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## Trademark Registration under Sections 2(a) and 2(e) of the Lanham Act: The Deception Decision

### Cover Page Footnote

Associate Professor of Law, University of Kentucky College of Law. The author wishes to acknowledge the helpful assistance of Messrs. James Liles and Philip Doty, former University of Kentucky law students, who did much of the research for this paper.

# TRADEMARK REGISTRATION UNDER SECTIONS 2(a) AND 2(e) OF THE LANHAM ACT: THE DECEPTION DECISION

KENNETH B. GERMAIN\*

## I. INTRODUCTION

THE concept of "deceptiveness" within the meaning of section 2 of the Lanham Act<sup>1</sup> has engendered considerable confusion among the legislators who enacted it, the judges who have interpreted it, and the commentators who have tried to analyze it. This Article will attempt to demonstrate that the concept is not immune to clarification.

## II. THE DECEPTIVENESS PROVISIONS AND THEIR LEGISLATIVE HISTORY IN BRIEF

Section 2 of the Lanham Act provides in relevant part:

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises . . . *deceptive* . . . matter. . . .

(e) Consists of a mark which, (1) when applied to the goods of the applicant is *merely* . . . *deceptively misdescriptive* of them, or (2) when applied to the goods of the applicant is *primarily geographically* . . . *deceptively misdescriptive* of them. . . .<sup>2</sup>

While it thus appears that a mark<sup>3</sup> that violates either section 2(a) or 2(e) cannot be registered, there is hope for section 2(e) violators because

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1. 15 U.S.C. § 1052(a), (e) (1970).

2. *Id.* (emphasis added).

3. According to the Lanham Act, "'mark' includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this chapter whether registered or not." *Id.* § 1127. In more general usage, "mark" means anything used to identify source regardless of whether it is registrable. See E. Vandenburg, *Trademark Law and Procedure* § 1.10, at 1 (2d ed. 1968) [hereinafter cited as Vandenburg]. See also *Black's Law Dictionary* 1122 (4th ed. 1951). Professors Kitch and Perlman have noted with curiosity "that section 2(a) applies to 'trademarks,' [whereas] section 2(e) applies to 'marks' . . . ." E. Kitch & H. Perlman, *Legal Regulation of the Competitive Process* 432 (1972) [hereinafter cited as Kitch & Perlman]. However, this inconsistency probably betokens nothing more than a legislative miscue since the term "trade-mark" used in the prefatory portion of section 2 should apply to the entire section, including subsection (e); and under sections 3 and 4 of the Act, 15 U.S.C. §§ 1053-54 (1970), service, certification, and collective marks are registrable, "[s]ubject to the provisions relating to the registration of trade-marks." The insignificance of the distinction between "marks" and "trademarks" is underscored by the fact that apparently no court has been concerned with this distinction.

section 2(f) permits registration of certain marks, including deceptively misdescriptive marks, that have "become distinctive of the applicant's goods in commerce,"<sup>4</sup> *i.e.*, have acquired a "secondary meaning."<sup>5</sup> For section 2(a) violators, however, there is no salvation whatsoever: no amount of "distinctiveness" will purge the defect. For this reason, it has aptly been said that section 2(a) is "more damning" than section 2(e).<sup>6</sup>

The problem, of course, is to distinguish between section 2(a) "deceptive" marks and section 2(e) "deceptively misdescriptive" marks. However,

the statutory formulation lends little further guidance and indeed, some confusion: although the consequences which attend disqualifications on these two deception grounds clearly differ, the statute nowhere indicates the substance of the differences between the disqualifications themselves.<sup>7</sup>

Moreover, the legislative history of these sections provides no clarification either. This led one commentator to conclude that "[w]hat scant legislative history there is, suggests only that both disqual-

4. 15 U.S.C. § 1052(f) (1970), provides that "[e]xcept as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce." This section clearly implies that, since paragraph (e) (deceptively misdescriptive) is not mentioned as an exception to section 2(f), section 2(e) deceptively misdescriptive marks must be registrable under section 2(f) upon a showing of secondary meaning. Accord, U.S. Dep't of Comm., Patent Office, Trademark Manual of Examining Procedure (TMEP) § 1208.05 (1974) [hereinafter cited as TMEP]; see *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 318 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967); 1 A. Seidel, S. Dubroff, E. Gonda, *Trademark Law and Practice* § 17.01, at 450 ("The purpose of Section 2(f) is to permit registration of those marks that are prohibited by Section 2(e) and that have become distinctive of the applicant's goods."); Leeds, *Trademarks—The Rationale of Registrability*, 26 *Geo. Wash. L. Rev.* 653, 662 (1958) ("it now seems settled that [a deceptively misdescriptive] mark may be registered." (citing the *GLASS WAX* case, discussed in text accompanying notes 77-84)). But see *Schulmerich Electronics, Inc. v. J.C. Deagan, Inc.*, 202 F.2d 772, 777 (C.C.P.A. 1953), which cast doubt upon the application of the secondary meaning doctrine to section 2(e) "deceptively misdescriptive" marks by its dictum rejecting the view "that a mark which is 'deceptively misdescriptive' within the meaning of Section 2(e) . . . properly may be registered if it be distinctive of an applicant's goods."

5. Secondary meaning accrues when "a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase [has] come to mean . . . to them, his trademark." *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912); see *Kitch & Perlman*, *supra* note 3, at 421-22; 1 J. McCarthy, *Trademark and Unfair Competition* § 15:2 (1973) [hereinafter cited as *McCarthy*]. See generally R. Oziel, *Contemporary Trademark Problems in Contested Patent Office Proceedings* 50-149 (1969).

6. *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 318 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967); accord, M. Beran, *An Introduction to Trademark Practice* 88 (1970).

7. P. Goldstein, *Copyright, Patent, Trademark and Related State Doctrines* 294 (1973).

ifications were intended to serve the same purposes."<sup>8</sup> However, it has also been stated that "[t]he colloquies occurring during several hearings show differences of opinion and some inconsistencies and cannot be considered conclusive in view of the specific action taken."<sup>9</sup> These are just two illustrations of the differences of opinion spawned by the uncertain meaning of sections 2(a) and 2(e) and their legislative history. Not surprisingly, the varying interpretations of judges and commentators have increased rather than decreased this uncertainty.

### III. ANALYSIS OF SECTION 2 DECEPTIVENESS AND DECEPTIVE MISDESCRIPTIVENESS

Marks that have some element of misdescription can be classified into four categories: arbitrary, misdescriptive, deceptively misdescriptive, and deceptive. It is hornbook trademark law that "arbitrary" marks are registrable on the Principal Register immediately upon "use in commerce,"<sup>10</sup> as defined by section 45 of the Lanham Act.<sup>11</sup> "Misdescriptive"<sup>12</sup> marks have not received much attention, but there are fairly strong indications that they are treated just like arbitrary marks.<sup>13</sup> "Deceptively misdescriptive"<sup>14</sup> marks fall within

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8. *Id.*, referring to Hearings on H.R. 102, H.R. 5461, and S. 895 Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess. 84-87 (1941); accord, Vandenburg, *supra* note 3, § 4.40, at 105 n.12: "[T]hose present and testifying at the hearings did not see any substantial difference between the prohibition against registration of 'deceptive' marks in Section 2(a) and the prohibition against the registration of 'deceptively misdescriptive' marks in Section 2(e)."

9. *S.C. Johnson & Son v. Gold Seal Co.*, 120 U.S.P.Q. 276, 281 (Comm'r Pats. 1959); cf. *In re Amerise*, 160 U.S.P.Q. 687, 690 (T.T.A.B. 1969) ("The legislative hearings conducted prior to the enactment of the Lanham Act shed no light on this question.")

10. 1 *McCarthy*, *supra* note 5, § 19:36-37; Vandenburg, *supra* note 3, § 2.20, at 57. Arbitrary marks are registered pursuant to section 1 of the Lanham Act, 15 U.S.C. § 1051 (1970), without recourse to section 2, *id.* § 1052, of that Act. Significantly, section 2 is phrased in terms of a mark's registrability "unless" it violates one or more of the specific prohibitions of subsections (a)-(e).

11. 15 U.S.C. § 1127 (1970).

12. This term is used to refer to marks that are misdescriptive but not deceptively so. See discussion in text accompanying notes 56-58 *infra*.

13. See discussion in text accompanying notes 56-58 *infra*; cf. *National Lead Co. v. Wolfe*, 223 F.2d 195, 199 (9th Cir.), cert. denied, 350 U.S. 883 (1955) (DUTCH BOY as applied to paint products not made in Holland. "Neither the word 'Dutch,' nor the words 'Dutch Boy' are used otherwise than in a fictitious, arbitrary and fanciful manner. Of course the word 'Dutch' is capable of being used as a geographical term. If used to indicate a product made in Holland or by some Dutch process, it could be a descriptive term. However, . . . appellant's trade mark does not contain words having either a geographical or descriptive sense.") Thus, there is a point where a mark is so misdescriptive that the purchaser would not be deceived or confused by the misdescriptiveness, but would recognize that it is being used in an arbitrary or fanciful sense. Cf. note 42 *infra*.

14. This term is used in lieu of the more cumbersome phrases "merely . . . deceptively

the prohibition of section 2(e) of the Act and cannot be registered unless secondary meaning is demonstrated under section 2(f). "Deceptive" marks cannot be registered at all, due to section 2(a). Thus, for purposes of registration, the four types of arguably deceptive marks fall into three classes: (1) registrable upon use, (2) registrable upon showing secondary meaning, (3) unregistrable. Although the real problem is discriminating between classes (2) and (3), a short discussion of class (1) will provide instructive background. For this discussion and the succeeding discussion of classes (2) and (3), the following chart, which shows judicial and administrative classifications of numerous trademarks, should be consulted.

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misdescriptive" and "primarily geographically . . . deceptively misdescriptive," as found in section 2(e)(1) & (2) of the Lanham Act, 15 U.S.C. §§ 1052(e)(1)-(2) (1970).

15. Included herein are marks that might be referred to as "suggestive." See the definition of "suggestive" in note 42 *infra*.

16. *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1972). For pre-Lanham Act cases involving ostensibly registrable "arbitrary" trademarks, see *Holeproof Hosiery Co. v. Wallach Bros.*, 172 F. 859 (2d Cir. 1909) (HOLEPROOF for hosiery); *Eiseman v. Schiffer*, 157 F. 473 (S.D.N.Y. 1907) (RADIUM for silk piece goods).

17. *National Lead Co. v. Wolfe*, 223 F.2d 195 (9th Cir.), cert. denied, 350 U.S. 883 (1955).

18. *In re Van Son Holland Ink Corp. of America*, 147 U.S.P.Q. 292 (T.T.A.B. 1965).

19. *In re Sweden Freezer Mfg. Co.*, 159 U.S.P.Q. 246 (T.T.A.B. 1968).

20. *In re International Minerals & Chem. Corp.*, 147 U.S.P.Q. 262 (T.T.A.B. 1965).

21. *Mem Co. v. Hes Co.*, 149 U.S.P.Q. 8 (S.D. Cal. 1966).

22. *In re Yardley Inc.*, 165 U.S.P.Q. 272 (T.T.A.B. 1970).

23. *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482 (5th Cir. 1971); see note 53 *infra*.

24. *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391 (C.C.P.A. 1969).

25. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (*per curiam*), cert. denied, 352 U.S. 829 (1956).

26. *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967).

27. *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799 (C.C.P.A. 1964).

28. *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786 (C.C.P.A. 1964).

29. *Caldwell Lace Leather Co. v. Western Filament, Inc.*, 173 U.S.P.Q. 695 (T.T.A.B. 1972).

30. *Ex parte London Gramophone Corp.*, 98 U.S.P.Q. 362 (Comm'r Pats. 1953).

31. *In re Amerise*, 160 U.S.P.Q. 687 (T.T.A.B. 1969).

32. *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273 (C.C.P.A. 1963).

33. *Ex parte Makers of Kal, Inc.*, 114 U.S.P.Q. 504 (Comm'r Pats. 1957).

34. *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799 (C.C.P.A. 1964).

35. *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786 (C.C.P.A. 1964).

36. *Caldwell Lace Leather Co. v. Western Filament, Inc.*, 173 U.S.P.Q. 695 (T.T.A.B. 1972).

37. *Sponge & Chamois Institute v. Curtiss-Wright Corp.*, 120 U.S.P.Q. 309 (T.T.A.B. 1959). Here, an opposer challenged the marks as being "deceptive" and "deceptively misdescriptive" and the court upheld the opposition on the basis that the mark was "deceptive and would result in deception of the . . . public," *id.* at 310, but no references were made to any specific section of the statute.

(3) Violative of Section 2(g):  
Not Registrable

(2) Violative of Section 2(e):  
Registrable Under Section 2(f)

(1) Registrable Upon Use Under Section 1 of Lanham Act

	Arbitrary <sup>15</sup>	Misdescriptive	Deceptively Misdescriptive	Deceptive
N O N	ICE CREAM (chewing gum) <sup>16</sup>	AUTOMATIC RADIO (air conditioners) <sup>24</sup>	GLASS WAX (waxless metal and glass cleaner) <sup>25</sup>	PRESIDENT'S FORMULA (vitamins not associated with the President) <sup>33</sup>
G E O			TUFIDE (non-leather products) <sup>26</sup>	VYNAHYDE (non-leather products) <sup>34</sup>
C O R			VYNAHYDE (non-leather products) <sup>27</sup>	DURA-HYDE (non-leather products) <sup>35</sup>
A P H			DURA-HYDE (non-leather products) <sup>28</sup>	NEOHIDE (non-leather products) <sup>36</sup>
I C A			NEOHIDE (non-leather products) <sup>29</sup>	CHAMI/CHAMI SPONGE (synthetic sponges) <sup>37</sup>
L				
G E O	DUTCH BOY/DUTCH (domestic paint) <sup>17</sup>		LONDON (records not made in London) <sup>30</sup>	AMERICAN LIMOGES (domestic china not made from clay from Limoges, France) <sup>38</sup>
G R	HOLLAND INK/HOLLAND (domestic ink) <sup>18</sup>		ITALIAN MAIDE (canned goods not connected with Italy) <sup>31</sup>	MAID IN PARIS (domestic perfume) <sup>39</sup>
A P H	SWEDEN (domestic kidney machine) <sup>19</sup>		AMERICAN BEAUTY (Japanese sewing machine) <sup>32</sup>	DANISH MAID (domestic dairy products) <sup>40</sup>
I C A	KENTUCKY TURF (non- Kentucky fertilizer) <sup>20</sup>			DUTCH BOY (domestic flower bulbs) <sup>41</sup>
L	ENGLISH LEATHER (domes- tic men's toiletries) <sup>21</sup>			
	LONDON LASHES (domestic lash lengthener) <sup>22</sup>			
	WORLD (carpets) <sup>23</sup>			

A. *Class 1: Marks Registrable Upon Use and  
Without Secondary Meaning*

Most of the marks in this class come within the following definition of "arbitrary:"

Arbitrary marks comprise those words, symbols, pictures, etc., which are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.<sup>42</sup>

While it is easy to see why ICE CREAM was "so incongruous and ludicrous"<sup>43</sup> as applied to chewing gum as to be considered arbitrary within the above definition, rather than "merely . . . deceptively misdescriptive" within the meaning of section 2(e)(1), it is much harder to justify classifying geographical marks in this category. The foundational case in this area involved the use of DUTCH and DUTCH BOY for paints having no connection whatsoever with Holland.<sup>44</sup> Although the Ninth Circuit expressly recognized that DUTCH had an obvious geographical significance and was "capable of being used as a geographical term,"<sup>45</sup> it concluded that "[n]either the word 'Dutch,' nor the words 'Dutch Boy' [was] used otherwise than in a fictitious, arbitrary and fanciful manner."<sup>46</sup> The court implied that the pivotal

38. *In re Salem China Co.*, 157 U.S.P.Q. 600 (T.T.A.B. 1968).

39. *In re Richemond*, 131 U.S.P.Q. 441 (T.T.A.B. 1961).

40. *In re Danish Maid Cultured Prods., Inc.*, 156 U.S.P.Q. 430 (T.T.A.B. 1967).

41. *National Lead Co. v. Michigan Bulb Co.*, 120 U.S.P.Q. 115 (Comm'r Pats. 1959) (dictum).

42. 1 *McCarthy*, *supra* note 5, § 11:4, at 350; accord, *In re Bonide Chem. Co.*, 46 F.2d 705, 706 (C.C.P.A. 1931) ("The meaning of some descriptive words or devices used as trade-marks is so foreign to the qualities or characteristics of the class of goods with which they are used as to render it unlikely that they would ever be regarded as used descriptively or deceptively. In such cases the marks are arbitrary and fanciful and form proper technical trade-marks."). As mentioned in note 15 *supra*, "suggestive" marks are closely akin to "arbitrary" marks. "It cannot be said that [suggestive marks] are primarily descriptive or that they are purely arbitrary or fanciful without any indication of the nature of the goods which they denominate. Such terms, indeed, shed some light upon the characteristics of the goods, but so applied they involve an element of incongruity, and in order to be understood as descriptive, they must be taken in a suggestive or figurative sense through an effort of the imagination on the part of the observer." *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir. 1940). Indeed, for all significant purposes, suggestive marks are treated just like arbitrary marks. 1 *McCarthy*, *supra* note 5, § 11:20(A), at 388.

43. *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1972).

44. *National Lead Co. v. Wolfe*, 223 F.2d 195 (9th Cir.), cert. denied, 350 U.S. 883 (1955).

45. *Id.* at 199.

46. *Id.* The court placed heavy reliance upon the Supreme Court's decision in *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251 (1916), a pre-Lanham Act case holding that THE AMERICAN GIRL was not descriptive or geographically descriptive of shoes actually made in America.



issue was whether the misdescriptive term was deceptive, *i.e.*, whether purchasers were misled.

Here there [was] no likelihood that the use of the name "Dutch" or "Dutch Boy" in connection with the appellant's goods would be understood by purchasers as representing that the goods or their constituent materials were produced or processed in Holland or that they are of the same distinctive kind or quality as those produced, processed or used in that place.<sup>47</sup>

This approach, followed by the Trademark Trial and Appeal Board in the HOLLAND INK<sup>48</sup> and SWEDEN<sup>49</sup> cases, among others,<sup>50</sup> may be objectionable because these marks, particularly the national indicia SWEDEN, and DUTCH and HOLLAND unadorned by BOY and INK respectively,<sup>51</sup> do tend to mislead the public into believing that there is an actual geographical connection.<sup>52</sup> If this geographical misdescriptiveness is "deceptive"<sup>53</sup> in the sense of section 2(e)(2) of the

47. 223 F.2d at 199.

48. In re Van Son Holland Ink Corp., 147 U.S.P.Q. 292 (T.T.A.B. 1965) (HOLLAND and HOLLAND INK applied to inks and related printing products).

49. In re Sweden Freezer Mfg. Co., 159 U.S.P.Q. 246 (T.T.A.B. 1968) (SWEDEN as applied to artificial kidney machines).

50. See cases cited in notes 20-23 *supra*; cf. Fleischwaren-Export-Gesellschaft v. Columbia Packing Co., 177 U.S.P.Q. 220 (T.T.A.B. 1973), where a section 2(e) opposition to DEUTSCHMACHER for domestic delicatessen meats (including beerwurst, berliner and frankfurters) was denied on the dubious ground that there was insufficient proof of the deceptive effect of the mark, even though the English translation of the mark is "German Maker." There the Board noted: "The mere fact that a mark may be comprised of a word or words having a German or other foreign connotation does not in and of itself render the mark geographically . . . deceptively misdescriptive." *Id.* at 221. The Board seems to have misused "connotation" for "denotation" and ignored the basic principle that mere use of a foreign language does not divest words of their descriptive content. See also Volkswagenwerk Aktiengesellschaft v. Church, 256 F. Supp. 626 (S.D. Cal. 1966), *aff'd*, 411 F.2d 350 (9th Cir. 1969) (action for auto repairman's alleged infringement of VOLKSWAGEN); 1 McCarthy, *supra* note 5, § 11:14(B).

51. The distinction is suggested because the addition of a second word to the geographical term may be viewed as diluting the geographical significance of that term. Professor McCarthy aptly made this point in relation to the mark AMERICAN: "On the whole, courts have held that the addition or variation of any element of AMERICAN, no matter how slight, will remove it from the geographically descriptive category for American-based sellers. For example, AMERICAN GIRL shoes, ALL AMERICAN on radios . . . . On the other hand, the unadorned, simple word AMERICAN has been held geographically descriptive on paper cups, gasoline, truck bodies, and automobile associations." 1 McCarthy, *supra* note 5, § 14:6, at 499 (footnotes omitted); accord, Merchant, Deceptive and Descriptive Marks, 56 Trademark Rep. 141, 155 (1966) [hereinafter cited as Merchant]; TMEP, *supra* note 4, § 1208.07; cf. marks involved in cases cited in notes 20-22, all of which involved "suggestive" terms annexed to geographical terms. The addition of the non-descriptive term BOY to DUTCH would seem more significant than the addition of the descriptive word INK to HOLLAND.

52. "The use of a geographical word in a nongeographical sense is fraught with danger; the word may not be understood in the sense intended, and may thus be deceptive . . . ." 3 R. Callman, Unfair Competition, Trademarks and Monopolies § 72.6, at 209 (3d ed. 1969).

53. Of course, for section 2(e)(2) to apply the mark would have to be "primarily geographically . . . deceptively misdescriptive." 15 U.S.C. § 1052(e)(2) (1970). In this regard it has recently

Lanham Act, then the mark should be treated as unsuitably misdescriptive.<sup>54</sup> Indeed, this view is supported by the Patent Office's refusal to register LONDON for phonograph records of non-British origin, even though the city of London did *not* have a reputation for that industry, since "where the word in question is primarily the name of a place and . . . the public might understand or think that the goods originated there or have some association or connection with the place . . . registration should be refused under section 2(e)."<sup>55</sup>

However, as suggested earlier, little is gained by this analysis, since even if a mark is "primarily geographically . . . misdescriptive" it is *not* denied registration unless it is "deceptively" so;<sup>56</sup> the issue once more is focused on "deceptiveness." This point was made by the Court of Customs and Patent Appeals in holding that AUTOMATIC RADIO was not deceptively misdescriptive of goods other than radios (in particular, air conditioners) since "[t]he proscription is not against misdescriptive terms *unless they are also deceptive*."<sup>57</sup> The legislative history of section 2(e) also supports this distinction between misdescriptive and deceptively misdescriptive.

Mr. THOMAS E. ROBERTSON. You mean the misdescriptive term is registrable, if not deceptive?

Mr. MARTIN. Right.

Mr. POHL. That is right.

Mr. ROGERS. As an illustration, "ivory" is applied to soap. It is a perfectly good trade-mark; but it is a descriptive term, but not as applied to soap.

Mr. POHL. . . . It is misdescriptive of soap, but it is not deceptive.<sup>58</sup>

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been noted that "[t]he word 'primarily' should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote, or unconnected with the goods." *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 486 (5th Cir. 1971); accord, *Vandenburgh*, supra note 3, § 4.60, at 113-15.

54. "Recognition of the word DUTCH as a trademark can be rationalized with what has been initially said only on the ground that under the circumstances present in [that] case, the word in question as applied to certain specified goods was no longer primarily geographical. Such cases are rare." *Merchant*, supra note 51, at 156.

55. *Ex parte London Gramophone Corp.*, 98 U.S.P.Q. 362, 363 (Comm'r Pats. 1953). But cf. *In re Yardley Inc.*, 165 U.S.P.Q. 272 (T.T.A.B. 1970), holding that LONDON LASHES was registrable for brush-on lash lengthener not from London, and placing reliance upon *In re Circus Ices, Inc.*, 158 U.S.P.Q. 64 (T.T.A.B. 1968) (allowed HAWAIIAN ICES to be registered for ices not connected with Hawaii).

56. See notes 12-13 supra and accompanying text.

57. *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 1396 (C.C.P.A. 1969) (emphasis added); accord, *Vandenburgh*, supra note 3, § 4.40, at 102. This should answer in the affirmative Professors Kitch and Perlman's query, "Is the term 'deceptively' a necessary modification of 'misdescriptive'?" *Kitch & Perlman*, supra note 3, at 432.

58. Hearings on H.R. 102, H.R. 5461, and S. 895 Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess. 85 (1941).

(This discussion led the legislators to annex the word "deceptively" to the word "misdescriptive" in sections 2(e)(1) and (2)).<sup>59</sup>

Thus, it all boils down to how to determine when a mark is deceptive and when a misdescriptive mark is deceptively so. "The test as to whether or not it is deceptive is how would it be regarded by the majority of purchasers at the time that the question arises . . ." <sup>60</sup> If the purchasers view the misdescription as "arbitrary" the mark is registrable without a hitch, but if they are deceived into believing that there is an actual connection the mark falls under sections 2(e) and/or 2(a).<sup>61</sup>

B. *Classes 2 and 3: Distinguishing Between "Deceptively Misdescriptive" and "Deceptive" Marks*<sup>62</sup>

As a preliminary matter it is important to dispel the notion that there might be no real difference between section 2(a) "deceptiveness" and section 2(e) "deceptive misdescriptiveness."

Since the words "or deceptively misdescriptive" were specifically added to Section 2(e) when paragraph (f) and paragraph (a) were already in the present form as far as the present question is concerned, it can only be concluded that there must have been some reason for the addition of the phrase. If the scope of "deceptively misdescriptive" recited in paragraph (e) is precisely the same as or contained entirely within the scope of the meaning of the word "deceptive" recited in paragraph (a), then the addition of the words to paragraph (e), particularly in view of the presence of paragraph (f), could only be taken as a wholly meaningless act. It must be concluded that, while the scope of the two phrases may overlap in that something included in 2(a) may also be included in 2(e), the phrase in paragraph (e) must include some things which are not included within the scope of paragraph (a). Hence it cannot be stated as a matter of law that if something is barred [from] registration under paragraph (e) as being deceptively misdescriptive it is ipso facto barred [from] registration under paragraph (a).<sup>63</sup>

59. See Merchant, *supra* note 51, 147-48.

60. Vandenburg, *supra* note 3, § 4.40, at 102-03 (footnote omitted); accord, 1 McCarthy, *supra* note 5, § 14:3, at 490; cf. *In re Van Son Holland Ink Corp. of America*, 147 U.S.P.Q. 292 (T.T.A.B. 1965).

61. Consequently, Professors Kitch and Perlman must receive a negative answer to their question, "Would 'Old Crow Whiskey' be denied registration under [section] 2(a) or 2(e) unless it were made from old crows?" Kitch & Perlman, *supra* note 3, at 432.

62. For a discussion of pre-Lanham Act law touching upon deceptiveness affecting registrability under the 1905 Act see Merchant, *supra* note 51, at 141-46, 148-50.

63. *S.C. Johnson & Son v. Gold Seal Co.*, 120 U.S.P.Q. 276, 281 (Comm'r Pats. 1959); accord, *In re Amerise*, 160 U.S.P.Q. 687, 690 (T.T.A.B. 1969) (observed the distinction between sections 2(a) and 2(e) with regard to registration on the Supplemental Register); *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 317-18 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967) ("since deceptive marks are precluded by Section 2(a) of the Statute and deceptively misdescriptive marks [are precluded] by Section 2(e)(1), it is logical to assume that the framers of the Statute intended them to be mutually exclusive, the former being more damning than the latter." *Id.* at 318).

Assuming that a distinction does exist, it is obviously a crucial one since, as stated earlier, "deceptively misdescriptive" marks can be salvaged by showing secondary meaning whereas "deceptive" ones cannot.<sup>64</sup> Unfortunately, "[t]he line . . . is a difficult one to draw,"<sup>65</sup> and courts tend to circumvent the issue whenever possible.<sup>66</sup> For example, without making any attempt to differentiate between sections 2(a) and 2(e), the Trademark Trial and Appeal Board has held that a mark is *neither* "deceptively misdescriptive" nor "deceptive."<sup>67</sup> Conversely, the Board has disposed of an opposer's dual objections to deceptiveness and deceptive misdescriptiveness by banning the mark as "deceptive" without distinguishing between the two grounds or indicating whether it had relied upon section 2(a) or 2(e).<sup>68</sup> In a third case the Board viewed the deceptive and deceptively misdescriptive claims as being different and so disposed of them individually. In so doing, however, it did not indicate any basis for distinguishing between the two.<sup>69</sup> Likewise, the Court of Customs and Patent Appeals once disposed of opposition claims based on sections 2(a) and 2(e) by explicitly denying the 2(e) objection on the ground that the mark was not *deceptively* misdescriptive, and implicitly denying the 2(a) objection by affirming the Trademark Trial and Appeal Board's disposition.<sup>70</sup> The dissent, on the other hand, condemned the mark without articulating whether it was deceptive or deceptively misdescriptive or both.<sup>71</sup>

Even more illustrative of this point are two fairly recent decisions by

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That sections 2(a) and 2(e) are distinct, the former being more damning than the latter, is further evidenced by the fact that the cancellation procedure under section 14(c) of the Lanham Act, 15 U.S.C. § 1064(c) (1970), is available to attack registration of a section 2(a) deceptive mark, but is not available to attack a section 2(e) deceptively misdescriptive mark. See *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 317 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967).

64. See notes 4-6 *supra* and accompanying text.

65. 1 *McCarthy*, *supra* note 5, § 14:12, at 511 (footnote omitted).

66. For example, in one of the few cases facing the issue, the Trademark Trial and Appeal Board commented: "There have been only a few decisions involving the registrability of a geographical term under Section 2(a) or Section 2(e) (2); but, nowhere in these decisions has the deciding tribunal had the occasion or felt the need to engage in a discussion pertaining to the differences between these subsections of Section 2 and the appropriate conditions for their application." In *re Amerise*, 160 U.S.P.Q. 687, 690 (T.T.A.B. 1969). But see text accompanying note 74 *infra*.

67. *A.F. Gallun & Sons v. Aristocrat Leather Prods., Inc.*, 135 U.S.P.Q. 459 (T.T.A.B. 1962) (COPY CALF for imitation leather wallets).

68. *Caldwell Lace Leather Co. v. Western Filament, Inc.*, 173 U.S.P.Q. 695 (T.T.A.B. 1972); *Sponge & Chamois Institute v. Curtiss-Wright Corp.*, 120 U.S.P.Q. 309, 310 (T.T.A.B. 1959) (CHAMI SPONGE for synthetic sponges).

69. *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 317-18 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967).

70. *Steinberg Bros. v. New England Overall Co.*, 377 F.2d 1004 (C.C.P.A. 1967) (NUHIDE for dungarees).

71. *Id.* at 1006 (Kirkpatrick, J., dissenting).

the Court of Customs and Patent Appeals which held that two marks were *both* "deceptive" and "deceptively misdescriptive" without offering any explanation whatsoever regarding the difference.<sup>72</sup> That court further compounded the confusion by stating in one of these cases that "no trademark rights can be acquired in a trademark that is deceptive or deceptively misdescriptive"<sup>73</sup>—a statement that is flatly inconsistent with the registrability of "deceptively misdescriptive" marks that have acquired secondary meaning under section 2(f).

When the courts have found marks violative of *either* section 2(a) or 2(e) they usually have not had to explain the difference between the two sections because only one or the other was involved in the pleadings.<sup>74</sup> In only two cases<sup>75</sup> has the issue been directly<sup>76</sup> met. These cases will now be discussed.

72. *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799 (C.C.P.A. 1964) (VYNAHYDE for non-leather products); *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 791 (C.C.P.A. 1964) (DURA-HYDE for non-leather products).

73. *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 788 (C.C.P.A. 1964).

74. The following cases applied section 2(a) without considering section 2(e): *In re Salem China Co.*, 157 U.S.P.Q. 600 (T.T.A.B. 1968) (AMERICAN LIMOGES); *In re Danish Maid Cultured Prods., Inc.*, 156 U.S.P.Q. 430 (T.T.A.B. 1967) (DANISH MAID); *In re Richemond*, 131 U.S.P.Q. 441 (T.T.A.B. 1961) (MAID IN PARIS). The following cases applied section 2(e) without considering section 2(a): *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273 (C.C.P.A. 1963) (AMERICAN BEAUTY); *Ex parte London Gramophone Corp.*, 98 U.S.P.Q. 362 (Comm'r Pats. 1953) (LONDON).

75. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (per curiam), cert. denied, 352 U.S. 829 (1956); *In re Amerise*, 160 U.S.P.Q. 687 (T.T.A.B. 1969).

76. The issue was dealt with indirectly in *Imperial Knife Associated Cos. v. National Silver Co.*, 150 U.S.P.Q. 209 (T.T.A.B. 1966). There the Trademark Trial and Appeal Board sustained an opposition to *PARISIENNE* as applied to drinkware and stemware. In so doing it rejected the applicant's defense that because the goods to which the opposer's mark was applied (knives, forks, and spoons) were not manufactured in Paris the opposer had "unclean hands." The defense was rejected because the Board found that *PARISIENNE* as applied to the opposer's American-made product was not "geographically deceptive."

The term "geographically deceptive" seems to be a hybrid of sections 2(a) and 2(e), but this is uncertain since the Board did not refer to either section. Its reasoning seemed to implicate both sections, along the lines of *GLASS WAX*. First it stated: "In our opinion, while the word 'Parisienne' is defined as a Parisian woman or girl, it would not indicate that applicant's goods . . . are of French origin." *Id.* at 210 (footnote omitted). This conclusion seems to imply that the Board found that the mark was not geographically misdescriptive under section 2(e).

Secondly, the Board stated that "any geographic significance which the term might possess is not of such a nature that it would induce prospective purchasers into buying [its] products. . . ." *Id.* The Board's reference to inducement of purchasers is reminiscent of the "influenced to purchase" reference in *GLASS WAX*, see text accompanying note 82 *infra*, and this would seem to indicate that the Board in effect was applying section 2(a). That it was in fact applying section 2(a) is apparent from its reliance on *In re Van Son Holland Ink Corp. of America*, 147 U.S.P.Q. 292 (T.T.A.B. 1965), a factually similar case (*HOLLAND* and *HOLLAND INK* as applied to inks not made in Holland) decided under section 2(a) and which also employed an "inducement" analysis. "[T]he question for consideration is whether or not [the geographical significance of the mark] would induce

In the GLASS WAX case,<sup>77</sup> the federal district court was called upon to decide whether that mark was arbitrary, descriptive, deceptively misdescriptive, or deceptive as applied to a *waxless* cleaner for glass *and* metal. The Trademark Examiner had earlier concluded that the mark was not deceptive, but was either descriptive or deceptively misdescriptive and therefore was unregistrable since no evidence of secondary meaning had been presented by the applicant.<sup>78</sup> The Commissioner of Patents agreed that the mark was either descriptive or deceptively misdescriptive, and so affirmed the refusal to register, but without reaching the section 2(a) "deceptiveness" question.<sup>79</sup> Fortunately, however, the district court did reach the question and in so doing provided a basis on which to analyze deceptiveness.

The district court held that GLASS WAX was not "deceptive" under section 2(a), but was "deceptively misdescriptive" under section 2(e)(1). Consequently, it affirmed the Patent Office's disposition of the case, while clarifying the deceptiveness issue. However, it refused to rule on the applicant's secondary meaning argument, preferring to defer to the expertise and procedures of the Patent Office in accordance with the legislative intent to vest the Patent Office with initial resolution of this matter.<sup>80</sup>

As to "deceptive misdescriptiveness," the court stated:

[T]he product contains either no wax, or wax in insufficient quantity to justify use of the word . . . . [C]ustomers might justifiably believe it does contain the element wax, *whether or not it was significant to them in purchasing the product . . . .*<sup>81</sup>

More instructively, however, as to "deceptiveness" the court, expressly following the lead of the Examiner of Interferences, concluded that:

[The absence of "wax" in GLASS WAX] does not automatically make the mark deceptive for the purposes of registration. The evidence does not establish that customers have been misled. To the contrary, it appears that the product satisfies the needs of the customers; *that the average or ordinary customer cares little about, and knows little about, the scientific composition of the product. . . .* The evidence does not show that the public has been *influenced to purchase* the product on account of

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prospective purchasers into buying applicant's products on the basis of this supposed geographic origin, in that the products possess some superior qualities or other attributes because of such origin." Id.

77. *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (per curiam), cert. denied, 352 U.S. 829 (1956).

78. Id. at 931.

79. *S.C. Johnson & Son v. Gold Seal Co.*, 90 U.S.P.Q. 373, 379 (Comm'r Pats. 1951). See text accompanying 66-72 *supra*.

80. 129 F. Supp. at 936-37.

81. Id. at 935 (emphasis added) (footnote omitted).

believing that it contained wax, or that the product was simply a wax to be placed upon glass.<sup>82</sup>

Most significantly, the court then set out the following test for deception under section 2(a):

*[D]eception is found when an essential and material element is misrepresented, is distinctly false, and is the very element upon which the customer reasonably relies in purchasing one product over another.*<sup>83</sup>

The upshot of the court's analysis seems to be that section 2(a) deception will be found only where there is *material* falsity, that is, falsity that directly affects the purchasing decision by virtue of the purchaser's reliance.<sup>84</sup> Section 2(e) "deceptive misdescriptiveness," also involves falsity that deceives the purchaser, but the falsity is immaterial because the purchaser is not concerned with and does not rely upon such falsity.

In *In re Amerise*,<sup>85</sup> the only other case that directly raised the issue of "deceptive" versus "deceptively misdescriptive," the Trademark Trial and Appeal Board implicitly concluded that ITALIAN MAIDE, the phonetic equivalent of Italian made, was "deceptively misdescriptive" as applied to canned vegetables in no way connected with Italy.<sup>86</sup> The Board adopted the following test for geographically deceptive misdescriptiveness:

It thus appears that the criteria for determining the registrability of a geographical designation under Section 2(e) (2) are whether the term conveys primarily or immediately a geographical connotation as to the origin of the goods in connection with which it is used and then whether the goods do in fact come from that geographical area. If they do not, then the mark is primarily geographically deceptively misdescriptive of such goods.<sup>87</sup>

In formulating this test, the Board placed heavy reliance upon the Court of Customs and Patent Appeals case wherein AMERICAN BEAUTY was held to be "primarily geographically deceptively misdescriptive" as applied to Japanese-made sewing machines because the mark suggested that the product was made in the U.S.A.<sup>88</sup> The ITALIAN MAIDE Board adopted the AMERICAN BEAUTY court's conclusion that such a mark

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82. *Id.* at 934 (emphasis added).

83. *Id.* (emphasis added).

84. Section 2(a) "deception," as interpreted by this Article, is analogous to common law fraud, which requires, *inter alia*, proof of reliance by the complainant. *Brackett v. Griswold*, 112 N.Y. 454, 20 N.E. 376 (1889); W. Prosser, *Torts* § 108, at 714 (4th ed. 1971).

85. 160 U.S.P.Q. 687 (T.T.A.B. 1969).

86. *Id.* at 691-92.

87. *Id.* at 691.

88. *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 276 (C.C.P.A. 1963).

"gives a false indication of geographical origin to that segment of the purchasing public which may be interested in the country of origin and in purchasing American-made goods and it is likely to deceive them".<sup>89</sup>

Unfortunately, the AMERICAN BEAUTY court also concluded that "the misdescriptiveness under the circumstances of this case *would necessarily be deceptive*."<sup>90</sup> This test for section 2(e) is disturbingly similar to the GLASS WAX court's test for section 2(a), a test that used as its touchstone material falsity likely to influence the purchasing decision.<sup>91</sup> By using this test, and by failing to discuss the applicability of section 2(a)—which admittedly had not been mentioned in the pleadings<sup>92</sup>—it may have further befuddled an already quite confusing area. Fortunately, the ITALIAN MAIDE Board did not adopt this aspect of the AMERICAN BEAUTY court's reasoning.

The ITALIAN MAIDE Board next delineated its test for section 2(a) deceptiveness:

As to Section 2(a), this Board has, in view of the absolute bar to the registration of a mark under this section, taken the position that a mark consisting of or comprising a geographical term is not deceptive under Section 2(a) unless it *involves a false assertion calculated, either planned, designed, or implied to deceive the public as to the geographical origin of the goods bearing the mark*. This contemplates situations where a party applies a geographical designation to a particular product *knowing that it will bestow upon the product an appearance of greater quality or saleability not actually possessed by it with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product*. While such intent is often difficult to prove and especially in ex parte proceedings, intent can and has been inferred under those circumstances where a geographical area or place is well-known for the particular product as France for perfumes, Denmark for cheese, Switzerland for watches, and so forth.<sup>93</sup>

Furthermore, the Board interpreted precedent as holding that "deception . . . under Section 2(a), is not present where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible."<sup>94</sup> This is intriguing both because of the use of the disjunctive "or" rather than the conjunctive "and," and because

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89. 160 U.S.P.Q. at 691, quoting *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 276 (C.C.P.A. 1963). Ironically, the Board referred only in passing to an extremely similar pre-Lanham case, *Campana Corp. v. Glanzberg*, 10 F. Supp. 876, 878 (E.D. Pa. 1935), that held that ITALIAN BALM was registrable under the 1905 Act even though it was "in the broad sense of the word, deceptive" as applied to an American-made product.

90. *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d at 276 (emphasis added).

91. See discussion in text accompanying notes 83-84 supra.

92. "The sole ground of opposition asserted in this court is . . . section 2(e) (2) . . ." 319 F.2d at 274.

93. 160 U.S.P.Q. at 691 (emphasis added).

94. *Id.* As the Board indicated, somewhat obliquely, this test was coined in the pre-Lanham ITALIAN BALM case of *Campana Corp. v. Glanzberg*, 10 F. Supp. 876, 878 (E.D. Pa. 1935); see note 89 supra.



the Board placed as much emphasis on the applicant's intent to deceive as on the actual deceptiveness of the applicant's mark. The emphasis on intent is an ill-advised position, both because of the great difficulty of proving intent, and, more importantly, because intent is nowhere mentioned or even alluded to in section 2 or any other section of the Lanham Act related to registration.<sup>95</sup>

The Board's view of the proper law to be applied to the ITALIAN MAIDE mark also merits mention. It first concluded that the mark fell "within the [non-deceptive] category of cases,"<sup>96</sup> because of its double entendre, as well as the fact that Italy is not particularly associated with canned vegetables, and the fact that American consumers are accustomed to seeing American products such as spaghetti sauce sold under Italian marks. It then decided that section 2(a) did not apply, and it finally concluded that the case should be "remanded to the examiner for consideration of the sufficiency of applicant's evidence in support of his claim of distinctiveness"<sup>97</sup>—a result that can be explained only on the basis of section 2(e)(2). In other words, the Board impliedly held that ITALIAN MAIDE was deceptively misdescriptive—the correct result, it is submitted—without expressly saying so or directly applying its own test of deceptive misdescriptiveness.

#### IV. NON-DECISIONAL VIEWS OF DECEPTIVENESS V. DECEPTIVE MISDESCRIPTIVENESS

By way of demonstration that scholars are every bit as mortal as judges, a noted authority added no clarity to the deceptiveness issue by his assessment that "[a]ny mark that is merely deceptively misdescriptive under the prohibition against registration in Section 2(e) . . . may also be within the prohibition against registration of 'deceptive' marks in Section 2(a), although a distinction has been drawn between the two."<sup>98</sup>

95. Proof of actual intent to deceive is, however, fairly persuasive evidence that the deception was material and the applicant believed he would succeed in deceiving: why else would he try? This indirect approach is analogous to the well-accepted doctrine in infringement cases that when there has been intentional counterfeiting of another's mark, confusion between the two marks will be presumed to exist. See *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466-67 (2d Cir.), cert. denied, 350 U.S. 832 (1955) (proof of actual intent to copy "gives rise to a powerful inference that confusion is likely, and puts on the alleged infringer the burden of going forward with proof that it is not." *Id.* at 467.); *My-T Fine Corp. v. Samuels*, 69 F.2d 76, 77 (2d Cir. 1934); 2 *McCarthy*, supra note 5, § 23:32(A); *id.* (Supp. 1974); *Vandenburg*, supra note 3, § 5.20, at 146.

96. *In re Amerise*, 160 U.S.P.Q. 687, 691 (T.T.A.B. 1969).

97. *Id.* at 692; see *TMEP*, supra note 4, § 1208.07, at 118.

98. *Vandenburg*, supra note 3, § 4.40, at 105. However, a new footnote to *Vandenburg's*

Then to make matters worse, in the accompanying explanatory footnote he stated that "[i]f the mark is not deceptive under Section 2(a) the question of whether the mark is deceptively misdescriptive under Section 2(e)(1) is moot, the former being more damning than the latter."<sup>99</sup> This view, however, was *rejected* by *W.D. Byron & Sons v. Stein Bros. Mfg. Co.*,<sup>100</sup> which this authority apparently misinterpreted.<sup>101</sup>

Treatise-writers Seidel, Dubroff and Gonda propounded the following test:

If the mark tends to mislead the purchaser into believing he is purchasing something that he is not, then the trademark is considered to be deceptive [section 2(a)]. If he is under the belief that he is purchasing the item but that it has qualities that are not actually present, then the mark would be considered misdescriptive [section 2(e)].<sup>102</sup>

As support for this test based upon deception as to the item itself, as opposed to deception only as to the qualities of the item, Seidel cited

quoted statement about section 2(a) deceptive marks contains the following language from *In re Amerise*: "[A] mark consisting of or comprising a geographical term is not deceptive under Section 2(a) unless it involves a false assertion calculated, either planned, designed, or implied to deceive the public as to the geographical origin of the goods bearing the mark. This contemplates situations where a party applies a geographical designation to a particular product knowing that it will bestow upon the product an appearance of greater quality or saleability not actually possessed by it with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product." *Id.* at n.9.1 (Supp. 1973), quoting *In re Amerise*, 160 U.S.P.Q. 687, 691 (T.T.A.B. 1969).

99. *Vandenburgh*, supra note 3, § 4.40, at 105 n.10, referring to *W. D. Byron & Sons v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 318 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967), cited in notes 4, 6 & 63 supra.

100. 146 U.S.P.Q. 313 (T.T.A.B. 1965), *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967).

101. The Byron Board stated that "[t]he question whether or not [the mark] is deceptively misdescriptive within Section 2(e) (1) . . . would appear to be moot, in view of the holding that [the mark] is not . . . deceptive . . ." *Id.* at 318. Perhaps the Board should have emphasized the word "appear," to underscore the fact that it was rejecting this view in favor of the view that sections 2(a) and 2(e) are "mutually exclusive." *Id.* The entire discussion was dictum, however, since the Board did not decide the question of deceptive misdescriptiveness. Rather, it found secondary meaning, which would have overcome deceptive misdescriptiveness and which therefore rendered unnecessary a finding as to deceptive misdescriptiveness. *Accord*, *S.C. Johnson & Son v. Gold Seal Co.*, 90 U.S.P.Q. 373, 379 (Comm'r Pats. 1951) (dictum).

102. 1 A. Seidel, S. Dubroff & E. Gonda, *Trademark Law and Practice* § 6.01, at 146 (1963); *accord*, *Merchant*, supra note 51, at 151. Although neither Seidel, supra, nor *Merchant* expressly acknowledged it, this line of demarcation was suggested earlier in a footnote in the *GLASS WAX* case which stated: "Cases cited by defendants to support their charge of deception involved marks which were deceptive or misleading in that they represented to the public that the article was something essentially different from the thing which they actually received. Here the evidence shows that customers sought a cleaner and were well satisfied. Had the evidence shown that customers bought the product as a wax for glass, a different problem would have been presented to the Court." *Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 934 n.10 (D.D.C. 1955), *aff'd sub nom.* *S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (per curiam), cert. denied, 352 U.S. 829 (1956).

the pre-Lanham CROW-TOX case.<sup>103</sup> In that case the Court of Customs and Patent Appeals affirmed the Patent Office's refusal to register CROW-TOX as applied to a *non*-poisonous pest repellent because the mark failed to accurately describe the product.<sup>104</sup> Seidel opined that this case would come under section 2(e) of the Lanham Act, thus suggesting that the deception went to a quality, *i.e.*, poisonousness of the product, rather than to the nature of the product itself, that is, a poison.<sup>105</sup> The mere statement of this supposed distinction should serve to demonstrate its ineffectiveness.

The Patent Office's Trademark Manual of Examining Procedure (TMEP) is designed to "provide trademark examiners in the Patent Office, trademark applicants, and attorneys and representatives for trademark applicants, with a reference work on the practices and procedures relative to prosecution of applications to register marks in the Patent Office."<sup>106</sup> It sets forth an interesting view on deceptively misdescriptive geographical marks:

If it is determined that the mark is primarily descriptive of geographic source, and the goods or services are *not* from that source, then the mark is primarily geographically *mis*-descriptive. Because of its primarily geographical character, the misdescriptiveness of the mark contains a *possibility of deception*, since the public is likely to recognize the geographical suggestion of origin and may be misled by it. Such a mark should be refused on the Principal Register, but it can be considered for registration . . . in accordance with Section 2(f) . . . .

If it is considered that there is *actual deception* . . . due to the misdescriptiveness contained in the primary geographic meaning of the mark, the Examiner must apply Section 2(a).<sup>107</sup>

This test based on "possibility of deception" versus "actual deception" is objectionable because the distinction is difficult to make.<sup>108</sup> It is

103. In re Bonide Chem. Co., 46 F.2d 705 (C.C.P.A. 1931).

104. Id. at 708-09.

105. 1 A. Seidel, S. Dubroff & E. Gonda, Trademark Law and Practice § 601, at 146 (1963).

106. Tegtmeier, Foreword to TMEP, *supra* note 4, at iii.

107. TMEP, *supra* note 4, § 1208.05 (emphasis added to "possibility of deception" and "actual deception").

108. Admittedly, this distinction does have an operational analogue in infringement cases. For example, section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1) (1970), uses "likelihood of confusion" as the test of infringement. However, it is quite clear that mere "likelihood" of confusion is sufficient only for injunctive relief, actual confusion being required for monetary relief. Id.; see 2 McCarthy, *supra* note 5, § 30:5; cf. Hubbard, Monetary Recovery Under the Copyright, Patent, and Trademark Acts, 58 Trademark Rep. 560, 588 (1968). Nevertheless, this "possibility" versus "actual" distinction does not seem appropriate in the registration context where the relief afforded for "violations" of either section 2(a) or section 2(e) is basically the same—refusal to register. Yet it could be counter-argued that a "possibly" deceptive mark—a section 2(e) mark under the TMEP analysis—should be treated as registrable (upon proof of section 2(f) secondary meaning), whereas an "actually" deceptive mark—a section 2(a) mark under the TMEP analysis—should be treated as unregistrable.

noteworthy that the TMEP does not suggest any procedure for drawing this distinction.

More significantly, the TMEP contains a second test for section 2(a) geographical deceptiveness—one that strongly suggests the influence of the GLASS WAX “materiality” test.<sup>109</sup>

The use of a term of geographic meaning is deceptive under Section 2(a) if the term is *of such nature that it misleads as to geographical source*, so that purchasers are moved to buy or not to buy in the belief that the goods or services originate in the place indicated.<sup>110</sup>

This test would have been more effectively stated if it had emphasized the phrase “so that purchasers are moved to buy in the belief that the goods or services originate in the place indicated,” rather than emphasizing the preceding phrase. The emphasis on the importance of purchasers’ motivations was supplied in the paragraph following the quotation under discussion: “If purchasers do not rely on the term and are not influenced by it, they are neither mislead [sic] nor deceived.”<sup>111</sup>

The TMEP enumerates the factors to be considered in deciding whether a mark is geographically deceptive under section 2(a). They are:

the type of goods or services to which the mark is applied; how well known the area is as a place of production of the goods or performance of the services; and the attitude of purchasers as to whether they rely in their purchasing on the term as indicating geographical origin.<sup>112</sup>

In keeping with its definition of geographical deception, therefore, the Trademark Manual includes purchaser-motivation as a factor to be considered in evaluating deceptiveness.

Professor McCarthy’s generally excellent treatise<sup>113</sup> does not shed much light on the section 2(a) versus section 2(e) issue. He starts in this cryptic fashion:

A mark may be “deceptively misdescriptive” under § 2(e) if it misrepresents any fact concerning the goods which may materially induce a purchaser’s decision to buy. A similar line between marks “deceptive” under § 2(a) and “primarily geographically [deceptively] misdescriptive” under § 2(e) is closely analogous to the deceptive-deceptively misdescriptive distinction . . . .<sup>114</sup>

This is followed by references to the “intention” test set out in the

109. See discussion in text accompanying notes 82-84 *supra*.

110. TMEP, *supra* note 4, § 1208.06 (emphasis in original).

111. *Id.*; see *id.* § 1202.02.

112. *Id.* § 1208.06.

113. McCarthy, *supra* note 5; see Germain, Book Review, 61 Ky. L.J. 931 (1973).

114. 1 McCarthy, *supra* note 5, § 11:19, at 385.

ITALIAN MAIDE<sup>115</sup> and SWEDEN cases<sup>116</sup> and proceeds to an analysis of the GLASS WAX case,<sup>117</sup> about which he concludes as follows:

The GLASS WAX decision did not draw a very clear or definite line between "deceptive" under § 2(a) and "deceptively misdescriptive" under § 2(e). Some element of deception is present in both characterizations. But the apparent *distinction in the GLASS WAX Case was the importance of the misdescriptive connotation upon the purchasing decisions of the consumer.*<sup>118</sup>

Thus, Professor McCarthy, though referring to the "intention" test, implicitly acknowledged the "materiality" test, but, unfortunately, failed to evaluate either.

Probably the best, and earliest, analysis of this problem was penned in 1958 by Assistant Commissioner Daphne Leeds. Based on the GLASS WAX case, Leeds wrote:

The distinction between a "deceptive" mark and a "deceptively misdescriptive" mark, within the meaning of the prohibitory provisions of the statute, seems to be that if purchasers are moved by the misdescriptive word or term to buy the product . . . the mark is "deceptive"; but if purchasers buy the product because it has given satisfaction and they do not care whether or not it contains or is the misdescribed product, the mark is "deceptively misdescriptive."<sup>119</sup>

With regard to geographic marks she had this to say:

In determining whether or not a mark is geographically deceptively misdescriptive when applied to the goods, one need only ask: Is it a geographical name or term which is likely to suggest that the product comes from the place or region named by the mark? If the answer is in the affirmative, the mark is "deceptively misdescriptive." *Are purchasers likely to care whether or not the product comes from the place or region which the mark identifies?* If the answer is in the negative, the mark is "deceptively misdescriptive"; but if the affirmative, it is "deceptive" and unregistrable under another provision of the act. This is to say that if a locality identified by a geographical name or term is known or noted for the production of goods in the category of applicant's, or for components of such goods, and purchasers are *moved by* the geographical name to buy the goods in the belief that they originate in the locality named, the geographical name or term is "deceptive" as applied to the goods.<sup>120</sup>

Thus, Leeds analyzed both geographical and nongeographical deceptiveness in terms of "materiality," *i.e.*, would the misdescription "move" the purchaser to purchase the goods or services.

115. In re Amerise, 160 U.S.P.Q. 687 (T.T.A.B. 1969); see notes 93-94 *supra* and accompanying text.

116. In re Sweden Freezer Mfg. Co., 159 U.S.P.Q. 246 (T.T.A.B. 1968).

117. Gold Seal Co. v. Weeks, 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom.* S.C. Johnson & Son v. Gold Seal Co., 230 F.2d 832 (D.C. Cir.) (*per curiam*), cert. denied, 352 U.S. 829 (1956).

118. 1 McCarthy, *supra* note 5, § 11:19, at 386 (*emphasis added*).

119. Leeds, Trademarks—The Rationale of Registrability, 26 Geo. Wash. L. Rev. 653, 662-63 (1958).

120. *Id.* at 663-64 (*emphasis added*) (footnotes omitted).

Material deceptiveness is deemed most offensive and dangerous and accordingly is classified as *fatally* unregistrable under section 2(a). If not material, the deceptiveness is deemed less offensive and dangerous and is only *initially* unregistrable as deceptively misdescriptive under section 2(e), and may be salvaged by section 2(f) secondary meaning. In this fashion consumers are adequately protected from *material* deceptions and are even given the initial benefit of the doubt vis-à-vis "immaterial" deceptions.

By focusing on materiality, courts can protect consumers' interests by using section 2(e) to reject possibly misleading marks<sup>121</sup> (like DUTCH and HOLLAND) without necessarily damning them to eternal unregistrability under section 2(a).<sup>122</sup> This would be consistent with the current widespread concern for the consumer and with the Federal Trade Commission's insistence on complete truthfulness in advertising,<sup>123</sup> particularly as such advertising may be interpreted by very unsophisticated persons.<sup>124</sup> It is also in keeping with the widely-held belief that the

121. Although this approach has the effect of discriminating between "actually" deceptive and "possibly" deceptive marks, the analytical starting point of materiality distinguishes this approach from the TMEP analysis discussed in notes 107-108 and accompanying text.

122. See *In re Amerise*, 160 U.S.P.Q. 687, 690 (T.T.A.B. 1969), where the Trademark Trial and Appeal Board noted that registrations were being improperly denied because Trademark Examiners were analyzing "deceptive" marks solely in terms of section 2(a) and failing to recognize the intermediate category of section 2(e) deceptive misdescriptiveness. Conversely, it is plausible to speculate that if the opponents of registration in the cases referred to in *In re Amerise*, *id.* at 691, had argued section 2(e), they might have succeeded in blocking registration—perhaps rightfully so—in the absence of secondary meaning. Cf. 1 McCarthy, *supra* note 5, § 11:19, at 386 ("The court in the GLASS WAX case was obviously straining not to hold the mark 'deceptive' under § 2(a) for such a decision would have barred the mark from any registration at all . . .").

123. See section 5 of the Federal Trade Commission Act, 15 U.S.C. § 45 (a)(1) (1970), outlawing "unfair or deceptive acts or practices in commerce;" *P. Lorillard Co. v. FTC*, 186 F.2d 52, 58 (4th Cir. 1950), where the court said: "To tell less than the whole truth is a well known method of deception; and he who deceives by resorting to such method cannot excuse the deception by relying upon the truthfulness per se of the partial truth by which it has been accomplished." See also section 14 of the Lanham Act, 15 U.S.C. § 1064(c) (1970), empowering the FTC to petition for cancellation of marks for a variety of reasons, including deceptiveness; *FTC v. Mary Carter Paint Co.*, 382 U.S. 46 (1965); *FTC v. Colgate-Palmolive Co.*, 380 U.S. 374 (1965); M. Beran, *An Introduction to Trademark Practice* 11-12 (1970), cautioning that misdescriptive or deceptive marks "[n]ot only will . . . be deemed objectionable when registration is sought, but there is the definite possibility that the Federal Trade Commission might object to the use of the trademark on grounds that it constitutes false and misleading advertising and hence is prohibited under the Federal Trade Commission Act." *Id.* at 11 (footnote omitted); Hanak, *The Quality Assurance Function of Trademarks*, 43 *Fordham L. Rev.* 363, 373 (1974), arguing for greater FTC involvement in policing trademarks.

124. See, e.g., *FTC v. Sterling Drug, Inc.*, 317 F.2d 669, 674 (2d Cir. 1963); *Charles of the Ritz Distribs. Corp. v. FTC*, 143 F.2d 676, 679-80 (2d Cir. 1944); *Heinz W. Kirchner*, 63 F.T.C. 1282 (1963), *aff'd*, 337 F.2d 751 (9th Cir. 1964).

use of descriptive and geographically descriptive trademarks should be discouraged.<sup>125</sup>

Lastly, the materiality test is workable. Admittedly, it is somewhat subjective, requiring a presumably sophisticated examiner or tribunal to determine what is in the mind of a diverse and often unsophisticated public, *i.e.*, what the public thinks the mark means and whether it cares about an inaccuracy. However, these determinations depend largely upon *objective* evidence contained in the record, *e.g.*, testimonial or survey materials that manifest *consumers'* interpretations of the marks involved.<sup>126</sup> Indeed, this is the very type of approach used daily by the courts and the Patent and Trademark Office to determine whether a mark poses a likelihood of confusing the public as to the origin of the goods or services to which the mark is applied.<sup>127</sup> Thus, if it is determined that members of the public believe that SWEDEN artificial kidney machines were made in Sweden, but it is further determined that *they do not care* whether they were made there or not, then section 2(e) is appropriate; whereas, if it is determined that they *do care*—ostensibly because they believe that Swedish-make medical machinery is superior in some way—then section 2(a) would be appropriate.<sup>128</sup>

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125. See 1 McCarthy, *supra* note 5, § 11:5(C); Vandenburg, *supra* note 3, § 4.60.

126. This objective, consumer-oriented approach is very different from the subjective, applicant-oriented "intent to deceive" approach approved of in the ITALIAN MAIDE and SWEDEN cases (see notes 93, 115-116 *supra* and accompanying text). The "intent to deceive" test requires peering into the applicant's mind to ascertain whether he intended to deceive—a very difficult and truly subjective endeavor.

127. See, *e.g.*, Aloe Creme Laboratories, Inc. v. Texas Pharmacal Co., 335 F.2d 72, 74 (5th Cir. 1964); Baker v. Simmons Co., 307 F.2d 458, 461, 463, 464 (1st Cir. 1962); LaTouraine Coffee Co. v. Lorraine Coffee Co., 157 F.2d 115, 117 (2d Cir.), cert. denied, 329 U.S. 771 (1946); Heublein, Inc. v. David Sherman Corp., 223 F. Supp. 430, 433-34 (E.D. Mo. 1963), *aff'd*, 340 F.2d 377 (8th Cir. 1965); 2 McCarthy, *supra* note 5, §§ 23:1-24. See generally R. Oziel, Contemporary Trademark Problems in Contested Patent Office Proceedings 116-34 (PLI 1969). But see Fort Howard Paper Co. v. Gulf States Paper Corp., 376 F.2d 904, 905 (C.C.P.A. 1967); Rex Shoe Co. v. Juvenile Shoe Corp. of America, 273 F.2d 179, 180 (C.C.P.A. 1959) ("Whether marks are likely to cause confusion or mistake or deceive average purchasers is, in final analysis, a matter of opinion."); 2 McCarthy, *supra* note 5, § 23:26.

128. This approach also helps answer Professors Kitch and Perlman's questions "Would use of the mark 'Old Crow Whiskey' be in violation of section 43(a)?" and "How do these various provisions [sections 2(a), 2(e), 43(a)] interrelate?" Kitch & Perlman, *supra* note 3, at 432.

Section 43(a) authorizes a civil action against one who uses "a false designation of origin, or any false description or representation" with relation to goods or services in interstate commerce. 15 U.S.C. § 1125(a) (1970). According to one authority, actions under section 43(a) require proof of (1) falsity, (2) actual or potential deception, (3) materiality to the purchaser, and (4) likelihood of injury to the complainant. Weil, Protectibility of Trademark Values Against False Competitive Advertising, 44 Calif. L. Rev. 527, 537 (1956); accord, Skil Corp. v. Rockwell Int'l Corp., 375 F. Supp. 777, 783 (N.D. Ill. 1974); Germain, Unfair Trade Practices under Section 43(a) of the Lanham Act: You've

## V. CONCLUSION

A careful reading of section 2 of the Lanham Act, with special sensitivity to the crucial differences between subsections (a) and (e), and an examination of judicial and non-judicial interpretations of those subsections, strongly suggests that "materiality" is the factor that separates the two kinds of marks. To illustrate this point and the various other conclusions drawn in this paper, the following analysis of the fictitious trademark *LOKEN LOLLIPOPS*<sup>129</sup> is presented:

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Come a Long Way, Baby—Too Far, Maybe?, 49 *Ind. L.J.* 84, 95-100 (1973), reprinted in 64 *Trademark Rep.* 193, 205-09 (1974), 13 *Publishing Entertainment Advertising L.Q.* 215, 228-33 (1974); see *Gold Seal Co. v. Weeks*, 129 *F. Supp.* 928, 940 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson v. Gold Seal Co.*, 230 *F.2d* 832 (D.C. Cir.) (per curiam), cert. denied, 352 *U.S.* 829 (1956); cf. *Middletown Mfg. Co. v. Super Sagless Corp.*, 382 *F. Supp.* 979, 983 (N.D. Miss. 1974), *aff'd*, 515 *F.2d* 509 (5th Cir. 1975) (misrepresentation irrelevant to purchasers). Marks violative of section 2(e) would most likely satisfy requirements (1) and (2) because of their misdescriptiveness—a type of falsity—and deceptiveness. However, under section 2(e) as interpreted by this Article, requirement (3) would be lacking since a determination that section 2(e) applies includes a determination that the deception was immaterial to the purchaser. Requirement (4) would be satisfied since objection to registration of a mark is raised either in an opposition proceeding or in a cancellation proceeding, both of which require the complainant to be damaged or be in a position to be damaged by registration of the mark on the principal register. Lanham Act §§ 13-14, 15 *U.S.C.* §§ 1063-64 (1970). Thus, due to the absence of "materiality"—the very feature that should be used to distinguish section 2(e) marks from section 2(a) marks—section 2(e) marks would not be actionable under section 43(a). Conversely, section 2(a) marks necessarily would violate section 43(a) since to be "deceptive" under section 2(a), a mark must be (1) false, (2) deceptive, and (3) materially deceptive to the purchaser. (Again, the "damage" component would be included in the requirements for bringing an opposition or cancellation proceeding). Consequently, while section 43(a) would allow section 2(e) marks to survive (both before and after any subsequent registration under section 2(f)), it would permanently condemn section 2(a) marks—a result wholly consistent with section 2(a)'s intent and operation to permanently bar registration of such marks. Thus, it should be concluded that "Old Crow Whiskey" does not come within section 43(a).

In response to Kitch and Perlman's observation that sections 2(a) and 2(e) refer to "trademarks" and "marks" respectively, whereas section 43(a) contains no reference to either (see Kitch & Perlman, *supra* note 3, at 432), it should be noted that section 43(a) was not designed specifically for use in ordinary trademark cases, but was intended to broadly cover situations where "the trademark itself describes or represents a false characteristic of the goods or services to which it relates, and to cases truly involving false designations of geographical origin." Germain, *Unfair Trade Practices Under Section 43(a) of the Lanham Act: You've Come a Long Way, Baby—Too Far, Maybe?*, 49 *Ind. L.J.* 84, 111-12 (1973), reprinted in 64 *Trademark Rep.* 193, 221 (1974), 13 *Publishing Entertainment Advertising L.Q.* 215, 246 (1974) (emphasis deleted). Thus, marks such as *NORMINK* for imitation fur, and *SCOTCH* for Panamanian whiskey, were properly held actionable. See *Mutation Mink Breeders Ass'n v. Lou Nierenberg Corp.*, 23 *F.R.D.* 155 (S.D.N.Y. 1959), and *Scotch Whiskey Ass'n v. Barton Distilling Co.*, 338 *F. Supp.* 595 (N.D. Ill. 1971), *rev'd* on other grounds, 489 *F.2d* 809 (7th Cir. 1973).

129. "Loken" is a fanciful amalgam of the given names of this Article's author and his wife. It has often been used as the mythical jurisdiction in which moot court cases arise.



- (1) If *LOKEN* is a common variety of bird (which of course has nothing to do with lollipops), then it is an "arbitrary" mark and is registrable under section 1 without recourse to section 2.<sup>130</sup>
- (2) If *LOKEN* means "sweet" and *LOKEN LOLLIPOPS* are sweet, then it is "merely descriptive" under section 2(e)(1) and cannot be registered except under section 2(f).
- (3) If *LOKEN* is a well-known geographic area and *LOKEN LOLLIPOPS* are manufactured there, then it is "primarily geographically descriptive" under section 2(e)(2) and cannot be registered except under section 2(f).
- (4) If *LOKEN* means "enormous" and *LOKEN LOLLIPOPS* are miniatures, then it is misdescriptive, *but not deceptively so*, and it is registrable without recourse to section 2.<sup>131</sup>
- (5) If *LOKEN* is the name of a West Indian resort island not known for any commercial goods, and *LOKEN LOLLIPOPS* are *not* made there, then it is geographically misdescriptive, *but not deceptively so*, and it is registrable without recourse to section 2.<sup>132</sup>
- (6) If *LOKEN* means "gelatin" and *LOKEN LOLLIPOPS* do not contain any gelatin, and *purchasers are fooled but do not care*, then it is "merely . . . deceptively misdescriptive" under section 2(e)(1) and it cannot be registered except under section 2(f).<sup>133</sup>
- (7) If *LOKEN* is the name of a geographic area that is well known as a source of manufactured goods other than foodstuffs, and *although purchasers are misled into believing that LOKEN LOLLIPOPS are made there they really do not care*, then it is "primarily geographically . . . misdescriptive" under section 2(e)(2) and cannot be registered except under section 2(f).<sup>134</sup>
- (8) If *LOKEN* means "sugarless" and *LOKEN LOLLIPOPS* are *not* sugarless, and *purchasers are thus misled with regard to something they do care about*, then it is "deceptive" under section 2(a) and can never be registered.<sup>135</sup>
- (9) If *LOKEN* is the name of town famed for its candy industry, and *LOKEN LOLLIPOPS* bear no relationship to that town, and *purchasers are thus misled*

130. Likewise, of course, if *LOKEN* is merely a coined, meaningless term, it is a "fanciful" mark and registrable without recourse to section 2.

131. *AUTOMATIC RADIO* for air conditioners was correctly analyzed this way. In re *Automatic Radio Mfg. Co.*, 404 F.2d 1391 (C.C.P.A. 1969); see discussion in text accompanying notes 12-13, 56-58 *supra*.

132. Cf. *Eastern Constr. Co. v. Eastern Eng'r Corp.*, 246 N.Y. 459, 466, 159 N.E. 397, 399-400 (1927) (Crane, J., dissenting) (action to enjoin use of trade name *EASTERN*).

133. *GLASS WAX* is the prototype example here. See discussion in text accompanying notes 81-84 *supra*.

134. *ITALIAN MAIDE* for canned vegetables and *LONDON* for phonograph records are apt examples. See discussions in text accompanying notes 85-89, 93-97 and 55 *supra*, respectively.

135. See, e.g., *Sponge & Chamois Institute v. Curtiss-Wright Corp.*, 120 U.S.P.Q. 309 (T.T.A.B. 1959) (*CHAMI SPONGE* for synthetic sponges); *Ex parte Makers of Kal, Inc.*, 114 U.S.P.Q. 504 (Comm'r Pats. 1957) (*THE PRESIDENT'S FORMULA* for vitamins having no connection with the United States President).

*with regard to something they do care about*, then it is "deceptive" under section 2(a) and can never be registered.<sup>136</sup>

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136. See, e.g., *In re Danish Maid Cultured Prods., Inc.*, 156 U.S.P.Q. 430 (T.T.A.B. 1967) (DANISH MAID for non-Danish dairy products); *In re Richemond*, 131 U.S.P.Q. 441 (T.T.A.B. 1961) (MAID IN PARIS for non-Parisian perfumes).