chemical composition; the use of the word in this sense is free to every one. To illustrate this by an example: It does not constitute an infringement of the rights of the owner of the word-mark "Citarin" if another manufacturer of chemical compositions sells his similar product under the name "Methylenocitras natricum, chemically identical with Citarin" or if he denotes his production on a label or on the covering by this phrase or only by the word "Citarin" in conjunction with his own trade-mark for chemical products and by his firm name. The same may be said of words like "Maizena," "Euchinin," "Tannigen," "Aspirin," "Pyramidon," etc., words which, although invented as trade-marks for particular articles by a particular manufacturer, have passed into use as common trade names for these articles and can be used as such by all manufacturers of this class of products.

The owners of these word-marks have no ground for complaint. The words have lost their characteristic feature as trade-marks because they are no longer known in the market as the distinctive names of the products of the particular manufacturers who are registered as the proprietors of these word-marks, but as the common names of anybody's products of the kind in question.

He who chooses a word-mark for a product for which a common trade name does not yet exist, e. g., for a newly invented chemical composition, must expect the development of the word of his invention into the common trade name of the product. He should, in choosing a trade-mark, take into consideration the fact that the trade and the public in general are in want of new names for newly invented pro-

¹¹ For an interesting and illustrative article on the privilege to use one's own name, see Steiner, *A Man and his Name* (1906) 25 YALE LAW JOURNAL, 341.

ducts that are brought into the market. The public interest opposes every attempt to infringe upon the liberty to satisfy this want.

The development of invented words, registered as trade-marks, into common trade names is of less frequent occurrence, if the word-mark is registered by the owner as a special mark to distinguish a particular brand or kind of his goods or articles from similar goods or articles of his own manufacture or trade. These special marks are used by the owner in conjunction with the general mark which he uses to distinguish all his products or articles of a particular class from similar products or articles made or sold by other manufacturers or traders. Yet examples may be cited where words registered as special marks have passed into common trade names for articles showing the same characteristics as the article for which the word-mark was registered. So the name "Planteur," which a manufacturer had invented to denote cigars of a particular form of his own manufacture, is known to have been adopted in the trade as the name of cigars of this particular form of whatsoever origin.

I would direct attention to the difference between the word-mark and the trade name, between the privileges, etc., conferred by registration of a word-mark and the similar interests with respect to the use of a trade name, inasmuch as they are often confounded. It has been contended that the registration of an invented name as a word-mark confers the exclusive privilege of applying or attaching the registered name to the article for which it is registered and to use it in connection with this article, not only to indicate, what is obvious, that the article is manufactured by the owner of the mark, but also to denominate the article itself; that is, to use it as a trade-mark and at the same time as the denomination of the article. Hence other manufacturers or traders, it is urged, should be prevented from selling similar articles under that name, although it might be used by the public at large as the common name of the article.

This assertion leads to the conversion of "property" in the trade-mark into "property" in a trade name. Accordingly, the use of the name should be absolutely forbidden to anybody else, even when there is no question of using it for the purpose of indicating the connection of the article with a particular manufacturer or trader. I believe this is an exaggeration, a misstatement that must be disapproved. The liberty of industry and commerce opposes monopoly or property in the nature of a patent in the use of any name, the more so because for certain articles a monopoly in the use of the name is equivalent to a monopoly in the nature of a patent in the manufacture of the article.

It is to be kept in mind that not every use of a name, but only such a use as is calculated to deceive buyers as to the origin of the goods, constitutes an infringement of the right of the registered owner of a word-mark. The action for "passing off" gives sufficient protection in all cases in which the use of the name does not constitute an

infringement of the name mark, but nevertheless is in some degree deceptive.¹²

The idea that property in a word-mark includes property in the name: the exclusive privilege of applying to the article the name suggested by the registered word, even if this word has passed into the common trade name of the article, has led to absurd consequences. The High Court of the Netherlands has rendered the strange decision¹³ that the manufacturer of pharmaceutical articles who applies to one of these articles the official name inserted in the pharmacopoeia, commits an infringement on the property in the trade-mark, composed of this name and registered on behalf of another manufacturer, even when there is no question of "passing off." Consequently, the owner of a registered word-mark for a pharmaceutical article should have the right to oppose as an infringement of his mark the use of the registered word or name as the name of the article by any other apothecary, chemist or dealer, although this word or name has been entered in the pharmacopoeia as the official name of the article and every precaution is taken not to deceive the public as to the origin of the article by using it in conjunction with the trade-mark and the trade name of its manufacturer. It seems that the court has neglected to appreciate fully the difference that exists between the trade-mark and the name of an article. This new idea of the trade-mark seems overstrained.

A right to the exclusive use of a name of an article of merchandise may be admitted, but should not be confounded with the right to the exclusive use of a trade-mark; it is an error to include in the trade-mark right the right to the name. The right to the trade name of an article, if it exists at all, is governed by its own rules according to its own nature and its own object.

The nature of the trade-mark also excludes the use of geographical names, e. g., Cognac, Champagne, Delft, Limoges, Sheffield as trade-marks.¹⁴ Geographical names may be used to distinguish similar articles connected with the place where they are manufactured or produced; they cannot be used to distinguish these articles in connection with the particular manufacturer or trader who manufactures them or who deals in them. The registration of a geographical name as a trade-mark for a particular article or class of goods does not prevent anybody from applying or attaching the name to similar articles or goods in order to denote the geographical or local origin. This does not imply that geographical names can be used arbitrarily; we argue only that the character and the protection of geographical names do not partake of the character and the protection of trade-marks. An action for "passing off" will probably afford an adequate remedy.

¹² See Lane, *Development of Secondary Rights in Trade-Mark Cases* (1909) 18 YALE LAW JOURNAL, 571.

¹³ Jan. 30, 1914, *Weekblad van het Recht*, no. 9633.

¹⁴ Great Britain, Trade Marks Act, 1905, sec. 9, sub-sec. 1 (4); Act of Cong. Feb. 20, 1905, 33 Stat. L. 726, sec. 5 (b).

From the nature of the trade-mark as a symbol to distinguish similar goods originating from a particular manufacturer or trader I conclude that the trade-mark does not cover the attributes of the article, its character, quality,¹⁵ form, color, etc., or the covering or envelope, or the label (*etiquet*), or its common trade name, or the name of its geographical origin. The protection of all these interests is not covered by the protection of the trade-mark; they are governed by their own rules, which do not form a part of the law of trade-marks.

¹⁵ Act of Cong. Feb. 20, 1905, 33 Stat. L. 726, sec. 5 (b).