

# The False Dichotomy Between Suggestive and Descriptive Trademarks

JAKE LINFORD\*

*Classifying a trademark as descriptive rather than suggestive fundamentally alters the scope of trademark protection. A descriptive mark, derived from a feature of the product or service sold, only qualifies for protection after the mark has acquired source significance, i.e., consumers see it as a trademark. A suggestive trademark, which indirectly invokes qualities of the product or service, is protected without evidence of source significance. Courts often struggle to distinguish between suggestive and descriptive marks. The effort would nevertheless be reasonable if the differences between suggestive and descriptive marks justified their disparate legal treatment. But in light of cognitive and historical research into language change, protecting a suggestive mark without evidence of source significance may not be warranted.*

*In fact, trademark law erroneously inflates the difference between suggestive and descriptive marks. This mistake becomes apparent in light of theoretical, historical, and cognitive research into “semantic shift”: the process by which words gain and lose meaning over time. Linguistic analysis reveals an inconsistency between how trademark doctrine treats suggestive and descriptive trademarks and how consumers likely process them. Suggestive and descriptive marks are not so dissimilar as to justify different treatment. Instead, they likely influence consumers in similar ways. As a result, trademark law should reposition the line between descriptive and suggestive trademarks. A suggestive mark, like a descriptive mark, should be protected only upon a showing that the mark has developed source significance in the minds of consumers.*

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\* Assistant Professor, Florida State University College of Law. My thanks to Jonas Anderson, Sarah Burstein, Francie Crebs, Laura Heymann, Jay Kesten, Irina Manta, Goldburn Maynard, Mark McKenna, Joseph Miller, Seth Oranberg, Janewa OseiTutu, Jason Rantanen, Andres Sawicki, Mark Seidenfeld, Mark Spottswood, Franita Tolson, Rebecca Tushnet, Hannah Wiseman, Sam Wiseman, Mary Ziegler, and participants at the 17th Annual Federalist Society Faculty Conference and workshops at Florida State University and the University of Chicago. Thanks as well to Gaelan Jones, Evan Liebovitz, and Luis Then for excellent research assistance. For inquiries, or to offer comments or feedback—which are always welcome—please contact me at [jlinford@law.fsu.edu](mailto:jlinford@law.fsu.edu).

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## I. INTRODUCTION

In trademark law, much depends on the relationship between the word chosen as a trademark and the product sold under the mark.<sup>1</sup> A firm might choose a mark derived from a quality or feature of the product sold—like SEALTIGHT for fasteners.<sup>2</sup> The firm cannot acquire protection in this “descriptive” mark unless it can provide evidence that consumers see the word as a source signifier which tells them this product with this name comes from a single source.<sup>3</sup>

A firm might instead choose a “suggestive” mark that indirectly invokes a quality or feature of the product sold—like GLEEM for toothpaste.<sup>4</sup> The firm can acquire protection in the suggestive mark upon the first use of the mark in commerce, whether or not the firm has evidence that consumers see the word as a trademark.<sup>5</sup> A suggestive mark is protected upon first use without evidence of

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<sup>1</sup> See, e.g., Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J.L. & TECH. 110, 113 (2015) [hereinafter Linford, “*Generic*” Trademarks].

<sup>2</sup> *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 252 F.3d 1010, 1012 (8th Cir. 2001).

<sup>3</sup> A trademark is distinctive or source signifying and thus protectable if consumers are likely to perceive that it “identifies goods or services produced or sponsored by a particular person.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(a) (AM. LAW INST. 1995). The person or firm may be unknown to the consumer. Suggestive marks are treated as inherently distinctive upon first use, *id.*, but descriptive marks must show that the mark has become distinctive, or acquired “secondary meaning” in the eyes of consumers, *id.* § 13(b). Even if the firm proves its descriptive mark has acquired trademark meaning, courts still presume the mark is weak. See, e.g., *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 974 (11th Cir. 1983) (“A descriptive mark . . . is considered weak and is given a ‘narrow range of protection.’” (quoting 1 J.T. MCCARTHY, TRADEMARKS & UNFAIR COMPETITION § 11:24, at 398 (1973))).

<sup>4</sup> See *B & B Hardware*, 252 F.3d at 1012; Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 771 (1990).

<sup>5</sup> See, e.g., *John H. Harland*, 711 F.2d at 974 (“[A] suggestive mark can be protected without evidence that it has acquired secondary meaning . . . .”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(a).

source significance because such a mark is presumed to be “inherently distinctive,”<sup>6</sup> i.e., innately capable of representing the source of a product.<sup>7</sup>

The distinction between suggestive and descriptive can shape the outcome of trademark litigation,<sup>8</sup> but distinguishing suggestive from descriptive marks is often difficult. Courts and scholars describe the suggestive–descriptive line as “nearly incapable of precise description”;<sup>9</sup> “not always clear”;<sup>10</sup> “shadowy”;<sup>11</sup> “murky”;<sup>12</sup> “wholly lacking . . . in distinctiveness”;<sup>13</sup> “difficult . . . to draw”;<sup>14</sup> “frequently difficult to apply”;<sup>15</sup> uncertain and impossible to extrapolate from precedent;<sup>16</sup> and “almost impossible to define in the abstract.”<sup>17</sup> Frequently, classifying a mark as either suggestive or descriptive is a decision “made on an intuitive basis rather than as the result of a logical analysis susceptible of

<sup>6</sup> See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (stating that “because their intrinsic nature serves to identify a particular source of a product, [suggestive marks] are deemed inherently distinctive and are entitled to protection” without evidence of source significance). Some courts also presume that a suggestive mark is strong. See, e.g., *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1131 (9th Cir. 1998) (concluding that the suggestive mark of the smaller junior user was inherently distinctive and thus deserved “broad protection”); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) (stating that suggestive marks are also considered “strong” as well as “presumptively valid” (quoting *Del Labs., Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 780 (S.D.N.Y.1981))). But see *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 385 (2d Cir. 2005) (“In the absence of any showing of secondary meaning, suggestive marks are at best moderately strong.”); *John H. Harland*, 711 F.2d at 974 (“[A]lthough a suggestive mark can be protected without evidence that it has acquired secondary meaning, [it] is comparatively weak.” (footnote omitted)).

<sup>7</sup> Throughout the text, when I say product, I mean good(s) or service(s), but use product (singular) to simplify.

<sup>8</sup> See, e.g., *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1040 (2d Cir. 1992); see also *infra* notes 56–79 and accompanying text.

<sup>9</sup> *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1033 (9th Cir. 2010); see also *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (“These categories, like the tones in a spectrum, tend to blur at the edges and merge together. The labels are more advisory than definitional, more like guidelines than pigeonholes.”); *infra* notes 10–18 and accompanying text.

<sup>10</sup> *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979).

<sup>11</sup> Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1188 (1948).

<sup>12</sup> Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471, 519 (1997) [hereinafter Dinwoodie, *Inherent Distinctiveness*].

<sup>13</sup> Jerre B. Swann, Sr., *Dilution Redefined for the Year 2002*, 92 TRADEMARK REP. 585, 597 n.95 (2002).

<sup>14</sup> Carter, *supra* note 4, at 771.

<sup>15</sup> *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980).

<sup>16</sup> *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979), *abrogated on other grounds by* *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003).

<sup>17</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:64 (4th ed. 2008).

articulation.”<sup>18</sup> The inquiry would nevertheless be worth the trouble if it was clear that the differences between suggestive and descriptive marks justify the disparate results we see in the law. In other words, the suggestive–descriptive line is justifiable if consumers are in fact likely to perceive a suggestive mark as inherently source signifying.

The creation of trademark meaning often involves adding a new sense to an existing word. Most word marks, including suggestive and descriptive marks, appropriate pre-existing words to bear source-signifying meaning.<sup>19</sup> Trademark law denies protection to descriptive marks without evidence of source significance because the mark is derived from a feature of the product and thus is presumed unlikely to stand out as a trademark.<sup>20</sup> On the other hand, trademark doctrine presumes that consumers see suggestive marks as inherently distinctive because there is a weak connection between the mark selected and the product sold.<sup>21</sup> The law presumes this weak connection leaves consumers with no choice but to make an “imaginative leap” to connect the mark with the designated product.<sup>22</sup> But there is evidence that the connection between a suggestive mark and the product sold are closer than the law recognizes. This Article marshals etymological,<sup>23</sup> theoretical, and cognitive literatures on semantic shift—the way words add and lose meaning over time<sup>24</sup>—to argue that a suggestive mark is much more like a descriptive mark than the law currently recognizes. The suggestive–descriptive distinction is thus illusory at best.

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<sup>18</sup> *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976).

<sup>19</sup> See *infra* notes 42–55 and accompanying text.

<sup>20</sup> U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(a) (July 2015) [hereinafter TMEP] (“Suggestive marks . . . when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. . . . [A] descriptive term . . . immediately tells something about the goods or services.”).

<sup>21</sup> *Id.*

<sup>22</sup> See, e.g., *Bihari v. Gross*, 119 F. Supp. 2d 309, 317–18 (S.D.N.Y. 2000) (holding that BIHARI INTERIORS is suggestive rather than descriptive because consumers are required to make “an imaginative leap” to correctly identify plaintiff’s interior design services); see also, e.g., *Am. Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106 (2d Cir. 1978) (holding ROACH MOTEL for insect traps at least suggestive, if not arbitrary, because of the incongruity between the concept of a motel, where guests are welcomed, and what type of motel might be built for roaches, who are usually unwelcome guests); *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (“A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”).

<sup>23</sup> *Etymology*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/64893> [<http://perma.cc/X8JZ-VE4V>] (“The facts relating to the origin of a particular word or the historical development of its form and meaning; the origin of a particular word.”).

<sup>24</sup> While this Article uses the term semantic shift, other scholars refer to these phenomena as semantic change, semantic progression, or semantic drift. See, e.g., ELIZABETH CLOSS TRAUOGOTT & RICHARD B. DASHER, REGULARITY IN SEMANTIC CHANGE 1 (2002).

The semantic shift literature indicates that the law may systematically overestimate the ability of a suggestive mark to clearly communicate that it serves as a trademark while simultaneously underestimating the processing advantages provided to a firm that selects a suggestive mark. Semantic shift research explains how words with multiple related meanings confer processing advantages that make it easier for readers and listeners to slide from one meaning to another. Readers and listeners process words with multiple related meanings more quickly and more efficiently than words with multiple unrelated meanings, or with only a single meaning. Whether the relationship between two words is metonymic (where a feature of a thing is used as the name of the thing, like “Green Beret” for members of the U.S. Army Special Forces)<sup>25</sup> or metaphoric (where one thing stands in for another with similar qualities, like “lip” for the edge of a cup),<sup>26</sup> the relationship is “cognitively efficient,” helping the reader resolve ambiguity by channeling the reader’s cognitive processes from one connected meaning to another.<sup>27</sup> Language change tends to follow this cognitively efficient route.<sup>28</sup> The metaphoric connection between a suggestive mark and the product offered may thus benefit from similar processing advantages as the metonymic connection between a descriptive mark and its associated product.<sup>29</sup> A suggestive mark is thus less likely to stand out as a source signifier than the law presumes. In light of these findings, this Article argues that the current line between suggestive and descriptive marks is incorrectly drawn.

This Article proceeds in three Parts. Part II describes the current approach to categorizing suggestive and descriptive marks, most famously summarized in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>30</sup> The *Abercrombie* spectrum is often criticized, but the standard critiques are unsatisfying. Those critiques fail to recognize how initial consumer perception of the connection between different meanings of a word shapes how trademark meaning is accessed,

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<sup>25</sup> See, e.g., René Dirven, *Metaphor As a Basic Means for Extending the Lexicon*, in THE UBIQUITY OF METAPHOR: METAPHOR IN LANGUAGE AND THOUGHT 85, 97 (Wolf Paprotté & René Dirven eds., 1985).

<sup>26</sup> Ekaterini Klepousniotou, *Reconciling Linguistics and Psycholinguistics: On the Psychological Reality of Linguistic Polysemy*, in THE COGNITIVE BASIS OF POLYSEMY: NEW SOURCES OF EVIDENCE FOR THEORIES OF WORD MEANING 17, 27 (Marina Rakova et al. eds., 2007) [hereinafter Klepousniotou, *Reconciling*].

<sup>27</sup> See *infra* Part III.C.

<sup>28</sup> See *infra* Part III.B.

<sup>29</sup> A metonymic relationship is one where a feature of a thing is used for the name of the thing, like SEALTIGHT as a trademark for fasteners, based on a quality one would expect a fastener to have. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 252 F.3d 1010, 1012 (8th Cir. 2001). Suggestive marks are instead metaphorically related to the good or service sold, like using GLEEM to sell toothpaste indirectly invokes the bright, shiny quality one could expect from thoroughly cleaned teeth. *PaperCutter, Inc. v. Fay’s Drug Co.*, 900 F.2d 558, 563 (2d Cir. 1990) (quoting Carter, *supra* note 4, at 771). These relationships are discussed more fully in Part IV, *infra*.

<sup>30</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976).

processed, and understood. To fill this gap, this Article looks to semantic shift research to understand how the connection between words cabins the communicative capacity of a mark and sets a baseline for the development of source significance. This Article is the first to apply semantic shift research to analyze how the perceived connection between descriptive, suggestive, and arbitrary marks and the products associated with those marks can shape consumer perception.<sup>31</sup> Part III offers an abbreviated account of research into semantic shift and provides background for the subsequent critique of the false dichotomy between suggestive and descriptive trademarks. Part IV applies those linguistic accounts to provide a limited defense of the *Abercrombie* spectrum, and to critique the suggestive–descriptive line in trademark law. In many respects, the *Abercrombie* spectrum properly sorts trademarks to reflect processing advantages identified in the semantic shift literature. But the legal distinction between suggestive and descriptive marks ignores the similarities between metonymic and metaphoric polysemy. Both descriptive and suggestive marks have a polysemous relationship with the good or service sold. Both marks thus provide processing advantages that reduce cognitive workload compared to other categories of trademarks. In light of this insight, the stark divide between suggestive and descriptive trademarks is not justified. The inherent distinctiveness line in trademark law should be redrawn, and a suggestive mark

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<sup>31</sup> See also generally Linford, “Generic” Trademarks, *supra* note 1. Linguistics—the study of symbols and their meanings—has made limited inroads in the analysis of trademark law and policy, but in subfields other than semantic shift. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 624 (2004) (applying a branch of linguistics, semiotics, or the study of signs, to trademark law and arguing that the “grammar [of trademark law] must be understood not simply in economic, but also in linguistic terms”); Graeme B. Dinwoodie, *What Linguistics Can Do for Trademark Law*, in TRADE MARKS AND BRANDS 140, 157 (Lionel Bently et al. eds., 2008) (arguing that while trademark law should not become beholden to linguistics, linguistic principles are embedded in trademark law, and linguistic theory can provide a means for uncovering “the inevitably prescriptive content of supposedly descriptive assessments of trademark claims”); Alan Durant, ‘How Can I Tell the Trade Mark on a Piece of Gingerbread from All the Other Marks on It?’ Naming and Meaning in Verbal Trade Mark Signs, in TRADE MARKS AND BRANDS, *supra*, at 107, 132 (suggesting that pragmatics and discourse analysis, the “branches of linguistics that investigate language in use,” are most likely to contribute to our understanding of the important issues in trademark law); Timothy Greene, *Trademark Hybridity and Brand Protection*, 46 LOY. U. CHI. L.J. 75, 77 (2014) (analyzing trademark dilution and genericness in light of psycholinguistics literature on semantic ambiguity resolution); Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1320–21 (2010) (arguing that incorporating linguistic theory on language formation can help trademark law better reflect consumers’ perceptions of language); Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1068–69 (2009) (applying psychological and brand perception literature to challenge Beebe’s semiotic analysis); Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007) (applying semiotic theory to argue for reforming the scandalous marks prohibition in trademark law).

should be protected only if the mark owner can provide evidence of source significance.

## II. THE CAPRICIOUS SUGGESTIVE–DESCRIPTIVE DICHOTOMY

This Article presumes, without deciding, that the dominant economic justification provides a proper normative basis for trademark law.<sup>32</sup> Under the economic rationale, the law protects a trademark as a unique source identifier so that consumers can more easily find a product from their preferred source.<sup>33</sup> Protecting a trademark from infringement reduces consumer search costs to the extent it prevents competitors from adopting a mark that would confuse consumers about the source of the competitor's product.

The economic justification also ostensibly provides the normative basis for the suggestive–descriptive line. Under the economic rationale, a trademark is protected because—and protectable to the extent that—the mark is “distinct from the product it brands and . . . [also] conveys information about that separate product.”<sup>34</sup> Trademark law divides word marks into two groups<sup>35</sup>: those that are inherently distinctive (including suggestive marks), and those that are not (including descriptive marks).<sup>36</sup> Suggestive marks are presumed inherently distinctive, protectable from first use in commerce, and often treated as inherently strong. On the other hand, descriptive marks are not protectable unless the mark owner can provide evidence of source significance or secondary meaning, and even then are presumed to be weaker than other trademarks.

Trademark theory assumes that a descriptive term fails, on first use, to distinguish itself from the product it brands because of the relatively

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<sup>32</sup> Trademark law embraces at least two categories of normative justifications that are somewhat in tension with one another: economic justifications that focus primarily on reducing consumer search costs; and moral justifications that include preventing injury to or misappropriation of mark owner goodwill and deception of consumers. For a description of the tension between these normative bases for trademark protection, see, for example, Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”*: *Toward a More Sensible Approach to Trademark Infringement*, 106 NW. U. L. REV. 1307, 1311–12, 1335, 1350 (2012) [hereinafter Bone, *Taking*].

<sup>33</sup> See, e.g., Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 778 (2004) (arguing that the historical normative goal of trademark law is to foster the flow of information in markets, thereby reducing search costs for consumers). *But see* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1840–41 (2007) (noting that while the dominant view is that “trademark law’s core policies [are] protecting consumers and improving the quality of information in the marketplace,” a historical examination of early trademark cases instead reveals that courts embraced a natural rights theory of trademark property, protecting mark owners from suffering diversion of consumers).

<sup>34</sup> Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 187, 190 (2007).

<sup>35</sup> This Article limits its analysis to word marks and does not consider the scope of protection for non-word trademarks like colors, images, or trade dress.

<sup>36</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(a) (AM. LAW INST. 1995).



straightforward connection between the mark and the good sold. Furthermore, selecting a descriptive mark may provide the mark owner with a troubling advantage over competitors. The mark owner may use the descriptive mark to prevent competitors from effectively communicating with consumers, essentially “free riding” on the connection between the product and the mark. Thus a mark owner cannot secure protection in a descriptive mark unless there is evidence that the mark has acquired source significance in the eyes of consumers.

On the other hand, because consumers must make what courts call “an imaginative leap” to connect the suggestive mark and the product sold,<sup>37</sup> trademark doctrine presumes a suggestive mark is inherently distinctive. The law assumes that the metaphoric connection between a suggestive mark and the product offered is too attenuated to confer processing power. Thus, the law presumes a suggestive mark is likely to stand out to consumers as a trademark, and that consumers will treat it as such.

The line between the two categories is difficult to draw, but some courts and commentators simplify the inquiry to questions of competitive necessity and the potential harm of language depletion. As this Part explains, those issues cannot be understood without recognizing what and how the mark communicates with consumers, and how consumers process the information that the mark attempts to convey.

#### A. *Trademark Protection Along the Abercrombie Spectrum*

Trademark law protects the exclusive use of a word only to the extent that the word signifies a singular source for a product. The rules for how easily a word can acquire protection as a trademark are based in large part on the relationship between the word chosen as a trademark and the product sold under that mark.<sup>38</sup> In *Abercrombie & Fitch Co. v. Hunting World, Inc.*, Judge Friendly articulated a widely adopted spectrum that described the capability of a given mark to acquire source significance, and thus trademark protection.<sup>39</sup> As the court stated in *Abercrombie*, the more inherently distinctive a mark, the more readily it can bear source significance, and the easier it is for the hopeful mark owner to acquire protection.<sup>40</sup> The following table summarizes the current state of the law.

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<sup>37</sup> See *Bihari v. Gross*, 119 F. Supp. 2d 309, 317–18 (S.D.N.Y. 2000).

<sup>38</sup> *Potomac Conference Corp. of Seventh-Day Adventists v. Takoma Acad. Alumni Ass’n, Inc.*, Civ. Action No. DKC 13-1128, 2014 WL 857947, at \*8 (D. Md. Mar. 4, 2014) (“Whether an unregistered mark is protected under federal law depends upon its classification—either as ‘generic,’ ‘descriptive,’ ‘suggestive,’ or ‘arbitrary/fanciful.’” (citing *U.S. Search, LLC v. U.S. Search.com, Inc.*, 300 F.3d 517, 523 (4th Cir. 2002))).

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

<sup>40</sup> *Id.*

Table 1: *Presumed Protectability and Strength Based on Position Along Abercrombie Spectrum*

<i>Abercrombie</i> Category (relationship between mark and product)	Protectability	Inherent Strength
<u>Fanciful mark:</u> Coined for use as a trademark, not derived from a pre-existing word <i>Ex.</i> : XEROX for photocopiers	Inherently protectable on first use	Presumed strong
<u>Arbitrary mark:</u> Derived from a pre-existing word that has no connection with the product <i>Ex.</i> : APPLE for computers		
<u>Suggestive mark:</u> Pre-existing word with some connection to the product, via an imaginative leap <i>Ex.</i> : SKINVISIBLE for transparent adhesive bandages; GLEEM for toothpaste		Varies—some courts presume suggestive marks are weaker than arbitrary / fanciful marks
<u>Descriptive mark:</u> Pre-existing term with a clear connection to the product sold, via a direct description of a product feature <i>Ex.</i> : SEALTIGHT for fasteners	Protectable only with evidence of source significance	Presumed weak
<u><i>Ex ante</i> generic mark:</u> Word whose meaning has shifted from a class of products, to one particular brand <i>Ex.</i> : HOG for Harley Davidson motorcycles denied protection, despite evidence of source significance, on grounds of trademark incapacity	Unprotectable, even with evidence of source significance	Not considered

Marks that are inherently distinctive qualify for protection without proof of source significance or secondary meaning.<sup>41</sup> As described along the *Abercrombie* spectrum, the strongest marks have no inherent relationship to the product sold. A fanciful mark is a made-up word, like XEROX for photocopiers. An arbitrary mark is derived from a pre-existing but unrelated word, like APPLE for computers. Both fanciful and arbitrary marks are considered strong and protected from the first use in commerce.<sup>42</sup>

Like arbitrary and fanciful marks, suggestive marks are treated as presumptively valid, and thus protectable without evidence of secondary meaning.<sup>43</sup> The first use of an inherently distinctive mark is treated as source signifying on the theory that consumers who see a word that doesn't describe the product will presume the word was meant to serve as a trademark and treat it like one.<sup>44</sup> As articulated in *Abercrombie*, a suggestive mark is treated as inherently distinctive because it hints at the quality or characteristic of the good without actually describing it.<sup>45</sup> A suggestive mark does not directly identify a feature of the product in question, but the suggestive mark "requires the consumer to exercise his imagination to reach a conclusion as to the nature of the[] goods [offered]."<sup>46</sup>

Unlike the aforementioned marks, descriptive terms more directly refer to a quality or characteristic of the product with which the mark is associated.<sup>47</sup> For example, a term like SEALTIGHT for fasteners describes qualities that a fastener would likely have, and the claimed mark is treated as directly related to the product designated. Due in part to an underlying suspicion that control of descriptive terms would make it more costly for competitors to enter the

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<sup>41</sup> See, e.g., *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984).

<sup>42</sup> See also *infra* Part IV.A.1–2.

<sup>43</sup> Some courts treat suggestive marks as inherently distinctive but also weaker than arbitrary or fanciful marks. Compare *M2 Software, Inc. v. Madacy Entm't*, 421 F.3d 1073, 1081 (9th Cir. 2005) (stating that suggestive marks, like descriptive marks, are "conceptually weak"), with *Pizzeria Uno*, 747 F.2d at 1527 (stating that suggestive marks are also considered "strong" as well as "presumptively valid" (quoting *Del Labs., Inc. v. Alleghany Pharmacal Corp.*, 516 F. Supp. 777, 780 (S.D.N.Y.1981))).

<sup>44</sup> Bone, *Taking*, *supra* note 32, at 1313 (citing *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000)).

<sup>45</sup> Suggestive marks were also a late addition to trademark law. See *Abercrombie*, 537 F.2d at 10 ("The category of 'suggestive' marks was spawned by the felt need to accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other . . .").

<sup>46</sup> *Synergistic Int'l, LLC v. Korman*, 470 F.3d 162, 171 (4th Cir. 2006) (quoting *Pizzeria Uno*, 747 F.2d at 1528); see also TMEP, *supra* note 20, § 1209.01(a) ("Suggestive marks . . . when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. . . . [A] descriptive term . . . immediately tells something about the goods or services.").

<sup>47</sup> Thomas McCarthy has described the difference between descriptive and suggestive marks as "no more objective and free of personal predilections than a test which asks persons to divide all color shades into 'light' and 'dark.'" MCCARTHY, *supra* note 17, § 11:71.

market,<sup>48</sup> a descriptive term is not considered inherently distinctive, and will not be protected unless the mark owner establishes that the term has acquired source significance or secondary meaning.<sup>49</sup>

A descriptive mark acquires source significance when it becomes sufficiently distinctive to establish “a *mental association* in buyers’ minds between the alleged mark and a single source of the product.”<sup>50</sup> Without proof of source significance, a descriptive trademark does not merit protection, and a court will not inquire whether an alleged infringer’s use of a similar mark on similar products is likely to confuse consumers.<sup>51</sup> To determine whether a mark has acquired source significance, courts and examiners look for evidence that the mark has come to represent the source of the product.<sup>52</sup> While it can be difficult to establish source significance, it is not impossible. For example, COCA-COLA has been frequently cited as the “paradigm of a descriptive mark that has acquired a secondary meaning.”<sup>53</sup>

Finally, a generic term is not protectable, even if it acquires secondary meaning.<sup>54</sup> Courts and scholars presume that any word that has once served as the name of a product may not function as a source signifying mark for that category of product. Under this doctrine of trademark incapacity, also known as the doctrine of de facto secondary meaning, trademark protection is denied even

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<sup>48</sup>Stephanie M. Greene, *Sorting Out “Fair Use” and “Likelihood of Confusion” in Trademark Law*, 43 AM. BUS. L.J. 43, 70–72 (2006) (arguing that allowing a monopoly of a descriptive term creates a barrier to entry because a potential competitor cannot use the descriptive term and therefore must expend more effort to communicate with and attract consumers).

<sup>49</sup>*See, e.g.*, *Larsen v. Terk Techs. Corp.*, 151 F.3d 140, 148 (4th Cir. 1998).

<sup>50</sup>MCCARTHY, *supra* note 17, § 15:5; *see also* *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996) (explaining that “secondary meaning” exists when, “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself” (quoting *Dayton Progress Corp. v. Lane Punch Corp.*, 917 F.2d 836, 839 (4th Cir. 1990))); *Wolf Appliance, Inc. v. Viking Range Corp.*, 686 F. Supp. 2d 878, 887 (W.D. Wis. 2010) (“Secondary meaning arises when a mark ‘has been used so long and so exclusively by one company in association with its goods or services that the word or phrase has come to mean that those goods or services are the company’s trademark.” (quoting *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 641 (7th Cir. 2001))).

<sup>51</sup>*See, e.g.*, *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 392 (7th Cir. 1992).

<sup>52</sup>*Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938). Relevant evidence of secondary meaning will include complaints by actual customers; surveys by relevant potential consumers; advertising expenditures; sales volume; and length of use. *See* Jake Linford, *Trademark Owner As Adverse Possessor: Productive Use and Property Acquisition*, 63 CASE W. RES. L. REV. 703, 728 (2013) [hereinafter Linford, *Adverse Possessor*]. One can ask consumers about cola, and they will inevitably recognize Coca-Cola as a distinctive brand, or one can look to sales and advertising, and Coca-Cola’s duration in the marketplace as proxies for consumer perception.

<sup>53</sup>*Larsen*, 151 F.3d at 148 n.7.

<sup>54</sup>*Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

when a mark owner presents otherwise overwhelming evidence that consumers see the term predominantly as a trademark.<sup>55</sup>

The inquiry into protectability is context sensitive. A word or phrase can be generic for one line of products, descriptive for a second, suggestive for a third, and arbitrary for a fourth. For example, as one court noted, “HONEY BROWN is generic in the context of ale beers, possibly descriptive in the context of lager beers, or wood stains, and probably suggestive or arbitrary in the context of grilling products, internet service providers, musical instruments, or paper products.”<sup>56</sup>

### B. *The High Stakes of the Suggestive–Descriptive Line*

Significant consequences turn on the suggestive–descriptive determination. Owners whose marks are designated as descriptive face hurdles acquiring a use-based registration and an uphill battle enforcing their marks against alleged infringers. Suggestive marks, however, qualify for registration without evidence of secondary meaning and are often presumed not only inherently distinctive but inherently strong. As this Section highlights, the consequences are drastic for an inquiry that turns on such exceedingly fine distinctions.

Failing to present evidence of secondary meaning is of no consequence for a suggestive mark, but results in loss or denial of protection for a descriptive mark. For example, in *American Express Marketing & Development Corp. v. Black Card LLC*, American Express challenged Black Card LLC’s registration of BLACKCARD for credit and debit card services on descriptiveness grounds.<sup>57</sup> The court was persuaded that BLACKCARD was descriptive of a premium grade of credit card.<sup>58</sup> Thus, when Black Card LLC presented no evidence of secondary meaning, the court ordered the cancellation of Black Card LLC’s registration.<sup>59</sup>

Other trademark doctrines also turn in large part on the suggestive–descriptive divide. For example, some mark owners claim a family of marks, like McDonald’s Corporation’s MC- family of marks for restaurant food items.<sup>60</sup> Scholars have argued that descriptive terms cannot constitute the common

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<sup>55</sup> *But see generally* Linford, “Generic” Trademarks, *supra* note 1 (applying theories of semantic shift to argue that generic terms should be allowed to obtain trademark protection when there is sufficient evidence that consumers primarily perceive the term as a trademark).

<sup>56</sup> *Real News Project, Inc. v. Indep. World Television, Inc.*, 88 U.S.P.Q.2d (BNA) 1299, 1306 (S.D.N.Y. 2008) (citation omitted).

<sup>57</sup> *Am. Express Mktg. & Dev. Corp. v. Black Card LLC*, 106 U.S.P.Q.2d (BNA) 1926, 1927 (S.D.N.Y. 2011). The USPTO’s electronic search system reports that the BLACKCARD mark was assigned to American Express. BLACKCARD, Registration No. 78717042.

<sup>58</sup> *Am. Express*, 106 U.S.P.Q.2d at 1933.

<sup>59</sup> *Id.* at 1934.

<sup>60</sup> *See, e.g., J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991) (holding that a formative like “Mc” need not operate as a trademark in order for protection to extend to a family of marks).

element of a family of marks.<sup>61</sup> Other authorities have instead held that a descriptive term can serve as the common element only when there is a strong showing of secondary meaning.<sup>62</sup> For instance, in *Spraying Systems Co. v. Delavan, Inc.*, plaintiff Spraying Systems sold a series of spray nozzle products under a family of -JET marks, like TEEJET, AIRJET, and FOAMJET.<sup>63</sup> The court in *Spraying Systems* concluded the -JET suffix was descriptive, rather than inherently distinctive, and rejected the plaintiff's claims due to failure to establish secondary meaning.<sup>64</sup> Spraying Systems protested that in *J & J Snack Foods Corp. v. McDonald's Corp.*, McDonald's Corp. had successfully defended its MC- family of marks without evidence of secondary meaning.<sup>65</sup> The court in *Spraying Systems* distinguished *J & J Snack Foods* on the ground that MC- was "inherently distinctive," unlike -JET, and evidence of secondary meaning was therefore not required.<sup>66</sup>

Other mark owners receive outsized benefit from a suggestiveness determination. For example, in *Innovation Ventures, LLC v. N.V.E., Inc.*, the court considered whether the mark 5-HOUR ENERGY for an "energy shot" was descriptive or suggestive.<sup>67</sup> Living Essentials, the mark owner's predecessor in interest, began marketing 5-HOUR ENERGY in 2005, shortly after the PTO rejected its trademark application on descriptiveness grounds.<sup>68</sup> In March 2006, N.V.E. entered the energy shot market with 6 HOUR POWER.<sup>69</sup> The district court granted N.V.E.'s motion for summary judgment on Living Essential's claim of trademark infringement,<sup>70</sup> finding no likelihood of confusion between the products. As part of its analysis, the district court concluded 5-HOUR ENERGY was a weak, descriptive mark,<sup>71</sup> which was, from the court's perspective, "[p]ivotal" in its determination that there was no genuine issue of material fact regarding likelihood of confusion.<sup>72</sup>

On appeal, N.V.E. argued that Living Essentials failed to establish secondary meaning in the 5-HOUR ENERGY mark prior to N.V.E.'s first use of

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<sup>61</sup> See, e.g., David J. Kera, *Tips from the TTAB: Family of Marks*, 67 TRADEMARK REP. 419, 420 (1977). Some authorities have articulated a similar rule. See, e.g., *Cambridge Filter Corp. v. Servodyne Corp.*, 189 U.S.P.Q. (BNA) 99, 103 (T.T.A.B. 1975).

<sup>62</sup> See, e.g., *Norwich Pharmacal Co. v. Salsbury Labs.*, 168 U.S.P.Q. (BNA) 250, 255 (T.T.A.B. 1970).

<sup>63</sup> *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 389 (7th Cir. 1992).

<sup>64</sup> *Id.* at 396.

<sup>65</sup> *J & J Snack Foods*, 932 F.2d at 1463.

<sup>66</sup> *Spraying Sys.*, 975 F.2d at 395.

<sup>67</sup> *Innovation Ventures, LLC v. N.V.E., Inc.*, 694 F.3d 723, 727 (6th Cir. 2012).

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.* at 728.

<sup>71</sup> *Id.* at 729 ("[G]iven the descriptive nature of Plaintiff's mark, i.e., that it provides users with five hours of energy, the mark itself has little strength." (emphasis omitted) (quoting the district court opinion, 747 F. Supp. 2d 853, 868 (E.D. Mich. 2010))).

<sup>72</sup> *Id.* at 731 (quoting 747 F. Supp. 2d at 871).

the 6 HOUR POWER mark.<sup>73</sup> If 5-HOUR ENERGY were descriptive, and if Living Essentials could not establish secondary meaning, it could not prevail in a claim that N.V.E.'s use of 6 HOUR POWER was likely to confuse consumers.<sup>74</sup> Instead, the court of appeals applied de novo review and concluded that 5-HOUR ENERGY was suggestive. In reaching that conclusion, the court noted that 5-HOUR ENERGY was suggestive because both the method of energy transference and the type of energy transferred were potentially ambiguous.<sup>75</sup> Reasonable minds might disagree with the court's determination, but even if the court was straining to find that consumers must use "imagination and perception to determine the nature of the goods,"<sup>76</sup> the holding left Living Essentials well-placed to proceed against N.V.E.

Likewise, in *Menashe v. V Secret Catalogue, Inc.*, a publicist and a fashion model sought a declaratory judgment that their use of SEXY LITTLE THING and SEXY LITTLE THINGS as a mark for lingerie was non-infringing.<sup>77</sup> Victoria's Secret had used SEXY LITTLE THINGS as a mark for lingerie prior to the declaratory plaintiffs' attempt to secure their own intent-to-use application.<sup>78</sup> But the plaintiffs claimed that SEXY LITTLE THINGS was descriptive for lingerie and that Victoria's Secret had not acquired secondary meaning prior to plaintiffs' first use.<sup>79</sup> The court instead concluded that because SEXY LITTLE THINGS was suggestive of Victoria's Secret's lingerie line, it could establish priority without an inquiry into secondary meaning.<sup>80</sup> Given the short window between the parties' entrance into the market, evidence of secondary meaning might have been difficult to establish. Victoria's Secret's priority win thus turned on the distinctiveness determination.

Courts have also noted, in disputes over whether alleged infringement will confuse consumers, that if a mark is suggestive "there is a stronger likelihood that a jury could reasonably conclude that the 'strength of the mark' factor" in the test for likelihood of confusion favors the mark owner.<sup>81</sup> For example, in *Wallach v. Longevity Network*,<sup>82</sup> the court gave little weight to survey evidence that a petitioner's mark had not acquired secondary meaning,<sup>83</sup> concluding that

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<sup>73</sup> *Innovation Ventures*, 694 F.3d at 728–29.

<sup>74</sup> *Id.* at 729 (citing *Burke–Parsons–Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 595–96 (6th Cir. 1989)).

<sup>75</sup> *Id.* at 730 (proposing that energy transference might occur through injections, pills, or exercise, and the energy transferred could be electrical or nuclear).

<sup>76</sup> *Id.* (quoting *Induct-O-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 362 (6th Cir. 1984)).

<sup>77</sup> *Menashe v. V Secret Catalogue, Inc.*, 409 F. Supp. 2d 412, 415 (S.D.N.Y. 2006).

<sup>78</sup> *Id.* at 417.

<sup>79</sup> *Id.* at 422.

<sup>80</sup> *Id.* at 425.

<sup>81</sup> *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1034 (9th Cir. 2010); *see also supra* note 43.

<sup>82</sup> *Wallach v. Longevity Network, Ltd.*, No. CV 04-2404 SJO (RZx), 2005 WL 5958091, at \*1 (C.D. Cal. Sept. 1, 2005).

<sup>83</sup> *Id.* at \*13.

petitioner's mark LONGEVITY for nutritional supplements was both incontestable and suggestive. The mark's incontestable status insulated it from a challenge based on descriptiveness, although the reach of the mark could still be limited if it were deemed weak.<sup>84</sup> But the court concluded the suggestiveness of the mark itself was evidence that the mark was not weak.<sup>85</sup>

Any observer of trademark law can find cases where they believe a court made a poor choice in policing the suggestive–descriptive line. The cases above highlight some recent close calls, and the dramatic difference that hinges on where the contested mark falls on the *Abercrombie* spectrum. The next Section considers the difficulty in drawing the suggestive–descriptive line, and the tests courts have applied in the attempt.

### *C. How Courts Distinguish Suggestive from Descriptive Trademarks*

Distinguishing distinctive from descriptive marks is a difficult endeavor with high stakes. Drawing the distinctiveness line comes down to a mix of two factors. Courts inquire whether protection of the mark might cause language depletion or otherwise harm competitors. They also ask how and what the mark communicates to consumers. The following table summarizes the current state of the law.

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<sup>84</sup> *Id.* at \*14; see also Linford, *Adverse Possessor*, *supra* note 52, at 754 (describing a split between the Courts of Appeals on whether an incontestable mark is entitled to a presumption of strength).

<sup>85</sup> *Wallach*, 2005 WL 5958091, at \*12.



Table 2: *Standard Articulation of Differences Between Descriptive, Suggestive, and Arbitrary Trademarks*

<i>Abercrombie Category</i>	<i>Relationship</i>	<i>Presumed Replacement Options</i>	<i>Presumed Language Depletion Risk</i>	<i>Presumed Processing Advantage</i>	<i>Bar to Protectability</i>
Descriptive	Direct	Few	Significant	Immediate connection	High bar—proof of secondary meaning required
Suggestive	Indirect	More / Many	Insignificant	Indirect connection; imaginative leap required	Low bar— inherently distinctive on first use
Arbitrary	No connection	Any word	None	Incongruous; no advantage	

1. *Line Drawing Based on Language Depletion and Suitable Replacement Marks*

For many courts, policing the line between descriptive and suggestive marks requires a judgment call about competitors' need to use the mark.<sup>86</sup> Appropriating a generic term may reduce the ability of competing firms to enter the market or sell their product, because they cannot use terms they would prefer to use to communicate with consumers.<sup>87</sup> The same rationale animates resistance to protection for descriptive marks. Courts assume that protecting a descriptive term as a trademark may create a monopoly over a word that competitors need to use.<sup>88</sup> Courts express concern over the lack of suitable substitutes. For example, in *Brother Records, Inc. v. Jardine*, the Ninth Circuit noted that “[i]f the trademark holder were allowed exclusive rights” in descriptive terms, “the language would be depleted in much the same way as if generic words were protectable.”<sup>89</sup>

<sup>86</sup> J. Janewa OseiTutu, *A Sui Generis Regime for Traditional Knowledge: The Cultural Divide in Intellectual Property Law*, 15 MARQ. INTEL. PROP. L. REV. 147, 179 (2011).

<sup>87</sup> William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 292–93 (1987).

<sup>88</sup> *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, 887 F. Supp. 2d 519, 533 (S.D.N.Y. 2012) (noting that “the Second Circuit has also considered whether a finding that a mark is inherently distinctive will make it difficult for manufacturers of similar products to market their goods” (citing *Abercrombie Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d. Cir. 1976))).

<sup>89</sup> *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 906 (9th Cir. 2003) (quoting *New Kids on the Block v. News Am. Publ'g Inc.*, 971 F.2d 302, 306 (9th Cir. 1992)).

While courts express concern over language depletion, a certain level of “language exclusivity” reduces consumer search costs.<sup>90</sup> If the law secures the ability of trademark owners to engage in relatively exclusive use of their respective marks to identify their individual products, consumers can more readily find the product they prefer to buy. Lower search costs can lead to more competitive markets, because consumers can more easily find replacement goods.<sup>91</sup> Protection of a nondistinctive mark would not, however, lower search costs, but would impose costs on competitors to the extent the non-distinctive mark “uses words, symbols, shapes, or colors that are common to those used by other producers” of a particular product.<sup>92</sup>

Some scholars see the danger of language depletion as directly related to the perceived inherent strength of the different *Abercrombie* categories. For example, Stephen Carter raises concerns that the farther along the *Abercrombie* spectrum a mark is from a fanciful term, i.e., a made up word, the greater the risk of language depletion.<sup>93</sup> Some commentators thus assume that concerns over language depletion will consistently arise with regard to descriptive marks, but rarely if ever for arbitrary marks. For instance, William Landes and Richard Posner assert that protection of descriptive terms may reduce welfare because “[a] given product has only so many attributes that interest buyers.”<sup>94</sup> On the other hand, for arbitrary marks, the “450,000 words in *Webster’s Third New International Dictionary* . . . are freely substitutable if one is uninterested in meaning.”<sup>95</sup>

Commentators disagree about whether protecting a suggestive mark threatens language depletion or competitive harm, and these competing assertions have little empirical support. For example, Landes and Posner conclude that the number of available suggestive marks is “not much less” than arbitrary or fanciful marks, noting that goods with suggestive marks like BUSINESS WEEK and WALL STREET JOURNAL compete effectively with goods with arbitrary marks like FORBES and BARRON’S.<sup>96</sup> The ability of marks to compete doesn’t speak to whether other competitors were blocked off

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<sup>90</sup> “Language exclusivity” is a term used by Stephen Carter. Carter, *supra* note 4, at 769. Landes and Posner instead call it “language monopoly.” Landes & Posner, *supra* note 87, at 292.

<sup>91</sup> See, e.g., *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985).

<sup>92</sup> Landes & Posner, *supra* note 87, at 288.

<sup>93</sup> Carter, *supra* note 4, at 775 (“[T]he elasticity of supply of low-cost substitute marks varies as a function of the distance of the mark from the generic.”).

<sup>94</sup> Landes & Posner, *supra* note 87, at 290. Landes and Posner observe, however, that if a descriptive term becomes a source signifier, granting protection “may create consumer benefits, by reducing confusion and search costs by more than the costs to rivals of being forbidden to use the same word.” *Id.* Lisa Ramsey argues instead that this shift occurs precisely because the law protects rights in descriptive terms, and the shift would be unlikely to occur without the legal right. Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1157–58 n.319 (2003).

<sup>95</sup> Landes & Posner, *supra* note 87, at 289.

<sup>96</sup> *Id.*

because they couldn't use a suggestive mark like WALL STREET JOURNAL to sell their newspapers. Other scholars voice suspicion that there may be a limited supply of suitable suggestive marks, or that commandeering a suggestive mark might create the same competitive advantage one acquires from controlling a descriptive mark. For example, Stephen Carter hypothesizes that the problem of language depletion may manifest just as strongly for suggestive marks as descriptive marks.<sup>97</sup> Similarly, Terry Fisher notes that protection of any mark can harm later entrants whether the protected name is informative or attractive.<sup>98</sup>

The threat of language depletion is not universally accepted.<sup>99</sup> Commentators have noted that the preference of many competitors is to select a distinctive and distinguishable mark that is unlike a prior competitor's mark.<sup>100</sup> Scholars have also noted that there are a limited number of firms that can effectively compete in a given market, reducing the number of alternative trademarks that must be available in order to support a properly functioning market.<sup>101</sup>

A more complete picture of the line between suggestive and descriptive marks requires more than an analysis of competition concerns.<sup>102</sup> In fact, correctly calculating the danger of language depletion depends on the cost to rivals of developing alternative means to denote the product sold.<sup>103</sup> In addition,

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<sup>97</sup> Carter, *supra* note 4, at 793–94; *cf. id.* at 774. (“[T]he possibility of rent-seeking through a costly language exclusivity is not limited to the case of a firm’s adoption of a generic word, and the other cases in which rent-seeking might occur are somewhat more difficult to deal with. The unhappy truth is that firms try consistently (often against their attorneys’ advice) to find marks that, while perhaps not generic, are a long way from being fanciful.”).

<sup>98</sup> William Fisher, *Theories of Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 168, 170 (Stephen R. Munzer ed., 2001) (“[T]rademarks can sometimes be socially harmful—for example, by enabling the first entrant into a market to discourage competition by appropriating for itself an especially attractive or informative brand name.”).

<sup>99</sup> See, e.g., *Chevron Chem. Co. v. Voluntary Purchasing Grps., Inc.*, 659 F.2d 695, 702–03 (5th Cir. Unit A Oct. 1981) (noting that available words are abundant and “possible varieties of advertising display and packaging are virtually endless”).

<sup>100</sup> See, e.g., *Jerre B. Swann, Sr., Dilution Redefined for the Year 2000*, 90 TRADEMARK REP. 823, 828 n.32 (2000).

<sup>101</sup> Carter, *supra* note 4, at 788 (“[O]nly a limited number of marks will be removed from the market language in any given product market, because there is not space for an infinite number of firms.”).

<sup>102</sup> McCarthy has suggested a laundry list of questions a court might ask to distinguish suggestive from descriptive marks. MCCARTHY, *supra* note 17, §§ 11:21–:22, :66–:71 (cited by *Trustco Bank, Nat’l Ass’n v. Glens Falls Nat’l Bank & Trust Co.*, 903 F. Supp. 335, 342 (N.D.N.Y. 1995)) (proposing courts consider 1) how much imagination is required to connect the term to the product; 2) whether the mark says something about the product that competitors would want to say about their similar competing products; 3) whether other sellers use the term; 4) whether the mark conjures up a purely arbitrary connection; and 5) whether buyers are likely to see the mark as a symbol of origin, or self-laudatory advertising).

<sup>103</sup> Landes & Posner, *supra* note 87, at 292.

questions of competitive harm turn on how a trademark communicates information to consumers, and how efficiently the mark can make connections between the source and the product offered for sale. It is not enough to ask how many substitutes are left when a mark owner selects a mark. The law must also consider which substitutes work as source signifiers or product identifiers and why. The next Section summarizes how courts and commentators describe the communicative effect of various trademarks along the *Abercrombie* spectrum.

## 2. *Communicative Power and the Imaginary Line Between Descriptive and Suggestive Marks*

The federal courts of appeals have articulated several related but distinct tests for distinguishing suggestive from descriptive marks. The majority of circuits ask about the degree of imagination required to connect the trademark to the product.<sup>104</sup> As the Seventh Circuit states, “if the mark imparts information directly, it is descriptive,” but “[i]f it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive.”<sup>105</sup> Applying a similar standard in *Soltex Polymer Corp. v. Fortex Industries, Inc.*,<sup>106</sup> the Second Circuit concluded that FORTIFLEX for plastic resin was suggestive despite its descriptive element because it “[o]bviously . . . takes imagination to conjure the image of plastic resin from the term ‘FORTIFLEX.’”<sup>107</sup> In other cases, the inquiry turns on the directness or immediacy of the connection between the product and the trademark.<sup>108</sup> For instance, in *In*

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<sup>104</sup> See, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 952 (7th Cir. 1992); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979), *abrogated on other grounds by* *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003). Some scholars criticize this imagination standard. See, e.g., Lee et al., *supra* note 31, at 1044 (“[I]magination’ and related inquiries introduce a theoretical sleight of hand: They begin with the premise that trademark protectability turns on consumer perception of inherent distinctiveness, but then formulate tests that instead evaluate the immediacy or degree of inherent descriptiveness.”).

<sup>105</sup> See, e.g., *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) (quoting ARTHUR H. SEIDEL, *TRADEMARK LAW AND PRACTICE* § 4.06, at 77 (1963)).

<sup>106</sup> *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1325, 1328 (2d Cir. 1987).

<sup>107</sup> *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 74 (2d Cir. 1988) (citing *Soltex Polymer*, 832 F.2d at 1328); see also *Stewart Paint Mfg. Co. v. United Hardware Distrib. Co.*, 253 F.2d 568, 573 (8th Cir. 1958), *cited with approval by* *Union Carbide*, 531 F.2d at 379 (“Suggestive terms ‘suggest’, but do not describe the qualities of a particular product. The distinction threatens to be one without a difference. Essentially, however, the common and ordinary meaning of the term to the public and the incongruous use of it as it relates to the product determine whether a term is suggestive.” (quoting the district court opinion, *Union Carbide*, 392 F. Supp. 280, 286 (N.D. Ill. 1975))).

<sup>108</sup> *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995) (defining the inquiry into imaginativeness as one concerning “how immediate and direct is the thought process from the mark to the particular product. If the mental leap between the word and the product’s attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” (citation omitted) (first

*re American Society of Clinical Pathologists*, the Court of Customs and Patent Appeals held that REGISTRY OF MEDICAL TECHNOLOGISTS was merely descriptive because it would “immediately convey to one seeing or hearing it the thought of appellant’s [board certification and examination services].”<sup>109</sup>

This inquiry into the imagination required of consumers versus directness of connection between the product and the mark has been subdivided into tests about whether the mark describes “the ingredients, qualities, or characteristics of the goods”;<sup>110</sup> “conveys information regarding a function, or purpose, or use of the goods”;<sup>111</sup> describes “a feature or part of the goods”;<sup>112</sup> or “conveys information about any properties of the goods.”<sup>113</sup> For many courts, the perception of communicative effectiveness turns on the immediacy of the connection between mark and product.

The suggestive–descriptive line also ostensibly turns on consumer perspective.<sup>114</sup> A descriptive term “conveys to one who is unfamiliar with the product its functions or qualities.”<sup>115</sup> Unfortunately, because evidence of secondary meaning is required only for descriptive marks, a court often

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quoting *Sleekcraft*, 599 F.2d at 349; and then quoting MCCARTHY, *supra* note 3, § 11.21[1], at 11-108 to -109); *In re Abcor Dev. Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978) (“[A descriptive mark] forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” (quoting *Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, 11 (2d Cir. 1976))); *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, 887 F. Supp. 2d 519, 533 (S.D.N.Y. 2012) (“The defining feature of a descriptive mark is that it gives the consumer an immediate idea of the contents of the product.”).

<sup>109</sup> *In re Am. Soc’y of Clinical Pathologists, Inc.*, 442 F.2d 1404, 1407 (C.C.P.A. 1971).

<sup>110</sup> *See, e.g., William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 528 (1924) (“A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trademark . . . .”); *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 608 (C.C.P.A. 1947) (“[T]he law w[ill] not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade . . . .” (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920))).

<sup>111</sup> *In re Abcor*, 588 F.2d at 813; *see also, e.g., In re Reynolds Metals Co.*, 480 F.2d 902, 903–04 (C.C.P.A. 1973) (stating that although “merely descriptive” marks are unregistrable, marks “suggestive of one purpose to which the goods may be put . . . are registrable”).

<sup>112</sup> *See, e.g., Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 733 (3d Cir. 1957) (“Here we have an effort to register an alleged trade-mark, consisting of something which is a mechanically functional feature of an automobile tire, and not registerable at all, and is descriptive of the particular type of tire . . . .” (quoting *Goodyear Tire & Rubber Co. v. Robertson*, 25 F.3d 833, 844 (4th Cir. 1928))).

<sup>113</sup> *See, e.g., JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE* § 2.03, at 2-31 (1988) (“[A term] is descriptive if it informs the purchasing public of the characteristics, quality, functions, uses, ingredients, components, or other properties of a product, or conveys comparable information about a service.”).

<sup>114</sup> *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 74 (2d Cir. 1988) (“The [Lanham] Act is aimed to protect purchasers in the marketplace, and it is their perception that determines whether a mark is descriptive or suggestive.” (citing *Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985))).

<sup>115</sup> *In re D.C. Comics, Inc.*, 689 F.2d 1042, 1044 (C.C.P.A. 1982).

evaluates likely consumer perception without key evidence of how consumers see the mark,<sup>116</sup> relying instead on how it thinks consumers will perceive the mark.<sup>117</sup>

Due to the close conceptual relationship between a descriptive mark and the product with which it is associated, some scholars argue that selecting a descriptive term as a mark allows the mark owner to “free ride” on associations between the mark and the product sold.<sup>118</sup> On the other hand, suggestive marks are treated as though they do not pose any danger of free riding because the connection between mark and product is insufficiently direct.<sup>119</sup> In fact, courts sometimes conclude that if the mark is suggestive, it is the second entrant that engages in problematic free riding which the law should discourage.<sup>120</sup>

Courts err in substituting the directness of the connection between the mark and the product for the effectiveness of the mark as a communicator. To the contrary, recent research indicates that some arbitrary or fanciful marks can be equally effective vessels for a number of different products. For example, when professional product namers like Catchword or Interbrand generate a list of names for a client, the client eventually chooses one, but many of the remaining names are catalogued and reused when the next client needs a name. These professional namers operate as if there exists a “Platonic ideal of good names, independent of products good or bad—a name so good that it could work, if not on anything, than at least on many things.”<sup>121</sup> This is so in part because recent studies suggest morphemes and phonemes, the building blocks of words, convey meaning even before those building blocks are combined into a word.<sup>122</sup>

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<sup>116</sup> Cf. *supra* note 76 and accompanying text (discussing the 5-HOUR ENERGY case).

<sup>117</sup> See, e.g., *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 301 (3d Cir. 1986).

<sup>118</sup> See, e.g., *Ramsey*, *supra* note 94, at 1155 (“[W]hen a descriptive term is first used as a mark, that mark is not yet distinctive, but it is valuable instantly—before any advertising or sales—because the term is attribute-identifying and provides information about the qualities and characteristics of the product. A business that selects and uses a descriptive term as a mark on its product is, in effect, free-riding off the attribute-identifying value of the descriptive term.” (footnote omitted)); see also *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1430 (7th Cir. 1985).

<sup>119</sup> See, e.g., *A.J. Canfield*, 808 F.2d at 297 (stating that suggestive marks convey indirect or vague information about the product or service).

<sup>120</sup> See, e.g., *Scandia Down*, 772 F.3d at 1430.

<sup>121</sup> Neal Gabler, *The Weird Science of Naming New Products*, N.Y. TIMES MAG. (Jan. 15, 2015), [http://www.nytimes.com/2015/01/18/magazine/the-weird-science-of-naming-new-products.html?\\_r=0](http://www.nytimes.com/2015/01/18/magazine/the-weird-science-of-naming-new-products.html?_r=0) [<http://perma.cc/4KJZ-BCRD>] (reporting on interviews with professional namers at Catchword and Interbrand).

<sup>122</sup> Multiple studies conducted by linguist Will Leben report that survey participants perceive some made-up words as fast, small, and light versus slow, big, and heavy depending on the vowels and consonants comprising the word and the order in which they are used. *Id.* For example, research participants report that “fip” sounds faster than “fop” because the word “fip” has less acoustic substance or weight than fop. Likewise, the “S” of Swiffer, a mark for mops with a disposable head, sounds fast and easy, while the “D” of Dasani, a mark for bottled water sounds heavier, and thus relaxing rather than refreshing. *Id.* See generally Jake Linford, *Are Trademarks Ever Fanciful?* (Dec. 2, 2015) (unpublished manuscript) (on

In analyzing trademark law, courts should consider how consumers process the information communicated by the trademark. The *Abercrombie* spectrum posits that the connection between the word chosen and the product offered channels trademark meaning. We can gain insight into whether that is so by examining how language changes, how change is processed and how new meanings are added to the lexicon. An understanding of these phenomena can help us evaluate how consumers are likely to react when a firm tries to add new source signifying meaning to an existing word. This information may then lead us to reconsider the treatment of various categories of trademarks along the *Abercrombie* spectrum.

This Article is not the first to question the *Abercrombie* spectrum, or whether courts should apply it. Standard critiques of the *Abercrombie* spectrum as it applies to word marks follow two primary lines of attack.<sup>123</sup> Some scholars argue that the spectrum lacks empirical support.<sup>124</sup> Other scholars suggest that focusing on the spectrum and on inherent or conceptual strength may distract courts from considering more important factors, like acquired or commercial strength.<sup>125</sup>

The existing literature provides insight into how and why a mark acquires source significance in context, but discounts the importance of the initial mark

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file with author) [hereinafter Linford, Fanciful?] (reporting on psychological, linguistic, and marketing research that shows sounds chosen to comprise a fanciful mark convey information that consumers may not recognize on a conscious level, but that nevertheless shapes consumer perception of the product associated with the mark).

<sup>123</sup> Courts and commentators primarily question the application of *Abercrombie* to non-word marks like trade dress, which includes both product packaging and product features, and color used as a source signifier. *See, e.g.,* Dinwoodie, *Inherent Distinctiveness*, *supra* note 12, at 568 (arguing that the *Abercrombie* spectrum “provide[s] a useless veneer to intuitive judgments of protectability” in trade dress cases).

<sup>124</sup> *See, e.g.,* Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1635–36 (2006) [hereinafter Beebe, *Empirical Study*] (arguing that commercial strength in the marketplace developed over time correlates with mark owner victory in trademark litigation more than inherent or conceptual strength); Kevin Blum et al., *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. 3, 25 (confirming results of the Beebe study with a different data set); Lee et al., *supra* note 31, at 1078, 1089, 1091–92 (arguing, based on consumer studies, that “contextual markers” on trademark packaging are more important than the conceptual relationship of the word chosen as a mark to the product); Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 HOUS. L. REV. 861, 871–74 (2011) (criticizing continued reliance on the *Abercrombie* spectrum on the ground that it was offered by judges decades before the start of empirical trademark and marketing research, and that it may be a poor proxy for how readily consumers will recognize a given mark as an indication of source).

<sup>125</sup> Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 738–43 (2004) (arguing that trademark law should focus on the context of trademark usage over categorical determinations); Timothy Denny Greene & Jeff Wilkerson, *Understanding Trademark Strength*, 16 STAN. TECH. L. REV. 535, 582 (2013) (arguing as a normative matter that commercial strength should trump inherent strength in trademark inquiries).

selection. These critiques are not fully satisfying because they tilt too far toward marketplace context and commercial strength, failing to fully recognize how initial consumer perception of the connection between different meanings of a word can shape how the meanings are accessed, processed, and understood. It is true that commercial strength can and should trump conceptual strength when there is evidence of the former,<sup>126</sup> but that does not mean courts should overlook inherent strength as a relevant starting point.<sup>127</sup> In fact, generalizable baselines about how consumers perceive trademarks can aid courts in reaching the ultimate question of whether a mark has acquired commercial strength.

Research on the interaction between conceptual and commercial strength is mixed. For instance, studies by Barton Beebe and Kevin Blum et al. identify some cases where developed commercial strength correlated with the outcome of trademark litigation but inherent strength did not.<sup>128</sup> But such a finding does not belie the importance of inherent strength as a starting point, particularly in light of evidence from the Beebe and Blum studies that conceptual and commercial strength dovetail in many cases,<sup>129</sup> and that conceptual strength frequently correlates with the ultimate outcome of litigation.<sup>130</sup>

A different type of critique, closer in spirit to the proposal in this Article, argues that the law should focus on how consumers process a mark. Lisa Ouellette suggests that the best way to understand how consumers perceive a mark is by looking to crowdsourced evidence of consumer perception like search engine results.<sup>131</sup> Ouellette's proposal considers how to track changes in trademark meaning over time. Irina Manta instead recommends observing the subconscious or automatic reactions of survey respondents, which she argues are more likely to mirror the snap buying decisions of consumers than direct survey responses.<sup>132</sup> Manta touches on a critical issue that this Article explores in more depth: Part III of this Article turns to research into language change to

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<sup>126</sup> See, e.g., Linford, *Adverse Possessor*, *supra* note 52, at 727–28. *But see* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 771 (1992) (rejecting invitation to hold that inherently distinctive trade dress that failed to acquire distinctiveness should be subject to forfeiture or defeasance).

<sup>127</sup> Cf. Greene & Wilkerson, *supra* note 125, at 537–38 (noting that courts made the “correct[] shift towards a focus on actual market strength” over inherent strength, but the shift “has resulted . . . in a relatively unbounded free-for-all in which beleaguered judges are asked to examine any evidence that might be probative of acquired strength” (emphasis omitted)).

<sup>128</sup> Blum et al., *supra* note 124, at 27.

<sup>129</sup> Beebe, *Empirical Study*, *supra* note 124, at 1638.

<sup>130</sup> *Id.* at 1637–39; Blum et al., *supra* note 124, at 26 (reporting that arbitrary marks were positively correlated with an ultimate finding of likelihood of confusion, while descriptive marks were negatively correlated with an ultimate finding of likelihood of confusion).

<sup>131</sup> Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CALIF. L. REV. 351, 362 (2014).

<sup>132</sup> Irina D. Manta, *In Search of Validity: A New Model for the Content and Procedural Treatment of Trademark Infringement Surveys*, 24 CARDOZO ARTS & ENT. L.J. 1027, 1036 (2007).



explain how the connection between the mark and the product sold can channel consumer processing, and set a baseline for the acquisition of source significance.

### III. SEMANTIC SHIFT: HOW EXISTING WORDS ADD NEW MEANINGS

This Part provides an overview of the etymological, theoretical, and cognitive literatures on language change necessary to understand how trademark acquisition is a form of semantic shift.<sup>133</sup> Most word marks are created by adding new, source-signifying meaning to a pre-existing word, like APPLE for a brand of computers, GLEEM for a brand of toothpaste, or SEALTIGHT for a brand of fasteners. Like the creation of trademark meaning, semantic shift is driven and motivated by the need to communicate. And like other semantic shift events, the creation of trademark meaning introduces ambiguity as new meanings are added to existing words. The effectiveness of the attempted communication, and the ease of processing the ambiguity, depends largely on the nature of the relationship between a new word or meaning and the older word from which it is derived.

This Part then explains how recent cognitive experiments support the etymological account with regard to how a listener or reader makes sense of a given use of a word with multiple meanings.<sup>134</sup> These studies measure participant response times in word recognition tasks, and report that exposure to one meaning of a word increases the speed with which a listener or reader can access other related, or polysemous, meanings. These same studies indicate that exposure to a homonymous, or unrelated meaning, confers no processing advantage. The cognitive evidence bolsters theoretical and etymological accounts of language change and supports the division of new meanings into established linguistic classifications.

If trademark law proposes to protect marks so they can (and to the extent that they) effectively convey information to consumers,<sup>135</sup> the law must take

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<sup>133</sup> See *infra* Part IV.A; see also Linford, “Generic” Trademarks, *supra* note 1, at 131–40. This summary also informs the prescriptions for reforming trademark law in Part IV.B–C, *infra*.

<sup>134</sup> See generally Ekaterini Klepousniotou & Shari R. Baum, *Disambiguating the Ambiguity Advantage Effect in Word Recognition: An Advantage for Polysemous but Not Homonymous Words*, 20 J. NEUROLINGUISTICS 1 (2007); Ekaterini Klepousniotou, *The Processing of Lexical Ambiguity: Homonymy and Polysemy in the Mental Lexicon*, 81 BRAIN & LANGUAGE 205 (2002) [hereinafter Klepousniotou, *Processing*]; Klepousniotou, *Reconciling*, *supra* note 26.

<sup>135</sup> See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2116 (2004) (“The three main policy reasons for protecting marks—reducing consumer search costs, maintaining and improving product quality, and remedying intentional deception—all relate to the quality of the product information available to consumers.”); Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 549 (2006) [hereinafter Bone, *Hunting Goodwill*] (“The core of trademark law . . . is based on a[n] . . . ‘information transmission model.’ This

consumer perception into account.<sup>136</sup> Like any other change in language, investing a term with source significance requires the new meaning to reach a critical mass of popular acceptance. Generalizable rules about language change may provide insight into how the connection between the trademark and the product facilitate communication and make the mark more appealing. These rules may thus also provide important insight into how to better reshape trademark law to meet its information transmission objective.

### *A. Motivations for Semantic Shift: Updating Language and Managing Ambiguity*

Language fluctuates constantly. New words are continually added to the lexicon as existing words gain new meanings. Twin motivations drive this semantic shift—enabling linguistic innovation and managing ambiguity.<sup>137</sup> For instance, a speaker might add a new meaning to an existing word to give voice to a new concept,<sup>138</sup> or to better describe objective changes in the world that require “a new name in a concrete situation.”<sup>139</sup> When new meanings are added to existing words, the audience must discern which of a word’s multiple meanings is intended by the speaker. Different meanings of a single word can create what scholars call homonymic tension or semantic overload.<sup>140</sup> But languages develop tools for dealing with this ambiguity,<sup>141</sup> evolving “curative devices . . . to resolve ‘intolerable’ conflicts.”<sup>142</sup>

The need to manage ambiguity also shapes semantic shift. Dirk Geeraerts postulates two rival principles of language efficiency: formal efficiency and conceptual efficiency. Formal efficiency seeks to optimize the directness of the relationship between a word and the thing it signifies, following a few simple

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model views trademarks as devices for communicating information to the market and sees the goal of trademark law as preventing others from using similar marks to deceive or confuse consumers.”).

<sup>136</sup> See Linford, “*Generic*” Trademarks, *supra* note 1, at 117–19.

<sup>137</sup> See Dirk Geeraerts, *Reclassifying Semantic Change*, 4 QUADERNI DI SEMANTICA 217, 226, 234 (1983) [hereinafter Geeraerts, *Reclassifying*].

<sup>138</sup> Andreas Blank, *Why Do New Meanings Occur? A Cognitive Typology of the Motivations for Lexical Semantic Change*, in HISTORICAL SEMANTICS AND COGNITION 61, 82–83 (Andreas Blank & Peter Koch eds., 1999) [hereinafter Blank, *New Meanings*]; *cf.* TRAUGOTT & DASHER, *supra* note 24, at 7 (stating that speaker-driven language change is a phenomenon that cuts across languages).

<sup>139</sup> Blank, *New Meanings*, *supra* note 138, at 62 (describing the decision of the inventor of a self-propelled underwater munition to name it *torpedo*, after a species of stingray); *see also* Linford, “*Generic*” Trademarks, *supra* note 1, at 131–34.

<sup>140</sup> STEPHEN ULLMANN, THE PRINCIPLES OF SEMANTICS 132 (2d ed. 1957) [hereinafter ULLMANN, PRINCIPLES] (quoting LEONARD ROBERT PALMER, AN INTRODUCTION TO MODERN LINGUISTICS 113 (1936)); Geeraerts, *Reclassifying*, *supra* note 137, at 226, 234. This tension can arise over polysemous senses as well as homonymous meanings.

<sup>141</sup> ULLMANN, PRINCIPLES, *supra* note 140, at 132.

<sup>142</sup> *Id.* at 134.

rules. First, language will shorten phrases, like *periodical paper* to *periodical*,<sup>143</sup> to economize expression.<sup>144</sup> Second, confusing ambiguity is often resolved by shifting toward monosemy, i.e., one meaning for one word.<sup>145</sup> In a lexicon that maximizes formal efficiency, ambiguity would be kept to a minimum, which can make communication easier. However, that clarity would come at its own cost: communicating a new concept would always require the creation of a unique word.

Unlike formal efficiency, conceptual efficiency optimizes existing connections between related things. Using the same word to signify two or more unrelated concepts tends to confuse readers and listeners, even if context can subsequently clear up initial confusion. Diachronic research into language change over time indicates that listeners more easily comprehend new and ambiguous words when those words relate to existing meanings.<sup>146</sup> For example, in Gallic French, two Latin terms for “rooster” and “cat” merged into one word, *gat*, that carried both meanings.<sup>147</sup> To resolve that ambiguity, *gat* for “rooster” was abandoned, and two new words for ‘rooster’ were adopted. The first new word for rooster added a new meaning to an existing word: *bigey*, a word for “parish curate,” took on “rooster” as an additional meaning.<sup>148</sup> Geeraerts argues this addition is conceptually or metaphorically efficient because both the curate of a parish and the rooster in the chicken coop are overseers of a given domain.<sup>149</sup>

Similarly, the word *faisan* for “pheasant” was modulated slightly to create a new word, *azan* for “rooster.”<sup>150</sup> This new word was more conceptually efficient than a word plucked out of the air, because pheasants and roosters are birds with a similar appearance. The conceptual relationship makes it easier to overcome the confusion that can occur when one word has multiple meanings.

In essence, Geeraerts argues that conceptual efficiency results in less semantic overload and is easier to process, even when formal inefficiency persists. In other words, it is easier to reach the intended meaning, rooster, when you start at pheasant or curate than when you start at cat.<sup>151</sup> The audience can tolerate formal inefficiency when new meaning is added to an existing word, because the audience can use conceptual efficiency as an interpretive tool.

As the Article explains in more detail in Part IV, most trademarks are created by adding new meaning to existing words, or fragments of words, rather

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<sup>143</sup> DIRK GEERAERTS, THEORIES OF LEXICAL SEMANTICS 39 (2010) [hereinafter GEERAERTS, LEXICAL SEMANTICS].

<sup>144</sup> Robert J. Manner, *The Conflict of Homonyms in English*, 12 LANGUAGE 229, 237 (1936).

<sup>145</sup> Geeraerts, *Reclassifying*, *supra* note 137, at 227; *see also infra* Part IV.B–C.

<sup>146</sup> Geeraerts, *Reclassifying*, *supra* note 137, at 225.

<sup>147</sup> *Id.*

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

<sup>149</sup> *Id.*

<sup>150</sup> *Id.*

<sup>151</sup> Geeraerts, *Reclassifying*, *supra* note 137, at 225.

than invented from scratch.<sup>152</sup> Those additions arguably reduce formal efficiency. But the connections between old and new meanings will allow the mark to trade on conceptual efficiency.

*B. Regularity in Semantic Shift: Distinguishing Polysemy from Homonymy*

The previous Section explained that semantic shift occurs when a speaker needs to say something new, and often happens in a manner that reduces confusing ambiguity. This Section describes how semantic shift occurs in predictable patterns across languages.<sup>153</sup> Those patterns can shape the acquisition of trademark meaning, which at its base is a form of semantic shift. The following table summarizes several regular forms of semantic shift, and whether the shift is formally or conceptually efficient.<sup>154</sup>

Table 3: *Regular Semantic Shift and Formal v. Conceptual Efficiency*

Semantic Innovation / Linguistic Relationship	Formal Efficiency	Conceptual Efficiency
<u>Monoseme</u> : Only one meaning	High	Low (New word, no relationship)
<u>Homonym</u> : No connection between existing meanings and the new meaning	Low	Low
<u>Metaphor</u> : Figurative connection between existing meanings and the new sense	Low	High
<u>Metonym</u> : Literal or contiguous connection between existing and new sense, like feature for the whole <i>Ex.: Green Beret</i> from distinctive headgear worn by U.S. Army Special Forces shifts to serve as a nickname for the organization and its members	Low	High

<sup>152</sup> See, e.g., Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 472 n.97 (2009) (comparing the originality required to create a fanciful, coined mark to the appropriation of pre-existing words that characterizes the creation of arbitrary, suggestive, or descriptive marks).

<sup>153</sup> TRAUGOTT & DASHER, *supra* note 24, at 3.

<sup>154</sup> See also *supra* notes 143–49 and accompanying text.

Some new entries into the lexicon are brand new words. When coined, these *monosemes* have a singular meaning.<sup>155</sup> The term monoseme came into common usage to describe technical medical terms at the turn of the 20th century, but has since been applied to certain prominent brands. For example, David Crystal points to Microsoft as an example of a monosemous term.<sup>156</sup> Any new word made up whole cloth will be a monoseme, at least at first.

New meanings are added to existing words in two primary ways: polysemy and homonymy. Polysemy describes the addition of a new meaning that is etymologically related to the existing meaning of a word.<sup>157</sup> Linguists posit that polysemes are interrelated in such a way that the reader or listener generates multiple meanings from a single, central, sense.<sup>158</sup> For example, a bank is simultaneously a financial institution, the building in which the financial institution is housed, any number of institutions that store things (like a blood bank), and a synonym for “rely upon,” i.e., “You can bank on it.”<sup>159</sup> All those meanings were derived from the Italian term for bench, which was “extended in Italian to [also mean] ‘tradesman’s stall, counter, [or] money changer’s table.’”<sup>160</sup>

Polysemous shifts regularly occur in two ways: *metaphoric* and *metonymic*.<sup>161</sup> Metaphoric shifts are based on a specific analogous similarity between different concepts.<sup>162</sup> For instance, *broadcast* originally meant scattering seed “abroad over the whole surface, instead of . . . sow[ing] in drills or rows”;<sup>163</sup> later came to mean scattering some thing widely abroad;<sup>164</sup> and was eventually used to refer to the process of disseminating a radio or television signal.<sup>165</sup> *Crane*, a bird with a long neck and legs, was likewise extended

<sup>155</sup> DAVID CRYSTAL, *HOW LANGUAGE WORKS* 191 (2006) (pointing to “Microsoft” as an example of a monosemous term); see also *Mononym*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/238541> [<http://perma.cc/Y92LSLLS>] (“Chiefly *Med. Obs.*, A technical name consisting of one word only.”). Monosemy is a circumstance where words or phrases have a single meaning, or where there is an absence of ambiguity. See generally CHARLES RUHL, *ON MONOSEMY: A STUDY IN LINGUISTIC SEMANTICS* (1989).

<sup>156</sup> CRYSTAL, *supra* note 155, at 191. While polysemes and homonyms are shared meanings for the same word, a monoseme stands apart from other lexemes.

<sup>157</sup> Allan defines polysemy as “the property of an expression with more than one meaning.” 1 KEITH ALLAN, *LINGUISTIC MEANING* § 3.3.1 (1986).

<sup>158</sup> Klepousniotou & Baum, *supra* note 134, at 4 (positing that polysemes have a single core meaning from which interrelated senses are derived, while homonyms have mutually exclusive meanings, one of which must be selected before further processing can occur).

<sup>159</sup> WILLIAM CROFT & D. ALAN CRUSE, *COGNITIVE LINGUISTICS* 109–10 (2004).

<sup>160</sup> *Bank*, n.3, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/15237> [<http://perma.cc/AT85-8UTE>].

<sup>161</sup> Klepousniotou, *Reconciling*, *supra* note 26, at 27.

<sup>162</sup> GEERAERTS, *LEXICAL SEMANTICS*, *supra* note 143, at 26–27.

<sup>163</sup> *Broadcast*, adj., adv., and n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/23507> [<http://perma.cc/5HUY-JXPE>].

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

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

metaphorically to a machine with a projecting arm used to raise and lower heavy weight.<sup>166</sup>

A metonymic shift is instead a change based on contiguity or connection between concepts or an understood association.<sup>167</sup> For instance, the word *horn* as it referred to “horn of an animal” was eventually used to describe a “wind instrument.” The shift was conceptually efficient because the use of animal horns as musical instruments made the new meaning of horn as a word for a musical instrument easier to process and remember.<sup>168</sup>

Another standard metonymic shift is a part–whole substitution, where “the meaning of the whole is transferred to a word that originally designated only a part of the whole.”<sup>169</sup> This shift often happens in political reporting, where the British Government is referred to collectively by the address of the Prime Minister’s residence, *Number 10* (as in Downing Street),<sup>170</sup> and the U.S. government is identified collectively as *Washington*.<sup>171</sup> In other cases, a distinguishing feature is used to represent the whole, like *Green Beret* for the military unit famous for wearing the distinctive headgear.<sup>172</sup>

Metaphoric and metonymic shifts are not formally efficient, because they violate the tendency toward monosemy, i.e., one meaning for each word.<sup>173</sup> They are nevertheless conceptually efficient, because the new meanings are cognitively related to existing meanings.<sup>174</sup> For the listener, every addition of a new term introduces potentially confusing ambiguity,<sup>175</sup> but when the new term is related to other terms familiar to the hearer, the ambiguity can be more readily resolved.<sup>176</sup> As Geeraerts explained, adding new meanings that are related to existing meanings is generally preferred to the alternative.<sup>177</sup> For the speaker, these polysemous shifts provide flexibility to communicate in new

<sup>166</sup> *Crane*, n.1, OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/43797> [http://perma.cc/CLK8-BEMS].

<sup>167</sup> TRAUGOTT & DASHER, *supra* note 24, at 28; *see also* Raymond W. Gibbs, Jr., *Process and Products in Making Sense of Tropes*, in METAPHOR AND THOUGHT 252, 258–59 (Andrew Ortony ed., 2d ed. 1993) (“[M]etonymy expresses simple contiguous relations between objects, such as part-whole, cause-effect, and so on.”).

<sup>168</sup> Andreas Blank, *Co-Presence and Succession: A Cognitive Typology of Metonymy*, in METONYMY IN LANGUAGE AND THOUGHT 169, 182 (Klaus-Uwe Panther & Günter Radden eds., 1999) [hereinafter Blank, *Co-Presence*].

<sup>169</sup> D. GARY MILLER, ENGLISH LEXICOGENESIS 110 (2014). Some scholars distinguish between metonymy and synecdoche. *Id.*

<sup>170</sup> Willem B. Hollmann, *Semantic Change*, in ENGLISH LANGUAGE: DESCRIPTION, VARIATION AND CONTEXT 301, 305 (Jonathan Culpeper et al. eds., 2009).

<sup>171</sup> M. JIMMIE KILLINGSWORTH, APPEALS IN MODERN RHETORIC: AN ORDINARY-LANGUAGE APPROACH 130 (2005).

<sup>172</sup> MILLER, *supra* note 169, at 111.

<sup>173</sup> *See supra* note 145 and accompanying text.

<sup>174</sup> *See* Geeraerts, *Reclassifying*, *supra* note 137, at 234.

<sup>175</sup> *Id.* at 225.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.*

circumstances.<sup>178</sup> Returning to the example of rooster, discussed above,<sup>179</sup> the connection between rooster and pheasant is metonymic—the two birds share a body type and common features. The connection between rooster and curate is metaphoric. A rooster acts in his henhouse domain as a curate acts in his parish. Both shifts were conceptually efficient, and thus preferable over rooster and cat sharing the word *gat*.

Unlike metonyms and metaphors, *homonyms* are unrelated meanings for the same word, and both cognitively and formally inefficient.<sup>180</sup> Homonyms look or sound the same,<sup>181</sup> but are usually etymologically distinct and come from different roots. For example, while the word “bank” can be used to describe a financial institution or the land at the edge of a river or stream,<sup>182</sup> those meanings are homonymous, stemming from independent and unrelated sources. As discussed in Part III.C, *infra*, recent cognitive experiments indicate that homonymous meanings operate as distinct concepts in the minds of the audience interpreting ambiguity, while polysemous meanings are stored as interrelated senses and are thus more easily processed and accessed. Thus, for a word with homonymous meanings, it is difficult, but not impossible, to simultaneously construe a given use of the word under both meanings.<sup>183</sup>

Finally, while both polysemy and homonymy are formally inefficient because they result in ambiguity, Dirk Geeraerts argues that polysemous ambiguity “is based on a conceptually efficient metaphorical process.”<sup>184</sup> As a result, a shift that adds polysemous ambiguity may be well received by the audience despite increasing formal inefficiency. There is thus some tendency for language to shift away from homonymous ambiguity toward polysemous ambiguity. As the next Section discusses, the relative ease of comprehending polysemous ambiguity compared to homonymous ambiguity is supported not only by diachronic accounts of language change over time, but also by recent cognitive research.

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<sup>178</sup> Dirk Geeraerts, *Diachronic Prototype Semantics. A Digest*, in *HISTORICAL SEMANTICS AND COGNITION*, *supra* note 138, at 91, 101–03.

<sup>179</sup> See *supra* notes 147–51 and accompanying text.

<sup>180</sup> Linguists sometimes differentiate between homonymous meanings (in effect, a new word sharing a similar form or sound) and polysemous senses (a new sense or variation on an existing meaning of a particular word). Technically, it is more accurate to say that homonyms are different words with the same lexeme—a collection of letters and sounds that comprise an identifiable unit. Each homonymous word is a separate lexical entry.

<sup>181</sup> For the sake of simplicity, I include within homonymy both homophones (lexemes that sound the same but have different written forms and different meanings) and homographs (lexemes with the same written form but different pronunciations and meanings). See generally Klepousiotou, *Processing*, *supra* note 134.

<sup>182</sup> *Bank*, *supra* note 160.

<sup>183</sup> CROFT & CRUSE, *supra* note 159, at 112.

<sup>184</sup> Geeraerts, *Reclassifying*, *supra* note 137, at 225.

### C. Cognitive Research: Processing Ambiguous Words

The etymological and theoretical accounts of semantic shift discussed in Parts III.A & B are supported by recent cognitive research that has detected statistically significant differences in the way listeners and readers access and process ambiguity across different categories of words. This experimental evidence suggests that listeners and readers who are confronted with ambiguous words rely on distinct processing mechanisms to access polysemous senses and homonymous meanings.<sup>185</sup> In other words, studies have identified significant differences in cognitive processing between homonymy and polysemy.<sup>186</sup> While exposure to a polysemous meaning helps the audience access or recall other polysemous meanings, exposure to a homonymous meaning provides no aid in accessing other homonymous meanings. The following table summarizes those findings.

Table 4: *Cognitive Processing Advantage Conferred by Different Types of Ambiguous Words*

Linguistic Relationship	Measured Processing Advantage
Metonymic Polysemy	Processing advantage over metaphoric polysemy, homonymy, and control words in all lexical tasks
Metaphoric Polysemy	Processing advantage over homonymy and control words in some lexical tasks
Homonymy	No processing advantage over control words in any lexical task

Early research into cognitive language processing posited that exposure to one meaning of a word with multiple meanings would aid in recognition of those other meanings. Several recent psycholinguistic and neurolinguistic studies by Ekaterini Klepousniotou and others report that it is not the existence of multiple meanings but the relationship between the meanings that affects audience recognition.<sup>187</sup> In these studies, respondents completed lexical tasks more

<sup>185</sup> Klepousniotou, *Reconciling*, *supra* note 26, at 42.

<sup>186</sup> *Id.* at 25 (citing studies by Tamiko Azuma & Guy C. Van Orden, *Why SAFE is Better Than FAST: The Relatedness of a Word's Meanings Affects Lexical Decision Times*, 36 J. MEMORY & LANGUAGE 484 (1997); Lyn Frazier & Keith Rayner, *Taking on Semantic Commitments: Processing Multiple Meanings vs. Multiple Senses*, 29 J. MEMORY & LANGUAGE 181 (1990); Steven Frisson & Martin J. Pickering, *The Processing of Metonymy: Evidence from Eye Movements*, 25 J. EXPERIMENTAL PSYCHOL. 1366 (1999); Jennifer Rodd et al., *Making Sense of Semantic Ambiguity: Semantic Competition in Lexical Access*, 46 J. MEMORY & LANGUAGE 245 (2002); John N. Williams, *Processing Polysemous Words in Context: Evidence for Interrelated Meanings*, 21 J. PSYCHOLINGUISTIC RES. 193 (1992)).

<sup>187</sup> See generally Klepousniotou & Baum, *supra* note 134; Klepousniotou, *Reconciling*, *supra* note 26.



quickly when presented with polysemous words—i.e., words having multiple related senses. Both metonymic and metaphoric polysemes conferred statistically significant processing advantages over control words in laboratory settings.<sup>188</sup> While both types of polysemes provided processing advantages compared to control words, metonymic polysemes conferred processing advantages more consistently across multiple experiments than metaphoric polysemes. In addition, metonymic polysemes conferred a statistically significant processing advantage compared with metaphoric polysemes. Metonymic polysemes also conferred a statistically significant processing advantage over homonyms. Metaphoric polysemes conferred a statistically significant advantage compared to homonyms in some studies. In other studies, the advantage conferred over homonyms was measurable but not statistically significant. Unlike metaphoric and metonymic polysemes, homonyms provided no processing advantage over control words across multiple studies.<sup>189</sup> A different series of experiments conducted by Devorah Klein and Gregory Murphy also observed a significant difference in the processing of polysemous words as opposed to homonymous words, although they described both effects as minor.<sup>190</sup>

The studies by Klepousniotou and Klein & Murphy suggest that for polysemes, the existence of multiple related senses of a word makes it easier to access the word in the reader's mental lexicon.<sup>191</sup> When there are several apparently identical words with polysemous or related meanings, they are mentally stored in a way that facilitates processing and recognizing the word. However, these studies also indicate that homonymous meanings convey no such processing advantage. Klepousniotou concludes from this evidence that homonymous words have multiple meanings with distinct representations in the mental lexicon.<sup>192</sup> Homonymous words are thus stored as different entries and

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<sup>188</sup> Klepousniotou, *Reconciling*, *supra* note 26, at 29. While the result was not statistically significant, in one study homonymous words were processed more slowly than the control words. *Id.*

<sup>189</sup> *Id.*

<sup>190</sup> Devorah E. Klein & Gregory L. Murphy, *Paper Has Been My Ruin: Conceptual Relations of Polysemous Senses*, 47 J. MEMORY & LANGUAGE 548, 551 (2002); *see also id.* at 556–57 (finding, in categorization tasks, “an advantage for the polysemous words over the homonyms, and thus that the polysemous items share more connections than just a repeated word. The polysemous senses have more conceptual coherence than the different homonym meanings do.”); *id.* at 563–64 (finding, in induction tasks, that “polysemous items had stronger induction than homonyms” and that “[t]he closer two senses were, the stronger the induction from one to the other”). *But see* Devorah E. Klein & Gregory L. Murphy, *The Representation of Polysemous Words*, 45 J. MEMORY & LANGUAGE 259, 259 (2001) (finding, contrary to theory of semantically shared polysemous senses, that using a word in one sense provided no processing advantage for using it in a difference sense, but instead slowed down the second use, relative to a control condition).

<sup>191</sup> *See also* Rodd et al., *supra* note 186, at 245 (finding a significant ambiguity advantage in lexical decision tasks for polysemous words with multiple related senses, and a delay for homonymous words with multiple unrelated meanings).

<sup>192</sup> Klepousniotou, *Reconciling*, *supra* note 26, at 29, 42.

accessed separately in the mental lexicon.<sup>193</sup> As a result, the speed with which the word is accessed may be reduced because multiple conflicting meanings are competing for activation in the reader's mind.<sup>194</sup> On the other hand, the difference in processing speed suggests that polysemes have a single representation with various senses and that, for the listener or reader, there is little or no semantic overload that might compromise the activation process.<sup>195</sup> At first glance, metaphors may appear to occupy a middle ground between metonymic polysemy and homonymy, supporting earlier theories that lexical ambiguity occurs on a spectrum.<sup>196</sup> However, the similarities between metaphor and metonym are greater than their differences, and are certainly greater than similarities between metaphor and homonym.

Like the cognitive research summarized above, marketing research often measures the speed of survey completion as a way to gauge implicit, subconscious, or unconscious responses. Processing speed can provide a clearer picture of how marks communicate and why marks are more effective than consumer responses to direct questions. As in other contexts, instantaneous or subconscious processing is often more powerful, and certainly more automatic, than deliberate decision-making mechanisms.<sup>197</sup>

It can nevertheless be problematic to extrapolate consumer habits from processing delays in laboratory experiments.<sup>198</sup> Some scholars have questioned what response time might actually tell us about consumer decisions because it is difficult, if not impossible, to “know at what point a response delay becomes enough to change a purchase decision.”<sup>199</sup> Thus, a delay in response time might not be “enough to justify realigning [trademark] doctrine.”<sup>200</sup>

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<sup>193</sup> *Id.*

<sup>194</sup> *Id.* at 29.

<sup>195</sup> *Id.*; see also *supra* notes 157–60, 191, and accompanying text.

<sup>196</sup> Klepousniotou, *Reconciling*, *supra* note 26, at 29 (citing Jurij D. Apresjan, *Regular Polysemy*, 142 LINGUISTICS 5 (1974)).

<sup>197</sup> See, e.g., Anthony G. Greenwald & Linda Hamilton Krieger, *Implicit Bias: Scientific Foundations*, 94 CAL. L. REV. 945, 951 (2006) (“The very existence of implicit bias poses a challenge to legal theory and practice, because discrimination doctrine is premised on the assumption that, barring insanity or mental incompetence, human actors are guided by their avowed (explicit) beliefs, attitudes, and intentions.”); L. Song Richardson, *Arrest Efficiency and the Fourth Amendment*, 95 MINN. L. REV. 2035, 2041 (2011) (discussing how to deal with implicit bias in policing and Fourth Amendment jurisprudence); Mark Spottswood, *Bridging the Gap Between Bayesian and Story-Comparison Models of Juridical Inference*, 13 LAW PROBABILITY & RISK 47, 54–56 (2014) (describing the effect of System 1 unconscious processing on decision making).

<sup>198</sup> Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 527–28 (2008) [hereinafter Tushnet, *Gone*]. But see Chris Pullig et al., *Brand Dilution: When Do New Brands Hurt Existing Brands?*, 70 J. MARKETING 52, 63–64 (2006) (finding statistically significant effects on brand consideration and choice from exposure to dilutive ads even after a five-day delay).

<sup>199</sup> Tushnet, *Gone*, *supra* note 198, at 528.

<sup>200</sup> *Id.* at 564.

But this critique may be misguided because the speed of the first response is often conversely related to the ease of subsequently changing the respondent's perspective. An instantaneous response, often referred to as System I processing, can be difficult to dispel even when a person is presented with new information that calls the first impression into question. Indeed, when faced with evidence that contradicts a quick initial impression, many individuals will double down on that initial impression.<sup>201</sup> In fact, careful deliberation can actually reinforce the first impulse rather than correct it. Thus, subconscious or unconscious responses should not be discounted as easy to correct simply because they occur quickly. If the initial instantaneous connection between the word and the mark excavates a processing channel, it may be relatively difficult to close off the channel or redirect information flowing through it. Thus, assuming that the effect of unconscious processing will be short-lived may be mistaken.

In addition, an implicit response may better predict future behavior than an explicit response for three main reasons.<sup>202</sup> First, the implicit approach may uncover attitudes that consumers themselves have not recognized.<sup>203</sup> Second, implicit measurements can better reveal the factors driving social behavior than explicit measurements.<sup>204</sup> Finally, implicit measurements can better predict actual product selection than self-reported measures.<sup>205</sup>

Turning to semantic shift literature for insights into trademark doctrine also provides an opportunity to address a related concern raised by Rebecca Tushnet: survey evidence is often viewed with skepticism because it can be distorted to favor the party paying for the survey.<sup>206</sup> To date, the semantic shift literature has not been infected with marketing or litigant money, and the aforementioned studies look to establish rules applicable across time and across languages. An understanding of how language changes over time, and how the relationship of words can affect processing speed, may help the law see beyond specific survey evidence generated for litigation by providing generalizable rules about language change that can be applied in the trademark context. The next Part applies semantic shift research to trademark law, and explains how a suggestive mark, like a descriptive mark, trades on the relationship between existing product-related and new source-signifying meanings.

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<sup>201</sup> See Spottswood, *supra* note 197, at 54–56; cf. Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 740 (2012) (arguing against a multifactor test to correct perceived problems in the scope of the derivative work right because “[w]e are very bad at understanding our own reactions. The reasons we give for our decisions tend to be wrong or easily manipulable without our awareness.”).

<sup>202</sup> GERALD ZALTMAN, *HOW CUSTOMERS THINK: ESSENTIAL INSIGHTS INTO THE MIND OF THE MARKET* 115–16 (2003); cf. Manta, *supra* note 132, at 1036.

<sup>203</sup> ZALTMAN, *supra* note 202, at 115.

<sup>204</sup> *Id.* at 115.

<sup>205</sup> *Id.* at 116. Zaltman is also an advocate of neuroimaging. *Id.* at 117.

<sup>206</sup> See Tushnet, *Gone*, *supra* note 198, at 568.

#### IV. SUGGESTIVE TRADEMARKS ARE NOT INHERENTLY DISTINCTIVE

This Part marshals semantic shift literature to provide a limited defense for the *Abercrombie* spectrum, and more importantly, to highlight a critical flaw therein—treating a suggestive mark as inherently distinctive. As I describe below, the relationship between either a suggestive or a descriptive mark and the product sold is polysemous. Selecting a descriptive mark, which is metonymically related to the product identified, or a suggestive mark, which is metaphorically related to the product, connects the mark to the product in a manner that will readily allow consumers to slip between source-signifying and product-designating meanings. As a result, it is unlikely that either the descriptive or suggestive mark inherently functions as a source signifier. In addition, those polysemous connections may allow the mark owner to benefit from processing advantages not conveyed by arbitrary marks, which are unrelated (or homonymous in relation) to the good or service designated.

Trademark law aims to protect a mark so that it can convey accurate information to consumers and extend its strongest protection to those marks that most clearly indicate source. If the law is to properly distinguish “inherently distinctive” marks from those that send mixed signals to consumers or evoke qualities of the product sold, then protection should not automatically extend to a suggestive mark on its first use in commerce. This Part concludes with proposals for reforming trademark law in accordance with this insight.

##### *A. Linguistics and Trademark Communication*

This Article argues that trademark acquisition is like any other form of semantic shift—a process by which new meaning is added to the lexicon. Research into semantic shift teaches that like the creation of trademarks, language change generally is driven by the need to find a new name or express a new idea. Those changes can create confusing ambiguity.<sup>207</sup> Semantic shift typically follows paths that reduce confusing ambiguity. For example, language tends to shift by adding related or *polysemous* meanings to existing words because the connection between meanings helps the reader or listener recognize and understand the new meaning. As trademark acquisition is a form of semantic shift, linguistic theory and cognitive research may provide insight into how trademark law can better reflect consumer perception and thus economize consumer search and reduce consumer confusion.

The *Abercrombie* spectrum is challenged for a litany of reasons, including failing to accurately reflect the best evidence of consumer perception and

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<sup>207</sup> STEPHEN ULLMANN, SEMANTICS: AN INTRODUCTION TO THE SCIENCE OF MEANING 209–10 (1962) (“Whenever a new name is required to denote a new object or idea, we can do one of three things: form a new word from existing elements; borrow a term from a foreign language or some other source; lastly, alter the meaning of an old word.”). As Ullmann recognized half a century ago, “[t]he need to find a new name is . . . an extremely important cause of semantic changes.” *Id.* at 210.

distracting courts from more critical inquiries.<sup>208</sup> While it would be a mistake for trademark disputes to depend entirely on the *Abercrombie* category to which a mark is assigned, the spectrum maintains some surprising utility in identifying the conceptual strength of trademarks. The application of linguistic theory and cognitive research helps resolve some of the perceived conflict between the formalism of the *Abercrombie* spectrum and the contextualism of standard trademark critiques. At its core, the *Abercrombie* spectrum reflects solid linguistic principles about how meaning is typically added to the lexicon. Many critiques of the *Abercrombie* spectrum are thus overstated.<sup>209</sup> However, while the *Abercrombie* categories are generally consistent with our best understanding of semantic shift, trademark law draws the boundary of inherent distinctiveness in the wrong place.<sup>210</sup>

As discussed in Part III.C, recent cognitive experiments indicate that the relationship between different meanings of the same word affect audience comprehension and processing.<sup>211</sup> Thus, the categorical differences in the widely adopted *Abercrombie* spectrum, while not outcome determinative, remain a useful starting point for understanding how consumers interact with trademarks. The *Abercrombie* categories, which have had a substantial impact on the development of trademark law, accurately reflect well-understood differences between monosemes, homonyms, and polysems. My scholarship is the first to relate the *Abercrombie* categories to the regular forms of language change they embody.<sup>212</sup> Table 5 summarizes the discussion that follows, charting the relationship between *Abercrombie* categories and linguistic categories of new and ambiguous words.<sup>213</sup>

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<sup>208</sup> See *supra* notes 123–30 and accompanying text.

<sup>209</sup> See *supra* notes 123–32 and accompanying text (providing a summary of those critiques).

<sup>210</sup> See *infra* Part IV.B.

<sup>211</sup> See *supra* Part III.C.

<sup>212</sup> See generally Linford, “Generic” Trademarks, *supra* note 1.

<sup>213</sup> An earlier version of this table was first published in Linford, “Generic” Trademarks, *supra* note 1, at 134–35. See generally *id.* for a critique of how “generic” terms are not protected even when they acquire strong source significance.

Table 5: *Relationship Between Types of Language Change and Trademarks Along the Abercrombie Spectrum*

Semantic Category (relationship between existing words/meanings and new word/meaning)	Abercrombie Spectrum (relationship between mark and product offered)	Legal Consequences	
		Protectability	Inherent Strength
<u>Monoseme</u> : Only one meaning	<u>Fanciful mark</u> : Coined for use as a trademark, not derived from a pre-existing word <i>Ex.</i> : XEROX for photocopiers	Inherently protectable on first use	Presumed strong
<u>Homonym</u> : No connection between existing meanings and the new meaning	<u>Arbitrary mark</u> : Derived from a pre-existing word that has no connection with the product sold <i>Ex.</i> : APPLE for computers		
<u>Metaphor</u> : Figurative connection between existing meanings and the new sense	<u>Suggestive mark</u> : Pre-existing word with some connection to the marked product. Consumers make connection between mark and product via an “imaginative leap” <i>Ex.</i> : SKINVISIBLE for transparent adhesive bandages; GLEEM for toothpaste		Varies—some courts presume suggestive marks are weaker than arbitrary and fanciful marks
<u>Metonym</u> : Literal or contiguous connection between existing and new sense, like feature for the whole. <i>Ex.</i> : <i>Green Beret</i> from distinctive headgear worn by U.S. Army Special Forces shifts to serve as a nickname for the organization and its members	<u>Descriptive mark</u> : Pre-existing term with a clear connection to the product sold, via a direct description of a product feature <i>Ex.</i> : SEALTIGHT for fasteners	Protectable only with evidence of source significance	Presumed weak
<u>Restriction</u> : Word formerly used to describe general category narrowed to represent a prototypical member of the category <i>Ex.</i> : <i>hound</i> narrowed from any dog to large hunting dog	<u>Ex ante generic mark</u> : Word whose meaning has shifted from a class of products to one particular brand. <i>Ex.</i> : HOG for Harley Davidson motorcycles denied protection, despite evidence of shift, on grounds of trademark incapacity.	Unprotectable, even with evidence of source significance	Not considered

Generally, the phenomena observed in tracing semantic shift can also be observed as firms seek to develop trademarks. Some trademarks are formed from pre-existing words, while others are surprising and new. As the following Sections explain in more detail, these *Abercrombie* categories (fanciful, arbitrary, descriptive, and suggestive) each mirror a regular manifestation of semantic change (monosemy, homonymy, metonymic polysemy, and metaphoric polysemy). This overlap indicates that research into semantic shift may provide valuable insight into the relationship between the *Abercrombie* categories and the conceptual strength of trademarks. A thorough understanding of this relationship is particularly important in light of the fact that trademark plaintiff win rates generally mirror the conceptual strength traditionally assigned to *Abercrombie* categories<sup>214</sup>: the “weaker” the mark, the fewer the cases won by the plaintiff.<sup>215</sup>

### 1. *Monosemous Fanciful Trademarks*

At the strong end of the *Abercrombie* spectrum we find fanciful trademarks. Unlike arbitrary and suggestive marks, fanciful marks are typically unrelated to pre-existing lexemes. Words like XEROX<sup>216</sup> and KODAK<sup>217</sup> are “fanciful” in origin because they are coined specifically for use as trademarks.<sup>218</sup> It may seem puzzling at first to describe the creation of a fanciful or coined mark as a semantic shift because those marks are often described as made up from whole cloth.<sup>219</sup> Nevertheless, creating a fanciful mark requires forging a new word from existing morphemes, the smallest building blocks of language. The process

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<sup>214</sup> Beebe, *Empirical Study*, *supra* note 124, at 1637–38.

<sup>215</sup> *Id.* Beebe discounted that result as turning on the way conceptual strength of a mark feeds into commercial strength in the marketplace. *Id.* at 1639. Beebe’s dismissal might turn in part on the failure of some courts to categorize marks in reported opinions as part of a likelihood of confusion determination. *Id.* at 1635–36.

<sup>216</sup> The term XEROX is ostensibly drawn from the technical name for the photocopying process, *xerography*, itself derived from Greek words for “dry” and “writing.” *SCM Corp. v. Xerox Corp.*, 463 F. Supp. 983, 985 n.2 (D. Conn. 1978).

<sup>217</sup> See *History: George Eastman*, KODAK, <http://www.kodak.com/ek/us/en/corp/aboutus/heritage/georgeeastman/default.htm> [<http://perma.cc/6VJJ-4G3A>] (“I devised the name myself. The letter ‘K’ had been a favorite with me—it seems a strong, incisive sort of letter. It became a question of trying out a great number of combinations of letters that made words starting and ending with ‘K.’ The word ‘Kodak’ is the result.” (quoting George Eastman, founder of Kodak)).

<sup>218</sup> Eve V. Clark & Herbert H. Clark, *When Nouns Surface as Verbs*, 55 *LANGUAGE* 767, 802 (1979) (“New technologies seem to be responsible for many of the denominal verbs that are now very common—*Xerox*, *telephone*, *wire*, *radio*, and *paperclip*. In each case, a complicated situation is expressed economically in a single verb.”).

<sup>219</sup> MCCARTHY, *supra* note 17, § 11:4. There are some close calls where the creation of some fanciful marks might seem homonymous. For example, Google selected its housemark by misspelling googol, the designation for one followed by 100 zeros. Math geeks know that, but many others do not.

of creating a fanciful mark is essentially monosemous.<sup>220</sup> The mark owner adds an entirely new entry into the lexicon by coining a new word from raw linguistic material to identify its product. A fanciful mark is inherently distinctive because it has no other meaning, at least when initially coined.

## 2. *The Natural Homonymy of Arbitrary Trademarks*

Next on the *Abercrombie* spectrum we find arbitrary marks, where the word selected as a mark has pre-existing meaning that is homonymous or unrelated to the product designated.<sup>221</sup> When establishing an arbitrary mark, the trademark owner applies an existing word to a product for which the word has not been commonly used and which neither suggests nor describes any ingredient, quality, or characteristic of the product.<sup>222</sup> For example, the word “apple” is familiar to any English speaker, while the two-dimensional image of an apple can cross linguistic barriers and bring to mind the fruit to any individual who has seen an apple. When Steve Wozniak and Steve Jobs first decided to sell computers under the APPLE trademark, there was at least one established meaning of “apple,” designating a category of fruit from a particular genus of tree,<sup>223</sup> but no sense of APPLE as a brand of computer hardware and software. Neither the word apple nor the image of an apple brought to mind computers and computer programs until Wozniak and Jobs began selling personal computer kits in 1976 under the APPLE mark.<sup>224</sup> Over time, the Apple Corporation added a new meaning to the word apple. Establishing an arbitrary trademark is thus a process of creating a new homonym: a new meaning for a pre-existing word that is unrelated to that word’s established meanings.

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<sup>220</sup> See also Eric McCreedy, *Unnatural Kinds*, 40 J. PRAGMATICS 1817, 1819, 1821 (2008) (stating that trademarks “exhibit one property of quotations that has been extensively discussed: <sup>TM</sup> takes (sequences of) words and treats them as (what amount to) singular terms,” perhaps indicating that other “natural” and “unnatural kinds” should have a single name, i.e., that “name-kind mapping should be one-one”).

<sup>221</sup> See *supra* notes 180–83 and accompanying text; see also Linford, “*Generic Trademarks*,” *supra* note 1, at 136–37.

<sup>222</sup> See *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219, 1243 (D. Colo. 1976), *aff’d*, 561 F.2d 1365 (10th Cir. 1977) (quoting jury instruction regarding the nature of an arbitrary mark).

<sup>223</sup> *Apple*, n., OXFORD ENGLISH DICTIONARY, <http://www.oed.com/view/Entry/9678> [<http://perma.cc/MJ2B-X7D8>] (“The round firm fruit (a pome) of any of various wild and cultivated trees of the genus *Malus* . . . occurring in a wide variety of forms, colours, and flavours . . .”).

<sup>224</sup> OWEN W. LINZMAYER, *APPLE CONFIDENTIAL: THE REAL STORY OF APPLE COMPUTER, INC.* 7 (1999); Stephen Wozniak, *Homebrew and How the Apple Came to Be*, in *DIGITAL DELI* (Steve Detlea ed., 1984), [http://www.atariarchives.org/deli/homebrew\\_and\\_how\\_the\\_apple.php](http://www.atariarchives.org/deli/homebrew_and_how_the_apple.php) [<http://perma.cc/5AD7-CPK6>]; see also APPLE, Registration No. 1078312 (APPLE for computers and computer programs recorded on paper and tape).



### 3. *The Metonymic Connection Between the Descriptive Mark and the Product*

As described in Part II.A, a descriptive mark “forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”<sup>225</sup> Because of this close connection between the mark and its source, descriptive marks are not afforded a presumption of protectability. Instead, a descriptive term must acquire source significance prior to protection as a trademark.

The product associated with a descriptive mark is related to the word or words from which the mark is drawn in a manner that resembles metonymic polysemy.<sup>226</sup> A descriptive mark builds on a characteristic of the good or service with which it is associated, while a metonymic shift is a change based on an association or connection between concepts.<sup>227</sup> The trademark owner seeks to secure protection in a mark that best reminds consumers of the product offered under the mark. For example, a term like SEALTIGHT for fasteners describes a quality a fastener should possess, and is thus descriptive in nature.<sup>228</sup> The relationship between descriptive mark and product is contiguous and metonymic like the relationship between the Green Beret nickname and the special forces unit it identifies.<sup>229</sup>

### 4. *The Metaphoric Connection Between the Suggestive Mark and the Product*

Like a descriptive mark, a suggestive mark is derived from a word with a connection to the product identified. Instead of direct appropriation of a product feature as a source signifier, a suggestive mark is indirectly related to a feature of the product.<sup>230</sup> For example, GLEEM for toothpaste evokes the way teeth should shine after brushing, but the connection is not as direct as a word like “clean.”<sup>231</sup> Unlike a descriptive mark, the law treats a suggestive mark as “inherently distinctive” because courts perceive the connection between the mark and the product as so tenuous that consumers must make an imaginative leap to link mark and product.<sup>232</sup>

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<sup>225</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

<sup>226</sup> See also Linford, “*Generic*” Trademarks, *supra* note 1, at 138–39.

<sup>227</sup> For instance, *horn* for “animal horn” added the sense of *horn* for “musical instrument,” due to the use of some animal horns as musical instruments or warning devices. *Blank, Co-Presence*, *supra* note 168, at 182; see also *TRAUGOTT & DASHER*, *supra* note 24, at 28.

<sup>228</sup> *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 252 F.3d 1010, 1012 (8th Cir. 2001).

<sup>229</sup> See *supra* notes 25, 172 and accompanying text.

<sup>230</sup> See *supra* notes 25, 172 and accompanying text.

<sup>231</sup> See *supra* notes 25, 172 and accompanying text.

<sup>232</sup> See *supra* note 22 and accompanying text.

Suggestive marks occupy a midpoint between arbitrary and descriptive marks along the *Abercrombie* spectrum and were recognized much later than their categorical companions. Prior to the passage of the Lanham Act, descriptive marks were incapable of acquiring trademark protection. What we now call arbitrary and fanciful marks were protectable “technical” marks.<sup>233</sup> Courts were split on what to do with terms that were not clearly arbitrary nor exactly descriptive.<sup>234</sup> For example, in *Filley v. Fassett*, the Supreme Court of Missouri noted that terms which were “either descriptions or suggestive of the style, character, or qualities of” the product could not be protected as a trademark.<sup>235</sup> On the other hand, in *O’Rourke v. Central City Soap Co.*, the district court opined that marks “suggestive of some supposed advantage to be derived from using [the product], or some effect produced by its use [are] ordinarily, though not always, upheld as valid trade-marks.”<sup>236</sup> The law eventually distilled around the notion that suggestive marks, like arbitrary and fanciful marks, were inherently distinctive.<sup>237</sup> But in light of semantic shift research, suggestive marks likely fall short of inherently indicating source. Thus, the courts made the wrong call.

The process of creating a suggestive mark mirrors metaphoric polysemy. A suggestive mark is a type of metaphoric extension, not unlike the adoption of the word *crane*, for ‘a long-necked fishing bird,’ to also identify a construction machine with a long boom used to move heavy loads.<sup>238</sup> Suggestive marks operate in metaphoric relationship to the words from which they are drawn,<sup>239</sup> requiring “the consumer to exercise his imagination to reach a conclusion as to the nature of the[] goods” offered under that mark.<sup>240</sup> For example,

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<sup>233</sup> Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 WIS. L. REV. 158, 160 n.8.

<sup>234</sup> *Educ. Dev. Corp. v. Econ. Co.*, 562 F.2d 26, 29 (10th Cir. 1977) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976); and then citing *Union Carbide Co. v. Ever-Ready Inc.*, 531 F.2d 366, 378–79 (7th Cir. 1976)).

<sup>235</sup> *Filley v. Fasset*, 44 Mo. 168, 177 (1869).

<sup>236</sup> *O’Rourke v. Cent. City Soap Co.*, 26 F. 576, 578 (C.C.E.D. Mich. 1885).

<sup>237</sup> Bone, *Hunting Goodwill*, *supra* note 135, at 564 n.74 (citing AMASA C. PAUL, THE LAW OF TRADE-MARKS, INCLUDING TRADE-NAMES AND UNFAIR COMPETITION § 37 (1903) (reporting on cases that treated a suggestive mark as a technical trademark)).

<sup>238</sup> See *supra* note 166 and accompanying text.

<sup>239</sup> Metaphoric extensions are based on a specific analogous similarity between concepts. GEERAERTS, LEXICAL SEMANTICS, *supra* note 143, at 27.

<sup>240</sup> *Synergistic Int’l, LLC v. Korman*, 470 F.3d 162, 171 (4th Cir. 2006) (quoting *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1528 (4th Cir. 1984)); see also TMEP, *supra* note 20, § 1209.01(a) (“Suggestive marks . . . when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. . . . [A] descriptive term . . . immediately tells something about the goods or services.”). As Judge Friendly wrote in *Abercrombie*, “[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

SKINVISIBLE was held to be suggestive for transparent adhesive bandages because nothing about the name SKINVISIBLE directly evokes the quality of adhesion.<sup>241</sup> But SKINVISIBLE directly references the features of transparency and the skin as the surface for adhesion. The “imaginative process” used by consumers to connect a mark to the product sold is not like the process of comprehending the natural homonymy of an arbitrary mark. An arbitrary mark stands out because it is derived from a word entirely unrelated to the product offered for sale.

The SKINVISIBLE mark is one of many for which the perceived distance between the mark and the product identified is a matter of reasonable disagreement.<sup>242</sup> Courts are required to distinguish descriptive from suggestive marks because the consequences are severe, but as the next Section makes clear, trademark law mistakenly exaggerates the difference between suggestive and descriptive marks. Semantic shift research indicates that a metaphoric polyseme like a suggestive trademark enhances the connection between mark and product through processing advantages similar to those provided by a metonymic polyseme like a descriptive mark. In contrast, an arbitrary mark highlights the connection between mark and source due to the lack of connection between mark and product.

### *B. The Suggestive Mark, Cognitive Efficiency, and Inherent Distinctiveness*

This Article presumes that the dominant economic rationale—securing the information transmission function of trademarks to economize consumer search and reduce consumer confusion—is a sufficient normative justification for trademark protection.<sup>243</sup> This Section thus argues that the law correctly extends protection on first use to a fanciful or arbitrary mark and correctly withholds protection from a descriptive mark until there is evidence of source significance. But the law errs in extending protection on first use to a suggestive mark.

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<sup>241</sup> *Minn. Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 1180 (C.C.P.A. 1972).

<sup>242</sup> *See supra* Part II.B.

<sup>243</sup> *See supra* notes 32–34 and accompanying text. This Article also presumes that courts are correct to construe marks as a whole, rather than considering their component parts. If that presumption is relaxed, there are reasons to suspect that many marks currently designated as fanciful are like descriptive marks to the extent that the individual sounds that comprise those marks carry meaning that communicates product characteristics. *See* Linford, *Fanciful?*, *supra* note 122 (arguing that in light of research into sound symbolism—how individual units of sound bear meaning even in some nonsense words—the perceived differences between descriptive marks and some fanciful marks may be overstated); *see also*, e.g., Richard R. Klink, *Creating Brand Names with Meaning: The Use of Sound Symbolism*, 11 *MARKETING LETTERS* 5 (2000) (reporting two studies in which respondents perceived undisclosed products with imaginary brand names as likely to be smaller, faster, lighter (weight), softer, and/or more feminine depending on the sounds comprising the imaginary brand).

According to the economic account, trademarks are protected so they can (and to the extent that they) effectively transmit information about the source of the product to consumers and markets.<sup>244</sup> Trademarks are protected from infringing uses so that consumers can rely on the mark to more easily find and purchase the product they desire from the source they prefer. “Inherently distinctive” trademarks are likewise protected from their first use in commerce because the law views them as possessing an innate capacity to transmit information about the source of the mark. Fanciful marks are inherently distinctive because they are new words coined for use as a trademark. On first use, a fanciful mark has no meaning other than its source signifying meaning.

### 1. *Linguistic Evidence: Arbitrary Marks Are Inherently Distinctive*

Arbitrary marks are also treated as inherently distinctive because there is no connection between the word chosen as a mark and the product offered. Linguists refer to such unrelated look-alike or sound-alike words as homonyms.<sup>245</sup> Diachronic and cognitive research suggests that homonymous arbitrary marks are properly categorized as inherently distinctive because this lack of connection has measurable effects on language change over time and on how an audience processes ambiguity when a word’s multiple meanings are unrelated.

Diachronic research, which considers change in meaning over time, observes a resistance to homonymous change but a disposition toward polysemous shift.<sup>246</sup> Semantic shift is most commonly channeled towards change that adds related meanings to existing words, rather than unrelated or conflicting meanings.<sup>247</sup> On the other hand, moving from one meaning to an unrelated meaning for the same word is not cognitively efficient. The lack of connection between the concepts impedes recognition and slows the ability of the audience to process ambiguity.

Cognitive research likewise indicates that homonymy does not facilitate the resolution of ambiguity. Homonyms offered no processing advantage compared to control words.<sup>248</sup> Study participants processed homonymous meanings like they processed dissimilar and unrelated words, rather than as senses of the same word.<sup>249</sup> Participants appeared to treat two homonymous terms as entirely distinct linguistic units. This research suggests it is difficult to simultaneously construe an ambiguous word using two homonymous meanings.<sup>250</sup> The brain

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<sup>244</sup> See *supra* note 135 and accompanying text.

<sup>245</sup> See *supra* Part IV.A.2.

<sup>246</sup> See *supra* Part IV.A.2.

<sup>247</sup> See *supra* notes 147–51 and accompanying text.

<sup>248</sup> See Klepousniotou, *Processing*, *supra* note 134, at 214.

<sup>249</sup> *Id.* at 215.

<sup>250</sup> See *supra* note 183 and accompanying text.

treats them like conflicting meanings.<sup>251</sup> Thus homonyms like *bank* for the land bounding a river and for a financial institution are likely to be treated as entirely different words, and exposure to one meaning can make it difficult to perceive the other. Likewise, *apple* for fruit and APPLE for computers are likely to be treated as entirely distinct concepts.

The addition of an unconnected meaning to a pre-existing word seems somewhat unnatural, not unlike the scene in the movie *Mean Girls* where one member of a clique tries to start the trend of using “fetch,” as in the phrase “That is so fetch,” as a synonym for “cool” or “awesome.” She is quickly shot down by the leader of the clique with a frosty “Stop trying to make ‘fetch’ happen. It’s not going to happen.”<sup>252</sup>

The unfamiliar nature of a homonymous addition does not make the creation of an arbitrary mark impermissible. Indeed, this jarring juxtaposition is what makes the arbitrary mark inherently distinctive. The difficulty of making the cognitive jump from an arbitrary mark to the associated product is a feature, not a bug, in the trademark regime. The lack of connection between mark and product helps the arbitrary mark stand out as a signifier of source.

Using *apple* to designate a computer is inherently distinctive because it is difficult for the audience to process *apple* in the context of computer sales as anything other than a new, source-signifying way to use a recognizable combination of letters. That lack of relationship jars the audience in a way that signals the word chosen does new work as a trademark—an identifier of source—rather than to identify the product sold. The initial disconnect between mark and product forces the public to see the term as a trademark. This disconnect between original and new meanings suggests that consumers are likely to see a trademark like APPLE for computers as inherently source signifying, just as they see monosemous fanciful marks as inherently source signifying.

## 2. Linguistic Evidence: Descriptive Marks Lack Inherent Distinctiveness

Unlike an arbitrary mark, a descriptive mark is seen to lack the native capacity to indicate source from first use. Under the current doctrine, a descriptive mark, which is derived from a characteristic of the product offered for sale, does not inherently distinguish source. Evidence from the semantic shift literature supports this categorization. As discussed above, descriptive marks have a metonymic relationship with the product offered.<sup>253</sup> Semantic shift literature shows that an audience can process ambiguity between polysemous

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<sup>251</sup> Some scholars even posit that homonymous meanings are stored as separate words in the mental lexicon. *See supra* note 192 and accompanying text.

<sup>252</sup> MEAN GIRLS (Paramount Pictures 2004).

<sup>253</sup> *See supra* Part IV.A.3.

senses—especially between metonyms—more easily than it can process jarring homonymous ambiguity.

First, the diachronic evidence suggests a preference for semantic shift where there is a close metonymic connection between existing and new meanings. For example, the shift in Gallic French from *faisan* for ‘pheasant’ to *azan* for ‘rooster’ added some ambiguity to language: sound-alikes can confuse an audience. The shift was nevertheless preferable to the previous ambiguity between *gat* for ‘rooster’ and for ‘cat.’<sup>254</sup> Scholars like Geeraerts argue that an addition of meaning that connects old and new meanings is conceptually efficient, and thus more readily accepted by readers and listeners than homonymous ambiguity.

Cognitive research also points to a connection between metonymic meanings that helps the audience resolve ambiguity. As mentioned above, early linguistic theories posited that any word with many meanings would be recognized more easily than a word with a single meaning. Recent research has refined that hypothesis. For example, Klepousniotou reports that when an ambiguous word shares multiple related meanings, the word is easier for readers and listeners to recognize. Study participants exposed to polysemes demonstrated statistically significant advantages in processing ambiguity, compared to their speed in processing other types of ambiguous or monosemous words.<sup>255</sup> This advantage aided participants in distinguishing real words from random assortments of letters, and appeared to prime or subconsciously prepare study participants to remember or recognize related meanings.<sup>256</sup> Unlike homonymous words, which convey no processing benefit and appear unconnected in the minds of survey participants, the research suggests that exposure to one meaning can trigger recognition of another related, or polysemous meaning.<sup>257</sup> The effect is strongest when there is a metonymic connection between the meanings.<sup>258</sup> The metonymic connection between descriptive mark and product sold is sufficiently close that the law properly concludes a descriptive mark is not inherently distinctive. Thus the law appropriately requires evidence of acquired distinctiveness before protecting a descriptive mark as a unique source signifier.

### 3. *Linguistic Evidence: Suggestive Marks Are Not Inherently Distinctive*

As discussed above, suggestive marks began as a makeweight between descriptive and arbitrary marks.<sup>259</sup> Courts wrestling with the question of how to

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<sup>254</sup> See *supra* notes 150–51 and accompanying text.

<sup>255</sup> See Klepousniotou, *Processing*, *supra* note 134, at 212–17.

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

<sup>257</sup> *Id.*

<sup>258</sup> Study participants exposed to metonymic polysemes demonstrated clear processing advantages, not only over control words in a variety of experimental settings, but also over ambiguous homonyms and metaphoric polysemes. *Id.* at 214.

<sup>259</sup> See *supra* notes 233–37 and accompanying text.

treat a suggestive mark eventually grouped them with fanciful and arbitrary marks. The law concedes a connection between the suggestive mark and the product offered, which is strikingly similar to the connection between the descriptive mark and the product sold. A descriptive mark lacks inherent distinctiveness due to the connection between mark and product. But the law perceives a larger gap between the suggestive mark and the product, a gap so wide that courts and scholars refer to the “imaginative leap” that the consumer must take to connect the mark to the product.<sup>260</sup> The law thus designates the suggestive mark as inherently distinctive, capable of standing out as a source signifier from its first use in commerce.

Research into semantic shift indicates the current doctrine makes too much of this imaginative leap. The case for treating a suggestive mark as inherently distinctive is much weaker than the case for an arbitrary mark. Grouping metaphoric suggestive marks with homonymous arbitrary marks indicates a failure to recognize how an audience processes metaphors and homonyms. A suggestive mark is less likely to be perceived as a source signifier from the consumer’s first exposure, because the metaphoric connection between mark and product has a stronger effect than the law currently recognizes. An arbitrary mark is inherently distinctive because the lack of relationship is jarring. A suggestive mark does not jar; it hints.

Like a descriptive mark, a suggestive mark is derived from a feature of the product sold. A suggestive mark shares many properties with a descriptive mark. Those similarities indicate that suggestive marks likely accelerate a connection in the minds of consumers between mark and product more readily than between mark and source.

Both descriptive and suggestive marks have a polysemous relationship to the product offered,<sup>261</sup> which semantic shift research indicates aids in processing and recognizing multiple meanings. First, according to diachronic research, a metaphoric relationship between two meanings of the same word is cognitively efficient and thus a relatively easy form of ambiguity for the reader or listener to process, much like a metonymic relationship. Semantic shift is thus commonly channeled towards polysemous change, which includes metaphoric shift. For instance, Geeraerts notes the cognitive efficiency of shifting away from *gat* to represent both ‘cat’ and ‘rooster,’ and instead adding rooster as a second meaning to *bigey*.<sup>262</sup> *Bigey* already signified a parish curate, so the addition of rooster decreased formal efficiency.<sup>263</sup> Nevertheless, the metaphoric connection between the behavior of a curate in his parish and a rooster in his yard made the addition cognitively efficient.<sup>264</sup>

Second, cognitive research by Klepousniotou and others indicate that, like metonyms, metaphors are processed as related senses of a single word stored

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<sup>260</sup> See *supra* note 22 and accompanying text.

<sup>261</sup> See *supra* Part IV.A.3–4.

<sup>262</sup> See *supra* notes 147–48 and accompanying text.

<sup>263</sup> See *supra* note 148 and accompanying text.

<sup>264</sup> See *supra* notes 148–49 and accompanying text.

together in the mental lexicon of the audience, and thus quickly accessed and recognized.<sup>265</sup> In other words, readers and listeners see metaphorically connected meanings as different aspects of the same word. Klepousniotou reports that in certain contexts, study participants exposed to metaphoric polysemes process those words more easily than words with multiple homonymous meanings, and more easily than words with one meaning.<sup>266</sup> While the cognitive processing benefit conferred by metaphors is not as consistent as the benefit conferred by metonyms, both types of polysemous relationships confer processing benefits that a homonymous relationship does not.

The diachronic and cognitive research indicates that the suggestive mark is connected to the product offered through mechanisms that enhance product salience more than source significance. The law may thus err in presuming that a suggestive mark is inherently distinctive. If the economic search cost account favors marks that are inherently distinctive with relatively automatic protection, the law should not extend that favor to suggestive marks. In addition, the effectiveness of the metaphoric connection between suggestive mark and product may mean that suggestive marks benefit from some of the anti-competitive advantages that caution against automatic protection of descriptive trademarks. The next Section considers this possibility.

#### 4. *Suggestive Marks and Cognitive Free Riding*

Trademark law puts hurdles before the putative owner of a descriptive mark because of the danger that the mark owner may be able to “free ride” on an association between mark and product.<sup>267</sup> As Lisa Ramsey notes, the descriptive mark itself “is attribute-identifying . . . provid[ing] information about the qualities and characteristics of the product.”<sup>268</sup> This effect is independent of concerns about language depletion.<sup>269</sup> Whether or not the descriptive term is the only or the best term available, the business that selects the descriptive term “is, in effect, free-riding off the attribute-identifying value of the descriptive term,”<sup>270</sup> at least until the mark acquires distinctiveness. This benefit is consistent with the significant advantage that metonymic polysemes convey in processing linguistic ambiguity. It is thus reasonable to ask the mark owner to establish some level of source significance before protecting the descriptive mark. But as the semantic shift research indicates, the same processing advantages manifest in metaphoric connections like the link between a suggestive mark and the product offered. While a metaphoric connection is not

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<sup>265</sup> See *supra* note 158 and accompanying text.

<sup>266</sup> Klepousniotou, *Processing*, *supra* note 134, at 214–16.

<sup>267</sup> See *supra* note 118 and accompanying text.

<sup>268</sup> Ramsey, *supra* note 94, at 1155.

<sup>269</sup> See *supra* notes 86–95 and accompanying text (providing a summary of language depletion arguments).

<sup>270</sup> Ramsey, *supra* note 94, at 1155.



as obvious or quite as strong as a metonymic connection, it is often highly effective at bringing connected meanings to mind. For a suggestive mark, the metaphoric connection links mark and product, not mark and source. The adoption of a suggestive mark may thus also trigger problematic free riding by the mark owner,<sup>271</sup> who may benefit from the tendency of consumers to embrace metaphoric shift.

In light of the semantic shift research, the law should reconsider the suggestive–descriptive line. Suggestive marks are not as naturally distinctive as the law presumes. In fact, the suggestive–descriptive line may be difficult to draw precisely because in many cases, the difference is more imagined than real. Suggestive marks occupy the middle ground between arbitrary and descriptive marks, but grouping suggestive marks with arbitrary marks is inconsistent with current research on how those marks are likely to be processed. Thus, a suggestive mark should not be treated as inherently distinctive. The following table summarizes the findings and proposed changes to the law. The next Section examines potential changes in more detail.

Table 6: *Differences Between Descriptive, Suggestive, and Arbitrary Trademarks in Light of Cognitive Literature*

<i>Abercrombie</i> Category	Linguistic Relationship	Measured Processing Advantage	Proposed Bar to Protectability
Descriptive	Metonymic Polysemy	Consistent processing advantage in lexical tasks	High bar—proof of source significance
Suggestive	Metaphoric Polysemy	Significant processing advantage in lexical tasks in some contexts	
Arbitrary	Homonymy	No processing advantage in any lexical tasks	Low bar— inherently distinctive on first use

### C. *Resetting the Inherent Distinctiveness Line*

As summarized in Part III, research into language change tells us how and why words gain new meanings, and how speakers and listeners deal with the ambiguity created when a word means more than one thing. The previous Section argued that a suggestive metaphoric mark is much less likely than an arbitrary mark to instantly signal its status as a trademark. On the other hand, a suggestive mark benefits from some of the same processing advantages as a

<sup>271</sup> See *supra* notes 118–20 and accompanying text.

descriptive metonymic mark.<sup>272</sup> Thus, the law should not treat a suggestive mark as inherently distinctive.

Recognizing that suggestive marks are not inherently distinctive should drive several changes to the law. The most dramatic potential change would be to treat only fanciful and arbitrary marks as inherently distinctive. A mark derived from a pre-existing word would be treated as inherently distinctive, and thus protected without evidence of source significance, only if there was no connection between existing meanings or senses of the mark selected and the product sold. Arbitrary marks would thus continue to be treated as inherently distinctive, but suggestive marks would not. Suggestive marks would instead be treated like descriptive marks. Protection would thus extend to a suggestive mark only with some indication that the mark had acquired a secondary, source-signifying meaning. The inquiry could work as it currently works for descriptive marks.<sup>273</sup>

Redrawing the suggestive–descriptive line would require a statutory change. Currently, section 2 of the Lanham Act,<sup>274</sup> the statute governing federal trademark protection, states that a trademark cannot be refused registration unless, *inter alia*, the mark is “merely descriptive of” the applicant’s product.<sup>275</sup> A suggestive mark is not inherently distinctive, but courts and trademark examiners would balk at defining it as “merely descriptive.” Thus, under the current statute, a suggestive mark may be registered upon first use, and federal trademark registration conveys nationwide rights in the mark.<sup>276</sup> The statute could be amended so that a trademark could be refused registration if the mark either is not inherently distinctive or has not acquired secondary meaning, with “inherently distinctive” defined as a mark with no inherent connection between the product and mark selected (or more categorically, as an arbitrary or fanciful mark).

Requiring evidence of source significance would delay some applications for trademark protection.<sup>277</sup> For many applicants, a denial on descriptiveness grounds is overcome by waiting for five years. After five years of relatively exclusive use, the law presumes that a descriptive mark has acquired distinctiveness.<sup>278</sup>

But treating a suggestive mark exactly like a descriptive mark might be an overcorrection. As discussed above, the cognitive research shows stronger and more consistent processing advantages for metonymic polysemes than

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<sup>272</sup> See *supra* Part IV.B.

<sup>273</sup> See *supra* Part II.A.

<sup>274</sup> 15 U.S.C. § 1052 (2012).

<sup>275</sup> *Id.* § 1052(e)(1).

<sup>276</sup> *Id.* §§ 1072, 1114.

<sup>277</sup> See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) (noting that “adding a secondary meaning requirement [to all claims of protectable trade dress] could have anticompetitive effects, creating particular burdens on the startup of small companies”).

<sup>278</sup> 15 U.S.C. § 1052(f).

metaphoric polysemes.<sup>279</sup> While a suggestive mark is not inherently distinctive like an arbitrary mark, it may not consistently convey the same processing advantages as a descriptive mark. Thus it might be safe to protect a suggestive mark earlier or more broadly than a descriptive mark, without protecting it from first use in commerce. If so, the law might properly continue to differentiate between suggestive and descriptive marks in some contexts.

If descriptive marks confer a greater processing advantage than suggestive marks, even though the latter are not “inherently distinctive,” it could be appropriate to set a lower bar for suggestive marks to acquire distinctiveness than descriptive marks. This might be accomplished in trademark litigation by imposing a lower standard for finding acquired source significance if the mark is suggestive rather than descriptive.<sup>280</sup> The law might also differentiate between descriptive and suggestive marks in commercial strength inquiries that constitute part of the standard trademark infringement analysis. For example, courts are currently split over whether a suggestive mark is entitled to a presumption of high commercial strength. A study conducted by Barton Beebe suggests that likelihood of confusion increases as the inherent strength of the mark increases along the *Abercrombie* scale. Beebe reported that courts found likelihood of confusion more frequently in cases where the senior user’s mark was categorized as suggestive compared to cases where the mark was categorized as descriptive.<sup>281</sup> Perhaps then a suggestive mark would have to provide evidence of secondary meaning before qualifying for protection, but the lack of direct connection between mark and product could serve as a thumb on the scale in favor of commercial strength grounded in conceptual strength.

The law might also allow the mark owner to register a suggestive mark with less evidence of source significance compared to, or after a shorter duration of substantially exclusive use than a descriptive mark. Pursuant to section 2(f) of the Lanham Act, substantially exclusive use of a descriptive mark for five years

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<sup>279</sup> See *supra* Part IV.B.

<sup>280</sup> Some courts find that a survey response indicating between thirty to thirty-five percent consumer recognition is sufficient to establish commercial strength for a suggestive mark but insufficient for descriptive marks. See, e.g., *Spraying Sys. Co. v. Delavan Inc.*, 975 F.2d 387, 394 (7th Cir. 1992).

<sup>281</sup> Beebe, *Empirical Study*, *supra* note 124, at 1638. The senior user won in nearly sixty percent (.588) of the cases where the mark was categorized suggestive, and in roughly twenty-five percent (.258) where the mark was categorized as descriptive. Courts concluded that the senior user’s mark was strong in exactly the same proportion (.588 to .258). *Id.* A follow-up study by Kevin Blum and his coauthors reported that there is not a significant difference in how courts handle suggestive and descriptive marks in every context. See *generally* Blum et al., *supra* note 124. For example, the Blum study reported a negative correlation in Beebe’s data between a finding that the senior user’s mark is suggestive or descriptive and a finding that the alleged infringer’s mark is similar to the plaintiff’s mark and thus likely to confuse consumers. *Id.* at 24. Blum and his coauthors concluded that this correlation might imply that courts require a similar degree of similarity between the senior and junior marks in order to find that similarity favors a likelihood of confusion whether the mark is suggestive or descriptive. *Id.*

is *prima facie* evidence that the mark has acquired source significance.<sup>282</sup> While five years looks like a unitary term, trademark examiners are actually instructed to apply differing levels of scrutiny to different types of marks when considering a section 2(f) application to register a trademark. For example, applications to register trade dress or marks derived from personal names do not automatically benefit from the five-year presumption.<sup>283</sup> The USPTO could likewise preserve some space between descriptive and suggestive marks by internally distinguishing between them. The five-year presumption in section 2(f) could also be amended to allow the trademark office to accept fewer than five years of substantially exclusive use as *prima facie* evidence that a suggestive mark has acquired source significance.

Some scholars argue that despite its flaws, *Abercrombie* should be retained as it stands because it serves as a good proxy for consumer perception in many cases,<sup>284</sup> and because the costs of changing the spectrum are too high.<sup>285</sup> It is true that requiring evidence of secondary meaning in more cases would not be costless. Mark owners hoping to establish secondary meaning must gather evidence of sales, advertising budgets, and the length of the mark's relatively exclusive use in the marketplace.<sup>286</sup> Courts also expect consumer surveys to establish source significance and those surveys can be expensive to generate.<sup>287</sup>

While these costs are not insignificant, requiring evidence of secondary meaning before protecting a suggestive mark may not cost as much as some critics fear. Many litigants already present consumer surveys into evidence because without such evidence, some courts express skepticism of the litigant's claim.<sup>288</sup> And requiring courts and examiners to distinguish between suggestive and descriptive marks, as they must under the current regime, is also costly due to the difficulty of drawing the suggestive–descriptive line.<sup>289</sup> In fact, some courts faced with classifying a mark along the suggestive–descriptive line

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<sup>282</sup> See *supra* note 274 and accompanying text.

<sup>283</sup> Linford, *Adverse Possessor*, *supra* note 52, at 724.

<sup>284</sup> Bone, *Hunting Goodwill*, *supra* note 135, at 558.

<sup>285</sup> Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1290 n.41 (2011).

<sup>286</sup> See, e.g., *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir. 1976).

<sup>287</sup> See, e.g., Lee Goldman, *The World's Best Article on Competitor Suits for False Advertising*, 45 FLA. L. REV. 487, 519 (1993) (“The survey requires considerable time and expert expenses that are not reimbursable as part of an award of costs.”); Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305, 1340 (2011) (“[C]onsumer surveys are expensive, putting relief from truly misleading claims out of the reach of smaller businesses.” (footnote omitted) (citing *inter alia* *Lon Tai Shing Co. v. Koch + Lowy*, No. 90-4464, 1990 U.S. Dist. LEXIS 19123, at \*58 n.15 (S.D.N.Y. Dec. 14, 1990) (stating that the 1990 cost of conducting a proper consumer survey in a trademark dispute could reach \$65,000))).

<sup>288</sup> See, e.g., *Universal City Studios, Inc. v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1478 (S.D.N.Y. 1986) (holding that absence of surveys is evidence that actual confusion cannot be shown). *But see* *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903, 908 (7th Cir. 1986) (holding that survey evidence is not required to secure a preliminary injunction).

<sup>289</sup> See *supra* Part II.

prudentially assume the mark is descriptive and then analyze evidence of source significance, perhaps to reduce the likelihood that the decision will be reversed.<sup>290</sup>

While there is reason to doubt the inherent distinctiveness of a suggestive mark, it is nevertheless possible that courts would resist even a modest change to the status quo vis-a-vis suggestive marks.<sup>291</sup> The law has treated suggestive marks as inherently distinctive for so long that the contours of a direct inquiry into whether a suggestive mark has acquired source significance might continue to follow that predisposition. We might see the same resistance to change even if Congress embraced one of the statutory revisions outlined above. The phenomenon has been observed in other areas of intellectual property law. For example, Clarisa Long has documented a tendency by federal courts to resist application of the Federal Trademark Dilution Act and refuse to find an infringement of the anti-dilution right.<sup>292</sup> Likewise, courts considering a forfeiture of federal copyright protection under the 1909 Copyright Act preferred to find that potentially divestive publication of a copyrighted work was actually a disclosure to a limited group that did not foreclose subsequent copyright protection.<sup>293</sup>

I make one other brief observation, which cannot be fully developed here. If the status quo holds, and trademark law continues to treat suggestive marks as inherently distinctive, the evidence on semantic shift should encourage mark owners to pursue suggestive marks over descriptive marks. Lawyers frequently counsel clients to select fanciful or arbitrary marks because if the mark is contested during litigation, a costly inquiry into source significance can sometimes be avoided.<sup>294</sup> Marketing experts often counsel clients to do exactly the opposite and select a mark as close to the generic line as possible because those marks are seen as easier to fill with trademark meaning.<sup>295</sup> Marketing experts argue that a descriptive mark will help consumers make a connection between product and source, and thus provide the mark owner with a leg up in its communicative efforts. The literature on semantic shift indicates that the metaphoric connection between a suggestive mark and the product sold can have similar benefits. Producers might therefore benefit from selecting a suggestive

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<sup>290</sup> See, e.g., *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 936 n.16 (4th Cir. 1995) (“Even if ‘Lone Star’ were deemed descriptive, the evidence of actual confusion certainly demonstrates that the mark has acquired secondary meaning in this case.”).

<sup>291</sup> Cf. Linford, *Adverse Possessor*, *supra* note 52, at 764–65.

<sup>292</sup> Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1032 (2006).

<sup>293</sup> Jake Linford, *A Second Look at the Right of First Publication*, 58 J. COPYRIGHT SOC’Y U.S.A. 585, 605–10 (2011); cf. Andrew Gilden, *Copyright Essentialism and the Performativity of Remedies*, 54 WM. & MARY L. REV. 1123, 1149–50 (2013).

<sup>294</sup> See, e.g., Julia Anne Matheson, *Missing the Mark: The Top 10 Trademark Mistakes in Advertising Campaigns*, TRADEMARK WORLD, Oct. 2008, at 41, 44 (“While the selection of a descriptive mark might make initial promotional efforts easier, it might prove a poor decision in the long run due to the difficulty of enforcing the mark against competitors.”).

<sup>295</sup> *Id.*

mark that will more effectively connect the mark to the product sold than an arbitrary mark, but in which it can secure protection more readily than in a descriptive mark.<sup>296</sup>

For those worried about language depletion as the primary reason to cabin protection for descriptive trademarks, a preference by producers for suggestive over descriptive marks would also be welcome. While we lack evidence about the ultimate number of potential suggestive marks that any mark owner could adopt, it is likely more than the number of relevant descriptive marks.<sup>297</sup> Thus, encouraging mark owners to favor suggestive over descriptive marks might reduce the threat of language depletion and the competitive harms that could spring from protecting descriptive marks.

While I acknowledge the difficulty of implementing the proposals outlined above, the semantic shift research calls into question the current protection of a suggestive mark on its first use in commerce. Trademark law is justifiable to the extent that it organizes the hierarchy of protection according to the processing costs of building source significance in a given word chosen as a mark. But trademark law draws too sharp a distinction between suggestive and descriptive marks, ignores the processing advantage that a suggestive mark may provide, and overestimates the ability of the suggestive mark to clearly signal source significance from its first use in commerce.<sup>298</sup> It may be possible to preserve some differences between suggestive and descriptive marks, and treat suggestive marks as a truly unique category. But if suggestive marks must be categorized either with arbitrary and fanciful marks or with descriptive marks, they should be classified with descriptive marks and denied protection until there is evidence of source significance.

## V. CONCLUSION

Trademark law awards protection based in large part on the inherent or conceptual strength of the mark. Courts use the *Abercrombie* spectrum as the main rubric for determining the conceptual strength of a given word mark. Investing a trademark with source-signifying meaning is a type of semantic shift, and research into semantic shift can thus clarify trademark law's virtues and limitations by providing a toolkit for reevaluating trademark law's presumptions about consumer perception.

While the *Abercrombie* spectrum has recently come under attack, semantic research justifies a limited defense for the spectrum. The types of language change recognized in the semantic shift literature, and the effects of different types of ambiguous words on language processing, indicate there are measurable differences in how consumers perceive words with multiple meanings. So long as the *Abercrombie* spectrum aligns with those findings,

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<sup>296</sup> My thanks to Fred Abbott for his thoughts on this point.

<sup>297</sup> See *supra* Part II.C.1.

<sup>298</sup> Seth Oranberg provided a valuable sounding board for framing this argument.

applying the spectrum will help trademark law meet its stated goal of reducing consumer search costs by ensuring trademarks can communicate accurate information about the source of the product, and therefore its quality, to consumers. This analysis not only sheds new light on the continued viability of the *Abercrombie* spectrum, but also highlights a key target for legal reform. Semantic shift literature calls the current suggestive–distinctive line into question.

The creation of a suggestive mark is a metaphoric semantic shift, which trades on audience predisposition towards cognitive efficiency. The current contours of the *Abercrombie* spectrum fail to recognize the power of that connection. Trademark doctrine mistakenly lumps suggestive and arbitrary marks together as inherently distinctive. The semantic shift literature provides evidence that arbitrary marks likely stand out as source-signifying from their first use in commerce. But the same is not true for suggestive marks. Suggestive and descriptive marks are not identical, but their similarities outweigh their differences, and those differences do not justify treating suggestive terms as inherently distinctive. If trademark law aims to distinguish between marks that automatically signal source and those that do not, and to require some evidence of source significance before protecting a mark with a strong connection to the product offered, then the inherent distinctiveness line should be redrawn.

