

Trademarks--Unfair Competition--Injunction (Time, Inc. v. Life Color Laboratory, Inc., 279 App. Div. 51 (1st Dep't 1951))

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The only apparent reason for the immunity rule is precedent, and the precedent in this country is questionable.¹⁸

Courts are faced with a choice: either to continue to enforce a common law doctrine of dubious ancestry¹⁹ under the drastically changed circumstances of present day life;²⁰ or to recognize the rights of the child by allowing it a cause of action against its parents.²¹ The preferable choice would appear to be to modify the parental immunity rule by restricting it to the home;²² and by permitting recovery in cases where the injury was negligently inflicted by a person who was acting in some capacity other than as parent.²³



TRADEMARKS—UNFAIR COMPETITION—INJUNCTION.—Plaintiff publishes a pictorial magazine of nation-wide circulation, displaying on its cover the registered trade mark "Life" in white block letters on a red background. In 1947 defendant opened a mail order business developing color film, and advertised in photography magazines under the name of "Life Color Labs." Defendant's title was in black and white, with the word "Life" given the same prominence as the other words. Plaintiff sought an injunction and an accounting. Although the parties were not engaged in competing businesses, and it was unlikely that their products would be confused, Special Term granted the injunction.¹ *Held*, reversed. An injunction will not

¹⁸ See note 12 *supra*. The Mississippi court, which established the precedent for the rule in the United States, either failed or was unable to cite any sound authority for its position denying suits against parents. The necessity of the court's statement of the "rule" is also debatable.

¹⁹ *Ibid*.

²⁰ See text at note 12 *supra*. *But see* Cannon v. Cannon, 287 N. Y. 425, 430, 40 N. E. 2d 236, 238 (1942).

²¹ See note 8 *supra*. *But cf.* Cannon v. Cannon, 287 N. Y. 425, 40 N. E. 2d 236 (1942); Boehm v. C. M. Gridley & Sons, 187 Misc. 113, 63 N. Y. S. 2d 587 (Sup. Ct. 1946); *cf.* Hewellette v. George, 68 Miss. 703, 9 So. 885, 887 (1891).

²² "Since parental discipline and control and the conduct of the domestic establishment are at the root of the denial of a cause of action, it would seem that the denial should, at least, be so confined. . . ." McCurdy, *supra* note 4, at 1080. *Cf.* Foy v. Foy Electric Co., 231 N. C. 161, 56 S. E. 2d 418 (1949); Wright v. Wright, 229 N. C. 503, 50 S. E. 2d 540 (1948); Cowgill v. Boock, 189 Ore. 282, 218 P. 2d 445 (1950). *But cf.* Cannon v. Cannon, 287 N. Y. 425, 40 N. E. 2d 236 (1942); Thickman v. Thickman, 83 N. Y. S. 2d 284 (Sup. Ct. 1949). The word "home" could be restricted to include *only* the actual physical dimensions of the domicile, or such activities as the members of the family engage in as a cohesive unit, *e.g.*, a Sunday picnic.

²³ *Cf.* Dunlap v. Dunlap, 84 N. H. 352, 150 Atl. 905 (1930); Worrell v. Worrell, 174 Va. 11, 4 S. E. 2d 343 (1939); Lusk v. Lusk, 113 W. Va. 17, 166 S. E. 538 (1932).

¹ Time, Inc. v. Life Color Laboratory, 198 Misc. 1038, 101 N. Y. S. 2d 586 (Sup. Ct. 1950). The court denied the accounting, there having been no proof of injury or damage to plaintiff.

issue to protect a trade mark right where the parties are not business competitors, and where the evidence does not show possible public confusion of the origin of the products. *Time, Inc. v. Life Color Laboratory, Inc.*, 279 App. Div. 51, 107 N. Y. S. 2d 957 (1st Dep't 1951).

A common law² trade mark right is acquired by the prior appropriation³ and user⁴ of a distinctive,⁵ fanciful or arbitrary⁶ designation. A word merely descriptive,⁷ generic⁸ or geographical⁹ cannot qualify as a trade mark unless, through extended use, it has become so associated with a product in the public mind that it may be said to have acquired a "secondary meaning."¹⁰

² A trade mark right at common law was entitled to essentially the same protection as a registered trade mark. In *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 543 (1920), it was stated: "The Registration Act . . . without changing the substantive law of trade-marks, provided . . . for the registration of marks . . . which, without the statute, would be entitled to legal and equitable protection. . . ." See *American Steel Foundries v. Robertson, Commissioner*, 269 U. S. 372, 380, 381 (1926); *Waldes v. International Mfrs.' Agency, Inc.*, 237 Fed. 502, 506 (S. D. N. Y. 1916).

³ *Atlas Beverage Co. v. Minneapolis Brewing Co.*, 113 F. 2d 672 (8th Cir. 1940); *Tillman & Bendel, Inc. v. Calif. Packing Corp.*, 63 F. 2d 498 (9th Cir. 1933); *accord*, *Hygienic Products Co. v. Judson Dunaway Corp.*, 81 F. Supp. 935 (D. N. H. 1948), *rev'd on other grounds*, 178 F. 2d 461 (1st Cir. 1949).

⁴ *United Drug Co. v. Theodore Rectanus Co.*, 248 U. S. 90 (1918); *Esso, Inc. v. Standard Oil Co.*, 98 F. 2d 1 (8th Cir. 1938).

⁵ See *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 673 (1901).

⁶ The mark itself must ordinarily indicate that it has been arbitrarily selected; it cannot be a mere descriptive term. In *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U. S. 251, 256, 257 (1916), the Court, referring to the term "The American Girl" as used to designate a brand of shoes, stated that the appellation was ". . . fanciful . . . arbitrarily selected . . . to designate shoes. . . ." See also *RESTATEMENT, TORTS* § 715, comment *c* (1938); see *Triangle Publications, Inc. v. Rohrlich*, 167 F. 2d 969, 972 (2d Cir. 1948).

⁷ *Caswell v. Davis*, 58 N. Y. 223 (1874); *Amoskeag Manufacturing Co. v. Spear & Ripley*, 2 Sandf. 599 (N. Y. 1849).

⁸ *Kochler v. Sanders*, 122 N. Y. 65, 25 N. E. 235 (1890); *cf.* *Ball v. Broadway Bazaar*, 194 N. Y. 429, 85 N. E. 674 (1909).

⁹ *Canal Co. v. Clark*, 13 Wall. 311, 324 (U. S. 1871). "They [geographical designations] point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies." See also *RESTATEMENT, TORTS* § 720 (1938).

¹⁰ The "secondary meaning" theory ". . . contemplates that a word . . . originally . . . incapable of exclusive appropriation . . . might nevertheless have been used so long and so exclusively . . . that . . . the word . . . had come to mean that the article was his product. . ." *Merriam Co. v. Saalfield*, 198 Fed. 369, 373 (6th Cir. 1912), *aff'd*, *Saalfield Pub. Co. v. Merriam Co.*, 238 Fed. 1 (6th Cir. 1917). Secondary meaning will usually attach to a geographical term only after protracted association. See *Sun Valley Mfg. Co. v. Sun Valley Togs, Inc.*, 39 F. Supp. 502 (S. D. N. Y. 1941) (failure to establish secondary meaning; corporate name). Some words seemingly never acquire a secondary meaning for trade mark purposes. See *Skinner Mfg. Co. v. General Foods Sales Co.*, 52 F. Supp. 432, 448 (D. Neb. 1943) ("*Raisin Bran*": *Held*, no secondary meaning despite long advertising campaigns and lack

Formerly, equitable relief was restricted to situations where the parties were in direct competition,¹¹ and where the defendant had "passed off" his goods for those of the plaintiff by use of a deceptively similar mark.¹² "Passing off," however, did not necessarily imply an intent to deceive the public.¹³ The gravamen of the proceeding was the harmful result, rather than the subjective intent of the defendant.¹⁴

Later cases have shifted the emphasis from the theft of trade, by use of deceptive markings, to the destruction of good will.¹⁵ The theory has been advanced that a trade mark is a creator of good will,¹⁶ rather than a mere identification of the product. Thus, injunctive relief has been predicated upon the "dilution" or "whittling away"¹⁷ of good will which was established by the long association of the public with the plaintiff's mark. Although the parties are not competitors, it is still possible that the public will be confused as to the source of the defendant's product.¹⁸ The plaintiff's reputation would thus be jeopardized since any defects in defendant's product could be associated with plaintiff's name.¹⁹

of competition in field). The word "Life" appears to be of the type which acquires secondary meaning if at all only after many years of exclusive use. *See Time, Inc. v. Life Color Laboratory, Inc.*, 279 App. Div. 51, 52, 107 N. Y. S. 2d 957, 958 (1st Dep't 1951). "... nor do we think that plaintiff has acquired a secondary meaning in the word 'Life' in the field of photography to the extent that its use as part of the name of defendant would constitute unfair competition."

¹¹ *General Baking Co. v. Goldblatt Bros., Inc.*, 90 F. 2d 241 (7th Cir.), *cert. denied*, 302 U. S. 732 (1937); *Astor v. West Eighty-Second St. Realty Co.*, 167 App. Div. 273, 275, 152 N. Y. Supp. 631, 633 (1st Dep't 1915) ("... without competition there can be no unfair competition, and hence no invasion of any equitable right.")

¹² *Croft v. Day*, 7 Beav. 84, 49 Eng. Rep. 994 (Rolls Ct. 1843); see 38 HARV. L. REV. 370, 371 (1925); 1 CALLMAN, UNFAIR COMPETITION AND TRADE-MARKS 40 (2d ed. 1950).

¹³ *Thaddeus Davids Co. v. Davids Manufacturing Co.*, 233 U. S. 461 (1914); *Colman v. Crump*, 70 N. Y. 573 (1877).

¹⁴ *Ibid.*; see 1 CALLMAN, *op. cit. supra* note 12, at 73, 74.

¹⁵ *Triangle Publications, Inc. v. Rohrlisch*, 167 F. 2d 696 (2d Cir. 1948).

¹⁶ See Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 818 (1927). "To describe a trademark merely as a symbol of good will, without recognizing in it an agency for the actual creation and perpetuation of good will, ignores the most potent aspect of the nature of a trademark. . . ."

¹⁷ *Lady Esther, Ltd. v. Lady Esther Corset Shoppe, Inc.*, 317 Ill. App. 451, 46 N. E. 2d 165 (1943); *cf. Tiffany & Co. v. Tiffany Productions, Inc.*, 147 Misc. 679, 264 N. Y. Supp. 459 (Sup. Ct.), *aff'd*, 237 App. Div. 801, 260 N. Y. Supp. 821 (1st Dep't 1932), *aff'd*, 262 N. Y. 482, 188 N. E. 30 (1933). See Note, 148 A. L. R. 13-125 (1944).

¹⁸ *L. E. Waterman Co. v. Gordon*, 72 F. 2d 272 (2d Cir. 1934); *Armour & Co. v. Master Tire & Rubber Co.*, 34 F. 2d 201 (S. D. Ohio 1925); *I. Rokeach & Sons, Inc. v. Atlas Import & Export Corp.*, 171 Misc. 407, 11 N. Y. S. 2d 864 (Sup. Ct. 1939).

¹⁹ See *Yale Electric Corp. v. Robertson*, 23 F. 2d 972, 974 (2d Cir. 1928);

There is scant possibility of obtaining injunctive relief on the theory that a trade mark is, in itself, a property right, and thus a fit subject for equitable protection.²⁰ It is well established that a trade mark is not a "right in gross," and is property only so far as it relates to the good will of an existing business.²¹

Where neither "passing off," nor an erosion of good will can be established, equity's reluctance to recognize an absolute property right in a name or mark will invariably pose an impassable barrier to relief. It is not surprising, therefore, that the injunction was denied in the principal case. The evidence indicated that there was no "passing off," and that the parties were not competitors. The plaintiff had never directly or indirectly participated in the business of commercial photography. The difference in the color of the advertisements and the lack of emphasis placed by the defendant upon the word "Life" also tended to show that there was little chance of confusion of the origin of defendant's product. While the possibility exists that the defendant was trading on the established good will attached to the word "Life," any possible "whittling away" would be *de minimis*.²² Nor does the fact that the plaintiff's mark was registered pursuant to federal statute²³ strengthen his position. Registration does not per se confer new substantive rights. Equitable principles continue to govern the issuance of an injunction, even to protect the exclusive use of a registered mark.²⁴

It is submitted that the decision in the instant case is sound. Recognition of an absolute property right in a name or mark would

Aunt Jemima Mills Co. v. Rigney & Co., 247 Fed. 407, 410 (2d Cir. 1917); Philadelphia Storage Battery Co. v. Mindlin, 163 Misc. 52, 54, 296 N. Y. Supp. 176, 179 (Sup. Ct. 1937).

²⁰ Some of the older cases enjoined partly on the theory of a property right in the name itself. *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137, 46 Eng. Rep. 868 (1863); *Hall v. Barrows*, 4 De G. J. & S. 15, 46 Eng. Rep. 873 (Ch. 1863). The theory was later repudiated in England. *Reddaway v. Banham*, [1896] A. C. 199, 209 (P. C.) ("I doubt myself whether it is accurate to speak of there being property in such a trade mark. . ."). The property concept of trade mark protection did not find favor in the United States. See *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 403, 414 (1916); *Loughran v. Quaker City Chocolate & Confectionery Co.*, 286 Fed. 694, 697 (E. D. Pa. 1923); *Chadwick v. Covell*, 151 Mass. 190, 23 N. E. 1068, 1069 (1890). The property theory has, however, been advocated by a leading treatise writer. See 3 CALLMAN, *op. cit. supra* note 12, at 1009.

²¹ See *United Drug Co. v. Rectanus Co.*, 248 U. S. 90, 97 (1918); *Standard Oil Co. v. Calif. Peach & Fig Growers*, 28 F. 2d 283, 284 (D. Del. 1928).

²² "There is no evidence that defendant's work is inferior or likely to discredit plaintiff if such confusion existed." *Time, Inc. v. Life Color Laboratory*, 198 Misc. 1038, 1039, 101 N. Y. S. 2d 586, 587 (Sup. Ct. 1950).

²³ 60 STAT. 428 (1946), 15 U. S. C. § 1652 (1946).

²⁴ ". . . courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent Office." 60 STAT. 438 (1946), 15 U. S. C. § 1116 (1946). See note 2 *supra*.

serve no useful purpose. Indeed, the varying interpretations placed on the term "property" in reference to trade-mark protection would seem to be distinctions of words rather than substance.²⁵ Whether trade marks be considered property or not, the need for their protection is based on harm threatened to business or good will by their unlawful appropriation. Where such threatened harm is lacking, there is no valid reason for granting injunctive relief.

²⁵ *Hanover Star Milling Co. v. Allen & Wheeler Co.*, 208 Fed. 513, 515 (7th Cir. 1913), *aff'd*, 240 U. S. 403 (1916). 1 NIMS, UNFAIR COMPETITION AND TRADE-MARKS 534 (4th ed. 1947).