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Trade Names: Protection Accorded Under Secondary Meaning Doctrine

Brooks P. Hoyt

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military law has since been revised and now provides for continuing jurisdiction over the more serious crimes when the accused cannot be tried in the courts of the United States or of any state, territory, or the District of Columbia.¹⁶ Discharge or separation from the service no longer serves to bar to the prosecution of major criminal acts committed overseas in time of war.

ORVILLE M. WESTON, JR.

TRADE NAMES: PROTECTION ACCORDED UNDER
SECONDARY MEANING DOCTRINE

Quality Courts United, Inc. v. Jones
59 So.2d 20 (Fla. 1952)

In a suit by Quality Courts United, Inc., to enjoin defendants from using the word "Quality" in advertising their motor courts, a final decree was entered enjoining defendants from using the word "Quality" in any manner reasonably calculated to indicate their membership in, or endorsement by, Quality Courts United, Inc. An order supplemental to the final decree interpreted the word "Quality" as used therein to provide that defendants might use the phrase "A Court with Quality" if in such manner that the word "Quality" was not emphasized in any way. On appeal, HELD, the word "Quality," as employed by complainant in relation to its business, has acquired a secondary meaning to the public which complainant may protect from infringement. Decree affirmed, and interpretative decree reversed on ground that it vitiated the benefits conferred by the final decree.

Words of a purely descriptive,¹ generic,² or geographical³ nature are

¹⁶64 STAT. 109 (1950), 50 U.S.C. §553 (Supp. 1952).

¹William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526 (1924); Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446 (1911).

²Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938); Dwight Lydell Chapter v. Loeks, 329 Mich. 342, 45 N.W.2d 311 (1951).

³Elgin National Watch Co. v. Illinois Watch Case Co., 179 U.S. 665 (1901); California Apparel Creators v. Wieder of California, Inc., 162 F.2d 893 (2d Cir. 1947); Surf Club v. Tatem Surf Club, Inc., 151 Fla. 406, 10 So.2d 554 (1942).

not subject to exclusive appropriation as trademarks.⁴ The probability that this rule, if literally applied, would result in commercial fraud led to its early modification through the secondary meaning doctrine.⁵ This doctrine, springing from several celebrated English cases,⁶ has become an integral part of the modern American law of unfair competition.⁷ It is grounded in the concept that a word may through constant usage in a particular manner acquire an additional meaning distinct from that which ordinarily attaches to it. Secondary meaning may be defined as association, nothing more.⁸ The doctrine contemplates that words through exclusive and extended use on the market by a producer with reference to his goods or business may acquire a secondary signification denoting the goods or business of that particular entrepreneur.⁹ While a public consciousness of the personal identity of the producer is not necessary, it must be shown that whatever is asserted to carry the secondary meaning has come to signify origin from a single source.¹⁰ Such words are commonly known as trade names, and their use by others in their secondary, as distinguished from their primary, sense will be enjoined.¹¹

The question of whether such a secondary meaning has been acquired is one of fact,¹² the critical questions at the outset always being whether the public is moved in any degree to purchase the product because of its source and how it distinguishes that source.¹³ If the buyer associates with the name merely the kind of product sold rather than a singleness of source of such product, the use of the name by others will not be restrained.¹⁴ In determining the question, factors

⁴Canal Co. v. Clark, 13 Wall. 311 (U.S. 1871).

⁵G. & C. Merriam Co. v. Saalfield, 198 Fed. 369 (6th Cir. 1912).

⁶Reddaway v. Banham, A.C. 199 (1896); Montgomery v. Thompson, A.C. 217 (1891); Wotherspoon v. Currie, L.R. 5 H.L. 508 (1872).

⁷Skinner Mfg. Co. v. General Foods Sales Co., 52 F. Supp. 432 (D. Neb. 1943).

⁸Nims, UNFAIR COMPETITION AND TRADEMARKS *37 (4th ed. 1947).

⁹G. & C. Merriam Co. v. Saalfield, 198 Fed. 369 (6th Cir. 1912); Baltimore Bedding Corp. v. Moses, 182 Md. 229, 34 A.2d 338 (1943).

¹⁰Coca-Cola Co. v. Koke Co. of America, 254 U.S. 143 (1920); National Nu Grape Co. v. Guest, 164 F.2d 874 (10th Cir. 1947).

¹¹Draper v. Skerrett, 116 Fed. 206 (C.C.E.D.Pa. 1902); Hartzler v. Goshen Churn & Ladder Co., 55 Ind. App. 455, 104 N.E. 34 (1914).

¹²Little Tavern Shops, Inc. v. Davis, 116 F.2d 903 (4th Cir. 1941); Drive It Yourself Co. v. North, 148 Md. 609, 130 Atl. 57 (1925).

¹³Crescent Tool Co. v. Kilborn & Bishop Co., 247 Fed. 299 (2d Cir. 1917).

¹⁴Bayer Co. v. United Drug Co., 272 Fed. 505 (S.D.N.Y. 1921); Weeks v. Variety Nut & Date Co., 103 F. Supp. 528 (E.D. Mich. 1952).

such as sales volume,¹⁵ priority of use,¹⁶ distance,¹⁷ and advertising¹⁸ may be considered. But each case depends absolutely upon its own circumstances, and a controlling precedent is not to be expected.¹⁹

When secondary meaning is relied upon, protection is more limited than in the case of a valid trademark.²⁰ The word or words sought to be protected are considered to be, in their primary sense, *publica juris*, the property of all.²¹ The injunctive relief accorded will hence be so limited in scope as to restrain the use by another of a term in its secondary, or acquired, sense only.²² The line of demarcation between the two types of uses is difficult to ascertain. The injunction will normally require the second user to accompany his use of the words with such indications as will unmistakably distinguish his product from that of the original manufacturer or vendor.²³ To justify relief it is necessary to show probability of confusion.²⁴ Mere possibility of public deception will not suffice.²⁵ Under the particular circumstances of a given case, however, an injunction which is, in effect, absolute in scope may issue if such is the only way to prevent confusion and probable deception of the public.²⁶

By its holding in the instant case, particularly with regard to the interpretative decree, the Florida Court has demonstrated a more complete recognition of the secondary meaning doctrine and the rights

¹⁵Shaler Co. v. Rite-Way Products, Inc., 107 F.2d 82 (6th Cir. 1939).

¹⁶Upjohn Co. v. Merrell Chemical Co., 269 Fed. 209 (6th Cir. 1920).

¹⁷McKay v. Legler, 36 So.2d 793 (Miss. 1948).

¹⁸Le Blume Import Co. v. Coty, 293 Fed. 344 (2d Cir. 1923).

¹⁹Wisconsin Electric Co. v. Dumore Co., 35 F.2d 555 (6th Cir. 1929).

²⁰Dixi-Cola Laboratories, Inc. v. Coca Cola Co., 117 F.2d 352 (4th Cir. 1941); U-Drive-It Co. v. Wright & Taylor, 270 Ky. 610, 110 S.W.2d 449 (1937). *Contra*: Hygeia Distilled Water Co. v. Hygeia Ice Co., 72 Conn. 646, 45 Atl. 957 (1900).

²¹General Industries Co. v. 20 Wacker Drive Bldg. Corp., 156 F.2d 474 (7th Cir. 1946); Addison v. Hooks, 91 Fla. 337, 107 So. 623 (1926).

²²Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938); Quaker State Oil Refining Co. v. Steinberg, 325 Pa. 273, 189 Atl. 473 (1937); Koolvent Metal Awning Corp. v. Price, 368 Pa. 528, 84 A.2d 296 (1951).

²³G. & C. Merriam Co. v. Saalfield, 198 Fed. 369 (6th Cir. 1912); Rubber & Celluloid Harness Trimming Co. v. Devoe & Reynolds Co., 233 Fed. 150 (D. N.J. 1916); *cf.* McGhan v. McGhan, 115 Fla. 414, 155 So. 633 (1934); Gottdiener v. Joe's Restaurant, Inc., 111 Fla. 741, 149 So. 646 (1933).

²⁴Esso, Inc. v. Standard Oil Co., 98 F.2d 1 (8th Cir. 1938).

²⁵Federal Securities Co. v. Federal Securities Corp., 129 Ore. 375, 276 Pac. 1100 (1929).

²⁶Barton v. Rex-Oil Co., 29 F.2d 474 (3d Cir. 1928); Bernstein v. Friedman, 62 Wyo. 16, 160 P.2d 227 (1945).