

NO MONOPOLY ON MONOPOLY:  
*ANTI-MONOPOLY, INC. v.*  
*GENERAL MILLS FUN GROUP, INC.*

I. INTRODUCTION

The validity of all traditionally secure trademarks of sole producers has been jeopardized by the Ninth Circuit's *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*<sup>1</sup> decision. In *Anti-Monopoly*, the court deviated from the traditional approach courts have taken in deciding whether a registered trademark has taken on generic significance by focusing on the potential consumers' motivation for buying the product, rather than on their perception of the mark's meaning.

This Comment will examine *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*<sup>2</sup>, and the standards and tests that the Ninth Circuit adopted in declaring the Monopoly trademark generic. It will also examine the evidence presented by the parties. This Comment will conclude that both the standard and test adopted by the Ninth Circuit were inappropriate, particularly in a case of a sole producer.

II. TRADEMARK LAW

Trademarks are protected to prevent consumer confusion that would arise if the buying public could not differentiate one product or producer from another<sup>3</sup> and to allow producers to adequately promote their products.<sup>4</sup> In attempting to prevent confusion, federal trademark law<sup>5</sup> provides for the exclusive use of marks for the purpose

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<sup>1</sup> 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, \_\_\_ U.S. \_\_\_, 103 S.Ct. 1234, *reh'g denied*, \_\_\_ U.S. \_\_\_, 103 S.Ct. 1805 (1983), (per Dunaway; the other panel members were Sneed J., and Tashima, A.O., sitting by designation).

<sup>2</sup> This case was initially brought in a California District Court, *Anti-Monopoly v. General Mills Fun Group*, 195 U.S.P.Q. 633 (N.D. Cal. 1977), and was then appealed to the Ninth Circuit, 611 F.2d 296 (9th Cir. 1979), which remanded to the District Court, 515 F. Supp. 448 (N.D. Cal. 1981). The case was appealed to the Ninth Circuit a second time, 684 F.2d 1316 (9th Cir. 1982). On appeal to the United States Supreme Court, certiorari was denied.

<sup>3</sup> S. REP. NO. 1333, 79th Cong., 2d Sess. 3, 5, *reprinted in*, 1946 U.S. CODE CONG. SERV. 1274, 1276. *See also* *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916). *See generally* Weigel, *Generic Names Versus Trademarks*, 52 TRADE-MARK REP. 768, 771 (1962); Note, *The Trademark Confusion Test-Good or Bad; Weak or Strong?* 5 B.C. INDUS. & COM. L. REV. 401 (1964).

<sup>4</sup> *See supra* note 3.

<sup>5</sup> Trademark Act of 1946, § 1-45, 15 U.S.C. §§ 1051-1072, 1091-1096, 1111-1121, 1123-1127 (1982) (The Lanham Act).

of source identification.<sup>6</sup> However, not all marks are entitled to trademark protection. When a mark merely describes the product associated with the mark, trademark status is denied. The exclusive use of a merely descriptive word would prevent competing producers from describing their products,<sup>7</sup> and consumers from identifying competing products.<sup>8</sup> When, however, a merely descriptive mark is associated with a product for an extended period, the association that the buying public makes between the mark and the product might become so strong that the mark no longer describes a type of product but takes on a secondary meaning<sup>9</sup> that denotes a particular product made by

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<sup>6</sup> S. REP. NO. 1333, 79th Cong., 2d Sess., 3 (1946), reprinted in 1946 U.S. CODE CONG. SERV. 1274. See generally Note, *The Trademark Confusion Test-Good or Bad; Weak or Strong?* 5 B.C. INDUS. & COM. L. REV. 401, 407 (1964).

<sup>7</sup> Descriptive words, "convey to the buyer the ingredients, qualities, or characteristics of the product." Educational Dev. Corp. v. Economy Co., 562 F.2d 26, 29 (10th Cir. 1977). Such characteristics of a product include color, odor, function, and dimension. Vision Center v. Opticks, Inc., 596 F.2d 111, 115 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980). American Heritage Life Ins. Co. v. Heritage Life Ins. Co., 494 F.2d 3, 11 (5th Cir. 1979). See Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 378 (7th Cir. 1976), cert. denied, 429 U.S. 830 (1976). See also Aloe Creme Laboratories v. Milsan, Inc., 423 F.2d 845 (5th Cir. 1970), cert. denied, 398 U.S. 928 (1970). When used in their primary sense, descriptive terms cannot be trademarked. 15 U.S.C. § 1052 (e)1 (1982); Field Enters. Ed. Corp. v. Cove Indus., 297 F. Supp. 989 (E.D.N.Y. 1969). Such terms are, "unsuited to the function of marks both because they are poor means of distinguishing one source of services from another and because they are often necessary to the description of all goods or services of a similar nature." M.B.H. Enters. v. WOKY, Inc., 633 F.2d 50, 54 (7th Cir. 1980). If, however, the descriptive term acquires a secondary meaning so that the public identifies the term with the source, the term is valid as a trademark. *Id.* 15 U.S.C. § 1052(f) (1982).

<sup>8</sup> M.B.H. Enters. v. WOKY, Inc., 633 F.2d 50, 55 (7th Cir. 1980). Penn Yan Boats, Inc., v. Sea Lark Boats, Inc., 359 F. Supp. 948 (S.D. Fla. 1972), *aff'd per curiam*, 479 F.2d 1328 (5th Cir. 1973); Riverbank Laboratories v. Hardwood Prods. Corp., 165 F. Supp. 747 (N.D. Ill. 1958). See generally 3R. CALLMAN, UNFAIR COMPETITION TRADEMARKS & MONOPOLIES, § 18.02 (4th ed. 1983).

<sup>9</sup> A descriptive word, through extensive use and advertising, may take on a new or "secondary" meaning which causes the public to primarily associate the product with a source. 15 U.S.C. § 1052(f) (1982). See RESTATEMENT OF TORTS, § 716 comments a,b (1938); Jean Patou, Inc. v. Jacqueline Cochran, Inc., 201 F. Supp. 861 (S.D.N.Y. 1962), *aff'd*, 312 F.2d 125 (2d Cir. 1963); Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co., 199 F.2d 407 (8th Cir. 1952); G. & C. Merriam Co. v. Saalfield Publishing Co., 198 F. 369 (6th Cir. 1912), *aff'd & modified*, 238 F. 1 (6th Cir.), cert. denied, 243 U.S. 65 (1917). See also Aloe Creme Laboratories, Inc. v. Milsan, Inc., 423 F.2d 845 (5th Cir.), cert. denied, 398 U.S. 928 (1970). See generally Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129 (S.D.N.Y. 1972); Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794 (9th Cir. 1970); Sunrise Home Juices, Inc. v. Coca-Cola Co., 220 F. Supp. 558 (S.D.N.Y. 1963). In Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366 (1st Cir. 1980), the court discussed requirements for establishing secondary meaning and acknowledged that, "Although in some cases of cancellation of federal registration the registrant may still be able to establish his common law right to exclusive use, where federal registration has been cancelled because the mark is found to be generic, it is almost impossible to establish the secondary meaning required for common law trademark protection." *Id.* at 376.

a single, but not necessarily identifiable, source.<sup>10</sup> Courts do not require that consumers be able to identify the name of the manufacturer, but merely that they know that the product emanates from a single source.<sup>11</sup>

Consistent with its goal of allowing the exclusive use of a term only when it describes the source of a product, federal trademark law cancels a trademark when the mark has come to identify a type of product rather than a single source.<sup>12</sup> “[A]ny claim to an exclusive right must be denied since this in effect would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell.”<sup>13</sup> When a trademark denotes the type of product rather than its source, courts label it “generic” and cancel its trademark status.<sup>14</sup>

The doctrine of genericness is most frequently invoked when a patented product loses its patent protection.<sup>15</sup> When a product is patented and is only produced by one source, consumers often come to know the product by its tradename.<sup>16</sup> The exclusive use of the name

<sup>10</sup> Bayer Co. v. United Drug Co., 272 F. 505, 509-12 (S.D.N.Y. 1921). See also Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129 (S.D.N.Y. 1972).

<sup>11</sup> Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129 (S.D.N.Y. 1972).

<sup>12</sup> 15 U.S.C. § 1064(c) (1982) provides that cancellation of a trademark may occur if, “at any time . . . the registered mark becomes the common descriptive of an article or substance. . . .”

<sup>13</sup> Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976).

<sup>14</sup> A “generic” name is the name of a class or a member of a class of things. W.E. Bassett Co. v. Revlon, Inc., 435 F.2d 656, 661 (2d Cir. 1970); Henry Heide, Inc. v. George Ziegler, Co., 354 F.2d 574, 576 (7th Cir. 1965). Granting an exclusive right in a generic name could lead to a monopoly in the article and is thus against public policy. Aloe Creme Laboratories, Inc. v. Milsan, Inc., 423 F.2d 845 (5th Cir.). *cert. denied*, 398 U.S. 928, *reh'g denied*, 400 U.S. 856 (1970). For further discussion on this subject, see *infra* notes 76-81 and accompanying text.

<sup>15</sup> Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169 (1896). See also Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938); Dupont Cellophane Co. v. Waxed Prods., 85 F.2d 75 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936), 304 U.S. 575 (1938); Amiesite Asphalt Co. of Am. v. Interstate Amiesite Co., 72 F.2d 946 (3d Cir. 1934). However, it is important to note that the validity of a trademark can be questioned before the patent has expired as well. Dresser Indus. v. Hereaus Engelhard Vacuum, Inc., 267 F. Supp. 963 (W.D. Pa. 1967), *aff'd*, 395 F.2d 457, (3d Cir.), *cert. denied*, 393 U.S. 934 (1968). See generally 1 J. GILSON, TRADEMARK PROTECTION & PRACTICE § 2.02[3] (1983). In *Kellogg*, the court stated that :

It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly. . . .

To say otherwise would be to hold that, although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly.

*Kellogg*, 305 U.S. at 118 (quoting Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 185 (1896)).

<sup>16</sup> American Thermos Prods. v. Aladdin Indus., 207 F. Supp. 9 (D. Conn. 1962) is an example of a manufacturer that tried to prevent this, but did not succeed. In that case, the court noted

by which consumers know the product would therefore prevent competitors from adequately identifying the product to the buying public, and would allow the original patent owner to maintain a monopoly on the product beyond its period of patent protection. In such a circumstance, the trademark is deemed generic and falls into the public domain.<sup>17</sup>

### III. TRADITIONAL GENERICNESS TEST

In 1921, Judge Learned Hand, in *Bayer Co. v. United Drug Co.*,<sup>18</sup> set forth what was to become the commonly accepted standard for determining whether a trademark has become generic.<sup>19</sup> Under this standard, the single question with which a court should be concerned is “merely one of fact: what do the buyers understand by the word for

that: The plaintiff . . . stamped its products with the word “Thermos,” followed by the words “Reg. Tr. Mk.” (“registered trademark”) . . . *Id.* at 16.

Between 1954 and 1957 the plaintiff's activities showed awareness of widespread generic use of “thermos” and of the necessity of doing much more than had been done prior to 1954 to stop such use and educate the public to the word's trademark significance. It planned, and ultimately put into effect, a diversification of products . . . The new plan brought about the manufacture of tents . . . bottle openers and cap catchers, all labeled as “Thermos” brand.

*Id.* at 19. However, these new measures were in vain because the word “thermos” had already fallen into the public domain. *Id.* at 22.

For an example of a trademark that came to be known as a product name, *see also*, *Dupont Cellophane Co. v. Waxed Prods.*, 85 F.2d 75 (2d Cir. 1936), *cert. denied*, 299 U.S. 601 (1936), 304 U.S. 575 (1938).

<sup>17</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938); *Singer Mfg. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896). *See also* *Scott Paper Co. v. Marcalus Co.*, 326 U.S. 249, 255 (1945). *See generally* *Roux Laboratories, Inc v. Clairol, Inc.*, 427 F.2d 823 (C.C.P.A. 1970); *Application of G.D. Searle & Co.*, 360 F.2d 650 (C.C.P.A. 1966); *Application of Preformed Line Prods. Co.*, 323 F.2d 1007 (C.C.P.A. 1963); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961); *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437 (C.C.P.A. 1960).

<sup>18</sup> 272 F. 505 (S.D.N.Y. 1921). In *Bayer*, the term “aspirin” was found to be a generic because, under the test set forth by the court, people understood the term as merely denoting the product rather than the source. The term was found to be the only word that people used to describe the product.

<sup>19</sup> For definition of “generic,” *see infra* notes 22, 76-81 and accompanying text. *See also* *Dresser Indus. v. Heraeus Engelhard Vacuum, Inc.*, 395 F.2d 457,463 (3d Cir.), *cert. denied*, 393 U.S. 934 (1968). *Coca-Cola Co. v. Snow Crest Beverages*, 162 F.2d 280 (1st Cir. 1947), *cert. denied*, 332 U.S. 809 (1947); *Dupont Cellophane Co. v. Waxed Prods.*, 85 F.2d 75, 81 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936); *Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F. Supp. 692, 697-98 (D.N.J. 1982); *WSM, Inc. v. Hilton*, 545 F. Supp. 1212, 1218 (W.D.Mo. 1982); *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (1950). *But cf.* *Surgicenters of Am. v. Medical Dental Surgeries*, 601 F.2d 1011,1016 (9th Cir. 1979) (This court interpreted *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) as merely sharpening the test introduced in *Bayer Co. v. United Drug Co.*, 272 F. 505,509 (S.D.N.Y. 1921).).

whose use the parties are contending."<sup>20</sup> Courts have developed a genus-species dichotomy test for determining how consumers view the particular word.<sup>21</sup> If the buying public perceives the mark as genus descriptive, denoting a general type of merchandise,<sup>22</sup> then the mark is generic and subject to cancellation. However, if the mark is perceived as species descriptive, denoting a particular item manufactured by a single source, then the mark is entitled to continued trademark status.<sup>23</sup>

#### IV. ANTI-MONOPOLY, INC. v. GENERAL MILLS FUN GROUP, INC.

##### A. *Anti-Monopoly I*

In reaching its decision that Monopoly was species rather than genus descriptive, the district court, construing the traditional genus-species dichotomy test,<sup>24</sup> relied on the results of consumer surveys which showed that Monopoly was perceived as being a unique real estate game manufactured by a single source.<sup>25</sup> The Ninth Circuit, in *Anti-Monopoly I*,<sup>26</sup> reversed the trial court, holding that the results of the consumer survey were insufficient to prove that the Monopoly mark was species, not genus descriptive.<sup>27</sup> According to the court, in order to prove that a mark is either genus or species descriptive, a determination of the buying public's motives for purchasing Monopoly must be made.<sup>28</sup> If consumers are motivated to purchase Monopoly by source-irrelevant characteristics, such as the length of time it takes to play the game or the strategy involved, rather than by source-relevant characteristics, such as the quality of the product, then the mark is genus descriptive and therefore invalid. But if the motivation is source-relevant, the word is species descriptive and may retain its trademark status.<sup>29</sup> The court found that the inquiry made by the district court failed to distinguish between source-relevant and source-irrelevant characteristics, and remanded the case for that determination to be made.<sup>30</sup>

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<sup>20</sup> *Bayer*, 272 F. at 509.

<sup>21</sup> *See Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (citing *Vision Center v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016 (1980)); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976).

<sup>22</sup> A generic term specifies a "type," or "genus," of things, "into which common linguistic usage consigns that product." *Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901, 905 (7th Cir. 1983).

<sup>23</sup> *Anti-Monopoly*, 611 F.2d at 301.

<sup>24</sup> *Anti-Monopoly*, 195 U.S.P.Q. at 637,638.

<sup>25</sup> *Id.* at 638.

<sup>26</sup> *Anti-Monopoly*, 611 F.2d at 306.

<sup>27</sup> The circuit court reversed the lower court in *Anti-Monopoly*, 611 F.2d at 305-06.

<sup>28</sup> *Id.* *See also Anti-Monopoly*, 684 F.2d at 1324-26.

<sup>29</sup> The difference between "source-relevant" and "source-irrelevant" terms is discussed in *Anti-Monopoly*, 684 F.2d at 1325-26. *See also Anti-Monopoly*, 611 F.2d at 305-06.

<sup>30</sup> *Anti-Monopoly*, 611 F.2d at 306.

### B. *Anti-Monopoly II*

On remand, the district court reconsidered whether the Monopoly trademark had become generic and once again upheld its validity.<sup>31</sup> Although the circuit court, in *Anti-Monopoly I*, directed the trial court to consider the buying public's motivation for purchasing Monopoly, the district court applied a variation on the traditional test and stated that motivation is not relevant in a trademark validation inquiry involving a sole producer.<sup>32</sup>

### C. *Anti-Monopoly III*

On appeal from *Anti-Monopoly II*, the circuit court again reversed the district court holding that the Monopoly trademark had become generic.<sup>33</sup> The court rejected much of the survey evidence introduced by General Mills, which supported Monopoly's continued validity, on the ground that it failed to adequately address the question of whether consumers purchase Monopoly for source-relevant or source-irrelevant reasons.<sup>34</sup> The case was remanded with express directions for the district court to declare the Monopoly trademark generic.<sup>35</sup>

## V. ANALYSIS OF GENERICNESS STANDARD

In a break from the traditional genus-species dichotomy test, the Ninth Circuit held that a court must distinguish between consumers' source-relevant and source-irrelevant motives for purchasing Monopoly in order to determine whether the registered trademark has acquired a generic meaning. In adopting this test, the court relied on the 1938 Supreme Court decision, *Kellogg Co. v. National Biscuit Co.*<sup>36</sup> In *Kellogg*, the Kellogg Company produced a cereal identical to National's once-patented "Shredded Wheat,"<sup>37</sup> which it also called Shredded Wheat. National sought to prevent this nomenclature.<sup>38</sup> Kellogg claimed that shredded wheat had become generic and should not receive trademark protection.<sup>39</sup> The Supreme Court held that in order for Na-

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<sup>31</sup> *Anti-Monopoly*, 515 F. Supp. at 451-52, 455.

<sup>32</sup> The district court regarded the motivation test as inapplicable in the case of a sole producer. *Id.* at 453-55.

<sup>33</sup> *Anti-Monopoly*, 684 F.2d at 1326.

<sup>34</sup> The Ninth Circuit rejected the survey evidence. *Id.* at 1323-26.

<sup>35</sup> *Id.*

<sup>36</sup> 305 U.S. 111 (1938).

<sup>37</sup> *Id.* at 113-114.

<sup>38</sup> *Id.* at 113.

<sup>39</sup> *Id.* at 116.

tional to have the exclusive right to use the term Shredded Wheat, it must show that "the primary significance of the term in the minds of the consuming public is not the product but the producer."<sup>40</sup>

The Ninth Circuit's reliance on *Kellogg* is misplaced for two reasons. First, *Kellogg* concerned a party attempting to establish secondary meaning for its mark, while *Anti-Monopoly* concerned a challenge to a valid trademark.<sup>42</sup> This resulted in the Ninth Circuit's application of an incorrect standard for determining genericness and its placement of the burden of proof on the owner of the trademark.<sup>43</sup> Second, in *Kellogg*, the products being promoted under the name Shredded Wheat were identical, while the products in *Anti-Monopoly* were only similar.

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<sup>40</sup> *Id.* at 118.

<sup>41</sup> See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938). For cases citing *Kellogg* as a case concerning secondary meaning, see *Wesley Jessen Division of Schering Corp. v. Bausch & Lomb, Inc.*, 698 F.2d 862 (1983); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (1983) (citing *American Heritage Life Ins., Inc. v. Heritage Life Ins. Co.*, 494 F.2d 3, 12 (5th Cir. 1974) and *Vision Center v. Opticks, Inc.* 596 F.2d 111, 118 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016 (1980)); *Walt-West Enters. v. Gannett Co.*, 695 F.2d 1050, 1057-58 (7th Cir. 1982); *American Scientific Chemical Inc., v. American Hosp. Supply*, 690 F.2d 791 (9th Cir. 1982); *Chevron Chemical Co. v. Voluntary Purchasing Groups*, 659 F.2d 695 (5th Cir. 1981); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5,8 (1st Cir. 1981) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976)); *President & Trustees of Colby College v. Colby College-N.H.*, 508 F.2d 804 (1st Cir. 1975); *Application of Honeywell, Inc.*, 497 F.2d 1344, 1349 (C.C.P.A. 1974); *W.E. Bassett v. Revlon, Inc.*, 435 F.2d 656 (2d Cir. 1970); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794 (9th Cir. 1970); *National Nu Grape Co. v. Guest*, 164 F.2d 874, 876 (10th Cir. 1947); *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429 (7th Cir. 1943); *American Fork & Hoe Co. v. Stampit Corp.*, 125 F.2d 473, 475 (6th Cir. 1942); *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 119 F.2d 316,322 (6th Cir. 1941); *W.L.W.C. Centers, Inc. v. Winners Corp.*, 563 F. Supp. 717, 723 (M.D. Tenn. 1983); *L.F. Gaubert & Co. v. Institute of Elec. & Elec. Eng'rs., Inc.*, 563 F. Supp. 123, 127 (E.D. La. 1983); *Union Carbide Corp. v. Ever-Ready, Inc.*, 392 F. Supp. 280 (N.D. Ill. 1975); *Exquisite Form Indus. v. Exquisite Fabrics of London*, 378 F. Supp. 403 (S.D.N.Y. 1974); *Hamm v. Knocke*, 374 F. Supp. 1183 (E.D. Cal. 1973). See generally *National Auto. Club v. National Auto. Club, Inc.*, 365 F. Supp. 879,885 (S.D.N.Y. 1973) (*Kellogg's* secondary meaning test was implemented to examine whether a mark would have been trademarked initially); *Redken Laboratories v. Clairol, Inc.*, 350 F. Supp. 1301 (C.D. Cal. 1972) (The *Kellogg's* secondary meaning test was implemented for the restoration of a mark.). But see *Inwood Laboratories v. Ives Laboratories*, 456 U.S. 844, 851 (1982); *Skinner Mfg. Co. v. Kelloggs Sales Co.*, 143 F.2d 895 (8th Cir. 1944) (*Kellogg's* secondary meaning test was implemented in trademark infringement cases).

<sup>42</sup> The court found that the term Monopoly was not the generic or common descriptive of an article or substance upon registration as a trademark and stated that:

Plaintiff introduced uncontested testimony at trial that, prior to Parker Brother's acquisition and manufacturer [sic], a real estate trading game was played in various parts of the country and that it was sometimes called "Monopoly!" This, however, is insufficient to prove that the term was the common descriptive name of all real estate games.

*Anti-Monopoly*, 195 U.S.P.Q. at 638.

<sup>43</sup> See *infra* note 55.

This resulted in the application of the doctrine of genericness to a circumstance in which it should logically not apply.<sup>44</sup>

### A. *Appropriate Standard*

In support of its decision to apply the *Kellogg* standard, the Ninth Circuit cited five cases where the primary significance standard was used. However, two of these cases, *Nissen Trampoline Co. v. American Trampoline Co.*,<sup>45</sup> and *Donald F. Duncan, Inc. v. Royal Toy Mfg. Co.*,<sup>46</sup> were secondary meaning cases. The other three, *King-Seely Thermos Co. v. Aladdin Indus.*,<sup>47</sup> *Feathercomb Inc. v. Solo Prods.*<sup>48</sup> and *Helene Curtis Indus. v. Church & Dwight Co.*,<sup>49</sup> dealt with validation inquiries which require standards far different than that proposed by the Ninth Circuit in *Anti-Monopoly I* and *III*.

In *King-Seely*, the owners of the "Thermos" trademark sought to prevent Aladdin Industries from infringing its mark.<sup>50</sup> In its defense, Aladdin claimed that the term Thermos had become generic.<sup>51</sup> The *King-Seeley* court adopted a standard set forth in *Feathercomb* for determining whether a registered trademark had become generic:

[A] mark is not generic merely because it has *some* significance to the public as an indication of the nature or class of an article. . . . In order to become generic the *principal* significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.<sup>52</sup>

The *King-Seeley* court acknowledged the existence of an even higher standard requiring the challenger to meet a very heavy burden of proof. "[A] defendant alleging invalidity of a trademark for genericness must show that to the *consuming public as a whole* the work has lost all its trademark significance."<sup>53</sup>

<sup>44</sup> See *infra* note 64.

<sup>45</sup> *Nissen Trampoline Co. v. American Trampoline Co.*, 193 F. Supp. 745, 748-49 (S.D. Iowa 1961).

<sup>46</sup> *Donald F. Duncan, Inc. v. Royal Toys Mfg. Co.*, 343 F.2d 655, 666 (7th Cir. 1965).

<sup>47</sup> *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 580 (2d Cir. 1963).

<sup>48</sup> *Feathercombs, Inc. v. Solo Prods.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962).

<sup>49</sup> *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977) (*en banc*), *cert. denied*, 434 U.S. 1070 (1978).

<sup>50</sup> *King-Seeley*, 321 F.2d at 581.

<sup>51</sup> *Id.* at 580.

<sup>52</sup> *Id.* Where the court cites *Feathercombs*, 306 F.2d at 256 (citing, *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494 (2d Cir. 1962)); *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143 (1920); *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U.S. 537 (1891).

<sup>53</sup> *Marks v. Polaroid Corp.*, 129 F. Supp. 243, 270 (D. Mass. 1955), *aff'd*, 237 F.2d 428 (1st Cir. 1956), *cert. denied*, 352 U.S. 1005 (1957).



The most widely adopted standard is that of "principal significance."<sup>54</sup> Under this standard, courts require a challenger to show that a registered trademark's principal significance has become product rather than source descriptive because a trademark which retains some of its source significance will protect the consuming public from confusion. Additionally, its exclusive use will not hamper competitors' ability to describe their product because it is not primarily associated with a product.

The Ninth Circuit, however, did not adopt either of these standards. Instead of requiring the challenger to prove that the mark's principal, if not only, significance is product descriptive, the court required the trademark owner to prove that the primary significance of the mark is source descriptive. Requirements as to both the placement of the burden of proof and the standard used, are completely different from the ones adopted by the very cases the court cites and by the majority of cases dealing with genericness inquiries as well.<sup>55</sup>

### B. *Burden of Proof*

Although it is appropriate to require a trademark owner to prove that a mark's primary significance is source descriptive when determining whether a merely descriptive term has acquired secondary meaning,<sup>56</sup> it is not appropriate when determining whether a presumptively valid trademark has taken on generic significance. When a prospective registrant is attempting to prove that his merely descriptive mark has acquired secondary meaning, he has the burden of proving that the primary significance consumers place on the mark is source descriptive.<sup>57</sup> Courts require such a heavy burden because the exclusive use of a term that has been used to describe a type of product is likely to cause consumer confusion.

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<sup>54</sup> To prove the invalidity of a trademark, it is necessary to show that the "primary significance to the public of the work is its indication of the nature and class of an article rather than as an indication of its source." *King-Seeley*, 321 F.2d at 581. See also *McGregor-Doniger Inc. v. Drizzle Inc.*, 590 F.2d 1126, 1131 (2d Cir. 1979); *Helene Curtis Indus. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977); *Stix Prods v. United Merchants & Mfrs.*, 295 F. Supp. 479, 490 (S.D.N.Y. 1968); *Thomas Pride Mills, Inc. v. Monsanto Co.*, 155 U.S.P.Q. 205 (N.D. Ga. 1967). See generally 1 J. GILSON, TRADEMARK PROTECTION & PRACTICE § 2.02(1)(1983).

<sup>55</sup> *Id.*

<sup>56</sup> Since, by definition, secondary meaning can only attach to terms which are mere descriptives and are, therefore, initially ineligible for acquiring trademark status, the burden of proof is substantially higher than in cases of initially valid terms. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

<sup>57</sup> *Id.*

When a registered trademark is challenged as being generic, there is a presumption that the mark is valid, thus requiring the challenger to meet the burden of proof. This presumption arises under section 1057 (b) of the Lanham Act, which states that,

A certificate of registration of a mark upon the principal register . . . shall be prima facie evidence of the validity of the registration, mark, and of registrant's ownership of the exclusive right to use the mark in connection with the goods or services specified in the certificate. . . .<sup>58</sup>

By relying on *Kellogg*, the Ninth Circuit destroyed the presumption of validity granted to owners of registered marks.<sup>59</sup> Once General Mills was required to prove primary significance through the motivation test, the burden of proof shifted from Anti-Monopoly to General Mills, thus making it extremely difficult for a sole producer's mark to retain trademark protection.

### C. Sole Producer

Requiring a party to establish that a trademark is generic, rather than species descriptive, in the case of a sole producer of a unique item is inappropriate in itself.<sup>60</sup> The usual generic inquiry arises when a manufacturer cannot describe a product because the word that must be used to describe it is being monopolized under trademark protection.<sup>61</sup> For example, "Yo-Yo"<sup>62</sup> and "Parcheesi"<sup>63</sup> were originally

<sup>58</sup> 15 U.S.C. § 1057(b) (1982). For cases interpreting this section, see *E.I. Dupont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 523 n. 45 (E.D.N.Y. 1975) ("burden of proof in rebutting the presumption of the validity of the plaintiff's trade-mark . . . which arises from its registration as a trade-mark with the United States Patent Office insofar as it is presumed not to be a descriptive or generic term. . . .") quoting, *American Thermos Prods. v. Aladdin Indus.*, 207 F. Supp. 9, 14 (D. Conn. 1962), *aff'd sub nom.*, *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963); *Dan Robbins & Assoc., Inc. v. Questor Corp.*, 599 F.2d 1009, 1013-14 (C.C.P.A. 1979) ("Under Section 7(b) of the Act, 15 U.S.C. §1057(b), registrations are presumed valid. One seeking cancellation must rebut that presumption by a preponderance of evidence."). See also *Surgicenters of Am., Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011 (9th Cir. 1979) (The court approved of the district court's recognition that a "properly registered service mark is presumed to be valid." *Id.* at 1014.).

<sup>59</sup> Reliance upon the *Kellogg* case was especially anomalous since the decision rested upon common law trademark principles. The common law standard permitted for a presumption against validity upon the expiration of a patent. It was presumed that during the patent monopoly, when the product had no competition or was dominant, the public would tend to use the mark as a generic name. See generally 1 J. GILSON, *TRADEMARK PROTECTION & PRACTICE* § 2.02[3] (Rel. 9, 1983).

<sup>60</sup> See *Anti-Monopoly*, 515 F. Supp. at 453.

<sup>61</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976). For more cases on this point, see generally *Application of Searle & Co.*, 360 F.2d 650 (C.C.P.A. 1966); *Application of Preformed Line Products Co.*, 323 F.2d 1007 (C.C.P.A. 1963); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961).

trademarks that were held to be generic terms and lost their protected status. If the product that the challenger is promoting is not identical to the product known by the trademark being challenged, then the rationale for the doctrine of genericness, which prohibits a manufacturer from retaining a monopoly on a term that has come to describe a product,<sup>64</sup> is not applicable.

The products Anti-Monopoly and Monopoly are not identical, they are merely similar.<sup>65</sup> That there was no necessity to name the challenger's game Anti-Monopoly is demonstrated by the fact that Anti-Monopoly was originally called "Bust the Trust."<sup>66</sup> Unlike shredded wheat, for example, it was possible to market the new game under a name that would not require the cancellation of the Monopoly trademark, thus illustrating the impropriety of cancelling the Monopoly trademark on the ground that it is generic.<sup>67</sup>

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<sup>62</sup> Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655 (7th Cir. 1955).

<sup>63</sup> Selchow v. Chaffee & Selchow Mfg. Co., 132 F. 996 (S.D.N.Y. 1904), *appeal dismissed*, 140 F. 989 (2d Cir. 1905).

<sup>64</sup> A generic term is not entitled to trademark status because the word or term does not indicate anything in the nature of origin, manufacture or ownership of an article and may with equal truth and right be employed by others for the same purpose. Annot., 55 A.L.R. FED. 243 (1981); *see* Elgin National Watch Co. v. Illinois Watch Case Co., 179 U.S. 665, 673 (1901). *Smith v. Chanel, Inc.* 402 F.2d 562,566-69(9th Cir. 1968); *see Abercrombie*, 537 F.2d at 10. In addition, the exclusive use of a generic term prevents competitors and potential competitors from describing their products by using a word that consumers believe represents the product. *Abercrombie*, 537 F.2d at 9; *Bayer Co. v. United Drug Co.*, 272 F. 505, 513-14 (S.D.N.Y. 1921); *see Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116-18 (1938)

*See also Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8,11(9th Cir.), *cert. denied*, 400 U.S. 916 (1970); Comment, *Section 14 of the Lanham Act-FTC Authority to Challenge Generic Trademarks*, 48 FORDHAM L. REV. 437,442(1980); *Smith*, 402 F.2d at 567.

<sup>65</sup> Anti-Monopoly, "bears remarkable similarities to Monopoly in terms of box size, lettering, board configuration and design." *Anti-Monopoly*, 515 F. Supp. at 450. However, the game rules emphasize the values of private enterprise in general and punish the monopolist, whereas Monopoly merely concentrates on real estate and rewards the monopolist. In other words, although the games may initially confuse consumers by appearing to be similar in both design and name, they are not actually similar games. Hence, the only game with rules like the rules of Monopoly is Parker Brothers' Monopoly. The only other game that could arguably be regarded as similar in nature to Monopoly is Finance; however, that game does not raise this issue because it is also produced by Parker Brothers. Yet, even if it were made by another company, it still might not infringe upon Monopoly's trademark. It is permissible to manufacture identical products (after the expiration of the original product's patent) as long as the names of such products are not the same—thus avoiding any consumer confusion of sources. *See Note, Trade-Marks and Trade-Names and Unfair Competition—Conscious Imitation of Competitor's Product Held Grounds for Trade-Mark Infringement*, 39 TEX. L. REV. 529 (1961).

<sup>66</sup> *Anti-Monopoly*, 515 F. Supp. at 450.

<sup>67</sup> *Id.*

## VI. ANALYSIS OF TEST

A. *Secondary Meaning Test*

The Ninth Circuit, in *Anti-Monopoly I* and *III*, inappropriately applied a standard commonly used in determining whether a merely descriptive term had acquired secondary meaning to a genericness inquiry.<sup>68</sup> In addition, the Ninth Circuit modified the secondary meaning standard, which requires the prospective registrant to show that the primary significance consumers place on his mark is source related,<sup>69</sup> by requiring General Mills to show that the buying public's primary motivation for purchasing the product was source-related.<sup>70</sup>

A new test had to be devised to implement this unconventional standard, since the traditional genericness test, which simply asks consumers if they know that the product emanates from a single source,<sup>71</sup> is inadequate to determine consumer motivation. The court construed *Kellogg*<sup>72</sup> as mandating courts to distinguish between a product's source-relevant and source-irrelevant characteristics and then to determine which characteristics motivated consumers to purchase the product.<sup>73</sup> If consumers replied that they would buy Monopoly because of its source-relevant characteristics, such as product quality, then Monopoly would be entitled to retain its trademark status. The court's rationale was that consumers would be motivated to purchase Monopoly because of the association they made between the product and its producer.<sup>74</sup> If, on the other hand, consumers replied that they would purchase Monopoly because of its source-irrelevant characteristics, such as the rules of the game, then Monopoly would be deemed generic and lose its trademark status. Here the court's rationale was that consumers would be primarily motivated to purchase a monopoly game, not Monopoly as produced by General Mills.<sup>75</sup> In such a case, the consumers' perception of the Monopoly mark would be genus descriptive.

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<sup>68</sup> See *supra* note 41.

<sup>69</sup> The secondary meaning standard was enunciated in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938). See also, *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977) (en banc), *cert. denied*, 434 U.S. 1070 (1978); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 580 (2d Cir. 1963); *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962).

<sup>70</sup> *Anti-Monopoly*, 684 F.2d at 1324-26; *Anti-Monopoly*, 611 F.2d at 305-06.

<sup>71</sup> *Bayer*, 272 F. at 509.

<sup>72</sup> 305 U.S. 111 (1938).

<sup>73</sup> *Anti-Monopoly*, 611 F.2d 302-06.

<sup>74</sup> *Anti-Monopoly*, 684 F.2d at 1324-26; *Anti-Monopoly*, 611 F.2d at 305-06.

<sup>75</sup> See *Anti-Monopoly*, 684 F.2d at 1324-25; *Anti-Monopoly*, 611 F.2d at 305-06.

### B. Genus

A genus is a type of product,<sup>76</sup> as opposed to a species, which is a particular brand of the genus.<sup>77</sup> In determining whether a work has taken on generic significance, the genus of the mark must be ascertained.<sup>78</sup> The definition of the genus to which a mark belongs is crucial, since a mark that describes a genus, rather than a species, is generic and will lose its trademark status.<sup>79</sup>

In traditional genericness inquiries, the genus to which the challenged mark belongs is defined before consumer surveys are taken.<sup>80</sup> Evidence is then introduced to determine whether the trademark is commonly used to describe the genus or the species.<sup>81</sup> In *Anti-Monopoly*,

<sup>76</sup> A generic term specifies the "type" or "genus" of things into which "common linguistic usage consigns that product." *Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901, 905 (7th Cir. 1983). See *Surgicenters of Am. v. Medical Dental Surgeries*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975); *R. Guastavino Co. v. Comerma*, 180 F. 920, 921 (2d Cir. 1910); *Bayer Co. v. United Drug Co.*, 272 F. 505, 513 (S.D.N.Y. 1921). See also *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980); *Vision Center v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016 (1980). *S.S. Kresge Co. v. United Factory Outlet, Inc.*, 598 F.2d 694, 696 (1st Cir. 1979). See generally 1 J. MCARTHY, TRADEMARKS & UNFAIR COMPETITION § 12:2 (1973).

<sup>77</sup> A brand-name item is a particular "species" of a type (or genus) of that product. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976); *Bayer Co. v. United Drug Co.*, 272 F.2d 505,513(S.D.N.Y. 1920); *R. Guastavino Co. v. Comerma*, 180 F. 920, 921 (2d Cir. 1910). See also *Reese Publishing Co. v. Hampton Int'l Co. Inc.*, 620 F.2d 7, 10 (2d Cir. 1980); *Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F.Supp. 1189,1196 (E.D.N.Y. 1983); *Boden Prods. v. Dori Foods Corp.*, 552 F.Supp. 493, 495 (N.D. Ill, E.D. 1982); *E.R. Squibb & Sons, Inc. v. Cooper Laboratories*, 536 F. Supp. 523, 527 (S.D.N.Y. 1982); *Car-Freshner Corp. v. Auto Aid Mfg. Corp.*, 461 F. Supp. 1055, 1058-59 (N.D.N.Y. 1978).

<sup>78</sup> "To allow trademark protection for generic terms, i.e., names which describe the genus [or type] of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *Eastern Air Lines v. New York Air Lines*, 559 F. Supp. 1270, 1276 (S.D.N.Y. 1983) (quoting *CES Pub. Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975)). See also *Application of G.D. Searle & Co.*, 360 F.2d 650 (C.C.P.A. 1966); *Application of Preformed Line Prods.*, 323 F.2d 1007 (C.C.P.A. 1963); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961); *Application of Deister Concentrator Co.*, 289 F.2d 496 (C.C.P.A. 1961); *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437 (C.C.P.A. 1960).

<sup>79</sup> Generic words do not warrant trademark protection because "[t]he Lanham Act provides that registration on the Principal and Supplemental Register is available only to marks capable of distinguishing applicant's goods. 15 U.S.C. §§ 1052,1091 (1982). A generic term by definition is not capable of distinguishing the goods from any particular source." *Loctite Corp. v. National Starch & Chemical Corp.*, 516 F. Supp. 190, 214 (S.D.N.Y. 1981).

<sup>80</sup> See, e.g. *Feathercombs, Inc. v. Solo Prods.*, 306 F.2d 251 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962); *Dupont Cellophane Co. v. Waxed Prods.*, 85 F.2d 75 (2d Cir. 1936); *American Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9 (D. Conn. 1962), *aff'd sub nom.*, *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963); *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

<sup>81</sup> Permissible, although not conclusive, evidence of generic status includes: testimony from members of the purchasing public, dictionary definitions, and consumer survey evidence. Thomas

the Ninth Circuit deviated from this procedure, by advocating an approach whereby the relevant genus would follow from the determination of consumers' source-relevant and source-irrelevant motives for purchasing the product.<sup>82</sup>

To illustrate its position, the Ninth Circuit entertained two hypothetical cases concerning a game called *En Passant*, which is manufactured by Chessco.<sup>83</sup> In the first scenario, the court stipulated that *En Passant* was a chess game identical to any other chess game. In such a case, if a consumer requested *En Passant*, it could be inferred that he wanted the species of chess game produced by Chessco. The court reasoned that since the genus "chess" is known to the consumer, his motivation for purchasing the product *En Passant* must be source-relevant. If it were otherwise, he would merely have requested a chess game. In the second scenario, the facts were slightly altered. *En Passant* was no longer identical to all other chess games, but was similar to them. *En Passant* had eighty-one squares, in contrast to the standard sixty-four square chess game. In these circumstances, the court found that it could no longer be inferred that the consumer requesting *En Passant* was using the term to describe source-relevant characteristics. In this instance, it was equally possible that the consumer was concerned with source-irrelevant characteristics such as durability, style or price.<sup>84</sup> The court then surmised that if a consumer purchased *En Passant* because of source-irrelevant characteristics, *En Passant* would be a genus in and of itself and not a species.<sup>85</sup>

In applying this method, the Ninth Circuit rejected the genus proposed by the district court, which was "all real estate games."<sup>86</sup> Instead, the court, examining the results of the consumer surveys, defined the genus as "all board games played by the rules of *Monopoly*."<sup>87</sup>

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*Pride Mills, Inc. v. Monsanto Co.*, 155 U.S.P.Q. 205 (N.D. Ga. 1967) held that consumer testimony and the understanding of the public far outweighs the value of expert testimony. *Nix v. Hedden*, 149 U.S. 304 (1893) and *Hancock v. The American Steel & Wire Co. of N.J.*, 203 F.2d 237 (C.C.P.A. 1953) upheld the use of dictionary definitions as admissible evidence. *But see Frederick Gash, Inc. v. Mayo Clinic*, 461 F.2d 1393 (C.C.P.A. 1972) Consumer Surveys were used in *American Thermos Prods. v. Aladdin Indus.*, 207 F. Supp. 9 (D. Conn. 1962), *aff'd sub nom.*, *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963), and *Feathercombs Inc. v. Solo Prods.*, 196 F. Supp. 299, *modified*, 306 F.2d 251 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962). However, they were rejected in *Dresser Indus., v. Hareaus Engelhard Vacuum, Inc.*, 267 F. Supp. 963 (W.D. Pa. 1967), *aff'd*, 395 F.2d 457 (3d Cir. 1968), *cert. denied*, 393 U.S. 934 (1968).

<sup>82</sup> *Anti-Monopoly*, 684 F.2d at 1324; *Anti-Monopoly*, 611 F.2d at 305-06.

<sup>83</sup> *Anti-Monopoly*, 611 F.2d at 303-04.

<sup>84</sup> *Id.* at 303.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.* at 305. *See also Anti-Monopoly* 195 U.S.P.Q. at 638.

<sup>87</sup> *Anti-Monopoly*, 611 F.2d at 305.

The application of this method is, however, inappropriate when the challenged trademark represents a sole producer.

Usually, a product such as a deck of cards or a chess game is manufactured by many sources, giving consumers an opportunity to choose one brand of the product over another based on its source-relevant characteristics. However, in the case of a product produced by only one source, consumers, if they want the product, must buy it from the single source based on its source-irrelevant characteristics.<sup>88</sup>

Under the traditional test, which asks whether the consumer knows that the product is made by a single source, products made by a single producer would be entitled to retain trademark protection, as consumers undoubtedly know that the product emanates from a single source. The new motivation test proposed by the Ninth Circuit would invalidate many trademarks owned by sole producers because consumers are motivated to purchase the products because they like them, not because of loyalty to the producers.

## VII. ANALYSIS OF SURVEYS

In determining whether the Monopoly mark was generic, the Ninth Circuit relied upon survey evidence introduced by the parties. Four surveys in support of their individual claims were presented: Thermos, Brand Name, Motivation, and Tide surveys. In cancelling the Monopoly mark the court relied upon the results of the Thermos and Motivation surveys.

In the Thermos survey,<sup>89</sup> consumers were asked if they were familiar with a real estate board game.<sup>90</sup> About fifty-three percent answered affirmatively and were then asked which game they would request in a store. Approximately eighty percent said that they would ask for the product Monopoly as opposed to "a game made by Parker Brothers."<sup>91</sup> Utilizing this survey, the court held that Monopoly was generic.

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<sup>88</sup> As noted by the district court, the test proposed by the Ninth Circuit necessarily required the consumer to make a comparison between the product in question and other products. However, in the case of a sole producer there is no other product to which the one in question can be compared. *Anti-Monopoly*, 515 F. Supp. at 453.

<sup>89</sup> *Id.* The "Thermos" survey was based on the test used in *King-Seeley Thermos Co. v. Aladdin Indus.*, 207 F. Supp. 9, 20-21 (D. Conn. 1962), *aff'd*, 321 F.2d 577 (2d Cir. 1963). The court held that "Thermos" was determined to be a generic term. The capitalized first letter of the word gave it a distinctive character and was recognized by the public as a particular product from a specific source.

<sup>90</sup> *Anti-Monopoly*, 684 F.2d at 1323.

<sup>91</sup> General Mills Fun Group, Inc. is the successor in interest to Parker Brothers who acquired all the rights to Monopoly and patented the game in 1935. *Id.* at 1318.

In the Brand Name survey,<sup>92</sup> consumers were asked whether they thought Monopoly was a brand name like "Chevrolet," which is manufactured by a sole producer, or if the term Monopoly was a common descriptive term like "automobile." The results of this survey showed that sixty-three percent of those polled recognized Monopoly as a brand name.<sup>93</sup> If Monopoly is understood by the public to be a brand name, then the significance which consumers attach to it is that of a unique product made by a particular company. For example, if a person buys brand X, he expects it to be brand X made by company X, its sole producer. Stipulating that a product name is considered to be a brand name implies a consumer's association of a product with a particular source.

In the Motivation survey, consumers were asked whether they were familiar with Monopoly, the business board game produced by Parker Brothers, and if they had purchased Monopoly within the last few years, or would do so in the near future. Those consumers who had purchased the game in the past were then asked why they bought it. Only fourteen percent mentioned source-relevant motives for making this purchase. Based on these results, the court declared Monopoly to be a generic term.<sup>94</sup>

General Mills introduced a survey, which they called the Tide survey, in order to prove the "*reductio ad absurdum* of the Motivation survey."<sup>95</sup> Under this survey, consumers were asked to supply a reason for purchasing Tide. Sixty percent of those who responded that they would buy Tide, said that they would do so because they felt that Tide is an effective product. When asked "Would you buy Tide primarily because you like Procter and Gamble's products or primarily because you like Tide detergent," about sixty-eight percent indicated the latter.<sup>96</sup> Thus, the Tide survey results lead to the conclusion that under the motivation test, even a strong trademark like Tide would be generic. According to the Ninth Circuit, the results of the Tide survey indicate that the general public regards Tide as the name of a particular detergent having particular qualities and not as a source descriptive term. The court acknowledged that this result might give Procter and Gamble "cause for alarm."<sup>97</sup>

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<sup>92</sup> This survey was based upon a survey approved by a district court in the "Teflon" case, *E.I. Dupont de Nemours & Co. v. Yoshida Int'l., Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975).

<sup>93</sup> *Anti-Monopoly*, 684 F.2d at 1321; *Anti-Monopoly*, 515 F. Supp. at 454-55.

<sup>94</sup> *Anti-Monopoly*, 684 F.2d at 1326.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*



Under the traditional standards, all of the surveys would have resulted in a finding of validity since they all illustrate that consumers are aware that the product is manufactured by a single source.

Even if the standard enunciated by the district court had been the correct standard, this case illustrates the problems inherent in utilizing survey evidence. As indicated by the court in *Anti-Monopoly II*, the Motivation survey was fraught with serious methodological flaws.<sup>98</sup> For instance, the survey questions were designed by the inventor of *Anti-Monopoly*, Dr. Anspach.<sup>99</sup> While the circuit court acknowledged this fact, it nonetheless dismissed the objection as lacking in merit. This, however, is contrary to the accepted practice in the field of social science research. An investigator's inherent bias is a basis for invalidating sociological studies.<sup>100</sup> Furthermore, the circuit court failed to address the criticism by the district court, that the form of the questions themselves appeared to be designed to elicit a response which would exclude reference to the products source. The first question in this survey states "that Monopoly is a 'business board game produced by Parker Brothers'."<sup>101</sup> Consumers are not likely to include in a response a fact which the interviewer has previously asked him to assume. For example, if the subject is asked, as he was in this survey, how he would request this game if he were purchasing it, he is not likely to respond that he likes the producer's products, as it was already stipulated that Parker Brothers is the producer. The above inadequacies indicate that at a minimum, a court, before accepting a survey as conclusive evidence

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<sup>98</sup> *Anti-Monopoly*, 515 F. Supp. at 453.

<sup>99</sup> *Id.*

<sup>100</sup> "The presence of bias on the part of an investigator is, obviously, sufficient to discredit the entire undertaking." F. COXTON, D. COWDEN & S. KLEIN, *APPLIED GENERAL STATISTICS* 6 (3d ed. 1967). Bias takes two forms—conscious and unconscious. It seems to be a universal principle that individuals interpret and remember facts in the light most favorable to themselves. *Id.* See also S. LABOVITE & R. HAGEDORN, *INTRODUCTION TO SOCIAL RESEARCH* 46 (1971). The *Thermos* court was:

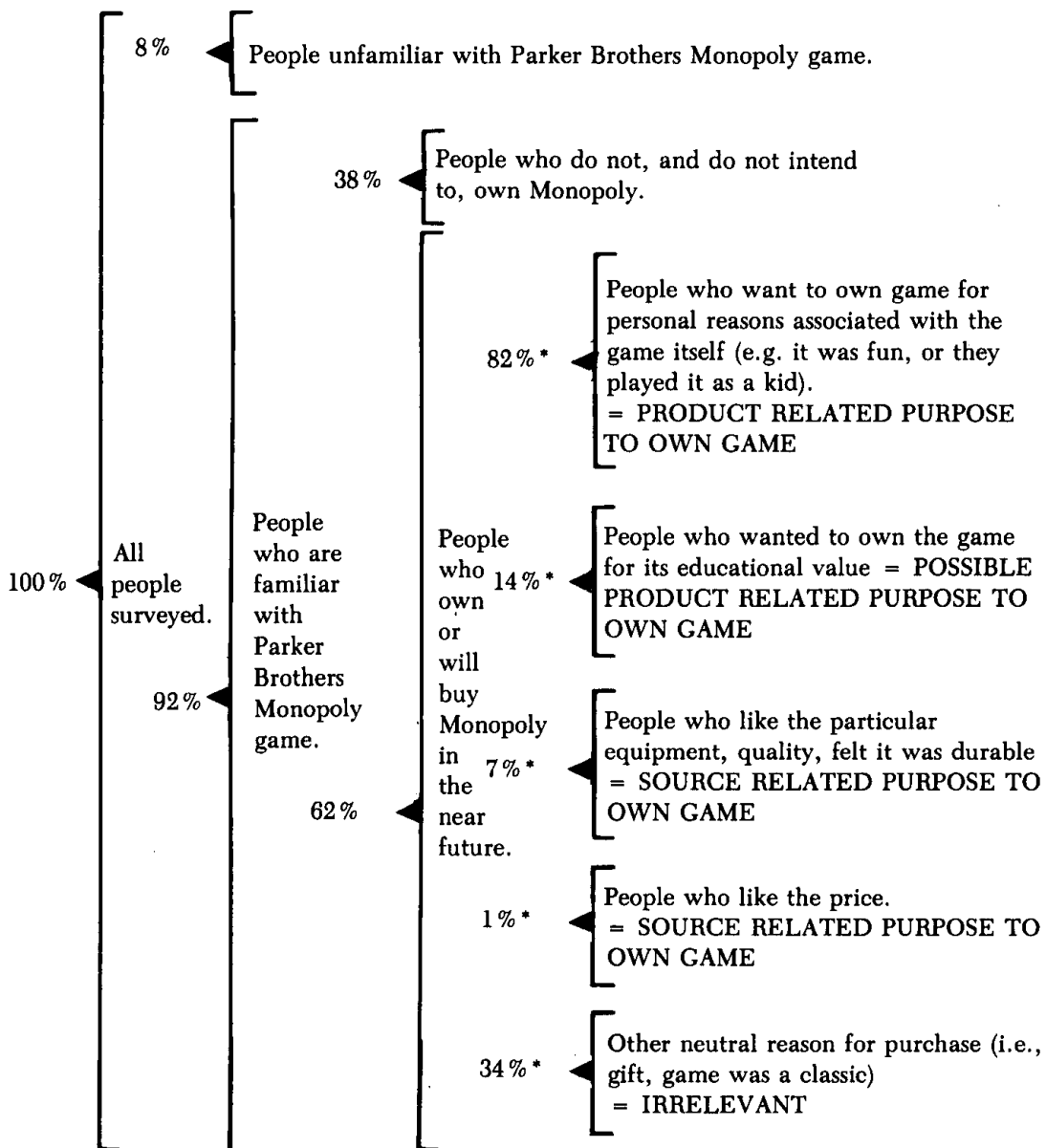
particularly impressed with the high degree of credibility of the interviewers who testified, their conscientiousness in carrying out their duties and their complete lack of bias. They did not know the purpose of the survey as it related to the trial; they did not know when they conducted the interviews, for whom the survey was being made or that it was to be used in litigation; they had never talked with the attorneys nor had they been interviewed or given any instructions by them; and, as each took the stand, she had no knowledge of what the trial was about. Here and there in the testimony it was brought out that some human error had occurred in a particular interview, but an adequate allowance had been made for such error in computing the results of the poll.

*American Thermos Prods. v. Aladdin Indus.*, 207 F. Supp. 9, 22 (D. Conn. 1962), *aff'd. sub nom.*, *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963).

<sup>101</sup> *Anti-Monopoly*, 515 F. Supp. at 453.

of a consumer's primary motivation for purchasing a product, should solicit expert testimony regarding the validity of the survey. Even the results of the Motivation survey can be construed as support for a finding of validity under the traditional standard, as a majority of those consumers surveyed are familiar with Parker Brother's Monopoly game.<sup>102</sup> The courts reliance on the Thermos survey is difficult to understand in light of its recognition that the validity of this survey had been

<sup>102</sup> In *Anti-Monopoly III*, the court discussed the results of the Motivation survey. Such results can be summarized as follows:



\*Percentages total more than 100% because people gave more than one reason for purchasing the game.

*Anti-Monopoly*, 684 F.2d at 1324 (chart constructed from case data).

questioned in *E.I. Dupont de Nemours & Co. v. Yoshida Int'l, Inc.*<sup>103</sup> where the court stated “[due to] the design of the question, [the respondents to the survey] more often than not focus[ed] on supplying the inquirer a ‘name’ without regard to whether the principal significance of the name supplied was ‘its indication of the nature or class of an article, rather than an indication of its origin.’ ”<sup>104</sup>

The Brand Name and Tide surveys were in effect summarily dismissed as irrelevant because of a lack of expert testimony.<sup>105</sup> However, these tests may be of some significance. The invalidation of the Thermos survey is significant in that it served to highlight the inconsistent treatment meted out by the court when reviewing the evidence,<sup>106</sup> and the Tide survey points out what an absurd effect the Motivation survey would have. In addition, the very fact that the four surveys introduced by the parties were split in result, in and of itself points to the unreliability of the survey.

#### VIII. CONCLUSION:

In adopting the primary significance standard and its resultant burden of proof, the Ninth Circuit substantially impaired a sole producers' ability to maintain a trademark. The test itself fails to foster any of the policies underlying federal trademark law and immediately evoked Congressional response. Senator Hatch has proposed a bill which would require the principal significance standard to be incorporated into the federal trademark law,<sup>107</sup> and would, if passed effectively overrule the Ninth Circuit's decision.

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<sup>103</sup> 393 F. Supp. 502 (E.D.N.Y. 1975).

<sup>104</sup> *Id.* at 527 (citing *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 580 (2d Cir. 1963) (citing *Feathercombs, Inc. v. Solo Prods.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962))).

<sup>105</sup> *Anti-Monopoly*, 684 F.2d at 1323, 1326.

<sup>106</sup> The mere lack of expert testimony was an inappropriate reason to label the survey as irrelevant; the original value of expert testimony has been questioned. *See Thomas Pride Mills, Inc. v. Monsanto Co.*, 155 U.S.P.Q. 205 (N.D. Ga. 1967); *Pennsylvania Dutch Co., v. Pennsylvania Amish Co.*, 186 U.S.P.Q. 154 (Pa. Comm. Pl. 1975); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823 (C.C.P.A. 1970). *But see Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479 (S.D.N.Y. 1968); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961).

<sup>107</sup> The bill, which clarified the circumstances under which trademarks may be cancelled, was introduced to Congress by Senator Hatch on June 9, 1983. S.1440, 98th Cong., 1st Sess.(1983). It states:

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That section 14(c) of the Lanham Trademark Act (15 U.S.C. 1064(c))

is amended by adding before the period at the end of such section, the following: "except that no registration of a mark shall be cancelled on the grounds that such mark has become a common descriptive name unless it is clear that in the minds of the consuming public the mark fails to indicate the source or quality of goods or services on which it is used. Purchaser motivation shall not be used to determine whether a mark is generic".