

# The Surveys That Broke Monopoly

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When a trademark becomes the common descriptive name of the type of article with which it has been associated, the owner of the mark loses the exclusive right to its use. The genericness doctrine marks the only place in the law of intellectual property in which success is punished rather than rewarded. Many terms that were once trademarks have long since become assimilated into ordinary speech. Trampoline, yo-yo, brassiere, and escalator were once registered trademarks. The word "thermos" began as the trade name of one particular brand of bottle that kept cold liquids cold and hot liquids hot. At one time, only Bayer used the word "aspirin," only DuPont used "cellophane."

Last year, the Ninth Circuit decided that Parker Brothers no longer had the exclusive right to the word "monopoly" as a trademark for its real estate trading game.<sup>1</sup> Although the court did not

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† Professor of Law and Sociology Emeritus, University of Chicago. I am much indebted to my colleague Douglas Baird who not only read early drafts of this article but in lengthy discussion broadened my vision of the many problems involved in this case. Prior to the first trial in the district court, Monopoly produced a survey on the likelihood of confusion. Although that survey is unrelated to this article, I note that lawyers for Parker Brothers consulted me on some technical aspects of that survey.

<sup>1</sup> *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982). Anti-Monopoly was invented by a professor of economics, Dr. Anspach. It was marketed unsuccessfully as "Bust the Trust," but found commercial success when it was marketed as "Anti-Monopoly" and packaged in a way that bore remarkable similarities to Monopoly "in terms of box-size, lettering, board configuration, and design." *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448, 450 (N.D. Cal. 1981), *rev'd*, 684 F.2d 1316 (9th Cir. 1982).

The case arose in the following sequence: when Anti-Monopoly appeared on the market, Parker Brothers protested. Anti-Monopoly responded with a suit demanding a declaratory judgment against continued use of the trademark "Monopoly" by Parker Brothers. Anti-Monopoly claimed that the mark was only "the common descriptive name" of an article, and therefore not entitled to protection. In defense, Parker Brothers insisted that Monopoly was its trademark for a particular game within the product category "real estate board games." Parker Brothers also asserted a counterclaim for infringement. In 1977 the district court ruled in favor of Parker Brothers. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 195 U.S.P.Q. (BNA) 634 (N.D. Cal. 1977). On appeal, the Ninth Circuit reversed and remanded. *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296 (9th Cir. 1979) [hereinafter cited as *Anti-Monopoly I*]. On remand, the district court again found for Parker Brothers. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448 (N.D. Cal. 1981) [hereinafter cited as *Anti-Monopoly II*]. The Ninth Circuit again reversed. *Anti-Mo-*

squarely face the question, it would appear that henceforth anyone can make a game identical to that made by Parker Brothers, call it "Monopoly," and sell it as his own, provided he clearly indicates that he, rather than Parker Brothers, is the producer of the game.

In this paper I will, after a brief description of the trademark law of genericness, review the Ninth Circuit's treatment of the surveys offered by the litigants. In the end I shall argue that even though the plaintiff's surveys were flawed, the real problem lies with the way the court interpreted trademark law, rather than its use or misuse of the statistical evidence.

### I. THE GENERICNESS DOCTRINE

A trademark is any word, name, symbol, or device adopted and used by a manufacturer to identify his own goods and to distinguish them from those manufactured or sold by others.<sup>2</sup> Trademarks help consumers to distinguish one producer from another. Someone who wants to buy the same cola beverage he drank yesterday can ask for "Coke" or "Pepsi" and be confident that he will be getting the same thing he bought yesterday. It would be harder for a consumer to identify a particular soft drink if competitors could not adopt marks, such as Coke and Pepsi, to identify their goods. Giving a competitor trademark protection for whatever word he chooses, however, might impoverish the language of commerce. For example, if only one producer could adopt "telephone" as a trademark for its telephones, all other makers of these devices would find it harder to tell consumers what they made, and consumers would have a harder time finding them.

A basic principle of trademark law therefore is that one cannot adopt as a mark a word that merely describes the goods one is selling unless one can show that the descriptive word has become distinctive of one's own goods in commerce.<sup>3</sup> One has to show that the word, which was once descriptive, has acquired "secondary meaning," that its primary significance in the minds of the consuming public is not the product, but the producer.<sup>4</sup> Nabisco ulti-

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nopoly, Inc. v. General Mills Fun Group, Inc., 684 F.2d 1316 (9th Cir 1982)[hereinafter cited as Anti-Monopoly III]. The saga has apparently ended with denial of Parker Brothers' writ of certiorari by the Supreme Court. CPG Prods. Corp. v. Anti-Monopoly, Inc., 103 S. Ct. 1234 (1983).

<sup>2</sup> Lanham Act § 45, 15 U.S.C. § 1127 (1976).

<sup>3</sup> *Id.* § 2(f), 15 U.S.C. § 1052(f) (1976). The statute allows trademark protection of descriptive marks that are "distinctive of the applicant's goods in commerce." *Id.* § 2(e), 15 U.S.C. § 1052(e) (1976) (excluding descriptions from trademark protection).

<sup>4</sup> *Id.* § 2(f), 15 U.S.C. § 1052(f) (1976).

mately could not protect "shredded wheat" and Miller could not protect "lite beer" because these words simply described the products they (and others) were selling;<sup>5</sup> the words did not serve a trademark function, for they did not distinguish Nabisco's or Miller's goods from those sold by others.

A more difficult problem arises when a trademark is not descriptive, but has been used for a long period of time by a single producer, often because the product had been patented. During the first part of this century, for example, Bayer had a patent on acetyl salicylic acid and used the mark "aspirin" to identify it. The question of whether the mark signified the product or the producer to the consuming public was not meaningful, because the public never had reason to make the distinction. There had been only one product made by a single producer. When other producers entered the market and tried to sell acetyl salicylic acid, they could not easily tell the public what they were selling. The public was wholly unfamiliar with the name of the chemical; it knew the product entirely by a registered trademark.<sup>6</sup>

Cases like *Bayer* present an awkward choice: either force new producers to spend time and energy reeducating the public, or take away from the first producer a mark that he has spent time and energy developing. This dilemma has been resolved in favor of the new entrants. Someone who develops a new product must make sure that he creates both a common descriptive name and a trademark for the article. Xerox is a mark for a kind of plain paper copier; Sanka is a mark for a kind of decaffeinated coffee; Vaseline is a mark for a kind of petroleum jelly. If a manufacturer fails to take such precaution and his mark becomes the common descriptive word for the article he sells, he loses the mark.

As stated so far, the doctrine is uncontroversial. Yet it leaves a difficult problem unexposed. Trademarks began as symbols that identified particular producers. Over time, however, marks have been used more to identify particular products and to distinguish them from other products than merely to distinguish them from the products of other producers. Although the consuming public associates the word "Thunderbird" primarily with a particular kind of car, it is well aware that the car is manufactured by a particular manufacturer, Ford. The advertising behind Smirnoff

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<sup>5</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116-17 (1938) (Shredded Wheat); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 80-81 (7th Cir. 1977), cert. denied, 434 U.S. 1025 (1978) (Lite Beer).

<sup>6</sup> *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

vodka is directed not so much at identifying the producer as at distinguishing this vodka from others, including Popov vodka, which is made by the same manufacturer. Courts have never squarely asked whether a producer forfeits trademark protection if he induces consumers to associate a name with a particular product, rather than with himself. Indeed, few have ever thought that such a forfeiture might arise.

This problem was raised but not satisfactorily solved in the *Anti-Monopoly* case, in which the Ninth Circuit had both to define the category of which Monopoly was a member and to decide whether to give trademark protection to "Monopoly" if the game were the only member of the product category.

In reaching its conclusions, the Ninth Circuit relied heavily on three consumer surveys submitted by the plaintiff, while rejecting two surveys submitted by the defendant. As the court put it: "The principal evidence in the case was in the form of consumer surveys . . . ."<sup>7</sup>

## II. THE SURVEYS AND THE NEW TEST OF "PRIMARY MEANING"

In this part I examine the five surveys presented to the court and try to assess their evidentiary value and their importance for the court's decision. This assessment can be made only in the context of the new test of "primary meaning" the Ninth Circuit established in the *Anti-Monopoly* case.

The traditional method of testing the primary meaning of a mark is based on the proposition that people may understand and use it to mean either the brand or the product category. Once a majority or a substantial minority of persons understands the mark to mean the category rather than the brand, the mark is lost. The test, however, is meaningful and hence applicable only if there is a real difference between the product and the product category. If the product and the product category coincide, i.e. if the category consists of one member only, the traditional primary meaning test makes no sense.

To fit that situation, the Ninth Circuit has fashioned a new test it believed had been established in *Kellogg Co. v. National Biscuit Co.*<sup>8</sup> ("*Shredded Wheat*"). The court concentrated on the Supreme Court's statement in *Shredded Wheat* that a mark acquires protection when its "primary significance . . . in the minds

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<sup>7</sup> *Anti-Monopoly III*, 684 F.2d at 1323.

<sup>8</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).

of the consuming public is not the product but the producer.”<sup>9</sup> In the Ninth Circuit’s view, each person, instead of belonging to one group or the other, is expected to harbor both meanings, with one of them occupying the “primary” position. There is another difficulty with equating the issue in the *Shredded Wheat* case with that in *Anti-Monopoly*; the Supreme Court used its test in the *Shredded Wheat* case to determine whether the mark had acquired secondary meaning, which is necessary to protect a descriptive mark. In *Anti-Monopoly* the Ninth Circuit applied the test to a mark that did not need secondary meaning to be protected.

#### A. The “Thermos” Survey

Shortly before the first trial, *Anti-Monopoly* produced a survey that was consciously modeled on the one the court relied on in finding that the word “thermos” had become generic.<sup>10</sup> There are, however, important, if subtle, differences between the original and its copy. The threshold question in the *Thermos* case was

[a]re you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time?<sup>11</sup>

The threshold question in the *Anti-Monopoly* “*Thermos*” survey was

[a]re you familiar with business board games of the kind in which players buy, sell, mortgage and trade city streets, utilities and railroads, build houses, collect rents and win by bankrupting all other players, or not?<sup>12</sup>

In form, the two questions, except for the limping “or not,” seem to be alike. But the typical interviewee (especially in a telephone interview) must have perceived the two questions to be very different. Most consumers when asked the *Thermos* question will have an approximate awareness of the many different shapes, colors, and even materials of containers that keep cold beverages cold and hot beverages hot, because they are usually well displayed in drug stores and supermarkets. Speaking of a “type of” container there-

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<sup>9</sup> *Id.* at 111, quoted in *Anti-Monopoly* I, 611 F.2d at 302.

<sup>10</sup> *American Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 14, 20-21 (D. Conn. 1962), *aff'd sub nom. King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963), *order modified*, 320 F. Supp. 1156 (D. Conn. 1970).

<sup>11</sup> *Id.* at 21 n.8.

<sup>12</sup> *Anti-Monopoly* III, 684 F.2d at 1323. Approximately 53% of the respondents answered they were familiar with board games of this kind. *Id.*

fore makes eminent sense. The parallel reference to "board games of the kind . . ." in the Anti-Monopoly Thermos survey has no counterpart in reality. The sneaked-in plural, however, buttressed by the addition of "the kind," probably had little effect. The rare interviewee on whom that nuance was not lost most likely perceived it as not more than an awkward introduction to the description of the familiar game. Otherwise, a stickler for precision who took the plural seriously would have had to answer: "No—I am familiar with only one game that fits your description." Under these circumstances, the answers to the question that follows,

[i]f you were going to buy this kind of game, what would you ask for, that is, what would you tell the sales clerk you wanted?<sup>13</sup>

held no surprise. About 80% of the interviewees answered, "Monopoly,"<sup>14</sup> because in their understanding all they had been asked was whether, from the detailed description of the game Monopoly they could identify its name. Why then did the authors of this survey put that false clause "games of the kind" into the question? They obviously intended<sup>15</sup> to establish direct proof of the generic character of the Monopoly name. If the court had followed the strict logic of question and answer, it might have concluded that the consumers had called the *type* of such games by the name Monopoly. But the court responded, as the interviewees undoubtedly did, by concluding "that the results of this survey are compelling evidence of a proposition"<sup>16</sup> that could not have been in much doubt, namely that those who are familiar with the game will call it Monopoly. The survey was of no help in defining the product category.

## B. The "Teflon" Survey

Parker Brothers also introduced a survey that measured consumer perception of Monopoly as a brand name. This survey was patterned after the survey that helped DuPont retain its Teflon trademark.<sup>17</sup> It was designed to find out what proportion of the public considered Monopoly to be a brand name. The Monopoly

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<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> Recall, as the court made clear, that Anti-Monopoly drafted the Anti-Monopoly Thermos survey. *Id.*

<sup>16</sup> *Id.* at 1324.

<sup>17</sup> *E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975).

interviewer, like the DuPont interviewer, began by explaining the survey's two key terms.

By *brand* name, I mean a name like *Chevrolet*, which is made by *one* company; by *common* name, I mean 'automobile,' which is made by a number of different companies.<sup>18</sup>

In the questions that followed the interviewee was then asked for each of eight different product names, read to him or her in turn, "[w]ould you say [the name] is a brand name or a common name?" Three of the eight names were brand names, three were common names, with Monopoly and Thermos thrown into the list.<sup>19</sup> The brand names were identified as such by more than two-thirds of the interviewees;<sup>20</sup> all generic names were identified as such by close to 90% of the interviewees;<sup>21</sup> 63% of all interviewees identified Monopoly as a brand name; 54% identified Thermos as a generic name.<sup>22</sup>

The survey provides fairly direct evidence to the effect that a substantial majority of the population understands Monopoly to be a brand name.<sup>23</sup> The court, however, gave the Teflon survey short shrift because in its view the survey begged the question: "The results of this survey had no relevance to the question in this case. Under the survey definition 'Monopoly' would have to be a 'brand name' because it is made by only one company."<sup>24</sup> The court's logic is correct, but its psychology is wrong. If the survey had omitted all references to a single or multiple source and the explanatory definition instead had stated that "Chevrolet, for instance is the *brand* name; automobile is the *common* name," I do not believe the survey results would have been any different. The

<sup>18</sup> Anti-Monopoly III, 684 F.2d at 1323. See also E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 526 (E.D.N.Y. 1975).

<sup>19</sup> The three common names were refrigerator, margarine, and aspirin. Each interviewee was presented three brand names from a pool of six: Tide, Lavoris, Seville, Coke, STP, and Jello. Market Facts—New York, Inc., A Further Study Concerning the Trademark Monopoly 2 (unpublished report, June 1981) (on file with *The University of Chicago Law Review*).

<sup>20</sup> The respective percentages were Tide 89%, Lavoris 85%, STP 83%, Seville 77%, Coke 74%, and Jello 68%. *Id.* at 10.

<sup>21</sup> The respective percentages were refrigerator 92%, margarine 88%, and aspirin 87%. *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> Arguably, the relevant universe should have been only that part of the population that had heard of the game Monopoly. In that case the brand identification ratio would have been even larger. The "Thermos" survey, see *supra* notes 10-16 and accompanying text, found that 92% of the public knows of the game. Anti-Monopoly III, 684 F.2d at 1324. The restriction would have raised the brand identification ratio from 63% to 68% (.63/.92).

<sup>24</sup> Anti-Monopoly III, 684 F.2d at 1323.

survey showed that in the consumer's mind Monopoly's primary meaning is that of a product.

### C. Motivation Survey I

Anti-Monopoly designed a telephone survey that purported to track the legal rule the Ninth Circuit had announced the first time it heard the Monopoly case, namely, that "the MONOPOLY trademark is valid only if 'the primary significance of the term in the minds of the consuming public is not the product but the producer.'"<sup>25</sup> The court went even further and suggested how this rule might be translated into operational terms:

It may be that when a customer enters a game store and asks for MONOPOLY, he means: "I would like Parker Brothers' version of a real estate trading game, because I like Parker Brothers' products. . . ." On the other hand, the consumer may mean: "I want a Monopoly game. . . . I am interested in playing the game of Monopoly. I don't much care who makes it."<sup>26</sup>

The survey-makers, following the court's instructions, framed the question as follows:

Which of these two statements best expresses your meaning when you ask for 'Monopoly' in a store? . . .

'I would like Parker Brothers' Monopoly game primarily because I like Parker Brothers' products.'

OR

'I want a Monopoly game primarily because I am interested in playing Monopoly.' I don't much care who makes it.<sup>27</sup>

Assuming for the moment that this is a proper way of formulating the court's doctrine,<sup>28</sup> it is noteworthy how the survey makers de-

<sup>25</sup> Anti-Monopoly I, 611 F.2d at 302 (quoting *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938)).

<sup>26</sup> *Id.* at 305-06.

<sup>27</sup> See Corey, Canapary & Galanis, National Telephone Survey and Intercept Survey at App. (telephone survey form) (unpublished report, June 1981) (on file with *The University of Chicago Law Review*). See also Anti-Monopoly II, 515 F. Supp. at 453 n.5 (N.D. Cal. 1981), *rev'd*, 684 F.2d 1316 (9th Cir. 1982).

<sup>28</sup> The district court chided Anti-Monopoly for the form of the survey question: "These responses were pulled, verbatim, from an illustration in the text of the appellate court opinion. Plaintiff's expert, not a trained attorney, misconstrued the purpose of the illustration, which was to illustrate a point, *not* to suggest language for a scientific study." Anti-Monopoly II, 515 F. Supp. at 453-54 n.5 (emphasis added; citation omitted), *rev'd*, 684 F.2d 1316



veloped the question schedule that led up to this key question; again the court informs us that the schedule was provided by Dr. Anspach, Anti-Monopoly's president.<sup>29</sup> His first question—"Are you aware of 'Monopoly,' the 'business board game produced by Parker Brothers?"—answered by 92% of the interviewees in the affirmative,<sup>30</sup> is followed by "[w]hy would you buy Monopoly? (PROBE FOR COMPLETE RESPONSE)."<sup>31</sup> At first glance these introductory questions seem innocent enough. On closer examination one can see how they might have affected the respondent's answer to the subsequent key question that asks the interviewee for his primary reason for buying Monopoly. First, describing the game initially as a business board game produced by Parker Brothers may have steered people away from listing the name of the manufacturer as a reason for buying the game. Those asked may have felt themselves pushed to provide information beyond that which they had already been told. A person might say that he liked a particular glass of beer because it was Budweiser, but the same person might not respond to the question, "Why do you like Budweiser beer," by saying that he liked Budweiser beer because it was Budweiser beer. This response, unlike the first, sounds tautological.

A second defect of the motivation survey was that it prodded the consumers first to list all the reasons why they would buy Monopoly; the interviewer was instructed to "probe for a complete response" (i.e., keep asking "any other reasons?"), a discretion normally avoided in legal surveys. This may have biased them in favor of saying that they would buy the game for reasons other than the single reason that it was made by Parker Brothers. It is not surprising, therefore, that a majority of the answers to the next question, "Why would you buy Monopoly?," referred to the product and the gratifications provided by the game.<sup>32</sup> But in spite of this thorough effort to focus the interviewees' attention on the product, a surprising 32% of them answered that the primary meaning of their asking for "Monopoly" would be that they like Parker Broth-

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(9th Cir. 1982). The court of appeals had a different opinion, describing the survey as "a reasonable effort . . . to find out [what the purchaser meant by "Monopoly"] and was modelled closely on what we said in our opinion." *Anti-Monopoly III*, 684 F.2d at 1325.

<sup>29</sup> *Anti-Monopoly III*, 684 F.2d at 1324.

<sup>30</sup> *Id.*

<sup>31</sup> See Corey, Canapary & Galanis, *supra* note 27, at App. (survey forms).

<sup>32</sup> *Anti-Monopoly III*, 684 F.2d at 1324. Eighty-four percent of the portion of the sample aware of the game mentioned an aspect of playing the game as the reason they had or would purchase it.

ers' products.<sup>33</sup> The district court justly remarked that this was an "impressive display of the amount of goodwill which Parker Brothers has imbued throughout its various games."<sup>34</sup> Be that as it may, the fact that 65% of the interviewees responded to the key question that for them, "Monopoly" meant primarily the game and not its producer,<sup>35</sup> gave the court the handle for canceling the mark.

#### D. Motivation Survey II

The second motivation survey, also prepared by the plaintiff, was of little import. Its only apparent purpose was to allay the plaintiff's concern that the key question in Motivation Survey I, which had followed the court's instructions very literally, might be considered biased towards eliciting the answer that favored the plaintiff. The change between the two surveys was slight:

##### Motivation I

Which of these two statements best expresses your meaning when you ask for 'Monopoly' in a store?

—I would like Parker Brothers' 'Monopoly' game primarily because I like Parker Brothers' products.

or

—I want a 'Monopoly' game because I am interested in playing 'Monopoly.' I don't much care who makes it.

##### Motivation II

Which of these two statements best expresses the primary reason why you would buy (did buy) 'Monopoly'?

—Primarily because of the way Parker Brothers manufacturers [sic], advertises or prices games.

or

—Primarily because I like playing the 'Monopoly' game.<sup>36</sup>

In the first Motivation survey, 65% had chosen the game-alternative; in the second, 84% chose it.<sup>37</sup> But since Motivation Sur-

<sup>33</sup> *Id.*

<sup>34</sup> Anti-Monopoly II, 515 F. Supp. at 455, *rev'd*, 684 F.2d 1316 (9th Cir. 1982).

<sup>35</sup> Anti-Monopoly III, 684 F.2d at 1324. The court of appeals disagreed with the district court's finding of methodological flaws in the survey, finding that the judgment used in constructing the survey was reasonable. *Id.* at 1325.

<sup>36</sup> See Corey, Canapary & Galanis, *supra* note 27, at App. (telephone and intercept survey forms) (interviewer's instructions omitted).

<sup>37</sup> *Id.* at 4, 8.

vey II was based on an "intercept" sample (the high sounding name for grabbing the first person that comes along—no sample at all), the court merely noted: "The results were very close to those of [Motivation I], but the expert did not claim that the intercept study was validly projectable."<sup>38</sup>

### E. The "Tide" Survey

Defendant Parker Brothers attempted to undercut the plaintiff's surveys by duplicating the plaintiff's first motivation survey, but substituting for Monopoly the brand "Tide"—one of the strongest and best known trademarks.<sup>39</sup> The results obtained in this survey suggest that under the court's legal rule the Tide mark would be lost, a *reductio ad absurdum* of the rule. Here are the results of the two surveys:

Would you buy Tide (Monopoly) primarily because you like—

	TIDE survey <sup>40</sup> %	MONOPOLY survey <sup>41</sup> %
the product itself . . . . .	68	65
this manufacturer's products . . .	12	32
other reasons and don't know . .	13	3

The Ninth Circuit did not cope well with this challenge. It stated:

We suspect that these results tend to show that the general public regards "Tide" as the name of a particular detergent, having particular qualities, rather than as one producer's brand name for the same detergent which is available from a variety of sources. We do not know whether the general public thinks this, or if it does, is correct in thinking this, or whether Procter and Gamble intend them to think it. If the general public does think this, and if the test formulated in *Anti-Mo-*

<sup>38</sup> *Anti-Monopoly III*, 684 F.2d at 1324-25.

<sup>39</sup> The district court commented that "it seems beyond argument that TIDE is a valid trademark." *Anti-Monopoly II*, 515 F. Supp. 448, 454 n.5 (N.D. Cal. 1981), *rev'd*, 684 F.2d 1316 (9th Cir. 1982). The Ninth Circuit may not have been convinced. *See infra* note 42 and accompanying text.

<sup>40</sup> Quatra Marketing Research, Inc., Tide Purchase Study 3 (unpublished report, June 20, 1980) (on file with *The University of Chicago Law Review*).

<sup>41</sup> These are the results of *Anti-Monopoly's* Motivation Survey I, on which the court relied. Corey, Canapary & Galanis, *supra* note 27, at 4. *See also supra* notes 32-35 and accompanying text.

*nopoly I* could be mechanically extended to the very different subject of detergents, then Procter and Gamble might have cause for alarm.<sup>42</sup>

Tide, identified as a brand name by 89% of the general public,<sup>43</sup> backed up by a safely entrenched generic name (laundry detergent), "might have cause for alarm"? Somebody must be kidding. There is only one possible reason for alarm, namely, the possibility that the primary meaning test prescribed in *Anti-Monopoly* would generally supersede the traditional primary meaning test. It is to this question that we now turn.

### III. THE NINTH CIRCUIT'S TEST OF PRIMARY MEANING

In developing its legal rule, the Ninth Circuit relied on language from the *Shredded Wheat* case, but that case does not stand for the proposition that all trademarks must identify in the public's mind the producer rather than the product. When a word, such as "monopoly," is not descriptive of the product in question, it is not necessary to establish "secondary meaning"; a word that is merely suggestive of the goods is routinely given trademark protection.<sup>44</sup> To be a trademark the word must only distinguish the goods from those of others, but there is no explicit requirement in the Lanham Act that a mark must both distinguish one's goods from those made by others *and* identify the goods as coming from an identifiable producer. Adding the latter requirement as a condition of trademark protection would defeat many marks now in existence. The court misapplied for its own use the crucial passage in *Shredded Wheat* that to retain the trademark protection it is necessary to show "that the primary significance of the term in the minds of the consuming public is not the product but the producer."<sup>45</sup> This passage describes the test for secondary meaning; the language does not justify the Ninth Circuit test.

We have seen that the difference between the traditional test of generic marks and the new Ninth Circuit test is more than a shift in emphasis; it poses a radically different question, and the difference goes deep. The traditional test has a clear meaning and, in principle at least, can be verified through corresponding observ-

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<sup>42</sup> *Anti-Monopoly III*, 684 F.2d at 1326.

<sup>43</sup> See *supra* note 20 and accompanying text.

<sup>44</sup> See *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025 (1978).

<sup>45</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118. (1938). See also *supra* notes 9, 25 and accompanying text.

able behavior. Thus, someone who uses "Thermos" to mean the brand will be irritated when the sales clerk brings a different brand of insulated bottle. Someone to whom Thermos means the genus will console and correct the sales clerk who answers "Sorry, we are out of the 'Thermos' brand but we have other brands of such bottles."

The verbal statement of the Ninth Circuit's test cannot be translated into a commensurate, observable behavior. Until "primary meaning" is defined with more precision in terms of the behavior it represents, it has no meaning, or at best only a very vague one.<sup>46</sup> What might be a meaningful translation of the statement "[b]y Monopoly I mean primarily the game, not Parker Brothers"? Here are some possibilities:

I am informed that Parker Brothers ceased to manufacture Monopoly; another company does that now. In this situation, do I buy Monopoly from the other company, or another board game from Parker Brothers?

I am informed that in addition to Parker Brothers two other firms now make Monopoly. If I have to choose, will I choose the Parker Brothers' product? What will I choose if in this situation a price differential obtains?

There may be many translations of the Ninth Circuit's "primary meaning" statement. The question is whether a test of such vagueness should determine what is probably the weightiest issue in trademark law. The traditional primacy test, measuring the proportion of customers who understand the name to mean the genus and not a species, a product category and not a brand, is clear and simple and can be translated into meaningful behavior, which in turn is directly related to the law's intent. It can be applied to all situations in which the genus consists of more than one member. The Ninth Circuit's primacy test, counting the proportion of persons who say they understand the name as primarily designating the product rather than the producer, is vague, and it is not at all certain that it can be translated with precision into any relevant behavior. Its juxtaposition to the old test, when there is more than one product in the genus, as was done by Parker Brothers' "Teflon" survey, reveals the inferiority of the Ninth Circuit's test.

It would seem that before anyone can demand that a trade

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<sup>46</sup> This should not surprise. "There are so many answers to the simple 'Why?' that we have no way of knowing how all these reasons fit together, if indeed we could elicit them all in the first place." H. ZEISEL, *SAY IT WITH FIGURES* 153 (5th ed. 1968).

name be cancelled because it had become generic, a genus must have come into existence, that is, a real genus of at least two members. The legal construct of a genus of one cannot suffice, because for such a genus there is as yet no meaningful operational way of making the fateful distinction.

#### CONCLUSION

The role the surveys played in *Anti-Monopoly* was important only in a superficial way. They did not have much effect on an outcome that was preordained by the incorrect legal rule the court had established. The surveys could have played an important role had the court seen their significance. By rejecting the "Teflon" survey on an unimportant technicality, and not seeing the relevance of the anomaly pointed out by the "Tide" survey, the court missed the opportunity to reassess its earlier ruling. The surveys should have led the court to ask whether Monopoly was fundamentally different from Tide or whether the court's initial holding was in fact more sweeping than was intended. Surveys typically implement a legal rule; the ones in the *Anti-Monopoly* case should have forced a reexamination of the rule.