Trademark Misuse in Dictionaries: Inadequacy of Existing Legal Action and a Suggested Cure

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TRADEMARK MISUSE IN DICTIONARIES: INADEQUACY OF EXISTING LEGAL ACTION AND A SUGGESTED CURE

GARY C. ROBB*

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INTRODUCTION

The Federal Trademark Act of 1946 (Lanham Act) provides that a trademark will lose its registered status "if the registered mark becomes the common descriptive name of an arti-

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Where trademark distinctiveness is a litigated issue, most courts find that the term has become "generic" if it is in general use by the buying public as a descriptive designation of the product rather than as an indication of origin. Because a generic listing of a trademark in a


"Trademark" is defined by the Act as "includ[ing] any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." 15 U.S.C. § 1127 ("Trademark"). For the functions of trademark protection see generally 1 J. McCarthy, Trademarks and Unfair Competition § 3B, at 86 (1973).

2. The issue may arise in litigation in several ways. Under 15 U.S.C. § 1064(c) "any person who believes that he is or will be damaged by the registration of a mark" may file a petition to cancel the mark's registration if that mark has become the "common descriptive name" of the product. Such petitioners will normally be business competitors but the FTC may petition for cancellation, also. Where the trademark owner brings an infringement suit, the infringer may raise as a defense the owner's abandonment of the mark. 15 U.S.C. § 1115(b)(2) (1976). Abandonment may result where the owner's conduct "causes the mark to lose its significance as an indication of origin"; i.e., the mark has become "generic." See, e.g., Leblanc Corp. v. H. & A. Selmer, Inc., 310 F.2d 449 (7th Cir. 1962), cert. denied, 373 U.S. 776 (1963) (defense that registered mark is merely descriptive used to defeat infringement suit).

Once the trademark becomes "generic" and its registration is cancelled, the term may be freely used by any competitor. 1 J. McCarthy, supra note 1, § 12:1, at 406. See also 3 R. Callman, Unfair Competition, Trademarks and Monopolies, at 224-25 (3d ed. 1969 & Supp. 1978).

Examples of once valid trademarks which have been cancelled for becoming the generic name of the product are aspirin, Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921), cellophane, DuPont Cellophane Co., Inc. v. Waxed Products Co., Inc., 85 F.2d 75 (2d Cir. 1936), thermos, King-Seely Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577 (2d Cir. 1963), and yo-yo, Donald F. Duncan, Inc. v. Royal Tops Manufacturing Co., Inc., 343 F.2d 655 (7th Cir. 1965).

3. The Lanham Act uses "common descriptive name" but "generic" has the same meaning. 1 J. McCarthy, supra note 1, § 12:18A, at 441. A trademark must identify goods and distinguish them from others. 15 U.S.C. § 1127 ("Trademark"). Once the term no longer identifies and distinguishes the goods so as to signify their origin but merely describes the type of product itself then the term can no longer serve as a trademark. It has lost its distinctiveness because the term fails to designate the source of the product and indicates only the general type. See 1 J. Gilson, Trademark Protection and Practice § 2.02 (1980 & Supp. 1980). Because of the frequent use of the term "generic" in this article, the quotation marks will no longer appear as the word will be used throughout with no specialized meaning.

4. The leading test of genericness was stated by Judge Learned Hand in Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921): "The single question, as I view it, in all these cases, is merely one of fact: What do buyers understand by the word for whose use the parties are contending?" The fact-finder must determine whether the buying public understands the term as designating a single source of
dictionary is significant evidence of this general public use,\(^5\) corporations have a large interest in preventing such a listing.\(^6\) However, the Lanham Act gives no statutory authority to proceed against noncompetitive, non-product generic use by another.\(^7\)

This article addresses one type of generic misuse involving the improper listing of registered trademarks in dictionaries. The article concludes that there is no legal remedy for a trademark holder against a dictionary publisher who improperly lists the holder's mark and suggests curative legislation.

Part I considers the merits of providing effective legal action to trademark owners against dictionary publishers in light of the available non-legal remedies. After concluding in Part I that there is a need for such a cause of action, Part II examines the existing sources of legal action against a dictionary publisher. Finally, Part III suggests legislation to enable a trademark holder to deal with dictionary misuse of his mark.

I. THE NEED FOR A LEGAL REMEDY AGAINST A DICTIONARY PUBLISHER

A dictionary listing of a trademark in a generic sense\(^8\) is

\(^{5}\) See note 9 infra and accompanying text.

\(^{6}\) After expensive advertising and promotion campaigns centered around a particular term, a mark becomes of great value to a corporation as a means of identifying its product and as a symbol of good will. S. Oppenheim & G. Weston, Unfair Trade Practices and Consumer Protection: Cases and Comments at 32-33 (3d ed. 1974). Consequently, a corporation will protect its trademark because of its substantial business value.


Other types of noncompetitive, non-product use are potentially harmful to the distinctiveness of a mark in addition to generic dictionary listings; e.g., use of the trademark in a generic sense in newspapers, books, magazines and trade journals is similarly outside of the statutory reach of the Lanham Act. 3 R. Callman, supra note 2 at 242 n.86, suggests the possibility of continuous generic misuse by a radio comedian against whom the corporate trademark owner would be without remedy even though such use may cause the public to understand the term in a generic way.

damaging evidence that the term has become the common descriptive name of the product.\textsuperscript{9} Even before litigation, the listing may induce writers, publishers and members of the buying public to use the trademark generically.\textsuperscript{10} Consequently, the improper dictionary listing may hasten the erosion and ultimate cancellation of the owner's proprietary rights in the mark.\textsuperscript{11} Although the Lanham Act requires the trademark owner to take action to maintain his mark's exclusiveness,\textsuperscript{12} it grants the owner no authority to proceed against such generic misuse.\textsuperscript{13}

To date, trademark owners have relied upon non-legal remedies to prevent or counteract the misuse of their mark by a dictionary publisher.\textsuperscript{14} The simplest course is objecting to the generic listing by writing letters of protest to the offending publisher.\textsuperscript{15} Yet, even if the publisher agrees to revise or strike for Coca-Cola, a trademark]." \textit{Id.} at 753 app. A generic listing is not corrected by an added indication that the term is also a registered trademark. Remarks of Mr. Hofstetter, \textit{id.} at 748.

9. 1 J. GILSON, supra note 3, at 2-14 to -16. Though courts and trademark tribunals differ as to the weight accorded a dictionary entry almost all consider such evidence relevant as helping to determine the meaning of the disputed term. \textit{See}, e.g., American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9 (D. Conn. 1962), aff'd, 321 F.2d 577 (2d Cir. 1963), where the court said: "[T]he fact that the word was being included in most dictionaries and the fact that the generic definition was occurring more and more often, evidenced the widespread growth of 'thermos' as a synonym for 'vacuum-insulated' in common usage particularly in connection with bottle, jug, jar and flask." 207 F. Supp. at 17.

Courts also make use of expert testimony, public testimony and consumer survey evidence in determining genericness. 1 J. GILSON, supra note 3, at 2-14 to -20.

10. Remarks of Mr. Kunin, 59 TRADEMARK REP., supra note 8, at 737.

11. Remarks of Mr. Hofstetter, \textit{id.} at 748.


Reasonable conduct under this provision may call for the trademark owner to discover generic uses by publications and protest such use. \textit{See} American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. at 17, where the court found the plaintiff corporation negligent for not seeking out and protesting generic uses of "thermos" by non-trade publications.

1 J. McCARTHY, supra note 1, § 12:19, at 423, suggests that a trademark owner should never be considered negligent for not suing a generic using publication "for the law appears to offer no sure basis on which to do so."

13. Lunsford, supra note 7, at 542.

14. \textit{See} Remarks of Mr. Hofstetter, 59 TRADEMARK REP., supra note 8, at 748. Mr. Hofstetter's statement that no trademark owner has initiated legal action against a dictionary publisher for generic misuse remains true today.

15. 3 R. CALLMAN, supra note 2, at 241. Many companies are reluctant to write
out the listing, the lengthy time between editions and the long useful life of a dictionary lessen the effectiveness of this self-help remedy.

The trademark owner might consider educational advertising as a method of strengthening his mark against the harmful effects of the generic listing.\textsuperscript{16} However, the effectiveness of such a campaign is doubtful and it may even work against the owner if the descriptiveness issue is litigated.\textsuperscript{17}

Foremost among the non-legal remedies is the service of the Committee on Dictionary Listings formed by the United States Trademark Association.\textsuperscript{18} The Committee acts as a general liaison between the dictionary publishers and the trademark owners in negotiations and maintains a file of preferred listings submitted by the owners which allows speedy inquiry by the publishers.\textsuperscript{19} The Committee has been successful in preventing the improper dictionary listing of many, though not all, registered trademarks.\textsuperscript{20} A working relationship with the publishers is crucial to the Committee's success and many major publishers remain in close contact but "where the dictionary publisher is unwilling to cooperate, nothing of a substantial nature can be done to force such cooperation."\textsuperscript{21} In any event, when the incorrect generic listing appears in a particular dictionary edition, the Committee is too late.

The trademark holder's interest in preventing a generic listing outweighs the interests of the dictionary publisher and

\textsuperscript{16} Such advertising seeks to educate the public as to the correct use of the trademark. 1 J. McCarthy, \textit{supra} note 1, § 12:19, at 422. \textit{E.g.}, "Our lawyers can present their entire case in 25 words or less. Xerox is a registered trademark. It identifies our products. It shouldn't be used for anything anybody else makes. Our lawyers figure 25 words or less to the wise should be sufficient." \textit{Time}, Sept. 19, 1969 at 37.

\textsuperscript{17} 1 J. Gilson, \textit{supra} note 3, § 2.02[7], at 2-28 to -29.

\textsuperscript{18} Lunsford, \textit{supra} note 7, at 542-43.

\textsuperscript{19} \textit{Id}

\textsuperscript{20} \textit{Id}

\textsuperscript{21} \textit{Id} at 543. See also Remarks of Mr. Patty, 59 \textit{TRADEMARK REP.}, \textit{supra} note 8, at 745.
the public in listing it. If the mark is repeatedly misused by a dictionary publisher the trademark owner must helplessly stand by and watch his mark deteriorate. Therefore, to preserve the distinctiveness of his valuable trademark under the Lanham Act, a trademark owner must have some effective legal remedy to stop generic misuse of his trademark by a dictionary publisher.

II. EXISTING LEGAL ACTION AGAINST DICTIONARY MISUSE OF TRADEMARKS

As this article argues that there is need for a legal remedy against generic listings of a trademark by a dictionary publisher, this section surveys the existing sources of such a cause of action.

A. The Lanham Act

Although it provides for the cancellation of a mark when it becomes generic, the Lanham Act gives no statutory remedy to trademark holders to prevent noncompetitive, noncommercial generic misuse. The Act affords the registrant a remedy

22. The publisher's interest in including a trademark definition is based on his desire to produce a competitive product. Remarks of Mr. Mitchell, 59 TRADEMARK REP., supra note 8, at 738-42. The creation of a legal remedy against generic listing will eliminate this competitive interest because any offending publisher would be sued by the trademark owner, thus negating whatever competitive advantage sought. See note 43 infra regarding the burden of an injunction on a dictionary publisher.

The public interest in freedom of speech and ideas will not be impaired by requiring a dictionary publisher to accurately list the term as a registered trademark. Maintaining the distinctiveness of a corporation's trademark benefits the public because the consumer is better able to identify a particular product. See 1 J. McCarthy, supra note 1, § 2:12, at 76-77.

The interest of the trademark holder, see note 6 supra, is preserving the trademark and its tremendous business value.

23. See Lunsford, supra note 7, at 542. ("If courts recognize that a trademark owner is damaged because of the use of the same or confusingly similar mark, how can they fail to be cognizant that potentially greater harm can result from repeated misuse of a mark?") (footnote omitted) (emphasis added).

24. 1 J. McCarthy, supra note 1, § 12:19, at 422. No action is available for noncompetitive confusion because the Act limits the test to infringers. 15 U.S.C. § 1114(1) (as amended). This section requires that confusing use of the mark be "use in commerce" which is defined as use of the mark on goods when sold or transported or on services when used for display or advertising purposes. 15 U.S.C. § 1127. Because the Act requires the likelihood of confusion, dilution will not be actionable as a type of infringement. See 1 J. Gilson, supra note 3, § 5.05[9], at 5-45 to -46.

See Note, 77 HARV. L. REV. 520, at 524-26 (1964) [hereinafter cited as Note], for
against competitors who use a confusingly similar mark but fails to protect him against continued generic misuse of his identical mark.

B. State Antidilution Statutes

Seventeen states have enacted antidilution statutes which provide for injunctive relief against "likelihood of injury to business reputation or of dilution of the distinctive quality of a mark . . . notwithstanding the absence of competition between the parties or the absence of confusion as to the source of the goods or services." The purpose of these statutes is to extend protection of a trademark beyond the Lanham Act by allowing an injunction against nonconfusing use of the mark by noncompetitors which affects the trademark's distinctiveness.

an excellent discussion of the scope of trademark protection provided by the Lanham Act.

26. Model State Trademark Bill § 12 (as amended through December 1964), reprinted in 2 J. Gilson, supra note 3, § 10.03, at 10-199 app. reads in full:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this Act, or a mark valid at common law, or a trade name valid at common law shall be ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of the goods or services.

Id.

The statutes are substantially alike as most states have followed the antidilution provision of the Model State Trademark Bill. See generally Pattishall, The Dilution Rationale for Trademark—Trade Identity Protection, Its Progress and Prospects, 67 TRADEMARK REP. 607 (1977).

This section of the article deals only with the dilution provision of the state antidilution statutes. The "injury to business reputation" provision of the antidilution statutes has not been given much attention by the courts. See 1 J. Gilson, supra note 3, § 5.05[2], at 5-30 n.10. Corporate plaintiffs still rely on the common law remedy of commercial disparagement in dealing with persons causing harm to their business reputation. See Part II.C.1 infra; 3 R. Callman, supra note 2, at 962-63.


27. See 1 J. Gilson, supra note 3, § 5.05[9], at 5-41; 2 J. McCarthy, supra note 1, § 24:13A, at 155. If the defendant's use of the trademark does not involve a likelihood
An antidilution statute, on its face, seems to provide a basis for action against a noncommercial generic user such as a dictionary publisher and many commentators favor this extended application of the statute. Callman states that the dilution doctrine fundamentally involves the loss of a trademark's distinctiveness by another's repeated use and this approach includes incorrect generic dictionary listings. However, courts are presently reluctant to apply the antidilution statutes to noncompetitive, commercial uses. Thus, it is not likely that they will further extend the statutes to noncompetitive, noncommercial uses such as improper dictionary listings.

The leading example of the general judicial nonacceptance of antidilution statutes is Girl Scouts of the United States v. Personality Posters Mfg. Co., where the court denied injunctive relief because of the absence of confusion despite the clear language of the New York antidilution statute that confusion is not required. Most courts agree with Girl Scouts of confusion per 15 U.S.C. § 1114(1), then no action for trademark infringement will lie under the Lanham Act.

28. See text at notes 41-43, infra.

29. See, e.g., 3 R. Callman, supra note 2, at 954-57; 2 J. McCarthy, supra note 1, § 24:13E, at 161 ("The dilution doctrine could, and should, be available for this [generic misuse] purpose"); Lunsford, supra note 7, at 544; Remarks of Mr. Hofstetter, 59 Trademark Rep., supra note 8, at 748.

Derenberg, The Problem of Trademark Dilution and the Antidilution Statutes, 44 Cal. L. Rev. 439 (1956), commenting on the enactment of antidilution statutes in four states, observes:

[I]t would seem clear that this language is broad enough not only to include the traditional case of dilution heretofore discussed, in which the uniqueness of a trademark may be impaired as a result of trademark use by others of the same mark on totally unrelated goods, but might also be resorted to to give some measure of relief in the far more serious and frequent cases of dilution through public use leading to a gradual loss of distinctiveness of a well known trademark.

Id. at 463 (emphasis added).

30. 3 R. Callman, supra note 2, at 954. Callman, in an oft-quoted passage, states:

The gravamen of a dilution complaint is that the continuing use of a mark similar to the plaintiff's will inexorably have an adverse effect upon the value of the plaintiff's mark, and that, if he is powerless to prevent such use, the plaintiff's mark will eventually be deprived of all distinctiveness.

Id.


32. 304 F. Supp. at 1233. In denying the injunction, the court stated: "Despite the seeming intention of this statute to confer protection where the federal Lanham Act might not, viz., even where there is no confusion as to the origin of the goods, the courts have denied relief where confusion is absent." Id. (citations omitted).
and require satisfaction of the traditional likelihood of confusion test under the Lanham Act. Even where there is confusion or the parties are in actual competition, some courts hold that the statute is inapplicable since an action for trademark infringement under the Lanham Act could then be brought. For various reasons, the concept of dilution "largely has

33. 3 R. Callman, supra note 2, at 957-58 and at 177-78 (Cum. Supp. 1978). See, e.g., Cue Publishing Co., Inc. v. Colgate-Palmolive Co., 45 Misc. 2d 161, 256 N.Y.S. 2d 239, aff'd, 259 N.Y.S. 2d 377 (1965) where the court refused to grant an injunction because to "give effect to the dilution doctrine some measure of confusion must be present . . . ." Id. at __, 256 N.Y.S. 2d at 245.

Callman argues that: "Unless recovery for dilution is allowed without reference to competition or confusion, the legislative mandate of the antidilution statutes will be frustrated . . . ." 3 R. Callman, supra note 2, at 178 (Cum. Supp. 1978).

But see Allied Maintenance Corp. v. Allied Mechanical Trades, Inc., 45 N.Y.2d 538, 369 N.E.2d 1162, 399 N.Y.S. 2d 628 (1977), where the New York Court of Appeals stated:

Notwithstanding the absence of judicial enthusiasm for the antidilution statutes, we believe that sec. 368-d [the New York antidilution statute] does extend the protection afforded trade-marks and trade names beyond that provided by actions for infringement and unfair competition. The evil which the Legislature sought to remedy was not public confusion caused by similar products or services sold by competitors, but a cancer-like growth of dissimilar products or services which feeds upon the business reputation of an established distinctive trademark or name. Id. at 544, 369 N.E.2d at 1165, 399 N.Y.S.2d at 632.

34. 1 J. Gilson, supra note 3, § 5.05[9], at 5-42. See also Pattishall, supra note 26 at 613-14. Courts also restrict the protection of the antidilution statutes by requiring that the trademark be a "strong mark." 2 J. McCarthy, supra note 1, § 24:14, at 162-64.

35. Courts and commentators have cited many reasons for the judicial reluctance to apply the state antidilution doctrine in the absence of confusion or competition. The difficulty of applying the state statute in conjunction with the federal Act is one explanation of why judges fail to apply the state act strictly. Note, supra note 24, at 528-29. This difficulty may join with the courts' desire to avoid the thorny problem of federal preemption. Id. Whether a state has power to provide additional statutory protection normally involves difficult constitutional questions where the federal act is within the constitutional authority of Congress. Developments in the Law—Competitive Torts, 77 Harv. L. Rev. 888, 943 (1964) [hereinafter cited as Developments]. But this constitutional question should not arise because there is no reason to believe that Congress intended the Lanham Act to preempt the area of trademark protection thus nullifying the state antidilution statutes. 1 J. Gilson, supra note 3, § 5.05[9], at 5-45 to -46. Although there is nothing in the Lanham Act itself indicating preemption, when the Lanham Bill was reported, the Senate Committee on Patents said that "the purpose of this bill is to place all matters relating to trademarks in one statute and to eliminate judicial obscurity . . . ." S. Res. 1333, 79th Cong., 2d Sess. (1943). Most courts have tacitly accepted the position that the Lanham Act does not preempt additional trademark protection afforded by the state. Note, supra note 24, at 189.

Another reason cited for the judicial nonacceptance of the antidilution statutes is
been ignored by the courts despite the plain dictates of the statutes."

Some courts, however, have applied the antidilution statute without requiring likelihood of confusion or competition and this appears to be the trend even though most have used the statute only as an alternative ground for relief. In *Bristol-Meyers Co. v. R. H. Macy & Co.*, the court expansively construed the New York antidilution statute in granting an injunction against a generic user of the plaintiff's

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their vagueness. The term “dilution” is nowhere defined, *Pattishall*, *supra* note 26, at 617, and the statutes are silent as to the likelihood of confusion. *1 J. Gilson, supra* note 3, § 5.05[9], at 5-42. The inherent fuzziness of the dilution concept makes judges hesitant to deal with it. *2 J. McCarthy, supra* note 1, § 24:13B, at 156.

Callman points to the “judicial unwillingness to recognize a trademark as property and an understandable antipathy to modern advertising,” *3 R. Callman, supra* note 2, at 960, as factors affecting the courts’ reluctance to apply the dilution statutes. He also suggests that the traditional connection of trademark protection to unfair competition may account for part of the hostile reaction to dilution. *Id.* at 959.

Uncertainty as to the desirability of additional trademark protection may be a factor. Note, *supra* note 24, at 528. The public interest is less affected where confusion is absent and the interests of the noncompetitive user may be substantial. *Id.* at 529.

Finally, Pattishall suggests that the courts are fearful of the potential abuse of antidilution statutes. *Pattishall*, *supra* note 26, at 615-16. Their concern is that large corporations will gain an unfair advantage over small businesses by strictly enforcing the distinctiveness of their trademarks and that free speech will be impaired. *Id.*

Whatever the reasons for the judicial reaction against state antidilution statutes (other than constitutional objections), they should not be relevant in light of the legislature’s clear policy determination that such statutes are desirable.

36. *Pattishall, supra* note 26, at 610.
37. *E.g.*, *Polaroid Corporation v. Polaroid, Inc.*, 319 F.2d 830 (7th Cir. 1963). This case is the leading judicial acceptance of a state antidilution statute because the court applied the provision unfettered by Lanham Act requirements stating that: “If the Anti-dilution Statute is not applicable to this situation, it is useless because it adds nothing to the established law on unfair competition . . . .” *Id.* at 837.

*See also* cases cited in *Pattishall, supra* note 26, at 611 n.30.
38. *2 J. McCarthy, supra* note 1, § 24:13D, at 159. “[I]n more recent cases, some courts are beginning to appreciate and enforce the dilution approach.” *Id.*
39. *1 J. Gilson, supra* note 3, § 5.05[9], at 5-44. *See, e.g.*, *Polaroid Corp. v. Polaroid, Inc.*, *supra* note 37.
41. The opinion in *Bristol-Meyers Co. v. R. H. Macy & Co.*, *id.*, nowhere indicates reliance upon the New York antidilution statute but this article assumes, as have many commentators, that the court applied the antidilution statute without explicit reference thereto. *See, e.g.*, *1 J. Gilson, supra* note 3, § 2.03, at 2-29 n.89; Remarks of Mr. Hofstetter, 59 TRADEMARK REP., *supra* note 8, at 748. *S. Oppenheim & G. Weston, supra* note 6, at 125 n.69. *Contra* 3 R. *Callman, supra* note 2, at 243 n.87, where the author states: “This was a typical case of comparative advertising.” *Id.*
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trademark. Although competing products were involved, the court came close to adopting the Callman interpretation of dilution in holding that, "Defendant is also guilty of diluting the distinctive quality of plaintiff's trademark 'Bufferin' by tending to render it generic and descriptive." But to date no court has applied an antidilution statute to noncompetitive, nonproduct generic use.

Although the state antidilution statutes "do seem to provide a basis for proceeding against the inaccurate definition of trademarks in dictionaries," the restrictive reading given them by most courts prevents a trademark holder from having a cause of action against a generic misuser. If he is to have a legal remedy, the aggrieved trademark holder must look elsewhere, for state antidilution statutes will not help him.

C. Common Law Tort Actions

Several commentators have suggested that a common law tort action be considered against an offending dictionary publisher where the mark is protected under the Lanham Act. The tort actions most applicable to the generic listing of a trademark by a dictionary publisher are defamation, commercial disparagement, interference with contractual relations, interference with prospective advantage and interference with property.

42. 151 F. Supp. at 514.
43. See 2 J. McCarthy, supra note 1, § 12:9, at 422.

Courts would probably be reluctant to apply an antidilution statute to a dictionary publisher because of the burden on him. The point in time at which injunctive relief is sought would be an important consideration. Correcting a listing at the publishing stage is far different from recalling purchased editions or sending out corrective statements. For a discussion of the corrective remedy, see Lunsford, supra note 7, at 543.

44. Lunsford, supra note 7, at 544.
45. See, e.g., Remarks of Mr. Hofstetter, 59 Trademark Rep., supra note 8, at 748-49; 3 R. Callman, supra note 2, at 242-43 & n.86.

46. Other common law torts might be considered as sources of an action by a trademark holder against a dictionary publisher but for the purposes of this article only those listed are worthy of treatment. This section deals mostly with intentional torts as where the dictionary publisher was informed of misuse but took no corrective action. This would generally be the case since a trademark holder should only resort to legal action where non-legal remedies, such as objection, have failed.
1. Defamation

The initial problem for a trademark holder bringing a defamation action against a dictionary publisher would be to categorize the generic dictionary listing as a defamatory communication. A corporation is defamed only if the statement reflects adversely upon its integrity or "business character." The generic listing of a trademark does not harm the business reputation of the holding corporation.

A further difficulty facing the trademark owner is presented by the solid defenses available for the dictionary publisher who has negligently or intentionally listed a registered trademark as a generic term. Truth would be the publisher's primary defense as he would be free to show that the term was correctly listed as a generic term. In addition, the usual tort defenses of acquiescence, laches and abandonment would be available to the dictionary publisher.

The publisher could also assert the constitutional privileges afforded the mass media for false defamatory statements. Since a corporation is not a "public figure," the standard announced by the Supreme Court in Gertz v. Robert Welch, Inc. would apply. Thus, the dictionary publisher would be liable only if he was negligent in listing the mark as a generic term. However, if a court determined that a trademark owning corporation was a "public figure," then the stronger constitutional privilege of New York Times Co. v. Sullivan could be used by the dictionary publisher. Under

47. See W. Prosser, THE LAW OF TORTS § 111 (4th ed. 1971) [hereinafter cited as Prosser], for an excellent discussion of the required elements for a cause of action in defamation.
48. Id. at 745.
49. See Remarks of Mr. Hofstetter, 59 TRADEMARK REP., supra note 8, at 749.
50. Id.
51. See Prosser, supra note 47, at 823-24. The courts have thus far limited "public figures" to living persons, but corporations are capable of satisfying the "public figure" tests of going public or seeking publicity and this may influence a future court to categorize a corporation as a "public figure." Id. See also the Court's discussion of "public figure" in the companion cases of Associated Press v. Walker and Curtis Publishing Co. v. Butts, 388 U.S. 130 (1967).
52. 418 U.S. 323 (1974). The Court held in Gertz that a private person could not maintain an action for defamation against a mass medium unless that medium was at least negligent in publishing the defamation.
53. See note 51 supra.
54. 376 U.S. 254 (1964). The Supreme Court, in the Sullivan case, gave a constitu-
this privilege, the publisher could not be found liable unless he acted with knowledge that the generic listing was false or with reckless disregard for its truth.

A defamatory action brought against a dictionary publisher for listing the plaintiff’s trademark as a generic term, absent extraordinary circumstances, could not succeed. Even if defamation was broad enough to encompass generic misuse of trademarks, the unavailability of an injunction renders relief inadequate as damages may not compensate for the ultimate loss of the trademark.

2. Commercial Disparagement

The tort of commercial disparagement provides for an action against persons who intend to and do cause pecuniary loss to a business enterprise by publishing falsehoods which reflect upon the quality of the business’ goods. This intent requirement is the first of several roadblocks lying in the way of a trademark holder who wishes to use commercial disparagement against a dictionary publisher. The trademark owner would have to prove an “improper intent” by the publisher to cause him financial harm. This would be futile since the publisher is merely advancing his own legitimate interests.

55. Where the dictionary definition of the trademark expressly defames the integrity or reputation of the holder, there would be a good cause of action in defamation, assuming that the other elements are satisfied. E.g., Coke [ pronunciation], n., Trademark, a dark-colored, carbonated soft drink produced by persons who murder babies and never pay the bills [short for Coca-Cola, a trademark].

56. See Developments, supra note 35, at 893.

57. This tort action has also been called “injurious falsehood,” “trade libel,” “disparagement of property,” “slander of goods” and “disparagement of quality.”

58. See Developments, supra note 35, at 893; Prosser, supra note 47, at 915-17. Though similar to defamation, disparagement focuses upon harm to economic relations rather than to reputation alone. Prosser, supra note 47, at 917.

59. Developments, supra note 35, at 895. Many courts still speak of a “malice” requirement for disparagement but this is normally satisfied by any sort of bad faith. Id. Several commentators have argued for the elimination of this intent requirement. See, e.g., Smith, Disparagement of Property, 13 Colum. L. Rev. 121, 137-39 (1913); Restatement of Torts §§ 626, 628 (1938). Both would allow the action based on the reasonable foreseeability of harm alone.

60. Even though disparagement is generally applicable to trademarks, Prosser, supra note 47, at 918-19, the tort is rarely applied outside of the context of unfair
Another obstacle for the trademark holder is characterizing the generic listing of his trademark as a false criticism of his product’s quality. Even where other products falling within the generic definition are inferior to the trademark owner’s own, the dictionary publisher has made no false statement reflecting upon the quality of the trademark owner’s product.61

As disparagement, like defamation, is not a ground for injunctive relief, the only remedy is in damages.62 But unlike defamation, disparagement limits recovery to special damages which must be pleaded and proved.63 This requirement involves proof of causation64 which could easily thwart the trademark holder’s action considering the use made of dictionary listings in trademark litigation.65

Furthermore, all of the common law defenses and constitutional privileges in defamation cases would be open to the dictionary publisher in a disparagement suit.66 In view of these available defenses and the problems of satisfying the prima facie elements of the action, commercial disparagement is at best a doubtful source of legal action by a trademark owner against generic use of his mark by a dictionary publisher.

61. The decision to list the trademark as a generic term may be treated as a statement of opinion such that the only question becomes whether the dictionary publisher believed that the entry was correct. See Developments, supra note 35, at 895 (emphasis added) (footnote omitted).

62. See Developments, supra note 35, at 902-05.

63. Id. at 899-900.

64. Id. at 901. If the plaintiff in disparagement can show an indirect loss by a drop in sales, most courts will allow recovery if “the causal relationship with the defendant’s statement can adequately be shown.” Id.

65. See note 9 supra and accompanying text.

66. Prosser, supra note 47, at 924. See notes 51-54 supra.
3. Interference with Contractual Relations

Liability for interference with contractual relations requires an intentional interference with an existing contract and this intent requirement poses the greatest problem for a trademark holder who would use this action against a dictionary publisher for the improper generic listing of his trademark. Though a few commentators have argued that negligence should be enough, almost all courts require that the interference be intentional. Since a dictionary publisher normally does not know of any contractual relations entered into by the trademark owner with which his generic listing would interfere, he cannot have intended any interference. Even if the publisher were aware of contracts entered into by the trademark owning corporation his actions would be privileged because his primary purpose is to seek his own unrelated advantage.

In addition, the usual tort element of causation immensely narrows the cause of action. It is difficult to imagine situations where an improper generic dictionary listing would be “a substantial factor in the failure of one of the parties to perform his obligations under the contract.” Consequently, the action


68. See, e.g., Harper, supra note 67, at 884-93. (“It should be enough to establish a prima facie case if the defendant, as a reasonable man, should have known of the likelihood of the existence of the contract and thereafter created an unreasonable risk of interfering with it.”) Id. at 886.


But for the privilege and causation factors, see notes 70 & 71 and accompanying text infra, the trademark holder would probably have grounds for an action in interference with contractual relations if negligence alone were enough.

70. See Prosser, supra note 47, at 942-46 for a discussion of privilege as a defense to liability against interference with contractual relations.


There are two ways a defendant may cause an interference with another’s contract: (1) He may physically or by some other tortious means prevent performance by a willing promisor or (2) induce one of the parties to enter into an inconsistent obligation or break the contract altogether. See Developments, supra note 35, at 960; Prosser, supra note 47, at 934-38. Situations are at least imaginable which would place the dictionary publisher who incorrectly lists a trademark as a generic term in the second category of interference. For example, even though the bulk of consumer transactions consist of executed contracts a purchaser in an executory contract might
fails to provide an aggrieved trademark holder with an adequate remedy.

4. Interference with Prospective Advantage

The similarity of interference with prospective advantage to interference with contractual relations renders the obstacle of intent fully applicable where the trademark holder would base his action against the dictionary publisher on interference with prospective advantage. The tort extends the liability of interference with contractual relations to situations where there is no existing contract but only the potential for economic gain. Thus, causation would be less difficult but the trademark holder would still have to show that the generic listing caused future purchasers of his product to opt for other brands thus depriving him of the opportunity of doing business. Mitigating this broader applicability is the more extensive privilege afforded defendants in interference with prospective advantage suits. A dictionary publisher need only assert his privilege to fully compete in the marketplace to defeat a trademark holder's action under this theory.

5. Interference with Property

The courts are not resolved as to whether a trademark should be classified as a form of property and those which do recognize it as such differ widely as to the amount of protection granted. Nevertheless, the courts are agreed that a registered trademark is not property subject to an action for con-

see the dictionary listing and break the contract under the belief that the producer is not the owner of an exclusive product or that other producers of the generic good will be less expensive.

72. See notes 67-69 supra and accompanying text.

73. See Prosser, supra note 47, at 949-59 & n.52. "The cause of action [interference with prospective advantage] has run parallel to that for interference with existing contracts." Id. at 952.

74. For a general discussion of interference with prospective advantage, see Prosser, supra note 47, at 949-69.

75. See id. at 949-51.

76. Id. at 754.

77. The privilege of competition is given special recognition by the courts. Id. at 954-62.

78. See generally 1 J. McCarthy, supra note 1, § 2:6, at 54-57; 3 R. Callman, supra note 2, at 28-47.
Accordingly, a trademark owner cannot base an action on the common law tort of interference with property.

III. SUGGESTED LEGISLATION FOR PROTECTION OF TRADEMARK OWNERS AGAINST GENERIC DICTIONARY LISTINGS

The need for effective legal action against the generic misuse of one’s trademark by a dictionary publisher and the inadequacy of existing causes of action point to a deficiency in the source of trademark protection: the federal Lanham Act. To rectify this protective gap, the Lanham Act should be amended to include a provision providing for a cause of action for trademark infringement against anyone that repeatedly uses a registered trademark in a manner which causes it to lose its significance as an indication of origin.

The nonspecification of a remedy would allow the courts to determine the fairest and most appropriate remedy in each instance. Freedom of speech objections made by critics of similar Lanham Act provisions are answered by the action’s limitation to mass media, the requirement that the generic use be repeated and the rigorous causation requirement. Such an amendment would give the trademark holder a way to prevent the transformation of his mark into a generic term which normally results from its inclusion in a dictionary as a descriptive word.

79. Only those intangible rights which can be represented by a document are subject to an action for conversion. See Prosser, supra note 47, at 81-83.
80. See Part I supra.
81. See Part II supra.
82. Similar provisions have been included in bills to amend the Lanham Act. See the Hawkes Bill, S. 1919, 80th Cong., 1st Sess. (1947); the Wiley Bill, S. 2540, 83d Cong., 1st Sess. 16 (1953).
Other commentators have called for legislation providing a remedy for a trademark holder against a generic misuser of his mark. See, e.g., Lunsford, supra note 7, at 545 & 547.

84. See notes 8-11 supra and accompanying text.
IV. CONCLUSION

The law offers no legal remedies to the hapless trademark owning victim of generic misuse. Where a dictionary publisher refuses to list a trademark as a registered mark or even to indicate its registered status, the trademark holder can do little to prevent his mark from becoming a "common descriptive name"\textsuperscript{85} subject to cancellation under the Lanham Act. This article suggests a curative amendment to the Lanham Act providing for a remedy against generic misusers of a trademark under narrow circumstances. Such legislation would enable a trademark owner to proceed against a dictionary publisher who lists his valuable mark as a generic term and thereby preserve the mark's distinctiveness as an indication of origin of his, and only his, product.

\textsuperscript{85} 15 U.S.C. § 1064(c) (1946) (as amended).