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# Are Trademarks Ever Fanciful?

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# Are Trademarks Ever Fanciful?

JAKE LINFORD\*

*A fanciful trademark—a made-up word like Swiffer for mops or Xerox for photocopiers—is presumed to neither describe nor suggest any qualities of the product associated with the mark. This presumption is consistent with the theory of linguistic arbitrariness: there exists no connection between a given word (tree) and the thing signified by the word (a large woody plant). Because a fanciful mark is assumed to be an empty vessel, meaningless until used as a trademark, it qualifies for protection from first use and receives broader protection against infringement than other categories of trademarks.*

*Research into sound symbolism challenges the theory of linguistic arbitrariness and thus the accepted gap between fanciful mark and mark-bearing product. Multiple studies demonstrate the existence of sound symbolism—connections between the individual sounds that constitute a given word and the meanings that a reader or listener ascribes to that word. Consumers are more likely to favor a new trademark when trademark meaning links to product type, even if they are not conscious of the link. Marketers often consider sound symbolism when coining a fanciful mark to create such a link. Nevertheless, the law presumes linguistic arbitrariness when it comes to fanciful trademarks.*

*Courts often assume that adopting a mark similar to a fanciful mark is evidence of bad faith, but a new entrant might reasonably desire to use sounds that convey product information. Overprotecting fanciful trademarks could thus impose unjustified costs on competitors, at least when sound symbolism connects the mark to the product offered for sale. Broad protection for fanciful marks that benefit from sound symbolism may therefore be misguided. Courts should instead engage in a more nuanced inquiry, accounting for sound symbolism when assessing the validity and scope of a fanciful mark.*

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INTRODUCTION

Firms prefer trademarks that communicate product features to consumers.<sup>1</sup> Trademark doctrine, however, discourages the selection of marks that are too descriptive because companies may otherwise monopolize a term that their competitors must also use.<sup>2</sup> Thus, when a firm selects a descriptive mark that uses a product characteristic as part of the mark, like Quickmop for a mop with a disposable head that is fast and easy to use, the firm cannot secure protection in the mark until it can show that the mark has acquired source significance—that consumers associate the mark with a particular source.<sup>3</sup> Even after a descriptive term like Quickmop acquires source significance, courts will grant relatively narrow protection against alleged infringers.<sup>4</sup>

But if a firm coins a “fanciful” word to use as a trademark, like Swiffer for a mop with a disposable head,<sup>5</sup> the firm gets automatic protection from first use, and the scope of that protection is exceedingly broad.<sup>6</sup> Trademark law presumes that a fanciful mark neither describes nor suggests any qualities of the product associated with the mark. A fanciful mark is treated like an “empty vessel,” meaningless until filled through use as a source signifier. Because of this perceived lack of connection between a fanciful mark and its associated prod-

1. Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367, 1419 (2015) [hereinafter Linford, *False Dichotomy*].

2. *Id.* at 1383.

3. *Id.* at 1376–78.

4. *See, e.g.*, John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 974 (11th Cir. 1983) (“A descriptive mark . . . is considered weak and is given a ‘narrow range of protection.’” (quoting 1 J.T. MCCARTHY, TRADEMARKS & UNFAIR COMPETITION § 11:24, at 398 (1973))).

5. Typically, a word with no inherent lexical meaning is categorized as a fanciful mark. One could argue, however, that Swiffer is suggestive of a disposable mop, rather than fanciful. Like a fanciful mark, a suggestive mark is treated as inherently distinctive, but in many jurisdictions, it receives a narrower scope of protection than a fanciful mark. *See infra* notes 39–40 and accompanying text; *see also* Linford, *False Dichotomy*, *supra* note 1, at 1376–78. A court might conclude Swiffer is a misspelling or slight mispronunciation of swifter. Swifter itself might be suggestive rather than descriptive of the mop’s desirable qualities. Generally, however, a newly coined word is categorized as fanciful, rather than suggestive, even if it sounds like a familiar word. *Compare* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:72 (4th ed. 2016) (listing marks that courts have found suggestive), *with id.* § 11:8 (listing marks that courts have found fanciful).

6. Courts have developed a hierarchy of trademark strength to distinguish marks that are too closely connected to products from those that are not. *See, e.g.*, Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (explaining the four generally accepted categories of terms: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful). A fanciful mark is presumed the strongest trademark along the *Abercrombie* hierarchy of trademark strength. *Id.*; 2 MCCARTHY, *supra* note 5, § 11:6.

uct, fanciful marks receive broader protection than other marks,<sup>7</sup> and courts often presume that a competitor's use of a mark similar to a fanciful mark indicates bad faith on the part of the competitor.<sup>8</sup>

But the presumption that a fanciful mark has no inherent meaning is questionable in light of recent research into sound symbolism. "Sound symbolism is the direct linkage between sound and meaning."<sup>9</sup> A nonsense word like Swiffer may lack a dictionary definition, but the component sounds in the word communicate speed and ease of use,<sup>10</sup> independent of whether the word resembles other known words.<sup>11</sup> Linguists, psychologists, and marketing scholars have repeatedly confirmed that certain sounds carry meaning separate from the word they form.<sup>12</sup> In study after study, scholars report that vowel and consonant sounds convey concepts like big/small, fast/slow, thin/thick, light/heavy, cold/warm, bitter/sweet, more/less friendly, or feminine/masculine, even when the word itself is nonsense.<sup>13</sup> For example, when asked to distinguish two imaginary pieces of furniture, approximately 80% of respondents say the one named Mal is larger than the one named Mil.<sup>14</sup>

Marketers and brand consultants use sound symbolism when selecting new trademarks.<sup>15</sup> They know the sounds chosen to comprise the mark can convey

7. See, e.g., *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir. 1980) ("Domino" is not a coined word, is not purely fanciful, and while its application to sugar may be arbitrary, it is still not to be accorded the same degree of protection given such coined and fanciful terms as 'Kodak' or 'Xerox.'"); see also *infra* Section I.A.2.

8. See, e.g., *American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 561–62 (2d Cir. 1953).

9. Leanne Hinton et al., *Introduction: Sound-Symbolic Processes*, in *SOUND SYMBOLISM* 1, 1 (Leanne Hinton et al. eds., 1994).

10. Neal Gabler, *The Weird Science of Naming New Products*, N.Y. TIMES MAG. (Jan. 15, 2015), [http://www.nytimes.com/2015/01/18/magazine/the-weird-science-of-naming-new-products.html?\\_r=0](http://www.nytimes.com/2015/01/18/magazine/the-weird-science-of-naming-new-products.html?_r=0) [<http://perma.cc/4KJZ-BCRD>] (Will Leben, linguist and professional trademark coiner, notes that the /s/ of Swiffer sounds fast and easy, compared to words that begin with a different consonant).

11. See *infra* notes 103–07 and accompanying text.

12. See, e.g., Barry Alpher, *Yir-Yoront Ideophones*, in *SOUND SYMBOLISM*, *supra* note 9, at 161 (reporting evidence of sound symbolism in Australian language of Yir-Yoront); Brian D. Joseph, *Modern Greek ts: Beyond Sound Symbolism*, in *SOUND SYMBOLISM*, *supra* note 9, at 222 (same: in modern Greek); Terrence Kaufman, *Symbolism and Change in the Sound System of Huastec*, in *SOUND SYMBOLISM*, *supra* note 9, at 63 (same: in Mayan language of Huastec); see also Russell Ultan, *Size-Sound Symbolism*, in 2 *UNIVERSALS OF HUMAN LANGUAGE* 525 (Joseph H. Greenberg ed., 1978) (arguing that the majority of the world's languages use sound symbolism); Mark Dingemanse et al., *Arbitrariness, Iconicity, and Systematicity in Language*, 19 *TRENDS IN COGNITIVE SCI.*, 603 (2015) (reporting on form-to-meaning correspondences across languages); Richard R. Klink, *Creating Brand Names with Meaning: The Use of Sound Symbolism*, 11 *MARKETING LETTERS* 5, 10 (2000) [hereinafter Klink, *Names with Meaning*] (reporting that undisclosed products with imaginary brand names are perceived as likely to be smaller, faster, lighter (weight), softer, and/or more feminine depending on the sounds used); Edward Sapir, *A Study in Phonetic Symbolism*, 12 *J. EXPERIMENTAL PSYCH.* 225, 288 (1929) [hereinafter Sapir, *Phonetic Symbolism*] (reporting that study participants perceive words with the vowel /a/ to represent greater magnitude or size compared to words with the vowel /i/, and proposing that effect might be consistent across languages).

13. E.g., Klink, *Names with Meaning*, *supra* note 12.

14. See *infra* notes 128–29 and accompanying text.

15. In fact, brand consultants and professional "naming" companies use sound symbolism as a key element in advising a firm which mark to choose in order to convey a message to consumers without

information that shapes consumer perception, even though consumers do not consciously recognize the effect.<sup>16</sup> Sound symbols not only convey meaning, but can also make trademarks more desirable. For example, for a dark beer, consumers will prefer fanciful marks with back vowel sounds that convey attributes of the dark beer like smoothness, mellowness, and richness over marks with front vowel sounds which are preferred when the product attributes are cold, clean, and crisp.<sup>17</sup>

Courts have not caught up with research into sound symbolism, and this oversight is understandable. For most of the twentieth century, psychologists and linguists embraced the theory of linguistic arbitrariness.<sup>18</sup> Under this theory, there is no inherent connection between a given word and the thing it signifies. For example, linguistic arbitrariness posits there is no innate relationship between a sound of a word (for example, tree) and the thing signified by the word (a large woody plant). Language users reach an unstated agreement that tree designates some plants and not others, but that agreement is not grounded in any symbolic relationship between word sound and meaning. Likewise, a newly coined fanciful trademark is seen to possess no inherent meaning. Language users thus might readily conclude that the mark points to a consistent product source, in part because the sounds that comprise the mark are presumed to provide no hint about product characteristics.

Empirical research into sound symbolism is of a more recent vintage but calls into question this presumption of linguistic arbitrariness. Evidence of sound symbolism thus also challenges the notion that fanciful marks bear no inherent meaning. If the building blocks of words convey meaning, then the presumption that fanciful marks communicate no product-relevant information will be inaccurate in many cases. In fact, the owner of a fanciful mark may get a head start in

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stating the message directly. Gabler, *supra* note 10 (reporting on interviews with brand consultants at Catchword and Interbrand, among others).

16. See, e.g., STEVEN PINKER, *THE STUFF OF THOUGHT: LANGUAGE AS A WINDOW INTO HUMAN NATURE* 303–04 (2007) (firms use “faux-Greek and Latinate neologisms” in names like Acura, Verizon, Viagra, and Altria “to connote certain qualities without allowing people to put their finger on what they are”); Edward Sapir, *Sound Patterns in Language*, 1 *LANGUAGE* 37, 39 (1925) (sound symbolism is characterized by “psychological aloofness”—the user is unaware of the effect); Eric Yorkston & Geeta Menon, *A Sound Idea: Phonetic Effects of Brand Names on Consumer Judgments*, 31 *J. CONSUMER RES.* 43, 44, 47 (2004) (reporting that study participants were unaware they used sound symbolism as an input in judgments); see also Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 *HOUS. L. REV.* 861, 886 (2011) (“Marketers strive to give even completely invented product names a euphonious sound that resonates with the characteristics they want consumers to associate with the product.”).

17. Tina M. Lowrey & L. J. Shrum, *Phonetic Symbolism and Brand Name Preference*, 34 *J. CONSUMER RES.* 406, 409 (2007).

18. Ferdinand de Saussure was an early, key proponent of linguistic arbitrariness, arguing against any inherent connection between a given word and the thing it signifies. FERDINAND DE SAUSSURE, *COURSE IN GENERAL LINGUISTICS* 67–69 (Charles Bally & Albert Sechehaye eds., Wade Baskin trans., 1959) (1916); see also Gwilym Lockwood & Mark Dingemanse, *Iconicity in the Lab: A Review of Behavioral, Developmental, and Neuroimaging Research into Sound-Symbolism*, 6 *FRONTIERS IN PSYCH.* 1, 1–2 (2015) (describing the dominant historical position of linguistic arbitrariness).

building consumer recognition and brand loyalty relative to competitors and may establish protection in a mark that communicates product qualities to consumers without paying the toll the law requires of other marks that convey product characteristics—a showing of source significance.<sup>19</sup>

In light of this research, it may be time to rethink current presumptions about the inherent distinctiveness and strength of fanciful trademarks. For example, similarities between a fanciful mark and the mark of a competitor might have less to do with a “bad faith” attempt on the part of the competitor to obtain some advantage from appropriating the goodwill of the fanciful mark owner and more to do with the communicative advantage conveyed by certain sound symbols.<sup>20</sup> Likewise, the strength of the connection between sound symbols and product characteristics in a fanciful mark should lead a court to question whether that fanciful mark ought to be treated as inherently distinctive or benefit from the presumption of broad inherent strength.<sup>21</sup>

This Article proceeds in three Parts. Part I describes the current view that fanciful marks are inherently source-signifying (and thus entitled to protection as a trademark upon first use in commerce) and inherently strong (and thus entitled to broader protection than other categories of marks). That current view is justified only if language creation and usage are governed by linguistic arbitrariness. Part II describes the theory of linguistic arbitrariness. It then summarizes recent research into sound symbolism and explains how this research complicates and challenges the theory of linguistic arbitrariness on which the extraordinary protection of fanciful marks depends. It also explains how marketers use sound symbols to create fanciful marks that can intrinsically communicate product features. Part III argues that even though accounting for sound symbolism may complicate trademark analysis, presumptions about the inherent source significance and strength of fanciful marks should be relaxed in light of how sound symbolism shapes—and potentially distorts—consumer perception.

This Article is part of a larger critique applying linguistic theory to trademark doctrine. Previous articles have questioned how courts and administrators categorize trademarks and how those categories drive legal outcomes with regard to trademark validity and scope of protection.<sup>22</sup> Future projects will explore how linguistic theory can motivate legal reform, including recalibrating the scope of trademark protection during trademark litigation.

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19. See *supra* note 3 and accompanying text.

20. See *infra* Section III.B.

21. *Id.*

22. See Linford, *False Dichotomy*, *supra* note 1, at 1389–91 (reviewing literature critiquing the uses and perceived abuses of the *Abercrombie* spectrum); Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J.L. & TECH. 110, 112 n.1 (2015) [hereinafter Linford, “Generic” Trademarks] (discussing other literature applying linguistic and semiotic theories to trademark puzzles).

## I. FANCIFUL MARKS

A trademark is a word, design, symbol, or other graphic figure that is used by the seller of a product to indicate—and by that product’s consumers to identify—the source of the product.<sup>23</sup> When consumers see Coca-Cola on a red can, they recognize the source of that can or at least that the can and its contents come from a specific source.<sup>24</sup> The source significance of a trademark also sends a message about product quality—the same product from a specific source should have consistent quality each time the consumer buys it.<sup>25</sup> Consumers use trademarks to economize search costs and identify the source of the product offered for sale.<sup>26</sup> Preventing trademark use by competitors that would likely confuse or deceive consumers enables those consumers to rely on the source significance and quality assurance provided by the mark.<sup>27</sup>

Like other words, trademarks are both denotative and connotative.<sup>28</sup> As the court noted in *G. Heileman Brewing Co. v. Anheuser-Busch Inc.*, to “denote” is “[t]o refer to specifically; mean explicitly,” whereas to “connote” means “[t]o suggest or imply in addition to literal meaning.”<sup>29</sup> Trademarks operate on at least these two levels. First, the mark denotes source<sup>30</sup>—it indicates “a single

23. See *Trademark*, BLACK’S LAW DICTIONARY (8th ed. 2004).

24. See *infra* note 31 and accompanying text.

25. But see Jake Linford, *Valuing Residual Goodwill After Trademark Forfeiture*, 93 NOTRE DAME L. REV. (forthcoming 2017) [hereinafter Linford, *Trademark Forfeiture*] (arguing that forfeiture mechanisms in trademark law ignore consumer perception and consumer investment in goodwill, thus weakening the ability of the average trademark to signal product quality).

26. Throughout the text, I use “product” to mean “good(s) or service(s).”

27. See Linford, *Trademark Forfeiture*, *supra* note 25.

28. The Article limits its analysis to word marks. It is unclear whether and how well the hierarchy of trademark strength applies to image marks, labels, product packaging, and product design. See, e.g., Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471, 509 (1997) (“[T]he *Abercrombie* test . . . is based on a linguistic reference between word and mark and is thus ill-suited to determine the inherent distinctiveness of shapes generally and of product design in particular.”); Rohit A. Sabnis, *Product Configuration Trade Dress and Abercrombie: Analysis of Ashley Furniture Industries, Inc. v. SanGiacomo N.A. Ltd.*, 1 MINN. INTELL. PROP. REV. 183, 193 (2000); Chad M. Smith, *Undressing Abercrombie: Defining When Trade Dress Is Inherently Distinctive*, 87 TRADEMARK REP. 160, 188 (1997) (arguing that the law regarding trade dress need not, and in fact cannot, map directly onto the law regarding word marks). Compare *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007 (2d Cir. 1995) (asserting that the *Abercrombie* taxonomy of trademark strength “make[s] little sense when applied to product features”), and *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1441 (3d Cir. 1994) (concluding that the *Abercrombie* taxonomy “does not fit the quite different considerations applicable to product configurations”), with *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 252, 260 (5th Cir. 1997) (acknowledging differences between design and word marks but nevertheless applying *Abercrombie* to product design and rebuffing “alarmist rhetoric” that trade dress protection improperly expands patent protection), and *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780, 785–88 (8th Cir. 1995) (embracing the *Abercrombie* taxonomy as a workable device for determining “whether and to what degree that feature is dictated by the nature of the product”).

29. 676 F. Supp. 1436, 1491 n.46 (E.D. Wis. 1987) (quoting AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 353, 283 (1969)), *aff’d*, 873 F.2d 985 (7th Cir. 1989).

30. Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 392 (2011).



thing coming from a single source.”<sup>31</sup> Second, because the mark points to a consistent, if anonymous source, it also connotes or hints at qualities of the marked product.<sup>32</sup> What the mark denotes and connotes in turn is determined in part by the symbol appropriated for use as a trademark.

Under U.S. trademark law, the connection between the mark chosen and the product offered can be critically important. If a trademark examiner or court determines that the mark and product are too closely connected, the hopeful owner must show that the mark has acquired source significance before the mark merits trademark protection. In addition, the more closely connected the mark is to the product, the weaker courts presume the mark to be, which raises the bar that a mark holder must surmount to prevail in trademark litigation.<sup>33</sup> Thus, some marks qualify more easily for protection and are perceived as inherently stronger than others.

When describing the inherent distinctiveness and strength of a trademark, courts generally use a spectrum of trademark significance most famously articulated in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>34</sup> At the unprotectable end of the spectrum are generic terms for the product offered, like Computer for computers.<sup>35</sup> Descriptive terms that identify qualities or characteristics of the product, like Sealtight for fasteners or Tasty for bread, are protectable only if they acquire distinctiveness—evidence that consumers have come to see the marks as source-signifying. Descriptive terms are “valuable instantly” because they provide information about product characteristics,<sup>36</sup> and the law thus requires a firm to show that consumers have come to see the descriptive term as a source signifier before it qualifies for trademark protection.<sup>37</sup>

Unlike a descriptive mark, the other categories of marks along the spectrum—suggestive, arbitrary, and fanciful—are protectable without evidence of source significance. Courts presume that consumers are likely to perceive these “inherently distinctive” marks as source-signifying from their first use in commerce.<sup>38</sup> Suggestive marks, like Penguin for air conditioners<sup>39</sup> or Coppertone for suntan lotion,<sup>40</sup> hint at product qualities without directly invoking them.<sup>41</sup> Courts often state that consumers must exercise imagination to discern product qualities from a suggestive mark, but the line between suggestive and descriptive marks is

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31. *Coca-Cola Co. v. Koke Co. of America*, 254 U.S. 143, 146 (1920).

32. See Heymann, *supra* note 30, at 392.

33. See Linford, *False Dichotomy*, *supra* note 1, at 1376–78.

34. 537 F.2d 4, 9–11 (2d Cir. 1976).

35. But see Linford, “Generic” Trademarks, *supra* note 22, at 113 (applying theories of semantic shift to argue that generic terms should be allowed to obtain trademark protection when there is sufficient evidence that consumers primarily perceive the term as a trademark).

36. Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1155 (2003).

37. Linford, *False Dichotomy*, *supra* note 1, at 1378.

38. See *infra* notes 46–47 and accompanying text.

39. *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999).

40. See *Douglas Labs. Corp. v. Copper Tan, Inc.*, 210 F.2d 453 (2d Cir. 1954).

41. Linford, *False Dichotomy*, *supra* note 1, at 1377.

difficult to draw.<sup>42</sup> Courts also disagree about whether suggestive marks are inherently strong.<sup>43</sup>

No such ambiguity plagues arbitrary marks. Arbitrary marks, like Apple for computers, use a pre-existing word to sell a product unrelated to that word. Courts presume this lack of connection causes an arbitrary mark to stand out as a source signifier, which leads courts to conclude that arbitrary marks are not only inherently distinctive, but also entitled to relatively broad protection.<sup>44</sup> Finally, as this Part details, fanciful marks—words created specifically for use as a mark, like Kodak for cameras—are not only inherently distinctive, but treated as uniquely strong.

#### A. HOW THE LAW PROTECTS FANCIFUL MARKS

This Section describes the law's special treatment of fanciful marks and the rationales offered for that treatment. A fanciful mark is a neologism, a made-up word coined for use as a mark, like Xerox for photocopiers.<sup>45</sup> Courts see the fanciful mark as an empty vessel, a symbol that has no meaning until the mark owner uses it as a source signifier.<sup>46</sup> Because the word has no lexical meaning, courts conclude there is no connection between the word and the product. The fanciful mark is therefore treated as inherently distinctive; it qualifies for protection at first use, without evidence of source significance.<sup>47</sup> Courts also presume, because of this lack of lexical connection between fanciful mark and

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42. *Id.* at 1370 (describing the unclear boundary between suggestive and descriptive marks).

43. *Compare* Dreamwerks Prod. Grp., Inc. v. SKG Studio, 142 F.3d 1127, 1130–31 (9th Cir. 1998) (concluding that the suggestive mark of the less-famous junior user was inherently distinctive and thus deserved “broad protection”), *and* Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1527 (4th Cir. 1984) (stating that suggestive marks are also considered “strong” as well as “presumptively valid” (quoting Del Labs., Inc. v. Alleghany Pharmacal Corp., 516 F. Supp. 777, 780 (S.D.N.Y. 1981))), *with* Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 385 (2d Cir. 2005) (“In the absence of any showing of secondary meaning, suggestive marks are at best moderately strong.”), *and* John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 974 (11th Cir. 1983) (“[A]lthough a suggestive mark can be protected without evidence that it has acquired secondary meaning, [it] is comparatively weak.”). This footnote was first included in Linford, *False Dichotomy*, *supra* note 1, at 1370 n.6.

44. *See infra* notes 45–49 and accompanying text.

45. The term xerox is not entirely fanciful. Xerox is a shortened form of *xerography*, derived from Greek words for “dry” and “writing” and suggested by a classics professor at Ohio State University. The term relates to the process of printing using dry ink invented by Chester Carlson. Several other names were considered, including Kleen Kopy and Dry Duplicator. Carlson preferred what he perceived to be the more accurate technical term: electrophotography. DAVID OWEN, COPIES IN SECONDS: CHESTER CARLSON AND THE BIRTH OF THE XEROX MACHINE 145 (2004). But the average consumer would be unfamiliar with the source of the term, and a court would therefore likely conclude the term xerox is fanciful. *See infra* note 69.

46. *See, e.g.*, Stephen L. Carter, *The Trouble With Trademark*, 99 YALE L.J. 759, 768 (1990) (“The charming, attractive mark not yet associated with any goodwill simply does not carry any information, and, consequently, cannot possibly economize on it.”).

47. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961) (“The presumption that a fanciful word or mark becomes distinctive and identifies the source of goods on which it is used immediately after adoption and *bona fide* first use is basic in trademark law.”). A fanciful mark is also entitled to registration without any evidence of source significance. *See* 15 U.S.C. § 1052(e) (2012).

associated product, that a fanciful mark is inherently strong, which gives the mark owner an advantage in trademark litigation.<sup>48</sup> Commentators are also nearly unanimous in the conclusion that fanciful marks merit broad protection or that protecting them poses low risk of competitive harm compared to other categories of marks.<sup>49</sup>

### 1. Fanciful Marks Are Presumed Inherently Source-Signifying

At the turn of the twentieth century, “technical trademarks,”<sup>50</sup> or inherently distinctive marks, “were presumed to represent the source of a product.”<sup>51</sup> Thus, “the first user of a trademark could sue to protect it without having to show that the word or symbol represented the product’s source in fact.”<sup>52</sup> Today, fanciful marks, like other inherently distinctive marks, receive the same treatment. It would be incorrect to say as a matter of black letter law that a fanciful mark is more inherently distinctive than an arbitrary or suggestive mark<sup>53</sup> because each category of mark is protected from first use in commerce. Nonetheless, it is rarely difficult for courts to identify a mark as fanciful and thus inherently distinctive, but it is often challenging to categorize a mark as suggestive rather than descriptive.<sup>54</sup>

### 2. Fanciful Marks Are Presumed Inherently Strong

Fanciful marks are also treated as inherently strong and are given an expansive scope of protection. Trademark litigation often devolves to a fact-intensive

48. See, e.g., *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1390–91 (9th Cir. 1993) (explaining that fanciful marks are inherently strong because of the lack of connection between mark and product); see 2 MCCARTHY, *supra* note 5, at § 11:6 (same).

49. See, e.g., Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 673–74, 694–95 (2004) [hereinafter Beebe, *Semiotic Analysis*] (“One reason why trademark law has traditionally granted broader protection to inherently distinctive marks is to provide an incentive to trademark producers to generate new words rather than appropriate from the language pre-existing words for commercial purposes.”); Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1910–11 (2011); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 273 (1987) (observing the costs of protecting a fanciful mark are low because a fanciful mark “has no information content except to denote a specific producer or brand”); Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 827–29 (1927). But see Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”: Toward A More Sensible Approach to Trademark Infringement*, 106 NW. U. L. REV. 1307, 1343 (2012) [hereinafter Bone, *Confusion*] (questioning why inherent strength bears on the likelihood of consumer confusion).

50. Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 563 (2006) (describing technical trademarks, a category of marks that would include modern fanciful and arbitrary marks and which qualified under older trademark regimes as property of the mark owner because they did not exist prior to their creation by the seller). Some cases also treated suggestive marks as technical trademarks. See Linford, *False Dichotomy*, *supra* note 1, at 1408.

51. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786 (1992) (Thomas, J., concurring) (citing *Heublein v. Adams*, 125 F. 782, 784 (CC Mass. 1903)).

52. *Id.*

53. Beebe, *Semiotic Analysis*, *supra* note 49, at 672.

54. Linford, *False Dichotomy*, *supra* note 1, at 1370.

inquiry into whether the use of a term as a trademark is likely to infringe the pre-existing rights of another party. Two of the factors often considered by courts<sup>55</sup>—the strength of the plaintiff's mark and perceived bad faith on the part of the alleged infringer—are more likely to favor the plaintiff when the mark is inherently distinctive and most likely to favor the plaintiff if the mark is fanciful.<sup>56</sup> The rights acquired through use of a fanciful mark are also presumed to reach farther into different but related product categories and geographical markets.<sup>57</sup>

In addition, the inherent strength of the plaintiff's mark also shapes the inquiry into whether the defendant's mark is confusingly similar to, and therefore infringes on, the plaintiff's mark. As Judge Learned Hand wrote in *Lambert Pharmacal Co. v. Bolton Chemical Corp.*, Lambert Pharmacal's adoption of the fanciful mark Listerine, which was "arbitrary in character," that is, unrelated to the plaintiff's medicinal mouthwash, provided a basis for Lambert "to insist that others in making up their arbitrary names should so certainly keep away from his customers as to raise no question."<sup>58</sup> Thus, the court concluded that Bolton Chemical Corporation's Listogen for medical mouthwash was infringing.<sup>59</sup> Listogen was also a fanciful mark, but that did not inure to Bolton's benefit. Judge Hand decided "there was no reason whatever why [Bolton] should have selected [a mark] which bore so much resemblance to the plaintiff's."<sup>60</sup> The fanciful nature of Listerine provided the basis for drawing a wide protective boundary around the mark.

Likewise, the Third Circuit in *Kos Pharmaceuticals, Inc. v. Andrx Corp.* held that Andrx's Altocor mark for an anticholesterol drug was confusingly similar to Kos Pharmaceutical's Advicor anticholesterol drug.<sup>61</sup> Kos's Vice President of Marketing testified that "Kos chose ADVICOR as 'a fanciful, made-up name' that would be 'an unusual, distinctive name to make the drug stand out to doctors as unique.'"<sup>62</sup> This uniqueness not only led the court to conclude that Advicor was inherently strong, but also shaped the way in which the court analyzed the similarity between the competing marks. The court concluded that similarities of sight and sound are accentuated when comparing an allegedly infringing mark to a fanciful mark.<sup>63</sup> The court found likely confusion even

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55. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1588–89 (2006) [hereinafter Beebe, *Multifactor Tests*].

56. *Id.* at 1637–39.

57. 2 McCARTHY, *supra* note 5, at § 11:6; Exxon Corp. v. XOIL Energy Res., Inc., 552 F. Supp. 1008, 1014 (S.D.N.Y. 1981) (an arbitrary mark is "entitled to the widest protection possible"). *But see* Bone, *Confusion*, *supra* note 49, at 1343.

58. 219 F. 325, 326 (S.D.N.Y. 1915); *see also* Virgin Enters. Ltd. v. Nawab, 335 F.3d 141, 148 (2d Cir. 2003) ("The more unusual, arbitrary, and fanciful a trade name, the more unlikely it is that two independent entities would have chosen it.").

59. *Lambert Pharmacal Co.*, 219 F. at 327–28.

60. *Id.* at 326.

61. 369 F.3d 700, 713 (3d Cir. 2004).

62. *Id.* at 707.

63. *Id.* at 713.

though, in a case in a different jurisdiction, a Kos executive testified that the “suffix COR . . . is very common in the [relevant] pharmaceutical [ ] category.”<sup>64</sup>

Some courts lump arbitrary and fanciful marks together as equivalent in their inherent distinctiveness and strength.<sup>65</sup> Other courts distinguish between arbitrary and fanciful marks.<sup>66</sup> But some empirical evidence indicates that fanciful marks are offered a wider scope of protection than arbitrary marks.<sup>67</sup> In addition, as the analysis in the next Section highlights, the common rationales advanced for the automatic and broad protection of inherently distinctive marks apply more readily to fanciful marks than to arbitrary or suggestive marks. Some rationales—the absence of prior lexical meaning and the creativity involved in coining a new mark—apply only to fanciful marks.<sup>68</sup>

#### B. WHY THE LAW TREATS FANCIFUL MARKS AS INHERENTLY DISTINCTIVE AND STRONG

A fanciful mark is seen as innately capable of communicating source to consumers and inherently deserving of broad protection. But why is this so? Courts have four loosely affiliated rationales for automatically protecting fanciful marks and providing a broad scope of protection. First, the fanciful mark has no inherent lexical meaning when the mark owner first coins it. Because the fanciful mark is an empty vessel, courts see the fanciful mark as automatically source-signifying when used as a mark. Second, that the mark is coined suggests to courts that the mark owner is entitled to the fruits of his or her creativity or at least a presumption that the mark was adopted in good faith. Third, because a fanciful mark has no meaning prior to its conception and use, competitive concerns that animate limits on the protection of descriptive marks or functional trade dress are seen as immaterial or at least less relevant. Fourth, courts treat fanciful marks as inherently distinctive because they are categorically distinguishable from descriptive marks. Protection for descriptive marks

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64. *Id.* at 707 (citing letters by Kos to the European Community Trademark Office regarding a dispute over confusion between Advicor and Activor for an over-the-counter stimulant). The court in *Kos* was not willing to grant much weight to the foreign filing. *Id.* at 713–14.

65. *See, e.g.,* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

66. *See, e.g.,* *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir. 1980); *France Milling Co., Inc. v. Washburn-Crosby Co., Inc.*, 7 F.2d 304, 306 (2d Cir. 1925) (“If the name or mark be truly arbitrary, strange, and fanciful, it is more specially and peculiarly significant and suggestive of one man's goods, than when it is frequently used by many and in many differing kinds of business.”); *Schechter*, *supra* note 49, at 829 n.80 (“A broader protection will be granted where a purely fanciful mark has been adopted, used and given wide publicity than where some words in ordinary use are adopted in a phrase which is commonplace and somewhat suggestive.” (quoting *Am. Fruit Growers, Inc. v. John Braadland, Ltd.*, 151 M.D. 239, 16 T.M. Rep. 409 (1926))).

67. *See* *Beebe, Multifactor Tests*, *supra* note 55, at 1637 (“[I]n the ninety dispositive opinions in which the court placed the plaintiff's mark in one of the five [distinctiveness] categories, the plaintiff multifactor test win rate steadily declined with the inherent strength of its mark: fanciful marks enjoyed the highest win rate, followed by arbitrary marks, suggestive marks, descriptive marks, and then generic marks.”).

68. *See infra* Sections I.B.1–2.

must be justified, but fanciful marks are not like descriptive marks, at least with regard to their lexical meaning. Thus, some courts use the categorical dissimilarities to drive differential treatment. The following Sections describe these rationales in more detail. Each rationale depends in part on the theory of linguistic arbitrariness—that there is no inherent connection between a given word and the thing it signifies, so a fanciful mark has no inherent denotation.

### 1. Fanciful Marks Presumably Lack Intrinsic Meaning and Thus Have No Inherent Connection to the Product

A fanciful mark is a word that is coined or invented to serve as a trademark.<sup>69</sup> Prior to its selection as a trademark, a fanciful mark is a nonword, or at least lacks a literal meaning. For example, until the Xerox Corporation began selling photocopiers, the combination of sounds and shapes that constitute the word “xerox” had no collective meaning.<sup>70</sup> Thus, unlike other words pressed into service as a mark, courts perceive that a fanciful mark has no pre-existing meaning.

Courts presume this novelty generates a significant impression on the mind of the buyer.<sup>71</sup> A fanciful mark is unique and thus less likely subject to the crowding that often narrows protection of descriptive marks.<sup>72</sup> For example, xerox had no public or collective meaning when consumers first encountered the term. Courts therefore presume consumers will readily recognize the term as identifying the source of the machines that bear it.<sup>73</sup>

Courts thus treat fanciful marks as inherently strong because they “have no intrinsic connection to the product with which the mark is used.”<sup>74</sup> A fanciful

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69. Words that have fallen out of use so sufficiently as to be totally unfamiliar to the ordinary consumer are also treated as fanciful. *See, e.g.,* Pa. Salt Mfg. Co. v. Myers, 79 F. 87, 89–90 (C.C.E.D. Mo. 1897) (noting that although a student of Latin might surmise that Saponifier is a product used to make soap, it would mean nothing to the average, uneducated consumer and would thus be considered a fanciful or arbitrary term); Collyrium, Inc. v. John Wyeth & Bro., Inc., 167 Misc. 231, 233–34, 3 N.Y.S.2d 42, 45 (N.Y. Sup. Ct. 1938) (noting that although medical professionals might recognize Collyrium as a term for an eye salve, the average consumer would not).

70. *See supra* note 45 and accompanying text.

71. *See* Pfizer Inc. v. Sachs, 652 F. Supp. 2d 512, 520 (S.D.N.Y. 2009) (finding that a mark was fanciful because it was coined “specifically for purposes of this trademark and has no meaning outside this context”); Aveda Corp. v. Evita Marketing, Inc., 706 F. Supp. 1419, 1428 (D. Minn. 1989) (“Fanciful marks, if adopted in a bona fide first use, are considered the strongest of marks because their inherent novelty creates a substantial impact on the buyer’s mind.”).

72. *See* Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 429 n.10 (2003) (comparing the crowded field of marks derived from “symbols, words or phrases in common use” (citing Schechter, *supra* note 49, at 828–29)).

73. This empty vessel quality may generate some resistance on the part of mark owners who are often advised by lawyers to select inherently distinctive marks but tend to gravitate toward marks with descriptive qualities. *See, e.g.,* Heymann, *supra* note 30, at 389. My thanks to Peter Karol for our discussion on this topic.

74. *See* Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp., 174 F.3d 1036, 1058 & n.19 (9th Cir. 1999) (“We have recognized that, unlike arbitrary or fanciful marks which are typically strong, suggestive marks are presumptively weak.”); *see also* Gift of Learning Found., Inc. v. TGC, Inc., 329 F.3d 792, 797–98 (11th Cir. 2003).

mark is presumed to “bear no logical or suggestive relation to the actual characteristics of the goods”<sup>75</sup> or is “totally unrelated to the product.”<sup>76</sup> Because a fanciful mark does not denote an affiliated product, courts presume that consumers will instead perceive the mark as inherently source-identifying.<sup>77</sup> Likewise, courts see the lack of connection between product and mark as a basis for affording broad protection to the mark.<sup>78</sup>

This perceived lack of connection between mark and source has also been interpreted to indicate that “any association [between mark and product] is the result of goodwill” acquired by the mark owner which “deserves broad protection from potential infringers.”<sup>79</sup> Courts posit that, in light of the arbitrariness of the choice of mark, consumers will likely conclude that products bearing the same mark or similar marks all come from the same source.<sup>80</sup> Likewise, courts have held that consumers are unlikely to recognize subtle differences between fanciful marks because when the words are meaningless, “slight variations in spelling or arrangement of letters are often insufficient to direct the buyer’s attention to the distinction between marks.”<sup>81</sup> Thus, in *Altira Group LLC v. Philip Morris Cos.*, the court held that defendant’s Altria mark for “charitable, shareholder, community, volunteer, arts and music and investment services” was confusingly similar to plaintiff’s Altira mark for venture capital investment services.<sup>82</sup> The court concluded consumers could be easily confused whether

75. *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 221 (3d Cir. 2000) (quoting *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986)).

76. *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999).

77. *See* *La. World Exposition, Inc. v. Logue*, 746 F.2d 1033, 1040 (5th Cir. 1984) (fanciful marks “readily identifi[y] the producer” (citing *Chevron Chem. Co. v. Voluntary Purchasing Grps.*, 659 F.2d 695, 702 (5th Cir. 1981))); Thomas F. Cotter, *Owning What Doesn’t Exist, Where It Doesn’t Exist: Rethinking Two Doctrines from the Common Law of Trademarks*, 1995 U. ILL. L. REV. 487, 502–03, 528 (1995) (“[D]escriptive and suggestive marks are generally more efficient [at generating goodwill] than arbitrary or fanciful marks” because descriptive and suggestive marks denote or connote product features); Alexandra J. Roberts, *How to Do Things With Word Marks: A Speech-Act Theory of Distinctiveness*, 65 ALA. L. REV. 1035, 1043 (2014) (“Fanciful and arbitrary marks map neatly onto the speech-act schema: KODAK for cameras and BUMBLE AND BUMBLE for hairspray are innately source-constative precisely because they are never goods-constative.”); Smith, *supra* note 28, at 186 (“[I]f the word communicates nothing to the consumer about the underlying product itself, the consumer will assume the word communicates only the product’s origin.”).

78. Xuan-Thao N. Nguyen, *Nationalizing Trademarks: A New International Trademark Jurisprudence?*, 39 WAKE FOREST L. REV. 729, 737 (2004) (“Both arbitrary and fanciful trademarks receive the highest level of trademark protection because these words themselves do not possess any relation to the accompanying goods or services to which the words are affixed.”).

79. *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1130 n.7 (9th Cir. 1998).

80. *See, e.g., Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 148 (2d Cir. 2003) (“If a mark is arbitrary or fanciful, and makes no reference to the nature of the goods it designates, consumers who see the mark on different objects offered in the marketplace will be likely to assume, because of the arbitrariness of the choice of mark, that they all come from the same source.”).

81. *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 731–32 (C.C.P.A. 1968); *see also* *E.I. Dupont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 511 (E.D.N.Y. 1975) (“It is generally thought that use of similar coined words renders confusion more likely.”).

82. 207 F. Supp. 2d 1193, 1196 (D. Colo. 2002).

comparing the marks by sight, by sound, or on their lack of inherent meaning.<sup>83</sup>

## 2. The Creation of a New Word is Seen to Justify Strong Protection

When created, a coined mark adds to, rather than subtracts from, the lexicon of known terms.<sup>84</sup> A coined mark can also be seen to embody the personality and creativity of the firm that coined it.<sup>85</sup> Courts presume that a fanciful mark is coined with its source-signifying purpose in mind.<sup>86</sup> Unlike a descriptive mark, which retains its original descriptive meaning even after acquiring source significance,<sup>87</sup> the fanciful mark ostensibly bears no other meaning. Therefore, a fanciful mark might merit broader protection than other marks on equitable grounds.<sup>88</sup> This presumption is so robust that at least one court treated the entitlement to a fanciful mark as sufficiently strong to persist even in the face of generic use by consumers of the fanciful mark,<sup>89</sup> which might otherwise strip the mark of source significance.<sup>90</sup> In addition, because the fanciful mark bears no common, lexical meaning, similarities of sight and sound will be accentuated, leading a court to conclude a competitor's use of a mark that resembles a fanciful mark is infringing.<sup>91</sup>

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83. *Id.* at 1198–99. Altira did not prevail on its motion for preliminary injunction, however, because the court found the parties' businesses overlapped little, if at all, and plaintiff's customers were sophisticated institutional investors and thus likely to take care to distinguish between plaintiff and defendant. *Id.* at 1202–04.

84. *See* Schechter, *supra* note 49, at 828–29 (positing, on the basis of this addition, that “[t]he rule that arbitrary, coined or fanciful marks or names should be given a much broader degree of protection than symbols, words or phrases in common use would appear to be entirely sound” because those marks stand out as somewhat unique); *see also* Landes & Posner, *supra* note 49, at 290 (positing an effectively limitless supply of fanciful marks).

85. *See* Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 353–54 (1988) (arguing that the treatment of arbitrary and fanciful marks as inherently distinctive reflects “the unseen hand of the personality justification” for intellectual property).

86. *See, e.g.,* Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 143 (2d Cir. 1997) (“[T]he term ‘fanciful’ . . . is usually applied to words invented solely for their use as trademarks.” (quoting Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11 n.12 (2d Cir. 1976))); JDR Indus., Inc. v. McDowell, 121 F. Supp. 3d 872, 884 (D. Neb. 2015) (“[A] fanciful mark is a coined word or phrase, such as Kodak, *invented solely* to function as a trademark.” (emphasis added) (citing Dreamwerks Prod. Grp., Inc. v. SKG Studio, 142 F.3d 1127, 1130 n.7 (9th Cir. 1998))); *see also* Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd., 187 F.3d 363, 369 (4th Cir. 1999) (“[A] mark qualifies as . . . fanciful if it is newly invented”); Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 464 (4th Cir. 1996) (“Fanciful marks are . . . made-up words expressly coined for serving as a trademark.”).

87. *See* Ramsey, *supra* note 36, at 1099.

88. Stork Rest., Inc. v. Sahati, 166 F.2d 348, 355 (9th Cir. 1948) (“Equity gives a greater degree of protection to ‘fanciful’ [trademarks] than it accords to names in common use.”).

89. *See* Selchow v. Baker, 93 N.Y. 59, 69 (1883).

90. *See* Linford, “*Generic*” Trademarks, *supra* note 22, at 150.

91. Kos Pharm., Inc. v. Andrx Corp., 369 F.3d 700, 713 (3d Cir. 2004) (finding that Advicor and Altacor are confusingly similar when both used for prescription cholesterol reducing drugs as “[t]wo names that look and sound similar will naturally seem even more similar where there are no differences in meaning to distinguish them”).



### 3. Protection for Fanciful Marks Presumably Does Not Threaten Competition Goals

Scholars and courts note that the protection of a descriptive term as a trademark threatens to prevent entry by competitors.<sup>92</sup> If one firm has a recognized right in Tasty as a mark for bread, other firms may be prohibited from using the term as a mark, even though their bread might be tasty as well. Even scholars unconcerned with the competitive harm posed by protecting descriptive marks recognize that many of those terms (especially laudatory terms) will frequently be appropriated by multiple firms for multiple lines of products, leading to narrow bands of protection for each appropriator of a descriptive term like Tasty.<sup>93</sup>

On the other hand, because a fanciful mark bears no inherent meaning, every competitor can choose its own fanciful mark.<sup>94</sup> Lack of connection between mark and product means there is likely no competitive harm if the mark is granted broad protection from first use. Thus, courts often presume that a fanciful mark was adopted not to free ride on consumer predisposition,<sup>95</sup> but “to indicate origin or ownership.”<sup>96</sup> In addition, at least some courts look at the use of a mark similar to a fanciful mark as evidence of the bad faith of the junior user.<sup>97</sup>

### 4. Fanciful Marks Are Seen as Categorically Distinct from Descriptive Marks

Courts also describe fanciful marks in terms of what they are not. Courts often couch the basis for early and extensive protection of fanciful and arbitrary marks by contrasting them with descriptive marks. For example, in *Heublein v. Adams*, the court concluded that the name Club Cocktails as applied to bottled cocktails was inherently distinctive because it could not be categorized as descriptive: “These words respond to all the tests of a valid trade-mark. They are not a geographical name, nor a personal name, nor are they descriptive

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92. See, e.g., Linford, *False Dichotomy*, *supra* note 1, at 1377–78.

93. See Schechter, *supra* note 49, at 828–29.

94. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 771 (1992) (explaining that an inherently distinctive mark is “not subject to copying by concerns that have an equal opportunity to choose their own inherently distinctive trade dress”).

95. Decisions in the Second Circuit go so far as to state that the owner of a descriptive mark assumes the risk of confusion. See, e.g., *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997); *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir. 1995).

96. See *Heublein v. Adams*, 125 F. 782, 784 (C.C.D. Mass. 1903).

97. See, e.g., *Durable Toy & Novelty Corp. v. J. Chain & Co.*, 133 F.2d 853, 855 (2d Cir. 1943) (explaining “it will be hard indeed for the newcomer to find any excuse for invading [a coined mark]”); *Emerson Elec. Mfg. Co. v. Emerson Radio & Phonograph Corp.*, 105 F.2d 908, 910–11 (2d Cir. 1939) (noting that cases involving technical or inherently distinctive trademarks “offer no difficulty” because the defendant is usually a “mere pirate” without any “excuse” for using the mark, and use “almost inevitably” involves “fraud”); Bone, *Confusion*, *supra* note 49, at 1323 n.98 (citing the cases aforementioned in this footnote); Fromer, *supra* note 49, at 1911.

within the meaning of the trade-mark law.”<sup>98</sup> Because a descriptive mark directly denotes some characteristic of the product offered for sale, like size, shape, or color, courts hesitate to extend protection to the descriptive mark.<sup>99</sup> A fanciful mark looks entirely different. The fanciful mark not only fails to denote product characteristics (which can also be said of an arbitrary mark), it fails to denote anything.<sup>100</sup> In other words, the law protects fanciful marks because they are not like descriptive marks.

Unfortunately, using the absence of descriptive features as the *sine qua non* of fanciful marks can lead to miscategorizations. The decision in *Heublein* itself is just such a failed attempt at mark classification. Most trademark experts would not categorize Club Cocktails as a fanciful, or even arbitrary mark, but the language in the *Heublein* case is prototypical of an approach that treats non-descriptiveness as equivalent to distinctiveness.

### C. FANCIFUL MARKS AND LINGUISTIC ARBITRARINESS

The aforementioned justifications for the broad protection afforded fanciful marks depend on linguistic arbitrariness—a lack of inherent connection between the form of the word and its meaning.<sup>101</sup> If the meaning of a word is by definition disconnected from its form, then any combination of letters when first used as a word will be an empty vessel, to later be filled with meaning. If that is true, then a fanciful mark cannot have any inherent connection to the product sold, and it cannot be mistaken for a descriptive or even a suggestive mark. Thus, protecting a fanciful mark is unlikely to have a significant negative impact on competitors. A fanciful mark would also make a novel contribution to the lexicon—letters and sounds combined in a new way, designed to communicate product source to consumers but not product characteristics.

Having presented the prevailing treatment of fanciful marks in this Part, Part II introduces the theory of linguistic arbitrariness that underpins this treatment. It then presents evidence of sound symbolism, which contravenes the theory of linguistic arbitrariness.

## II. LINGUISTIC ARBITRARINESS AND SOUND SYMBOLISM

Human language is an imperfect tool for communication. Our utterances are filled with ambiguity, words loaned from foreign languages, and neologisms that the audience must construe with partial information.<sup>102</sup> Language users develop tools to resolve that ambiguity and make sense out of nonsense. Consider, for example, Lewis Carroll’s well-known poem, “Jabberwocky,” which opens “‘Twas brillig, and the slithy toves/Did gyre and gimble in the

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98. *Heublein*, 125 F. at 784.

99. Linford, *supra* note 1, at 1384.

100. *See supra* Section I.B.1.

101. *See infra* Section II.A.

102. *See* Linford, *False Dichotomy*, *supra* note 1, at 1390–1402.

wabe.”<sup>103</sup>

Context clues hint at some interpretations for the apparently meaningless words in “Jabberwocky.”<sup>104</sup> *’Twas* indicates time, so *brillig* likely designates a time of day, like dawn or dusk. *Brillig* also sounds like brilliant, so one might guess the action takes place during the day. *Toves* apparently move in two ways (they *gyre* and *gimble*), which suggests that *gyre* and *gimble* are both action verbs. *Gyre* is similar to gyrate, whereas *gimble* resembles shamble. *Toves* are therefore things that can move or be moved. *Slithy* is likely an adjective, modifying *toves*, and *slithy* sounds like slimy and lithe. The use of the prepositional phrase *in the wabe* indicates that *the wabe* is a place suitable for *slithy toves* to *gyre* and *gimble*. *Wabe* looks and sounds like wave or wake. One could postulate that *the wabe* has a significant amount of water and, at least at *brillig*, is full of undulating *slithy toves*.<sup>105</sup>

But nonsense words can deliver meaning in another way, independent of context clues like word position or similarity to known words.<sup>106</sup> The sounds that comprise a word can also convey meaning. This phenomenon of sound symbolism—a direct connection between word sound and word meaning—has been measured for consonants and vowels in English and other languages. The effect of this sound symbolism is sufficiently strong that with the right sound symbols, “nonsense words function indistinguishably from conventional words.”<sup>107</sup>

Historically, scholars resisted suggestions that sound symbolism shaped word meaning, preferring an account of linguistic arbitrariness—a lack of connection between word meaning and word form.<sup>108</sup> Linguistic arbitrariness is the unstated theory undergirding the treatment of fanciful marks.<sup>109</sup> But recent evidence of sound symbolism calls into question the theory of linguistic arbitrariness and thus complicates the presumption that a fanciful mark bears no product significance.

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103. LEWIS CARROLL, *THROUGH THE LOOKING GLASS: AND WHAT ALICE FOUND THERE* 19 (Plain Label Books 2007) (1871).

104. These context clues can include phonological priming—whether the nonsense word rhymes with or shares sounds with a word that the listener recognizes—and syntactical and distributional information, which suggests meaning based on whether the nonsense word corresponds to a traditional part of speech. See Matt A. Johnson & Adele E. Goldberg, *Evidence for Automatic Accessing of Constructional Meaning: Jabberwocky Sentences Prime Associated Verbs*, 28 *LANG. & COGNITIVE PROCESSES* 1439 (2013); Gary Lupyan & Daniel Casasanto, *Meaningless Words Promote Meaningful Categorization*, 7 *LANG. & COGNITION* 167, 168 (2014) (citing Angel Cabrera & Dorris Billman, *Language-Driven Concept Learning: Deciphering Jabberwocky*, 22 *J. EXPERIMENTAL PSYCH.: LEARNING, MEM. & COGN.* 539 (1996)).

105. See Lupyan & Casasanto, *supra* note 104, at 168.

106. See *id.* at 182–83.

107. *Id.* at 167.

108. See *infra* Section II.A.

109. See *supra* Section I.B.

## A. LINGUISTIC ARBITRARINESS

Linguistic arbitrariness is the idea embodied in the famous lines from Shakespeare, “[t]hat which we call a rose/By any other name would smell as sweet.”<sup>110</sup> According to the theory of linguistic arbitrariness, there is no inherent relationship between the sound and image of a word, or the signifier, and the concept or thing represented by the word, known as the signified.<sup>111</sup> Thus, there is no natural connection between the signifier t-r-e-e, pronounced <trí>, and its signified, “a woody perennial plant having a single usually elongate main stem generally with few or no branches on its lower part.”<sup>112</sup> Linguistic arbitrariness does not mean that one is free to choose any signifier to stand in for the signified we call a tree, but that our collective agreement to use tree to signify the plant has nothing to do with the form of the word.<sup>113</sup> Under a theory of absolute linguistic arbitrariness, a neologism like a fanciful mark will be meaningless until meaning begins to collectively coalesce around the word,<sup>114</sup> and the form of the word chosen will provide no clue to the intended interpretation.<sup>115</sup> Likewise, any randomly selected label for an object should be functionally equivalent to any other.<sup>116</sup>

The theory of linguistic arbitrariness is consistent with the current treatment of fanciful marks. Indeed, the manner in which courts handle fanciful marks depends on linguistic arbitrariness. If linguistic arbitrariness is the default starting point for any new word, then any fanciful mark will work as well as any other fanciful mark to designate the source of consumer goods. With no inherent connection between product and mark, the fanciful mark should stand out as a source signifier from the first experience consumers have with the mark. Thus, the apparent lack of connection between fanciful mark and product category reduces potential anticompetitive side effects of trademark protection<sup>117</sup> and provides some basis for viewing a fanciful mark as sufficiently unique to merit

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110. J.M. Balkin, *Nested Oppositions*, 99 YALE L.J. 1669, 1697 (1990) (citing WILLIAM SHAKESPEARE, ROMEO AND JULIET act 2, sc. 2, lines 43–44 (Barbara A. Mowat & Paul Werstine eds.); JOHN M. ELLIS, AGAINST DECONSTRUCTION 45–46 (1989)).

111. The linguist Ferdinand de Saussure is credited with the key articulation of linguistic arbitrariness. Saussure posited that arbitrariness was a fundamental characteristic of language. Saussure conceded the existence of onomatopoeia, but discounted it as rare. DE SAUSSURE, *supra* note 18, at 69, 131–34.

112. *Tree*, MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (11th ed. 2006).

113. As a semiotician might say, the “ordinary meaning [of the mark] could not reasonably be understood to describe or suggest any characteristic of its referent.” Beebe, *Semiotic Analysis*, *supra* note 49, at 671.

114. *Id.* at 634 (“As Claude Lévi-Strauss explained, the sign is arbitrary *a priori*, but non-arbitrary *a posteriori*.” (first citing DAVID HOLDCROFT, SAUSSURE: SIGNS, SYSTEM, AND ARBITRARINESS 53 (1991); then citing ROLAND BARTHES, ELEMENTS OF SEMIOLOGY 51 (Annette Lavers & Colin Smith trans., 1967) (1964))).

115. Sam J. Maglio et al., *Vowel Sounds in Words Affect Mental Construal and Shift Preferences for Targets*, 143 J. EXPERIMENTAL PSYCHOL. 1082, 1082 (2014).

116. *See id.*

117. *See, e.g.*, Beebe, *Semiotic Analysis*, *supra* note 49, at 674 (observing that if the law aims to provide an incentive to trademark producers to generate new words, the law should limit the grant of

automatic, strong protection.<sup>118</sup>

For nearly a century, linguistic arbitrariness has been the default position for linguists and psychologists studying language.<sup>119</sup> This linguistic arbitrariness, however, is overstated. As the next Section explains, linguistic and psychological research has detected significant connections between word form and word meaning by way of sound symbolism. “Sound symbolism is the direct linkage between sound and meaning.”<sup>120</sup> Academic resistance to sound symbolism was initially high, with scholars voicing dismay at its continual resurgence.<sup>121</sup> But evidence in favor of sound symbolism continues to pile up. In study after study, research subjects identify vowel and consonant sounds that shape word meaning,<sup>122</sup> even though study participants rarely recognize the impact that sound symbolism has on how they construe nonsense words.<sup>123</sup> These findings refute the theory of linguistic arbitrariness. Unlike courts and legal scholars, marketers have been aware of the benefits of sound symbolism for some time now, and they seek competitive advantage by utilizing the communicative and attractive function of sound symbols when coining a fanciful trademark.<sup>124</sup>

#### B. SOUND SYMBOLISM

Researchers provide mounting evidence that sound symbolism has a broader effect on word meaning than is recognized under a strong form of linguistic arbitrariness. Meaning is not fully independent of word form. Indeed, the evidence gathered suggests that, to a significant extent, “the sounds of words can convey meaning apart from their actual definitions, and this meaning can systematically bias perceptions and judgments.”<sup>125</sup>

A handful of early scholars posited that sound symbolism might shape word meaning,<sup>126</sup> but empirical research into sound symbolism did not begin in

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the broadest protection to fanciful marks; an arbitrary mark is not a new lexical unit, merely a new meaning for an existing word).

118. *See, e.g., id.* at 694–95 (arguing that antidilution protection, a broad protection against any use of the mark regardless of product category and irrespective of confusion, should properly be limited to fanciful marks, which are the only marks that are potentially sufficiently unique to merit such protection).

119. Lockwood & Dingemanse, *supra* note 18, at 1 (summarizing the dominant position of linguistic ambiguity); Frederick J. Newmeyer, *Iconicity and Generative Grammar*, 68 *LANG.* 756, 758 (1992) (arguing that the extent of sound symbolism in any given language is “vanishingly small”).

120. Hinton et al., *supra* note 9, at 1.

121. *See, e.g.,* James J. Jenkins, 4 *CONTEMPORARY PSYCHOLOGY* 193, 194 (1959) (“Phonetic symbolism . . . has been thrown out of psychology and linguistics again and again but persists in returning when its latest antagonist turns his back.”).

122. *See, e.g.,* Lockwood & Dingemanse, *supra* note 18, at 4.

123. *See, e.g.,* Yorkston & Menon, *supra* note 16, at 44.

124. *See* Gabler, *supra* note 10, at 41; *see also infra* Section II.C; *cf.* Tushnet, *supra* note 16, at 886.

125. Lowrey & Shrum, *supra* note 17, at 412.

126. *See, e.g.,* WILHELM VON HUMBOLDT, *ON LANGUAGE: ON THE DIVERSITY OF HUMAN LANGUAGE CONSTRUCTION AND ITS INFLUENCE ON THE MENTAL DEVELOPMENT OF THE HUMAN SPECIES* 73–74 (Michael Losonsky, ed., Heath, trans. 1999) (1836) (identifying three ways in which the sound of a word may designate the signified object: direct imitation, like onomatopoeia; symbolic designation, by which the

earnest until the twentieth century. Anthropologist–linguist Edward Sapir is credited with the first laboratory experiment demonstrating sound symbolism.<sup>127</sup> In Sapir’s most famous study, 500 subjects, aged eleven to adult, including native English and Chinese speakers, were asked which of two imaginary tables bearing the names *mal* and *mil* was larger. The vast majority of respondents (approximately 80%) identified *mal* as the larger table.<sup>128</sup> To Sapir, this indicated that the /a/ sound conveyed largeness when compared to the /i/ sound.<sup>129</sup>

Another early study asked respondents to select the name that better suited one of two shapes or creatures.<sup>130</sup> In that study and subsequent experiments, respondents repeatedly—and sometimes overwhelmingly<sup>131</sup>—associate words like *takete* or *kiki*, which have plosive consonants, with shapes or creatures possessing spiky features, and words like *maluma* or *bouba*, which have sonorant consonants, with round features.<sup>132</sup>

The effect of sounds on word meaning has been identified in many subsequent studies.<sup>133</sup> Research participants commonly associate the vowel /i/ with adjectives like precise, bright, spiky, fast, small, and red; the vowel /u/ is commonly associated with adjectives like broad, dark, and round; and the vowel /a/ is commonly associated with adjectives like large and yellow.<sup>134</sup> Back

sound “produce[s] for the ear an impression similar to that of the object upon the soul;” and analogical designation, whereby words with similar meanings are given similar sounds, irrespective of any inherent sound symbolism.).

127. See generally Sapir, *Phonetic Symbolism*, *supra* note 12 (arguing there are types of linguistic expression that suggest a psychological symbolism).

128. *Id.* at 230 (research participants consistently chose words like *mal* with the /a/ sound as the more appropriate name for a large table, compared to words like *mil* with the /i/ sound).

129. *Id.* at 234.

130. See Wolfgang Köhler, *GESTALT PSYCHOLOGY: AN INTRODUCTION TO NEW CONCEPTS IN MODERN PSYCHOLOGY* 224–25 (1947) (*takete* and *maluma*).

131. James Surowiecki, *What’s in a Brand Name?*, *NEW YORKER*, Nov. 14, 2016 (“In one experiment, . . . [n]inety-five per cent of those who were asked which of two made-up words—‘bouba’ or ‘kiki’—best corresponded to each picture said that ‘bouba’ fit the curvy object and ‘kiki’ the spiky one.”).

132. *Id.*; see also Mark Aveyard, *Some Consonants Sound Curvy: Effects of Sound Symbolism on Object Recognition*, 40 *MEMORY & COGNITION* 83, 86, 88 (2012) (replicating the *taketa* and *maluma* effect for plosive and nonplosive consonants); Ković Vanja et al., *The Shape of Words in the Brain*, 114 *COGNITION* 19, 19 (2010) (reporting more rigorous studies of the *takete* and *maluma* effect); Daphne Maurer et al., *The Shape of Boubas: Sound-Shape Correspondences in Toddlers and Adults*, 9 *DEVELOPMENTAL SCI.* 316 (2006) (same); V.S. Ramachandran & E.M. Hubbard, *Synaesthesia—A Window into Perception, Thought and Language*, 8 *J. CONSCIOUSNESS STUD.* 3, 19 (2001) (*kiki* & *bouba*).

133. This Article takes no position on why sound symbolism correspondences exist. For a review of literature providing theories for why correspondences between word form and meaning occur, see Janis B. Nuckolls, *The Case for Sound Symbolism*, 28 *ANN. REV. ANTHROPOLOGY* 225 (1999); Susan Krupa McCune, *Exploring the Combinatory Effects of Phonesthemes in Brand Naming* 8–9 (Aug. 2011) (unpublished M.A. thesis, California State University, Long Beach) (on file with author).

134. Stanley S. Newman, *Further Experiments in Phonetic Symbolism*, 45 *AM. J. PSYCHOL.* 53 (1933) (finding words with front vowels like /i/, /e/, and /a/ were perceived as lighter and softer than words with back vowels like /u/, /o/, and /au/); Lockwood & Dingemanse, *supra* note 18, at 5 (diagramming cross-modal map of typical associations with front vowels /i/, /u/, and /a/).

vowels like /o/ and /u/ are perceived as larger, darker, thicker, harder, slower, warmer, less bitter, less feminine, less friendly, stronger, and less pretty than front vowels like /e/ and /i/.<sup>135</sup> Similar results show associations between sound and taste,<sup>136</sup> sound and color,<sup>137</sup> and color and touch.<sup>138</sup>

Studies have also identified sound symbolism for consonants. Words with voiceless consonants (/p/, /t/) are perceived to identify things that are smaller, less potent, lighter, and sharper than things identified by words with voiced consonants (/b/, /d/). Words with fricatives (/s/, /f/, /z/) are perceived to designate things that are smaller, lighter, and faster than things designated by words with vocal stops (/p/, /k/, /b/).<sup>139</sup>

Sound symbolism has multiple effects that provide advantages in language comprehension. Research participants can consistently guess the meaning of sound-symbolic foreign language words at a statistically significant rate above random chance.<sup>140</sup> Correspondences between word form and meaning also appear to guide language interpretation and learning.<sup>141</sup> Sound symbolism even appears to help children learn or perceive word meanings across multiple languages.<sup>142</sup> These effects hold for nonsense words, like fanciful marks. These effects are also independent of “phonological priming,” meaning the similarity of nonsense words to meaningful words does not drive the effect.<sup>143</sup> Sound symbolism research also shows that in many contexts, people are predisposed to prefer certain sensory combinations over others.<sup>144</sup> Those sensory combinations can be successfully used by individuals exposed to an unknown word to decipher its meaning or at least salient characteristics about the thing signified.<sup>145</sup>

135. See Klink, *Names with Meaning*, *supra* note 12, at 14.

136. See Julia Simner et al., *What Sound Does that Taste? Cross-Modal Mappings Across Gustation and Audition*, 39 PERCEPTION 553, 553, 561 (2010).

137. See Gladys A. Reichard et al., *Language and Synesthesia*, 5 WORD 224, 224–30 (1949) (reporting salient synesthetic correspondences between sounds and colors for some adults).

138. Vera U. Ludwig & Julia Simner, *What Colour Does That Feel? Tactile-Visual Mapping and the Development of Cross-Modality*, 49 CORTEX 1089, 1089 (2013).

139. Carlyle Folkins & Peter B. Lenrow, *An Investigation of the Expressive Values of Graphemes*, 16 PSYCHOL. REC. 193 (1966); Klink, *Names with Meaning*, *supra* note 12, at 14; Newman, *supra* note 134, at 68–69. A more detailed description of the meanings attributed to phonemes is compiled in McCune, *supra* note 133, at 33–35.

140. See Lockwood & Dingemanse, *supra* note 18, at 7.

141. See Lupyan & Casasanto, *supra* note 104, at 168; Lynne C. Nygaard et al., *Sound to Meaning Correspondences Facilitate Word Learning*, 112 COGNITION 181, 181 (2009) (sound symbolism facilitates learning of foreign words in adults and children); Susan J. Parault & Paula J. Schwanenflugel, *Sound-Symbolism: A Piece in the Puzzle of Word Learning*, 35 J. PSYCHOLINGUISTIC RES. 329 (2006) (sound symbolism facilitates learning of unfamiliar words in native language in adults and children).

142. See Lockwood & Dingemanse, *supra* note 18; Mutsumi Imai et al., *Sound Symbolism Facilitates Early Verb Learning*, 109 COGNITION 54, 54 (2008).

143. Lupyan & Casasanto, *supra* note 104, at 182–83. For an example of phonological priming, see *supra* notes 103–05 and accompanying text.

144. Simner et al., *supra* note 136, at 553.

145. See *id.* at 566.

## C. FIRMS AND MARKETERS USE SOUND SYMBOLISM WHEN COINING TRADEMARKS

Sound symbolism allows marketers to communicate with consumers by selecting sounds for fanciful marks that connote desirable product characteristics. For example, as linguist and “professional namer” Will Leben has noted, the “S” of Swiffer, a mark for a mop with a disposable head, sounds fast and easy, whereas the “D” of Dasani, a mark for bottled water, sounds heavier and thus relaxing rather than refreshing.<sup>146</sup> Marketing research has identified multiple productive examples of sound symbolic preferences involving fictitious trademarks. For example, one study found that French, Spanish, and Chinese speaking subjects preferred fictitious brand names when the position of the vowel in the mouth matched the product’s perceived size attributes.<sup>147</sup>

In a second study, research participants were more likely to associate *Godan* than *Gidan* with a dark beer (/o/ conveys richness and darkness, compared to /i/), *Nellar* than *Nullar* with a faster Internet service (/e/ conveys speed compared to /u/), and *Kutum* than *Kitum* with a masculine deodorant (/u/ conveys masculinity compared to /i/).<sup>148</sup> In a similar study by the same author, research participants responded more favorably to *Silbee* than *Polbee* for shampoo (/s/ and /i/ are more closely associated with softness than /p/ and /o/); to *Zindin* than *Bondin* for pain relievers (/z/ and /i/ better communicate rapidity than /b/ and /o/); and to *Vextril* over *Guxtril* for a laptop computer (/v/ and /e/ better convey lighter weight than /g/ and /u/).<sup>149</sup>

A fourth study found participants perceived the fictional *Frosh* brand ice cream to be smoother, richer, and creamier than the similarly named *Frish*, consistent with the sound symbolism of the /ä/ sound in *Frosh*.<sup>150</sup> A fifth study expanded on previous research by comparing multiple fanciful brands for the same product and contrasting product attributes that might be desirable for the same product.<sup>151</sup> That study found that research participants preferred fanciful brand names with back vowels like *Gommel* for SUVs, hammers, and a “smooth, mellow, and rich” beer.<sup>152</sup> Participants likewise preferred brand names with front vowels like *Gimmel* for convertibles, knives, and “cold, clean, and crisp” beer (/o/ communicates largeness, heaviness, and smoothness compared

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146. Gabler, *supra* note 10, at 42.

147. L. J. Shrum et al., *Sound Symbolism Effects Across Languages: Implications for Global Brand Names*, 29 INT’L J. RES. MARKETING 275, 276 (2012).

148. Klink, *Names with Meaning*, *supra* note 12, at 10, 12 (reporting, for example, that participants perceived that *Godan* would be a stronger, darker, heavier beer than *Gidan* and also that they liked *Godan* better as a name for a dark beer).

149. Richard R. Klink, *Creating Meaningful New Brand Names: A Study of Semantics and Sound Symbolism*, 9 J. MARKETING THEORY & PRAC. 27, 29–31 (2001) [hereinafter Klink, *New Brand Names*].

150. Yorkston & Menon, *supra* note 16, at 46.

151. Lowrey & Shrum, *supra* note 17, at 412.

152. *Id.* at 409–12 (reporting a roughly 2:1 preference for brand names where desirable characteristics of the product match the sound symbolism of the vowel(s) in the brand name).



to /i/).<sup>153</sup>

A sixth study found that across twelve different product categories,<sup>154</sup> respondents identified brand names to bear meaning consistent with previously identified sound symbols.<sup>155</sup> The effect was significant whether the related sound symbol was a consonant or vowel.<sup>156</sup> For example, respondents selected *Vilp* as a faster brand of the motorcycle than brands using different consonants or vowels (both /v/ and /i/ communicate speed compared to other consonants and vowels).<sup>157</sup>

These studies show that the sounds in otherwise meaningless brand names arouse powerful associations in the minds of consumers, which can be used to transmit product-related information.<sup>158</sup> A wholly invented trademark is treated as inherently source-signifying and inherently strong because it bears no other denotation, but this research suggests that the sounds that constitute a mark may denote product characteristics that shape consumer perception, even when consumers do not consciously recognize the effect.

At least one study suggests that the effects of sound symbolism combine with descriptive elements to increase the positive reaction of study participants to a phony brand. For example, in a study of a shampoo brand, study participants preferred a shampoo brand with both sound symbolic and descriptive elements (Silsoft) over a brand with only a sound symbolic element (Silbee) or no sound symbolism or descriptiveness (Polbee).<sup>159</sup> The results of that study do not establish that sound symbolism is not as attractive to consumers as descriptiveness, but that different or multiple types of meaning can combine to make a brand name more desirable.

This research into sound symbolism puts significant pressure on the theory of linguistic arbitrariness. It also raises questions about whether fanciful marks are truly “fanciful” in the empty-vessel, product-irrelevant, competition-neutral sense that courts and scholars have embraced to date. Part III considers how to treat fanciful marks in light of this new evidence about how sounds shape word meaning.

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153. *Id.* Shrum, Lowrey, and other coauthors later confirmed this effect in English, French, Spanish, and Chinese. Shrum et al., *supra* note 147, at 278.

154. McCune, *supra* note 133, at 34; *see also id.* at 37–39 (reporting a 2:1 or greater preference for multiple sound symbolic brand names, with a *p* value of < 0.0003).

155. *Id.* at 41.

156. *Id.* at 42–43.

157. *Id.* at 55.

158. Andrew Wong, *Branding and Linguistic Anthropology: Brand Names, Indexical Fields, and Sound Symbolism*, 36 PRACTICING ANTHROPOLOGY 38, 39 (2014).

159. Klink, *New Brand Names*, *supra* note 149, at 31 (also finding study participants prefer brand names for laptop computers and pain relievers that combine descriptive and sound symbolic elements to names that only use sound symbolic elements).

### III. HOW FANCIFUL IS FANCIFUL?

Sound symbolism challenges the theory of linguistic arbitrariness, and in doing so, challenges the presumption that a fanciful mark merits strong (or perhaps instant) protection. This Part reconsiders the rationales for affording broad protection to fanciful marks and suggests that sound symbolism complicates those rationales. Indeed, assuming that fanciful marks do not communicate product features may actually distort the standard likelihood of confusion analysis for trademark infringement. If fanciful marks convey information about product characteristics via sound symbolism, the law should account for the connection just as it does for descriptive marks. This might be done by dialing back some of the presumptions in favor of broad protection of fanciful marks.

Evidence of sound symbolism might also lead courts to reconsider the sight-sound-meaning components typically analyzed when assessing the similarity of two trademarks. In determining whether a junior use of a mark is infringing, courts consider the sight, sound, and meaning of litigants' trademarks as encountered in the marketplace.<sup>160</sup> Courts contemplate whether these elements in the respective marks "combine to create a general commercial impression that is the same" for the marks of the prior user and the alleged infringer.<sup>161</sup> Courts typically weigh similarities between marks more heavily than differences.<sup>162</sup> But similarities between individual sounds for competing products might be similar because the sounds communicate product features. When that is so, competitors should arguably be allowed to utilize those sounds in composing fanciful marks. At a minimum, courts should not conclude that the junior user has adopted its mark in bad faith based on similarities of product-relevant sound symbols.

#### A. FANCIFUL MARKS AND SOUND SYMBOLISM

This Section returns to the justifications for extending broad protection to fanciful marks introduced in Section I.B. and reconsiders them in light of evidence of sound symbolism. The evidence described in Part II indicates that sound symbolism is a phenomenon with real power. If the sounds that comprise a mark bear meaning, courts can no longer safely presume that extending broad protection to fanciful marks poses no potential competitive harm. Indeed, if the effect of sound symbolism is particularly strong, there may be little or no difference between the competitive advantages conveyed by some fanciful marks and most descriptive marks.

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160. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (9th Cir. 1979), *abrogated on other grounds by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

161. See, e.g., *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 229 (3d Cir. 2000).

162. See, e.g., *Sally Beauty Co., Inc. v. Beautyco, Inc.*, 304 F.3d 964, 972 (10th Cir. 2002); *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40 (D.C. Cir. 1956).

## 1. Sound Symbols May Connect Fanciful Marks to Mark-Bearing Products

Not every fanciful mark is as empty a vessel as courts currently presume. Research into sound symbolism has established connections between the sounds that comprise a word and the meanings that the audience will ascribe to the word. Sound symbolism need not communicate product qualities, but it often will. It is therefore problematic for courts to assume a fanciful mark bears no inherent meaning. Courts thus cannot safely presume a lack of connection between a fanciful mark and the product offered without considering sound symbolism.

Although any word can bear connotations driven by sound symbolism, the effect of this connotation may actually be more prominent for fanciful marks than for arbitrary marks. An arbitrary mark, like Apple for computers, takes a pre-existing word and uses it to designate the source of a product unrelated to that word. By definition, every arbitrary mark has at least one pre-existing lexical meaning, if not more.<sup>163</sup> Such a pre-existing meaning may swamp connotative, sound symbolic meanings. For an empty vessel like a fanciful mark, sound symbolism may actually have an outsized effect because the fanciful mark has no lexical meaning when first coined. Considered in that light, courts might more safely extend broad protection to an arbitrary mark than a fanciful mark.

## 2. Coining a Fanciful Mark is a Strategic Endeavor

Courts presume that because a fanciful mark was coined for use as a mark, the adoption of the mark is in good faith, and its protection is unlikely to have a harmful impact on competition. Enforcing a descriptive mark, by contrast, is often taken to signal an interest in keeping competitors from using descriptive terms.<sup>164</sup> But creating a new word to serve as a trademark is presumed to have almost entirely salutary effects.

That presumption is problematic for at least two reasons. First, adding a new word to the lexicon is not particularly valuable to the community at large if legal barriers prevent others from using the term. Courts have developed principles of descriptive fair use, which allows a competitor or the public to use a mark for comparative purposes,<sup>165</sup> and nominative fair use, which allows a competitor or the public to use the mark in reference to the marked product or mark owner.<sup>166</sup> But commentators question whether those defenses are suffi-

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163. Linford, *False Dichotomy*, *supra* note 1, at 1406–08, 1411–12.

164. *See, e.g.*, *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 651 (8th Cir. 1984) (discussing documents which demonstrate claimant's intent to use LA as a mark "to 'preempt' the low alcohol beer market" which "would inhibit competition").

165. *See, e.g.*, *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1058 (7th Cir. 1995).

166. *See, e.g.*, *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

ciently robust.<sup>167</sup> Courts could potentially police the scope of trademark protection at the likelihood of confusion stage. But when the mark is fanciful, the cases tend to cut sharply in favor of the mark owner.<sup>168</sup> Some courts even refuse to extend the descriptive fair use defense to fanciful marks.<sup>169</sup> Thus, expanding the size of the lexicon does not necessarily expand public use of the coined mark, even if the mark owner has created novel linguistic terrain. Second, as discussed in the next Section, evidence of sound symbolism suggests that selecting a fanciful mark with product-designating sound symbols provides a competitive advantage that may cause distortions in the market.

### 3. Sound Symbols May Provide Competitive Advantage

Courts currently presume a fanciful mark is entitled to broad protection compared to other marks because the new word has no lexical meaning. But a neologism that uses sound symbols may have potentially deleterious effects on competition. Indeed, the mark owner's choice of a fanciful mark may be far less capricious than the law presumes. There is some evidence that fanciful marks are often created with an ear toward sound symbolism.<sup>170</sup> Firms gain an advantage when the mark connotes product features because it is easier for consumers to associate the mark with those features. If certain combinations of consonants and syllables are more effective at conveying size, color, shape, or taste, then that connotation may be equally important to competitors.

Furthermore, sound symbolism complicates the assumption that a fanciful mark attracts consumers solely because of mark owner effort. As Judge Learned Hand said in reference to fanciful marks, courts rarely find a justification for a defendant to select a fanciful mark that too closely resembles another fanciful

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167. William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 88, 97 (2008) (arguing that descriptive fair use fails to protect many expressive uses, and nominative fair use is "excessively complex and [thus also] minimally useful").

168. See *supra* notes 58–64 and accompanying text (discussing the Listerine and Altocore cases).

169. See, e.g., *Inst. for Sci. Info., Inc. v. Gordon & Breach, Sci. Publishers, Inc.*, 931 F.2d 1002, 1010 (3d Cir. 1991) (noting that fair use defense presupposed that plaintiff's mark is descriptive); *Nat'l Football League Props. v. Playoff Corp.*, 808 F. Supp. 1288, 1293 (N.D. Tex. 1992) ("Because the marks involved here are more in the nature of fanciful or arbitrary rather than descriptive . . . even if the marks are used descriptively, the defense remains unobtainable because the marks themselves are not descriptive marks."); see also ANNE GILSON LALONDE ET AL., *TRADEMARK PROTECTION AND PRACTICE* § 11.08[3][d][i] (2008) ("When a mark has no other meaning besides its use as a mark, it cannot qualify for the fair use defense because it has no descriptive meaning to monopolize."). But see *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995) ("Regardless whether the protected mark is descriptive, suggestive, arbitrary, or fanciful as used in connection with the product or service covered by the mark, the public's right to use descriptive words or images in good faith in their ordinary descriptive sense must prevail over the exclusivity claims of the trademark owner.").

170. See generally Gabler, *supra* note 10 (detailing the process by which firms often employ sound symbolism in the development of marks). But see McCune, *supra* note 133, at 44 ("Phonesthemes cannot just be selected randomly, inserted into a name, and assumed to consistently deliver the expected results. . . . Therefore, use of phonesthemes should be developed in a systematic way that incorporates testing to confirm that the consumers' perceptions of the name match the goals and positioning desired by the brand itself.").

mark.<sup>171</sup> But research into sound symbolism challenges the consensus view that the similarity is unjustified. Instead, the decision of a competitor to choose a mark that bears significant similarity to a fanciful mark may be driven at least in part by sound symbolism. In other words, the competitor might be trying to invoke product qualities through the use of similar sounds,<sup>172</sup> in addition to creating a new word to denote product source. Thus, a presumption that the defendant who selects a mark too similar to a fanciful mark “cannot claim that he is exercising the normal privilege of using ordinary language”<sup>173</sup> may be ill-founded.

#### 4. Sound Symbolism Closes the Gap Between Fanciful and Descriptive Marks

The perceived differences between fanciful and descriptive marks begin to collapse as we acquire better information about consumer perception and the formation of language meaning. Consumers are more likely to be attracted to products bearing a mark with positive sound symbolism, even if they do not consciously recognize it.<sup>174</sup> A fanciful mark may plainly denote source, but it may also connote product. As the research into sound symbolism shows, that connotation has an effect. The effect is not only measurable in laboratory experiments, but is one that marketers and firms rely on. Firms frequently create new words by carefully selecting sounds that will connote product qualities, even if they don’t denote those qualities. In light of this evidence of sound symbolism, some fanciful marks likely have descriptive characteristics that communicate product qualities in a way the law does not currently recognize.

#### B. WHAT SHOULD THE LAW DO WITH SOUND SYMBOLS?

It may be time to reconsider the expansive protection extended to fanciful marks. Adjusting the validity or scope of protection for trademarks by accounting for sound symbolism would not be entirely costless. The traditional spectrum of trademark infringement is a rough proxy for the likelihood that consumers will see the mark predominately as a source signifier rather than a product signifier. Its continued utility has been defended on the ground that it is correct often enough to be useful and perhaps too costly to replace.<sup>175</sup> With regard to

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171. See *Lambert Pharmacal Co. v. Bolton Chem. Corp.*, 219 F. 325, 326 (S.D.N.Y. 1915) (comparing Listerine and Listogen for medicinal mouthwash, the court stated “[i]n choosing an arbitrary trade-name, there was no reason whatever why [the defendant] should have selected one which bore so much resemblance to the plaintiff’s; and in such cases any possible doubt of the likelihood of damage should be resolved in favor of the plaintiff”).

172. Firms and marketers seem keen to create fanciful marks that connote product qualities through the use of sound symbols. See Gabler, *supra* note 10, at 41; see also *supra* Section II.C; cf. Tushnet, *supra* note 16, at 886.

173. *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 908–09 (3d Cir. 1952).

174. See Shrum et al., *supra* note 147, at 278 (consumer response to sound symbols “appear[s] to be relatively automatic”); Yorkston & Menon, *supra* note 16, at 44.

175. See Linford, *False Dichotomy*, *supra* note 1, at 1418 (first citing Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 558 (2006);

trademark validity, categorizing marks as inherently distinctive or initially descriptive based on the lexical connection between the mark and the product offered may reduce administrative costs compared to a finely-tuned inquiry into less salient (but no less important or effective) connections like sound symbolism.<sup>176</sup> Likewise, in a likelihood of confusion inquiry, courts may frequently use the inherent strength of the mark as a proxy for commercial strength.<sup>177</sup>

Abandoning the simplicity of the *Abercrombie* spectrum will increase administrative costs, and increased administrative costs can serve as a barrier to entry for some plaintiffs.<sup>178</sup> If a firm cannot protect a mark without presenting evidence of source significance, it will take the firm longer to settle its claim to the mark. The delay can be costly. In addition, amassing evidence of source significance is itself a costly endeavor.<sup>179</sup>

But the accuracy of the *Abercrombie* spectrum has recently been called into question.<sup>180</sup> This is in part because judges with limited information designed the spectrum as a cost-saving mechanism<sup>181</sup> and in part because reduced administra-

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then citing Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1290 n.41 (2011)).

176. This intuition with regard to the administrative cost savings of using the *Abercrombie* categories as a rough proxy for consumer perception of source significance resonates with the comparative lower administrative costs of applying a rule rather than a standard. See Isaac Ehrlich & Richard A. Posner, *An Economic Analysis of Legal Rulemaking*, 3 J. LEGAL STUD. 257, 269 (1974); Louis Kaplow, *Rules Versus Standards: An Economic Analysis*, 42 DUKE L.J. 557, 589–92 (1992) (comparing the relative advantages of a “simple rule,” a “complex standard,” and a “complex rule”); Cass R. Sunstein, *Problems with Rules*, 83 CAL. L. REV. 953, 956–57 (1995) (describing the debate over the preferability of “clear, abstract rules laid down in advance” compared to “law-making at the point of application through case-by-case decisions, narrowly tailored to the particulars of individual circumstances”).

177. See *supra* note 67 and accompanying text.

178. For example, as the Supreme Court noted in the context of inherently distinctive trade dress, requiring evidence of secondary meaning can have anticompetitive effects, including imposing “particular burdens on the startup of small companies.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992).

179. See Linford, *False Dichotomy*, *supra* note 1, at 1418.

180. See, e.g., Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1078, 1089, 1091–92 (2009) (arguing based on consumer studies that “contextual markers” on trademark packaging are more important than the conceptual relationship of the word chosen as a mark to the product); Linford, *False Dichotomy*, *supra* note 1, at 1402–20 (arguing in light of etymological and cognitive studies into language change that suggestive marks should not be classified as inherently distinctive); Linford, “*Generic*” *Trademarks*, *supra* note 22, at 146–47 (arguing that categorically denying protection to “generic” trademarks artificially hampers language change and introduces error that will harm consumers).

My own previous inquiries into the continued legitimacy of the *Abercrombie* spectrum have offered a “limited defense” for continuing to treat fanciful marks as entitled to instant protection, due to its single lexical meaning as a source signifier when first used in commerce. See Linford, *False Dichotomy*, *supra* note 1, at 1402. But the evidence of sound symbolism summarized in Part II, *supra*, leads me to reconsider that conclusion in the ways outlined in this Section.

181. Tushnet, *supra* note 16, at 871–74 (criticizing continued reliance on the *Abercrombie* spectrum on the ground that judges crafted it decades before the start of empirical trademark and marketing research and that it may be a poor proxy for how readily consumers will recognize a given mark as an indication of source).

tive costs typically correlate with increased error costs.<sup>182</sup> By definition, rules and rule-like proxies both over- and under-correct. The *Abercrombie* categories serve as a shortcut for the inquiry we would prefer to pursue in a costless universe. Instead of presuming that consumers perceive similar categories of marks in the same manner, we might increase accuracy with information about how consumers see a particular mark used in association with certain products in a given commercial context.<sup>183</sup> A strictly lexical inquiry into the relationship between mark and product is a proxy that reduces administrative costs. But the relative ease of identifying a fanciful mark based on its lexical novelty hides another level of meaning, driven by sound symbols and connections that consumers may not consciously recognize, but cannot ignore. If fanciful marks frequently benefit from sound symbolism—and such a benefit seems to be the goal of modern branding efforts—then automatically extending the broadest possible protection to fanciful marks may impose too high a cost on competitors.

Accounting for sound symbolism will require a deeper inquiry into the validity and scope of fanciful marks,<sup>184</sup> with more nuance than is allowed by the current rule-like presumptions, which favor instant protection of an extremely broad scope. Change could come to trademark litigation in several ways. First, courts and trademark examiners could take a more careful look at whether a fanciful mark comprises sounds that connote product characteristics at the validity stage. If the sounds selected are not message bearing, or bear no message connected to the product offered, then a coined mark may be treated as inherently distinctive. On the other hand, if the sounds that comprise the fanciful mark convey a message related to the product offered, those sounds provide communicative advantage to the mark owner, and courts should take that advantage into account when assessing the inherent distinctiveness of the fanciful mark.

What might that mean? A fanciful mark that benefits from sound symbols shares features with suggestive and descriptive marks. Both suggestive and descriptive marks connote product features. Suggestive marks communicate

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182. See, e.g., Tun-Jen Chiang, *The Rules and Standards of Patentable Subject Matter*, 2010 WIS. L. REV. 1353, 1400 & n.240 (2010) (“Rules have higher error costs but lower administrative costs; standards have lower error costs but higher administrative costs. The relative size of the two types of cost will determine the efficient choice between the alternative methods of regulation in particular settings.” (quoting Richard A. Posner, *Employment Discrimination: Age Discrimination and Sexual Harassment*, 19 INT’L REV. L. & ECON. 421, 423 (1999))).

183. See *id.* at 1400–01 (“[I]f we could ignore administrative costs by assuming unlimited resources, we should always use a standard. In a zero cost world, standards will always produce perfect substantive outcomes of zero error cost.”).

184. Cf. Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1658–68 (2003) (identifying validity, scope, and remedies as three potential policy levers to adjust patent protection); Joseph Scott Miller, *Abercrombie 2.0—Can We Get There From Here? Thoughts on “Suggestive Fair Use,”* 77 OHIO ST. L.J. FURTHERMORE 1, 2–3 (2016), <http://moritzlaw.osu.edu/students/groups/oslj/files/2016/02/Vol.-77-1-14-Miller-J-Response.pdf> [<https://perma.cc/9HFN-79JZ>] (proposing the use of a “suggestive fair use” defense as a lever to reflect the lack of substantive difference between suggestive and descriptive trademarks).

them metaphorically,<sup>185</sup> whereas descriptive marks communicate them metonymically.<sup>186</sup> The law currently draws a sharp line between suggestive and descriptive marks, but given the similar ways speakers and listeners process metaphoric and metonymic language, perhaps it should not.<sup>187</sup> Similarly, if a fanciful mark secures competitive advantage through the selection of sound symbols that communicate product features, it might be advisable to require evidence that the mark has acquired source significance before protecting it as a source-signifying trademark.<sup>188</sup> At a minimum, courts should be less confident that the success of a fanciful mark is entirely related to its effectiveness as a source signifier when there is evidence that the sounds comprising the mark are product signifying.

Second, in likelihood of confusion cases, courts should be more hesitant to presume that a fanciful mark is automatically entitled to broad protection. This second change is a shift in perception, more than a shift in method. Mark strength is subjective, and an inquiry into actual commercial strength (including consumer surveys, ad expenditures, and the volume of product sales) should be as important as inherent strength.<sup>189</sup>

A third change would be decidedly more concrete and perhaps more important.<sup>190</sup> When comparing the components of a word mark (first syllable, vowel sounds, consonants), litigants should put courts on notice of potential connotative effects of those component parts.<sup>191</sup> Courts should similarly exercise some caution in concluding the marks are confusingly similar when the similarity depends on sounds that connote product features. A court informed of the communicative import of a sound symbol might instead treat the sound symbol as descriptive when comparing the marks based on their sight, sound, and meaning and thus entitled to much narrower protection.

185. See Linford, *False Dichotomy*, *supra* note 1, at 1407–10.

186. See *id.* at 1407–08.

187. See *id.* at 1415–21; see also Miller, *supra* note 184, at 14 (arguing that the law might embrace “a robust suggestive fair use defense [to] blunt the force of misclassifying suggestive marks as inherently distinctive on first use”). Laura Heymann argues that trademark law overreaches to the extent that mark owners are allowed to prevent appropriation of connotations, rather than denotation. See Heymann, *supra* note 30, at 386.

188. The reader may object that this is a higher bar than is placed on suggestive and arbitrary marks. Nothing in this analysis would forestall applying the same analysis to suggestive or arbitrary marks, although the Article proposes that the effect of sound symbolism might be stronger for a fanciful mark than an arbitrary or suggestive mark because a fanciful mark lacks inherent lexical meaning. See *supra* Section III.A.1.

189. See Linford, *False Dichotomy*, *supra* note 1, at 1389–90 (first citing Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 738–43 (2004); then citing Timothy Denny Greene & Jeff Wilkerson, *Understanding Trademark Strength*, 16 STAN. TECH. L. REV. 535, 582 (2013)).

190. Beebe’s analysis suggests the two most critical factors in a standard likelihood of confusion inquiry are whether the court concludes the marks at issue are similar and whether the court concludes the junior user appropriated its mark in bad faith. See Beebe, *Multifactor Tests*, *supra* note 55, at 1589, 1622.

191. This would not be a costless exercise for the defendant. Gathering evidence of sound symbolism would require an appeal to experts. As described in Part II, sound symbolism is a phenomenon one might expect would escape judicial notice.



Discounting the use of similar sound symbols by the alleged infringer is not as dramatic a shift from current law as it might initially appear. In some cases, courts are already sensitive to the frequency with which a given syllable can arise in a particular market. For example, in the pharmaceutical context, drug compounds often use certain letters<sup>192</sup> or share certain syllables. Thus, in *Pharmacia Corp. v. Alcon Laboratories, Inc.*, the court concluded that many pharmaceutical products shared the suffix “-atan” with plaintiff’s Xalatan glaucoma treatment, and therefore defendant’s use of the same suffix in its Travatan glaucoma treatment was not likely to confuse doctors.<sup>193</sup>

Consider what sound symbolism might indicate about the strength and scope of another pharmaceutical: Prozac. In *Eli Lilly & Co. v. Natural Answers, Inc.*, the court found that Natural Answers’ use of Herbrozac for an herbal mood elevator infringed Eli Lilly’s Prozac mark for its drug to treat clinical depression.<sup>194</sup> The court concluded that Prozac was a strong, fanciful mark, describing it with the standard superlatives often applied to a coined word:

The PROZAC® mark is unusually strong. . . . [I]t is a fanciful word that carries no meaning apart from its use to identify a product. It does not describe or suggest the function of the product it names. When the seller of a product coins a word just for the product, as Lilly did with PROZAC, trademark protection is at its highest.<sup>195</sup>

In comparing the sight, sound, and meaning of the marks, the court concluded their similarities overwhelmed their differences. Herbrozac begins with “Herb-” instead of “P-,” but the court concluded that the use of the “-rozac” suffix created a message that Natural Answers offered “herbal PROZAC.”<sup>196</sup> In addition, the court discounted the difference between the /b/ sound in Herbrozac and the /p/ sound in Prozac, finding that they were very similar.<sup>197</sup> As one might expect, the court also concluded that Natural Answers intended to copy the Prozac mark.<sup>198</sup>

Evidence from sound symbolism studies suggests that some of the sounds that form the Prozac mark have product-relevant meanings. A court sensitive to sound symbolism might reasonably conclude that the case for fancifulness

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192. See Surowiecki, *supra* note 131 (“‘X’ and ‘z’ are held to be memorable and redolent of speed and fluidity. The letter ‘x’ occurs sixteen times as often in drug names as in other English words; ‘z’ occurs eighteen times as often.”).

193. 201 F. Supp. 2d 355, 376 (D.N.J. 2002) (“‘Syrocol’ [and] ‘Cheracol’ . . . do not look or sound enough alike to justify a holding of trademark infringement. The only similarity is in the last syllable, and that is not uncommon in the names given drug compounds.” (citing Upjohn Co. v. Schwartz, 246 F.2d 254, 262 (2d Cir. 1957))).

194. 86 F. Supp. 2d 834, 836, 843 (S.D. Ind.), *aff’d*, 233 F.3d 456 (7th Cir. 2000).

195. *Id.* at 843 (first citing Polaroid Corp. v. Polaroid, Inc., 319 F.2d 830, 837 (7th Cir. 1963); then citing Hyatt Corp. v. Hyatt Legal Servs., 736 F.2d 1153, 1158 (7th Cir. 1984)).

196. See *id.* at 841.

197. See *id.*

198. See *id.* at 845.

might not be as overwhelming as it initially appeared. The /o/ sound conveys smoothness and mellowness, and its use suggests a product could provide some relief from symptoms of depression or improve relaxation.<sup>199</sup> On the other hand, /z/ conveys speed or efficacy, a valuable aspect of any medical product.<sup>200</sup> The presence of these sound symbols might indicate that Natural Answers had some basis for its use of “-oz-” in the Herbrozac mark, despite Lilly’s prior use of Prozac. In addition, sound symbolism research suggests that the difference between /p/ and /b/ can be significant. Voiceless consonants like /p/ are perceived to identify things that are lighter than things identified by voiced consonants like /b/.<sup>201</sup> What the court in *Eli Lilly* saw as an inconsequential difference appears more significant when we account for sound symbols.

Courts should also resist the temptation to presume the junior user has appropriated the fanciful mark in bad faith when common elements between the marks are sounds that communicate product features. Courts often find similarity between a fanciful mark and a competitor’s mark to indicate bad faith adoption by the competitor. As Judge Learned Hand explained, the decision of the competitor to adopt a fanciful mark “long . . . employed [that] had become known to the trade” is often taken as an indication of “a deliberate purpose to obtain some advantage from the trade which [the first user] had built up.”<sup>202</sup> Thus, if the competitor adopts a mark too similar to a pre-existing mark “for no reason that he can assign,” a court needs no more evidence of bad faith.<sup>203</sup> But sound symbolism provides a reason for the competitor to adopt a mark with some similar characteristics: to communicate product features to consumers. Evidence of sound symbolism could help a court determine whether a defendant had a good faith reason to adopt a mark that is similar to an existing mark and used on comparable products.<sup>204</sup> Instead of presuming that a fanciful mark does not restrict competition, courts should consider whether the component sounds in the mark are particularly effective in connoting relevant product qualities. If the fanciful mark uses product-indicating sound symbols, then allowing the mark owner to appropriate those terms may have competition-restricting effects.<sup>205</sup> Thus, if the similar elements between the senior and junior marks are

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199. See *supra* notes 135, 148, and accompanying text.

200. See *supra* notes 149, 192, and accompanying text.

201. See *supra* note 139 and accompanying text.

202. *Am. Chiclé Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 561–63 (2d Cir. 1953) (quoting *Miles Shoes, Inc. v. R.H. Macy & Co.*, 199 F.2d 602, 603 (2d Cir. 1952)).

203. *Id.* at 563; cf. *E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F. Supp. 1403, 1413 (E.D. Cal. 1994) (“When the senior user’s trademark is famous in the marketplace and when the junior user was aware of the trademark and its fame, a presumption of bad faith arises from the choice of the same name.”).

204. Cf. *Pfizer, Inc. v. Y2K Shipping & Trading, Inc.*, 70 U.S.P.Q.2d 1592, 1597 (E.D.N.Y. Mar. 26, 2004) (“Good faith may be found where the defendant ‘has selected a mark which reflects the product’s characteristics, has requested a trademark search or has relied on the advice of counsel.’” (quoting *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 575 (2d Cir. 1993))).

205. Linford, *False Dichotomy*, *supra* note 1, at 1384 (“Protection of a nondistinctive mark would not, however, lower search costs, but would impose costs on competitors to the extent the non-

sound symbols that communicate features of the products offered, courts should not treat that similarity as evidence of bad faith and should perhaps discount it entirely.<sup>206</sup>

Two more radical shifts might follow recognition of sound symbolism, but it is not clear that the evidence is sufficiently strong to support either change. First, courts might stop treating any fanciful mark as inherently distinctive or inherently strong. Instead, every mark would need evidence of secondary meaning to qualify for protection. This change would upend the status quo, but if the status quo relies on demonstrably false presumptions, perhaps it is time to upend it. At a minimum, Congress, courts, and scholars should consider whether it is time to rethink trademark law's underlying presumptions about inherent distinctiveness and inherent strength in light of the recent cascade of evidence about how consumers see the world and how marketing influences what they see.

Second, some sound symbols in some contexts might be essentially functional and therefore fail to qualify for trademark protection.<sup>207</sup> The law bars protection of functional product elements as source signifiers. For example, the first seller of a construction sign with a dual spring support mechanism cannot claim trade dress protection in the use of dual springs if the dual spring design makes the product work better or cheaper to produce, even if consumers see the dual springs as source-signifying.<sup>208</sup> Likewise, some scholars have posited that current trademark claims may exhaust the supply of attractive words that can suitably serve as arbitrary or suggestive marks.<sup>209</sup> The same could be true of certain sound symbols. If the combinations of potentially effective or attractive sound symbols are not limitless, then perhaps some of those symbols should be available for any seller to use, and courts should therefore treat them as incapable of supporting a claim for trademark protection. At a minimum, courts should not dismiss the effect out of hand.

### C. CHALLENGES IN APPLYING SOUND SYMBOLISM TO TRADEMARK LAW

Two final objections might counsel against engaging in a more refined inquiry into sound symbolism, but neither objection is insurmountable. First, granting immediate and broad protection incentivizes firms to select fanciful marks instead of descriptive marks. If courts begin to treat fanciful marks like descriptive marks, and require a showing of source significance, or provide

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distinctive mark 'uses words, symbols, shapes, or colors that are common to those used by other producers' of a particular product.'" (quoting Landes & Posner, *supra* note 49, at 288)).

206. *Cf.* Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 27 (1st Cir. 2008) (similarity between Boston Duck Tours and Super Duck Tours "is a result of each party's decision to use a generic phrase to describe its product").

207. *See, e.g.*, Xiyin Tang, A Phonaesthetic Theory of Trademark Functionality (Jan. 2016) (unpublished manuscript) (on file with author).

208. *See* Traffix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 35 (2001).

209. *See, e.g.*, Barton Beebe & Jeanne C. Fromer, Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion (unpublished manuscript) (on file with author).

narrower protection against infringement, the incentive to select a fanciful mark is reduced. Firms may then be more likely to select descriptive marks with the attendant underlying harms to competition.<sup>210</sup> This shift might impose net harm on the competitive market, and evidence of sound symbolism does not indicate that its effects are more important than lexical meaning.

Second, deciding a case based on individual features or subparts of the mark, rather than the word as a whole, is contrary to the standard likelihood of confusion analysis, which requires the court to consider whether the marks, “viewed in their entirety,” are confusingly similar.<sup>211</sup> In fact, the Supreme Court has instructed courts not to subdivide marks and instead to consider each mark as a whole.<sup>212</sup> But considering sound symbolism requires looking at individual sounds in addition to—not instead of—looking at the mark in its entirety. Furthermore, when viewing the mark as a whole, courts recognize “the common-sense precept that the more forceful and distinctive aspects of a mark should be given more weight, and the other aspects less weight.”<sup>213</sup> Therefore, courts may account for sound symbolism—and discount similarity that stems from product-signifying sounds—without contradicting established precedent.

#### CONCLUSION

The consensus view is that fanciful marks are entitled to the broadest possible scope of protection. That view depends on a strong form of linguistic arbitrariness. In light of evidence of sound symbolism, however, linguistic arbitrariness cannot be taken for granted. Sound symbolism shapes how the audience perceives a word and receives its messages, both evident and concealed. Firms can use the sound symbolism in a fanciful mark to communicate product features in a way that is not readily apparent, but nevertheless powerful. Component sounds can convey meaning about product features, and picking the right sounds can increase product desirability. Failing to account for sound symbolism may therefore lead to a level of protection for fanciful marks that imposes unacceptable costs on competitors. Trademark validity and scope may thus benefit from some recalibration to increase their sensitivity to the impact of sound symbolism.

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210. *Id.*

211. *See* *Kos Pharm., Inc. v. Andrx Corp.*, 369 F.3d 700, 713 (3d Cir. 2004) (quoting *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 216 (3d Cir. 2000)); *M2 Software, Inc., v. Madacy Entm't*, 421 F.3d 1073, 1082 (9th Cir. 2005) (“[T]he trademark is not judged by an examination of its parts, but rather ‘the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace.’” (quoting *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir. 1993))).

212. *See* *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 . . .”).

213. *See, e.g., A & H Sportswear*, 237 F.3d at 216.

