

TRADE-MARKS: What constitutes an inringement of trade-marks for similarity.

September 14, 1936.

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Hon. Dwight H. Brown,
Secretary of State,
Jefferson City, Missouri.

Dear Sir:

This department acknowledges your letter and enclosures of September 10th, wherein you state as follows:

"Will you please note the enclosed application to register Asper-Selzer as a trade-mark for tablet form of alkaline aspirin, and correspondence which we have had with the firm of Anderson and Whittington, St. Louis, Mo., on the subject. While we rejected the registration of this trade-mark under the general head of medicine, due to the fact that we have Alka Seltzer already registered as a medicine, the argument of Anderson and Whittington is the dissimilarity of one medicine against the other.

"We shall be glad to have an opinion from you so we may know how to proceed in the matter."

The applicant in the letter dated August 8th asks re-consideration of his trade-mark, and states as follows:

"We enclose herewith application of S. A. Whittington for registration of trade mark consisting of the hyphenated word "ASPER-SELZER", together with the fee of one dollar.

"This application was returned by your office as being in conflict with the already registered name "ALKA SELTZER".

We request your re-consideration of the application and offer the following suggestions.

"The two products are dissimilar both in their claimed effects and in their ingredients. The effective ingredient, not claimed to be present in Alka Seltzer, is monoacetic-acidester of salicylic acid, or aspirin. Trade names applied to the various forms of aspirin commonly use the shortened word 'asper'. It immediately distinguishes the product as one whose active element is aspirin and is therefore not in any way to be confused with Alka Seltzer or similar alkaline effervescents.

"The word 'seltzer' is in common use and in the public mind denotes effervescence. There are Alka Seltzer, Bromo Seltzer, and the more common seltzer water.

"By the union of the two commonly understood words, we have Asper-Selzer, an effervescent form of aspirin, differing from Alka Seltzer in its active ingredient, and differing from, for instance, Asper Gum, by its form.

"Far from intending to infringe upon Alka Seltzer, or for that matter Bromo Seltzer, we have purposely gone out of our way and, to some extent at least, prejudiced ourselves in the eyes of a discriminating public by misspelling the word 'seltzer' in order that an independent and distinctive recognition might attach to our product."

We wish to say in the very beginning that the reports are full of decisions dealing with the question of infringement of trade-marks and trade-names where the charge is similarity, and it has therefore been frequently said that each case must depend upon its own circumstances. Thus in the case of Lambert Pharmacal Co. v. Bolton Chemical Corp., 219 Fed. 325, 1. c. 328, the court said:

"A discussion of the many cases in which similarities have, or have not, been thought infringements, serves no end;

applications of the accepted principle no doubt vary, but no two cases are alike. One must trust one's own sense of the likelihood of confusion and the absence of any justification for the defendant's choice of name.

And in the case of *Gehl v. Hebe Co.*, 276 Fed. 271, 1. c. 272, the court said:

"A question of similarity of trade-names as applied to a particular product must of necessity be largely a matter of impression. From absolute copy of a name to one which is radically and essentially different there are names innumerable, with varying degrees and shades of difference; and it would be impossible to lay down any general line of cleavage between infringing and noninfringing names."

However, since the decisions yield general principles, they may be helpful in disposing of the particular case.

There are a group of cases which hold that whether a trade-mark infringement exists does not depend solely on similarity to the eye or ear, but on whether there is such similarity as readily leads the mind of customers to confusion. The case of *American Lead Pencil Co. v. L. Gottlieb & Sons*, 181 Fed. 178, 1. c. 180, announces the above principle and states as follows:

"I have no difficulty in finding that the phrase 'Knoxall' is an infringement of the phrase 'Beats-All'. There is no such limitation as the defendant puts upon the infringement of a trade-mark; i.e., that the similarity must go only to the eye or ear. The question cannot be treated in any such technical manner, for always the substantial question is whether the defendant is likely to steal the complainant's trade by the use of the trade-mark in question. I am quite satisfied in this case that there is such similarity between the two phrases as would readily lead in the mind of customers to confusion; a case in point is the infringement of

'Keepclean' by 'Sta-Kleen.' Florence Manufacturing Company v. J. C. Dowd & Co. (C.C.A.) 178 Fed. 73. There are many other decisions in the books which show that it is not alone similarity to the ear or eye which constitutes infringement."

Another group of cases lays emphasis on the principle that it is not necessary to constitute infringement of a trade-mark that the similarity be such as to deceive a cautious purchaser, but it is sufficient if it would deceive the ordinary and unwary purchaser. Thus in the case of Allen v. Walker & Gibson, 235 Fed. 230, 1. c. 237, we find the court using the following language:

"In law the trade-marks are the same if, when applied to the same class and kind of goods, they so clearly resemble each other as to deceive the ordinary purchaser, who gives such attention to the same as the ordinary purchaser usually gives, and cause such purchaser to purchase the one thing, supposing it to be the other. It is not necessary that the similarity must be such as to deceive and mislead the cautious purchaser. It is sufficient to show the similarity is such as to deceive the ordinary and unwary purchaser."

And in the case of Drummond Tobacco Co. v. Tinsley Tobacco Co., 52 Mo. App. 10, 1. c. 26, we find the following statement by the court:

"It is not essential to the right of relief to show that anyone was actually deceived. Filley v. Fassett, 44 Mo. 168."

Then there is the principle that where there is a doubt as to whether a word for which registration is sought as a trade-mark is deceptively similar to a word already registered and applied to the same class of goods, the doubt will be resolved in favor of the protection of the public. To this effect is the case of Lambert Pharm. Co. v. Mentho-Listine Chem. Co., 47 App. Cases (D.C.) 197, 1. c. 198, wherein the court said:

"It is agreed that the goods on which the marks are used are the same, and that the only question before the court is whether the marks are so similar as to be liable to create confusion in trade. Passing over the possible non-

registerability of the mark because it is the name of the applicant company, we will dispose of the case on the single question of the deceptive similarity of the marks. The case is ruled by Re Barrett Mfg. Co. 37 App. D. C. 111, where the word 'Creo-Carbolin' was held to be deceptively similar to the word 'Carbolineum.' It was there held that the prefix 'Creo' did not render the marks dissimilar, and the same is here true of the prefix 'Mentho.' Besides, there would be nothing to control the manner in which the prefix might be printed so as to give especial prominence to the word 'Listine.' Where there is doubt it should be resolved in favor of the protection of the public."

In the case of National Food Products Corp. v. Jell-O Co., 19 Fed. (2d) 797, the court in holding that the registration of the trade-mark "Jell-O" precluded another's registration of the trade-mark "Mel-O" for use on goods of the same descriptive properties, said:

"The opposition is based upon the ground that 'Mel-O' is deceptively similar to opposer's trade-mark 'Jell-O,' and, when so applied to the same description of goods, will likely cause confusion in trade, to the serious injury of the opposer.

"Each party has taken considerable testimony in the case, and both have filed briefs. We do not find it necessary, however, to enter here into a detailed discussion of the evidence and arguments, for in our opinion the words 'Jell-O' and 'Mel-O' are so obviously similar both in sound and appearance that the use of both as trade-marks upon goods of the same descriptive properties would manifestly be likely to mislead the purchasing public, and produce confusion in the trade."

Can it be said then that the words "Asper" and "Alka", when combined with the word "Seltzer", are so similar that they would readily lead the mind of customers to confusion, remembering that the similarity need not be such as to deceive a cautious

purchaser, but that it is sufficient if it would deceive the ordinary and unwary purchaser, and further remembering that if there is a doubt it is to be resolved in favor of the existing mark for the protection of the public?

Our reply is in the negative, and we rely on the following authorities to support our position.

In the four cases that follow, only one word was involved in the trade-mark, but they have a similarity in the hind part, and the difference is in the front part.

In the case of Valvoline Oil Co. v. Havoline Oil Co., 211 Fed. 189, l. c. 193, the court in holding that the word "Valvoline" did not infringe upon the word "Havoline", said:

"We then come to the question of trade-mark infringement. I am of the opinion that the words are distinct from each other and that there is no confusion. There are, of course, many cases in the books in which the courts have made clear that they cannot be deceived by disingenuous distinctions (N. K. Fairbank Co. v. Central Lard Co. (C.C.) 64 Fed. 133, and many others which could be cited); but here there is a real distinction in sound, in appearance, and, popularly speaking, in meaning."

And in the case of L. P. Larson, Jr., Co. v. Wm. Wrigley, Jr., Co., 253 Fed. 914, l. c. 915, the court in holding that the word "Spearmint" was not infringed by the word "Peptomint", said:

"'Peptomint' is so different in appearance and sound that there would be no infringement, even if 'Spearmint' were a proper trade-mark."

And again in the case of Davies-Young Soap Co. v. Selig Co., 16 Fed. (2d) 352, the court in holding that the trade-mark "Selco" was not so deceptively similar to the mark "Dysco" as to preclude registration of the former for use on similar goods, said:

"We do not find it necessary to review or discuss the various cases which have been cited by counsel, but content ourselves with saying that in our opinion

the words 'Dysco' and 'Selco' are not so similar, either in appearance or pronunciation, as to make confusion in the trade probable."

And in the case of Switzer v. J. N. Collins Co., 23 Fed. (2d) 775, the court in holding that the trade-mark "Honeymels" for use on candy did not infringe on a prior mark "Buttermels", said:

"Appellant opposes the registration by appellee of the trade-mark 'Honeymels' for use on candy. The opposer is the prior user of the mark 'Buttermels' as a trade-mark for candy.

"Unquestionably the words 'butter' and 'honey,' standing alone, are descriptive; but, when joined to the suffix 'mels,' they are nothing more than suggestive, and are subject to use as valid trade-marks. The suffix 'mels,' meaning sweets, has had a use on candy in connection with the mark 'caramels' long prior to the adoption and use of opposer's mark. Indeed, the name 'caramels' is a common one, extensively employed to refer to candy mixtures of a popular kind. Both parties have borrowed this suffix, and by combination with descriptive terms have constructed legitimate trade-marks. The suffix 'mels' being common to both marks, the distinctive feature is between the words 'honey' and 'butter.' It was properly held by the Commissioner that no confusion could arise from the use of these two words in connection with the same quality of goods. With this holding we agree."

The following two cases are more in keeping with the instant case in that there is an identity between the second word of the trade-mark, but there is no substantial similarity between the first word of the former and the first part of the latter, either in appearance, sound, or meaning.

In the case of Potter Drug & Chemical Corp. v. Pasfield Soap Co., 102 Fed. 490, 1. c. 493, the court in holding that the use of the words "Cuticle Soap" did not infringe complainant's trade-mark "Cuticura Soap", said:

"The remaining question is whether the use of the words 'Cuticle Soap' by the defendant infringes complainant's trade-mark, 'Cuticura Soap.' The words are to a considerable degree unlike to the eye, unlike to the ear, unlike in spelling, unlike in meaning, and unlike in suggestion. The complainant's word, 'Cuticura,' suggests that the soap is curative in its application to the skin. The defendant's word, by itself, has no such meaning, although the indorsements upon the back illustrate that it is recommended for various diseased conditions of the skin. But such recommendation is quite apt to accompany the advertised sale of any soap used for toilet purposes, and it is quite beyond the power of the complainant to monopolize such advantage."

And in the case of Coca-Cola Co. v. Carlisle Bottling Works, 43 Fed. (2d) 101, l. c. 114, the court, after reviewing numerous authorities, held that the trade-mark "Roxa Kola" was not an infringement on the trade-mark "Coca-Cola", and said:

"I think, therefore, that I am justified in drawing from this survey the general rule that in such cases where the front part of the two trade-marks involved differ in appearance, sound, and meaning, there is no infringement even though there may be similarity amounting to identity in the last parts. It is only a very exceptional case which will not be governed by this rule. Possibly deeper reflection on these cases and a wider survey might affect this statement, but I shall accept it as sound in disposing of this case. What do we find here? There is identity between the second word of defendant's trade-mark and the second part of plaintiff's compound word, but there is no substantial similarity between the first word of the former and the first part of the latter, either in appearance, sound, or meaning. The first part of plaintiff's compound word has some meaning. It at least suggests that plaintiff's article has some

connection with the coca leaf as well as the cola nut. The first word of defendant's trade-mark has no meaning. It is purely arbitrary. In determining the question as to the similarity in appearance and sound, note should be taken of how well known plaintiff's article is. Its trade-mark has been burnt into the consciousness of people generally. Instinctively one recalls in memory its appearance and sound. It would seem to be well-nigh incredible that one calling for 'Coca-Cola' and furnished a bottle of defendant's article would think that he was receiving plaintiff's and would not at once recognize that he was not."

The words "Asper" and "Alka" are to a considerable degree unlike to the eye, unlike to the ear, unlike in spelling, unlike in meaning, and unlike in suggestion. The word "Alka" suggests alkaline, while the word "Asper" suggests aspirin. Again, as stated in the Coca-Cola case, supra, "Alka Seltzer" has been so well advertised in the press and radio, "that it has been burnt into the consciousness of the people generally."

From the foregoing, we are of the opinion that the words "Asper-Selzer" are not an infringement upon the trade-mark "Alka Seltzer", and therefore subject to registration.

Respectfully submitted,

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Assistant Attorney General.

APPROVED:

JOHN W. HOFFMAN, Jr.,
(Acting) Attorney General.

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