THE DEATH OF *WEBSTER'S* AS A DICTIONARY TRADEMARK: A SHAGGY-DOG STORY

PART TWO, 1914-1994

Bryan A. Garner

In Part One of his *Webster's* shaggy-dog story (published in the Summer 2023 issue of the *Green Bag*),[1] Bryan Garner sketched the first 70 or so years of legal maneuvering by the company that acquired rights to Noah Webster's famous dictionary in 1844 – G. & C. Merriam Co. – and its early disputes with various entrepreneurs who began publishing dictionaries with the word "Webster" in the title. By the early 1890s, Merriam was suing some of them in federal court, and a colorful schemer named George W. Ogilvie emerged as Merriam's primary antagonist. As intellectual property law developed in the late 19th and early 20th centuries, the courtroom conflicts between Merriam and Ogilvie (and others) changed accordingly. The litigation continued through most of the 20th century, but in the early 1900s, there was also a moment when the conflicts took a legislative turn. And that is where Part Two picks up Garner's story.

– *The Editors*

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[1] Bryan A. Garner, *The Death of Webster's as a Dictionary Trademark: A Shaggy-Dog Story – Part One, 1844-1915*, 26 Green Bag 2d 287 (2023).

AN ARKANSAS CONGRESSMAN, William A. Oldfield, who was chair of the House Committee on Patents, was accused by two congressional staffers of trying to "sell" legislation on the Webster question. Oldfield's erstwhile private secretary (C.E. Kay), together with his erstwhile stenographer and typist (Elsie Hunt), swore out affidavits that Oldfield had sought, in December 1914, to exact $10,000 from either George W. Ogilvie or G. & C. Merriam Co. for passing or defeating legislation that would allow anyone to publish Webster dictionaries with impunity.[2] (These affidavits were made public in March 1916 by Oldfield's political opponent, Tom W. Campbell.) Applying to Congress, Ogilvie was seeking an explicit amendment to the Copyright Act. Because the House Committee was evenly divided, Oldfield told Kay, within Hunt's hearing, that he could "pick up some easy money" from one side or the other in this bitter fight.[3] Kay wrote a letter to President Woodrow Wilson alerting him to Oldfield's corruption. Nothing seems to have come from these allegations – no ethics reprimand, much less removal from office – and Oldfield served several more terms in Congress until his death in 1928. Nor did the Webster-related legislation progress to enactment.

Ogilvie also died in 1928,[4] but his ghost would continue to torment Merriam for many years. The successor to his publishing enterprise, Alfred H. Cahen's burgeoning World Syndicate Publishing Company in Cleveland, had taken over Ogilvie's books. For example, World Syndicate published *The New Age Webster Dictionary Self-Pronouncing* in 1933, and *Webster's Universal Dictionary* three years later – both with the mandatory disclaimer on the title page. (It also issued several editions of George W. Conklin's *Words as They Look: A Quick-Reference Speller*. Remember that Conklin was Ogilvie's pseudonym.) In the end, World Syndicate would give rise to the *Webster's New World Dictionaries*.

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[2] These are reproduced in *Judsonia Weekly Advance* (Ark.), 22 Mar. 1916, at 1, 6.

[3] *Id*. at 1.

[4] "Woman's Kindness Brings Her $5000," *Asbury Park Evening News* (N.J.), 27 Jan. 1928, at 1 (describing contents of Ogilvie's will, including a trust for older brother David P. Ogilvie [d. 1940], a $2,500 gift to "sister" [estranged wife] Jennie Ogilvie, and appointing Central Trust [later Hanover Trust] as trust of the residuary estate). *See also* Library of Congress, Copyright Office, *Catalogue of Copyright Entries* (1934), at 1964 (noting Hanover Trust as one of the "executors of George W. Ogilvie, the proprietor," under *Munro*).

William A. Oldfield, a Democrat, represented Arkansas in the U.S. Congress for ten terms, from 1909 to 1928, including two terms chairing the House Committee on Patents and two terms as House minority whip.

About 1940, Merriam decided to pursue proceedings against World Syndicate and a few other publishers before the Federal Trade Commission (FTC), which Congress had created in 1914. The statute that gave birth to the agency prohibited unfair methods of competition and unfair acts or practices that affect commerce. It empowered the FTC to prosecute violators before administrative tribunals.[5] Merriam's efforts paid off the next year. On November 14, 1941, the FTC filed a formal complaint against World Syndicate, two other dictionary publishers, and three individuals, charging them with engaging in unfair competition and false advertising.[6] Thus began a process of investigation and adjudication that would last through the end of the decade. The FTC complaint borrowed heavily from Merriam's filings, dryly and laconically reciting the facts that the respondents had been in the business of publishing and selling dictionaries throughout the United States, "us[ing] of the name 'Webster' or 'Webster's' in titles for said dictionaries," while many other dictionary publishers with which they competed didn't use *Webster* or *Webster's* in their publications. The respondents were also accused of sometimes failing to include or make conspicuous the disclaimer, "This dictionary is not published by the original publishers of Webster's Dictionary or by their successors,"[7] and of falsely claiming that experts had updated the contents of their dictionaries.[8]

The complaint contained many factual and legal errors. It was asserted that Merriam (1) had acquired "all of the publisher's right, title, and interest in said [1828] dictionary,"[9] when in fact it was the 1841 edition; (2) had been assigned the "right, title, and interest" in the "trade name Webster's Dictionary,"[10] when in fact it had never been registered as a tradename; and (3) had been the sole publisher "of a dictionary known as 'Webster' or 'Webster's' until 1904,"[11] overlooking all the litigation of the 1890s. These allegations were followed by claims that *Webster* and *Webster's* signaled com-

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[5] 15 U.S.C. § 45.

[6] *In re World Syndicate Publishing*, 46 F.T.C. 223, 225 (1942).

[7] *Id*. at 227.

[8] *Id*. at 229-31.

[9] *Id*. at 226.

[10] *Id*.

[11] *Id*.

pleteness, comprehensiveness, and accuracy,[12] and that the public generally associated the name Noah Webster with excellence and with Merriam.

In a decision issued on November 22, 1949, the FTC adjudicators found that the respondents had indeed engaged in unfair competition and misrepresented their products in specific ways. The FTC ordered World Syndicate and the other respondents to stop claiming that their dictionaries published up to that time (1) were compiled or published by Noah Webster or his successors; (2) had been "edited or revised by a staff of eminent authorities in philology or lexicography" or by certain individuals when neither was true; and (3) contained newer or better content than dictionaries published by others when the dictionaries were wholly or substantially identical to older dictionaries and only had different titles, covers, bindings, jackets, or prefaces.[13]

But these were pyrrhic victories for Merriam. The FTC tribunal also pointed out the many erroneous claims in Merriam's complaint. The company had never acquired the publishing rights to Noah Webster's 1828 dictionary or an "exclusive right to publish Webster's Dictionaries," and it had not purchased "Webster's Dictionary" as a tradename. An unnamed witness for World Syndicate Publishing who had personally been publishing dictionaries since 1887 – someone who had almost certainly worked with Ogilvie – testified that every dictionary his firm sold between 1889 and 1904 had the name *Webster's* in its title, without any agreement or arrangement with Merriam. The firm had sold more than 15 million copies. At least 11 other companies were found to be selling *Webster's* dictionaries before 1904.[14] (Several of these companies doubtless belonged to Ogilvie.) Since then, even more companies (many owned by Ogilvie) had published and sold dictionaries with that name. Although the FTC acknowledged that Merriam's dictionaries were "most superior" in the opinions of erudite people, the evidence didn't establish that the general public understood or believed that any dictionary titled *Webster* or *Webster's Dictionary* must be a Merriam publication. Of the 40 members of the public who testified in the adjudicative proceeding, more than 30 didn't assume Merriam published all *Webster* or *Webster's* dictionaries. The others were vague and indefinite

[12] *Id*. at 226-27.

[13] *Id*. at 243.

[14] *Id*. at 240.

in their understanding. Most of those witnesses didn't even connect the name *Webster* with Noah Webster and didn't know whether the lexicographer was Noah or Daniel. Professors and librarians testified that the general public didn't pay attention to publishers. The FTC concluded: "to the public the word 'Webster' simply means a dictionary."[15]

Merriam didn't file another lawsuit about the term *Webster's* until the 1990s. This last stand was against Random House.

In 1982, Merriam had changed its name to Merriam-Webster, doubtless trying to help the public differentiate between itself and other dictionary publishers. But competition was still raging, and in 1991 Random House made a move on Merriam-Webster's lucrative college-dictionary line. Random House had apparently concluded, like others before it, that any English-language dictionary not called *Webster's* was at a disadvantage in the American market. So Random House retitled its collegiate-size dictionary *Webster's College Dictionary*. Among its entries was one for *Webster's* as "a dictionary of the English language." Merriam-Webster sued for infringement of both trademark and trade dress on grounds that Random House's combined use of *Webster's* and *College*, coupled with its red cover, created a likelihood of confusion.[16]

The dictionaries certainly looked similar. Merriam-Webster's collegiate dictionary had a red dustjacket, with the title in large letters across the front. Random House's dictionary had an almost identical crimson – maybe a shade different – with the Random House logo perched atop the large *Webster's* to command the eye's attention. But despite its similarity, "Random House" appeared four times on the jacket.

Random House was not the only publisher using *Webster's* in similar-looking dictionary titles. Houghton Mifflin had introduced a *Webster's University Dictionary* in 1984. Simon & Schuster had introduced *Webster's New World Dictionary* in 1988. Both dictionaries were marketed with red dustjackets and titles with white lettering.

Before trial, the federal district court denied Merriam-Webster's request for an injunction, stating that consumers were unlikely to be confused after looking at the book's cover because Random House's name was printed

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[15] *Id*. at 240-41.

[16] *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 68 (2d Cir. 1994).

unmistakably there.[17] The court reasoned that *Webster's* is a descriptive term for dictionaries but also stated that *Webster's* had no secondary (distinctive) meaning.[18]

The jury awarded Merriam-Webster more than $2 million in lost profits and punitive damages.[19] The jury also found *Webster's Collegiate* to be a valid trademark – even though Merriam-Webster had never registered the phrase. It found that Random House had intentionally adopted Merriam-Webster's trade dress and had diluted the distinctiveness of Merriam-Webster's trademark W*ebster's Collegiate* in violation of New York law.[20] Even so, the jury found that the word *Webster's*, as applied to dictionaries, was generic.

After posttrial motions, the trial court doubled the damages to $4 million. (Isn't litigation fun?) It was a major victory for Merriam-Webster. Three years later, on appeal, the Second Circuit Court of Appeals reversed, nullifying all the damages. (Again, isn't litigation fun?) The appellate court held that under New York law, Random House hadn't diluted Merriam's trademarks or trade dress on two grounds: (1) there wasn't a likelihood of confusion between dustjackets, and (2) *Webster's* was utterly generic.[21]

With the reversal on appeal, the parties were left in essentially the same positions they had occupied before this litigation began – if you disregard their huge legal fees and the years of frazzled nerves while the business folks awaited each of the dozens of rulings that inched toward the ultimate resolution.

Merriam-Webster hasn't sued anyone over the use of *Webster's* since the 1990s.

If *Webster's* is worthless as a trademark or signal of distinctiveness, why do publishers still attach *Webster's* to so many American dictionaries? The answer is that although it may be worthless in law, it isn't worthless in business. For generations, Merriam and its successors promoted *Webster's* so successfully that people came to trust the name as authoritative. As Ogilvie

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[17] *Merriam-Webster, Inc. v. Random House, Inc.*, 1991 WL 50951, at *6 (S.D.N.Y. 4 Apr. 1991).

[18] *Id.* at *3.

[19] *Merriam-Webster, Inc.*, 35 F.3d at 68-69.

[20] *Merriam-Webster, Inc. v. Random House, Inc.*, 815 F. Supp. 691, 695 (S.D.N.Y. 1993).

[21] *Merriam-Webster, Inc. v. Random House, Inc.*, at 67, 72.

well understood, Americans have been conditioned to believe – no matter how illogically – that the name itself signals high-quality content.

Few names have achieved fame comparable to *Webster's*. But fame comes at a price: in this case the price of what intellectual-property lawyers call "genericide" – the loss of a trademark that becomes a mere household name as opposed to a brand name.[22] Today Merriam-Webster boasts what it reasonably can: "Other publishers may use the name Webster, but only Merriam-Webster products are backed by over 150 years of accumulated knowledge and experience."[23] True enough.

Today, the copyrighted material of Merriam-Webster's competitors has migrated into various channels. Random House's content has been integrated into Dictionary.com. The *Webster's New World* line, deriving from Ogilvie, became a distinguished desk reference under the transformative editorship of David B. Guralnik in the 1950s and 1960s. World Publishing (Ogilvie's successor in interest) was acquired by Times Mirror in 1963, then by William Collins Sons in 1974, then by Simon & Schuster in 1980, then by John Wiley & Sons in the 1990s, then by Houghton Mifflin before 2014, and then by Collins Reference before 2020. Since the 1970s, *Webster's New World* – a fine piece of work under any imprint – has become the official dictionary of American journalistic outlets, including the Associated Press, *The New York Times*, *The Wall Street Journal*, and United Press International. Its front matter contains no disclaimers about not being affiliated with Merriam-Webster: there's no legal requirement, after all.

And so this shaggy-dog story comes to an end. But *shaggy-dog* in which sense?

> *Merriam-Webster's Collegiate Dictionary* (11th ed. 2011): shaggy-dog . . . *adj* (1946): of, relating to, or being a long-drawn-out circumstantial story concerning an inconsequential happening that impresses the teller as humorous or interesting but the hearer as boring and pointless.
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> *Webster's New World College Dictionary* (5th ed. 2014): shaggy dog (story) [as if from such an anecdote involving a *shaggy dog*] a long, rambling joke or anecdote involving strange or absurd incidents and regarded as ultimately pointless.

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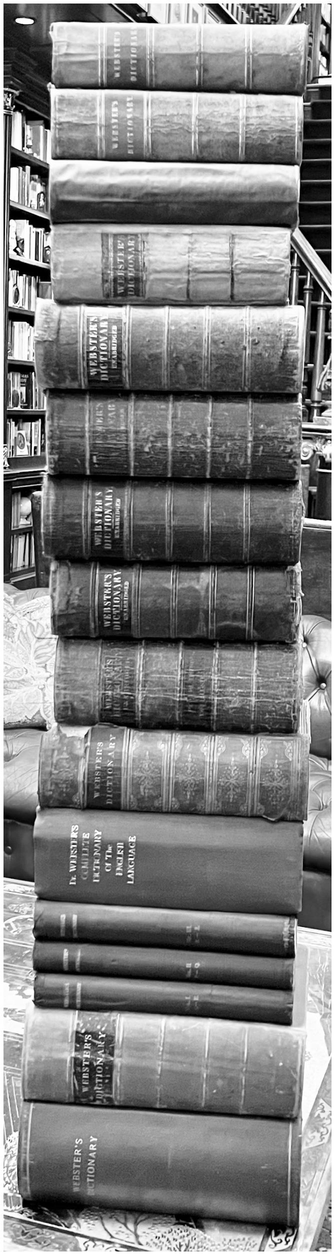
[22] *See Black's Law Dictionary* 838 (Bryan A. Garner ed., 11th ed. 2019).

[23] Merriam-Webster, About Us, FAQ (2022), www.merriam-webster.com/about-us/faq.

> *Dictionary.com* (accessed 10 July 2023): shaggy-dog story a funny story, traditionally about a talking dog, that, after an often long and involved narration of unimportant incidents, has an absurd or irrelevant punch line.

The only definitional points from which we dissent are Merriam-Webster's use of the words *boring* and *inconsequential* and its omission of any reference to a punch line. This story certainly wasn't boring or inconsequential to Merriam-Webster as it was unfolding! So maybe Merriam-Webster would argue that, by definition, this hasn't been a shaggy-dog story at all. But it certainly qualifies as long, it involves strange and even absurd incidents, and the narrative is highly involved. Oh, and let us add this final line: over a long period of pugilistic publishing, George W. Ogilvie landed plenty of below-the-belt punches.

GJB



A selection of Webster's from the author's Penrose Library.