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STUDENT NOTES

GOODS OF THE SAME DESCRIPTIVE PROPERTIES

"To the lawyer it is the synonym of confusion; to the layman it is meaningless."¹ Thus wrote one author concerning the term, goods of the same descriptive properties. This term plays an important part in the law of trade-marks and unfair competition; for regardless of whether the issue is one of registration, infringement, or unfair competition, one of the questions to be decided is whether the trade-marks are to be used on goods of the same descriptive properties. However, it is the purpose of this note to study the term as it is used by the courts in determining those cases in which relief is sought for unfair competition caused by the using of the same or resembling trade-mark on the defendant's goods.

As a direct result of the general presumption that one could not adopt and use a trade-mark to the exclusion of all others where the second user applied it to dissimilar goods, goods of the same descriptive properties acquired meaning as a legal term. The Supreme Court has supported this presumption by saying, "The mere fact that one person has adopted and used a trade-mark on his goods does not prevent the adoption and use of the same trade-mark by others on articles of a different description."² Sec. 5 of the Federal Trade-Mark Act of 1905, 15 U.S.C.A. Sec. 85, also bears this out by implication in its provision:

"That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, 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."

Therefore, since the problem of the use of a trade-mark by one other than its first user reduces itself to a determination of whether the subsequent use is on goods of the same descriptive properties, it would seem that the court's task would be simple and the results consistent. However, a study of the cases will reveal surprising results. One of the latest cases to illustrate this is *Standard Brands v. Smidler*³ in which the plaintiff was the owner of a registered trade-mark "v-8" which he had been using since 1937 to identify a vegetable juice cocktail composed of eight vegetable juices. He also

¹ NIMS, UNFAIR COMPETITION AND TRADE-MARKS (3rd. ed. 1929) 579.

² *American Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926).

³ 151 F. 2d 34 (C.C.A. 2d, 1945).

made and sold other well known food products and a dry vitamin tablet trade-marked "Stams". In 1942 the defendant began to sell dry vitamin tablets bearing the trade-mark "V-8". The plaintiff sued for infringement of its trade-mark and unfair competition and obtained a judgement. A permanent injunction was issued restraining the defendant from so using the trade-mark "V-8". Other cases have held that "Kodak" could not be used as a trade-mark for bicycles as it was a trade-mark for cameras;⁴ that the manufacturer of "Philco" radio sets and accessories was entitled to enjoin the use of "Philco" as a trade-mark for razor blades;⁵ that the use of the trade-mark "Dunhill" in selling shirts could be enjoined by the maker of "Dunhill" pipes and smoking supplies;⁶ that the use of the word "Vogue" and the letter "V" as a label for hats was unfair competition as to the style magazine "Vogue";⁷ that the trade-mark "Waterman" as used on fountain pens was entitled to protection by injunction restraining the use of the same trade-mark on razor blades;⁸ that the use of the name "Tiffany" as the name of a corporation engaged in the jewelry business precluded its use as the name of a corporation distributing motion pictures;⁹ and that the trade-mark "Rolls-Royce" as used on automobiles could not be used by the makers of radio tubes.¹⁰ In contrast with these cases are those in which the courts have held that the use of the trade-mark "Gold-Medal" by the defendant on wheat flour did not exclude its use by the plaintiff on prepared pancake and buck wheat flour as they were not goods of the same descriptive properties;¹¹ and that the plaintiff who used the name "Borden's" on condensed milk was not entitled to an injunction to restrain the use, by the defendant, of the name "Borden's" on ice cream.¹²

It is apparent from the divergent results reached in the above mentioned cases, that no definite rule could be laid down as to what constitutes goods of the same descriptive properties; for no court could, in each case, merely note the goods on which the trade-mark is used and thus come to its decision. For each case is oc-

⁴ Eastman Kodak Co. v. Kodak Cycle Co., 15 Rep. Pat. Cas. 105 (1898).

⁵ Philadelphia Storage Battery Co. v. Mindlin, 163 Misc. 52, 296 N.Y. Supp. 176 (1937).

⁶ Alfred Dunhill of London v. Dunhill Shirt Shop, 3 F. Supp. 487 (1929).

⁷ Vogue Co. v. Thompson-Hudson Co., 300 Fed. 509 (C.C.A. 6th, 1924).

⁸ L. E. Waterman Co. v. Gordon, 72 F. 2d 272 (C.C.A. 2d, 1934).

⁹ Tiffany & Co. v. Tiffany Productions Inc., 147 Misc. 679, 264 N.Y. Supp. 459 (1932).

¹⁰ Wall v. Rolls-Royce of America, Inc., 4 F. 2d 333 (C.C.A. 3rd, 1925).

¹¹ France Milling Co. v. Washburn-Crosby Co., 3 F. 2d 321 (S.D. N.Y. 1925).

¹² Borden Ice Cream Co. v. Borden's Condensed Milk Co., 201 Fed. 510 (C.C.A. 7th, 1912).

casioned by the subsequent use of another's trade-mark and it is a consideration of the result of this use and not a consideration of the trade-mark alone nor of the goods alone that solves the problem. The earlier cases held that if this use resulted in an invasion of the original user's rights, relief would be granted.¹³ This is simply another method of stating that if the subsequent user could, by the adoption of another's trade-mark, pass off his goods as those of the latter and thus divert sales and customers of the latter, the goods were of the same descriptive properties and unfair competition would result. The courts in these cases in holding "passing off" to be the fundamental test, were careful to point out that whether the public was likely to be confused as to the source of the goods or not was merely evidence that the original user's rights had been invaded and was not the test.¹⁴ However, the later cases were not limited by this narrow interpretation of "passing off", but were decided on the broader test of whether confusion among the public as to the source of the goods would result.¹⁵ This change is due to the courts' acquiring a different concept of the value of a trade-mark to its first user. The best statement to illustrate this is that of Judge Learned Hand who said:

"However, it has of recent years been recognized that a merchant may have a sufficient economic interest in the use of his mark outside the field of his own exploitation to justify interposition by a court. His mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner's reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is a symbol of its possessor and creator, and another can use it only as a mask."¹⁶

The basis for this increased economic interest of a merchant in his trade-mark is the growth of manufacturing and modern methods of merchandising. The public has become familiar with numerous examples of a variety of products coming from one source and wearing the same trade-mark, and therefore, the subsequent use of another's trade-mark would confuse the public as to the source of the goods. Thus, as shown by the cases *supra*, the scope of protection of the first user of a trade-mark has been widened by using the con-

¹³ *Borden Ice Cream Co. v. Borden's Condensed Milk Co.*, 201 Fed. 510 (C.C.A. 7th, 1912); *American Washboard Co. v. Saginaw Mfg. Co.*, 103 Fed. 281 (C.C.A. 6th, 1900).

¹⁴ *Ibid.*

¹⁵ *Standard Brands v. Smidler*, 151 F. 2d 34 (C.C.A. 2d, 1945); *Philadelphia Storage Battery Co. v. Mindlin*, 163 Misc. 52, 296 N.Y. Supp. 176 (1937).

¹⁶ *Yale Electric Corp. v. Robertson*, 26 F. 2d 972, 974 (C.C.A. 2d, 1928).

fusion as to the source test to determine whether the goods are of the same descriptive properties.

In this connection, it is interesting to note that one writer has concluded that the only rational basis for protection of a trade-mark should be the preservation of its uniqueness, and "that such uniqueness or singularity is vitiated or impaired by its use upon either related or non-related goods."¹⁷ Thus he would do away with the problem of goods of the same descriptive properties as the deciding factor in determining whether unfair competition exists in the use of the same mark by another. However, uniqueness of the trade-mark is only one of the important factors causing confusion among the public as to the source. For a unique trade-mark such as "Skrip" reflects the quality of a single source, whereas a non-unique trade-mark such as "King" or "Crown" is used on many various products. Therefore, the use of a unique trade-mark by a subsequent user would more readily cause confusion as to the source than would the subsequent use of a non-unique trade-mark.

It is submitted that the test as to whether the goods are of the same descriptive properties is whether confusion among the public as to the source of the goods will result, and that uniqueness of the trade-mark itself is an important factor in that it directly affects confusion among the public as to the source of the goods.

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¹⁷ Schecter, *The Rational Basis of Trade-Mark Protection* (1927) 40 HARV. L. R. 813, 831.