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## Registered Trademark Marking Requirements

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## Registered Trademark Marking Requirements

Cameron K. Wehringer\*

**D**AILY, HOURLY, it seems as though someone, someplace, is adding after a word, name, symbol, or device . . .<sup>1</sup> another symbol, ®, or an asterisk (\*) keyed to the words others may add immediately next to, or under, the word, name [etc.]. These words, having an almost mystic quality to them, are "Registered in U. S. Patent Office" or "Reg. U. S. Pat. Off." Most add the ® or the word equivalent on the goods, on the label, in advertising, on television showings, and practically any other place. It is all done for "protection." But protection against what?

Many people who see the ®, or equivalent, probably agree with the advertising people (who might believe that trademark lawyers exist solely to despoil their copy and art work) that ® means something, but what? With a shrug of their collective shoulders they don't know, probably care less, and if asked as to the looks, might say it is not an attractive addition! The worst of it is, from the viewpoint of the interested attorney and layman, that there is no consistency as to where and how frequently ® appears. The ® symbol is at times rarely used, sometimes moderately used, and sometimes perhaps over-used. Two major questions then. What is the necessary use, and what is the situation as to prevailing use?

### Necessary Use

The use of ® and the word equivalents, is found in the Trademark Act of 1946.<sup>2</sup> First in Section 29 appears a statement to disregard a prior number section. This earlier section, 22, concerns constructive notice of a claim of trademark ownership of Principal Registrations.<sup>3</sup> The ® section, 29, reads in full:<sup>4</sup>

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<sup>1</sup> Trademark definition in greater part as given in the Trademark Act of 1946 (Lanham Act) Section 45 (15 U. S. C. 1127).

<sup>2</sup> Trademark Act of 1946, Section 29 (15 U. S. C. 1111).

<sup>3</sup> The section, 22, is short and to the point:

Registration of a mark on the principal register provided by this Act or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof. 15 U. S. C. 1072.

<sup>4</sup> 15 U. S. C. 1111.

Notwithstanding the provisions of section 22 hereof, a registrant of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this Act, shall give notice that his mark is registered by displaying with the mark as used the words "Registered in U. S. Patent Office" or "Reg. U. S. Pat. Off." or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this Act by a registrant failing so to mark goods bearing the registered mark, or by a registrant under the Act of March 19, 1920, or by the registrant of a mark on the supplemental register provided by this Act no profits and no damages shall be recovered under the provisions of this Act unless the defendant had actual notice of the registration.

These words serve to treat alike with 1946 Act registrations trademarks registered under the earlier Acts. The Section can be summarized as warning that if ® (or stated equivalents) is not placed *on* the goods, then profits and damages are *not* recoverable, *unless* the alleged infringer had *actual* notice.

There are then, four points re ®. (1) The ® symbol (or equivalent) is to be used to mark the goods, which may be on the goods. Usage elsewhere, such as in advertising, in leaflets, and so on, is not required by statute as to (2) Recovery of profits and damages under the Act. If the advertising art, for example, is found to be of greater importance than a speculative accounting by a probable infringer, (3) Failure to use ® will *not* preclude an injunction against the offending use.<sup>5</sup> The notice provisions of this Section do not affect opposition proceedings, nor a common-law unfair competition action. (4) To recover financially from an infringer without ®, *actual* notice is needed.

### 1. Use of ® on the Goods

Use of the word "obvious" in law is dangerous, but it seems "obvious" that sometimes a trademark cannot be used to mark the goods, that is *on* the goods. The goods might be a liquid, too tiny, or another reason may prevent marking. Then it should follow that use on the container, on a label affixed to the container, or use in similar proximity would be use on the goods, that is, marking the goods.<sup>6</sup> This was so found in the *Dexedrine*

<sup>5</sup> Note 20, *infra*. Section 34 (15 U. S. C. 1116).

<sup>6</sup> *Merrick v. Sharp & Dohme*, 185 F. 2d 713, 718 (7th Cir. 1950), *cert. den.* 340 U. S. 954, 95 L. Ed. 687, 71 Sup. Ct. 573 (1951).

case<sup>7</sup> where

On the label of each bottle there appears the word Dextro-drine footnoted with an asterisk after which appears "T. M. Reg. U. S. Pat. Off." and a reproduction of the tablet, indicating its color, shape, and size with the designation "Trade [picture] Mark." We conclude that the requirements of Title 15 U. S. C. A. §§ 1051, 1072, and 1111, have been complied with and accordingly the District Court did not err in its preliminary conclusion that Dextro-drine is a valid trademark.

Not only does this support the statement that label usage is use on the goods, but it also supports use of an asterisk (\*) keyed to an identification and the correct marking for configuration trademark.<sup>8</sup> The present Section 29 is analogous to the 1905 Act Section 28. The 1905 Section spelled out the proximity factor with clarity.<sup>9</sup> It was quoted in a 1914 case where an accounting was refused as being an empty act. The reason was that damages could not be recovered as notice was not given by use nor to the person accused.<sup>10</sup> Without affixation of ® to the goods, proof of notice is required. This can be a problem as was shown in another 1905 Act case where the notice was held insufficient upon appeal.<sup>11</sup> Therefore, marking the goods is advisable if profits and damages are likely to be sought should another infringe. Use of ® on the goods becomes a policy and business decision. It may be thought, on the other hand, that financial recovery is too speculative, or that an injunction would be suf-

<sup>7</sup> *Ross-Whitney Corp. v. Smith Kline & French Lab.*, 207 F. 2d 190, 99 USPQ 1 (9th Cir. 1953).

<sup>8</sup> The related question as to a container being admissible as a trademark is discussed in *Wehringer, Two for One: Trademarks and Design Patents*, to be published.

<sup>9</sup> Section 28. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this cannot be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice. 33 Stats. 730. 15 U. S. C. 107. *Pinaud, Inc. v. Huebschman*, 27 F. 2d 531, 538 (E. D. N. Y. 1928) *aff. w. o. op.* 27 F. 2d 538 (2d Cir. 1928), *cert. den.* 278 U. S. 644, 73 L. Ed. 558, 49 Sup. Ct. 80 (1928).

<sup>10</sup> *Rossman v. Garnier*, 211 Fed. 401, 406, 407 (8th Cir. 1914).

<sup>11</sup> *Perry v. Amer. Hecolite Denture Corp.*, 78 F. 2d 556, 559 (8th Cir. 1935).

ficient should another infringe. The individual situation will be controlling.

## 2. Recovery of Profits and Damages

Section 29 is explicit as to the recovery of profits and damages.<sup>12</sup> The 1905 Act analogous Section 28 was equally blunt.<sup>13</sup> There seems little reason to argue that profits and damages are not available if ® is not used; or if not marked, that financial recovery is only for the sales made after proper notice was given.<sup>14</sup> Rudolf Callmann wrote as to the 1946 Act, that if the aggrieved party "sues on his common-law trade-mark, recovery of full damages and profits should be permitted."<sup>15</sup> The United States Supreme Court has so found in a matter concerning a 1905 Act Registration. After summarizing Section 28, the Court pointed up the distinction:<sup>16</sup>

The infringement that is sued for is infringement of a registered trade-mark, not infringement of a trade-mark. That is the plain meaning of [Section 28 of the 1905 Act] . . .<sup>17</sup>

Were it thought that jurisdiction, financial recovery, or any other statutory provision might be a problem, actual notice of the registered trademark concerned would cure such problematical defect<sup>18</sup>—both under Section 28 of the 1905 Act and under Section 29 of the 1946 Act. If profits and damages are all important, perhaps consideration should be given to the common-law aspects of the individual matter, to see if a solution is present.

The question as to the distinction between profits and damages, what properly constitutes each, and what are the deductible items found in arriving at an evaluation in an accounting need not here concern us. There is an excellent paper reviewing this for the interested reader by Robert Price.<sup>19</sup>

<sup>12</sup> *Supra* note 4.

<sup>13</sup> *Supra* note 9.

<sup>14</sup> *Treasure Imports, Inc. v. Henry Amdur & Sons, Inc.*, 127 F. 2d 3 (2d Cir. 1942).

<sup>15</sup> 4 Callmann, *Unfair Competition and Trade-Marks* 1872 (2d Ed. 1950).

<sup>16</sup> *Stark Bros. Co. v. Stark*, 255 U. S. 50, 51, 52, 65 L. Ed. 496, 41 Sup. Ct. 221 (1921).

<sup>17</sup> *Supra* note 9.

<sup>18</sup> *Supra* note 16.

<sup>19</sup> Price, *Financial Recovery in an Action for Trademark Infringement*, 47 TMR 1297 (1957).

### 3. An Injunction Does Not Depend Upon ®

The statute is clear in its statement that an injunction lies irrespective of the use of ®.<sup>20</sup> This provision is also consistent with the 1905 Act remedies. A distinction was made between enjoining infringement and restraining for unfair trade from granting an accounting in a case where the registered trademark notice was missing.<sup>21</sup> As clearly stated in an *Admiral* case,<sup>22</sup> where the court found that damages could not be sustained:

The right to damages as provided by the statute is a distinct and separate remedy from the injunctive relief demanded.<sup>23</sup>

In the *Q-Tips* case,<sup>24</sup> after determining that *Q-Tips*, a valid trademark, was infringed by Johnson's Cotton Tips, the court noted:

. . . the remaining issue is whether the district court was correct in giving the plaintiff an injunction but declining to order an accounting of profits and damages.<sup>25</sup>

Its answer was:

. . . that if there is no showing that the plaintiff's business has been hurt or that the defendant has made profit out of the infringement, there is no call for relief other than that given by injunction.<sup>26</sup>

While this goes to the "when" of an accounting, it also shows that an injunction and other relief are not dependent, one upon the other. Each is separate.<sup>27</sup> An injunction can lie—without ®.

### 4. Actual Notice

The question of notice arises when ® is not used on the goods, and not only an injunction is contemplated, but also the

<sup>20</sup> Sections 32(1) and 34 (15 U. S. C. 1114(1) and 1116). Noted 3 Callmann, *op. cit. supra* note 15, 1720.

<sup>21</sup> *Rossman v. Carnier*, *supra* note 10. Cf. *Ramirez & Feraud Chili Co. v. Las Palmas*, 146 F. Supp. 594, 599, 110 USPQ 525, 47 TMR 217, 221, 222 (SD Cal. 1956), *affd. memo dec.* 245 F. 2d 874, 114 USPQ 73, *cert. den.* 355 U. S. 927, 2 L. Ed. 2d 357, 78 Sup. Ct. 384 (1958).

<sup>22</sup> *Admiral Corp. v. Admiral Employment Bureau, Inc.*, 151 F. Supp. 629, -- USPQ --, 47 TMR 776 (D. C. N. D. Ill. 1957).

<sup>23</sup> *Id.* 151 F. Supp. at 631, 47 TMR at 777, 778.

<sup>24</sup> *Q-Tips, Inc. v. Johnson & Johnson*, 206 F. 2d 144, -- USPQ --, -- TMR -- (3rd Cir. 1953), *cert. den.* 346 U. S. 867, 98 L. Ed. 377, 74 Sup. Ct. 106 (1953).

<sup>25</sup> *Id.* at 145.

<sup>26</sup> *Id.* at 149.

<sup>27</sup> *Ibid.* The court in noting that the evidence supporting an accounting was not brought forth in the beginning graphically remarked:

. . . he is too late if he kept it for a second bite of the cherry.

recovery of profits and damages, which will date from the time of *actual* notice.<sup>28</sup> The question is, what constitutes sufficient notice? What is actual notice is not clear.<sup>29</sup> Should actual notice be only *express* notice?<sup>30</sup> Or, may actual notice also be *implied* notice?<sup>31</sup> The answer in a trademark matter is unknown.

Implied notice, were it included in actual notice, means that the man who exercises reasonable diligence would get that knowledge or notice so as to learn the mark is registered.<sup>32</sup> The cases discussing implied notice are real property cases, and, it can be argued, should be persuasive in trademark matters. Assuming both express and implied notices were to be held part of actual notice, the question would concern the type of facts which would inform a reasonably diligent person.

<sup>28</sup> *Admiral Corp. v. Sewing Machine Sales Corp.*, 156 F. Supp. 796, 798, 116 USPQ 17, 48 TMR 484 (SD NY 1957). 3 Callmann, *op cit. supra* note 15, 1720 states:

Section 29 provides that damages shall not be assessed unless the defendant had "actual notice of the registration"; there is no such requirement with respect to the issuance of the injunction.

<sup>29</sup> In a footnote to *United States v. Certain Parcels of Land, Etc.*, 85 F. Supp. 986, 1002 (footnote 13) (S. D. Cal. 1949) the court noted:

A search of the authorities for a definition of "notice" in this type of a case [suit to condemn land] reveals that this word, with its adjectives "actual," "constructive," "implied," and "presumptive," has not, in all of its ramifications, acquired a standardized meaning in the legal nomenclature . . . If a reasonably prudent man is put upon inquiry he can be charged with actual notice.

Citing: *Hawke v. California Realty & Construction Co.*, 28 Cal. 377, 152 Pac. 959 (1915).

<sup>30</sup> Express notice is that kind of actual notice which consists of knowledge actually brought personally home; information which of itself gives actual notification. Express notice embraces not only personal knowledge, but also that which is communicated by direct information, either written or oral, from those who are cognizant of the fact communicated. 66 C. J. S. *Notice* Sec. 4.

<sup>31</sup> Notice is actual when it is directly and personally given to the person to be notified . . . may be either express or implied. 66 C. J. S. *Notice* Sec. 3 . . . implied notice is generally regarded as a kind of actual notice which consists of knowledge of facts so informing that a reasonably cautious person would be led by them to the ultimate fact; that which, if prosecuted with ordinary diligence, will furnish information of the fact . . . implied notice is generally regarded as differing from constructive notice, in respect of the character of the inference on which it rests, in that implied notice arises from an inference of fact . . . while constructive notice is the creature of positive law, or rests on strictly legal presumptions which are not allowed to be controverted . . . *Id.* Sec. 5.

<sup>32</sup> *United States v. Certain Parcels of Land, Etc.*, *supra* note 29; *Continental Supply Co. v. Marshall*, 52 F. Supp. 717 (WD Okla. 1953), *rev. on other grounds*, 152 F. 2d 300 (10th Cir. 1946), *cert. den.* 327 U. S. 803, 90 L. Ed. 1028, 66 Sup. Ct. 962 (1946); *United States v. West*, 132 F. Supp. 934, 936 (ND Ga., 1955), *Mayor Etc. of Baltimore v. Whittington*, 78 Md. 231, 236, 237, 27 Atl. 984 (1893); *Bridgewater Boro v. Pa. P. U. C.*, 181 Pa. Sup. 84, 97, 124 A. 2d 165 (1956).

Consider for a moment what would be implied (actual) notice if the ® were to be required in advertising henceforth, but not used. Assume an infringement occurs. Would it not be implied that a reasonably diligent person, who is alleged to have infringed, would see the product which has been advertised? Can there be exceptions such as mail order items, sectionally distributed but nationally advertised items, and other similar cases? Probably for certain items a reasonably diligent person would be expected to see the goods—and ®. Most likely this would be true for certain nationally advertised and distributed products. Examples might include: soap, cigarettes, toothpaste, lipstick and other daily-living items. A rationale of common-sense seems to be indicated.

If marking were omitted on the goods, but included in advertising, could implied notice be found? Would this not be a question of fact? One of the items might be the extent of the advertising concerned, and the type. Again, take a daily-living item, such as aspirin, hair tonic, or toothpaste. Could it be argued that the advertising failed to reach a person exercising reasonable diligence? Here, the only diligence would be to keep open one's eyes and ears. And yet, there seem to be counter-arguments for even the most heavily promoted items—as the responsibility for reaching the alleged infringer would then be on the advertiser-complainant, and not on the person who is to exercise diligence. Should this mythical person have chosen magazine "X" or magazine "Y"? Should he have watched a particular television program? Or should his search have been confined to the newspapers? The questions would be asked and the answers uncertain. The importance of ® on the goods looms.

If marking were omitted, both on the goods and in other media (assuming other media were used), what would be implied (actual) notice? Can it be asserted that a man exercising reasonable diligence would learn of the registered nature of the mark? Would this infer he would use a qualified search organization? Which one? Even the best ones do not always report the same marks. Does not this line of inquiry also need an answer to the question—would this reasonably diligent man learn of the mark, *and then* consider whether it is registered?

There are many questions, but few answers at this time. The easiest course is to assume that for trademark matters, actual notice might mean express notice, or that knowledge



actually brought home to the party to be affected thereby.<sup>33</sup> If the marking program for trademarks is considered in this light, some problems may be avoided and evaded.

The safest course is to use ®, on the goods. This ® use should be clear. But what is clear use is disputed among users as seen in the following section.

### Current Practice

#### 1. Why in Advertising?

A logical question appears as why bother to use ® in advertising and other media not akin to on the goods. There seem to be two reasons. The first: A use of ® might "frighten" and thereby deter would-be-infringers. The second: The ® use may help the public realize the identified word is a trademark and not a generic word.

The first reason concerning the warning or frightening of would-be-infringers is one not found in the cases. To the extent it is a valid and sufficient reason depends upon an individual's judgment.

The second reason can in turn be divided into two situations. Situation "A" is where the mark is suggestive of, or close to the generic word. This might be contended to include a mark such as *Cream Wipt* for salad dressings containing cream,<sup>34</sup> or *Paint Masters* for dry paste, and ready-mixed paints,<sup>35</sup> or *Easy* for touch-up enamel supplied in self-spraying containers for application to domestic laundry and other appliances and *Easytint* for white paint particularly constructed to be mixed with various colors as desired.<sup>36</sup> In such cases, it can be asserted that vigilance is needed to make the public realize the trademark nature of the word or words. This may be helpful especially if others have

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<sup>33</sup> *Strahorn-Hutton Evans Commission Co. v. Florer*, 7 Okla. 499, 54 Pac. 710 (1898).

<sup>34</sup> This was not the issue. The question was whether *Dream Whip* for a pudding mix, *inter alia*, was likely to be confused with *Cream Wipt* for salad dressings containing cream. The Court thought confusion was likely. *Cream Wipt Foods, Inc. v. General Foods Corp.*, 126 USPQ 55 (CCPA 1960).

<sup>35</sup> *Inter alia*. The mark was found not descriptive. *Benjamin Moore & Co. v. Lasting Products Co.*, 126 USPQ 207 (Tm. Bd. 1960).

<sup>36</sup> The court affirmed the dismissal of an opposition against *Easytint* based on the mark *Easy* for the respective goods noted in the text. *Murray Corp. of America v. Red Spot Paint Co.*, 126 USPQ 390 (CCPA 1960). A list of other *Easy*-marks was given in the opinion.

similar marks for similar goods—with the line defining confusing similarity being hair-line thin.

Situation "B" is where the trademark owner is almost too successful and must vigorously assert his rights to show his trademark is just that, and has not become generic. If the trademark owner is successful in his sales promotion he may find his word becoming a companion to Cellophane as

It . . . makes no difference what efforts or money the Du pont Company expended in order to persuade the public that 'cellophane' means an article of Du Pont manufacture. So far as it did not succeed in actually converting the world to its gospel it can have no relief.<sup>37</sup>

In such cases, the mark must be policed, its distinctiveness preserved, and extraordinary care taken to prevent misuse. This includes care in the trademark owner's own use of the mark in all media.<sup>38</sup> The use must be a proper use.<sup>39</sup>

However, does not this beg the question to some extent? Why, other than on the goods, cannot the trademark owner merely state something akin to

[Mark]—Trademark

and not ® or equivalent? There seems to be no reason according to the statute, *viz.* profits, damages, and injunctive relief, why he cannot. And it would have a blessing when the item is exported to Canada. "Trademark" use would carry over a well understood term common to both countries. There is then no necessity of separate advertising runs to distinguish the U. S. registration notice from the separate Canadian situation.<sup>40</sup>

<sup>37</sup> *Du Pont Cellophane Co. v. Waxed Products Co.*, 85 F. 2d 75, 81 (2d Cir. 1936), *cert den.* 299 U. S. 601, 81 L. Ed. 443, 57 Sup. Ct. 194 (1936). Also "aspirin." *Bayer Co. v. United Drug Co.*, 272 Fed. 505 (DC S. D. N. Y. 1921).

<sup>38</sup> 3 *Callmann*, *op. cit. supra* note 15, 1154.

<sup>39</sup> *Clairol, Incorporated v. Roux Distributing Co., Inc.*, 126 USPQ 397 (CCPA 1960). This was a cancellation action. The Court noted (at p. 398):

Even though 'color bath' may have been a novel way of describing a liquid for coloring hair, the words were, as [first] used by appellee [Roux], nevertheless descriptive of its hair coloring liquid at the time when appellant [Clairol], to more fully describe the goods, added the common word "hair" thereto. The resultant expression is nothing but the normal use of the English language.

*Hair Color Bath* had been a supplemental registration for hair tinting and coloring preparations and was stricken from the register as generic.

<sup>40</sup> If it so happens that the same marks are registered in both the United States and Canada, then possibly the mark followed by (or by an asterik

(Continued on next page)

*Other than* on the goods, assume the mark is only identified by "Trademark." The main disadvantage might be the first mentioned—that of not sufficiently "frightening" the would-be infringer. After all, the use of ® symbol does carry with it a certain aura of holiness. This holiness to the viewer may only be that the mark is somewhat unique, that it was registrable, and that there is an ownership claim,<sup>41</sup> but is this not a lot? The use of ® does not affect the trademark owner's rights. Nor does it affect his remedies. And certainly it does not affect his right to an injunction. The advertising director would find this lack of differentiation a boon. The reader might also. Both for the reason that the picture is not confused with (e.g.) asterisks keyed to "trademark" for the non-registered trademarks and ® or a dagger (†) keyed to "Reg. U. S. Pat. Off." for registered marks, or similar segregation of value.<sup>42</sup>

Du Pont is one of the finest exponents of proper trademark usage, including use of ® or the word equivalent.<sup>43</sup> Yet, in its most excellent booklet on "How to Use the Trademarks . . ." the stress is not placed on the registered aspect. The stress, properly, falls on the "Du Pont trademark" claim. For example, Du Pont shows an illustrative footnote for its *Dacron* as "Du Pont trademark for its polyester fiber." In its section on "Written Advertising" appears the statement as to *Dacron*:

If preferred, the circled "R" can be replaced by an asterisk referring to a footnote "\*Du Pont trademark" or both may be done.

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(Continued from preceding page)

keyed to) "Registered Trademark in the U. S. and in Canada" (which has been seen) could be used. This does not follow the Section 29 language viz. "Pat. Off." which in non-on the goods use, is unnecessary. Whether a U. S. Court would hold this met the requirements of the marking section if used on the label—the issue being raised in a demand for an accounting—is unknown. It does take a chance in that it departs from the statutory language.

<sup>41</sup> Section 7(b) reads:

A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.

(15 U. S. C. 1057b).

<sup>42</sup> Much less the confusion if Canada is also to be considered.

<sup>43</sup> After *Cellophane*, supra note 37, this is to be expected!

The examples which follow in the booklet, if not reviewed with this statement in mind, might lead the quick-reader to believe ® is required. It is, *only* if the above statement is not used.

What holds true for advertising, would hold true for other non-on the goods usage. This would include booklets, leaflets, lists of products, sales slips, and so on *ad infinitum*.

## 2. How Used on the Goods?

Varying practices are followed. One of the more familiar rules of thumb advises use of ® with the "first and most prominent use" of the trademark. Whether this is more or less effective than an accurate, but quiet and positive legend that

[Mark] is Reg. U. S. Pat. Off. for [goods]

has not been resolved.

Some practices seem to be an effort to follow the statute, but at the same time to avoid any intrusion into the advertising art work. Might these be found to be without the spirit of the statute and worthless? There are as many examples as time is taken to find them. Some of the more prominent include use of such small type in comparison to the type elsewhere used, and especially in comparison to the type for the trademark, that the ® symbol is seen only when one assiduously searches for it. Examples which follow go with the phrase: "Only the names and places are changed to protect the innocent."

A well-known and heavy-selling cereal has a hard-to-read ® after the relatively inconspicuous use of the house mark on the back panel, and a ® after one of the smaller uses of the cereal trademark on the side panel. There is also a side panel statement:

Trade Marks Reg. U. S. Pat Off.

The question is—what are the trademarks concerned? The two found after a search? Others? On the panel where this statement appears, neither house mark nor trademark is used. It would seem better to state

[House mark] and [cereal trademark]—Reg. U. S. Pat. Off.<sup>44</sup>

<sup>44</sup> This has the added virtue of being adaptable to a trademark licensing situation. Language similar to "by [company], the trademark owner" could follow. There are other requirements in trademark licensing. One article is Wehringer, Trademark Licenses: Control Provided, Control Exercised, 47 TMR 287 (1957).

A prominent whisky distiller has a legend "Trademarks and Label Style Reg. U. S. Pat. Off." but *nothing* tells what are the trademarks.

On the other hand, in the category of non-® use, is found a woman's hair spray from a prominent beauty house. There is no indication as to what is its trademark, and if it is registered. Several popular cigarettes have absolutely no trademark claim nor notice as to registration of the mark or marks on the package. A prominent instant coffee manufacturer does not claim its mark nor symbol on the label, although once its house mark was the subject of a suit finally decided by the United States Supreme Court. Several domestic liquor distillers do not identify their trademarks. One imported one states "Registered Trademark" but whether this means the country of origin, or the United States, or both, is not known. A prominent toiletry manufacturer who has seen its sales and advertising budget skyrocket does not use ® for its trademarks or its house marks on its products.

An example of a moderate use of ® is sometimes found. Pick up a bottle of a certain premium beer, well advertised as a quality product, and one can almost play a game of "guess how many ® symbols there are." The ® is of a size that is quickly visible, yet the thickness of line and intensity of color blends with the art work when the bottle is on a shelf. It seems to illustrate a good blending of advertising and legal requirements. The several ® symbols each identify a particular trademark. One is for the "brand," another for the slogan-mark, a third for the design-mark, a fourth for the label-mark, and so on. This seems to be within the letter and the spirit of Section 29.

Rarely, it seems, is there an over-emphasis of ®. This would be used so that whenever and wherever the trademark appears an identification such as ® or word equivalent would follow. The emphasis probably would be on the word equivalent. There might also be a statement in the textual portion of the label or advertising media of the claim to trademark ownership. It might be expected that this would be in a field where the trademark owner is predominant. One prominent synthetic fiber manufacturer is found to use the ® word equivalent quite heavily.

What is advisable depends upon the nature of the mark and the importance of money.<sup>45</sup> Certainly if a mark is "weak," or

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<sup>45</sup> This money factor can be dual: Both welcome in the event of an infringement suit and as a deterrent factor to avoid infringement suits.

suggestive, or likely to become generic, more precautions are likely to be taken. This is not merely to provide for a claim for profits and damages, but to emphasize the trademark claim. If the mark is "strong," and if in the event of an infringement arising an injunction alone, or money from the date of actual notice, would be considered satisfactory, then any use of ® seems unneeded. Business risks must be assessed in view of the individual legal situation.

### Solutions—?

An interesting solution is that posed by Lewis Garner<sup>46</sup> in advocating trademark use as the criteria of what is a trademark. He commented that:

To display the terms "Trademark," "Brand," "Reg. U. S. Pat. Off.," "®," etc., next to or under trademarks is one feature of trademark display, but it is only important to the extent—and no more—that it causes the public to react to the mark as a trademark. If a trademark is used properly, the public will subconsciously and automatically insert the word "brand" between the trademark and the product name, regardless of whether the user himself displays this term.<sup>47</sup>

Although his article goes beyond the scope of the matter in hand, considering any word susceptible of trademark ownership when used as a trademark, it would eliminate the problem as to use of ®.

Another solution might be the statutory setting of standards for the marking of ®. This would go beyond the present requirements which are causing some difficulty, and state when and where. For example, the Copyright Law requires a stated legend<sup>48</sup> and in a stated place.<sup>49</sup> Can this type of requirement be adapted for registered trademark usage? It might be required to be in a certain place, such as with the manufacturer's name, with such other notices that might be required, and so on. The legend itself might be:

[Trademark]—Reg. U. S. Pat. Off.

with a substitution of ® permitted. This would permit a listing of trademarks to avoid the "cereal situation" and could include

<sup>46</sup> Garner, A Display Theory of Trademarks, 47 TMR 303 (1957).

<sup>47</sup> *Id.*, 47 TMR at 325.

<sup>48</sup> 17 U. S. C. 19.

<sup>49</sup> 17 U. S. C. 20.

labels, designs, and so forth by either a miniaturization or by a word identification. This might be similar to:

[Trademark], label, and container—®

This legend could be followed by the registrant's name if the marks are used by a licensee. For a non-registered trademark the use of the mark followed by the word "Trademark" would seem to be a natural development, adopted by custom and convenience in avoiding questions as to what is a trademark. This marking revision need not be an onerous provision, and could be keyed to the item of profits and damages. In other words, as today, an injunction would lie without the legend,<sup>50</sup> but profits and damages could not be obtained unless actual notice has been given. (Should actual notice be confined to express notice?)

One advantage to this would be apparent to the advertising staff. Copy could serve its purpose, even when that copy is a label or other usage on the goods. Litigation might be minimized as to what is or is not proper usage, and the reasonable diligent person need not hunt around the goods or container to determine whether the mark is registered—or contra-wise, if it has been dedicated to the public as a generic term.

If a change is made, why should not

Registered in U. S. -or- Reg. U. S.<sup>51</sup>

<sup>50</sup> Thus this would not be in conflict with the Paris Convention, which the U. S. ratified on May 30, 1887, and the London Revision, ratified on June 2, 1934. 4 Callmann, *op. cit. Supra* note 15, 2199. As he stated (at p. 2217):

Article 5 expressly provides: "Articles shall not be required to bear any sign or mention of the patent, the utility model, or the registration of the trade-mark or of the deposit of the industrial design or model for recognition of the right."

Article 5 is not inconsistent with section 29 of the Lanham Act. The "right" referred to in Article 5 is not to be understood as the right to recover for infringement, but as the right to claim ownership and use of the mark as applied to goods or services and the right to be protected under the Convention.

<sup>51</sup> The symbol ® can still be used. This symbol is occasionally used abroad by local companies, but such use is without comparable statutory authority as provided in the United States (15 U. S. C. 1111). There is no recognized and accepted meaning for ® in such foreign countries. However, an international agreement could provide a code for use. This might be: When only ® appears this would signify that the trademark is registered in the country of manufacture. When border-crossing is involved ® would be followed by the International Code Letters of the country or countries where registered. Thus, ®USA would identify a trademark registered in the United States, ®D a mark registered in Germany, ®F a mark registered in France, and so on. The traveler will recognize these letters as they are used on automobile licenses. Use is,

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be sufficient. The place, the Patent Office, is not important to the viewer. What is important is that a trademark has been properly registered under a federal statute, and if the statute places the registration burdens in the Patent Office, or another [new] division, this seems to be procedural.

In the alternative, things can proceed as they have. No problems seem to have arisen. But, let ® be confined to where it is required—on the goods. After all, the fifth point given as an accomplishment of the 1946 Act was<sup>52</sup>

Generally to simplify trade-mark practice . . .

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(Continued from preceding page)

therefore, established. When a mark is registered in more than one country, the advantage of this proposal is most readily seen. Illustrating the above: As now, a product manufactured in the United States, and here sold, carries ®. This is sufficient. The product is exported to another country and there the mark is also registered. The registrant wishes to have this known. The symbol is then ® USA, F. Of course, the desirability of noting registration is here not questioned. If it is not important to the trademark owner and registrant, the marking discussion is academic.

<sup>52</sup> Senate Committee on Patents, Senate Report No. 1333, May 14, 1946. 79th Cong. 2nd Sess. 1946. U. S. Code Cong. Serv. 1274, 1276.