

# THE GRAMMAR OF TRADEMARKS

by  
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*How do people talk when they talk about trademarks? If trademarks have become, as linguist Geoffrey Nunberg suggests, our “new global tongue,” perhaps we should pay greater attention to the grammar we use when we talk about them. We use “Coke” to refer to the Coca-Cola beverage in the North, and “coke” to refer to any kind of soda in the South, yet we still manage to get the drinks we desire. We use trademarks as verbs—we “xerox” a document or “tivo” a television program—without losing sight of the fact that “Xerox” and “TiVo” are brands of particular products. We use trademarks as metaphor and as slang—“Kleenex,” for example, has been used as street language for ecstasy—without changing our opinion of the products to which they relate. And yet, like overly academic grammarians, courts and trademark owners often rely on linguistic structures and rules in trademark law, telling consumers how to use and pronounce the names of products and services with which they engage and defining rights based on outmoded assumptions about conversations around brands. Thus, as with the debate over the proper role of dictionaries, trademark law might benefit from a more direct consideration of its role in creating language—in other words, whether it should be prescriptive (and define proper word usage) or descriptive (and reflect common word usage). Incorporating linguistic theory on language formation helps to begin this inquiry.*

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## I. INTRODUCTION

Tort law's reasonable person is a measure of conduct—the activities in which one engages, the choices one makes and, in trademark law, the way in which one processes information. In negligence law, the reasonable person is the embodiment of the law's requirements: One is negligent if one has failed to act in accordance with his or her<sup>1</sup> actions, and one is deemed not negligent if one has acted as he or she would have done. In some cases, the jury may be asked simply to assess a party's actions in light of its own experience, taking into account some characteristics (such as physical infirmities) and not others (such as intelligence).<sup>2</sup> In other cases, a court will take an economic approach by assuming that the reasonable person takes cost-effective precautions.<sup>3</sup> In still other cases, a party's actions will be assessed in light of external standards, such as industry practice or a relevant statute.<sup>4</sup> In all of these instances, however, negligence law's reasonable person standard is largely prescriptive. Except in special circumstances, the law does not base liability on whether a party acted according to his own preferences or limitations, nor does the law expect litigants in most negligence cases to present surveys of individuals asking how they would have acted under similar circumstances. Rather, the law constructs an ideal reasonable person as a standard by which to gauge the propriety of a party's conduct. A party is thus expected to comply with this standard or to train herself to do so; in other words, the standard establishes a normatively "correct" way of acting.<sup>5</sup> To be sure, the standard incorporates some

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<sup>1</sup> Characterizing the reasonable person as either male or female may well have ramifications with respect to whether the party's activity is deemed to be reasonable. See generally Margo Schlanger, *Gender Matters: Teaching a Reasonable Woman Standard in Personal Injury Law*, 45 ST. LOUIS U. L.J. 769 (2001).

<sup>2</sup> RESTATEMENT (SECOND) OF TORTS § 283C cmt. a (1965) ("So far as physical characteristics are concerned, the hypothetical reasonable man may be said to be identical with the actor."); *id.* § 289 cmt. n (noting that the reasonable person standard does not incorporate the defendant's "attention, perception, memory, knowledge of other pertinent matters, intelligence, and judgment").

<sup>3</sup> See *United States v. Carroll Towing Co.*, 159 F.2d 169, 173 (2d Cir. 1947) (Hand, J.) (using cost-benefit analysis of negligence).

<sup>4</sup> See *The T.J. Hooper*, 60 F.2d 737, 740 (2d Cir. 1932) (rejecting argument that industry standard should control); *Tedla v. Ellman*, 19 N.E.2d 987, 991–92 (N.Y. 1939) (holding that although duty is generally established by applicable statute, plaintiffs were justified in noncompliance).

<sup>5</sup> As Mayo Moran has noted, the risk of personification is that the reasonable person's assumed characteristics "tend to mirror those of the privileged in our

descriptive elements. To the extent that the law's determination of what constitutes reasonable care acknowledges evidence from the field—jurors' own experiences, industry standards, and the like—the standard will reflect how individuals actually act (or, at least, how they believe they would act). Moreover, in certain instances, such as medical malpractice cases, where the industry standard is dispositive, industry participants have the ability to shape the standard more directly.<sup>6</sup> But the fact that the reasonable person is an idealized standard that determines liability means that it cannot escape its prescriptivist nature. It purports to reflect what the ordinary person *would* do but, by incorporating a sense of judgment, ultimately dictates what actors *should* do.<sup>7</sup>

In trademark law, the reasonable person plays a different role. Because the standard of fault in a trademark infringement or dilution case is strict liability, the propriety of a defendant's actions does not turn on whether the defendant acted reasonably, although certain defenses may incorporate the related concepts of fairness and good faith.<sup>8</sup> Instead, trademark law's reasonable person is the person whom trademark law purportedly benefits: the "reasonably prudent consumer."<sup>9</sup> The reasonably prudent consumer provides the context against which the defendant's actions are judged, rather than the standard of liability itself, and so at least purports to be descriptive in nature. In infringement cases, for example, courts ask whether the defendant's use of the plaintiff's mark would be likely to cause a reasonably prudent consumer to be confused into thinking that the defendant's goods or services are produced by, authorized by, or sponsored by the plaintiff trademark holder,<sup>10</sup> rendering acceptable those uses that confuse only unreasonable

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society." MAYO MORAN, *RETHINKING THE REASONABLE PERSON: AN EGALITARIAN RECONSTRUCTION OF THE OBJECTIVE STANDARD* 306 (2003).

<sup>6</sup> See James Gibson, *Doctrinal Feedback and (Un)Reasonable Care*, 94 VA. L. REV. 1641, 1654–58 (2008).

<sup>7</sup> Cf. MORAN, *supra* note 5, at 307 (discussing the "endemic confusion between the normative and descriptive components of the [reasonable person] standard"). Of course, the fact that the reasonable person is a standard means that its contours can change over time. PETER M. TIERSMA, *LEGAL LANGUAGE* 79 (1999).

<sup>8</sup> See, e.g., 15 U.S.C. § 1115(b)(4) (2006) (providing a defense to infringement if the defendant's use of the mark at issue is a use "which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin"). The standard of fault is not strict in a secondary liability case. See, e.g., *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 (1982).

<sup>9</sup> This individual is also referred to in the case law as the "reasonable consumer," the "reasonable purchaser," the "reasonably prudent purchaser," or the "reasonably careful purchaser," among other similar terms. See, e.g., *Int'l Ass'n of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996) (using "reasonably prudent purchasers exercising ordinary care"); *Upjohn Co. v. Schwartz*, 246 F.2d 254, 262 (2d Cir. 1957) (using "reasonably careful purchasers"); *Royal Typewriter Co. v. Cachelin*, 127 F. Supp. 173, 175 (S.D.N.Y. 1954) (using both "ordinarily prudent purchasers" and "ordinary careful purchaser").

<sup>10</sup> See, e.g., *Dreamwerks Prod. Grp. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998) ("The test for likelihood of confusion is whether a 'reasonably prudent

consumers.<sup>11</sup> In attempting to answer the confusion question, courts typically, as in negligence cases, take some characteristics of actual consumers into account: whether they are sophisticated or unsophisticated; whether they are under pressure to select goods quickly or proceed more leisurely; whether they are capable of thoughtfully making decisions in the marketplace or tend to act heedlessly.<sup>12</sup> But, unlike in negligence cases, courts in trademark cases will sometimes consider evidence of the reasonable consumer's cognitive process, such as surveys, expert testimony, or third-party uses such as media reports or dictionary entries. In this way, the reasonable person in trademark law aims, at least, to be more descriptive than prescriptive: It attempts to reflect how consumers actually think about the marks in question, without conveying a normative judgment as to whether consumers *should* think about the marks in such a manner.<sup>13</sup> This is not to say that judges

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consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the [plaintiff's] marks.”).

<sup>11</sup> Courts may also reference the reasonable consumer in dilution cases, in which the question is whether the defendant's use of the plaintiff's mark is likely to dilute the plaintiff's mark through blurring or tarnishment, but they appear to be just as likely to rely on the semantic association between the two marks. *See, e.g., V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 385, 388 (6th Cir. 2010) (holding that federal anti-dilution law creates a presumption “that a new mark used to sell sex related products is likely to tarnish a famous mark if there is a clear semantic association between the two,” but noting that the presumption may be rebutted by evidence “in the form of expert testimony or surveys or polls or customer testimony”); *Visa Int'l Serv. Ass'n v. JSL Corp.*, 610 F.3d 1088, 1091 (9th Cir. 2010) (“[A] plaintiff seeking to establish a likelihood of dilution is not required to go to the expense of producing expert testimony or market surveys; it may rely entirely on the characteristics of the marks at issue.”). *But see Eli Lilly & Co. v. Natural Answers, Inc.*, 86 F. Supp. 2d 834, 852 (S.D. Ind. 2000) (“For blurring to occur, there must be some mental association in the reasonable consumer's mind between the plaintiff's and the defendant's uses of the mark.”).

<sup>12</sup> Thus, among the various factors considered by courts in determining whether the defendant's actions are likely to cause confusion among consumers, the question of the “reasonably prudent consumer” is likely to arise most directly in considering consumer sophistication. *See, e.g., Brookfield Commc'n, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1060 (9th Cir. 1999) (noting that the reasonably prudent consumer is expected to be “more discerning—and less easily confused—when he is purchasing expensive items”). For an overview of courts' and commentators' views on consumer sophistication in this regard, see Thomas R. Lee, Glenn L. Christensen & Eric D. DeRosia, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, 57 EMORY L.J. 575, 577–78 (2008).

<sup>13</sup> *See, e.g., E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 510 (E.D.N.Y. 1975) (“In weighing the evidence of likelihood of confusion, the court must strive to place itself in the shoes of a prospective purchaser. In this role, the court does not act as an enlightened educator of the public but takes into account the mythical ordinary prospective purchaser's capacity to discriminate as well as his propensity for carelessness.”); Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1645 (2006) (suggesting that the multifactor test of the likelihood of consumer confusion “is essentially a substitute for empirical work”). The goal of descriptiveness may be more aspirational than actual. *See id.* at 1641–42 (stating that although survey evidence is widely believed to be

are immune from the tendency to view issues from their own perspectives,<sup>14</sup> or that trademark law should not adopt a more prescriptivist approach by conveying expectations to consumers.<sup>15</sup> Nor is it to ignore the fact that consumers are not a monolithic entity, and so there will always be some consumers who respond differently from others. But, on the whole, trademark cases purport to reflect courts' desire to respond to conditions in the marketplace rather than to create them *ex ante*.

There is one aspect, however, in which trademark law's view of the reasonable person embodies a tension between prescription and description: in determining whether a word can function as a trademark at all.<sup>16</sup> On the one hand, the ultimate answer to this question is whether a word will have or continues to have trademark significance to consumers in the relevant market, a question that is typically answered by reference to empirical evidence. On the other hand, this inquiry is in service of a more prescriptive goal of trademark holders: to shape the

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highly persuasive in trademark infringement cases, the case law does not accord with this view); Graeme B. Dinwoodie, *What Linguistics Can Do for Trademark Law*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 140, 157 (Lionel Bently et al. eds., 2008) (noting that "linguistic understanding of key terms of art in trademark law illustrates the inevitably prescriptive content of supposedly descriptive assessments of trademark claims").

<sup>14</sup> See, e.g., *Londontown Mfg. Co. v. Cable Raincoat Co.*, 371 F. Supp. 1114, 1118 (S.D.N.Y. 1974) ("In the trademark field, the precedents are so numerous and varied that resort to categories is often difficult and unrewarding. That an infringer is the Devil quoting Scripture sometimes cannot be determined until it is found that he is an infringer. In this field of law more than almost any other, the reaction of the trial judge as a person often concludes the issue. And sometimes an analogue can be found for a decision either way, leaving the Court with the rather comfortable feeling that it is, after all, supported by precedent."). See also FRANK SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 166 (1925) (noting that "the so-called ordinary purchaser changes his mental qualities with every judge") (internal quotation marks omitted); Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS U. L.J. 781, 783 (2008).

<sup>15</sup> See, e.g., *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121 (2004) (noting that "some possibility of consumer confusion must be compatible with fair use" of a mark); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 488 (2005) (contending that, in some trademark cases, "the law should act as a norms creator, setting aspirational goals rather than responding to current consumer expectations"); Alan Durant, "How Can I Tell the Trade Mark on a Piece of Gingerbread from All the Other Marks on It?": *Naming and Meaning in Verbal Trade Mark Signs*, in TRADE MARKS AND BRANDS, *supra* note 13, at 107, 120 (considering linguistics' relevance to the question of "how far trade mark law should reflect public thinking about commercial communication and how far it should be normative in relation to use of signs (as part of commercial regulation and governance)"). As Joe Miller has pointed out to me, courts in parody cases are also somewhat prescriptive in that they are essentially telling consumers that they should "get the joke," even if not all of them would otherwise do so.

<sup>16</sup> Nonlexical elements and trade dress can serve as and are also subject to many of the claims raised herein. I focus in this Article only on word marks.

language usage not only of competitors in the marketplace but of the public more generally.<sup>17</sup> For example, consumers, writers, and dictionary editors are often reminded, more or less forcefully, that trademarks should be used only as capitalized modifiers of common nouns, as in a “Xerox photocopier.”<sup>18</sup>

Trademark holders who communicate this view typically do so from a position of perceived ownership and monopoly, one that is occasionally reinforced by commentators.<sup>19</sup> Although one would ordinarily not think of language as something that can be owned, trademark doctrine encourages this assumption, from the inescapable terminology of property (which talks of “trademark owners” or “trademark holders”), to the view that an invented word (such as “Xerox”) is a stronger trademark than an existing word used in a trademark sense and thus deserves broad legal protection, to the belief that appropriate enforcement activities include not only attempts to stop competitors from engaging in uses of marks that frustrate consumers’ purchasing decisions but also attempts to limit the ability of consumers, writers, and others from using marks as part of discourse. To extend the property metaphor further, then, trademark law encourages trademark holders to think of enforcement as akin to thwarting adverse possession: The trademark’s inviolability must be defended against any and all encroachments, lest the right to own the mark be relinquished to those who are using it for some personal benefit.

But while some uses of a mark are indeed infringing, not every use of a mark is a legally relevant encroachment. To say that all uses of a trademark inconsistent with its prescribed form will cause that trademark to lose its original associations reflects a narrow view of how language functions in society. That view, typically denominated by the linguistic community as “prescriptive,” contends that communication benefits from rules and directives supplied by authorities who educate speakers as to correct uses of language.<sup>20</sup> Descriptivists, by contrast, who occupy much

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<sup>17</sup> ROGER SHUY, *LINGUISTIC BATTLES IN TRADEMARK DISPUTES* 3 (2002) (discussing trademark law’s attempt “to create a purism that tries to eliminate what it considers to be the deviant varieties of language, a goal that is consistent with law’s innate need to be prescriptive”). Shuy is a prominent expert witness in trademark cases.

<sup>18</sup> Michael Atkins, *Are Anti-Genericism Ads Effective?*, SEATTLE TRADEMARK LAWYER (Oct. 25, 2007, 9:32 PM), <http://seattletrademarklawyer.com/blog/2007/10/26/are-anti-genericism-ads-effective.html> (discussing Xerox advertisement).

<sup>19</sup> See, e.g., SHUY, *supra* note 17, at 2 (stating that “trademark law is about the right to monopolize the use of language”); Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 769 (1990) (“Trademark protection matters because it allows a firm to remove a word from the market language, in the sense that it allows the firm to prevent others from using the word or anything confusingly similar to it. This creates what might be called language exclusivity.”).

<sup>20</sup> There is a certain resemblance between the standard economic justification for many principles of liability in trademark law (reducing “search costs” or “imagination costs” for consumers by eliminating conflicting signals) and the justification offered by some prescriptivists for rules of language usage (to limit the cognitive effort necessary to communicate). Compare, e.g., *Qualitex Co. v. Jacobson*

of the modern linguistics academy, take a more community-focused view of language formation, in which language use is correct if it furthers effective communication, without regard to its place in a language hierarchy or compliance with certain rules of grammar. As a result, context becomes vitally important, such that a lexical unit can have multiple, and independent, meanings. Context may suggest a usage that is formal or informal, standard or not standard, or traditional or modern, but in all cases, language is, ultimately, the way in which reasonable people communicate to promote understanding.

Trademark law has not yet fully resolved its place in this debate. Although it purports in large part to be motivated by promoting consumers' understanding of commercial communications, it does not strongly distinguish between uses of marks that frustrate understanding and those that do not, often permitting trademark holders to control expressive uses of a mark.<sup>21</sup> Such distinctions would be more easily made by focusing on the fact that a trademark is, quite simply, the proper name of a brand of good or service.<sup>22</sup> Trademark validity asks whether consumers recognize a word as a proper name in context; trademark infringement involves the confusing adoption of the same or similar name by another for its goods or services; and trademark dilution involves the use of a famous name in instances in which the law has determined that only one entity is legally entitled to use that name for its goods or services, regardless of the lack of confusion created by the second use.<sup>23</sup> A description of trademark law, then, that claims that the

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Prods. Co., 514 U.S. 159, 163–64 (1995) (discussing search costs theory of trademark law), and *Ty Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) (discussing “higher imagination cost[s]” as a possible justification for anti-dilution law), with David Foster Wallace, *Tense Present: Democracy, English, and the Wars over Usage*, HARPER'S MAGAZINE, Apr. 2001, at 39, 48–49 (noting that even though “[a] listener can usually figure out what I really mean when I misuse *infer* for *imply*,” this usage may “require at least a couple extra nanoseconds of cognitive effort, a kind of rapid sift-and-discard process, before the recipient gets it”).

<sup>21</sup> See, e.g., Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 414 (2010).

<sup>22</sup> Durant, *supra* note 15, at 114 (“What makes a sign ‘distinctive’ for the purpose of trade mark law, from the language point of view, is essentially that it operates as a name conventionally does: it attempts to make unique, unambiguous reference, without elaboration or description, in a manner that will be successfully recognized in a given context by the sign’s addressee (for trade mark law, the average consumer).”).

<sup>23</sup> See *Visa Int’l Serv. Ass’n v. JSL Corp.*, 610 F.3d 1088, 1091 (9th Cir. 2010) (calling the association of two products with the same trademark the “quintessential harm addressed by anti-dilution law”); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:6 (4th ed. Supp. 2008) (analogizing the question “Who are you?” asked of a person, to which the usual response would be one’s name, to the function performed by a trademark and distinguished from the answer to the question “What are you?”). On the parallel between personal names and trademark law, see WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 167 (2003); Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. (forthcoming 2010).

doctrine is about establishing and preserving the *meaning* of marks rather than certain *associations* with those marks risks unmooring the law from its proper purpose. Names don't have definitions as other words do; "Marilyn Monroe" and "Microsoft," for example, both have particular references linked to biographical or historical data and evoke particular associations, but one cannot provide a definition for either one in the same way one can define the words "tree" or "table."<sup>24</sup> (In other words, the names "Marilyn Monroe" and "Microsoft" each point to a single reference in context, whereas "tree" and "table" can each be used to refer to any one of a class of items.) Thus, whatever justifications can be proffered for a prescriptivist view of language generally—such as ensuring conformity to what are deemed "standard" (and often class-based) modes of speaking—those justifications are less compelling when offered in the context of trademark law. If trademark law is really about clarity in naming, reference, and associations, rather than about meaning, it should discourage those uses that frustrate such references, focusing instead on whether consumers view and use the mark in question as the proper name of the plaintiff's brand of product or service. Attention to reference would avoid imbuing a more inventive mark with property-like significance; rather the inquiry would be simply whether, in context, consumers were likely to understand the word at issue to have a naming function. In this way, trademark holders would not be credited for challenging uses that do not reflect confusion as to the mark's referent. Uses of a mark in a verb form, for example (such as "I xeroxed that document yesterday"), do not of themselves indicate that the mark no longer has referential power, particularly given that trademark holders engage in such uses themselves.<sup>25</sup>

Ultimately, trademark law should, consistent with a descriptivist view of language more generally, extend speakers' fluidity with language into the commercial sphere, reflecting consumers' perceptions of language

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<sup>24</sup> JOHN I. SAEED, *SEMANTICS* 27 (2d ed. 2003) ("Names . . . are labels for people, places, etc. and often seem to have little other meaning. It does not seem reasonable to ask what the meaning of *Karl Marx* is, other than helping us to talk about an individual."). The treatment of trademarks in *Webster's Third* was a matter of considerable controversy. See HERBERT C. MORTON, *THE STORY OF WEBSTER'S THIRD: PHILIP GOVE'S CONTROVERSIAL DICTIONARY AND ITS CRITICS* 215–23 (1994); Worth J. Higgins, "Proper Names Exclusive of Biography and Geography": *Maintaining a Lexicographic Tradition*, 72 *AM. SPEECH* 381, 382 (1997). It is, admittedly, all too easy to slip into the habit of describing trademarks as having meaning. See, e.g., Laura A. Heymann, *Metabrands and Intermediation: A Response to Professor Fleischer*, 12 *HARV. NEGOT. L. REV.* 201, 218–19 (2007).

<sup>25</sup> Stuart Elliott, *The Verb Treatment for an Investment House*, *N.Y. TIMES*, Mar. 15, 2010, at B6 (reporting advertising campaign for the Vanguard Group that introduced the verb "Vanguarding"); Geoffrey K. Pullum, *Trademark Grammar*, *LANGUAGE LOG* (May 22, 2004, 11:42 AM), <http://itre.cis.upenn.edu/~myl/language-log/archives/000943.html> (suggesting that modern advertising encourages consumers to use trademarks as language).



rather than attempting to shape them.<sup>26</sup> Drawing from linguistic theory and modes of speaking in the nontrademark sphere, in which language variations are a common characteristic of communication, can help inform this process. The reasonable consumer, like the reasonable person of tort law, must be at some level a judicial abstraction, a necessary result of the time- and resource-limited process of litigation.<sup>27</sup> But courts need not disregard the fact that despite exhortations from trademark holders, consumers use trademarks as language in a playful sense, often without losing sight of the word's reference to a brand of good or service. The typical consumer does not always need to rely on formal structures such as metaphorical hierarchies, parts of speech, or rules of grammar to communicate effectively in every situation. Just as reasonable speakers of English may easily accommodate both the use of "hope" as a campaign slogan and "Hope" as a woman's first name, the reasonable consumer may well recognize that one can xerox something on any photocopier but that only one company makes Xerox photocopiers.<sup>28</sup> The reasonable consumer likely understands that an Egg McMuffin is a food item that can be ordered only at McDonald's but that a McJob can be held anywhere. Thus, trademark's reasonable consumer does not function prescriptively as a model of how other consumers

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<sup>26</sup> Cf. SHUY, *supra* note 17, at 195 (suggesting that linguistics is relevant to, *inter alia*, questions relating to fanciful marks and the meaning understood by the "ordinary person").

<sup>27</sup> 1 KEITH ALLAN, *LINGUISTIC MEANING* 2 (1986) ("We ascribe to S[peaker] and H[earer] the sort of capabilities and judgment attributed to the 'reasonable man' in law; they are the hypothetical men-in-the-street who adopt whatever practice is customary under the prevailing circumstances . . ." (footnote omitted)); Jennifer Davis, *Locating the Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law*, 2 *INTELLECTUAL PROP. Q.* 183, 185 (2005) (suggesting that "the existence of the average consumer [in European and U.K. trademark cases] is itself a matter of trust rather than science"); *id.* at 198–99 (suggesting that greater equality in income and education in postwar Europe led courts to assume a reasonable consumer); Dinwoodie, *supra* note 13, at 148 (noting that the reasonable consumer must be "in large part a legal fiction that implements a vision of the degree of consumer protection regulation that Congress and the courts think appropriate without rendering commerce inefficient").

<sup>28</sup> Higgins, *supra* note 24, at 388 ("[A]lthough people often refer to any photocopier as a *xerox* (the usual popular spelling—with a small *x*), still everyone knows that there is also a copier whose brand name is *Xerox*."). *But see* Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 *YALE L.J.* 1323, 1342 (1980) ("Even when knowledgeable consumers understand a mark to be both a product-category word and a trademarked brand name, their decisions respecting trade-offs between quality and price may be hindered by their inability to determine whether competitors' products are indeed substitutable."); Itamar Simonson, *Trademark Infringement From the Buyer Perspective: Conceptual Analysis and Measurement Implications*, 13 *J. PUB. POL'Y & MARKETING* 181, 185 (1994) (discussing difficulties in distinguishing consumer understanding of trademark status from consumer use of a trademarked word). The difference in views may be explained by whether one is primarily a linguist, a lawyer, or an economist and, relatedly, whether one is measuring communicative effectiveness or purchasing decisions.

should act; rather, trademark's reasonable consumer helps us to understand how trademark holders should act.

Reasonable speakers of English have an interest in effective communication, and trademark law should assume that they talk about trademarks with this goal in mind. An area of the law that purports to be largely about the use of language should, as I discuss in Part II, take more account of the way that language develops as it is spoken, rather than encouraging trademark holders to impose rules of engagement. As I discuss in Part III, such rules do not reflect the way that reasonable people speak and, therefore, are unlikely to be obeyed except under threat of legal sanction. Thus, it might be useful to abandon such efforts in most circumstances, focusing plaintiffs' and courts' attention on the relevant issue at hand: Does the available evidence indicate that consumers understand the word in question to be a trademark, despite uses that do not reflect a formalist approach to trademark grammar?<sup>29</sup> The answer to this question may not, in many cases, require additional evidence; it may simply require a change in focus from a view of trademarks as property to a view of trademarks as language. If, as one commentator has suggested, the "reasonable person" represents, at its core, "the module of shared commonsense world knowledge,"<sup>30</sup> the law should recognize that language is inherently a shared experience—no less so when we are speaking the language of trademarks. In other words, if trademark law purports to rely on how the reasonable consumer engages with trademarks, it should be more willing to accommodate the language the reasonable person actually uses.

## II. HOW LANGUAGE DEVELOPS: PRESCRIPTIVIST VERSUS DESCRIPTIVIST APPROACHES

The debate over how language develops generally involves two opposing camps.<sup>31</sup> The prescriptivist school takes an objective view of language, asserting that there are correct meanings, pronunciations, and grammars in a language, with rules that proper speakers of the language are taught to follow. Language's formalist nature, under this theory, yields a set of "building blocks": word parts that form words, which in turn form sentences, which in turn form discourse.<sup>32</sup> "Grammar" is then "[t]he study of the building-block structure, the inherent properties of

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<sup>29</sup> Jerre B. Swann, *The Validity of Dual Functioning Trademarks: Genericism Tested by Consumer Understanding Rather Than by Consumer Use*, 69 TRADEMARK REP. 357, 358 (1979) (contending that "the ultimate question is not the extent of consumer use in a generic sense, but the extent of consumer understanding of a trademark sense").

<sup>30</sup> James Franklin, *The Representation of Context: Ideas from Artificial Intelligence*, 2 LAW, PROBABILITY & RISK 191, 198 (2003).

<sup>31</sup> Although I focus in this Article on the English language, I do not mean to suggest that different issues arise with respect to different languages (or, indeed, that different issues do not arise).

<sup>32</sup> GEORGE LAKOFF & MARK JOHNSON, *METAPHORS WE LIVE BY* 204 (1980).

the parts, and the relationships among them.”<sup>33</sup> Dictionaries and grammar guides, according to this view, collect the appropriate rules and are consulted as authoritative sources when debates arise.<sup>34</sup>

The descriptivist school, by contrast, takes a subjective view of language, rejecting the idea of a correct meaning, usage, or pronunciation of a word. Descriptivists define language in terms of actual use, such that meaning is derived from how people communicate rather than from an external set of rules.<sup>35</sup> This is not to say that this approach dismisses structure or conventions; rather, it is simply that these conventions are studied rather than imposed. Indeed, descriptivists assume that both speakers and listeners are, to use the legal terminology, “reasonable persons”: that they proceed according to the conventions of the language in which they are conversing and that they share an interest in effective and efficient communication.<sup>36</sup> Because communication is the goal of language usage, a particular usage cannot be said to be incorrect so long as the audience for the communication can understand what is being said.<sup>37</sup> Descriptivist theorists thus view the appropriate goal

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<sup>33</sup> *Id.*; see also DAVID CRYSTAL, HOW LANGUAGE WORKS: HOW BABIES BABBLE, WORDS CHANGE MEANING, AND LANGUAGES LIVE OR DIE 233 (2005) (describing a prescriptivist grammar as “an account of the language’s possible sentence structures, organized according to certain general principles”). Grammar might be then further broken down into syntax (sentence formation) and morphology (word formation). See *id.* at 183.

<sup>34</sup> William Strunk, Jr., and E.B. White’s *The Elements of Style* and the more recent *Eats, Shoots & Leaves* by Lynne Truss have become popular volumes of the genre. WILLIAM STRUNK JR. & E.B. WHITE, *THE ELEMENTS OF STYLE* (3d ed. 1979); LYNNE TRUSS, *EATS, SHOOTS & LEAVES: THE ZERO TOLERANCE APPROACH TO PUNCTUATION* (2004). See also JACK LYNCH, *THE LEXICOGRAPHER’S DILEMMA* 225 (2009) (describing how Webster’s marketing department touted the dictionary as an authority because “authority—even authoritarianism—sold dictionaries”).

<sup>35</sup> LAKOFF & JOHNSON, *supra* note 32, at 217, 228. Thus, the objectivist meaning of “grammar” is distinct from what some linguists refer to as a “generative grammar,” the latter referring to the internal rules that speakers of English intuit to understand why “the dog ran away” represents typical word order in English while “ran dog away the” does not. See STEVEN PINKER, *WORDS AND RULES: THE INGREDIENTS OF LANGUAGE* 4 (1999).

<sup>36</sup> ALLAN, *supra* note 27, at 3 (“There is (normally) a mutual expectation that S[peaker] and H[earer] will behave reasonably towards one another, and will cooperate with one another, in their language interchanges as in other kinds of social behaviour.”); PAUL GRICE, *STUDIES IN THE WAY OF WORDS* 26 (1989) (describing the “Cooperative Principle” as expecting that a participant in a conversation will “[m]ake [his or her] conversational contribution such as is required, at the stage at which it occurs, by the accepted purpose or direction of the talk exchange in which [he or she is] engaged”); Eve V. Clark & Herbert H. Clark, *When Nouns Surface as Verbs*, 55 *LANGUAGE* 767, 782–83 (1979) (noting that “indexical” expressions such as “that woman” have meaning only in context, thus requiring a “moment-to-moment cooperation” between speaker and listener).

<sup>37</sup> The rules championed by prescriptivists are often characterized by descriptivists as “standard English” or “formal English.” Geoffrey Nunberg, *The Decline of Grammar*, *ATLANTIC MONTHLY*, Dec. 1983, at 31, 32 (“[T]he linguists have won over a large part of the educational establishment, so that ‘correct English’ has come to

of dictionaries and other reference tools as reflecting how the language is spoken rather than setting down rules that must be followed.<sup>38</sup> Although dictionaries and similar reference works hold a certain place of authority as sources of formal or standard English—witness the attention paid to the words that are added to the leading dictionaries each year—the ultimate goal of modern lexicographers is to act as “language reporters,”<sup>39</sup> not language legislators.

Of course, both schools derive meanings and grammar from some external sources; the difference between the two is the nature of those sources. Prescriptivists will often identify particular speakers of English as authorities, relying on the works of well-regarded writers and other educated users of language as examples of proper English.<sup>40</sup> Descriptivists rely more broadly on popular usage, using categories such as “standard” and “nonstandard,” rather than “correct” and “incorrect,” to indicate forms that have attained more widespread levels of usage. Thus, in the descriptivist view, language is a fluid process, a living organism that changes over time rather than a static, mathematical construct that adheres to certain long-established rules; to a prescriptivist, rules provide order and predictability, ensuring that speakers and listeners will share a common understanding.<sup>41</sup> For example, to a prescriptivist, the word

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mean no more than ‘standard English,’ the English spoken by the ‘educated middle class.’”).

<sup>38</sup> See, e.g., SIDNEY I. LANDAU, *DICTIONARIES: THE ART AND CRAFT OF LEXICOGRAPHY* 240–72 (2d ed. 2001) (describing positions); LYNCH, *supra* note 34, at 113–15 (same); Roy H. Copperud, *English As It's Used Belongs in Dictionary*, EDITOR & PUBLISHER, Nov. 25, 1961, at 44, 44 (“Twenty minutes spent on the conclusions of any reputable linguist in the last 25 years should convince even the most obtuse that the business of a dictionary is to report how words are used, and not to prescribe or proscribe meanings.”); Albert H. Marckwardt, *Dictionaries and the English Language*, 52 *ENGLISH J.* 336 (1963). The debate reached a fever pitch when the third edition of *Webster's New International Dictionary* was issued in 1961; many essays on the topic are collected in *DICTIONARIES AND THAT DICTIONARY* (James Sledd & Wilma R. Ebbitt eds., 1962).

<sup>39</sup> Strawberry Saroyan, *In Land of Lexicons, Having the Last Word*, N.Y. TIMES, Mar. 19, 2005, at B9 (quoting Erin McKean, editor-in-chief of the *Oxford American Dictionary*). Courts and the Patent and Trademark Office will, on occasion, refer to dictionaries when determining the trademark significance of a word. See, e.g., *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.* 494 F.2d 3, 11 n.5 (5th Cir. 1974) (“The dictionary definition of the word is an appropriate and relevant indication of the ordinary significance and meaning of words to the public.” (internal quotation marks omitted) (using *Webster's Third New International Dictionary* (1961))); MCCARTHY, *supra* note 23, § 11:69 (discussing use of dictionaries by the Trademark Trial and Appeal Board).

<sup>40</sup> LYNCH, *supra* note 34, at 190 (“The job of the prescriptive grammarian is to encourage writers to model their usage on the great writers of the past.”). Of course, many of these writers did not consistently follow the rules for which they are cited as authorities. See Geoffrey K. Pullum, *50 Years of Stupid Grammar Advice*, THE CHRONICLE REVIEW, Apr. 17, 2009, <http://chronicle.com/article/50-Years-of-Stupid-Grammar/25497>.

<sup>41</sup> Compare Nunberg, *supra* note 37, at 37 (“[W]e should no more ask linguistic scientists to tell us what sounds best than we should ask economists to tell us which

“ain’t” would be characterized as not an English word, despite its facial conformity with orthographical standards, while to a descriptivist, “ain’t” is clearly part of the English language, given its long pedigree and usually clear meaning, even if it might be characterized as nonstandard.<sup>42</sup> The element of shared understanding—of being able to characterize a word as how reasonable people speak—is important even in a descriptivist world. Teenagers who use “bad” to mean “good” might be hailed as language innovators; someone who uses “bad” to mean “purple” will almost certainly be deemed to be talking nonsense, at least until sufficient numbers of people adopt a similar usage.<sup>43</sup> This is not to say that a modern linguist would advocate abandoning all grammar and vocabulary education or that term papers will henceforth be written in the same vocabulary as text messages. To the contrary, modern linguists acknowledge that certain forms of communication are appropriate for certain contexts—a business letter will be written differently from a postcard, and a discussion between friends will sound different from a discussion in a courtroom. But all this means is that speakers of English use the language that is appropriate to the circumstances: more formal English in more formal settings, and more casual English elsewhere, with either one being “correct” only in particular circumstances.

It is true that users of dictionaries, having been told throughout their schooling that certain language uses are incorrect, may not always grasp this distinction. The continued vitality of works such as *Eats, Shoots & Leaves* and similar grammar guides suggests that speakers of a language use dictionaries and similar reference works not simply to learn the meanings of words and structures with which they are unfamiliar but to learn the correct meaning or pronunciation of a word.<sup>44</sup> But even

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distribution of property will be fairest; those matters are for us to decide.”), with Mark Halpern, *A War that Never Ends*, ATLANTIC MONTHLY, Mar. 1997, at 19, 20 (responding to Nunberg by asserting that arguments that linguistic rules are man-made “are no more arguments against laws governing language usage than they are against laws governing vehicular traffic”).

<sup>42</sup> McCandlish Phillips, *Webster Soups Up Its Big Dictionary*, N.Y. TIMES, Sept. 7, 1961, at 37 (discussing inclusion of “ain’t” in *Webster’s Third New International Dictionary*). Indeed, from a descriptivist view, a well-entrenched nonstandard usage may, over time, become standard. LYNCH, *supra* note 34, at 15 (noting of certain pronunciations that “[a]t some point the wrong version became right”).

<sup>43</sup> PINKER, *supra* note 35, at 15–16. Certain race- and class-based judgments will affect whether language variations are deemed “acceptable” and by whom; witness, for example, the debate between those who characterize a certain language variation as “African American Vernacular English” and those who characterize it as “Ebonics.” See Geoffrey K. Pullum, *Ideology, Power, and Linguistic Theory* 3–4 (Dec. 13, 2006), <http://people.ucsc.edu/~pullum/MLA2004.pdf> (discussing the debate).

<sup>44</sup> Wilson Follett, *Sabotage in Springfield: Webster’s Third Edition*, THE ATLANTIC, Jan. 1962, at 73, 77 (“The fact that [a dictionary’s] compilers disclaim authority and piously refrain from judgments is meaningless: the work itself, by virtue of its inclusions and exclusions, its mere existence, is a whole universe of judgments, received by millions as the Word from on high.”); Dwight MacDonald, *Three Questions for Structural Linguists, Or Webster 3 Revisited*, in DICTIONARIES AND THAT DICTIONARY,

characterizing a word usage as “correct” tells us nothing about how that status is achieved. In modern lexicography, “correct” means “most accepted usage”; it is not the equivalent of a pronouncement from l’Academie française.<sup>45</sup> We look to grammar guides to tell us how a certain class of individuals speaks in certain situations; we would seem foolish if we used these same manuals to guide our conversations in all circumstances.

Admittedly, this formal/casual distinction does not map directly onto trademark usage among consumers. Consumers likely do not have an intuition that leads them to use the word “Xerox” differently in a more formal setting from the way they would use it in a more casual one, in the same way they might use “I am going to tell her” in the former and “I’m gonna tell her” in the latter. But they do think about trademarks in a related way in that they typically understand that context matters to reference. If a reasonable user of English knows that the word “text” in the sentence “Can you please text me your telephone number?” relates to a different technology from the one denoted by the word “text” in the sentence “All students must have the required text on the first day of class,” that same speaker of English might well understand that the word “Xerox” in the sentence “You should buy a Xerox rather than a Canon; the Xerox is cheaper” has a different reference from the word “xerox” in the sentence “Can you please xerox this document for me before you go home?” It is when the first sentence becomes nonsensical that “Xerox” fails to have any distinctive reference, not necessarily when the second sentence becomes a matter of common usage.

Yet just as grammar guides aim to tell readers the proper ways to use language, trademark owners expend effort on educating consumers, writers, and others about rules of trademark usage that would mandate the characterization of the second “xerox” sentence as incorrect. These shibboleths arise from the belief that in order to prevent a slide to generic status,<sup>46</sup> a trademark must always be used in precisely the same

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*supra* note 38, at 256, 257 (noting that *Webster’s Third’s* use of labels such as “substandard,” “nonstandard,” and “slang” are in part prescriptive because “they imply a value judgment”); Patrick E. Kilburn, *Onward to Agincourt: Or, Once More Unto the Breach, Dear Friends*, in *DICTIONARIES AND THAT DICTIONARY*, *supra* note 38, at 265, 266 (refuting MacDonald by explaining that a dictionary’s label of a usage as nonstandard is, in fact, descriptive).

<sup>45</sup> Cf. TIERSMA, *supra* note 7, at 116 (“[W]hen Noah Webster approached Chief Justice John Marshall for an endorsement of his dictionary, Justice Marshall is reported to have refused, commenting that in America it was individuals rather than public bodies that dictate language use.” (citing Shirley Brice Heath, *A National Language Academy?: Debate in the New Nation*, 189 *LINGUISTICS* 9, 33 (1977))).

<sup>46</sup> As to the appropriateness of the term “genericide,” see John Algeo, *Five Reference Books*, 51 *AM. SPEECH* 144, 148 (1976) (reviewing *THE NEW COLUMBIA ENCYCLOPEDIA* (William H. Harris & Judith S. Levey eds., 1975)) (calling “genericide” “one of the worst constructed neologisms of recent times” because its word formation suggests that it means “murder of genera (or, in this case, generic terms),” rather than its opposite).

way, as “Xerox® photocopiers” and in no other form, because other uses will suggest that the word no longer serves as a trademark. Trademark holders presumably take these actions because courts deem the extent to which a trademark holder has “policed one’s trademark” as an important factor in determining trademark validity, including policing uses of the mark beyond potentially confusing uses by competitors.<sup>47</sup> This is both curious and unfortunate: curious, because it seems to conflict with assertions elsewhere by courts that exhortations in the form of advertising cannot serve to transform a generic term into a trademark,<sup>48</sup> and unfortunate, because it encourages trademark holders to send cease-and-desist letters to any entity using a trademark in an unorthodox fashion, including media outlets and dictionary publishers,<sup>49</sup> regardless of

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<sup>47</sup> See *Ill. High Sch. Ass’n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996) (Posner, J.) (“A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.”); *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 124 (S.D.N.Y. 1989) (“A trademark owner’s efforts at policing its trademarks is further proof of the strength of those marks.”); Charles R. Taylor & Michael G. Walsh, *Legal Strategies for Protecting Brands from Genericide: Recent Trends in Evidence Weighted in Court Cases*, 21 J. PUB. POL’Y & MARKETING 160, 164–65 (2002) (contending that the success rate for parties that rely on “indirect evidence such as newspaper and trade journal articles and dictionary definitions” is low but encouraging trademark owners to send letters to “media that misuse the trademark”). *But see* *Playboy Enters., Inc. v. Chuckleberry Pub., Inc.*, 486 F. Supp. 414, 422–23 (S.D.N.Y. 1980) (“The owner of a mark is not required to police every conceivably related use—thereby needlessly reducing non-competing commercial activity and encouraging litigation—in order to protect a definable area of primary importance.”). See also Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1792 (2007) (contending that trademark doctrine gives too much weight to “non-commercial and/or non-competitive trademark use contexts” in determining the generic status of a mark).

<sup>48</sup> See *infra* note 54.

<sup>49</sup> Linguists generally maintain that dictionary editors should not be responsive to such requests. See, e.g., LANDAU, *supra* note 38, at 407 (“The lexicographer has no intention of depriving a trademark owner of the exclusive right to use a term; but he is in the business of writing dictionaries and his overriding obligation is therefore to dictionary users. He cannot allow any special-interest group to determine what goes in his dictionary or how it is represented.”); Michael Adams, *Lexical Property Rights: Trademarks in American Dictionaries*, VERBATIM, Winter 2005, at 1, 1 (urging dictionaries to “record the flow of trademarks into the general American vocabulary”). Commentators are divided as to the legal implications of dictionary action or inaction. Compare, e.g., Deborah R. Gerhardt, *Consumer Investment in Trademarks*, 88 N.C. L. REV. 427, 494 (2010) (arguing in favor of a safe harbor from trademark infringement for reference tools), with, e.g., Julius R. Lunsford, Jr., *Trademarks and Semantics: The Use and Misuse of Trademarks in Dictionaries and Trade Journals*, 6 GA. L. REV. 311, 334 (1972) (arguing in favor of a statutory remedy “designed to correct the misuse and the incorrect definition of trademarks in dictionaries and other publications”), and Gary C. Robb, *Trademark Misuse in Dictionaries: Inadequacy of Existing Legal Action and a Suggested Cure*, 65 MARQ. L. REV. 179, 195 (1981) (arguing in favor of a cause of action against any entity, including a dictionary publisher, “that repeatedly uses a registered trademark in a manner which causes it to lose its

whether such use serves to indicate that the mark has ceased to function as the proper name of a brand of good or service.<sup>50</sup> These letters, like many other attempts to characterize the state of the law to the public, can create both a legal and a linguistic feedback loop. From a legal perspective, such letters risk expansion of the scope of trademark law. If the letters' recipients come to believe that the law permits only authorized uses of trademarks, this belief may be reflected in surveys and other assessments of consumer perceptions of trademark validity.<sup>51</sup> From a linguistic perspective, such letters may train consumers and the media in how to talk about trademarks, even if this causes them to speak unnaturally, which will then nevertheless feed back into courts' views of whether a term continues to serve as a trademark.<sup>52</sup>

One cannot blame trademark owners in this regard: Their economic interests compel them to resist language change of this sort, and courts have, correspondingly, done little to discourage them from engaging in broad enforcement efforts. Indeed, the nature of the judicial and administrative process in trademark disputes, which results in a ruling or opinion, conveys a prescriptivist's sense of trademark use as something to be legislated rather than reported. But while the ever-expanding consumer marketplace may be in need of structure and rules in order to

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significance as an indicator of origin"). (Lunsford was, at the time his article was published, the assistant vice president in charge of trademarks and patents for the Coca-Cola Company.) The European Union takes a different view of the duties of dictionary publishers. See Council Regulation 40/94, art. 10, 1993 O.J. (EC) (requiring revision of entries upon request of a trademark holder if an entry "gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered"). The International Trademark Association provides its members with a form letter that can be sent to dictionary publishers. See Int'l Trademark Ass'n, *Misuse of Trademarks in Dictionaries and Style Guides*, [http://www.inta.org/images/stories/downloads/InfoPub/dictionary and style guide template letter.doc](http://www.inta.org/images/stories/downloads/InfoPub/dictionary%20and%20style%20guide%20template%20letter.doc).

<sup>50</sup> In a 2010 April Fool's Day post, Google played on these conventions by announcing that in light of the (humorous) decision of the city of Topeka, Kansas, to change its name to "Google," it would be changing its name to "Topeka"; the post included a list of appropriate uses of the new name ("Before our blind date I did a Topeka search on him") and inappropriate uses ("Before our blind date I topeka'd him"). Eric Schmidt, *A Different Kind of Company Name*, THE OFFICIAL GOOGLE BLOG (April 1, 2010, 12:01 AM), <http://googleblog.blogspot.com/2010/04/different-kind-of-company-name.html>.

<sup>51</sup> William McGeveran, *The Trademark Fair Use Reform Act*, 91 B.U. L. REV. (forthcoming 2010) (noting that threat letters "serve a broader signaling function, by warning against all unauthorized uses of a mark"); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 774 (2009) ("Consumer expectations largely define trademark rights, yet those expectations are influenced by consumers' understanding (or misunderstanding) of the law.").

<sup>52</sup> Folsom & Teply, *supra* note 28, at 1353 (suggesting that media usage of marks "may reflect not the public's understanding of the trademarked word, but rather the media's own editorial policies—policies that inevitably reflect the existence of numerous trademark-policing programs designed to pressure the media into 'proper' trademark usage").



function effectively, this need does not require the trademark law equivalent of Strunk and White. If trademark law does indeed purport to reflect how the reasonable consumer acts in the marketplace, that reflection should incorporate the fact that language variation is an inherent characteristic of the English language.

### III. THE LANGUAGE OF TRADEMARKS

Trademark validity depends on how consumers interpret words. Because trademarks are, as is typically described, indicators of source, whether something functions as a trademark depends on whether consumers interpret a word as functioning as the proper name of a brand of product or service as opposed to communicating some other information about the product. In the phrase “Hershey’s delicious chocolate,” for example, the word “chocolate” communicates the type of product at hand; the word “delicious” communicates a characteristic about the product; and the word “Hershey’s” communicates the proper name of the brand of chocolate (which identifies, explicitly or implicitly, the company that makes or takes responsibility for the quality of the candy). As with language generally, and particularly with names, much depends on context. “Apple” on its own does not indicate trademark status until one knows if the speaker is talking about fruit or computers, just as “George Washington” may indicate the name of a president or the name of a university, depending on the nature of the communication at issue.<sup>53</sup>

Courts and commentators have long recognized that trademark meaning is a matter of consumer response. In other words, the mere fact that a company has spent millions of dollars in advertising a brand or sent innumerable cease-and-desist letters encouraging a particular use of a claimed mark does not lead to trademark validity if those efforts fall on deaf ears.<sup>54</sup> The ultimate question, as Judge Hand noted many years ago, “is merely one of fact: What do the buyers understand by the word for whose use the parties are contending?”<sup>55</sup> More specifically, as the

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<sup>53</sup> The graphical presentation of a word may also affect how consumers interpret a term. See Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1038 (2009) (contending that graphical placement of the text is what communicates trademark status to consumers and that even a generic word will be interpreted as a trademark given appropriate graphical treatment).

<sup>54</sup> See, e.g., *Co-Rect Prods., Inc. v. Marvy! Adver. Photography, Inc.*, 780 F.2d 1324, 1332 (8th Cir. 1985) (“[D]esires or intentions of the creator . . . are irrelevant. Instead, it is the attitude of the consumer that is important.”); *Dupont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 81 (2d Cir. 1936) (“It, therefore, makes no difference what efforts or money the DuPont Company expended in order to persuade the public that ‘cellophane’ means an article of DuPont manufacture. So far as it did not succeed in actually converting the world to its gospel it can have no relief.”).

<sup>55</sup> *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

Supreme Court phrased it some years later, a putative trademark holder must demonstrate that the “primary significance of the term in the minds of the consuming public is not the product but the producer.”<sup>56</sup> If consumers understand the word to be the proper name of a brand of product or service, the word serves as a trademark (that is, as a reference to the company that stands behind the good); if consumers understand the word to be something else (for example, the common name of a product or a characteristic of the product), the word does not serve as a trademark in that context.

Despite the narrow focus of this inquiry, some courts, trademark holders, and commentators have focused not on assessing the understanding of the reasonable consumer but rather on adhering to various prescriptivist rules of trademark grammar, concluding that failure to follow these rules means, *ipso facto*, that the claimed trademark is invalid. The underlying theme of these rules is that a trademark must be represented in only one lexical form (without a plural suffix and with a capital letter), as only one part of speech (as an adjective, not as a noun or verb), and with a tightly constrained scope of references (and so not used in any metaphorical or colloquial sense). But just as the sentence “I wondered who she was referring to” continues to have meaning in English despite its lack of conformity with prescriptivist rules of grammar, a trademark can still be viewed as a trademark despite uses by consumers and writers that fail to conform with these purported rules of trademark grammar. I discuss some of these rules, and how our understanding of reasonable (and common) modes of conversation subvert them, below.

#### A. *Rule #1: Trademarks May Not Be Used Metaphorically*

Both the prescriptivist and descriptivist views of language incorporate a theory of metaphor—the phenomenon of “understanding and experiencing one kind of thing in terms of another,”<sup>57</sup> such as the trope we use when we talk about time “marching on.” Metaphors are such a fundamental part of communication that we likely are not even aware of their use in many instances.<sup>58</sup> Indeed, the concept of metaphor is fundamental to how most trademarks work. Except for words invented to serve as trademarks—such as “Kodak” and “Xerox”—all trademarks, being words in the English language, operate on a level other than a literal one in that they require consumers to use a familiar word or

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<sup>56</sup> *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938).

<sup>57</sup> LAKOFF & JOHNSON, *supra* note 32, at 5.

<sup>58</sup> Lee et al., *supra* note 53, at 1050 (asserting that “there is ample evidence that people derive the semantic meanings of complex stimuli such as metaphors so rapidly and effortlessly that the cognitive process can be called automatic”). Those favoring an objective theory of language are likely to view metaphor as simply an alternative correct meaning for the word, while descriptivists will judge the metaphor by whether it fulfills the needs of participants to a communication for effective discourse. See LAKOFF & JOHNSON, *supra* note 32, at 211.

expression in a new and initially unfamiliar context.<sup>59</sup> The trademark “Brawny” for paper towels, for example, is intended not only to serve as the name of the product but also to encourage consumers to think of the product in terms of human strength. The trademark “Apple” for consumer electronics, while perhaps not designed to create a metaphorical association between the company and fruit, was presumably chosen because of the word’s appealing associations; alternatives with a negative association (such as “Spinach” for the youth market), one can assume, were not under consideration.<sup>60</sup> Even a mark that more directly describes the characteristics of the good or service with which it is associated operates using a form of metaphor, so long as it is recognized as a name rather than as a description, in that it encourages consumers to associate the term with a particular company and its products rather than with all products of that class generally (hence the reference in the doctrine to “secondary meaning”).<sup>61</sup> In short, a trademark works because

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<sup>59</sup> See *Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578, 586 (S.D.N.Y. 1972) (“Words must be used in a ‘trademark sense’ in order to constitute a mark. This means they must function in a fanciful, imaginative manner when perceived by the public.”); *United Lace & Braid Mfg. Co. v. Barthels Mfg. Co.*, 221 F. 456, 461 (E.D.N.Y. 1915) (“Every good trade-mark is suggestive; once seen or heard, its association with the product is readily fixed in the mind.”). Cf. SHUY, *supra* note 17, at 37 (“It is also quite likely that all marks are suggestive in some sense, otherwise they wouldn’t work at all.”). Some courts recognize the metaphorical nature of trademarks but only as to suggestive marks. See, e.g., *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 196 (S.D.N.Y. 2000) (“When choosing what to call the article, the creator of the suggestive name meaningfully fixes upon associational terms that will identify the product figuratively and will appeal to the consumer by allusion and metaphor.”).

While invented words have no literal meaning, they are, presumably, created with an eye and ear toward their linguistic effect. As Steven Pinker notes, companies incorporate phonesthesia when they invent brand names “using faux-Greek and Latinate neologisms built out of word fragments that are supposed to connote certain qualities without allowing people to put their finger on what they are.” STEVEN PINKER, *THE STUFF OF THOUGHT: LANGUAGE AS A WINDOW INTO HUMAN NATURE* 304 (2007) (citing Acura, Verizon, Viagra, and Altria as examples); see also JOHN ALGEO, *ON DEFINING THE PROPER NAME* 58 (1973) (“To take words like *Vercingetorix* or *Popocatepetl* as better examples of proper names than *Sue* and *Dartmouth* because the former are arbitrary, at least to most English speakers, whereas the latter have some descriptive value, is to ignore the obvious fact that most names have some motivation. Those that do not are the exception, not the paradigmatic case.”).

<sup>60</sup> Cf. MARTY NEUMEIER, *THE BRAND GAP: HOW TO BRIDGE THE DISTANCE BETWEEN BUSINESS STRATEGY AND DESIGN* 84 (2006) (suggesting that trademarks that “use Anglo-Saxon words, or the names of people, tend to be high-imagery names, producing vivid mental pictures that aid recall” (citing Apple Computer and Betty Crocker as examples)); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 671 (2004) (categorizing such marks as catachrestic).

<sup>61</sup> Durant, *supra* note 15, at 130, 134 (construing “descriptive” trademarks as consistent with “a sense closer to ‘general communicative use’, and contrast[ing] with specifically ‘naming’ use”); Dinwoodie, *supra* note 13, at 143 (“On the whole . . . it is probably true that terms that are descriptive fail immediately to act as source identifiers in the marketplace.”).

it causes consumers to think of a particular lexical unit as a proper name in addition to whatever literal meaning the word holds. The lexical unit "camel" engenders no metaphorical associations when it is used in connection with the desert animal; the same word used in connection with cigarettes operates on an additional "dimension of meaning."<sup>62</sup>

Thus, trademark validity should depend on a fairly binary distinction: Does the word operate on a literal level (as the common name of a good or service) or on a metaphorical level (as the proper name of a brand of good or service)? Trademark doctrine's *Abercrombie* hierarchy,<sup>63</sup> however, rewards the creativity inherent in a mark, and in so doing, imports Lockean property notions into what should be a linguistic analysis.<sup>64</sup> In his opinion for the Second Circuit, Judge Friendly set forth "some basic principles of trademark law," beginning with what he noted were the "four categories of terms" from the case law that reflected increasing degrees of "eligibility to trademark status and the degree of protection accorded," ranging from no protection at all to the strongest degree of protection: (1) generic (words such as "bread" for the baked good), (2) descriptive (words such as "Fresh" as a mark for bread), (3) suggestive (words such as "Farmer's Choice" as a mark for bread), and (4) arbitrary or fanciful (such as "Rainbow Bread" or "Zazz Bread").<sup>65</sup> Locating a claimed mark along this spectrum has now become a typical first step in any trademark opinion, much as a grammarian might begin his or her analysis by diagramming a sentence.<sup>66</sup> The purpose of the exercise, as suggested by Judge Friendly, is to determine whether the word at issue functions as a trademark, such that "inherently distinctive"

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<sup>62</sup> Durant, *supra* note 15, at 130 ("[T]he capability of the sign to have more than one dimension of meaning—to operate on more than one level at once, like a poetic image—is almost certainly what the trade mark owner wanted it to do.").

<sup>63</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>64</sup> *Cf. Ill. High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 246 (7th Cir. 1996) ("[A] trademark is not nearly so secure an entitlement as a property right. It is mainly just a designation of source and dies when it ceases to designate, for whatever reason other than the culpable conduct of the defendant." (citations omitted)).

<sup>65</sup> *Abercrombie*, 537 F.2d at 9. This was not the only categorization that could have been drawn from the existing case law. *See, e.g.*, OWEN DAVIES TUDOR, A SELECTION OF LEADING CASES ON MERCANTILE AND MARITIME LAW 573 (2d ed. 1868) (distinguishing fanciful names from four other kinds of trademarks: (1) those denoting the place of manufacture, (2) those denoting the manufacturer, (3) symbols, and (4) combinations of the other four types). For discussions of the linguistic properties of trademark neologisms, see Louise Pound, *Trade-Name Irradiations*, 26 AM. SPEECH 166 (1951), and Louise Pound, *Word-Coinage and Modern Trade-Names*, 4 DIALECT NOTES 29, 40–41 (1913) (noting the increase in invented trademarks in the late nineteenth and early twentieth centuries and expressing surprise that consumers did not view such neologisms with distrust).

<sup>66</sup> *See, e.g.*, Lee et al., *supra* note 53, at 1035 n.4 (stating that the *Abercrombie* hierarchy "has been embraced repeatedly by the Supreme Court as establishing the governing framework for trademark distinctiveness under federal law"); *id.* at 1037 (asserting that "[j]udges, practitioners, and scholars reflexively and unquestioningly have embraced the *Abercrombie* formulation of trademark distinctiveness").

marks (fanciful, arbitrary, and suggestive marks) are entitled to protection *ab initio*, while descriptive marks are protectable only upon proof of “secondary meaning”—that is, when the relevant consumer market views the word as a mark rather than as a description of a characteristic of the good or service. The more imaginative the trademark is determined to be, according to the *Abercrombie* hierarchy, the more protection it receives.<sup>67</sup>

But, as other commentators have suggested, once it has been determined that a word functions as a mark—that it can and does function as a proper name of a product or service—its degree of metaphor is irrelevant to its validity.<sup>68</sup> Fanciful, arbitrary, suggestive, and descriptive marks with secondary meaning are all deemed valid marks, and the “degree of protection accorded” would seem to be, as a matter of formalism, the same for each. If the question at hand is truly what consumers understand “by the word for whose use the parties are contending,”<sup>69</sup> the answer need not depend on whether the word is invented, suggestive of the product’s characteristics, or descriptive of them. Rather, the answer should depend on whether the reasonable consumer would understand the word in question—in light of presentation, use, and context—to be functioning as a proper name.<sup>70</sup> Generic words and mere descriptions do not function in any metaphoric sense at all. They are lexical units that can be defined and thus can be said to have meaning, in contrast to proper names, which can be defined only in terms of their referential function.<sup>71</sup> Indeed, the case law on which the *Abercrombie* court relied suggests this framework. Earlier courts had not viewed trademark validity along a spectrum of distinctiveness,

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<sup>67</sup> See, e.g., *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1130 (9th Cir. 1998) (rejecting argument that “dream” as used in the trademark “Dreamwerks” is suggestive, noting that “[d]ream’ is used in too many different ways to suggest any particular meaning to the reasonable consumer”); *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 199 (S.D.N.Y. 2000) (“In this Court’s view, no subtlety or intimation, no mental detour or thought gymnastics are demanded to span by creative leap the small space evident here between the product and name and its source.”). Note, however, that a court’s determination of whether a claimed mark is, for example, suggestive may well depend on the vocabulary the court brings to the exercise, knowledge that may or may not match that of the relevant consumer.

<sup>68</sup> Beebe, *supra* note 60, at 671 (noting that eligibility for trademark protection depends on whether the mark is distinctive of source or not); Lee et al., *supra* note 53, at 1038 (advocating elimination of *Abercrombie* hierarchy in favor of test that renders “all non-generic word marks . . . eligible for protection so long as they satisfy the ‘trademark use’ requirement”).

<sup>69</sup> *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

<sup>70</sup> Of course, the question of the mark’s acquired distinctiveness—how well its metaphor resonates in the marketplace—is another matter entirely. Such distinctiveness may be relevant to how likely it is that consumers will assume that uses of the mark by competitors are related to the mark holder.

<sup>71</sup> Cf. PINKER, *supra* note 59, at 11 (“A name really has no definition in terms of other words, concepts or pictures. Instead it points to an entity in the world, because at some instant in time the entity was dubbed with the name and the name stuck.”).

ranking “fanciful” marks stronger than “suggestive” ones, and so forth down the line. Rather, the terms “fanciful” (or “fancy,” as some courts called them) and “suggestive” were each used in particular cases to distinguish the technical trademarks at issue in that case from merely descriptive or generic words. These courts thus envisioned only a binary distinction: marks that were distinctive because they functioned as the proper name of a product or service and marks that merely described some quality of the product.<sup>72</sup>

The suggestion that a trademark’s validity depends not simply on whether it operates on a metaphorical or naming level but also on *how* metaphorical it is does, however, contribute to an understanding of trademark ownership as the ability to control language use. First, the *Abercrombie* hierarchy, by suggesting that marks that are more metaphorical are entitled to a greater degree of protection, conveys an expectation that control of all of an evocative mark’s subsequent uses and associations will belong to the entity that developed the trademark. Some courts have suggested, along these lines, that the greater protection given to arbitrary and fanciful marks is justified because the trademark owner has expended effort to create the metaphorical association among consumers and thus deserves enhanced legal protection of the fruits of its labor.<sup>73</sup> Second, the hierarchy may contribute to increasing the scope of the Lanham Act’s anti-dilution provision, which creates a cause of action against uses of a famous and distinctive mark that are likely to cause dilution of that mark, defined as “association arising from the

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<sup>72</sup> See, e.g., *Le Blume Import Co., Inc. v. Coty*, 293 F. 344, 351 (2d Cir. 1923) (distinguishing between claimed trademarks that describe the characteristics of the associated good and words that are “merely ‘suggestive’” of those characteristics); *Leonard v. White’s Golden Lubricator Co.*, 38 F. 922, 922 (C.C.S.D. Ohio 1889) (rejecting defendant’s argument that “Valvoline” was compound of “valve” and “oleine” (oil) and therefore descriptive, holding it to be fanciful); *O’Rourke v. Central City Soap Co.*, 26 F. 576, 578 (C.C.E.D. Mich. 1885) (holding that “anti-washboard” as applied to soap was not descriptive, “although the natural inference from [the term] is that by the use of the soap the necessity of rubbing clothes is obviated”). See also 2 MCCARTHY, *supra* note 23, at § 11:63 (stating that the “suggestive” category arose in cases interpreting the 1905 Federal Trademark Act as a way of “uphold[ing] the registration of marks that were only subtly ‘descriptive’”); *id.* § 11:12 (stating that courts “hardly ever” distinguish between “arbitrary” and “suggestive” marks, since neither requires proof of secondary meaning).

<sup>73</sup> See, e.g., *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1130 n.7 (9th Cir. 1998) (noting that with both fanciful and arbitrary marks, “the trademark holder must work hard to make consumers associate the trademark with the product. This suggests that any association is the result of goodwill and deserves broad protection from potential infringers.”); *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 197 (S.D.N.Y. 2000) (“Recognizing the larger commitment of both resourcefulness and resources that must be spent to procure market success with a given suggestive term, the law rewards the extra demands by conferring broader trademark protection upon this class than that granted to the merely descriptive term.”). Relatedly, one court has suggested that descriptive or suggestive marks are “better candidates for genericness” than fanciful trademarks. *Ty Inc. v. Perryman*, 306 F.3d 509, 513 (7th Cir. 2002).

similarity between a mark or trade name and a famous mark” that is likely either to impair the distinctiveness of the mark or to harm the reputation of the mark.<sup>74</sup> In essence, the anti-dilution statute allows mark holders to control the metaphors associated with the famous mark, whether those metaphors are distasteful or simply inconsistent with the mark holder’s preferred associations.<sup>75</sup> Despite the provision that the distinctiveness of the famous mark may be inherent or acquired,<sup>76</sup> one wonders whether courts are more likely to find dilution the higher the mark falls on the *Abercrombie* hierarchy;<sup>77</sup> if that is the case, anti-dilution doctrine would then tend to reinforce the notion that marks with stronger inherent metaphorical associations can be used only in ways approved by their creators.

This belief—that the only permissible types of metaphorical trademark uses are the ones associated with the trademark by its holder—does not, however, reflect the way in which consumers use marks as parts of language. In particular, consumers, writers, and others are often told that extending the metaphor associated with a trademark to other, related concepts is an improper use of the mark and, in some cases, risks adverse legal action.<sup>78</sup> And yet, reasonable speakers not only engage in such metaphorical wordplay often, but can do so without losing sight of the mark’s original naming function.<sup>79</sup> This is true not only

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<sup>74</sup> 15 U.S.C. §§ 1125(c)(2)(B), (C) (2006).

<sup>75</sup> Heymann, *supra* note 24, at 218–19 (“The brand owner, in [anti-dilution cases], is claiming a right to the exclusive mental association with the brand in the minds of the public.”); Sara Stadler Nelson, *The Wages of Ubiquity in Trademark Law*, 88 IOWA L. REV. 731, 735 (2003) (arguing that trademark owners who make similarly dilutive uses of their marks should forego entitlement to a remedy under anti-dilution law).

<sup>76</sup> 15 U.S.C. § 1125(c)(1).

<sup>77</sup> See, e.g., *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, No. 91166701, 2010 TTAB LEXIS 225, at \*63 (T.T.A.B. June 11, 2010) (“Even though inherent distinctiveness is not required, the statute is weighted toward a finding of dilution when the famous mark in question is commercially-strong and inherently distinctive.” (citing *Perfumbay.com Inc. v. eBay Inc.*, 506 F.3d 1165 (9th Cir. 2007))). The statute provides that “[t]he degree of inherent or acquired distinctiveness of the famous mark” can be considered by the court in determining whether the defendant’s mark is likely to cause dilution of the plaintiff’s mark by blurring. 15 U.S.C. § 1125(c)(2)(B)(ii).

<sup>78</sup> See NAOMI KLEIN, *NO LOGO: TAKING AIM AT THE BRAND BULLIES* 177 (1999) (“[W]hen we try to communicate with each other by using the language of brands and logos, we run the very real risk of getting sued.”); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 975 (1993).

<sup>79</sup> See, e.g., *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1132 (9th Cir. 1998) (“If you received junk e-mail, you were Spammed. The childish antics of politicians are Mickey Mouse. Lousy, mindless work is a McJob. A quick fix is a Band-Aid. Glitz and ditz make for a Barbie World. Calling something the Rolls Royce of its class is shorthand for referring to a refined product targeted at those with expensive tastes. And maudlin family gatherings make for Kodak moments. None of these

of well-documented uses such as “putting a Band-Aid on the situation” or calling something the “Cadillac of its class” but also of more playful, consumer-driven metaphorical uses. For example, the “Mc-” formative of McDonald’s has become a generative metaphor,<sup>80</sup> spawning not only references to a “McJob” or a “McMansion,” the former of which was added to *Merriam-Webster’s Dictionary* in 2003,<sup>81</sup> but consumer-created brand extensions, such as the “Mc10:35,” a combination of a double hamburger and an Egg McMuffin, so named because 10:35 a.m. is the most likely time to be able to order both a breakfast item and a lunch item at a McDonald’s restaurant.<sup>82</sup>

Trademark holders often bristle at these uses, sending cease-and-desist letters or making other entreaties to try to curb such neologisms.<sup>83</sup> The argument, apparently, is that the extension of the metaphor from corporate-created associations to consumer-created associations causes a weakening of the brand, such that the original metaphor no longer persists—that, for example, the prevalence of “McMansion” means that “McDonald’s” will cease to refer to the fast-food restaurant chain.<sup>84</sup> But there is no reason to think that this will be the case. Many users of the term will be well aware that the meaning of “McMansion” derives from the extension of the metaphors associated with the McDonald’s trademark (mass-production and uniform design) to single-family-home architecture. Such consumers will understand that a newspaper’s

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phrases had any meaning before the trademark was absorbed into the language; each is evidence of how commerce and culture transform each other.”); *see also* *Lucasfilm, Ltd. v. High Frontier*, 622 F. Supp. 931, 935 (D.D.C. 1985) (“The new meaning of the phrase in the political or scientific context does not affect the distinct, and still strong secondary meaning of STAR WARS in trade and entertainment.”) (rejecting attempt to enjoin use of “Star Wars” as a popular name for Ronald Reagan’s strategic defense initiative); Gerhardt, *supra* note 49, at 487 (arguing for a “cultural dilution” exception for such uses).

<sup>80</sup> PINKER, *supra* note 59, at 240 (describing generative metaphors).

<sup>81</sup> Rupert Cornwell, *Dictionary Definition of ‘McJob’ Is Slap in Face, Says Angry Burger Boss*, THE INDEPENDENT (U.K.), Nov. 10, 2003, <http://www.independent.co.uk/news/world/americas/dictionary-definition-of-mcjob-is-slap-in-face-says-angry-burger-boss-735176.html>.

<sup>82</sup> Phil Villarreal, *Check Out the Secret McMenu Item That’s Sweeping SF, the Mc10:35*, THE CONSUMERIST (Mar. 5, 2010, 8:46 AM), <http://consumerist.com/2010/03/check-out-the-secret-mcmenu-item-thats-sweeping-sf-the-mc1035.html>. *See also* SHUY, *supra* note 17, at 102–03 (asserting that media uses of “Mc” (as in “McJob”) involve metaphorical meanings).

<sup>83</sup> *See, e.g.*, Cornwell, *supra* note 81 (describing the opposition of McDonald’s to dictionary entry).

<sup>84</sup> *See* SHUY, *supra* note 17, at 103 (contending that such uses indicate that the prefix has “come [to] develop its own meaning” and has “broken loose from association with McDonald’s”). Of course, this example does not follow directly from the *Abercrombie* hierarchy’s influence, since “McDonald’s” is not an invented word. But, I contend, the proprietization of trademarks that is embedded in *Abercrombie*’s language leads naturally to a view of trademarks and their associations as inviolate. What is characterized as a fear of genericness, therefore, may really be a resistance to undesirable associations.



reference to “McMansions” is extending the underlying metaphor in a playful manner and not describing a new offering from the restaurant chain. And even if other users do not make the connection, this does not mean that such users are likely to consider “McDonald’s” generic for hamburger restaurants.<sup>85</sup> To be sure, extensions that use the metaphor in a way that causes consumers to think that McDonald’s is responsible for the good or service at issue constitute infringement.<sup>86</sup> But the use of the metaphorical association in other, expressive contexts would not have meaning for many if the metaphor were not robust.

In sum, courts should be aware of the atmospheric effects that the *Abercrombie* spectrum of distinctiveness can have. By encouraging trademark holders and others to think of trademarks in terms of degrees of strength, rather than in terms of metaphor, the hierarchy suggests that the more metaphorical a mark is or has become, the less it becomes available for additional metaphorical use. This is not to say that judges can no longer rely on their intuition about the metaphorical function of a mark; such a function may be assumed from the type of mark at issue or its context, such that survey or other evidence is not required.<sup>87</sup> It is to say, rather, that how the concept of trademark validity is framed is important. Thinking of certain marks as better or stronger than others suggests a concomitant expansion of dominion over those trademarks that can carry over to the noncommercial context. This mindset then encourages trademark holders to promulgate additional rules in an attempt to further control how those marks are used. As I now describe, however, perfectly reasonable communication about trademarks can take place in violation of these rules, without any indication that consumers have lost sight of the status of the trademarks at issue.

### *B. Rule #2: Trademarks Should Not Appear in Lowercase*

Wordplay is an important part of one’s ability to communicate in a language. To be conversant in parody, puns, and other literary tropes is to fully participate in popular culture. Even more mundane communications require a certain agility in comprehension—for example, to continue the discussion on metaphor, a reasonable speaker of English would feel comfortable saying that something was “water

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<sup>85</sup> Likewise, the fact that a famous individual may lend his or her name to a metaphorical use does not prevent that name from continuing to identify the individual, even if some speakers are unaware of the derivation. See *infra* notes 92–94 and accompanying text.

<sup>86</sup> See, e.g., *McDonald’s Corp. v. Druck & Gerner, DDS., P.C.*, 814 F. Supp. 1127, 1135 (N.D.N.Y. 1993) (enjoining use of “McDental” for dental practice).

<sup>87</sup> Cf. Dinwoodie, *supra* note 13, at 143 (noting that many of trademark law’s rules “have been induced over time from the reasoned outcomes in individual cases, where the outcome to some extent has been informed by how language *has* been used and understood in the marketplace”). On the relevance of administrative costs to such decision making, see generally Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004).

under the bridge” without worrying that her listener would think she was engaging in a discussion about civil engineering. Slang, in particular, is organically formed, taking on meaning through shared understanding. The first person to use “cool” to mean “well-regarded” (as in, “That new song is really cool”) may have been met with blank stares;<sup>88</sup> today, no one either questions this use of the word in context or finds herself without a word to describe the temperature that is the opposite of warm. Context is the key to understanding which meaning of “cool” is intended.

Indeed, as linguists have recounted, most of the words we use in the English language are polysemic—that is, they are associated with several (related) meanings.<sup>89</sup> Thus, it is rather pointless to ask what a word means because the answer depends on the context in which the word is used and the community within which one is speaking and listening.<sup>90</sup> This fact does not, of course, render a word incapable of carrying meaning; indeed, a single word can be associated with two facially contradictory meanings without losing its legitimacy as a word in the English language. Consider, for example, the word “dust,” which can mean both to put a powder on something (“to dust a cake with powdered sugar”) and to remove a powder from something (“to dust the bookshelves”), or the word “trim,” which can mean both to remove something (“to trim one’s hair”) and to add something (“to trim a Christmas tree”).<sup>91</sup>

The same phenomenon exists once one moves into naming practices, even though here one of the links is to an association rather than to a meaning. Although capitalization will often distinguish a proper name from a common usage, this is not always the case, particularly in oral communication. Yet, speakers typically have few problems negotiating the various associations attached to a single lexical unit. One can say of another that he has a Napoleon complex without losing sight of the fact that “Napoleon” also refers to a historical figure;<sup>92</sup> the nonalcoholic cocktail made with ginger ale and grenadine and often enjoyed by children is a Shirley Temple, as is the child film star and later

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<sup>88</sup> For a discussion of the etymology of this meaning, see Ben Zimmer, *Cool*, N.Y. TIMES, May 30, 2010, § E (Magazine).

<sup>89</sup> Polysemy, in which a word’s multiple meanings are related, is often distinguished from homonymy, in which a word’s multiple meanings are unrelated, although the line can be difficult to draw. ALLAN, *supra* note 27, at 147–48. However denominated, the discussion is not completely distinct from the discussion of metaphor above.

<sup>90</sup> CRYSTAL, *supra* note 33, at 191 (“The word *charge* could be something to do with money, crime, soldiering, electricity, or explosives—to take just five possibilities.”); Geoffrey Nunberg, *The Non-Uniqueness of Semantic Solutions: Polysemy*, 3 LINGUISTICS & PHIL. 143, 175–76 (1979) (suggesting that language is a matter of collective agreement).

<sup>91</sup> See, e.g., Clark & Clark, *supra* note 36, at 793.

<sup>92</sup> See LANDAU, *supra* note 38, at 212 (describing how such words, which develop “one or more senses distinct from any necessary relation with the person after whom the word was formed,” will usually have a separate definition in a dictionary).

U.S. representative to the United Nations and ambassador to Ghana for whom the drink was named.<sup>93</sup> In neither of these instances does the use in one area require relinquishing the reference in another area; indeed, it is likely that at least some users of these terms are unaware of the individuals from whom the term was derived.<sup>94</sup> Linguistic theory advises us that these types of uses do not involve, technically, the same word—rather, they involve, like other names, separate units occupying the same lexical space.<sup>95</sup> This is true even when the same lexical unit appears both in capitalized form (to indicate a proper name) and in lowercase form (to indicate a common noun). The concept of “faith,” for example, may be spelled in the same way as the name “Faith,” but that doesn’t make the two the same “word”—one is a common noun that can be defined as “trust in something without proof,” and one is a reference to a female individual, with no definition beyond its reference. The exhortation “I have faith, and that’s all I need” means one thing when uttered by a congregant; “I have Faith, and that’s all I need” means something different when uttered by Faith’s partner. The existence of the common noun does not, in and of itself, weaken the ability of the proper noun to serve as a name, nor is qualification of the proper noun typically necessary to clarify its meaning.<sup>96</sup>

The concept of polysemy is already inherent in trademark law in at least two respects. First, trademark law accommodates the practice of allowing a lexical unit to serve as the name for two different kinds of products at the same time, such as “Delta” for airlines and “Delta” for faucets. Such marks are allowed to be used by different producers for distinct products or services because they operate in different markets

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<sup>93</sup> EUGENE EHRLICH, WHAT’S IN A NAME?: HOW PROPER NAMES BECAME EVERYDAY WORDS 204 (1999). A Roy Rogers, named after the television cowboy, is a similar nonalcoholic drink typically served to children. *Id.*

<sup>94</sup> Such terms sometimes undergo a period of transition, during which knowledge of the original naming association is essential to understanding meaning. *See, e.g.*, Clark & Clark, *supra* note 36, at 784 (explaining how the use of Houdini in sentences such as “My sister Houdini’d her way out of the locked closet” depends “not merely on one’s knowledge of English, but also on one’s knowledge of particular facts about Houdini the historical figure”).

<sup>95</sup> *Cf.* Pullum, *supra* note 25 (“Jack Daniel’s is a product (a bourbon), and not a trademark; *Jack Daniel’s* is a trademark—you can’t serve it on the rocks.”).

<sup>96</sup> The language of some courts has reflected a misunderstanding of this distinction in trademark cases. *See, e.g.*, Sullivan v. CBS Corp., No. 00 C 5060, 2002 U.S. Dist. LEXIS 6625, at \*15–16 (N.D. Ill. Apr. 8, 2002), *aff’d*, 385 F.3d 772 (7th Cir. 2004) (stating, in a case involving “Survivor” the television show and “Survivor” the rock band, that “[i]n fact, the word ‘survivor’ is a commonly used noun that appears in a standard dictionary in lower case. As such, it could be deemed generic and thus unworthy of any trademark protection.” (dictum)); Tsiolis v. Interscope Records, Inc., 946 F. Supp. 1344, 1352 (N.D. Ill. 1996) (holding, despite federal registration for “Aftermath” as the name of a heavy metal band, that the word “aftermath” was “a term undeserving of trademark protection” because “the noun ‘aftermath’ appears entirely in lower-case letters” in two dictionaries and had no secondary meaning relating to band).

and so are unlikely to give rise to confusion among consumers.<sup>97</sup> Notwithstanding this characteristic, it is likely that consumers will at some point encounter such marks without any accompanying generic word (“I’m flying Delta to my brother’s wedding”). Trademark law thus assumes that consumers have the agility to provide the appropriate association given context; the fact that the same word, absent context, could have more than one association does not deprive the word of trademark status.<sup>98</sup> More perniciously, perhaps, trademarks have been adopted as drug slang, with “Lucky Charms,” “M&M’S,” and “Kleenex” all used as words for ecstasy.<sup>99</sup> One does not anticipate, however, that consumers of such products are unable to buy cereal, chocolate, and facial tissues when they go to the supermarket; the only confusion may be among law enforcement officers who are not conversant in the relevant language.

Second, as discussed earlier, trademark protection is not limited to invented words. Trademark law provides that a lexical unit can serve both as the name of a product or service and as a common word with a non-trademark meaning,<sup>100</sup> such as “Apple” for consumer electronics and “apple” for a piece of fruit, and reasonable consumers recognize that these multiple references can share the same lexical space without rendering any reference nugatory. As with other types of words, context—a stylized font or the sentence structure of advertising copy, for example—allows the consumer to select from among various linguistic options. Trademark law incorporates this concept most directly with respect to so-called descriptive marks—marks that are co-existent with words that can describe a quality or characteristic of the property. Once such marks develop “secondary meaning,” an association that signifies the word as a trademark, the lexical unit now serves two functions: one as the common word, which any manufacturer should be free to use to describe its product,<sup>101</sup> and one as the trademark. But the same phenomenon takes place with any trademark that isn’t an invented word. The use of “Camel” for cigarettes similarly creates two lexical units sharing the same word space: one that functions as the proper name for a

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<sup>97</sup> See, e.g., *Dawn Donut Co., Inc. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 364 (2d Cir. 1959).

<sup>98</sup> See, e.g., Durant, *supra* note 15, at 109; Heymann, *supra* note 24, at 220; Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 529–30 (2008).

<sup>99</sup> MICHAEL ADAMS, SLANG: THE PEOPLE’S POETRY 39 (2009) (noting the “clever placement of ecstasy’s first syllable as the final syllable of *Kleenex*, where no one expects a drug reference”).

<sup>100</sup> Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 973 (1990) (noting that “ownership of a trademark gives rise to what is, in essence, a homonym”).

<sup>101</sup> See 15 U.S.C. § 1115(b)(4) (2006) (providing a defense to infringement to a party whose “use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin”).

particular type of cigarette and one that identifies a type of animal. Trademark law thus assumes that consumers will become comfortable with the fact that many, if not most, of the words claimed as trademarks will also be used in connection with other meanings and associations in other contexts, with capitalization sometimes, but not always, providing a key to interpretation.<sup>102</sup>

Yet despite these assumptions, trademark holders and some commentators assert that any time a word used as a trademark appears in lowercase type, consumers are unlikely to be able to engage in such interpretive efforts, such that the validity of the mark will be chipped away. This belief is rehearsed by scholars,<sup>103</sup> by associations such as the International Trademark Association, which promulgates media guides delineating the proper uses of trademarks,<sup>104</sup> and even by word processing programs such as Microsoft Word, which will autocorrect certain words that share a lexical unit with trademarks by replacing a lowercase letter with a capital, in something akin to a reverse Cupertino effect.<sup>105</sup> Whether a trademarked term appears in lowercase may not be irrelevant to determining whether speakers view the word as continuing to serve as the proper name of a product or service.<sup>106</sup> But context is critically important to distinguishing between lowercased uses that suggest that consumers no longer recognize the proper name as such and lowercased uses that do not so suggest. For example, as has been well-documented, in the southern portion of the United States, “Coke” is

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<sup>102</sup> Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent?: Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 149 (1996) (“If, indeed, symbols are routinely assigned multiple meanings, the law ought to start from the premise that audiences have a great deal of experience with confusing signals and that, absent a specific reason to believe otherwise, the interpretive strategies that a listener ordinarily pursues will also be used in the marketplace.”). A linguist might refer to the distinction conferred by capitalization as an example of prosody. See, e.g., 2 ALLAN, *supra* note 27, at 1–2.

<sup>103</sup> See, e.g., John Dwight Ingram, *The Genericide of Trademarks*, 2 BUFF. INTELL. PROP. L.J. 154, 160 (2004).

<sup>104</sup> INT’L TRADEMARK ASS’N, A GUIDE TO PROPER TRADEMARK USE FOR THE MEDIA AND PUBLISHING PROFESSIONALS (2009), [http://www.inta.org/downloads/documents/2009\\_TrademarkUse.pdf](http://www.inta.org/downloads/documents/2009_TrademarkUse.pdf).

<sup>105</sup> The term “Cupertino effect,” which refers to the occasion when a computer’s spell-checker automatically replaces an unknown word with an undesired word, originated from the substitution of the word “Cupertino” for the words “cooperation” or “cooperatation,” resulting in references such as “Cupertino agreements” in European Union documents. Elizabeth Anne Muller, *Cupertino and After*, LANGUAGE MATTERS, Sept. 2000, at 9, 10; Benjamin Zimmer, *The Cupertino Effect*, LANGUAGE LOG (Mar. 9, 2006, 4:21 PM), <http://itre.cis.upenn.edu/~myl/languageelog/archives/002911.html>.

<sup>106</sup> See, e.g., *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 171 (7th Cir. 1996) (“If the term ‘door systems’ appeared in a standard dictionary in lower case, this would be powerful evidence that the term was generic, because nouns and other nominatives listed in dictionaries, save for the occasional proper name, denote kinds rather than specific entities (‘dog,’ not ‘Fido’).”).

used to refer to the soft drink manufactured by the Coca-Cola Company, while “coke” is used to refer to any soft drink.<sup>107</sup> Thus, it would not be unusual for a restaurant patron to respond to the question “What kind of coke do you want?” with “I’d like a Coke coke, please.”<sup>108</sup> The use of the lowercased (by implication in aural speech) “coke” does not indicate that “Coke” no longer serves as a proper name; rather, it simply means that the lowercased form is used to refer to a category of similar items (“drinks that are like Coke”), just as “xerox” is often used to refer to a category of photocopiers, of which “Xerox” is one, and “tylenol” is used to refer to the drug with the formulaic name of acetaminophen, of which “Tylenol” is a particular brand name.<sup>109</sup> Indeed, it may well be the case that, in some instances, use of the lowercased form of the trademark involves fewer communication costs than the corresponding common noun. For example, some consumers searching for competitors to Tylenol may not be aware of the common noun “acetaminophen”; using “tylenol” to mean “pain relievers that are formulated like Tylenol” helps to ensure that such consumers get what they want without imposing the burden of learning pharmacological vocabulary.<sup>110</sup>

Courts that purport to take account of the reasonable consumer’s perceptions and beliefs should therefore recognize that the appearance of a trademark in lowercase type does not, of itself, indicate that the word no longer functions as a proper name in the appropriate context. More specifically, courts should be open to taking a nuanced approach, recognizing that speakers of a language often use the same lexical unit in association with more than one reference and rely on context to supply

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<sup>107</sup> Scott Leith, *In the South, a “Coke” Could Be a Pepsi: Pop, Anyone? Soda? Generic Term for Drinks Is Regional*, ATLANTA J. CONST., Jan 27, 2005, at 1E (describing study tracking regional variations in term used for soft drinks).

<sup>108</sup> Adams, *supra* note 49, at 7 (criticizing dictionary publisher for failing to recognize the difference between “Coke” as a trademark and “coke” as a southern regionalism for a soft drink).

<sup>109</sup> As Steven Pinker has highlighted, a small lexical difference can suggest a distinction between a particular item and a category of items. PINKER, *supra* note 59, at 165 (noting that in Google’s keyword buy program, plurals (such as “digital cameras”) cost more than singulars (“digital camera”) because the singular “is generic, and is likely to be typed by someone who wants to know how they work,” while a plural “is more likely to be referential, and typed by someone who wants to know about the kinds that are out there and how to get one”). See also, e.g., Desai & Rierson, *supra* note 47, at 1847 (noting that someone asking a colleague for a “kleenex” may not care what brand of tissue he is given, but someone buying tissue in the supermarket may want to buy Kleenex to the exclusion of other brands); Michael Grynberg, *Things Are Worse Than We Think: Trademark Defenses in a “Formalist” Age*, 24 BERKELEY TECH. L.J. 897, 920 (2009) (noting that a generic drug manufacturer’s use of “Tylenol” as a search engine keyword “may serve as the junior user’s signal that ‘I am in the same product category as TYLENOL,’ not ‘I am TYLENOL’”).

<sup>110</sup> Simonson, *supra* note 28, at 194 (“In many cases, buyers use trademarks as generic terms, not only casually and for convenience purposes, but because they apparently do not know other effective ways to communicate the type of product they seek.”).

any necessary clarification. A similar distinction was recognized by the court in the well-known 1921 case of *Bayer Co. v. United Drug Co.*,<sup>111</sup> in which the question was whether the term “aspirin” had become generic. Using an approach that would likely not find favor among courts today, the court deemed the term generic among consumers but a trademark (as “Aspirin”) with respect to manufacturing chemists, druggists, and physicians, noting that if trademark law could allow different uses of the same word among “vertical divisions of the demand,” the same “must apply to horizontal.”<sup>112</sup> While the remedy may have been unique, the underlying principle still holds: The ultimate question is what “buyers understand by the word for whose use the parties are contending.”<sup>113</sup> The use of a lowercase form does not, by itself, confirm that a trademark has become generic absent an indication that a capitalized use no longer refers to the trademarked good or service.

*C. Rule #3: A Trademark Must Always Be Used as an Adjective, Never as a Noun (Including Possessive or Plural Forms) or as a Verb*

Trademark owners and commentators will often suggest that a trademark must always be used as an adjective modifying a generic common noun, such as in the phrase “Ford car” or “Xerox photocopier.”<sup>114</sup> (It may be that the “trademarks must be adjectives” rule comes from the fact that words used as descriptive marks are typically

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<sup>111</sup> 272 F. 505 (D.N.Y. 1921).

<sup>112</sup> *Id.* at 514. *See also, e.g.,* *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 27 (D. Conn. 1962) (granting defendant the right to use “thermos” so long as it was preceded by “Aladdin’s” and reserving to plaintiff the right to use the capitalized “Thermos,” stating “[t]herefore, those consumers who desire to buy the trademarked products of the plaintiff can identify them by exactly the same trademarks that they have always seen”).

<sup>113</sup> *Bayer*, 272 F. at 509. *See also, e.g.,* *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 524 (E.D.N.Y. 1975) (“It cannot be thought unusual for a generic term describing the nature or class of an article . . . to be associated with its major indicator of source . . . but it does not necessarily follow that the public has lost sight of the distinction.”); GEOFFREY K. PULLUM, *Punctuation and Human Freedom*, in *THE GREAT ESKIMO VOCABULARY HOAX AND OTHER IRREVERENT ESSAYS ON THE STUDY OF LANGUAGE* 67, 73 (1991) (contending that “gratuitous capitalization destroys distinctions: consider the contrast between the words *Xerox* (the name of a corporation) and *xerox* (a verb that the Xerox Corporation has tried desperately to eliminate, and forbids its staff to use)”).

<sup>114</sup> *See, e.g.,* 1 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 2.02[6] (Karin Green ed., 2010) (providing practice tips to reduce risk of genericism, including using word marks as “a proper adjective that modifies a noun” and not using a trademark in the possessive, in the plural, or as a verb); Sidney A. Diamond, *How to Use a Trademark Properly*, 61 TRADEMARK REP. 431, 432, 438–39 (1971) (discussing rules for proper trademark use, including ensuring use as a “proper adjective” and avoiding “incorrect grammatical form[s],” plurals, and possessives); INT’L TRADEMARK ASS’N, *supra* note 104 (noting that “Please hand me a KLEENEX tissue” is correct, while “[It was] a five-KLEENEX movie” is incorrect).

adjectival,<sup>115</sup> but it is probably more accurate to characterize trademarks as proper names and, therefore, more like nouns.<sup>116</sup>) To use a trademark as a noun—as in, “I’m going to buy a Ford next week,” “My Ford’s interior is black,” or “There are three Fords in the parking lot” or as a verb—“Could you please xerox that document for me?”—is seen as evidence that the mark has lost its naming function and become generic. Courts, for their part, can be imprecise about the effect of such uses, suggesting that they are strong evidence that a proper name has lost its trademark function.<sup>117</sup>

But the literary device known as “anthimeria,” in which one part of speech is substituted for another, dates back at least as far as Shakespeare, as Arthur Quinn has noted: “Thank me no thankings, nor proud me no prouds,” from *Romeo and Juliet*, and “Every why hath a wherefore” from *Comedy of Errors* are but two examples.<sup>118</sup> As with

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<sup>115</sup> *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 404 (6th Cir. 2002) (stating that a “merely descriptive” mark is “very similar to an adjective” in that it “is often said to identify a characteristic of the thing”); *Royal Baking Powder Co. v. Sherrell*, 93 N.Y. 331, 334 (1883) (“Letters or figures which, by the custom of traders or the declaration of the manufacturers, are only used to denote quality, are incapable of exclusive appropriation, but are open to use by any one, like the adjectives of the language.”).

<sup>116</sup> *Cf. Folsom & Tepley*, *supra* note 28, at 1325 n.21 (1980) (“The disagreement over whether a trademark is a proper adjective or a proper noun reflects the possibility that a trademark can be used elliptically, omitting the generic term when it is obviously understood.”); *Pullum*, *supra* note 25 (contending that trademarks are used as “attributive modifiers,” not as adjectives).

<sup>117</sup> *See, e.g., FreecycleSunnyvale v. Freecycle Network, Inc.*, No. C 06-00324 CW, 2006 U.S. Dist. LEXIS 74767, at \*8–9 (N.D. Cal. Oct. 3, 2006) (holding that counterclaim that plaintiff had “willfully and intentionally induced third parties to infringe the Marks by encouraging others to misuse the Marks in the form of verbs, adjectives, gerunds, and participles . . . so that this misuse will result in the Marks being rendered generic” stated a cause of action for contributory infringement); *Birtcher Electro Med. Sys., Inc. v. Beacon Labs., Inc.*, 738 F. Supp. 417, 420 (D. Colo. 1990) (“[Defendant] showed numerous instances in which [Plaintiff’s] literature and videotaped advertising used the terms [at issue] as nouns as opposed to adjectives, indicating that the terms were generic labels for the product itself.”). Some courts that appear to be favorable to uses such as “I’ll have a Budweiser” err in describing this use as “generic,” albeit a usage that does not render the mark invalid. *See, e.g., Caesars World, Inc. v. Milanian*, 247 F. Supp. 2d 1171, 1194–95 (D. Nev. 2003) (“[O]ccasional generic usage does not destroy a trademark. Indeed, often the use of a trademark as a generic noun illustrates the power of a trademark. . . . [T]he consumer ordering ‘a hamburger and a Coke’ is demonstrating brand loyalty, not genericness.”), *aff’d*, Nos. 03-16063, 03-16685, 2005 U.S. App. LEXIS 1533 (9th Cir. Feb. 1, 2005). Some courts, however, indicate an understanding of the distinction. *See, e.g., Feathercombs, Inc. v. Solo Products Corp.*, 306 F.2d 251, 256 (2d Cir. 1962) (“A mark is not generic merely because it has some significance to the public as an indication of the nature or class of an article. If that were so, then Feathercombs’ frequent reference to its product as ‘the Feathercomb’ might well have caused it to lose exclusive right to the [mark].”).

<sup>118</sup> ARTHUR QUINN, *FIGURES OF SPEECH: 60 WAYS TO TURN A PHRASE* 50–51 (1982) (citing WILLIAM SHAKESPEARE, *ROMEO AND JULIET*, act 3, sc. 5, and WILLIAM



metaphors, anthimeria rely on their contraposition to an existing structure for the conveyance of meaning; hence, it would be illogical to assume that the structure is eviscerated simply because the device is employed.<sup>119</sup> Thus, the claim that the only correct use of a trademark is as an adjective modifying a generic noun rarely reflects how reasonable consumers tend to speak. Conversations about trademarks often include a form of anthimeria; for example, it is common for speakers to use a trademark in a noun form (such as “I’d like a Budweiser with my lunch, please”), with no indication that they fail to get the products they desire.<sup>120</sup> And once a trademark is used as a noun, it would not be surprising, from a linguist’s perspective, that possessive and plural uses would follow.<sup>121</sup> Indeed, at least one court has recognized its own tendency to use trademarks in this way. In *American Dairy Queen Corp. v. New Line Productions, Inc.*,<sup>122</sup> the plaintiff, who held a trademark in “Dairy Queen” for a chain of ice-cream restaurants, sought to enjoin the producers of a mock documentary—about beauty contests in rural Minnesota—who planned to call the film “Dairy Queens,” a wordplay on the dairy industry in that part of the country.<sup>123</sup> The plaintiff claimed that the use of “Dairy Queens” for the title of the film would “cause the public to associate its trademarked name with the unwholesome content of the film.”<sup>124</sup> In concluding that the plaintiff was likely to achieve success on

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SHAKESPEARE, COMEDY OF ERRORS, act 2, sc. 2). Linguists might call this device “conversion” or a “functional shift.” See, e.g., CRYSTAL, *supra* note 33, at 227 (providing “to referee” as an example of a noun-to-verb conversion).

<sup>119</sup> QUINN, *supra* note 118, at 52 (“The anthimeria, to be an anthimeria, needs a stable grammatical structure to rebel against. Only a theist can be a sinner.”).

<sup>120</sup> GILSON LALONDE, *supra* note 114, § 2.02[6] (noting that, for certain products, “manufacturers and consumers use the mark as a noun”); 1 MCCARTHY, *supra* note 23, § 12:27 (“The person who orders for lunch a ‘BIG MAC and a COKE’ undoubtedly has brand knowledge and brand loyalty. . . . Since everyone knows the generic names, they are dropped in ordinary usage.”); *id.* § 12:8 (noting that uses such as “[m]ake me a Xerox of this” are “casual, non-purchasing uses” that constitute “very weak evidence of generic usage”); Ronald R. Butters, *A Linguistic Look at Trademark Dilution*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 507, 514 (2008) (noting that consumers can recognize a mark as a brand name “even if consumers sometimes use the brand name figuratively or in shorthand (*i.e.*, synecdochical) reference to the type of goods or service that each brand represents”); Diamond, *supra* note 114, at 443–44 (acknowledging that consumers often use trademarks without an accompanying generic term). Of course, additional information can be provided to resolve any lingering interpretation issues, such as when a restaurant server responds to the request for a “coke” by saying, “We serve only Pepsi. Is that OK?”

<sup>121</sup> See, e.g., Pullum, *supra* note 25 (“[S]ince every regular noun has a genitive form, every trademark that has the form of a singular noun has a genitive form too: *My Porsche’s top speed is 130 mph* is not rationally regarded as a misuse of a trademark.”).

<sup>122</sup> 35 F. Supp. 2d 727 (D. Minn. 1998).

<sup>123</sup> The film did not reference the restaurants or ice cream in any way. *Id.* at 729. After losing the case, New Line released the film under the title “Drop Dead Gorgeous.”

<sup>124</sup> *Id.*

the merits (a questionable result), the court noted that the two marks were “identical—save and except the single letter ‘s’ which makes New Line’s term plural.”<sup>125</sup> The pluralization of the Dairy Queen mark, the court noted, was irrelevant, since “Dairy Queens” was likely to be understood as the equivalent of “Dairy Queen,” particularly in light of the court’s own experience in “taking its children for ‘Dairy Queens’ on a warm summer’s evening.”<sup>126</sup>

Indeed, in some cases, the way in which trademarks are rendered in plural form bolsters their status as proper names rather than as common nouns. Because trademarks are, like other names, “stretches of sound” as opposed to embodiments of the “canonical roots” of the words with which they share a lexical unit, their plural forms are often constructed differently from the way in which they would be formed if they were not proper names.<sup>127</sup> Thus, just as Julia Child and her husband, Paul, would be referred to jointly as the Childs, not the Children, the plural of “Mickey Mouse” is usually “Mickey Mouses,” not “Mickey Mice”; the plural of “Sony Walkman” is typically not “Sony Walkmen”; and the Toronto hockey team is the Maple Leafs, not the Maple Leaves.<sup>128</sup> In each case, the root that appears to be included within each mark (“mouse,” “man,” and “leaf”) in fact does not exist; the identical lexical unit serves, in the trademark, solely as a name and not as a common noun.

Reasonable speakers of English also regularly engage in the literary trope of metonymy, another type of noun use. Metonymy refers to the use of one name to refer to a larger entity, such as the use of “the White House” in the phrase “the White House issued a statement today” to refer to the U.S. government or “Wall Street” to refer to New York’s financial industry. (Some might refer to this particular type of metonymy as synecdoche, which is the use of a part of something to refer to the whole, such as the phrase “hungry mouths to feed.”) Trademarks are likewise used as a substitute for the corporation itself or one of its employees, such as the use of “Budweiser” as a substitute for “the beer made by the Anheuser-Busch company” (as in “I’d like a Budweiser, please”) or the use of “the *Times*” in the phrase “the *Times* hasn’t arrived at the press conference yet” to indicate a reference to “the reporter from the *Times*.”<sup>129</sup> Trademarks can also be used to refer to the owners of the

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<sup>125</sup> *Id.* at 730.

<sup>126</sup> *Id.*

<sup>127</sup> PINKER, *supra* note 35, at 153–56 (noting that onomatopoeia works in this way, such that the past tense of “beep” is “beeped,” not “bept”).

<sup>128</sup> *Id.* at 163 (noting that because “Walkman” doesn’t have the word “man” as its root, the plural is usually “Walkmans” rather than “Walkmen”); *id.* at 164 (explaining that the plural is typically “Mickey Mouses” because “Mickey Mouse” as an expression no longer involves reference to an animal).

<sup>129</sup> LAKOFF & JOHNSON, *supra* note 32, at 35. As Steven Pinker points out, polysemic associations can be combined in the same expression. PINKER, *supra* note 59, at 110 (giving as an example “The *Boston Globe* decided to change its size and

products with the marks or to the consumers who buy the products. At a service station, for example, the manager might tell a mechanic, “Go out and tell the blue Volkswagen that her car is ready,” while a restaurant server might tell a colleague, “The Dr. Pepper is sitting at table six.”<sup>130</sup> None of these uses follows the purported rules of trademark grammar—indeed, each expression on its face uses the mark to refer to something other than the trademarked good—and yet the trademark function of the term is unchanged.

Use of a trademark as a verb, such as “I’m going to xerox that document,” “Did you remember to tivo that television program?” or “I need to photoshop my wrinkles out of that photograph,” is equally common. In some cases, the verbs involve the use only of the trademarked good rather than a similar product in its class. “I’m going to google the answer to that” probably still involves the use of the Google search engine; one does not (yet) google any information on Yahoo! or “greyhound” to any city except on a Greyhound bus. In other cases, the trademark-as-verb may refer to an action accomplished not with the trademarked product but with another product in its class. Speakers use “xerox” to refer to making a copy of a document on any photocopier, whether a Xerox photocopier or not, and “photoshop” to refer to the act of digital photo editing generally, not just by using Adobe’s Photoshop software.<sup>131</sup> As linguists have noted, this conversion may be motivated by a conversational vacuum. In areas of new technology, speakers of a language reach for a verb form to convey the action they take when they make use of a new type of product. An innovative product, or the first of its kind, fills this gap—hence, the verb “to xerox” might have been

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typeface,” in which “*Boston Globe*” refers both to the company and to the physical newspaper it produces).

<sup>130</sup> Cf. PINKER, *supra* note 59, at 112.

<sup>131</sup> Indeed, courts have used the terms “xeroxed” or “Xeroxed” as a synonym for “photocopied” in a multitude of cases, including a handful of intellectual property cases. See, e.g., *Silverstein v. Penguin Putnam, Inc.*, 522 F. Supp. 2d 579, 597 (S.D.N.Y. 2007) (“To prepare the manuscript for *Complete Poems*, Ms. Breese cut and pasted or Xeroxed sheets directly from previous Parker compilations.”). One Eleventh Circuit opinion originally contained such a usage; the opinion was reissued with the term revised. *Compare St. Charles Mfg. Co. v. Mercer*, 719 F.2d 380, 381 (11th Cir. 1983) (case involving “St. Charles” trademark for kitchen cabinets) (“By this time, the majority of brochures (approximately 3000) had been distributed. Consequently, defendants made the corrections primarily on *xeroxed copies*.” (emphasis added)), *with St. Charles Mfg. Co. v. Mercer*, 737 F.2d 891, 892 (11th Cir. 1983) (“By this time, the majority of brochures (approximately 3000) had been distributed. Consequently, defendants made the corrections primarily on *photocopies*.” (emphasis added)). Similarly, “photoshopped” appears in more than one opinion. See, e.g., *Furminator, Inc. v. Kim Laube & Co., Inc.*, No. 4:08CV00367 ERW, 2009 U.S. Dist. LEXIS 118930, at \*9 n.1 (E.D. Mo. Dec. 21, 2009) (describing a photograph that had been “photoshopped” to include a false date in an attempt to create prior art in a patent case).

needed when the technology was fairly new, whereas no such verb “to pepsi” was needed to refer to consuming a cola beverage.<sup>132</sup>

Trademark holders may claim that such uses dilute the distinctiveness of the mark—that to use “xerox” to refer to the act of photocopying generally, for example, will cause “Xerox” to cease to function as a trademark. But context and form make all the difference. Just as the words “Apple” and “apple” can occupy the same lexical space but denote different referents, the fact that consumers “tivo” a television program doesn’t necessarily mean that consumers no longer recognize “TiVo” as a trademark. *Webster’s Third New International Dictionary*, for example, defines “linotype” in a way that explicitly recognize polysemic uses: as meaning “to operate a Linotype machine” or “to set by means of a Linotype machine.”<sup>133</sup> Indeed, the top-of-mind use of a trademark in its verb form, far from indicating the mark’s generic status, may well indicate the enduring fame of the brand.<sup>134</sup>

This is not to say, of course, that a trademark can never become generic; such a fate has befallen several former marks.<sup>135</sup> But given what we know about how consumers use marks in conversation, it seems overly simplistic to guide the genericism inquiry by reference to formalistic criteria. The reasonable consumer treats trademarks as a part of language,<sup>136</sup> creating new word forms where those forms enhance

<sup>132</sup> 1 ALLAN, *supra* note 27, at 243. Writers on linguistic issues, too, can be in disagreement about the breadth of such principles. *Compare, e.g.*, SHUY, *supra* note 17, at 50–51 (stating that “[o]ne of the signs of the generic nature of an expression is its ability to flexibly move across grammatical categories”), and Butters, *supra* note 120, at 513 n.19 (suggesting that the use of a mark as a verb “would appear to be far more robust linguistic evidence that the user does not think of the term as a brand name”), with Ben Yagoda, *Parts of Speech*, N.Y. TIMES, July 9, 2006, § E (Magazine), at E22 (“Not only is ‘I googled that hottie’ great publicity for the company, but it’s fresh and funny and an excellent example of how anthimeria gives English an invigorating slap upside the head.”). As Ben Zimmer has noted, the first known appearance of the verb “google” is by one of Google’s cofounders, who used the term “googling” in a listserv posting in 1998. Ben Zimmer, *Googling vs. Bing-ing*, VISUAL THESAURUS (Jan. 22, 2010), <http://www.visualthesaurus.com/cm/wordroutes/2147>.

<sup>133</sup> MORTON, *supra* note 24, at 222 (discussing entry). A lexicographer might therefore deem “linotype” to be generic while characterizing “Linotype” as a trademark.

<sup>134</sup> Oded Shenkar & Ephraim Yuchtman-Yaar, *Reputation, Image, Prestige, and Goodwill: An Interdisciplinary Approach to Organizational Standing*, 50 HUM. REL. 1361, 1364–65 (1997) (suggesting that the use of “Xerox” and “Federal Express” as verbs indicates “[t]he highest degree of familiarity” or reputation).

<sup>135</sup> *Ty Inc. v. Perryman*, 306 F.3d 509, 513 (7th Cir. 2002) (giving thermos, yo-yo, escalator, cellophane, and brassiere as examples).

<sup>136</sup> *See, e.g.*, *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1180 (9th Cir. 2010) (“Although trademark holders gain something by pushing their trademark into the lexicon, they also inevitably lose a measure of control over their mark.”); Fritinancy: Verb My Noun, [http://nancyfriedman.typepad.com/away\\_with\\_words/2006/07/verb\\_my\\_noun-1.html](http://nancyfriedman.typepad.com/away_with_words/2006/07/verb_my_noun-1.html) (July 14, 2006) (“Companies spend millions turning their brands into household words—words that take on vigorous independent lives, stretch their muscles, and through the magic of anthimeria become active parts of

communication and relying on context and cooperation when necessary to clarify matters. In many cases, that context will reflect the continuing vitality of the trademark. Assessing such evidence by whether consumer discourse complies with certain rules, by contrast, is likely to lead to a misguided result.

#### IV. CONCLUSION

Incorporating a greater awareness of how the reasonable person talks about trademarks does not mean resorting to a linguistic free-for-all. Trademark owners must, of course, be sensitive to uses by third parties that indicate that their mark is losing its status as the proper name of a brand of good or service and instead is becoming generic, such as the use of the mark by a competitor for its own branded good or service. But courts, in providing guidance to trademark owners, should be equally sensitive to language formation and adoption. Greater attention to this process does not necessarily require additional evidence; rather, it may simply require a more nuanced and linguistically informed interpretation of the existing evidence.

Trademark holders may well continue to exhort consumers to talk about trademarks only in the authorized way—whether through advertising, entreaties to dictionary editors, or cease-and-desist letters—but such efforts are unlikely to result in an organic change in consumer practices. Consumers are likely to resist uses such as “Frosted Flakes brand cereal” or “Xerox brand photocopier” in typical conversations for several reasons, not least of which is that such formations violate the Gricean maxim of Quantity.<sup>137</sup> In other words, if consumers are communicating satisfactorily with their existing speech patterns, it is difficult to see why they would be inspired to make things more complicated, save for fear of liability. Indeed, as linguist Geoffrey Nunberg has noted, trademarks are part of a universal naming system that can be remarkably robust even when they are used by speakers employing dramatically different language variations:

You may not know how to say “soft drink” or “athletic shoe” in Italian, but nowadays you can always get by in Rome by asking for a Coca-Cola or Nikes. From an international point of view, those are the real common nouns now. We’re all drawn together under the

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speech—and then spend millions more to keep us from using the words in our households.”). Cf. Lunsford Jr., *supra* note 49, at 330 (“[T]rademarks are not parts of speech because they are not properly a part of the language.” (quoting 1947 letter from Edward S. Rogers to G. & C. Merriam Co.)).

<sup>137</sup> GRICE, *supra* note 36, at 26–27 (characterizing the maxim of Quantity as encompassing two submaxims: “Make your contribution as informative as is required (for the current purposes of the exchange)” and “Do not make your contribution more informative than is required”). See also LYNCH, *supra* note 34, at 227 (noting that speakers of a language don’t stop using a word just because a dictionary indicates that the use is substandard).

international lingua branda, with only our separate verbs to keep us apart.<sup>138</sup>

Courts would therefore do well to stop encouraging trademark holders to “police their marks” through such third-party efforts and to focus instead on brand-recognition advertising and enforcement actions against competitors.<sup>139</sup>

To be sure, adopting a linguistically descriptive view of trademark validity is only the first step. Recognizing that the use of “xerox” as a verb does not necessarily mean that “Xerox” has ceased to be a trademark stops courts from plunging ahead to a finding of generic status, but it does not tell judges when the tipping point has been reached or whose usage courts should consider in order to determine when generic status exists. Those inquiries are, at root, the same as they ever were: Do consumers understand the word in question to be the proper name of a brand of product or service or the common name of a product or service? The answer to this question should continue to be descriptive in nature but should also be properly focused. If courts are to rely on presumptions about how the reasonable consumer communicates, they should at least consider the information that linguists already know in this regard. The reasonable consumer is not a slave to structure; she can use language, including trademarks, in diverse and playful ways without losing sight of her starting point. Modern linguistics theory recognizes that effective communication can take place even absent prescriptive rules of grammar. Trademark law, which aims to promote effective communication in the commercial realm, should take better account of this insight.

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<sup>138</sup> GEOFFREY NUNBERG, *Branding the Phonetosphere*, in *THE YEARS OF TALKING DANGEROUSLY* 189, 192 (2009).

<sup>139</sup> Folsom & Teply, *supra* note 28, at 1354 (contending that efforts to police trademarks are economically inefficient because “such measures normally do not stimulate demand for a firm’s product”); Higgins, *supra* note 24, at 389 (“While we cannot say with certainty that the Coca-Cola Company, for instance, intended merely to regain its increasingly generic trademark when it marketed its ‘New Coke’ product, its campaign certainly did have that effect.”).