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# A LINGUISTIC JUSTIFICATION FOR PROTECTING “GENERIC” TRADEMARKS

Jake Linford<sup>†</sup>

17 YALE J.L. & TECH. 110 (2015)

## ABSTRACT

*A trademark is created when a new meaning is added to an existing word or when a new word is invented in order to identify the source of a product. This Article contends that trademark law fails in critical ways to reflect our knowledge of how words gain or lose meaning over time and how new meanings become part of the public lexicon, a phenomenon commonly referred to as semantic shift. Although trademark law traditionally turns on protecting consumers from confusing ambiguity, some of its doctrines ignore consumer perception in whole or in part. In particular, the doctrine of trademark incapacity—also known as the de facto secondary meaning doctrine—denies trademark protection to a term that was once a generic product designation, even if consumers now see the term primarily as a source-signifying trademark.*

*Analyzing trademark acquisition through the lens of semantic shift sheds light on how the trademark incapacity doctrine misunderstands both the nature of language and the role of consumer perception in shaping trademark’s competition policy. Courts and scholars suggest that a generic term will rarely acquire source significance, and that even if it does, there are competitive, conceptual, and administrative grounds for denying trademark protection. The standard account is*

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*mistaken: restriction of meaning—of which the change from a generic product designation to a source signifier is one example—happens frequently across time and across languages. In addition, understanding how and why restriction occurs highlights flaws in common justifications for trademark incapacity. This Article proposes replacing the doctrine of trademark incapacity with the primary significance test already applied at other stages of trademark litigation. If there is evidence that a majority of consumers have come to see the term as source-signifying rather than product designating, the law should recognize that source significance and the term should qualify for federal trademark protection.*

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## INTRODUCTION

A term that designates a singular source for goods and services, rather than the goods or services themselves, qualifies for protection as a trademark. Trademark law thus turns in large part on when a word or symbol acquires and loses source-signifying meaning in the eyes of consumers. While

linguistics—the study of symbols and their meanings—has made limited inroads in the analysis of trademark law and policy,<sup>1</sup> the existing scholarship has yet to mine a cornerstone concept in linguistics: semantic shift.<sup>2</sup> The study of semantic shift in historical and cognitive semantic literatures is the study of how a given word changes over time—first by entering the public lexicon, and then by gaining or losing meanings.<sup>3</sup> These new words and meanings enter the lexicon as speakers search for new ways to express themselves. As Stephen Ullmann recognized half a century ago, “The need to find a new

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<sup>1</sup> See, e.g., 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) (arguing that while trademark law should not become beholden to linguistics, linguistic principles are embedded in trademark law, and linguistic theory can provide a means for uncovering “the inevitable prescriptive content of supposedly descriptive assessments of trademark claims”); 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: AN INTERDISCIPLINARY CRITIQUE 107, 132 (Lionel Bently et al. eds., 2008) (suggesting that pragmatics and discourse analysis, the branches of linguistics that investigate language in use, are most likely to contribute to our understanding of the important issues in trademark law); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 624 (2004) [hereinafter Beebe, *Semiotic*] (applying a branch of linguistics, semiotics, or the study of signs, to trademark law and arguing that the “grammar [of trademark law] must be understood not simply in economic, but also in linguistic terms”); Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1320-21 (2010) (arguing that incorporating linguistic theory on language formation can help trademark law better reflect consumers’ perceptions of language); Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1068-69 (2009) (applying psychological and brand perception literature to challenge Beebe’s semiotic analysis); Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007) (applying semiotic theory to argue for reforming the scandalous marks prohibition in trademark law); Timothy Greene, *Trademark Hybridity and Brand Protection*, 46 LOY. U. CHI. L.J. 75 (2014) (analyzing trademark dilution and genericness in light of psycholinguistics literature on semantic ambiguity resolution).

<sup>2</sup> Other scholars refer to these phenomena as semantic change, semantic progression or semantic drift. See, e.g., ELIZABETH CLOSS TRAUOGOTT & RICHARD B. DASHER, REGULARITY IN SEMANTIC CHANGE 1 (2002) (defining semantic change as a shift “from one linguistically coded meaning to another”).

<sup>3</sup> STEPHEN ULLMANN, SEMANTICS: AN INTRODUCTION TO THE SCIENCE OF MEANING 209-10 (1962) (“Whenever a new name is required to denote a new object or idea, we can do one of three things: form a new word from existing elements; borrow a term from a foreign language or some other source; lastly, alter the meaning of an old word.”).

name is . . . an extremely important cause of semantic changes.”<sup>4</sup>

Simply put, semantic shift is change in the meaning of a word. The process of creating trademark meaning shares many characteristics with other types of semantic shift. A trademark is a word, phrase, or symbol that identifies goods or services from a particular source.<sup>5</sup> When a word or symbol gains source-signifying meaning, it qualifies for protection as a trademark. Like other forms of semantic shift, investing a trademark with meaning adds a new entry to the commercial lexicon. For example, the Beatles plucked APPLE from among many pre-existing options as a trademark for their record label, while Steve Jobs and Steve Wozniak picked APPLE as a trademark for personal computers. At other times, a trademark is an entirely new entry into the lexicon. For instance, the word XEROX did not exist before it was coined as a designation for photocopiers. In both cases, language changes to accommodate new terms or new meanings for existing terms.

As a doctrinal matter, whether a given word obtains protection as a trademark turns in part on the relationship between the claimed mark and the word or words from which it is derived. That relationship is mapped out along a spectrum of inherent strength, most famously articulated in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>6</sup> The court in *Abercrombie* established that the strength of a mark’s claim to trademark protection depends on the likelihood that consumers will be able to invest the mark with source-signifying meaning, based on the distance between the mark chosen and the good it signifies. While scholars have criticized the *Abercrombie* spectrum as inaccurate or an unwelcome distraction from more crucial inquiries,<sup>7</sup> these categories generally reflect regular forms of semantic shift.<sup>8</sup>

However, the synchronicity between theories of semantic shift and the legal reality of trademark acquisition breaks down when we reach the treatment of “generic” trademarks—

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<sup>4</sup> *Id.* at 210.

<sup>5</sup> This article is limited to trademarks comprised of words and does not address whether these principles could also apply to trade dress or design marks.

<sup>6</sup> 537 F.2d 4 (2d Cir. 1976).

<sup>7</sup> For a summary of these arguments, see Jake Linford, *The False Dichotomy Between Suggestive and Descriptive and Suggestive Trademarks*, 76 OHIO ST. L.J. (forthcoming 2015), available at [http://papers.ssrn.com/abstract\\_id=2585114](http://papers.ssrn.com/abstract_id=2585114), [hereinafter Linford, *False Dichotomy*].

<sup>8</sup> See *infra* Part II.A.

words that identify, or have identified, a good or service—but subsequently acquire source-signifying meaning. Under the doctrine of “trademark incapacity,”<sup>9</sup> courts dismiss evidence that consumers perceive a term as source-signifying, cabining the evidence as an indication merely of de facto—i.e., legally insignificant—secondary meaning.<sup>10</sup>

For example, Microsoft Corporation sued Lindows.com, Inc. for trademark infringement, alleging that Lindows.com’s use of LINDOWS as a mark for a computer operating system infringed Microsoft’s prior rights in WINDOWS as a mark for its operating system.<sup>11</sup> In response, Lindows.com challenged the WINDOWS mark on genericness grounds.<sup>12</sup> When Microsoft adopted the WINDOWS mark in 1985, computer programmers and competitors were using “windows” as a noun to designate a graphical user interface (“GUI”) or its windowing capability.<sup>13</sup> Microsoft argued that the WINDOWS mark was no longer generic because the primary meaning of “windows” in the computing context had changed from designating GUIs to signifying Microsoft’s WINDOWS operating system. Microsoft provided consumer surveys in which “67% of the relevant consumer population identified ‘Windows’ as the ‘brand name of a product put out by one company.’”<sup>14</sup> But despite this evidence, the district court refused to give an instruction that would have allowed the jury to consider the change in trademark meaning.<sup>15</sup>

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<sup>9</sup> Louis Altman coined the phrase “trademark incapacity.” 3 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:33 (4th ed. 1983); *see also id.* §§ 18:17 n.56, 18:20 n.3, 23:37 n.47, 40:57. This process goes by other names, including the better-known but unwieldy “de facto secondary meaning doctrine.” This article primarily uses the term trademark incapacity.

<sup>10</sup> *Abercrombie*, 537 F.2d at 9 (describing a generic term as “one that refers, or has come to be understood as referring, to the genus of which the particular product is a species” and holding that proof of source significance in the eyes of consumers, “by virtue of which some ‘merely descriptive’ marks may be registered, cannot transform a generic term into a subject for trademark”).

<sup>11</sup> *Microsoft Corp. v. Lindows.com, Inc.*, 64 U.S.P.Q.2d 1397, 1398, 1400 (W.D. Wash. 2002) [hereinafter *Lindows I*]

<sup>12</sup> *Id.* at 1404-07.

<sup>13</sup> *Id.* at 1400; *Microsoft Corp. v. Lindows.com Inc.*, 66 U.S.P.Q.2d 1371, 1373-74 (W.D. Wash. 2002) [*Lindows II*].

<sup>14</sup> *Lindows I*, 64 U.S.P.Q.2d at 1407-1410.

<sup>15</sup> *Microsoft Corp. v. Lindows Com, Inc.*, 69 U.S.P.Q.2d 1863, 1864 (W.D. Wash. 2004) (refusing to instruct the jury that “the [WINDOWS] trademark would [ ] be valid today so long as the primary significance of the term today is not generic.”) [*Lindows III*]. The court of appeals refused to hear an interlocutory appeal on the issue. *Microsoft Corp. v. Lindows.com, Inc.*, No. 04-80024, 2004 WL 1208044 (9th Cir. May 19,

As a matter of black letter law, the court in *Lindows.com* properly rejected Microsoft’s requested jury instruction because under the doctrine of trademark incapacity, if the term chosen was once generic, any subsequent addition of trademark meaning is irrelevant. But the doctrine of trademark incapacity is inconsistent with one of the most standard types of semantic shift: *restriction*. When a word is restricted, it undergoes a shift in meaning from a broad designator for all members within a category to a prototypical member of the category.<sup>16</sup> For example, in Old English, *hound* or *hund* once meant any kind of dog, but the meaning was restricted over time to long-eared hunting dogs.<sup>17</sup> A generic term that acquires source significance is another manifestation of restriction in meaning. For instance, in the 1800s, *kiss* once identified any small sweetmeat or piece of confection,<sup>18</sup> but *kiss* or *kisses* now brings to mind a particular type of candy—the teardrop-shaped chocolates offered for sale by the Hershey Company.<sup>19</sup> While restriction happens frequently, the doctrine of trademark incapacity requires courts to ignore evidence that so-called generic terms have acquired source significance in the minds of consumers.

More broadly, the doctrine of trademark incapacity is also incongruous with trademark law’s ostensible focus on acknowledging consumer perception and protecting consumers from confusion. Trademark protection is typically justified on the ground that consumers use the trademark to distinguish between the goods and services of different vendors.<sup>20</sup> Thus, trademark law looks to the consumer as the target audience by which protection and infringement should be measured. Trademark incapacity turns away from evidence about

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2004) [*Lindows IV*]. Microsoft subsequently bought the LINDOWS mark for \$20 million. Kim Peterson, *Microsoft sues Lindows—then pays \$20 million*, SEATTLE TIMES, July 20, 2004, [http://old.seattletimes.com/html/business/technology/2001983512\\_lindows20.html](http://old.seattletimes.com/html/business/technology/2001983512_lindows20.html).

<sup>16</sup> DIRK GEERAERTS, THEORIES OF LEXICAL SEMANTICS 26-27 (2010) [hereinafter GEERAERTS, LEXICAL SEMANTICS].

<sup>17</sup> TERRY CROWLEY & CLAIRE BOWERN, AN INTRODUCTION TO HISTORICAL LINGUISTICS 200 (4th ed. 2010); Willem B. Hollmann, *Semantic Change, in ENGLISH LANGUAGE: DESCRIPTION, VARIATION AND CONTEXT* 525, 528 (Jonathan Culpeper et al. eds., 2009).

<sup>18</sup> *Kiss*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/103691> (last visited Nov. 7, 2014) (“Name for a small sweetmeat or piece of confectionery; a sugar-plum.”).

<sup>19</sup> See *infra* notes 58-61 and accompanying text.

<sup>20</sup> See *infra* notes 27-37 and accompanying text. The protection also provides an incentive for those vendors to maintain consistent quality because the vendor is allowed to internalize the value of the reputation or goodwill acquired in the trademark.

consumer perception if the court concludes a potential mark ever carried generic meaning.

Trademark incapacity might be justified if generic terms rarely acquired a critical mass of source significance. If that were so, we might prevent costly errors by ignoring the occasional case where a generic term undergoes restriction and its primary meaning narrows to source significance. But in fact, generic terms take on source signifying meaning quite often. Case law provides multiple examples where courts have ignored evidence that consumers perceive an ostensible generic product designation as a source-signifying trademark.<sup>21</sup> In addition, linguistic research suggests that restriction happens frequently—perhaps more frequently than any other form of semantic shift.<sup>22</sup> Unfortunately, courts and scholars mistakenly assume that the shift of a generic term to source-signifying meaning happens infrequently precisely because courts almost never grant trademark protection to former generic terms.<sup>23</sup> The error-cost rationale for trademark incapacity is thus circular. Indeed, ignoring restriction that occurs to generic terms—and the development of source significance in the eyes of consumers—may well increase error in trademark litigation.<sup>24</sup>

Scholars and courts have also defended trademark incapacity on normative grounds, identifying several interlaced justifications for the doctrine: concerns about granting mark owners monopoly power or causing language depletion; a general distrust of trademark-owning incumbents; and an application of the functionality doctrine due to a perception that generic terms are immutable like tangible product features. However, understanding how trademark acquisition reflects the broader phenomena of semantic shift provides an avenue for refuting those justifications.<sup>25</sup>

The Article proceeds in three Parts. Part I outlines trademark law's commitment to consumer search and consumer perception, before turning to the conflict between that ostensible commitment and the doctrine of trademark incapacity. Some scholars have offered critiques of trademark incapacity, recognizing the problem of ontological rejections of source significance without providing a theory for why it is important to acknowledge language change in the *ex ante*

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<sup>21</sup> See *infra* Part I.B.

<sup>22</sup> See *infra* Part II.B.

<sup>23</sup> See *infra* Part I.C

<sup>24</sup> See *infra* Part III.A.1.

<sup>25</sup> See *infra* Part III.A.2.



generic context as well as in other contexts. Part II provides such a theoretical basis, beginning with a brief discussion of the drivers of semantic shift before describing how trademark acquisition is a form of semantic shift. While trademark law reflects many regular forms of semantic shift, the doctrine of trademark incapacity drives a wedge between the law of trademark acquisition and the reality of semantic shift. The shift from generic term to source-signifying trademark is an example of restriction, one of the most frequently occurring forms of semantic shift and one that increases the information conveyed by the restricted form.<sup>26</sup> Part III makes the case for abandoning the doctrine of trademark incapacity in favor of the primary significance test already applied in cases where a protected mark loses trademark significance and slides into genericness as a product designation.

## I. CONSUMER PERCEPTION AND TRADEMARK INCAPACITY

As this Part explains, the goal of trademark law is to lower consumer search costs and prevent consumer confusion. The dominant justification for trademark law is thus tied to consumer perception. The doctrine of trademark incapacity, however, ignores evidence of consumer perception and instead disqualifies marks derived from generic terms due to their etymology. The ostensible rationales underlying the doctrine of trademark incapacity cannot justify the refusal to consider evidence of consumer perception.

### A. *Trademark Law, Consumer Perception, and Consumer Confusion*

The dominant rationale for trademark protection is reducing consumer search costs.<sup>27</sup> A trademark can serve as an

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<sup>26</sup> APRIL M.S. MCMAHON, UNDERSTANDING LANGUAGE CHANGE 178-79 (1994).

<sup>27</sup> Cf. Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1190 n.93 (2005) (“[I]f trademark law were to abandon consumer benefit as a foundation, there could simply be no plausible theoretical foundation for trademark regulation.”). While reducing consumer search costs is the dominant rationale, some scholars have provided an alternate justification for trademark protection. See, e.g., Barton Beebe, *Search and Persuasion in Trademark Law*, 103 MICH. L. REV. 2020, 2025 (2005) [hereinafter Beebe, *Search and Persuasion*] (proposing two varieties of consumer sophistication: search sophistication, the ability of consumers to distinguish between similar trademarks; and persuasion sophistication, their capacity to choose products independently of marketer influence); Margaret Chon, *Slow Logo: Brand Citizenship in Global Values Networks*, 47 U.C. DAVIS L. REV. 935 (2014) (reexamining trademark law through the heuristic of brand citizenship); Mark P.

indicator that products bearing the mark originate from a single seller.<sup>28</sup> Consumers can thus rely on the trademark to identify products they wish to buy, which reduces the cost of finding those products. While there are other accounts justifying trademark protection,<sup>29</sup> this Article will critique trademark incapacity from within the dominant account.

Questions of whether a trademark qualifies for protection and whether a trademark has been infringed are answered by assessing consumer perception of that mark.<sup>30</sup> Some trademarks are considered inherently capable of distinguishing the goods or services of one producer from those of others, and it is presumed that consumers see them as source-signifying. Other trademarks are seen as merely descriptive of some quality or feature of the product or service, and protection is extended only if the mark acquires a secondary, source-signifying meaning.<sup>31</sup> Distinguishing a term that is merely descriptive (and is thus unprotectable) from one that is inherently distinctive or has acquired secondary meaning (and is thus protectable) requires assessing whether consumers better understand a given term to describe a characteristic of a

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McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 821 (criticizing the failure of the consumer search cost theory to limit the expansion of trademark rights); Jeremy N. Sheff, *Biasing Brands*, 32 CARDOZO L. REV. 1245 (2011) (arguing that psychological and marketing research can manipulate consumer perception, weakening the consumer search account).

<sup>28</sup> See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987).

<sup>29</sup> See, e.g., Jake Linford, *Trademark Owner as Adverse Possessor: Productive Use and Property Acquisition*, 63 CASE W. RES. L. REV. 703 (2013) (describing how trademark law bases protection on productive use by the mark owner) [hereinafter Linford, *Adverse Possessor*]; Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841 (2007) (arguing that “trademark law, like all unfair competition law, sought to protect producers from illegitimate diversions of their trade by competitors”).

<sup>30</sup> See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 966 (Fed. Cir. 2007) (discussing the use of online resources to measure consumer perception); *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1395 (9th Cir. 1993) (“Consumer perceptions are relevant in determining whether a non-inherently distinctive mark has acquired secondary meaning and should therefore be treated as a strong mark.”) (internal citations omitted); *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 996 n.10 (7th Cir. 1989) (“[C]onsumer perception should be measured by considering the mark as applied to the product in question and the reaction of the consumer audience to which the trademark is directed in the marketplace.”) (internal citations omitted).

<sup>31</sup> See *infra* notes 121-144 and accompanying text.

product, or to signify the source of the product itself.<sup>32</sup> The perception of “the average potential consumer in the context of the existing marketplace and exposed to the information currently available in the marketplace” weighs heavily in assessing whether a mark merits protection, or whether confusion has occurred.<sup>33</sup>

Trademark law is likewise aimed at preventing or correcting “confusion among consumers regarding the origin of the goods [or services] offered” to the public.<sup>34</sup> Consumer confusion often occurs when a junior user adopts a mark identical or sufficiently similar to the mark of a senior user to identify the same or similar products or services.<sup>35</sup> That confusion can increase consumer search costs.<sup>36</sup> Trademark law thus bars not only the use of a mark identical to that of the senior user, but also the use of a mark that is confusingly similar to the senior user’s mark.<sup>37</sup>

While the dominant rationale for trademark protection is to prevent consumer confusion, there are aspects of trademark law that are surprisingly disconnected from consumer perception. This Article focuses on one such divergence: trademark law has developed a doctrine of “trademark incapacity,”<sup>38</sup> more commonly referred to as a principle of *de facto* secondary meaning.<sup>39</sup> If a court concludes that the mark was ever a generic term, any source-signifying meaning the

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<sup>32</sup> See, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 952 (7th Cir. 1992).

<sup>33</sup> *Heileman*, 873 F.2d at 995; see also Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1260 (2014).

<sup>34</sup> *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 551 (6th Cir. 2005); see also Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 722 (2004) (“Confusion among consumers is the grave iniquity against which trademark laws and jurisprudence are intended to guard.”).

<sup>35</sup> Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 482 (2005) (“An infringement of a trademark is one that increases consumer search costs, normally by confusing consumers.”).

<sup>36</sup> *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976) (“The trademark laws exist not to ‘protect’ trademarks, but, as above indicated, to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.”).

<sup>37</sup> *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1926).

<sup>38</sup> 3 CALLMANN, *supra* note 9, § 20:33 (coining the term “trademark incapacity”).

<sup>39</sup> See, e.g., Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 730 (1999) [hereinafter Dinwoodie, *Ontology*].

mark may have later acquired is dismissed as mere “de facto secondary meaning” bearing no legal significance.<sup>40</sup> The generic term can never acquire trademark protection, even if consumers have come to identify the mark with a specific brand or product. The next Section describes the doctrine of trademark incapacity in more detail, highlighting how that doctrine is disconnected from the consumer search and consumer perception justifications for trademark law.

### B. *Trademark Incapacity in the Case Law*

Under the doctrine of trademark incapacity,<sup>41</sup> a term that is generic ex ante for a genus of goods or services cannot be transformed into a trademark by the commercial behavior that typically provides a basis for acquiring secondary meaning.<sup>42</sup> As stated by the court in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,<sup>43</sup> generic terms, which “refe[r], or ha[ve] come to be understood as referring, to the genus of which the particular product is a species,” cannot acquire trademark protection.<sup>44</sup> The rationale for trademark incapacity is that “no matter how much money and effort the user of a generic term has poured

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<sup>40</sup> See, e.g., *Hunt Masters, Inc. v. Landry’s Seafood Restaurant, Inc.*, 240 F.3d 251, 254-255 (4th Cir. 2001) (holding that because *crab house* was obviously generic for a restaurant that served crab, “it [was] not necessary to determine whether the term [became] generic through common use, rendering Hunt’s customer survey irrelevant”); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 938 n.6 (7th Cir. 1986) (discounting study that indicated source significance of “liquid control” as not relevant to whether term is generic); *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979) (holding that because “light” for low-calorie beer was obviously generic, “proof” of secondary meaning “would not advance [plaintiff’s] trademark claim, because . . . if a word is generic it ‘can never become a trademark’”); *Lindows III*, 69 U.S.P.Q.2d at 1864, (instructing jury that a genericness inquiry should consider the time the claimant began using the mark, and refusing to instruct the jury that a trademark is valid if the mark was generic when the claimant entered the market but had subsequently acquired source significance); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:47 (describing how courts discount evidence of secondary meaning acquired in generic terms) (4th ed. 2015).

<sup>41</sup> See 3 CALLMANN, *supra* note 9, § 20:33.

<sup>42</sup> See, e.g., *In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 782 (T.T.A.B. 1981) (defining a generic term as one “so highly descriptive that no quantum of evidence of acquired distinctiveness is sufficient to qualify it for registration under Section 2(f)”; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. b (2007) (“[T]he public interest in maintaining access to generic terms precludes the recognition of trademark rights.”).

<sup>43</sup> 537 F.2d 4 (2d Cir. 1976) (creating a hierarchy of conceptual trademark strength based on the degree to which the mark directly describes the product or service).

<sup>44</sup> *Id.* at 9.

into promoting the sale of its merchandise, and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.”<sup>45</sup> Evidence that consumers perceive the term as a trademark is thus ignored or dismissed.<sup>46</sup>

This bar against a generic term acquiring distinctiveness is easiest to understand at the extreme. For example, in the absence of the trademark incapacity doctrine, a seller of computers might still find it difficult to secure COMPUTER as a mark for its goods. It is unlikely that the seller could persuade a critical mass of consumers that COMPUTER designates only the seller’s computers marketed by that particular producer. The difficulty of establishing such a shift in meaning suggests that a prophylactic rule like the trademark incapacity doctrine might have some use at the far edge of the *Abercrombie* spectrum.<sup>47</sup>

There are, however, many cases where semantic shift has been measured, source significance acquired, and evidence of consumer perception nevertheless ignored. For example, in *Harley-Davidson, Inc. v. Grottanelli*,<sup>48</sup> the court marshaled the ex ante bar in dismissing evidence that 98 percent of consumers viewed the term HOG as a source signifier for Harley-Davidson’s motorcycles, rather than as a generic designation for large motorcycles.<sup>49</sup> In another case, Hotels.com, L.P. applied to register HOTELS.COM as a service mark for its online hotel booking services.<sup>50</sup> Hotels.com presented evidence that 76 percent of survey respondents identified HOTELS.COM as a trademark instead of a common or generic name.<sup>51</sup> But the Trademark Trial and Appeal Board (“TTAB”) concluded that HOTELS.COM was generic because “hotels” was a generic designation for the provision of hotel booking services and the addition of “.com” was insufficient to permit trademark protection.<sup>52</sup> The TTAB thus refused to

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<sup>45</sup> *Id.*

<sup>46</sup> A.J. Canfield Co. v. Honickman, 808 F.2d 291, 304 (3d Cir. 1986) (“Underlying the genericness doctrine is the principle that some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might become identified with a source and so acquire ‘de facto’ secondary meaning.”).

<sup>47</sup> See *infra* Part III.A.1

<sup>48</sup> 164 F.3d 806 (2d Cir. 1999).

<sup>49</sup> Jerre B. Swann, *Genericism Rationalized*, 89 TRADEMARK REP. 639, 654 n.96 (1999) (citing the *Grottanelli* Appellate Record at A76).

<sup>50</sup> *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301 (Fed. Cir. 2009).

<sup>51</sup> *In re Hotels.com, L.P.*, 87 U.S.P.Q.2d 1100, 1110-12 (T.T.A.B. 2008).

<sup>52</sup> *Id.* at 1100-11. *But see In re Steelbuilding.com*, 415 F.3d 1293, 1296-97

credit the survey and affirmed the trademark examiner's decision to refuse registration. The TTAB noted, however, that should the applicant persuade a court on appeal that the mark was not *ex ante* generic, the survey provided sufficient evidence of acquired distinctiveness to support registration. Thus, the Board's determination of *ex ante* genericness was fatal to the registration of the mark even in the face of otherwise persuasive evidence of that HOTELS.COM had acquired secondary meaning.

Additionally, the trademark incapacity doctrine often tempts courts to invoke the *ex ante* bar in cases where the mark is a compound word or phrase, despite the well-established "anti-dissection" rule that trademarks are protected as a whole and should be evaluated as a whole.<sup>53</sup> Courts mistakenly apply the *ex ante* bar to compound marks whose components appear clearly generic or "highly descriptive,"<sup>54</sup> even if the compound term as a whole has not

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(Fed. Cir. 2005); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004) ("[I]n unique circumstances a [top level domain indicator] could perform a source-indicating function."). The court in *Oppedahl & Larson* explained:

Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark. In those rare instances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a TLD, such as ".com," ".net," etc. In those unusual circumstances, the addition of the TLD can show Internet-related distinctiveness, intimating some "Internet feature" of the item.

*Id.*

<sup>53</sup> See, e.g., *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920) ("The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."); see also *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) (ruling that the decision by the district court to break the EVEREADY mark down into its component pieces was clearly erroneous because "[w]ords which could not individually become a trademark may become one when taken together"); 2 MCCARTHY, *supra* note 40 § 11:27.

<sup>54</sup> Under § 1052(f) of the Lanham Act, a descriptive term can be presumed to have acquired distinctiveness upon a showing of five years of "substantially exclusive and continuous use." 15 U.S.C. § 1052(f) (2006). That presumption was historically relaxed for marks that are "so highly descriptive" they were deemed incapable of acquiring secondary meaning. *In re Institutional Investor, Inc.*, 229 U.S.P.Q. 614, 617-18 (C.C.P.A. 1986) (affirming decision by the trademark examiner that the mark INTERNATIONAL BANKING INSTITUTE for international banking seminars was "so highly descriptive or generic that it is utterly incapable of functioning as a trademark or acquiring distinctiveness, no matter what quantity of evidence of alleged distinctiveness or secondary meaning is submitted"). Some opinions suggest a relationship between the

been used as a product designation in the past. For example, in *A.J. Canfield Co. v. Honickman*,<sup>55</sup> the Court of Appeals for the Third Circuit held that the term CHOCOLATE FUDGE for soda was generic for a rich, chocolate-flavored soda, although CHOCOLATE FUDGE had never before been used in that combination for that purpose.<sup>56</sup> Likewise, TURBODIESEL was held generic for diesel engines even though the compound term had not previously been used by competitors or consumers in connection with diesel engines.<sup>57</sup>

The trademark incapacity doctrine has not been uniformly applied, but the exceptions prove the rule. On occasion, the TTAB has recognized acquired distinctiveness in a formerly generic term. For example, in an unpublished opinion, the TTAB reversed a refusal by the Trademark Office to register the mark KISSES for chocolate candy.<sup>58</sup> The TTAB recognized that the Hershey Company had acquired distinctiveness in KISSES, building up secondary meaning over ninety years.<sup>59</sup> This secondary meaning was reflected in a survey where 80 percent of respondents identified KISSES as a trademark.<sup>60</sup>

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descriptiveness of the proposed mark and the proof required to establish secondary meaning. *See, e.g.,* *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1581 (Fed. Cir. 1988) (“[T]he more descriptive the term, the greater the evidentiary burden to establish secondary meaning.”).

<sup>55</sup> 808 F.2d 291 (3d Cir. 1986).

<sup>56</sup> The CHOCOLATE FUDGE case was a close call. The Seventh Circuit initially affirmed a preliminary injunction against a competitor’s use of the CHOCOLATE FUDGE designation, *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903 (7th Cir. 1986), but later held that collateral estoppel precluded reconsideration of the Third Circuit’s finding of genericness, *A.J. Canfield Co. v. Vess Beverages, Inc.*, 859 F.2d 36 (7th Cir. 1988). The Third Circuit created its own genericness test outside of the primary significance test:

[W]hen a producer introduces a product that differs from an established product class in a significant, functional characteristic, and uses the common descriptive term of that characteristic as its name, that new product becomes its own genus, and the term denoting the genus becomes generic if there is no commonly used alternative that effectively communicates the same functional information.

*Honickman*, 808 F.2d at 293.

<sup>57</sup> *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892 (C.C.P.A. 1966).

<sup>58</sup> *In re Holmstead, Inc.*, No. 75/183,278 (T.T.A.B. Apr. 4, 2000).

<sup>59</sup> *Id.* at 11.

<sup>60</sup> *Id.* at 8. As the Board noted, 16.5 percent of respondents identified the KISSES mark as a generic term, compared with 9 percent who identified MILK DUDS as a generic term, and 4.4 percent who identified M&M’s as a generic term.

The court recognized secondary meaning despite substantial evidence amassed by the examiner that kiss started out as a generic designation for a small piece of confection or chocolate candy.<sup>61</sup>

There is at least one other limited exception to the trademark incapacity doctrine. Marks that lose protection because of a slide into genericness have occasionally reacquired distinctiveness and thus regained trademark protection. Both SINGER for sewing machines and GOODYEAR RUBBER for “goods produced by the processes known as Goodyear’s invention” were found generic by the Supreme Court in the nineteenth century,<sup>62</sup> but both marks reacquired trademark protection in the twentieth century.<sup>63</sup> These trademark resurrection cases are perhaps outliers, because such restorations have occurred infrequently.<sup>64</sup> However, trademark resurrection cases still indicate that the ex ante bar is not uniformly applied, at least in cases where the mark acquired secondary meaning before falling into genericness. The trademark incapacity doctrine thus appears not to consistently reach marks that held secondary meaning before they became generic.

At its extreme, the doctrine of trademark incapacity is absurd. In the middle ages, *code* was a term both for a baptism robe or chrism cloth, and for pitch or cobbler’s wax.<sup>65</sup> These meanings are obsolete and have been for centuries. It would be odd for a court to conclude that CODE is generic if used as a

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<sup>61</sup> *Id.* at 4. See also *Hershey Co. v. Promotion in Motion, Inc.*, No. 07-1601, 2011 WL 5508481, at \*9 (D.N.J. Nov. 7, 2011) (unpublished) (concluding, in light of “Hershey’s multiple Teflon surveys offering direct evidence of the primary significance of KISSES as a brand to consumers . . . that a reasonable fact finder could not find the KISSES mark generic”).

<sup>62</sup> *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888).

<sup>63</sup> *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953) (affirming district court decision that Singer had, “by the constant and exclusive use of the name ‘Singer’ in designating sewing machines and other articles manufactured and sold by it and in advertising the same continuously and widely—recaptured from the public domain the same ‘Singer’”); *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 729 (D. Minn. 1965) (holding that while the Supreme Court found that “Goodyear Rubber” was descriptive and could not be appropriated as a trademark, that case had “no bearing on the issue of secondary meaning”).

<sup>64</sup> Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1832 (2007); 2 MCCARTHY, *supra* note 40, § 12:30.

<sup>65</sup> *Code*, n.2, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/35579> (last visited Nov. 7, 2014); *Code*, n.3, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/35580> (last visited Nov. 7, 2014).



trademark for baptistery clothing or for a sealant. Nevertheless, a strong form of trademark incapacity would bar recognition of any source significance, because as a historical matter, *code* was once a term used to describe both things.

Trademark incapacity is not required by the language of the Lanham Act, which articulates the scope of federal trademark protection. Section 2(e)(1) of the Lanham Act authorizes the Trademark Office to reject an application to register a trademark if it determines that the mark “is merely descriptive” of the goods or services of the applicant.<sup>66</sup> But mere descriptiveness is not among the justifications for ignoring subsequently acquired source significance.<sup>67</sup> Likewise, Section 14 specifies that a trademark registration may be cancelled if the mark becomes generic, and mandates use of a primary significance test to determine whether or not the mark has become generic.<sup>68</sup> There is no statutory requirement for treating a generic term as though it cannot acquire source significance.<sup>69</sup>

Why, then, apply the doctrine of trademark incapacity? The next section summarizes standard justifications for trademark incapacity as well as critiques of the doctrine. This summary lays the groundwork for a discussion in Part II of what theories of semantic shift can teach us about trademark acquisition, and particularly the acquisition of source significance in a generic term.

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<sup>66</sup> 15 U.S.C. § 1052(e)(1) (Lanham Act (L.A.) § 2(e)(1)).

<sup>67</sup> *Id.* § 1052(f) (noting that, with the exception of provisions other than § 2(e)(1), “nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce”).

<sup>68</sup> *Id.* § 1064(3) (L.A. § 14(3)). In 1984, Congress passed the Trademark Clarification Act of 1984, Pub. L. No. 98-260, 98 Stat. 3335, to reverse the effect of the decision in *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 611 F.2d 296 (9th Cir. 1979), and to restate the traditional test for ex post genericness, which inquired into the primary significance of the term to the purchasing public. The primary significance test is now part of the statutory language, at least with regard to the genericness of a registered mark. 15 U.S.C. § 1064(3) (L.A. § 14(3)) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

<sup>69</sup> If a generic term were construed to “compris[e] matter that, as a whole, is functional,” that would provide a basis under § 1052(e)(5) for denying registration, or under § 1064(3) for cancelling the registration. 15 U.S.C. §§ 1052(e)(5), 1064(3) (L.A. §§ 2(e)(5), 14(3)). I argue in Part III.A.2(3), *infra*, that a generic term is different from a functional feature.

C. *Standard Justifications for and Prior Critiques of Trademark Incapacity*

The standard justifications for trademark incapacity, discussed in more detail in Part III.A, fall into two overlapping categories. First, if a legitimate shift from a generic term to a source-signifying trademark happens rarely, the trademark incapacity doctrine might serve as a prophylactic rule to prevent courts from erroneously finding a source-signifying shift that does not exist, while avoiding the administrative costs that come with an inquiry into the alleged change.<sup>70</sup> For example, Thomas McCarthy has considered at length whether a generic term may be “elevated over time into a trademark,”<sup>71</sup> concluding that such an event is extraordinarily rare.<sup>72</sup> McCarthy posits that such a shift would require “a radical change in consumer perception and usage of words,” which he identifies as happening only twice—in the *Singer* and *Goodyear* cases.<sup>73</sup> The mistake, however, is in arguing that the requisite change in consumer perception rarely occurs because courts have rarely extended legal significance to it. In fact, the case law is full of circumstances where a claimant provides evidence of a shift from genericness to source significance, but the courts discount it.<sup>74</sup>

Second, justifications for trademark incapacity articulate three intertwined rationales grounded in competition policy. One rationale argues that granting protection in “the common name of an article” may provide the first entrant with something approaching monopoly power to sell that product.<sup>75</sup> This concern is sometimes articulated as unease about “language depletion,”<sup>76</sup> the notion that too many common terms might be appropriated as property, leaving new entrants

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<sup>70</sup> Cf. Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004) [hereinafter Bone, *Enforcement Costs*]; see also *infra* Part III.A.1.

<sup>71</sup> 2 MCCARTHY, *supra* note 40, § 12:30.

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*; see also *supra* notes 62-64 and accompanying text.

<sup>74</sup> See *supra* Part I.B.

<sup>75</sup> See, e.g., *Am. Aloe Corp. v. Aloe Creme Labs., Inc.*, 420 F.2d 1248, 1252 (7th Cir. 1970); see also *infra* notes 210, 213-225 and accompanying text.

<sup>76</sup> See, e.g., *New Kids on the Block v. News Am. Publ'g Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (stating that generic trademarks receive no protection and that the holder of such a mark obtains no right to exclude others, so that producers may not “deplete the stock of useful words by asserting exclusive rights in them”). *But cf.* *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 169 (1995) (rejecting a similar “color depletion” theory as a basis for denying trademark protection for the use of a particular color on a good).

without access to words needed to sell competing goods to the public.<sup>77</sup> A related rationale favors protecting competitors over incumbents. These competition concerns are seen by others as a facet of the functionality doctrine,<sup>78</sup> which bars trademark protection in product features that are essential elements of a given product.<sup>79</sup>

Increasing competition is often seen as directly correlated with lowering consumer search costs,<sup>80</sup> but competition policy and consumer confusion can pull in different directions. Some consumers will be confused in almost any conflict between junior and senior users of trademarks. Trademark law nevertheless ignores the confusion of those consumers unless the mark is distinct enough to justify concluding that many consumers see it as source-signifying, or in cases where limited numbers of consumers have testified of confusion, but a plaintiff’s case is otherwise not particularly strong.<sup>81</sup> Thus, even if some consumers see a generic term as source-signifying and are consequently confused when competing producers use the term, the law might tolerate the confusion to preserve competition.<sup>82</sup>

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<sup>77</sup> Laura R. Bradford, *Emotion, Dilution, and the Trademark Consumer*, 23 BERKELEY TECH. L.J. 1227, 1242 (2008).

<sup>78</sup> See, e.g., Dinwoodie, *Ontology*, *supra* note 39, at 729-30. See also *infra* notes 235-239 and accompanying text.

<sup>79</sup> See, e.g., *Qualitex*, 514 U.S. at 164 (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).

<sup>80</sup> See, e.g., *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 14 (1st Cir. 2008); Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 98 TRADEMARK REP. 1345, 1373-74 (2008) (“[T]he ultimate purpose of reducing consumer search costs is to facilitate the operation of [the] marketplace. If trademark law interferes with competition, trademark law must give way, or it will end up destroying the village in order to save it.”).

<sup>81</sup> See, e.g., *McDonald’s Corp. v. Shop at Home, Inc.*, 82 F. Supp. 2d 801, 810 (M.D. Tenn. 2000) (noting that sixteen instances of actual confusion “borders on insignificant” for a mass marketer like McDonald’s).

<sup>82</sup> See *Soc’y of Fin. Examiners v. Nat’l Ass’n of Certified Fraud Examiners Inc.*, 41 F.3d 223, 225 (5th Cir. 1995) (vacating summary judgment and injunctive relief in plaintiff’s favor because a question of fact remained on whether the purported mark was generic, and noting that “[e]ven total confusion, however, is irrelevant if [the purported mark] constitutes a ‘generic’ mark”); cf. Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 793 (2004) [hereinafter Dogan & Lemley, *Consumer Search Costs*] (“[T]he genericness doctrine can impose search costs on consumers, particularly when a once-famous mark such as ‘aspirin’ or ‘thermos’ becomes generic.”).

Critics of trademark incapacity have taken different positions on the justifications outlined above. Scholars like Graeme Dinwoodie have noted the problem of handling trademarks ontologically.<sup>83</sup> In the words of Thomas McCarthy, the doctrine of trademark incapacity is problematic because it empowers a court to “assume that which is to be decided.”<sup>84</sup> But even McCarthy falls prey to the mistaken notion that a shift from a generic term to a source-signifying designation is, by nature, vanishingly rare.<sup>85</sup> Louis Altman instead urges courts to inquire whether “there has been a complete transformation of [generic into source-signifying] meaning,”<sup>86</sup> in essence requiring a complete replacement of any generic meaning with secondary meaning before trademark protection may vest.<sup>87</sup>

Some critics see genericness and source significance as opposite sides of the same coin.<sup>88</sup> This binary view misapprehends the issue. As discussed in more detail in Part II, a word can have multiple senses, and can even have conflicting meanings. Likewise, a term used as a trademark has the potential to bear both product identifying and source-signifying meanings, at least in the minds of different consumers, and perhaps in the mind of the same consumer at different times.<sup>89</sup> The binary view thus misses some of the complexity that semantic shift theories can help us appreciate.

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<sup>83</sup> Dinwoodie, *Ontology*, *supra* note 39, at 729.

<sup>84</sup> 2 MCCARTHY, *supra* note 40, § 12:47; *see also* 3 CALLMANN, *supra* note 9, § 20:33.

<sup>85</sup> 2 MCCARTHY, *supra* note 40, § 12:47 (proposing leaving a slight opening for asserting a trademark in a formerly generic name “to accommodate the rare and extraordinary event that a generic name over a period of years loses it[s] generic significance and achieves trademark significance.”); *cf. infra* Part II.B.

<sup>86</sup> 3 CALLMANN, *supra* note 9, § 20:33. Altman nevertheless concedes the anti-competitive argument “if the mark retains a substantial vestige of its original generic or descriptive meaning.” *Id.*

<sup>87</sup> *See infra* notes 282-285 and accompanying text for a critique of the replacement standard.

<sup>88</sup> *See, e.g.*, Marc C. Levy, *From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine*, 95 TRADEMARK REP. 1197, 1202 (2005) (“[T]here is no such thing as a ‘generic’ word with secondary meaning.”) (quoting *Miller Brewing Co. v. Falstaff Brewing Corp.*, 503 F. Supp. 896, 906 (D.R.I. 1980), *rev’d*, 655 F.2d 5 (1st Cir. 1981)).

<sup>89</sup> *Cf.* Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1339-40 (1980) (discussing three possible types of consumer perception of “trademarked generic words”); Heymann, *supra* note 1, at 1342 (arguing that consumers can hold generic and source-signifying meanings in mind simultaneously).

Other scholars see trademark incapacity as a subset of functionality. For example, Vanessa Bowman Pierce has argued that the genericness inquiry should be subsumed into a functionality inquiry.<sup>90</sup> Pierce’s concept of functionality, however, is confined to preventing the protection of “core words to which all competitors may need access.” Thus, if “effective competition is possible” without the use of the term, “neither functionality nor genericism should preclude at least qualified protection” of the term.<sup>91</sup> Vincent Palladino, on the other hand, expresses concern that at least “for products that are not unique, [equating] functionality and genericness seems unsound” because a competitor always needs to copy a functional element in order to compete, but does not need to use a word to compete “when the word has become associated with the products of only *one* producer.”<sup>92</sup> Palladino’s argument is somewhat conclusory, and he buys into the same binary structure that plagues other critiques, but he points in the direction of the real conundrum, one that focuses on the importance of change.<sup>93</sup> Functional features do not change, but language does.

These critiques nevertheless fail to account for *why* it is important to focus on current rather than historic language usage. To encapsulate the argument that follows, language is dynamic, and language change appears to occur more rapidly now than at any point in history.<sup>94</sup> Part II outlines how those

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<sup>90</sup> Vanessa Bowman Pierce, *If It Walks Like a Duck and Quacks Like a Duck, Shouldn’t It Be a Duck?: How a “Functional” Approach Ameliorates the Discontinuity Between the “Primary Significance” Tests for Genericness and Secondary Meaning*, 37 N.M. L. REV. 147, 185 (2007).

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

<sup>92</sup> Vincent N. Palladino, *Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys*, 92 TRADEMARK REP. 857, 869 (2002).

<sup>93</sup> *Id.*; see also 2 MCCARTHY, *supra* note 40, § 15:24 (recognizing the inherent “fluidity” of trademark rights in his criticism of the strong form of de facto secondary meaning).

<sup>94</sup> The editors of the *Barhart Dictionary of New English* reported five thousand new words, or neologisms, between 1963 and 1972, roughly five hundred per year. See John Algeo, *Where Do All the New Words Come From?*, 55 AM. SPEECH 264, 267 (1980). But in the 1989 edition of the OED, editor John Simpson stated in the preface that “[t]he pace of inclusion of new words has been increased to a rate of about 4,000 per year.” John Simpson, *Introduction* to THE OXFORD ENGLISH DICTIONARY (2d ed. 1989). Other authors have noted spikes in neologism during periods of great creative and literary output. See, e.g., GEOFFREY HUGHES, A HISTORY OF ENGLISH WORDS 27 (2000) (identifying a spike in neologisms at the turn of the seventeenth century). Communication technology also increases the rate with which new words are adopted. See, e.g., ALVIN TOFFLER, FUTURE SHOCK 151-54 (1970) (describing how *A-OK* effectively entered the lexicon overnight as the American public heard an astronaut

changes typically occur. In particular, Part II.B explains how *restriction*—a narrowing shift in the meaning of a word from any member of a broad category to a prototypical member of that category—is the most common form of semantic shift. In Part III, the Article applies these findings to the trademark incapacity doctrine, refuting the functionality and error-cost rationales that are presumed to provide a basis for the doctrine.

## II. LANGUAGE CHANGE AND TRADEMARK MEANING

Semantic shift is the creation of new meaning, either by adding new senses to existing words, or adding new words to the lexicon. Similarly, creation of the source significance necessary to qualify for trademark protection is a form of semantic shift. Like semantic shift generally, the creation of trademark meaning is driven by the need to communicate. And like semantic shift, trademark law provides rules for how to resolve confusing ambiguity. In both linguistic and legal realms, the effectiveness of the communication and the ease of processing the ambiguity depend largely on the nature of the relationship between a new word or meaning and the older word or words from which it is derived.

Trademark acquisition also resembles semantic shift in another way. Semantic shift happens in regular patterns that linguists identify as occurring repeatedly over time and across languages. Each stop on the *Abercrombie* spectrum correlates with a category of semantic relationship, with one notable exception. Restriction of meaning occurs when the meaning of a word designating a category of things is narrowed to designate a prototypical member of the category.<sup>95</sup> By many accounts, restriction is the most common form of semantic shift.<sup>96</sup> But as discussed in Part I.B, trademark law treats the restrictive shift from a generic product category to a source-signifying trademark as forbidden, based in part on the mistaken premise that restriction in the trademark context is extremely rare.

This Part presents evidence regarding the frequency of restriction and how restriction occurs. Part III then considers whether the justifications for trademark incapacity hold water in light of this evidence, and how we might change trademark law to more closely match our best understanding of how language actually changes.

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use it during a televised flight).

<sup>95</sup> See *infra* notes 145-146, 152-157 and accompanying text.

<sup>96</sup> See, e.g., GEERAERTS, LEXICAL SEMANTICS, *supra* note 16, at 26-27.

A. *Semantic Shift and the Abercrombie Spectrum*

Living languages are not static. The lexicon of a given language—the total number of words available to speakers of that language—must continually make room for new entries.<sup>97</sup> Two motivations drive this creation of new meaning, or semantic shift.<sup>98</sup> First, semantic shift is motivated by the speaker’s need to say new things and communicate more effectively, which encourages the speaker to “risk” a semantic innovation.<sup>99</sup> If the innovation fails, the attempt is dismissed as a “nonce-formation.”<sup>100</sup> If the innovation spreads to other members of the speech community, it first becomes an “occasional” or context-specific meaning.<sup>101</sup> Occasional or innovative uses that gain sufficient popularity may become context-independent, “usual” meanings.<sup>102</sup>

Adding a new meaning to an old word is an efficient means of saying something new in a recognizable way. For instance, the torpedo, a self-propelled submarine explosive, was named for a type of stingray.<sup>103</sup> Andreas Blank has proposed that the inventor called it a torpedo because he thought that “this was a pretty convincing metaphor” for the way the explosive device moved through the water and could surprise its target.<sup>104</sup>

On the other hand, introducing new meanings to a given word can also cause confusing ambiguity.<sup>105</sup> A listener or reader faced with conflicting meanings may find it difficult to

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<sup>97</sup> See, for example, *omnishambles*, a new word coined in an episode of the British television satire *In the Thick of It*. *Omnishambles*, n., OXFORD DICTIONARIES, <http://www.oxforddictionaries.com/us/definition/English/omnishambles> (last visited Nov. 7, 2014) (“n., British informal, a situation that has been comprehensively mismanaged, characterized by a string of blunders and miscalculations.”).

<sup>98</sup> Dirk Geeraerts, *Reclassifying Semantic Change*, 4 QUADERNI DI SEMANTICA 217, 226, 234 (1983) [hereinafter Geeraerts, *Reclassifying*].

<sup>99</sup> Andreas Blank, *Why Do New Meanings Occur? A Cognitive Typology of Motivations for Lexical Semantic Change*, 61, 82-83 in *HISTORICAL SEMANTICS AND COGNITION* (Andreas Blank & Peter Koch eds., 1999) [hereinafter Blank, *HISTORICAL SEMANTICS*]; GEERAERTS, *LEXICAL SEMANTICS*, *supra* note 16, at 14-16 (suggesting that individual behavior drives general language change over time) (citing HERMANN PAUL, *PRINZIPIEN DER SPRACHGESCHICHTE* (5th ed. 1920)).

<sup>100</sup> See Hollmann, *supra* note 17, at 535.

<sup>101</sup> WILLIAM CROFT, *EXPLAINING LANGUAGE CHANGE: AN EVOLUTIONARY APPROACH* 4-5, 105 (2000).

<sup>102</sup> Traugott and Dasher refer to occasional meanings as “subjectification[s],” which enter the lexicon as usual meanings once they are “fairly wide spread.” TRAUGOTT & DASHER, *supra* note 2, at 32.

<sup>103</sup> Blank, *supra* note 99, at 62.

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

<sup>105</sup> *Id.*

understand the word. Ambiguity can thus increase the cost of communicating, and to that extent may be inefficient and undesirable.<sup>106</sup> When such ambiguity arises, it can create what scholars call homonymic tension or semantic overload.<sup>107</sup>

When confusing ambiguity arises, earlier meanings often disappear as newer meanings are added.<sup>108</sup> For example, the Latin word *persona* gradually extended from “mask” to “individual human being,” and then branched off to “parish priest.” The resulting ambiguity was subsequently resolved by adopting the variant *parson* for “parish priest,” and abandoning *persona* for the same.<sup>109</sup> Homonymic tension can thus force some meanings out of the lexicon.<sup>110</sup> When old meanings disappear, ambiguity is reduced, making the language more efficient.<sup>111</sup>

Semantic shift occurs in a variety of well-documented ways, enabling new expression and tempering confusing ambiguity. Sometimes a speaker makes up a whole new word. At inception, such a word is *monosemous*, having only one meaning.<sup>112</sup> At other times, an existing word can be pressed into service for new purposes. Words gain and lose meaning in predictable patterns across languages,<sup>113</sup> and these patterns may shape the acquisition of trademark meaning, which at its base is a type of semantic shift.<sup>114</sup> Often, there is a relationship between the existing word and its new meanings. There are six standard categories of semantic change that build on existing meaning: *restriction*, *widening*, *metaphoric polysemy*,

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<sup>106</sup> Geeraerts, *Reclassifying*, *supra* note 98 at 227.

<sup>107</sup> STEPHEN ULLMANN, *THE PRINCIPLES OF SEMANTICS: A LINGUISTIC APPROACH TO MEANING* 132 (1951) (quoting LEONARD ROBERT PALMER, *AN INTRODUCTION TO MODERN LINGUISTICS* 113 (1936)); Geeraerts, *Reclassifying*, *supra* note 98, at 226, 234.

<sup>108</sup> Robert J. Menner, *Multiple Meaning and Change of Meaning*, 21 *LANGUAGE* 59, 61 (1945); *see also id.* at 67 (describing how the old French word *nice*, meaning “ignorant” or “simple,” morphed into two senses—(1) “fastidious,” “particular,” “refined,” which is also now nearly abandoned; and (2) “agreeable”).

<sup>109</sup> Joachim Grzega & Marion Schöner, *English and General Historical Lexicology: Materials for Onomasiology Seminars*, 1 *ONOMASIOLOGY ONLINE MONOGRAPHS* 1, 32 (2007).

<sup>110</sup> Robert J. Menner, *The Conflict of Homonyms in English*, 12 *LANG.* 229, 234 (1936) [hereinafter Menner, *Homonyms*]; *see also infra* notes 167-170 and accompanying text.

<sup>111</sup> ULLMANN, *supra* note 107, at 134 (language evolves “curative devices . . . to resolve ‘intolerable’ conflicts”).

<sup>112</sup> *See infra* notes 125-126 and accompanying text.

<sup>113</sup> TRAUGOTT & DASHER, *supra* note 2, at 3.

<sup>114</sup> *See infra* notes 121-144 and accompanying text.



*metonymous polysemy, amelioration, and pejoration.*<sup>115</sup> Sometimes, new meanings are *homonymous*, or unrelated to old meanings.<sup>116</sup>

Like semantic shift, trademark acquisition is speaker-driven, exhibits regular behavior, and appears to be shaped by settled processing patterns used by listeners and readers when construing lexical ambiguity. Reconsider Blank’s description of how the torpedo was named.<sup>117</sup> The motivation to find “a new name in a concrete situation”<sup>118</sup> drives the efforts of the trademark owner to innovate. Each trademark is a symbol, indicating that goods or services sold under that mark will be of a consistent quality from a stable source.<sup>119</sup> New meaning added to an existing word can point toward that source.<sup>120</sup>

In *Abercrombie & Fitch Co. v. Hunting World, Inc.*,<sup>121</sup> the Second Circuit provided a spectrum of conceptual trademark strength based on the relationship between the new trademark and existing meanings of the appropriated word. As Judge Friendly articulated in *Abercrombie*, the more inherently distinctive a mark, the more readily it can bear source significance and the easier it is for the hopeful mark owner to acquire trademark protection.<sup>122</sup>

Some trademarks are *fanciful*, created for the purpose of signifying products from a singular source, like XEROX for photocopiers. Other marks are formed from preexisting words. An *arbitrary* mark is formed when the word used is not related to the product identified, like APPLE for computers. *Suggestive* marks indirectly evoke some aspect of the product, like SKINVISIBLE for transparent adhesive bandages, while

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<sup>115</sup> Elizabeth C. Traugott, *Semantic Change: An Overview*, in THE FIRST GLOT INTERNATIONAL STATE-OF-THE-ARTICLE BOOK: THE LATEST IN LINGUISTICS 385 (Lisa Cheng & Rint Sybesma eds., 2000). I discuss the following types of semantic shift in more detail *infra*: *restriction*, notes 151-173 and accompanying text; *widening*, notes 174-180 and accompanying text; and *metaphoric* and *metonymous polysemy*, notes 132-141 and accompanying text. For a more detailed discussion of what metaphoric and metonymous polysemy can teach us about the acquisition of secondary meaning in suggestive and descriptive trademarks, see generally Linford, *False Dichotomy*, *supra* note 7.

<sup>116</sup> See *infra* notes 127-131 and accompanying text.

<sup>117</sup> See *supra* notes 103-104 and accompanying text.

<sup>118</sup> Blank, HISTORICAL SEMANTICS, *supra* note 99, at 62.

<sup>119</sup> Beebe, *Semiotic*, *supra* note 1, at 623.

<sup>120</sup> Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 563 (2006) [hereinafter Bone, *Goodwill*].

<sup>121</sup> 537 F.2d 4 (2d Cir. 1976).

<sup>122</sup> *Id.* at 9.

*descriptive* marks, like SEALTIGHT for fasteners, are derived from a quality or feature of the identified good or service. Although the *Abercrombie* spectrum has been criticized as an acontextual distraction from the key inquiries in trademark law,<sup>123</sup> the spectrum nevertheless plays a critical role in trademark law's inquiry into source significance.

As the following chart highlights, key points along the *Abercrombie* spectrum mirror commonly understood forms of semantic shift—for the most part.<sup>124</sup> The sole outlier is the treatment of a generic term in trademark law. While restriction—the shift from a general to a narrow meaning—occurs frequently and across languages, the restriction in consumer perception when a word like “hog” shifts from product type to product source is given no legal effect.

<b>Semantic Category</b> (relationship between existing words/meanings and new word/meaning)	<b>Abercrombie Spectrum</b> (relationship between mark and product or good offered)
Monoseme: only one meaning.	Fanciful mark: coined for use as a trademark, not derived from a preexisting word.  <i>Ex:</i> XEROX for photocopiers.
Homonym: no connection between existing meanings and the new meaning.	Arbitrary mark: derived from a pre-existing word that has no connection with the good or service sold.  <i>Ex:</i> APPLE for computers.

<sup>123</sup> See, e.g., Lee et al., *supra* note 1, at 1078 (“[T]he *Abercrombie* classification system is built on a faulty theoretical notion that semantic meaning is the determinant of the extent to which consumers will esteem a mark to be a source-indicator.”). But see Linford, *False Dichotomy*, *supra* note 7, at 24-25.

<sup>124</sup> In addition, research by Barton Beebe suggests that the mark's place on the *Abercrombie* spectrum correlates with the eventual outcome in litigation. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1635-39 (2006) [hereinafter Beebe, *Multifactor*].

<p>Metaphor: figurative connection between existing meanings and the new sense.</p>	<p>Suggestive mark: pre-existing word with some connection to the mark, via an imaginative leap.</p> <p><i>Ex:</i> SKINVISIBLE for transparent adhesive bandages; GLEEM for toothpaste.</p>
<p>Metonym: some connection between existing and new sense, like feature for the whole.</p> <p><i>Ex:</i> <i>Green Beret</i> from distinctive headgear worn by U.S. Army Special Forces shifts to serve as a nickname for the organization and its members.</p>	<p>Descriptive mark: pre-existing term with a clear connection to the good or service sold, via a direct description of a product feature.</p> <p><i>Ex:</i> SEALTIGHT for fasteners.</p>
<p>Restriction: word formerly used to describe general category narrowed to represent a prototypical member of the category.</p>	<p>Ex ante generic mark: word whose meaning has shifted from a class of products to one particular brand.</p> <p><i>Not an example:</i> HOG for Harley Davidson motorcycles denied protection, despite evidence of shift, on grounds of trademark incapacity.</p>

A fanciful mark, like XEROX for photocopiers,<sup>125</sup> is a monoseme—a word with a singular meaning.<sup>126</sup> Before XEROX

<sup>125</sup> SCM Corp. v. Xerox Corp., 463 F. Supp. 983 (D. Conn. 1978). The term XEROX is ostensibly drawn from the technical name for the photocopying process, *xerography*, which itself is derived from Greek words for “dry” and “writing,” ξηρό εγγράφως. Earle Hitchner, *Xerox Is Not a Verb*, in PROPHETS IN THE DARK: HOW XEROX REINVENTED ITSELF AND BEAT BACK THE JAPANESE 431, 431 (1992).

<sup>126</sup> Monosemy is the condition where a word or phrase has a single meaning,

was coined as a name for photocopying machines, that combination of letters had no meaning. On the *Abercrombie* scale, a fanciful mark is considered the most inherently distinctive trademark. It is easy for consumers to perceive the mark as a source signifier because the fanciful mark has no prior relationship to the product identified.

An *arbitrary* mark, like APPLE for computers,<sup>127</sup> has a homonymous relationship to the word appropriated as a source signifier. *Homonyms* are words that look and/or sound the same,<sup>128</sup> but have multiple unrelated meanings.<sup>129</sup> For example, while the word *bank* can refer to a financial institution or the bank of a river, each meaning is homonymous, stemming from independent sources.<sup>130</sup> Historical and cognitive research

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or where there is an absence of ambiguity. CHARLES RUHL, ON MONOSEMY: A STUDY IN LINGUISTIC SEMANTICS (1989). A monoseme has a singular, and often technical meaning. *Monosemic*, adj.2, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/253725> (last visited Mar. 10, 2015) (“Of a word: having only one meaning”); cf. *Mononym*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/238541> (last visited Nov. 7, 2014) (“A technical name consisting of one word only.”). The term monoseme came into common usage to describe technical medical terms at the turn of the twentieth century. Scholars have also applied the term to certain prominent trademarks or trade names. For example, David Crystal offers MICROSOFT as an example of a monosemous term. DAVID CRYSTAL, HOW LANGUAGE WORKS 191 (2005).

<sup>127</sup> OWEN W. LINZMAYER, APPLE CONFIDENTIAL: THE REAL STORY OF APPLE COMPUTER, INC. (1999); Stephen Wozniak, *Homebrew and How the Apple Came to Be*, in DIGITAL DELI (Steve Ditlea ed., 1984); see also Trademark Reg. No. 1,078,312 (Nov. 29, 1977) (APPLE for computers and computer programs recorded on paper and tape).

<sup>128</sup> For the sake of simplicity, I include within homonymy both homophones, words that sound the same but have different written forms and different meanings, and homographs, words with the same written form but different pronunciations and meanings; see generally Ekaterina Klepousniotou, *The Processing of Lexical Ambiguity: Homonymy and Polysemy in the Mental Lexicon*, 81 BRAIN & LANGUAGE 205 (2001).

<sup>129</sup> Keith Allan defines homonymy as “the relation between two or more expressions which have the same form but different meanings.” 1 KEITH ALLAN, LINGUISTIC MEANING 147 (1986). Grzega and Schöner identify several reasons for such a change: speakers drop sounds at the end of words, or certain sounds are abandoned from language over time, causing previously distinguishable words to become indistinguishable. Grzega & Schöner, *supra* note 109, at 32.

<sup>130</sup> *Bank* as an institution derives from the Italian term for bench. *Bank*, n.3, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/15237> (last visited Nov. 7, 2014); see also *infra* note 133 and accompanying text. The meaning of *bank* as the side of a river, or other raised shelf of ground, on the other hand, is of Scandinavian origin. *Bank*, n.1, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/15235> (last visited Nov. 7, 2014). The two terms collapsed into the same word, *banke*, in early modern English. *Id.*

suggests that readers and listeners process unrelated or homonymous meanings as if they were completely different words.<sup>131</sup> In the trademark context, adopting an arbitrary mark is not accidental. For example, Steve Jobs and Steve Wozniak selected APPLE as a source signifier for the personal computers they built. But the absence of a relationship between the mark and the goods or services makes the arbitrary trademark more clearly distinctive than trademarks more intimately connected to the offered good or service.

Unlike the coining of monosemes, or homonymous shift, some semantic shift creates a new meaning that is closely related, or *polysemous* to existing meanings.<sup>132</sup> Linguists posit that polysemes are interrelated in such a way that the reader or listener derives multiple meanings from a single or central sense.<sup>133</sup> Polysemous senses are etymologically related, stemming from a common source. To take an earlier example in a different direction, the word *bank* means a financial institution, the building in which the financial institution is housed, any number of institutions that store things (like a blood bank), and a synonym for “to rely upon,” for example, “you can bank on it.”<sup>134</sup> All those meanings derived from the Italian term for bench, which was “extended in Italian to mean, alternately, ‘tradesman’s stall, counter, money changer’s table’” and more.<sup>135</sup>

Polysemous shifts are of two regular types: *metonymic* (for example, *Green Beret*, the distinctive headgear of the United States Army Special Forces extended to a nickname for the

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<sup>131</sup> WILLIAM CROFT & D. ALAN CRUSE, *COGNITIVE LINGUISTICS* 112 (2004) (suggesting that it is difficult, but not impossible, to simultaneously construe an ambiguous word using two homonymous meanings); Ekaterina Klepousniotou, *Reconciling Linguistics and Psycholinguistics: On the Psychological Reality of Linguistic Polysemy*, in *THE COGNITIVE BASIS OF POLYSEMY: NEW SOURCES OF EVIDENCE FOR THEORIES OF WORD MEANING* 29 (Rakova et al. eds., 2007) [hereinafter Klepousniotou, *Reconciling*]; Ekaterina Klepousniotou & Shari R. Baum, *Disambiguating the Ambiguity Advantage Effect in Word Recognition: An Advantage for Polysemous but Not Homonymous Words*, 20 *J. NEUROLINGUISTICS* 1, 4 (2007) [hereinafter Klepousniotou & Baum, *Disambiguating*] (explaining that homonyms have mutually exclusive meanings, one of which must be selected before further processing can occur).

<sup>132</sup> Allan defines polysemy as “the property of an expression with more than one meaning.” 1 ALLAN, *supra* note 129, at 147.

<sup>133</sup> Klepousniotou & Baum, *Disambiguating*, *supra* note 131, at 4 (explaining that polysemes have a single core meaning from which interrelated senses are derived).

<sup>134</sup> CROFT & CRUSE, *supra* note 131, at 109-110.

<sup>135</sup> *Bank*, n.3, *OXFORD ENGLISH DICTIONARY*, <http://www.oed.com/view/Entry/15237> (last visited Nov. 7, 2014).

organization and its members),<sup>136</sup> and *metaphoric* (for example, *lip* for “part of the body around the mouth” extended to “edge of a cup”).<sup>137</sup> In both cases, the speaker perceives some similarity between two concepts, and uses the word for the first concept to refer to the second.

Descriptive and suggestive marks are both polysemous with the goods or services identified. *Descriptive marks* are related to the word or words from which they are drawn in a manner that resembles metonymic polysemy. A descriptive mark builds on a characteristic of the good or service offered, while a metonymic shift is a change based on contiguity between concepts.<sup>138</sup> For example, a term like SEALTIGHT for fasteners describes the qualities a fastener would likely have and is thus descriptive in nature.

The creation of a *suggestive mark* mirrors metaphoric polysemy. Suggestive marks operate in metaphoric relationship to the words from which they are drawn,<sup>139</sup> requiring “the consumer to exercise his imagination to reach a conclusion as to the nature of the . . . goods” offered under that mark.<sup>140</sup> For example, SKINVISIBLE for transparent bandages is a portmanteau that conveys a characteristic of the product—transparency—but in a way that hints at, rather than expressly states, the connection.<sup>141</sup>

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<sup>136</sup> D. GARY MILLER, ENGLISH LEXICOGENESIS 111 (2014) (offering several examples of metonymic polysemy, such as the use of *redcoat* for British military officer and *skirt* for a woman).

<sup>137</sup> Klepousniotou, *Reconciling*, *supra* note 131, at 27.

<sup>138</sup> See TRAUOGOTT & DASHER, *supra* note 2, at 28. For instance, *horn* for “animal horn” added the sense of *horn* for “musical instrument,” due to the use of some animal horns as musical instruments or warning devices. Andreas Blank, *Co-Presence and Succession: A Cognitive Typology of Metonymy*, in METONYMY IN LANGUAGE AND THOUGHT 169, 182 (Klaus-Uwe Panther & Günter Radden eds., 1999).

<sup>139</sup> Metaphoric extensions are based on a specific analogous similarity between concepts. GEERAERTS, LEXICAL SEMANTICS, *supra* note 16, at 27. For instance, *broadcast* originally meant to “scatter[ seed] abroad over the whole surface, instead of . . . sow[ing] in drills or rows,” then to “scatter[ something] widely abroad,” and later came to mean “[d]isseminate[] by means of radio or television.” *Broadcast*, v. OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/23507> (last visited Nov. 7, 2014).

<sup>140</sup> Synergistic Int’l, LLC v. Korman, 470 F.3d 162, 171 (4th Cir. 2006) (quoting Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1528 (4th Cir. 1984); see also U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(a) (2014) (“Suggestive marks . . . when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services . . . [But a] descriptive term . . . immediately tells something about the goods or services.”).

<sup>141</sup> Minnesota Min. & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179, 1180

As with the processing of different types of semantic innovation, trademarks qualify for protection based on the relationship between the mark and the offered good or service. Fanciful, arbitrary, and suggestive marks are treated as inherently distinctive, qualifying for trademark protection from first use. While suggestive marks are classified as inherently distinctive, some courts consider a suggestive mark to be weaker than arbitrary or fanciful marks and thus entitled to narrower protection from alleged infringement.<sup>142</sup> A descriptive mark is protectable only after source significance is established.<sup>143</sup>

At a rough cut, the different treatment of fanciful, arbitrary, suggestive, and descriptive marks is defensible in light of how listeners and readers process confusing ambiguity. It is easy for consumers to view a fanciful mark as a source signifier because the lack of relationship between the mark and any other word will lead the consumer to perceive the word as a trademark. Likewise, the lack of connection between the arbitrary mark and the good or service offered will be perceived by consumers as distinct lexical entries, i.e., two clearly distinct things that share superficial similarities in visual or audible element. Likewise, suggestive and descriptive marks are closely connected with the good or service sold. If trademark protection turns on consumer perception, the mark owner should be required to build up secondary meaning or commercial strength before the law protects a descriptive or suggestive term from trademark infringement.<sup>144</sup>

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(C.C.P.A. 1972) (reversing decision of the TTAB which sustained an opposition to the application to register SKINVISIBLE on ground of mere descriptiveness under § 2(e)(1) of the Lanham Act).

<sup>142</sup> *Compare* M2 Software, Inc. v. Madacy Entm’t, 421 F.3d 1073, 1081 (9th Cir. 2005) (concluding that suggestive marks, like descriptive marks, are “conceptually weak”), *with* Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1527 (4th Cir. 1984) (concluding that suggestive marks are considered “strong” as well as “presumptively valid”), *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1131 (9th Cir. 1998) (concluding that the mark of the smaller junior user was inherently distinctive and thus deserved “broad protection”), *and* Beebe, *Multifactor*, *supra* note 124, at 1637-38 (analyzing likelihood of confusion cases and reporting that courts concluded a suggestive mark was strong in just under 59 percent of cases, but concluded that an arbitrary mark was strong in over 68 percent of cases, and that a fanciful mark was strong in every reported case).

<sup>143</sup> *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir. 1976) (“Secondary meaning need only be shown if a mark . . . is found to be or is conceded to be descriptive.”).

<sup>144</sup> For a more complete consideration from a linguistic standpoint of whether suggestive and descriptive marks should be treated differently, see Linford, *False Dichotomy*, *supra* note 7.

On the other hand, trademark incapacity is not defensible in light of our best understanding of how people process linguistic ambiguity and language change. While trademark acquisition is a subset of the broader phenomenon of semantic shift, the doctrine of trademark incapacity discounts restriction, which may be the most common form of semantic shift. The next Section explains the phenomenon of restriction in more detail.

*B. Regularity of Restriction in Semantic Shift*

Semantic shift occurs in regular patterns. This Section considers two well-recognized patterns, *restriction* and *widening*, and what they can teach us about consumer perception and consumer confusion. *Restriction* is narrowing in meaning from a broad category to a prototypical member of that category.<sup>145</sup> For example, *queen* once meant “wife” or “woman,” but the meaning has narrowed to “king’s wife” or “female sovereign.”<sup>146</sup> *Widening* happens when the name of a thing comes to represent the category to which the thing belongs.<sup>147</sup> For instance, the French *arriver* originally meant “to reach the river bank,” but has broadened to mean “to reach a destination.”<sup>148</sup> Restriction and widening are both examples of semantic change that occurs because of a focus by speakers and listeners on a prototypical member of a group. A significant amount of semantic shift is driven by the focus on a prototypical example of a given category.<sup>149</sup> Thus, some scholars identify restriction and widening as the most important processes of semantic change.<sup>150</sup>

Michel Bréal, one of the founders of semantic linguistics, first posited that restriction is the most frequently occurring regular semantic shift.<sup>151</sup> Historical accounts support this

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<sup>145</sup> Restriction is also called narrowing or specification. GEERAERTS, LEXICAL SEMANTICS, *supra* note 16, at 27.

<sup>146</sup> *Id.*

<sup>147</sup> Widening is also called generalization or broadening. *Id.*

<sup>148</sup> *Id.*

<sup>149</sup> Blank, *supra* note 99, at 62-63.

<sup>150</sup> See MICHEL BRÉAL, SEMANTICS: STUDIES IN THE SCIENCE OF MEANING 189 (Cust trans., 1964) (“[T]he facts of restriction are of the most frequent occurrence.”); GERT RONBERG, A WAY WITH WORDS: THE LANGUAGE OF ENGLISH RENAISSANCE LITERATURE 32 (1992); see also Francisco Yus, *Relevance Theory*, in THE OXFORD HANDBOOK OF LINGUISTICS 679, 693 (Bernd Heine & Heiko Narrog eds., 2012) (arguing that the creation of metaphors often involves “both broadening and narrowing of concepts”).

<sup>151</sup> BRÉAL, *supra* note 150, at 106; see also MCMAHON, *supra* note 26, at 178-79 (explaining that restriction is the most natural form of language change, particularly when a loan word is introduced, and the old word



theory. For example, the shift from Old English to Middle English is replete with instances of semantic restriction and loss of Old English vocabulary.<sup>152</sup> Much of that restriction occurred as new “loanwords” were introduced from other languages, and the meanings of both old and new terms were narrowed as they came into conflict. For instance, while the Old English word *goma* once referred broadly to “jaw, palate, and inside of the mouth,” the introduction of *palate* from the Latin and *jaw* from an unidentified source coincides with a restriction of *goma*, or *gum*, to refer only to the connective tissue surrounding the teeth.<sup>153</sup> Cultural and technological change also explains some semantic shift, as words are lost due to irrelevance. For example, no one walks around with a body of retainers anymore, so a word like *folgoþ*—the Old English word for “a body of retainers”—has been rendered obsolete.<sup>154</sup>

Often, a term designating a whole category is narrowed or restricted to a prototypical member of the category.<sup>155</sup> For example, *meat* once meant “food,” but has narrowed to “edible flesh.”<sup>156</sup> The shift of a generic term to a trademark—like the shift from understanding *hog* to mean any large motorcycle to specifically Harley Davidson motorcycles—is another example of restriction.<sup>157</sup>

There are multiple examples through history of semantic restriction from the whole category to a prototypical member. For example, *corn* stems from the Latin word for grain. In a given locale, the term will adopt a usual meaning corresponding to the dominant crop in the region. *Corn* is thus narrowed in the United States to mean maize, while in most of England, corn refers to what U.S. consumers would call wheat, and in northern England and Ireland, corn identifies what U.S. residents call oats.<sup>158</sup> Other examples include *skyline*

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must “recoil” to stay relevant); ROBERT P. STOCKWELL & DONKA MINKOVA, *ENGLISH WORDS: HISTORY AND STRUCTURE* 158 (2001) (arguing that restriction is an unnatural change but conceding that restriction happens “quite frequently” in some contexts).

<sup>152</sup> C.M. MILLWARD & MARY HAYES, *A BIOGRAPHY OF THE ENGLISH LANGUAGE* 205 (3d ed. 2012) (“The type of semantic change easiest to find between OE and ME (and during ME) is narrowing of meaning . . . . [M]any OE words acquired narrower, more specific meanings in ME as a direct result of loans from other languages.”).

<sup>153</sup> *Id.*

<sup>154</sup> *Id.* at 203.

<sup>155</sup> BRÉAL, *supra* note 150, at 106.

<sup>156</sup> LEONARD BLOOMFIELD, *LANGUAGE* 426 (1933).

<sup>157</sup> *See supra* notes 48-49 and accompanying text.

<sup>158</sup> *Corn*, n.1, *OXFORD ENGLISH DICTIONARY* at II.3.a, <http://www.oed.com/view/Entry/41586> (last visited Nov. 7, 2014).

narrowing from any horizon to a horizon decorated by skyscrapers;<sup>159</sup> and *wife* narrowing from any woman of humble rank or low employment to married woman or spouse.<sup>160</sup> The Old English *steorfan*, meaning “to die,” narrowed in Modern English to *starve*, meaning “to die of hunger.”<sup>161</sup> *Art* originally had general meanings connected to “skill,” “technique,” or “craft,” but is now primarily related to aesthetic skill in a fine art.<sup>162</sup> At the time the Constitution was drafted, *science* broadly referred to knowledge or learning, but has narrowed today to refer to the investigation of natural phenomena through observation and experimentation.<sup>163</sup> *Accident* has narrowed from any unforeseen event to an unfortunate one.<sup>164</sup> *Fowl* in Old English referred to any bird, but narrowed to a domesticated bird raised for food or a wild hunted for sport.<sup>165</sup> The meaning of *girl* narrowed from “child or young person of either sex” in Middle English to “female child” or “young woman.”<sup>166</sup>

It is not unusual for two or more ambiguous meanings to coexist for a time before one of the meanings is forced out.<sup>167</sup> Restriction does not necessarily force old meanings out of the lexicon entirely. But even when a meaning is not forced out, semantic overload is resolved as words abandon potentially conflicting meanings or are otherwise narrowed. For example, since *light* (from Old English, meaning “bright,” “brilliant,” “or “shining”) and *light* (from German, the antonym of heavy) coexist in English, it is difficult to use a phrase like “light materials” without resorting to a compound such as “light

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<sup>159</sup> VICTORIA FROMKIN ET AL., AN INTRODUCTION TO LANGUAGE 361 (10th ed. 2013).

<sup>160</sup> GEORGE YULE, THE STUDY OF LANGUAGE 233 (4th ed. 2010).

<sup>161</sup> MCMAHON, *supra* note 26, at 177-78.

<sup>162</sup> CRYSTAL, *supra* note 126, at 224-30; Alan L. Durham, “Useful Arts” in the Information Age, 1999 B.Y.U. L. REV. 1419, 1425 (1999).

<sup>163</sup> Durham, *supra* note 162, at 1425 (“A reference to Dr. Johnson’s definition of ‘scientifick’ will show . . . that the natural science which the present connotation of the word calls to mind was, in the days when the Constitution was written, referred to as ‘natural philosophy.’”) (quoting Giles S. Rich, *Principles of Patentability*, 28 GEO. WASH. L. REV. 393, 396-97 (1960)).

<sup>164</sup> FRANCIS KATAMBA, ENGLISH WORDS: STRUCTURE, HISTORY, USAGE 175 (2004).

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

<sup>166</sup> Hollmann, *supra* note 17, at 304.

<sup>167</sup> See, e.g., TR AUGOTT & DASHER, *supra* note 2, at 12; see also 2 JOHN LYONS, SEMANTICS § 10.4, at 397 (explaining that the context in which an ambiguous word is presented can be “such that all but one of the possible interpretations are irrelevant or relatively improbable”).

weight.”<sup>168</sup> Likewise, *sand* in Old English meant both the strip of land next to a body of water and the particulate matter common to that land. When the German word *shore* was borrowed to refer to the body of land, *sand* was narrowed to mean only the granular particles.<sup>169</sup> The semantic overload created by the ambiguity resulted in the narrowing of both terms.<sup>170</sup>

In addition, restriction increases the amount of information conveyed by the restricted form of a word, compared to the broader form. As the meaning restricts, the term can be applied more precisely and requires less contextual processing.<sup>171</sup> Thus, a restricted term communicates more efficiently. Think back to the restriction of *hound* from designating any dog to designating a long-eared hunting dog.<sup>172</sup> If I tell you that I’ve lost my dog, you might ask me what type of dog he is before trying to find him. When *hound* meant any dog, it did not convey much information about the breed of dog in question. However, when the meaning of *hound* was restricted to large dogs used for hunting, the word conveyed more information to the listener. Compare this to the way a child first learning English may use a word like “dog” to represent any four-legged mammal.<sup>173</sup> The more general the word, the less information it conveys.

Restriction has its opposite. A term designating the prototypical member of a category may be widened or generalized to represent the whole category.<sup>174</sup> For example, *dog* used to refer to specific large or strong breeds of domesticated canines (and still does in Danish), but has since been broadened to include any domesticated canine regardless of size.<sup>175</sup> Widening happens frequently, but less often than restriction.<sup>176</sup>

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<sup>168</sup> TRAUGOTT & DASHER, *supra* note 2, at 12; *see also* Menner, *Homonyms*, *supra* note 110, at 241-42.

<sup>169</sup> C.M. MILLWARD & MARY HAYES, *A BIOGRAPHY OF THE ENGLISH LANGUAGE* 205 (3d ed. 2012).

<sup>170</sup> As discussed in another article, this same effect can arise in cases where confusing use is tolerated in the trademark context. *See* Jake Linford, *Trademark Infringement as Semantic Shift* (2015) (unpublished manuscript) (on file with author).

<sup>171</sup> MCMAHON, *supra* note 26, at 178 (“[A] restricted form is applicable to fewer situations but tells us more about each one.”).

<sup>172</sup> *See supra* note 17 and accompanying text.

<sup>173</sup> ALLAN, *supra* note 129, at 103.

<sup>174</sup> BRÉAL, *supra* note 150, at 115-21; GEERAERTS, *LEXICAL SEMANTICS*, *supra* note 16, at 26-27.

<sup>175</sup> Hollmann, *supra* note 17, at 304.

<sup>176</sup> *See supra* notes 150-151 and accompanying text.

Semantic shift is a natural phenomenon, but in the trademark context, it is also a phenomenon with legal consequences. When a trademarked term is widened to represent the product category as a whole, the mark owner can lose protection in the mark.<sup>177</sup> For example, KLEENEX, the “proprietary name of an absorbent disposable cleansing paper tissue,”<sup>178</sup> has ostensibly broadened over time to add a second polysemous meaning as a designation for “any disposable cleansing paper tissue, regardless of brand.”<sup>179</sup> Likewise, the CELLOPHANE mark lost source significance when a court concluded the mark had primarily become a generic designation for a transparent sheet of semi-viscous paper ideal for preserving food.<sup>180</sup> Consumers who continue to rely on the source significance of a mark that undergoes generislide will be confused,<sup>181</sup> but consumers who have adopted the broader meaning might welcome cheaper competition by a free-riding new entrant who uses the former trademark to identify competing products or services.<sup>182</sup>

Likewise, if a generic term acquires source-significance and is recognized as a trademark, as this Article supports,<sup>183</sup> competitors who plan to use the term to designate their own products will find a mark owner backed with legal authority to secure injunctive relief and/or damages against the competitor’s confusing use. Consumer and competitor investment in the restricted generic term will be the inverse of interest in the widened trademark. Consumers who would not be confused by the competition may pay more for the products

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<sup>177</sup> See *infra* notes 201-207 and accompanying text; see also Jake Linford, *Generislide and Trademark’s Other Slippery Slopes* (2015) (unpublished manuscript) (on file with the author) [hereinafter Linford, *Generislide*].

<sup>178</sup> *Kleenex*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/103818> (last visited Nov. 7, 2014).

<sup>179</sup> ROBERT J. JEFFERS & ILSE LEHISTE, *PRINCIPLES AND METHODS FOR HISTORICAL LINGUISTICS* 129 (1979); see also Heymann, *supra* note 1.

<sup>180</sup> *Du Pont Cellophane Co. v. Waxed Products Co.*, 6 F. Supp. 859 (E.D.N.Y. 1934).

<sup>181</sup> Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 TRADEMARK REP. 1223, 1241 (2007) (noting that doctrines like abandonment “present ‘hard cases’ precisely because there are search cost rationales on both sides of the argument,” and recognizing that, from an economically grounded “search costs perspective, the automatic preference given to one group of consumers over another can be troubling”) [hereinafter Dogan & Lemley, *Search-Costs Theory*].

<sup>182</sup> See generally Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507 (2005); Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. REV. 60 (2008).

<sup>183</sup> See *infra* Part III.B.

they desire because trademark protection can increase costs for competitors, but consumers who have adopted the narrowed meaning will have lower search costs to find the products they desire.

As discussed in Part I.B, the doctrine of trademark incapacity currently denies legal significance to semantic restriction when the term that acquires secondary meaning was once a generic product designation. The doctrine is out of step with the best current understanding of how semantic shift occurs and how language users manage confusing ambiguity. Part III refutes the standard justifications for trademark incapacity, then proposes an alternative doctrinal approach to bring trademark law in line with our best evidence about how consumers process restriction.

### III. TRADEMARK (IN)CAPACITY AND THE MYTH OF SHIFT-RESISTANT TERMS

If trademark law aims to optimize consumer search costs and minimize consumer confusion, then the law should reflect how consumers will likely process the semantic change that occurs when trademark meaning is created. The treatment of generic marks under the doctrine of trademark incapacity is at cross-purposes with these aims. The process by which a generic trademark gains source significance is a form of restriction, and ignoring restriction—and the consumer perception of source significance that comes with it—may well increase error in trademark litigation. Competition justifications for trademark incapacity likewise fall short precisely because they purport to divorce competition concerns from consumer confusion, even though consumer confusion is the *sine qua non* of trademark infringement.

Because trademark law should accurately reflect consumer concerns and reduce consumer search costs, we should embrace a doctrine that better reflects regular semantic shift. Trademark law should thus abandon the incapacity doctrine. This Article argues instead for applying a primary significance standard for the acquisition of trademark protection. Under the primary significance standard, a term for which the primary meaning is a source-signifying trademark should receive federal trademark protection, regardless of whether the term was once a generic designation.

#### A. *Recognizing Trademark’s Capacities*

Parts I.B and I.C described the current function of the trademark incapacity doctrine as it currently operates, and outlined several proposed justifications for the doctrine. This Section now turns to the argument, grounded in the semantic shift literature, for why the law should abandon the trademark

incapacity doctrine in favor of recognizing the capacity of any term to serve as a trademark where the appropriate semantic shift has in fact occurred.

First, it is important to separate questions of trademark incapacity from the general inquiry that a fact finder must make into whether a mark is source-signifying. If a term is *currently* generic, the term does not merit trademark protection because there is insufficient source significance and therefore no trademark right to enforce. Trademark incapacity, however, adds another layer to the inquiry by requiring the fact finder to determine whether the term was *ever* a generic designation for the product category, often ignoring current source significance. Thus, in *Grottanelli*, the court granted greater weight to a dictionary definition stating that *hog* was once used to designate any big motorcycle, than to evidence that 98 percent of surveyed consumers associated the term *hog* with Harley Davidson motorcycles.<sup>184</sup>

What harm requires this linguistic grave-digging? This second level of inquiry requires justification above and beyond the obvious harm of granting trademark protection to a term the majority of consumers see as a generic product designation. If there is no separate justification, then we should simply handle the analysis as we do for descriptive marks, and look for secondary meaning as measured by consumer perception, claimant's efforts, and other relevant proxies. Part III.A.1 describes and refutes an error-cost justification for trademark incapacity. Part III.A.2 then considers and rebuts justifications for trademark incapacity grounded in competition policy.

#### 1. Refuting the Error-cost Justification for Trademark Incapacity

Some courts and scholars argue that trademark incapacity is justified because it reduces administrative and error costs,<sup>185</sup> but ignoring semantic restriction may well increase error and consumer confusion. Trademark law has, to date, artificially hampered recognition of semantic restriction when it occurs. This limitation may impose real costs on consumers, costs that trademark law ostensibly seeks to alleviate.

Enforcement costs come in two general varieties: administrative costs—the cost of getting an answer, and error costs—the costs imposed on litigants and society if a court

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<sup>184</sup> *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999); *see supra* note 48-49 and accompanying text.

<sup>185</sup> *See generally* Bone, *Enforcement Costs*, *supra* note 70.

reaches the wrong result.<sup>186</sup> In the trademark incapacity context, both the administrative and error cost analyses turn in part on the relative frequency with which we should expect restricting shifts.<sup>187</sup> Courts and scholars articulating the doctrine of trademark incapacity often posit that generic terms generally do not acquire source-signifying meaning,<sup>188</sup> treating the few cases where courts have recognized the shift, like *Singer* or *Goodyear*, as outliers.<sup>189</sup> Consider again the COMPUTER trademark hypothetical discussed in Part I. Trademark rights in COMPUTER for an information processing device appear problematic because we are in the midst of an era where it seems that nearly everyone in the United States owns or has access to a computer. If the majority of trademark incapacity cases were like this hypothetical case, one might conclude that a shift in meaning from a generic product designation to source signifier is so unlikely that we should avoid the administrative cost of finding out whether it ever happens. Trademark incapacity’s static view of language seems sensible at that extreme end of the scale.

But if, as Part II describes, meaning in language is subject to persistent, if not continual change,<sup>190</sup> one might be puzzled by how trademark law handles generic terms. In particular, the doctrine of trademark incapacity may generate error because it turns on a misapprehension about how frequently semantic restriction occurs. A shift from a generic product designation to a source-signifying trademark is a prototypical

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<sup>186</sup> See *id.* at 2123 (“In general, there are two types of enforcement cost: administrative (or process) costs and error costs.”).

<sup>187</sup> *Id.*

<sup>188</sup> See, e.g., *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009) (“[G]eneric terms by definition are incapable of indicating source.”); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.”). Occasionally, courts have phrased the trademark incapacity doctrine in a manner that might leave room for a source-significance-acquiring semantic shift. See, e.g., *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986) (“A generic term is the common descriptive name of a class of goods or services, and, *while it remains such* common descriptive name, it can never be registered as a trademark because such a term is ‘merely descriptive’ within the meaning of § 2(e)(1) of the Lanham Act and is incapable of acquiring de jure distinctiveness under § 2(f) of the Lanham Act.”) (emphasis added) (citations omitted).

<sup>189</sup> See *supra* notes 62-64 and accompanying text.

<sup>190</sup> See Anne Curzan, *What Makes a Word Real?*, TED (Mar. 2014), [http://www.ted.com/talks/anne.curzan\\_what\\_makes\\_a\\_word\\_real](http://www.ted.com/talks/anne.curzan_what_makes_a_word_real) (describing the speaker’s practice of delaying the start of her college English class each day until students share two new words).

example of restrictive change, and restriction is, by some accounts, the most common form of semantic shift.<sup>191</sup> Even if restriction were no more common than any other form of semantic shift,<sup>192</sup> there is no reason from a linguistic standpoint to think a generic term cannot change to primarily designate a single source for a good, or that consumers cannot process the restriction. The current trademark regime may introduce error by pretending that restriction cannot happen or happens so rarely that it should be ignored. In addition, the doctrine encourages courts to engage in faulty compartmentalization of compound marks (as with HOTELS.COM, CHOCOLATE FUDGE SODA or TURBODIESEL).<sup>193</sup> The trademark incapacity doctrine is thus an unfortunate static outlier in an otherwise dynamic trademark system.

Trademark incapacity might nevertheless be justified if the harm from a false positive (the shift has not occurred, but the court concludes the mark can be protected) is greater than the harm from a false negative (the shift has occurred, but the court concludes the mark cannot be protected).<sup>194</sup> Denying protection under the doctrine may thus turn on a perceived imbalance in error costs. Some have suggested that allowing a generic term to acquire source significance will increase consumer search costs.<sup>195</sup> For example, if one seller is granted trademark rights in COMPUTER for personal information processing devices, other sellers might struggle to find another word that adequately identifies competing products to consumers. Consumers might find only one type of computer and miss a product they would prefer to buy because the trademark rights of the company selling computers under the COMPUTER trademark prohibits competitors from using the term “computer” to sell them.

This apprehension drove the Supreme Court’s analysis in *Kellogg Co. v. National Biscuit Co.*<sup>196</sup> There, the Court contemplated the competitive impact of granting National Biscuit an exclusive right to use the term “Shredded Wheat”

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<sup>191</sup> See *supra* notes 151-154 and accompanying text.

<sup>192</sup> See STOCKWELL & MINKOVA, *supra* note 151, at 158.

<sup>193</sup> See *supra* notes 50-52, 55-57, and accompanying text.

<sup>194</sup> Cf. Joseph Miller, *Error Costs & IP Law*, 2014 U. ILL. L. REV. 175 (describing how in close cases, courts should put a thumb on the scale against interpreting intellectual property provisions broadly because the cost of a false positive is higher than the cost of a false negative).

<sup>195</sup> See *supra* note 80 and accompanying text.

<sup>196</sup> 305 U.S. 111 (1938). I will return to *Kellogg* in the discussion of functionality and trademark incapacity in Part III.A.2(3).



when that was the term by which consumers had come to identify the product sold by both parties.<sup>197</sup> Denying Kellogg the right to refer to the product by name would have limited its ability to communicate with interested consumers. This could result in an increased price for the “official” shredded wheat product line as competitors are required to find a different, but sufficiently similar name by which to identify their competing products.

While courts have posited that protecting generic terms increases consumer search costs because it prevents competitors from providing consumers with information they need about the products offered,<sup>198</sup> that is the case only so long as the term is *currently* perceived by a critical mass of consumers as generic. In a counterfactual world where the majority of consumers see shredded wheat not as a product category but instead as a trademark, the consumer search cost rationale does not support trademark incapacity.<sup>199</sup> The purported imposition on consumers has little to do with whether the term *was once* generic or merely descriptive.<sup>200</sup>

The consumer search cost problem in the trademark incapacity context can be better understood by considering how a trademark loses protection. A mark can lose protection if it ceases to serve as a source signifier.<sup>201</sup> Trademark law applies a primary significance or “majority wins” standard to determine when a shift in consumer perception changes a protectable source signifier into an unprotectable product designation.<sup>202</sup> Courts do not ask whether *every* consumer sees

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<sup>197</sup> *Kellogg*, 305 U.S. at 118.

<sup>198</sup> *See, e.g.*, *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 14 (1st Cir. 2008) (“[I]n accord with the primary justifications for protecting trademarks—to aid competition and lower consumers’ search costs—the law does not grant any party exclusive rights to use generic terms as trademarks.”).

<sup>199</sup> Scholars engaging in economic analyses of trademark law argue the trademark incapacity doctrine is likely inefficient. *See, e.g.*, Bone, *Enforcement Costs*, *supra* note 70, at 2124; Desai & Rierson, *supra* note 64, at 1832-33. *But see* Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003) (arguing on First Amendment grounds that even descriptive marks do not merit trademark protection).

<sup>200</sup> *Cf.* Goldman, *supra* note 182 (describing multiple constituency problems in the internet search context); Grynberg, *supra* note 182 (arguing that defendants in trademark litigation may serve as proxies for consumers who are not confused by, and may prefer the information conveyed by, the allegedly confusing use).

<sup>201</sup> 15 U.S.C. § 1127(2) (L.A. § 45).

<sup>202</sup> 15 U.S.C. § 1127 (L.A. § 45) (“A mark shall be deemed ‘abandoned’ . . . [w]hen any course of conduct of the owner, including acts of omission as

the mark as generic. Rather, courts considering a claim of ex post genericness look for evidence that a majority of the relevant consumer base now uses the mark as a generic product designation. Once a majority of consumers see the mark as generic, it no longer qualifies for trademark protection.<sup>203</sup> Many marks have lost trademark protection in the United States, including aspirin, cellophane, and escalator.<sup>204</sup>

The slide out of protection (which elsewhere I have called “generislide”)<sup>205</sup> is justified on the ground that the majority of consumers see the term primarily as a product designator, even though some consumers will find it more difficult to locate the product they want if, for example, they think of *aspirin* as a designation for a pain reliever from a particular source. Stacy Dogan and Mark Lemley have noted the law is willing to “sacrifice” the interests of consumers who still see a mark as source-signifying “as soon as a critical mass of consumers treats the term as generic,”<sup>206</sup> because “the harm to consumers who associate the term with the entire class of goods outweighs the harm to the diminishing number who view it only as a mark.”<sup>207</sup> Under a search-cost rationale, the mark should fall into genericness so that competitors can sell their own “aspirin” under another mark.

The same search-cost rationale should shape the outcome when a majority of consumers see a formerly or potentially generic term primarily as a source-signifying trademark.

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well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.”); *see also* Big Island Candies, Inc. v. The Cookie Corner, 269 F. Supp. 2d 1236, 1251 (D. Haw. 2003) (“[F]or a genericness survey, majority usage controls.”) (internal citations omitted).

<sup>203</sup> *See infra* notes 271-274 and accompanying text. The Xerox Corporation has been fighting this trend for decades. *See, e.g.*, Linford, Generislide, *supra* note 177 (describing Xerox’s efforts).

<sup>204</sup> *See* Haughton Elevator Co. v. Seeberger, 85 U.S.P.Q. (BNA) 80 (Apr. 3, 1950); Du Pont Cellophane Co. v. Waxed Products Co., 6 F. Supp. 859 (E.D.N.Y. 1934); Bayer Co. v. United Drug Co. 272 F. 505, 512 (S.D.N.Y. 1921) (holding that aspirin had become a generic mark to consumers, but not pharmacists, who were familiar with the chemical name acetylsalicylic acid).

<sup>205</sup> *See* Linford, Generislide, *supra* note 177.

<sup>206</sup> Dogan & Lemley, *Consumer Search Costs*, *supra* note 82, at 794.

<sup>207</sup> Dogan & Lemley, *Search-Costs Theory*, *supra* note 181, at 1242 (“[T]he genericness doctrine can impose substantial search costs on consumers, particularly when a once-famous mark such as ‘aspirin’ or ‘thermos’ becomes generic.”). Courts do not always leave those confused consumers and the producers who sell to them without remedy. *See infra* notes 286-301 and accompanying text.

Under the trademark incapacity doctrine, however, the use of a term as a nominative product designator always trumps adjectival trademark use, even if a majority of the public sees the term primarily as a trademark. It may nevertheless be the case that the junior user stands as a proxy for consumers who benefit from potentially confusing speech, or who easily process confusing ambiguity. Michael Grynberg, for example, has argued that courts should expressly recognize that the defendant in a trademark lawsuit can serve as a proxy for consumers who are not confused by and therefore may benefit from the junior user’s entry. Such a focus, from Grynberg’s perspective, would minimize problematic trademark expansion,<sup>208</sup> and might be best applied when it is unclear how many consumers can tolerate confusion and how many suffer from it. But if there is clear evidence about the relative size of the constituencies, then primary significance is the proper test for whether an *ex ante* generic term qualifies for trademark protection.

If trademark law properly focuses on minimizing search costs for the majority of consumers,<sup>209</sup> the trademark incapacity doctrine should give us pause. Applying the doctrine of trademark incapacity can increase consumer search costs. As scholars have recognized in the generislide context, favoring the perception of a dwindling minority of consumers that a word is a trademark harms the majority who see a former mark as a generic product identifier. If trademark law is to reduce consumer search costs, the law should apply the same primary significance standard to determine whether a shift in consumer perception has changed a product designation into a protectable source signifier.

## 2. Rebutting the Competition Justification for Trademark Incapacity

If avoidance of error costs does not explain trademark incapacity, perhaps courts are instead justified in ignoring restrictive shift in the trademark space on normative grounds. These normative justifications are roughly grouped together as aspects of competition policy and fall into three basic

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<sup>208</sup> See Grynberg, *supra* note 182. Eric Goldman has made a similar argument in the internet search context, positing that at least some consumers benefit when a search for information about one vendor presents information about competing vendors (for example, presenting results for Adidas shoes when a searcher types “Nike”). See Goldman, *supra* note 182, at 525.

<sup>209</sup> See, e.g., Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1690-91 (1999).

categories. First, courts frequently observe that allowing a claimant to “convert common descriptive names, which belong to the public, to their own exclusive use”<sup>210</sup> could provide the claimant with something approaching monopoly power. This language depletion argument presumes stasis in language change. But as the semantic shift literature makes clear, stasis is not a feature of living languages, and concerns about language depletion are likely overstated. Second, some courts and scholars ground competition policy in a preference for disruption or second entrants, but doing so privileges language change benefiting some parties over others. Finally, some courts and scholars have mistakenly grouped trademark incapacity cases with functionality cases, which consider whether a product feature (like springs holding up a construction sign) qualify for protection as source-signifying trade dress. But lumping generic terms in with product features misreads early case law. In addition, unlike generic terms, product features are relatively static. Indeed, as Romeo Montague recognized in Shakespeare’s play, the name of a thing is chimerical, while its features can be essential.<sup>211</sup>

(1) *Language Depletion and Monopoly Power*

Competition analysis is sometimes couched in terms of language depletion.<sup>212</sup> The language depletion argument posits that protecting a previously generic term as a trademark conveys something akin to monopoly power.<sup>213</sup> At the extreme,

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<sup>210</sup> *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 848 (1961).

<sup>211</sup> WILLIAM SHAKESPEARE, *ROMEO & JULIET*, act 2, sc. 2, in *THE OXFORD SHAKESPEARE: THE COMPLETE WORKS OF WILLIAM SHAKESPEARE* (W.J. Craig ed., 1914) (1597) (“What’s in a name? that which we call a rose / By any other name would smell as sweet.”).

<sup>212</sup> Xuan-Thao N. Nguyen, *Nationalizing Trademarks: A New International Trademark Jurisprudence?*, 39 *WAKE FOREST L. REV.* 729, 742-43 (2004) (describing how trademark incapacity prevents the removal of words from language through trademark propertization of generic terms); see also Ann Bartow, *The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues*, 97 *KY. L.J.* 263, 281 (2009) (“Providing an incentive for companies to coin fanciful trademarks makes a certain kind of sense if one is concerned about language depletion.”); Alexandra J. Roberts, *How to Do Things with Word Marks: A Speech-Act Theory of Distinctiveness*, 65 *ALA. L. REV.* 1035, 1055 (2014) (“If the PTO and courts overprotect descriptive marks by allowing their registration and enforcement without secondary meaning, they risk depleting the language available to competitors and chilling speech by granting a property right in a term that serves no trademark function.”).

<sup>213</sup> See *supra* note 76 and accompanying text.

the argument is likely correct at least some of the time. If we all use the word “computer” to refer to our personal information processing devices, sellers will likely need to use the word “computer” to sell competing devices to us. If one seller is allowed to secure trademark rights in COMPUTER as a mark, other sellers may not be able to tell consumers about their offerings without exposing themselves to legal liability.

In a static lexicon, allowing a trademark owner to secure rights in a generic term would be problematic precisely because it is impossible to imagine other generic designations arising in a language that does not change. Trademark incapacity might thus prevent the removal of words from common language. However, in the absence of lexical stasis, the language depletion rationale is significantly weaker.<sup>214</sup> Consider this modification of the aforementioned COMPUTER hypothetical. One of the first “computers” was imagined by Charles Babbage, who called his conceptual device an “analytical engine.”<sup>215</sup> If you were to offer a new line of computing devices under the mark ANALYTICAL ENGINE, the term would be unfamiliar to most modern consumers. But the etymology would be problematic. The term would have a history, known to those familiar with Babbage’s work. If you tried to enforce your rights against me when I sell computers under a mark similar or identical to your ANALYTICAL ENGINE mark, a court may reject your claim in accordance with the trademark incapacity doctrine solely because the first computer imagined was known as an analytical engine. Thus, regardless of any evidence of source significance in the eyes of consumers, your claim against me would fail.<sup>216</sup>

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<sup>214</sup> The depletion or word scarcity justification has more traction in the color depletion context, although the Supreme Court rejected a strong form of the color depletion rationale in *Qualitex Co. v. Jacobsen Products Co., Inc.* See 514 U.S. 159 (1995); *supra* note 76. Despite innovations in the color naming department—for example, Farrow & Ball offers paint in such obfuscatory varieties as babouche, pelt, and brinjal—we tend to think of colors as coming in three primary and three tertiary shades. In fact, many consumers cannot discern subtle differences in shade. The author, for example, scored a 31 on an online color-acuity test, suggesting a less than perfect ability to distinguish between similar shades. Colors can be, and are frequently renamed, but for many consumers, eggplant is just purple. The underlying color perceived does not change.

<sup>215</sup> See, e.g., ALEXANDER JOHN ANDERSON, FOUNDATIONS OF COMPUTER TECHNOLOGY 397 (1994).

<sup>216</sup> Rejecting your hypothetical claim would also be problematic for consumers who look to the mark ANALYTICAL ENGINE as a source for your computers and who would be confused by my use of the same term for similar products. See *supra* notes 201-209 and accompanying text.

Fears of language depletion are in fact likely overstated. For example, *champagne* was seen as a generic designation for sparkling wine until the term was retaken as a Geographic Indication within the European Union for sparkling wine produced in the Champagne district of France.<sup>217</sup> Spanish producers of sparkling wine were forced to find a new identifier for their product, and chose *cava*.<sup>218</sup> The language depletion rationale would lead one to expect that Spanish producers of sparkling wine would be crippled by the inability to use *champagne*. That does not appear to be the case. Sales of Spanish cava did not drop after the rechristening, either in Spain or the rest of Europe.<sup>219</sup> In fact, one news outlet reported that as of 2002, Spain sold “more of its celebratory wine under the name of ‘cava’ than all the champagne from Champagne.”<sup>220</sup> There is some indication, however, that U.S. consumers see cava as a cheap option compared to “authentic” champagne.<sup>221</sup> This suggests cava may be an imperfect replacement for champagne. Cava producers may well invite some perception problems because they set an aggressively low price for cava.<sup>222</sup> On the other hand, that perception may have driven consumers to cava during financial downturns, allowing cava to successfully compete as a low-cost entrant.<sup>223</sup>

Furthermore, rejecting semantic shift based on the history of the word is a fallacy common to linguists and lexicographers. On occasion, new meanings are rejected based on the fallacy known as “argument from etymology.”<sup>224</sup> An argument from

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<sup>217</sup> See Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications*, 58 HASTINGS L.J. 299, 321-23 (2006).

<sup>218</sup> *Id.* at 369. *Cava* is Spanish for “caves,” where wine was preserved or aged in the 1800s in the Catalonian region of Spain.

<sup>219</sup> *L’Espagne Effervescente en France*, VINS MAG., Winter 2002, at 16 (describing a growing success in northern France of sales of cava).

<sup>220</sup> *French Wrath Produces Bitter Whine*, WASH. TIMES, Nov. 29, 2002, <http://www.washingtontimes.com/news/2002/nov/29/20021129-102555-4226r>.

<sup>221</sup> Lettie Teague, *Cava Seeks to Make a New Name for Itself*, WALL ST. J., July 4, 2013, <http://www.wsj.com/articles/SB10001424127887324183204578563500481816138> (describing a tasting where the tasters expressed unwillingness to pay \$35 per bottle “for a Cava!” but might consider paying that price for Champagne).

<sup>222</sup> Victoria Moore, *Cava: Why It’s Time to Stop Laughing at this Spanish Sparkler*, THE TELEGRAPH, May 31, 2013, <http://www.telegraph.co.uk/foodanddrink/wine/10089672/Cava-why-its-time-to-stop-laughing-at-this-Spanish-sparkler.html>.

<sup>223</sup> See, e.g., Nick Squires, *Prosecco and Cava Have Edge on Champagne in Sparkling Wine Market*, THE TELEGRAPH, Dec. 31, 2009, <http://www.telegraph.co.uk/foodanddrink/wine/6914021/Prosecco-and-cava-have-edge-on-champagne-in-sparkling-wine-market.html>.

<sup>224</sup> See, e.g., GEOFFREY HUGHES, A HISTORY OF ENGLISH WORDS 27 (2000).

etymology refutes a semantic shift, or the growth of a new meaning, based on the perceived conflict between the new meaning and earlier meanings. As C.S. Lewis once trenchantly observed, however, resistance to language change often springs up precisely because a vocal minority is uncomfortable with how established words have taken on new meanings.<sup>225</sup>

(2) *Competition Policy and the Preference for Disruption*

Trademark incapacity might instead be normatively grounded in a different sort of competition analysis, based on a perceived right of competitors that trumps both the right of a putative mark owner and the understanding of consumers.<sup>226</sup> We might call it a preference for disruption, an assumption that any communication cross-cutting a dominant market player is valuable in and of itself. This disruption rationale is not entirely inconsistent with the marketplace of ideas

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<sup>225</sup> C.S. LEWIS, *STUDIES IN WORDS* 18 (2d ed. 1967) (“Statements that honour, or freedom, or humour, or wealth ‘do not mean’ this or that are proof that it was beginning to mean, or even had long meant, precisely this or that. We tell our pupils that *deprecate* does not mean *depreciate* or that *immorality* does not mean simply *lechery* because these words are beginning to mean just those things. We are in fact resisting the growth of a new sense.”) (emphasis in original).

<sup>226</sup> See *supra* notes 75-82 and accompanying text. Rebecca Tushnet has argued that the point of the functionality and de facto secondary meaning doctrines is to encourage competition “by preventing a single producer from obtaining rights in a phrase that is necessarily generic even if consumers associate the phrase with the market leader—as with AOL’s use of ‘You’ve Got Mail.’” Rebecca Tushnet, *Why the Customer Isn’t Always Right: Producer-Based Limits on Rights Accretion in Trademark*, 116 *YALE L.J. (THE POCKET PART)* 352, 353 (2007) [hereinafter Tushnet, *Producer-Based Limits*]. Tushnet might also embrace trademark incapacity for the same reason she criticizes the dilution doctrine: “[A] doctrine that favors meanings approved by established producers above meanings offered by challengers . . . is anticompetitive.” Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 *TEX. L. REV.* 507, 561 (2008) [hereinafter Tushnet, *Sixty Milliseconds*]; cf. Irina D. Mantra, *Bearing Down on Trademark Bullies*, 22 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 853, 853-54 (2012) (“[T]rademark bullying has become a persistent problem . . . achieving anti-competitive results.”). In *Abercrombie*, for example, the court identified a competitor’s “right to call an article by its name.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); cf. Stephanie M. Greene, *Sorting Out “Fair Use” and “Likelihood of Confusion” in Trademark Law*, 43 *AM. BUS. L.J.* 43, 70-71 (2006) (arguing that allowing monopoly of a descriptive term creates a barrier to entry because a potential competitor cannot use the descriptive term and therefore must expend more effort to communicate with and attract consumers). *But see* Linford, *Adverse Possessor*, *supra* note 29, at 721-26 (responding to critiques of protection of descriptive terms from a productive use framework).

rationale for the First Amendment, which posits that the more speech we receive (collectively), the more likely that truth will win out.<sup>227</sup> But the current incapacity doctrine defaults to an assumption that the harm from recognizing trademark rights to consumers and producers who use the term as a product designation is so great that it must trump any benefit to consumers who have come to see the mark as source-signifying, or to the producer who has invested resources in creating source significance. Thus, the *ex ante* bar against protecting a trademark derived from a generic designation is packaged as competition policy, but nonetheless grounded in the assumption that some competitors, and some consumers, merit protection over others.

A doctrine favoring the junior user in the trademark incapacity context may do so because of a general distrust of trademark owners and the “black arts” of marketing. Recent trends include neuromarketing, which purports to make advertisement more effective by targeting subconscious rather than conscious responses.<sup>228</sup> If marketers hold some power to influence consumer perception at a subconscious level, perhaps some courts properly distrust any evidence of shift in consumer perception.<sup>229</sup> Unfortunately, discounting all evidence of consumer perception would effectively unravel the secondary meaning inquiry entirely and leave us with nothing but arguments from etymology. Even if we presume that marketers engage in emotional rather than practical appeals, consumers might still prefer to purchase products to which they feel an emotional connection.<sup>230</sup> It is also not clear why we should assume marketing tricks are employed exclusively by the senior user, and not the junior user. Assessing the persuasion

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<sup>227</sup> *See, e.g.*, *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail, rather than to countenance monopolization of that market . . .”).

<sup>228</sup> *See, e.g.*, Natasha Singer, *Making Ads that Whisper to the Brain*, N.Y. TIMES, Nov. 13, 2010, <http://www.nytimes.com/2010/11/14/business/14stream.html>.

<sup>229</sup> *But see* Levy, *supra* note 88, at 1213 (“While corporations with large marketing budgets undoubtedly have a great deal of power as language users, it is presumptuous to assume that a single corporation, even with a large marketing budget, has the ability to cause the majority of consuming America to forget that the mark is also a common name. It stands to reason that other forces are likely in play.”).

<sup>230</sup> Bone, *Goodwill*, *supra* note 120, at 602-03 (summarizing Phillip Nelson’s argument that critics lack a normative basis for distinguishing between good (properly adopted) and bad (advertising induced) preferences) (citing Philip Nelson, *The Economic Consequences of Advertising*, 48 J. BUS. 213, 213 (1975)).



sophistication of consumers<sup>231</sup> is a problem that applies to each interaction between a consumer and a seller, whether that seller is the first entrant or the most recent entrant.

Finally, every semantic innovation is cabined by public acceptance or the lack thereof.<sup>232</sup> For example, MTV used an advertising campaign in New York City in a failed attempt to insert new terms into the language, like *round* as a synonym of cool. If the new terms were adopted, the changes did not last, leading at least one scholar to conclude, “You cannot sell a language.”<sup>233</sup>

### (3) *Functionality and Trademark Incapacity*

A third way to articulate the justification for trademark incapacity is to view it as part of a broader functionality doctrine.<sup>234</sup> The Supreme Court’s functionality jurisprudence has been less than clear,<sup>235</sup> and the Lanham Act fails to define the term. But it may only slightly oversimplify to say the functionality doctrine prevents an incumbent producer from barring new entrants from selling a product with a given feature, even if the product feature is clearly source-signifying,<sup>236</sup> so long as the feature is also one that a competitor needs to use in order to offer a competing product.<sup>237</sup> For

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<sup>231</sup> See Beebe, *Search and Persuasion*, *supra* note 27 at 2025.

<sup>232</sup> See *supra* notes 99-102 and accompanying text. See also Hollmann, *supra* note 17, at 535 (describing a nonce-formation, a failed attempt to coin a new word).

<sup>233</sup> SETH LERNER, *INVENTING ENGLISH* 259 (2007).

<sup>234</sup> See *supra* note 78 and accompanying text; see also Mark P. McKenna & Katherine J. Strandberg, *Progress and Competition in Design*, 17 *STAN. TECH. L. REV.* 1, 5 (2013) (“[T]rademark law subordinates its static competition goals to the patent and copyright systems’ judgments about how to encourage inventive and creative progress and promote dynamic competition.”).

<sup>235</sup> See generally Graeme B. Dinwoodie, *The Story of Kellogg Co. v. National Biscuit Co.: Breakfast with Brandeis*, in *INTELLECTUAL PROPERTY STORIES* 220 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2005) [hereinafter Dinwoodie, *Story of Kellogg*].

<sup>236</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 213 (2000) (“Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.”); Bone, *Enforcement Costs*, *supra* note 70, at 2180 (“The goal of the functionality doctrine is to strike a balance between limiting the acquisition of market power and reducing information-related consumer harms.”).

<sup>237</sup> There is some disagreement on whether functionality protects a right to compete or a right to copy. Compare Robert G. Bone, *Trademark*

example, if a product feature like a dual spring design on a traffic sign is considered an essential feature of the product,<sup>238</sup> then a putative mark owner cannot secure trade dress protection—protection for packaging and designs, rather than words or symbols—whether or not consumers perceive the feature as source-signifying.<sup>239</sup>

On the surface, the functionality inquiry is similar to the trademark incapacity inquiry. But trademark incapacity does not fall within the umbrella of functionality for two interconnected reasons. First, the connection between functionality and trademark incapacity is due in part to a misreading of the Supreme Court's decision in *Kellogg Co. v. National Biscuit Co.*<sup>240</sup> The decision in *Kellogg*, which has an important functionality aspect,<sup>241</sup> is also mistakenly treated as a progenitor of trademark incapacity.<sup>242</sup> In *Kellogg*, the Court denied relief to National Biscuit, which sought to prevent Kellogg from selling a competing breakfast cereal in the same

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*Functionality Revisited and Revised*, at 21-22 (Univ. Tex. Law Sch., Law and Econ. Research Paper No. e554, 2014), available at <http://ssrn.com/abstract=2433179> (noting the shift in functionality doctrine from protecting a right to copy to protecting the right to compete), and Dinwoodie, *Story of Kellogg*, *supra* note 235, at 246-47 (arguing that the Court has not been clear on whether patented product features are functional because the quid pro quo of patent protection requires those features to be thrust into the public domain, creating a right to copy, or because copying the features is necessary to sell the product and thus necessary to maintain a competitive infrastructure) with McKenna & Strandberg, *supra* note 234, at 29 (arguing that the right to copy unpatented features is the basis of the functionality doctrine because it provides the basis for free competition), and Mark P. McKenna, *(Dys)functionality*, 48 HOUS. L. REV. 823, 836-39 (2011) (suggesting that courts considering the functionality doctrine, at least from a patent perspective, have focused on the right of competitors to “share in the benefit of consumer desire for objects in a particular form” by copying that form, rather than the right to compete generally).

<sup>238</sup> See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

<sup>239</sup> See *supra* notes 236-237 and accompanying text.

<sup>240</sup> *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111 (1938).

<sup>241</sup> *Id.* at 122 (holding that defendant was entitled to make the biscuits at issue in a “pillow-shape,” because the shape “is functional” and “the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape”).

<sup>242</sup> See, e.g., *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986); Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 880 n.229 (2004) (“The leading case on de facto secondary meaning is the Supreme Court’s decision in *Kellogg* . . . which held that there was no trademark rights in ‘shredded wheat,’ despite the fact that consumers recognized that there was a single source of the product.”).

“pillow” shape as National Biscuit (the functionality issue),<sup>243</sup> and using the name “shredded wheat” to do so (the ostensible trademark incapacity issue).<sup>244</sup> The blend of the two concepts in the Court’s regrettably unclear opinion<sup>245</sup> has understandably led some courts and commentators to think the same concerns animate both functionality analysis and application of the trademark incapacity bar. But *Kellogg* actually turns on whether the term “shredded wheat” had become or was currently operating as a generic designation, rather than its etymology as a generic term.<sup>246</sup> Understanding semantic shift helps us understand how trademark incapacity and functionality turn on distinct issues.

In *Kellogg*, National Biscuit sought to bar Kellogg’s sale of pillow-shaped breakfast cereal biscuits on the ground that both the shape of the biscuits and the name “shredded wheat” were distinctive source signifiers that identified the product as coming from National Biscuit.<sup>247</sup> National Biscuit’s predecessor in interest held a patent in the pillow-shaped biscuits and the machinery to make them.<sup>248</sup> The patents expired in 1912, thrusting the production method into the public domain.<sup>249</sup> If the shape of the biscuits were treated as a protected source signifier, Kellogg could be barred from offering the biscuits for sale. The Court denied National Biscuit’s claim to trademark protection in the pillow shape.<sup>250</sup> Because the biscuit patents had expired, the Court concluded that Kellogg had a right to copy the shape and the method for making the biscuits.<sup>251</sup>

The Court in *Kellogg* also held that National Biscuit possessed no exclusive right to use “shredded wheat” as a

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<sup>243</sup> *Kellogg*, 305 U.S. at 119-22.

<sup>244</sup> *Id.* at 117-19, 121.

<sup>245</sup> See Dinwoodie, *Story of Kellogg*, *supra* note 235, at 238-39; 2 MCCARTHY, *supra* note 40, § 12:47.

<sup>246</sup> 2 MCCARTHY, *supra* note 40, § 12:47 (“Although its opaque opinion is far from clear, the U.S. Supreme Court in [*Kellogg*] apparently held that all that plaintiff had proven was a minority usage or de facto secondary meaning in the generic name ‘shredded wheat.’”).

<sup>247</sup> *Kellogg*, 305 U.S. at 115.

<sup>248</sup> *Id.* at 119-20 (“[O]n the expiration of a patent . . . there passes to the public the right to make the machine in the form in which it was constructed during the patent.”) (citing *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 185 (1896)); Dinwoodie, *Story of Kellogg*, *supra* note 235, at 239.

<sup>249</sup> *Kellogg*, 305 U.S. at 114 (“[The district court] held that upon the expiration of the [patent], the name of the patented article passed into the public domain.”); see also Dinwoodie, *Story of Kellogg*, *supra* note 235, at 225.

<sup>250</sup> *Kellogg*, 305 U.S. at 119-20.

<sup>251</sup> *Id.* at 119.

source signifier. While that part of the holding is cited as an early example of the trademark incapacity doctrine,<sup>252</sup> the ruling instead turns primarily on the Court's perception that National Biscuit never established "shredded wheat" was primarily a source signifier. The Court instead categorized National Biscuit's evidence of source significance as insufficient.<sup>253</sup> The Court never opined on what should happen if National Biscuit's evidence established that "shredded wheat" was primarily a source signifier.<sup>254</sup>

*Kellogg* is thus a peculiar starting place for the doctrine of trademark incapacity. The central feature of the doctrine is to deny protection to terms that were once generic, even in the face of probative evidence of primary source significance. Indeed, the Court noted that the patents on the process for creating the pillow shaped biscuits "repeatedly used" the word "shredded" . . . as descriptive of the product."<sup>255</sup> In light of this use, the term "shredded wheat" was "essentially necessary" to describe the product.<sup>256</sup> The Court also noted that Kellogg's right to make the article included "the right to use the term by which the public knows it."<sup>257</sup> The present tense of "knows" here is telling. As the Court articulates, "shredded wheat" was a generic designation for the product in question when the case was decided.<sup>258</sup> National Biscuit failed to show a change in

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<sup>252</sup> See *supra* note 242.

<sup>253</sup> *Kellogg*, 305 U.S. at 113 ("[T]o establish a trade name in the term 'shredded wheat' the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer. This it has not done.").

<sup>254</sup> In *National Biscuit Co. v. Kellogg Co.*, 91 F.2d 150 (3d Cir. 1937), the Third Circuit enjoined Kellogg's use of the pillow shape and the term "shredded wheat." The court concluded that the process for making the pillow-shaped biscuits entailed no shredding, and thus the term "shredded wheat" was suggestive and capable of bearing source significance. *Id.* at 152-53. The court also seemed troubled that Kellogg had frequently changed the name of its pillow-shaped biscuit cereal. The court viewed these name changes as a deliberate attempt to deceive the public and free ride on National Biscuit's goodwill. *Id.* at 153-55. The court was also persuaded that National Biscuit had successfully developed source significance in the term "shredded wheat," *id.* at 153, and that the resulting "property right . . . should be respected," *id.* at 154.

<sup>255</sup> *Kellogg*, 305 U.S. at 117.

<sup>256</sup> *Id.* at 118.

<sup>257</sup> *Id.* at 117; see also *id.* at 118 (explaining that use of the name "shredded wheat" "was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly").

<sup>258</sup> In addition, the Court concluded that Kellogg clearly met that obligation, making "every reasonable effort to distinguish its product" from National

consumer perception.<sup>259</sup> *Kellogg* has simply been misunderstood by many courts as a trademark incapacity case.<sup>260</sup>

Even if one is inclined to engage in a broad reading of the genericness analysis in *Kellogg*, the question remains: Why did the Court bother to discuss National Biscuit’s failure to prove secondary meaning? If the Court meant that no generic term could acquire distinctiveness, why bother assessing the evidence of secondary meaning at all? As others have recognized, the opinion in *Kellogg* is a bit muddled,<sup>261</sup> and while some read the Court to clearly establish a trademark incapacity bar, it did not do so cleanly.<sup>262</sup>

Restrictive change happens all the time, while a shift in the necessity of offering a particular product or product feature most likely does not. Functionality assumes that the core aspects of products do not change over time.<sup>263</sup> When a product or process has been patented, the public and competitors get the promise of eventual open competition after the patentee’s window of protection closes. This quid pro quo is built into the offer of patent rights to inventors. When the patent expires, the product, or the process of making it, becomes part of the public domain. Any competitor can then produce and sell the product, driving prices toward the marginal cost of production (what it costs to make the product) as multiple sellers begin offering competing products. This competition saves consumers money.

When consumer demand changes, producers offer updated products to meet that demand. Product features in the public domain do not change, although their popularity might vary over time.<sup>264</sup> The flagging popularity of a feature or process

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Biscuit’s product. *Kellogg*, 305 U.S. at 116; *see also infra* notes 291-307 and accompanying text (describing the limits of unfair competition protection in trademark incapacity cases).

<sup>259</sup> *Kellogg*, 305 U.S. at 118-19.

<sup>260</sup> *Cf.* McKenna & Strandberg, *supra* note 234, at 29 (citing *Kellogg* as an example of “longstanding Supreme Court precedent holding that there is a right to copy unpatented product features”).

<sup>261</sup> *See supra* note 245 and accompanying text.

<sup>262</sup> I appreciate helpful feedback from Margaret Chon, Justin Hughes, and Mark McKenna on this issue.

<sup>263</sup> *Cf.* Joseph Miller, Error Costs & Functionality Exclusions, Presentation at Works in Progress in Intellectual Property 2014, Santa Clara University School of Law (Feb. 8, 2014) (arguing that the presumption that trademark protection is weaker than other regimes may hold true for word marks, but not for product design).

<sup>264</sup> For example, while most consumers experience music through their phones or computers, there is a limited but growing demand for vinyl records and record players. Ed Christman, *Record Store Day: Just How*

does not change its status within the public domain, although the lack of popularity may well discourage copying. The critical point is that the stasis that drives the functionality analysis for product features is suboptimal for analyzing competition concerns vis-à-vis the protection of word marks, because stasis is not a characteristic of living languages.<sup>265</sup>

Finally, at its heart, the functionality doctrine is a tool for maintaining lines between intellectual property regimes. As the Supreme Court stated in *Qualitex Co. v. Jacobson Products Co., Inc.*,<sup>266</sup> the goal of the functionality doctrine is to prevent trademark law from trenching on the role of patent law and “inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>267</sup> Unlike the functionality doctrine, which polices boundaries between patent law and trademark law, trademark incapacity deals with the question of whether a generic term can be treated as though it has added source significance, a question internal to trademark law.<sup>268</sup>

To summarize, in light of the tendency of language to undergo restrictive semantic shift, there is reason to doubt the error-cost justification for trademark incapacity. Likewise, rationales grounded in competition policy are too quick to dismiss language change and consumer perception and fail to vindicate applying trademark incapacity in its current form. The next section proposes applying a primary significance standard to determine whether generic terms can acquire trademark protection.

### *B. The Primary Significance Test Best Measures Semantic Shift*

It is time to retire the trademark incapacity doctrine and its per se bar against protecting formerly generic terms. Instead, the law should apply a primary significance test. If there is evidence that the majority of consumers have come to see the term as source-signifying rather than merely product-

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*Big Is the Resurgence?*, BILLBOARD, Apr. 18, 2013 (reporting an upsurge in vinyl sales from 990,000 in 2007 to 4.5 million in 2012).

<sup>265</sup> Cf. Bone, *Enforcement Costs*, *supra* note 70, at 2157 (“[T]here is a special problem with protecting trade dress that does not apply to word marks. Enjoining other firms from using a design feature can impede competition in the product market when the design feature serves an important function for the product itself.”).

<sup>266</sup> 514 U.S. 159 (1995).

<sup>267</sup> *Id.* at 164.

<sup>268</sup> My thanks to Becky Eisenberg for this insight.

designating, the term should be protectable like any other trademark.

As discussed above, courts faced with a genericness challenge to a protected mark apply a primary significance test to determine if the mark retains distinctiveness.<sup>269</sup> As one court recognized, “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”<sup>270</sup> When considering whether a trademark has suffered generislide, “majority usage controls.”<sup>271</sup> If the majority of consumers see a particular term as a trademark rather than a product category, generislide has not occurred.

The traditional “Teflon” and “Thermos” surveys applied in generislide disputes investigate how consumers perceive and use the challenged mark.<sup>272</sup> For example, in *Ty, Inc. v. Softbelly’s, Inc.*,<sup>273</sup> a survey conducted by the plaintiff’s expert found that 60 percent of respondents identified BEANIES as a brand name for soft plush toys filled with beads. While that could also indicate that as many as 40 percent of respondents saw the term as a generic identifier, the court concluded that the 60 percent response rate was evidence that the primary significance of the mark was to designate the source of the plaintiff’s goods.<sup>274</sup>

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<sup>269</sup> See *supra* notes 201-207 and accompanying text.

<sup>270</sup> *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90 (Fed. Cir. 1986).

<sup>271</sup> *Big Island Candies, Inc. v. Cookie Corner*, 269 F. Supp. 2d 1236, 1251 (D. Haw. 2003); see also Palladino, *supra* note 92, at 877 (noting that the genericness inquiry focuses on whether the primary significance of a challenged mark is to identify goods from a particular source, as opposed to the product itself).

<sup>272</sup> *E.T. Browne Drug Co. v. Cococare Prods, Inc.*, 538 F.3d 185, 193 (3d. Cir. 2008). Teflon and Thermos surveys differ in how they engage in the inquiry. Thermos surveys employ a series of open-ended questions, while Teflon surveys use closed-ended questions. See E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TRADEMARK REP. 1118, 1122 (2009). A Teflon survey explains the difference between product designations and trademarks to participants, and then asks participants to categorize terms like “washing machine” or “Chevrolet” as a generic designation or a trademark. If a majority of respondents categorize the mark as a generic designation, courts take that as evidence of generislide. A Thermos survey instead asks a respondent how she would ask for a product in a store. If the majority of consumers give the brand name, for example, “Thermos,” rather than “vacuum bottle,” the survey indicates that the mark has become generic. See *E.T. Browne Drug*, 538 F.3d at 195.

<sup>273</sup> 353 F.3d 528 (7th Cir. 2003).

<sup>274</sup> *Id.* at 530-31. While the court in *Ty* referred to the plaintiff’s survey

The same standard could be applied in acquired distinctiveness cases. Courts would inquire how consumers use the formerly generic term, and litigants could present survey evidence on the issue. Assuming the study is otherwise valid, if a majority of respondents identify the term as a trademark, then the study provides important evidence that the term has acquired secondary meaning and thus qualifies for trademark protection. Courts could also use information designed to anticipate consumer requirements, like search engine results, to track current usage.<sup>275</sup>

The primary significance standard would also preserve a distinction in how frequently descriptive and generic terms can acquire trademark protection. The primary significance standard is a more exacting standard than the showing of secondary meaning required to secure protection in a descriptive mark. A primary significance standard would require that more than 50 percent of consumers perceive the mark as source signifying. That level of consumer recognition is sufficient, but not necessary, to establish that a descriptive mark has acquired secondary meaning.<sup>276</sup> Many courts instead conclude that a showing in the 30 percent range is probative evidence that a descriptive term has acquired secondary meaning.<sup>277</sup> Some might argue that primary significance sets too low a threshold for a generic term to acquire distinctiveness, but it is a higher bar than the law currently requires for protecting other categories of marks.

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evidence as probative, the defendant also failed to present its own survey evidence of genericness.

<sup>275</sup> See Lisa Larrimore Oullette, *The Google Shortcut to Trademark Law*, 102 CAL. L. REV. 351, 354 (2014) (arguing that Google search engine results could “help adjudicate whether a mark has fallen into genericide”).

<sup>276</sup> *Spraying Systems Co. v. Delavan, Inc.*, 975 F.2d 387, 394 (7th Cir. 1992); see also *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 381 (7th Cir. 1976) (finding that responses to a likelihood of confusion survey indicated that over 50 percent of respondents identified plaintiff’s products with defendant’s mark, and concluding that “an extremely significant portion of the population associates [plaintiff’s] products with a single anonymous source”).

<sup>277</sup> *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 295 (7th Cir. 1998) (finding survey results in the 30 percent range probative of secondary meaning); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (28 percent); *Shuffle Master Inc. v. Yehia Awada*, No. 2:05-CV-01112-RCJ-(RJJ), 2006 WL 2547091, at \*3 (D. Nev. 2006) (35 percent); *McNeil-PPC v. Granutec, Inc.*, 919 F. Supp. 198, 203 (E.D.N.C. 1995) (38 percent). Other courts have held that survey results in the 30 percent range are insufficient. See, e.g., *Johnson & Johnson v. Actavis Group*, No. 06 Civ. 8209(DLC), 2008 WL 228061, at \*2 (N.D. Cal. 2006) (finding a 32 percent response rate insufficient to establish plaintiff’s color mark is source signifying as a matter of law).



In addition, applying the primary significance standard in the trademark acquisition context would not require a change to federal trademark law.<sup>278</sup> The Lanham Act already includes language which embraces the concept of semantic shift. For example, a registered trademark can be cancelled if it “*becomes* the generic name for the goods or services . . . for which it is registered . . . .”<sup>279</sup> Textually, the Act requires cancellation if a mark becomes generic, but not if a mark is currently source-signifying, even if it was generic at one point.<sup>280</sup> The Act also specifies grounds on which the Trademark Office may reject an application, including a determination that the mark “is merely descriptive” of the goods or services of the applicant.<sup>281</sup> The statute does not grant refusal based on whether the mark was ever descriptive, but instead merely inquires whether the mark is descriptive at the time of application. While the statute does not compel this Article’s preferred prescriptive approach, it provides no obstacle to it.

Some commentators have advocated instead for a replacement rule.<sup>282</sup> Under a replacement rule, a generic term could only acquire trademark protection if the old meaning has been completely lost.<sup>283</sup> At least one court reads *Singer* as a case where the trademark resurrection occurred precisely because the Singer mark “had wholly lost in then contemporary public usage its generic meaning.”<sup>284</sup> In other words, SINGER

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<sup>278</sup> See also 3 CALLMANN, *supra* note 9, § 20:33 (describing in detail how “[t]he Lanham Act does not appear to compel the retention of the trademark incapacity doctrine”); Levy, *supra* note 88, at 1211.

<sup>279</sup> 15 U.S.C. § 1064(3) (L.A. § 14) (emphasis added).

<sup>280</sup> Congress prescribed the primary significance standard for determining whether generislide has occurred. See *supra* note 68 and accompanying text.

<sup>281</sup> 15 U.S.C. § 1052(e)(1) (L.A. § 2).

<sup>282</sup> See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15, ill. 1 (1995) (proposing that a term that has a preexisting generic meaning cannot acquire trademark rights unless the preexisting generic meaning has become obsolete).

<sup>283</sup> See, e.g., *Ex Parte Pocket Books, Inc.*, 91 U.S.P.Q. (BNA) 182, 185-86 (Chief Examiner 1951) (refusing registration for *Pocket Book* for pocket-sized books and noting that “[i]t would appear that before the word could be considered a trade mark, it must become practically obsolete as a generic name for the article and must be recognized by the public as a trade mark rather than as a generic term of the English language” and that the “distinctiveness as a trade mark should not be recognized without complete overwhelming proof”).

<sup>284</sup> *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 7 n.2 (1st Cir. 1981) (proposing that the court in *Singer* awarded trademark protection to a previously generic mark specifically because the term had fallen out of common linguistic use and reacquired a primary source-signifying meaning).

was protected as a trademark because no one used the word as a generic designator for sewing machines.

But a replacement standard would fail to protect trademarks where there is clear evidence that a semantic shift has occurred and that the trademark meaning is the dominant, though not the exclusive meaning. Thus, the replacement rule would not go far enough in reforming trademark law. For example, a replacement rule would leave marks like KISSES without trademark protection, because nearly 17 percent of survey respondents identified KISSES as a generic term, even though 80 percent perceived KISSES as source-signifying.<sup>285</sup>

Others might conclude that the common law of unfair competition, embodied in Section 43(a) of the Lanham Act,<sup>286</sup> sufficiently protects the secondary meaning acquired in a generic mark, even though courts refuse to recognize evidence of secondary meaning and thus deny protection to those marks. Courts have applied unfair competition remedies to prevent “passing off” and to create some distance between senior and junior users of generic terms when the senior user has acquired de facto secondary meaning. For example, in *Genesee Brewing Co. v. Stroh Brewing Co.*,<sup>287</sup> the Court of Appeals for the Second Circuit noted that a junior user is obligated to use “every reasonable precaution to prevent confusion or the practice of deception in the sale of its product,”<sup>288</sup> even when using a generic product designation.<sup>289</sup> The rationale is that the senior user’s claim to a mark is weak, and thus the senior user is entitled only to “relief that will eliminate public confusion over . . . sponsorship.”<sup>290</sup>

There are two problems with relying on unfair competition remedies against passing off. First, cases like *Genesee Brewing*

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<sup>285</sup> See *supra* note 60 and accompanying text.

<sup>286</sup> 15 U.S.C. § 1125(a).

<sup>287</sup> *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137 (2d Cir. 1997) (holding HONEY BROWN generic as applied to ales and affirming denial of plaintiff’s motion for preliminary injunction).

<sup>288</sup> *Id.* at 151 (quoting *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938)).

<sup>289</sup> *Genesee Brewing Co.*, 124 F.3d at 150; see also *Gaylord Entm’t Co. v. Gilmore Entm’t Grp.*, 187 F. Supp. 2d 926, 951 (M.D. Tenn. 2001) (stating that a trier-of-fact could determine that the defendant engaged in unfair competition in its activities related to the adoption, promotion, and solicitation sales of the disputed mark, even if the term “Opry” were generic, so long as the unfair competition claim was not predicated solely on the defendant’s use of the term “Opry”).

<sup>290</sup> *Home Builders Ass’n of Greater St. Louis v. L&L Exhibition Mgmt., Inc.*, 226 F.3d 944, 950 (8th Cir. 2000).

may be the exception, rather than the rule.<sup>291</sup> Many cases refuse to extend unfair competition protection to a generic term, even in light of evidence of actual consumer confusion. For example, in *BellSouth Corp. v. White Directory Publishers, Inc.*, the court discounted evidence of consumer confusion on the ground that a mark, once dedicated to the public, could never be pulled back into trademark protection, and denied any relief.<sup>292</sup> Cases like *BellSouth* call into question whether unfair competition law can do the work of recognizing semantic shift when it has occurred.

Second, even when courts provide unfair competition relief to senior users, courts frequently rely on disclaimers requiring the junior user to disavow connection with the senior user as the only relief.<sup>293</sup> For example, in *Barton v. Rex-Oil Co.*,<sup>294</sup> plaintiff was not entitled to protection of its registered trademark, DYANSHINE for shoe polish because the court concluded the mark was “merely descriptive” of the product.<sup>295</sup> The court nevertheless concluded that consumers were confused by the similarity of the names and directed the district court to order defendants to add an affirmative, prominent disclaimer stating that its DYE AND SHINE polish was not produced by the plaintiff.<sup>296</sup>

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<sup>291</sup> See, e.g., 2 MCCARTHY, *supra* note 40, § 12:48 (opining that courts err when suggesting that they can create exclusive rights in generic terms under the law of unfair competition, and that the user of a generic term can obtain relief for passing off only if the newcomer engages in false and confusing usage “*above and beyond* mere use of the generic name”).

<sup>292</sup> 42 F. Supp. 2d 598, 612 (M.D.N.C. 1999) (“Where the record so conclusively establishes that a term was placed in the public domain as a generic symbol by its creator and has been so used for over thirty years by all in the industry, including the proponents of the mark and its predecessors, survey evidence such as that presented by BellSouth cannot serve even to create a genuine issue as to the status of the mark.”).

<sup>293</sup> See, e.g., *Blinded Veterans Ass’n v. Blinded American Veterans Found.*, 872 F.2d 1035, 1047 (D.C. Cir. 1989) (speculating that on remand, the district court could order the defendant “to attach a prominent disclaimer to its name to notify the public that defendant’s organization was not associated with plaintiff’s”); *Warner Bros. Pictures v. Majestic Pictures Corp.*, 70 F.2d 310, 312-13 (2d Cir. 1934) (requiring defendant to include a disclaimer on advertisements for its film “Gold Diggers of Paris,” stating that defendant’s film was not based on an earlier play or film with the same title).

<sup>294</sup> 2 F.2d 402, 406-07 (3d Cir. 1924).

<sup>295</sup> *Id.* at 404. Under the Federal Trade-Mark Act then in force, neither generic nor descriptive terms could be registered. Common law protection against unfair competition could still be obtained in a descriptive term. See *id.* (citing *Warner & Co. v. Lilly & Co.*, 265 U.S. 526 (1924)).

<sup>296</sup> *Id.* at 407.

Disclaimers, like the one ordered in *Barton*, are most likely ineffective. Rebecca Tushnet notes that prominent disclaimers might work when research respondents encounter “tombstone ads”—print-only ads that are highly informational—but they rarely work in the context in which they are encountered.<sup>297</sup> Other research suggests that disclaimers actually have a reverse effect: consumers presented with disclaimers are in many cases more likely to associate the product sold with the source disclaimed.<sup>298</sup>

The failure of disclaimers to clear up confusion has been observed in other contexts as well. One FDA study indicates that in some cases, survey respondents were more confident that food provided health effects when the statement of the health effect was qualified or somewhat disclaimed than when the health claim was unqualified.<sup>299</sup> Text-only disclaimers were ineffective at helping survey respondents recognize different levels of scientific support for certain health claims.<sup>300</sup> In addition, disclaimers did not change the positive view of the health claim when consumers held an existing, erroneous belief in the claim.<sup>301</sup>

A handful of cases suggest that a court could provide a stronger remedy for passing off than merely ordering a disclaimer. For instance, in *Murphy Door Bed Co., Inc. v. Interior Sleep Systems, Inc.*,<sup>302</sup> the plaintiff sought to prevent the use of its registered MURPHY BED mark by the defendant

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<sup>297</sup> Tushnet, *Sixty Milliseconds*, *supra* note 226, at 532 (citing Jacob Jacoby & Robert Lloyd Raskopf, *Disclaimers in Trademark Infringement Litigation: More Trouble than They Are Worth?*, 76 TRADEMARK REP. 35, 36, 54-58 (1986)); *see also* Gita Venkataramani Johar & Carolyn J. Simmons, *The Use of Concurrent Disclosures to Correct Invalid Inferences*, 26 J. CONSUMER RES. 307, 320 (2000); Mitchell E. Radin, *Disclaimers as a Remedy for Trademark Infringement: Inadequacies and Alternatives*, 76 TRADEMARK REP. 59, 61-67 (1986).

<sup>298</sup> Jacob Jacoby & George J. Szybillo, *Why Disclaimers Fail*, 84 TRADEMARK REP. 224 (1994).

<sup>299</sup> Brenda M. Derby & Alan S. Levy, *Effects of Strength of Science Disclaimers on the Communication Impacts of Health Claims*, (U.S. Food & Drug Admin., Working Paper No. 1, 2005), *available at* <http://www.fda.gov/OHRMS/dockets/dockets/03N0496/03N-0496-rpt0001.pdf> (last viewed Nov. 7, 2014).

<sup>300</sup> *Id.*

<sup>301</sup> *Id.* The value of the FDA study in describing behavior of disclaimers more generally may be mitigated by a strong tendency of consumers to believe in spurious health effects. *See* Ben Goldacre, *The Medicalisation of Everyday Life*, THE GUARDIAN, Sept. 1, 2008 (arguing that consumers “invite [magical claims about health benefits] because we want to live in a simple universe of rules with justice, easy answers, and predictable consequences”).

<sup>302</sup> 874 F.2d 95 (2d Cir. 1989).

to sell a competing product. Although the court concluded that “Murphy bed” was generic for a bed that could be concealed in a wall closet, and the registration was thus invalid, it affirmed an injunction against the defendant. *Murphy Door Bed* is of limited use as unfair competition precedent supporting the grant of injunctive relief, however, because the defendant had agreed in a licensing deal not to use the Murphy name if the contract were ever terminated,<sup>303</sup> and the court was not clear whether it was affirming the injunction on unfair competition or breach of contract grounds.<sup>304</sup>

In other cases, courts have restricted subsequent confusing use of a generic term without enjoining the use per se. For example, in *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*,<sup>305</sup> the court concluded that while King-Seeley’s THERMOS mark for vacuum bottles had fallen into generic usage in the minds of most consumers, some segment of the market still recognized THERMOS as a mark for King-Seeley’s goods.<sup>306</sup> Thus, the court ordered injunctive relief requiring Aladdin to precede any use of the word “thermos” with its house mark, to confine its use of “thermos” to the lower-case “t,” and to never use the words “original” or “genuine” in describing its product.<sup>307</sup>

If courts followed *Murphy Door Bed* in granting injunctions against the confusing use of “generic” marks that acquire secondary meaning, remedies against passing off would be sufficient to validate consumer perception. Even the replacement rule would be preferable over the status quo, which leaves the public and the mark owner at the mercy of ineffective disclaimers and the occasional judicial outlier. Nonetheless, the primary significance standard will better protect consumers from confusion and reduce consumer search costs by focusing the judicial inquiry on the acquired source significance of the term in question, rather than its generic etymology.

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<sup>303</sup> *Id.* at 102.

<sup>304</sup> *Compare id.* at 102 (“Although the injunction was issued to prevent trademark infringement, it was proper because defendants had contracted to refrain from use of the Murphy name in the event of a termination of the distribution agreement and did not so refrain.”), *with id.* at 104 (“[Defendants] committed breaches of their contract with Murphy and engaged in unfair competition. We therefore affirm the district court’s entry of a permanent injunction . . .”).

<sup>305</sup> 321 F.2d 577, 581 (2d Cir. 1963).

<sup>306</sup> *Id.* at 579 (“[T]here is an appreciable, though minority, segment of the consumer public which knows and recognizes plaintiff’s trademarks.”).

<sup>307</sup> *Id.* at 581.

## CONCLUSION

Semantic shift—the addition of meaning to the public lexicon—is driven simultaneously by a need to communicate and a need to resolve confusing ambiguity. Investing a word or phrase with source significance such that it becomes a trademark is a type of semantic shift. Like any other entry into the creative lexicon, trademarks are created to fill a communicative need. But the doctrine of trademark incapacity incongruously disregards restriction, a common form of semantic shift. Ignoring restriction may exacerbate consumer confusion and increase consumer search costs.

Understanding that the formation of trademark meaning is a form of semantic shift reminds us that sound competition policy cannot neglect the importance of consumer comprehension. Instead, trademark law must take into account consumer perception and properly weight consumer confusion. The doctrine of trademark incapacity does neither. The law should instead adopt a primary significance test for determining whether a mark that was once generic has acquired sufficient distinctiveness to merit trademark protection. Trademark law would then better match its accepted search-cost rationale, and trademark acquisition would better reflect the semantic shift of which it is a part.

This Article focuses on what the semantic shift literature can teach us about trademark incapacity. There is more work to be done in determining whether trademark law currently strikes the right balance between incumbents and new entrants and between interested groups of consumers. But an understanding of semantic shift provides crucial insight into how trademark owners as “speakers” initiate and maintain semantic shifts that create new trademark meaning, and how the public as “listeners” accept, reject, and reshape those attempts at source-signifying innovation. Incorporating theoretical and cognitive research on language change may help us better evaluate the key descriptive and normative claims for the current trademark regime at each phase in the lifecycle of a trademark. Thus, recognizing how language changes can spur effective legal reform that better reflects the consumer protection and competition concerns at the heart of the trademark system.