

# WHO AUTHORS TRADEMARKS?

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## INTRODUCTION

This essay explores the role of public authorship in trademark, a role that has been both taken for granted and ignored. Public authorship has been taken for granted even as it has become embedded in the concept of secondary meaning and other familiar trademark doctrines. Nevertheless, the public's significance as trademark creator for ownership questions has rarely been acknowledged. Although no other intellectual property regime poses so many legal tests that depend upon public consciousness, no other form of intellectual property provides so little corresponding recognition of a public domain.

By associating a symbol with an object, the public contributes to the authorship of trademarks. This associative power grants a word or icon meaning as the representation of a particular object. A major theme in this essay is the linking together of doctrinal fragments to elaborate the circumstances and implications of the public's role in creating intellectual property.

There is a countervailing tendency to identify the producer of the trademark as the sole possessor of rights. It is the producer, so the argument goes, who designs the mark and invests in its dissemination through advertising. Moreover, in Frank Schechter's classic formulation, a trademark represents the good will accrued over time. Society as a whole benefits from the trademark holder's vested interest in maintaining quality across numerous transactions. Since the trademark holder both invents and sustains the worth of the mark, it is his or her claims to private ownership that must be protected.<sup>1</sup>

Similar arguments about the investment of labor are often used to legitimize tangible property. But here it is employed to bolster private entitlements to language and iconography. Intellec-

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I would like to thank Ralph Brown, Wendy Gordon, Sarah Harding, and Steven Heyman for their thoughtful reading of an earlier draft. This essay is dedicated to the memory of Professor Ralph S. Brown, who taught the first class in intellectual property at an American law school and, many years later as an emeritus professor, was my teacher at Yale Law School.

<sup>1</sup> See Frank L. Schechter, *Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927). For an extended discussion of Schechter's thesis, see *infra* Part II.

tual property, I suggest, is different.<sup>2</sup> As a form of expression, there is a clear and ever-present public role in shaping language. Trademarks are even one step further from tangible property than other species of intellectual property. Peculiar to trademarks, the communicative sign is a placeholder for a robust but intangible cultural relationship between producer and consumer. The very existence of this relationship begs the question of the consumer's creative role. One scholar has called trademarks "owning what doesn't exist."<sup>3</sup> This essay deals with the still more difficult problem of creating what does not exist. How do two parties with competing interests (commercial entities and the public as interpreter) work to create a trademark? What privileges emerge from this joint authorship?

This essay is part of a larger scholarly enterprise to carve out a more expansive public domain within the realm of intellectual property and, more particularly, trademarks.<sup>4</sup> It seeks to aim at the very heart of the dilemma of public entitlement: reluctance of courts to protect the use of intellectual property against its creators.<sup>5</sup> If the public can be shown to be an author or symbolic creator, then, perhaps the same authorial rights granted to individual creators (such as the person or corporation that affixes signs

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<sup>2</sup> For an opposing view, see Frank Easterbrook, *Intellectual Property Is Still Property*, 13 HARV. J.L. & PUB. POL'Y 108 (1990) (arguing for the treating of intellectual property as largely identical with real property).

<sup>3</sup> Stephen L. Carter, *Owning What Doesn't Exist*, 13 HARV. J.L. & PUB. POL'Y 99 (1990) (arguing that this non-tangible quality makes it hard to apply classic utilitarian analysis to trademarks). A number of scholars have seen intangible property rights in government licenses. See Charles Reich, *The New Property*, 73 YALE L.J. 733 (1964). Scholars have also recognized individual liberties to do as one wishes with one's body. See Bruce Ackerman, *Levels of Generality In Constitutional Interpretation: Liberating Abstraction*, 59 U. CHI. L. REV. 317 (1992). Here I will suggest that the intangibility of trademarks, and the way they are summoned into existence, invests interpretive powers in the public that create public property rights.

<sup>4</sup> On the need to craft new theories of the public domain, see David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147 (1981); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990).

<sup>5</sup> Most notably, this reluctance has posed a significant threat to traditional First Amendment rights. Examples include prohibitions against the use of a caricature of the Reddy Kilowatt symbol in an environmental campaign against a power plant, see *Reddy Communications, Inc. v. Environmental Action Found.*, 477 F. Supp. 936 (D.C. 1979), and the use of the five-ringed Olympic symbol by those opposed to the conversion of an Olympic Village into a prison, see *Stop the Olympic Prison v. United States Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980).

Similar restrictions have been placed upon non-political parodies. See, e.g., *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 220 (2d Cir. 1979) (enjoining use of actresses in Dallas Cowboy cheerleader uniforms in pornographic film); *Coca Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (enjoining depiction of the Coca-Cola sign with the words "enjoy cocaine"); *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962) (restricting use by insecticide manufacturer of modified beer slogan, "where there's life there's Bugs").

upon consumer goods) can be attributed to the public as well.<sup>6</sup>

The problem of public entitlement is especially significant for trademarks. Unlike copyright or patent, there is no set limit to the time to which the privilege extends.<sup>7</sup> And, unlike copyright, trademark lacks a broad doctrine of fair use. Yet, even if trademark included a more robust fair use exception, it might not provide an answer to the problem of public domain. Copyright fair use has been eroded through the courts' tendency to immunize creators from responding to even compelling public interests.<sup>8</sup> Therefore, I have not suggested that a capacious fair use doctrine should be extended to trademarks.<sup>9</sup> Instead, I have focused upon the public

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<sup>6</sup> The clash between trademark law and Constitutional rights has spawned a large scholarly literature. Often these works argue for the trumping power of First Amendment rights. See, e.g., Mark A. Daglitz, *Trademark Parodies and Free Speech: An Expansion of Parodists' First Amendment Rights in L.L. Bean, Inc. v. Drake Publishers, Inc.*, 73 IOWA L. REV. 961 (1988); Harriet K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies without Wrongs*, 65 B.U. L. REV. 923 (1985); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131 (1989). See also Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must Trademarks Be?*, 22 Pepp. L. Rev. 7 (1994) (finding use of Lanham Act's scandalous mark clause violative of First Amendment rights).

As Cass Sunstein has suggested, however, astonishing changes in the diffusion of information have raised the question of whether the First Amendment is capable of adequately protecting public speech interests. See CASS R. SUNSTEIN, *DEMOCRACY AND THE PROBLEM OF FREE SPEECH* 1-16 (1993). Rochelle Dreyfuss makes a distinction between competitive language which should be restricted under trademark law and expressive language, such as parody, which should be left unregulated. See Rochelle Dreyfuss, *Expressive Generosity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 406-08 (1990). It is difficult to distinguish between commercial and non-commercial speech just as it is difficult to distinguish between political and non-political speech.

<sup>7</sup> See Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287 (1988). Hughes argues that "the greatest difference between the bundles of intellectual property rights and the bundles of rights over other types of property is that intellectual property always has a self-defined expiration, a built-in sunset." *Id.* at 296. This statement is rather puzzling since trademark doctrine lacks such a restriction. Yet, it is possible to apply this notion of sunset and non-sunset restrictions to differentiate trademark from other intellectual property regimes.

<sup>8</sup> See Wendy Gordon, *Toward a Jurisprudence of Benefits: The Norms of Copyright and the Problem of Private Censorship*, 57 U. CHI. L. REV. 1009 (1990) (discussing the ability of copyright holders to deny access to critics and others); William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1661 (1988) (calling for the non-enforcement of fair use when it conflicts with certain public interests); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987) (arguing that the Constitution's copyright clause embodies free speech through a notion of public benefit).

The Supreme Court recently asserted the need to recognize an intellectual property public domain. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) ("Free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception."). Nevertheless, the court's emphasis upon the diffusion of ideas (rather than symbols) suggests that copyright and patent have more compelling claims for free exploitation. *Id.* at 157-60.

<sup>9</sup> To the extent that confusion is more difficult to show, the recent amendment to the Lanham Act, the Federal Dilution Act of 1995, requiring that only commercial use of a famous mark is actionable under dilution standards, creates some relief for non-commercial users of the mark. See 15 U.S.C. § 1125(c).

authorial role in associating a symbol with an object. An authorial model creates competing interests of the public as creator.

A number of legal scholars have proposed alternative models. These are based either upon a personality theory of property rights or the rights of the commons within a labor theory-Lockean paradigm. Connecting ownership with self-constitution or personhood, the personality theory of property argues that certain objects which shape the expression of individual identity should be seen as different than fungible commodities. Other property rights should be balanced against this need for self-construction. Trademarks as status symbols fall under this analysis.<sup>10</sup>

The various forms of Lockean models seek to limit those rights and privileges of trademark owners that intrude upon the public right to either a linguistic or cultural commons.<sup>11</sup> Private trademark privileges are constrained in order to prevent harm to the commons. Here the balancing test is between private rights and public good. Thus, a major concern is that both the personality theory and Lockean paradigms begin with the premise that through sole creation of the trademark, its holder has established ownership. In the original position, according to these models, all property rights belong to the trademark holder. It is only second-in-time concern with the making of individual selves or common good that legitimizes limiting those rights.

What I want to do here is to posit an alternative model of public authorship where private trademark rights are limited from the very beginning. My model is founded upon both a personality theory and a labor theory for creating intellectual property. But there is a major point of departure. Even as these other paradigms limit certain private entitlements they remain highly individualistic: it is the individual identity at stake in the personality theory and the first-in-time individual acquisition in the Lockean labor theory. The public authorship model, however, addresses the question of collective identity. It is the collective personality of culture that participates in the authorship of trademarks and that act of collec-

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<sup>10</sup> See Malla Pollack, *Your Image is My Image: When Advertising Dedicates Trademarks to the Public Domain — with an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1392 (1993). Pollack argues that lifestyle-centered trademarks should be viewed as needed for creation of the self. As this essay progresses, I take a Sandelian position that the self emerges in relationship to the collective. The most articulate exposition of the personality theory is MARGARET JANE RADIN, REINTERPRETING PROPERTY 1-71 (1993). Cf. William Joseph Singer, *The Reliance Interest in Property*, 40 STAN. L. REV. 614 (1988) (arguing that reliance upon the owned property of another should create property rights).

<sup>11</sup> For a discussion of models proposed by Wendy Gordon and Stephen Carter, see *infra* Part III.

tive labor establishes a stake to trademark symbolism contemporaneous with any private claims.

This is significant for a number of reasons. First and foremost, it is significant because it recognizes a too often ignored role of the public in creating property rights. Despite the mixing of labor power, proprietary rights of tangible goods such as manufactured objects are generally assigned to the person who controls the means of production. In intellectual property, where the stakes are cultural, it is possible to make a more cogent argument about the costs of property alienation.

Second, a public authorship model shifts the burden of claims, away from the public and back to the private enterprise seeking trademark protection. Under a personality theory of property, an individual must demonstrate the personal loss entailed as a result of deprivation of certain kinds of property. A Lockean labor model limits ownership only through demonstrable disadvantage to the commons. Here, however, the public does not have to prove harm. Instead, it is the trademark holder's proprietary claims that are limited *ab initio* because of the public contribution in creating the mark.

The third reason for a public authorship model is practical. The model carves out a public stake in all trademarks. Not simply those marks that are charged with status/personal meaning or those that might threaten the cultural or linguistic domain, but the over-all regulation of trademarks by the public is justified as a compelling public purpose. Although according to classical trademark doctrine public regulation of trademarks varies with the distinctiveness of the mark, there is always a core public interest that cannot be lost.

Part I of this article, "Is there an Author for a Trademark?," poses the question of authorship for trademarks. I suggest here that recent scholarship in literary criticism has redefined authorship in ways that are quite relevant to trademark law. It proposes that readers, as well, may serve as creators. Part II, "Functionalism and the Lost Public," critiques Frank Schechter's utilitarian and historicist interpretation of the meaning of trademark. Instead of Schechter's producer-centered history of trademark, tracing its evolution from guild marks to the embodiment of marketing goodwill, this section proposes a consumer-centered counter-history. It shows how the identity of consumer goods originated with palming-off statutes, but accrued its real importance as mass production consumer goods became available, and these goods became identi-

fied with social distinctions. I argue against recognizing sole proprietary rights for the trademark holder.

Part III, "Locke and the Cultural Commons," returns to the question of public rights. Here I examine a number of creative attempts to construct a public entitlement for trademarks based upon Lockean labor theory. While drawing upon these proposals, this section offers a richer reading of Locke which takes into account his linguistic theory of public language-making as well as his theory legitimizing property rights based upon the creator's contribution of labor. I suggest here that a labor theory argument would be strengthened by placing public authorship in the original position.

Part IV, "The Public Role in Trademark Doctrine," examines how deeply the public role is embedded in traditional trademark common law doctrine. The central theme of this section will be authorship through association. Much of the doctrinal landscape traversed is well known: descriptive and arbitrary marks, secondary meaning, confusion and dilution, and abandonment through generic use. By emphasizing the public role in associating meaning with the mark, however, I unite these disparate doctrinal strands to weave a coherent understanding of trademark common law.

### I. IS THERE AN AUTHOR FOR A TRADEMARK?

The question of trademark authorship has often been obscured through cultural commonplaces. Trademarks are bound to a commercial context, functional (identifying a product) rather than primarily creative and condensed rather than an expressive elaboration of ideas and sensibilities. Just as we imagine authors in a picturesque café in Saint-Germain rather than among the shops of Herald Square, such authorship seems an unusual question for commercial language such as trademarks. Yet a trademark is a creature of symbolic language. Like any other symbol or text, trademarks do not simply appear out of whole cloth. They are authored. But what does that mean for a mark rather than a book?

Authorship is not a simple concept for either trademarks or the literary realm of copyright. Take the debates currently raging in copyright scholarship. Drawing upon literary theory, a number of copyright scholars have questioned the very idea of the author.<sup>12</sup>

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<sup>12</sup> Two seminal essays prompted literary debates about authorship that influenced copyright scholars: Michel Foucault, *What is an Author?*, in *TEXTUAL STRATEGIES: PERSPECTIVES IN POST-STRUCTURALIST CRITICISM* 141 (Josué V. Harari ed., 1979), and Roland Barthes, *The Death of the Author*, in *IMAGE-MUSIC-TEXT* 142 (Stephen Heath ed., 1977). See also Jacques Derrida, *Signature Event Context*, 1 *GLYPH* 172-97 (1977).

Authorship, they argue, is a cultural construction.<sup>13</sup> What makes an author? Do not some "authors" (even Shakespeare) stitch together texts from pre-existing plots? Or even borrow characters and scenes whole cloth from other narratives? Why should certain kinds of expression, like literary production, be privileged above other types?<sup>14</sup>

Such questions strike at the core of assigning special legal privileges that restrict the use and distribution of written texts. If authorship is elusive in copyright, however, it is even more so in trademark. While copyright has its classic image of the literary author and patent law its notion of an inventor, trademark is established simply through commercial use.

Compare the role of authorship in trademark and copyright. Launching a critique of copyright's doctrinal insistence upon a central place for the author, Peter Jaszi has traced the rise of this privileged conception to the eighteenth-century origins of copyright doctrine.<sup>15</sup> The Romantic movement, especially, asserted extreme claims for understanding individual works as the expression of an individual self. It created the myth of the author as trans-

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<sup>13</sup> See Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship,"* 41 DUKE L.J. 455 (1991) [hereinafter Jaszi, *Toward a Theory of Copyright*]; Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, 10 CARDOZO ARTS & ENT. L.J. 293 (1992); Robert H. Rotstein, *Beyond Metaphor: Copyright Infringement and the Fiction of the Work*, 68 CHI.-KENT L. REV. 725 (1993); Keith Aoki, *Adrift in the Intertext: Authorship and Audience "Recoding" Rights*, 68 CHI.-KENT L. REV. 805 (1993); Martha Woodmansee, *On the Author Effect: Recovering Collectivity*, 10 CARDOZO ARTS & ENT. L.J. 279 (1992); James Boyle, *A Theory of Law and Information: Copyright, Spleen, Blackmail, and Insider Trading*, 80 CALIF. L. REV. 1413 (1992) (arguing that copyright protection is often predicated upon a distinction between public and private information informed by the stereotype of the Romantic author). See also OF AUTHORS AND ORIGINS; ESSAYS ON COPYRIGHT LAW (Brad Sherman & Alain Strowel eds., 1994) and THE CONSTRUCTION OF AUTHORSHIP, TEXTUAL APPROPRIATION IN LAW AND LITERATURE (Martha Woodmansee & Peter Jaszi, eds., 1994). For a related philosophical inquiry, see Jeremy Waldron, *From Authors to Copiers: Individual Rights and Social Values in Intellectual Property*, 68 CHI.-KENT L. REV. 841 (1993) (noting that cultural assumptions about authorship inform how we think about the legal issues of copying).

Among the historical studies of authorship are Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the "Author,"* 17 EIGHTEENTH-CENTURY STUD. 425 (1984), and Mark Rose, *The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship*, 23 REPRESENTATIONS 51 (1988); see also MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 1-8 (1993); Carla Hesse, *Enlightenment Epistemology and the Laws of Authorship in Revolutionary France, 1777-1793*, 30 REPRESENTATIONS 109 (1990) (tracing the alternative political meanings of authorship in Revolutionary France, from *Ancien Régime* individual creator to Revolutionary actor in a broader project of public enlightenment); Monroe E. Price & Malla Pollack, *The Author in Copyright: Notes for the Literary Critic*, 10 CARDOZO ARTS & ENT. L.J. 703 (1992) (discussing the plasticity of the notion of authorship in copyright). For a comparative perspective, see DAVID SAUNDERS, *AUTHORSHIP AND COPYRIGHT* (1992).

<sup>14</sup> See Peter Jaszi, *Who Cares Who Wrote "Shakespeare?,"* 37 AM. U. L. REV. 617 (1988); James D.A. Boyle, *The Search for an Author: Shakespeare and the Framers*, 37 AM. U. L. REV. 625 (1988).

<sup>15</sup> See Jaszi, *supra* note 14.

formative genius. Jaszi has argued that such a notion of the author is a stalking horse for economic interests that dominate intellectual production at the expense of the public.<sup>16</sup>

Unlike Jaszi's article *Toward a Theory of Copyright*, this essay seeks to resurrect the idea of the author in trademark to carve out a greater role for the public domain. The idea of authorship presented here differs considerably from the traditional Romantic understanding of the author as dominant creative force. Trademark cannot be freighted with mythic notions of authorship in the same way as a great work of literature or art. As Justice Holmes remarked, a trademark cannot be compared to Milton's *Paradise Lost*.<sup>17</sup> Indeed, the public authorial role in trademark is much closer to the Court's definition of authorship as enumerated in *Burrow-Giles Lithographic Co. v. Sarony*<sup>18</sup>: "he to whom anything owes its origin . . ."<sup>19</sup> Trademark originates from a linguistic partnership of consumer/interpreter as well as producer/writer.

#### A. Author As Creator

This essay suggests that trademark is less a matter of invention or design of a sign than the association of a mark with a particular object. Association occurs in two stages. During the first stage, a producer associates a sign with an object. It may be placed upon the object as a label or incorporated into its over-all design. During the second stage, that association is recognized and invested with meaning by the public as an interpretive community.<sup>20</sup> Following association of the object with the sign there is a third stage where the object-sign association is contextualized within a broader cultural context. As will be examined below, the public power of association plays a pivotal role in a number of trademark doctrines

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<sup>16</sup> See Jaszi, *Toward a Theory of Copyright*, *supra* note 13; ROSE, *supra* note 13.

<sup>17</sup> See *Chadwick v. Covell*, 23 N.E. 1068, 1069 (Mass. 1890).

<sup>18</sup> 111 U.S. 53 (1884).

<sup>19</sup> *Id.* at 58. This case still serves as the standard legal definition of authorship. See *Feist Publications v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991) (discussing whether a telephone book is a collection of facts or a copyrightable authored text).

<sup>20</sup> By the word "sign," I mean a fundamental element of communication. A sign has various expressions in trademark law. It may be either linguistic (words as found on a label) or non-linguistic (pictorial representation or trade-dress). According to the widely accepted semiotician Ferdinand de Saussure, the sign has two intertwined characteristics: (1) signifier (the tangible expression of communication) and (2) signified (its conceptual meaning). See FERDINAND DE SAUSSURE, *COURSE IN GENERAL LINGUISTICS* 1-12 (W. Baskin trans., McGraw Hill Book Co. 1974) (1915). I am suggesting an application of these two ideas to trademark doctrine. The first stage is the creation of a signifier (the making of the tangible mark itself). The second stage is that of the signified (the investing of the mark with meaning). I will use these terms from semiotics, sign and signifier, throughout the essay.



such as the establishing of secondary meaning.<sup>21</sup>

Who makes a mark is not an idle question. Intellectual property rights are often founded upon a right to the product of one's own labor that begins with an act of creation. The Lockean notion that creators should be rewarded with just deserts has been enshrined in natural rights arguments for the protection of intellectual property rights against free riders. In the words of Justice Brandeis, a person or corporation should not "reap where it has not sown."<sup>22</sup> Ownership of intellectual property commonly rests upon claims to creation or the transfer of those claims. Regardless of whether the writings remain locked away in a study drawer, like those of Kafka, or lack any economic utility whatsoever, intellectual property rights are linked to authorship.<sup>23</sup>

This article seeks to redefine the public role in making trademarks by drawing upon a dominant insight of post-structuralist cultural theory that interpretation is an act of creation. It uses two critical approaches: (1) new understandings of the meaning of authorship found in reader-response theory, and (2) new understandings of the meaning of consumption and language drawn largely from the work of Pierre Bourdieu. These approaches see cultural forms as constructed through interpretive interaction. Reader-response criticism emphasizes the convergent relationship between the beholder and the work. It views readers as actualizing a text and becoming co-producers of that text through interpretation. The idea of the text encompasses its reception as well as the language composed by the writer.<sup>24</sup>

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<sup>21</sup> See *infra* Part IV.

<sup>22</sup> *International News Service v. Associated Press*, 248 U.S. 215, 239 (1918) (Brandeis, J., dissenting).

<sup>23</sup> See LAWRENCE BECKER, *PROPERTY RIGHTS: PHILOSOPHICAL FOUNDATIONS* (1977); JEREMY WALDRON, *THE RIGHT TO PRIVATE PROPERTY* (1988); Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 *IND. L. REV.* 516 (1993); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 *J.L. & ECON.* 265 (1987); Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 *COLUM. L. REV.* 516 (1981) (asserting that the collection of information warrants copyright because of a labor theory of just deserts); Timothy J. Brennan, *Copyright, Property, and the Right to Deny*, 68 *CHI.-KENT L. REV.* 675 (1993).

For an attempt to construct an economic fair use rationale, see Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 *COLUM. L. REV.* 1600 (1982).

<sup>24</sup> Reader-response theory developed as a response to the New Criticism idea of the autonomy of text. See WOLFGANG ISER, *THE ACT OF READING* 3-52 (1978); WOLFGANG ISER, *PROSPECTING: FROM READER RESPONSE TO LITERARY ANTHROPOLOGY* 3-41 (1989); Tzvetan Todorov, *Reading as Construction*, in *THE READER IN THE TEXT* 67 (Susan R. Suleiman & Inge Crosman, eds., 1980).

Two strands of reader-response theory take a different approach to the question of reader authorship. Closer to the argument in this article, Wolfgang Iser sees readers as co-creators. Georges Poulet, on the other hand, suggests a greater distance between reader and text. He sees the interaction as largely one of two consciousnesses. See Georges

Here it will be argued that the public forms an interpretive community whose reading of trademark symbolism casts it in the role of creating authorial-like meanings about the mark itself. Bourdieu situates language within a social context. All language consists of words and a linguistic market which informs how those words are defined. For Bourdieu language is *contextualized* meaning. It is not static nor an idealized dictionary full of words, but a dynamic exchange of signs, interpretations, and social mimesis, with its meaning shifting from one context to another.<sup>25</sup>

### B. *Investing in a Symbol*

Authorship in trademark can be redefined to include a public act of interpretive association precisely because it lacks the idea of individual authorial/inventive production that lies at the center of other intellectual property regimes. The Constitution established federal regulation of patent and copyright "to promote the progress of science and useful arts by securing . . . authors and inventors the exclusive right to *their* respective writings and discoveries."<sup>26</sup> While acknowledging the practical need to encourage investment in literary and scientific expression, this provocative use of the possessive pronoun implies that copyright and patent may protect intellectual creations for the sake of the creator himself.

With its more tenuous connection to authorship, trademark is not mentioned with patent and copyright. Instead, the Supreme Court in the *Trade-Mark Cases*<sup>27</sup> ruled that federal power to regulate trademarks fell solely under the Commerce Clause: "[T]he ordinary trademark has no necessary relation to invention or discovery."<sup>28</sup> In its decision, the Court made a clear distinction between trademark law and the author-driven doctrines of patent and copyright. It held that trademarks are established often as the result of accident, not of design; that trademarks take root over a considerable period, not as a result of sudden invention; and that they are

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Poulet, *Criticism and the Experience of Interiority*, in *READER RESPONSE CRITICISM* 41 (Jane P. Tompkins ed., 1980). David Bleich argues that the first step in reader-response is fictionalization, the making of an aesthetic object no longer real. See DAVID BLEICH, *SUBJECTIVE CRITICISM* 97-133 (1978). A similar phenomenological response may take place when trademarks as objects are seen as distanced through brands from their utility. Response theory also applies to images such as art. See DAVID FREEDBERG, *THE POWER OF IMAGES: STUDIES IN THE HISTORY AND THEORY OF RESPONSE* 1-26 (1989).

<sup>25</sup> See PIERRE BOURDIEU, *LANGUAGE AND SYMBOLIC POWER* 1-36 (John B. Thompson ed., Gino Raymond & Matthew Adamson trans. 1991).

<sup>26</sup> U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

<sup>27</sup> 100 U.S. 82 (1879).

<sup>28</sup> *Id.* at 94.

not the "fruits of intellectual labor,"<sup>29</sup> unlike copyrights or patents.

This remarkable early admission of the problem of authorship in trademarks has gone relatively unnoticed. The dilemma comes from two commonplaces. First, there is the identification of right to ownership with creativity. How much creativity is enough to warrant protection?<sup>30</sup> Nobel Prizes are not awarded for trademarks. Despite Madison Avenue's self-promotion about creative advertising, no one speaks of a trademark artist. Fabricating symbols seemed to the Supreme Court in the *Trade-Mark Cases* as requiring "no fancy or imagination, or genius"<sup>31</sup> and as too simple a task to "legitimize an entire intellectual property regime."<sup>32</sup>

The second rights argument justifying intellectual property is based upon labor. A large expenditure of intellectual labor is not required to design a label. Here, too, the *Trade-Mark Cases* Court seemed skeptical, stating that trademark is "simply founded on priority of appropriation."<sup>33</sup> How much "sweat of the brow" is needed to establish proprietary rights?<sup>34</sup> Taking a natural rights approach, however, trademark must be justified by some form of labor.

If not *intellectual* labor, then what kind of labor can serve as the foundation for proprietary privileges? How can the rights of the trademark holder be predicated upon investing labor in symbolic production? The solution has been to shift the notion of labor investment from the actual sign to the good will embodied by that sign. Good will is defined as the willingness of a customer to continue doing business after the first transaction. It is a bit of a semiotic shell game: the consumer object is signified by good will

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<sup>29</sup> *Id.*

<sup>30</sup> Even with copyright, there is a concern that the act of creation be original and independent enough. See Jaszi, *supra* note 14 (noting that Shakespeare's dramas, written prior to the rise of authorial dominance, are a pastiche of material from other sources and demonstrate the difficulty of determining originality standards); Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993) (attempting to determine thresholds of creativity that might warrant protection); Elizabeth H. Wang, *(Re)productive Rights: Copyright and the Post-Modern Artist*, 14 COLUM.-VLA J.L. & ARTS 261 (1990) (explaining that the multiplicity of modern art media often entails reproduction, making it difficult to determine originality in traditional ways).

<sup>31</sup> *Trade-Mark Cases*, 100 U.S. at 94.

<sup>32</sup> *Id.*

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

<sup>34</sup> Courts have come to differentiate between creativity and hard work. See Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Information*, 90 COLUM. L. REV. 1865 (1990) (recognizing the need to protect "high authorship," such as literature, justified through creativity and "low authorship," such as maps and computer data bases, justified through labor arguments). Justice O'Connor recently stated that "copyright awards originality, not effort." *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991); see also Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992) (arguing that the *Feist* decision fails to fulfill the Constitutional mandate promoting the creation of intellectual property).

which, in turn, is signified by a trademark.<sup>35</sup>

Is it possible to argue that trademarks are institutional publicity rights?<sup>36</sup> Just as individuals have the right to control commercial use of their identity so should the identity of products be protected. Identity for trademark reflects the product itself and the feelings it generates (i.e., good will). This makes for an important distinction between publicity rights and trademarks. Publicity rights depend upon the identification of the persona. A celebrity expends considerable efforts to make his or her self distinct. Elton John wears peculiar glasses, Madonna can often be found in lingerie. No prior commercial exploitation of that self is necessary. Good will, however, depends upon the reputation of a product with consumers in a commercial setting. It requires consumer consciousness. This explains why there is a confusion rationale for trademarks but not for publicity. Good will is an identification created by the public.<sup>37</sup>

But is good will authored in the same way as more tangible symbols? The classic understanding of good will is as reputation. While trademark serves as the marker for how a potential consumer might identify a product, the good will itself is seen as emerging from care in maintaining quality and marketing. The next section traces the emergence of a modern doctrine of good will. It examines the seminal trademark theory of Frank Schechter who transformed good will from consumer evaluation of quality into brand attachment generated through mass marketing.

## II. FUNCTIONALISM AND THE LOST PUBLIC

No work has been more influential in shaping the lenses

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<sup>35</sup> See J. THOMAS MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION* § 2.7-2.10 (2d ed. 1984).

<sup>36</sup> See Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603 (1984) (suggesting that the confusion rationale provides insufficient protection for corporate logos and that there should be a right analogous to a publicity right for these symbols); Pollack, *supra* note 10 (arguing that symbols serving as markers for lifestyles should receive less protection).

<sup>37</sup> See MCCARTHY, *supra* note 35, § 28.01-28.02; Robert C. Post, *The Social Foundations of Defamation Law: Reputation and the Constitution*, 74 CAL. L. REV. 691 (1986) (referring to reputation as property because it reflects exertion of labor or talent to create self).

In *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977), an analogy is made to the goals of patent and copyright that protects creative labor. Interestingly, the Supreme Court does not make a comparison to trademarks where, as discussed above, it is more difficult to make an argument founded upon notions of creative labor. Yet, publicity rights are also very much a creature of legal making. See JANE M. GAINES, *CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW* 1-41 (1991); Michael Madow, *Private Ownership and Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 147-81 (1993) (illustrating how Melville Nimmer, who frequently represented Hollywood interests, worked to create a tort distinct from a privacy tort).

through which we examine trademark doctrine than that of Frank Schechter. Prior to his two works, the pathbreaking 1926 article, *The Rational Basis of Trademark Protection*,<sup>38</sup> and a 1925 book entitled *Historical Foundations of Trade-Mark Law*,<sup>39</sup> trademark common law rarely addressed broader questions of purpose.<sup>40</sup> Moreover, Schechter's thinking was embodied in the codification of trademark doctrine in the Lanham Act. In this section I will examine Schechter's functionalist and historical claims at some length, addressing each in turn. I will also argue that Schechter's notion of trademark has been critical in establishing the idea of the public as a distant and disenfranchised entity.

#### A. *Functional Denial of the Public Role*

Schechter began by rejecting the earlier orthodoxy of trademark as a means of identifying the source of a product.<sup>41</sup> He argued that it does not matter whether cocoa comes from one manufacturer or another.<sup>42</sup> Do consumers really care? Are they familiar with different manufacturing processes? What is significant is that the trademark, the sign affixed to goods serves as a promise of a certain quality. Schechter disassociated trademark from the sphere of production and reassociated it with consumption. More will be said about this intellectual shift when discussing Schechter's historical argument.<sup>43</sup>

This step was critical for the most daring part of Schechter's argument, that "the trademark is not merely the symbol of good will but often the most effective agent for the creation of good will, imprinting upon the public mind an anonymous and impersonal guaranty of satisfaction, creating a desire for further satisfac-

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<sup>38</sup> See *supra* note 1.

<sup>39</sup> FRANK L. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADEMARKS* (1925).

<sup>40</sup> See Schechter, *supra* note 1, at 813-33; Elizabeth Cutter Bannon, *Revisiting "The Rational Basis of Trademark Protection,"* 24 J. MARSHALL L. REV. 65 (1990); SCHECHTER, *supra* note 39. Schechter's task, as he saw it, was to update the trademark doctrine to create stronger protection at a time of expanding commerce and broad national markets. Looking beyond reliance on traditional common law of trademarks, he sought federal legislation that would embody common law notions with Schechter's own readings of the purposes behind those notions. See Schechter, *Fog and Fiction in Trade-Mark Protection*, 36 COLUM. L. REV. 60 (1936). Schechter is also seen as the father of dilution doctrine in trademark, identifying the injury that would result from the unauthorized use of an established mark to identify non-competing goods. Elliot B. Staffin, *The Dilution Doctrine: Towards a Reconciliation with the Lanham Act*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 105, 108 (1995).

<sup>41</sup> See Schechter, *supra* note 1, at 814

<sup>42</sup> *Id.* at 813-33.

<sup>43</sup> See *infra* Part II.B.

tions.”<sup>44</sup> The transformation is striking. No longer a passive marker of origins, trademark becomes a kind of motor that sets into motion latent consumer demand. It is a magical invocation that conjures up tempting images, desires, and consumer fantasies. In traditional trademark doctrine, good will emerged only from repeat transactions. For Schechter, however, good will might be actively created through marketing.

Not too much imagination is needed to see that fueling Schechter’s essay was a Keynesian paradigm for stimulating stagnant markets.<sup>45</sup> Product differentiation elicits consumer desire and therefore increases purchasing, making the economy stronger. The purpose of trademark, in short, was to help generate longing for more consumer goods. In Schechter’s words, “the mark actually sells the goods.”<sup>46</sup> Behind this model lies a utilitarian rationale. Commercial regulation of trademarks maximizes the good through encouraging quality products, decreases consumer search costs, and (significantly for Schechter) reinvigorates the macroeconomy.

The public would benefit. At the same time, however, the public was seen as largely one-dimensional and passive, subject to shrewd attempts to shape its consciousness. Schechter assumed a model of consumer manipulation. At the time when Schechter was writing and Madison Avenue was just beginning to shape the tastes of a consuming public, such a straight-forward model of consumer response must have been more compelling. It continues to have immense influence on trademark doctrine. Yet in light of contemporary cultural studies, Schechter’s functionalism seems remarkably impoverished. Two arguments undercut his model: (1) Schechter ignored the cultural function of trademarks that extends beyond their economic value, and (2) this cultural function is defined through a complex field of public symbolic readings and not simply through marketing.

### 1. Cultural Functionalism and Territories of the Self

Schechter distinguishes between producer and consumer in *The Rational Basis of Trademark Protection*.<sup>47</sup> The producer or marketer is a rational maximizer of private gain (and, as a conse-

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<sup>44</sup> Schechter, *supra* note 1, at 819.

<sup>45</sup> Around 1930, shortly after the publication of Schechter’s *Rational Basis*, other functional interpretations emerged. See Nathan Isaacs, *Traffic in Trade Symbols*, 44 HARV. L. REV. 1210 (1931), and Grover C. Grismore, *The Assignment of Trade-Marks and Trade Names*, 30 MICH. L. REV. 489 (1932).

<sup>46</sup> Schechter, *supra* note 1, at 819.

<sup>47</sup> *Id.*

quence, public good) who employs rational marketing strategies. Conversely, Schechter defines inclinations as irrational. The consumer is full of fanciful tastes and acts according to whims generated through clever marketing. Why, after all, should consumers prefer blue jeans of one brand over another of equal quality? Why drive a Mercedes when a Chevrolet might provide just as adequate transportation?<sup>48</sup>

Schechter's argument favors trademark holders by privileging them for their rationality. Yet, are consumers really irrational? The seemingly irrational, arbitrary, and simply responsive choices of consumers are just the opposite.<sup>49</sup> Purchasers carefully choose material goods to construct an outward expression of identity. Just as producers charge a symbol with meaning through advertising, consumers invest social or cultural capital. In the evocative phrase of Irving Goffman, consumers make possible "territories of the self."<sup>50</sup> Schechter's functionalism is too limited because it fails to take into account the way trademarks themselves act as cultural signs. The style of the object as well as the mark identifies the user. A consumer might declare herself the kind of person who wears Polo horn-rimmed glasses (rather than any other sort) and affects the particular Anglophilia of Ralph Lauren tweed. Alternatively, a consumer might opt for a more American, more macho persona, wearing Stetson hats and smoking Marlboros. Identification with a particular trademark is intimately bound with self-constitution.

Moreover, individuals invest marks with meaning far beyond what is assigned by marketers. Take granola, for example. A granola manufacturer might market its product as natural or healthy. Consumers, on the other hand, borrow the corporate symbol of this granola and use it to identify themselves as proponents of a simple life. The trademark then cascades with a host of other symbols such as Birkenstock sandals, Thoreau, Vermont woods, vegetarianism, Walt Whitman, and Shaker furniture.

This seems to point towards a possible personality theory of property argument. Consumer proprietary rights are based upon the close attachment of consumer identity with trademarks. But such claims would be weakened by the fact that there is already ample access within markets to the cultural symbols embodied by

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<sup>48</sup> For a major critique of the manipulative model, see MARY DOUGLAS & BARON ISHERWOOD, *THE WORLD OF GOODS: TOWARDS AN ANTHROPOLOGY OF CONSUMPTION* 15-24, 56-70 (1978).

<sup>49</sup> See JOHN O'SHAUGHNESSY, *WHY PEOPLE BUY* 79-97 (1987); DAVID PEARS, *MOTIVATED IRRATIONALITY* 2-16 (1984).

<sup>50</sup> IRVING GOFFMAN, *RELATIONS IN PUBLIC: MICROSTUDIES OF THE PUBLIC ORDER* 28-61 (1971).

material goods. For example, if personal identity is already attached to Chanel No.5, designer clothes, or a certain type of automobile, then all the consumer has to do is purchase the item. It is also difficult to untangle circular arguments about consumer manipulation and consumer autonomy. Does a buyer purchase a shirt with a prominent L.L. Bean logo because advertising has communicated that this speaks of rural independence or because as a Maine-sort-of-person there is a need to borrow the commercial expressions of that lifestyle? Or, does the purchase occur for both reasons?

## 2. Collective Meaning of Symbols

Personality theory must be mixed with a labor theory of property. The public, marketers, and any denizens of the contemporary cultural landscape dwell in a world that has been collectively created. Here, again, the work of Pierre Bourdieu is important. Bourdieu views consumer choice as taking place within a field of cultural norms. The purchasing of goods is an attempt to place oneself within that field. In his classic work, *Distinction*,<sup>51</sup> Bourdieu shows how consumers make choices constrained by social norms that suggest what is appropriate for their status and social position. Marketing simply avails itself of these pre-existing social categories.

The collective investment in creating these cultural and social categories is immense. Limiting his view to economic investment, Schechter fails to take into account the cultural investment of a symbol with meaning. This economic focus explains his primary concern with protecting the trademark holder's investment. For Schechter, the crux of trademark protection is anti-dilution.

Dilution as a potential harm is defined as "the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods."<sup>52</sup> Here again, the public mind is critical but the public right is minimal. Even though Elm City Beer only refers to a kind of ale, for example, its mark would be protected against use identifying other goods such as packaged nuts or pretzels. It does not matter whether the public is mistaken about the business relationship between the beer and the snack food.

Instead, anti-dilution protection is a kind of boundary tending, cordoning off use of alternative names and symbols by other

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<sup>51</sup> PIERRE BOURDIEU, *DISTINCTION: A SOCIAL CRITIQUE OF THE JUDGEMENT OF TASTE* 2-43 (Richard Nice trans. 1984).

<sup>52</sup> Schechter, *supra* note 1, at 825.



goods in order to avoid competing images or symbols gaining access to consumer consciousness. Trademark holders are the primary beneficiaries of dilution doctrine. However, there are other concerns that trademarks might be seen as protecting such fraud. Schechter makes a claim for stronger protection of property rights in trademarks by focusing on the cause for relief rather than the deception of the public. Schechter seeks to protect a producer's good will investment from infringement. The producer standardizes production, invests in advertising, and targets certain markets. No question exists today about the magnitude of this labor-capital investment. Vast resources are expended on advertising alone. Nike, for example, has spent close to three hundred million dollars on advertising.<sup>53</sup> The image is one of hardscrabble merchandising at best, manipulation of consumers at worst. As Justice Frankfurter wrote, the holder of a trademark exploits the psychological function of symbols by "making every human effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol."<sup>54</sup>

Not only do marketers invest in trademarks, but consumers make a considerable investment as well. They invest psychological meaning, as seen in the significant sales of goods emblazoned with the old-fashioned Coca-Cola mark, and they often invest additional capital by consciously choosing to purchase a specific brand rather than another. In fact, their affirmative purchasing of goods subsidizes the advertising costs invested by marketers. If trademarks ensure product differentiation, sustain quality, create a usable shorthand to lower consumer search costs, or help stimulate the economy, it is the consumer who pays dearly for these benefits through his or her pocketbook.<sup>55</sup>

Finally, Schechter's *Rational Basis* implicitly assumes that investment should be rewarded. Yet many other kinds of investments (like those in innovative machinery, untried technology, or a new

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<sup>53</sup> See *Nike, Inc. v. "Just Did It" Enterprises*, 6 F.3d 1225, 1225-28 (7th Cir. 1993). For a discussion of *Nike*, see *infra*, notes 153-56 and accompanying text.

<sup>54</sup> *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

<sup>55</sup> Law and economics analysis has been used largely to legitimate trademark holders' economic advantage. See Landes & Posner, *supra* note 23 (asserting that the use of trademarks contributes to wealth-maximization through promoting economic efficiency through diminishing search costs and stimulating quality production).

A number of scholars have shed doubt on the economic advantages of intellectual property regimes. See, e.g., Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L.J.* 1165 (1948) (arguing that the reputation of goods, not advertising value, is in the public interest); Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 *HARV. L. REV.* 281 (1970) (disputing the economic advantages of copyright exclusion); Ralph H. Folsom & Larry L. Tepley, *Trademarked Generic Words*, 89 *YALE L.J.* 1323 (1980).

physical location) lack any sort of protective privileges. Investments are often more important for generating economic value. Why should investments in good will be singled out for reward with a grant of monopolistic rights over the use of a particular symbol? Trademarks might even erect unnatural barriers to market entry by other products at a cost to the economy as a whole. Schechter's tilting of protection in favor of private property interests represents more than the inability to recognize a more robust public role. It emerges from a larger failure to see trademark as anything more than a one-dimensional economic actor.

### B. *Historical Denial of the Public Role*

The public has fared no better through Schechter's investigation of trademark legal history. According to Schechter, trademarks underwent a transformation from a guild mark indicating origins to a functional symbol representing the quality of a product.<sup>56</sup> Schechter argued that when trademarks ceased to be compulsory guild symbols in the early modern period, they became commercial assets in their own rights.<sup>57</sup> This tale, then, is about the rise of trademarks as property. Producers saw trademarks first as exclusive patents from the Crown, later as property. Schechter fails, however, to address the public's historical role in shaping the creation of these symbols.<sup>58</sup>

Just as Peter Jaszi has mined the legal history of copyright,<sup>59</sup> it is necessary to construct a revisionist historical understanding of trademark. Jaszi argues that the Romantic movement fabricated a new notion of the author as a larger than life literary figure.<sup>60</sup> Here it will be argued that Romanticism was critical for constructing a public authorial stake in trademark. A seminal recent book, Colin Campbell's *The Romantic Ethic and the Spirit of Modern Consumerism*,<sup>61</sup> links mass consumption with the Romantic movement's search for individual expression. Romanticism emphasized the development of sensibilities through objects of art and the self-conscious awareness of the magnetic power (sometimes attractive,

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<sup>56</sup> See generally, Schechter, *supra* note 1, at 813-15. For a recent discussion of trademarks prior to the Industrial Revolution, see Keith M. Stolte, *How Early Did Anglo American Trademark Law Begin? An Answer to Schechter's Conundrum*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 505 (1993).

<sup>57</sup> *Id.* at 815-19.

<sup>58</sup> See SCHECHTER, *supra* note 39, at 3-18, 78-79.

<sup>59</sup> See Jaszi, *Toward a Theory of Copyright*, *supra* note 13.

<sup>60</sup> See *id.* at 455.

<sup>61</sup> COLIN CAMPBELL, *THE ROMANTIC ETHIC AND THE SPIRIT OF MODERN CONSUMERISM* (1987).

sometimes repulsive) of a world of clearly differentiated goods.<sup>62</sup>

The Romantic Movement was a critical component in the creation of authorship for copyright. The movement also played an important role in making mass consumer culture, with all its authorial implications for trademarks. The widening variety of available consumer goods were used to craft an outer presentation of the self. Schechter traces the emergence of trademark from a signifier of an object's origins to its identity as property. The historical presentation below suggests a counter-narrative that reverses Schechter's approach by arguing that trademarks began as property. During the age of mass consumption, however, they became a form of expressive language.

### 1. Signs Emerge from Historical Context

Peter Jaszi points to the ways texts were constructed from surroundings.<sup>63</sup> In a similar fashion, an historical revision of trademark legal history would discuss the context of the market culture that served as a milieu shaping the relationship between trademarks and the public. Schechter does the opposite. He sees trademark as a sign affixed to an object rather than as a dynamic language emerging in the midst of market exchanges.

This literalist association of sign with trademark is the reason Schechter begins his genealogy of trademarks with guild marks. It is an unfortunate choice for his argument. The guild mark was most certainly seen as a property asset. It did not signify the identity of the object for the benefit of consumers as much as it served as a patent granted for the sake of producers. Similar to Schechter's depiction of modern trademark as non-physical property rights, guild marks represented a bundle of rights against others.

The right to exclusive production was valued rather than the symbol itself. Since only certain guilds were allowed to make certain products, competition for these monopoly privileges was stiff. For example, when umbrellas came to France toward the end of the seventeenth-century, the wooden comb guild (which pointed to the handle) and the fan guild (which pointed to the fabric) battled for a state patent. The guild mark was most certainly a sought after species of property. The purpose of guild marks was to impede free competition.<sup>64</sup>

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<sup>62</sup> *Id.*

<sup>63</sup> See Jaszi, *Toward a Theory of Copyright*, *supra* note 13, at 456.

<sup>64</sup> A standard account of the history of trademark law can be found in MCCARTHY, *supra* note 35, § 5.1. See also SCHECHTER, *supra* note 39; WILLIAM H. SEWELL, JR., WORK AND

A guild mark shares some troubling similarities with Schechter's notion of functional trademarks. It was protected to benefit the producer, created differentiated markets, and established a monopoly (if not over symbolic expression) at least over production. Nor was Schechter correct that the guild mark served to identify the origins of goods. There was no reason to do so. For the most part, transactions were face-to-face. Personal attestations made by sellers served as a mark for the object. Moreover, all objects of a certain sort were either produced by a specific guild or imported. Counter to Schechter's portrait, the guild mark ensured quality through self-regulation. Each trade community had inspectors who examined products to ensure that they met certain standards.<sup>65</sup> If not, they might be destroyed on the spot. Sumptuary laws and a culture of status-based consumption limited the extent to which guild marks might entice consumers.

The problem is not that Schechter was an inaccurate historian. Historical research was not, after all, his area of expertise. What is important is that Schechter's identification of trademarks with guild marks, and his notion of their ultimate transformation into a species of property, invests producers with an historical justification for a private entitlement to trademarks. Indeed, it would have been possible for Schechter to tell a different story, one that began with the rise of unfair competition doctrine in the mid nineteenth century. The centerpiece of this counter-narrative would have been the consuming public.

With the exception of a tort for the fraudulent palming off of goods as those of another, little trademark doctrine developed until the middle of the nineteenth century. Its real emergence came as the Industrial Revolution increased access to commodities. In 1844, Justice Story granted the first injunction for trademark infringement.<sup>66</sup> Congress did not pass its first trademark statute seeking to regulate registration protected under common law until the 1870s.<sup>67</sup> The Supreme Court grappled with its constitutional basis in the *Trade-Mark Cases*.<sup>68</sup> England followed a similar chronology, formalizing trademark by statute during the 1880s.<sup>69</sup> In the

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REVOLUTION IN FRANCE: THE LANGUAGE OF LABOR FROM THE OLD REGIME TO 1848 2-37 (1980).

<sup>65</sup> In France, these inspectors were called *jures*.

<sup>66</sup> See LAWRENCE M. FRIEDMAN, A HISTORY OF AMERICAN LAW 226-27 (1973).

<sup>67</sup> An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights, Ch. 2, §§77-84, 16 Stat. 198 (1870).

<sup>68</sup> 100 U.S. 82 (1879).

<sup>69</sup> See Patents, Designs, and Trademarks Act, 46 & 47 Vict, c.57 (1883); Merchandise Marks Act, 50 & 51 Vict, c.28 (1887).

case of both England and America, however, these statutes sought largely to prevent fraud against the public.

Schechter's decision to embark upon trademark history with guild marks as his starting point rather than unfair competition demonstrates a view of trademarks that favors producers. Trademark history is conflictual. There are two competing interpretive strands: (1) trademark as protecting producer property rights (Schechter's appeal to guild mark origins) against trademark as protecting consumers from fraud (unfair competition laws), and (2) trademark as expression of product for the purpose of marketing (Schechter's functionalism) against trademark as expression of consumer's cultural attachment to product (cultural critique as developed below). The first halves of these equations emphasize producer rights, the second halves focus upon consumer interests. Schechter, and the prevailing commonplace legal theory, have favored producers because they have failed to reevaluate the cultural role of trademarks. In the next section, it will be argued that the rise of a mass culture of consumption created new consumer-centered meanings for trademarks.<sup>70</sup>

## 2. Birth of a Consumer Society

Historians speak of the birth of a consumer society in late eighteenth-century England. This transformation was sparked by the commercialization of fashion in the form of development of shop windows, rapid obsolescence of styles, emphasis upon novelty and an explosion of available consumer goods. Josiah Wedgwood pioneered product differentiation with china patterns targeted for different segmented markets. For the patriotic middle class, Wedgwood had scenes of Chatham dying and Wesley preaching. Through royal patronage, however, he also appealed to consumption that mimicked aristocratic tastes. England's new commercial activity was still largely based upon small workshops. Yet consumers animated much of England's shift to economies of scale. Sustained with profits from trade, a growing middle class demanded more and more consumer goods. New tastes and preferences were developed that could only be met by mass production.<sup>71</sup>

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<sup>70</sup> See McCARTHY, *supra* note 35, § 2.7-2.10; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (stating that historical origins of trademark doctrine constitutes common law fraud, and "while that may result in the creation of 'quasi-property rights' in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.").

<sup>71</sup> See NEIL MCKENDRICK ET AL., *THE BIRTH OF CONSUMER SOCIETY IN EIGHTEENTH-CENTURY ENGLAND* 1-196 (1982); GRANT McCracken, *CULTURE AND CONSUMPTION: NEW APPROACHES TO THE SYMBOLIC CHARACTER OF CONSUMER GOODS AND ACTIVITIES* 3-30 (1988);

By the middle of the nineteenth-century, large scale manufacturing of consumer goods set into motion a second consumer revolution, a culture of mass consumption. Trademarks were enmeshed in the emergence of this fully elaborated culture of mass consumption in the late nineteenth-century that stretched from the Bonmarché to the conspicuous consumption of the Gilded Age. The hallmarks of mass consumption included international exhibitions and fairs, industrial design and the rise of professional advertising. But the most striking development in this period was the advent of department stores.<sup>72</sup> Filled with consumer norms of a growing bourgeoisie, department stores reproduced aristocratic conceptions of luxury while reflecting distinctly middle-class notions of domesticity. However, making goods widely available threatened to erode the social distinctions created through different patterns of consumption. The division of products into a variety of different kinds, made still more differentiated through trademark, allowed the reestablishment of status-based distinction.

The culture of mass consumption represented by department stores also served as the centerpiece of a new consumer mentality where consumer choice served as a primary means of establishing individual identity. In his classic theory of conspicuous consumption, Thorstein Veblen attributes a good deal of purchasing to imitation or emulation<sup>73</sup>. However, Veblen's conception overemphasizes the role of consumption in signaling status. It fails to appreciate the ways that consumption constructs identity in a variety of more complex ways. This identity construction is placed within a broad field of cultural forms.

With this new found emphasis upon consumption as expression, trademarks took on an increased significance paralleling the rise of mass consumer markets. In England and America, the Morrisonian Arts and Crafts movement as well as a backward-looking aristocratic intellectual movement, represented by such figures as

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William M. Reddy, *The Structure of a Cultural Crisis: Thinking about Cloth in France Before and After the Revolution*, in *THE SOCIAL LIFE AS THINGS: COMMODITIES IN CULTURAL PERSPECTIVES* 261 (Arjun Appadurai, ed. 1986) (tracing the difficult passage from guild produced cloth to commodity).

<sup>72</sup> See JEAN-CHRISTOPHE AGNEW, *COMING UP FOR AIR: CONSUMER CULTURE IN HISTORICAL PERSPECTIVE* (John Brewer & Roy Porter, eds., 1993); William R. Leach, *Transformation in a Culture of Consumption: Women and Department Stores 1890-1925*, 74 *J. AM. HIST.* 71 (1984); MICHAEL B. MILLER, *THE BON MARCHÉ: BOURGEOIS CULTURE AND THE DEPARTMENT STORE 1869-1920* (1981); SIMON J. BONNER, *CONSUMING VISIONS: ACCUMULATION AND THE DISPLAY OF GOODS IN AMERICA 1880-1920* (1989); SUSAN STRASSER, *SATISFACTION GUARANTEED: THE MAKING OF THE AMERICAN MASS MARKET* (1989); ROBERT W. RYDELL, *WORLD OF FAIRS: THE CENTURY OF PROGRESS EXPOSITIONS* (1993).

<sup>73</sup> THORSTEIN VEBLEN, *THE THEORY OF THE LEISURE CLASS: AN ECONOMIC STUDY ON INSTITUTIONS* (Penguin USA 1994) (1899).

Henry Adams, Henry James, and William Dean Howells, demonstrated an ambivalent relationship to mass consumption.<sup>74</sup> But many citizens of this new consumer society chose not to repudiate mass-produced goods. A broader response was to personalize material goods themselves. For example, Victorians identified themselves with a certain kind of fountain pen or a set of leatherbound copies of Trollope.

An analogy is often made between trademark privileges and publicity rights. The trademark creates publicity for an object. Taking this one step further, the trademark itself (especially in certain circumstances where goods are more personal or serve cultural functions as symbols) becomes the marker not just for an object but for other things as well, such as an individual consumer and a variety of cultural meanings that the mark might represent. Birkenstock might be the trademark for both an individual and a pair of sandals. Both, in a sense, bear the same symbol. What this means is that trademark is further disentangled from production. In a more impersonal and anonymous world, trademark recreated a personalized connection. But the connection in a full-fledged consumer society is to the object. Marx called this disassociation between production and consumption (and the consequential depiction of commodities as having their own meaning independent of their physical nature) "commodity fetishism."<sup>75</sup>

The world of consumers has often been portrayed as individual, as individual choice and individual presentation of the self (where people pride themselves on their uniqueness and their difference from others). It evokes images that place individuals within different categories of class, status, or sensibility. But many of the choices made by individuals reflect broader cultural preferences. Middle-class Englishmen might prefer one set of goods, upper-class another. These cultural distinctions created the sphere in which consumption took place. Despite the individual choices made by buyers, a collective definition of consumers emerged during the nineteenth century.

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<sup>74</sup> See E.P. THOMPSON, WILLIAM MORRIS: ROMANTIC TO REVOLUTIONARY 1-21 (1955); T. J. JACKSON LEARS, NO PLACE OF GRACE: ANTIMODERNISM AND THE TRANSFORMATION OF AMERICAN CULTURE 1880-1920 261-298 (1981); JEAN-CHRISTOPHE AGNEW, THE CONSUMING VISION OF HENRY JAMES 64-100 (Richard Wrightman & T.J. Jackson Lears eds., 1980); ROSS POSNOCK, THE TRIAL OF CURIOSITY: HENRY JAMES, WILLIAM JAMES, AND THE CHALLENGE OF MODERNITY 27-53 (1991); DAVID E. SHI, THE SIMPLE LIFE: PLAIN THINKING AND HIGH LIVING IN AMERICAN CULTURE (1985).

<sup>75</sup> KARL MARX, CAPITAL: A CRITIQUE OF POLITICAL ECONOMY (Frederick Engels ed., Samuel Moore & Edward Aveling trans., The Modern Library 1936) (1867); see SIDNEY W. MINTZ, SWEETNESS AND POWER: THE PLACE OF SUGAR IN MODERN HISTORY 3-150 (1985) (studying the disassociation between consumption and production).

Narrow Schechterian notions of functionalism lost sight of the cultural construction of consumer objects by grafting utilitarian conceptions of public benefit onto the dominant nineteenth-century legal ideal of individual ownership. Not surprisingly, then, public benefit pales in comparison to tangible private property rights. The public inhabits only a shadowy place in Schechter's paradigm.

### III. LOCKE AND THE CULTURAL COMMONS

The success of Schechter's functionalism did not bode well for the public domain. In response, a number of imaginative scholars have taken a natural rights path that leads back to John Locke. In many ways, Locke is the natural starting point for a discussion of property rights. His *Two Treatises of Government*<sup>76</sup> have informed virtually every philosophical consideration of ownership. Both the Constitution and courts drew upon it as a source demonstrating the legitimacy of proprietary rights.<sup>77</sup> Using Locke to carve out public entitlement, however, has its risks because it has been seen as a manual for individual acquisition. In C.B. MacPherson's classic portrait, Locke legitimized the private proprietary instinct that served as the basis for early modern capitalism.<sup>78</sup> But Locke also may be read for the limits placed upon the appropriation of property. It should be recalled that at the center of Locke's philosophical landscape stood a commons.

Briefly stated, Locke's theory of property is described as life, liberty, and estates.<sup>79</sup> It includes not only real property but ownership of rights as well. This is especially important for more intangible forms of intellectual property. Most discussions of Lockean property theory have retained real property as the sole model. But

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<sup>76</sup> See JOHN LOCKE, *TWO TREATISES OF GOVERNMENT* (Peter Laslett ed., 1960) (1690).

<sup>77</sup> See John Dunn, *The Politics of Locke in England and America in the Eighteenth Century*, in JOHN LOCKE: PROBLEMS AND PERSPECTIVES 45 (John Yolton ed., 1969) (arguing against the influence of Locke on American Revolutionary thought). *But see* SHANON C. STIMSON, *THE AMERICAN REVOLUTION IN THE LAW: ANGLO-AMERICAN JURISPRUDENCE BEFORE JOHN MARSHALL* 40-48 (1990) (reaffirming the significance of Locke).

<sup>78</sup> See C.B. MACPHERSON, *THE POLITICAL THEORY OF POSSESSIVE INDIVIDUALISM: HOBBS TO LOCKE* 194-97 (1962). James Tully has presented a collectivist Locke as opposed to Macpherson's possessive individual. Pointing to the absence of private property in a state of nature, Tully argues that private property exists only in a civil society and can therefore be redistributed for the public good. See JAMES TULLY, *A DISCOURSE ON PROPERTY: JOHN LOCKE AND HIS ADVERSARIES* (1980).

<sup>79</sup> See JOHN LOCKE, *The Second Treatise of Government*, ch. 9, § 123, in LOCKE, *supra* note 76. This broad definition of rights has been the source of some controversy. Compare EDWARD ANDREW, *SHYLOCK'S RIGHTS: A GRAMMAR OF LOCKIAN CLAIMS* 3-24 (1988) (defining rights as permission, not as moral direction), with A. JOHN SIMMONS, *A LOCKEAN THEORY OF RIGHTS* 3-101 (1992) (defining rights as a whole theory of moral determination that shapes politics and economics).



intellectual property, trademarks in particular, is different. Two arguments will be made about that difference. First, intellectual property has a special relationship to a collective cultural construction of the self. Second, it will be shown that intellectual property is a creature of civil society and that different rules apply to a commons in civil society than in a state of nature.

Every individual begins with a property right in that person's body. In Locke's original position, a state of nature, all other property is held in common. Locke's reading of this earliest condition is driven by a theological conception of a property transfer from God to humankind in common. No person or property is subject to the arbitrary power of any other individual. But God also bequeaths a reason to exploit the commons for individual gain. Since idleness is a sin, people have an affirmative duty to work at their property, satisfying basic needs for themselves and others.<sup>80</sup> The commons is meant to provide sustenance for everyone. There is a limit to how much man can enjoy this world in a natural state. Common land cannot be fully exploited. Therefore Locke suggests that private acquisition of property allows persons to improve property, increasing its value. In the earliest stages of appropriation there is a limit as to how much can be privatized: "*As much Land as a Man Tills, Plants, Improves, Cultivates, and can use the Product of, so much is his Property.*"<sup>81</sup> The rise of a monetary system ("*a little piece of yellow Metal, which would keep without wasting or decay*"),<sup>82</sup> however, enlarges the amount of land that might be appropriated for the benefit of both the possessor and society as a whole. Appropriating land "increase[s] the common stock of mankind," through yielding more produce than uncultivated common land.<sup>83</sup> But private acquisition should neither cause harm by taking away the sustenance of others nor lead to waste.<sup>84</sup>

Acquisition takes place through mixing labor with property. By gathering acorns, according to Locke's well-known image, labor

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<sup>80</sup> LOCKE, *supra* note 79, ch. 5, §§ 26-34. God gave the world for "the use of the Industrious and Rational (and *Labour* was to be *his Title* to it) not to the Fancy or Covetousness of the Quarrelsome and Contentious." *Id.* § 34. See also Dunn, *supra* note 77, at 1-15; THE POLITICAL THOUGHT OF JOHN LOCKE: AN HISTORICAL ACCOUNT OF THE ARGUMENT OF THE "TWO TREATISES OF GOVERNMENT" (1982) (discussing *Two Treatises* as a theological work with intellectual underpinnings rooted in the Protestant ideal of a calling); SIMMONS, *supra* note 79, at 222-251 (stating that Locke's philosophy of rights emerges from a creative mix of religious and secular purposes).

<sup>81</sup> LOCKE, *supra* note 79, ch. 5, § 32.

<sup>82</sup> *Id.* § 37.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.*

and object converge to permit appropriation.<sup>85</sup> In the classic Lockean state of nature (though later it will be shown that this is not always the case) it does not require the consent of others to appropriate property from the uncultivated portion of the commons. Appropriation can occur through any number of actions such as gathering, tilling, or eating. These are what Robert Nozick calls historical entitlements, based on what people have done.<sup>86</sup> It is unclear, however, how much needs to be done. What amount of labor is needed to be intermixed in order to make an object one's own? Why should adding labor, to pose the question used in the earlier section for trademarks, fence off part of the commons without the consent of others?

#### A. *Provisions for the Second-in-Time Public*

Other theories for creating public trademark entitlements in a Lockean framework have assumed a state-of-nature commons. This commons is cultural or linguistic. In the beginning, the intangible cultural commons is freely available to all its members until one chooses to exploit a particular word or symbol. That person fences off the symbol restricting access to others. No limitations are placed upon the right of individuals to fence. The question for these alternative arguments is how to protect the second-in-time demands for public entitlement so that access can be restored.

Wendy Gordon and Stephen Carter have pressed for public concerns based upon the important provision established by Locke that private possession should not cause harm to others. Private rights are trumped by Locke's imposed duty that goods must be left in common when an unjustified or wrongful harm is caused by removing them. Wendy Gordon uses this provision to argue that trademark's exclusion of others from access to a cultural commons may cause harm. Take, for example, the use of a mark for purposes of satire or cultural reference. If such borrowing were disallowed based upon a dilution rationale, there would be a loss of expressive power. Individuals need culture as they need produce for physical sustenance. The "no-harm principle" creates an entitlement to this cultural commons.<sup>87</sup>

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<sup>85</sup> *Id.* at ch. 9, § 123.

<sup>86</sup> See ROBERT NOZICK, ANARCHY, STATE, AND UTOPIA 153-155 (1974); see also JEREMY WALDRON, THE RIGHT TO PRIVATE PROPERTY 138 (1988).

<sup>87</sup> See Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Property*, 102 YALE L.J. 1533, 1537 (1993). It is unclear whether the original appropriation is illegitimate if enough is not left for others. See Jeremy Waldron, *Enough and as Good Left for Others*, 29 PHIL. QUART. 319 (1979). A recent dissent has suggested the application of Professor Gordon's theory of harm through restricting forms of expression.

Not overtly Lockean but nevertheless sharing the intellectual contours of the *Second Treatise*, Stephen Carter has critiqued the idea that trademarks are created without cost to consumers.<sup>88</sup> He argues that there are a limited number of appropriate names for any product.<sup>89</sup> If a producer should make a common phrase, such as “sparkling” for mineral water, into a trademark, then there would be an impoverishment of market language to describe other products.<sup>90</sup> Carter points to the shrinking pool of language left for other market entrants to use.<sup>91</sup>

Both Gordon and Carter have envisioned a cultural or symbolic commons. And both use a notion of harm to generate public entitlement. But, both arguments assume that the trademark is created by its holder and that only its harm to the commons is problematic. The difficulty with such an approach is that it places the public in a second-in-time role. Against the accepted process of private acquisition, Gordon and Carter must argue for public entitlement predicated upon a harm to an individual. Here lies the tragedy of the cultural commons. What happens when the harm to the cultural commons is one that injures many people (or perhaps the commons itself) but not enough to undertake the cost of making a claim against private exclusive power over a trademark?

Suppose a manufacturer of cigarettes has a slogan “I’d rather fight than switch.” In the midst of a labor dispute over reporting production failures of fellow employees, a number of non-unionized workers start sporting buttons that read “I’d rather fight than snitch.” Following traditional limits on trademark dilution, the tobacco company might win an injunction against use of the slogan. Gordon’s no-harm proviso would allow the protesting employees access to this part of their cultural fabric. But a small band of workers would not be able to match the legal resources of a major corporation. Moreover, they probably would not be willing to battle for a slogan that would become irrelevant when the labor dispute ended.

Or take the actual case of a chicken restaurant which used the advertising slogan “only a breast in the mouth is better than a leg in the hand.”<sup>92</sup> This phrase is clearly a double entendre referring

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See *White v. Samsung Elec. of Am, Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting).

<sup>88</sup> See Stephen L. Carter, *The Trouble With Trademark*, 99 YALE L.J. 759, 759 (1990).

<sup>89</sup> *Id.* at 781.

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 178 (T.T.A.B. 1978).

to both a chicken limb as well as the female body. Such language is deeply offensive and should not warrant protection as a trademark. This, in fact, is the case under the Lanham Act's bar on offensive trademarks.<sup>93</sup> But Gordon's no-harm proviso suggests that since it does not affect *individual* expression there might not be grounds to deny extension of legal protection. What is affected by demeaning women is the quality of public language *in general*, the cultural commons still under public control. Women feel unable to express themselves freely in an environment where language is charged with sexist meanings. The public authorship model proposed in this paper would allow the public to retain the power of trademark regulation.

Second-in-time public arguments place the public in an odd position. A private individual can enclose part of the cultural commons without consent. But the public must make an affirmative claim demonstrating harm in order to regain access to the commons. This hardly seems fair. In the next section, it will be argued that a Lockean framework allows use of the commons by private persons but not individual appropriation without consent.

### B. *Personal Self and the Cultural Commons*

Property, Locke tells us, is created through the intermingling of labor with an object. In the original state of nature, the body is the sole owned property. Thus, labor emerges from a self where there is unquestionable self-proprietorship. The relationship between self and other is at the heart of Locke's system. However, most considerations of Lockean notions of intellectual property ignore the discussion of both language and the self in *An Essay Concerning Human Understanding*.<sup>94</sup> Three arguments will be made. First, already existing proprietary rights over the person mean an evolving self (the "Personal Self" argument). This requires symbols from the cultural commons to place the self in relation to others. Second, language is always based upon association of word with object that requires consent (the "Linguistic Association-Consent" argument). Third, while a state-of-nature commons can be appropriated for private use without the agreement of others, a commons in a civil society requires consent (the "Commons through Compact" argument). Trademark is only found in the context of a civil society.

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<sup>93</sup> See 15 U.S.C. § 1115 (1994).

<sup>94</sup> See JOHN LOCKE, AN ESSAY CONCERNING HUMAN UNDERSTANDING (Peter H. Nidditch ed., Oxford Univ. Press 1975) (1690).

Locke distinguishes between personal identity and personal self. Personal identity is the unchanging essence of an individual, independent of external reality. It is personal identity that ensures someone of being a prince even after he exchanges clothes with a pauper. Personal self, on the other hand, is a conscious self dependent upon externals.<sup>95</sup> It is personal self which might be transformed through a relationship with the other while appropriating property or interacting with others in a civil society. Personal self is a creature of culture.

Following Gordon's ideas, it can be argued that privatizing culture violates Locke's no-harm provision. Robinson Crusoe can appropriate his desert island through building a stockade or cultivating the soil. But his tale depends upon a long tradition of castaway narratives, stories of marvelous possessions, and language itself that must be as accessible for others as it is for him. Yet the "personal self argument" suggests that there is another kind of harm beyond expression. This harm is the inability to transform the self into another self. In the Lockean schema a person is owned by himself or herself from the beginning. The making of the personal self *requires* interaction with others mediated through external culture. Otherwise that self becomes stunted.<sup>96</sup>

Trademarks, as argued in the critique of Schechterian functionalism,<sup>97</sup> allow the contextualization of the person with a broad social milieu. A contextual redefining of personhood is at risk if part of the commons is enclosed because of lost access to symbols (like trademarks) that place the self in relation to others. The MacPherson possessive self comes from acquiring real property and the expressive self develops into other selves through interaction within the framework of the cultural commons.

The "Linguistic-Association-Consent" argument states that language is different than real property because its appropriation always demands consent. For Locke, words are "*Signs of internal Conceptions . . . [and] Ideas within his own mind . . .*"<sup>98</sup> Each individual determines the marks for ideas or objects within his own mind. Language begins as an internal system of nomenclature. But sharing that nomenclature creates a common language. It is

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<sup>95</sup> See *id.* bk. II, ch. 27, §§ 1, 9.

<sup>96</sup> See C. FRED ALFORD, *THE SELF IN SOCIAL THEORY: A PSYCHOANALYTIC ACCOUNT OF ITS CONSTRUCTION IN PLATO, HOBBS, LOCKE, RAWLS, AND ROUSSEAU* 112-39 (1991) (arguing that the Lockean self is predicated upon an idealization of acquisition and domination of others through property). My argument is that intermixing, with other selves more than with property, lies at the heart of the Lockean self.

<sup>97</sup> See *supra* Part II.

<sup>98</sup> LOCKE, *supra* note 94, bk. III, ch. 1, § 2.

this second aspect of creating language that makes it dependent upon the “use or consent” of others. Even the Emperor Augustus, Locke tells us, could not make a Latin word without the acknowledgment of the public at large.<sup>99</sup> What Locke is describing is a cultural commons. But there is a critical difference between Lockean real property in a state-of-nature commons and the cultural commons. The difference is that appropriation of real property commons can take place without the assent of others. Acquiring cultural property requires consent.

The idea of trademarks as language requires precisely the same consent. Just because a manufacturer feels that steel wool pads should be called Brillo does not make that name part of the common language without broad agreement. In Locke’s conception of language, two stages take place. First, there is an association of the idea with the word in the individual mind. Second, there is an association of individual with individual to make the word part of a common vocabulary. Lockean associational invention of language shares a remarkable similarity to the model of authorship this essay outlines for trademarks. If language or trademarks are made through consent, it should logically follow that they cannot be alienated without consent. Robert Filmer mocked Lockean notions of consent because it would be impossible for everyone to gather in the same place at the same time.<sup>100</sup> But, linguistic consent for new words or trademarks is comparatively easy to establish. Culture and language is ultimately a collective enterprise.

Finally, the “Compact through Consent” argument suggests that private appropriation is limited in civil society and that the cultural commons is a creature of civil society. Locke’s appropriation in a state of nature has often been seen as a recipe for establishing ownership in *any* commons. But that is not the case. Locke, in fact, does not claim all common land to be alienable. He distinguishes between two conditions, America and England. Land in America is still largely in a state of nature. Subject to the provisions of neither wasting land nor harming others, this land may be appropriated for private use. England, on the other hand, has a commons that cannot be appropriated readily. “In land that is common in England or any other country where there are plenty of people under government who have money and commerce, no one can enclose or appropriate any part without the consent of all

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<sup>99</sup> Id. §§ 2, 8.

<sup>100</sup> See Waldron, *supra* note 87, at 151.

his fellow commoners because this is left common by compact."<sup>101</sup>

In America the commons precedes civil society, in England it follows the association of individuals with one another. Locke is unclear whether language is a precondition or a consequence of the creation of civil society.<sup>102</sup> While real property may or may not be found in a state of nature, I would argue that intellectual property is *always* a product of civil society. Certainly, social interaction in a civil society creates language and culture. The purpose of property rights in a state of nature like America is to allow exploitation in order to maximize wealth. On the other hand, property rights in a civil society (Locke's England) are also meant to regulate interaction between individuals. This regulation is subject to the rules set down by the majority. Left common by compact, trademarks as language can only be appropriated through consent.

Within a Lockean framework, intellectual property is different than real property according to a three-pronged argument. First, only intellectual property is critical for the development of the personal self. Other kinds of sustenance are fungible in a Lockean milieu through a pair of means: (1) the "American" commons where vast amounts of uncultivated land diminish the particular advantages of each potential plot, and (2) the currency-based market economy where the owner of real property can provide foodstuffs similar to what one can grow oneself. Neither of these fungible forms, it has been argued, apply to intellectual property.

Second, only intellectual property is subject to Locke's notion that language is created through consent to symbol-object associations. These associations created through consent require consent to alienate as well. Third, only intellectual property is *always* a commons established through compact. It arises as something that might be exchanged under civil society and not within a state-of-nature. Unlike Locke's acorns, cultural symbols can never be fully unowned.

Not all contemporary theories of justice are equally compatible with this communitarian understanding of intellectual property or trademark creation. John Rawls, for example, strips the self of interests, individual values, and relationships with others.<sup>103</sup> Rawlsian property is called "primary goods."<sup>104</sup> These are whatever "any

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<sup>101</sup> LOCKE, *supra* note 79, ch. 5, § 35.

<sup>102</sup> LOCKE, *supra* note 94, bk. III, ch. 2, § 1 (stating that "[c]omfort and advantage of society . . . [cannot] be had without communication of thoughts"); *id.* bk. III, ch. ix, § 3 (asserting that language upholds "common conversation and commerce about the ordinary affairs and conveniences of civil life").

<sup>103</sup> See JOHN RAWLS, A THEORY OF JUSTICE 62 (1971).

<sup>104</sup> *Id.*

rational man would want.”<sup>105</sup> But, as argued above, intellectual property is property most reflective of the self. While most rational people would want something as beautiful as an original Kandinsky painting, his art is reflective of himself and limits might be imposed on the power of the state to demand alienation of this art. Similarly, for trademarks there is something that the self is *dependent* upon for its full development. Ironically, as Michael Sandel has pointed out, the need to develop a self with all its relationships creates the need for collective or communitarian notions of property<sup>106</sup> (and, I would argue, even more for intellectual property).

There is another reason the model for trademark acquisition is different than for real property. Real property is appropriated by mixing with labor. Trademarks are a variation on this theme with a substantial difference. The first stage of trademark creation takes place when the laboring self is intermixed with others. The intermixing of selves creates a cultural commons. This is a precondition for the second phase of intermixing of language (or trademark) with object. In the next section, these Lockian notions of consent will be seen as embedded within trademark doctrine.

#### IV. THE PUBLIC ROLE IN TRADEMARK DOCTRINE

Trademark doctrine demonstrates a notable reliance upon public perception. The power invested in the public is largely associative: the power to identify a sign with an object to the exclusion of others. Part IV is divided in two sections. The first section, “Making and Unmaking through Association,” discusses establishing meaning for trademarks and how that meaning might be lost. The second section, “Meaning in Context,” explores how associative meaning changes in different linguistic markets.

##### A. *Making and Unmaking Through Association*

##### 1. Using the Usable Part of the Cultural Commons

“Recognition and association are the cornerstones of secondary meaning.”<sup>107</sup> “Secondary meaning,” wrote one appellate

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<sup>105</sup> *Id.*; see also ALFORD, *supra* note 96, at 140-55. Two major critiques of this Rawlsian deracinated self may be found in CHARLES TAYLOR, *SOURCES OF THE SELF: THE MAKING OF MODERN IDENTITY* (1989), and MICHAEL J. SANDEL, *LIBERALISM AND THE LIMITS OF JUSTICE* (1982). Although this is not the place for a full-scale critique of Robert Nozick, it should be mentioned that Nozick’s critique of redistributive justice ignores the existence of a Lockean commons that might be used as a source for redistributing the *fruit* of that commons. See NOZICK, *supra* note 86, at 149-82.

<sup>106</sup> See SANDEL, *supra* note 105.

<sup>107</sup> *SmithKline Bechman Corp. v. Pemex Prods. Co.*, 605 F. Supp. 746, 750 (E.D.Pa. 1985).



judge, “has been defined as association, nothing more.”<sup>108</sup> Almost no other element of trademark doctrine so embodies the idea of establishing text through association and so underscores the public role in authorship. Unlike distinctive marks like “Kodak,” suggestive marks require secondary meaning to become descriptive marks. For example, a dish washing soap called “Pleasant detergent” requires further association to transform the descriptive term “pleasant” into a particular product name.<sup>109</sup> It may be defined as the association by the consuming public of a once independent word/symbol with a product that transforms the word/symbol into a distinctive mark. Producers must speak to the consumer through associative language of symbol/object. The consumers must see the *disassociated symbol* as invested with meaning, even where the object is not present.<sup>110</sup>

Trademark creation is a two-step process. First, a producer affixes a symbol to the product. Second, the public associates the symbol with the product. The producer affixing a symbol might be called primary meaning while secondary meaning embodies the idea of public association. This association takes place in the midst of a market where linguistic exchange parallels the transfer of goods.<sup>111</sup> Both the producer and the consuming public are joint authors.

It seems puzzling that recognition in addition to first-in-time use by a manufacturer or marketer should be necessary to establish the suitability of a trademark. Secondary meaning does not address utilitarian rationales for trademark doctrine including commercial regulation and Schechter’s potential injury coming from the use of the mark.<sup>112</sup> Traditional fraud or palming off claims can be used to regulate commerce while misappropriation doctrine would grant relief for injury to the trademark holder. It might be

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<sup>108</sup> *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970). *See also* *The American Angus Ass’n v. Sysco Corp.*, 829 F. Supp. 807, 827 (E.D.N.C. 1993) (stating that “the prime element of secondary meaning is association between the alleged mark and a single source of the product”); *Visser v. Macres*, 29 Cal. Rptr. 367, 370 (1963) (holding that secondary meaning is acquired when the public “submerges the primary meaning of the name . . . in favor of its meaning as a word, identifying that business.”); *McCARTHY*, *supra* note 35, § 1502.

<sup>109</sup> *See* *Clinton Detergent Co. v. Procter & Gamble Co.*, 302 F.2d 745 (C.C.P.A. 1962) (deciding a similar case involving Joy Detergent).

<sup>110</sup> *See* *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 820 (9th Cir. 1980) (acknowledging “mental recognition” that different products with same mark come from same source).

<sup>111</sup> *See* *Coca-Cola Co. v. Seven-Up Co.*, 497 F.2d 1351 (C.C.P.A. 1974) (holding that “Uncola” lacks linguistic meaning until acquired in marketplace).

<sup>112</sup> *See* Stephen L. Carter, *Does it Matter Whether Intellectual Property is Property?*, 68 *CHI-KENT L. REV.* 715 (1993).

argued that secondary meaning demonstrates a trademark's worth to the public and, therefore, justifies the cost of employing legal resources to protect it. But why, then, is it not a requirement for fanciful marks. There is no reason why a product called "Ineptie" should not warrant the same protection as one labeled "Mr. Clean."<sup>113</sup>

To explain the doctrine of secondary meaning it is necessary to return to natural rights theory. Secondary meaning recognizes that the public is granting a right through its creative association of the object with the mark. There are two ways of understanding this. First, it might be proposed that the public fully transfers a word from the storehouse of common language to a private party for the purpose of trade. As discussed earlier, addition of language to a Lockean cultural commons requires consent. Locke did not discuss alienation. He discussed how language is added through use. But, how would consent for alienation be acquired? Does consent to alienate demand a higher standard of agreement than consent to increase the linguistic dimensions of the cultural commons?<sup>114</sup> As Justice Stevens has stated, "language, even in a commercial context, properly belongs to the public . . . ."<sup>115</sup> This solution is troubling because it assumes a substantial permanent alienation of part of the public's linguistic-symbolic heritage. It would be difficult to later return and claim harm due to loss of that piece of common culture.

Secondary meaning might also be seen as the construction of a new word from a number of sources including a pre-existing English word, a product with its affixed label fabricated by a producer, and the interpretive associational power of the public. According to Locke, if language is a symbolic representation of an idea, then descriptive trademarks do not take language but draw upon it for marketing. The "pleasant" of the dish detergent company simply looks like the common word "pleasant" in English. But pleasant

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<sup>113</sup> It might further be argued that secondary meaning is necessary because if the mark had no meaning it would simply be Babel and, as such, unworthy of protection. However, we do protect Babel in copyright. It is possible to copyright utter nonsense, poorly crafted or even unintelligible expression. If trademark is not *Paradise Lost*, not every copyrightable nonsense tale is *The Walrus and the Carpenter*.

<sup>114</sup> See *Long Island-Airports Limousine Service Corp. v. New York Airport Services Corp.*, 641 F. Supp. 1005 (E.D.N.Y. 1986) (rejecting the establishment of secondary meaning for Long-Island Airports Limousine because it was established during a period of monopoly). This case is puzzling unless one interprets the court's decision as being concerned primarily with *free* consent as a prerequisite for establishing secondary meaning. Moreover, even inherently distinctive marks may be strengthened through wider recognition. See *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d Cir. 1979).

<sup>115</sup> *Park'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 215 (1985) (Stevens, J., dissenting).

may evoke very different images, from a Sunday in the country to a meal with a friend. Prior to the introduction of this particular dish soap, no one would associate pleasant with washing dishes. But that is precisely the point. The mark is really a newly created symbol constituted by a tightly bound sign-product association.

The two words, then, are "pleasant" (English term representing enjoyment) and "Pleasant-detergent" (commercial term for a particular kind of dish soap). The sign "Pleasant-Detergent" would be conjured up in advertising, attached to a product, or bandied about within market settings. This suggests the limits of public alienation of its creation. "Pleasant Detergent" is not a Lockean *res nullius*, an unowned piece of property. It was created by the public association of a pre-existing word and an already owned object. Unlike fanciful or arbitrary names like "Kodak" or "Exxon," it was not the result of a sole party's labor. Thus, under Lockean natural rights theory, public entitlement of this newly coined phrase should be retained for use outside of its single commercial association.<sup>116</sup>

Compare this kind of linguistic association elaborated for descriptive marks with suggestive marks. Descriptive marks convey an immediate idea of the product. "Wheaties" consists of wheat, "Oatnut" is bread made of oats and nuts.<sup>117</sup> "Pentomino" is a domino with five sides.<sup>118</sup> Suggestive marks require "thought and perception to reach a conclusion as to the nature of the goods."<sup>119</sup> "Chicken-of-the-Sea" is only suggestive because one might not necessarily conjure up an image of tuna without a leap of imagination. It might be expected that greater imagination would lead to a larger public role in the creation of suggestive marks.<sup>120</sup> But the

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<sup>116</sup> On occasion, courts have employed arguments that resonate with Lockean logic. *See, e.g.,* Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317 (C.C.P.A. 1981) (recognizing the importance of "free use" of language); Bada Co. v. Montgomery Ward & Co., 426 F.2d 8, 11 (9th Cir. 1970) (holding that one "competitor will not be permitted to impoverish the language of commerce by preventing his fellows from fairly describing their own goods"). Every kind of intellectual property requires participants, users, to acquire value. What makes trademarks different is that they require participants to acquire meaning.

<sup>117</sup> *See In re Entenmann's Inc.*, 15 U.S.P.Q.2d (BNA) 1750 (P.T.T.A.B. 1990).

<sup>118</sup> *See Golomb v. Wadsworth*, 592 F.2d 1184 (C.C.P.A. 1979).

<sup>119</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merchants & Mfgs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

<sup>120</sup> Two tests exist for distinguishing between descriptive and suggestive marks, the Competitors Needs Test and the Competitors Use Test. The Competitors Needs Test evaluates the amount of imagination required to interpret the trademark. The more imagination required, the less likely the words or symbols will be needed by competitors. *See Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366 (7th Cir. 1976). The Competitors Use Test asks whether competitors employed these words or symbols when describing their product. *See Shoe Corp. of Am. v. Juvenile Shoe Corp. Of Am.*, 266 F.2d 793 (C.C.P.A. 1959); *Fire-*

imaginative leap is really made by the producer, and the public simply follows suit. The producer is the one who calls suntan lotion "Coppertone," creating a linguistic association that might enrich the cultural commons.<sup>121</sup> It makes sense according to Lockean natural rights to reward the suggestive mark with stronger initial protection against other *commercial entities* than a descriptive trademark.

Association still needs to be recognized by the public and the public should retain its entitlement for non-market uses. Descriptive marks borrow heavily from the linguistic commons and require public recognition through secondary meaning before warranting *commercial* protection. On the other hand, descriptive and arbitrary marks warrant early protection prior to use from commercial interference. This is because they are based upon either linguistic (arbitrary marks) inventiveness, such as renaming New York Telephone "Nynex," or imagistic inventiveness, such as associating the color of tanned skin with the burnished color of metal that is reminiscent of the bronze age. Yet through use of arbitrary or suggestive marks they take on additional cultural meanings. In no cases can the public fully alienate linguistic creation from the Lockean cultural commons once it has entered common usage.

## 2. Unusable Part of the Cultural Commons

Public entitlement for trademark is based upon two principles. First, certain public inheritances, like descriptive marks, take on *commercial* meaning through public association. Second, in certain other trademarks, such as arbitrary or suggestive marks, producers take upon themselves a larger role in their commercial creation. *After* being exchanged as commercial entities, these become part of the Lockean cultural commons. The fanciful mark "Oreo" was introduced into the commercial sphere as the name of a cookie. But African-Americans adopted it to refer to those who are black on the outside, white on the inside. In that form, the word is fully part of the cultural commons.

Finally, there are marks which cannot be made commercial because their cultural meaning is either collective or their use would be so offensive to the collective. The Lanham Act<sup>122</sup> prohibits registration of a number of types of trademarks on the basis of

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stone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 U.S.P.Q. (BNA) 557 (1970); MCCARTHY, *supra* note 35, § 11.21.

<sup>121</sup> See Douglas Lab. v. Copper Tan, Inc., 210 F.2d 453 (2d Cir. 1954).

<sup>122</sup> 15 U.S.C. §§ 1052-72, 1091-96, 1111-27 (1994).

content. These prohibitions include purely descriptive marks,<sup>123</sup> marks that are primarily surnames,<sup>124</sup> and geographic names if the secondary meaning exception cannot be met.<sup>125</sup> Moreover, the Lanham Act excludes registration of "immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute."<sup>126</sup> These limitations express the problem of associating a symbol/name with meaning if meaning already exists. For example, surnames are arbitrary designations for an individual. This person is called Abercrombie rather than Fitch. In a sense, then, Abercrombie is a trademark for persons, shared within an exclusive semi-public domain by everyone named Abercrombie. The number of people with that name may increase (Abercrombies pass down the mark to their children or share with a spouse or Fitches may change their name to Abercrombie) but it is applied solely to this limited set of individuals. Different Abercrombies are distinguished in a variety of ways. There is Alexander Abercrombie, Bertram Abercrombie, the Abercrombie from New York, the Abercrombie from Boston, Abercrombie the professor, and Abercrombie the insurance salesman. Because human beings are singular and found within local settings there is little confusion (though occasionally one has to resort to middle names for someone with the common appellation of Smith).

But the association is between person and name. Using it as the designation for a product requires wresting it away from its sole connection to individual identity and attaching it to a physical object. Such a reassociation is legitimate because the naming of the self is really one communicative channel and the association with a commercial product is another. In the case of celebrities, however, the name has become commercialized. Self and the commons have intermingled. It therefore would be prohibited to name a perfume after Elizabeth Taylor while there would be no problem using a name already in currency for an ordinary individual. For ordinary persons, the name is arbitrary or fanciful (this individual is an "Abercrombie") but for products it becomes a descriptive term (Abercrombie's may be translated as the restaurant owned by Abercrombie). Consequently, secondary meaning is required to reestablish this new association.

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<sup>123</sup> See *id.* § 1052(e)(1).

<sup>124</sup> See *id.* § 1052(e)(4).

<sup>125</sup> See *id.* § 1052(e)(3).

<sup>126</sup> *Id.* § 1052(a).

A public role is also required because the extension of the Abercrombie name to a restaurant encroaches upon the entitlement of every other Abercrombie. Another member of the Abercrombie family would be barred from opening a restaurant with the same name in the city. In a recent case, for example, Joseph Gallo (brother of the Gallos who own Gallo Winery) was prohibited from using his surname on packaged cheeses).<sup>127</sup> Unlike surnames, there is no secondary meaning requirement for historical names. While Michelangelo will be unaffected by a paint store named in his honor, the entitlement of everyone bearing the Abercrombie name diminishes if it is called Abercrombie. A secondary meaning requirement means that public use of language (its perception and associational power) trumps limited group entitlements to names.

Geographic terms also touch upon a limited group entitlement. To reserve the term "New York" or even a colloquial phrase like "knickerbocker" for association with just one product would diminish the entitlement of other commercial entities that wish to identify their place of origin. The phrase "New York" belongs to all New Yorkers. Nevertheless, the public's secondary meaning can trump the limited entitlement of New Yorkers. In a recent case, a manufacturer was barred from calling its cream cheese "Pennsylvania" because the public would have been confused by the similarity of the mark to an already valid trademark established through secondary meaning, Philadelphia Brand Cream Cheese.<sup>128</sup>

The bar against using national or religious symbols and immoral marks, however, underscores the limits of mark making. It prohibits registration for trademarks which "falsely suggest a connection" with such public symbols as flags, religious images, or national emblems and seals.<sup>129</sup> The language of the Lanham Act is telling. All connections are false because it is problematic to associate national or religious symbols with private commercial ventures. While public association at times trumps limited group entitlements, the public is unwilling to make private its own linguistic and cultural commons.

The immoral mark clause of the Lanham Act<sup>130</sup> demonstrates the boundaries placed upon public association by prohibiting "immoral" or "scandalous" marks. The public is willing to contribute to the associative creation of an ordinary commercial mark where

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<sup>127</sup> See *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280 (9th Cir. 1992); see also *Scarves by Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167 (2d Cir. 1976).

<sup>128</sup> See *Kraft Gen. Foods, Inc. v. BC-USA, Inc.*, 840 F. Supp. 344 (E.D.Pa. 1993).

<sup>129</sup> See 15 U.S.C. § 1052(a).

<sup>130</sup> *Id.*

it will reap the advantage of diminishing consumer confusion but remains reluctant to associate the object with something lewd. Such prohibitions exist when calling brassieres "bubby trap" or using the slogan "only a breast in the mouth is better than a leg in the hand" for a chicken limb.<sup>131</sup> Once again, the measure of whether to engage in associational joint making of a trademark is dependent upon public perception: first, whether the public finds the phrase or depiction lewd when seen alone (genitalia or sexual relations may always be seen as inappropriate for commercial use); second, its meaning as seen in association with the product.<sup>132</sup> *Libido*, for example, was determined as a permissible trademark for perfume because the use of fragrances is often charged with sexuality.<sup>133</sup>

An intriguing rationale may be made for the bar against lewd trademarks. Since women are a community with public rights, the public would not consent to a creative associative act making trademarks which subject a member to offensive sexual innuendo. Women would be granted standing to challenge the use of "booby trap" much as commercial competitors have the right to oppose registration of confusing or similar trademarks. In these cases there is confusion of a different sort, symbolic intermingling of commercial and sexual spheres.<sup>134</sup> Recent scholarship has attacked the immoral mark clause as having a chilling effect on free speech.<sup>135</sup> The argument here, however, is that registration reflects state action less than it does the withholding of public aid in the joint creation of a mark. Offensive language would have a corrosive affect on the cultural commons.

### 3. Unmaking Trademarks

Nothing underscores the authorial power of public association more than its ability to unmake trademarks. By becoming generic,

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<sup>131</sup> *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (P.T.T.A.B. 1971); *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 178 (T.T.A.B. 1978).

<sup>132</sup> *See In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (determining that a wine could not be called *Madonna* because of the improper association with alcohol). This case has become the touchstone for examining Immoral Mark issues as questions of association.

<sup>133</sup> *See Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. 481 (BNA) (1952).

<sup>134</sup> On the problem of confusing these spheres, see MICHAEL WALZER, *SPHERES OF JUSTICE: A DEFENSE OF PLURALITY AND EQUALITY* 3-30 (1983). My analysis here dovetails with that of CATHERINE A. MACKINNON, *ONLY WORDS* (1993).

<sup>135</sup> *See* Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity be Another's Registered Trademark?*, 54 OHIO ST. L.J. 331 (1993); Robert N. Kravitz, *supra* note 6; Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158 (1982).

aspirin, cellophane, thermos, and other trademarks have lost their distinctive meaning.<sup>136</sup> Thermos, once a specific trademark, was applied to other vacuum-sealed containers that keep liquids at a constant temperature.<sup>137</sup> Public association of a mark with a broad variety of similar products means that a sign or symbol becomes part of a public domain. But it is not a sudden transfer of rights from a private holder of the trademark to a linguistic commons. For example, the first holder of "Shredded Wheat" only had "de facto secondary meaning."<sup>138</sup> The Supreme Court held that the mark was generic.<sup>139</sup> This means that the public never associated the symbol with the object of a particular producer but merely with the general type of goods. At the time Shredded Wheat was produced by just one company, the name referred to that company alone. As other companies began to produce similar cereal biscuits, there was no particular or distinct association with the producer to prevent that association from spreading to all makers of the same sort of products.<sup>140</sup>

### B. *Meaning in Context*

This essay has argued that the authorial role of the public has created a public domain. Authorship legitimizes the public power to determine what will or will not be a protected trademark. It is established through association. This section will contrast competing doctrinal developments in trademark law. One development challenges the emphasis on public-derived meaning and the other seeks to deepen that meaning through contextualizing it within a linguistic market.

The creation of secondary meaning as well as the use of inherently distinctive trade dress have both come under attack. Sometimes secondary meaning cannot be proved because a product is in an early stage of marketing. To claim injunctive relief, holders of trademarks have argued for secondary meaning in the making. Secondary meaning in the making is defined as a presumption that meaning will develop in the future.<sup>141</sup> No requirement is made to

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<sup>136</sup> See *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75 (2d Cir. 1936). Jacqueline Stern, *Genericide: Cancellation of Registered Trademarks*, 51 *FORDHAM L. REV.* 666 (1983).

<sup>137</sup> See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963).

<sup>138</sup> See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119 (1938).

<sup>139</sup> See *id.* at 117.

<sup>140</sup> See *id.* at 120; *DuPont*, 85 F.2d at 81 (holding that no matter how much money was spent in marketing to ensure that cellophane would not be deemed generic, "so far as it did not succeed in actually converting the world to its gospel, it can have no relief").

<sup>141</sup> See Willajeanne F. McLean, *The Birth, Death, & Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 *AM. U. L. REV.* 737 (1993); Timothy R.M. Bryant, *Trademark*



demonstrate how the mark is presently perceived by the public. Secondary meaning in the making is largely based upon the intent of the person who seeks exclusive use for a trademark. As one judge has pointed out, secondary meaning in the making is "focused solely upon the intent and actions of the seller of the product to the exclusion of the consuming public."<sup>142</sup> Secondary meaning in the making relies upon the intent of the producer. Are there plans to invest in advertising? Will the product be marketed soon? As has been argued in the section on functionalism,<sup>143</sup> a large chasm stands between marketing and public cultural meaning. The second doctrine I wish to discuss, inherently distinctive trade dress, relies upon a reading of the product itself.

In the recent case of *Two Pesos v. Taco Cabana Int'l Inc.*,<sup>144</sup> the Supreme Court examined whether trade dress infringement could be found without a determination of consumer confusion. Two Mexican eating establishments shared a similar menu, floor plan, and interior decor. The restaurants were built around patios and were decorated with murals. Both used bright, festive colors. Finding that the decor of the first restaurant was "inherently distinctive," the Court held that the first restaurant was unique enough that questions of secondary meaning were irrelevant.<sup>145</sup> This decision places at risk the traditional public role in making trademarks.

Both secondary meaning in the making and inherently distinctive arguments have been questioned by courts and scholars. They are seen as handing advantages to existing trademark holders that crowd out new entrants.<sup>146</sup> More importantly for the argument here, they do apparent violence to the public role in making trademarks. These doctrines see the trademark holder as the sole author. Yet the idea of *assuming* public reaction based upon marketing is very troubling. Without the association of the trade

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*Infringement: The Irrelevance of Evidence of Copying to Secondary Meaning*, 83 Nw. U. L. REV. (1989); *National Lampoon, Inc. v. American Broadcasting Co.*, 376 F. Supp. 733 (S.D.N.Y. 1974).

<sup>142</sup> *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 684 F.2d 546, 550 (8th Cir. 1982).

<sup>143</sup> See *supra* Part II.

<sup>144</sup> 505 U.S. 763 (1992).

<sup>145</sup> See *id.* Such analysis reduces secondary meaning into something of contingent importance. See *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695 (5th Cir. 1981) (requiring a demonstration of secondary meaning only when it was determined that the trade dress was not sufficiently distinctive). How distinctive is distinctive enough is hard to show. See *Publications Int'l, Ltd. v. Landoll, Inc.*, No. 98-1490, 1998 U.S. App. LEXIS 31382 (7th Cir.) ("[C]ourts have struggled to articulate a standard for when a trade dress is sufficiently distinctive to be entitled to the prima facie protection of the Lanham Act.").

<sup>146</sup> See generally Carter, *supra* note 112; *Black & Decker*, 684 F.2d 546.

dress with a symbol identifying the source, how can there be secondary meaning and, consequently, likelihood of confusion?<sup>147</sup> In *Two Pesos*, Justice Thomas claimed that “the first user of an arbitrary package, like the first user of an arbitrary word, should be entitled to the presumption that his package represents him without having to show that it does so in fact.”<sup>148</sup> Yet as has been shown above, trademark common law has commonly held that representation of descriptive marks requires the acknowledgment of an outside viewer. As Locke suggested, a person can claim to invent a word but unless that linguistic change takes hold, it is meaningless. Justice Thomas has confused claims and meaning.

Secondary meaning in the making and inherently distinctive arguments are non-contextual. These doctrines understand trademarks or trade dress as symbols outside of a context of communication between producer and consumer. Focusing upon intent of the producer (secondary meaning in the making) or distinctiveness of product (inherently distinctive) is problematic. Just because a producer intends or even takes action to market a product does not mean that this attempt will be successful. The doctrine of generic trademarks is an example of the thwarting of producer intent. The Court in *Two Pesos* did not examine the differences that might arise from trade dress for a service (where face-to-face contact takes place) as opposed to an object nor did it ask whether Mexican decor is not a logical direction for any Mexican restaurant to follow.

Without reference to the public, it is clear that the decision in *Two Pesos* only protects the holder of the mark, not the public, from commercial confusion. The intent examined should be that of the individuals seeking to follow the lead of the first holder. Is this a conscious attempt to copy a successful business venture? Is free-ridership intended? If this was the case, a bad faith action could be initiated. For questions of distinctiveness, it should be the understanding of the public that determines whether products are distinctive enough, not an objective standard. The objective standard of *Two Pesos* concentrates on the “total image of the business.”<sup>149</sup> Yet distinctiveness for an interpretive community might very well lie in the details. Perhaps the wearing of large Sombreros by waiters or even serving a dish as a specialty of the house is sufficient to set off one restaurant from another. There is no objective

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<sup>147</sup> See *Laureyssens v. Idea Group, Inc.*, 768 F. Supp. 1036 (S.D.N.Y.), *aff'd in part, vacated in part & rev'd in part*, 964 F.2d 131 (2d Cir. 1992).

<sup>148</sup> *Two Pesos*, 505 U.S. at 787.

<sup>149</sup> *Id.* at 765.

standard for the cultural distinctions found by consumers.<sup>150</sup> Not only has this essay tried to argue for a broader understanding of authorship (including the public as well as the producer who determines the packaging), but also for a more dynamic definition of a trademark. A trademark is not simply a phrase or symbol or trade dress. It is not what might be thought of as a word of sorts. Instead, it is the product of an act of dynamic communication. Two types of association have been described above: (1) initial meaning, where the producer affixes a sign to a package, and (2) secondary meaning, where the public associates sign and product as connected. What will be proposed now is a third kind of association: Tertiary meaning. The tertiary meaning is the placing of a sign-symbol in a context.

A publisher could affix the phrase "red book" to a particular work. When a reader sees a reference to this red book, the reader only thinks about Chairman Mao. Yet much later that reader comes across a plum book. The Plum Book describes legal jobs available in the federal government. This book has little to do with Mao's reference (he might even be horrified by any suggestion of similarity) other than perhaps playing on the idea of a colored cover. The plum is a pun on plum jobs. In the context of tertiary meaning the Plum Book is completely distinct from Mao's Red Book.

Contexts come in a variety of forms. It is possible to divide the contextual use of language into three kinds: (1) to whom said? (2) about what said? (3) how said?<sup>151</sup> When someone says "how are you" to a critically ill friend it has a very different meaning than when it is said to a stranger in passing. When speaking about a coffee as robust, it means something very different than talking about an Olympic athlete. Or, finally, when someone says "I could kill you for that," it means something very different if said in a context of humor or anger. The lion of Dreyfuss investment services is not the same as the cowardly lion of the Wizard of Oz.<sup>152</sup> All this seems obvious. But it has been difficult for courts to contextualize language in quite this way.

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<sup>150</sup> Compare *id.*, with *Haagen-Dazs, Inc. v. Frusen Gladje, Ltd.*, 493 F. Supp. 73 (S.D.N.Y. 1980). In *Haagen-Dazs*, the court stated that the plaintiff did not have an exclusive right to a unique marketing theme. These cases constitute inherently distinctive approaches to the copyright doctrine of substantial similarity.

<sup>151</sup> I have not addressed the question of multiple linguistic markets based upon differing sophistication and expertise. Children, for example, are much more susceptible to confusion. Professional, well-educated consumers are less likely to blur distinctions. See *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 702 F. Supp. 1031 (S.D.N.Y. 1988).

<sup>152</sup> See *Dreyfus Fund Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 1117 (S.D.N.Y. 1981).

Some recent decisions, however, have moved in this direction. The question in *Nike v. "Just Did it" Enterprises*<sup>153</sup> is "to whom said?" A mail-order entrepreneur parodied the Nike t-shirt reading "just do it" with an emblem saying "Mike."<sup>154</sup> Advertisements for the shirt were sent only to people with the first name of Mike. Even though the word Mike looked very much like Nike from a short distance, the court held there was no confusion. Writing only to a discrete population and only through the mail, trademark as contextualized language was spoken only to certain people.<sup>155</sup> The trade channels were substantially different.<sup>156</sup>

On the other hand, courts can be confused about "to whom said?" In *Playboy Enterprises v. Chuckleberry Publishing*,<sup>157</sup> Playboy sought relief against the publishing of a voyeuristic magazine entitled "Playman."<sup>158</sup> Playboy had failed to act against other publishing ventures like *Playgirl*, an analogous erotic magazine directed towards women.<sup>159</sup> The case might have been resolved by applying crowded field doctrine. Surrounded by numerous similar marks, a trademark cannot be very distinctive. But the court determined that Playboy was aimed at a heterosexual market and only would recognize competing signs meant for heterosexual men.<sup>160</sup> Here, unfortunately, context was drawn in a terribly narrow fashion.

*Scottish Whisky Ass'n v. Watson*<sup>161</sup> addresses the question of "about what said?" Black Watch Scotch was made in America but every attempt was made to link it with Scotland.<sup>162</sup> Its label bore the regimental badge of the Scottish Black Watch Regiment, thistles, and the word "Highlands."<sup>163</sup> It spelled "whisky" without an "e" as is the case for Scottish whiskeys, not with an "e" as is the usual usage for American produced liquors. Claiming that the product prompted deceptive confusion, it was argued that consumers would think that the liquor actually came from Scotland.<sup>164</sup> Yet the context (and the tertiary meaning) was meant to be evocative

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<sup>153</sup> 6 F.3d 1225 (7th Cir. 1993).

<sup>154</sup> See *id.* at 1226. In *Anheuser-Busch, Inc. v. Florists Ass'n of Greater Cleveland*, 603 F. Supp. 35 (N.D. Ohio 1984), florists used the advertising phrase "this bud's for you," with strong references to a Budweiser Beer slogan. The court decided that the difference between flowers and beer markets argued against trademark confusion.

<sup>155</sup> See *Nike*, 6 F.3d at 1230.

<sup>156</sup> See *id.*

<sup>157</sup> 486 F. Supp. 414 (S.D.N.Y. 1980).

<sup>158</sup> See *id.* at 418.

<sup>159</sup> See *id.* at 421.

<sup>160</sup> See *id.*

<sup>161</sup> 958 F.2d 594 (4th Cir. 1992).

<sup>162</sup> See *id.* at 598.

<sup>163</sup> See *id.* at 595.

<sup>164</sup> See *id.* at 596.

of Scottish liquor, not Scotland itself. The court decided against confusion.<sup>165</sup>

A third case, *Jordache v. Hogg Wylde, Ltd.*,<sup>166</sup> deals with the context of "how said?" The court determined that humorous speech was different from serious speech even if both were commercial.<sup>167</sup> Meant for those with svelte figures, Jordache designer jeans were parodied by a company manufacturing jeans for heavy-set women.<sup>168</sup> These pants were called "Lardashe." The delicate horse insignia of Jordache was replaced with a garish pig-pocket. Swine, in general, were the theme of this company's marketing.<sup>169</sup> The court felt that the use of humor established a completely different context.<sup>170</sup> The humorous quality of parody created an associational rift between Jordache and Lardashe so that the use of a mocking trademark was "not likely to create in the mind of consumers a particularly unwholesome, unsavory, or disagreeable association."<sup>171</sup> It dismissed claims of misappropriation or dilution. The association of lardashe-to-humor was greater than that of lardashe-to-Jordache.<sup>172</sup>

Association means authorship and context points to meaning. Within trademark doctrine lies the material to construct a public domain. During the moment of associational creation, the public permits certain kinds of trademark privileges. The public never alienates symbols or words from the Lockean commons because to do so would be to lose touch with a collective self.

## V. WE HAVE MET THE AUTHOR AND HE IS US

This essay has traced a set of definitions somewhat different than the usual depiction of trademarks. A trademark is not a word or symbol but an association of an object with a sign. A trademark is not authored by the production/marketing of an object in its package but by a joint interpretive enterprise between author and

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<sup>165</sup> *Id.*

<sup>166</sup> 625 F. Supp. 48 (D.N.M. 1985).

<sup>167</sup> *See id.* at 50.

<sup>168</sup> *See id.*

<sup>169</sup> *See id.*

<sup>170</sup> *See id.* at 51.

<sup>171</sup> *Id.* at 57.

<sup>172</sup> *See Toho Co. Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981) (allowing use of garbage bags called Bagzilla after the ape character Godzilla); *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F. 2d 112 (2d Cir. 1984) (allowing the game Donkey Kong as a parody of King Kong); *John W. Carson v. Here's Johnny Portable Toilets, Inc.* (6th Cir. 1983) (allowing the parody use of identifying phrase for toilets); *Girl Scouts of the United States of America v. Personality Posters, Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969) (allowing a poster of a pregnant Girl Scout with the Girl Scout phrase "Be Prepared").

public. A trademark is not interpreted alone but always in a linguistic context. The purpose behind this reinterpretation is to carve out a public entitlement for trademarks.

This reinterpretation requires a rethinking of the very definition of intellectual property. Intellectual property is different. In an attempt to place the accent on the “intellectual,” rather than the “property,” I have discussed the ways that the public always does (and *must* as a political imperative) retain a robust role in shaping expression. If, as Jennifer Nedelsky suggests, legal notions of property have created the bounded self,<sup>173</sup> then intellectual property, I believe, can serve as a model for an unbounded, collectivist self. This is especially true for trademarks, as signs of a material culture embedded in everyday life. Its abstraction of symbol as representing a relationship, its reliance upon public readings, its ability to seep into the many corners of our lives makes trademark, as paradigmatic of intellectual property as a whole, a means for connecting disparate selves.

New Republican legal theorists have struggled with the problem of what constitutes a community, often seeking to locate community in discourse.<sup>174</sup> I have argued here for a linguistic or interpretive community, a community with collective rights over its cultural creation. The question, ultimately, is one of legal authority. “When I use a word,” said Humpty Dumpty in *Through the Looking Glass*, “it means just what I choose it to mean — neither more nor less. The question is which is to be the master — that’s all.”<sup>175</sup>

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<sup>173</sup> See Jennifer Nedelsky, *Law, Boundaries, and the Bounded Self*, 30 REPRESENTATIONS 162, 162-89 (1990).

<sup>174</sup> See, e.g., Bruce Ackerman, *The Storrs Lectures: Discovering the Constitution*, 93 YALE L.J. 1013 (1984) (distinguishing between ordinary and constitutional politics, where constitutional politics depends upon discourse aimed towards the public good and where ordinary politics is dependent upon personal ambition); Owen Fiss, *Objectivity and Interpretation*, 34 STAN L. REV. 739 (1982) (viewing legal discourse as constructing a Constitutional interpretive community).

<sup>175</sup> LEWIS CARROLL, *THROUGH THE LOOKING-GLASS* 106-09 (Schocken Books 1987) (1872).