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GENERICIDE: CANCELLATION OF A REGISTERED TRADEMARK

INTRODUCTION

The purpose of a trademark is to indicate to the public that goods come from a particular source.¹ The use of trademarks is regulated by the Lanham Act (Act).² Congress created the Act in order to protect a trademark owner in his use of a particular mark and to prevent public confusion concerning the source of goods.³ Registration of a mark

1. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412-13 (1916). A trademark is defined by federal statute 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." 15 U.S.C. § 1127 (1976). Judge Learned Hand wrote that a manufacturer's trademark "is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. . . . [A] reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask." *Yale Elecs. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928). As one court stated, "[a] trade-mark is a trade-mark because it is indicative of the origin of the goods." *G.&C. Merriam Co. v. Saalfeld*, 198 F. 369, 372 (6th Cir. 1912), *aff'd in part*, 238 F. 1 (6th Cir.), *cert. denied*, 243 U.S. 651 (1917).

Trademarks have been used for hundreds of years. They were developed in order to trace responsibility for shoddy workmanship. Rogers, *The Lanham Act and the Social Function of Trade-marks*, 14 Law and Contemp. Probs. 173, 173-74 (1949). For a comprehensive discussion of trademark law, see generally L. Amdur, *Trademark Law and Practice* (Lanham Act ed. 1948); 3 R. Callmann, *the Law of Unfair Competition, Trademarks and Monopolies* (3d ed. 1969 & Supp. 1982); 1 J. McCarthy, *Trademarks and Unfair Competition* (1973); E. Vandenburg, *Trademark Law and Procedure* (2d ed. 1968).

2. Pub. L. No. 79-489, 60 Stat. 427 (1946) (current version at 15 U.S.C. §§ 1051-1127 (1976)). Federal registration of a trademark serves as notice to the public of an ownership claim. *Id.* § 1072. The trademark owner is granted exclusive use of his mark, *id.* § 1057(b), so that all others are prohibited from affixing that mark to similar goods. *Id.* § 1114(1). Four categories of marks have been recognized for determining whether registration of a term is appropriate: 1) arbitrary (a common term, used in an unfamiliar manner); 2) fanciful (a newly created or coined term), or suggestive (a term requiring imagination to link it to the trademarked goods); 3) descriptive (a mark that describes a quality or characteristic of the trademarked product and will be registered only if the term has acquired a secondary meaning, so that the public associates the term with the producer); and 4) generic (a term that is the common name for a type of goods, is part of the general vernacular and which will not be registered as a trademark). *See, e.g., Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014-15 (9th Cir. 1979); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131-32 (2d Cir. 1979); *Educational Dev. Corp. v. Economy Co.*, 562 F.2d 26, 28 (10th Cir. 1977); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976); *Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 692, 697-98 (D.N.J. 1982); *Discount Muffler Shop, Inc. v. Meineke Realty Corp.*, 535 F. Supp. 439, 444-45 (N.D. Ohio 1982); *Nature's Bounty, Inc. v. Superx Drugs Corp.*, 490 F. Supp. 50, 53 (E.D.N.Y. 1980).

3. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274.

creates a presumption that it is valid;⁴ however, the Act provides that a registered mark may be cancelled if it has become the "common descriptive name" for a product.⁵ In other words, a mark may be cancelled if it has lost its trademark significance and become generic.⁶ A generic term, such as the word "car," designates a type or class of goods, rather than indicating that the product comes from a single source.⁷

The traditional standard for determining genericness is based on how the public perceives the contested mark⁸—whether consumers understand the mark to mean only a type of product, or whether they recognize the name as being source indicative.⁹ A new standard,

4. 15 U.S.C. § 1057(b) (1976); *e.g.*, *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982); *Playboy Enters. v. Chuckleberry Publishing Inc.*, 687 F.2d 563, 567 (2d Cir. 1982); *American Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106 (2d Cir. 1978); *Venetianaire Corp. of Am. v. A & P Import Co.*, 429 F.2d 1079, 1080 n.1 (2d Cir. 1970); *Miss Universe, Inc. v. Patricelli*, 408 F.2d 506, 509 (2d Cir. 1969); *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 316 (2d Cir. 1958); *Trak Inc. v. Ski-Trac, Inc.*, 209 U.S.P.Q. (BNA) 507, 510 (N.D. Cal. 1980).

5. 15 U.S.C. § 1064(c) (1976). Although this section provides that cancellation may be granted on several grounds, this Note addresses only the issue of genericness, and all references to cancellation concern cancellation based on a finding that a mark is the common descriptive name for a product.

6. "A 'generic' term 'conveys information with respect to the nature or class of an article,' while a trademark identifies the *source* of a particular product or article." *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 523 n.43 (E.D.N.Y. 1975) (quoting 3 R. Callmann, *supra* note 1, § 70.4, at 111); *see* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 579 (2d Cir. 1963); *Discount Muffler Shop, Inc. v. Meineke Realty Corp.*, 535 F. Supp. 439, 444 (N.D. Ohio 1982); *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

7. *Carcione v. Greengrocer, Inc.*, 205 U.S.P.Q. (BNA) 1075, 1077 (E.D. Cal. 1979) ("If the primary significance of the term in the minds of the consuming public is that the term refers to the producer and not to the general class of goods or services, then the term is not generic."); *accord* *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1016 (9th Cir. 1979).

8. The public perception test has been consistently applied in cancellation cases. *See, e.g.*, *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962); *Ross-Whitney Corp. v. Smith Kline & French Labs.*, 207 F.2d 190, 194-95 (9th Cir. 1953); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 81 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 445 (D. Or. 1978); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 523 (E.D.N.Y. 1975); *Stix Prods., Inc. v. United Merchants & Mfrs.*, 295 F. Supp. 479, 490 (S.D.N.Y. 1968); *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921); 3 R. Callmann, *supra* note 1, § 74.2, at 237; 1 J. McCarthy, *supra* note 1, § 12:2(A), at 406-07.

9. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 77 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921); *R. Guastavino Co. v. Comerma*, 180 F. 920, 921 (C.C.S.D.N.Y. 1910); *L. Amdur, supra* note 1, at 310-12.

however, was recently established by the Ninth Circuit in *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*,¹⁰ which examines purchasers' motivation for buying trademarked goods in order to determine whether those goods constitute their own product category (genus).¹¹ Under this standard, if a court finds that the trademarked goods constitute a distinct genus, the relevant mark would be the generic name for that category of goods, its registration would be subject to cancellation, and its use available to everyone.¹²

The *Anti-Monopoly* case raises the dual question of what standard should be applied in determining whether a registered trademark has become generic, and what burden of proof must be met to satisfy the appropriate standard. This Note concludes that public perception is the correct standard and proposes a set of factors to be considered in determining how the public perceives the contested mark. The Note further contends that the policy concerns of the Act mandate placing a heavy burden of proof on the party that is challenging a trademark's validity.

I. THE PROPER TEST: PUBLIC MOTIVATION OR PUBLIC PERCEPTION?

A. Defining the Tests

Although the Act does not set forth a standard for determining whether a registered mark has become generic, Judge Learned Hand established such a test in the early 1900's: "The single question . . . is merely one of fact: What do the buyers understand by the word for whose use the parties are contending?"¹³ This standard, the public perception test, has consistently been applied in cancellation proceedings.¹⁴ It is the correct standard to apply because it focuses on the ultimate purpose of a trademark—to denote that marked goods have been produced by a single manufacturer—and evaluates whether consumers understand that the mark indicates one manufacturer's goods.¹⁵ An evaluation of public understanding serves the Act's basic

10. 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

11. *Id.* at 1324-25. For the appellate court's first decision in this case, see *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 611 F.2d 296, 302-04 (9th Cir. 1979).

12. 611 F.2d at 302-03.

13. *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

14. See *supra* note 8.

15. See, e.g., *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979); *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 513 F.2d 1226, 1226 (9th Cir. 1975) (Ely, J., concurring); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 580 (2d Cir. 1963); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-701 (2d Cir. 1961); *Independent Nail & Packing Co. v. Stronghold Screw Prods., Inc.*, 205 F.2d 921, 925-26 (7th Cir.), *cert. denied*, 346 U.S. 886 (1953); *Le Blume Import Co. v. Coty*, 293 F. 344, 353-58 (2d Cir. 1923); *Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 692, 698 (D.N.J.

objectives of protecting valid trademarks and preventing public confusion concerning the origin of goods.¹⁶ If consumers recognize the trademark as a brand name, they will not be confused concerning the goods' origin. Thus, because the term is fulfilling the proper function of a trademark, it should be afforded the full protection of the law.

In *Anti-Monopoly*, however, the Ninth Circuit established a different standard for determining whether a registered mark has become generic.¹⁷ The court's analysis focused on an evaluation of whether the relevant trademarked goods constitute an entire genus, or merely a species.¹⁸ A genus is a broad category or class of goods (laundry soap, for example), whereas a species is one of many similar products making up a larger category of goods¹⁹ ("Tide" is a species of laundry soap). Under the Ninth Circuit standard, a term may be generic even though the public recognizes the contested term as a brand name, which is source indicative, if the court finds that the trademarked goods constitute their own genus.²⁰ This determination is made by evaluating why consumers purchase the trademarked goods.²¹ The court reasoned that consumers' motivation for buying the relevant goods would indicate whether the product is unique, or so different from other manufacturers' products that it should be considered to be its own genus.²²

The court employed a two-part public opinion survey designed to ascertain public motivation in purchasing the trademarked goods, Parker Brothers' real estate trading board game, "Monopoly." Consumers were first asked simply to state their reasons for purchasing the

1982); *Loctite Corp. v. National Starch & Chem. Corp.*, 516 F. Supp. 190, 199 (S.D.N.Y. 1981).

16. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274; *accord* *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1228 (3d Cir. 1978); *Smith v. Chanel, Inc.*, 402 F.2d 562, 566 (9th Cir. 1968); *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 122-23 (9th Cir.), *cert. denied*, 391 U.S. 966 (1968); *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J., specially concurring); *In re National Distillers & Chem. Corp.*, 297 F.2d 941, 951-53 (C.C.P.A. 1962) (Rich, J., concurring); D. Robert, *The New Trade-Mark Manual* xx-xxi (1947).

17. See 684 F.2d at 1324-25.

18. See *id.* at 1324; *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 611 F.2d 296, 302-04 (9th Cir. 1979). The Ninth Circuit reasoned that a product can change from being a species into being a genus if "a product's popularity is such that its mark is no longer primarily source-identifying, the product itself, though originally a species of another generic class, 'becomes its own genus' and its name is then deemed generic." 3 R. Callmann, *supra* note 1, § 74.5, at 88 (Supp. 1982).

19. See *Surgicenters of Am., Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

20. See 684 F.2d at 1322-24.

21. *Id.* at 1324-25.

22. 611 F.2d at 302-04.

trademarked goods.²³ Reasons relating to the product itself were considered an indication that the product constituted a genus.²⁴ Examples of such reasons included that the game was interesting, educational, fun or a family game.²⁵ Durability, price and quality were classified as source-related reasons indicating that "Monopoly" is only a species.²⁶

The second part of the test involved asking those interviewed which of the following statements best expressed their reasons for buying the trademarked goods: "I would like Parker Brothers' 'Monopoly' game primarily because I like Parker Brothers' products"—an indication that the consumers are buying for source-related reasons; or "I want a 'Monopoly' game primarily because I am interested in playing 'Monopoly,' I don't much care who makes it"—a product-related reason.²⁷

The Court of Customs and Patents Appeals recently rejected the idea that a unique product should be deemed to constitute a new product category and therefore be denied the exclusive use of its trademark name.²⁸ The special concurring opinion specifically rejected the purchaser motivation test, stating that the public's reasons for buying products are "legally immaterial" in determining whether a mark is generic, and that such a determination should not depend upon how broadly or narrowly the court defines the genus of goods.²⁹ Similarly, in *Bayer Co. v. United Drug Co.*,³⁰ the landmark case in which Judge Learned Hand set forth the public perception test, the court noted that a trademark's validity should not rigidly depend

23. 684 F.2d at 1324.

24. *See id.* at 1324-25.

25. *Id.* at 1324.

26. 611 F.2d at 303.

27. 684 F.2d at 1324.

28. *In re DC Comics, Inc.*, 689 F.2d 1042, 1045 (C.C.P.A. 1982). In *SK & F Co. v. Premo Pharmaceutical Labs., Inc.*, 481 F. Supp. 1184, 1188 (D.N.J. 1979), *aff'd*, 625 F.2d 1055 (3d Cir. 1980), the district court afforded protection to the contested trademark (the trade dress of the goods) based on the fact that the product was unique and no similar product existed on the market.

29. *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., specially concurring); *accord* 1 J. McCarthy, *supra* note 1, § 12:6, at 417 ("[T]he problem of defining a genus of products is merely a secondary test to the ultimate question: What do buyers think the word means?").

The district court in *Anti-Monopoly* also rejected the motivation survey, stating that the dispositive issue was not why the public buys "Monopoly" sets, but rather what they understand the term "Monopoly" to mean. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448, 454 (N.D. Cal. 1981), *rev'd*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983). Based on the cumulative weight of the evidence, the district court found that the term "Monopoly" was not generic. *Id.* The appellate court reversed that finding as being "clearly erroneous." 684 F.2d at 1322-26.

30. 272 F. 505 (S.D.N.Y. 1921).

upon differentiating between goods that constitute a genus and those that constitute a species.³¹

B. *The Aftermath of Anti-Monopoly*

Even the strongest trademarks are threatened by the purchaser motivation test.³² Two surveys concerning the trademark "Tide" clearly illustrate this concern. In one survey, 89% of those interviewed recognized "Tide" as a brand name.³³ Under the public perception test, "Tide" would be considered a very strong trademark because it clearly denotes source to the public. In a survey based on the purchaser motivation test, however, more than two-thirds of those interviewed gave product-related reasons for purchasing "Tide";³⁴ therefore, "Tide" would constitute its own genus and be subject to cancellation as being generic. In response to the "Tide" survey, the court in *Anti-Monopoly* stated:

[The] results tend to show that the general public regards "Tide" as the name of a particular detergent, having particular qualities, rather than as one producer's brand name for the same detergent which is available from a variety of sources If the general public does think this . . . Proctor and Gamble might have cause for alarm.³⁵

Many trademarks would be threatened if unique products, or trademarked goods that are substantially different from other manufacturers' goods, are classified as being a genus unto themselves.³⁶ Manufac-

31. *Id.* at 513.

32. See *Petition for Certiorari, CPG Prods. v. Anti-Monopoly, Inc.*, No. 82-1075 (U.S. Dec. 23, 1982), reprinted in 25 *Pat. Trademark & Copyright J.* (BNA) 189, 189 (1983); 3 R. Callmann, *supra* note 1, at § 74.5, at 90 (Supp. 1982).

33. Brief for Parker Brothers as Defendant, Counterclaimant and Appellee at 15, *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

34. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1326 (9th Cir. 1982), cert. denied, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

35. *Id.*

36. See *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 611 F.2d 296, 303 (9th Cir. 1979). In *E.R. Squibb & Sons, Inc. v. Cooper Labs., Inc.*, 536 F. Supp. 523 (S.D.N.Y. 1982), the district court applied the genus/species test and found that the plaintiff's trademark "Angle" was generic. It concluded that the term "Angle" designates a category or genus of goods: all toothbrushes with bent handles. *Id.* at 528. The court focused on defining the genus, rather than examining public perception of the contested mark and noted that "little direct evidence of the public's understanding of the term was presented." *Id.* The court also noted that if the trademark owner were permitted to retain exclusive use of the term as a trademark, competitors would still be able to describe products that were similar to the trademarked product. *Id.* See *infra* pt. II(A) for a discussion of the need for alternative terms.

turers generally promote their goods based on the products' unique qualities.³⁷ Many manufacturers spend fortunes publicizing their goods with the idea that if the public associates the trademark with a desirable characteristic of the product, such as quality or social status, consumers will be persuaded to buy the trademarked goods.³⁸ Producers often emphasize that their goods differ from other manufacturers' goods by advertising a special taste, an unsurpassed cleaning power, a secret recipe or an unusually challenging game.³⁹ Who is to say which product qualities may safely be promoted without causing the trademarked goods to be classified as a genus and which may not? The purchaser motivation test attempts to establish precisely such a delineation.

An analogy may be made to antitrust law by applying the rationale set forth by the Supreme Court:

A retail seller may have in one sense a monopoly on certain trade because . . . no one else makes a product of just the quality or attractiveness of his product, as for example in cigarettes. Thus one can theorize that we have monopolistic competition in every non-standardized commodity with each manufacturer having power over the price and production of his own product. However, this power that, let us say, automobile or soft-drink manufacturers have over their trademarked products is not the power that makes an illegal monopoly [T]here are certain differences in the formulae for soft drinks but one can hardly say that each one is an illegal monopoly.⁴⁰

Although products differ from one another, it can hardly be said that such differences create entirely new categories of goods, requiring denial of trademark rights.⁴¹

Under the purchaser motivation standard, a product constitutes its own genus if consumers indicate that they are interested in buying the product, but do not care who makes it.⁴² This implies that consumers

37. *In re DC Comics, Inc.*, 689 F.2d 1042, 1053-54 (C.C.P.A. 1982) (Nies, J., specially concurring); *see Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1223 (8th Cir.) (the uniqueness of the product's design entitled the product to trademark protection), *cert. denied*, 429 U.S. 861 (1976).

38. *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 122 (9th Cir.), *cert. denied*, 391 U.S. 966 (1968).

39. *In re DC Comics, Inc.*, 689 F.2d 1042, 1053-54 (C.C.P.A. 1982) (Nies, J., specially concurring).

40. *United States v. E. I. DuPont de Nemours & Co.*, 351 U.S. 377, 392-93 (1956)(footnotes omitted).

41. *In re DC Comics, Inc.*, 689 F.2d 1042, 1045 (C.C.P.A. 1982) ("[A]ppellant cannot be considered to have created a new product category, the rubric of which . . . should remain available for all to employ in commerce, simply by having originated and promoted . . . [a] unique [product].").

42. *See Anti-Monopoly Inc. v. General Mills Fun Group*, 684 F.2d 1316, 1324 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

must know the identity of the producer for a trademark to be valid.⁴³ An individual, however, is generally unaware of who makes the trademarked goods,⁴⁴ and usually a person's primary objective is to buy particular goods and not to seek out a particular producer per se.⁴⁵ Trademark law has traditionally afforded protection to marks that indicate source, even though the source is anonymous.⁴⁶ The value of a trademark is that it permits consumers to be confident that they are getting the goods they have asked for and want to receive.⁴⁷ The trademark becomes the manufacturer's symbol in place of his name⁴⁸ so that purchasers need not know the identity of the manufacturer; rather, they need only know that a trademark identifies the excellence of his work.⁴⁹

C. Legislative Policies

Both the public perception test and the concept that a mark may be valid even though the producer is anonymous were set forth more than twenty years before the Act was adopted.⁵⁰ In passing the Act, Congress intended to remedy certain judicial interpretations of the trademark law that existed at that time.⁵¹ It did not establish an alternative test for determining genericness, nor did it indicate that a producer's name need be known by the public as a prerequisite to trademark validity.

43. See 3 R. Callmann, *supra* note 1, § 74.5, at 89-90 (Supp. 1982).

44. E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 512 & n.8 (E.D.N.Y. 1975); 3 R. Callmann, *supra* note 1, § 82.2(a), at 774; *id.* § 84.1, at 935.

45. *In re* DC Comics, Inc., 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., specially concurring).

46. See, e.g., McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1131 (2d Cir. 1979); Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 381 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); Feathercombs, Inc. v. Solo Prods. Corp., 306 F.2d 251, 255 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962); Tas-T-Nut Co. v. Variety Nut & Date Co., 245 F.2d 3, 7 (6th Cir. 1957); Crescent Tool Co. v. Kilborn & Bishop Co., 247 F. 299, 300 (2d Cir. 1917); National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 658-59 (W.D. Wash. 1982); E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 512 (E.D.N.Y. 1975); Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921); 3 R. Callmann, *supra* note 1, § 74.2, at 235-36.

47. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274; *accord In re* National Distillers & Chem. Corp., 297 F.2d 941, 952 (C.C.P.A. 1962)(Rich, J., concurring); D. Robert, *supra* note 16, Introduction at xxi.

48. Yale Elecs. Corp. v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928).

49. See R. Guastavino Co. v. Comerma, 184 F. 549, 550 (S.D.N.Y. 1911).

50. See Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

51. S. Rep. No. 1333, 79th Cong., 2d Sess. 5, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1276.

Disregarding public understanding of a mark runs counter to the basic teachings of trademark law⁵² and loses sight of the underlying goals of the Act.⁵³ A determination of whether a registered mark has become generic should be based on public perception of the contested term, rather than on public motivation for purchasing the trademarked goods.

II. PROPOSED FACTORS FOR DETERMINING GENERICNESS

Public understanding of a mark is an amorphous concept⁵⁴ for which no single definitive evidentiary factor exists. Moreover, courts have failed to establish a standard set of factors to be examined in evaluating public perception. Evaluating the validity of a mark based on a cohesive group of factors would further the goals of the Act by ensuring consistency in the application of trademark law.⁵⁵ Such factors should include: 1) availability of alternative terms; 2) likelihood of confusion; 3) public opinion surveys; 4) secondary meaning; 5) advertising and sales; and 6) manner and length of use. These factors have all been used at different times in cancellation or trademark infringement cases and should be considered as a group whenever a trademark is challenged as generic.

A. *The Availability of Alternative Terms*

A primary consideration in cancellation proceedings is whether there are terms, other than the contested mark, that can be used to accurately describe the relevant goods.⁵⁶ This factor should be given

52. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 81 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *accord* 3 R. Callmann, *supra* note 1, § 74.2, at 237.

53. *See In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J., specially concurring).

54. *See McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1133 (2d Cir. 1979); *Del Labs, Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 781 (S.D.N.Y. 1981); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975); 3 R. Callmann, *supra* note 1, § 82.1(1), at 757; *see also* *HMH Publishing Co. v. Brincat*, 504 F.2d 713, 716 (9th Cir. 1974) ("[D]octrinal confusion, conflicting results, and judicial prolixity" are the "hallmarks" of trademark infringement cases, which also involve an examination of whether the public associates a trademark with a single source.).

55. *See* S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274.

56. *See, e.g.*, *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 663 (7th Cir. 1965); *Ross-Whitney Corp. v. Smith Kline & French Labs.*, 207 F.2d 190, 195 (9th Cir. 1953); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 79-80 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *Bayer Co. v. United Drug Co.*, 272 F. 505, 510-11 (S.D.N.Y. 1921); *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 445 (D. Or. 1978).

considerable weight in determining whether a term is generic because the doctrine of genericness is based on the concept that manufacturers and consumers should be able to describe goods that are similar or identical to the trademarked goods.⁵⁷ If the public knows the product by only one description, no individual will be granted the exclusive use of that name.⁵⁸

The term "aspirin," for example, had been used generically by the producer and the public for more than a decade⁵⁹ and was found to be generic because it had become the only name by which the public knew that particular kind of drug.⁶⁰ The only alternative description available to competitors marketing the same product was "acetyl salicylic acid," a complicated term with which the public was unfamiliar.⁶¹

Granting exclusive use of a term that is the only publicly recognizable name for a category of goods unfairly limits competition⁶² because it confers a monopoly on the trademark owner by rendering competitors unable to describe their goods effectively.⁶³ Competitors are hampered in the sale of their goods, and consumers cannot easily discover whether products similar to the trademarked goods are available from other sources. If adequate synonyms are available, however, permitting a trademark owner to retain exclusive rights in a mark does not handicap competitors or consumers.⁶⁴ Widespread use of alternative terms may prove that competitors do not need the contested mark to describe their goods.⁶⁵ Moreover, trademark protec-

57. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976); *Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir.), *cert. denied*, 400 U.S. 916 (1970); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 663 (W.D. Wash. 1982); *Del Labs., Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 780 n.1 (S.D.N.Y. 1981) (quoting *Reese Publishing Co. v. Hampton Int'l Communications, Inc.*, 620 F.2d 7, 10 (2d Cir. 1980)); *L. Amdur*, *supra* note 1, at 310.

58. *L. Amdur*, *supra* note 1, at 310; see *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 445 (D. Or. 1978); 1 J. McCarthy, *supra* note 1, § 12:2(F), at 409-10.

59. *Bayer Co. v. United Drug Co.*, 272 F. 505, 510-12 (S.D.N.Y. 1921).

60. *Id.*

61. *Id.* at 511.

62. *Smith v. Chanel, Inc.*, 402 F.2d 562, 566-69 (9th Cir. 1968).

63. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975).

64. *L. Amdur*, *supra* note 1, at 310.

65. *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 447 (D. Or. 1978); see *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 483-84 (S.D.N.Y. 1968) (contested term was found valid; alternative descriptions had been used by competitors for many years to describe similar products); *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J. 1952) (same), *aff'd*, 206 F.2d 144 (3d Cir.), *cert. denied*, 346 U.S. 867 (1953).

tion may be afforded to the contested mark even though existing synonyms are not generally used.⁶⁶ Along the same lines, consideration should be given to whether use of the contested trademark is necessary to describe certain goods or whether a challenging party simply hopes to reap the benefits of the owner's advertising and goodwill. Whether a competitor is "riding the coattails" of the trademark owner⁶⁷ is frequently a factor in trademark infringement cases.⁶⁸

A valid trademark does not, by itself, constitute a restraint of trade.⁶⁹ When the Act was passed, Congress specifically stated that trademark protection does not foster monopolies.⁷⁰ Moreover, as noted by one court, "it is significant that in almost every reported instance where the antitrust misuse of a trademark has been raised as a defense, it has been rejected."⁷¹ Trademark protection bars competi-

66. See *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 526 (E.D.N.Y. 1975).

67. *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 356-57 (9th Cir. 1948).

68. See, e.g., *Spring Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1134 (2d Cir. 1982); *James Burrough Ltd. v. Sign of Beekeeper, Inc.*, 540 F.2d 266, 277 (7th Cir. 1976); *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 122 (9th Cir.), cert. denied, 391 U.S. 966 (1968); *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 356-57 (9th Cir. 1948); *SK & F Co. v. Premo Pharmaceutical Labs., Inc.*, 481 F. Supp. 1184, 1190 (D.N.J. 1979), aff'd, 625 F.2d 1055 (3d Cir. 1980).

Interestingly, in *Anti-Monopoly* the plaintiff first marketed his game under the name "Bust the Trust" with unsuccessful results. After changing the name to "Anti-Monopoly," the plaintiff sold more than 400,000 games, making almost a million dollars. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 195 U.S.P.Q. (BNA) 634, 636-37 (N.D. Cal. 1977), rev'd and remanded, 611 F.2d 296 (9th Cir. 1979), on remand, 515 F. Supp. 448 (N.D. Cal. 1981), rev'd, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983). As one court noted, it is sometimes difficult to understand why a manufacturer would choose "a mark that had long been employed . . . and had become known to the trade instead of adopting some other means to identify its goods . . . unless there was a deliberate purpose to obtain some advantage . . . which [the trademark owner] had built up." *Miles Shoes, Inc. v. R.H. Macy & Co.*, 199 F.2d 602, 603 (2d Cir. 1952), cert. denied, 345 U.S. 909 (1953); *accord Spring Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1135 (2d Cir. 1982); *American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 562-63 (2d Cir. 1953).

69. S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, reprinted in 1946 U.S. Code Cong. Serv. 1274, 1275; see *Smith v. Chanel, Inc.*, 402 F.2d 562, 566 (9th Cir. 1968) (use of trademarks promotes competition by enabling consumers to identify goods that please them); see also *Rogers, supra* note 1, at 175 (Without trademarks, "[t]here would be competition, to be sure, but it would be competition to see who could make the worst goods, not the best; and he would win whose product was the cheapest, poorest, and most dishonest.").

70. S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, reprinted in 1946 U.S. Code Cong. Serv. 1274, 1275.

71. *Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jena*, 298 F. Supp. 1309, 1314 (S.D.N.Y. 1969), aff'd, 433 F.2d 686 (2d Cir. 1970), cert. denied, 403 U.S. 905 (1971). But see *Borden, Inc. v. FTC*, 674 F.2d 498, 512 (6th Cir. 1982) ("When a seller possesses an overwhelmingly dominant share of the market, . . . and differenti-

tors from using one particular term but does not prevent the competitive production and sale of identical goods.⁷² Except for the contested term, a wealth of other words and phrases is available to competitors to describe their goods to the public.⁷³

Modern advertising techniques have greatly enhanced a manufacturer's ability to describe his product to the public.⁷⁴ Recognition of this fact is appropriate in light of the Act's objective of conforming trademark law to "present-day" business practices.⁷⁵ Advertising that involves visual representations, such as television, billboards, magazine and newspaper ads, permits a manufacturer to reinforce the description of the product with a picture of the goods. As a result, the manufacturer is able to illustrate to the public the type of goods he is attempting to sell, thus reducing a producer's need for a single term to describe his product.

Comparative advertising also enhances a competitor's ability to communicate with the public, providing a tool by which he can educate consumers concerning the goods he is attempting to sell.⁷⁶ A competitor may actually use the contested trademark in his advertising to clarify what he is selling.⁷⁷ For example, the defendant's use of the trademark "T.V. Guide" in a television commercial was found to be acceptable comparative advertising.⁷⁸ The defendant used the

ates its product from others through a recognized and extensively advertised brand name, thereby enabling the seller to control prices or unreasonably restrict competition, then monopoly power may be found to exist.").

72. *Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jena*, 298 F. Supp. 1309, 1314 (S.D.N.Y. 1969), *aff'd*, 433 F.2d 686 (2d Cir. 1970), *cert. denied*, 403 U.S. 905 (1971); see *National Football League Properties, Inc., v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 663 (W.D. Wash. 1982) ("Plaintiffs do not seek to prohibit the manufacture of jerseys, only jerseys which bear their marks. The jerseys are the product and not the marks.").

73. *R. Guastavino Co. v. Comerma*, 184 F. 549, 550 (S.D.N.Y. 1911); *accord Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 317 (2d Cir. 1958); *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 361 (9th Cir. 1948); *Coca-Cola Co. v. Old Dominion Beverage Corp.*, 271 F. 600, 604 (4th Cir.), *cert. denied*, 256 U.S. 703 (1921); *Formica Corp. v. Newnan Corp.*, 396 F.2d 486, 488 (C.C.P.A. 1968) (quoting *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910)).

74. See *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 317 (2d Cir. 1958) ("[T]he ingenuity of the public relations profession supplies new words and slogans as they are needed.").

75. S. Rep. No. 1333, 79th Cong., 2d Sess. 5, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1276.

76. *Seven-Up Co. v. No-Cal Corp.*, 191 U.S.P.Q. (BNA) 202, 209 (E.D.N.Y. 1976); see *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 776 (9th Cir. 1981); *Smith v. Chanel, Inc.*, 402 F.2d 562, 565 (9th Cir. 1968); Lee, *Comparative Advertising, Commercial Disparagement and False Advertising*, 71 Trade-Mark Rep. 620, 621 (1981).

77. *E.g.*, *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 776 (9th Cir. 1981); *Smith v. Chanel, Inc.* 402 F.2d 562, 563-64 (9th Cir. 1968).

78. *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 445 F. Supp. 875, 877-78 (S.D. Fla. 1978), *aff'd*, 626 F.2d 1171 (5th Cir. 1980).

trademark to inform the public about the type of product it produced. The commercial stated:

This is a T.V. Guide. When you buy it . . . that's all you get. . . .
This is the Miami Herald's T.V. Book. When you buy it . . . you
get . . . extras.⁷⁹

Using this kind of advertising, a manufacturer marketing a board game similar or identical to "Monopoly" could develop an ad that says: "Here is our new real estate trading board game. It's just like Parker Brothers' game, 'Monopoly,' but ours is better because . . ."

In evaluating a trademark's validity, considerable weight should be given to the question of whether alternative terms exist that may be used to describe goods similar to the trademarked product. In making this evaluation, the competitors' enhanced ability to describe their goods as a result of modern day marketing techniques and comparative advertising should be taken into account.

B. Likelihood of Confusion

A major objective of the Act is to prevent public confusion concerning the origin of goods.⁸⁰ Congress intended to regulate the use of trademarks in such a manner that consumers could be confident that when purchasing a trademarked product they would in fact get the goods they intended to receive.⁸¹ In determining whether a mark should be deemed generic, an evaluation should be made as to whether cancellation would result in confusion concerning the origin of goods bearing the contested mark.⁸² One court noted that cancellation should be granted only "[i]f the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, and . . . [therefore induced] to believe that he is buying the goods of the original trader."⁸³ In other words, cancellation should not be

79. *Id.* at 877 n.4.

80. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274.

81. *Id.* at 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274. Trademark law attempts to "minimize confusion of the public as to the origin of the product and to avoid diversion of customers misled by a similar mark." *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1228 (3d Cir. 1978); *accord Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 692, 698 (D.N.J. 1982); *see Rogers, supra* note 1, at 176.

82. *See Brooks Bros. v. Brooks Clothing, Ltd.*, 60 F. Supp 442, 453 (S.D. Cal. 1945) (The likelihood of confusion "is inherent in the use of the . . . [contested mark] by anyone but the plaintiff."), *aff'd per curiam*, 158 F.2d 798 (9th Cir.), *cert. denied*, 331 U.S. 824 (1947).

83. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936) (quoting *Ford v. Foster*, 7 L.R.-Ch. 611, 628 (Ch. App. 1870)); *see also L. Amdur, supra* note 1, at 304 (same).

granted if confusion is likely to result from an appreciable number of buyers associating the contested mark with a single source and, after cancellation, being unaware that the cancelled mark may be used by other manufacturers.⁸⁴

In trademark infringement cases, courts will act to prevent confusion when "there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled or indeed simply confused, as to the source of the goods in question."⁸⁵ When surveys have indicated that as little as 11% to 25% of the public might be deceived, courts have granted trademark protection to the relevant term to avoid confusion.⁸⁶ Application of a similar standard is appropriate in cancellation proceedings because both trademark infringement and cancellation cases focus on whether the public perceives a mark as indicating that goods derive from, or are associated with, a particular source.⁸⁷ In a case in which a large percentage of the public associates the contested term with the producer, such as the *Anti-Monopoly* case,⁸⁸ the likelihood of confusion becomes even more significant. The best indicator of probable confusion is evidence showing that there have been instances of actual confusion.⁸⁹ Therefore, in a

84. See *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412-13 (1916) ("The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another."), quoted in *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 84 (3d Cir. 1982); *S.C. Johnson & Son v. Johnson*, 116 F.2d 427, 429 (2d Cir. 1940) ("[T]he wrong involved is diverting trade from the first user by misleading customers who mean to deal with him."); 3 R. Callmann, *supra* note 1, § 74.2, at 236 (a trademark should not be cancelled if "part of the public continues to associate the mark with a particular . . . source").

85. *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (per curiam, *cert. denied*, 439 U.S. 1116 (1979)); *accord* *Spring Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1129 (2d Cir. 1982); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1130 (2d Cir. 1979); 3 R. Callmann, *supra* note 1, § 84, at 929.

86. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 385-86 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *e.g.*, *Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (25%); *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 279 (7th Cir. 1976) (15%); *Jockey Int'l, Inc. v. Burkard*, 185 U.S.P.Q. (BNA) 201, 205 (S.D. Cal. 1975) (11.4%).

87. See, *e.g.*, *Coca-Cola Co. v. Overland Inc.*, 692 F.2d 1250, 1254 n.10 (9th Cir. 1982) (cancellation case); *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977) (same), *cert. denied*, 434 U.S. 1070 (1978); *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976) (trademark infringement case); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 387 (7th Cir.) (same), *cert. denied*, 429 U.S. 830 (1976).

88. The survey accepted by the Ninth Circuit indicated that more than 55% of the public associated the term "Monopoly" with a single source. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1322-23 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

89. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 383 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 45-46 (5th

cancellation proceeding, evidence of actual confusion is another factor to be examined.

The competitive need to describe goods similar to the trademarked goods must be balanced against the risk that a number of buyers who know and use the term as a trademark will be deceived if other manufacturers use that mark.⁹⁰ If the possibility of confusion exists, protection of consumers "must be given primary consideration."⁹¹

C. Public Opinion Surveys

No generally accepted formula for determining public perception by means of a survey has been established by the courts,⁹² even though survey evidence is often employed in cases concerning public perception.⁹³ Conclusions regarding public understanding may vary dramatically, depending upon the survey used.⁹⁴ In a case pertaining to the trademark "Teflon,"⁹⁵ for example, one survey indicated that 68% of the purchasers considered "Teflon" to be a brand name,⁹⁶ so that it denoted source and was therefore a valid trademark. A different

Cir. 1975); Spangler Candy Co. v. Crystal Pure Candy Co., 353 F.2d 641, 643-44 (7th Cir. 1965); Standard Oil Co. v. Standard Oil Co., 252 F.2d 65, 74 (10th Cir. 1958).

90. American Thermos Prods. Co. v. Aladdin Indus., 207 F. Supp. 9, 27 (D. Conn. 1962), *aff'd sub nom.* King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577 (2d Cir. 1963); Marks v. Polaroid Corp., 129 F. Supp. 243, 270 (D. Mass. 1955), *aff'd*, 237 F.2d 428 (1st Cir. 1956), *cert. denied*, 352 U.S. 1005 (1957).

91. American Thermos Prods. Co. v. Aladdin Indus., 207 F. Supp. 9, 27 (D. Conn. 1962), *aff'd sub nom.* King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577 (2d Cir. 1963); *see* Black Hills Jewelry Mfg. Co. v. LaBelle's, 489 F. Supp. 754, 756 (D.S.D.) ("Under the Lanham Act the interests of the public are supreme."), *aff'd*, 633 F.2d 746 (8th Cir. 1980).

92. Standard Oil Co. v. Standard Oil Co., 141 F. Supp. 876, 887 (D. Wyo. 1956), *aff'd*, 252 F.2d 65 (10th Cir. 1958); *see* American Thermos Prods. Co. v. Aladdin Indus., 207 F. Supp. 9, 21 (D. Conn. 1962), *aff'd sub nom.* King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577 (2d Cir. 1963).

93. *See, e.g.*, Squirtco v. Seven-Up Co., 628 F.2d 1086, 1091 (8th Cir. 1980); James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 277-79 (7th Cir. 1976); Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 386 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 525-28 (E.D.N.Y. 1975); Jockey Int'l Inc. v. Burkard, 185 U.S.P.Q. (BNA) 201, 205 (S.D. Cal. 1975); American Thermos Prods. Co. v. Aladdin Indus., 207 F. Supp. 9, 20-22 (D. Conn. 1962), *aff'd sub nom.* King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577 (2d Cir. 1963); *In re Raytheon Co.*, 202 U.S.P.Q. (BNA) 317, 319-20 (Trademark Trial & App. Bd. 1979); *see also* 1 J. McCarthy, *supra* note 1, § 12:2(G), at 410 ("Since the ultimate test of genericness is customer usage, consumer survey evidence is relevant to the generic significance of a term.").

94. *See* E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 525-27 (E.D.N.Y. 1975); N.Y. Times, Oct. 27, 1982, at B1, col. 1.

95. E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502 (E.D.N.Y. 1975).

96. *Id.* at 526.

survey, however, indicated that 86% of the consumers considered it to be the common descriptive term for a type of product,⁹⁷ which would mean that the term was generic. Similarly, in *Anti-Monopoly*, the surveys introduced by the parties also reached opposite conclusions concerning public perception of the mark.⁹⁸

One expert in the field of public opinion surveys has asserted that different responses may be elicited simply by rearranging certain questions in the survey.⁹⁹ Another polling expert has commented that if five surveys were conducted, there would be five different results.¹⁰⁰ Given these inconsistencies,¹⁰¹ survey evidence should not be afforded great weight, but rather it should be used only to corroborate evidence presented by the other factors discussed in this Part.¹⁰²

The Ninth Circuit, however, relied on a survey as compelling evidence that the mark "Monopoly" had become generic.¹⁰³ In this survey, interviewers described a board game involving the buying, selling and trading of real estate, in which the winner succeeded in bankrupting opponents.¹⁰⁴ Approximately 80% of the interviewees who were familiar with the goods described said that if they were to buy such a game they would ask for "Monopoly."¹⁰⁵ The court therefore held that the term "Monopoly" was generic, based on the premise that the public uses the name of the game to denote the game itself rather than its producer.¹⁰⁶ A similar survey had been used in the case involving the trademark "Teflon."¹⁰⁷ Yet, the *Teflon* court rejected the survey's

97. *Id.* at 525.

98. *See Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1321-24 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983). Four separate surveys were introduced as evidence: 1) the "Brand-name" survey; 2) the "Thermos" survey; 3) the "Motivation" survey; and 4) the "Tide" survey. *Id.* at 1323-26.

99. N.Y. Times, Oct. 27, 1982, at B1, col. 5.

100. *Id.* at B5, cols. 3-4.

101. Surveys may not accurately reflect public perception because many individuals "do not take the same trouble to avoid confusion when they are responding to sociological investigators as when they spend their cash." *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 660-61 n.4 (2d Cir. 1979) (quoting *American Luggage Works, Inc. v. United States Trunk Co.*, 158 F. Supp. 50, 53 (D. Mass. 1957)), *cert. denied*, 445 U.S. 951 (1980); *accord Hawley Prods. Co. v. United States Trunk Co.*, 259 F.2d 69, 78 (1st Cir. 1958); *General Motors Corp. v. Cadillac Marine & Boat Co.*, 226 F. Supp. 716, 737-38 (W.D. Mich. 1964).

102. *See American Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9, 20-21 (D. Conn. 1962), *aff'd sub nom. King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963); *Monsieur Henri Wines, Ltd. v. Duran*, 204 U.S.P.Q. (BNA) 601, 606 (Trademark Trial & App. Bd. 1979).

103. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1323-24 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

104. *Id.* at 1323.

105. *Id.*

106. *Id.*

107. *See E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 525 (E.D.N.Y. 1975) ("Survey I").

validity because the survey focused on obtaining the name that consumers would use to ask for the goods described, without regard to what they understood the name to mean.¹⁰⁸

A trademark is often used by the public to identify both the product and the producer.¹⁰⁹ As one court stated, a mark should not be deemed "generic merely because it has *some* significance to the public as an indication of the nature or class of an article. . . . [T]o become generic the *principle* significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin."¹¹⁰ The public's understanding of a term as being indicative of both product and producer was well illustrated in a case involving the trademark "Dictaphone."¹¹¹ Almost all of the non-expert witnesses presented by the challenging party testified that the name "Dictaphone" was generally used to designate a type of product.¹¹² This would indicate that the term had become generic. Cross-examination revealed, however, that although the witnesses used the name to refer to a type of product, they knew that the term was in fact a trademark for a specific manufacturer's goods.¹¹³ The mark was therefore valid because it was source indicative. The witnesses also stated that they were aware of alternative descriptions for the relevant goods, such as "dictating machines" or "dictation equipment."¹¹⁴

That consumers request a product by the name given to the goods by the manufacturer does not negate the mark's source-denoting func-

108. *Id.* at 527 (The dispositive issue is not what purchasers would ask for; rather it is whether they recognize the term as a brand name or whether they view it solely as a common descriptive term for a category of goods.); see *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J. 1952) ("Instances of use of the word . . . in a generic sense . . . do not of themselves necessarily establish that the buyers' understanding is that it is the name of a kind of goods sold."), *aff'd*, 206 F.2d 144 (3d Cir.), *cert. denied*, 346 U.S. 867 (1953).

109. *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., specially concurring). Courts have recognized the dual function of a name. *E.g.*, *Life Savers Corp. v. Curtiss Candy Co.*, 182 F.2d 4, 8 (7th Cir. 1950); *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J. 1952), *aff'd*, 206 F.2d 144 (3d Cir.), *cert. denied*, 346 U.S. 867 (1953); *R. Guastavino Co. v. Comerma*, 180 F. 920, 921 (C.C.S.D.N.Y. 1910).

110. *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962); *accord Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 n.10 (9th Cir. 1982); *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977), *cert. denied*, 434 U.S. 1070 (1978); 1 J. Gilson, *Trademark Protection & Practice*, § 2.02(1), at 2-11 to 2-14 (1976).

111. *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437 (D. Or. 1978).

112. *Id.* at 445.

113. *Id.*

114. *Id.*

tion.¹¹⁵ As described by one court, “[w]hen a person informs us that he has bought a Ford, he need not add that it was an automobile. And when he buys a Stetson, we know that he is buying a hat.”¹¹⁶ The name indicates both product and producer; therefore, a survey indicating that the public would use a trademark to ask for certain goods described to them is ambiguous. Such a survey fails to clarify the primary significance of the name used.¹¹⁷

In *Anti-Monopoly*, another survey—the “brand name” survey—was conducted in which consumers were asked to classify various words as either a common name for an item (the word “car” was given as an example of a common name) or as a brand name (e.g. “Chevrolet”).¹¹⁸ The results indicated that 63% of the population recognized the term “Monopoly” as a brand name.¹¹⁹ This survey duplicated the method that had been accepted by the court in the “Teflon” case.¹²⁰ Nevertheless, the Ninth Circuit rejected this survey because a “brand name” was defined as a term indicating a product made by one company.¹²¹ The court stated that “[u]nder the survey definition, ‘Monopoly’ would have to be a ‘brand name’ because it is made by only one company.”¹²² Yet, this rationale presupposes that the public is aware that only one company produces “Monopoly,” which, if true, would show that the term is source indicative. In any case, the definition used is appropriate because the purpose of a brand name is to indicate to the public that the goods are made by a single producer.¹²³

That a product is manufactured by only one company is irrelevant in determining a mark’s validity.¹²⁴ As stated by Judge Learned Hand,

115. *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., specially concurring) (“Such a given name is a proper name, like the name of an individual, not a generic name, so long as the public uses it to identify a product of a single source.”); see *Petition for Certiorari, CPG Prods. v. Anti-Monopoly, Inc.*, No. 82-1075 (U.S. Dec. 23, 1982), *reprinted in* 25 *Pat. Trademark & Copyright J.* (BNA) 189, 189-90 (1983).

116. *Brooks Bros. v. Brooks Clothing, Ltd.*, 60 F. Supp. 442, 454 (S.D. Cal. 1945), *aff’d per curiam*, 158 F.2d 798 (9th Cir.), *cert. denied*, 331 U.S. 824 (1947).

117. See *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 580 (2d Cir. 1963); *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 527 (E.D.N.Y. 1975).

118. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1323 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

119. *Id.* at 1321.

120. See *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 527 (E.D.N.Y. 1975).

121. 684 F.2d at 1323.

122. *Id.*

123. See *supra* note 1.

124. *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., specially concurring).

"all that is needed for a valid trade-mark is that the name should indicate the manufacture of the owner, whether there are other manufacturers or not."¹²⁵

The "brand name" survey appears to present the most reliable evidence concerning public perception because it addresses the essential question of a term's primary significance and the public's understanding of it.¹²⁶

In surveys used to ascertain public perception of a contested mark, the trademarked goods should be shown to the interviewees, packaged as the goods would normally be at the time of sale.¹²⁷ Asking questions pertaining to trademarked goods that the interviewees can see better reflects the reality of the marketplace than do questions posed in the abstract.¹²⁸

D. Secondary Meaning

Another factor to be examined in a cancellation proceeding is whether the challenged mark has acquired and retained a secondary meaning. If the public associates the relevant trademarked goods with a single source, the mark is said to have acquired a secondary meaning.¹²⁹ Consequently, the term has become a brand name, and its

125. *R. Guastavino Co. v. Comerma*, 180 F. 920, 921 (C.C.S.D.N.Y. 1910).

126. *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 527 (E.D.N.Y. 1975) ("[T]he public is quite good at sorting out brand names from common names.").

127. *See, e.g., Amercian Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 660-61 n.4 (2d Cir. 1979), *cert. denied*, 445 U.S. 951 (1980); *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 277-78 (7th Cir. 1976); *National Football League Properties, Inc. v. Dallas Cap & Emblem Mfg. Inc.*, 26 Ill. App. 3d 820, 823, 327 N.E.2d 247, 250 (1975); *see also Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (Likelihood of confusion "is based on an examination of the marks as a whole, including visual impression."); *In re Abcor Dev. Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978) ("Evidence of the context in which a mark is used on labels, packages, or in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark.").

128. A trademark should be examined in relation to normal buying conditions. *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1137 (2d Cir. 1979); *see Spring Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1133 (2d Cir. 1982); *Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); *Grotrian, Helfferich, Schulz, Th. Steinweg Nechf. v. Steinway & Sons*, 523 F.2d 1331, 1341-42 (2d Cir. 1975); *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429, 433 (7th Cir. 1943); *Del Labs., Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 782-83 (S.D.N.Y. 1981) (quoting 3 R. Callmann, *supra* note 1, § 82.2(c), at 807); *In re Abcor Dev. Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978).

129. *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1219 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912), *aff'd in part*, 238 F. 1 (6th Cir.), *cert. denied*, 243 U.S. 651 (1917); *National Football League Properties, Inc. v. Wichita*

primary significance is necessarily source indicative.¹³⁰ As such, the mark should not be cancelled.

The Ninth Circuit, however, stated that a registered mark might be invalid even if more than 50% of the public associates the mark with one producer.¹³¹ The court incorrectly based its conclusion on *Kellogg Co. v. National Biscuit Co.*,¹³² in which the Supreme Court held that the term "shredded wheat" was generic even though many people associated the product with a single manufacturer.¹³³ The doctrine of secondary meaning could not be applied in that particular case¹³⁴ because the contested mark had been used generically for many years before the case was heard and moreover, had been denied trademark registration based on a finding that the term was generic.¹³⁵

Courts have consistently held that if a term is originally generic, and therefore part of the common vernacular prior to registration or use, the term cannot acquire secondary meaning and thus be granted trademark protection.¹³⁶ A registered mark, however, is presumed to be non-generic¹³⁷ and may acquire secondary meaning.¹³⁸ In *Anti-*

Falls Sportswear, Inc., 532 F. Supp. 651, 658 (W.D. Wash. 1982); *Black Hills Jewelry Mfg. Co. v. LaBelle's*, 489 F. Supp. 754, 756-57 (D.S.D.), *aff'd*, 633 F.2d 746 (8th Cir. 1980); 3 R. Callmann, *supra* note 1, § 77.2, at 346.

130. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912), *aff'd in part*, 238 F. 1 (6th Cir.), *cert. denied*, 243 U.S. 651 (1917); *see Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 256 (2d Cir.) (a registered mark becomes non-distinctive and generic when it loses its secondary meaning), *cert. denied*, 371 U.S. 910 (1962); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 663 (W.D. Wash. 1982) (contested mark was not generic based on proof of secondary meaning, and the likelihood that confusion would result from use by a producer other than the trademark owner); 3 R. Callmann, *supra* note 1, § 74.2, at 236-37 (trademark should not be cancelled so long as "part of the public continues to associate the mark with a particular, albeit unknown, source").

131. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1322-23 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

132. 305 U.S. 111 (1938).

133. *Id.* at 118-19.

134. *Id.*

135. *Id.* at 116, 118.

136. *E.g.*, *Purolator, Inc. v. EFRA Distribs., Inc.*, 687 F.2d 554, 562 (1st Cir. 1982); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960); *see* 1 J. McCarthy, *supra* note 1, § 15:7, at 534 ("Once determined to be a generic designation of a class of goods, no amount of evidence of purported secondary meaning can give legal protection to that generic term.").

137. *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 775-76 (9th Cir. 1981); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976); *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 317 (2d Cir. 1958); *see* 15 U.S.C. § 1115(a) (1976).

138. *See McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131-32 (2d Cir. 1979); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir.), *cert.*

Monopoly, the Ninth Circuit failed to distinguish between terms originally generic and terms that have been granted registration, which are therefore presumed to be valid.¹³⁹

E. Advertising and Sales

In cancellation proceedings, courts should also consider the amount of time, money and energy expended by the trademark owner in promoting his trademark, together with the volume of sales generated.¹⁴⁰ These factors are already consistently used to evaluate whether a term has acquired a secondary meaning,¹⁴¹ based on public perception. They are particularly valuable because no scientifically accurate method of measuring public understanding exists.¹⁴²

In *Anti-Monopoly*, the district court gave weight to the fact that Parker Brothers had made a substantial investment in the promotion

denied, 429 U.S. 830 (1976). If a term is generic before registration, it "already belongs to the public." *G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912), *aff'd in part*, 238 F. 1 (6th Cir.), *cert. denied*, 243 U.S. 651 (1917). This differs from a cancellation proceeding in which it must be determined that a word which has been used exclusively by the trademark owner for some period of time has become *publici juri*. See *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 661 (2d Cir. 1970) (the "Shredded Wheat" case was distinguished because the term "shredded wheat" was originally generic, whereas the contested term in *Bassett* was merely descriptive, and therefore could acquire a secondary meaning). Similarly, in *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976), the court stated that the defendant was wrong in relying on the "Shredded Wheat" case "for the proposition that . . . a particular name is incapable of acquiring a secondary meaning even through long and exclusive use with a single product," *id.* at 1219 n.12, which is the proposition upon which the Ninth Circuit relied. The Eighth Circuit explained that on the facts of the "Shredded Wheat" case, the doctrine of secondary meaning was inapplicable for policy reasons; "the courts will never apply the 'secondary meaning' doctrine so as to create monopoly rights." *Id.* (quoting *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961)).

139. See *Petition for Certiorari, CPG Prods. v. Anti-Monopoly, Inc.*, No. 82-1075 (U.S. Dec. 23, 1982), *reprinted in* 25 *Pat. Trademark & Copyright J. (BNA)* 189, 189 (1983).

140. This consideration is consistent with the underlying objective of the Act to protect a trademark owner who "has spent energy, time, and money" to promote his trademarked goods. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274.

141. See, e.g., *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 82 (3d Cir. 1982); *Faberge, Inc. v. Saxony Prods., Inc.*, 605 F.2d 426, 428 (9th Cir. 1979); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1133 n.4 (2d Cir. 1979); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 483 (S.D.N.Y. 1968); *La Maur, Inc. v. Alberto-Culver Co.*, 179 U.S.P.Q. (BNA) 607, 610 (D. Minn. 1973), *aff'd per curiam*, 496 F.2d 618 (8th Cir.), *cert. denied*, 419 U.S. 902 (1974); 3 R. Callmann, *supra* note 1, § 77.3, at 349.

142. See *supra* note 101.

and policing of the "Monopoly" trademark.¹⁴³ On appeal, however, the Ninth Circuit discounted these factors, stating that a trademark owner's investment in a mark does not of itself create protectable rights.¹⁴⁴ The court based its reasoning on the premise that promotion of a mark is irrelevant unless the trademark owner succeeds in convincing consumers that the term is primarily source indicative.¹⁴⁵ This premise, however, begins with the conclusion that such promotion has failed to convince the public; in the initial determination of whether a term is source indicative, the amount of expenditures is an important factor to be considered.

Both advertising and the sale of the trademarked goods can have a substantial impact on how the public perceives the mark. Both bring the trademark to the consumers' attention and act as reminders that the trademark is a brand name,¹⁴⁶ thereby educating the public to recognize a term as the hallmark of a particular manufacturer.¹⁴⁷ A large quantity of sales may indicate that purchasers are pleased with the goods produced by that particular manufacturer and have thus chosen to continue purchasing that brand of goods.¹⁴⁸ Consequently, the source-denoting value of a mark may be greatly strengthened by a trademark owner's expenditure of time, money and energy, and by a large volume of sales.¹⁴⁹

Another case involving the "Monopoly" trademark, heard by the Trademark Trial and Appeals Board¹⁵⁰ during the period of time that the *Anti-Monopoly* case was being tried and appealed in the Ninth Circuit, illustrates the importance of these factors. A subsequent user of the term "Monopoly" was prohibited from registering it as a brand name for wearing apparel because such use was likely to cause confusion concerning the source of the goods. The Board accorded weight

143. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448, 454 (N.D. Cal. 1981), *rev'd*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

144. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1322 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

145. *Id.* at 1322-23 (citing *HMH Publishing Co. v. Brincat*, 504 F.2d 713, 719 (9th Cir. 1974)).

146. *See Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 701-02 (2d Cir. 1961).

147. *See Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975); 3 R. Callmann, *supra* note 1, § 82.1, at 756.

148. *See Smith v. Chanel, Inc.*, 402 F.2d 562, 566-67 (9th Cir. 1968).

149. *See Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 701 (2d Cir. 1961); *National Lead Co. v. Wolfe*, 223 F.2d 195, 197 n.1 (9th Cir.), *cert denied*, 350 U.S. 883 (1955); *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 356 (9th Cir. 1948); *Car-Freshner Corp. v. Auto Aid Mfg. Corp.*, 201 U.S.P.Q. (BNA) 233, 238 n.10 (N.D.N.Y. 1979).

150. *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 U.S.P.Q. (BNA) 396 (Trademark Trial & App. Bd. 1979), *aff'd*, 648 F.2d 1335 (C.C.P.A. 1981).

to the fact that Parker Brothers had used the term "Monopoly" for over forty years, actively policing and promoting its use.¹⁵¹ Recognizing that the manufacturer had sold more than 80 million "Monopoly" game sets and had invested more than \$5 million on advertising,¹⁵² the Board concluded that the game "enjoys an enormous popularity, and the term 'MONOPOLY' . . . is the symbol of a widespread, pervasive, and very favorable goodwill."¹⁵³ Extensive advertising and steady sales present circumstantial evidence¹⁵⁴ that a mark has acquired the type of distinctiveness described by the Board. An inference may therefore be drawn that the endeavors of the trademark owner have resulted in a public awareness that the contested mark is a brand name and source indicative.¹⁵⁵

F. Manner and Length of Use

The Senate hearings pertaining to the Act indicate that a mark should not be cancelled solely because of the public's misuse of that term; rather, cancellation should be granted only when misuse by the public is coupled with misuse by the trademark owner.¹⁵⁶ By using a generic term in conjunction with the use of the trademark to describe the product, the owner may provide the public and other manufacturers with an alternative method of describing the product and thereby prevent public misuse.¹⁵⁷

151. *Id.* at 398-99.

152. *Id.* at 398.

153. *Id.* at 400. The Board commented that "Monopoly" "falls within that category of marks known as 'famous' marks." *Id.*

154. *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 701-02 (2d Cir. 1961); *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 440-41 (D. Or. 1978); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975); *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 827-29 (C.C.P.A. 1970).

155. The steady promotion of a mark "impregnate[s] the atmosphere of the market with the drawing power of a congenial symbol," *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942), so that it becomes "more likely than not" that the trademark owner has succeeded in establishing a public awareness of the source-denoting value of the contested mark. *W. E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 661 (2d Cir. 1970); see *Kampgrounds v. North Del. A-OK Campground, Inc.*, 415 F. Supp. 1288, 1293 (D. Del. 1976) (the contested mark had become distinctive as a trademark through the promotional efforts maintained by the trademark owner over a long period of time), *aff'd*, 556 F.2d 566 (3d Cir. 1977).

156. D. Robert, *supra* note 16, at 34 ("[A] company that has a good trade-mark and is making every effort to maintain its rights, should not lose the right because the public wants to use that name." (quoting Senate hearings on H.R. 82, 78th Cong., 2d Sess. 103)).

157. See *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975); *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 482-83 (S.D.N.Y. 1968).

In many instances, improper use of a trademark by its owner has been responsible for the term's becoming generic.¹⁵⁸ The terms "aspirin"¹⁵⁹ and "cellophane,"¹⁶⁰ for example, were used generically by the trademark owners to define the product being sold. The product labels provided no indication that the terms were meant to denote source, or were brand names.¹⁶¹ The manufacturer of "Singer" sewing machines also advertised his product as "Singers" without using the generic designation, "sewing machines."¹⁶² In each instance, generic use of the term had become so widespread and pervasive that the public knew of no other terms to describe the relevant goods.¹⁶³ In addition, the trademark owners of "thermos" and "cellophane" acquiesced in the generic use of the terms by the public for an extended period of time.¹⁶⁴ Although both manufacturers subsequently attempted to regenerate the value of their marks as source indicative, the efforts made were too few and too late.¹⁶⁵ On the other hand, the

158. 3 R. Callmann, *supra* note 1, § 74.2, at 240-42; *see, e.g.*, Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 180 (1896); Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655, 663 (7th Cir. 1965); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 78-80 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); Bayer Co. v. United Drug Co., 272 F. 505, 510-12 (S.D.N.Y. 1921); Questor Corp. v. Dan Robbins & Assocs., 199 U.S.P.Q. (BNA) 358, 364 (Trademark Trial & App. Bd. 1978), *aff'd*, 599 F.2d 1009 (C.C.P.A. 1979).

Because the trademark owner is powerless to control the manner in which the mark is used in dictionaries, journals and newspapers, cancellation based on evidence of generic use in such publications has been criticized. *See* James Huggins & Sons v. Avenarius Bros., 106 U.S.P.Q. (BNA) 271, 272-73 (C.C.P.A. 1955); *In re Bridge*, 170 U.S.P.Q. (BNA) 428, 430 (Trademark Trial & App. Bd. 1971); 1 J. McCarthy, *supra* note 1, § 12:9, at 422-23. *See generally* Robb, *Trademark Misuse in Dictionaries: Inadequacy of Existing Legal Action and a Suggested Cure*, 65 Marq. L. Rev. 179 (1981). Affording weight to dictionary usage has also been criticized because it indicates the lexicographer's perception of the mark, but does not necessarily reflect public understanding of the term. *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1021 (9th Cir. 1979) (Goodwin, J., dissenting); *see Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699 (2d Cir. 1961).

159. Bayer Co. v. United Drug Co., 272 F. 505, 510-11 (S.D.N.Y. 1921).

160. DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 78-80 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936).

161. *Id.*; Bayer Co. v. United Drug Co., 272 F. 505, 510-11 (S.D.N.Y. 1921).

162. Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 180-81 (1896).

163. *Id.* at 180; DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 79-80 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); Bayer Co. v. United Drug Co., 272 F. 505, 510 (S.D.N.Y. 1921); Q-Tips, Inc. v. Johnson & Johnson, 108 F. Supp. 845, 863 (D.N.J. 1952), *aff'd*, 206 F.2d 144 (3d Cir.), *cert. denied*, 346 U.S. 867 (1953).

164. King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577, 578-79 (2d Cir. 1963); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 78-80 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *see* E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 528 (E.D.N.Y. 1975); Stix Prods., Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 483 n.11 (S.D.N.Y. 1968).

165. King-Seeley Thermos Co. v. Aladdin Indus., 321 F.2d 577, 578-79 (2d Cir. 1963); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 78-80 (2d Cir.),

trademark owner of "Teflon" had consistently used a generic term to describe the trademarked goods whenever the trademark was used, and for many years had fought misuse of the term by others.¹⁶⁶ One court noted that the strength of a trademark is "an amorphous concept with little shape or substance when divorced from the mark's commercial context, including an appraisal of the owner's policing efforts to ensure that whatever distinctiveness or exclusivity has been achieved is not lost through neglect, inattention, or consent to infringing use."¹⁶⁷

The length of time for which a mark has been used is also important in this respect.¹⁶⁸ A mark is strong if it is distinctive;¹⁶⁹ it is distinctive if consumers have been educated to recognize it as the symbol of a particular source.¹⁷⁰ As one commentator has noted, "[i]t seems to follow as a necessary conclusion that the trade-mark has the advantage of strength where its owner . . . can point to a long period of time during which his mark was used on a great quantity of articles, as symbolic of his business."¹⁷¹ The Act itself recognizes the importance of the length of use by the trademark owner; it provides that exclusive and continuous use of a mark for a period of five years is prima facie evidence that the mark has acquired a secondary meaning and is therefore source indicative.¹⁷²

Each of the factors discussed in Part II can be valuable in determining the validity of a trademark. Cancellation, however, should not be based on a random analysis of miscellaneous factors, but rather should be based on the weight of the evidence presented by a coherent group of factors, applied in a consistent manner.

cert. denied, 299 U.S. 601 (1936); see *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975).

166. *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975); see *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 446 (D. Or. 1978) (court noted that the trademark owner had consistently taken action to prevent misuse of the contested term).

167. *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975).

168. See, e.g., *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 82 (3d Cir. 1982); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); *La Maur, Inc. v. Alberto-Culver, Co.*, 179 U.S.P.Q. (BNA) 607, 611 (D. Minn. 1973), *aff'd per curiam*, 496 F.2d 618 (8th Cir.), *cert. denied*, 419 U.S. 902 (1974); see also *Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974) (the longer a trademark has been used, "the greater may be the number of facts . . . to be considered in determining the quantum of proof required").

169. *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978); *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976); *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 440 (D. Or. 1978); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975); see *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 701-02 (2d Cir. 1961).

170. *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978).

171. 3 R. Callmann, *supra* note 1, § 82.1, at 756, *quoted in* *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir. 1978).

172. 15 U.S.C. § 1052(f) (1976).

III. THE APPROPRIATE BURDEN OF PROOF

In determining how the public perceives a contested trademark, the point at which sufficient evidence has been presented to prove that the contested mark has become generic is unclear.¹⁷³ Although the factors to be considered permit the court to give weight to both the need of competitors to describe their products¹⁷⁴ and the consumers' need to be protected against confusion concerning source,¹⁷⁵ the factors enumerated afford very little opportunity to weigh the interests of the trademark owner. In light of the Lanham Act's basic objective of protecting both the goodwill the owner has developed and his investment in the trademark,¹⁷⁶ weight should be given to the harm that cancellation may cause the trademark owner.¹⁷⁷ His interests, therefore, should be an important element in selecting the proper burden of proof.

A registered trademark often has substantial value to the trademark owner;¹⁷⁸ it may actually be a company's most valuable asset,¹⁷⁹ con-

173. See *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. (BNA) 437, 445 (D. Or. 1978); *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829 (C.C.P.A. 1970).

174. See *supra* pt. II(A).

175. See *supra* pt. II(B).

176. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, 5, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274, 1276; see *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) ("The redress that is accorded in trade-mark cases in based upon the party's right to be protected in the good-will of a trade or business."); *Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1403 (C.C.P.A. 1974) ("The problem of achieving [the] legislative purpose of the Act becomes apparent from the variable factors which can be present in [a] . . . cancellation proceeding: degree of likelihood of confusion, relative length of time of use of a mark, and relative investment in good will by the parties."). The addition of § 1064(c), providing for cancellation of a registered mark, does not appear to have altered the underlying goals of the Act. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 375-76 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976) (citing *D. Robert*, *supra* note 16, at 138).

177. See *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 664 (2d Cir. 1979) (the equities involved must be weighed, trademark infringement case), *cert. denied*, 445 U.S. 951 (1980); *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 49 (2d Cir. 1978) (*per curiam*), *cert. denied*, 439 U.S. 1116 (1979); *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 534 (2d Cir. 1964); *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61, 78 (N.D. Cal. 1972), *aff'd per curiam*, 513 F.2d 1226 (9th Cir. 1975); see also 3 R. Callmann, *supra* note 1, § 74.3(c), at 252 ("It appears highly inequitable to deprive a pioneer of the very substantial value in the goodwill of his trademark, which took time and money to establish.").

178. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916), *quoted in* *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 84 (3d Cir. 1982); *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1003 (C.C.P.A. 1967). Assets involving millions of dollars are often at stake. See, e.g., *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 483 (S.D.N.Y. 1968) (trademark

stituting the cornerstone upon which a successful business has been built. Cancellation might well be destructive to such a business,¹⁸⁰ causing a loss of patrons and damage to the trademark owner's reputation.¹⁸¹ If members of the public continue to associate the term with the trademark owner, cancellation of the mark may damage his reputation because work bearing that mark will be attributed to him.¹⁸² Customers may be so dissatisfied with the product they have purchased that they will not buy that product again or any other product that they believe comes from the original trademark owner.¹⁸³

One court concluded that both the Act and "fair competition [require] that those who invest time, money and energy into the development of goodwill and a favorable reputation be allowed to reap the advantages of their investment."¹⁸⁴ In a case involving the well-known trademark "Coke,"¹⁸⁵ the Supreme Court recognized and gave weight to the tremendous goodwill that the producer had developed in his trademark. Writing for the Court, Justice Holmes observed that the trademark had acquired a meaning "in which perhaps the product is more emphasized than the producer but to which the producer is entitled."¹⁸⁶

Registration of a mark creates a strong presumption of validity,¹⁸⁷ and "[t]he general presumption of validity resulting from federal registration includes the specific presumption that the trademark is

for goods with sales of \$90 million over a fifteen-year period); *Questor Corp. v. Dan Robbins & Assocs.*, 199 U.S.P.Q. (BNA) 358, 362 (Trademark Trial & App. Bd. 1978) (sales of approximately \$14 million over a six-year period), *aff'd*, 599 F.2d 1009 (C.C.P.A. 1979).

179. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942); *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J., specially concurring).

180. *In re Myers*, 201 F.2d 379, 383-84 (C.C.P.A. 1953); *see Questor Corp. v. Dan Robbins & Assocs.*, 199 U.S.P.Q. (BNA) 358, 364 (Trademark Trial & App. Bd. 1978), *aff'd*, 599 F.2d 1009 (C.C.P.A. 1979).

181. *See Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 967 (2d Cir. 1981); *Smith v. Chanel, Inc.*, 402 F.2d 562, 566 n.13 (9th Cir. 1968).

182. *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 356-57 (9th Cir. 1948); *see Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 967 (2d Cir. 1981); *Maier Brewing Co. v. Fleishmann Distilling Corp.*, 390 F.2d 117, 122 (9th Cir.), *cert. denied*, 391 U.S. 966 (1968).

183. *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 122 (9th Cir.), *cert. denied*, 391 U.S. 966 (1968).

184. *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); *see Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182, 2188 n.14 (1982) ("Applying a trademark to goods produced by one other than the trademarks' owner . . . deprives the owner of the good will which he spent energy, time and money to obtain." (trademark infringement case)).

185. *Coca-Cola Co. v. Koke Co.*, 254 U.S. 143 (1920).

186. *Id.* at 146.

187. *See supra* note 4.

not generic.”¹⁸⁸ In a cancellation proceeding, therefore, the burden of proof rests on the challenging party,¹⁸⁹ and sufficient evidence must be presented to overcome the presumption of validity.

In *Anti-Monopoly*, the district court ruled that “convincing evidence” was needed to overcome the presumption of validity.¹⁹⁰ Yet, the appellate court ruled that the presumption could be overcome by a “preponderance of the evidence,”¹⁹¹ a lighter burden. To be consistent with the Act’s objective of protecting a trademark owner’s investment,

188. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982); *Reese Publishing Co. v. Hampton Int’l Communications, Inc.*, 620 F.2d 7, 11 (2d Cir. 1980); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1132 (2d Cir. 1979); *Miss Universe, Inc. v. Patricelli*, 408 F.2d 506, 509 (2d Cir. 1969).

189. *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 775-76 (9th Cir. 1981); *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1020-21 (9th Cir. 1979) (Goodwin, J., dissenting); *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 U.S.P.Q. (BNA) 698, 704 (N.D. Ga. 1980); *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 523 (E.D.N.Y. 1975); *American Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9, 14 (D. Conn. 1962), *aff’d sub nom. King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963); *James Huggins & Son, Inc. v. Avenarius Bros.*, 223 F.2d 494, 497 (C.C.P.A. 1955); 3 R. Callman, *supra* note 1, § 74.2, at 244 (“[I]t is the defendant’s burden to prove that the . . . trademark has passed into public domain. This is a heavy burden to sustain.”). In *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448 (N.D. Cal. 1981), *rev’d*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983), the district court properly placed the burden of proof on the challenging party. The court concluded that the presumption of validity had not been overcome: “This court cannot say from the facts before it that [source attribution] is not the ‘primary significance’ of the mark.” *Id.* at 455. The appellate court, on the other hand, concluded that even though the evidence showed that 55% of the public associated “Monopoly” with the producer, the term was generic. 684 F.2d at 1322-23. The appellate court thereby shifted the burden of proof from the challenging party to the trademark owner. In *Dan Robbins & Assocs. v. Questor Corp.*, 599 F.2d 1009 (C.C.P.A. 1979), the court pointed out that the challenging party had erroneously attempted to shift the burden of proof onto the trademark owner. *Id.* at 1015.

190. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448, 451-52 (N.D. Cal. 1981), *rev’d*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983).

191. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1319 (9th Cir. 1982), *cert. denied*, 51 U.S.L.W. 3613 (U.S. Feb. 22, 1983). For a discussion of the phrase “preponderance of the evidence,” see *Spaulding Bakeries Inc. v. Interstate Brands Corp.*, 209 U.S.P.Q. (BNA) 355, 356-57 (Trademark Trial & App. Bd. 1980).

The Ninth Circuit based its ruling on *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 775-76 (9th Cir. 1981), without discussing the rationale for imposing the lighter burden of proof. The *Vuitton* case also offered no rationale, relying on *Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399 (C.C.P.A. 1974). 644 F.2d at 775-76. In *Massey*, the court merely stated that “a preponderance of evidence will usually be ‘sufficient’ ” to prove that a defendant’s mark is so similar to the trademark owner’s symbol that a likelihood of confusion exists. 492 F.2d at 1403. The court does not discuss what burden of proof must be met to cancel a mark on the grounds of genericness, nor does it address the question of whether a heavy burden or a light one is preferable.

a heavy burden of proof¹⁹² should be applied. A trademark owner can be afforded substantial protection by requiring the challenging party to show that to the "*public as a whole*" the contested mark has "lost all its trademark significance."¹⁹³ Similarly, it has been held that cancellation should be denied unless the challenging party can show that misuse of the contested term has become "so widespread and of such duration that there can be no doubt that to the . . . public generally the mark identifies the article as to kind rather than as to source."¹⁹⁴ Other courts have required that the evidence be "clear and convincing"¹⁹⁵ or "conclusive."¹⁹⁶ Any of these standards are appropriate because they further the objectives of the Act by protecting registered trademarks and protecting the owners' investments therein.¹⁹⁷

When doubts exist concerning the primary significance of the contested term, an additional measure of protection may be afforded the trademark owner by resolving such doubts in favor of the trademark's validity.¹⁹⁸ When evidence leaves unresolved doubts in a trademark infringement case, those doubts are resolved in favor of the trademark owner.¹⁹⁹ Application of this standard in cancellation proceedings is

192. See, e.g., *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1021 (9th Cir. 1979) (Goodwin, J., dissenting); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 523-24 (E.D.N.Y. 1975); *Thomas Pride Mills, Inc. v. Monsanto Co.*, 155 U.S.P.Q. (BNA) 205, 208 (N.D. Ga. 1967).

193. *Marks v. Polaroid Corp.*, 129 F. Supp. 243, 270 (D. Mass. 1955), *aff'd*, 237 F.2d 428 (1st Cir. 1956) (emphasis in original), *cert. denied*, 352 U.S. 1005 (1957); *accord* *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 1118 (C.C.P.A. 1972).

194. *Formica Corp. v. Newnan Corp.*, 149 U.S.P.Q. (BNA) 585, 587 (Trademark Trial & App. Bd. 1966), *rev'd on other grounds*, 396 F.2d 486 (C.C.P.A. 1968); see *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *L. Amdur*, *supra* note 1, at 304.

195. *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975).

196. *Thomas Pride Mills, Inc. v. Monsanto Co.*, 155 U.S.P.Q. (BNA) 205, 208 (N.D. Ga. 1967); *James Huggins & Son, Inc. v. Avenarius Bros.*, 97 U.S.P.Q. (BNA) 474, 476 (Examiner in Chief 1953), *aff'd*, 223 F.2d 494 (C.C.P.A. 1955); 3 R. Callmann, *supra* note 1, § 74.2, at 244; see *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 180 (1896).

197. S. Rep. No. 1333, 79th Cong., 2d Sess. 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274.

198. *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1021 (9th Cir. 1979) (Goodwin, J., dissenting); *E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 523-24 (E.D.N.Y. 1975); *Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1403 n.7 (C.C.P.A. 1974); *Fricks' Foods, Inc. v. Mar-Gold Corp.*, 417 F.2d 1078, 1080 (C.C.P.A. 1969); 3 R. Callmann, *supra* note 1, § 74.2, at 236.

199. See, e.g., *San Fernando Elec. Mfg. Co. v. J.F.D. Elecs. Components Corp.*, 565 F.2d 683, 684 (C.C.P.A. 1977); *Formica Corp. v. Newnan Corp.*, 396 F.2d 486, 488 (C.C.P.A. 1968); *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 U.S.P.Q. (BNA) 396, 401 (Trademark Trial & App. Bd. 1979), *aff'd*, 648 F.2d 1335 (C.C.P.A. 1981).

appropriate because it would be irreconcilable to interpret the Act as requiring vigilance in preventing trademark infringement, while at the same time interpreting it to require a lenient standard for cancellation of a mark. Such a standard is also appropriate because consideration must be given to the likelihood that cancelling a mark will cause confusion for those consumers who know the term as a brand name. The interests of the trademark owner can best be protected by imposing a heavy burden of proof on the challenging party, and resolving doubts in favor of validity.

CONCLUSION

Public understanding is the key for determining whether a registered trademark has lost its source-denoting value and become generic. To evaluate public perception, a broad set of factors should be examined as a whole, including the availability of alternative terms, the likelihood that cancellation will cause confusion concerning source, and the trademark owner's use and promotion of the contested term. A heavy burden of proof should be imposed on the challenging party and any remaining doubts should be resolved in favor of the term's validity in order to further the basic Lanham Act objective of protecting the trademark owner. Such guidelines will create a balanced method of evaluating a mark's validity and will result in consistent and equitable decisions in cancellation proceedings.

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