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Trademarks and Unfair Competition by J. Thomas McCarthy

Kenneth B. Germain
University of Kentucky

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Special Book Review

TRADEMARKS AND UNFAIR COMPETITION

By J. THOMAS MCCARTHY

ROCHESTER, NEW YORK: LAWYERS CO-OPERATIVE PUBLISHING CO.,
1973. Pp. 1663, WITH INDEX, TABLE OF CASES, AND APPENDICES
2 vols. \$55.00.

This two-volume treatise is composed of two helpful tables of contents—one summarized and one detailed—33 well-conceived chapters, seven useful appendices, a table of cases and an index. The quality of the printing—all important in an oft-used reference book—is excellent: the paper is heavy, opaque, and white, while the print is bold and black.

The first six chapters are devoted to “background” matters such as the relation between trademark law and the law of unfair competition, the philosophy and history of trademark and unfair competition law, and the meanings and derivations of many of the basic terms. In one of these chapters the author clearly and accurately explains the controversy over the propriety and justifiability of “persuasive” and “informative” advertising. Elsewhere, he suggests the constant tension between competitors and consumers: many of the former want enforcement of “business ethics” in order to protect their investments and to prevent others from “reaping where they have not sown”; the latter often care little about anything except getting quality merchandise and services for the lowest price possible. This difference in viewpoint shows up very clearly in the area of copying, for although competitors condemn slavish copying of another’s popular goods, consumers generally benefit from such copying. The “tension” thus arises because the interests of the competitors and the consumers are in conflict.

The seventh chapter discusses the various formats that trademarks may assume, while the succeeding three chapters cover trade dress, trade names, and literary and artistic rights. Special emphasis is placed on the effects of the landmark *Sears* and *Compco* cases¹ on these aspects of unfair competition.

Chapters 11 through 18 cover many of the traditional aspects of trademark law, including the doctrines of descriptive, generic, surname

¹ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Daybrite Lighting, Inc.*, 376 U.S. 234 (1964).

and geographical marks; secondary meaning; acquisition and loss of trademark rights; and transfers of the incidents of ownership by assignment and license.

Chapters 19 through 21 are devoted to a very comprehensive exposition of all aspects of federal registration of "marks,"² including an especially enlightening discussion of Patent Office proceedings, which discussion is clarified by sample forms printed in the text.³ Chapter 22 briefly discusses various state registration schemes and ramifications; it contains some helpful charts showing the nature of each state's system.

Chapters 23 through 26 are concerned with numerous aspects of infringement—the basic "likelihood of confusion" test, infringements involving "related" goods, various types of infringing situations, and the geographical limitations of infringement. Chapters 30 through 32 complement chapters 23 through 26 by covering remedies, defenses, and procedures applicable to infringement suits. Chapter 33 rounds out the trademark materials by providing a very helpful set of "Checklists of Legal Claims and Defenses."

A few areas of unfair competition not directly related to trademarks are nicely covered also. False advertising is covered in a chapter which discusses common law remedies and cases brought under the relatively new "federal law of unfair competition" developing around § 43(a) of the Lanham Act. In addition, there are two chapters on competitive restrictions related to sales of businesses and the rights and duties of ex-employees. Unfortunately, these two chapters are not quite as well done as most of the others.

In the table of cases all references are to chapter and sections; this is not as effective as references to specific pages. Moreover, cases are listed only by plaintiffs' names; there is no table of cases by defendants' names. The index refers to subsections in addition to chapters and sections, and is otherwise excellent because of its detailed and complete coverage.

The appendices are well-chosen and very useful. In addition to the Lanham Act, there are references to some related trademark statutes and a table of text references for each section of the Act. Moreover, the official Trademark Rules of Practice, many forms for use in the Patent Office, and samples of notices issued by the Patent Office in trademark registration proceedings are included. Unfortu-

² Under § 45 of the Lanham Act, the word "mark" refers to "any trade-mark, service mark, collective mark, or certification mark entitled to registration under this act." 15 U.S.C. § 1127, ¶ 13 (1970).

³ This inclusion of sample forms *in the text* is far more convenient than the typical placement of such forms in appendices.

nately, however, there are no tables of articles and books cited, or of word or symbol marks.⁴

The remainder of this review will be devoted to comments on the coverage, organization, writing style, quality of citations, and special features of the treatise, and on the author's "viewpoint."

As indicated above, this treatise emphasizes the law of trademarks proper and related aspects of unfair competition such as trade names, trade dress and product simulation. What is missing—with reference to a broad interpretation of the term "unfair competition"—is material on the role of the Federal Trade Commission, coverage of the international aspects of trademark law, and chapters on such topics as trade secrets, disparagement, tortious interference with contractual relations, and unfair practices in connection with gifts, premiums, and lotteries. It could also be said that "unfair competition" should include price discrimination, sales below cost and resale price maintenance along with such other antitrust-related subjects as boycotts and territorial restrictions. Although the absence of these various topics does not detract from the effectiveness of the treatise vis-a-vis the covered topics, it may make a prospective purchaser with limited resources more inclined to buy a treatise with broader coverage.⁵

The organization of the treatise is quite excellent. The chapters are logically chosen and make it easy to find the various topics covered. In addition, the medium-length and long chapters are divided into sensible subchapters which add to the overall clarity. For example, chapter 20, which is entitled "Inter Partes Trademark Proceedings in the Patent Office" and spans 91 pages, is divided into five subchapters designated "Opposition Proceedings," "Cancellation Proceedings," "Concurrent Use Proceedings," "Interference Proceedings," and "Procedure in Inter Partes Cases." Chapters and subchapters are conveniently further divided into sections, all of which are very clearly labeled in the detailed table of contents printed in the front of each volume, at the beginning of each chapter, and in the body of the text itself. The organization is especially well-conceived because it carefully categorizes the analysis into "old" or "modern" views and "common law" or "Lanham Act" rules.

The writing style of the author is clear and readable, especially because he avoids the extensive use of textual footnotes. Ample use is

⁴ All of these features are included in E. VANDENBURGH III, *TRADEMARK LAW AND PROCEDURE* 628-46 (2d ed. 1968), and a table of word marks is included in 5 R. CALLMANN, *UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* (3d ed. 1968).

⁵ The five-volume treatise by Mr. Callmann, *supra* note 4, is the standard comprehensive work on unfair competition; it covers all of the topics just mentioned in the text.

made of apt quotations, which generally appear in the text, rather than in footnotes. Moreover, unlike the other treatises in the field,⁶ the author makes considerable use of drawings and photographs of numerous trademarks and related trade designations; these visual presentations are far more instructive than written descriptions—especially when the issue involved is something like “confusing similarity.”

The author’s citations of case authorities are generally very sound. All of the major cases seem to be cited and there is an obvious and prudent preference for very recent cases where available.⁷ Unfortunately, however, quotations are not cited to the exact pages on which they actually appear, and references to the periodical literature are skimpy in some areas.

As “special features” of merit I would list the “checklists” provided in the last chapter and in a few scattered sections and the roughly two dozen “comments” sections and numerous short paragraphs interspersed throughout the text at crucial points. These “comments” are excellent because they pull together various ideas already discussed and stimulate thought about problematic current issues.

A few words about the “viewpoint” manifested by the author may be of interest because of the very obvious and strong “protectionist” bias that pervades the leading treatise on unfair competition and trademarks.⁸ Happily, I am able to write that the current author is only slightly “protectionist” and has completely avoided emotional and patently biased positions.

In conclusion, the reviewed treatise provides an excellent exposition and analysis of the law of trademarks and part of the greater law of “unfair competition.” It is well conceived, well written, and beautifully organized, and would make a valuable addition to the library of any practitioner who at least dabbles in trademarks and unfair competition. Furthermore, judging from my recent experience this past semester, the McCarthy treatise can be a valuable tool for law teachers and law students in connection with basic courses in unfair trade practices or trademarks. Indeed, I consider it the best treatise available on the law of trademarks and closely-related matters.

*Kenneth B. Germain**

⁶ See treatises cited in note 4 *supra*; A. SEIDEL, S. DUBROFF & E. GONDA, TRADEMARK LAW AND PRACTICE (1963).

⁷ There is a much greater emphasis on recent cases than there is in the other comparable treatises. This is especially true since the latest supplements for the Callmann and Vandenburg works are dated 1971 and since the Seidel-Dubroff-Gonda work has never been supplemented.

⁸ R. CALLMANN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES (3d ed. 1967-70).

* Assistant Professor of Law, University of Kentucky College of Law. A.B., Rutgers University (1966); J.D., New York University School of Law (1969).