

Mark Talk

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*The trier of fact, like a lexicographer of modern slang, must attempt to find out what meaning the public now attaches to a designation that already has a primary meaning in the language.*²

-J. Thomas McCarthy

I. INTRODUCTION

In late 2015, breakout beauty brand Glossier launched “Boy Brow,” a grooming pomade designed to shape and add volume to eyebrows and create a more androgynous, less fussy brow. Glossier successfully applied to register BOY BROW as a trademark for “eyebrow cosmetics” in 2016 and the application sailed through without objection. Today, though, an examining attorney might pause to consider whether the mark is merely descriptive—whether it directly describes the product’s purpose or desired effect (enabling users to give themselves a “boy brow”). If so, the next question for the applicant and examining attorney would be secondary meaning: has the phrase come to serve as an indicator of source? Given Glossier sold four million tubes of Boy Brow in five years³ and invested significantly in advertising, the traditional secondary meaning markers are very likely met. But secondary meaning is explicitly a measure of *consumer* perception—what matters is whether consumers understand something to be a trademark, not whether the mark owner wants it to be one. In ascertaining whether secondary meaning exists, then, factfinders ought to be less interested in how the brand owner uses the term and more interested in how the public does.

A quick search for “boy brow” on Reddit, a popular website with a number of fora⁴ devoted to beauty and makeup, returns 98 threads that reference “boy brow” in the title, 94 of which appear to reference the Glossier product.⁵ Clues that the uses reference the brand include users capitalizing both terms, pairing the phrase with the brand name (“glossier boy brow”), and posting the thread on the Glossier subreddit. The four posts that use the phrase in a descriptive, non-branded way include one post describing a male dog’s eyebrows, two posts about drag

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² 2 MCCARTHY ON TRADEMARKS & UNFAIR COMP. § 15:30 (5th ed.).

³ Erica Smith, *Glossier Finally Made a Boy Brow for Redheads*, The Cut (Sept. 14, 2020).

<https://www.thecut.com/2020/09/glossier-boy-brow-auburn.html>

⁴ This page lists 61 different subreddits (fora within reddit) devoted to makeup, not including those devoted to specific brands, like Glossier. [u/justpointyourtoes](https://www.reddit.com/r/justpointyourtoes), “A master list of the makeup related subreddits! Please add to it if I’ve left anything out!”

https://www.reddit.com/r/MakeupAddiction/comments/333xed/a_master_list_of_the_makeup_related_subreddits/

⁵ <https://www.reddit.com/search/?q=%22boy%20brow%22>

makeup,⁶ and just one that uses the phrase “boy brow” to refer to a general look rather than a product.⁷ A search for the hashtag #boybrow or “boy brow” on social networking platforms Instagram, TikTok, Twitter, Pinterest, Tumblr, and Twitch return results of which all or the vast majority use the phrase in reference to the branded product.⁸ And search engine Google, which Lisa Larrimore Ouellette has persuasively argued may hold the key to determinations like secondary meaning because its algorithm is trained to give consumers what they’re seeking,⁹ also returns primarily Glossier-related results for a “boy brow” search.

In the case of “boy brow,” then, the “mark talk”—what I call consumers using marks in online speech—presents clear-cut evidence of secondary meaning. And unlike traditional secondary meaning factors like ad spend and length of producer use, mark talk directly reflects how consumers understand and use the phrase.

Until approximately the 1920s, descriptive terms and phrases were not eligible for trademark protection.¹⁰ By 1938, though, the Supreme Court recognized that even descriptive terms were capable of serving as trademarks and thus merited protection if their owners could show they had acquired distinctiveness in the minds of consumers.¹¹ The Lanham Act formalized that recognition¹² in 1946, providing that even for those categories of marks deemed merely descriptive, “nothing¹³...shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” When descriptive marks become distinctive for goods or services based on use and exposure, courts refer to that new, source-indicating denotation as “secondary meaning.”¹⁴ A lot has changed since 1946, particularly in

⁶ https://www.reddit.com/r/Drag/comments/iczqp0/tips_for_keeping_the_boy_brows_hidden/
[<https://perma.cc/3X4M-AEKG>]

⁷ https://www.reddit.com/r/Drag/comments/ku74bu/i_used_my_boy_brows_and_i_love_the_turn_out/
[<https://perma.cc/YV22-Q2VH>]

⁸ https://www.reddit.com/r/Youiqueamua/comments/iv5n8v/boy_brows_are_out_skunk_brow_is_in/

⁸ The fact that uses of “boy brow” or #boybrow reference the branded product is indicated, on these platforms, by the user tagging #glossier or @glossier, referencing “Glossier” elsewhere in the text, or including the product itself or other Glossier trade dress in the image posted.

⁹ Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CAL. L. REV. 351 (2014).

¹⁰ 2 MCCARTHY ON TRADEMARKS & UNFAIR COMP. § 15:30 (5th ed.); but see, e.g., *Am. Waltham Watch Co. v. U.S. Watch Co.*, 173 Mass. 85, 85–86, 53 N.E. 141, 142 (1899) (“the word ‘Waltham,’ which originally was used by the plaintiff in a merely geographical sense, now, by long use in connection with the plaintiff’s watches, has come to have a secondary meaning as a designation of the watches which the public has become accustomed to associate with the name.”).

¹¹ *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938).

¹² But see *United States Patent & Trademark Office v. Booking.com B. V.*, 140 S. Ct. 2298, 2311, 207 L. Ed. 2d 738 (2020) (“It is true that the Lanham Act altered the common law in certain important respects. Most significantly, it extended trademark protection to descriptive marks that have acquired secondary meaning.”).

¹³ Except, of course, for bars on specific categories of marks, including those that are generic or functional, those that create a false association with a living individual, and those that create a likelihood of confusion with another registered mark.

¹⁴ Another term for the same concept is “acquired distinctiveness,” and the two phrases are frequently treated as synonymous. *United States Patent & Trademark Office v. Booking.com B. V.*, 140 S. Ct. 2298, 2303, 207 L. Ed. 2d 738 (2020) (“[T]o be placed on the principal register, descriptive terms must achieve significance ‘in the minds of the public’ as identifying the applicant’s goods or services—a quality called ‘acquired distinctiveness’ or ‘secondary meaning.’”), quoting *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 120 S. Ct. 1339, 1340, 146 L. Ed. 2d 182 (2000). But marks that are inherently distinctive may gain additional distinctiveness through use, and we sometimes call that “acquired distinctiveness” too (or “commercial strength,” in the language of many jurisdictions’ multi-

the ways that trademarks accrue meaning. But the ways that courts and the USPTO assess the existence of secondary meaning¹⁵ has scarcely evolved at all.¹⁶

The court-created doctrine of secondary meaning is premised on the existence of a simpler world. In it, producers create advertisements for general audiences on broad-reaching platforms and offer products for sale; consumers passively view those ads and either purchase the products or don't. While published opinions paid lip service to the importance of consumer perception in assessing trademark validity and incursion upon others' rights, producers had little ability to actually ascertain consumers' views. They could only offer up their own actions, aspirations, and investment. For decades, courts have used advertising expenditures, length of use, and other company actions as proxies to evaluate secondary meaning because, other than by survey or affidavit, they could not measure consumer perception directly.

But the internet has upset that model and destabilized the binary roles of producers investing in trademarks and consumers passively receiving information about them.¹⁷ Now, consumers might learn about trademarked goods not only from producers but from peers, paid influencers, or strangers posting on social media. And consumers don't just internalize those messages and vote with their wallets; they talk to and about brands by posting reviews, sharing experiences, making expressive uses,¹⁸ complaining publicly, or avowing fandom through follows and likes. Producers and factfinders have unfettered access to consumer speech that both talks about and

factor tests for likelihood of confusion). We don't, however, use "secondary meaning" for inherently distinctive marks, so this paper favors "secondary meaning" to describe the acquisition and achievement of distinctiveness by the kind of marks that would be unprotectable and unprotected without it.

¹⁵ The USPTO accepts three categories of evidence to establish secondary meaning under § 2(f):

- Prior Registrations*: A claim of ownership of one or more active prior registrations on the Principal Register of the same mark for goods or services that are sufficiently similar to those identified in the pending application;
- (2) *Five Years' Use*: A verified statement that the mark has become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made; and
- (3) *Other Evidence*: Other appropriate evidence of acquired distinctiveness.

TMEP § 1212; 15 U.S.C. § 1052(f); 4 CALLMANN ON UNFAIR COMP., TR. & MONO. § 20:16 (4th ed.). This paper focuses primarily on the third prong's "other evidence" and the evidence considered by federal courts.

¹⁶ The secondary meaning factors that courts apply today differ little from those considered from the earliest days of recognition of descriptive terms as protectable trademarks, even before the passage of the Lanham Act. See, e.g., *Trappey v. McIlhenny Co.*, 281 F. 23, 24 (5th Cir. 1922) (considering length and exclusivity of use and extent of advertising efforts in finding geographically descriptive term TABASCO distinctive for hot sauce); *Lincoln Motor Co. v. Lincoln Auto. Co.*, 44 F.2d 812, 817 (N.D. Ill. 1930) ("it has come to be understood that a secondary meaning may be established in a name or word as designating the product of a particular manufacturer and a good will built up under the name by length of use, fair dealing, the intrinsic merit of the product, and expenditures of large sums for advertising to familiarize the public therewith...") (finding LINCOLN had acquired secondary meaning for cars); *Locatelli, Inc. v. Tomaiuolo*, 129 F. Supp. 630, 634 (D.N.J. 1955) ("The evidence relevant to the question of secondary meaning is: (a) the period of time the name has been used, (b) the nature and extent of advertising expenditures, (c) sales volume."); *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 727-729 (D. Minn. 1965) (finding secondary meaning based on advertising expenditures, size of company, length and scale of use, and affidavits from purchasers and prospective retailers).

¹⁷ See generally Dustin Marlan, *Is the Word 'Consumer' Biasing Trademark Law?* 8 TEXAS A&M L. REV. 367 (2021), exploring unintended effects of situating members of the public as constant "consumers" in the language of Lanham Act cases.

¹⁸ See generally Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489 (2017).

incorporates marks—speech that reflects whether, how, and what trademarks mean to the speakers. In fact, consumers play an increasingly important role in making trademarks “mean” in the first place, through dialogue with firms and one another.¹⁹

Why does it matter?

Trademark law has been slow to respond to that paradigm shift. While courts and scholars have grappled with difficult questions around infringement and liability in the digital age, and some trademark doctrines have evolved significantly since the Lanham Act was passed in 1946, little attention has been paid to how online use can reveal whether a mark has acquired distinctiveness.²⁰ This article proposes adopting more direct proof of consumer perception given the ready availability of a tremendous body of online consumer speech using and discussing trademarks. If factfinders truly want to measure consumers’ perceptions rather than producers’ aspirations, they must not be constrained by outdated approaches.²¹ Instead, they can and should look to that online consumer speech and new forms of analysis²² for more direct evidence of consumer perception, which will in turn lead to more accurate outcomes.

II. SECONDARY MEANING

So how do trademarks “mean,” and who makes that meaning?

Descriptive words and phrases are not protected as trademarks immediately upon use. Instead, to meet the Lanham Act’s requirement that marks must be distinctive to be protectable, federal trademark law requires evidence that those descriptive terms have acquired secondary meaning—a trademark meaning second to their primary meaning, the descriptive one.²³

¹⁹ As Jessica Kiser has written, “The modern concept of branding includes substantial creative content produced by the trademark owner and its marketing professionals, but also content created by consumers in response to the company’s creative content.” *Brandright*, 70 ARK. L. REV. 489, 496 (2017). “A consumer contributing to brand development actually furthers the unique recognition of that brand as the source of the underlying good or service.” *Id.* at 502.

²⁰ Noted exceptions include Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CAL. L. REV. 351 (2014); Ronald Coleman, *Fashion Dos: Acknowledging Social Media Evidence as Relevant to Proving Secondary Meaning*, 106 TRADEMARK REP. 776, 780 (2016).

²¹ Technically, they’re not constrained; the USPTO and some courts explicitly acknowledge that in addition to the applicable secondary meaning factors, any other evidence tending to show a mark has become distinctive will be considered. E.g. *Yamaha Intern. Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1583, (Fed. Cir. 1988), cited in *Schlafly v. St. Louis Brewery*, 909 F.3d 420, 424 (Fed. Cir. 2018); *Shammas v. Rea*, 978 F.Supp.2d 599, 612 (E.D. Va. 2013) (the Perini factors for determining secondary meaning are “non-exhaustive”).

²² See, e.g., Suneal Bedi, *Rethinking the Chilling Effect: An Empirical Investigation Using Text Analysis* (Jan. 4, 2021 draft on file with author) (using text analysis to measure the chilling effect of social media speech restrictions on restaurant reviews).

²³ Some courts go further, calling secondary meaning a misnomer because when it truly exists, the trademark meaning becomes primary. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118, 59 S. Ct. 109, 113, 83 L. Ed. 73 (1938) (“[T]o establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”); *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972) (“To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer”), cited in TMEP §1212; *Walt-W. Enters., Inc. v. Gannett Co.*, 695 F.2d 1050, 1060 (7th Cir. 1982) (Mark in question unprotectable unless owner “can show that the way in which it employed the term dispelled the tendency of listeners to regard the

Surnames,²⁴ geographic descriptors,²⁵ misdescriptive phrases,²⁶ and laudatory terms²⁷ are also subject to the secondary meaning requirement, as are colors,²⁸ product design,²⁹ and many other categories of nonverbal marks. While the Lanham Act doesn't define secondary meaning (or even use the phrase at all)³⁰ it states that a mark that is not inherently distinctive will be protectable and protected once it "has become distinctive of the applicant's goods in commerce." Even before the Lanham Act abolished the distinction between technical and descriptive marks, the Supreme Court acknowledged that the existence of "secondary signification" can transform a descriptive term into a source indicator, which in turn makes possible deceptive use by others.³¹ Distinctiveness is necessary for federal registration and is a threshold requirement for establishing the valid trademark rights necessary to enjoin infringing uses.

Trademark law is said to have two main goals—consumer protection and producer reward.³² While some scholarship treats as primary the goals of informing consumers, protecting them against deception, and enabling them to make efficient decisions, the goal of motivating producer investment in trademarks is by most accounts equally important. As Mark McKenna has argued, it was this second goal that gave rise to modern trademark law.³³ Different trademark doctrines serve these two goals to different extents—antidilution doctrine, for example, is almost entirely motivated by producer reward and related goals like preserving brand purity. The prohibition on registration of deceptive marks, on the other hand, primarily has in mind consumer safety (though it also aids producers by curbing unfair competition in the form of

term as [descriptive] and instead regard the primary significance of the term as designating a single ... source"). See also John T. Cross, *Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems*, 76 NEB. L. REV. 95, 119 (1997) ("The acquisition of 'secondary' meaning is really a change in the primary definition of the word, at least when that word is used in the context of a particular good or service.").

²⁴ 15 U.S.C. §1052(e)(4); TMEP §1211; *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995).

²⁵ 15 U.S.C. §1052(e)(2); TMEP §1210.

²⁶ TMEP §1209.04. Misdescriptive phrases must not be deceptive; deceptive marks are barred from registration regardless of whether the owner can establish secondary meaning.

²⁷ TMEP §1209.03(k); citing *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012); *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1172 (TTAB 2013); *In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998).

²⁸ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995).

²⁹ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000). Other categories of trade dress that are capable of inherent distinctiveness, such as product packaging, may not possess it and thus would also require secondary meaning for protection.

³⁰ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) ("Secondary meaning' is a term from the common law; the Lanham Act refers to marks that have acquired source significance as 'ha[ving] become distinctive.'").

³¹ *Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 179 U.S. 665, 673-74, 21 S. Ct. 270, 274, 45 L. Ed. 365 (1901), abrogated by *Hurn v. Oursler*, 289 U.S. 238, 53 S. Ct. 586, 77 L. Ed. 1148 (1933) ("It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public, and on those to whose employment of it the special meaning has become attached."); see also *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938) ("Here we have a secondary meaning to the descriptive term, 'Nu-Enamel.' This establishes, entirely apart from any trade-mark act, the common law right of the Nu-Enamel Corporation to be free from the competitive use of these words as a trade-mark or trade name.").

³² A third oft-cited goal, improving efficiency, can be said to serve both consumers and producers, as well as competition and capitalism more broadly.

³³ Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1848-49 (2007) ("close study of traditional trademark principles suggests that critics delude themselves when they seek to limit trademark law by tying protection to consumer expectations.").

deceptive speech). Prohibiting infringement by giving producers statutory causes of action against uses that create a likelihood of confusion with registered or unregistered marks serves both camps. In applying likelihood of confusion factors to a junior user's use, a court rewards the senior user for investing in a mark by prohibiting a junior user from free-riding on that goodwill; it simultaneously protects consumers who might be misled by the infringing mark.

So perhaps it's unsurprising that most secondary meaning indicators foreground a mark owner's continued investment in a mark; those factors simply reflect the goal of producer reward. If a producer values a mark highly enough to invest substantial time and money in it, advertise it, register it, and police others' uses of marks similar to it, then that mark is likely to stick around for a while. Granting it federal protection rewards the investment the producer has made up to that point and provides incentive for continued investment. And as courts and scholars reiterate, actual consumer perception is impossible to intuit without survey evidence, which is (or has frequently been portrayed as) expensive, unreliable, and malleable in the hands of experts.³⁴ Survey evidence of secondary meaning is rarely put forward,³⁵ and courts vary substantially in how they interpret it.³⁶ So the doctrine has evolved to reward what's easiest to measure.

But producers' actions can never tell the whole story, and pretending they do is disingenuous. Descriptive terms and phrases aren't immediately protectable for two reasons. First, we expect that consumers will initially understand them as providing information about the goods and services rather than indicating source. Trademark law presumes that consumers will regard fanciful marks like KODAK for cameras or arbitrary marks like PENGUIN for books as trademarks from those marks' first use, because KODAK is a made-up word that possesses no other meaning aside from its trademark meaning. PENGUIN has a primary dictionary meaning, but no logical descriptive meaning when applied to books. But consider WEIGHT WATCHERS for weight loss services, or TASTY for snack foods, or NO MORE TANGLES for hair detangler spray. When we first encounter them, they appear informational, describing some aspect of the goods' or services' purpose, taste, or effect, respectively. Only after consumers repeatedly encounter the marks used or advertised in connection with specific goods or services will they come to understand them as source indicators—or so the story goes.

³⁴ Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2131 (2004) (“Consumer surveys are the best evidence of secondary meaning, but surveys are difficult to design properly and expensive to conduct.... Judges also find it difficult to evaluate survey methodology, especially when confronted with competing expert testimony, and this increases the likelihood of error.”); Linford, *Democratizing Access to Survey Evidence of Distinctiveness*, TRADEMARK LAW AND THEORY: REFORM OF TRADEMARK LAW (Dinwoodie & Janis, eds), Elgar, 2019, available for download at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3276315 (“the costs of conducting a trademark survey have historically been high enough to discourage many mark owners from offering survey evidence of consumer perception. Well-heeled litigants can fund surveys, but those with a smaller war chest cannot.”).

³⁵ Survey evidence is only mentioned in about 15-20% of trademark infringement decisions, and most of those surveys are likely designed to measure actual confusion, rather than secondary meaning. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1586, 1622 (2006); Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1035 (2012).

³⁶ See Dominic A. Azzopardi, *Disarray Among the Circuits: When Are Consumer Surveys Persuasive?*, 104 IOWA L. REV. 829, 841 (2019) (Finding that while most courts agree that surveys showing secondary meaning among less than 25% of respondents are insufficient and surveys showing secondary meaning among over 60% of respondents are sufficient, results in the 25%-60% range tend to be interpreted differently in different jurisdictions).

The second reason that descriptive marks are not automatically granted protection is a policy reason. If it were too easy to obtain exclusive rights for descriptive terms, producers would monopolize them at the expense of new entrants, impeding competition and consumer access to information. Even in the face of empirical evidence suggesting that manner of use matters as much as distinctiveness and that displaying a descriptive term in a trademark-like way can lead consumers to perceive matter as a mark from their very first exposure to it,³⁷ trademark law declines to award rights in descriptive terms until secondary meaning is established. It makes sense that exclusive rights in language that will be desirable and useful to competitors should only be granted upon an impressive showing that consumer perception has shifted, and that therefore if competitors make use of identical or very similar matter, their use may deceive consumers. And of course, the Lanham Act explicitly requires distinctiveness, either inherent or acquired.

Most circuits consider a number of factors³⁸ in assessing whether a descriptive mark, or any mark that is not inherently distinctive, has acquired sufficient secondary meaning to deem it protectable.³⁹ In theory, secondary meaning assessments gauge consumer perception—have consumers come to view the mark as a source indicator, rather than merely a descriptor of the goods or services? In practice, most secondary meaning indicators provide only circumstantial evidence. But as J. Thomas McCarthy has acknowledged in his treatise, “direct evidence ‘is not a requirement and secondary meaning can be, and most often is, proven by circumstantial evidence.’”⁴⁰

³⁷ Thomas R. Lee, Eric DeRosia, & Glenn Christiansen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1060 (2009); Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV 1977 (2019).

³⁸ Of course, “[n]o single factor is determinative and every one need not be proven.” *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 312 (6th Cir. 2001).

³⁹ Circuits consider anywhere from a few to close to a dozen factors. See, e.g., *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 978 (10th Cir. 2002) (“(1) a history of successful sales; (2) evidence of intentional copying [;] . . . and (3) long use of the . . . trade dress.”); *FN Herstal SA v. Clyde Armory Inc.*, 838 F.3d 1071, 1083-84 (11th Cir. 2016) (“(1) the length and manner of its use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the public’s mind between the name and the plaintiff’s product or business; and (4) the extent to which the public actually identifies the name with the plaintiff’s product or venture”); *Parks LLC v. Tyson Foods, Inc.*, 863 F.3d 220, 231 (3d Cir. 2017) (“(1) the extent of sales and advertising leading to buyer association; (2) length of use; (3) exclusivity of use; (4) the fact of copying; (5) customer surveys; (6) customer testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and, (11) actual confusion.”); *Test Masters Educ. Servs., Inc. v. Robin Singh Educ. Servs., Inc.*, 799 F.3d 437, 445 (5th Cir. 2015) (“(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant’s intent in copying the [mark]”); *Converse, Inc. v. Int’l Trade Comm’n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1120 (Fed. Cir. 2018) (“(1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.”).

⁴⁰ *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 922 (E.D. Va. 2017), amended, No. 116CV425LMBIDD, 2017 WL 4853755 (E.D. Va. Oct. 26, 2017), citing McCarthy (Defendant’s argument that plaintiff has not demonstrated actual market recognition “appears to challenge the very nature of the secondary meaning test, which acknowledges that five of the six factors—advertising expenditures, sales success, media coverage, attempts to plagiarize, and exclusivity of use—are all circumstantial evidence.”).

Courts vary in what factors they consider indicative of secondary meaning,⁴¹ but the most common secondary meaning factors are indeed circumstantial. They include amount and manner of producer advertising; advertising expenditure; exclusivity, length, and manner of use of the mark; sales success, amount of sales, and number of customers; established place in the market; proof of deliberate copying or attempts to plagiarize;⁴² and the proprietor’s use of the term and efforts to promote a conscious connection, in the public’s mind, between the name or mark and a particular product or venture.⁴³ When trade dress is at issue, litigants often also tout (and factfinders often also inquire about) “look-for” advertising that explicitly highlights the specific feature for which protection is sought or “image” advertising that features the trade dress.⁴⁴ Most jurisdictions openly acknowledge those factors to provide only indirect evidence. Per the Seventh Circuit, “The facts that [a mark owner used a mark for a number of years] and spent large sums of money in advertisements containing the term are simply not germane unless it can show that the way in which it employed the term dispelled the tendency of listeners to regard the term as [descriptive] and instead [led them to] regard the primary significance of the term as designating a single... source.”⁴⁵ The majority of circuits keep consumer perception at the fore and make clear that evidence related to producer investment serves only as proxy—the more producers invest in a mark, the more likely consumers are to come to view the term or phrase *as* a mark. But many judicial opinions lean heavily on circumstantial evidence, treating it as definitive proof of secondary meaning rather than just an indicator of how consumers likely perceive a term. And some circuits articulate a multi-factor test of which consumer perception itself is only one of many factors.⁴⁶

The problem with reading producer investment to answer the secondary meaning question should be obvious. A trademark is a collection of consumer perceptions.⁴⁷ Each mark is a product of its

⁴¹ See Ingrida Karins Berzins, *The Emerging Circuit Split over Secondary Meaning in Trade Dress Law*, 152 U. PA. L. REV. 1661, 1663 (2004) (describing “the growing rift among the circuits in the application of factors that are used to evaluate secondary meaning” and concluding upon surveying recent case law that “secondary meaning litigation reveals that circuits vary both in the types of factors considered and in the depth of evidentiary support required.”).

⁴² There are (1) cases and jurisdictions that “state that secondary meaning is irrebuttably presumed from the act of copying; (2) cases that state that copying is presumed, albeit rebuttably, from the act of copying; and (3) cases that state that copying is merely one factor in the evidentiary determination of secondary meaning.” Michael Lewis Wells, *Trademark Infringement: The Irrelevance of Copying to Secondary Meaning*, 85 NW. U. L. REV. 473 (Fall, 1988/Winter, 1999) (arguing evidence of copying is irrelevant to establishing whether a mark possesses secondary meaning).

⁴³ See Jake Linford, *Trademark Owner as Adverse Possessor*, 63 CASE W. RES. U. L. REV. 703 (2013) (arguing courts might use the prior proxies to determine this last factor).

⁴⁴ E.g. *Vital Pharm., Inc. v. Monster Energy Co.*, 472 F. Supp. 3d 1237, 1258 (S.D. Fla. 2020) (“image” advertising supports an inference of secondary meaning: “while an advertisement that explicitly directs consumers to a product’s trade dress may *help* to foster secondary meaning, it is not *necessary* to do so.”).

⁴⁵ *Walt-W. Enters., Inc. v. Gannett Co.*, 695 F.2d 1050, 1060 (7th Cir. 1982).

⁴⁶ See, e.g., Ninth Circuit model jury instructions (defining secondary meaning in terms of consumer perception but articulating a multi-factor test, of which consumer perception and actual confusion are two of nine factors and the balance of factors focus on producer investment and exclusive use).

<https://www.rid.uscourts.gov/sites/rid/files/documents/juryinstructions/otherPJI/9th%20Circuit%20Model%20Civil%20Jury%20Instructions.pdf>. See also *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, No.

EDCV1401926JAKSPX, 2017 WL 3271706, at *25 (C.D. Cal. Aug. 1, 2017).

⁴⁷ Kevin Keller, *Conceptualizing, measuring, and managing consumer-based brand equity*, J. OF MARKETING 1993; Aaker, *Managing Brand Equity*, 2009.

interpretive communities,⁴⁸ and those communities are composed of consumers. Without consumer participation, there can be no secondary meaning.⁴⁹ Critical cultural legal studies scholar Rosemary Coombe notes how “law may freeze the play of signification by legitimating authorship, deeming meaning to be value properly redounding to those who ‘own’ the signature or proper name, without regard to the contributions or interests of those others in whose lives it figures.”⁵⁰ Members of the public are expected to engage in the play and work that imbues trademarks with meaning, but are seldom credited for that effort.

An “audience-focused theory,” as Laura Heymann has advocated in the context of reputation, better acknowledges a trademark’s social nature. Because secondary meaning is a form of reputation, or what trademark law calls “goodwill,” Heymann’s words apply equally well to it: secondary meaning “is fundamentally a social concept; it does not exist until a community collectively forms a judgment about an individual or firm that has the potential to guide the community’s future interactions.”⁵¹ And while factfinders are asked to reach binary conclusions as to the existence of secondary meaning, goodwill itself is vague and diffuse—it includes not only the factual but also the emotional and affective.⁵² Brands increasingly call on consumers to help build commercial strength, sometimes actively inviting participation and other times intentionally stepping back to foster brand communities’ independent development.⁵³ Nonetheless, trademark law has resisted full acknowledgement and incorporation of the crucial role of consumer speech.⁵⁴

And when it comes to gauging consumer perception directly, whether or not they acknowledge the importance of the endeavor, courts have mostly thrown up their hands. Many consider testimonials and surveys the only permissible forms of direct evidence. They regard their jurisdiction’s factors as indicators of consumer perception, even though what they really measure is producers’ attempts to affect consumer perception, not the success of those attempts.⁵⁵ They treat consumer perception as a black box, its contents unknowable to anyone but the individual

⁴⁸ For more on the concept of “interpretive community” outside of the context of trademark law, see Keyes, Cheryl L. “Empowering Self, *Making Choices, Creating Spaces: Black Female Identity Via Rap Music Performance*, THE J. OF AM. FOLKLORE 113.449 (2000): 255-69.

⁴⁹ Chi-Ru Jou, *The Perils of A Mental Association Standard of Liability: The Case Against the Subliminal Confusion Cause of Action*, 11 VA. J.L. & TECH. 2, 66 (2006) (“The public’s reception is part of the ‘authorship’ process since its acceptance of the new, brand-identifying function for a common word is required before a trademark is created.”).

⁵⁰ Rosemary J. Coombe, *Critical Cultural Legal Studies*, 10 YALE J.L. & HUMAN. 471 (1998).

⁵¹ Laura A. Heymann, *The Law of Reputation and the Interest of the Audience*, 52 B.C. L. REV. 1341, 1341 (2011).

⁵² Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 555 (2006).

⁵³ Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489, 523 (2017).

⁵⁴ Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489, 496 (2017) (“Consumers are invited to participate in the development of, and discourse about, a brand, but trademark law is not designed to protect or allow for such discourse and co-development.”).

⁵⁵ See, e.g., Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CAL. L. REV. 351, 353 (2014) (“Courts frequently lack the evidence to evaluate acquired distinctiveness properly: surveys are expensive and unreliable, and circumstantial evidence such as sales data and advertising spending are weak proxies for consumer perception.”).

consumers themselves,⁵⁶ and cling to the factors that courts have recited in their jurisdiction for almost a century.

These indirect indicators of secondary meaning have dominated case law even though they reflect only the producer's attempts to alter consumer perception,⁵⁷ and despite a paucity of evidence establishing that if a producer intends to teach consumers to view their mark as a mark, the producer's desire will come true. Finding secondary meaning based solely on how much money a producer spends advertising the goods or services it sells under the mark or how long it has offered goods for sale bearing the mark doesn't necessarily reveal anything about how consumers perceive that mark when they encounter it in the marketplace.⁵⁸ As Jake Linford observes, "The US trademark system gives lip service to the importance of consumer perception but fails to accurately account for it."⁵⁹

Do any of the traditional circumstantial factors offer insight? Unsolicited media coverage is frequently cited as proof of secondary meaning,⁶⁰ while it too is a proxy for consumer perception, it's closer to direct evidence than most of the others and comes from a more objective source.⁶¹ It simultaneously reflects the perception of a subset of the public—journalists—and reinforces among readers that the mark is a mark, helping the mark acquire distinctiveness. Several courts have grouped unsolicited media coverage (traditionally a reference to newspapers, magazines, and other products of formal journalism) and social media coverage together as evidence of secondary meaning⁶² or consider social media coverage analogous to traditional media coverage.⁶³ Meanwhile, the Second Circuit in a recent case

⁵⁶ See, e.g., *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42 (1st Cir. 1998) (courts must "look[] into the minds of potential customers").

⁵⁷ Direct evidence includes direct consumer testimony and consumer surveys.

⁵⁸ Suneal Bedi and Michael Schuster, *Towards an Objective Measure of Trademark Fame*, 54 UC DAVIS L. REV. 431, 483-485 (2020).

⁵⁹ Jake Linford, *Democratizing Access to Survey Evidence of Distinctiveness*, TRADEMARK LAW & THEORY: REFORM OF TRADEMARK LAW 3 (Dinwoodie & Janis, eds. 2019).

⁶⁰ The phrase "unsolicited media coverage" itself seems to mean different things to different courts and in different contexts. The Federal Circuit, for example, has described the factor as "unsolicited media coverage of the product embodying the mark," *Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1120 (Fed. Cir. 2018), while other circuits in other contexts look for use of the word mark or explicit discussion of the trade dress feature at issue.

⁶¹ But see 1 TRADE DRESS PROTECTION § 13:15 (2d ed.) ("it is probably true that much of this coverage, while not paid advertising, results from public relations efforts of the trade dress owner.").

⁶² E.g., *Car-Freshner Corp. v. Am. Covers, LLC*, No. 19-2750, 2020 WL 6788150, at *7 (2d Cir. Nov. 19, 2020) ("The record contains considerable evidence of widespread recognition of the 'Black Ice' mark (in its paper hanging tree form) in unsolicited news and social media coverage and in popular culture."); *George Sink, P.A. Injury Lawyers v. George Sink II Law Firm LLC*, 407 F. Supp. 3d 539, 555 (D.S.C. 2019), modified sub nom. *George Sink PA Injury Lawyers v. George Sink II Law Firm LLC*, No. 2:19-CV-01206-DCN, 2019 WL 6318778 (D.S.C. Nov. 26, 2019), appeal dismissed sub nom. *Sink v. George Sink II Law Firm LLC*, No. 19-2359, 2019 WL 9042869 (4th Cir. Dec. 18, 2019), and appeal dismissed sub nom. *George Sink, P.A. v. George Sink II Law Firm, LLC*, No. 19-1960, 2019 WL 8112874 (4th Cir. Dec. 18, 2019) ("There is also plenty of evidence of unsolicited media coverage of Sink P.A., including news articles, social media posts, and awards for Best Law Firm from The State newspaper.").

⁶³ *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 922 (E.D. Va. 2017), *amended*, No. 116CV425LMBIDD, 2017 WL 4853755 (E.D. Va. Oct. 26, 2017) ("just as unsolicited media coverage offers circumstantial evidence of consumer awareness of a brand, the size of a producer's social media following is indicative of the number of

considering likes and comments on social media pages questioned whether such metrics qualify as “unsolicited,” given that the pages “invite people to ‘follow them.’”⁶⁴ Most courts that consider this factor require the media coverage be unsolicited to distinguish it from paid advertising, so it’s unclear why “invited” but unpaid coverage would fail to qualify.

Likewise, social media influencer posts also straddle the divide between traditional advertising and consumer mark talk. Influencers purport to share their personal opinions, experiences, and sincere recommendations directly with their followers, giving them an air of authenticity that makes their endorsements particularly persuasive.⁶⁵ Given that influencer marketing plays an increasingly dominant role in many companies’ marketing strategies, and some mark owners believe “‘savvy exploitation of low- and no-cost promotion via social media’ and celebrity endorsements eliminate[] the need for traditional paid advertising,”⁶⁶ litigants are beginning to put forward influencer endorsements as evidence of secondary meaning. In one recent case, the Ninth Circuit affirmed a district court’s finding of secondary meaning based in part on the producer’s gifting the product to influencers and celebrities at the Emmy’s and Oscars.⁶⁷ In another, it affirmed a finding of secondary meaning for adidas’ Stan Smith trade dress, acknowledging that the company “reaps significant but difficult-to-quantify value from placing the Stan Smith with celebrities, musicians, athletes, and other ‘influencers’ to drive consumer hype.”⁶⁸

As for the other forms of circumstantial evidence, advertising expenditures may be meaningful, if the ad features the mark prominently in a trademark way and is the type of ad consumers are likely to view, absorb, and learn from. But ads may be less reflective of secondary meaning in an age of time-shifting and multiple-screen viewing, and ads may in some cases leave lasting impressions about the house brand or the product itself without affecting consumer perception of the mark for which secondary meaning is asserted. Likewise, number of sales or customers does not always tell the whole story—if the mark is not featured prominently in a trademark way, or is merely a secondary, tertiary, or limping mark,⁶⁹ consumers may purchase a product repeatedly without ever coming to view the descriptive phrase it bears *as a mark*.⁷⁰ In *Zatarains*, for

consumers who are familiar with a brand, interested in receiving additional information about it, and presumably tend to feel goodwill toward the producer.”)

⁶⁴ LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A., 209 F. Supp. 3d 612, 656 (S.D.N.Y. 2016), *aff’d sub nom.* LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA, 720 F. App’x 24 (2d Cir. 2017).

⁶⁵ Alexandra J. Roberts, *False Influencing*, 109 GEO. L. J. 81 (2020).

⁶⁶ LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A., 209 F. Supp. 3d 612, 656 (S.D.N.Y. 2016), *aff’d sub nom.* LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA, 720 F. App’x 24 (2d Cir. 2017) (brand representative testified that he “didn’t feel like it was necessary to invest [LVL XIII’s] dollars into print ads and things of that nature, especially with the dying business of print publications this day and age”).

⁶⁷ H.I.S.C., Inc. v. Franmar Int’l Importers, Ltd., No. 316CV00480BENWVG, 2019 WL 1545675, at *3 (S.D. Cal. Apr. 9, 2019), *aff’d sub nom.* H.I.S.C., Inc. v. Rajanayagam, 810 F. App’x 560 (9th Cir. 2020).

⁶⁸ Adidas Am., Inc. v. Skechers USA, Inc., 149 F. Supp. 3d 1222, 1235 (D. Or. 2016), *aff’d in part, rev’d in part*, 890 F.3d 747 (9th Cir. 2018).

⁶⁹ See Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 923 (2017), defining “limping marks” as “marks that are always accompanied by, and need the support of, other marks, rather than serving on their own to identify a particular brand, or to create a separate commercial impression.”

⁷⁰ See, e.g., *In re JC Hosp. LLC*, 802 F. App’x 579, 584 (Fed. Cir. 2020) (affirming the TTAB’s refusal to register where “the mark THE JOINT often appeared in connection with other marks (e.g., ‘Hard Rock’ or ‘Hard Rock Hotel & Casino’). The Board stated that ‘it is unclear which mark ... attracts public attention.’”).

example—a case often cited and widely taught⁷¹ to introduce the concept of secondary meaning—the court treated the number of products sold bearing the mark FISH-FRI as compelling evidence that the mark had acquired secondary meaning, even though the house mark ZATARAIN’S was prominent on the packaging and it would have been equally plausible to assume that consumers understood ZATARAIN’S as the trademark and “fish-fri” as the descriptive phrase explaining what the box contained: batter for frying fish.⁷² And when it comes to trade dress, sales and advertising are particularly untrustworthy indicia of secondary meaning, especially without a “look-for” approach or another way of highlighting the trade dress as source indicator rather than decoration or product feature.⁷³

Length of exclusive use suffers from similar flaws as advertising. It may also grant too great a first-mover advantage, as the first producer to sell a particular kind of product can assert proprietary rights in a descriptive term for that product if others don’t quickly adopt the same term to compete in the same space. It is tautological that the factors that focus on producer investment reward wealth and longevity; conversely, they disadvantage newcomers and smaller mark owners. In many cases, applying the secondary meaning factors leads factfinders to affirm the rights of a large, wealthy junior user over those of a smaller senior user—when both use descriptive marks, the first to imbue the mark with secondary meaning gets prior rights regardless of who made use first, and a well-known player with broad reach is far better-equipped to generate secondary meaning (or the appearance of secondary meaning based on established proxies) quickly.⁷⁴

Attempts to plagiarize, another factor common across jurisdictions, may or may not be meaningful.⁷⁵ While copying indicates awareness on the part of competitors, it doesn’t necessarily provide persuasive evidence that consumers—who are less likely to be attuned to product details and more likely simply to buy the item they want for other reasons, such as

⁷¹ Westlaw lists 1,738 citing references; most major Trademark Law casebooks include excerpts from the case, including Dinwoodie & Janis at 56; Beebe, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK at 40; etc.

⁷² *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983), abrogated by *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004) (“Since 1950, Zatarain’s and its predecessor have continuously used the term ‘Fish-Fri’ to identify this particular batter mix. Through the expenditure of over \$400,000 for advertising during the period from 1976 through 1981, Zatarain’s has promoted its name and its product to the buying public. Sales of twelve-ounce boxes of ‘Fish-Fri’ increased from 37,265 cases in 1969 to 59,439 cases in 1979. From 1964 through 1979, Zatarain’s sold a total of 916,385 cases of ‘Fish-Fri.’ The district court considered this circumstantial evidence of secondary meaning to weigh heavily in Zatarain’s favor.”).

⁷³ “Advertising may not support secondary meaning where, as here, ‘the promotional material does not use the design alone but instead with other marks.’” *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 655–56 (S.D.N.Y. 2016), *aff’d sub nom. LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA*, 720 F. App’x 24 (2d Cir. 2017) (“Even more damaging [to its claim of secondary meaning], LVL XIII has not established that any of its promotional materials called attention to the [toe plate] as an indication of source.”), citing TMEP § 1202.02(b)(i); *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 1403 (C.C.P.A.1975); *In re Mogen David Wine Corp.*, 372 F.2d 539, 542 (C.C.P.A.1967).

⁷⁴ See *Two Pesos, Inc. v. Taco Cabana*, 505 US 763 (1992).

⁷⁵ See generally *Trademark Infringement: The Irrelevance of Copying to Secondary Meaning*, 85 NW. U. L. REV. 473 (Fall, 1988/ Winter, 1999) (arguing copying is irrelevant for secondary meaning); *Defining the Role of the Defendant’s Intentions Under Section 43(A) of the Lanham Act: Centaur Communications v. A/S/M Communications*, 46 WASH & LEE L. REV. 335 (Winter, 1989) (“although evidence of copying is persuasive it is not a sufficient showing of secondary meaning on its own”).

availability and price, especially in the age of Amazon⁷⁶—perceive matter that is descriptive or not inherently distinctive as a mark.

Expert surveys of consumers provide direct, or at least quasi-direct,⁷⁷ evidence of consumer perception and are considered by many courts the best evidence of secondary meaning.⁷⁸ But surveys are not required for a finding of secondary meaning.⁷⁹ One reason courts have refrained from requiring surveys is that they have tended to be expensive. But as Jake Linford has argued persuasively, options like Mechanical Turk make conducting surveys far more affordable.⁸⁰ While experts with prestigious resumes rack up big bills, there are only a few types of secondary meaning surveys that courts have blessed as acceptable; litigants tend to stick with those rather than try to forge new ground⁸¹ by experimenting with new survey forms, venturing into corpus linguistics, or investing time and energy into gathering less common kinds of direct evidence of secondary meaning. It should therefore be possible for litigants to rely on less highly-credentialed experts whose rates aren't upwards of a thousand dollars an hour.⁸²

But proxies, surveys, and direct testimony are no longer the only ways to gauge consumer sentiment.

III. USING MARK TALK

Times have changed since courts began evaluating “secondary significance” and the Lanham Act codified protection for descriptive marks as long as they had acquired distinctiveness. Today, consumers have so much to say about the goods they love and hate, the labels that define them, the service providers that did them wrong. Mark talk abounds. Consumers talk about brands and marks all over social media, from Facebook to TikTok to Twitter to YouTube, on individual profiles, company pages, affinity groups, and influencer posts.⁸³ Product reviews and feedback are everywhere, especially Yelp and Amazon, where reviews can number in the thousands and the star ratings a product receives determines whether shoppers select it. Online fora dedicated to specific groups and interests are rife with product and service recommendations and reactions. Readers respond to blog posts, newspaper and magazine articles, and reviews by posting

⁷⁶ See Grace McLaughlin, *Fanciful Failures: Keeping Nonsense Marks Off the Trademark Register*, 134 HARV. L. REV. 1804 (2021) (highlighting the use by Amazon sellers of random, often unpronounceable strings of letters as trademarks).

⁷⁷ 2 McCarthy on TRADEMARKS & UNFAIR COMP. § 15:30 (5th ed.)

⁷⁸ 2 McCarthy on TRADEMARKS & UNFAIR COMP. § 15:30 (5th ed.), citing *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 12 U.S.P.Q.2d 1740, 1744 (9th Cir. 1989). *Accord Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, n.9, 228 U.S.P.Q. 429, n.9 (8th Cir. 1985) (“Consumer surveys are recognized by several circuits as the most direct and persuasive evidence of secondary meaning.”).

⁷⁹ 2 McCarthy on Trademarks and Unfair Competition § 15:30 (5th ed.).

⁸⁰ Linford, *Democratizing Access to Survey Evidence of Distinctiveness*, TRADEMARK LAW AND THEORY: REFORM OF TRADEMARK LAW (Dinwoodie & Janis, eds), Elgar, 2019 (pdf at 2); Suneal Bedi and David Reibstein, *Measuring Trademark Dilution by Tarnishment*, 95 INDIANA L. J. 683 (2020).

⁸¹ Robert Thornburg, *Trademark Surveys*, 4 J. MARSHALL REV. INTELL. PROP. L. 91 (2005).

⁸² Linford, *Democratizing Access to Survey Evidence of Distinctiveness*, TRADEMARK LAW AND THEORY: REFORM OF TRADEMARK LAW (Dinwoodie & Janis, eds), Elgar, 2019 (pdf at 2).

⁸³ See Laura A. Heymann, *The Law of Reputation and the Interest of the Audience*, 52 B.C. L. REV. 1341, 1352-53 (2011) (“[R]eputation development has, it goes without saying, been enhanced by the Internet. ... What was formerly communicated via in-person word of mouth or through letters to company executives can now be broadcast to a worldwide audience, retransmitted, and discussed.”).

thoughts of their own. Even information like the number of Facebook likes or Twitter followers a corporate account accrues can reflect consumer awareness of marks, with some caveats. All together, this mark talk represents a tremendous corpus of online conversations using or discussing trademarks, and that corpus is capable of answering the secondary meaning question at least as well as producer-centric proxies like ad expenditure and length of use.⁸⁴ Taking both types of evidence in combination provides stronger proof of secondary meaning or its absence than either type of information taken alone and better serves the goals of trademark law.

Scholars have considered how to extract brand information from a corpus to glean whether a term is a name or a noun by conducting content analysis,⁸⁵ close-reading a data set, or simply counting. Julian Nyarko trained a language model on Reddit posts to extract empirical data on how similar or different consumers' use of a trademark is to their use of a generic term.⁸⁶ Adam Kilgarriff's research focuses on "whether a disputed term exhibits the linguistic behavior characteristic of a name (identifying the source or producer of a product or service) or the linguistic behavior characteristic of an ordinary common noun" using corpus linguistics.⁸⁷ In fact, there's some evidence that mark talk not only reflects consumer perception, it also helps shape it. Researchers in a study about learning new meanings for old words found that participants recognized words they already had in their vocabulary more quickly when they were paired with related new meanings, but only when the study required participants to *use* the words' new meanings in a new context; the same learning effect did not take place after a more superficial or passive learning period.⁸⁸ And Jessica Kiser's work describes how consumers who participate in discourse about and development of a brand may consider it more valuable and feel more loyalty toward and a deeper connection with that brand⁸⁹—all of which translate to secondary meaning or goodwill. So expert testimony that presents a robust set of examples of consumers using or referencing descriptive marks as trademarks ought to be considered persuasive evidence of secondary meaning. Likewise, expert testimony that presents evidence of the opposite should weigh toward the opposite conclusion.

Applicants to register trademarks and litigants asserting protection for common law marks are beginning to cite what goes on in online spaces to the USPTO and courts, who sometimes take heed and sometimes don't. Litigants have cited as evidence of secondary meaning the number of people that have visited their social media pages;⁹⁰ how many follow their corporate Twitter

⁸⁴ Lisa Ouellette has advocated for the use of Google and other search engine results to help gauge trademark strength, given the tremendous amount of data Google gathers and brings to bear in organizing results to give searchers what they're seeking. Ouellette, *The Google Shortcut to Trademark Law*, 102 CALIF. L. REV. 351, 363 (2014).

⁸⁵ Harold H. Kassarian, *Content analysis in consumer research*, J. OF CONSUMER RESEARCH 4.1 (1977): 8-18; Harwood, Tracy G., and Tony Garry, *An overview of content analysis*, THE MARKETING REV. 3.4 (2003): 479-498.

⁸⁶ Meeting notes on file with author from Mar. 12, 2021 discussion.

⁸⁷ Adam Kilgarriff, *Corpus Linguistics in Trademark Cases*, DICTIONARIES: J. OF THE DICTIONARY SOC. OF NORTH AM., Number 36, 2015, pp. 100-114.

⁸⁸ Jennifer M. Rodd, Richard Berriman, Matt Landau, Theresa Lee, Carol Ho, M. Gareth Gaskell & Matthew H. Davis, *Learning new meanings for old words: effects of semantic relatedness*, MEM. COGNIT. 2012 Oct; 40(7):1095-108.

⁸⁹ Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489, 496, 516 (2017).

⁹⁰ Kalamazoo County Convention and Visitors Bureau, Inc. v. Southwest Michigan First Corporation, 2017 WL 8640798 (W.D. Mich. 2017).

account;⁹¹ how many have liked their corporate or brand Facebook page;⁹² the number of “impressions” on Facebook and “likes” spread across posted content;⁹³ their “social media following” overall;⁹⁴ and the number of online reviews their branded products have received.⁹⁵ In one recent federal case, the court acknowledged the “positive and unsolicited reviews and recommendations by consumers” as compelling evidence of secondary meaning.⁹⁶ In a TTAB case, the Board granted summary judgment on the question of mere descriptiveness, relying heavily on the substantial evidence of mark talk in the form of online drink recipes the petitioner put forth recipes to support its assertion that the registered trademark BUCK was merely descriptive for bourbon because “buck” is a well-known bourbon-based drink.⁹⁷

Still, few factfinders have moved beyond the producers’ advertising efforts on social media and consumers’ decisions to smash that like button to actually put forward examples of consumers using or referencing trademarks in their posts, reviews, comments, and complaints. But they should.

Luxury handbag brand Céline offers an example of using mark talk to establish secondary meaning in trade dress. When Céline applied to register its “iconic luggage ‘face’ design,” the USPTO initially refused registration based on lack of distinctiveness. Céline responded with a 750-page document arguing its trade dress had acquired distinctiveness based on all of the usual factors, including the brand’s 6 years of continuous use; sales totaling over \$150 million; extensive unsolicited media attention; advertising expenditures in excess of \$17 million, with \$1 million specifically directed to advertising and promoting the bag’s design; intentional copying;

⁹¹ T-Mobile US, Inc. v. AIO Wireless LLC, 991 F.Supp.2d 888 (S.D. Tex. 2014).

⁹² Clearly Food & Beverage Co., Inc. v. Top Shelf Beverages, Inc., 102 F.Supp.3d 1154 (W.D. Wash. 2015); CrossFit, Inc. v. 2XR Fit Sys., LLC, No. CIV. 2:13-1108 KM, 2014 WL 972158, (D.N.J. Mar. 11, 2014) (holding CrossFit’s more than 500,000 “likes” on Facebook supported a finding of distinctiveness); In Re Frito-Lay N. Am., Inc., No. 91212680, 2017 WL 914086, at *18 (TTAB Feb. 21, 2017), Aff’d in Part, Vacated in Part, Remanded by Real Foods Pty Ltd. v. Frito-Lay North America, Inc. (Fed. Cir. 2018) (fact that applicant had over 16,000 Facebook “likes” and its products have been featured on several blogs insufficient to establish secondary meaning for highly descriptivr mark CORN THINS for crispbread slices).

⁹³ LHO Chicago River, L.L.C. v. Rosemoor Suites, LLC, 2017 WL 467687 (N.D.Ill. 2017).

⁹⁴ Vital Pharm., Inc. v. Monster Energy Co., 472 F. Supp. 3d 1237, 1257 (S.D. Fla. 2020) (“social media network [that] spans hundreds of thousands of followers and reaches over 230 million people worldwide” could support a finding “that VPX’s advertising efforts support its claim that Bang’s trade dress has achieved secondary meaning.”); Sazerac Co., Inc. v. Fetzer Vineyards, Inc., 251 F. Supp. 3d 1288, 1304, 1307 (N.D. Cal. 2017), aff’d, 786 F. App’x 662 (9th Cir. 2019) (genuine issue of material fact as to whether trade dress had acquired distinctiveness precluded summary judgment on infringement claim).

⁹⁵ LHO Chicago River, L.L.C. v. Rosemoor Suites, LLC, 2017 WL 467687 (N.D.Ill. 2017); Dead End Survival, LLC v. Does 1-3, No. 1:18-CV-2008-MHC, 2018 WL 3954756, at *6 (N.D. Ga. May 21, 2018) (“While Dead End has not submitted concrete evidence that ‘the public actually identifies the name with the plaintiff[.]’s product or venture,’ Dead End has shown that its products...sold well on Amazon and earned a high ranking from customers.”).

⁹⁶ Kid Car NY, LLC v. Kidmoto Techs. LLC, No. 19-CV-7929 (PKC), 2021 WL 466975, at *5 (S.D.N.Y. Feb. 9, 2021) (denying motion to dismiss infringement claims).

⁹⁷ Frank Lin Distillers Prod., Ltd., No. 91211205, 2016 WL 837731, at *1 (Feb. 5, 2016) (granting summary judgment on descriptiveness issue and citing petitioner’s evidence of the use of “buck” on Reddit, bartender wikis, and numerous other websites on which users can post drink recipes, along with books and magazines); see also Applicant/Petitioner’s Memorandum in Support of Motion for Summary Judgment in Frank Lin Distillers v. Njoy Spirits (filed Nov. 4, 2015), available at <https://ttabvue.uspto.gov/ttabvue/v?pno=92060288&pty=CAN&eno=9> .

efforts to maintain exclusive rights by policing the trade dress; and direct testimony from retailers, brand partners, and other third parties.⁹⁸ But the USPTO found those traditional forms of evidence unpersuasive, issuing second and third office actions.



Celine Luggage Bag

Céline then took a different approach to bolster its assertion of the design’s secondary meaning. It gathered evidence that individual consumers recognized the trade dress as a face—a horizontal zipper framed in a rectangle arguably representing a mouth, beneath two handle supports regarded as eyes⁹⁹—and associated it uniquely with Céline. A declaration by John Maltbie, Director of Intellectual Property for mark owner Louis Vuitton Americas, appended a table of user comments posted online in response to blog posts about the bag,¹⁰⁰ like “Now all I see is a sad robot when I look at that bag!”; “I can’t get over the fact that it looks like a :/ face”; “Is it me or do the contrasting leather bits and zipper look like two eyes and a square mouth...”; “I see the funny face in it too!”, and many more.¹⁰¹ Céline also submitted examples of consumer posts about knockoffs, some of which reference the trade dress with specificity (“Celine inspired smiley bag!”).¹⁰²

⁹⁸ Third Office Action Response at 4-13.

⁹⁹ Second Office Action Response at 14, Supp. Dec. of Pascale Lepoivre at 2 (Jan. 15, 2015).

¹⁰⁰ According to Maltbie, the idea to play up the “face” aspect of the trade dress and do so using consumers’ own words came out of a phone conversation with the trademark examining attorney to whom the application was assigned. John Maltbie (@jmaltbie), Twitter (Oct. 27, 2020) <https://twitter.com/jmaltbie/status/1321274571371253766> (“[The examining attorney] mentioned a line in an early affidavit about the bag looking like a face—so we jumped on that and found a surprising number of face call outs online and tied the face idea to Jobson’s affidavit.”).

¹⁰¹ “I agree with everyone who said it looks like a face with a zipped mouth”; “The everso omnipresent Celine luggage tote. The sad face bag, that makes everyone so happy!” “It was never my kind of bag—too structured and to have a bag with a face, nope for me.” Maltbie Dec. para 27, Third Office Action Response at 26-31.

¹⁰² Maltbie Dec. para 28, Third Office Action Response at 31-40.

I have always been puzzled by this bag's popularity — I can't stand it. It's big, blocky, kinda tacky and <i>looks like a robot.</i> "	<i>Comment on PurseBlog Asks: Are You Over the Céline Luggage Tote?</i> , Purseblog (Apr. 10, 2015), http://www.purseblog.com/celine/are-you-over-the-celine-luggage-tote/	Page 128
"I was never under the Luggage Tote. Sorry, but I don't get the love — too many bells and whistles, <i>it looks like a face to me</i> , and it is really heavy; people complain about the weight of a Birkin but the Luggage is much heavier."	<i>Comment on PurseBlog Asks: Are You Over the Céline Luggage Tote?</i> , Purseblog (Apr. 10, 2015), http://www.purseblog.com/celine/are-you-over-the-celine-luggage-tote/	Page 128
"I'm with you on all counts, ellavanw. <i>Especially that it looks like a face. I've never been able to get past that.</i> "	<i>Comment on PurseBlog Asks: Are You Over the Céline Luggage Tote?</i> , Purseblog (Apr. 10, 2015), http://www.purseblog.com/celine/are-you-over-the-celine-luggage-tote/	Page 128

Several other courts have acknowledged the relevance of mark talk to a finding of secondary meaning or commercial strength.¹⁰³ In other cases, applicants and litigants have put forward evidence of mark talk that factfinders have ignored or deemed inadequate.¹⁰⁴ For example, the owner of MYO MASSAGE cited its five-star rating and ranking on Trip Advisor and its 4.5 star rating and 233 reviews on Yelp, but the court found the mark's high degree of descriptiveness and lack of exclusive use weighed more heavily than that evidence,¹⁰⁵ rendering the mark weak.

It's possible that factfinders considering evidence of mark talk creates a one-way ratchet: including evidence of mark talk supports a finding of secondary meaning, while the absence of mark talk has no effect.¹⁰⁶ But the same Reddit pages that reflect consumers' consistent use of BOY BROW as a mark reveal that other terms, like DevaChan's registered trademark NO-POO, are used far more often in the descriptive sense than the trademark one.¹⁰⁷ And courts have occasionally indicated the absence of mark talk weighed against a finding of commercial strength.¹⁰⁸ The Sixth Circuit held the word mark DJ LOGIC commercially weak based on the

¹⁰³ See, e.g., *Penshurst Trading Inc. v. Zodax LP*, No. 14-CV-2710 RJS, 2015 WL 4716344, at *3 (S.D.N.Y. Aug. 7, 2015), *aff'd sub nom. Penshurst Trading Inc. v. Zodax L.P.*, 652 F. App'x 10 (2d Cir. 2016) (denying defendant attorneys' fees where plaintiff's evidence of secondary meaning, including "voluminous social media posts" invoking the trade dress," cut against defendant's argument that the suit was exceptionally meritorious).

¹⁰⁴ E.g. *In re JC Hosp. LLC*, 802 F. App'x 579, 584 (Fed. Cir. 2020) (affirming refusal to register based on lack of secondary meaning despite applicant's evidence of 25 years of exclusive use, substantial marketing expenditures and revenue, and "a variety of online websites and forums (e.g., various social media websites, Yelp and TripAdvisor forums, and YouTube) [that] show press and public recognition.").

¹⁰⁵ *Myo, LLC v. Brull & York, LLC*, No. 1:18-CV-370-RP, 2019 WL 136820, at *4 (W.D. Tex. Jan. 8, 2019).

¹⁰⁶ See Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 551 (2006) (goodwill's "elasticity tends to drive trademark law in expansive directions.").

¹⁰⁷ The subreddit entitled "NoPoo" is dedicated to discussion of a no-shampoo philosophy or method; redditors use the space to discuss eliminating shampoo or using it only rarely. A review of the results for a "nopoo" search on Reddit reveals few to none relate to the Devachan-owned brand, and those uses that do reference the brand tend to include its main trademark "Deva" (or Deva trademarks "Devachan" or "Devacurl").

¹⁰⁸ See, e.g., *Car-Freshner Corp. v. Am. Covers, LLC*, No. 19-2750, 2020 WL 6788150, at *8 (2d Cir. Nov. 19, 2020) (finding BAYSIDE BREEZE lacks commercial strength where "the record lacks evidence that 'Bayside Breeze' has prompted unsolicited news and consumer social media coverage"); *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 656 (S.D.N.Y. 2016), *aff'd sub nom. LVL XIII Brands, Inc. v. Louis*

evidence submitted and noted that more information about the artist’s social media presence would have been helpful:

A plaintiff with low album sales or no representation could nevertheless show commercial success suggesting broad recognition of his mark using web-based indicators of popularity, e.g., YouTube views¹⁰⁹ . . . For instance, how many and what kind of Twitter followers does Kibler have? A large number of followers, or celebrities likely to re-tweet Kibler’s messages to their large number of followers, for example, would suggest that many types of people know his work and mark. We can say the same of the number and kind of Kibler’s Facebook fans, likes, posts, and re-posts.¹¹⁰

Mark talk poses various challenges, of course. Applicants and litigants may face some admissibility hurdles when putting forth mark talk evidence, but those hurdles are not insurmountable; several practitioners have offered practical advice to those seeking to get social media evidence admitted.¹¹¹ Astroturfing is already a widely-acknowledged problem, and many companies have been accused of writing their own reviews, paying employees to do it for them, or amplifying and upvoting positive reviews from others.¹¹² A practice called “brushing,” in which a company sends an unsolicited product to an Amazon user and then posts a product review using their name, is on the rise. Some mark owners use trademark law as a weapon to prune negative speech so that only positive speech remains.¹¹³ Secondary meaning doesn’t care

Vuitton Malletier SA, 720 F. App’x 24 (2d Cir. 2017) (a reasonable jury could not find secondary meaning for plaintiff’s trade dress where the plaintiff referenced social media promotion but “offered no concrete proof of the existence, let alone success, of such an action plan.” Plaintiff produced evidence of 12 social media posts, but none were from the relevant time period. *Id.* at 659.).

¹⁰⁹ Kibler v. Hall, 843 F.3d 1068, 1076 (6th Cir. 2016), cert. denied, 138 S. Ct. 91, 199 L. Ed. 2d 27 (2017).

¹¹⁰ Kibler v. Hall, 843 F.3d 1068, 1075 (6th Cir. 2016), cert. denied, 138 S. Ct. 91, 199 L. Ed. 2d 27 (2017).

¹¹¹ Social media evidence can be admitted by general authentication or via expert testimony. Ronald Coleman, *Fashion Dos: Acknowledging Social Media Evidence as Relevant to Proving Secondary Meaning*, 106 TRADEMARK REP. 776, 780 (2016). But see, e.g., LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A., 209 F. Supp. 3d 612, 638 (S.D.N.Y. 2016), *aff’d sub nom.* LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA, 720 F. App’x 24 (2d Cir. 2017) (excluding testimony of plaintiff’s expert witness on secondary meaning as unqualified and excluding his expert report, which found secondary meaning based in part on social media evidence—specifically, his review of “over 100,000 unsolicited third-party online posts,” *id.* at 644, focusing on “the content of the images [of LVL XIII sneakers posted on social media platforms], the comments that accompany the images, [] the number of likes, [and] the dates,” *id.* at 647). To authenticate mark talk offered into evidence, the proponent must demonstrate that it accurately reflects the information as it appeared on the website and that the evidence was posted by the purported source. Dan Farino & Douglas J. Leney, *Social Media can be a Minefield—Or a Gold Mine*, THE NAT. LAW J. (2016), <https://www.archerlaw.com/wp-content/uploads/2016/08/Social-Media-Can-be-a-Minefield-or-a-Gold-Mine.pdf> [<https://perma.cc/E7QT-URRU>]. Farino and Leney compare several jurisdiction’s approaches to authenticating social media evidence and conclude that cases reveal “widely disparate outcomes and a lack of clarity and predictability.”

¹¹² Vitamins Online, Inc. v. HeartWise, Inc., 207 F. Supp. 3d 1233 (D. Utah 2016), vacated in part on reconsideration, No. 2:13-CV-982- DAK, 2017 WL 2733867 (D. Utah 2017).

¹¹³ Eric Goldman, *Online Word of Mouth and its Implications for Trademark Law*, TRADEMARK LAW & THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 106-108, Graeme B. Dinwoodie and Mark D. Janis, eds., Edward Elgar Press, 2007 (“Online word of mouth can play an essential marketplace-disciplining/rewarding function for brands (rewarding the good; punishing the bad), but trademark law can interfere with that mechanism, acting as a tool to curb the production and dissemination of online word of mouth. . . trademark owners can selectively excise content from the Internet—favorable word of mouth can stay, but unfavorable word of mouth must go.”). Conversely, Goldman highlights how producers can control word of mouth far less than other factors like advertising and quality.

about good versus bad press—a consumer who posts “Crunch is the worst brand of chocolate bar” and one who posts “Crunch is my favorite brand of chocolate bar” provide equally useful evidence of secondary meaning by demonstrating awareness that “Crunch” is a brand name rather than a mere descriptor. But if courts are to take social media evidence of secondary meaning seriously, they will also have to be aware of the risks of producers cherry-picking evidence, injecting their own mark talk inorganically, or taking down those comments and reviews that demonstrate consumers view a term as descriptive or generic.

V. CONCLUSION

This essay has focused specifically on using mark talk as direct evidence of secondary meaning. But of course, mark talk can be useful in a number of other contexts, including proving trademark strength, fame, genericness, and likelihood of confusion. If courts and the USPTO update their understanding of viable evidence of consumer perception to include mark talk, mark owners and junior users trying to establish protectability or its absence will benefit from more direct, more accurate information about how consumers perceive and use their marks. Accepting mark talk may also lead producers to reconsider how they invest in marks, motivating them to prioritize actually altering consumer perception rather than simply throwing their whole budget at traditional advertising.

In the seventy-five years since the passage of the Lanham Act, so much has changed—from how we make purchasing decisions and interact with brands, to how we measure language evolution. Yet the secondary meaning factors have somehow remained static. If a finding of secondary meaning purports to reflect consumers’ actual understanding of a putative mark, it’s time to reconsider our methods.