

Abstract:
Confronting the Genericism Conundrum

By
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Recent lawsuits and articles have drawn attention to a growing issue in intellectual property law, the aggressive and arguably abusive tactics of intellectual property (“IP”) rights holders. Indeed in the trademark context, some maintain and there are arguments to support the idea that trademark holders bring these actions as a means of manipulating the public through direct control of the public’s ability to use language. Nonetheless, if one supposes for a moment that trademark holders and their counsel are acting at some level of good faith and are rational, it may be that something else in the law itself drives this otherwise questionable behavior. This paper argues that the doctrine of genericism—under which a court may determine a previously valuable mark is or has become generic, thus losing all trademark status and value—as it is currently applied forces the trademark holder to police her rights in this extreme manner for fear of losing her mark.

Specifically, this paper investigates the theoretical and historical evolution of the doctrine and posits that current genericism doctrine has strayed far from its roots, which are in consumer understanding in the marketplace and enhancing competition, and now concerns itself with an inappropriate property type of analysis that places great weight on non-commercial and/or non-competitive trademark use contexts (e.g., dictionary entries, newspapers, noncompetitive third-party uses, etc.). This focus leads to inefficient results, i.e., trademark holders engaging in extensive advertising, letter campaigns, and litigation to try to protect the mark and prevent it from being deemed generic.

As such this paper argues that the doctrine should be re-anchored to focus on the mark’s ability to act as a source identifier for the consumer in commercial contexts. Re-focusing genericism on *consumer* contexts rather than non-consumer, expressive contexts will allow the analysis to embrace a more sophisticated, broad understanding of trademarks. This approach recognizes a term’s ability to perform more than one function in language depending on the user of the term and the context of the term’s use (i.e., commercial and non-commercial). In addition, this revised understanding of genericism would undermine trademark holders’ ability to claim the need to engage in what would otherwise be frivolous and/or abusive enforcement strategies, because they could no longer hang their collective hat on the excuse that they were required to do so to avoid falling victim to genericism. In short, this retooling of the doctrine would allow trademark owners to enjoy the full benefits of the source identifying functions of their marks while at the same time creating a space in which the public may enjoy full use of the terms without fear of reprisal by mark owners.

Confronting the Genericism Conundrum[†]

By

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Introduction

Do you Yahoo!?! Did you Google someone or something today? Use a Kleenex? If so, how did you understand the terms Yahoo!, Google, or Kleenex? Did they mean a general experience or product or did they signify a specific product or service? Maybe the significance depended on the context in which you used the term. If you were buying tissue, you may have meant specifically Kleenex,¹ or you may have used the term to mean any tissue, or you may have meant the term to be both. That is, you may have thought, “I need Kleenex” (substituting the term for tissue), reached the aisle with tissues, and then discerned between Kleenex tissue and its competitors because at that point—the commercial point—the brand² mattered to you.

Insofar as you used any of the terms in a general way to indicate a product or service class rather than a specific product or service, one group would be quite upset.

That group is the trademark holders, because such uses may lead to a finding that the

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¹ Note that, when using Microsoft Word, typing “kleenex” with a lower case “k” causes the autocorrect function to capitalize the word to signify that it is a proper noun.

² The terms “trademark,” “mark,” and “brand” are used interchangeably throughout this article. Although almost anything may function as a trademark (e.g., color, smell, sound), this article focuses on word marks and the way they function as part of language. *See, e.g.,* Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159 (1995) (holding that the green and gold color of dry cleaning press pads was a protectable trademark); *Id.* at 162 (noting the registration of NBC’s three chimes as a trademark); *In re Clarke*, 17 U.S.P.Q. 2d 1238, 1240 (T.T.A.B 1990) (allowing registration of plumeria blossom-fragranced thread); *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978) (ringing made by “ship’s bell clock” registrable with acquired distinctiveness).

trademark has become generic. Once a term is deemed generic, that is, the general term used to refer to a product or service category, the formerly valuable mark loses its ability to function as a trademark. When that happens, the mark, which may have been highly valuable to the trademark holder, becomes essentially worthless.

As one can imagine, trademark holders who invest considerable sums of money in developing and protecting their marks do not wish to find their marks deemed generic. Rather, a company's marketing goal is to build brand dominance to the point of ubiquity, so that the brand is the first thing on a consumer's mind when considering a purchase of a particular type of good.³ Further, the brand identifies the company and/or its products for the consumer, and ideally conveys (hopefully positive) information as well. Put differently, the trademark holder's goal is to build and maintain consumer awareness of the trademark so that consumers come to see the trademark as a sign of "consistent source and quality."⁴ Indeed, one of the touchstones of trademark law is the idea that "[t]he value of a trademark is the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand. . . ."⁵

Thus, in this paper we address the related concepts of genericism and genericide. We use the term "genericism" to refer to the over-arching doctrine applied by courts to determine whether a word or term should be deemed "generic" and hence incapable of

³ On brand building and its importance in general, see WILLIAM J. MCEWEN, *MARRIED TO THE BRAND* (2005); see also MICHAEL J. SILVERSTEIN & NEIL FISKE, *TRADING UP: WHY CONSUMERS WANT NEW LUXURY GOODS AND HOW COMPANIES CREATE THEM* (2005).

⁴ Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 789 (1997).

⁵ William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) [hereinafter Landes & Posner, *Trademark Law: An Economic Perspective*]; accord *Qualitex Co.*, 514 U.S. at 163-64 ("[T]rademark law. . . reduces the customer's costs of shopping and making purchasing decisions, for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.") (emphasis in original and internal citations omitted).

functioning as a trademark. Genericide is really a subset of genericism and refers to the process by which a mark that was once highly valuable and unquestionably protectable loses all trademark status and value. As such, genericism encompasses genericide but also covers broader issues related to this area of trademark law. Both doctrines have flaws that lead to incoherence, inefficiencies, and undesirable behaviors.

Under current trademark doctrine a business person may choose an arguably descriptive mark—one which describes the attributes of the product or service to which it is attached—and invest in her mark so that it acquires secondary meaning. When that occurs the term is considered source identifying and thus can be a trademark. Yet under current genericism doctrine, the same mark holder may discover that the mark is considered “generic” and hence invalid only *after* creating goodwill associated with the mark.

Business owners who chose arbitrary or fanciful names face an inverse problem. Arbitrary or fanciful marks such as Xerox or Yahoo! do not need to develop secondary meaning; such terms are source-identifying at the outset (i.e., inherently distinctive). Still, that source identifying quality can be lost, if the mark is used in a manner that eliminates its distinctiveness.⁶ Thus under the doctrine of genericide mark holders are required to “police” their marks and failure to do so may lead to a court finding that the source-identifying function of the mark no longer exists.⁷ However, under the current doctrine not only uses by competitors in commercial contexts can show that the mark has lost its

⁶ Section 45 of the Lanham Act provides that “[a] mark shall be deemed to be ‘abandoned’ . . . [w]hen any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used. . . .” 15 U.S.C. § 1127 (2005).

⁷ *Id.*; see also Xuan-Thao N. Nguyen, *Nationalizing Trademarks: A New International Trademark Jurisprudence?*, 39 WAKE FOREST L. REV. 729, 740 & n.40 (2004) (discussing trademark policing).

source-identifying quality; uses by *non-competitors* in *expressive* or *informative* contexts (such as newspapers or dictionaries) are taken as evidence of the death of the mark. This approach poses serious problems because it requires (or, at the very least, encourages) trademark holders to pursue expensive and perhaps harmful if not quixotic strategies, ranging from letter campaigns to lawsuits, to attempt to control the manner in which society uses language. If mark holders do not try to prevent these expressive, non-commercial uses, a court may rely on such evidence to show that the mark has morphed from a valuable intellectual property asset into a communal term with no value as a mark.

These policing efforts by trademark holders may impinge on another important interest: the public's ability to use and adapt language as it sees fit.⁸ Much has been written about the arguably abusive tactics of trademark holders who aggressively enforce their rights.⁹ Indeed, in the trademark context some maintain—and there are arguments to support—that trademark holders attempt to manipulate the public through direct control of the public's ability to use language.¹⁰ Those wishing to protect the expressive aspects of language assert that speech interests should trump a mark holder's ability to control and protect her mark from public uses, even uses that under current doctrine could lead to the term losing its value as a mark.¹¹

⁸ See notes 234-245 and accompanying text.

⁹ See e.g., K.J. Greene, *Abusive Trademark Litigation and the Incredible Shrinking Confusion Doctrine—Trademark Abuse in the Context of Entertainment Media and Cyberspace*, 27 HARV. J.L. & PUB. POL'Y. 609 (2004); Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031 (2005).

¹⁰ See generally Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 406-410 (1990) (tracing the shift to a pure property approach to trademark rights and noting the way in which this shift limits the potential for expressive use of trademarks); Greene, *supra* note 9 (suggesting limitations to curb abusive trademark litigation practices).

¹¹ See Dreyfuss, *supra* note 10, at 418-19 (arguing that when a term is required for expressive needs and no other term is available that use must be allowed).

We argue that these explanations, at best, do not tell the whole story. If we are to address the problems caused by current genericism doctrine and its apparently attendant abusive trademark litigation, we should understand the issue from both sides of the fence: First, what is the mark holder’s perspective regarding trademark protections? Second, what is the history of and rationale behind genericism doctrine? Third, when must speech interests (if ever) trump a mark holder’s ability to control and protect her mark? By investigating these areas it appears that genericism doctrine may be redeemable such that both trademark and speech interests may be satisfied.

Specifically, this paper posits that current methods for determining whether a term is generic—a line-drawing process that attempts to classify words and terms etymologically as either a “genus” (generic) or a “species” (a protectable trademark)¹²—grant undue weight to non-commercial and/or non-competitive trademark use contexts (e.g., dictionary entries and newspapers)¹³ and thus stray far from trademark’s roots in source identification analysis. Moreover, the current doctrine fails to examine how affording the term trademark status will impact competition, to the detriment of both consumers and potential mark holders. This approach causes incoherence and uncertainty leading to inefficiencies.

As such we contend that the genericism doctrine should be re-anchored to focus on the mark’s ability to act as a source identifier for the consumer in commercial contexts. By refocusing the genericism question on *consumer* contexts rather than non-consumer contexts the doctrine may better reflect a term’s ability to perform more than one function in language, depending on the user of the term and the context of the term’s use. In

¹² See notes 164-167 and accompanying text, *infra*.

¹³ These issues are discussed in Section II, *infra*.

addition, refocusing the doctrine on the mark's ability to act as a source-identifier in a commercial context—while considering the effect of trademark protection on competition—would provide businesspeople with greater clarity regarding what constitutes a protectable mark and what types of usage may contribute to a mark's demise. Furthermore, this approach allows and encourages mark holders to expend resources on developing goodwill and the source-identifying properties of their marks rather than wasting resources on currently required yet largely impotent campaigns to protect their marks from what should be considered fair use. Finally, this revised understanding of genericism would undermine trademark holders' ability to claim the need to engage in what would otherwise be frivolous and/or abusive enforcement strategies, because they could no longer hang their collective hat on the excuse that they were required to do so to avoid falling victim to genericide. As such, this retooling of the doctrine allows trademark holders to enjoy the full benefits of the source-identifying functions of their marks, while creating a space in which the public may enjoy full use of the terms without fear of reprisal by mark holders.

Section I of this article explains the clash of interests that underlie the genericism conundrum. It begins with an explanation of trademark value from a business perspective, as supported by the law and economics understanding of trademark law. Next, the section explains and then investigates the language and speech theories of how people use trademarks and how trademarks function expressively, beyond the commercial context. Section II provides some fundamentals of trademark taxonomy and traces the evolution of the genericism doctrine. Section III examines the way in which the doctrine currently operates and identifies the ways in which the doctrine is inefficient

and/or ineffectual in promoting the core purposes of trademark law. Section IV sets forth a modest proposal for the reform of the doctrine, focusing on (1) a putative trademark's ability to function as a source-identifier in the relevant marketplace, and (2) the competitive effect of extending trademark protection.

I. *Why Genericism Matters*

This section begins by first presenting why trademarks (AKA brands) are so important to business. From there the section examines the theoretical underpinnings of trademark law. By analyzing the law and economics, free speech, and linguistic theories related to trademarks, this section seeks to show how—rather than conflicting—these theoretical presentations provide a framework for unraveling the problems currently seen in the genericism doctrine.

A. *The Power of the Brand*

In the debate regarding the extent of trademark holders' rights versus the public's need to use language freely, the trademark holders' perspective can be lost. Ignoring this story fails to appreciate the real interests that mark holders and the economy have in protecting marks. While some argue—and certain trademark holders' behaviors support the idea—that mark holders engage in abusive rights enforcement,¹⁴ analysis of the problem must not focus solely on the negative aspects of holding and enforcing a trademark. To do so presupposes bad faith on the trademark holder's part and requires

¹⁴ See generally Greene, *supra* note 9.

one to believe that mark holders and their attorneys engage in overly aggressive enforcement strategies merely to vex the public and to commandeer language. A comprehensive critique of genericism and genericide must recognize that trademarks are powerful tools in a company's economic arsenal.¹⁵ Indeed, much of a company's value and potential for long-term growth can be traced to its brand value.¹⁶ These facts explain some of trademark holders' behaviors and why the law must protect the value of trademarks.

Trademarks and brands play an important role in a company's ability to generate capital. Marketing theorists opine that "[p]erhaps the most distinctive skill of professional marketers is their ability to create, maintain, protect, and enhance brands."¹⁷ Marketers typically define "brand equity" as "the price premium the brand commands times the extra volume it moves over an average brand."¹⁸ The value of a brand is expressed when a company realizes a net worth greater than its tangible asset value.¹⁹

Brands can be so powerful that some companies employ a strategy of purchasing other companies merely to build a brand portfolio, as evidenced by Nestle's \$4.5 billion

¹⁵ See generally KLAUS JENNWEIN, INTELLECTUAL PROPERTY MANAGEMENT: THE ROLE OF TECHNOLOGY-BRANDS IN THE APPROPRIATION OF TECHNOLOGICAL INNOVATION (2005) (presenting a theory of how brand-equity and technology assets interact to allow companies to extract value from initial technological investments).

¹⁶ See Warren E. Buffet, *The Essays of Warren Buffet: Lessons for Corporate America*, 19 CARDOZO L. REV. 1, 173 (1997) (selected, arranged, and introduced by Lawrence E. Cunningham).

¹⁷ PHILIP KOTLER, MARKETING MANAGEMENT 404 (2000). Kotler defines a brand as "a name, trademark, logo, or other symbol." *Id.*

¹⁸ *Id.* at 405. Valuation of a brand, however, is subjective at best, as evidenced by the numerous other brand valuation methods used in the marketing industry. A direct measure approach adds up the investment of capital into the brand and adjusts for inflation. Jacques Chevron, *Valuing Brands, on Paper and in Truth*, BRANDWEEK, Jan. 17, 2000, at 24. While this method is perhaps the easiest, it penalizes brands that do not heavily advertise. The brand awareness method contrasts the percentage of targeted customers who have *tried* the product versus customers that *regularly purchase* the product. Comparing this figure to the overall advertising budget results in a more conservative valuation of the brand than any other method. *Id.*

¹⁹ For an extended investigation of the relationship between brand-equity and intangible assets, see generally JENNWEIN, *supra* note 15.

purchase of Rowntree, a price that was five times Rowntree's book value.²⁰ Warren Buffet explains his company's purchase of See's Candy for \$25 million—despite a book value of \$8 million—as based on See's Candy's economic goodwill; in other words, the \$17 million premium was for the “excess of cost over equity in net assets acquired.”²¹ As Buffet explains:

Relatively few businesses could be expected to consistently earn the 25% after tax on net tangible assets that was earned by See's. . . . It was not the fair market value of the inventories, receivable or fixed assets that produced the premium rates of return. Rather it was a combination of intangible assets, particularly *a pervasive favorable reputation with consumers based on countless pleasant experiences that they have had with both product and personnel.*²²

The “goodwill” described by Buffet above—the “pervasive favorable reputation with consumers based on countless pleasant experiences that they have had with both product and personnel”—demonstrates in part why brands may be so highly valued. It does not, however, tell the entire story. Marketers also encourage the public to build identities and form emotional bonds with brands: “A brand can also create a connection by serving as a ‘badge,’ or an outward sign that tells the world something about the buyer or the user.”²³ Similarly, Professor Barton Beebe writes that “consumers consume

²⁰ KOTLER, *supra* note 17, at 405.

²¹ See Buffet, *supra* note 16, at 172-73.

²² See *id.* at 173 (emphasis added). Other examples of payment for brand-equity include when U.K.-based GrandMet acquired Pillsbury, likely paying just short of \$1 billion, or 88% of the purchase price, to acquire the Pillsbury brands, including Green Giant, Old El Paso, and Haagen-Dazs; and BMW's purchase of the Rolls-Royce brand name from Volkswagen for \$65 million. Chevron, *supra* note 18, at 24; see also William Diem, *BMW Gains Rolls-Royce Brand After All*, AUTOMOTIVE NEWS, August 3, 1998, at 25. More recently, communications giant SBC paid \$16 billion to keep the AT&T brand when the two companies merged, because AT&T as a brand is “deeply rooted in the American consumer psyche”. Jon Britton, former SBC spokesman, has stated that the new advertising campaign to push the AT&T brand would be the largest in the history of either company. *SBC Starting All Over with the Name Game*, THE SAN FRANCISCO CHRONICLE, Nov. 23, 2005, at C1.

²³ See MCEWEN, *supra* note 3, at 36. McEwen lists five ways this symbolic function can manifest itself: as a sign of prestige (e.g., the status of wearing a Rolex watch), personal quality (e.g., youth for Pepsi or competitive excellence in Nike), membership (e.g., the club-like aspect of owning a Harley-Davidson motorcycle), memory trigger (e.g., associating a food brand with family tradition), and/or self-completion (e.g., brands consumers see as signs of self-completion such as Marlboro as a sign of being a rugged man

trademarks to signal status The culture industries. . . have long sold trademarks as commodities in their own right.”²⁴

The power of brands to serve a symbolic, expressive function translates into market value. Brands can become symbols by which people define and express themselves, such that people spend money far beyond the cost of the utility of the good to reinforce that identity or have that means of expression.²⁵ Professor Beebe argues that “[e]ntire areas of trademark doctrine cannot be understood except as systems of rules designed to facilitate the commodification—indeed, the ‘industrial production’—of social distinction.”²⁶ Although this trend may be viewed as both inefficient and exploitative of the consumer, others have argued that the pervasive use of brands not only benefits the brand holder, but also serves a valuable community-building function in modern society.²⁷

or L’Oreal as sign of being worth spending extra for oneself). *Id.* at 36-38. For an excellent account of how Nike built its brand, see generally DONALD KATZ, *JUST DO IT: THE NIKE SPIRIT IN THE CORPORATE WORLD* (1994).

²⁴Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 *UCLA L. REV.* 621, 624 (2004).

²⁵ See SILVERSTEIN & FISKE, *supra* note 3. Some argue that such expenditures are not irrational because, when trademarks function properly, a consumer may wish to expend greater resources on a given brand despite *knowing* that it is identical to a competitor’s cheaper good in constituent materials, because the consumer wishes to ensure that the materials are assembled in a certain way that assures some specific type of quality. See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW* 174 [hereinafter LANDES & POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW*]; see also Shahar Dilbary, *Famous Trademarks and the Rational Basis for Protecting ‘Irrational Beliefs’*, *Law and Technology Scholarship* (March 21, 2006) (Berkeley Center for Law & Technology Paper No. 19; available at the eScholarship Repository, University of California, <http://repositories.cdlib.org/bclt/lts/19>), at 13-19.

²⁶ Beebe, *supra* note 24, at 624.

²⁷ Friedman writes that “the value-expressive dimension of brand names suggests that brand name usage performs a valuable social function by engendering feelings of community on the part of those who share brand identification. This facilitation of group affiliation seems especially important in light of the loss of community that is said to commonly accompany life in complex societies such as contemporary America.” Monroe Friedman, *The Changing Language of Consumer Society: Brand Name Usage in Popular American Novels in the Postwar Era*, 11 *JOURNAL OF CONSUMER RESEARCH* 927, 936 (1985); see also Dilbary, *supra* note 25 (arguing that “Snobbery”—consumer brand preference—benefits both consumers and producers and is economically efficient). For an investigation of the reciprocal nature of language, culture, and society, see JAMES BOYD WHITE, *WHEN WORDS LOSE THEIR MEANING: CONSTITUTIONS AND RECONSTITUTIONS OF LANGUAGE, CHARACTER, AND COMMUNITY* (1984).

For all of these reasons trademarks or brands may be extremely valuable—in fact, a company’s brand may be its *most* valuable asset. Business Week’s annual global brand report ranks the top one hundred global brands by dollar value, estimating the amount the brand is likely to earn in the future.²⁸ Since Business Week first published the Global Brand Scoreboard in 2001, the three top-ranked brands have remained steady: Coca-Cola, Microsoft and IBM, valued at \$67.5 billion, \$59.9 billion and \$53.3 billion, respectively.²⁹

Although the above figures are based in part on subjective factors and therefore their accuracy is open to debate,³⁰ they undoubtedly demonstrate that companies have a lot to lose when it comes to their brands—particularly the most famous³¹ ones. Not surprisingly, companies vigorously seek to protect these assets. In a corporate setting failure to pursue any and all possible threats to a brand would arguably be a breach of fiduciary duty. For if a brand is an intangible asset, like any asset it can drop in value just as easily as it can rise. Genericide poses the ultimate threat, as it can reduce the value of the billion-dollar mark to zero.

B. The Traditional Law and Economics Explanation of Brand Value

²⁸ *Global Brands*, BUSINESS WEEK, July 2005, at 90.

²⁹ *Id.*

³⁰ Branding consultant Interbrand (which provides data for Business Week’s annual report) estimates brand value by projecting five years of earnings and sales, minus operating costs, taxes and charges for the capital employed. The strength of the brand is also assessed by factoring market leadership, stability, and global reach. *Id.* Other brand valuation methodologies exist, which may reach significantly different conclusions regarding the value of identical brands. See, e.g., John Willman, *Valued Measure of Success: Managing brands is no easy task but a new ranking brings science to a black art*, FINANCIAL TIMES, Apr. 3, 2006, at 1 (unveiling BrandZ Top 100, prepared by Millard Brown Optimor, which values IBM brand at \$36.1 billion, compared to Interbrand IBM valuation of \$53.4 billion; noting other differences as well); see also note 18, *supra*.

³¹ “Famous” is a term of art in trademark dilution law. The Federal Trademark Dilution Act (FTDA)—which provides broad protection of trademarks against “diluting” uses that do *not* cause a likelihood of consumer confusion—protects only “famous” trademarks. 15 U.S.C. § 1125 (c)(1)(A-H). See notes 246-257 and accompanying text, *infra*, discussing the link between the dilution and genericide doctrines.

The law and economics movement offers one explanation for why trademarks may be so highly valued, at least when they function efficiently. Given that the courts have largely adopted the law and economics analysis of trademarks as the primary justification for their existence, we turn here to a brief description of the traditional doctrine.

The classic economic rationale behind trademark law is that trademarks should be protected because they are economically efficient; trademarks help to minimize consumers' search costs, the pre-purchase analysis a consumer performs to make her purchase decision.³² William Landes and Richard Posner set forth the idea as follows: “[A] trademark conveys information that allows the consumer to say to himself, ‘I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me that the attributes are the same as that of the brand I enjoyed earlier.’”³³ These principles relate to a trademark's function as a source-identifier.³⁴

³² Ralph Folsom & Larry Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1335 (1980); accord, Stephen Carter, *The Trouble with Trademark*, 89 YALE L.J. 759, 762 (1990); Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 729-30 (2004).

³³ Landes & Posner, *Trademark Law: An Economic Perspective*, *supra* note 5, at 268-270; see also Folsom & Teply, *supra* note 32, at 1336 (“A properly functioning trademark provides a short-hand means of associating currently tendered products with past or anticipated experiences and thereby eliminates the need to make repeated searches for nonprice information.”).

³⁴ See 15 U.S.C. § 1127; accord 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.1 (4th ed. 2005) (“to become a ‘trademark’ is to identify the source of one seller's goods and distinguish that source from other sources”). Of course, a mark's capacity for source identification is not immutable. As companies are bought and sold, as product information changes, and as products are altered, consumers' understanding of brands will change based on one or a combination of these sorts of events. Some commentators argue, based on this potential (or arguably inherent) instability, that the economic value of trademarks to the consumer has been seriously overstated. See, e.g., Bartow, *supra* note 32, at 730-32; see also Irene Calboli, *Trademark Assignment ‘with Goodwill’: A Concept Whose Time Has Gone*, 57 FLA. L. REV. 771, 830-31 (2005) (arguing that trademarks should be transferable “with or without goodwill,” in part because trademark owners have always had the ability to change the quality or nature of

The United States Supreme Court has also articulated this reasoning:

A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark holder has something of value.³⁵

Not surprisingly, the law and economics presentation of trademarks accords with the valuation of brands in business discussed above. As stated by Warren Buffet, brands have the ability to generate tremendous value for a company because they are “intangible assets, particularly consisting of a pervasive favorable reputation with consumers based on countless pleasant experiences that they have had with both product and personnel.”³⁶

This economic theory manifests itself via a typical trip to the grocery store. For example, assume one enters the supermarket for the purpose of buying teriyaki sauce. If the shopper has sampled or researched a particular brand of sauce before, he gains certain information about the brand, e.g., that Soy Vay® teriyaki sauce has the distinct taste of ginger. Here, the trademark informs the buyer about the class of goods—teriyaki sauces—and tells the buyer that, when choosing among teriyaki sauces, he can pick specific ones with specific characteristics. If he likes ginger, he may choose Soy Vay®; if he hates ginger, he may avoid it. In either case, as the purveyor of the product educates the buyer about the product’s traits or the buyer performs some initial research, the buyer gains the benefit of being able to go to a store and buy the right sauce with the

their products at will); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367 (1999) (further critiquing the economic justification for trademark law).

³⁵ *Misawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

³⁶ Buffet, *supra* note 16, at 173; *see also* Calboli, *supra* note 34, at 799-814 (defining and discussing the concept of “goodwill” associated with a trademark).

characteristics she wants without having to check the label or perform new research each time she buys the sauce.

Trademark infringement destroys a mark's ability to reduce consumer search costs and is therefore inefficient, as well as potentially harmful to both the consumer and the trademark holder. Infringement occurs when a competitor copies the relevant mark so that he can trick the consumer into buying his product, when the consumer was seeking out the trademark holder's goods or services. In other words, if a trademark is functioning properly as a source-identifier and the consumer has developed an affection for the product to which it is attached (i.e., the product has attained goodwill), competitors may be tempted to appropriate that goodwill by selling their own products under the same or a confusingly similar trademark.³⁷ When this type of free-riding occurs, trademark law applies a likelihood of confusion analysis to determine whether the consumer will be deceived by the practice.³⁸ Accordingly, though the mark holder enforces her rights against the free-rider, it is primarily the consumer who is protected.³⁹

Again, a trip to the supermarket illustrates the concept. If I like Soy Vay® teriyaki sauce and I am “tricked” into buying a competitor's inferior sauce because the competitor has placed a confusingly similar “Soy Vey” label on its bottle, both I and the maker of the “real” Soy Vay® have been injured via trademark infringement. If the

³⁷ As Landes and Posner state, “The benefits of trademarks in lowering search costs presuppose legal protection because the cost of duplicating someone else's trademark is small and the incentive to incur this cost in the absence of legal impediments will be greater the stronger the trademark.” LANDES & POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW*, *supra* note 25, at 168; *see also* Klieger, *supra* note 4, at 789; *but see* Lemley, *supra* note 9, at 1031-32 (noting that the property label for trademarks and the “rhetoric of free riding in intellectual property” “are misguided” as they allow for intellectual property right holders to “fully internalize the benefits of their creativity [which] will inevitably get the balance [between inventors'/ creators' control and competition] wrong.”).

³⁸ *See, e.g.*, *AMF Inc. v. SleekCraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (listing factors considered by the courts in analyzing likelihood of confusion).

³⁹ Klieger, *supra* note 4, at 793-94.

competitor’s copying does not result in a “likelihood of confusion” on my part, however, there is no infringement and, absent dilution,⁴⁰ no actionable injury.

C. *Limitations on the Scope of Protection Afforded to Trademarks*

Traditionally, trademarks—unlike their cousins patents and copyrights—have enjoyed only limited protection outside the likelihood of confusion context. As explained above, in theory at least, uses of trademarks that do not infringe should not impinge on the mark’s ability to act as a source identifier and therefore are not inefficient. Yet as trademarks (AKA brands) have become more and more valuable as corporate assets,⁴¹ trademark holders have understandably pushed at the boundaries of trademark law and succeeded in expanding its scope, arguably reducing efficiency and hindering competition.

In most contexts, intellectual property law aims to incentivize potential holders of intellectual property rights to develop intellectual property by giving “as little protection as possible consistent with encouraging innovation.”⁴² To that end, copyright and patent law grant limited monopolies to allow the rights holder to exploit the value of the

⁴⁰ Both the Federal Trademark Dilution Act (FTDA) and state anti-dilution laws protect “famous” or highly distinctive marks against dilution, even in the *absence* of likelihood of confusion. See notes 248-254 and accompanying text, *infra*. The dilution doctrine has greatly expanded the scope of trademark protection, at least for the strongest marks, much to the dismay of many commentators. See generally Klieger, *supra* note 4; *but cf.* Dilbary, *supra* note 25 (arguing that anti-dilution laws benefit both producers and consumers because “contamination” of a mark destroys its value to the consumer).

⁴¹ See notes 20-30 and accompanying text, *supra*.

⁴² Lemley, *supra* note 9, at 1031; see also LANDES & POSNER, THE ECONOMIC STRUCTURE OF TRADEMARK LAW, *supra* note 25, at 8 (describing how property rights in physical items are aimed towards managing natural scarcity and price concerns, whereas intellectual property creates scarcity “which could not otherwise be maintained”) (citations omitted).

creation for a limited period of time.⁴³ That system essentially and temporarily grants rights in gross—that is, the holder of the intellectual property has exclusive control over it and generates capital based on that control for a finite period of time.⁴⁴ As to copyright and patent law, this notion is enshrined in the Constitution, which empowers Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁴⁵ In contrast, trademark law has no explicit Constitutional mandate but instead emerged from the common law tort of unfair competition.⁴⁶ Also in contrast to copyrights and patents, trademarks do not expire after a set period of time, but instead endure so long as the mark holder continues to use the mark, potentially in perpetuity.⁴⁷ As a result, a fundamental tenet of trademark law has always been that, unlike copyrights and patents, trademarks are *not* held “in gross” and therefore the trademark holder’s right to prohibit others’ use of the mark is limited to circumstances in which that use harms consumers, as determined via the “likelihood of confusion” standard.⁴⁸

⁴³ U.S. CONST. art. I, § 8; *see also* Lemley, *supra* note 9, at 1042; *cf.* David W. Barnes, *A New Economics of Trademarks* (April 1, 2006) (Seton Hall Public Law Research Paper No. 886045; available at SSRN: <http://ssrn.com/abstract=886045>) (arguing that the differences between copyrights and patents on the one hand and trademarks on the other are not as stark as is often presented, but rather that, like copyrights and patents, trademarks are public goods with non-rivalrous characteristics and must be understood as such “to supply an optimal amount of information about products and their sources”).

⁴⁴ LANDES & POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW*, *supra* note 25, at 8.

⁴⁵ U.S. CONST. art. I, § 8.

⁴⁶ LANDES & POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW*, *supra* note 25, at 166.

⁴⁷ The Lanham Act provides that owner of a federally-registered trademark may maintain that registration by filing a renewal application (attesting to continued use) and paying a specified fee every ten years. There is no limit on the number of times the mark owner may renew his trademark registration. 15 U.S.C. §§ 1058, 1059 (2005) (Lanham Act §§ 8, 9).

⁴⁸ *See* *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) (“In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one’s good-will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or package in which it is sold.”); *accord* *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413-14 (1916).

As the rights of trademark holders have expanded, however, this fundamental tenet has eroded. Put simply, trademark holders have relied upon a pure property conception of their rights to expand their dominion over those rights.⁴⁹ This development poses serious problems because it strikes at the heart of the balance between intellectual property rights, competition, and expression that the law should respect and protect. To understand what is at stake when we refer to “expression,” we now turn to an examination of the expressive capacity of trademarks.

D. Trademarks’ Capacity for Expressive Use

As explained above, trademarks are often considered and treated as corporate assets—often extremely valuable ones—that primarily serve to act as source identifiers for the goods or services to which they are attached. However, in confronting the genericism conundrum, we must also take into account trademarks’ ability to function beyond this dimension. Professor Barton Beebe contends that the law and economics approach “cannot explain, predict, or justify certain outcomes in [trademark] law, nor can it articulate the need for necessary reforms.”⁵⁰ According to Beebe, this failing occurs in part because trademarks are “a semiotic doctrine elaborating the principles of sign systems, of language. If there is a ‘language of commodities,’ then trademark doctrine is

⁴⁹ Many commentators have bemoaned this trend in trademark law. *See, e.g.*, Dreyfuss, *supra* note 10, at 406-410 (tracing the shift to a pure property approach to trademark rights and noting the way in which this shift limits the potential for expressive use of trademarks); Lemley, *supra* note 9, at 1032 (arguing that use of “[t]he rhetoric of real property, with its condemnation of ‘free riding’ by those who imitate or compete with intellectual property owners,” has resulted in “a legal regime for intellectual property. . . in which courts seek out and punish virtually any use of an intellectual property right by another”); *but see* Robert G. Bone, *Enforcement Cost and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004) (examining trademark law and criticisms of its expansion and arguing that the law’s apparent inconsistencies may best be understood as a way to address over- or under-enforcement of trademark rights and related costs).

⁵⁰ *See* Beebe, *supra* note 24, at 624 (arguing that law and economics cannot explain the “concepts of trademark ‘distinctiveness’ and trademark ‘dilution.’”).

its grammar, and this grammar must be understood not simply in economic, but also in linguistic terms.”⁵¹

Although corporations construct trademarks either by inventing words or investing common words with commercial meaning, the public plays an important role in accepting those meanings and the public may—as it may with all language—manipulate terms and endow them with additional meaning.⁵² Judge Kozinski has explained the phenomenon as follows:

[T]rademarks [may] transcend their identifying purpose. Some trademarks enter our public discourse and become an integral part of our vocabulary. . . . Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.⁵³

Thus, we may find a trademarked word so pervasive and useful that we begin to use it in noncommercial contexts and indeed not as a trademark at all. We may incorporate a trademarked term into our everyday language, either through speech or writing, as a way to convey more than the trademark meaning of the term.⁵⁴ In short, we may use a trademark “expressively.”

⁵¹ *Id.* at 624.

⁵² *See generally id.* (applying semiotic theory to trademark law to explain the way in which trademarks have both source distinctive and differential distinctive properties and the rise of the differential understanding as related to the commoditization of trademarks).

⁵³ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

⁵⁴ In artistic contexts, expressive uses entail incorporating a trademark into a painting, sculpture, etc. These uses fall under a different yet related issue of the incorporation of a trademark into art and whether a given use is protected under First Amendment principles. *See, e.g.,* *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003) (artistic works incorporating and transforming *Mattel*’s Barbie doll constituted parodic speech protected by the First Amendment).

Expressive uses of trademarks are pervasive in contemporary culture. For example, we may ask for a Kleenex when we mean any facial tissue. We may tell someone to “just put a Band-Aid on the problem” as a way of saying, “Use a quick fix.”⁵⁵ Moreover, the way in which the public uses words—including trademarks—is constantly changing. “[N]ew words and expressions” may be viewed as “natural concomitants of social change that remain as long as people find them useful.”⁵⁶ In other words, language is innovative and the public will adopt or drop words at will and as necessary.⁵⁷

Examples of the evolutionary nature of language abound. When Xerox was the dominant if not the only maker of a copying machine, we might have “Xeroxed” a document instead of photocopying it. In the 1980s and 1990s, the public may have primarily used the term “Walkman” to mean any portable audio cassette player; yet now that audio cassette players have been superseded by mp3 players, “Walkman” may be more commonly used to refer to the original Sony device. Today, a person may say “iPod” to mean any mp3 player or to mean only the mp3 player sold by Apple, Inc.—all depending on who the speaker is and the context in which he uses the term.

As the above examples demonstrate, trademarks function differently for different people in different contexts and are capable of different yet simultaneous uses. The law and economics literature offers a way to describe this phenomenon. Professors Folsom and Teply characterize trademarks that behave in this manner as hybrid terms. Such terms “perform a variety of informational functions—ranging from the provision of pure

⁵⁵ *Mattel, Inc.*, 296 F.3d at 900 (“How else do you say that something’s ‘the Rolls Royce of its class’? What else is a quick fix, but a Band-Aid?”).

⁵⁶ Friedman, *supra* note 27, at 936; accord Shawn M. Clankie, *Brand Name Use in Creative Writing: Genericide or Language Right?*, in *PERSPECTIVES ON PLAGIARISM AND INTELLECTUAL PROPERTY IN A POSTMODERN WORLD* 259 (Lide Buranen and Alice M. Roy eds., 1999).

⁵⁷ Clankie, *supra* note 56, at 262 (“Language change and innovation are natural and, in general, unmanageable.”).

commercial or source-related information to the provision of pure generic or product-category information—at the same time.”⁵⁸ Based on this understanding Folsom and Teply identify “three types of consumers, each perceiving the significance of a hybrid trademarked generic word differently”:

- (1) those who are unaware of any source significance for the mark and who use the word as a product-category word, thereby facing added search or transaction costs;
- (2) those who are aware of the source and nonprice significance of the mark and who do not perceive, or use, the word as a product-category word; and
- (3) those who know that the mark has source significance, but who also use it in a product-category sense, and thereby may suffer increased search costs.⁵⁹

Folsom and Teply illustrate how the economic justification for trademarks based on their capacity to act as source identifiers is congruent with their concurrent capacity for expressive use. At one end of the spectrum, users may afford a term no trademark significance because they interpret it as the name of a product category. For these users, the term is generic and hence useless as a source identifier. It is inefficient to treat truly generic terms as trademarks, because they do not act as source identifiers and hence would *increase* consumer search costs if given trademark protection. At the opposite end of the spectrum are users who regard the term only as a trademark and for whom it always functions as a source identifier. For these consumers the mark is optimally efficient; its protection as a trademark *decreases* consumer search costs. In the middle are those who afford the term both trademark significance and non-trademark significance, complicating any attempt to analyze the impact on search costs and hence to determine the point at which trademark protection of the term becomes inefficient. In

⁵⁸ Folsom & Teply, *supra* note 32, at 1339.

⁵⁹ *Id.* at 1340.

this part of the spectrum people use a term as a trademark or expressively depending on the context. In truth, many if not the majority of “famous” trademarks fall into this middle spectrum.

As discussed above, many brands function as both mega-valuable corporate assets and as invaluable expressive elements of language.⁶⁰ At the core of this tension are the questions of whether trademarks are diminished by uses other than as trademarks or whether the law should force users to use terms in non-hybrid manners at the cost of losing the expressive dimension of the terms.⁶¹ Trademarks consist of words that symbolize a product and identify source, but once created, consumer upon consumer may use the trademark without the trademark holder having to produce anything new; in short trademarks, like ideas, need only be created once and as such seem to be nonrival goods with infinite capacity:

An idea only needs to be created once to satisfy consumer demand while an apple must be produced for each consumer. Essentially, this means that the marginal costs of allowing an additional person to use an idea are zero. Most economists accept that it is efficient to maximize access to, and consequently consumption of, an existing nonrival good because generally there is only an upside; additional private benefits come at no additional cost. Ideas, like other nonrival goods, have infinite capacity.⁶²

⁶⁰ *Accord* Dreyfuss, *supra* note 10, at 400-01 (noting the way in which Barbie can mean the doll itself and an image of a pretty but vapid woman); *cf.* LANDES & POSNER, *THE ECONOMIC STRUCTURE OF TRADEMARK LAW*, *supra* note 25, at 168-69 (examining economics of language and noting, “The importance of trademarks to language is only modest, however, because the contribution they make to the language is mainly a byproduct of the contribution the products they designate make to the world of things.”).

⁶¹ *See generally* Brett Frischmann, *An Economic Theory of Infrastructure and Commons Management*, 89 MINN. L. REV. 917 (2005).

⁶² *Id.* at 946; *see generally* Barnes, *supra* note 43 (noting that trademarks have been thought of as private goods but arguing that in fact trademarks function as public goods). Professor Frischmann explains that nonrivalry relates to infrastructure and argues that infrastructure resources are “are sharable in the sense that the resources can be accessed and used by multiple users at the same time” and notes, “Infrastructure resources vary in their capacity to accommodate multiple users, and this variance in capacity differentiates nonrival (infinite capacity) resources from partially (non)rival (finite but renewable capacity) resources.” Frischmann, *supra* note 61, at 942. Although fully understanding whether trademarks function as infrastructure or more likely have infrastructure characteristics is beyond the scope of this article, it may be that trademarks’ hybrid nature makes them partially nonrivalrous which means that “one user’s

Put differently, one could think of the purely nonrival characteristics of a trademark and consider that, when used as input for expression or commentary, the trademark generates a public good.⁶³ The question becomes one of whether the expressive user would pay for the access to the good.⁶⁴ The problem is that the expressive user is unlikely to pay for such a use, although society's interest in having such a use is high.⁶⁵ We argue that this conflict culminates in the genericism doctrine because, as it operates today, the doctrine forces the trademark holder to protect her mark via means that threaten beneficial, expressive uses, if not squash them out of existence.

As such we now turn to a historical perspective of genericism and genericide. This analysis seeks to unravel how the doctrine evolved and how its current application has strayed, such that it effectively serves neither the economic nor the expressive interests described above.

II. The Genericism Conundrum

A. The Trademark Name Game

To understand the problem the genericism doctrine poses, the generic term must be understood in the context of the five basic classes into which a term may fall when

consumption directly affects another user's" but "can be managed in a way that avoids rivalrous consumption." *Id.* at 951.

⁶³ See generally Barnes, *supra* note 43 (detailing the theoretical issues around public goods and market failures).

⁶⁴ See *id.* at 28 (explaining that "Marginal cost pricing fails to provide an allocatively efficient supply of public goods in a competitive marketplace").

⁶⁵ See Glynn S. Lunney, Jr., *Fair Use and Market Failure: Sony Revisited*, 82 B.U.L. REV. 944, 975 (2002) (detailing the problem in copyright context); accord Barnes, *supra* note 43 (citing Lunney and applying the insight to trademarks).

determining its trademark status: arbitrary, fanciful, suggestive, descriptive, and generic.⁶⁶ A term seeking to function as a trademark receives specific treatment as determined by the category to which it belongs.⁶⁷ In general, terms that qualify on the arbitrary or fanciful end of the spectrum are considered to be the strongest marks meriting the broadest scope of protection; terms deemed generic receive no trademark protection; and suggestive or descriptive marks fall in the middle.⁶⁸ Even though these classifications are critical in determining whether and to what degree a trademark will be protected against infringement, courts recognize that it is often exceedingly difficult to determine the appropriate label for a given term:

These categories, like the tones in a spectrum, tend to blur at the edges and merge together. The labels are more advisory and definitional, more like guidelines than pigeon holes. Not surprisingly, they are somewhat difficult to articulate and apply.⁶⁹

At the top of the heap lie arbitrary and fanciful marks. These types of marks are considered inherently distinctive and, therefore, may be registered as trademarks under the Lanham Act with no proof of acquired secondary meaning.⁷⁰ Marks are considered

⁶⁶ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

⁶⁷ See *Entrepreneur Media, Inc.*, 279 F.3d 1135, 141 (9th Cir. 2002).

⁶⁸ *Id.* (citing *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir.1992)); see also *Abercrombie & Fitch Co.*, 537 F.2d at 9.

⁶⁹ *Berner Int'l Corp. v. Mars Sales Co.*, 987 F.2d 975, 979 n.2 (3d Cir. 1993); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001); *Blinded Veterans Ass'n*, 872 F.2d at 1039; *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983); see also *Miller Brewing Co. v. Falstaff Brewing Corp.*, 503 F. Supp. 896, 906 (D.R.I. 1980); *rev'd*, 655 F.2d 5 (1st Cir. 1981) (“One is tempted to compare the intellectual contortions involved in placing a word or symbol in its ‘proper’ category to the legendary scholastic pursuit of numbering the angels that can dance on the head of a pin.”); see also *Bartow*, *supra* note 32, at 738 and note 49 (criticizing: “Sorting marks into these malleable categories is performed as a matter of law, and judges generally accomplish this task by referencing their internal visceral impressions. This type of subjective contextualizing by courts deciding trademark disputes is seemingly required by extant legal doctrine and accustoms judges to using intuition, and to make instinctive rather than evidence driven legal determinations under the Lanham Act.”).

⁷⁰ *Abercrombie & Fitch Co.*, 537 F.2d at 11 (noting that suggestive, arbitrary, and fanciful marks are entitled to registration without proof of secondary meaning).

“inherently distinctive” when “their intrinsic nature serves to identify a particular source of a product.”⁷¹ In other words, due to the nature of the mark, the law *presumes* that the mark is functioning as a source identifier. Arbitrary and fanciful marks are also considered to be the strongest types of marks and, therefore, (somewhat counterintuitively) the most likely to be infringed.⁷²

Although arbitrary and fanciful marks are often grouped together, they actually describe two different types of trademarks. Arbitrary marks adapt a common word to an uncommon setting, such as “apple” for computers or a record label.⁷³ “The identical word can be generic or arbitrary depending on context; generic if it is the name of the good or service in common parlance (‘car’ as a textual mark for an automobile), and arbitrary if it has no logical association whatsoever with the underlying product (‘car’ as a textual mark for fabric softener).”⁷⁴ Fanciful marks consist of invented words such as “Google,” “Kodak,” and “Xerox,” as opposed to common words used in an uncommon manner.⁷⁵ “The term ‘fanciful,’ as a classifying concept, is usually applied to words invented solely for their use as trademarks. When the same legal consequences attach to a

⁷¹ Two Pesos, 505 U.S. at 769.

⁷² The court in *Virgin Enterprises Ltd. v. Nawab*, 335 F.3d 141, 148 (2d Cir. 2003), explains that “[i]f a mark is arbitrary or fanciful, and makes no reference to the nature of the goods it designates, consumers who see the mark on different objects offered in the marketplace will be likely to assume, because of the arbitrariness of the choice of mark, that they all come from the same source.”

⁷³ See *Abercrombie & Fitch Co.*, 537 F.2d at 9 n. 6 (noting that the word “Ivory” may be generic as applied to elephant tusks but arbitrary as applied to soap). Two users of the arbitrary mark “apple” have recently litigated the rights to this mark. Apple Records first challenged Apple Computer’s use of “Apple” 25 years ago, settling the matter in 1991 with Apple computers agreeing not to offer music related products. Recently, Apple Records lost its attack on Apple Computer’s entry into the music business via its iTunes and iPod offerings. Justice Mann declared Apple computer’s use of “Apple” in this context did not violate the parties’ earlier agreement. *Apple Corps Limited v. Apple Computer Inc.*, [2006] EWHC 996 (CH), available at <http://news.findlaw.com/hdocs/docs/apple/aclaC50806opn.html>.

⁷⁴ Bartow, *supra* note 32, at 742.

⁷⁵ *Abercrombie & Fitch Co.*, 537 F.2d at 11.

common word, i.e., when it is applied in an unfamiliar way, the use is called ‘arbitrary.’”⁷⁶

In the middle of the trademark class spectrum sit suggestive marks. Like arbitrary and fanciful marks, suggestive marks are considered inherently distinctive and may be registered as trademarks with no proof of secondary meaning.⁷⁷ However, unlike an arbitrary or fanciful mark, a suggestive mark is not a made-up word or a word used in an arbitrary context; it “suggests” the nature of the good or service to which it is attached.⁷⁸ A suggestive mark differs from a descriptive mark in that it does not directly describe the attributes of the relevant good or service, but rather “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.”⁷⁹ For example, the name “Coppertone” does not describe the color of a particular type of suntan lotion, but it does suggest the intended or hoped-for appearance of the consumer, after using the product.⁸⁰ Courts have reasoned that suggestive marks are entitled to greater protection than descriptive ones, because the competitor’s need to use the suggestive mark—unlike a descriptive term—is arguably minimal: “The English language has a wealth of synonyms

⁷⁶ *Id.*

⁷⁷ *Id.*; see also *Two Pesos*, 505 U.S. at 769 (suggestive, arbitrary and fanciful marks are deemed inherently distinctive because their intrinsic nature serves to identify a particular source of a product).

⁷⁸ See, e.g., *Tumblebus, Inc. v. Cranmer*, 399 F.3d 754 (6th Cir. 2005) (upholding district court’s finding that “Tumblebus,” as applied to mobile gymnastics instruction for children, was suggestive); *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986 (7th Cir. 2004) (“Niles,” as applied to stuffed toy camel, found suggestive); *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 740 F.2d 631, 641 (7th Cir. 1984) (district court did not err in finding “LA” for low alcohol beer suggestive rather than descriptive); *Citibank, N.A. v. Citibanc, Inc.*, 724 F.2d 1540 (11th Cir. 1984) (“Citibank” as applied to a bank found suggestive, but dissent argues that mark should be considered generic); *Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666 (7th Cir. 1982) (upholding district court’s finding that “The Money Store,” as applied to money lending services, was suggestive); *American Home Prods. Corp. v. Johnson Chemical Co., Inc.* 589 F.2d 103, 106 (2d Cir. 1978) (“Roach Motel” as applied to insect trap found “at least” suggestive, if not arbitrary); *Douglas Laboratories Corp. v. Copper Tan, Inc.*, 210 F.2d 453 (2d Cir. 1954) (“Copper Tone” for suntan lotion found suggestive rather than descriptive).

⁷⁹ *Abercrombie & Fitch Co.*, 537 F.2d at 11 (citation omitted).

⁸⁰ See *Douglas Laboratories Corp.*, 210 F.2d 453 (“Copper Tone” for suntan lotion found suggestive rather than descriptive).

and related words with which to describe the qualities which manufacturers may wish to claim for their products and the ingenuity of the public relations profession supplies new words and slogans as they are needed.”⁸¹

A descriptive mark, as the term implies, “conveys an immediate idea of the ingredients, qualities or characteristics of the goods” or services to which it is attached.⁸² For example, the name “Teddy Graham” describes a teddy bear-shaped graham cracker cookie; therefore, the mark could be considered descriptive of *any* graham cracker shaped like a teddy bear. In that sense, descriptive terms travel close to being the general term for a product or service category (i.e., generic).⁸³ The Lanham Act allows registration of “merely descriptive” terms such as “Teddy Graham” only when the term has acquired distinctiveness, or secondary meaning.⁸⁴ The term “secondary meaning” is itself a bit of a misnomer. A term is said to have acquired secondary meaning only when its *primary* meaning in the minds of the consuming public is that of a source identifier: “[A]s a result of [the descriptive term’s] use, prospective purchasers have come to perceive [the term] as a designation that identifies goods [or] services” that are “produced or sponsored by a particular person.”⁸⁵ In other words, if the consuming public takes the term “Teddy

⁸¹ Abercrombie & Fitch Co., 537 F.2d at 11 (citation omitted).

⁸² *Id.* (internal citation omitted); *see, e.g.*, In re Oppedahl & Larson LLP, 373 F.3d 1171 (Fed. Cir. 2004) (upholding T.T.A.B. finding that “patents.com,” as applied to software for tracking patent applications and issued patents, was descriptive); Security Center, Ltd. v. First National Security Centers, 750 F.2d 1295 (5th Cir. 1985) (upholding district court finding that “security center,” as applied to business housing private storage vaults, was descriptive rather than suggestive); Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir. 1983) (upholding district court finding that “chick-fri” and “fish-fri,” as applied to coating for fried food, was descriptive rather than suggestive); Spex, Inc. v. The Joy of Spex, Inc., 31 U.S.P.Q. 2d 1019 (N.D. Ill. 1994) (“spex” found descriptive).

⁸³ In re The Boston Beer Co., 198 F.3d 1370, 1373 (Fed. Cir. 1999).

⁸⁴ 15 U.S.C. § 1052(f) (“[N]othing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”) (Lanham Act § 2(f)).

⁸⁵ RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 13(a),(b) (1995); *see also* Zatarain’s, Inc., 698 F.2d at 795 (mark has acquired secondary meaning if it denotes to the consumer “a single thing coming from a single source”) (citing Coca-Cola Co. v. Koke Co., 254 U.S. 143, 146 (1920)); *see also* Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851 n. 11 (1982).

Graham” to mean a specific product emanating from a specific source—i.e., it is functioning as a source identifier—the term can be a trademark. Absent proof of secondary meaning, a descriptive term cannot be protected as a trademark.⁸⁶

Regardless of the trademark category in which a term resides, all valid trademarks must function as source identifiers, with the attendant benefits in efficiency to the consumer explained above. Descriptive and suggestive marks serve the additional function of conveying information to the consumer about the products to which they are attached. From a marketer’s perspective, descriptive and suggestive terms are the most valuable types of marks, because they educate the consumer about the product, negating or at least reducing the need to do so through advertising. Soy Vay®, for example, could be classified as a suggestive mark, as the name alludes to the inclusion of soy sauce in the product and the attendant taste. If instead the sauce were called SHABAZZ or some other fanciful name, a consumer looking at the label would have no idea of what was in the sauce and/or how it tasted. To discover the qualities of the product, the consumer would have to be informed and/or induced to experiment with the sauce by advertising. Thus, all trademarks are not created equal and, somewhat ironically, those marks that are the “strongest” in terms of their inherent distinctiveness (fanciful and arbitrary marks) are probably the least efficient in reducing consumer search costs.⁸⁷ Nonetheless, these types of marks are entitled to the highest degree of protection under both common law and the Lanham Act.

⁸⁶ 15 U.S.C. § 1052(e) (No mark may be registered which is “merely descriptive” of the applicant’s goods).

⁸⁷ See Carter, *supra* note 32, at 770-71. Carter characterizes descriptive and suggestive marks as “cheaper information economizers” and, hence, more efficient. Carter further points out that, even as to fanciful or arbitrary marks, some are more desirable than others, as evidenced by the amount of time and money companies invest in choosing their marks. *Id.*

Generic words are unprotectable under the Lanham Act⁸⁸ and the common law doctrine of unfair competition⁸⁹ because they do not (or no longer) have the capacity for source identification. The generic name is incapable of ever becoming a trademark, at least as to the product with which the generic name is associated.⁹⁰ “If the primary significance of the trademark is to describe the *type of product* rather than the *producer*, the trademark is a generic term”⁹¹ For example, if one calls one’s product “apple peeler” and the product is a device to peel apples, the term is generic and cannot be used as a trademark. Yet if one’s product is a computer or a record, “apple” is arbitrary and entitled to the highest trademark protection. In contrast, as was the case with the word “aspirin,” a mark may begin as fanciful—a trademark class that receives the highest protection—and then drop to the lowest, unprotected class of terms, generic through the process of genericide.⁹²

⁸⁸See 15 U.S.C. § 1064 (“A petition to cancel a registration of a mark. . . may. . . be filed. . . (3) [a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered. . . .”); 15 U.S.C. § 1127 (“A mark shall be deemed to be ‘abandoned’ . . . [w]hen any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used. . . .”); 15 U.S.C. § 1115 (b) (even “incontestable” marks are subject to the defense “that the mark has been abandoned by the registrant”).

⁸⁹See *Miller Brewing Co. v. Falstaff Brewing Co.*, 655 F.2d 5, 7-8 & n.2 (1st Cir. 1981) (citing cases); *but see* notes 127-133 and accompanying text.

⁹⁰See notes 117 and 188, *infra*.

⁹¹*Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (emphasis in original; internal citations omitted). *See, e.g., Id.* (affirming summary judgment on grounds that “Filipino Yellow Pages,” as applied to phone directory marketed to Filipino-American community, was generic); *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153 (7th Cir. 1996) (reversing district court grant of preliminary injunction on grounds that “Shoe Warehouse” and “Warehouse Shoes,” as applied to store selling large inventory of shoes, was generic); *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 80 (7th Cir. 1977) (reversing district court grant of preliminary injunction on grounds that “lite beer,” as applied to low-calorie beer, was generic); *compare Anheuser-Busch Inc. v. Stroh Brewery Co.*, 740 F.2d 631, 641 (7th Cir. 1984) (district court did not err in finding “LA” for low alcohol beer suggestive rather than descriptive); *see also Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 930 (9th Cir. 2005) (reversing summary judgment on grounds that “yellow cab” was not generic as a matter of law); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001) (reversing T.T.A.B. finding that “1-888-M-A-T-R-E-S-S” was generic).

⁹²See notes 136-150 and accompanying text, *infra*.

The twin goals of trademark law—economic efficiency and consumer protection—are not served in the case of generic words and, therefore, they cannot become (or remain) trademarks. When a word is or becomes generic, in theory that word is or has become the name of the good or service to which it is attached. For example, if grocery shoppers called *all* teriyaki sauces “soy vays,” the name would no longer inform the consumer about the attributes of one specific sauce. A word that is truly generic signals only that the good is a member of a particular product class.

For the same reason, granting trademark rights in generic words does nothing to prevent the consumer from being deceived, in the grocery store or elsewhere. If all teriyaki sauces are called soy vays, then so long as the label is placed upon a good in the proper product class, the consumer gets what he pays for when he buys a bottle of soy vay. Therefore, the consumer receives no benefit from trademark protection of truly generic words. Perhaps most importantly, generic words do not receive trademark protection because doing so would substantially harm the trademark holder’s competitors by preventing them from telling the public the name of the product or service they were attempting to sell.⁹³ Thus, trademark protection does not apply to generic words or terms, because such protection would provide no benefit to the consumer and in fact would substantially harm the consumer by suppressing competition. In addition, the public as a whole would suffer if truly generic words were allowed to become trademarks, because the public’s ability to use such words in everyday speech and print would potentially be abbreviated. For all of these reasons, trademark protections do not apply to generic words.

⁹³ See Nguyen, *supra* note 7, at 744; see also Folsom & Teply, *supra* note 32, at 1323.

B. *Following the Path to Genericism: The Evolution of a Doctrine*

For the reasons stated above, producers of goods or services typically do not choose obviously generic names as trademarks. They have no incentive to do so, for (1) the name can and will be duplicated by competitors (with no legal redress); and (2) for that reason, it serves no source-identifying purpose. However, many generic names did not start out that way. They were created as protectable—often even arbitrary or fanciful—trademarks but evolved into generic words through the process of genericide. Many words that we use today in common speech have suffered this fate, including aspirin, brassiere, cola, escalator, lanolin, linoleum, Murphy bed, thermos, and yo-yo.⁹⁴ Moreover, the line between descriptive and generic words has proved to be an exceedingly difficult one to draw; therefore, the trademark holder may choose a brand name that she thinks is descriptive, only to learn later (much to her dismay and financial detriment) that the term is generic and hence unprotectable.⁹⁵ The following section traces the origins of the genericism doctrine in trademark law and critiques the manner in which it has evolved.

⁹⁴ See *Murphy Door Bed Co., Inc. v. Interior Sleep Systems*, 874 F.2d 95 (2nd Cir. 1981) (Murphy bed); *Donald F. Duncan, Inc. v. Royal Tops Manufacturing Co.*, 343 F.2d 655 (7th Cir. 1965) (yo-yo); *King Seely Thermos Co. v. Alladin Indus., Inc.*, 321 F.2d 577, 581 (2nd Cir. 1963) (thermos); *Dixi-Cola Laboratories, Inc. v. Coca-Cola Co.*, 117 F.2d 352 (4th Cir. 1941) (cola); *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (Comm’r Pat. 1950) (escalator); *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (aspirin); *Charles R. DeBevoise Co. v. H&W. Co.*, 69 N.J. Eq. 114, 60 A.D. 407 (1905) (brassiere); *Jaffe v. Evans & Sons*, 70 A.D. 186, 75 N.Y.S. 257 (1902) (lanolin); *Linoleum Mfg. Co. v. Nairn*, 7 Ch.D. 834 (1878) (linoleum).

⁹⁵ See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (shredded wheat); *Retail Services, Inc., v. Freebies Publishing*, 364 F.3d. 535 (4th Cir. 2004) (freebies); *Natron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397 (6th Cir. 2002) (smart power); *Miller Brewing Co., v. Falstaff Brewing Corp.*, 655 F.2d 5 (1st Cir. 1981) (lite beer); *CES Pub Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11 (2nd Cir. 1975) (consumer electronics); *Bascom Laundry Corp. et. al. v. Telecoin Corp. et.al.*, 264 F. 2d 331 (2nd Cir. 1953) (launderette); *Schwan’s IP, LLC v. Kraft Pizza Co.*, 379 F. Supp. 2d 1016 (D. Minn. 2005) (brick oven pizza); *Loctite Corp. v. National Starch and Chemical Corp.*, 516 F. Supp. 190 (S.D.N.Y. 1981) (super glue).

1. *The Common Law Roots of Genericism and Genericide*

a. *Common law distinctions between trademarks and trade-names*

At common law, only “technical trademarks”—what today would be classified as fanciful, arbitrary or suggestive marks—were protected against trademark infringement.⁹⁶ Similarly, only technical trademarks were registrable under the Trade-Mark Act of 1905, which was intended to codify, not alter, the common law of trademarks.⁹⁷ The 1905 Act specified that personal names, geographic terms and terms that were “descriptive of the goods with which they are used, or of the character or quality of such goods” could not be registered.⁹⁸ However, even though these “non-technical trademarks” were excluded from protection under trademark law, they were still entitled to protection—if the user could prove they had acquired secondary meaning—as “trade names” under the common law tort of passing off or unfair competition.⁹⁹ In fact, even the 1905 Act allowed for

⁹⁶ See *Canal Co. v. Clark*, 80 U.S. 311, 323 (1871) (holding that “a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, [cannot] be employed as a trade-mark and the exclusive use of it be entitled to legal protection”); *Lawrence Manuf’g Co. v. Tennessee Manuf’g Co.*, 138 U.S. 537, 547 (1891) (same).

⁹⁷ The Act specified that it did not “prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if . . . this Act had not been passed.” Trade-Mark Act of 1905, ch. 592, § 23, 33 Stat 724 (1905) (repealed 1946).

⁹⁸ Trade-Mark Act of 1905, ch 592, § 5, 33 Stat 724 (1905) (repealed 1946).

⁹⁹ See, e.g., *Standard Oil Co. of Maine v. Standard Oil Co. of N.Y.*, 45 F.2d 309, 310 (1st Cir. 1930) (because “Standard Oil” and “Standard Oil Company” had acquired secondary meaning, appellee was entitled to protection against “unfair or fraudulent use” of the name in competition); *Computing Scale Co. v. Standard Computing Scale Co.*, 118 F. 965, 967 (6th Cir. 1902) (when a word “is incapable of becoming a valid trade-mark. . . yet has by use come to stand for a particular maker or vendor, its use by another in this secondary sense will be restrained as unfair and fraudulent competition. . . .”); *American Waltham Watch Co. v. U.S. Watch Co.*, 53 N.E. 141, 142 (Mass. 1899) (even though “Waltham” was not a valid trademark, it had acquired secondary meaning and hence was entitled to protection from unfair competition); see generally RESTATEMENT OF TORTS § 716 (b) & cmt. b (1938) (trade name has acquired “secondary meaning” when “a substantial number of present or prospective purchasers understand the designation, when used in connection with goods, services, or a business, not in its primary lexicographical

registration of marks that were “in actual and exclusive use as a trademark” for ten years preceding its date of enactment (February 20, 1905), even if such marks were descriptive or otherwise did not qualify as technical trademarks.¹⁰⁰ This provision—often labeled the Ten-Year Law—has been described as “a codification of the secondary meaning theory.”¹⁰¹

Common law trademarks were initially entitled to broader protection than were common law trade names.¹⁰² During the late nineteenth century, the courts recognized an exclusive property right in trademarks that created a virtual monopoly on the part of the trademark holder.¹⁰³ As the United States Supreme Court reflected in *The Trade-Mark Cases*, “The right to adopt and use a symbol or a device to distinguish the goods or

sense, but as referring to a particular place or association”); HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* § 50 (3d ed. 1929) (“In the absence of secondary meaning, the law of unfair competition does not protect a name which is based on or is truly descriptive of the construction common to, or characteristics of an article.”).

¹⁰⁰Trade-Mark Act of 1905, ch 592, § 5, 33 Stat 724 (1905) (repealed 1946); *Thaddeus Davids Co. v. Davids*, 233 U.S. 461, 466-67 (1914) (interpreting this section of the Act).

¹⁰¹NIMS, *supra* note 99, at § 43; *see also id.* at § 229a. The now-ubiquitous trademark “Coca-Cola” is an example of a mark that was registered under the Ten-Year Law. *See Nashville Syrup Co. v. Coca-Cola Co.*, 215 F. 527, 530 (6th Cir. 1914).

¹⁰²*See Church & Dwight Co. v. Russ*, 99 F. 276, 278-79 (C.C. Ind. 1900) (discussing differences between technical trademarks and trade names); Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 316-17 (1979) (describing differences between technical trademarks and trade names in the context of late-nineteenth century “legal formalism”); Milton Handler & Charles Pickett, *Trade-Marks and Trade Names – An Analysis and Synthesis: Part I*, 30 COLUM. L. REV. 168, 168-70 (1930) (explaining the technical differences between trademarks and trade names); JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* § 4 (4th ed. 1924) (opining that trademark rights are “broader and by far . . . more valuable” than rights to a trade-name).

¹⁰³*See, e.g.,* Kenneth J. Vandevelde, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 BUFF. L. REV. 325, 343-44 (1980) (describing early treatment of trademarks as “absolute property”); McClure, *supra* note 102, at 317-19 (characterizing early treatment of technical trademarks as conferring monopolistic property rights); Grafton Dulany Cushing, *On Certain Cases Analogous to Trade-Marks*, 4 HARV. L. REV. 321, 322 (1890) (noting that “[a] trademark has become an absolute right”); *cf. HOPKINS, supra* note 102, at § 24 (arguing that trademark rights are not “monopolistic” in character).

property made or sold by the person whose mark it is, *to the exclusion of use by all other persons*, has been long recognized by the common law. . . . It is a property right. . . .”¹⁰⁴

Trade names, on the other hand, were protected only when they had acquired secondary meaning, as discussed above, and only in cases of “fraud.”¹⁰⁵ At its core, the common law “fraud” requirement, in cases of unfair competition or trade dress infringement, was and is essentially identical to the “likelihood of confusion” standard that now applies in trademark infringement cases as well.¹⁰⁶ In other words, there is no trademark infringement and no “unfair” competition if the consumer is not likely to be confused by the alleged misuse of the trademark or the trade name. Some earlier cases involving common law trade names also required that, to constitute “fraud” necessary to enjoin a competitor’s use of a trade name, the plaintiff had to show that the defendant *intended* to pass off his goods as those of the plaintiff; in other words, that the defendant

¹⁰⁴ The Trade-Mark Cases, 100 U.S. 82, 92 (1879) (emphasis added); *see also* Kidd v. Johnson, 100 U.S. 617, 619 (1879) (“The right to use the trade-mark is not limited to any place, city, or State, and, therefore, must be deemed to extend everywhere.”).

¹⁰⁵ *See* Cushing, *supra* note 103, at 332 (in “cases analogous to trade-marks,” i.e., cases involving common law trade names, “fraud is the gist of the action”); HOPKINS, *supra* note 102, at § 22 (“While fraud is presumed from the wrongful use of a trademark it must be proven, directly or by inference, in all cases of unfair competition which do not involve a technical trademark.”) (citing cases); *see also id.* at § 61 (use of “merely descriptive word” will not be restrained unless circumstances show “fraud on the part of the user”).

¹⁰⁶ *See, e.g.*, Auto Body Specialists, Inc. v. Vallee, 500 A.2d 372, 375 (N.H. 1985) (in a case of common law infringement of a trade name, plaintiff’s right to injunctive relief depends on whether a “substantial likelihood of confusion resulted from defendant’s use”) (Souter, J.) (citations omitted); Boice v. Stevenson, 187 P.2d 648, 653 (Ariz. 1947) (“The universal test [of unfair competition] is whether the public is likely to be deceived”) (citation omitted); J.C. Penney Co. v. Walker, 395 S.W.2d 76, 79 (Tex. App. 1965) (Wilson, J., concurring) (noting that, even if a descriptive name has acquired secondary meaning, “if there is not shown confusion of the public or tendency to deception,” there is no unfair competition); Sartor v. Schaden, 101 N.W. 511, 513 (Iowa 1904) (even if a word is not “capable of becoming an arbitrary trade-mark,” if it has acquired secondary meaning its use will be restrained if “confusion [of the public] has been or is likely to be produced”); Family Record Plan, Inc. v. Mitchell, 342 P.2d 10, 16 (Cal. App. 1959) (whether trade dress has been infringed depends in part on “whether the public is likely to be deceived”) (citation omitted); New York World’s Fair v. World’s Fair News, 256 A.D. 373, 374 (N.Y. App. 1939) (“The determining factor is not that people have actually been deceived but that there is a likelihood of that happening.”) (citation omitted); *see also* Handler & Pickett, *supra* note 102, at 169 (competitor’s use of a trade names will be restrained only when such use “render[s] it likely that the public will confuse the products bearing the marks”).

had an intent to confuse.¹⁰⁷ This requirement, however, was applied inconsistently, with most courts eventually adopting what the Supreme Court of Georgia characterized as the “better view” that “an actual fraudulent intent need not be shown if the necessary and probable tendency of defendant’s conduct is to deceive the public and to pass off his goods or business as that of the plaintiff. . . .”¹⁰⁸

As the monopolistic approach to trademarks gave way to the now-familiar maxim that trademarks are *not* held “in gross,” courts imposed limitations on trademark rights that were identical to those already in place for cases involving trade names.¹⁰⁹

Therefore, the supposed distinction between common law trademarks and trade-names became more formalistic than real, and courts began to treat the two classes of common

¹⁰⁷ See, e.g., J.C. Penney Co., 395 S.W.2d at 79 (Wilson, J., concurring) (action for “deceptive simulation” of “generic words” that have acquired secondary meaning requires a finding that “such simulation was calculated to deceive ordinarily prudent persons”); *Belleville News-Democrat, Inc. v. St. Clair County Publishers, Inc.*, 167 N.E. 2d 573, 575 (Ill. App. 1960) (use of generic or descriptive word that has acquired secondary meaning may be enjoined when its use by another “is palpably intended to deceive”); *New York World’s Fair*, 256 A.D. at 375 (when “the appropriation and continued use of the name of another. . . are conceived in bad faith and with an intent to deceive the public, equity will afford complete and adequate relief. . . .”); *Drive It Yourself Co. v. North*, 130 A. 57, 59 (Md. App. 1925) (use of “merely generic or descriptive” words may be enjoined only if there is “actual fraud or intent to deceive”); McClure, *supra* note 102, at 317 (in an unfair competition claim plaintiff “was required to prove . . . fraudulent intent by the defendant”).

¹⁰⁸ *Saunders System Atlanta Co., Inc. v. Drive It Yourself Co. of Georgia*, 123 S.E. 132, 136 (Ga. 1924); see also *McGraw-Hill Pub. Co. v. American Aviation Associates*, 117 F.2d 293, 296 (D.C. Cir. 1940) (“Unfair competition in the trade name field is not concerned with intent or plan; it is enough if the acts of the defendant in light of plaintiff’s reputation result in an unfair benefit to the former”). According to the Restatement of Torts, “fraud”—in terms of the defendant’s actual (not implied) intent to deceive the public—was a required element of trade-name infringement under the common law only when plaintiff’s trade-name had *not* acquired secondary meaning: “[t]he notion that fraud is necessary for trade name infringement is largely due to the loose denomination of such a name as a trade name.” RESTATEMENT OF TORTS, *supra* note 99, at § 717 cmt. a; see also *First Wisconsin Nt’l Bank v. Wichman*, 270 N.W.2d 168, 173 (Wis. 1978) (same); see generally E.H. Schloper, Annotation, *Doctrine of Secondary Meaning in the Law of Trademark and of Unfair Competition*, 150 A.L.R. 1067, 1133 (1944) (noting split of authorities as to whether “it is necessary for the plaintiff to show actual fraud on the part of the defendant” in cases where plaintiff’s rights in a trade-name are predicated on secondary meaning).

¹⁰⁹ See, e.g., *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916) (“Common-law trademarks, and the right to their exclusive use, are, of course, to be classed among property rights, but only in the sense that a man’s right to the continued enjoyment of his trade reputation and the good will that flows from it, free from unwarranted interference by others, is a property right, for the protection of which a trademark is an instrumentality. [*T*]he right grows out of use, not mere adoption.”) (emphasis added and internal citation omitted); see also *Church & Dwight Co. v. Russ*, 99 F. 276, 278 (C.C. Ind. 1900) (“The tendency of the courts at the present time seems to be to restrict the scope of the law applicable to technical trademarks, and to extend its scope in cases of unfair competition.”) (citations omitted).

law marks essentially the same.¹¹⁰ The Supreme Court recognized and articulated this development in 1916:

Courts afford redress or relief upon the ground that a party has a valuable interest in the good-will of his trade or business. . . . The essence of the wrong consists of the sale of the goods of one manufacturer for those of another. *This essential element is the same in trade-mark cases as in cases of unfair competition unaccompanied by trademark infringement.* In fact, the common law of trademarks is but a part of the broader law of unfair competition.¹¹¹

Despite this similarity of treatment under the common law, a trade name (unlike a common law trademark) could not be registered under the Trademark Act of 1905 if it did not meet the requirements of the Ten-Year Rule.¹¹² This discrepancy was not particularly important, as the benefits of federal registration were limited.

The rights of registered trademark holders expanded greatly when the Lanham Act was passed in 1946. First, the Act expanded the types of marks that were eligible for protection under the federal law by allowing registration of even “merely descriptive marks,” so long as they have become “distinctive of the applicant’s goods in commerce.”¹¹³ A “common descriptive” name of an article (i.e., a generic name), however, could not be registered under any circumstances.¹¹⁴ Therefore, since 1946, a descriptive mark that has acquired secondary meaning (but not a generic one) may be

¹¹⁰ See Handler & Pickett, *supra* note 102 (arguing that trademarks and trade names are essentially treated the same under common law); RESTATEMENT OF TORTS, *supra* note 99, at § 717 cmt. a (stating that “there are no important differences between the protection given to the interest in trade-marks and that given to the interest in trade names”).

¹¹¹ Hanover Star Milling Co., 240 U.S. at 412-13 (emphasis added).

¹¹² Trade-Mark Act of 1905, ch 592, § 5, 33 Stat 724 (1905) (repealed 1946); Thaddeus Davids Co. v. Davids, 233 U.S. 461, 466-67 (1914) (interpreting this section of the Act); Barber-Colman Co. v. Overhead Door Corp., 65 F.2d 147, 150 (C.C.P.A. 1933) (holding that mark which has acquired secondary meaning, but is not a technical trademark, cannot be registered under Trade-Mark Act of 1905 unless 10-year rule applies); see also Zechariah Chafee, Jr., *Unfair Competition*, 53 HARV. L. REV. 1289 (1940) (arguing that, because trade names and trademarks are essentially treated the same under the common law, both should be protected and registrable under the Federal Trademark Act).

¹¹³ Lanham Act, ch 540, § 2(e) & (f), 60 Stat 427, 429 (1946) (amended 1988).

¹¹⁴ Lanham Act, ch 540, § 15(4), 60 Stat 427, 434 (1946) (amended 1988).

protected from infringement under the Lanham Act as well as the state common law of unfair competition. Second, unlike previous iterations of the federal trademark statute, the 1946 Lanham Act expanded the rights of registered trademark holders beyond those attainable under common law. At common law, trademark (and trade name) rights were limited to the mark holder’s geographic area of use—in other words, the first user of the mark could claim priority only in those geographic areas in which his mark had acquired “goodwill.”¹¹⁵ Under the 1946 Lanham Act, however, the holder of a registered mark acquired nationwide priority against any “junior” user of the mark, even if the junior user was the first to acquire goodwill in a given geographic area.¹¹⁶

b. *Common law treatment of generic or “common descriptive” terms as trade-names*

In contrast to the 1946 Lanham Act, the common law treated neither “descriptive” nor “generic” terms as “technical trademarks,” and therefore they could not be protected against *trademark* infringement. However, this discrepancy in terminology made little practical difference, at least with regard to terms that had acquired secondary meaning. As explained above, such terms were protected from infringement under the common law doctrine of unfair competition.

Modern caselaw generally takes as a given the notion that, unlike descriptive terms, “generic” words or terms are and have always been unprotectable under the

¹¹⁵ Hanover Star Milling Co., 240 U.S. at 414; United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97-98 (1918).

¹¹⁶ Lanham Act, ch 540, § 2(d), 60 Stat 427, 428 (1946) (amended 1988).

common law, even if such words have acquired secondary meaning.¹¹⁷ Although courts have consistently held that “generic” or “common descriptive” terms cannot be registered as trademarks under the Lanham Act,¹¹⁸ a closer examination of the common law of unfair competition reveals that these cases did not attempt to draw a bright line between generic and descriptive terms.¹¹⁹ In other words, common law courts—unlike modern ones—did not devote a great deal of attention to determining whether a given term should be etymologically classified as generic or descriptive. Both “words descriptive of qualities or attributes” and “generic designations” were potentially protectable as trade

¹¹⁷ See, e.g., *Blinded Veterans Ass’n v. Blinded American Veterans Found.*, 872 F.2d 1035, 1045 n. 22 (D.C. Cir. 1989) (“generic term that acquires de facto secondary meaning is still not afforded trademark protection”); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 924 (10th Cir. 1986) (“Trademarks that have become generic are subject to cancellation even if they have acquired a secondary meaning.”); *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) (generic term “cannot become a trademark under any circumstances”); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977) (“[E]ven proof of secondary meaning. . . cannot transform a generic term into a subject for trademark.”); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (same); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 15 (2d Cir. 1975) (“merely descriptive” terms can be “rescued as trademarks” via proof of secondary meaning, but generic terms cannot); see generally 2 MCCARTHY, *supra* note 34, §§ 12:1, 12:47 (generic name “can never function as a trademark to indicate origin”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. a (1995) (“Generic designations are not subject to appropriation as trademarks at common law. . . .”); 3 LOUIS ALTMAN, *CALLMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 20:33 n. 49 & 50 (West 2004) (citing cases).

¹¹⁸ See, e.g., *J. Kohnstam, Ltd. v. Louis Marx and Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960) (“common descriptive name” of an article cannot be registered as a trademark, despite evidence of secondary meaning); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 846 (C.C.P.A. 1961) (canceling registration of the mark Ha-Lush-Ka on the grounds that it was the “common descriptive name for egg noodles”); *In Re Space-General Corp.*, 136 U.S.P.Q. 77, 78 (T.T.A.B. 1962) (refusing registration of Space Electronics for navigational guidance equipment on grounds that it was a “common descriptive name”); *In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 776 (T.T.A.B. 1981) (refusing registration of “Softsoap” for liquid soap on grounds that “proof of secondary meaning cannot transform a generic term into a subject for trademark registration”); *but cf. In re Minnetonka, Inc.*, 3 U.S.P.Q. 2d 1711, 1713 (T.T.A.B. 1987) (finding that “Softsoap” is not generic, based on additional evidence submitted in support of trademark application).

¹¹⁹ See, e.g., *Speaker v. Shaler Co.*, 87 F.2d 985, 987 (7th Cir. 1937) (noting that “descriptive words” are “included within the broader category of generic terms”); *HOPKINS, supra* note 102, at § 46 (defining a “generic term” as any term that is “too general in its meaning to become the monopoly of an individual in application to merchandise,” including geographical names, proper names, and descriptive words).

names (but not as technical trademarks), *if they functioned as source identifiers in the marketplace* (if, in other words, they had acquired secondary meaning).¹²⁰

Although McCarthy characterizes this view as an “aberrant” one adopted by only a minority of courts,¹²¹ numerous state and federal courts have held – particularly during the pre-Lanham Act era – that so-called “generic terms” are entitled to protection from “passing off” or infringement, if they have acquired secondary meaning. In fact, the common law precedents of most states held that the secondary meaning doctrine applied to words both “generic” and descriptive in character.¹²² Likewise, many federal courts have also held that “purely generic or descriptive” words are entitled to protection from

¹²⁰ Handler & Pickett, *supra* note 102, at 169; *see also* McClure, *supra* note 102, at 316 (same); HOPKINS, *supra* note 102, at § 49 (noting that “[t]he protection of equity is extended under proper circumstances to generic words as readily as to technical trademarks”); *see generally* Schloper, *supra* note 108, at 1095 (stating that “words, or combinations of words, may, by acquiring secondary meaning, become entitled to protection . . . though in their primary sense they are . . . generic or descriptive”).

¹²¹ 2 MCCARTHY, *supra* note 34, § 12:46.

¹²² *See, e.g.*, Bell v. Davidson, 597 P.2d 753, 755 (Ok. 1979) (generic or descriptive names may be protected against unfair competition if they have acquired secondary meaning); Staple Cotton Cooperative Ass’n v. Federal Staple Cotton Co-op Ass’n, 162 So.2d 867, 869 (Miss. 1964) (same); Storm v. Canyon Amusement Corp., 79 N.W. 2d 698, 700 (S.D. 1956) (same); Golden Slipper Square Club v. Golden Slipper Rest. & Catering, 88 A.2d 734 (Pa. 1952) (same); Farrell v. Mennen Co., 235 P.2d 128, 130 (Utah 1951) (same); Bernstein v. Friedman, 160 P.2d 227, 229 (Wyo. 1945) (same); Houston v. Berde, 2 N.W.2d 9, 10 (Minn. 1942) (when “generic words are used in a trade-name,” their use will be restrained when such use causes confusion or deception); Academy of Motion Picture Arts & Sciences v. Benson, 104 P.2d 650, 652 (Cal. 1940) (deceptive use of “generic, descriptive, personal, and geographic names” that have acquired secondary meaning constitutes unfair competition); Jenney Mfg. Co. v. Leader Filling Stations Corp., 196 N.E. 852, 855 (Mass. 1935); Electric Supply Co. v. Hess, 245 P. 27, 28 (Wash. 1926) (secondary meaning doctrine applies to “common, descriptive [and] generic words”); Saunders System Atlanta Co., Inc. v. Drive It Yourself Co. of Georgia, 123 S.E. 132, 136 (Ga. 1924) (same); American Waltham Watch Co. v. U.S. Watch Co., 53 N.E. 141, 142 (Mass. 1899) (plaintiff can exclude defendant from “the mere use of generic words, unqualified and unexplained, when they would mislead plaintiff’s customers to another shop”); MacPhail v. Stevens, 586 P.2d 1339 (Colo. App. 1978) (generic and descriptive terms are not entitled to trademark protection without a showing of secondary meaning); Anti-Defamation League of B’nai B’rith v. Arab Anti-Defamation League, 340 N.Y.S.2d 532, 543-44 (1972) (either “generic or descriptive” tradenames may be entitled to protection upon showing of secondary meaning); Williamson v. Answer Phone of Jacksonville, Inc., 118 So. 2d 248, 251 (Fla. App. 1960) (same); Better Business Bureau of Kansas City Adv. Club, Inc. v. D. J. Chappell, 307 S.W.2d 510, 515 (Mo. App. 1957) (same); Moskins Stores, Inc. v. Columbus Bentley Mercantile Co., 22 Ohio Law Abs. 488, 1936 WL 4309 at *1 (Oh. App. 1936) (same; quoting Corpus Juris); Hartzler v. Goshen Churn & Ladder Co., 104 N.E. 34, 38 (Ind. App. 1914) (same).

unfair competition, provided that they have acquired secondary meaning.¹²³ Although the reasoning of these cases (particularly the federal ones) has largely been repudiated,¹²⁴ some states still adhere to this doctrine. For example, in 1985 Justice Souter (while sitting on the New Hampshire Supreme Court) wrote that “words or phrases may enter commerce as *merely generic or descriptive*, but commercial usage can invest them with a secondary meaning associating them with a given business, so as to entitle that business to protect the association.”¹²⁵ Oregon also recognizes that “generic names” may acquire “a legally protectible secondary meaning” under the common law.¹²⁶ As recently as 1998, a Pennsylvania court held that even though a “generic term” is never granted trademark protection, “an action for unfair competition on the basis of likelihood of

¹²³ *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 F. 651, 659-60 (Cir. Ct. Del. 1899); *see also* *Murphy Door Bed Co., Inc. v. Interior Sleep Systems, Inc.*, 874 F.2d 95, 102 (2d Cir. 1989) (recognizing state law doctrine by which “a generic term already in public use later acquires secondary meaning . . . thus warranting trademark protection”); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 374-75 (1st Cir. 1980) (although “at common law terms that are generic are normally not subject to appropriation as trademarks, . . . a strong showing of secondary meaning may be sufficient to grant a right to exclusive use”); *American Aloe Corp. v. Aloe Crème Laboratories, Inc.*, 420 F.2d 1248, 1251 & 1253 (7th Cir. 1970) (noting that “in the absence of a strong showing of secondary meaning, a generic name cannot be the basis of a trademark”); *Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836, 838 (2d Cir. 1935) (generic word may acquire secondary meaning); *G.W. Cole Co. v. American Cement & Oil Co.*, 130 F. 703, 705 (7th Cir. 1904) (“unfair use” of even a “purely generic or descriptive word” may be enjoined as unfair competition); *Dadirrian v. Yacubian*, 98 F. 872, 879-80 (1st Cir. 1900) (“secondary use of a generic term” may be protected if such use may confuse the public); *Bliss Cleaning Niagara, Inc. v. Midwest Brake Bond Co.*, 339 F. Supp. 2d 944, 965 (W.D. Mich. 2004) (“Generic and descriptive marks. . . are not entitled to trademark protection unless they have acquired secondary meaning”); *Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, Inc.*, 371 F. Supp. 900, 908 (W.D. Ark. 1974) (same); *American Products Co. v. American Products Co.*, 42 F.2d 488, 489 (E.D. Mich. 1930) (words which are “purely generic or descriptive” are not arbitrary trade-marks, but still may be protected from unfair competition); *Dry Ice Corp. of America v. Louisiana Dry Ice Corp.*, 46 F.2d 526, 531 (W.D. La. 1930) (secondary meaning doctrine may apply to descriptive words or “names of a generic class”), *rev’d on other grounds*, 54 F.2d 882 (5th Cir. 1932).

¹²⁴ *See* note 117, *supra*.

¹²⁵ *Auto Body Specialists, Inc. v. Vallee*, 500 A.2d 372, 374 (N.H. 1985) (finding “auto body specialists” to be a protectable trade name) (emphasis added). In *Vallee*, Justice Souter characterized the “view that generic (or even some descriptive) terms are *inherently* incapable of *ever* becoming secondary meaning marks” as “ill-considered.” *Id.* (emphasis in original).

¹²⁶ *Classic Instruments, Inc. v. VDO-Argo Instruments, Inc.*, 700 P.2d 677, 687 (Or. App. 1985) (citation omitted); *see also* *Liquidators v. Clifton*, 286 P. 152, 153 (Or. 1930); *Umpqua Broccoli Exchange v. Umpqua Valley Broccoli Growers*, 245 P. 324, 327 (Or. 1926).

confusion may still lie.”¹²⁷ Of course, most “generic” names (e.g., apple peeler, beer, cookies) are unlikely, by their very nature, to acquire secondary meaning, and therefore were unlikely to acquire protection under the common law.¹²⁸ However, most common law cases did not hold that “generic” names were inherently incapable of acquiring secondary meaning.

Modern courts refuse to extend trademark protection to generic words or terms because they are concerned that doing so would negatively impact competition: “[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.”¹²⁹ The early common law courts shared this same concern, and for this reason they were unwilling to extend *trademark* rights—which were, at least initially, significantly more monopolistic in character than rights in a trade name¹³⁰—to generic *or* descriptive words or terms. In 1871 the United States Supreme Court held that neither a “generic name, [nor] a name merely descriptive of an article of trade. . . [may] be employed as a trade-mark and the *exclusive* use of it be entitled to legal protection.”¹³¹

However, as noted above, the courts’ refusal to extend trademark rights to such words did not preclude their protection as trade names under the common law doctrine of unfair competition. The courts attempted to protect competition in such cases via what today would be characterized as “classic fair use”—the principle that a trademark holder

¹²⁷ Pennsylvania State Univ. v. University Orthopedics, Ltd., 706 A.2d 863, 871 (Pa. Super. 1998).

¹²⁸ See, e.g., Bourne, 385 P.2d at 736 (noting that when a trade name is “primarily composed of generic or descriptive words” instead of words that “have some distinctive or identifying character of their own,” it is “much more difficult to prove a secondary meaning”).

¹²⁹ Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

¹³⁰ See notes 102-104 and accompanying text, *supra*.

¹³¹ Canal Co. v. Clark, 80 U.S. 311, 323 (1871) (emphasis added).

cannot “prevent others from accurately describing a characteristic of their goods.”¹³² Therefore, even if a generic or descriptive term had acquired secondary meaning and hence was protectible as a “trade name,” a competitor could use that term to describe his own goods, so long as the goods were marked in a manner that would “clearly [denote] the origin, manufacture or ownership of such articles,” and/or negate “any idea that they were produced or sold” by the trade name holder.¹³³ Therefore, a competitor was not deprived of “the right to call an article by its name”¹³⁴; he could do so, so long as his use of the name did not “mislead the public and divert business from his competitor to himself.”¹³⁵

2. *Death by Patent—the Emergence of the Primary Significance Test*

As explained above, under the common law of unfair competition, the courts did not place a great deal of emphasis on the etymological distinction between generic and descriptive terms, and therefore few cases attempted to demarcate a finite border between the two. However, the courts did hold that some words or terms—even those that were

¹³² *New Kids on the Block v. News America Pub. Co.*, 971 F.2d 302, 306 (9th Cir. 1992) (citation omitted); *see also* 15 U.S.C. § 1115(b)(4) (party’s use of a trademark “which is descriptive of and used fairly and in good faith only to describe the goods or services of such party” is not actionable); *Cairns v. Franklin Mint Co.*, 292 F.2d 1139, 1150-52 (9th Cir. 2002) (explaining the difference between “classic” and “nominative” fair use).

¹³³ *Dennison Mf’g Co. v. Thomas Mf’g Co.*, 94 F. 651, 659-60 (Cir. Ct. D. Del. 1899); *see also* *Guastavino Co. v. Comerma*, 180 F. 920, 922 (S.D.N.Y. 1910); *G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912) (if descriptive words have acquired secondary meaning, defendant “is required to accompany his use of the bare word with sufficient distinguishing marks. . . to prevent the otherwise normally resulting fraud”); *Hansen v. Siegel-Cooper Co.*, 106 F. 691, 692 (Cir. Ct. S.D.N.Y. 1900); *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, 87, 53 N.E. 141, 142 (1899) (“mere use of generic words, *unqualified and unexplained*,” may be enjoined when such use would mislead consumers) (emphasis added); *Skinner v. Martin*, 109 U.S.P.Q. 156, 158 (Cal. App. Super. 1956) (when trade name protection is extended to words which are also “generic,” restriction of use “will be considerably more limited. . . because the words tell the truth generally, and only in special uses are deceptive”).

¹³⁴ *See* note 129, *supra*.

¹³⁵ *OK Bus & Baggage Co. v. OK Transfer & Storage Co.*, 165 P. 136, 140 (Ok. 1917).

arbitrary or fanciful and presumed to be distinctive—did not act as source identifiers and hence could not be trademarks *or* trade names. The courts recognized the evolutionary nature of language, such that even “technical” trademarks could lose their ability to act as source identifiers and hence lose their entitlement to protection from infringement. This phenomenon, which we now refer to as genericide, was much more likely to occur when the mark was placed on a product that was or had been the subject of a utility patent.¹³⁶

Trademark holders who obtain patents on the goods to which their trademarks are attached may fall victim to their own success. Because the trademark/patent holder enjoys a monopoly over the production of the good during the patent period, the trademark label placed on the good typically serves a dual function: to identify the sole source of the good (i.e., the trademark holder) and to identify the good itself.¹³⁷ When the patent period ends, consumers continue to identify the good by using the trademark. Therefore, when new producers come into the marketplace, they suffer a serious competitive disadvantage if they cannot use the trademark to identify the good. After all, the consuming public understands nothing else, regardless of whether the term would otherwise be characterized as arbitrary, fanciful, suggestive, or descriptive. The Supreme Court has described the “death by patent” process as follows:

¹³⁶ *See, e.g.,* Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938) (shredded wheat); Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 185 (1896) (Singer); Nupla Corp., v. IXL Mfg. Co., Inc, 114 F.3d 191 (Fed. Cir. 1997) (Cush-N-Grip); Donald F. Duncan, Inc. v. Royal Tops Manufacturing Co., 343 F.2d 655 (7th Cir. 1965) (yo-yo); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75 (2d Cir. 1936) (cellophane); Micro Motion, Inc. v. Dan Floss A/S, 49 U.S.P.Q. 2d 1628, 1629 (T.T.A.B. 1998) (Massflo); Birtcher Electro Medical Systems, Inc. v. Beacon Laboratories, Inc., 738 F. Supp. 417 (D.Colo. 1990) (Argon Beam Coagulator); Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921) (aspirin); Haughton Elevator Co. v. Seeberger, 85 U.S.P.Q. 80, 81 (Comm'r. Pat. 1950) (escalator); Charles R. De Bevoise Co. v. H.& W. Co., 60 A. 407 (N.J. Eq. 1905) (brassiere); Linoleum Mfg. Co. v. Nairn, 7 Ch. D. 834 (1878) (linoleum).

¹³⁷ *See* Kellogg Co., 305 U.S. at 118; Singer Mfg. Co., 163 U.S. at 186-87; Blinded Veterans Ass’n v. Blinded American Veterans Foundation, 872 F.2d 1035, 1044 n. 21 (D.C. Cir. 1989).

It . . . follows from the cessation of the [patent] monopoly and the falling of the patented device into the domain of all things public that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly. [T]he designated name. . . [is] . . . necessary to vest the public with the full enjoyment of that which ha[s] become theirs by the disappearance of the monopoly.¹³⁸

Consider, for example, the terms “aspirin” and “shredded wheat.”¹³⁹ In both cases the manufacturer had a patent on the product. It marketed the product solely under a mark of its choosing but did not offer the public or a potential future competitor an alternative term with which to refer to the product.¹⁴⁰ The contemporaneous use of the patent and trademark created a situation in which competitors and courts could credibly claim that the term in question was the general name of the product and not a source identifier and, therefore, unprotectable.

Judge Learned Hand eloquently described the genericide process in *Bayer Co. v. United Drug Co.*,¹⁴¹ a case involving the genericide of a name that was initially fanciful (“aspirin”)¹⁴² but became generic. In this case, Judge Hand found that consumers (not surprisingly) did not recognize “monoaceticacidester of salicylicacid” or “acetyl salicylic acid” as the name of their favorite headache remedy:

The single question, as I view it, in all these cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending? If

¹³⁸ *Kellogg Co.*, 305 U.S. at 118 (citing *Singer Mfg. Co.*, 163 U.S. at 185). Although this language from the Supreme Court’s opinions in *Kellogg* and *Singer* could be interpreted to suggest that a trademark applied to a patented product *necessarily* becomes generic upon expiration of the patent, courts have almost uniformly held to the contrary: whether a trademark becomes generic upon expiration of the underlying patent is a question of fact. *President Suspender Co. v. MacWilliam*, 238 F. 159, 163 (2d. Cir. 1916) (citation omitted); see generally 2 MCCARTHY, *supra* note 34, § 12:52.

¹³⁹ *Kellogg Co.*, 305 U.S. 111 (shredded wheat); *Bayer Co.*, 272 F. 505 (aspirin).

¹⁴⁰ *Kellogg Co.*, 305 U.S. at 117; *Bayer Co.*, 272 F. at 510-11 (finding that the consumer had “never heard the name ‘acetylsalicylic acid’ as applied to [the drug], and without some education could not possibly have kept it in his mind, if he had”); compare *Ty Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 532 (7th Cir. 2003) (noting that “[s]ometimes a trademark owner will sponsor a generic term precisely in order to avoid its mark becoming generic”).

¹⁴¹ 272 F. 505 (S.D.N.Y. 1921).

¹⁴² *Id.* at 509 (describing “aspirin” as a “coined” word that “means nothing by itself”).

they understand by it only the kind of goods sold, then, I take it, it makes no difference whatever what efforts the plaintiff has made to get them to understand more. He has failed¹⁴³

Judge Hand concluded that the word “aspirin” was no longer a valid trademark for consumers because it had lost *all* of its ability to function as a source identifier for the consumer.¹⁴⁴

The record was not quite so clear when Justice Brandeis wrote his seminal opinion of *Kellogg Co. v. National Biscuit Co.*¹⁴⁵ This case addressed the question of whether the term “Shredded Wheat” was “generic” and hence unprotectable as a common law trade name.¹⁴⁶ The process for making the product in question, shredded wheat, had been patented and, during that period of exclusive use, only the term “shredded wheat” had been applied to the product.¹⁴⁷ After that patent expired, the question arose as to whether the term “shredded wheat” was available to all makers of “pillow-shaped wheat biscuits” or whether the successor in interest to the goodwill of the patent holder should have the exclusive use of the term.¹⁴⁸ This case is frequently cited as the source of the

¹⁴³ *Id.*

¹⁴⁴ *Id.* at 510 (finding that consumers “did not understand by the word [aspirin] anything more than a kind of drug”). Judge Hand reached the opposite conclusion with regard to the “manufacturing chemists, retail druggists, and physicians” who purchased the drug directly from Bayer. *Id.* at 513. He found that this class of purchasers understood “Aspirin” to mean “the plaintiff’s manufacture,” and further that they “ha[d] recourse to another and an intelligible name for it [acetyl salicylic acid], actually in use among them.” *Id.* As to this group of consumers, Hand concluded that “Aspirin” was still a valid and protectable trademark. *Id.* at 513-14.

¹⁴⁵ 305 U.S. 111 (1938). For an excellent investigation regarding the history and importance of *Kellogg*, see Graeme Dinwoodie, *The Story of Kellogg Co. v. National Biscuit Co.: Breakfast with Brandeis*, in INTELLECTUAL PROPERTY STORIES 220 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

¹⁴⁶ The Court recognized that common law governed whether the mark “Shredded Wheat” was protectable. *Kellogg Co.*, 305 U.S. at 113.

¹⁴⁷ *Id.* at 118.

¹⁴⁸ *Id.* at 111-12.

“primary significance” doctrine, which has become the touchstone for genericism analysis today, both in case law¹⁴⁹ and in the Lanham Act itself.¹⁵⁰

Applying the terminology of Folsom and Teply, Justice Brandeis essentially found that “Shredded Wheat” was a hybrid trademark¹⁵¹: some consumers perceived it as a source identifier, but others perceived it as the generic name of the article. Brandeis recognized that “many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff’s factory at Niagara Falls.”¹⁵² However, he determined that this understanding of the term as a source identifier was only its “subordinate meaning.”¹⁵³ Because the Court found that the generic understanding of “Shredded Wheat” was the predominant or “primary significance” of the term, it held that “Shredded Wheat” was not a protectable trade name.¹⁵⁴

Justice Brandeis’ opinion can and should be interpreted in the context of the common law as it was understood when the opinion was written. As noted above, during this period courts did not often attempt to delineate between “generic” and descriptive terms (and may have used these monikers interchangeably); in either case, their focus was rather on whether the word(s) in question had acquired “secondary meaning.” In language strikingly similar to that employed by Justice Brandeis, the Restatement of

¹⁴⁹ See, e.g., *America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 823 (4th Cir. 2001) (applying “primary significance” test in finding “instant message” generic); *Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996) (mark is generic if its “primary significance. . . to the relevant public is to identify the class of product or service”); *Berner Int’l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982 (3rd Cir. 1993) (“the primary significance test must be utilized to determine a term’s genericness”).

¹⁵⁰ See 15 U.S.C. § 1064 (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”)

¹⁵¹ See notes 58-59 and accompanying text, *supra*.

¹⁵² 305 U.S. at 118.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

Torts (published in 1938, the same year as *Shredded Wheat*), explained that “secondary meaning” does not refer to “a *subordinate* or rare significance. It means rather a subsequent significance added to the previous meaning of the designation and becoming *in the market* its usual and *primary significance*.”¹⁵⁵

Considered in this context, Justice Brandeis’ reasoning in *Shredded Wheat* can at least arguably best be understood as a clarification of the common law secondary meaning doctrine—a holding that the doctrine applies *only* when the source-identifying function of the alleged trade name has become its “primary significance” in the mind of the consumer. Conversely, at least when dealing with a descriptive word or term, if the “primary” significance is not that of a source identifier, it cannot be protected as a common law trade name. Viewed in this light, the lesson to be learned from *Shredded Wheat* is that a term is “generic” and hence not a valid trade name when it has failed to acquire or has lost its secondary meaning—when its source-identifying capacity is not or is no longer its “primary significance.” In *Shredded Wheat*, Justice Brandeis found that “shredded wheat” lacked secondary meaning, primarily because it was “the term by which the biscuit in pillow-shaped form [was] generally known to the public.”¹⁵⁶ Even though the term “shredded wheat” apparently retained some degree of source-identifying capacity, this was the “subordinate meaning” of the term and not its “primary significance.”¹⁵⁷

¹⁵⁵ RESTATEMENT OF TORTS, *supra* note 99, at § 716 (b) & cmt. b (emphasis added).

¹⁵⁶ 305 U.S. at 116-17. The Court noted that “[f]or many years, there was no attempt to use the term. . . as a trade-mark.” *Id.*; *see also id.* at 117 (noting that, in 1905, the Commissioner of Patents refused to register “Shredded Whole Wheat” as a mark under the Ten-Year Clause of the 1905 Act, on grounds that “these words accurately and aptly describe an article of food which has been produced for more than ten years”) (internal citation omitted).

¹⁵⁷ *Id.* at 118.

Some courts have interpreted Brandeis' reasoning in this manner and have cited *Shredded Wheat* in support of the common law proposition that if the "primary significance" of a term is that of a source identifier (i.e., it has acquired secondary meaning), it may be a protectable mark, even if it might otherwise be characterized as "generic."¹⁵⁸ However, as noted previously, the modern trend has been to absolutely bar any type of trademark protection for "generic" words (under either the Lanham Act or common law), and federal opinions holding otherwise have largely been disavowed or reversed.¹⁵⁹ For example, in *Keebler Co. v. Rovira Biscuit Co.*, the First Circuit stated in dicta that, although "at common law terms that are generic are normally not subject to appropriation as trademarks, . . . a strong showing of secondary meaning may be sufficient to grant a right to exclusive use"¹⁶⁰ However, in a decision issued one year later, the First Circuit disavowed that statement, labeling it an "error" derived from "precisely the same error" by Justice Brandeis in *Shredded Wheat*.¹⁶¹

In rejecting plaintiff's claim that the secondary meaning doctrine applied, Justice Brandeis wrote that "[t]here is no basis here for applying the doctrine of secondary meaning."¹⁶² Most modern courts avoid the perceived "error" described by the First Circuit in *Keebler* by interpreting the above statement by Brandeis as an affirmation of the proposition that, if a term is generic, it cannot be protected as a trade mark, regardless

¹⁵⁸ See, e.g., *American Aloe Corp. v. Aloe Crème Laboratories, Inc.*, 420 F.2d 1248, 1251 & 1253 (7th Cir. 1970) (noting that "in the absence of a strong showing of secondary meaning, a generic name cannot be the basis of a trademark"); *Feathercombs, Inc. v. Solo Products Corp.*, 306 F.2d 251, 256 (2d Cir. 1962) (holding that "[a] mark is not generic merely because it has some significance to the public as an indication of the nature or class of an article," and further "[t]o become generic the principle significance of the word must be its [generic meaning], rather than an indication of its origin").

¹⁵⁹ See, e.g., *Miller Brewing Co. v. Falstaff Brewing Corp.*, 503 F. Supp. 896, 906-07 (D.R.I. 1980) (rejecting proposition that a term can be "generic" in the face of the admitted presence of secondary meaning"), *rev'd*, 655 F.2d 5 (1st Cir. 1981).

¹⁶⁰ 624 F.2d 366, 374-75 (1st Cir. 1980).

¹⁶¹ *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 8 (1st Cir. 1981).

¹⁶² *Id.*

of whether there is evidence that it has acquired secondary meaning.¹⁶³ Instead, the courts apply the primary significance test to determine whether a word or term is “generic” in the first instance, separate from any consideration of secondary meaning. As further discussed below, their attempts to do so have been fraught with difficulty.

3. *The Modern Genericism Doctrine: Who are you? What are you?*

As the primary significance test took hold, courts interpreted it differently and struggled to navigate the questions the test poses. Most modern courts approach the question of whether a term is or has become generic by applying a now-familiar test, borrowed from the language of scientific classification: a generic term is one that is, or has become, the name of a *class* of goods or services, the “genus of which the *particular* product or service is a species.”¹⁶⁴ Specifically put in the context of the primary significance test, the question becomes whether “the primary significance of the trademark is to describe the *type of product* rather than the *producer*.”¹⁶⁵ If so, “the

¹⁶³ See note 117, *supra*, and note 188, *infra*; see also Dinwoodie, *supra* note 145, at 236 (“As the Court noted, the existence of secondary meaning was beside the point once the term was classified as generic. No evidence of plentiful sales or extensive advertising, typical evidence pointing to secondary meaning, could alter the unprotectability of the term SHREDDERED WHEAT.”).

¹⁶⁴ Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc., 198 F.3d 1143, 1147 (9th Cir. 1999) (emphasis added); see also Park 'N Fly v. Dollar Park and Fly, Inc., 469 U.S. 189, 194 (1985); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976); Surgicenters of America, Inc. v. Medical Dental Surgeries, Co., 601 F.2d 1011, 1014 (9th Cir. 1979); cf. Arthur J. Greenbaum, Jane C. Ginsburg, & Steven M. Weinberg, *A Proposal for Evaluating Genericism after “Anti-Monopoly*, 73 TRADEMARK REP. 101, 109-110 (1983) (noting the “long-standing, widely-embraced fallacy that genericism may be determined by dividing the relevant world of goods into genuses and species”).

¹⁶⁵ Filipino Yellow Pages, 198 F.3d at 1147 (emphasis in original) (citation omitted); see also Blinded Veterans Ass’n v. Blinded American Veterans Found., 872 F.2d 1035, 1039 (D.C. Cir. 1989) (“A generic term is one commonly used to denote a product or other item or entity, one that indicates the thing itself, rather than any particular feature or exemplification of it.”); Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 790 (5th Cir. 1983) (generic term “connotes the basic nature of articles or services rather than the more individualized characteristics of a particular product”) (citation omitted).

trademark is a generic term and cannot be a valid trademark.”¹⁶⁶ Somewhat curiously, some courts have attempted to refine this test by relying upon the “who-are-you/what-are-you” test: “A mark answers the buyer's questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the generic name of the product answers the question ‘What are you?’”¹⁶⁷ Although the test may seem simple in its articulation (once one gets past the difficulty of making a trademark talk and answer questions), it has proved difficult in application.

III. Problems Created by the Current Iteration and Application of the Genericide Doctrine

The following section examines some of the key difficulties that have arisen to confound courts in the application of the modern genericide doctrine. In this section we argue that the current doctrine over-emphasizes the etymological categorization of words, rather than the core questions of (1) whether the mark functions as a source-identifier in a commercial context, and (2) whether trademark protection will help or hinder competition. We begin by examining the genus/species and “once generic, always generic” precepts that guide courts when determining whether a term is generic and show why these approaches lead the doctrine astray. We then explain how current doctrine relies on overbroad evidence when making a genericism determination, such that

¹⁶⁶ Filipino Yellow Pages, 198 F.3d at 1147.

¹⁶⁷ *Id.* (internal citations omitted); *see also* Society of Fin. Examiners v. National Ass’n of Certified Fraud Examiners, 41 F.3d 223, 227 (5th Cir. 1995); CES Publishing Corp. v. St. Regis Publications, 531 F.2d 11, 13 (2d Cir. 1975); Van Well Nursery, Inc. v. Mony Life Ins. Co., 421 F. Supp. 2d 1321, 1328 (E.D. Wash. 2006); Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571 (D.N.J. 1985) (describing “who are you-what are you” test as “the clearest test for genericness”).

trademark holders are forced to waste resources and pursue otherwise noninfringing uses as they police their marks. Finally, this section examines the relationship between the dilution doctrine's rights-in-gross, property-based understanding of trademarks to the evolution of the genericism doctrine.

A. The Elusive Distinction between Genus and Species, or Generic and Descriptive Terms

One of the key conceptual problems in understanding the genericism doctrine and indeed trademark law is the way in which the law parses the difference between the name of a product class (which is considered generic) and the name of a particular product (which may be a valid trademark). In other words, where do we draw the line between genus and species? Put in the context of the spectrum of marks, the question may become whether the mark is generic (and hence incapable of functioning as a trademark) because it is the name of a product class, or merely descriptive of a particular product within that class of goods or services, in which case the mark may be afforded trademark protection upon a showing of secondary meaning. We argue that this elusive distinction should not be the cornerstone of genericism analysis.¹⁶⁸

In theory the distinction between product class and product, or generic and descriptive terms, should be simple. A generic term is the common name for a product or product class, which has no ability to function as a source identifier. In truth, these words or terms are rarely if ever the source of trademark litigation. After all, few companies

¹⁶⁸ See also Folsom & Teply, *supra* note 32, at 1351 (stating that the courts “have made artificial and unworkable distinctions with respect to the classification of a trademarked word as generic or descriptive” in determining whether to allow proof of secondary meaning); see also Greenbaum, Ginsburg & Weinberg, *supra* note 164, at 109-110 (noting the “long-standing, widely-embraced fallacy that genericism may be determined by dividing the relevant world of goods into genres and species”).

(and even fewer marketers) are likely to choose names that are obviously generic (e.g., cookie, beer, restaurant) to distinguish their goods or services, because they are incapable of doing so. In many cases, however, words or terms are found to be generic (i.e., the name of a product class) when, at least to the naked eye, they appear to be descriptive—that is, they describe the attributes of the good or service to which they are attached: e.g., Lite Beer,¹⁶⁹ Filipino Yellow Pages,¹⁷⁰ Blinded Veterans Association,¹⁷¹ Warehouse Shoes.¹⁷² In such cases, it is not difficult to see why the putative trademark holder may have been surprised to learn that he had chosen a “generic” name for his business.¹⁷³ As stated previously, a generic term is not protectable as a mark, regardless of whether it has acquired secondary meaning among the relevant group of consumers.¹⁷⁴

This scenario may best be understood as the inverse of the “death by patent” phenomenon described earlier. In these cases, a company does not use an arbitrary or fanciful name to describe a state-of-the art, newly patented product. Instead, the company uses a common (or arguably descriptive) name that the consumer already understands to describe the relevant good or service. The company extensively markets

¹⁶⁹ See *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 80 (7th Cir. 1977) (“lite beer” found generic).

¹⁷⁰ See *Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (“Filipino Yellow Pages” found generic).

¹⁷¹ *Blinded Veterans Ass’n v. Blinded American Veterans Foundation*, 872 F.2d 1035 (D.C. Cir. 1989) (“Blinded Veterans Association” found generic).

¹⁷² See *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153 (7th Cir. 1996) (“Shoe Warehouse” and “Warehouse Shoes” found generic).

¹⁷³ This difficulty was exacerbated by the Patent and Trademark Office’s creation of yet a third category of terms by refusing to register terms that it characterizes as “so highly descriptive” that they cannot function as marks, even though they are not “generic.” See, e.g., *In re Industrial Relations Counselors, Inc.*, 224 U.S.P.Q. 309 (T.T.A.B. 1984) (refusing to register “Industrial Relations Counselors, Inc.,” as applied to seminars in industrial relations, on grounds that it was too highly descriptive, regardless of whether it had acquired secondary meaning); see generally 2 MCCARTHY, *supra* note 34, § 12:22; see also Linda McLeod, *The Status of So Highly Descriptive and Acquired Distinctiveness*, 82 TRADEMARK REP. 607, 623-27 (1992) (criticizing PTO practice of refusing to register marks on grounds that they are “so highly descriptive”). In the 1997 edition of the Trademark Manual of Examining Procedure, the PTO instructed examiners to abandon the practice of refusing to register marks on grounds that they were “so highly descriptive” that they could not function as marks. T.M.E.P. § 1209.01(c) (1997 rev.).

¹⁷⁴ See note 117, *supra*, and note 188, *infra*.

and advertises its good or service, and through its efforts the name attached to the good or service acquires secondary meaning in the minds of the consuming public. In other words, even though the name did *not* act as a source identifier when the company adopted it, it evolves to function in this manner, much the same way even an arbitrary or fanciful term attached to a newly patented product may evolve into a generic word when it *loses* its ability to function as a source-identifier. In this type of situation, the mark holder's fate rides on the court's determination of whether the word or term initially chosen was generic or descriptive. The courts themselves acknowledge that the distinctions between categories of marks (e.g., generic v. descriptive, or descriptive v. suggestive) "are less than clearly defined and may be difficult to utilize."¹⁷⁵

Judge Becker of the Third Circuit tackled the question of how to distinguish a generic term from a descriptive one in *A.J. Canfield Company v. Honickman*.¹⁷⁶ In *Canfield* the product at issue was Diet Chocolate Fudge Soda.¹⁷⁷ The legal issue was whether "'chocolate fudge' as applied to diet soda" was entitled to federal trademark status.¹⁷⁸ Judge Becker noted that the question was a difficult one as to which reasonable minds not only could disagree but had disagreed, as evidenced by three district courts analyzing the question and reaching three different results: suggestive (or at worst

¹⁷⁵ *Berner Int'l Corp. v. Mars Sales Co.*, 987 F.2d 975, 979 n.2 (3d Cir. 1993); *see also* *Henri's Food Products Co., Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1306 (7th Cir. 1987) (difference between "common descriptive name," aka generic term, and "merely descriptive mark" often "is not visible to the naked eye"); *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1015 (9th Cir. 1979) (recognizing that "courts often have difficulty in distinguishing between generic and descriptive terms"); and note 69, *supra*.

¹⁷⁶ *A. J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986).

¹⁷⁷ *Id.* at 292.

¹⁷⁸ *Id.*

descriptive), descriptive, and generic.¹⁷⁹ Judge Becker found that “diet chocolate fudge soda” was not suggestive because, rather than “requir[ing] imagination, thought or perception to reach a conclusion as to the nature of goods,” the phrase “denote[d] a flavor” and consumers would need no imagination to understand the nature of the soda.¹⁸⁰ The court then turned to the question of whether the term was descriptive or generic.

To make this determination the court attempted to “define the relevant product category, or ‘genus.’”¹⁸¹ Judge Becker found, however, that neither the primary significance test nor an examination of consumer perceptions helped determine what he held was the first question to understand, namely “whether chocolate soda or chocolate fudge soda is the relevant product genus for evaluating genericness....”¹⁸² Judge Becker noted that the primary significance test is of no use until one has determined the status of the term:

[T]he primary significance test is generally satisfied if a term signifies a product that emanates from a single source, i.e., a product brand, but it is not satisfied if the product that emanates from a single source is not only a product brand but is also a product genus. The primary significance test does not, in and of itself, tell us how to differentiate a mere product brand from a product genus.¹⁸³

In other words, when examining the question of genericness, where the court draws the line between genus and species may be somewhat arbitrary and strongly controls if not predetermines the outcome of the case. If the court deems the term in question to denote a product category, then it would be considered a genus and hence generic. Yet if the court determines that the product is part of a larger category or genus, then it will almost

¹⁷⁹ *Id.* (citing *A.J. Canfield Co. v. Vess Beverages, Inc.*, 612 F. Supp. 1081 (N.D.Ill.1985), *aff'd*, 796 F.2d 903 (7th Cir.1986); *Canfield v. Concord Beverages Co.* (Scirica, J.); *Yoo-Hoo Chocolate Beverages Corp. v. A.J. Canfield Co.*, 229 U.S.P.Q. 653 (D.N.J.1986) (Sarokin, J.)).

¹⁸⁰ *A. J. Canfield Co.*, 808 F.2d at 297-98 (citations omitted).

¹⁸¹ *Id.* at 298 (citation omitted).

¹⁸² *Id.* at 299.

¹⁸³ *Id.* at 301.

certainly find that the term is descriptive and can be a trademark if secondary meaning is shown. Under such an approach, the boundaries of genericism are infinitely malleable.¹⁸⁴

Judge Becker elucidated the malleability of the test when he wrote: “For example, in *Kellogg*, if wheat cereals were the relevant product class, then Shredded Wheat would be merely a brand. But once it was decided that cereals containing pillow-shaped forms of wheat shreds was the relevant product class, the term ‘shredded wheat’ was obviously generic.”¹⁸⁵ For this reason, the genus/species distinction is singularly unhelpful in notifying a potential trademark holder or her competitor of whether a given term will be considered “generic” by the courts.

The inherent uncertainty and unpredictability of the current system imposes costs on both trademark holders and the public. From the trademark holder’s perspective, the prospect of adopting a descriptive mark is a tempting one—once the mark has acquired distinctiveness, or secondary meaning (which is presumed after five years of “substantially exclusive and continuous use”), it may be registered and entitled to the full protections of the Lanham Act.¹⁸⁶ Moreover, unlike fanciful or arbitrary marks (or, to a lesser degree, even suggestive ones), the descriptive trademark has the added advantage of informing the consumer about the attributes of the good or service to which it is attached, reducing the need to inform the consumer of these attributes via advertising.¹⁸⁷ However, because the putative trademark holder (even one with a highly-paid legal staff) arguably has no real way of knowing whether a descriptive term will be characterized as a genus (i.e., generic and hence invalid) or descriptive of a species, he runs the risk of

¹⁸⁴ See Greenbaum, Ginsburg & Weinberg, *supra* note 164, at 110 (characterizing the genus-species test as a “meaningless” and “infinitely manipulable” classification attempt).

¹⁸⁵ A. J. Canfield Co., 808 F.2d at 301 n. 12.

¹⁸⁶ 15 U.S.C. § 1052 (f).

¹⁸⁷ See note 87 and accompanying text, *supra*.

losing the considerable investment that he may have made in establishing secondary meaning. Because secondary meaning is presumptively acquired after five years of use, many trademark holders wait this period of time before even attempting to register an arguably descriptive trademark. As a result, five years of advertising and accumulated goodwill may go down the proverbial drain.

Consumers lose in this scenario as well. When a trademark holder invests considerable sums of money to create secondary meaning—in other words, to create a connection between a particular product or source and the mark in the mind of the consuming public—not surprisingly, she often succeeds. When secondary meaning is established and the putative mark is functioning as a source-identifier, confusion and inefficiency may result when the mark is deemed “generic” and free for all to use.

B. Once Generic, Always Generic

In addition to the inherent uncertainties in determining whether a term is or has become generic, another troublesome feature of the modern doctrine is the permanence of that determination. Although one might assume that, all things being equal, if a trademark can transmute from arbitrary or fanciful to generic because it no longer functions as a mark (i.e., it is no longer a source identifier), it should be able to travel in the other direction—from generic to at least some type of protectable mark if it functions as one in the minds of the consuming public. Such an assumption, however, would be incorrect, at least in the context of modern trademark law. Under these circumstances the mark is said to have acquired only “de facto” secondary meaning, which is the legal equivalent of *no* secondary meaning: “No amount of purported proof that a generic term

has acquired a secondary meaning associating it with a particular producer can transform that term into a registrable trademark.”¹⁸⁸

For example, in *Harley-Davidson Inc. v. Grottanelli*,¹⁸⁹ in which the term “HOG” was deemed generic, “[s]urveys of motorcycle enthusiasts in the trial record reflected a ninety-eight percent association of HOG with Harley.”¹⁹⁰ Yet, the court found that the term was generic prior to Harley-Davidson’s first use of it as a mark in the 1980’s, largely based on dictionary definitions of the term dating back to 1967 and usage of the term by the media in 1935.¹⁹¹ As a result, even though the “primary significance” of HOG in 1999 was that of a source-identifier (i.e., a trademark), it legally could not function as one.¹⁹² The court reasoned that “[t]he public has no more right than a manufacturer to withdraw from the language a generic term, already applicable to the relevant category of products, and accord it trademark significance, at least as long as the term retains some generic meaning.”¹⁹³ The fact that HOG as applied to motorcycles would ordinarily be considered an arbitrary and hence highly distinctive mark made no difference.¹⁹⁴

In another recent example, defendant Lindows.com argued that Microsoft Corporation’s trademark “Windows,” as applied to operating software, was a generic

¹⁸⁸ *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 374 (1st Cir. 1980); *see also* note 117, *supra*.

¹⁸⁹ 164 F.3d 806 (2d Cir. 1999).

¹⁹⁰ Jerre B. Swann, *Genericism Rationalized*, 89 TRADEMARK REP. 639, 654 (1999) (*citing Grotanelli* Appellate Record at A76). *See also* *Miller Brewing Co.*, 561 F.2d at 80 n. 6 (noting that “even if the mark is descriptive there is enough evidence of secondary meaning to support the District Court’s order [holding that the mark was valid and infringed]”, but reversing on the ground that “light beer” or “lite beer” is a generic name).

¹⁹¹ *Harley-Davidson, Inc.*, 164 F.3d at 810-11 & n. 8, 10; *see also id.* at n. 2 (citing media usage of the term throughout 1960’s and 1970’s).

¹⁹² *See also Miller Brewing Co.*, 561 F.2d at 80 n.6.

¹⁹³ *Harley-Davidson, Inc.*, 164 F.3d at 812. The court concluded that the term HOG retained generic meaning based on dictionary definitions of the term in 1992. *Id.* at 810-11 & n. 9.

¹⁹⁴ *Id.* at 810 (“No manufacturer can take out of the language a word, even a slang term, that has generic meaning as to a category of products and appropriate it for its own trademark use.”).

term, unprotectable as a trademark, because it was used generically by the public when Microsoft adopted it in the 1980's. The district court refused to grant summary judgment on this issue, due to the existence of disputed issues of fact. It ultimately held, however, that it would instruct the jury to "consider whether the Windows mark was generic during the period before Microsoft Windows 1.0 entered the marketplace in November 1985" and would "not instruct the jury that even if Windows were generic prior to November 1985, the trademark would nonetheless be valid today so long as the primary significance of the term today is not generic."¹⁹⁵ In short, the jury would be told that a generic term was not capable of achieving trademark status, even if its "primary significance," in the mind of the consuming public, was that of a source-identifier. Less than six months after the court rendered this decision, Microsoft and Lindows entered into a "global settlement" under which Microsoft agreed to pay Lindows \$20 million to relinquish its name and all related Web domains to Microsoft.¹⁹⁶

Although some courts, including the Second Circuit in *Grotanelli*, have suggested that it may be *possible* for generic terms to evolve into protectable trademarks, few have so held.¹⁹⁷ Even those courts that have recognized the possibility of such a transformation have refused to apply the "primary significance" test to determine the status of the mark in question; instead, they have suggested that formerly generic terms

¹⁹⁵ Microsoft Corp. v. Lindows.com, Inc., 2004 WL 329250 (W.D. Wash. 2004) (emphasis in original).

¹⁹⁶ Joris Evers, *Microsoft to Pay \$20M to End Lindows Trademark Battle*, Jul. 19, 2004, http://www.infoworld.com/article/04/07/19/Hnmslindowstrademark_1.html.

¹⁹⁷ The *Grotanelli* court suggested that "if a generic word could ever be infused with trademark significance, the word must have ceased to have current generic meaning." 164 F.3d at 811. *See also* New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 305 n. 4 (9th Cir. 1991) (noting that "[a]n interesting question is whether a word, although once generic, may become protectable") (dicta).

may function as marks only when the generic meaning of the term has been completely obliterated from the public consciousness.¹⁹⁸

The courts have been slightly more receptive to the idea that generic words may become protectable trademarks, upon acquisition of secondary meaning, when the generic word is being “reclaimed” by the former trademark holder—i.e., the word or term began its life as a trademark; fell victim to genericide; and then came full circle back to its former trademark status.¹⁹⁹ Even these types of cases have been characterized as “extraordinarily rare.”²⁰⁰ The two most commonly cited examples of trademarks that resurfaced from the public domain are “Singer” for sewing machines²⁰¹ and “Goodyear” for tires.²⁰² More recently, the Federal Circuit held that Opryland could introduce evidence that the term “opry,” as applied to country music entertainment, was not

¹⁹⁸ See, e.g., *Miller Brewing Co. v. Falstaff Brewing Co.*, 655 F.2d 5, 8 (1st Cir. 1981) (“Where a generic association of a word or term has become obsolete and is discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word.”).

¹⁹⁹ See, e.g., *Grotanelli*, 164 F.3d at 811 (distinguishing such cases on the basis that the words at issue “were originally proper names of the manufacturer”).

²⁰⁰ 2 MCCARTHY, *supra* note 34, § 12:30.

²⁰¹ See *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953) (holding that Singer had “recaptured from the public domain the name ‘Singer’” and therefore the name had become (again) a “valid trademark . . . entitled to protection as such”); *cf.* *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 183 (1896) (finding that the name “Singer” had come “to indicate, in its primary sense, to the public, the class and type of machines made by the Singer Company. . . and thus this name constituted their generic description”).

²⁰² See *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 729 (D. Minn. 1965) (holding that plaintiff had “met its burden of proof on the issue of secondary meaning” and therefore had a protectable trademark); *cf.* *Goodyear’s Rubber Manuf’g Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 603 (1888) (holding that “Goodyear Rubber” is not “capable of exclusive appropriation” because it is “descriptive of a class of good and therefore generic”).

generic,²⁰³ even though the Eighth Circuit had held that it was a generic term just ten years earlier.²⁰⁴

The “once generic, always generic” tenet of trademark law is problematic from an economic perspective, as it effectively increases consumer search costs. If the “primary significance” of a term in the commercial context is that of a source identifier, consumers generally do not benefit when competitors are allowed to use the word generically.²⁰⁵ As one commentator has observed, “[E]rroneously failing to protect the word when it in fact serves as a source-identifying mark might be very costly if consumers end up confused about a competing firm's product.”²⁰⁶

C. The Overbroad Scope of Evidence that Contributes to a Trademark's Demise

Perhaps because the “test” for identifying a generic term is such an elusive and arguably arbitrary one, courts turn to various sources of circumstantial evidence to assist them in making this determination. Such evidence typically includes dictionary definitions of the word or words used in the mark; uses of the mark by and in the media; and other types of non-competitive uses. We contend that this type of evidence is of little

²⁰³ *Opryland U.S.A. Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 853 (Fed. Cir. 1992); *see also* *Gaylord Entertainment Co. v. Gilmore Entertainment Group, LLC*, 187 F. Supp. 2d 926, 942 (M.D. Tenn. 2002) (holding that plaintiff is “not collaterally estopped [by the 8th Circuit’s decision in *Hilton*, finding the term ‘Opry’ to be generic] from litigating the primary significance to the relevant public of the term ‘Opry’ today”).

²⁰⁴ *WSM, Inc. v. Hilton*, 724 F.2d 1320, 1326 (8th Cir. 1984).

²⁰⁵ *See, e.g.*, *Ty Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 532 (7th Cir. 2003) (Posner, J.) (acknowledging that “[t]o determine that a trademark is generic and thus pitch it into the public domain is a fateful step” which “may confuse consumers who continue to associate the trademark with the owner’s brand”).

²⁰⁶ Bone, *supra* note 49, at 2123. Professor Bone contends that, in this type of scenario, the cost of a “false negative error”—a ruling that errantly denies trademark protection—is much higher than the cost of a “false positive error,” a ruling that errantly grants trademark protection. *Id.* As a result, Professor Bone reasons that, from the perspective of avoiding error cost, “a rule that reduces the frequency of false negatives even as it increases the frequency of false positives is likely to be superior. . . , as long as the latter effect is not too great.” *Id.*

value in enabling the court to answer what should be the core question in any genericism determination: whether the mark is functioning as a source-identifier in the relevant commercial context. At best, it demonstrates that the word or term is or may be functioning as a hybrid trademark, while shedding little light on which understanding of the term constitutes its “primary significance” to the consumer in a commercial context. Moreover, the current doctrine’s insistence that trademark holders “police” against noncompetitive, noninfringing uses of their marks leads to overly aggressive trademark enforcement activities, which are inefficient and, perhaps more importantly, may have the undesirable effect of stifling the public’s ability to use language as it sees fit.

1. Problems created by trademark policing

As noted above, under the current genericide doctrine, uses of a mark by dictionaries, yellow pages, newspapers, and other non-competing sources reflecting public understanding of a term are used to demonstrate that a term is generic rather than source identifying.²⁰⁷ Though mark holders can and should diligently police their marks against *competitive* misuse, mark holders cannot (and, we argue, should not) try to stop dictionaries, yellow pages, newspapers, and other non-competing third parties from using

²⁰⁷ See, e.g., *Harley Davidson, Inc. v. Grotanelli*, 164 F.3d 806, 809 (2nd Cir. 1999) (citing dictionary definition of “hog” as evidence that “hog” is a generic term); *Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999) (citing use of the term “Filipino yellow pages” in a *Los Angeles Times* article and in the dictionary as evidence of the term’s genericness); *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153, 1158 (7th Cir. 1996) (citing dictionary definition of “warehouse” as evidence that “Shoe Warehouse” and “Warehouse Shoes” are generic terms); *Miller Brewing Co. v. G.Heilman Brewing Co.*, 561 F.2d 75, 80 (7th Cir. 1977) (citing definition of “light” and the “misspelled equivalent” as evidence that “lite” is a generic term); *Retail Services, Inc. v. Freebies Publishing*, 364 F.3d 535, 544-545 (4th Cir. 2004) (citing dictionary definition of “freebie” as evidence that it is a generic term); cf. *Natron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 407 (6th Cir. 2002) (noting that the absence of a dictionary definition for “Smart power” is not conclusive evidence that the term is *not* generic).

words that are trademarks in ways other than as a mark.²⁰⁸ This behavior constitutes fair use of the mark and should be encouraged, not discouraged, by the courts. Furthermore, as discussed above, the nature of language is such that people will adapt words as they see fit²⁰⁹ and trademarks used in their expressive capacity constitute a public good that we wish to encourage rather than suppress.

Therefore, the question arises as to why the case law insists that mark holders must “police” their marks in these contexts. After all, one person’s policing is another person’s harassment, or worse, abusive trademark litigation.²¹⁰ There are costs to engaging in these types of policing strategies, both from the standpoint of the trademark holder and of the public.

2. *The cost of policing from the perspective of the trademark holder*

Through various means trademark holders strive to maintain their marks’ source-identifying qualities, and for good reason. The Lanham Act specifies that failure to do so results in the death of the mark: “A mark shall be deemed to be ‘abandoned’ . . . [w]hen any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the *generic name* for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.”²¹¹ Trademark holders who do not pursue infringers may be contributing to the death of their marks via genericide. As one court has explained, “Without question, distinctiveness can be lost by

²⁰⁸ 2 MCCARTHY, *supra* note 34, § 12:28; *accord* Illinois High School Ass’n v. GTE Vantage, Inc., 99 F.3d 244, 246 (7th Cir. 1996).

²⁰⁹ See notes 50-54 and accompanying text, *supra*.

²¹⁰ See generally Greene, *supra* note 9. As discussed below, although there is not currently a doctrine of trademark misuse, Judge Posner has recognized that a copyright holder using litigation to gain rights she does not have is engaging in abuse of process. See Assessment Technologies of WI, LLC, v. Wiredata, Inc., 350 F.3d 640, 647 (7th Cir. 2003).

²¹¹ See 15 U.S.C. § 112 (emphasis added).

failing to take action against infringers. If there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the ‘mark’ as a source identification. When that occurs, the conduct of the former holder, by failing to police its mark, can be said to have caused the mark to lose its significance as a mark.”²¹²

Unchallenged use of a mark by *competitors* understandably contributes to the genericide of a mark. To refer back to our grocery store example, if all the teriyaki sauces on the shelf are labeled soy vays and the maker of the “real” Soy Vay® does not object, the brand loses its source-identifying significance. Soy Vay no longer signals the consumer that she is buying a particular type of sauce with a hefty kick of ginger; instead it merely tells her that she is buying teriyaki sauce. Therefore, the courts’ insistence on the mark holder’s duty to police the mark in this context makes sense. As noted above, however, courts consider much more than this type of evidence in determining whether a mark holder has “abandoned” her mark and hence contributed to its death via genericide.

Although mark holders have no legal right to dictate the manner in which newspapers and dictionaries utilize and portray their marks, they are expected to expend resources in this quixotic and potentially harmful endeavor. Judge Posner writes:

A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.²¹³

Yet, use of a trademark as a common noun or verb, in a noncommercial context, does not have the same direct impact on a mark’s source-identifying capacity as does an infringing

²¹² *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 766 (C.C.P.A. 1982); *accord* *Malaco Leaf, AB v. Promotion in Motion, Inc.*, 287 F. Supp. 2d 355, 364-65 (S.D.N.Y. 2003); *Rossner v. CBS, Inc.*, 612 F. Supp. 334, 339 (S.D.N.Y. 1985).

²¹³ *Illinois High School Ass’n*, 99 F.3d at 246.

use by the trademark holder's competitor. Such noncommercial uses typically indicate that the mark is functioning in a hybrid function (a fate that is practically inevitable for the most famous trademarks). Very few people decide how to use a word by first consulting the dictionary or by blindly mimicking the way a reporter used the word in *Newsweek* or *The New York Times*. Dictionary entries and media uses certainly may *reflect* some of the ways in which a term is used. These noncommercial uses of a trademark are, however, poor barometers of the consumer's perception of the mark in *commercial* contexts and – unlike competitive misuse of the mark – they do not necessarily *affect* consumer perceptions in commercial settings. Thus, with our understanding that people will use language as they see fit, it is inefficient to require trademark holders to engage in the cat-herding endeavor of “policing” these types of noncommercial uses.²¹⁴

Nonetheless, trademark holders—particularly those who own “famous” marks—have taken Judge Posner's advice and often pursue expensive “education” strategies to combat noncommercial “misuse” of their marks.²¹⁵ Xerox, for example, engaged in a massive advertising campaign to educate consumers about the “proper” use of its mark. One such advertisement depicts a graveyard of trademarks, including escalator, trampoline, cube steak, lanolin, dry ice, raisin bran, nylon, mimeograph, shredded wheat, yo-yo, kerosene, cornflakes, and high octane.²¹⁶ At the top of the ad, copy reads in bold,

²¹⁴ See also Folsom & Teply, *supra* note 32, at 1354 (noting that these types of policing efforts are inefficient in that they do not “stimulate demand for a firm's product”).

²¹⁵ On this point Professors Folsom and Teply conclude that the need to engage in these types of policing efforts may signal the mark's drift from trademark to generic term. In other words, according to Folsom and Teply, such actions signal that the term is already losing its strength as a mark, and a court should consider the necessity of such policing efforts as a sign of that decline. *Id.*

²¹⁶ See Jane C. Ginsburg, Jessica Litman, and Mary L. Kelvin, TRADEMARKS AND UNFAIR COMPETITION LAW: CASES AND MATERIALS 317 (3d ed. 2001).

“Once a trademark, not always a trademark.”²¹⁷ Under that lead, the copy tells the tale of the dead trademarks: “They were once proud trademarks, now they’re just names. They failed to take precautions that would have helped them have a long and prosperous life.”²¹⁸ The copy then seeks the reader’s help to keep Xerox from suffering this fate by asking the reader to use Xerox as an adjective, never as a verb or noun.²¹⁹ This concern is not only one for Xerox or a recent phenomenon; Kodak sponsored a similar advertising campaign in 1920,²²⁰ and many others have engaged in analogous efforts.²²¹

In addition to noncommercial uses, courts may also consider the existence of other commercial, yet non-infringing, uses of the same or a similar mark to be evidence that a word or term is generic.²²² For example, in *Filipino Yellow Pages*, the Ninth Circuit affirmed the district court’s ruling, on summary judgment, that the mark “Filipino Yellow Pages”—as applied to an advertisers’ phone directory marketed to the Filipino-American community in California—was generic, not descriptive, based partly on evidence that the mark holder “did not bring suit to challenge the marketing of . . . a second *Filipino Yellow Pages* to the Filipino-American community on the East Coast.”²²³ It seems fairly clear that, if such a suit had been brought, it would have been unsuccessful

²¹⁷ *Id.*

²¹⁸ *Id.*

²¹⁹ *Id.*

²²⁰ *Id.* at 319.

²²¹ See *id.* at 319-328 (showing advertising combating genericism sponsored by Weight Watchers®; Tabasco®; Realtor®; Kimberly-Clark Corporation’s Kleenex®; Huggies®; Depends®; Freedom®; Delsey® and Kotex® brands; Bacardi®; Plexiglass®; Levi’s®; American Express®; and Rolls-Royce®).

²²² See, e.g. *Natron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 406 (6th Cir. 2002) (use of a term “by third parties in trademark registrations” may be considered evidence of term’s genericness); *Van Well Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1331 (E.D. Wash. 2006) (evidence of public understanding of a term may be obtained from “any competent source,” including third parties’ use of the term); *March Madness Athletic Ass’n, LLC v. Netfire, Inc.*, 162 F. Supp. 2d 560, 572 (N.D. Tex. 2001) (finding that “the frequent use of March Madness for events and phenomena having nothing to do with basketball also raises a genuine issue of material fact as to whether MMA has a protectable right to the phrase”; citing use of “March Madness” in conjunction with “legislative activity, polka festivals, and sales or specials on cars, furniture, and electronic equipment” as examples).;

²²³ *Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999).

if not downright frivolous. Paper phone directories are targeted to a local audience, for obvious reasons; very few people in New York City need to use the Los Angeles phone directory. Therefore, little to no likelihood of confusion arises when two phone directories, on opposite Coasts, use the same name. Trademark holders should not be encouraged or pressured to bring frivolous lawsuits.²²⁴

In any event, it is unclear why non-competing third-party uses of the same or a similar name should be considered relevant to a determination that a given name is *generic*. As discussed above, a truly generic term has no source-identifying significance and therefore is an unlikely and unwise choice for a brand name. Descriptive names, however, can act as source identifiers, through acquired distinctiveness; are protectable as trademarks under the Lanham Act if they have acquired distinctiveness; and have the added benefit of telling the public about the attributes of the good or service to which they are attached.²²⁵ Commercial uses of the same or similar marks in noninfringing contexts—sometimes referred to as “third party uses” of the mark—are and should be considered evidence that the term is descriptive rather than inherently distinctive,²²⁶ but such uses do not prove and should not even suggest that the term is generic.

²²⁴ Cf. *What-A-Burger, VA v. Whataburger Corp.* Christi, TX, 357 F.3d 44, 448-521 (4th Cir. 2004) (affirmative defenses of laches and acquiescence did not apply, despite junior user’s unchallenged use of the mark for 32 years, because such use was not likely infringing due to geographic distance between markets of junior and senior user); see also *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 462 (4th Cir. 1996) (trademark owner has “no obligation to sue” until likelihood of confusion is imminent).

²²⁵ Descriptive marks are the weakest type of protectable mark. See notes 82-87 and accompanying text, *supra*. Some commentators argue, for various reasons, that descriptive terms, like generic ones, should not be protectable as trademarks. See, e.g., Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003) (arguing that extending trademark protection to descriptive marks violates the First Amendment).

²²⁶ See, e.g., *Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 793 (5th Cir. 1983) (characterizing “the extent to which a term actually has been used by others marketing a similar service or product” as the “final barometer of the descriptiveness of a particular term”); see also *Vision Center v. Opticks, Inc.*, 506 F.2d 111, 117 (5th Cir. 1979) (citing widespread use of “vision center” by optical stores across the nation as evidence of the term’s descriptiveness); *Investacorp, Inc. v. Arabian Investing Banking Corp.*, 931 F.2d 1519, 1523 (11th Cir. 1991) (citing evidence that eighty competitors used the word “invest”

The genericide doctrine’s focus on noncommercial, noninfringing uses diverts the trademark holder’s attention away from brand building and other activities that may enhance the mark’s capacity as a source identifier.²²⁷ Instead, it pressures them to expend money and goodwill on quixotic endeavors ranging from “education campaigns” designed to change the way the public uses the English language, to frivolous threats of litigation or lawsuits aimed at noninfringing or fair uses of their marks.²²⁸ This aspect of the genericide doctrine harms not only trademark holders, but also those who become the targets of the hyper-enforcement activities that result. Any type of weak or, at worst, frivolous litigation (or threat of litigation) is costly and should be discouraged or sanctioned, not encouraged, by legal doctrine.

3. *The negative effect of trademark policing on the public’s right to use trademarks expressively*

As noted previously, many valid trademarks—particularly the most famous ones—can and do function expressively.²²⁹ In other words, even though a trademark may function as a source-identifier in a commercial context, it may have other meanings and uses as well. It should not be surprising that “hybrid” trademarks exist. After all, few

in their trademarks as evidence that “investacorp” is descriptive); *King-Size, Inc. v. Frank’s King Size Clothes, Inc.*, 547 F. Supp 1138, 1155 (D.C. Tex. 1982) (noting widespread use of “king size” to refer to large clothing and shoes as evidence that the term is descriptive); *cf. Blendco, Inc. v. Conagra Foods, Inc.*, 132 Fed Appx. 520, 522 (5th Cir. 2005) (finding the term “Better-N-Butter” to be suggestive, where only two other companies had used the term to describe a “nondairy butter-flavored oil”) (unpublished); *Security Center, Ltd. v. First National Security Centers*, 750 F.2d 1295, 1300 (5th Cir. 1985) (“Security Center” used in reference to business that houses private storage vaults found suggestive when only twelve out of 105 members of the relevant trade association used the term to describe similar services).

²²⁷ See *Folsom & Teply*, *supra* note 32, at 1354; see also *id.* (contending that the need to engage in these types of policing efforts may signal that the term is losing its strength as a mark, and that courts should consider the necessity of such policing efforts as a sign of that decline).

²²⁸ *Accord* *Wiredata, Inc.*, 350 F.3d at 647 (acknowledging that copyright owners using litigation as a method of obtaining rights beyond the scope of copyright engage in an abuse of process)

²²⁹ See notes 50-54 and accompanying text, *supra*.

words have only one meaning. For example, the word “snow” is defined as (1) “precipitation in the form of . . . white ice crystals”; (2) “a dessert made of stiffly beaten whites of eggs, sugar, and fruit pulp”; (3) cocaine or heroin; or (4) “to deceive, persuade, or charm glibly.”²³⁰ Even though definitions 2-4 are fairly clearly derived from the first definition of the word “snow,” their existence does not undermine or call into question the validity of the word “snow” as it refers to fluffy, white, frozen precipitation. We determine the meaning of the word by the context in which it is used. Despite trademark holders’ best efforts to the contrary, a trademark is much like any other word, and therefore its meaning and use—depending on the context—will evolve over time.²³¹

The law recognizes and protects the expressive use of trademarks under the doctrine of fair use. The Lanham Act provides that if a trademark is used “otherwise than as a mark,” then such use is not actionable.²³² Therefore, if a trademark is being used expressively—not as a source identifier—then such use is not actionable by the trademark holder. The Act’s recognition and protection of fair use directly reflects a core principal of trademark law: trademarks are not held “in gross.”²³³ The public has a right to use trademarks in this manner.

As discussed above, the genericide doctrine’s characterization of noncommercial, noninfringing uses of a trademark as evidence that the mark has become generic incentivizes trademark holders (directly and indirectly) to “police” these types of uses. While the “education campaigns” discussed above may be viewed as relatively harmless

²³⁰ WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 1117 (1983).

²³¹ See Clankie, *supra* note 56, at 262 (“Language change and innovation are natural and, in general, unmanageable.”).

²³² 15 U.S.C. § 1115(b)(4) (2005).

²³³ See, e.g., *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) (“In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one’s good-will in trade. . . .”); *accord Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413-14 (1916).

(except to the extent that the cost of such campaigns is passed along to the consumer), other trademark policing efforts have a more direct and negative effect on consumers. Frivolous lawsuits are the most obvious example of this type of behavior; however, most trademark holders do not have to resort to such measures. Typically, just the threat of litigation (even when ever so lightly implied) by a corporate giant is sufficient to dissuade a person from making fair use of a trademark.²³⁴ Although trademark law does not recognize the doctrine of trademark misuse,²³⁵ Judge Posner has recognized the possibility of abusive litigation or “misuse” in the copyright context. The same reasoning applies to trademark law. To paraphrase Judge Posner, “[a trademark] owner[’s] use [of]] an infringement suit to obtain property protection ... that [trademark] law clearly does not confer, hoping to force a settlement or even achieve an outright victory over an opponent that may lack the resources or the legal sophistication to resist effectively, is an abuse of process.”²³⁶

One Web site, Chilling Effects (www.chillingeffects.org) maintains a growing database of more than 1700 cease and desist letters covering the full range of intellectual property law. These cease and desist letters demonstrate that trademark holders often threaten to sue in cases which—at least in the eyes of a person familiar with trademark law—would be demonstrably frivolous. These trademark holders often claim a fear of

²³⁴ Of course, sometimes such policing efforts have the opposite effect. Online lexicographer Paul McFedries, after receiving letters from Google requesting that he recognize Google as a trademark, chose to note Google as a trademark while listing evidence of generic uses of the term, including uses in the *Chicago Tribune*, *The Denver Post*, and the *Telegraph-Herald*. Furthermore, the site links to Google derived words and phrases, such as Google bombing, Googlejuice, and Googleverse, as well as noting some use the term “google” to mean to search for anything at all. See WordSpy at <http://www.wordspy.com/words/google.asp> (last visited April 3, 2006). WordSpy is a lexicography Web site “devoted to *lexpionage*, the sleuthing of new words and phrases. These aren’t ‘stunt words’ or ‘sniglets,’ but new terms that have appeared multiple times in newspapers, magazines, books, Web sites, and other recorded sources.” Wordspy Home Page, <http://www.wordspy.com/> (last visited April 3, 2006).

²³⁵ See *Association of American Medical Colleges v. Princeton Review, Inc.*, 332 F. Supp.2d 11, 18-19 (D.D.C. 2004); *Juno Online Services, L.P., v. Juno Lighting, Inc.*, 979 F. Supp 684, 690 (N. D. Ill. 1997).

²³⁶ *Wiredata, Inc.*, 350 F.3d at 647.

genericism as the driving force behind such threats. The Lego Group’s letter to the operator of a Lego fan site, located at “www.ratemylego.com” and “www.ratemylegos.com,” is an example.²³⁷ The letter informs the fan that “our trademarks must never be used descriptively or generically (i.e., Legos), but must always be used as an adjective followed by a descriptive noun (e.g., LEGO® toys) and must never be combined with other words (with or without a hyphen) to form a new word.”²³⁸ The letter then claims that the fan’s registration of the www.ratemylego.com and www.ratemylegos.com domain names constitutes trademark infringement, and then requests that he “immediately and permanently cease” using the domain names, and that he agree never to register them again.²³⁹ Lego’s Fair Play policy, a “Legal Notice” regarding its intellectual property rights posted on the Lego Web site, specifies that “[t]he Lego trademark cannot be used in an Internet address,” on the theory that doing so would create the “misleading impression that the LEGO Group sponsored the homepage.”²⁴⁰ Moreover, the Fair Play policy “insists” that “the LEGO logo NEVER be used on an unofficial web site,” regardless of context.²⁴¹

²³⁷ Posting of Leggo that Domain Name to, <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1076> (Dec. 16, 2003). Another Lego related letter may be found at Chilling Effects, <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=517>.

²³⁸ Posting of Leggo that Domain Name to <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1076> (Dec. 16, 2003). Other letters with similar rationales include ones from Wiley Publishing, Inc. regarding its For Dummies series: “If the mark is used by too many different sources, it becomes a ‘generic’ term, and Wiley may lose its exclusive right to use it.” Chilling Effects, <http://www.chillingeffects.org/protest/notice.cgi?NoticeID=355> (Jul. 15, 2002). Sun MicroSystem’s letter regarding its Java mark provides another example: “Like all trademarks, ‘Java’ should not be used as a noun, but instead should be used as an adjective. Please use an appropriate generic descriptor, for example, ‘technology,’ after each Java based trademark.” Chilling Effects, <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=231>.

²³⁹ Chilling Effects, <http://www.chillingeffects.org/domain/notice.cgi?NoticeID=1076> (Dec. 16, 2003).

²⁴⁰ Lego.com, Fair Play, Please, <http://www.lego.com/eng/info/default.asp?page=fairplay&bhcp=1> (last visited Jun. 1, 2006).

²⁴¹ *Id.* (emphasis in original).

In this case, the *former fan*²⁴² was not infringing the Lego trademark, as he was not using the mark “as a mark”—his use of the mark would almost certainly be characterized as a nominative fair use.²⁴³ Moreover, because he was not selling anything or competing with Lego in any way on the site, he probably was not “using” the mark at all, as “use” has been defined under the Lanham Act.²⁴⁴ The Lego Group undoubtedly knows that it does not have an absolute right to control when and how its trademark is used in the context of a domain name or a Web site, yet it attempts to suppress all such uses, at least in part due to concerns about genericide.²⁴⁵ This behavior inhibits speech that should be encouraged and protected by the Lanham Act.

D. *The Dilution Connection*

One other unfortunate side effect of the current version of the genericide doctrine—particularly its emphasis on noninfringing, noncommercial uses of trademarks as evidence of genericism—has been the expansion and legitimation of the oft-

²⁴² Lego’s policing efforts in this case prompted the once-enthusiastic Lego fan to create a link on the www.ratemylego.com and www.ratemylegos.com domain names to a separate Web page denoted “legogroupsucks.com” and “saynotolegos.com.” In it he argues that “companies who purposely use the law to try to intimidate domain holders into surrendering their names under frivolous claims are un-ethical. [] These people have no trouble alienating their fans for the sake of profit. Sadly I contributed to the revenue of the company and thus indirectly to the salaries of the lawyers who now try to take my domain. Instead of spending the past week having fun and building my lego toys, I am forced to waste my time protesting the company who makes the toys I love. For these reasons, Lego group sucks; along with all the other companies who try to bully good-faith domain holders out of their names.” Lego Sucks, <http://legogroupsucks.com/> (Jan. 2, 2004).

²⁴³ The Ninth Circuit recognized the nominative fair use doctrine in *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992). In this case, the Ninth Circuit held that a newspaper did not infringe the New Kids on the Block trademark by conducting a telephone poll inviting readers to vote for their favorite New Kid. *Id.* at 307-09.

²⁴⁴ See *Bosley Medical Institute, Inc. v. Kremer*, 403 F.3d 672, 679-680(9th Cir. 2005) (holding that www.bosleymedical.com, a Web site highly critical of the mark owner, did not infringe or dilute the BOSLEY MEDICAL trademark, because it did not constitute commercial use of the mark).

²⁴⁵ The Lego Group’s Fair Play policy and cease-and-desist letter may also be interpreted to reveal a broader agenda of claiming rights “in gross” to its trademark, divorced from any legitimate concern about genericide. See Lemley, *supra* note 9, at 1032 (noting that, when acting under a property-based conception of trademark rights, trademark holders “seek out and punish virtually any use of an intellectual property right by another”).

criticized²⁴⁶ dilution doctrine. Even though genericide is a relatively rare (though not always unsuccessful) basis for a dilution claim,²⁴⁷ in reality it is inherently linked to the justification for the existence of a dilution cause of action.

The Federal Trademark Dilution Act (FTDA) accords the holder of a “famous”²⁴⁸ trademark the right to enjoin a commercial use of its mark that “causes dilution of the distinctive quality of the mark.”²⁴⁹ “Dilution” is defined as “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”²⁵⁰ As the Supreme Court has recognized, “[u]nlike traditional infringement law, the prohibitions against trademark dilution are not the product of common-law development, and are not motivated by an interest in

²⁴⁶ See, e.g., Klieger, *supra* note 4.

²⁴⁷ See, e.g., Selchow & Richter Co. v. McGraw-Hill Book Co., 580 F.2d 25, 27-28 (2d Cir. 1977) (upholding district court’s finding of irreparable injury based on theory that defendant’s use of “Scrabble” in “The Complete Scrabble Dictionary” could render plaintiff’s mark generic); Sykes Laboratory, Inc. v. Calvin, 619 F. Supp. 849, 859 (C.D. Cal. 1985) (“[t]he anti-dilution statute in no way restricts the right to advertise a claim that one’s product is as good as a better known brand but one may not do it in a way that risks turning the latter into a generic term”); Norton Co. v. Newage Industries Inc., 204 U.S.P.Q. (BNA) 382, 1979 U.S. Dist. LEXIS 14289 (E.D. Pa. 1979) (use of the words “Tygon-type tubing” in defendant’s promotional materials infringed plaintiff’s Tygon mark and constituted unfair competition because such use was “calculated or likely to cause [plaintiff’s] mark to lose its significance as an indication of origin”); cf. Ty Inc. v. Perryman, 306 F.3d 509, 514 (7th Cir. 2002) (rejecting theory of dilution that would allow mark owners to enjoin mark usage solely because such use may “threaten to render the mark generic”); Diversified Marketing, Inc. v. Estee Lauder, Inc., 705 F. Supp. 128, 134 (S.D.N.Y. 1988) (rejecting argument that advertising slogan, “If You Like ESTEE LAUDER. . . You’ll Love Beauty USA” diluted Estee Lauder mark by tending to make it generic); see generally David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531, 558-66 (1991) (criticizing theory of dilution by genericide).

²⁴⁸ See note 31, *supra*.

²⁴⁹ 15 U.S.C. § 1125(c)(1); see also *Moseley v. V Secret Catalogue*, 537 U.S. 418, 431 (2003) (noting that, according to the legislative history, the FTDA is designed to “to protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion”) (internal citation omitted).

²⁵⁰ 15 U.S.C. § 1127. The FTDA was enacted in 1995; however, dilution has existed as a state law cause of action for many years. See, e.g., Cal. Bus. & Prof. Code § 14330 (providing for injunctive relief upon a showing of “[l]ikelihood of injury to business reputation or of dilution of the distinctive quality of a mark. . . notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services”).

protecting consumers.”²⁵¹ Dilution has been characterized as treading “very close to granting rights in gross in a trademark.”²⁵² The theory of dilution by blurring has been explained as follows:

If one small user can blur the sharp focus of the famous mark to uniquely signify one source, then another and another small user can and will do so. Like being stung by a hundred bees, significant injury is caused by the cumulative effect. . . . This is consistent with the classic view that the injury caused by dilution is the gradual diminution or whittling away of the value of the famous mark by blurring uses by others.²⁵³

When Congress enacted the FTDA, it cited “the use of DUPONT shoes, BUICK aspirin, and KODAK pianos” as examples of dilution that would be actionable under the statute.²⁵⁴

If one “whittles away” at a stick for an extended period of time, the stick will ultimately be reduced to a pile of wood shavings. Similarly, at least in theory, the result of a persistent course of dilution will be the genericide or disappearance of the trademark. Even though genericide is not commonly stated as a specific ground for a dilution claim,²⁵⁵ the two doctrines are therefore inextricably linked, at least in the mind of the trademark holder. When attempting to “police” a trademark, some mark holders tend to conflate the two concepts, as amply illustrated by this language from a cease-and-desist letter:

In short, this trademark is an extremely valuable asset of our company and we want to protect it against dilution. For your information, dilution is a relatively new area of law, which requires the owner of a trademark to protect it against "erosion" and/or dilution. Some famous examples of trademark dilution are

²⁵¹ Moseley, 537 U.S. at 429.

²⁵² Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999).

²⁵³ Savin Corp. v. Savin Group, 391 F.3d 439, 449 (2d Cir. 2004) (quoting 4 MCCARTHY, *supra* note 34, § 24:94); *see also* General Motors Corp. v. Autovation Techs., Inc., 317 F. Supp. 2d 756, 764 (E.D. Mich. 2004).

²⁵⁴ H.R. REP. NO. 104-374, at 1030 (1995), *as reprinted in* 1995 U.S.C.C.A.N. 1030.

²⁵⁵ *See* note 247, *supra*.

Kleenex tissues, Xeroxing, Scotch Tape and Aspirin, as these marks were not protected by their respective owners and today have become almost generic terms. [O]ur goal is to prevent such ‘generalization’ from happening to our trademarks.²⁵⁶

Both genericide and dilution are driven, at least in part, by the idea that uses of a mark in noncommercial²⁵⁷ and/or noninfringing contexts necessarily deplete the mark’s ability to function as a source identifier, and/or constitute evidence that the mark has *lost* its source-identifying significance. As explained both above and below, we believe that this effect has been overstated, and moreover that the cost of preventing or “policing” against such uses exceeds any benefit that is derived from it.

IV. *A Modest Proposal to Reform the Genericism Doctrine*

As explained above, we contend that the current version of the genericism doctrine is inherently flawed and requires reform. The following section presents our proposal for a revised understanding and implementation of the doctrine, one which we believe more effectively balances the rights of trademark holders and the public, and which better reflects the core purposes of trademark law: (1) protection against consumer confusion, and (2) preservation and optimization of efficiency and competition.

We argue that the genericism doctrine’s primary focus should shift from the elusive genus/species distinction to the question of whether the putative mark is functioning as a source identifier in the context of the relevant marketplace. If it is not

²⁵⁶ <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=149>; see also IDG letter to UCO Lick Observatory, <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=474> (using same language).

²⁵⁷ While uses of a mark in noncommercial settings (e.g., by the media or dictionaries) may arguably dilute the distinctive qualities of a mark, they are not actionable, as the FTDA applies only to “commercial use in commerce” of a mark, 15 U.S.C. § 1125(c)(1), and it recognizes the affirmative defense of fair use for “noncommercial use” of the mark, use by the news media, and use in comparative advertising. 15 U.S.C. §§ 1125(c)(4)(A)-(C).

... serving its intended purpose, then it can and should be characterized as “generic”—it is not functioning as a trademark. If the word or term is functioning as a trademark—i.e., a source-identifier—then the court should examine whether extending trademark protection to the word or term would have an unacceptable impact on competition. If so, then regardless of whether the mark has acquired distinctiveness, it should be deemed generic and hence unprotectable. Such a system would better protect the rights and interests of both trademark holders and the public.

A. *The Consumer Perspective: Interpreting Primary Significance and Secondary Meaning*

The first step in determining whether a putative trademark is “generic” should be to determine whether it acts as a source identifier in the relevant commercial context. In other words, is it distinctive, or (in the case of arguably descriptive terms) has it acquired secondary meaning? If the answer is “no,” then the term cannot be a trademark. As Judge Learned Hand stated in the *Bayer* case:

The single question. . . in all these cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, then. . . it makes no difference whatever what efforts the plaintiff has made to get them to understand more. He has failed²⁵⁸

Terms that do not satisfy this basic purpose should not be protected as trademarks.

Absent an unacceptable impact on competition, however, those that do serve this function should be treated as marks.

²⁵⁸ *Id.* at 509.

As discussed earlier, current doctrine holds that, if a term denotes a product class (i.e., a genus), then it is “generic” even if it is functioning as a source identifier. In such cases, the term is said to have acquired only “de facto” secondary meaning, and hence cannot be protected as a trademark.²⁵⁹ As at least one court has recognized (although it was reversed), the idea that a term can be declared “generic” even though its “primary significance” in the minds of the consuming public is that of a source identifier is somewhat illogical:

If the acid test of a symbol's capacity to differentiate is public perception, then the process of labeling for purposes of protectability cannot be undertaken without reference to that perception. [] To label a word or logo ‘generic’ in the face of the admitted presence of secondary meaning is to assert that every word has some absolute, inherently correct characterization that the law will discern without regard to what the public may think the word means.²⁶⁰

The modern concept of “de facto” secondary meaning is also inconsistent with the original understanding of genericism, as derived from the common law of unfair competition. This body of law protected words or phrases that were not considered technical trademarks from infringement, but only *if* they had acquired distinctiveness, or secondary meaning.²⁶¹ Under the common law, the key question was whether the term at issue had acquired secondary meaning—in other words, whether its “primary significance” to the consumer had become that of a source identifier; if it had not, the term was not entitled to protection from infringement.²⁶² In other words, at least with regard to terms that were not arbitrary or fanciful, the questions of genericism (i.e., unprotectability) and secondary meaning were not separately analyzed; they were

²⁵⁹ See note 188 and accompanying text, *supra*.

²⁶⁰ *Miller Brewing Co. v. Falstaff Brewing Corp.*, 503 F. Supp. 896, 906-07 (D.R.I. 1980); *rev'd*, 655 F.2d 5 (1st Cir. 1981).

²⁶¹ See note 99 and accompanying text, *supra*.

²⁶² See note 155 and accompanying text, *supra*.

effectively one and the same. For all of these reasons, we argue that modern courts should also turn their attention to “secondary meaning” or distinctiveness as the *first* step in determining the “primary significance” of a given term.

1. *The problem of the hybrid mark*

When, as was the case in *Bayer*, the court determines that the consuming public ascribes *no* source-identifying significance to the term at issue, the inquiry is a relatively simple one: the term is not a trademark. However, most cases are not so easy. As discussed previously, trademarks (at least the most famous ones) are like most words, in that they typically have more than one meaning. These “hybrid terms,” as Folsom and Teply have described them, “perform a variety of informational functions—ranging from the provision of pure commercial or source-related information to the provision of pure generic or product-category information—at the same time.”²⁶³ In other words, different consumers may understand a trademark to mean different things, and/or a single consumer may apply multiples meanings to the same trademark, depending on the context in which it is used.²⁶⁴ When determining whether a term is generic, the court should focus on the “primary significance” of the term to the consumer in a *commercial context*, and should give little weight to evidence of uses outside that context.²⁶⁵

We argue that the all-or-nothing approach, which suggests that consumers take a term to signify primarily either a source or, if not a source, a product class, fails to

²⁶³ Folsom & Teply, *supra* note 32, at 1339.

²⁶⁴ *Id.*

²⁶⁵ This statement is not to say that expressive uses do not impact language and potentially the trademark itself. Rather, as discussed below, those uses and impacts are better addressed under a competition analysis.

capture the way in which terms actually function. In fact, the “primary significance” to the consumer shifts depending on the context in which the term is used. In other words, the fact that the public may use trademarks in a non-trademark manner does not necessarily lead to the conclusion that such uses harm the trademark and/or the policies of increasing economic efficiency and consumer protection that lie at the core of classic trademark doctrine.²⁶⁶ Moreover, these other, “expressive” uses of trademarks have inherent value, and the public’s right and ability to use trademarks in such ways should not be stymied or quashed, as is often the case today.²⁶⁷

For example, KLEENEX is a trademark that is widely considered to be borderline generic. Yet, even though this mark has a widely-understood “generic” meaning that is arguably the “primary significance” of the term, there is evidence that it also functions as a source identifier, in the proper context. Consider that a person with a cold can walk into a colleague’s office, ask for a “kleenex” and be handed a tissue but not a Kleenex[®]-brand tissue. At that moment the person with the runny nose is likely to accept the tissue offered without complaining or caring about the brand. When that same person is in a supermarket, however, she may certainly care whether she buys Kleenex[®] versus Puffs[®] brand facial tissue, due to her experience with the brands’ relative softness or thickness. Indeed, she might be confused if a box of facial tissue were labeled “Puffs Kleenex.” The key question should be whether consumers still perceive KLEENEX as a source-identifier in the marketplace, not whether they use “kleenex” as a common noun (as they undoubtedly do), in other settings.

²⁶⁶ See notes 211-228 and accompanying text, *supra*.

²⁶⁷ See notes 229-245 and accompanying text, *supra*.

For similar reasons, the traditional notion that the trademark holder should never use her mark as a noun or verb, but only as an adjective with a generic term appended to the mark,²⁶⁸ takes an overly constrictive view of the ways in which the public uses language. Although many familiar marketing campaigns, such as “Do you Yahoo!?” and “Dude, you’re getting a Dell,” arguably use the respective marks improperly, they do not appear to have morphed these marks into generic terms. For example, the “Dude, you’re getting a Dell” campaign has the word computer implied in the statement, but has not resulted in consumers saying “Get a Dell” when they really mean to get a Compaq, a Gateway, or some other computer.²⁶⁹ Thus, although these trademarks have been used in ways that traditionally have been seen as contributing to genericism, that use has not confused the public or limited other competitors’ ability to enter the market. Marketers have simply chosen to reflect the way in which people tend to speak.

Some argue that allowing a company to keep using hybrid terms such as KLEENEX as trademarks harms consumers and increases search costs.²⁷⁰ This argument can be best understood as a question of the information available to the consumer. In theory, experience goods such as toothpaste, mouthwash, clothing, and so on do not pose a problem when generic terms are used as trademarks because the consumer will engage in the experience at relatively low cost—²⁷¹e.g., purchase toothpaste, try it out, and possibly try another maker’s toothpaste and another’s until she finds the one she likes. In

²⁶⁸ For example, the International Trademark Association explicitly instructs trademark owners *not* to use trademarks as nouns or verb and to always use the trademark with a generic term to avoid possible genericide rulings regarding the trademark in question. *See* Information and publishing FAQ How Do I Use a Trademark Properly? available at http://www.inta.org/index.php?option=com_simplefaq&task=display&Itemid=0&catid=284&page=1&getcontent=5#FAQ75 (last visited June 1, 2006).

²⁶⁹ Similarly, to Yahoo! is likely seen as different from Googling by consumers, in that to Google is to use the Google search engine and to Yahoo! is to partake in the range of Yahoo! services.

²⁷⁰ Folsom & Teply, *supra* note 32, at 1340-1346.

²⁷¹ *Id.* at 1342.

addition, these products are sold in stores where pre-purchase comparison is facilitated because the consumer can read labels, examine packaging, and even try the product.²⁷²

When a consumer shops for more expensive and/or less-frequently purchased goods (such as a several thousand dollar motorcycle), however, the concern is that the information available when shopping for experience goods is not as easily available and as such consumers “face either enhanced risks in purchasing the possible substitute or increased search costs, unless there is a readily available, reliable means of determining whether competing products possess the functional attributes associated with the trademarked word.”²⁷³ In other words, an uniformed or unsophisticated consumer will be likely to over rely on the trademarked generic term and purchase only the mark holder’s product rather than a competitor’s equally good product because the consumer will wish to stick with the product bearing the generic term she knows.²⁷⁴

The frequency with which a consumer will be without “readily available, reliable means of determining whether competing products possess the functional attributes associated with the trademarked word”²⁷⁵ may, however, be diminishing. Given the greater availability of information to the consumer from all sides—the Internet, television, trade and consumer comparison magazines, the marketer who pursues all these avenues as well as employs packaging and placement tactics in stores, and consumer awareness of substitute generic products for brand products—consumers are less likely to be unarmed as they shop for goods and more likely to be able to use a brand name generically in common speech but as a source-identifier when consuming. As such, the

²⁷² *Id.*

²⁷³ *Id.* at 1343.

²⁷⁴ *Cf.* Bartow, *supra* note 32, at 771 (questioning likelihood of confusion analysis and the way in which consumer sophistication is determined).

²⁷⁵ Folsom & Teply, *supra* note 32, at 1343.

issue raised in allowing one company to claim a term as its trademark is better addressed by focusing on the way language evolves and whether the term is necessary for competition.

2. *The doctrine should recognize and reflect that the meaning of words evolves over time*

As described above, most words have more than one meaning, and those meanings can and will change over time. A word or term which has no secondary meaning may acquire it; a word which has abundant secondary meaning may lose it all. The current doctrine, however, largely fails to reflect the fluidity of language. Under the “once generic, always generic” theory, courts refuse to recognize as trademarks source-identifying terms—even arbitrary ones—that may have been “generic” at some point in their life cycle as part of the English language. The doctrine should not attempt to freeze the “primary significance” of a word at a given point in time, as to do so is both artificial and inefficient.

As previously discussed, several courts have held that, if a word or term was used generically in the past (usually based on a dictionary definition or some similar source), it cannot ever become a valid trademark, at least when the term retains any shred of generic meaning.²⁷⁶ However, this approach deviates from the core question of whether the term

²⁷⁶ See, e.g., *Miller Brewing Co. v. Falstaff Brewing Co.*, 655 F.2d 5, 8 (1st Cir. 1981) (“Where a generic association of a word or term has become obsolete and is discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word.”); see also notes 188-198 and accompanying text, *supra*.

is functioning as a source-identifier in the relevant commercial context and, therefore, renders potentially inefficient results. For that reason, it should be abandoned.

When a court deems a term generic, based on an understanding of the term that is not or is no longer shared by most consumers, such a decision imposes higher search costs on the consumer. In other words, when courts ignore or refuse to recognize the “primary significance” of the term in the relevant market, inefficiencies result. The *Harley-Davidson v. Grottanelli*²⁷⁷ case is a prime example. There, rather than allow consumers to maintain their predominant use of “Hog” as meaning a particular type of Harley-Davidson motorcycle, the court held that anyone could use the term to mean large motorcycles, based on dictionary definitions and reports in the media that were published twenty to fifty years earlier.²⁷⁸ As a result of this decision, consumers may have been required to distinguish between Honda Hogs and Harley Hogs, and would likely wonder whether Harley-Davidson had entered into joint ventures with those manufacturers. Absent competitive necessity, as discussed in the following section, courts should avoid increasing consumer search costs and thus undermining the efficiency that is ideally embodied in trademarks.

B. *The Doctrine Must Focus on Competition*

Once the court has determined that a term has source-identifying significance, the court should look to the question of whether according trademark protection to that term

²⁷⁷ *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999).

²⁷⁸ See note 191 and accompanying text, *supra*.

would have an unacceptable impact on competition. If so, then the term should be deemed generic, regardless of its source-identifying properties:

Underlying the genericness doctrine is the principle that some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might become identified with a source and so acquire ‘de facto’ secondary meaning.²⁷⁹

If there is only one word or term that the public understands as signifying the product, even if they have come to associate that name with a single source, the trademark holder should not be able to erect a barrier to entry into the marketplace by preventing her competitor from calling the product by its name. Therefore, the genericide doctrine must address the question of when competition requires that a word or term be available for all to use.

The inquiry that the court should undertake in addressing this question is analogous to a determination of functionality in the context of trade dress law. Trade dress (e.g., product packaging or design) may function as a source identifier, just like a word mark.²⁸⁰ Functionality renders trade dress unprotectable, much in the same way that genericism renders a word mark unprotectable. The Supreme Court has held that a feature of trade dress is “functional” if it is “essential to the use or purpose of the article or if it affects the cost or quality of the article.”²⁸¹ More broadly, the Court has held that a product feature is functional “if exclusive use of the feature [by the party claiming trade dress protection] would put competitors at a significant non-reputation-related

²⁷⁹ A. J. Canfield Co. v. Honickman, 808 F.2d 291, 308 (3d Cir. 1986); *see also* American Cynamid v. Connaught Laboratories, Inc., 800 F.2d 306, 308 (2d Cir. 1986) (“[c]onsumers will not benefit. . . if trademark law prevents competitors from using generic or descriptive terms to inform the public of the nature of their product”).

²⁸⁰ *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (holding that trade dress, like a word mark, may be inherently distinctive).

²⁸¹ *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001); *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995) (same); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982) (same).

disadvantage.”²⁸² This broader statement regarding the underlying purpose of the functionality doctrine applies equally well in the genericism context: if granting one person the exclusive use of a word or term to identify a good or service puts that person’s competitors at a “significant non-reputation-related disadvantage,” then the courts should not grant trademark protection to the term. In short, it should be considered generic.

In the trade dress context, many courts consider the existence of “alternative designs” in analyzing the competitive necessity aspect of the functionality doctrine. If a competitor can achieve the same utility as the product feature in question through an alternative design, this fact tends to suggest that the feature is not “functional.”²⁸³ Similarly, courts can and should consider the existence of alternative words to use as source identifiers (or lack thereof) in determining whether “competitive necessity” renders a word or term generic: “Whether the term that identifies the product is generic . . . depends on the competitors' need to use it. At the least, if no commonly used alternative effectively communicates the same functional information, the term that denotes the product is generic.”²⁸⁴

²⁸² *Qualitex*, 514 U.S. at 165 (citing *Inwood*, 456 U.S. at 850 n.10). More recently, the Supreme Court has emphasized the “traditional” test of functionality—“essential to the use or purpose of the article or affects the cost or quality of the article”—and suggested that the competition-based definition of functionality applies primarily in the context of aesthetic functionality. *Traffix Devices, Inc.*, 532 U.S. at 33.

²⁸³ See, e.g., *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1341 (C.C.P.A. 1982) (discussing relevance of the existence of alternative designs to a finding of competitive necessity); *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (concluding that existence of alternative designs is a valid source of evidence in determining functionality). After the Supreme Court’s decision in *Traffix*, 532 U.S. 23, the circuit courts have split on the continued relevance of alternative designs to a determination of functionality. Compare *Valu Engineering*, 278 F.3d at 1276 (alternative designs may be considered as evidence of non-functionality), with *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355 (5th Cir. 2002) (availability of alternative designs is “irrelevant” if feature is functional under the “traditional test”).

²⁸⁴ *A. J. Canfield Co.*, 808 F.2d at 305-06 (citations omitted). See also *Bone*, *supra* note 49, at 2123 (observing that “if there are many alternative words for firms to use as trademarks, an erroneous decision to give a particular firm trademark protection in one such word would not be terribly costly because a competitor could easily choose another word for its mark”).

Smart producers and marketers already know that they have a duty to develop generic alternatives to the trademarks that they attach to their goods and services, particularly when they are in a position to achieve market dominance.²⁸⁵ Few companies make the mistake that Bayer made in the early 1900's, when it marketed its new drug under the label "Aspirin," without providing any viable alternative for the consumer to identify the drug.²⁸⁶ Thus, TiVo calls its product a DVR. Kleenex makes facial tissues. Xerox sells photocopiers.

Whether the public is willing to adopt the alternative generic term offered up by the producer of the good or service depends in part on the amount of effort put into promoting the alternative term and its linguistic desirability. For example, as is the case with Xerox, TiVo, and Kleenex, assuming that these trademarks function as source-identifiers, the question is whether DVR, facial tissue, and photocopier are viable terms to allow for competition.

While business owners who choose arbitrary or fanciful names for their products may be aware of the need to choose a generic alternative, the need to do so when choosing a seemingly descriptive name may be less obvious. In *Canfield*, for example, the product name in question was Diet Chocolate Fudge Soda, a term which was found generic.²⁸⁷ While a competitor could make a competing diet soda that also purports to taste like chocolate fudge and give it a suggestive ("Diet Fudgilicious"), arbitrary ("Purple") or fanciful ("Zango") name, using such names would impose a "significant

²⁸⁵ See *Ty Inc. v. Softbelly's, Inc.*, 353 F.3d 528, 532 (7th Cir. 2003) (noting that "[s]ometimes a trademark owner will sponsor a generic term precisely in order to avoid its mark becoming generic. Xerox succeeded with 'copier,' and 'Sanka' was saved from becoming generic by the emergence of 'decaf' to denote the product of which Sanka was for long the best-known brand.").

²⁸⁶ *Bayer Co. v. United Drug Co.*, 272 F. 505, 510-11 (S.D.N.Y.1921) (finding that the consumer had "never heard the name 'acetylsalicylic acid' as applied to [the drug], and without some education could not possibly have kept it in his mind, if he had").

²⁸⁷ *A. J. Canfield Co.*, 808 F.2d 291.

non-reputation-related disadvantage” on the competitor. Unlike Diet Chocolate Fudge Soda, these names (especially the fanciful and arbitrary ones) tell the consumer little to nothing about the soda inside the can, and therefore the competitor would have to expend considerable resources to educate the consumer about his product, unlike the holder of the Diet Chocolate Fudge Soda mark.²⁸⁸ In *Canfield*, Judge Becker found the Diet Chocolate Fudge Soda mark to be generic, because there was no acceptable alternative to describe the product: “Flavors. . . have unique characteristics, and we can imagine no term other than ‘chocolate fudge’ that communicates the same functional information, namely, that this soda has the taste of chocolate fudge, a particular, full, rich chocolate taste.”²⁸⁹

In short, the putative trademark holder who chooses a descriptive term to label his good or service should weigh the issue of available alternatives just as much, if not more, than if he had chosen an arbitrary or fanciful mark. The question that should be asked is whether there is another way to describe the product that communicates its attributes just as effectively and efficiently. If not, the business owner or marketer should choose a different mark. Otherwise, the business owner risks a great deal in expending resources to acquire secondary meaning that may ultimately be for naught.

C. The Solution in Action

Suppose that a few years from now iPod has been entered into dictionaries as meaning any portable multimedia device, appeared in numerous newspaper and journal

²⁸⁸ See Carter, *supra* note 32, at 770-71 (characterizing descriptive and suggestive marks as “cheaper information economizers” and, hence, more efficient); see also note 87 and accompanying text, *supra*.

²⁸⁹ A. J. Canfield Co., 808 F.2d at 308.

articles as a general term for a multimedia device, and has been otherwise used as shorthand for a portable multimedia device; all despite Apple’s best efforts to persuade “lexicographically influential persons” that the term is Apple’s trademark and only designates Apple’s portable multimedia device. At such a point, suppose further that Walnut, a licensee of Apple’s iPod platform and maker of its own portable multimedia device, mismanages its product line such that Apple—as it must, lest it fail to control the quality of products associated with its mark and thus lose its trademark²⁹⁰—terminates the license agreement. After the end of the relationship Walnut decides to continue making its portable multimedia device using a different software platform but calling the device Walnut’s iPod. Apple would have to bring suit to prevent this use and most likely Walnut would defend itself in part by claiming that “iPod” had become generic.

At trial, evidence demonstrates that iPod is a hybrid term, i.e., some use the term in a product-category manner, some in a source identifying manner, and some in a combination of the previous two manners,²⁹¹ and that the media has used the term generically. Under these facts, despite the varying ways in which the term is used, a court would have to find that either the term was generic or not. There is no available middle ground. And, under these facts, a court would likely find that the term had become generic; that “the trademark was initially an invented term and lost its protection because of later public expropriation.”²⁹²

Under our proposed approach, however, a more rational inquiry would follow.

The court would first examine whether the term iPod had any source identifying qualities.

²⁹⁰ When a trademark holder fails to exert sufficient control over the quality or type of goods manufactured by a licensee, the trademark holder has engaged in “naked licensing” and thereby abandons the mark. *Stanford v. Osborne Industries, Inc.*, 52 F.3d 867, 871 (10th Cir. 1995) (citations omitted).

²⁹¹ *Folsom & Tepley*, *supra* note 32, at 1339.

²⁹² *Murphy Door Bed Co. v. Interior Sleep Sys.*, 874 F.2d 95, 102 (2d Cir. 1989).

If that inquiry failed to demonstrate that iPod retained any level of source identification, the inquiry would end because, absent source-identification, the term is not functioning as a trademark. If, however, source identification were found, the court would examine whether the competitors required the term to enter and compete in the market. The defendant would bear the burden of showing that there was no other commercially viable way in which to refer to a given product.

Given that multimedia player or MMP are available alternative terms to iPod, a court should rule that iPod was not necessary to facilitate competition. The analysis is the same when considering descriptive terms that have acquired secondary meaning, such as Diet Chocolate Fudge Soda. In cases of this sort, the trademark holder has chosen to use terms that are more open to challenge on competitive necessity grounds. The trademark may have acquired secondary meaning, but when the terms are the essence of the idea of the product such that alternative terms are not available, the trademark will be ceded so that competitors may enter the market fairly. This approach requires that trademark holder choose marks carefully and deploy terms to allow competition. Yet that is a result that we should foster. For, as Judge Hand noted, a trademark is not supposed to be a monopoly eliminating competition; rather it is supposed to enhance the marketplace and protect the consumer. As such, whoever seeks the benefits of trademark status must then expend some resources to develop terms that also allow competition. Such a requirement would add some small cost to the trademark beneficiary, but it is a task that fits easily within the marketing department.²⁹³ Moreover, society will gain two terms rather than one.²⁹⁴ More importantly, from an efficiency standpoint, it fosters competition and

²⁹³ See Dreyfuss, *supra* note 10 at 416-417.

²⁹⁴ *Id.* at 419.

reduces the potential for long-term costs, such as enforcement campaigns of questionable usefulness and the possibility that a competitor could invalidate the mark.

Conclusion

Current genericism doctrine requires an all-or-nothing, static approach to understanding how a term functions in society. In analyzing whether a term is protectable, courts traditionally look first to the term's status: is it generic or not, i.e., is its "primary significance" that of a product class (genus) or of a particular product (species)? Courts often determine that significance by focusing on the way in which the term is used in noncommercial, public contexts such as newspapers and dictionaries. We disagree with this approach.

First, marks (at least the most famous ones) rarely function in a purely source-identifying manner. Rather, such marks tend to have a hybrid nature whereby they have multiple meanings, often to the same person, depending on the context in which they are used. To determine whether the term is functioning as a valid trademark, the courts should focus on its "primary significance" in the commercial context, recognizing that the term may have additional, "generic" meanings as well.

Second, the current doctrine's approach, which relies on an overly broad scope of evidence in deeming a trademark generic, forces irrational behaviors on the part of mark holders in that they must expend resources trying to persuade the media, dictionaries, and others from making fair use of their marks. Thus, mark holders waste resources trying to influence actors over whom they have no right or ability to control (through "education,"

bullying, and, in some cases, litigation), rather than spending those resources more efficiently elsewhere and/or cutting the cost of their goods or services.

A rational genericide doctrine should focus on two basic questions, recognizing that the answers to those questions may and likely will change as language evolves: (1) Does the mark function as a source identifier i.e., what is its primary significance in the relevant marketplace?; and (2) Would protecting the term as a trademark impose a “significant non-reputation-related disadvantage” on competitors? Such a doctrine would strike a better balance between the significant interests that both trademark holders and the public have in this fundamental struggle over the meaning and right to use language.