

1937

## TRADE MARKS AND TRADE NAMES - MARK USED ON PATENTED ARTICLE - EFFECT OF EXPIRATION OF PATENT

William J. Isaacson  
*University of Michigan Law School*

Follow this and additional works at: <https://repository.law.umich.edu/mlr>



Part of the [Intellectual Property Law Commons](#)

---

### Recommended Citation

William J. Isaacson, *TRADE MARKS AND TRADE NAMES - MARK USED ON PATENTED ARTICLE - EFFECT OF EXPIRATION OF PATENT*, 35 MICH. L. REV. 852 (1937).

Available at: <https://repository.law.umich.edu/mlr/vol35/iss5/22>

This Regular Feature is brought to you for free and open access by the Michigan Law Review at University of Michigan Law School Scholarship Repository. It has been accepted for inclusion in Michigan Law Review by an authorized editor of University of Michigan Law School Scholarship Repository. For more information, please contact [mlaw.repository@umich.edu](mailto:mlaw.repository@umich.edu).

TRADE MARKS AND TRADE NAMES — MARK USED ON PATENTED ARTICLE — EFFECT OF EXPIRATION OF PATENT — *P* company had distributed patented razor-blades marked *Enders*, and, upon the expiration of its patent, registered the word as a trade mark. It also used the term *Keen-Kutter*, as part of its mark, but the use of this term on other goods antedated the patent by several years. *P* now seeks to enjoin the *D* company from using either term as part of its trademark. *Held*, (1) the word *Enders* having become descriptively designative of this type of razor and blade, *D* was entitled to use it upon expiration of *P*'s patent; (2) as to *Keen-Kutter*, since it was used many years before the patent and since the patent did not contribute greatly to the value of the word as a trade mark, *D* will be enjoined from using it as a part of his mark. *Enders Razor Co. v. Christy Co.*, (C. C. A. 6th, 1936) 85 F. (2d) 195.

The question before the court seems to be, are there any significant differences between the two situations to warrant the court in distinguishing between them? That is, is there ground to declare that the mark which was intimately associated with the patent falls into the public domain, whereas that

part which preceded the patent in point of time is to be protected? The great weight of authority is that such a distinction exists.<sup>1</sup> Whether this distinction is well-founded is dependent upon what the true function of the trade mark is. Those courts which declare that the expiration of the patent constitutes an abandonment by *P* are merely indulging in one of the ramifications of the principle that the trade mark is property.<sup>2</sup> The reasoning is that because a trade mark is property, the rules governing property apply.<sup>3</sup> When *P* takes out his patent, he impliedly agrees to abandon the trade mark upon the expiration of the patent.<sup>4</sup> Although this fiction applies equally as well to trade marks on patented articles, which have not become descriptive, such application is not made.<sup>5</sup> This is evidence that the real basis for the rule that a trade mark will become open to the public upon expiration of a patent is not that *P* agreed to abandon it. The reason for the rule lies, rather, in the fact that to hold otherwise would result in the patentee perpetuating the monopoly acquired through the patent.<sup>6</sup> If the functional view<sup>7</sup> as to the basis of trade mark protection is adopted, the question of intent of the plaintiff has no significance. The perti-

<sup>1</sup> In *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169 at 185, 16 S. Ct. 1002 (1896), which is the leading case on this question, it was said, "It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public . . . there must also necessarily pass to the public the generic designation which has arisen during the monopoly. . . ." In *Batcheller v. Thompson*, (C. C. A. 2d, 1899) 93 F. 660, which is the leading case holding the doctrine of *Singer Mfg. Co. v. June Mfg. Co.* to be inapplicable if the use of the term antedated the patent, it was said: "In this case the name antedated the patent by more than two and a half years, and the name and not the patent . . . gave value to the article." Other decisions following this case are *President Suspender Co. v. Macwilliam*, (C. C. A. 2d, 1916) 238 F. 159; *Avenarius v. Kornely*, 139 Wis. 247, 121 N. W. 336 (1909); *Dupont Cellophane Co. v. Waxed Products*, (D. C. N. Y. 1934) 6 F. Supp. 859. But see dissenting opinion in *Avenarius v. Kornely*, supra.

<sup>2</sup> *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169 at 186, 16 S. Ct. 1002 (1896): "It is elementary that there is a right of property in a name. . . . But this right . . . may become public property by dedication or abandonment."

<sup>3</sup> *Ibid.*, 163 U. S. 169 at 186, citing *DE MARAGY, INTERNATIONAL DICTIONARY OF INDUSTRIAL PROPERTY*: "Abandonment in industrial property is an act. . . ." The essential condition to constitute abandonment is that one having a right should consent to the dispossession. For an excellent article criticizing this approach, see 30 *COL. L. REV.* 695 (1930).

<sup>4</sup> *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 16 S. Ct. 1002 (1896).

<sup>5</sup> *President Suspender Co. v. Macwilliam*, (C. C. A. 2d, 1916) 238 F. 159 at 163: "It is to be observed that the doctrine of the *Singer Case* rests upon the fact that the name had come to indicate the invention and thus constituted its generic description."

<sup>6</sup> *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 16 S. Ct. 1002 (1896); *NIMS, UNFAIR COMPETITION AND TRADE-MARKS*, 3d ed., § 207 (1929).

<sup>7</sup> *NIMS, UNFAIR COMPETITION AND TRADE-MARKS*, 3d ed., § 186 (1929); *Elgin Nat. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665 at 673, 21 S. Ct. 270 (1901), defining a trade mark as "a distinctive mark of authenticity, through which the products of particular manufacturers or merchants may be distinguished," whose office is "to point out distinctively the origin or ownership of the articles to which it is affixed."

ment inquiry is: What was the association between *P*'s product and his trade mark in the mind of the public?<sup>8</sup> If the legitimate function of the trade mark is none other than to designate the source of the goods, it must, of necessity, follow that when a mark ceases to do this, it will no longer be protected.<sup>9</sup> In view of the extension of the law of unfair competition to more than "passing off,"<sup>10</sup> can there be a rational basis for protecting a mark which has lost its distinctiveness although its origin antedates the patent which has expired? The functions ascribed to the trade mark should depend on the policy factors involved, more so in this segment of the law than in the law in general.<sup>11</sup> With this in mind, the following reasons as to why *P*'s rights should be protected in such a case are suggested. First, to refuse protection in effect penalizes the ingenious tradesman who has expended large sums of money to make his trade mark a household word.<sup>12</sup> By hypothesis this development occurred without the aid of a government-protected monopoly in the form of a patent, and at a time when competitors had an equal opportunity to build up a trade mark. Such advertising expenditures are just as much a part of the business as the plant and machinery.<sup>13</sup> A second reason in favor of protection is to be found in the fact that the commercial world abounds in trade mark pirates. This necessitates clear, concise rules lest unfair trade practices be encouraged.<sup>14</sup> The line between what is descriptive and what is not is so hazy and ill-defined, that any other rule gives an easy opening for the unscrupulous.

*William J. Isaacson*

<sup>8</sup> See 30 COL. L. REV. 695 (1930).

<sup>9</sup> *Prestonettes, Inc. v. Coty*, 264 U. S. 359, 44 S. Ct. 350 (1924).

<sup>10</sup> *International News Service v. Associated Press*, 248 U. S. 215 at 242, 39 S. Ct. 68 (1918), where it was said: "defendant's conduct differs from the ordinary case of unfair competition in trade principally in this, that, instead of selling its own goods as those of complainant, it substitutes misappropriation in the place of misrepresentation, and sells complainant's goods as its own."

<sup>11</sup> See 38 HARV. L. REV. 370 (1925); Schecter, "The Rational Basis of Trade-mark Protection," 40 HARV. L. REV. 813 (1927); NIMS, UNFAIR COMPETITION AND TRADE-MARKS, 3d ed., § 10 (1929).

<sup>12</sup> See 36 COL. L. REV. 502 (1936).

<sup>13</sup> See *Hilson Co. v. Foster*, (C. C. N. Y. 1897) 80 F. 896. But see Isaacs, "Traffic in Trade-Symbols," 44 HARV. L. REV. 1210 at 1212 (1931): "The manufacturer has simply succeeded in having a path beaten to his door by creating in the public a habit of using his private word. This possibility may not be socially desirable."

<sup>14</sup> See NIMS, UNFAIR COMPETITION AND TRADE-MARKS, 3d ed., § 218a (1929). In discussing what should govern priority of right to protection, there is reasoning used which seems to be equally applicable in this situation, "the growth theory and the theory that the trade mark follows the trade seem to be leading away from stability and certainty in trade mark titles, and to be an encouragement to infringement and passing off. Capital is not encouraged to invest in the development of a branded article if. . ."