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## TRADE-MARKS - REGISTRATION - LIKELIHOOD OF CONFUSION

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TRADE-MARKS — REGISTRATION — LIKELIHOOD OF CONFUSION — The applicant sought registration of the trade-mark "Powermax" for gasoline. The application was opposed on the ground of prior use and registration of "Powerine" for the same product. The register already contained the marks "Powerfuel," "Powerline," "Powerite," "Powero," "Powerflash," and "Powerized" for gasoline. *Held*, the application was properly denied. The mark must be considered as a whole, and the fact that the registered mark, or a portion of it, is descriptive in character does not justify disregarding the similarity in passing on the right to register. The showing of other confusing marks on the register does not help this applicant. *Skelly Oil Co. v. Powerine Co.*, (Cust. & Pat. App. 1936) 86 F. (2d) 752.

The question as to when trade-marks are confusingly similar arises both on registration under federal statutes and in infringement suits.<sup>1</sup> Though the statutes are designed for registration only, the courts have held that the dominant purpose of the sections here involved is the prevention of confusion and deception.<sup>2</sup> In carrying out this purpose, all doubts are construed against the

<sup>1</sup> The Trade-Mark statute of 1905, 15 U. S. C., § 85, provides: "trade-marks which are identical . . . or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered." There is a provision with a similar meaning in the act of 1920, 15 U. S. C., § 121.

<sup>2</sup> *B. F. Goodrich Co. v. Hockmeyer*, (Cust. & Pat. App. 1930) 40 F. (2d) 99; *California Packing Corp. v. Tillman & Bendell, Inc.*, (Cust. & Pat. App. 1930) 40 F. (2d) 108.

newcomer.<sup>3</sup> Because it is useless to register a mark, the use of which may be later enjoined, the tests for similarity in registration have become the same as those for the infringement of a trade-mark.<sup>4</sup> Broadly, this test is the determination of whether or not the marks are so similar as to lead the public to believe the goods to which they are applied come from a common origin.<sup>5</sup> The statutes specify that the new mark cannot be registered if it (1) resembles a known mark so as to be confusingly similar and (2) is applied to merchandise of the same descriptive properties. The recent cases seem to suggest, as a test for the first element, that if the new mark includes one of the syllables of a simple mark, or one of the words of a compound mark, registration of the new mark will be denied.<sup>6</sup> The courts have interpreted "descriptive properties," as used in the statutes, to mean a class.<sup>7</sup> The goods are considered of the same class if there is anything to suggest that perhaps they might be from the same source.<sup>8</sup> The principal case illustrates an application of these rules to a trade-mark conceded to be descriptive.<sup>9</sup> If they had been applied in a like manner to previous registrations, doubtless the trade-marks mentioned above would not have been regis-

<sup>3</sup> *Sutter Packing Co. v. Piggly Wiggly Corp.*, (Cust. & Pat. App. 1933) 64 F. (2d) 1006.

<sup>4</sup> *American Steel Foundries v. Robertson*, 269 U. S. 372, 46 S. Ct. 160 (1926). The applicant in the present case cited *Feil Co. v. Robbins Co.*, (C. C. A. 7th, 1915) 220 F. 650, but the court dismissed it on the ground that it was an infringement suit and not in point. No authority was cited for such a view. It seems that the distinction is unfounded and adds but another complication to the law.

<sup>5</sup> *NIMS, UNFAIR COMPETITION AND TRADE-MARKS 611* (1929); *Waltke & Co. v. Schafer & Co.*, (D. C. App. 1920) 263 F. 650.

<sup>6</sup> *Tew*, "Recent Decisions of the Court of Customs and Patent Appeals in Trade-Mark Cases," 14 *PATENT OFFICE SOC. J.* 165 at 171 (1932). The *Celotex* cases deny this, but they held "Flametex," "Opal-tex," and "Fir-tex" confusingly similar to "Celotex." *Celotex Co. v. Bronston Bros. & Co.*, (Cust. & Pat. App. 1931) 49 F. (2d) 1048; *Celotex Co. v. Chicago Panel-Stone Co.*, (Cust. & Pat. App. 1931) 49 F. (2d) 1051; *Celotex Co. v. Millington*, (Cust. & Pat. App. 1931) 49 F. (2d) 1053; 27 *ILL. L. REV.* 228 (1932). The "Fashion Park" cases illustrate the trend. In 1930, "Fashion Lane" and "College Park" were held not confusingly similar to "Fashion Park." *Rosenberg Bros. & Co. v. Wetherby-Kayser Shoe Co.*, (Cust. & Pat. App. 1930) 37 F. (2d) 437; *Rosenberg Bros. & Co. v. Levin & Sons*, (Cust. & Pat. App. 1930) 37 F. (2d) 962. But in 1931, "Fashion Row" was held confusingly similar to "Fashion Park." *Fashion Park v. The Fair*, (Cust. & Pat. App. 1931) 49 F. (2d) 830. These cases can be reconciled on the type of goods involved, but the statements on confusing similarity appear to be in conflict. See note 10, *infra*.

<sup>7</sup> *Tew*, "Goods of the Same Descriptive Qualities," 14 *PATENT OFFICE SOC. J.* 578 (1932).

<sup>8</sup> *Yale Elec. Corp v. Robertson*, (C. C. A. 2d, 1928) 26 F. (2d) 972, noted in 23 *ILL. L. REV.* 835 (1929); *Aunt Jemima Mills Co. v. Rigney*, (C. C. A. 2d, 1917) 247 F. 407.

<sup>9</sup> Nothing in the principal case indicates under which statute registration is sought. But from the report on the same case in 25 *T. M. Rep.* 619 (1935) it appears to be under the statute of 1905. Though observing descriptive properties, the decision is based solely on confusing similarity.

tered. According to prior adjudications under federal statutes<sup>10</sup> and the common law, descriptive words cannot be protected as trade-marks.<sup>11</sup>

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<sup>10</sup> *Reo Motor Car Co. v. Traffic Motor Truck Corp.*, (D. C. App. 1925) 4 F. (2d) 303, decided that the prior registration of "Speed Wagon" did not bar the registration of "Speedboy." The court said, "having adopted a descriptive mark, appellant has no right to exclude another from the use of the descriptive features of the mark, if used in such a way as to distinguish the two marks." *AnSCO Photoproducts, Inc. v. Eastman Kodak Co.*, (D. C. App. 1927) 19 F. (2d) 720, held that "Speedway" could be registered though opposed by the user of "Speedex," since the similarity resulted from the use of the word "speed" to which neither party could claim exclusive rights. Dean, "Trade Mark Rights in Descriptive Words," 3 *Austr. L. J.* 38 (1929), discusses the same point in relation to infringement suits. See note 6, *supra*.

<sup>11</sup> The common law said that a trade-mark was owned and that it was not right that a party should own a descriptive word. *Brown Chemical Co. v. Meyer*, 139 U. S. 540, 11 S. Ct. 625 (1891).