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The Doctrine of Secondary Meaning

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various stages, and in conformity to the adopted rules of procedure. But in a larger sense it includes legal advice and counsel, and the preparation of legal instruments and contracts by which legal rights are secured although such matter may or may not be depending in court."

The court also noted the extreme difficulty of separating law from accounting in the field of tax law, but steadfastly held that the question of the net operating loss was a legal question, and maintained that, while accountants may ordinarily fill out tax returns, when a legal question arises, they cannot attempt to deal with it. For, in this area, "A service performed by one individual for another, even though it be incidental to some other occupation, may entail a difficult question of law which requires a determination by a trained legal mind."

The West Virginia definition of the practice of law would seem to be of little or no help in making determinations in this area, and this provokes a final question as to the purpose such a definition should serve. Should it attempt to cover all possible fact situations under which the problam could arise, or should it provide a broad structure upon which each case would be decided on its particular facts? The present definition is of the latter type, and it is the opinion of the writer that this is the only practical answer. A definition of the former type could possibly be contained in a multivolume treatise, scarcely less, and would have to be revised and rewritten every time a clever layman discovered a heretofore undiscovered way to practice law.

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The Doctrine of Secondary Meaning

The Doctrine of Secondary Meaning was developed by courts of equity prior to the existence of trade mark acts in order to afford protection to manufacturers and producers from "palming off" by competitors attempting to profit on an established reputation. A concrete example may help to clarify the problem. Suppose *A*, a manufacturer of ball point pens has, over a period of time, consistently used a particular marking on the barrels of his pens. *B*, a new-comer in the field begins to use the exact same marking on his pens. It is readily apparent that individuals purchasing pens from a retailer may purchase a pen of B's thinking that it was the

product of *A* since the pen carried the distinct mark of *A*. Even in the absence of any trade mark act if *A*'s mark had acquired a secondary meaning in the eyes of the purchasing public in that they associate the mark with *A*'s product, *A* has an equitable remedy against *B*.

The Doctrine of Secondary Meaning was concisely defined by Judge Denison[1] when he stated that,

> "The secondary meaning theory . . . contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark. So it was said that the word had come to have a secondary meaning."

This definition would be most comprehensive and complete if it had included the area of nonfunctional features, because the Secondary Meaning Doctrine is not limited to a word or phrase acquiring a secondary meaning but may, as we shall see, attach to the nonfunctional features of products.

This writer will attempt to enumerate the various elements the courts have considered in ascertaining the existence or nonexistence of a secondary meaning in relation to a word, phrase, or nonfunctional feature (mark) concerning one's product. Attention will also be given to the remedy one has against infringement after a secondary meaning has been acquired, and the limitations of the doctrine.

In determining whether a secondary meaning has been acquired, it is generally held that the following are to be considered:[2]

I. *The length of time that the word, phrase, or mark has been used by the manufacturer or producer*

Generally, the acquisition of a secondary meaning does not occur suddenly but is acquired after a long period of continued user.[3] However, there are instances where although there was

[1] Merriam v. Saalfield, 198 Fed. 369 (6th Cir. 1912).

[2] *Cf.* Time, Inc. v. Life Television Corp., 123 F. Supp. 470 (D.C. Minn. 1954).

[3] Upjohn Co. v. Merrell Chemical Co., 269 Fed. 209 (6th Cir. 1920).

such continued user, a secondary meaning never came into existence.[4] For instance, it often occurs that the word, phrase, or mark is so descriptive of an entire field of business that it is never transformed into a mark of identification of a particular product. In such a situation the period of time the word, phrase, or mark was employed would be immaterial as to the creation of any rights in a particular manufacturer or producer. Thus, it may be said that while the element of time has some bearing on the creation of a secondary meaning as to a particular product, it is by no means conclusive.

II. *Nature and extent of advertising*

The extent to which the word, phrase, or mark is advertised will have a definite effect on the creation of a secondary meaning. The more intense the advertising campaign, the more probably a secondary meaning will evolve, in that the public will tend to associate the word, phrase, or mark with the product of the particular producer with which they most often see and hear it, thereby creating a definite, sensual relationship between the word, phrase, or mark and a particular product. Here again, however, the fact that there has been an extensive advertising campaign is not conclusive.[5] Secondary meaning is not proven simply by reference to advertising campaigns but it is simply another element to consider.[6]

III. *Prior user*

In the usual case a word, phrase, or mark will acquire a secondary meaning for the first producer or manufacturer who appropriates its use in point of time. This logically follows as he has the longer period of user which, as mentioned above, has a decided effect on the creation of a secondary meaning and will normally start proceedings against the junior user before he can validly claim that any secondary meaning has attached to his product. However, once again it is apparent that the element of prior user could not be conclusive in every case as to who has or has not acquired a secondary meaning in relation to his product.

It is conceivable that under certain circumstances the junior user may be the first to acquire a secondary meaning in relation to a

[4] Skinner Mfg. Co. v. General Food Sales Co., 52 F. Supp. 432 (D.C.D. Neb. 1943).

[5] A. & H. Transp. Inc. v. Saveway Stations, Inc., 214 Md. 325, 135 A.2nd 298 (1957).

[6] *Ibid.*

word, phrase, or mark. Consequently, the mere use of a word, phrase, or mark prior to a subsequent user will create no rights in the senior user unless a secondary meaning has actually developed.[7] In the last analysis it may be stated that while all of the foregoing elements have a definite bearing on the existence of a secondary meaning in relation to a particular person's product, whether such meaning actually exists will depend on public association of the word, phrase, or mark with a particular producer.

The next problem that concerns us is once one has acquired a secondary meaning concerning his product, what is the nature of his right and what protection is afforded? It has been said that once a secondary meaning is established by a preponderance of the evidence, it will be protected as a property right.[8] It is clear that the doctrine constitutes the creation of intangible property rights in that before the secondary meaning attached, the property right was nonexistent.

The protection offered the possessor, once a secondary meaning is established, is based on a common law right existing separate and apart from any trade mark act.[9] It would seem that insofar as secondary meaning does create a property right a showing of fraud or unfair competition would be unnecessary in order to enjoin its exploitation by another. If this were not so a property right could easily be destroyed or unwillingly "transferred" to another by his own wrongful conduct.

The legal means of protecting one's rights under the Secondary Meaning Doctrine is by an injunction forbidding its use[10] which may or may not be accompanied by consequential damages. Such relief prevents the "palming off" of goods as those of another, deception of the public, and trading on a reputation established by another.[11]

It is important to note some of the limitations and conditions bearing on the Doctrine of Secondary Meaning:

(A) If, in the first instance, the word, phrase, or mark was unlawfully appropriated, the existence of a secondary meaning is

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[7] Katz Drug Co. v. Katz, 188 F.2d 696 (8th Cir. 1951).

[8] Case cited note 3 *supra.*

[9] Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938).

[10] Lawyers Title Ins. Co. v. Lawyers Title Ins. Corp., 109 F.2d 35 (App. D.C. 1939).

[11] Eisenstadt Mfg. Co. v. J. M. Fisher Co., 232 Fed. 957 (D.C. R. I. 1916).

no justification for its continued use,[12] and such unlawful user will be enjoined.

(B) The exclusive right to use the word, phrase, or mark only extends to the area of its popularity.[13]

The second limitation is based on the proposition underlying the entire theory of secondary meaning, that is, a certain segment of the buying public associates the word, phrase, or mark with the product of a certain producer and consequently no secondary meaning and therefore no property rights exists beyond the limits of the business area of the possessor. It is believed that one who has acquired a secondary meaning in relation to his product should be protected beyond the actual limits of his business area to the extent of the area in which it is not unreasonable to assume his business may someday expand. Consequently, this would eliminate any infringement on the good will of an expanding business and prevent "palming off" by competitors.

(C) Secondary meaning can not extend to the area of functional features of a product.[14]

It would seem that this is a reasonable limitation in that a producer can not be expected to forego a superior product in favor of an inferior one because a prior producer had acquired a secondary meaning as to a functional element of his product. These matters are more properly protected under trade mark acts.

However, it is well settled that a nonfunctional feature of a product can acquire a secondary meaning which will be protected against an impingement by others.[15] The cases are in conflict as to what extent one may copy the nonfunctional features of another's products and the effect secondary meaning has on such appropriation.

The majority view holds that one may copy the nonfunctional features of another's product so long as they have not become so associated with one user to have acquired a secondary mean-

[12] Neva-Wet Corp. of America v. Never Wet Processing Corp., 277 N.Y. 163, 13 N.E.2d 755 (1938).

[13] Cohen v. Nagle, 190 Mass. 4, 76 N.E. 276 (1906).

[14] Coca Cola Co. v. Gay-Ola Co., 200 Fed. 720 (6th Cir. 1912).

[15] Crescent Tool Co. v. Kelborn & Bishop Co., 247 Fed. 299 (2nd Cir. 1917).

ing.[16] However, there are cases which forbid any imitation of nonfunctional features.[17]

It is believed that one should be allowed to copy nonfunctional features that have not acquired a secondary meaning unless it be established that such use was intended for the purpose of "palming off" a subsequent user's product for that of the original users so as to deceive the public and injure the business of the originator. Some cases have indicated that when one copies well-known nonfunctional features of another's product that the court may assume that the infringer intended to "palm off" his product as that of the originator's.[18] Such an assumption, however, would be without basis in many cases and consequently, an inference of this nature should not be so readily inferred, but should be made the subject of proof. It has also been held that the imitation by one manufacturer of the goods of another in name, appearance, marking, and color of packages, even if such similarities singly would not be unlawful if accompanied by good faith, may collectively constitute "unfair competition" where there is an actual purpose to deceive and defraud purchasers.[19]

In conclusion, it is apparent that the equitable Doctrine of Secondary Meaning in conjunction with the trade mark acts affords industry adequate protection against unscrupulous competitors and deters public deception which would otherwise go unchecked.

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[16] *Ibid.*

[17] Rushmore v. Manhattan Screw & Stamping Works, 163 Fed. 939 (2nd Cir. 1908).

[18] Enterprise Mfg. Co. v. Landers, Frary & Clark, 131 Fed. 240 (2nd Cir. 1904).

[19] Case cited note 14 *supra.*