

PRIMARY SIGNIFICANCE: PROVING THE CONSUMER'S PERCEPTION

I. INTRODUCTION

The distinctiveness of a trademark is the principal factor courts have traditionally examined in determining the degree of protection the mark will be afforded.¹ Terms for which trademark protection is sought are customarily grouped as generic, descriptive, suggestive, and arbitrary or fanciful.² Generic terms receive no trademark protection,³ while arbitrary or fanciful marks are regarded as being inherently distinctive⁴ and are protectable and registrable immediately upon use.⁵ Suggestive marks are those which describe or suggest a characteristic of a product: They are registrable and entitled to the same protection as arbitrary or fanciful terms.⁶ Descriptive terms can neither be registered nor protected unless secondary meaning is proven.⁷ Even if registrable, however, these descriptive terms traditionally have been categorized as "weak" marks, and as such, given a narrower range of protection than fanciful, arbitrary, or suggestive terms.⁸

¹ See 3 R. CALLMANN, *THE LAW OF UNFAIR COMPETITION TRADEMARKS AND MONOPOLIES* § 69 (3d ed. 1969); 1 J. GILSON, *TRADEMARK PROTECTION AND PRACTICE* § 2.01 (1982); see also *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 862 (C.C.P.A. 1962) ("Distinctiveness . . . means that the *primary* meaning of the word . . . is as a designation of source rather than of a characteristic of the product." (emphasis in original)).

² 1 J. MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION* § 11:2 (1973); see, e.g., *King-Size, Inc. v. Frank's King Size Clothes, Inc.*, 547 F. Supp. 1138, 1151 (S.D. Tex. 1982) (complete discussion of four terms).

³ See *infra* notes 9-16 and accompanying text.

⁴ See 1 J. MCCARTHY, *supra* note 2, at § 11:2. "A fanciful mark is a word which is coined for the express purpose of functioning as a trademark. It could also be any obscure or archaic term not familiar to buyers." *Id.* The following trademarks have been determined to be fanciful: "Kodak," "Sanka," and "Clorox." *Id.* at § 11:3(D). An arbitrary mark is "a word or symbol which is in common usage in the language, but which is arbitrarily applied to the goods or services in question in such a way that it is not descriptive or suggestive." *Id.* at § 11:2. The following trademarks are examples of arbitrary marks: "Ivory" as applied to soap, "Bumble Bee" as applied to tuna and "Dove" as applied to soap.

⁵ *Id.*; see also Lanham Act § 2, 15 U.S.C. § 1052(f) (1982). This section states in pertinent part: "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." *Id.* A trademark does not have to be registered in order to be protected under the common law of unfair competition. 1 J. GILSON, *supra* note 1, at § 1.04 [2] [b]; see 1 J. MCCARTHY, *supra* note 2, at § 2.2.

⁶ 1 J. MCCARTHY, *supra* note 2, at § 11:20 (A). For a complete discussion of why the category of suggestive marks arose, see *id.* at § 11:20 (B). An example of a suggestive mark is "Handi-Wipes."

⁷ See *infra* notes 18-22 and accompanying text.

⁸ See 1 J. MCCARTHY, *supra* note 2, at § 11:24.

A generic term is the common name of the product or service itself.⁹ It identifies the nature or class of an article, and in essence answers the question, "What are you?"¹⁰ A trademark, on the other hand, identifies the trademarked goods and distinguishes them from those manufactured or sold by others.¹¹ A trademark therefore answers the question, "Who are you?"¹² Thus, generic terms and trademarks serve totally different functions.¹³ It is well settled that generic names are free for all to use and hence may not be appropriated as trademarks.¹⁴ Moreover, the Lanham Act provides for the cancellation of the federal registration of a trademark if it at any time "becomes the common descriptive name of an article or substance"¹⁵ All trademarks are capable of becoming generic

⁹ 1 J. McCARTHY, *supra* note 2, at § 12:1; *see* 1 J. GILSON, *supra* note 1, at § 2:02; Zivin, *Understanding Generic Words*, 63 TRADE-MARK REP. 173, 174 (1973).

¹⁰ Zivin, *supra* note 9, at 174-75; *see* 1 J. McCARTHY, *supra* note 2, at § 12:1. McCarthy gives the following example of a generic response to a question: "[A] person is asked 'Who are you?' If he answers, 'I am a man, homo sapiens', he is not telling the questioner *who* he is, but *what* he is." *Id.* (emphasis in original).

¹¹ Lanham Act § 45, 15 U.S.C. § 1127 (1982); *see* 1 J. McCARTHY, *supra* note 2, at § 12:1.

¹² 1 J. McCARTHY, *supra* note 2, at § 12:1. Referring back to McCarthy's example, *supra* note 10, the trademark response to the "who are you?" question would be the person's proper name; e.g., "I am Bob Smith."

¹³ *Id.*; *see also* Folsom & Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1323 (1980) ("[o]ne of the most important limitations on the legal protection of a word adopted as a trademark is that it cannot be a term that refers, or has come to be primarily understood by the consuming public as referring, to a product category").

¹⁴ *See* Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938) ("[s]haring in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all"); Elgin Nat'l Watch Co. v. Illinois Watch Case Co., 179 U.S. 665, 673 (1901) ("no . . . words can be appropriated as a valid trademark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth and with equal right for the same purpose"); Delaware & Hudson Canal Co. v. Clark, 80 U.S. (13 Wall.) 311, 323 (1872) ("[n]or can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trademark and the exclusive use of it be entitled to legal protection"). This view has been carried through in the Lanham Trademark Act which provides that "merely descriptive" marks shall be denied registration on the principal register: "No trade-mark . . . shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive . . . of them. . . ." Lanham Act § 2, 15 U.S.C. § 1052 (1982).

¹⁵ Lanham Act § 14(c), 15 U.S.C. § 1064 (1982). That section provides in pertinent part:

A petition to cancel a registration of a mark . . . may . . . be filed by any person who believes that he is or will be damaged by the registration of a mark

. . . .
(c) at any time if the registered mark becomes the common descriptive name of an article or substance. . . .

Id. "Common descriptive name" has been interpreted by the courts as meaning "generic name." *See* Anti-Monopoly, Inc. v. General Mills Fun Group, 611 F.2d 296, 301 (9th Cir. 1979), *on remand*, 515 F. Supp. 448 (N.D. Cal. 1981), *rev'd and remanded*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

whether they are arbitrary, fanciful, suggestive, or descriptive with secondary meaning.¹⁶

While many courts do not sharply distinguish between generic names and descriptive terms, the two should not be confused.¹⁷ A descriptive term is generally understood to be one which "informs the purchasing public of the characteristics, quality, functions, uses, ingredients, components, or other properties of a product, or conveys comparable information about a service."¹⁸ It answers the question "What does it do?," or "What does it look, sound, feel or taste like?"¹⁹ Descriptive terms may acquire trademark significance if they attain secondary meaning.²⁰ This occurs when the term comes to be regarded by the consuming public as designating the source of the product.²¹ Judge Denison's often quoted explanation of secondary meaning is as valid today as it was in 1912:

There is nothing abstruse or complicated about this theory. . . . It contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to

¹⁶ See Zivin, *supra* note 9, at 176.

¹⁷ See 1 J. GILSON, *supra* note 1, at § 2.02 (1974); see also *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11 (2d Cir. 1975) (lower court reasoned secondary meaning might protect generic name); *Jewel Tea Co. v. Kraus*, 187 F.2d 278 (7th Cir. 1950) (phrase "generically descriptive" criticized as meaningless); *Redken Laboratories, Inc. v. Clairor Inc.*, 350 F. Supp. 1301 (C.D. Cal. 1972) (product name "Condition" held generic of process but descriptive of goods), *aff'd in part, vacated in part*, 501 F.2d 1403 (9th Cir. 1974); *Application of Automatic Radio Mfg. Co.*, 404 F.2d 1391 (C.C.P.A. 1969) (phrase "generically descriptive" criticized as meaningless).

¹⁸ 1 J. GILSON, *supra* note 1, § 2.03, at 2-31.

¹⁹ *Id.* § 2:02, at 2-8.1. "In addition, a mark is 'descriptive' if it is descriptive of . . . the class of users of the goods . . . or of the end effect upon the user." 1 J. MCCARTHY, *supra* note 2, at § 11.5(B); see also 1 J. GILSON, *supra* note 1, § 2.03, at 2-31. Some examples of terms which have been considered descriptive are "lite" as applied to beer, "feathercombs" as applied to hair retaining combs, and "steak and brew" as applied to restaurants. See *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5 (1st Cir. 1981); *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251 (2d Cir. 1962); *Longchamps, Inc. v. Eig.*, 167 U.S.P.Q. (BNA) 81 (S.D.N.Y. 1970).

²⁰ See, e.g., *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 336 (1938) (trademark or tradename which has acquired secondary meaning in addition to its descriptive character entitled to protection). A descriptive term may be registered under § 2 (f) of the Lanham Act if it becomes distinctive. 15 U.S.C. § 1052 (f) (1982); see *supra* note 5 for partial text of statute. Distinctive in § 2 (f) means the same thing as secondary meaning. *Application of Automatic Radio Mfg. Co.*, 404 F.2d 1391 (C.C.P.A. 1969).

²¹ See 1 J. MCCARTHY, *supra* note 2, at § 11.9; see also *Salton Inc. v. Cornwall Corp.*, 477 F. Supp. 975, 988 (D.N.J. 1979) ("[s]econdary meaning comes about when a phrase or name has been used so long and so exclusively by one producer that to consumers of the item the word or phrase now means that producer's product"); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 608 (S.D.N.Y. 1979) ("secondary meaning connotes the association in the mind of the public of the trademark with the source of the goods"); *American Basketball Ass'n v. AMF Voit, Inc.*, 358 F. Supp. 981, 986 (S.D.N.Y. 1973) (" 'secondary meaning' . . . is equivalent to an association between the 'trademark' and the supposed source of the goods such that an ordinary man would immediately associate the goods with their source").

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 had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark. So it was said that the word had come to have a secondary meaning, although this phrase, 'secondary meaning,' seems not happily chosen, because, in the limited field, this new meaning is primary rather than secondary; that is to say, it is, in that field, the natural meaning.²²

While all generic terms are descriptive, however, all descriptive terms are not generic.²³ The difference between the two is largely perceptual: If the mark is perceived one way, it is generic, if another, it is descriptive. While it is difficult to draw this distinction with any precision it is a crucial one. If the term is determined to be generic it can never be given trademark protection, but if determined to be descriptive, it can be given trademark protection upon proof of secondary meaning.²⁴

The modern trademark functions on three different levels—"as an indication of origin or ownership, as a guarantee of constancy, and as a medium of advertisement."²⁵ A trademark has been described as "a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants."²⁶ As such, they are valuable commodities. Trademark owners must thus be ever wary; a determination of genericness would strip them of a very valuable asset.

²² *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912), *aff'd and modified*, 238 F. 1 (6th Cir.), *cert. denied*, 243 U.S. 651 (1917).

²³ Zivin, *supra* note 9, at 175; see Leavenworth, *Lost Monopolies*, 32 TRADE-MARK BULL. 329 (1937), reprinted in 61 TRADE-MARK REP. 28 (1971).

²⁴ 1 J. MCCARTHY, *supra* note 2, at § 12:5; see *supra* note 5. It is possible, but extremely difficult, to reclaim a generic term from the public domain. See, e.g., *Singer Mfg. Co. v. Briley*, 207 F.2d 519 (5th Cir. 1953) (term Singer, held generic in 1895, recaptured from public domain by continuous use on variety of products). For a complete discussion of the difficulties encountered in reclaiming a generic term, see 1 J. MCCARTHY, *supra* note 2, at § 12:10.

²⁵ 3 R. CALLMANN, *supra* note 1, at § 65; see 1 J. MCCARTHY, *supra* note 2, at § 3:1(B). Gilson, on the other hand, sees trademarks as serving six different and exclusive functions: "(a) designates the source or origin of a particular product or service, even though the source is to the consumer anonymous; (b) denotes a particular standard of quality . . . ; (c) identifies a product . . . and distinguishes it from . . . others; (d) symbolizes the good will of its owner . . . ; (e) represents a substantial advertising investment . . . ; (f) protects the public from confusion and deception" 1 J. GILSON, *supra* note 1, at § 1.03; see also Diamond, *The Historical Development of Trademarks*, 65 TRADE-MARK REP. 265 (1975) (discusses historical functions of trademarks).

²⁶ *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

II. DOCTRINE OF GENERICNESS

The seminal decision on genericness came from the Southern District Court of New York in 1921.²⁷ In *Bayer Co. v. United Drug Co.*,²⁸ Judge Learned Hand identified the test for determining whether an arbitrary name has become generic as “[W]hat do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, then . . . it makes no difference whatever what efforts the plaintiff has made to get them to understand more.”²⁹ The court pointed out that to consumers the term “aspirin” meant only a product, not a manufacturer, and therefore “aspirin” was generic as to that segment of the population, and could not be given trademark protection.³⁰ Judge Hand did hold, however, that the term “aspirin” continued to serve as a source indicator to manufacturing chemists, physicians, and retail druggists, and thus was a valid trademark only with regard to that group.³¹ According to Judge Hand the test was clear: If the term denoted *only* the product, it was generic and therefore not amenable to trademark protection, but if it served as a source indicator, trademark protection was warranted.³²

The law rarely remains black and white and the doctrine of genericness is no exception. Seventeen years after Judge Hand's *Bayer* decision, the Supreme Court granted certiorari to determine whether National Biscuit Company held the exclusive right to the term “Shredded Wheat.”³³ The Court, in holding the term “Shredded Wheat” to be generic, did not apply the “only product” standard formulated by Judge Hand, but rather determined that a trademark is generic if its “primary significance” in the minds of consumers is to indicate the product rather than its source.³⁴

The National Biscuit Company manufactured “a product composed of whole wheat which ha[d] been boiled, partially dried, then

²⁷ *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

²⁸ *Id.*

²⁹ *Id.* at 509.

³⁰ *Id.* at 510. Two factors considered by the court were first, that aspirin was a patented product until 1917, and second, that there was no alternative name for the product other than its chemical name, *acetyl salicylic acid*. *Id.* at 511.

³¹ *Id.* at 510. The court held that in direct sales to the public the defendant could use the term “aspirin” to describe its product, while in sales to professional customers, the defendant could not use the term “aspirin” at all, but had to designate it as *acetyl salicylic acid*. *Id.* at 514.

³² *Id.* at 509; see *supra* text accompanying note 29.

³³ *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) [hereinafter cited as *Shredded Wheat*].

³⁴ *Id.* at 118.

drawn or pressed out into thin shreds and baked" in pillow-shaped form.³⁵ This process was covered by a patent which expired in 1912.³⁶ Beginning in 1912 and ending in 1919, the Kellogg Company manufactured a similar product.³⁷ In 1927 Kellogg resumed production.³⁸ In 1928, National Biscuit brought an unfair competition action against two of Kellogg's dealers.³⁹ This suit was discontinued by stipulation, and in 1932 National Biscuit brought a federal action seeking an injunction against alleged unfair competition by Kellogg.⁴⁰ The district court dismissed the bill in 1935, finding that the name "Shredded Wheat" was a descriptive term and that the National Biscuit Company had not proven "passing off" or deception.⁴¹ The Court held that "upon the expiration of the . . . patent . . . the name of the patented article passed into the public domain."⁴² The Court of Appeals for the Third Circuit affirmed the decree of the district court, but upon rehearing vacated its own decision and reversed the decision of the district court, directing it " 'to enter a decree enjoining [Kellogg] from the use of the name 'Shredded Wheat' as its trade-name and from advertising or offering [it] for sale' " in the biscuit form.⁴³

The Supreme Court found that National Biscuit had not acquired the right to the exclusive use of the term "Shredded Wheat" as its trade name.⁴⁴ The Court set forth two bases for its decision. Justice Brandeis first determined that upon the expiration of the patent, "the name 'Shredded Wheat,' as well as the product, the process and the machinery employed in making it, ha[d] been dedicated to the public."⁴⁵ The Court stated that during the patent period "Shredded Wheat" was the common name of the patented product, and as such,

³⁵ *Id.* at 113.

³⁶ *Id.* at 117-18.

³⁷ *Id.* at 114. Kellogg's final product was similar in form to that made by National Biscuit, but its manufacture was different in that the wheat was reduced to dough before shredding.

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.* at 114-15 (quoting *National Biscuit Co. v. Kellogg Co.*, 91 F.2d 150, 152 (3d Cir. 1937), *rev'd*, 305 U.S. 111 (1938)).

⁴⁴ *Id.* at 116.

⁴⁵ *Id.* at 117-18 (citing *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896)). The *Singer* Court had held that after the expiration of the patent, the patented device fell into the public domain and that "along with the public ownership . . . there must also necessarily pass to the public the generic designation of the thing . . ." *Singer*, 163 U.S. at 185.

the term "Shredded Wheat" was generic long before the patent expired.⁴⁶

The other basis for the Court's decision has had profound effects on trademark law. The Court stated that "'Shredded Wheat' . . . is the generic term of the article, which describes it with a fair degree of accuracy; and is the term by which the biscuit in pillow-shaped form is generally known by the public."⁴⁷ Justice Brandeis found that "to establish a trade name in the term 'shredded wheat' the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer."⁴⁸ Although courts over the years have not always explicitly cited the *Shredded Wheat* rationale,⁴⁹ it is now clear that the "primary significance" analysis set forth by the Court in 1938 is the test to be applied in determining whether any term—be it arbitrary, fanciful, suggestive,

⁴⁶ *Shredded Wheat*, 305 U.S. at 118. This Comment will not explore further the Court's first basis for its determination of genericness. For a discussion of the effect of patent expiration upon trademarks see Greenberg, *The Effect of Patent Expiration on Trade Mark Rights*, 25 J. PAT. OFF. SOC'Y 564 (1943). Zivin notes that, in any event, the patent issue added nothing to the reasoning of the *Shredded Wheat* Court. Zivin, *supra* note 9, at 185.

⁴⁷ *Shredded Wheat*, 305 U.S. at 116. The Court's language lent itself to confusion by failing to distinguish between generic terms that are incapable of trademark significance, and descriptive terms that can become valid trademarks if they develop a secondary meaning. Consequently, some courts have read the *Shredded Wheat* opinion as setting forth the test for determining when a descriptive term has acquired secondary meaning, rather than as the test for genericness. See, e.g., *King-Size, Inc. v. Frank's King Size Clothes, Inc.*, 547 F. Supp. 1138, 1156 (S.D. Tex. 1982) ("In order to establish secondary meaning, the [plaintiffs] must show more than a subordinate meaning which applies to it. [Plaintiffs] must show that the primary significance of the term in the minds of the consuming public is not the product but the producer." (citing *Shredded Wheat*, 305 U.S. at 118)); accord *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655 (2d Cir.), cert. denied, 445 U.S. 951 (1979); *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847 (W.D.N.Y. 1980); *Clarke v. K-Mart*, 473 F. Supp. 1299 (W.D. Pa. 1979); *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129 (S.D.N.Y. 1972). But cf. *Shredded Wheat*, 305 U.S. at 118 ("[t]here is no basis here for applying the doctrine of secondary meaning").

⁴⁸ *Shredded Wheat*, 305 U.S. at 118. National Biscuit contended that it had the exclusive right to the name "Shredded Wheat" because the term had acquired "secondary meaning." *Id.* But such consumer association between the product name and the product's source when there is only one manufacturer of the product, is merely "de facto secondary meaning" and does not indicate that the term is not generic. Simply stated:

If a term is proven to be generic, evidence of purported buyer association of the term with a single source will not change the result. Any such evidence is called "de facto secondary meaning". De facto secondary meaning might arise during the period when a seller is the single source [W]hen one source is the only seller of a product, the public might associate the generic name of the product with the single source seller merely because there is no one else on the market.

1 J. MCCARTHY, *supra* note 1, at § 12:15.

⁴⁹ See *infra* note 92 and accompanying text.

or descriptive with secondary meaning—has expired into genericness.⁵⁰

The genericness doctrine itself has undergone little change since *Shredded Wheat*. A continuing source of difficulty, however, is determining what proofs are indicative of the “primary significance of the term in the minds of the consuming public.”⁵¹ This Comment will examine the proof problems encountered in applying this standard. This can best be done by identifying and analyzing the proof accepted by the courts in three cases: (1) *American Thermos Products Co. v. Aladdin Industries, Inc.*;⁵² (2) *E.I. DuPont de Nemours & Co. v. Yoshida International, Inc.*;⁵³ and (3) *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*⁵⁴

A. *American Thermos Products Co. v. Aladdin Industries, Inc.*
(*Thermos*)⁵⁵

In *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*,⁵⁶ in 1963, the Second Circuit Court of Appeals affirmed the District Court of Connecticut's *Thermos* ruling that the registered trademark “Thermos” had become generic.⁵⁷ The Second Circuit applied the “primary significance” analysis and concluded that there had been sufficient evidence before the district court to sustain a determination of genericness.⁵⁸ In finding the trademark “Thermos” to be generic, the district court had traced the history of King-Seeley's use of the trademark

⁵⁰ See, e.g., *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 103 S. Ct. 1234 (1983); *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325 (7th Cir. 1977), cert. denied, 434 U.S. 1070 (1978); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.* 321 F.2d 577 (2d Cir. 1963); *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251 (2d Cir.), cert. denied, 371 U.S. 910 (1962). But see *Marks v. Polaroid Corp.*, 129 F. Supp. 243, 270 (D. Mass. 1955) (court used stricter *Bayer* standard, stating that to prove genericness, “[one] must show that to the consuming public as a whole the word has lost all its trademark significance” (emphasis in original)), *aff'd*, 237 F.2d 428 (1st Cir. 1956).

⁵¹ *Shredded Wheat*, 305 U.S. at 118.

⁵² 207 F. Supp. 9 (D. Conn. 1962), *aff'd sub nom.* *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) [hereinafter cited as *Thermos*].

⁵³ 393 F. Supp. 502 (E.D.N.Y. 1975) [hereinafter cited as *Teflon*].

⁵⁴ 195 U.S.P.Q. (BNA) 634 (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 and remanded*, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 103 S. Ct. 1234 (1983) [hereinafter cited as *District Court I*].

⁵⁵ *Thermos*, 207 F. Supp. at 9.

⁵⁶ 321 F.2d 577 (2d Cir. 1963) [hereinafter cited as *King-Seeley*].

⁵⁷ *Id.*

⁵⁸ *Id.* at 581.

and analyzed the effect that this usage had on the public's understanding and usage of the term.⁵⁹ The court examined three separate time periods.⁶⁰ They found that during the first period, from 1907 to 1923, King-Seeley had conducted an "educational program to popularize 'Thermos bottle' as the name of that product"⁶¹ Its advertising and literature during this period referred to the product as "Thermos bottle" without any other generic term such as "vacuum bottle."⁶² The court found that editorials and other publications from this period evidenced the public's usage and understanding of the word "Thermos" as the name of a product, and determined that by 1923 "Thermos" had acquired "firm roots" as a generic term.⁶³

In 1923, apparently because of an intimation in an earlier district court opinion that the term "Thermos" might be generic,⁶⁴ King-Seeley began to use "vacuum" or "vacuum bottle" in conjunction with the word "Thermos."⁶⁵ King-Seeley continued to use the word "Thermos" in a generic fashion, however, in the text of its catalogues and in the description of its products.⁶⁶ The court stated that during this second period, from 1923 to 1953, the evidence showed there were hundreds of literary and editorial usages of the term "Thermos" as a generic term.⁶⁷ Although cognizant of the widespread misuse of the term "Thermos," King-Seeley failed at that time to take affirmative action to seek out generic uses by the public, and protested only those of which it happened to become aware.⁶⁸ The court described King-Seeley as concerned about the possibility that such uses might render its trademark generic, yet unwilling to protest "for fear of creating ill-

⁵⁹ *Thermos*, 207 F. Supp. at 15-19.

⁶⁰ *Id.*

⁶¹ *Id.* at 15.

⁶² *Id.*

⁶³ *Id.* at 16.

⁶⁴ *American Thermos Bottle Co. v. W.T. Grant Co.*, 279 F. 151 (D. Mass.), *aff'd*, 282 F. 426 (1st Cir. 1922). W.T. Grant had attempted to argue that the "Thermos" trademark had become generic. The district court did not consider this issue because it had not been properly pleaded, but did note that the validity of the "Thermos" trademark was "not absolutely free from doubt." *Id.* at 152.

⁶⁵ *King-Seeley*, 321 F.2d at 579.

⁶⁶ *Thermos*, 207 F. Supp. at 13, 17.

⁶⁷ *Id.* The court examined newspapers, magazines, treatises, textbooks, encyclopedias, and dictionaries in which the term "Thermos" was used generically. *Id.*

⁶⁸ *Id.* During this 30-year period, King-Seeley wrote less than two or three dozen protest letters with regard to nontrade generic uses of "Thermos." The corporation did, however, notify those in the trade using the term generically that it was a trademark. *Id.*

will and for fear of losing the economic advantage" it gained as a result of this "widespread free advertising."⁶⁹

During the last time period examined by the district court, from 1954 to 1957, the company changed its name, used the "Thermos" trademark on products other than vacuum bottles, and intensified its policing activities.⁷⁰ The court found that these efforts had come too late, since by 1953 "the generic use of 'thermos' had become firmly impressed as a part of the everyday language of the American public."⁷¹

Although the district court based its holding on evidence detailing King-Seeley's lack of diligence in policing its mark and the resulting generic public usage during the three critical periods, the court also considered proof of the public's current usage and understanding of the term.⁷² The presentation by the parties of the evidence regarding current public usage varied, based upon their divergent understandings of the law.⁷³

The plaintiff, King-Seeley, believed that the defendant, in order to prove genericness, had "the burden of showing that 'Thermos' ha[d] *only* a descriptive use and that to the consuming public *as a whole* 'Thermos' ha[d] lost *all* of its trade-mark significance."⁷⁴ Accordingly, King-Seeley introduced evidence aimed at proving that an "appreciable minority segment" of consumers perceived "Thermos" as

⁶⁹ *Id.* at 13. The court examined memoranda from King-Seeley's files which apparently evidenced its awareness that the trademark "Thermos" was in danger of becoming a common word. *Id.* at 17 n.4. In a letter dated July 23, 1946, the Vice President in Charge of Sales addressed the problem of misuse of the company trademark, and stated that the consensus was that affirmative action was indeed necessary. The court noted that despite this consensus, little was done with regard to nontrade generic uses. *Id.*

⁷⁰ *Id.* at 19. The plaintiff changed the name of the company from American Thermos Bottle Company to the American Thermos Products Company. Before the plaintiff's diversification program its product line consisted of only insulated containers and accessories for those containers. During the period from 1957 to 1961, the plaintiff wrote 3,678 protest letters, and in 1959 engaged the services of a clipping bureau to identify editorial and literary descriptive uses of "Thermos" in the media. *Id.*

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.* at 22 (emphasis in original). King-Seeley relied upon *Marks v. Polaroid Corp.*, 129 F. Supp. 243 (D. Mass. 1955), *aff'd*, 273 F.2d 428 (1st Cir. 1956), as well as *Selchow v. Baker*, 93 N.Y. 59 (1883), an earlier case which had held that an arbitrary or fanciful word is entitled to protection, notwithstanding "that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article." *Thermos*, 207 F. Supp. at 22 (quoting *Selchow v. Baker*, 93 N.Y. 59, 68-69 (1883)). The plaintiff argued that "so long as the word is a trademark to some members of the public there remains the possibility that someone may be deceived." *Id.*

a trademark specifying their product.⁷⁵ To this end, the plaintiff introduced hundreds of media examples where the term "Thermos" was used in its proper trademark forms.⁷⁶ To further support its contention that a substantial minority of consumers recognized the "Thermos" trademark's significance, King-Seeley surveyed 3,650 consumers to establish whether they were familiar with any trademark or brand names for vacuum bottles.⁷⁷ Approximately one-third of those surveyed responded "Thermos."⁷⁸ The court found that despite inherent flaws in this survey, it was corroborative of the plaintiff's allegation that an appreciable minority segment of consumers recognized "Thermos" as the trademark of King-Seeley's products.⁷⁹

The defendants alleged that a generic understanding of the term "Thermos" by a "large majority of consumers" would render the term generic, notwithstanding the fact that there may have been an appreciable minority of consumers for whom the term functioned as a

⁷⁵ *Thermos*, 207 F. Supp. at 21. The plaintiff believed that if it succeeded in showing trademark significance to a minority segment, the defendant would be unable to meet its burden of showing that the term had no trademark significance to the public as a whole. *Id.* at 22.

⁷⁶ *Id.* at 19. The court noted, however, that for the most part these were uses made to appear in advertising aimed at the trade or in articles in trade publications. Since the defendant had conceded that the trade recognized and used "Thermos" as the plaintiff's trademark, the court gave this evidence little weight. *Id.*

⁷⁷ *Id.* at 20. The plaintiff's survey asked the following question: "Please name any trademark or brand names, with which you are familiar, for vacuum bottles, insulated bottles or other containers, which keep the contents hot or cold." *Id.*

⁷⁸ *Id.* at 21.

⁷⁹ *Id.* The court found fault with the survey in that the nature of the question focused the mind of the interviewee upon trademarks or brand names, and thus "left little or no opportunity for the revelation of a generic or descriptive use of 'thermos' in the answer." Furthermore, the interviewees did not constitute a representative cross section of the consuming public, and those who were chosen to testify were generally aware of the issues and had been interviewed by counsel. *Id.* The plaintiff failed in almost every respect to conform with the principles governing the admissibility of survey evidence set forth in the *MANUAL FOR COMPLEX LITIGATION*, § 2.712 (rev. ed. 1982), which states:

The offeror has the burden of establishing that a proffered poll was conducted in accordance with accepted principles of survey research, that is, that the proper universe was examined, that a representative sample was drawn from that universe, and that the mode of questioning the interviewees was correct. He should be required to show that the persons conducting the survey were recognized experts; the data gathered was accurately reported; and the sample design, the questionnaire, and the interviewing were in accordance with generally accepted standards of objective procedure and statistics in the field of such surveys. Normally this showing will be made through the testimony of the persons responsible for the various parts of the survey.

Id. (footnote omitted).

trademark.⁸⁰ The defendant, like King-Seeley, introduced hundreds of excerpts, but these showed thousands of generic uses of the term "Thermos."⁸¹ In addition, Aladdin utilized the services of a philologist who explained his theory of why the public so readily accepted "Thermos" as a generic term.⁸² Aladdin also introduced a survey designed to measure consumer usage of the term "Thermos."⁸³ The survey was

⁸⁰ *Thermos*, 207 F. Supp. at 22. The defendant relied upon *Bayer*, 272 F. at 505, *Shredded Wheat*, 305 U.S. at 111, and *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir.) (Second Circuit, following *Bayer* rationale, invalidated "Cellophane" trademark as generic), *cert. denied*, 299 U.S. 601 (1936); see *supra* notes 27-48 for discussions of *Bayer* and *Shredded Wheat*.

⁸¹ *Thermos*, 207 F. Supp. at 20. The court concluded that this evidence reflected the widespread use and understanding of "Thermos" as a generic term. Both the plaintiff and the defendant introduced definitions of the word "Thermos" from a number of dictionaries. This evidence, however, was inconclusive. Most of the definitions categorized the term "Thermos" as an adjective meaning "vacuum insulated," as a noun designating "vacuum insulated" products, and as a trademark. The court stated that the plaintiff "may rightfully claim that the mention of the trade-mark use is a recognition of the existence of the trade-mark; but it is equally proper for the defendant to assert that it also presents the word as one generically used." *Id.*

⁸² *Id.* The court found the expert's testimony "logical and persuasive." His theory was that public acceptance of the term "Thermos" as generic was "in part attributable to a characteristic of the general public, and a familiar phenomenon in linguistics, that people tend to adopt and use the shortest and simplest word which will adequately communicate the idea or call to mind the object or product that they want to tell about." *Id.*

⁸³ See *id.* at 21. The defendant's survey satisfied the criteria set forth in the MANUAL FOR COMPLEX LITIGATION, *supra* note 79. The following questions were asked:

Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time?

Have you yourself ever used (or filled) such a container — that is, the type to keep liquids cold or hot?

What was the occasion for using such a container?

If you were going to buy one of these containers tomorrow — that is, the type that keeps food and beverages hot or cold — what type of store would you select to make your purchase?

What would you ask for — that is, what would you tell the clerk you wanted?

Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold?

If you were going to describe one of these containers to a friend of yours — what words would come to your mind first to describe a container that keeps liquids hot or cold?

Do you, or does anyone else within your household own a container such as we have been talking about?

How many are owned by all members of your household?

What do you call this (these) containers?

Do you know the names of any manufacturers who make these containers that keep liquids [sic] hot or cold?

Can you name any trade-marks or brand names that are used on these containers?

Thermos, 207 F. Supp. at 21 n.8.

conducted among persons who indicated an awareness of containers used to keep liquids hot or cold.⁸⁴ Seventy-five percent of those familiar with these types of containers called such containers a thermos, eleven percent responded with the term "vacuum bottle," and twelve percent were aware that "Thermos" had trademark significance.⁸⁵

The district court held for Aladdin, determining that it was not required to prove that "Thermos" had lost all its trademark significance to the consuming public as a whole, but only that the term had become generic to a great majority of consumers.⁸⁶ Instead of relying upon the *Shredded Wheat* primary significance analysis, the court engaged in a lengthy and at times strained analysis of the *Bayer*⁸⁷ decision to reach this conclusion.⁸⁸

The district court focused on King-Seeley's acts of using the trademark generically, on documents and testimony attesting to King-Seeley's lack of diligence in policing the mark, and on evidence in periodicals, publications, dictionaries, and consumer files of the resulting generic understanding and usage by the public.⁸⁹ The district court viewed the proffered surveys only as corroborating the decision it had already reached based on the aforementioned evidence.⁹⁰

Thermos thus became the "first case to declare a once arbitrary trademark generic where the product to which it was applied had not enjoyed a patent monopoly."⁹¹ The Second Circuit, however, applied the primary significance analysis and stated in its affirmance that a term is generic if its primary significance in the minds of the consum-

⁸⁴ *Thermos*, 207 F. Supp. at 21.

⁸⁵ *Id.* at 21-22.

⁸⁶ *Id.* at 25.

⁸⁷ The court also discussed *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936). *Thermos*, 207 F. Supp. at 23-28.

⁸⁸ *Thermos*, 207 F. Supp. at 23-28. A thorough reading of the *Bayer* decision uncovers little to support the *Thermos* court's interpretation. The *Bayer* court begins its analysis with a statement outlining the burden of proof upon the defendant: "Prima facie I should say, since the word is coined and means nothing by itself, that the defendant must show that it means *only* the kind of drug to which it applies." *Bayer*, 272 F. at 509 (emphasis added). This statement is hardly supportive of the *Thermos* court's interpretation of the defendant's burden.

⁸⁹ See *supra* text accompanying notes 59-63.

⁹⁰ *Thermos*, 207 F. Supp. at 22.

⁹¹ Swann, *The Validity of Dual Functioning Trademarks: Genericism Tested by Consumer Understanding Rather Than By Consumer Use*, 69 TRADE-MARK REP. 357, 365 (1979); cf. *Bayer*, 272 F. at 505 (aspirin patented until 1917); *DuPont Cellophane*, 85 F.2d at 77 (cellophane also patented).

ing public is the product and not the producer.⁹² Under this rationale, if a great majority of the consuming public considered the term to be product indicative and a minority considered it source indicative, the term would be generic.⁹³ In the instant case, where a great majority of the consuming public considered the term "Thermos" to be the name of a product and not an indication of its source, the term had become generic.⁹⁴

In reaching its decision, the circuit court gave less weight to King-Seeley's acts of commission and omission than had the district court, and relied more heavily upon Aladdin's survey.⁹⁵ The court stated that "whether the appropriation by the public was due to highly successful educational and advertising campaigns or to lack of diligence in policing or not is of no consequence."⁹⁶ What was of consequence, according to the circuit court, was "what the public's understanding is of the word that it uses."⁹⁷ The circuit court agreed with the district court's conclusion that the defendant's survey showed that the great majority of the public using "Thermos" had attached no trademark significance to the term.⁹⁸ While the district court considered this survey as only corroborating its holding, the circuit court apparently believed that the survey alone was sufficient to prove that the primary significance of the term "Thermos" was its indication of a product, rather than its source.⁹⁹

⁹² *King-Seeley*, 321 F.2d at 581. The Second Circuit cites the following language from its earlier decision, *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962), as setting forth the standard to be applied in any determination of genericness:

[A] mark is not generic merely because it has *some* significance to the public as an indication of the nature or class of an article In order to become generic the *principal* significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.

King-Seeley, 321 F.2d at 580 (emphasis in original). This is nothing more than the *Shredded Wheat* "primary significance" standard. See *supra* text accompanying notes 48-50. The Second Circuit concluded that in the instant case "the primary significance to the public of the word 'thermos' is its indication . . . of an article rather than as an indication of its source" *King-Seeley*, 321 F.2d at 581.

⁹³ See *King-Seeley*, 321 F.2d at 580.

⁹⁴ *Id.* Limitations were placed, however, on the use of term "Thermos." Any use by the defendant of the word "Thermos," had to be preceded by "Aladdin's," it could only use thermos with a lower case "t," and it could never use the words "original" or "genuine." *Id.* at 581.

⁹⁵ *Id.* at 579-80.

⁹⁶ *Id.* at 579.

⁹⁷ *Id.* at 580.

⁹⁸ *Id.* at 579-80.

⁹⁹ *Id.* at 580.

Therefore, a party attempting to prove genericness could reasonably presume that while evidence of misuse of the trademark or lack of diligence in policing it would be helpful, it would not be necessary if the party were able to prove by a survey that the primary significance of the trademark in question was product and not producer. After *Thermos*, a trademark apparently could become generic based upon the public's perception of it, regardless of anything the producer had or had not done to preserve its mark. The defendant in *E.I. DuPont de Nemours & Co. v. Yoshida International, Inc.* took just this position.

B. *E.I. DuPont de Nemours & Co. v. Yoshida International, Inc.*
(*Teflon*)¹⁰⁰

In *Teflon*, the District Court for the Eastern District of New York held the "Teflon" trademark to be nongeneric.¹⁰¹ Dating from 1946, E.I. DuPont de Nemours and Company (DuPont) was the owner of the registered trademark "Teflon."¹⁰² In 1969, Yoshida International, Inc. (YKK) introduced the "Eflon" zipper into the American market.¹⁰³ DuPont subsequently brought an action against YKK alleging trademark infringement,¹⁰⁴ and YKK defended by arguing that the "Teflon" trademark had become generic.¹⁰⁵

The court found the primary significance analysis to be the proper standard against which a determination of genericness should be weighed.¹⁰⁶ Characterizing YKK's burden as "a heavy one," the

¹⁰⁰ *Teflon*, 393 F. Supp. at 502.

¹⁰¹ *Id.*

¹⁰² *Id.* at 505. The term "Teflon" was coined by DuPont before 1946 as an arbitrary or fanciful term. *Id.* at 506. DuPont was the owner of seven U.S. trademark registrations of "Teflon," which were all in effect at the time of the litigation. *Id.*

¹⁰³ *Id.* at 506. The court, however, was not convinced that Yoshida International, Inc. (YKK) had adopted the term without the intent of deceiving the public; since the defendant's intentions were ambiguous all doubts about intent were resolved against YKK. *Id.* at 509. YKK sought trademark registration of "Eflon" in the United States Patent Office, and DuPont filed opposition proceedings. These proceedings were stayed when DuPont filed the trademark infringement action. *Id.* at 506.

¹⁰⁴ *Id.* at 505. DuPont instituted the suit in January 1971, two years after YKK had first introduced the "Eflon" zipper into the American market. *Id.* at 506. Based primarily on the similarity of the marks and the strength of the "Teflon" mark, the court concluded that DuPont had prevailed on its claim of trademark infringement. *Id.* at 523.

¹⁰⁵ *Id.* at 509. DuPont did not dispute YKK's contention that, if proven, the genericness claim would be a complete defense to the trademark infringement action. *Id.* at 523.

¹⁰⁶ *Id.* The court relied upon *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962); *see supra* text accompanying note 58.

court asserted that all "doubts should be resolved in favor of the trademark owner" ¹⁰⁷ The court's basis for this assertion was its finding that the "Teflon" trademark was a strong mark,¹⁰⁸ and that DuPont had "over the years conducted a vigilant trademark education and protection program."¹⁰⁹ The court found that DuPont had taken great care to ensure that its mark was accompanied by an appropriate generic phrase in all advertising of its product.¹¹⁰ Distinguishing the instant case from *Thermos*, the court noted that, unlike King-Seeley, DuPont had never acquiesced to generic usage by others.¹¹¹ While noting that these factors were not controlling, the court found that they were sufficient to require YKK to make a "clear and convincing" showing that the primary significance of "Teflon" was to indicate product rather than source.¹¹²

DuPont sold its resins to industrial buyers who in turn used the resins on their non-stick products.¹¹³ The General Electric Company was one of the manufacturers who had used the "Teflon" mark.¹¹⁴ YKK cited as "dispositive evidence" letters from General Electric's consumer correspondence file demonstrating that their consumers continued to associate the word "Teflon" with General Electric's non-stick coating six years after General Electric had ceased using the "Teflon" mark.¹¹⁵ YKK apparently hoped to prove thereby that consumers understood "Teflon" as meaning nothing more than non-stick

¹⁰⁷ *Teflon*, 593 F. Supp. at 523. The court noted that the trademark owner should be given the benefit of the doubt especially when "he can demonstrate having taken appropriate action to counteract or resist indiscriminate use of the mark by the public." *Id.* at 523-24. The court recognized, however, that the owner's intent is not a controlling factor. *Id.* at 524; accord 3 R. CALLMANN, *supra* note 1, at § 74.2.

¹⁰⁸ *Teflon*, 393 F. Supp. at 512. The *Teflon* court stated that "[w]here the public has been educated to recognize and accept a particular mark as the hallmark for a particular source of that product, or the mark itself is inherently unique or has been the subject of wide advertisement, it is a strong trademark." *Id.*; see also 3 R. CALLMANN, *supra* note 1, at § 74.2 (mark's distinctiveness measured by its relative strength or weakness).

¹⁰⁹ *Teflon*, 393 F. Supp. at 507. DuPont made efforts to instruct both its "Teflon" resin salesmen and its customers on the proper usage of the "Teflon" trademark. DuPont also occasionally engaged in protective advertising. *Id.*

¹¹⁰ *Id.* at 528.

¹¹¹ *Id.*

¹¹² *Id.* at 527-28.

¹¹³ *Id.* at 506. Many of these manufacturers participated in a certification program, whereby DuPont certified the finish as "DuPont approved" and the manufacturers were then able to advertise their products under the "Teflon" mark. *Id.*

¹¹⁴ *Id.* at 524.

¹¹⁵ *Id.* General Electric had stopped using the "Teflon" mark and had begun to use the term "GE Double Non-Stick Coating." *Id.*

coating. The court found, however, that the letters evidenced no more than an association in the minds of a handful of consumers between non-stick coating and "Teflon."¹¹⁶ The court determined that this association in itself was not evidence of genericness, and therefore disregarded the evidence.¹¹⁷

YKK also introduced various advertisements, court decisions, and U.S. patents which employed the term "Teflon" in a generic manner.¹¹⁸ The court, however, found these to be isolated examples of generic usage and, as such, insufficient to satisfy YKK's burden of proving that the primary significance of "Teflon" in the minds of the consuming public was product and not source.¹¹⁹

YKK's principal proof consisted of two professionally conducted surveys.¹²⁰ Both surveys were modeled after the survey that had been accepted by the *Thermos* court as corroborative of its finding that "Thermos" was generic to a majority of consumers.¹²¹ The first *Teflon* survey was conducted among adult women who indicated an awareness of " 'kitchen pots and pans that have their inside surfaces coated by chemical substances to keep grease or food from sticking to them.' "¹²² When asked to give the name of these pots and pans, 86.1% of this "aware" group mentioned "Teflon" or "Teflon II" exclusively.¹²³ When further asked what "name they would use to

¹¹⁶ *Id.*

¹¹⁷ *Id.* The court observed that "[i]t cannot be thought unusual for a generic term describing the nature or class of an article (non-stick coatings and finishes) to be associated with its major indicator of source (TEFLON), but it does not necessarily follow that the public has lost sight of the distinction." *Id.* The court disregarded the letters noting that there was no way of determining how representative they were. *Id.* at 524 n.48.

¹¹⁸ *Id.*

¹¹⁹ *Id.* The court attached no significance to the court decisions and U.S. patents finding that these reflected only "how a handful of people might refer to TEFLON . . . in a highly technical use and giving no indication of whether they also understood the term to be a trademark." *Id.* at 524 n.49. As to the advertisements and other published material proffered by the defendant, the court stated that proof of "individual instances of advertiser or industrial use have little probative value on overall public understanding." *Id.* at 524-25.

¹²⁰ *Id.* at 525. These surveys were in conformance with the guidelines for the introduction of survey evidence. *See supra* note 79.

¹²¹ *See supra* note 83 and accompanying text.

¹²² *Teflon*, 393 F. Supp. at 525 (quoting Def. Exh. P, pp. 8, 11 & Table 1). Of those women questioned 90.6% responded that they were aware of such products. *Id.* According to accepted survey practices, "[a]ware" respondents [are] those who [indicate] an awareness of the subject matter of the survey by responding in some affirmative fashion to an initial question" designed to determine whether they fit into the target universe. *See id.* at 525 n.51 (quoting Def. Exh. P, pp. 9, 11).

¹²³ *Id.* at 525.

describe the pots and pans to a store clerk or friend," 71.7% responded only "Teflon" or "Teflon II."¹²⁴ DuPont was identified as the manufacturer by 7.3% of these "aware" women.¹²⁵

The second survey was substantially a duplication of the first, the sole difference being the awareness indication question. The awareness indication question in the second survey was designed to identify those women who were familiar with " 'substances that manufacturers sometimes apply to the surfaces of certain products in order to prevent things from sticking to them.' "¹²⁶ The results of the second survey essentially corroborated the first; 81.4% of the "aware" respondents mentioned "Teflon" or "Teflon II" exclusively when asked the name that the substances are called, and sixty percent stated "Teflon" or "Teflon II" as the name they would use to describe the products containing these substances to a store clerk or friend.¹²⁷

In response to YKK's surveys DuPont introduced two surveys conducted by telephone.¹²⁸ In the first survey, the universe selected consisted of individuals over eighteen years of age.¹²⁹ These respondents were told: " 'Protective coatings are sometimes applied by manufacturers to the inside of household utensils in order to prevent food and grease from sticking.' " They were then asked, " 'Do you know a brand name or trademark for one of these coatings?' "¹³⁰ Of the sixty percent that responded affirmatively, eighty percent answered "Teflon" when asked, " '[W]hat is that brand name or trademark?' "¹³¹ All respondents were then asked, " 'Can you think of any other words or terms to describe these coatings?' "¹³² Sixty-eight percent of those who had answered the prior questions with the word

¹²⁴ *Id.*

¹²⁵ *Id.* This statistic is virtually irrelevant, since it has long been an accepted tenet of trademark law that a trademark is not generic because customers are unaware of the manufacturer's identity. See *Bayer*, 272 F. at 509.

¹²⁶ *Teflon*, 393 F. Supp. at 525. Of those women questioned, 89.4% indicated awareness. *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Id.* (quoting Pl. Exh. 61, Questionnaire entitled "Protective Coating Study-A"). The awareness indication question was similar to that used in YKK's surveys. See *supra* note 122 and accompanying text. The only difference between the second question and the first question in YKK's two surveys was that DuPont's survey requested the "brand name" while YKK's survey asked only for the "name." *Teflon*, 393 F. Supp. at 525.

¹³¹ *Teflon*, 393 F. Supp. at 526. By comparison, 86.1% and 81.4% of the aware respondents in YKK's surveys answered "Teflon" when asked simply to identify a name of the product. *Id.*

¹³² *Id.* (quoting Pl. Exh. 61, Questionnaire entitled "Protective Coating Study-A").

"Teflon" knew of no other word to describe the coating. Thirty-two percent of that group were able to supply other terms, and the one most frequently given was "Non-Stick."¹³³

DuPont began its second survey by explaining to its telephone respondents the difference between a brand name and a common name, using the example "'Chevrolet—automobile.'"¹³⁴ A brand name, the interviewees were told, is an indicator of a product "'made by one company.'"¹³⁵ The interviewees were then read a list of eight names, including "Teflon," and were asked to identify them as brand names or common names.¹³⁶ Sixty-eight percent of the respondents identified "Teflon" as a brand name, and thirty-one percent believed it was a common name.¹³⁷

After reviewing the four surveys, the court found that DuPont's second telephone survey, the brand name survey, was the only one which reflected the public's understanding of the term.¹³⁸ The court determined that the design of the other three surveys focused the attention of the interviewee "on supplying the inquirer a 'name', without regard to whether the principal significance of the name supplied was 'its indication of the nature or class of an article, rather than an indication of origin.'"¹³⁹ The court found that the brand-name survey results indicated "that the public is quite good at sorting

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.* at 527 (quoting Pl. Exh. 61, Questionnaire entitled "Protective Coating Study — B").

¹³⁶ *Id.* The results of this brand name survey were as follows:

<u>NAME</u>	<u>BRAND</u>	<u>COMMON</u>	<u>DON'T KNOW</u>
	%	%	%
STP	90	5	5
THERMOS	51	46	3
MARGARINE	9	91	1
TEFLON	68	31	2
JELLO	75	25	1
REFRIGERATOR	6	94	—
ASPIRIN	13	86	—
COKE	76	24	—

Id. at 526 n.54 (quoting Pl. Exh. 61, Table 2).

¹³⁷ *Id.* at 526.

¹³⁸ *Id.* at 527.

¹³⁹ *Id.* (quoting *King-Seeley*, 321 F.2d at 580). The court noted the substantial similarity between DuPont's first survey asking for "brand name or trademark" and YKK's surveys which asked for "name or names." *Id.* Neither survey explained to the interviewees the difference between brand names and common names. The court concluded that both surveys were "ambiguous on the question of whether the responses truly reflect generic use . . . to the extent indicated." *Id.* at 526.

out brand names from common names, and, for TEFLON, answers the critical question left unanswered by the ambiguities [in the other surveys]—that of the *principal significance* of the TEFLON mark to the public.”¹⁴⁰

The court concluded that while YKK had failed to make a “clear and convincing” showing that “Teflon” was a generic term, DuPont had succeeded, through its brand name survey, in proving that it was a brand name.¹⁴¹ It is important to note that while the court relied heavily upon the brand name survey as direct proof of the primary significance of the term in the mind of the consuming public, this was not the sole basis for the decision.¹⁴² In finding that YKK had not met its burden,¹⁴³ the court also relied upon DuPont’s affirmative efforts to protect the distinctiveness of its trademark.

The *Teflon* court found that the brand name survey was proof of the primary significance of the mark to the consuming public, but that a *Thermos*-type survey was not probative at all.¹⁴⁴ Evidence of DuPont’s proper use of and diligence in policing its mark was not used as direct evidence of primary significance of the term.¹⁴⁵ Rather, this evidence was seen as “. . . emphasiz[ing] . . . the gravity of defendants’ burden,” and as explaining why the transformation of trademark to generic term did not occur in this case.¹⁴⁶ Accordingly, a trademark owner relying on the *Teflon* decision would believe it could prevail in defending its mark against a claim of genericness by coming forward with evidence of proper usage of and diligence in policing its trademark, along with a brand name survey indicating that a majority of consumers who are aware of its product perceive the terms as a trademark. Parker Brothers, owners of the registered trademark “Monopoly,” apparently believed just that.

C. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*¹⁴⁷

In February of 1983, the Supreme Court refused to consider a Ninth Circuit Court of Appeals decision that cancelled the trademark

¹⁴⁰ *Id.* at 527 (emphasis in original). While the court did not reject YKK’s contention that the surveys revealed “some evidence and examples of generic use of TEFLON by the public,” it stated that “ ‘some evidence’ of generic usage is not sufficient.” *Id.* at 526 n.56.

¹⁴¹ *Id.* at 528. The court stated that the burden upon the defendant was “clear and convincing” evidence, but disclaimed this standard by noting that “no matter how defendants’ burden is described, it simply has not been met on this record and the defense must fail.” *Id.*

¹⁴² *Id.*

¹⁴³ *Id.* at 527-28.

¹⁴⁴ *Id.* at 526-27.

¹⁴⁵ *Id.* at 527-28.

¹⁴⁶ *Id.*

¹⁴⁷ *District Court I*, 195 U.S.P.Q. (BNA) at 634.

"Monopoly."¹⁴⁸ The game "Monopoly" was first commercially produced in late 1932 or early 1933.¹⁴⁹ Ralph Anspach, a professor of economics, created the game "Anti-Monopoly" and began marketing it in December of 1973.¹⁵⁰ The controversy that resulted in the rendering of the term "Monopoly" as "generic" began when Anti-Monopoly, Inc. responded to threats of legal action by Parker Brothers by bringing an action against General Mills Fun Group for a declaratory judgment of invalidity and/or noninfringement of the "Monopoly" trademark.¹⁵¹ In addition, Anti-Monopoly sought to have the "Monopoly" trademark cancelled, in part because it had become generic.¹⁵² Parker Brothers counterclaimed for a declaration of validity, trademark infringement, and for injunctive relief.¹⁵³

1. The First Decision of the District Court—*Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*¹⁵⁴

The United States District Court for the Northern District of California held in 1977 that the "Monopoly" trademark had not

¹⁴⁸ *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983).

¹⁴⁹ *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 299 (9th Cir. 1979), *on remand*, 515 F. Supp. 448 (N.D. Cal. 1981), *rev'd and remanded*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983). Parker Brothers is an unincorporated division of General Mills Fun Group. The game "Monopoly" was first played on college campuses by small groups of individuals. The original producer of the game obtained a copyright and, in March 1935, assigned all rights to the game and game equipment to Parker Brothers. The game was patented in 1935 and the patent was assigned to Parker Brothers. The patent expired in 1952. In 1935 and 1936, Parker Brothers also obtained federal trademark registration for "Monopoly." *Id.*

¹⁵⁰ *Id.* at 299-300. Anti-Monopoly, Inc. was a California corporation formed by Ralph Anspach, a professor of economics, to market his game "Anti-Monopoly." *Id.* at 299. Professor Anspach initially intended to market the game under the title, "Bust the Trust, The Anti-Monopoly game" but subsequently decided "Anti-Monopoly" was the better title. *Id.* at 300. Professor Anspach's application for federal trademark registration was rejected by the United States Patent and Trademark Office based on the possibility of confusion, mistake, or deception with Parker Brothers' "Monopoly" trademark. Professor Anspach never appealed the decision. *Id.*

¹⁵¹ Brief in Opposition to Petition For a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit at 7-8, *CPG Prods. Corp. v. Anti-Monopoly, Inc.*, 103 S. Ct. 1234 (1983). "Anti-Monopoly filed suit against Parker Brothers only after Parker Brothers turned down Anti-Monopoly's offers of disclaimer and change of name to antimonopolist, antimonopoly or antimonopolism." *Id.* at 9.

¹⁵² *District Court I*, 195 U.S.P.Q. (BNA) at 637. Anti-Monopoly also argued that both the "Monopoly" trademark, and the patent for the game had been fraudulently obtained by Parker Brothers. *Id.* The court found both arguments "lacking in merit." *Id.* at 638.

¹⁵³ *Id.* at 637.

¹⁵⁴ *Id.*

become generic, and had been infringed by Anti-Monopoly.¹⁵⁵ In so concluding, the district court noted that the application of the common word "monopoly" to a game was "arbitrary and unique" and thus the 1935 and 1936 trademark registrations had been properly granted.¹⁵⁶ The district court further found that the term did not become generic after its registration, since "[t]he primary significance of MONOPOLY . . . is not that it describes all board games involving real estate trading but rather that it is the title of a particular and very popular board game produced by a single company."¹⁵⁷

Anti-Monopoly submitted a survey similar to the one used in *Thermos*.¹⁵⁸ People were asked the question: " 'Are you familiar with business board games of the kind in which players buy, sell, mortgage and trade city streets, utilities and railroads, build houses, collect rents and win by bankrupting all other players, or not?' "¹⁵⁹ About fifty-three percent responded affirmatively. Those respondents were then asked: " 'If you were going to buy this kind of game, what would you ask for, that is, what would you tell the sales clerk you wanted?' "¹⁶⁰ Eighty percent responded: "Monopoly."¹⁶¹ The court found these survey results to be unconvincing since it had determined that a ruling of genericness required a finding that the "term monopoly now refers to all real estate trading board games" ¹⁶² Judge Williams therefore issued a permanent injunction against plaintiff's use of the mark "Anti-Monopoly," and Anti-Monopoly appealed.¹⁶³

2. The First Decision of the Court of Appeals— *Anti-Monopoly, Inc. v. General Mills Fun Group* (*Anti-Monopoly I*)¹⁶⁴

The Ninth Circuit Court of Appeals reversed the district court's findings as to the validity of the trademark, and held that the district

¹⁵⁵ *Id.* at 638-39.

¹⁵⁶ *Id.* at 638. The court also noted: "[a]t the most, MONOPOLY is a suggestive title validly registered without the necessity of proof of secondary meaning." *Id.*

¹⁵⁷ *Id.*

¹⁵⁸ See *supra* note 83 and accompanying text.

¹⁵⁹ *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1323 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983).

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *District Court I*, 195 U.S.P.Q. (BNA) at 638 & n.3.

¹⁶³ *Id.* at 640. The court issued the permanent injunction based upon its decision that Parker Brothers had proved trademark infringement. *Id.*

¹⁶⁴ 611 F.2d 296 (9th Cir. 1979), *on remand*, 515 F. Supp. 448 (N.D. Cal. 1981), *rev'd and remanded*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983) [hereinafter cited as *Anti-Monopoly I*].

court had erroneously applied the genericness doctrine as set forth by the Supreme Court in *Shredded Wheat*.¹⁶⁵ The court found that the genericness doctrine had not changed significantly since the *Shredded Wheat* decision and stated that “[i]f the primary significance of the trademark is to describe the type of product rather than the producer, the trademark has become a generic term and is no longer a valid trademark.”¹⁶⁶ The court noted that even though Parker Brothers is the only producer of “Monopoly,” and the public therefore must associate the term “Monopoly” with that company, “the trademark is invalid unless source identification is its primary significance.”¹⁶⁷ Where there is only one source of a product, it is difficult to determine whether a name is regarded by the public as generic or is regarded as indicating only that source.¹⁶⁸

The Ninth Circuit set forth the genus/species analysis as one way of determining primary significance.¹⁶⁹ The court defined genus as “a product category including essentially interchangeable goods made by unique producers,” and defined a species as a “sub-classifier.”¹⁷⁰ A term which identifies a genus would be generic, while a term which identifies a particular producer’s product within that genus would be a species and could function as a trademark. The court held that the district court had erred in defining the “genus” as “‘all board games involving real estate trading’” and reasoned that the term “Monopoly” could be generic because the unique game which that trademark identifies could constitute a genus unto itself.¹⁷¹ By first defining the genus as “all real estate trading games” and then asking the primary significance question, the district court, according to the Ninth Circuit, failed to resolve the crucial issue: “Do consumers use the term

¹⁶⁵ *Id.* at 301-04; see *supra* notes 48-50 and accompanying text.

¹⁶⁶ *Anti-Monopoly I*, 611 F.2d at 304.

¹⁶⁷ *Id.* at 302. This is the same de facto secondary meaning argument made by the Supreme Court in *Shredded Wheat*. See *supra* note 48.

¹⁶⁸ 1 J. McCARTHY, *supra* note 2, at § 12:15. This determination, however, must be made since “[s]ource identification is the only word function which trademark law is designed to protect.” *Anti-Monopoly I*, 611 F.2d at 304.

¹⁶⁹ *Anti-Monopoly I*, 611 F.2d at 303. According to the Ninth Circuit, the proper genus must be identified before a determination of genericness can take place. *Id.*

¹⁷⁰ *Id.* (footnote omitted).

¹⁷¹ *Id.* at 305. The *Anti-Monopoly I* court reasoned that “if consumers think of MONOPOLY as a unique game, and differentiate it from all other real estate trading games by source-irrelevant characteristics, e.g., length of time it takes to play, or strategy involved, MONOPOLY may constitute its own genus.” *Id.* It must be noted, however, that a court, by expanding or contracting the definition of a genus of products, can substantially affect the final determination of whether a term is “generic.” See 1 J. McCARTHY, *supra* note 2, at § 12:6.

MONOPOLY primarily to denote the product, or instead to denote its producer?"¹⁷² The appellate court accordingly remanded the case to the district court for further proceedings to determine the primary significance of the term "Monopoly."¹⁷³

3. The Second Decision of the District Court—

*Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*¹⁷⁴

On remand, the district court again found that the "Monopoly" trademark was valid and had been infringed.¹⁷⁵ Judge Williams noted that a determination of primary significance is particularly difficult when it concerns a "single producer of a unique game."¹⁷⁶ The court permitted the presentation of additional survey evidence in order to help make that determination.¹⁷⁷

The court accepted the results of a survey conducted by Parker Brothers which was modeled on the brand name survey approved by the court in *Teflon*.¹⁷⁸ That survey established that sixty-three percent of the public perceived "Monopoly" as the "brand name" of a product, and that fifty-five percent of the recognizing group named Parker Brothers as the producer of the "Monopoly" game.¹⁷⁹ The district court, however, rejected a "motivation" survey conducted by Anti-Monopoly which had been designed in accordance with the language suggested by the circuit court in *Anti-Monopoly I*.¹⁸⁰

Anti-Monopoly's motivation survey was directed to persons who had recently purchased or were about to purchase "Monopoly."¹⁸¹

¹⁷² *Anti-Monopoly I*, 611 F.2d at 305.

¹⁷³ *See id.* at 306. The court set out an example, quoted *infra* at text accompanying note 253, for the lower court to follow.

¹⁷⁴ 515 F. Supp. 448 (N.D. Cal. 1981), *rev'd and remanded*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983) [hereinafter cited as *District Court II*].

¹⁷⁵ *Id.* at 455.

¹⁷⁶ *Id.* at 452-53. The court noted that normally the "primary significance" analysis "is implemented by ascertaining whether a mark denotes a 'particular producer's goods or services . . . [or whether] the word is identified with all such goods or services, regardless of their suppliers.' . . . This is a straightforward task in markets where several producers manufacture the generic item in question." *Id.* at 452 (quoting *Surgicenters of Am., Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1016 (9th Cir. 1979)). Where there is only one producer of the product the analysis becomes more complex. *See id.*; 1 J. McCARTHY, *supra* note 2, at § 12:15.

¹⁷⁷ *District Court II*, 515 F. Supp. at 452-53.

¹⁷⁸ *Id.* at 454; *see Teflon*, 393 F. Supp. at 502; *supra* text accompanying notes 134-37.

¹⁷⁹ *District Court II*, 515 F. Supp. at 454.

¹⁸⁰ *Id.*; *see infra* text accompanying note 253.

¹⁸¹ *District Court II*, 515 F. Supp. at 453. The first two survey questions were:

(1) "Are you aware of 'MONOPOLY,' the *business board game produced by Parker Brothers?*", (2) "Have you purchased MONOPOLY within the last couple of

Those consumers were asked the open-ended question: " 'Why did [or would] you buy "MONOPOLY"?' " ¹⁸² and the structured question: " 'Which of these two statements best expresses your meaning when you ask [to purchase] . . . MONOPOLY in a store?' Choices: '(1) I would like Parker Brothers' "MONOPOLY" game primarily because I like Parker Brothers' products.' or '(2) I want "MONOPOLY" game primarily because I am interested in playing "MONOPOLY." I don't much care who makes it.' " ¹⁸³

Judge Williams criticized Anti-Monopoly's motivation survey, stating that the test set forth by the Ninth Circuit requires a determination of the primary significance of the mark, not an explanation of an actual purchaser's motivation for purchasing the game. ¹⁸⁴ The district court concluded that the cumulative weight of the evidence did not prove that the primary significance of "Monopoly" was product as opposed to source. ¹⁸⁵ In so holding, the court followed the rationale of the *Teflon* court and gave great weight to Parker Brothers' expenditures in promoting and policing their trademark, and to the "brand name" survey in which fifty-five percent of the public correctly identified Parker Brothers as the producer of the game. ¹⁸⁶

4. The Second Decision of the Court of Appeals— *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc. (Anti-Monopoly II)* ¹⁸⁷

The court of appeals again reversed the district court, vacating as "clearly erroneous" the district court's finding that "Monopoly" pri-

years?", or "Is it possible that you would buy 'MONOPOLY' now or in the near future either for yourself, as a replacement, or as a gift?"

Id. (emphasis in original).

¹⁸² *Id.* In response to these open-ended questions, "82% mentioned some aspect of the playing of the game (product indicators) and only 7% mentioned the equipment and 1% spoke of price (source indicators)." Brief in Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit at 15-16, *CPG Prods. Corp. v. Anti-Monopoly, Inc.*, 103 S. Ct. 1234 (1983).

¹⁸³ *District Court II*, 515 F. Supp. at 453 n.5. Thirty-two percent of those surveyed chose the first response, and 65% chose the second. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 1324 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983).

¹⁸⁴ *District Court II*, 515 F. Supp. at 454. The court noted that consumers obviously purchase products because they desire them, but stated that "[t]he dispositive issue . . . is not why consumers buy MONOPOLY sets, but rather, what is their *understanding* of the name MONOPOLY?" *Id.* (emphasis in original).

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

¹⁸⁷ 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 103 S. Ct. 1234 (1983) [hereinafter cited as *Anti-Monopoly II*].

marily denotes its producer, Parker Brothers.¹⁸⁸ In reaching the conclusion that "Monopoly" had become generic since it was registered, the *Anti-Monopoly II* court carefully examined the proof of primary significance accepted by Judge Williams.¹⁸⁹ Judge Williams had ruled that Anti-Monopoly had the burden of proving genericness "by convincing evidence."¹⁹⁰ The circuit court ruled, however, that this placed too heavy a burden on Anti-Monopoly, and found that the presumption of validity in favor of a registered trademark could be defeated merely by a preponderance of the evidence.¹⁹¹

The circuit court agreed with Judge Williams' finding that the evidence overwhelmingly showed that Parker Brothers had successfully promoted the game "Monopoly."¹⁹² Rather than resulting in the protection of the mark, however, the *Anti-Monopoly II* court determined that this successful promotion of the term "Monopoly" as "the name of the game" resulted in the term becoming generic.¹⁹³ The principal evidence offered by the parties consisted of a number of surveys. The Ninth Circuit rejected both of Parker Brothers' surveys, a brand name survey and a "Tide" survey,¹⁹⁴ and accepted Anti-Monopoly's *Thermos*-type survey and motivation survey.¹⁹⁵

The court found the brand name survey to be "no evidence" in support of the district court's finding.¹⁹⁶ According to the Ninth Circuit, the fatal error in the brand name survey was that interviewees were told: " 'By *brand* name, I mean a name like *Chevrolet*, which is made by *one* company . . . ' " ¹⁹⁷ Thus, by definition, "Monopoly" would automatically be a brand name because only one company

¹⁸⁸ *Id.* at 1322.

¹⁸⁹ *Id.* at 1321-26.

¹⁹⁰ *District Court II*, 515 F. Supp. at 451.

¹⁹¹ *Anti-Monopoly II*, 684 F.2d at 1319; *see also* Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 373 (1980) (better rule is to require only preponderance of evidence); Dan Robbins & Assocs. v. Questor Corp., 599 F.2d 1009, 1013-14 (C.C.P.A. 1979) (defendant may satisfy burden of proof with respect to specific defect he alleges in plaintiff's registration by preponderance of evidence). *But cf.* *Teflon*, 393 F. Supp. at 502 ("clear and convincing" standard applied); *supra* note 112 and accompanying text.

¹⁹² *Anti-Monopoly II*, 684 F.2d at 1322; *District Court II*, 515 F. Supp. at 450. The district court had found that "Parker Brothers has expended substantial time, energy, and money in promoting and policing their trademark, expending over \$4 million in advertising expenditures." *Id.* at 454.

¹⁹³ *Anti-Monopoly II*, 684 F.2d at 1323.

¹⁹⁴ *See infra* text accompanying notes 200-02.

¹⁹⁵ *Anti-Monopoly II*, 684 F.2d at 1323-26.

¹⁹⁶ *Id.* at 1323.

¹⁹⁷ *Id.* (emphasis in original).

produces the game.¹⁹⁸ Partly because of this built-in bias, the court concluded that the survey was “not even some evidence” of the primary significance of “Monopoly” in the minds of consumers.¹⁹⁹

Parker Brothers introduced the “Tide” survey in an attempt to demonstrate the absurdity of the motivation survey.²⁰⁰ The “Tide” survey was merely a duplication of the motivation survey, but instead of analyzing the trademark “Monopoly,” it tested the trademark “Tide.”²⁰¹ Parker Brothers intended to, and in fact did, show that even as strong a trademark as “Tide” would be considered generic under the motivation test.²⁰² The Ninth Circuit, however, concluded that the “Tide” survey was “of no relevance to this case.”²⁰³ The court’s rejection of both the defendant’s surveys thus left Anti-Monopoly’s *Thermos*-type and motivation surveys as the only direct evidence of the primary significance of the term.

Anti-Monopoly’s first survey was patterned after the survey accepted by the *Thermos* court.²⁰⁴ Although acknowledging that the *King-Seeley* court described the survey as only “‘generally corroborative of the court’s conclusions drawn from other evidence,’”²⁰⁵ and that the *Teflon* court had found the *Thermos*-type survey to be defective,²⁰⁶ the Ninth Circuit nonetheless held the results of this survey to be “compelling evidence” that a vast majority of consumers who were aware of the product would use the name “Monopoly” when asking to purchase the game.²⁰⁷

The *Anti-Monopoly II* court found the motivation survey to be clear support for its conclusion that the primary significance of “Monopoly” was to designate the product rather than its source.²⁰⁸ In

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* The court also noted that on cross-examination and redirect examination of Parker Brothers’ expert witness, it became clear that this survey was nothing more than a duplication of the *Teflon* survey and that the witness had no opinion as to the relevance of this survey to any issue in the case. *Id.*

²⁰⁰ *Id.* at 1326.

²⁰¹ *Id.*

²⁰² See *District Court II*, 515 F. Supp. at 453 n.5.

²⁰³ *Anti-Monopoly II*, 684 F.2d at 1326. The Ninth Circuit commented that “if the test formulated in *Anti-Monopoly I* could be mechanically extended to the very different subject of detergents, then Procter and Gamble might have cause for alarm.” *Id.*

²⁰⁴ *Id.* at 1323; see *supra* text accompanying notes 158-62.

²⁰⁵ *Anti-Monopoly II*, 684 F.2d at 1324 (quoting *King-Seeley*, 321 F.2d at 580); see *supra* text accompanying note 90.

²⁰⁶ *Anti-Monopoly II*, 684 F.2d at 1324; see *supra* note 144 and accompanying text.

²⁰⁷ *Anti-Monopoly II*, 684 F.2d at 1324.

²⁰⁸ *Id.* at 1326.

addressing the district court's contention that the survey merely sought consumer motivation,²⁰⁹ the Ninth Circuit reiterated its position stated in *Anti-Monopoly I* that, in determining primary significance, "what was relevant was the sense in which a purchaser used the word 'Monopoly' when asking for the game by that name."²¹⁰ The court characterized the motivation survey as a "reasonable effort" to ascertain the sense in which purchasers used the term.²¹¹ Thus, the Ninth Circuit concluded that the district court was "clearly erroneous" in finding that the primary significance of the term "Monopoly" was source.²¹²

The *Anti-Monopoly II* decision has been criticized as an "aberrant deviation" from traditional trademark law.²¹³ Most critics insist that the Ninth Circuit's decision has introduced consumer motivation as the new standard against which genericness should be tested.²¹⁴ A careful reading of the Ninth Circuit's decision, however, shows that this is not the case.

The Ninth Circuit in both *Anti-Monopoly* decisions had said very clearly that all determinations of genericness should involve the primary significance analysis set forth by the Supreme Court in *Shredded Wheat*.²¹⁵ The Ninth Circuit did not create a new test, but rather employed the motivation survey as *one means* of directly answering

²⁰⁹ *Id.* at 1325; see *supra* note 184 and accompanying text.

²¹⁰ *Anti-Monopoly II*, 684 F.2d at 1325; see *Anti-Monopoly I*, 611 F.2d at 305-06.

²¹¹ *Anti-Monopoly II*, 684 F.2d at 1325.

²¹² *Id.* at 1326.

²¹³ See *In re DC Comics, Inc.* 215 U.S.P.Q. (BNA) 394, 404 (C.C.P.A. 1982) (Nies, J., concurring) (questioned validity of consumer motivation as measure of primary significance); Hemp, *A Lot Rides on a Good Name, Trademark Law Is Unsettled*, N.Y. Times, Sept. 7, 1983, at D1, col. 2; Lefkowitz & Graham, *Court Rules that 'Monopoly' Has Suffered Genericide*, Legal Times, Mar. 7, 1983, at 14, col. 1.

²¹⁴ See Note, *Genericide: Cancellation of a Registered Trademark*, 51 *FORDHAM L. REV.* 666 (1983); Lefkowitz & Graham, *supra* note 213. Seven amicus briefs were filed in support of General Mill's petition for a writ of certiorari. The majority of these briefs argued that the Ninth Circuit's decision promulgated a new test of genericness. See, e.g., Motion for Leave to File Brief *Amicus Curiae* and Brief *Amicus Curiae* of the United States Trademark Association at 4, *CPG Prods. Corp. v. Anti-Monopoly, Inc.*, 103 S. Ct. 1234 (1983).

The Ninth Circuit held instead that the validity of the term at issue should be tested not on the basis of its primary significance to the public but solely on the basis of the Circuit Court's interpretation of reasons given by some members of the public as to why they had bought or would buy the product sold under that term. Application of such a test could jeopardize the validity of a significant number of important and valuable trademarks.

Id.

²¹⁵ *Anti-Monopoly II*, 684 F.2d at 1324; *Anti-Monopoly I*, 611 F.2d at 302.

the crucial question: "Do consumers use the term MONOPOLY primarily to denote the product, or instead to denote its producer?"²¹⁶

The court characterized the motivation survey as a good attempt to determine the sense in which a purchaser used the word when asking for the game by that name,²¹⁷ but neither stated nor implied that this test was to be applied in lieu of the primary significance analysis. Further, while the Ninth Circuit gave great weight to Anti-Monopoly's motivation survey, the court also relied on a *Thermos*-type survey, Parker Brothers' intensive promotion of the "Monopoly" name, and the descriptive nature of the term itself.²¹⁸ Although critics are correct in asserting that the motivation survey should not be the test of genericness, the *Anti-Monopoly II* decision does not threaten to make it so. The motivation survey was merely a survey accepted by one court as evidence of the primary significance of a word in a case involving a unique product made by a single manufacturer.²¹⁹

III. ANALYSIS

It has been forty-five years since the Supreme Court stated, in *Shredded Wheat*, that in order for a term to be generic its primary significance in the minds of the consuming public must be the product and not the product's producer.²²⁰ After forty-five years of litigation, however, the courts are still wrestling with this amorphous concept. As demonstrated by the foregoing analysis, no definitive method of proving primary significance has emerged from the courts' opinions. It has become clear, however, that in making a determination of the primary significance of a term, the courts will weigh a number of factors, including both direct and indirect evidence.

The indirect evidence the courts have considered has taken many forms, including the trademark owner's misuse of the mark in advertising or packaging,²²¹ the diligence with which the owner policed its

²¹⁶ *Anti-Monopoly I*, 611 F.2d at 305; see *Anti-Monopoly II*, 684 F.2d at 1324-26.

²¹⁷ *Anti-Monopoly II*, 684 F.2d at 1325.

²¹⁸ See *id.* at 1322-24.

²¹⁹ See *supra* note 208 and accompanying text.

²²⁰ See *supra* note 48 and accompanying text.

²²¹ See *Folsom & Teply*, *supra* note 13, at 1324; see, e.g., *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 181 (1896) (improper usage of "Singer" in labeling); *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 663 (7th Cir. 1965) (improper use of "Yo-Yo" in sales literature and advertising); *King-Seeley*, 321 F.2d at 579 (improper use of "Thermos" in sales literature); *DuPont Cellophane*, 85 F.2d at 78-80 (improper use of "Cellophane" in advertising). Misuse of the trademark includes the promotional efforts of trademark owners aimed at encouraging the public to use their trademarks as "household words." *Folsom & Teply*, *supra* note 13, at 1325; see *infra* note 229.

mark,²²² and the availability of alternative generic terms or phrases.²²³ This type of evidence is generally used to explain the transition from trademark to generic phrase.²²⁴ These factors can be used offensively to show the cause of this transition, and defensively to show that no such cause existed. In *Thermos*, the defendant used evidence of King-Seeley's misuse of the mark in advertising and its lack of diligence in policing the improper usage of others offensively to show that causation.²²⁵ In *Teflon*, the plaintiff DuPont defensively employed evidence of its proper usage of the mark and the diligence with which it policed the misuse of others in order to show that no such cause existed.²²⁶ In both instances the courts' rulings were consistent with this evidence. In *Anti-Monopoly*, Parker-Brothers attempted a defensive use of this type of evidence by showing that it had spent time, energy, and money in promoting and policing use of the term "Monopoly."²²⁷ The district court relied in part upon this evidence in finding the term was not generic.²²⁸ The circuit court, however, found that this evidence showed only that Parker Brothers had so successfully promoted "Monopoly" as the "'name of the game,' that it became generic."²²⁹ Thus, in *Anti-Monopoly*, the same evidence, that of promotion of the mark, was used both offensively and defensively.

The availability or absence of a short and simple alternative name for the product is another factor considered by the courts.²³⁰ The *Bayer* court, for example, found that aspirin had become generic, in part because *acetyl salicylic acid* was not a term which could be easily used by the public to identify the drug.²³¹ Yet, as was pointed out by the *Thermos* court, the availability of an alternative term for the product is, by itself, insufficient to prove nongenericness.²³² The trademark may still be determined to be generic, even in the presence

²²² Folsom & Teply, *supra* note 13, at 1325; *see, e.g., Thermos*, 321 F.2d at 578-79; *DuPont Cellophane*, 85 F.2d at 78-80 (trademark owners acquiesced in generic use of their terms by public and media for extended periods of time).

²²³ Folsom & Teply, *supra* note 13, at 1324; *see infra* text accompanying notes 230-33.

²²⁴ Folsom & Teply, *supra* note 13, at 1324.

²²⁵ *See supra* notes 61-70 and accompanying text.

²²⁶ *See supra* notes 109-11 and accompanying text.

²²⁷ *District Court I*, 195 U.S.P.Q. (BNA) at 637.

²²⁸ *Id.*

²²⁹ *Anti-Monopoly II*, 684 F.2d at 1323. Trademark owners must police their mark as well as promote it. If the mark is promoted as the common name of the product, this promotion is tantamount to misuse, and may contribute to the mark becoming generic. *See Folsom & Teply, supra* note 13, at 1329 n.41.

²³⁰ *See Folsom & Teply, supra* note 13, at 1324; Note, *supra* note 214, at 674.

²³¹ *Bayer*, 272 F. at 510-11.

²³² *King-Seeley*, 321 F.2d at 580. The court stated that "the test is not what is available as an alternative to the public, but what the public's understanding is of the word that it uses." *Id.*

of an adequate alternative term, if the party alleging genericness can show through direct evidence that the contested trademark has become synonymous with the alternative term.²³³

While evidence of the trademark owner's misuse of the mark, the owner's lack of diligence in policing the mark, and the nonavailability of alternative terms can be used effectively to explain the transition from trademark to generic term,²³⁴ it is not direct evidence of the primary significance of the term; rather, it is indirect evidence, analogous to a causation argument in negligence law. Just as causation alone is insufficient to prove negligence, presenting only indirect evidence of factors that may contribute to the deterioration of a mark is insufficient to prove genericness. A party claiming negligence must come forth with evidence of "harm" to complete his case. So, too, in order to prove genericness it must be shown that the primary significance of the contested term in the minds of the consuming public is product rather than source.

To prove primary significance, one must engage in a two-step analysis. First, the significance of the term must be determined—that is, does the consuming public understand the term as identifying the product, or the product's source? Once this has been ascertained, a comparison must take place to prove which understanding is primary. If a substantial portion of the public understands the term to denote simply the product, then the trademark has become generic.

Generic uses of a trademark in trade publications, magazines, newspapers, patents,²³⁵ as well as dictionary citations,²³⁶ are seen as evidence of the public's understanding of the term. While such evi-

²³³ See *id.*

²³⁴ See 1 J. MCCARTHY, *supra* note 2, at § 12.2(G).

²³⁵ See 1 J. GILSON, *supra* note 1, at § 2.02[2]; Folsom & Teply, *supra* note 13, at 1328. Evidence of public usage has also been tendered in the form of correspondence, memoranda, order forms, and testimony from members of the purchasing public. *Id.*; see, e.g., *Thermos*, 207 F. Supp. at 19-20. The weight given to media clips varies in direct proportion to the amount of such usage that can be shown. Compare *Thermos*, 207 F. Supp. at 20 (hundreds of clippings from publications showing literally thousands of literary and editorial uses of "Thermos" given substantial weight) with *Teflon*, 393 F. Supp. at 524-25 (various advertisements, published material, and patents showing examples of generic usage considered isolated examples of public usage and given little weight).

²³⁶ 1 J. GILSON, *supra* note 1, at § 2.02[2]. "The inclusion of a trademark in a dictionary is not conclusive on the question of whether it has become or is legally generic . . ." *Id.* The court may use the presence of the term or its absence in the dictionary to draw inferences for or against genericness. *Id.*; see also *Miller Brewing Co. v. Falstaff Brewing Corp.*, 208 U.S.P.Q. (BNA) 919 (D.R.I. 1980) (dictionary meanings create at most rebuttable presumption of consumer perception), *rev'd on other grounds*, 655 F.2d 5 (1st Cir. 1981); *In re Minnetonka, Inc.*, 212 U.S.P.Q. (BNA) 772, 778 (TTAB 1981) (appearance of term as generic in dictionaries "is not conclusive, if for no other reason than that this would endow editors of such works with the power to destroy trademarks, merely by defining them generically"). *But cf.* *Surgicenters of Am., Inc. v. Medical*

dence shows what some portion of the public understands by the term, it does not necessarily show the "primary" understanding of the term by the public.²³⁷ Consumer surveys are capable of combining both the "understanding" and "primariness" elements of the primary significance analysis. This can be accomplished by establishing the public understanding of the trademark through quantifiable results which indicate the relative significance of the different public perceptions of the term. As such, the consumer survey is the only direct evidence of primary significance.²³⁸

A basic problem remains, however, in deciding what type of survey will be considered probative by the courts. The *Thermos*-type survey was disregarded by the *Teflon* court,²³⁹ but regarded as probative by the *Anti-Monopoly II* court.²⁴⁰ The brand name survey was considered probative by the *Teflon* court,²⁴¹ but was considered totally inappropriate by the *Anti-Monopoly II* court.²⁴² Recently, in *Nestle Co. v. Chester's Market, Inc.*,²⁴³ the District Court of Connecticut invalidated the trademark "Toll House" as applied to cookies because it had become generic.²⁴⁴ In so doing, the court disregarded a *Thermos*-type survey,²⁴⁵ a brand name survey,²⁴⁶ and a motivation

Dental Surgeries, Co., 601 F.2d 1011, 1015 n.11 (9th Cir. 1979) (presence of term in dictionary often seen as persuasive evidence of how term is understood and used by consuming public).

²³⁷ 1 J. GILSON, *supra* note 1, at § 2.02[2]. *But cf.* Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 375 (1st Cir. 1980) (indirect evidence can establish genericness; direct evidence such as consumer surveys desirable but not necessary).

²³⁸ 1 J. MCCARTHY, *supra* note 2, at § 12.2(G).

²³⁹ See *supra* text accompanying note 144.

²⁴⁰ See *supra* text accompanying note 207.

²⁴¹ See *supra* text accompanying note 144.

²⁴² See *supra* text accompanying notes 196-99.

²⁴³ 571 F. Supp. 763 (D. Conn. 1983).

²⁴⁴ *Id.* The district court granted the defendant's motion for summary judgment and found that to most consumers, "Toll House" was associated with a chocolate chip cookie using a certain recipe, not the product of a specific manufacturer. *Id.*

²⁴⁵ *Id.* at 776. The *Thermos*-type survey was not a complete duplication of the survey accepted by the *Thermos* court. *Id.* It asked only two questions, which read:

[1.] Now I want to ask you about cookies that have small pieces of chocolate in them. I am talking about cookies that you or someone else might make or cookies that you or someone else might buy. My first question is this: If you were shopping or if you were talking with someone, what basic product word or words would you use in referring to cookies that have small pieces of chocolate in them?

[2.] Any other basic product words?

Id. at 771. The court found that the survey merely showed that "chocolate chip" was the answer most frequently given (75.8% as opposed to 13.8% for Toll House), *id.* at 771, 776, and as such "is a more frequently used generic term for cookies that have small pieces of chocolate in them than is Toll House." *Id.* at 776. The court noted that "[w]hat is important is the primary significance of that word in the minds of consumers, not that they use another word more frequently in describing the same product." *Id.*

²⁴⁶ *Id.* at 777. The court questioned whether "a brand name survey could under any circumstances be evidence to support a finding of genericness," and noted that even if it could, there

survey,²⁴⁷ and relied instead upon marketing surveys not designed to prove genericness, but rather commissioned years earlier by Nestle to “guide the company’s future participation in the baking market.”²⁴⁸ It is thus evident that one cannot merely duplicate a survey that was accepted in a previous trademark case and be assured of its relevance in another case.²⁴⁹ There will always be a number of differing but statistically valid methodologies, and as long as they adhere to the principles governing the reception of survey evidence adopted by the Judicial Conference to the United States, they may be admitted into evidence.²⁵⁰ All surveys, however, must meet the threshold requirement of relevance to the issue to be decided in the case. While the *Thermos*, *Teflon*, and *Anti-Monopoly* opinions do not point to any one methodology that will be accepted as relevant to the issue of primary significance in every instance, they do serve to point out those methods which are most viable.

The motivation survey was an attempt by *Anti-Monopoly* to measure the primary significance of a term used to name a unique item made by a single producer. When dealing with a trademark of an item made by only one producer it is difficult, if not impossible, to determine whether the name is regarded by the public as primarily identifying either the product or its source since, in a single producer situation, “[c]onsumers probably don’t distinguish whether the name is the generic name of that ‘thing’ sold or indicates that ‘thing’ sold only by one seller.”²⁵¹ When the consumer thinks of the name, the

was a defect in Nestle’s survey. The key term on the list of terms to be identified was simply “Toll House” and not “Toll House cookies,” and thus respondents who indicated that “Toll House” was a brand name may have been referring to “Toll House” chocolate morsels. *Id.*

²⁴⁷ *Id.* at 772-73. The motivation-type survey was deemed inadmissible by the court because it was not timely submitted. The court found that even if this survey were admitted, the survey results were irrelevant since the study ascertained only consumer motivation in purchasing “Toll House” chocolate morsels, and the issue it was deciding concerned only Toll House cookies. *Id.* at 773 n.6.

²⁴⁸ *Id.* at 770, 776. The court noted that these marketing surveys “clearly probed the primary significance of the term Toll House in the minds of consumers.” *Id.* at 776. The “Detailed Findings” section of one of the surveys concluded that “[t]he primary association with the Toll House name, as could be expected, relates to chocolate—chocolate chip cookies, chocolate bits, etc.” *Id.* at 770. This “finding” may have strongly influenced the court because this statement was the equivalent of an admission that the term was generic.

²⁴⁹ *Id.* at 777; see *Anti-Monopoly II*, 684 F.2d at 1323.

²⁵⁰ See *supra* note 79.

²⁵¹ 1 J. McCARTHY, *supra* note 2, at § 12:15; see also *District Court II*, 515 F. Supp. at 453 (“In the case of the single producer of a unique item, it is a difficult and delicate task to separate product from source characteristics as they appear in the consumer’s mind.”).

consumer must automatically think of one producer, because only one producer makes the product.

Anti-Monopoly's motivation survey was one method of dealing with this very difficult problem. The Ninth Circuit in *Anti-Monopoly II* characterized their previous decision in *Anti-Monopoly I* as clearly stating that what was relevant in determining primary significance was "the sense in which a purchaser used the word 'Monopoly' when asking for the game by that name."²⁵² By way of illustration, the *Anti-Monopoly I* court set forth the following example:

It may be that when a customer enters a game store and asks for MONOPOLY, he means: "I would like Parker Brothers' version of a real estate trading game, because I like Parker Brothers' products. Thus, I am not interested in board games made by Anti-Monopoly, or anyone other than Parker Brothers." On the other hand, the consumer may mean: "I want a 'Monopoly' game. Don't bother showing me Anti-Monopoly, or EASY MONEY, or backgammon. I am interested in playing the game of Monopoly. I don't much care who makes it."²⁵³

The motivation survey incorporated this exact phrasing into the responses to the structured question in the survey which asked "[W]hich of these two statements best expresses your meaning when you ask [to purchase] . . . MONOPOLY in a store?"²⁵⁴ The court in *Anti-Monopoly II* saw the motivation survey as a reasonable attempt to determine the sense in which the consumer used the word.²⁵⁵ The survey, however, has been vigorously criticized as measuring consumer motivation instead of consumer perception.²⁵⁶

This criticism is valid. By asking "what is your meaning when you ask to purchase," one will get answers that reflect the consumer's motivation in purchasing the game. The buyer's motivation for making a given purchase, however, does not necessarily reflect the primary significance in the consumer's mind of the name of the product

²⁵² *Anti-Monopoly II*, 684 F.2d at 1325.

²⁵³ *Anti-Monopoly I*, 611 F.2d at 305-06.

²⁵⁴ *District Court II*, 515 F. Supp. at 453 n.5.

²⁵⁵ *Anti-Monopoly II*, 684 F.2d at 1325.

²⁵⁶ See, e.g., *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., concurring) (consideration of purchaser motivation is "an esoteric and extraneous inquiry"); Lefkowitz & Graham, *supra* note 213, at 14 ("genericness . . . depends not on any perception that the public may have . . . but rather on what motivates . . . purchasers to buy the trademarked product . . ."). Seven amicus briefs were filed in support of Parker Brothers' petition to the Supreme Court for issuance of a writ of certiorari to review the *Anti-Monopoly II* decision. All seven argued that the motivation survey does not measure consumer understanding of the term.

which he has requested. The only reasonable explanation for the court giving the survey such great weight is that it echoed the court's prior language, by which the court felt bound. This does not, however, change the fact that the motivation survey is not at all probative of primary significance. The motivation survey was designed specifically in response to the circuit court's suggestion in *Anti-Monopoly I* as to how genericness might be established in single-producer situations.²⁵⁷ The utility of the motivation survey in future trademark cases involving single producers is questionable, however, since it failed to measure the public's understanding of the term. A better approach might be that suggested by Professor McCarthy:

The prime question is: What does the public call this "thing"? If, to the public, the "thing" is called by the term that the seller intends as a trademark, then it is not a mark at all—it is generic. But if the public calls the "thing" by some name other than the mark, then the mark probably does function as a mark even though there is . . . no one else on the market with the "thing."²⁵⁸

This inquiry is simple in its form and neutral in its approach, since it concentrates solely on what the public calls the item without reference to why they might purchase it. Thus, the significance of the term is the focus of the inquiry, rather than the significance of the product as it relates to a buyer's motive in making a purchase. By eliminating the extraneous element of motivation, McCarthy's approach is a purer determinant of the primary significance of the term in the very difficult single-producer situation.²⁵⁹

Although severely criticized by the *Anti-Monopoly II* court, and accepted as relevant to the issue of primary significance only by the *Teflon* court, the brand name survey can still be useful if properly constructed. The brand name surveys submitted in both *Teflon* and *Anti-Monopoly* began by using the example "Chevrolet—automobile" to explain the difference between a brand name and a common name.²⁶⁰ They defined a brand name as a name of an item made by only one company, and a common name as the name of an item made by a number of different companies.²⁶¹ The *Anti-Monopoly II* court

²⁵⁷ See *supra* text accompanying note 253.

²⁵⁸ 1 J. MCCARTHY, *supra* note 2, § 12:15, at 434.

²⁵⁹ McCarthy's test may be implemented by a "blind test" approach. Consumers could be presented with a product that has been stripped of all trademark identification and asked, "What would you call this product?" If they use the trademark as the response to this question, then the trademark is generic.

²⁶⁰ See *supra* text accompanying notes 134 & 197.

²⁶¹ See *id.*

noted that the survey had no evidentiary value in a single-source situation, since the name of an item produced by a single producer would always, by definition, be a brand name.²⁶²

The *Teflon* case, however, was a situation in which more than one producer made the non-stick coatings product. Thus, the definition of a brand name as the name of an item made by one company would not appear to have biased the results of the survey, since "Teflon," unlike "Monopoly," would not by definition always be a brand name. Consumers might, in accord with the definitions, associate the term "Teflon" with non-stick coatings made by other producers and therefore identify it as the common name of the product. Those who perceived "Teflon" as being made by only one company, however, could identify it as a brand name. The definitions, therefore, did not in any way dictate their choices. Accordingly, the *Teflon* court's acceptance and the *Anti-Monopoly* court's rejection of the brand name survey appear to have been entirely proper.

One way to avoid potential criticism of the brand name survey is to construct a survey in which brand names and common names are not defined in terms of the number of producers of the product. The plaintiff in *Nestle*, for example, commissioned a brand name survey in which the interviewees were told: "a brand name is a special name that identifies the manufacturer or the source of a product, while a common name is a general category name for the product itself."²⁶³ These definitions would thus be applicable to both single and multiple producer situations, since the existence of a brand name or common name is not dependent upon the number of producers making the product with which the term is associated. It might be noted that the *Nestle* court did not reject the survey because of any defect in the survey definitions. The court disregarded the survey because the survey listed simply "Toll House" among the key terms to be identified, while the dispute concerned the trademark significance of the term "Toll House" as used in conjunction with the word "cookies."²⁶⁴

The conclusion to be drawn from these cases is that the brand name survey would probably be an effective means of proving primary significance, subject to certain conditions. The trademark term that appears in the survey must be the exact one at issue, and the definitions of "brand name" and "common name" should be neutral, as discussed above, in order to avoid biasing the results. Once these

²⁶² See *supra* text accompanying note 198.

²⁶³ *Nestle Co.*, 571 F. Supp. at 763.

²⁶⁴ See *supra* note 246.

conditions have been met, there would appear to be no reason to reject the results of a brand name survey as evidence of the primary significance of a trademark.

The *Thermos* survey attempted to measure consumer usage, and thereby consumer understanding, of the term "Thermos."²⁶⁵ The survey asked the following key questions:

- [1] If you were going to buy one of these containers tomorrow—that is, the type that keeps food and beverages hot or cold . . . What would you ask for—that is, what would you tell the clerk you wanted?
- [2] Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold?
- [3] If you were going to describe one of these containers to a friend of yours—what words would come to your mind first to describe a container that keeps liquids hot or cold?
- [4] Do you know the names of any manufacturers who make these containers that keep liquids [sic] hot or cold?
- [5] Can you name any trade-marks or brand names that are used on these containers?²⁶⁶

In the first question the survey takers were attempting to determine whether consumers at the point of purchase used the term "Thermos" as the common name of the product. The defect in this question, however, is that if a person simply responds "Thermos," one is unable to distinguish whether the respondent is using the term in its source-designating sense or in a generic sense.²⁶⁷ In other words, were they asking for any vacuum bottle, or a "Thermos" brand vacuum bottle?

The second key question in the *Thermos* survey is not at all probative of the primary significance of the term. While the availability of alternative terms may be one piece of indirect evidence considered by the court,²⁶⁸ "the test [for genericness] is not what is available as an alternative to the public," but what is the public's understanding of the disputed term.²⁶⁹ The fourth key question in the survey sought to measure consumer awareness of the identity of the manufacturer. This inquiry is also irrelevant, since it has long been recognized that

²⁶⁵ *Thermos*, 207 F. Supp. at 20.

²⁶⁶ *Id.* at 21 n.8.

²⁶⁷ This defect was recognized by the *Teflon* court. See *supra* text accompanying note 139.

²⁶⁸ See *supra* text accompanying notes 230-33.

²⁶⁹ *King-Seeley*, 321 F.2d at 580.

trademark validity does not require that the public know the identity of the trademark owner.²⁷⁰

The third key question, like the first, was designed to ascertain whether consumers used and understood the term "Thermos" as the common name of the product. This question, however, does not suffer from the same defect as question one, since it specifically asks what words are used to *describe* the product? Thus, a consumer responding "Thermos" to this question is indeed using it in a generic sense. While a "Thermos" response would show that the term was used to designate the product, this alone is not sufficient to show that the primary significance of the term is to designate the product rather than its source. Trademark law has long recognized the principle that a valid trademark can perform the dual functions of identifying both product and source.²⁷¹ A trademark only becomes generic when the source-designating function is no longer primary.²⁷² Therefore, although a significant segment of the public may respond "Thermos" to question three, and it can thereby be shown that they understand the term as designating the product, this is not conclusive. It is, rather, only half of the inquiry. The survey must further probe whether the consumers also use and understand the term as a trademark. The fifth and final key question accomplishes this by asking a question that can only be answered in terms of trademarks or brand names that the consumer associates with the product. It therefore measures only the trademark significance of the term. These two questions take into consideration the dual functions of trademarks since the results of question three prove the term's generic significance, and the results of question five prove its trademark significance. A comparison of the responses to questions three and five can then be made in order to determine which understanding is primary.

The relevance of the *Thermos* survey as an indicator of primary significance may be questioned because it was disapproved by the

²⁷⁰ See *Bayer*, 272 F. at 509 (trademark can be valid if consumers know product comes from single, although anonymous, source); *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 255 (2d Cir. 1962); 3 R. CALLMANN, *supra* note 1, § 84.1, at 1628.

²⁷¹ See, e.g., *Coca-Cola Co. v. Koke Co.*, 254 U.S. 143, 146 (1920) ("[i]t hardly would be too much to say that the drink characterizes the name as much as the drink . . . [W]e see no reason to doubt that . . . it has acquired a secondary meaning in which perhaps the product is more emphasized than the producer but to which the producer is entitled."); *Selchow & Righter Co. v. McGraw-Hill Book Co.*, 439 F. Supp. 243 (S.D.N.Y. 1977) (trademark no less valid because it identifies both product and source), *aff'd*, 580 F.2d 25 (2d Cir. 1978); see generally Swann, *supra* note 91.

²⁷² 1 J. McCARTHY, *supra* note 2, at § 12:2(c); see *supra* text accompanying note 48.

Teflon court.²⁷³ This rejection, however, should not significantly detract from the survey's future effectiveness since in *Teflon* neither defendant, YKK, nor plaintiff, DuPont, utilized the survey properly. YKK's survey only made half the inquiry necessary to a determination of primary significance. Although YKK asked the respondents what name they would use to describe the item to a store clerk or friend, they never asked the balancing question, "Can you name any trade-names or brand names that are used on these items?" Thus, while YKK was able to show that a substantial majority of consumers would use the contested term to describe the product, they were not able to show that this was its primary significance. They did not ask the companion question concerning trademarks, and therefore no comparison could be made to determine which significance was primary. DuPont, however, commissioned a survey which did ask the companion question: "Do you know a brand name or trademark for one of these coatings?"²⁷⁴ This survey showed that a great majority of consumers understood "Teflon" as a trademark.²⁷⁵ One can only speculate what the results would have been had these two questions been included in the same survey. But when one compares the results of the two questions, they show that a great majority of the public understood the term as indicating both source and product, and thus that it probably was not generic.²⁷⁶

The relevance of the *Thermos*-type survey was legitimately questioned by the *Teflon* court, since the surveys presented in that case were improperly designed. As the foregoing analysis shows, if questions three and five were included in one survey, the elements of "primariness" and "significance" of the term would have been proven. Thus, if properly constructed, the *Thermos*-type survey apparently continues to be a viable means of proving primary significance.

IV. CONCLUSION

The "primary significance" analysis set forth by the Supreme Court in *Shredded Wheat* remains the standard against which a deter-

²⁷³ See *supra* text accompanying note 144.

²⁷⁴ *Teflon*, 393 F. Supp. at 525 (quoting Pl. Exh. 61, Questionnaire entitled "Protective Coating Study-A").

²⁷⁵ *Id.* at 527.

²⁷⁶ *Id.* YKK had conducted two very similar surveys. The results of the first survey showed that 71.7% used "Teflon" descriptively, and the second survey showed that 81.4% used "Teflon" descriptively. *Id.* at 525. DuPont's survey showed that 80% of those questioned understood "Teflon" as a trademark. *Id.* at 526. A comparison of these results does not clearly show the term to be generic. Thus, the presumption of validity in favor of registered trademarks should govern.

mination of genericness will be made. It is a very difficult standard to apply, since it calls for a probe into the minds of the consuming public. While there is no definitive method of proving this amorphous concept, the opinions analyzed herein show that an attorney desiring to prove genericness must come to court armed with both indirect and direct evidence of the primary significance of the contested term.

If properly utilized, the *Thermos*-type survey and the brand name survey represent viable methods of proving primary significance. When using the *Thermos*-type survey, the attorney must ensure that both the product-denoting question (number three) and the source-denoting question (number five) are asked because without both questions a comparison of responses could not be made to determine which significance is primary. When using the brand name survey, the attorney must ensure that the survey defines both brand name and common name in source-neutral terms, and that the term which appears in the survey is the exact trademark at issue.

Both the *Thermos*-type survey and the brand name survey can be effectively used in multiple producer situations and, if properly designed, appear to be valid in single producer situations. It is extremely difficult to determine primary significance in a single producer situation, since whenever the consumer thinks of the trademark, he must automatically think of the one producer who makes the trademarked item. Therefore, an attorney faced with a single producer situation may think it wise to avoid surveys that attempt to measure primary significance in quantifiable terms and opt instead for the method espoused by Professor McCarthy, in which people are simply asked, "What do you call the thing?" The motivation survey, though accepted by the Ninth Circuit as proof of primary significance of a term in a single producer situation, should never be used, since it does not reflect the primary significance of the term but rather the consumer's motivation for making a given purchase. The motivation survey was merely a response to the Ninth Circuit's suggestion of how a determination of primary significance could be made in the *Anti-Monopoly* case. As such, the survey amounted to no more than a legal argument in a particular case.

No matter which survey an attorney chooses, the court is likely to give greater weight to the direct survey evidence when the results of the survey are corroborated by strong indirect evidence since the court is not then faced with making a determination based upon competing statistics alone. Thus, an attorney who is able to come to court armed with strong indirect evidence which supports the results of a statistically valid, properly designed survey can be reasonably confident of

proving his or her case. Even so, the primary significance analysis is in essence a subjective test, and the simple truth is that sometimes no amount of evidence can take the place of the gut feeling that the court itself may have about a contested term.

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