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## TRADE-MARKS – MAP AS A TRADE-MARK REGISTERABLE UNDER ACT OF 1905

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TRADE-MARKS — MAP AS A TRADE-MARK REGISTERABLE UNDER ACT OF 1905 — Canada Dry Ginger Ale filed an application for the registration, under the Trade-Mark Act of February 20, 1905, as amended, of a colored map of Canada used by it as a trade-mark for maltless beverages sold as soft drinks. The Commissioner of Patents ruled the mark was not a valid trade-mark at common law and was intended to fall within the statutory prohibition against the registry of “merely a geographical name or term.” On appeal, Canada Dry asserted that the mark was a valid common-law trade-mark, and that even though not otherwise registerable, it became so by virtue of a secondary meaning acquired by long exclusive use. *Held*, that it was not a valid common-law trade-mark, because the map “conveys the same idea that the word ‘Canada,’ without the map, would convey, and either the map—or the word—would be understood by purchasers as indicating that the goods were produced in Canada”;<sup>1</sup> and, that a geographic term descriptive of the place where the articles were manufactured is not registerable even though it has acquired a secondary meaning. *In re Canada Dry Ginger Ale, Inc.*, (Cust. & Pat. App. 1936) 86 F. (2d) 830.

The Trade Mark Act of 1905,<sup>2</sup> under which Canada Dry sought to register its map of Canada, provides for the registration of those marks, in general, which were considered by the common law as technical trade-marks.<sup>3</sup> The act explicitly prohibits registration of “merely a geographical name or term.”<sup>4</sup> Despite reports of a few early cases which appeared to consider such marks as good technical trade-marks,<sup>5</sup> this, too, is but declaratory of the common law.<sup>6</sup>

<sup>1</sup> *In re Canada Dry Ginger Ale, Inc.*, (Cust. & Pat. App. 1936) 86 F. (2d) 830 at 831.

<sup>2</sup> 33 Stat. L. 724, 15 U. S. C., § 81 et seq.

<sup>3</sup> *Hercules Powder Co. v. Newton*, (C. C. A. 2d, 1920) 266 F. 169; *Beckwith v. Commr. of Patents*, 252 U. S. 538, 40 S. Ct. 414 (1920); 35 MICH. L. REV. 989 (1937); JUHASS and MENCHER, *AMERICAN INDUSTRIAL PROPERTY* 31 ff. (1931).

<sup>4</sup> 33 Stat. L. 724, 15 U. S. C., § 85 (b).

<sup>5</sup> *Handler and Pickett*, “Trade Marks and Trade Names” 30 COL. L. REV. 168, 759 (1930). These are cited and discussed *ibid.* p. 194, and by NIMS, *UNFAIR COMPETITION*, 3d ed., 278 ff. (1929).

<sup>6</sup> *McIlhenney v. New Iberia Extracts of Tobasco Pepper Co.*, 34 App. D. C. 430 (1910).

In the principal case the court concludes that a colored map of Canada causes the same reaction in the mind of the public as would the word "Canada." It follows that the map, the equivalent of the word, is itself barred by the act. That the public upon seeing the map on this product would know it was therefore made in Canada seems highly questionable. Surely no producer would be likely to adopt that as the way to disclose his place of manufacture. And the court apparently recognizes the hardship caused Canada Dry in reaching such a conclusion, for it quotes with approval an earlier case which observed: "There is much to be said in favor of a registration law which would give legal and governmental sanction to any mark which it could be shown the public had accepted. Such a system would enable this plaintiff to prevail; but Congress must first create it."<sup>7</sup> In the light of this attitude one wonders if some method might not have been adopted whereby the security of registration could have been afforded this map. The court rejected the argument that since the act stipulates against "merely a geographical name," that any such name which had acquired a secondary meaning—that is, is something more than merely a geographical name—can be registered. In denying the validity of this contention the court follows clear language of the United States Supreme Court.<sup>8</sup> It has been said that "secondary meaning, as such, is of no significance when it comes to the question of registerability of marks and time and money are wasted in taking proofs on the point."<sup>9</sup> But that would not foreclose the interpretation which would limit the prohibition to *words*, and view it as not including such symbols as colored maps. Since the generally accepted purpose of the act is to protect the indicia of the origin and ownership of the product, an interpretation which will permit registration of this map would appear to do no violence to the act.<sup>10</sup> The traditional

<sup>7</sup> *Hercules Powder Co. v. Newton*, (C. C. A. 2d, 1920) 266 F. 169 at 175.

<sup>8</sup> *Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 21 S. Ct. 270 (1901).

<sup>9</sup> Spencer, "Observations On the Registerability of Trade-Marks," 23 *GEORGETOWN L. J.* 456 at 460 (1935). The writer is First Assistant Commissioner of the United States Patent Office. It will be noted that he suggested that language appeared in the case of *In re Plymouth Motor Corp.*, (Cust. & Pat. App. 1931) 46 F. (2d) 211, which might give rise to this type argument. In the principal case the court points out that much of the uncertainty raised by the Plymouth Case was resolved by its decision in *Barber-Colmen Co. v. Overhead Door Corp.*, (Cust. & Pat. App. 1933) 65 F. (2d) 147.

<sup>10</sup> The aim of trade-marks is to prevent confusion, to designate the origin of the goods to which the mark is applied. *In re Eastman Kodak Co.*, (Cust. & Pat. App. 1935) 80 F. (2d) 270; *In re Keller, Heumann & Thompson Co.*, (Cust. & Pat. App. 1936) 81 F. (2d) 399; *Elgin American Mfg. Co. v. Elizabeth Arden, Inc.*, (Cust. & Pat. App. 1936) 83 F. (2d) 681. This map, it is believed, would accomplish this.

The aim of the Trade-Mark Act is to guard such marks. *Vermont Maple Syrup Co. v. F. N. Johnson Maple Syrup Co.*, (D. C. Vt. 1921) 272 F. 478; *Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 21 S. Ct. 270 (1901). See Schecter, "Rational Basis of Trade-Mark Protection," 40 *HARV. L. REV.* 813 (1927).

Marks which were "words" and apparently more geographical than the map have been registered, for example: "Old South," *Southeastern Brewing Co. v. Blackwell*, (C. C. A. 4th, 1935) 80 F. (2d) 607; and "Dublin Stout," *Arthur Guinness, Sons & Co. v. Oscar Von Bernuth, Inc.*, (D. C. N. Y. 1923) 14 F. Supp. 210. Presence on the registry of even more objectionable marks cannot be used as an argu-

objection to registration of geographical *words* which have come to indicate the source and not the place of manufacture is that the monopoly over the word gained from registration would result in a monopoly of manufacturing in that place.<sup>11</sup> Since the monopoly would still permit its use in the literal sense, when printed in such form as to avoid confusion, this fear has been challenged as groundless.<sup>12</sup> The writer believes his suggestion does not rest upon the presence or absence of validity in the monopoly argument, because monopoly of this map could in no conceivable fashion result in Canada Dry monopolizing the manufacture of beverage in Canada. A ginger ale manufacturer can tell the world his plant is located in Canada by an unobtrusive statement of address,<sup>13</sup> indeed, use of a map would be less apt to convey this information. The only explanation for another's use of such map would lie in the desire of that party to confuse the public. Such "passing off" would be enjoined in an action for unfair competition.<sup>14</sup> It is conceivable that registration might be enough to dissuade one who would otherwise be tempted to avail himself of such temporary confusion.<sup>15</sup> To forestall such action it is submitted that registration ought to be granted if possible. Especially is this so since the act does not affect the substantive rights of the trade-mark user to any material degree.<sup>16</sup> The interpre-

ment in favor of registration of a mark itself objectionable, *American Fruit Growers, Inc. v. Michigan Fruit Growers, Inc.*, (Cust. & Pat. App. 1930) 38 F. (2d) 696; *In re Ric-Wil Co.*, (Cust. & Pat. App. 1937) 87 F. (2d) 516.

Cases involving maps have been few. The Washington Supreme Court in *Vittucci Co. v. Merline*, 130 Wash. 483, 228 P. 292 (1924), was asked to enjoin the use of a label for olive oil because of its confusing similarity to the label on plaintiff's olive oil. Both labels prominently displayed the map of Italy. The court said such display was to show where the oil came from, that this is similar to using the name of the locality "of which no trader can acquire the exclusive use" (130 Wash. at 488), citing *Delaware & Hudson Canal Co. v. Clark*, 13 Wall. (80 U. S.) 311, 20 L. Ed. 581 (1871). The language was dicta, the court having found there was no such similarity as to cause confusion. But the Court of Appeals of the District of Columbia in *American Printing Ink Co. v. American Printing Ink Co.*, (D. C. App. 1927) 23 F. (2d) 764, saw "no objection to the registration of the mark" whose background was a map of the United States with the city of Chicago located. The one opposing registration, in fact, did not raise the claim that this was subject to the objection of being a geographical name. It would appear more descriptive of the place of manufacture than the map of Canada in the principal case.

<sup>11</sup> *Delaware & Hudson Canal Co. v. Clark*, 13 Wall. (80 U. S.) 311, 20 L. Ed. 581 (1871); *Shaver v. Heller & Merz Co.*, (C. C. A. 9th, 1901) 108 F. 821, 65 L. R. A. 878. And *HOPKINS, TRADE-MARKS, TRADE NAMES, AND UNFAIR COMPETITION*, 3d ed., § 68 (1917).

<sup>12</sup> *Handler and Pickett*, "Trade Marks and Trade Names," 30 COL. L. REV. 168, 759 (1930). And see *NIMS, UNFAIR COMPETITION*, 3d ed., § 98c (1929).

<sup>13</sup> *Campana Corp. v. Glanzberg*, (D. C. Pa. 1935) 10 F. Supp. 876.

<sup>14</sup> *United Lace & Braid Mfg. Co. v. Barthels Mfg. Co.*, (D. C. N. Y. 1915) 221 F. 456; *Kellogg Co. v. Quaker Oats Co.*, (C. C. A. 6th, 1916) 235 F. 657 and *Anheuser-Busch Inc. v. Budweiser Malt Products Corp.*, (C. C. A. 2d, 1923) 295 F. 306.

<sup>15</sup> Referred to by *GEIER, PATENTS, TRADE-MARKS AND COPYRIGHTS*, 7th ed., 69 (1934), and *Spencer*, "Registerability of Trade-Marks," 23 *GEORGETOWN L. J.* 456 (1935).

<sup>16</sup> "No right of property is concluded by registration of a mark, and the parties

tation suggested would be justifiable in view of the fact that objectionable monopoly would not result. This map, indicating the source of the product, under such an interpretation would be registerable.

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affected are free to seek such relief as courts of law or equity may award." *Patton Paint Co. v. Sunset Paint Co.*, (App. D. C. 1923) 290 F. 326 at 328. *Dyer Quarry Co. v. Schuylkill Stone Co.*, (C. C. N. J. 1911) 185 F. 557. *Andrew Jergens v. Woodbury*, (D. C. Del. 1921) 273 F. 952, *affd.* (C. C. A. 3rd, 1922) 279 F. 1016, *cert. den.* 260 U. S. 728, 43 S. Ct. 92 (1922).