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## Part III: **Legal language outside of court**



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# 11 Linguistic analysis in trade mark law: current approaches and new challenges

## 1 Introduction

Trade mark law is prominent among areas considered of special interest to scholars concerned with language in the legal sphere. In introductions to forensic linguistics, the field is regularly listed along with document authorship, speaker identification, product warnings, the meaning of defamatory statements, and other topics (Coulthard and Johnson 2007; Gibbons and Turell 2008).

There are two main reasons for this level of interest. The first reason is that, traditionally and almost certainly still, most trade marks consist of verbal signs (or “figurative” marks comprised of words in a given stylisation, or “get-up”).<sup>1</sup> So the question of which verbal signs are registrable as trade marks, and whether use of such signs by third parties will infringe the proprietary rights of trade mark owners, invites analysis and discussion. The second reason concerns a different level of language use: namely, the terminology through which trade mark law governs the verbal signs which function as marks. That terminology amounts to a legal metalanguage of specialised semiotic/legal terms which operate in tandem with other legal terminology. Basic terms include “sign” itself or “figurative” as used above, as well as “distinctive”, “descriptive” and “generic”. Each term in this cluster is used in ways that overlap with but are not the same as how the same term is used in linguistics or in general discussion of language. Along with other technical terms describing effects that signs may produce, including “dilution”, “blurring” and “tarnishment”, as well as nonce terms favoured as professional shorthand by counsel and judges (such as “side by side use” or “double identity”), such words create the apparatus through which trade marks are conceptualised and classified.

An important field of commercial language behaviour is in this way legally regulated by means of a conceptual framework which differs significantly from any corresponding terminology or approach in linguistics or related fields. It is unsurprising, therefore, that the language of trade marks should not only interest lawyers but also linguists, including professional linguists who in some jurisdictions are engaged as expert witnesses in trade mark disputes.

This chapter describes the interaction that has taken place between law and linguistics on the subject of trade marks. We begin with a summary of the main

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<sup>1</sup> Barton Beebe and Jeanne Fromer, in a recent (2018) article we discuss below, estimate that by the end of 2016 there were over 2 million active trade mark registrations on the (US) Patent and Trademark Office’s register, of which more than 95% included text and more than 75% consisted only of text (Beebe and Fromer 2018:956-7) As far as we are aware, no equivalent data are available for UK marks.

legal measures governing verbal signs used as marks, taking European Union trade mark law as our main reference but introducing US law where appropriate. We then describe how courts address language-related questions in particular, and ask how compatible the understanding of communication relied on in trade mark law is with accounts developed in linguistics. Highlighting both commonality and contrast, we examine the contribution made to trade mark law by linguists in two major traditions: an applied linguistic tradition of expert evidence, illustrated below principally by the work of US linguist Roger Shuy; and an interdisciplinary tradition of efforts to understand trade marks in semiotic terms, illustrated by an influential article by US legal scholar Barton Beebe (Beebe 2004). We then consider some “intermediate” studies between linguistics and trade mark law: studies which use linguistic scholarship to support arguments for changes in the law. In these sections, our illustrations are concerned with the work of US scholars who have paid most attention to linguistic issues in trade mark law. We go on, however, to explore how far similar insights might illuminate approaches taken by the European courts and the challenges they face. We conclude by asking how linguistic contributions to trade mark law might develop through further collaboration between lawyers and linguists.

## 2 Trade marks: the legal context

Before exploring areas of overlap between trade mark law and linguistics, we should introduce the main sources of trade mark law itself, as well as key economic and social assumptions that have determined its scope.

The degree of protection afforded to registered trade marks is determined by a combination of national, regional and international legislation. The Paris Convention<sup>2</sup> ensures among other things that foreign nationals have a right to register their marks on the same terms in any Convention country as any national of that country. The TRIPS agreement (1994),<sup>3</sup> which derives from the WTO (World Trade Organisation), sets out minimum standards for national or regional protection of trade marks. In the European Union (EU), a process of harmonisation of trade mark law has taken place between Member States; so final interpretation of trade mark law in this jurisdiction falls to the European Court of Justice (now known as the CJEU, formerly the ECJ). In the United States, trade mark law is governed by a combination of the federal Lanham Act<sup>4</sup> and laws passed by individual states, although (as with EU trade mark law) such protection must be consistent with TRIPS and the Paris Convention.

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<sup>2</sup> The Paris Convention for the Protection of Industrial Property, 1883 (as amended September 28, 1979). The Convention has 176 signatories.

<sup>3</sup> The Agreement on Trade Related Aspects of Intellectual Property Rights, 1994.

<sup>4</sup> The Lanham (Trademark) Act (Pub.L. 79-489, 60 Stat. 427, enacted July 5 1946, codified at 15 U.S.C. 1051 et seq. (15 U.S.C. ch. 22))

International conventions set rules and minimum standards for registered trade mark protection. But protection is almost exclusively national in scope. A UK or German registration will protect a registered mark only within the borders of the UK or Germany; a US trade mark registered under federal law will only protect that mark within the US. There are nevertheless some exceptions to this principle. These include the European Union Trade Mark (EUTM), whose protection extends across the European Union as a whole,<sup>5</sup> and signs protected under the Madrid Protocol,<sup>6</sup> whose protection covers signatory countries.

In most jurisdictions, it is also possible for businesses to claim protection for marks which have not been registered. In the UK and to some extent in the US, the law of passing off will prevent misleading use by a third party of an unregistered trade mark which has become distinctive of a particular business. In passing off cases, however, what the law seeks to protect is not the trade mark as such, nor primarily the interest of consumers, but the goodwill of the business which might be harmed by third-party use, for example through loss of sales or damage to reputation. The labelling by a leading supermarket of a chocolate bar which was not made in Switzerland as SWISS CHALET (together with a picture of a Swiss chalet)<sup>7</sup> was for instance held to be a misrepresentation which would damage the goodwill of Swiss chocolate producers. Although consumers who attribute desirable qualities to “Swiss chocolate” would be the direct victims of such a misrepresentation, it was not their interests that were at the centre of the action but those of Swiss producers. In addition to passing off measures, unfair competition laws in many jurisdictions (including continental Europe and the United States) can protect unregistered trade marks from unauthorised use by third parties. The main aim of this area of law is to protect the public at large, as much as the first user of the mark. Finally, consumer protection laws designed to prevent conduct harmful to consumers may protect unregistered marks if those marks are used deceptively.

The relevance of this general context is that, in contrast with the protection of unregistered marks, what the registered trade mark regime is designed to protect is not the business goodwill which the trade mark represents but the trade mark itself.

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5 Decisions on the registration of an EUTM (formerly a CTM) are taken by the EUIPO (formerly the OHIM) in Alicante. A decision may be appealed to the Opposition Division, the Board of Appeal, and then to the General Court, before finally to the CJEU. The EUTM is regulated by Regulation (EU) No. 2015/2424 of the European Parliament and of the Council of 16 December 2016.

6 Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007). On English and European trade mark law, see Aplin and Davis (2017); and Waelde, Brown, Kheria & Cornwell (2016).

7 *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] ETMR 205. Throughout the chapter we present signs used as marks (whether registered or not) in uppercase. This is not a fully satisfactory convention, in that some marks are distinguished in part by whether any, some or all their letters are in uppercase or lowercase (e.g., “AquaPerfect”); also, many verbal marks are registered in a “figurative” form, being distinctive partly on the basis of their font, colour and other aspects of design.

This major difference makes linguistic investigation of such marks far more pertinent. Unlike unregistered trade marks, which can generally only be transferred between businesses along with attendant goodwill, registered marks can be licensed or sold without the underlying business.<sup>8</sup> When that happens, although the registered trade mark is understood as a badge of origin it may in fact communicate very little about the origin of goods or services on which it is placed. The mark might, for example, represent the business of the retailer of such goods, as with a supermarket's own brand products. Or it may have been acquired by a company which bears no direct responsibility for producing the goods that carry the mark. An example of this second possibility is the multinational drinks corporation Diageo, whose trade marks include JOHNNY WALKER for Scotch whisky, GUINNESS for stout, and VEUVE CLIQUOT for champagne. In terms of production, a single developing-world factory may manufacture clothing that will carry a number of different, in some cases world-renowned trade marks.

Protection of trade marks by means of registration is of primary benefit to a proprietor. But the justifications most commonly given for trade mark protection go beyond that narrow interest. Protection of a registered trade mark functioning as a badge of origin is claimed both to reduce consumer search costs and to ensure the quality of goods. These effects follow because such costs will be reduced if the proprietor maintains a good and consistent quality over time. Registration, it follows, encourages producers to expend on quality; and consumers will be willing to pay a premium price for trade-marked goods because they gain the benefit of known quality (Landes and Posner 1987). These advantages would be lost if the trade mark ceases to act as a badge of origin.

Sometimes a trade mark is recognised as carrying additional messages apart from indicating the origins of the goods. For instance, it may serve as a vehicle for other attractive qualities which attach to those goods or services. In such circumstances it is proprietors' interests which are paramount in granting protection. In an early EU trade mark case, *Arsenal Football Club v Reed*, it was suggested by the Advocate General that a distinctive mark might indicate not just quality but also reputation, as well as the renown of the producer or even "a way of seeing life".<sup>9</sup> In order for such effects to be conveyed by a trade mark, the proprietor may have had to make a considerable investment in building particular ways of perceiving or understanding the mark, an investment that may also be deemed worthy of protection against those who would seek to free ride on it.

Increasingly EU trade mark law has been interpreted as designed to protect such additional meanings, which go beyond the earlier role of a mark as purely an indication of origin. Such additional meanings contribute to what are referred to as "brand values";

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<sup>8</sup> Many registered trade marks acquire wider meanings beyond being perceived solely as a badge of origin. Arguably, these meanings attach as much to the underlying business as to the mark, and are sometimes referred to as "brand values". To this extent, they share something in common with the idea of goodwill.

<sup>9</sup> *Arsenal Football Club plc v Reed* (Case C-206/01 [2002] ECR I-10273 at AG 46.

and some of the complexity surrounding verbal trade marks, both from a linguistic and a legal perspective, arises from those extra meanings. The CJEU has acknowledged such meanings in a number of decisions. For example, in *Sigla SA v OHIM* the General Court identified other “messages” that a mark might convey as: “...luxury, lifestyle, exclusivity, adventure, youth”; and the Court went on to acknowledge that such messages can exist independently of goods or services to which they attach.<sup>10</sup> Recently, the CJEU has gone further, suggesting that as well as acting as a badge of origin trade marks may serve further functions including communication, investment and advertising. Perhaps of most interest to linguists is what has been called the “communication function”. As yet, however, the CJEU has not elucidated precisely what “communication function” means, beyond a mark’s ability to reflect the quality of goods on which it is placed or to act as an advertising tool. Nevertheless, recent judicial focus on the sign’s various meanings beyond that of an indicator of origin, and on its multiple functions, accentuates the potential importance and relevance of approaches seeking to understand such phenomena, such as approaches based on linguistics and semiotics.

### 3 Trade mark law: provisions which raise questions about language

What legal measures within this general framework are most relevant in understanding language use in this area of law? The answer lies in a number of important details.

The EU Trade Marks Directive (TMD)<sup>11</sup> defines a registerable sign as “any sign capable of being represented graphically which is capable of distinguishing the services of one undertaking from those of other undertakings”. A trade mark may consist of a word or combination of words, but it may alternatively consist of a shape, colour, sound or even a smell (or some combination of any or all of these), as long as it can be represented graphically in a manner which is “clear, precise, self-contained, easily accessible, intelligible, durable and objective”, and capable of acting as a badge of origin.<sup>12</sup> The new Trade Mark Directive has dropped the necessity for graphic representation, in part to accommodate more easily non-verbal or visual signs, such as for example smell marks.

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**10** *Sigla SA v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (EU.T.2007:93).

**11** First Council Directive 89/104/EEC, 21 December 1988, to approximate the laws of the Member States relating to trade marks, codified as Directive 2008/95/EC. The codified version contains an annex (Annex II) which tabulates correspondence between the 1989 and 2008 directives. There is now a new Trade Mark Directive: Directive (EU) 2015/2436 of the European Parliament and of the Council to approximate the laws of Member States relating to trade marks (Recast).

**12** *Siekmann v Deutsches Patent-und Markenamt* (Case C-273/00) [2002] ECR I-11737.

The distinctiveness of a sign, including its capacity to act as a badge of origin in relation to the goods and services against which it is registered (as classified according to the 1957 Nice Classification, which divides products and services into categories),<sup>13</sup> is judged, like so much else in trade mark law, through the eyes of the “average consumer”, who is deemed to be “reasonably well informed, reasonably observant and circumspect”. It is assumed that such a consumer will be the average consumer for the goods or services for which registration is sought, and further assumed that the consumer will consider the mark as a whole and not break it down into constituent parts. For example, it was held that the sign SAT.2 for satellite dishes might be distinctive even though SAT on its own might not.<sup>14</sup> A distinctive mark might in principle be as short as one letter (e.g., the Greek character “alpha”, for beer),<sup>15</sup> or as long as a slogan such as I CAN’T BELIEVE IT’S NOT BUTTER! for margarine.<sup>16</sup>

In principle, signs in different media are treated equivalently. A verbal mark may be initially distinctive either because it is an invented word, such as KODAK, or because it consists of a word or combination of words which bear no relation to the goods or services against which those words are used; a common example of this given by the UK courts is NORTH POLE for bananas. Some marks may also be distinctive if they are merely suggestive of the goods or services against which they are registered: for instance, AIRBUS for a passenger airplane. Conversely, a sign will not be registered if it is judged to lack distinctiveness, or if it is held to be descriptive, or if it is common to the relevant trade. An example of a non-distinctive mark might be a common name such as NICHOLS for retail services, or a slogan such as TAKE A BREAK for chocolate bars. A descriptive mark might be a geographic name, or even a neologism such as DOUBLEMINT for gum, created out of two descriptive words.<sup>17</sup>

Signs which may for any of those reasons initially lack a capability to act as a badge of origin may nevertheless acquire distinctiveness as what is called a “secondary meaning” over time and through use on the market. Once again, the measure of acquired distinctiveness will be whether the mark in question is perceived as a badge of origin by the average consumer for the relevant goods and services. Conversely, a registered trade mark may be declared invalid if it is shown to have lacked distinctiveness at the time of registration. Or it can be revoked if it has become deceptive or generic over the period since registration. Most famously, both aspirin and the trilby hat lost trade mark protection by becoming generic.

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**13** The Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957), administered by WIPO (the World Intellectual Property Organization).

**14** *SAT.1 Satellitenfernsehen GmbH v OHIM* (Case C329/02) P [2004] ECHR I-8317.

**15** *BORCO-Marken-Import Matthiesen* (Case C 265/09) [2011] E.C.R. I-8265.

**16** Registered as a UK trade mark by Unilever in 1990 for margarine and other spreads.

**17** *OHIM v Wm Wrigley Jr Company* (Case C-191/01) P [2003] ECR I-12447.



The principle that an initially non-distinctive trade mark may be registered on proof of distinctiveness acquired through use betrays the neo-classical economic underpinnings of the TMD. It also impacts on what had traditionally, in some jurisdictions, been a protected public domain or “commons” of non-proprietary words and other signs. Prior to the TMD, in many jurisdictions including the UK and Germany trade marks would not be registered even if they were distinctive, if they were also marks that other traders might wish to use. Thus, HAVE A BREAK for chocolate bars was denied registration in 1983 because at that time the court held that, in a period when an increasing number of people “snacked”, the phrase HAVE A BREAK would be valuable to other traders. But HAVE A BREAK was successfully registered in 2007, following implementation of the TMD and after lengthy litigation, on the basis that it had acquired distinctiveness through use (Davis and Durant 2015). Obviously some words may be descriptive or non-distinctive in one context but not in another, depending on the type of goods against which they are registered. An example would be use of CARIBBEAN for bananas and for skiing equipment: based on the reasoning above we can assume CARIBBEAN would not be registered without evidence of acquired distinctiveness for bananas but would be seen as inherently distinctive in relation to skiing equipment.

Another reason a sign will not be registrable (a so-called “relative ground”, one of the TMD’s “further grounds for refusal or invalidity concerning conflicts with earlier rights”), is if it conflicts with an earlier registered mark. There are several grounds for such conflict; some require proof of consumer confusion and some do not. The grounds are important because, with a few exceptions, they also constitute the basis for infringement actions. An identical sign used on identical goods (so-called “double identity”) will be barred from registration or, if used on the market, may be found to have infringed an earlier mark even without proof of consumer confusion. In such circumstances it is difficult to suppose that the average consumer would not be confused as to the origin of the goods or services at issue.<sup>18</sup> In contrast with identical signs, similar signs used on similar goods (or identical signs used on similar goods, or similar signs used on identical goods) will only be refused registration, or found to infringe, if the average consumer is likely to be confused. Whether a likelihood of confusion exists depends on a host of factors including: visual, aural (phonetic), and/or conceptual similarity between the two signs; the degree of distinctiveness of the registered mark; how much attention will be paid to both the mark and the sign at issue by the average consumer (which will depend on the nature of the goods and how they are sold); and the degree of similarity between those goods. “Similarity”, in

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<sup>18</sup> This situation has been complicated by recent CJEU decisions which have held that infringement depends on the use of the later sign affecting one or more functions of the registered trade mark including but not limited to its origin function. See for example, *L’Oreal SA v Bellure NV* [2009] (Case C-487/07) ECR I-5185.

such circumstances, is in part linguistic but as can be seen not exclusively a linguistic property of the signs at issue.

To take an example, in the case of *Picasso*<sup>19</sup> the proprietors of the PICASSO trade mark as used on automobiles objected to registration of PICARO, also for cars. The CJEU decided that, while PICASSO was a distinctive mark on account of the fame of the painter, it was not a distinctive mark for cars. In *BSH Bosch v OHIM*,<sup>20</sup> other factors were taken into account. In that case, the applicant sought to register the word AQUAPERFECT as a EUTM for kitchen goods including washing machines. Its application was opposed by Bosch, which had the registered mark WATERPERFECT for many of the same goods, also including washing machines. In deciding whether the marks were similar enough to cause confusion, the EU General Court examined the following considerations: the level of attention exercised by consumers (high in relation to washing machines; not high in relation to daily kitchen goods); the degree of visual similarity, as the words were of similar length; the presence of phonetic similarity, in that the words had the same number of syllables, a common element “perfect” and first syllables of similar length and sound; and that there was conceptual similarity, as the marks had the same “semantic content” (the average EU consumer would know that *aqua*<sup>21</sup> was Latin for water and even non-English speakers would understand the meanings of *water* and *perfect*). In light of these similarities, and despite the fact that the earlier mark had only a weak distinctive character, being somewhat descriptive, the court held there was a likelihood of confusion.

Further forms of analysis may be introduced where registered marks convey messages that extend beyond their role as an indicator of origin. It is a commonplace, for example, that the meaning of a trade mark nurtured on one category of goods can transfer to others. The VIRGIN mark, which began life applied to sound recordings, has been registered for financial services, air travel and beverages, among other things. Virgin describes its mark as connoting “service quality”, “fun”, and “value for money”, as well as “competence” and “rule breaking”, all of which are connotations which relate substantially or wholly to commercial use of VIRGIN rather than to the word *virgin* as found in other contexts.<sup>22</sup> That a trade mark can embody such additional meanings is recognised by the TMD and also in the US, notably by the Trade Mark Dilution Revision Act (2006). Under the TMD a registered trade mark with a reputation (a category defined by the mark’s degree of public recognition, taking into consideration factors including its market share, the intensity as well as geographical extent and duration of its use, and the scale of investment made by the undertaking in

<sup>19</sup> *Ruiz Picasso v OHIM* (Case C-361/04 PO [2006] ECR I-643).

<sup>20</sup> *BSH Bosch und Siemens Hausgerate GmbH v OHIM* (T-123/14) EU:T:2015:52; GC.

<sup>21</sup> We follow the convention here of representing citation forms for words in italics and representations of meaning in quotation marks.

<sup>22</sup> <http://www.integratedbrands.org/brands/virgin/@@details>. Compare the claimed associations with the dictionary meanings and symbolic associations conventionally associated with virgin.

promoting it) is protected against any attempt by a third party to register the same or a similar sign, or to make unauthorised use of the registered mark, if such use would take unfair advantage of or be detrimental to the distinctiveness or reputation of the registered mark. This is so even if the third-party sign is used in relation to dissimilar goods or services, and even if the average consumer would not be confused. In such cases the average consumer is taken to make a “link” between the registered mark and the sign, in that use of the later sign will “call to mind” the earlier registered mark.<sup>23</sup>

The overall purpose of these relatively recent prohibitions is to protect a registered mark not against confusion as to origin but against three other, potentially damaging consequences of commercial use by a third party if the consumer makes the relevant link. Each is legally defined but difficult to apply. First, trade marks with a reputation are protected against “dilution” of their distinctive character (sometimes referred to as “blurring”). For example, use of the sign BOTUMAX for pharmaceuticals was held to dilute the distinctiveness of the mark BOTOX for similar goods.<sup>24</sup> Second, marks with a reputation are protected against damage to that repute, as a result of use of the same or a similar mark on less desirable goods or services. This is known as “tarnishment”, and an early example recognised by the Benelux court was the effect on the repute of the mark CLAERYN for gin by the use of the sign KLAREIN for toilet cleaner.<sup>25</sup> Thirdly, a proprietor might suffer damage as a result of another trader “free riding” on the repute of its registered mark. Notice that in this third category there is no damage to the mark as such: simply by attaching the registered mark to its own goods, a third party may be held to have appropriated attractive qualities from that mark without rewarding the proprietor who nurtured them. Thus, in *L’Oreal v Bellure*<sup>26</sup> the defendant used the names of L’Oreal’s expensive perfumes to describe their own cheaper smell-alike scents. In this case, the defendant was found to be free riding on L’Oreal’s carefully nurtured, exclusive reputation.

## 4 Contributions by linguists

The brief introduction we have given to the context and key provisions of trade mark law allows us now to address the question of how linguistic expertise has been brought to bear on this highly detailed legal framework. Linguists, we suggest, have engaged in dialogue with trade mark law and lawyers in two main ways. They have given expert evidence in trade mark cases; and they have sought to develop a more general semiotic understanding of how trade marks function. We introduce each

<sup>23</sup> *Intel Corp Inc v CPM UK Ltd* (Case C-252/07) [2008] WLR (D) 371 at 42/.

<sup>24</sup> *Farmeco AE Dermokallyntika v OHIM* [2010] ECLI:EU:T:458 (General Court).

<sup>25</sup> *Colgate Palmolive v Lucas Bols* (Claeryn/Klarein) [1976] IIC 420.

<sup>26</sup> *L’Oreal SA v Bellure NV* [2009] (Case C-487/07) ECR I-5185.

approach in turn; then we discuss some examples of work in which a more interdisciplinary approach to issues in trade mark law has been attempted.

#### 4.1 Expert evidence in trade mark disputes

It is difficult to know exactly how widespread linguistic evidence is in trade mark cases. This is partly a result of differing admissibility considerations between jurisdictions, and partly because most cases settle before reaching court. Any expert evidence or advice that has been given will not form part of the public record if a settlement arrived at in advance of court proceedings is subject to a confidentiality agreement. What is clear, despite this, is that expert linguistic evidence is far more likely to be either adduced or admitted in US cases than in the UK or EU (or in most other jurisdictions).

This difference between jurisdictions is not new. US courts have always been more willing to admit empirical evidence of any description in trade mark cases than UK courts. In English law, in early cases a judge would frequently decide whether there had been an infringement (or make some other adjudication) based on his own assessment and without benefit of evidence. An interesting example of an early collision between that approach and the possibility of linguistic expertise can be found in the late nineteenth-century case *Harden Star Hand Grenade Fire Extinguisher Company's Trade Mark*,<sup>27</sup> in which the question for the court was whether the trade mark HAND GRENADE FIRE EXTINGUISHER was descriptive. The plaintiffs submitted an affidavit from a “philologist” (Mr. Henry Morley LL.D, Professor of English Literature at University College London) stating that the mark’s four words were not “words of common use in the English language” and qualified as a “fancy” phrase. To counter this assertion, the applicant produced an affidavit by a Mr Silvanus Thompson, formerly Professor of Experimental Physics at University College Bristol, to the effect that the four words “formed an admirable description of the article, and that there was nothing fancy about them, and that they were purely descriptive” (134). According to the judge, Chitty J, this was the first time expert evidence had been adduced “to explain the English language”. But he rejected that evidence, saying it was a matter of common sense and, by implication, a matter within the competence of the judge to decide. “This is not a question”, he opined, “and I say this emphatically – for a grammarian or a philologist. It is a question of the ordinary fair meaning of the terms to any ordinary Englishman” (134).

The role of empirical evidence in trade mark cases has continued to be contentious, despite many examples of professional advice being given as well as occasional courtroom testimony. A relatively rare example of linguistic evidence in a UK trade

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<sup>27</sup> RPC (1886) 3(9), 132-7.

mark case is the UK linguist Chris Heffer's testimony in *Bambino Mio v Cazitex*,<sup>28</sup> both at first instance and on appeal. While Heffer's evidence appears to have been sympathetically received, little was said in the report of one hearing, and nothing at all in the other, as to its legal significance. Such a tendency for linguistic evidence to be included in law reporting either only minimally or not at all may nevertheless be not so much a comment on its significance or otherwise as a reflection of the fact that trials follow multiple lines of legal reasoning; evidence given by expert witnesses may be subordinate to other steps of potentially greater legal importance.

Given a reluctance on the part of most English and European judges to admit linguistic evidence in trade mark cases, it is scarcely surprising that the most prominent linguistic experts in trade mark law have been Americans, in particular the US academics Roger Shuy and Ronald Butters (in an interview in 2010 the latter commented that trade mark cases amounted to about three quarters of his forensic linguistic consultancy work).<sup>29</sup> In our brief discussion below, first we exemplify the approach typically taken, illustrating our account from the work of Roger Shuy (whose *Linguistic Battles in Trademark Disputes* (2003) remains the most widely cited study in the field). Then we compare that general approach with three European cases which have decided the same kinds of question without the benefit of expert evidence.

Shuy's book discusses ten cases, reporting the author's involvement in trade mark litigation over approximately two decades. Of the ten cases, seven were reported in US law reports; and five, Shuy points out, involved an opposing linguistic expert. The core features of Shuy's approach emerge clearly in one case turning on whether use of the phrase HEALTH SELECTIONS, as the name of a new food product, infringed the trade mark HEALTHY CHOICE.<sup>30</sup> Shuy's analysis (2002:69–80) examines similarities and differences determining how far the two marks sound the same (phonetics), look the same (morphology, their word structure), and/or have similar meaning (semantics, explored through relative synonymy).

In assessing the sound structure of the disputed marks, Shuy draws attention to evidence given in an earlier trade mark case by another US linguist, Jerrold Sadock, involving the marks LITTLE DOLLIE and LITTLE DEBBIE for cupcakes. In that earlier case, Sadock had used a form of phonological analysis called distinctive feature analysis to demonstrate that the sounds of the two marks were only 13% different. Distinctive features are aspects of sounds that indicate the minimal contrasts between sounds systematically used in a language (Chomsky and Halle 1968). Structural analysis of such features (in effect, a grid of the components of consonants and vowels in the two marks) had allowed Sadock to provide a quantitative assessment of how far

<sup>28</sup> *Bambino Mio v Cazitex* [2009] EWCA Civ 922

<sup>29</sup> "Interview with Seemaab Naseem". Aston University: Centre for Forensic Linguistics.

<sup>30</sup> *ConAgra Inc v Acme Commercial Corp*, US District Court for the District of Nebraska, Civil Action No 8: CV 91-119.

the two phrases resembled each other; and Sadock produced a detailed chart in court indicating the existence or absence of each specified feature. Following Sadock's example, Shuy reports that he produced an equivalent analysis and found the quantitative outcome similarly compelling. But he comments that, although the lawyers he was working with were impressed, they doubted whether such detailed presentation would be effective in court. So Shuy produced a simpler analysis, summarising the degree of difference in a manner likely to be more accessible to general, "ordinary" language users.

Among linguistic specialisms, it is worth noting that phonetic/phonological evidence is usually considered the most decisive in court. This is because the sound structure of language is scarcely accessible to untrained language users, while what language means (with exceptions in areas such as dialect, jargon, and words loaned from other languages) is often considered to fall within the normal competence of a language user, and certainly of a judge.

Meaning questions were nevertheless central in another case in which Shuy was called: *McDonald's Corporation v Quality Inns International*.<sup>31</sup> In that case, in which McDonald's alleged infringement by the hotel chain Quality Inns following the latter's decision to create a new brand, McSleep Inns, Shuy examined what he calls "the meaning of a patronymic prefix": effectively, what *Mc* means when used to create new compounds such as *McNugget*, *McFlurry*, and *Mcjob*.

As in virtually all litigation, the legal issues in *McDonald's* were wide-ranging. Shuy's linguistic contribution drew on collected corpora of language use, and combined dictionaries with a database of newspaper, magazine and media use as well as with use of *Mc* collected from relevant commercial sectors. His analysis prompted him to group together attested instances of the prefix into seven major types: proper names, alliterative patterns based on proper names, acronyms, McDonald's product names, Macintosh-related computer products, parodies of a fast food product or service, and other uses conveying more general meanings of "basic, convenient, inexpensive and standardised". Shuy acknowledged that it is not possible for a linguist to say exactly how consumers understand "Mc", stressing that he did not set out to answer that question. A linguist, Shuy emphasises, is concerned with language patterns which show what a word *can* mean, and therefore how consumers might be expected to understand it based on established conventions of use. Shuy contrasts this kind of evidence with survey evidence – commonly used in trade mark cases, in the US and sometimes in Europe – which reports what actual consumers have said about what they thought (for example whether they were confused, or whether sign X called sign Y to mind).

McDonald's prevailed in Shuy's case, and the court's reception of his evidence, as he recalled it later, reveals attitudes towards semantic analysis which differ from those shown towards phonetic evidence. Courtroom questioning mostly concerned

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<sup>31</sup> US District Court for the District of Maryland, Civil Action No. PN-87-2606.

method, especially how different senses associated with a word-form are divided up and grouped together, and so with how many meanings there are (a complicated and not fully scientific construct either in semantics or lexicography). Questioning related to those issues prompted further probing of how far divergent inferences as regards the meaning of “Mc” might be warranted by alternative linguistic approaches.

Two brief illustrations cannot of course do justice to Shuy’s evidence; and the linguistic issues described here do not represent the only kinds of question explored in linguistic evidence either by Shuy or other linguists. Other issues have included the boundary between descriptive and imaginative or associative signs; the meaning of words transferred across languages (as in Heffer’s UK evidence on an English-speaking consumer’s likely understanding of the word *bambino*); and the significance of generic senses reported in dictionaries. Butters (2007) has also written on trade mark dilution, and in doing so summarised how, in his view, linguistic expertise can be useful in three main ways: by “providing evidence for the determination of one dimension of fame”; by “providing evidence with respect to the validity of the mark where genericness issues are raised by the defendants”; and by “determining the likelihood of blurring and tarnishment with respect to the phonological, morphological, and semantic characteristics of the mark” (Butters 2007:518). Butters describes these three concerns as still “rather conservative goals”, suggesting that linguists could potentially also shed light on the nature of tarnishment by applying expertise sometimes brought to bear on alleged defamatory statements or by adapting how linguists assess whether trade marks violate federal trade mark law forbidding “immoral, deceptive, or scandalous matter; or matter which may disparage” (2007:518). These areas suggest a substantial forensic linguistic agenda for the future. Because linguistic consultancy in trade mark cases is often not written up, however, it remains unclear how much use has been made since the article was published of linguistic evidence of each of these kinds, or how far the wider aim Butters intimates – that of “shedding light on the nature of” tarnishment or other aspects of trade mark law (2007:518–9) – has been achieved.

## 4.2 European parallels and differences

US courts, we have said, tend to be more willing to admit linguistic evidence than European courts. Yet broadly equivalent issues arise in European cases, and are dealt with without assistance from linguists. A brief comparison with how European courts have addressed such issues may therefore help to focus the question whether, and if so how far, UK and European courts are disadvantaged by lack of expert linguistic evidence. We consider this issue by referring briefly to three cases; each appears initially to be primarily a matter of two verbal signs with disputed similarity in their form.



1. The 1999 case *Lloyd Schuhfabrik Meyer v Klijsen Handel* concerned whether the degree of similarity between the signs LLOYD and LOINT'S, for shoes, would lead to consumer confusion.<sup>32</sup> The CJEU held that it would, and that aural similarity between the two was sufficient to cause confusion even in the absence of visual or conceptual similarity. The Court's judgment was arrived at without expert assistance. An impressionistic judicial assessment was made of the view of the average consumer, with attention directed not only to similarity between the signs themselves but also to similarity between the types of product in question and the methods used in marketing them. Although the court's assessment did not draw on expert evidence, it still took account of sound patterns including: the same number of syllables; similarity of features between the two marks' final consonant clusters (with the possessive apostrophe "s" in "Loint's" disguising the base form *Loint* which is closer to LLOYD); and greater saliency attributed to similarity occurring at the beginning of the two marks rather than at the end. No doubt these similarities could have been described more precisely by linguists. But expert evidence on such linguistic characteristics could only have been introduced (if either side had applied to submit it) at the cost of greater procedural complexity and expense – both of these also being important considerations for the courts to assess in case management.
2. The 2014 case *Volvo v OHIM* involved more complicated linguistic argument.<sup>33</sup> The case concerned the disputed signs VOLVO and LOVOL for cars, and the General Court confirmed earlier decisions made in proceedings by the Opposition Division and the Board of Appeal, which had held that LOVOL was neither conceptually, visually nor aurally similar to VOLVO.<sup>34</sup> The Board of Appeal had presented its linguistic reasoning in detail. The complainant, Volvo, submitted that both signs contain five letters and both consist of combinations of the letters "v", "o" and "l". The capital letters "V" and "L", it contended, were both angular characters, so their geometric structure was also similar. Volvo further submitted that the marks had the same vowel sequence ("o" followed by "o") as well as a parallel A-B-A pattern in their consonants: one has v-l-v; the other l-v-l. At syllable level, Volvo stated that both marks are characterised by "vol" and "vo" "and/or their inversion". On pronunciation, it argued that (i) the syllables "vol", "vo" and "lov" have striking similarities; (ii) both signs repeat the vowel "o", which dominates the way each sign is pronounced; and (iii) both signs contain "the soft consonants 'l' and 'v'", which, when pronounced, "do not create any strong sounds". As regards conceptual comparison, Volvo expressed the view that it is

<sup>32</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97) [1999] ECR I-3819.

<sup>33</sup> *Volvo Trademark Holding AB v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-524/11) [2015] ETMR 10.

<sup>34</sup> All three of these courts, in turn, hear appeals from the EU IPO. Appeals from the General Court go to the CJEU.



impossible to compare the signs in question, since neither has a meaning in any EU language. It submitted nevertheless that consumers coming across LOVOL would be intrigued by a new mark for cars and would ask themselves whether that new mark had any connection with an old and highly reputed trade mark for cars; on that basis they would be led to associate LOVOL with VOLVO.

The Board of Appeal rejected those arguments. It acknowledged that the signs at issue shared four out of five letters but observed that those letters did not appear in the same order. On aural comparison, the Court found that the mere fact that the marks had the same number of syllables was of no importance. Rather, given the difference between the vowel sounds in both syllables of the respective signs (since the same letter “o” is pronounced differently on each of the four occasions it occurs), the marks were aurally dissimilar. Moreover, the signs differed in their initial letters (“v” and “l”), as well as in their first syllable (“vol” and “lo”). On this point the court noted that – according to case law, rather than citing linguistics – consumers normally attach more importance to the beginnings of words. Nor could Volvo base any valid argument on supposed similarity between the capital letters “L” and “V”. On this point the court reasoned that, rather than looking for similarity, the average consumer instinctively contrasts letters of the Roman alphabet. Drawing on case law again rather than linguistics, the Board found it unlikely that the average consumer would divide the marks into their respective syllables so as to create an anagram and on that basis associate LOVOL with VOLVO.

Patterning by means of sound reversal or inversion was given particular attention. On Volvo’s argument that the first syllable of LOVOL is a reversal of “vol”, the Court noted that Volvo had not provided any example of an EU language according to whose rules the trade mark LOVOL breaks down into the syllables “lov” and “ol”. On the contrary it stated that, according to the rules of many if not most EU languages, LOVOL analyses into the syllables “lo” and “vol”. Volvo could therefore not validly argue that both marks are composed only of the syllables “vol”, “vo” and “lov”. Even assuming that the first syllable of LOVOL could be “lov”, Volvo had not provided any evidence to substantiate its assertion that the average consumer would divide a short meaningless word into syllables and then read the first syllable backwards.

As can be seen, the Board’s reasoning in this case (confirmed by the General Court) is attentive to detail and by no means linguistically naive, despite no expert linguists being called. At various points technical linguistic contrasts are invoked, for example how the letters “l” and “v” are articulated differently: “‘l’ is an alveolar consonant, whereas ‘v’ is a labiodental consonant”. Sometimes linguistic concepts and terminology do falter, as for instance in this description of the VOLVO sign: “the juxtaposition of the consonants ‘l’ and ‘v’ means that the space between those sounds is slightly compressed, whereas, in the word LOVOL, the vowels and consonants are alternated, with the result that pronunciation of that

word is more flowing. Consequently, the signs at issue have a different rhythm of pronunciation” (at paragraph 44). While legal and linguistic commentary relate awkwardly at some points, however, in general they appear complementary even where concerned with sound patterns which, we have noted above, tend to be the aspect of language most in need of specialist expertise.

3. Our third case, the 2015 case *Maier v ASOS*, also ostensibly turns on sound and visual similarity: between the marks ASSOS and ASOS applied to clothing.<sup>35</sup> At first instance, it was submitted that the public did not consistently distinguish between pronunciation of the two signs by using a long vowel (as in *stay*) for ASOS and a short vowel (as in *cat*) for ASSOS. During proceedings, Asos also accepted that ASOS was commonly misspelt as ASSOS, including in consumer search requests typed into Internet browsers. The judge, Rose J, held that there was both visual and aural similarity between the signs. She also accepted that the mark ASSOS was inherently distinctive, and that, although it did have a meaning in Greek (“best”), it did not have any descriptive meaning when used in connection with clothing.

What is striking in the official transcript of the Court of Appeal hearing, however (where the Court confirmed the lower court’s judgment), is that only 4 out of 259 paragraphs (including Sales, LJ’s dissent) are concerned with visual, aural and conceptual similarity between the two signs. The other 255 paragraphs deal with other issues between the parties, including the relation between the goods being marketed (general versus specialist cycling clothing), styles of marketing online, and respective market segments (upper versus popular), as well as the availability and merits of available defences.

Do these cases permit any more general comparison as regards the value of linguistic evidence regarding trade marks? While in each case similarity between verbal marks will understandably appear to linguists to be primarily a matter of the formal characteristics of the respective signs, for the courts – following a principle also embedded in a great deal of linguistic thinking, the requirement to analyse language use in context – similarity must be assessed in the context of the parties’ business practices. It is not surprising therefore that in many cases the most important legal issues may be more concerned with provisions governing use of marks in particular kinds of commercial undertaking, or in their marketing contexts, than with their linguistic form. Potentially, expert linguistic evidence could have been submitted in any of the three cases we have discussed, if one of the parties had applied to do so and if the judge ruled such evidence admissible. But the legal value of such evidence would have depended on a variety of factors, including many concerned with language use in a given context rather than language form.

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<sup>35</sup> *Roger Maier, Assos of Switzerland SA v ASOS plc, ASOS. com Ltd* [2015] EWCA Civ 220.

### 4.3 Semiotic analysis of trade mark law

Expert linguistic evidence in trade mark disputes is not, we suggested above, the only context in which trade mark law has been of interest to linguists. We now illustrate another major approach, less concerned with judgments made by one particular court than with questions about how courts in general decide (and should decide) trade mark disputes. To illustrate this direction, we discuss the most influential exemplar of that approach: an influential article by US law academic Barton Beebe, “The Semiotic Analysis of Trademark Law” (Beebe 2004).

Beebe seeks to understand trade mark law as a whole, including the procedural and policy issues it raises, by bringing broad linguistic concepts to bear. His overall argument is that economic approaches to trade mark analysis (e.g., emphasising the efficiency-enhancing function of trade marks by reducing search costs and encouraging investment) have not succeeded in explaining satisfactorily either the crucial concept of trade mark “distinctiveness” or more recent notions such as trade mark “dilution”. One of his aims, accordingly, was to develop a richer account of such concepts, by viewing trade mark law through the lens of semiotics. Beebe urges that the concept of distinctiveness should be reconceptualised as two (distinct) types: “source distinctiveness”, denoting a trade mark’s source-indicating capability; and “differential distinctiveness”, a trade mark’s degree of separation in terms of sound, form and meaning from other marks around it (this kind of distinctiveness he bases on the capability of formal contrasts to convey conceptual or evocative effects, and is not related to the badge of origin function).

The ambition of Beebe’s arguments emerges most clearly from his historical account of trade mark law’s development. But the consequences he claims are current. Beebe proposes that, in different circumstances, courts should assess different axes of a sign’s functional potential: whether or not it possesses “source” distinctiveness, when evaluating its eligibility for protection against infringement; and how far a sign has “differential” distinctiveness, when what is in question is the scope of its protection against infringement. The theoretical basis for this proposal lies in early twentieth-century descriptions of how signs signify; indeed Beebe suggests that trade mark law has developed an almost parallel understanding of signs to that present in semiotic thinking.

Two established accounts of how signs function are juxtaposed in Beebe’s article with judicial opinions in US cases and with theoretical scholarship on trade marks, including work by Schechter and Posner. The first, semiotic account is that developed by Ferdinand de Saussure; the other comes from the work of logician and polymath C. S. Peirce.

In a discipline-defining but now infrequently read series of lectures transcribed and edited after his death, Saussure (1983 [1916]) suggested that signs consist of two elements or aspects: a signifier (or formal material: for a trade mark, what is commonly considered the whole “sign” but what in Saussure designates more narrowly the verbal form or sound); and a signified (an idea or concept conveyed by association

with that signifier). For Saussure, the two aspects were inseparable, like (in his famous image) the recto and verso of a sheet of paper. Communication, he argued, is made possible not by either aspect on its own but by the relations that signs consisting of these two aspects enter into. Saussure identifies two kinds of relation, hence Beebe's proposed two kinds of distinctiveness: a relation of "signification", in which a sign means something in the world (Saussure's example is that a five-franc coin can be exchanged for a loaf of bread); and a relation of "value", through which the sign takes its place in a system of contrasts with other signs around it (the five-franc coin is equivalent to five one-franc coins). Communication utilises both kinds of relation. The sign's potential to refer to things in the world had of course been acknowledged for centuries; Saussure's innovation was to draw attention to how far meaning is produced by – and how much it depends on – the system or network of structural relations which creates the contrasts between signs. This aspect of Saussure's thinking (his other main achievement was to shift the emphasis of linguistics away from philological enquiry towards systemic, "synchronic" analysis) has been important, though also often challenged, in a great deal of subsequent thinking about meaning and more generally about the relation between language, thought and reality.

The second account of signs Beebe draws on comes from the work of C. S. Peirce. Peirce's model is sometimes called triadic, or triangular, because, as well as having a tangible symbol (signifier) and cognition produced in the mind (signified), Peirce also insisted on the importance of a third element: the thing referred to (the referent). Peirce's resulting model consists of a physical sign that creates a concept, with these two aspects in combination pointing to an extra-linguistic referent. Modern linguistics, it should be noted, is no longer so preoccupied with these fundamental characteristics of sign functioning, and typically describes the relations entered into by verbal signs in different terms, such as sense relations, denotation and connotation, and reference. But the nature of the sign has continued to play an important role in semiotics generally, as well as in literary and cultural theory.

Beebe's central insight in the article was to show how semiotic terminology can be used to describe many features of trade mark law, mapping legal developments onto how signs work in general. To simplify somewhat, he divides the history of trade mark signification into three phases: a "classic triadic structural relation of the trade mark"; a more recent "dyadic structural relation of the trade mark"; and an emergent phase of the "floating signifier and hypermark". The main difference between the three phases, Beebe suggests, concerns how the three elements of a semiotic sign, as described above, function in relation to one another.

In Beebe's "classic, triadic structural relation", the qualification of a word or symbol to function as a trade mark required three elements:

1. A tangible symbol or device (a signifier)
2. Use of that symbol as a mark by a manufacturer or seller of goods or services (those goods being the signifier's referent – though note here the complication of Saussure's relative lack of engagement with reference, as well as the difficulty in

trade mark law in distinguishing consistently between goods and the commercial undertaking as the sign's referent)

3. Performance of the function of identifying and distinguishing the goods from goods made or sold by others (in Beebe's conceptualisation, a signified combining the goods with their associated goodwill based on quality, reliability, etc.)

In describing this "classic" structure, Beebe draws attention to difficulties in such an account, including the risk of merging together product, producer, and goodwill in a reduced concept of a sign's "meaning". But a deeper instability in the three-way relation, he suggests, runs through the more recent development of trade mark law.

In Beebe's view, the "classic" three-part structure now coexists with a newer, "dyadic" structure in which the mark's function relates more to what is signified (goodwill, positive affect, resonance or evocation) than to any referent. Accompanying this second phase or structure, Beebe contends, is a new level of commodification of semiotic sign value, creating an "industrial production of social distinction" (2004:624) The kinds of social distinction in question are contrasts between associations (i.e., aspects of the signified) rather than qualities of a referent, the commercial source. If there is a material referent in this newer commercial structure, that referent is no longer a matter of producers or products but "the consumer himself". He/she is "the commodity-form about which the trade mark is designed to convey information" (2004:659).

Such weakening of the role of the referent in the nexus of producer and product was, Beebe maintains, already under scrutiny in Schechter's writing in the 1920s, in a commercial movement away from the "strict source" requirement associated with mediaeval guilds (when marking products could be a liability as much as an asset) towards an "anonymous source theory" reflecting modern modes of industrial production (Schechter, 1926–7). The outcome of such changes, Beebe argues, is that courts have now become willing to protect promotional extensions of trade marks far beyond their traditional source-denotative function. (2004:660).

Beebe's third phase, that of the "floating signifier and the hypermark", is more speculative. He notes that trade mark regimes continue to change in tandem with wider shifts in commerce and culture, and have become a system of marketing communication and consumer information in which a tangible mark (the signifier) may now only imply a signified that is "so indefinite or contested as to constitute an 'empty category'" (2004:667). Not only is there no identifiable referent, but the signifier is empty of connoted meanings of a kind that might underpin social distinction by appealing differently to different consumers. Beebe comments that in this phase, "There is only distinctiveness from, not of" (2004:669). Trade marks operate to achieve such "differential distinctiveness", or contrast with surrounding signs (Saussure's "value"), without any reference to a source (Saussure's "signification"); and consumers interpret trade mark signifiers in this altered marketplace as if the signs are designations of source without questioning whether they are, or giving any particular meaning to what "source" designation indicates.

Beebe extrapolates from this theoretical-historical analysis a series of arguments why courts should move towards decisions based on his two types of distinctiveness. He submits, for example, that dilution is concerned with differential distinctiveness rather than source distinctiveness: it occurs because, by being similar, two signifiers lessen each other's degree of contrast even where there is no issue of confusion. He also discusses the relation between trade mark tarnishment and dilution. In recent developments, Beebe contends, the trade mark signifier creates the goodwill it communicates, generally by means of what, echoing Schechter, he describes as "vast expenditures in advertising... which the courts concede should be protected to the same extent as plant and machinery" (2004:685). Extended protection granted to creating rather than reflecting goodwill, Beebe argues, is part of a contemporary trade mark landscape riven by contradictions.

#### 4.4 The challenge of greater interdisciplinarity

We turn now to two directions in recent publications which attempt closer integration between trade mark law and linguistic analysis than either applied linguistic evidence or semiotic overview. The approaches we describe have in common that, in more concrete ways than Beebe's general semiotic account, they bring linguistic evidence and argument to bear in advancing critiques of particular trade mark law doctrines and in order to advocate legal changes. Together, the articles we describe might in this way be thought an "intermediate" direction for research.<sup>36</sup>

In a recent article, "Are we running out of trademarks? An empirical study of trademark depletion and congestion" (Beebe and Fromer 2018), Beebe and co-author Jeanne C. Fromer (2018) argue that two related phenomena, trade mark "depletion" and trade mark "congestion", threaten the ability of trade mark regimes to fulfil the policy objectives of promoting efficient and fair competition and minimising consumer search costs. Their article presents evidence of increased trade mark scarcity, and points to the likelihood in future of a shortage of suitable verbal signs for prospective trade mark proprietors to register and use.

To understand their research, it is necessary first to consider what trade mark depletion and congestion are. The term "trade mark depletion" refers to the using up, in relevant commercial fields, of available signs.<sup>37</sup> Trade mark law has typically presumed an inexhaustible supply of unclaimed, potential verbal trade mark signs that are likely to be as competitively effective as those already claimed. The authors submit that this is a testable empirical assumption and that it is incorrect. The supply of competitively effective marks, they argue, is exhaustible and has already reached

<sup>36</sup> Possible such directions were influentially outlined and encouraged in Dinwoodie (2008).

<sup>37</sup> The concept of trade mark "depletion" is first outlined in the US Supreme Court decision in *Qualitex Co. v. Jacobson Products Co.* 514 U.S. 159 (1995).

a severe level of scarcity, with the consequence that the overall ecology of the trade mark system is at risk.

The availability of potential trade mark signs is complicated, the authors assert, by the likelihood that some signs are more suitable for trade mark purposes than others. Marketers, for instance, urge that verbal marks should be short; and common words are also considered desirable by comparison with neologisms because their everyday use can impart feelings including familiarity and authenticity. Signs with such characteristics have also shown themselves to be easy to pronounce and recall, and are valued especially where a word's connotations reinforce a brand's message. Marketing experts also advise against descriptive words or phrases, because such signs will not be granted legal protection on registration as inherently distinctive. Would-be trade mark proprietors nevertheless often choose evocative signs in order to convey information about characteristics of the product, even at the risk of losing distinctiveness, in the belief that the leverage of recognition and recall may compensate for the need for additional investment in advertising to cultivate acquired distinctiveness. Such considerations reflect a general point: that, given limits to human cognition and communication, some signs enjoy a competitive advantage as trade marks over others.

“Trade mark congestion” describes a related process. Even if a mark is already registered, this fact does not preclude other undertakings from registering the same or a similar mark in connection with different goods or services. Many marks, Beebe and Fromer point out, have multiple registrants in different classes. By 2015, for example, there were according to their data over 100 active single-word US registrations for ACE across the Nice classes, owned by nearly 100 different registrants (Beebe and Fromer 2018:1012–3). Even where such “parallel use” of the same mark does not confuse consumers as to commercial source, it may diminish a given mark's distinctiveness by creating a potentially diluting or blurring effect.

In these circumstances new trade mark applicants are increasingly obliged to resort to less competitively effective marks. With almost every naturally occurring one-syllable word already claimed, commercial undertakings select longer signs or portmanteau (combined or blended) words, or strategically drop vowels or change spellings in existing words, or devise neologisms. The authors argue that such complexity and potential obscurity can lead to increased consumer search costs and contribute to an erosion of the public, linguistic domain.

To test their sense that serious problems surround the availability of verbal signs, Beebe and Fromer assess evidence that conflicts with the intuitive consensus about an unlimited supply of verbal signs. They examine all trade mark applications filed at the US Patent and Trademark Office from 1982 until 2015; they analyse registrations for the most frequently used words and surnames in American English by consulting COCA (the Corpus of Contemporary American English) and US Census data on the most frequently occurring names. They also scrutinise an original dataset of phonetic representations of word marks, in order to estimate scope for further user-friendly



neologisms. Finally, because of the contemporary significance of Internet domain names, they assess registration data for domain names at the .com top-level.

The extensive empirical data they collected consistently show increased use of, scarcity in, and pressure on signs available for registration as marks. Applications and publication rates have varied by year but risen steeply overall, albeit with an increased rate of refusals because of impermissible similarity with already registered signs. Looking forward, the authors report on the availability of one-syllable neologisms, examining all combinations compatible with English sound patterns. In some Nice classes they report that half of all one-syllable possibilities have been claimed. Extending their analysis to likelihood of confusing similarity, the authors claim results are even starker. Since a word mark registration in a given class depletes not only the word it matches but also all similar words in the same class whose use would confuse consumers as to source, the authors argue that a full assessment of depletion should include not only identity but also non-identical similarity between claimed marks and the supply of possible new signs. Calculating relative distance between strings of letters by using a tool to count the number of operations (such as insertion, deletion, or transposition) required to transform one into another, the authors report that nearly all new signs based on frequent words would be confusingly similar with an active trade mark registration. Even as regards possible one-syllable neologisms, the authors show that over half of the most frequent syllables in American English have been claimed as one-syllable marks; and in their examination of top-level .com domain name registrations, the authors found almost complete saturation.

Beebe and Fromer conclude their article by turning to policy initiatives that might mitigate the effects of depletion and congestion they claim to have demonstrated. Among initiatives they discuss is variable pricing for registration in different fields, depending on level of congestion, in order to internalise costs that such registration imposes on competitors. Citing evidence that, among audited registrations over a two-year pilot period roughly half could not be verified as being in use as claimed, they also urge increased maintenance and renewal fees for trade marks, as well as a general tightening of enforcement procedures.

The other direction in recent scholarship we wish to draw attention to we can illustrate by reference to two related articles by US trade mark scholar Jake Linford.<sup>38</sup> Like Beebe and Fromer, Linford argues in favour of changes in trade mark law. His arguments, however, are not based, like theirs, on “big data” but on theoretical work on language change. Linford discusses how far analysis of “semantic shifts” (i.e., linguistic processes of meaning change) can illuminate the relationship between signs claimed as trade marks and goods to which they are attached. Linford’s focus in each of the two articles we describe is an established category of verbal signs as

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<sup>38</sup> Linford, Jake. 2015a. A linguistic justification for protecting “generic” trademarks; Linford, Jake. 2015b. The false dichotomy between suggestive and descriptive trademarks.



understood in trade mark law: in one article, so-called “generic” marks, in the other “suggestive” (sometimes known as “imaginative” or “associative”) marks. These two categories form part of what in US trade mark law is called the “Abercrombie scale” (or “spectrum”): an arrangement of different types of sign and their relation to goods promulgated in the case of *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>39</sup> (The US categories broadly correspond to distinctions we described above in relation to UK and European law.)

The Abercrombie scale lists five categories of trade mark signs (or potential signs), which we illustrate here in relation to words or phrases: “fanciful” (made-up words, such as XEROX); “arbitrary” (words with no discernible connection between sign and the class of goods to which it is applied: our example for UK signs was NORTH POLE for bananas; Linford uses the standard but more problematic US example APPLE for computers)<sup>40</sup>; “suggestive” (signs where the goods are evoked imaginatively by the sign: Linford exemplifies this class by GLEEM and SKINVISIBLE, for toothpaste and cosmetics; an active mental leap is needed to connect sign with goods); “descriptive” (signs which identify characteristics or qualities of the goods; Linford’s main example is SEALTIGHT, for fasteners); and “generic” (signs which name a category of goods within which the sign is proposed – inevitably unsuccessfully – as a source indicator for one particular supplier: Linford discusses the made-up examples COMPUTER for computers and HELICOPTER for helicopters, as well as, he argues more problematically, HOG initially for big and then specifically for Harley Davidson motorcycles).

The Abercrombie categories characterise types of relationship between sign and class of goods. They are not formal categories like phoneme or verb, or names for general tropes like metaphor or synecdoche. Although several of the relations do depend on figurative tropes which extend or transfer meaning (e.g. metaphor and metonymy), the categories also depend crucially, as we stressed above, on situations of commercial use for any given sign. What makes the categories a “scale” is that they represent an ordering of relations, such that, when a prospective mark is assessed, a judgment as to which category it is in has major legal and commercial consequences: the top three categories “fanciful”, “arbitrary” and “suggestive” are all considered inherently distinctive, and so registrable on application; “descriptive” signs can only be registered on demonstration of acquired distinctiveness (“secondary meaning”), assessed by an analysis of commercial context; “generic”

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<sup>39</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2<sup>nd</sup> Cir. 1976).

<sup>40</sup> Seeking to register APPLE for computers is generally considered to create a homonym (two identical forms with no connection in meaning, and so an arbitrary relation between the two meanings: fruit and computer). Alternatively, however, the sign might in context be argued to convey metaphorical meanings, and polysemous extension: a computer might be viewed as “natural” like an apple, or a new beginning like “A is for Apple”, or, especially if visualised with a bite taken out of it, the sign might symbolise digital entry into (Biblical) knowledge acquired from the tree of life.

signs, at the bottom, cannot be registered at all (even if acquired secondary meaning were shown).

In each of the two articles we consider, Linford links his discussion of a particular sign type to a doctrinal issue. In one of the articles (Linford 2015a), he urges an extension of possible protection, proposing a change to the US doctrine of “trademark incapacity” or “de facto secondary meaning” (“de facto” in this context means something like “legally insignificant”); the result would be that marks considered “generic” could be – as they now cannot be – granted protection as distinctive source indicators, if satisfactory proof were submitted of acquired distinctiveness. In the other article (Linford 2015b), Linford proposes a reduction in available protection, by withdrawing treatment of “suggestive” marks as inherently distinctive and instead requiring proof of secondary meaning in such instances, as for “descriptive” marks.

To understand Linford’s arguments, it is necessary to consider further the relationship between the Abercrombie scale and semantic change. A trade mark is created, Linford suggests, when a “source identifying” meaning is added to an existing word (or phrase), or when a word is invented to identify the commercial origin of a product. Where the sign in question is already in use in the language, then its existing meaning or meanings are extended and it becomes polysemous; where a neologism is created, then its source-indicating meaning is its first and only meaning.

What is important for Linford is that distinctions made in the Abercrombie scale appear mostly to align with mechanisms of “semantic shift”; and in areas where there appear to be discrepancies between the two he urges that trade mark treatment of signs should be reconfigured so that it better reflects wider, demonstrated principles of language change. “Generic” signs, he points out in the article on this category of signs, have in many instances in the history of languages undergone semantic narrowing (to a prototypical or particular instance); so there should be no obstacle in registering formerly generic signs as trade marks where the narrowing change of meaning can be demonstrated to a satisfactory standard. “Suggestive” signs in the Abercrombie scale, he argues in the article on a “false dichotomy” between “suggestive” and “descriptive signs”, are in processing terms more similar to “descriptive” signs than they are to “arbitrary” signs; both, he suggests, are typically polysemous (either by metaphorical or metonymic transfer); and signs with these properties have been shown in experimental studies to enjoy processing advantages that result in easier recognition and recall by comparison with (homonymic) signs, where there is no link between a sign’s earlier meaning and its new meaning. Extrapolating from experimental modelling of language change mechanisms to trade mark use, Linford concludes that allowing registration of suggestive signs because they are assumed to be inherently distinctive confers an unjustified advantage on them, as well as an anti-competitive commercial advantage on the undertaking which owns them.

This account of Linford's arguments inevitably simplifies greatly the author's engagement with semantic theory and trademark doctrine.<sup>41</sup> But it does illustrate the speculative character of the two articles, and may be useful in highlighting difficulties to be faced by anyone seeking to progress such lines of research in the future. Four areas of difficulty are worth noting. First, although the Abercrombie categories are often described as forming a "scale", suggesting step-changes at relevant borderlines (albeit with inevitable fuzzy borderline disputes), they are also, as Linford notes, alternatively viewed as a "spectrum": this alternative description foregrounds how far signs within a given category range in semantic space between adjacent categories and may differ considerably from each other as well as from signs in other categories. Secondly, pairings of signs and categories of goods are generally not made in trade mark law entirely in the abstract; both for registration and infringement purposes they are modulated, for the sign by its particular design, juxtaposition and use and for the goods by particulars of commercial context. Third, transfer of ideas from principles of semantic change to trade mark doctrine is a bold step, both theoretically (from descriptive linguistic reconstruction, through psycholinguistic experiments, to normative application to processes of naming) and practically (from naturally occurring language change to commercial naming and regulation). Fourthly, the metalanguage currently shared by trade mark law and linguistics may not be adequate to support the necessary linkages of argument between fields. The idea of "meaning", to take one key example, is difficult to apply consistently unless distinctions are made at least between denotation, connotation, and reference, and unless it is also shown how such distinctions are to work in relation to naming. Further, if an analogy is to be made between "efficiency" of language change mechanisms (or of "communication" more generally) and efficiency in consumer search costs, then more nuanced terminology and attention to contexts of use is likely to be needed. So too with the attractive-sounding "regular" semantic change, which like many terms already in use in trade mark metalanguage is linguistically both polysemous and vague, and could mean "consistent and rule-governed", "periodic", or even just "usual and ordinary".<sup>42</sup>

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**41** In the course of the two articles, Linford brings together late nineteenth-century philological accounts of semantic change (including Bréal's celebrated classification of mechanisms such as sense widening, narrowing, amelioration and pejoration), with later developments in semantics ranging from Ullmann through to cognitive semantic accounts such as Blank's (1999) typology of motivations for lexical semantic change, Klepousniotou's (2002) comparison between the processing of homonymy and polysemy, Croft and Cruse's (2004) analysis of construal processes, and the 'invited inference' theory of regularity in semantic change developed in Traugott and Dasher (2005). For detailed discussion of such semantic approaches, see Geeraerts (2010).

**42** At the very beginning of their study, Traugott and Dasher (2005) point out that not all areas of the lexicon show the same degree of regularity in semantic change. Most irregularity, they note, occurs in fields where words ("primarily in the nominal domain") are exposed to "reference and therefore to changing life-styles and ideologies". Such words are scarcely subject to regular models of language change because they are "particularly susceptible to extralinguistic factors such as change in the nature or the social construction of the referent." (Traugott and Dasher 2005: 3-4).

## 5 What role for linguistics in trade mark law?

The various directions in established and newer linguistic approaches to trade marks that we have outlined differ not only in aims and method, but also in strategy: in how they seek to engage with and inform trade mark law's procedures and institutions. The "expert evidence" approach is essentially a kind of applied linguistics. It offers expertise in particular cases and stays within that expertise by remaining detached from legal procedures and reasoning. In contrast, "semiotic" and more fully interdisciplinary approaches urge dialogue between linguistics and trade mark jurisprudence but remain problematic, we suggest, in connecting generalisations with specific legal issues under debate. While all the approaches offer insights into how trade mark signs work, none in its present form offers a fully satisfactory way forward as regards longer term collaboration between lawyers and linguists.

Turning from analysis and critique towards our own suggestions for fresh lines of enquiry, we now consider whether there might be more fruitful ways to address the sorts of questions and problems in trade mark law we have described. One way of framing the issues we see as important is to acknowledge that both legal and linguistic analysis of trade mark signs occurs in three related conceptual areas (areas we differentiate from stages in legal proceedings such as registrability assessment and infringement litigation). In each, the approaches taken by the respective disciplines parallel each other but never fully coincide. To this extent, engagement between the two disciplines is arguably still as much a non-encounter as an encounter.

The three conceptual areas, or domains of enquiry, we have in mind are: (i) analysis of formal features and meanings of particular signs used as marks; (ii) generalisation or idealisation of sign interpreters' /consumers' perceptions and behaviour; and (iii) appeals to empirical evidence. We consider each separately, and inevitably very briefly.

### 5.1 Analysis of signs used as marks

It would be impossible for trade mark registrars and courts to avoid borrowing words and categories from general and more technical linguistic usage to identify and compare the verbal phenomena they are examining (e.g. consonants, vowels, and syllables; or parts of speech and basic grammatical relations). Familiar metalinguistic categories of this kind may be considered "ordinary words of English" rather than legal terms of art and are often used, at least as viewed from a linguistic perspective, imprecisely or even incorrectly by the courts. Such categories are defined more exactly in linguistics than in law, and are subject to theoretical investigation as parts of the language system. For the courts' descriptive purposes, however, special expertise in using such terms seems unnecessary in most cases (e.g. it is possible to know sufficiently that the four sounds made by the one letter "o" in the two signs VOLVO

and LOVOL differ from one another without phonemic categorisation). Labelling the properties of signs more precisely might help clarify discussion, but it brings significant disadvantages of cost and complexity; so there seems good sense in a legal presumption that assessing the relative similarity or difference between the features of marks encountered in a supermarket or car showroom should be kept as simple as possible (particularly because commercial setting may have an impact on how the respective signs are perceived).

There are two other kinds of terminology, however, that invite greater interdisciplinary interest. Less familiar, more interpretive concepts are sometimes used in trade mark analysis including “neologism”, “loan-word”, “figurative”, “connotation”, and “parallelism”. The characteristics, use and consequences of such categories seem less clear. These are no longer ordinary words of English in any ordinary (rather than legal) sense, and appear to have become legal terms of art, though only in the sense of being terms only decipherable by lawyers and not subject to other scrutiny rather than because they have clear definitions or standards of use. Beyond such categories there are also complex legal constructs such as “visual, aural and conceptual similarity”, a compound which includes estimation of degree and processes of combination and balancing in creating a more impressionistic global assessment.

Faced with such an array of terms and associated concepts, some linguists have urged that trade mark lawyers and linguists should work together to define terms, so that relevant terminology is translatable between the two fields. This, it might be argued, could lead to increased procedural clarity and legal certainty. As many of the examples above suggest, however, many language-related terms in trade mark law are not purely metalinguistic; they combine linguistic meaning with other characteristics: e.g. a specific contextual relation (a connection between sign and class of goods); a wider contextual relation (use of a sign within specialised marketing practices of a given field of commerce); and a normative implication (the legal consequence for a sign of falling inside or outside a given linguistic-legal category, such as being “distinctive”). Legal application of such concepts requires combined linguistic and commercial assessment, within a precisely specified legal framework. Linguistic research into such terms and concepts, both in general and as applied in particular cases, needs accordingly to be an interdisciplinary form of investigation.

## 5.2 How consumers perceive and construe signs

A similarly complicated interface is to be found between linguistic and legal thinking in our second area. To appreciate the significance of this area, it is necessary first to say more about the average consumer, who in European trade mark law is assumed to be reasonably well-informed, reasonably observant and circumspect (and whose US cousin has been attributed similar characteristics: “the ordinary purchaser in

the exercise of ordinary care and caution in such matters”).<sup>43</sup> Assigning interpretive authority to a generalised consumer in this way inevitably involves idealisation: an act of abstraction towards selected characteristics based on potentially quite different alternative processes, including generalisation from the behaviour of observed consumers; normative assessment derived from a general theory or value system, related in this case to consumption; and creation of a legal construct for reasons of procedural efficiency.

Viewed from the perspective of how the idealisation is made the average consumer in trade mark law hovers between different conceptions. The average consumer is average for the classes of goods to which the sign in question relates rather than general across all marketing situations, and pays greater or less attention to different kinds of purchase. Recently, the CJEU has also identified a second average consumer: the average internet user, who is assumed to have the same characteristics as the original but with more or less actual knowledge of how websites function.<sup>44</sup> Both online and in the real world, the average consumer is presumed to be a rational market actor: a utility-maximizing individual able to process information in order to make the most advantageous choice (Davis 2005).

Trade mark signs are viewed as one element of the information available to the average consumer in making rational choices. When that average consumer is deciding how verbal signs look or sound, however, or what they mean or what other signs they link to or call to mind, these characteristics are inevitably supplemented with other, tacit linguistic and psychological assumptions that do not take the form of standards (such as “reasonably well-informed” or “circumspect”) but are specific capabilities or behaviours, including noticing, inferring, comparing, and linking. Those linguistic and psychological capabilities contribute to being “circumspect” or “reasonably well-informed”, but cannot be derived from any normative category. In assessing how the average consumer might react in specific circumstances without recourse to evidence, frequently legal authorities simply put themselves in the place of the average consumer. They did so for example when a EUTM registration was sought for SOLVO for computer programs and was opposed by the proprietor of VOLVO for automobiles. The General Court assumed that the average consumer of SOLVO software would be a “professional” who would “scrupulously” examine the software and possibly even meet the provider’s employees. On that basis, the average consumer would be unlikely to be confused.<sup>45</sup> Alternatively however, it might be argued that an understanding of the capabilities or behaviours that the relevant average consumer brings to bear can only be derived either from actual evidence in specific cases, or from what is understood through idealisations made in other fields about how people behave, for example how they see and interpret signs, or compare and recall them. It is therefore an interesting

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<sup>43</sup> *McLean v Fleming* 96 U.S. 245, 24 L. E.

<sup>44</sup> *Google France Sarl v Louis Vuitton Mallettier* (Case C-236/08-238/08) [2010] E.C.R. I-2417 at 99.

<sup>45</sup> *Grebenshikove v OHIM* (T-394/10) [2014] ETMR 22 at 35-36.

research problem how behaviours and capabilities involved in trade mark law relate to equivalent idealisations made about communicative behaviour in linguistics.

Linguistics does of course have its own forms of idealisation about language users. But such idealisations are devised in relation to the field's own research goals, rather than concerned with the characteristics or kind of behaviour attributed to the average consumer. There may as a result be little to be gained by referring to present linguistic idealisations in trying to understand how verbal signs used as trade marks are perceived and understood. This point can be illustrated by reference to the most well-known linguistic idealisation, Chomsky's concept of linguistic competence in generative grammar; in that context, idealisation refers to a native speaker's knowledge of language as a system of rules such that he or she can produce and understand an indefinite number of sentences, many never formulated or heard before, and can recognise grammatical mistakes and ambiguities (Chomsky 1965). Linguistic competence understood in this way relates ultimately to a research claim about linguistic innateness, and differs fundamentally from the kind of behavioural generalisation involved in the idea of the average consumer. It is true that a less obviously dissimilar idealisation was put forward in sociolinguistics soon after Chomsky, in Hymes's notion of communicative competence (Hymes 1966), an idealisation based not only on grammaticality as in Chomsky but modelling the ideal speaker/hearer's knowledge that permits production and comprehension of utterances appropriate to the setting or context in which they occur (i.e., a concept of competence that incorporates social determinants such as the relationship between speaker and hearer and the time and place of speaking). What seems clear, however, is that neither form of linguistic idealisation aligns easily with the very different abstraction involved in the legal concept of the average consumer. While incompatibility between legal and linguistic generalisations may have little practical consequence in law – where judges will almost certainly continue, in most instances, to decide what the average consumer's view would be based on impression or their own example – it raises new and interesting interdisciplinary possibilities as regards how far linguistics or psychology might contribute to understanding “average consumer” assessments.

### 5.3 Appeal to empirical evidence

Both trade mark law and linguistics place a high value on evidence, but not necessarily evidence of the same things, or for the same purpose, or discovered by the same methods. In European law, the CJEU has made it clear that empirical evidence such as the extent of use of a mark and consumer opinion polls may be deployed in helping to decide whether or not a mark is distinctive in the eyes of the average consumer. But there is a difference in this respect between the treatment of distinctiveness and of confusion. In UK cases concerned with confusion, the courts have generally treated the average consumer as a “hypothetical legal construct”, about whose views



the court can “make up its own mind” without the necessity of “counting heads”. In *Hearst Holding v AVELA*, Birss, J gave a pithy description of the relationship between the average consumer and the test for confusion. He noted that the parties to the case were agreed that the average consumer “is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”<sup>46</sup> Less frequently, the courts will accept that likelihood of confusion is a matter of individuals whose views might be measured by empirical evidence, including opinion polls (Davis 2015). But generally they take the view that empirical evidence of confusion is expensive to gather and rarely probative.<sup>47</sup>

In this context, it is worth asking what kinds of linguistic evidence would demonstrate best how far the courts’ decisions could be assisted by linguistic expertise, either in addition to or instead of the kinds of survey evidence more readily admitted at present. Such evidence could potentially take a number of different forms (leaving aside evidence from introspection, i.e. searching one’s intuitions for examples and counterexamples in relation to a particular linguistic claim). Linguistic evidence might consist of any one or a combination of the following:

1. Acoustic, experimental phonetic, and theoretically derived phonological evidence (as regards how words are pronounced, including the pronunciation of trade mark neologisms; or regarding the relative saliency of first and subsequent syllables in words).
2. Corpus linguistic searches for tokens of a given word or phrase, to establish frequency-of-use, common collocations, or comparison with use of the same or other signs. Such investigation could potentially help to show, as Heffer tried to, whether the word *bambino* is used in English often enough and in suitable circumstances to make it recognisable as meaning “baby or young child”; or how often and where the English word “baby” is followed by “dry”, as a way of exploring whether the phrase “Baby Dry”, somewhat controversially registered as a mark, occurs in descriptive contexts in addition to use as a suggestive brand name for nappies.<sup>48</sup>
3. Psychological or psycholinguistic research into the perception of signs, including: what they evoke; how easily they are recalled and what triggers such recall; how similar a sign is perceived to be in relation to other signs; the relative likelihood of association between different signs; and how multiple meanings ascribed simultaneously to signs co-exist and relate to each other (a topic increasingly relevant in the context of additional functions attributed to trade mark signs, and perhaps especially complex in relation to slogans (Davis and Durant 2011).

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<sup>46</sup> *Hearst Holding Ltd v AVELA Inc* [2014] EWHC 439 (Ch).

<sup>47</sup> *Interflora v Marks & Spencer* [2014] EWCA Civ1403.

<sup>48</sup> *Proctor & Gamble Co v OHIM* (C383/99 P) [2001] ECR I-6251.



## 6 Conclusion

The possible new lines of enquiry we are drawing attention to in this chapter in some instances resemble current forms of forensic linguistic evidence, and might be submitted in that form in jurisdictions which permit such evidence. But whether linguistic research would assist a court in a given case should not in our view be the only test of whether such research is worth doing. A more general significance is also possible: contribution to a legal and academic culture of trade mark discussion that may not impact on particular cases but contributes to the development of the area of law as a whole.

Alongside the necessary interdisciplinarity of such research, another characteristic seems indispensable: engagement with the procedural exigencies of trade mark law. For example, the first two of the three domains we proposed above as suitable for further linguistic enquiry will always be present in trade mark cases. There will always be formal analysis of signs by legal authorities applying statute and case law (e.g., both as regards absolute and relative grounds of registration, and in infringement cases); and there will always be an assessment of the view of the average consumer, situated in the relevant commercial context. What will not always be present is empirical evidence, the area perhaps most favoured among linguists. Often, indeed, such evidence is found by the courts to be unhelpful even where submitted. Even if the courts were more enthusiastic than they now appear to be, however, there would still be a difficulty. If such evidence were required in all cases in support of the view to be taken of the average consumer, or even in most, judicial systems dealing with trade mark cases would grind to a halt, or at least become prohibitively expensive for most claimants.

In the EU, where there are 24 official languages, the burden of acquiring expert evidence in trade mark cases is almost certainly exacerbated. Frequently, in cases involving either registration of a word or phrase as a EUTM or in a subsequent dispute, the legal authorities may need to take account of its meaning in more than one language. Perhaps unsurprisingly, the courts have generally concluded that such disputes may be resolved by recourse to the average consumer without a need for expert translation. An example is *Intra-Press v Golden Balls Ltd*,<sup>49</sup> which ultimately came before the CJEU. In *Intra-Press* it was necessary for the courts to assess the similarity between two signs *Golden Balls* and *Ballon D'Or*. *Intra-Press*, a French company, had a EUTM registration for *BALLON D'OR*. *Golden Balls Ltd* sought registration for *GOLDEN BALLS* for a wide variety of goods identical and similar to those for which *BALLON D'OR* had already been registered. The case reached the General Court, which found for the applicant in those proceedings, *Golden Balls Ltd*, and the decision was endorsed by the CJEU. The General Court held, *inter alia*, that the average consumer, including the average Francophone consumer who would generally have a weak understanding of English,

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<sup>49</sup> *Intra-Press SAS v OHIM, Golden Balls Ltd* [2015] ETMR 6.

would not see the marks as meaning the same thing. Furthermore, the clear difference between the linguistic origins of the two marks would make any immediate discovery of a shared hidden meaning for the signs more difficult, both for Francophone and Anglophone consumers with an average level of attention. Finally, the General Court held that, in any event, it was improbable that the result arrived at through an analysis of the translation would spontaneously enter the head of the average consumer concerned, contemplating a simple purchase of everyday consumer goods. The decision was reached without taking into account any empirical evidence at all about, for example, the level of understanding of either Francophone or Anglophone consumers. Nor did the General Board require advice from an expert translator.

The approach of the EU courts in the “Golden Balls” case emphasises once again that, despite the frequently high financial stakes which result from corporate investment in branding, there is an eminently practical reason for adopting a notion such as the average consumer and limiting the kind and scale of evidence submitted, much as in the past judges were willing to rely on their own “common sense”. Practical and procedural considerations should accordingly be incorporated into future interdisciplinary thinking, alongside recognition that trade mark lawyers have a strong motivation to explore the complex language issues raised in trade mark law and are likely to be as highly adept in doing so as linguists.

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