

WHAT LINGUISTICS CAN DO FOR TRADEMARK LAW

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Introduction

In his contribution to this volume, Alan Durant provides legal scholars with both a rich understanding of how linguists view terms that are part of the basic argot of trademark law and a potentially vital explanation of the different social functions that word marks might serve.¹ Both aspects of his analysis introduce the complex variable of reality into trademark law. Trademark law must decide whether and when to take account of that complex reality, and what weight to afford such reality, no matter how enriched an account linguists offer about the actual meaning of signs. In this response, I suggest that, while trademark law should not become beholden to linguistics, the lessons of Durant's linguistic analysis are to some extent already accommodated in the practice of trademark law, and could be important guides in the further development of a number of legal principles.

Part I of this Chapter explains why linguistics should matter to trademark law. Traditionally, and still most typically, words comprise the largest group of trademark subject matter. Trademark law is structured around protecting the meanings of those words, at least as understood by consumers, in order (classically) to prevent consumer confusion. I suggest some reasons why trademark law might ignore the precise reality of consumer understanding. However, the *starting point* (if not always the end point) of trademark law in many contexts is an understanding of how signs actually work in context, and linguistics is one way of establishing that starting point for words. I explain how trademark law (despite some superficial departures) does in large part take into consideration Durant's observation that legal analysis would comport more with the reality of how words function if it focused on marks *as they are used*.

Part II of the Chapter focuses on Durant's exploration of the concepts of "distinctiveness" and "descriptiveness", as understood by lawyers and linguists, respectively. Durant highlights a divergence between linguistic and legal understandings of these core parts of trademark terminology. One could attenuate the significance of this divergence simply by recognizing that the legal usage reflects technical terms of art. Instead, I argue that Durant's analysis should reinforce important lessons for legal

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¹See Alan Durant, *How Can I Tell The Trademark on a Piece of Gingerbread from all the Other Marks On It? Naming and Meaning in Verbal Trade Mark Signs*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE (Lionel Bently, Jennifer Davis & Jane Ginsburg, eds. 2007).

scholars. In particular, it helps us to understand that these terms are, to *some* extent, vehicles for more complex policy prescriptions than either exoteric usage or current technical understandings would suggest. Current trademark law fails adequately to acknowledge the other-than-supposedly-ordinary meaning of these key parts of trademark terminology, undermining the transparency of trademark lawmaking.

Finally, in Part III, I argue that particular insights developed by Durant from the field of linguistics may prove valuable in illuminating several points of contention in contemporary trademark law. For example, Durant argues that there is less inherent meaning to words than commonly assumed, even in conjunction with particular goods—a coupling on which trademark law focuses in deciding whether to recognize trademark rights without proof of actual distinctiveness. The assessment of this relation, sometimes described as a test of conceptual strength, nominally determines² whether a term is treated as inherently distinctive and hence immediately protectable.³ Instead, Durant emphasizes that what words mean and what effects they have “depend on how they are used as much as on the inherent meaning potential of the signs themselves.” International policymakers increasingly focus on lubricating the system of international registration, which tends to favor the adoption of marks that are treated as inherently distinctive. Durant’s work suggests that this is the wrong focus, or at least that we need to defend the emphasis on trademark registration as pursuing more discrete goals of economic policy.

Likewise, Durant’s analysis of the different functions of words may be of great help in the development of the “fair use” or “descriptive, non-trademark use” defense, the latter of which is becoming one the most contested parts of trademark law in a number of countries.⁴ Fair use is one doctrinal setting in which trademark law tries to separate the protectable and unprotectable meaning that a term might simultaneously carry. Yet, according to Durant, linguistic theory suggests that it is difficult to separate the descriptive understandings of a word from its source-identifying character. Instead, linguistics may offer a number of concepts that can help delineate the types of

²As I discuss in Part I, *infra*, this rule which ostensibly operates as an assessment of the relation between the sign and the goods in practice is informed by a number of considerations that make the analysis even more contextual.

³Conceptual strength is also relevant to questions of infringement, although the weight that courts attach to that factor in their infringement analysis is uncertain. See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 95 CAL. L. REV. 1581, 1633-36 (2006) (concluding that “in opinions that do address the issue of trademark strength, and inherent strength in particular, there is a surprisingly good correlation between inherent strength and success in the multifactor test” but also noting that “in those opinions in which the court's assessment of the mark's inherent strength was at odds with its assessment of the mark's acquired strength, a finding of acquired strength (or weakness) almost invariably trumped a finding of inherent weakness (or strength)”).

⁴See generally Graeme B. Dinwoodie and Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. ____ (2007); Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. ____ (2007); see generally TRADEMARK USE (Jeremy Philips and Ilanah Simon eds., 2005).

permissible uses of a trademark in a more refined fashion than the current legal concepts of “descriptive use” or non-trademark use.

I. The Limits of Reality: Trademark Law and Linguistic Meaning

A. **Signs Functioning in Principle**

Durant argues that the main emphasis in legal studies is on how signs function in changing markets rather than how signs function in principle. This is surely correct, and appropriate. Trademark law is at bottom a mercantile law, concerned with actual marketplace effects. But trademark law has developed rules that on their face purport to reflect how signs function in principle. For example, it is standard black-letter law that “descriptive” terms will not immediately operate as source identifiers; trademark law assumes that consumers will not use such types of signs to identify and distinguish the goods of one producer from those of another.⁵ To receive trademark protection for a descriptive term, a producer must show that the term has acquired a secondary meaning in the marketplace.⁶

One might surmise that such rules of law say, or assume, something about how signs function in principle.⁷ But it is important to recognize that many of these rules have been induced over time from the reasoned outcomes in individual cases, where the outcome to some extent has been informed by how language *has* been used and understood in the marketplace. On the whole—and this is an important prudential consideration, as discussed below—it is probably true that terms that are descriptive fail immediately to act as source-identifiers in the marketplace.

Moreover, the classification of a term as *de iure* descriptive, although nominally a question of fact in a trademark suit,⁸ might also be understood simply as a legal conclusion about whether or not a term should immediately be reserved to the exclusive use of a single producer in the field in question. This broader understanding of the classification of a term as descriptive is bolstered if one examines some of the ways in which courts make a determination of whether a term is descriptive or distinctive. For

⁵See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC), 1989 O.J. (L 40) 1, art. 3 (hereinafter “Trademark Directive”).

⁶Similar rules of law apply to non-word marks. Thus, in the United States, recent case law mandates that product design marks be protected only upon proof of secondary meaning, because, according to the Supreme Court, consumers ordinarily do not identify the source of a product by its shape or design. See *Wal-Mart Stores v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

⁷See Durant, *supra* note 1, at ___.

⁸See *Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983). Likewise, the European Court of Justice has developed rules about how to determine distinctiveness or confusion, but has left it to national courts to make factual determinations about how signs actually operate. Of course, the line between EU-wide legal rules and national factual assessments of consumer understanding is not always clear. See *Arsenal Football Club v. Reed*, 2003 E.T.M.R. 73 (Court of Appeal 2003) (UK).

example, in *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, the Court of Appeals for the Fifth Circuit identified four considerations that bore on this question: the dictionary meaning of the term, whether it requires imagination, thought and perception to reach a conclusion as to the nature of the goods based on the term used, the extent of third party usage of the term, and whether competitors needed the term in order to compete.

To be sure, the first two factors—dictionary meaning, and the extent of imagination required to understand the nature of the goods from the term used—appear to look at inherent meaning. But looking at third party usage of the term, and whether competitors needed the term in order to compete, allow a court to have regard to the use of the mark in the marketplace whilst making a nominally conceptual determination. To be sure, much judicial analysis in this area appears essentially intuitive and unreasoned, as was the case in *Zatarain's* itself, but the legal determination at least appears to proceed from more than merely an assessment of how the term in question functions in principle.⁹

Finally, to the extent that rules regarding different *types* of signs have not been consolidated into statutory form, but instead operate as a presumption or rule of thumb, those rules may on occasion give way to empirical reality. Thus, in *Peacable Planet v. Ty, Inc.*¹⁰ Judge Richard Posner explored the rationales behind another rule that appears to operate on assumptions about how certain signs function in principle, namely, that personal names should not be protected as trademarks absent secondary meaning.¹¹ These include the assumption that “some names are so common--such as ‘Smith,’ ‘Jones,’ ‘Schwartz,’ ‘Wood,’ and “Jackson”--that consumers will not assume that two products having the same name therefore have the same source, and so they will not be confused by their bearing the same name.” (Like the rule on descriptive terms, the personal name exclusion also reflects economic or competitiveness concerns, namely, allowing a person to use his own name in his own business and ensuring that owners of businesses are not prevented from communicating useful information to the consuming public.)

⁹In addition, as discussed below, the classification of the mark on the spectrum of distinctiveness reflects parallel, but related, realities. Thus, the factors allow courts to consider not only how the term will function in use for consumers, but whether its reservation to one producer would generate competitive costs. See Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 NORTH CAROLINA L. REV. 471, 503-04 (1997) (explaining the dual lenses through which distinctiveness is assessed). See *infra* Part II. Likewise, the Supreme Court’s assimilation of product design marks with descriptive terms, while justified in terms of the function of a product designed for consumers, was in large part intended to pursue other goals such as preservation of competition. See *Samara, supra*.

¹⁰362 F.3d 986 (7th Cir. 2004).

¹¹Judge Posner explained that “[a]lthough cases and treatises commonly describe personal names as a subset of descriptive marks, . . . it is apparent that the rationale for denying trademark protection to personal names without proof of secondary meaning can't be the same as the rationale just sketched for marks that are “descriptive” in the normal sense of the word. Names, as distinct from nicknames like ‘Red’ or ‘Shorty,’ are rarely descriptive.” *Id.*

However, despite the assumptions about how personal names function in principle, Judge Posner argued that the scope of a rule is often limited by its rationale and concluded that in the case before him (NILES for stuffed toy camels), the reality of how NILES would operate in the marketplace should prevail over routinized application of the “rule” on personal names. He explained that:

rules of law are rarely as clean and strict as statements of them make them seem. So varied and unpredictable are the circumstances in which they are applied that more often than not the summary statement of a rule—the terse formula that judges employ as a necessary shorthand to prevent judicial opinions from turning into treatises—is better regarded as a generalization than as the premise of a syllogism. The "rule" that personal names are not protected as trademarks until they acquire secondary meaning is a generalization, and its application is to be guided by the purposes that we have extracted from the case law. When none of the purposes that animate the "personal name" rule is present, and application of the "rule" would impede rather than promote competition and consumer welfare, an exception should be recognized. And will be; for we find cases holding, very sensibly--and with inescapable implications for the present case--that the "rule" does not apply if the public is unlikely to understand the personal name as a personal name.

Thus, even where trademark law may seem to adopt rules reflecting beliefs about how signs function in principle, the derivation of such rules, their practical implementation, and their interpreted scope often allow legal analysis to reflect marketplace realities. As a result, much of trademark doctrine fits quite well with Durant’s linguistic conclusion that, both as regards eligibility for protection and enforcement of rights, the meaning of signs should be judged on the basis of criteria concerning the use of the signs in a given context.¹²

B. Departures from Reality or More Complex Reality

On occasion, however, trademark law departs from Durant’s principle, and ignores the precise social reality of consumer understanding of words as used. In this section, I suggest some of the reasons why trademark law might do so, and discuss what those departures from reality might mean for the relevance of linguistics to trademark law.

¹²See Durant, *supra* note 1, at ___ (noting that “what [signs] mean, what effects they have, and how far they infringe particular rights, all depend on how they are used as much as on the inherent meaning potential of the signs themselves.”).

1. *Competing Goals*

Trademark law may seek to pursue prescriptive goals that over-ride protecting the sanctity of actual consumer understanding. For example, most trademark laws permit third parties to make unauthorized use of a protected term otherwise than as a mark, in order fairly and in good faith to describe the qualities or characteristics of the goods of that third party.¹³ In a recent case, *KP Permanent v. Lasting Impressions*,¹⁴ the United States Supreme Court recognized that the policy objectives underlying the so-called classic fair use defense might on occasion trump the classic concern of trademark law with avoiding a likelihood of confusion. That is, the competitive gains that flow from enabling rival producers to make use of essential descriptive terms may exceed the reduction in search costs that would be achieved by prohibiting the competitors' somewhat confusing use. Likewise, the greater latitude sometimes afforded those who make unauthorized use of a trademark for parodic purposes might simply reflect a concern for free speech values that is more fundamental than solicitude for the integrity of consumer understanding.¹⁵

In some instances, these competing considerations appear incommensurable, requiring courts confronted with infringement claims to muddle through, trying best as they can to optimize competing social objectives. For example, in 1938 the United States Supreme Court held that rivals of the original producer of SHREDDED WHEAT pillow-shaped biscuits were entitled to use that term (which the Court deemed generic) in part because of competition considerations and concerns attendant to the integrity of the patent system.¹⁶ But the Court also required the rivals to use the term in ways that paid due regard to whatever consumer association of the term with the original producer in fact remained.

On other occasions, the limit on trademark rights can be explained as fully concordant with the affirmative purposes of trademark law. For example, one can

¹³Section 33(b)(4) of the Lanham Act provides that it shall be a defense to an action for infringement of any mark "that the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin."

¹⁴*See* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004) (recognizing that not all forms of confusion are actionable under trademark law, and thus holding that a third party may be permitted to engage in some uses of a mark notwithstanding that such uses cause confusion.).

¹⁵*See, e.g.,* *Mattel, Inc v. Walking Mountain Productions*, 353 F.3d 792, 807 (9th Cir. 2003) (permitting the use of BARBIE in the titles of photographs that displayed BARBIE dolls in "various absurd and often sexualized positions", where "the public interest in free and artistic expression greatly outweighs its interest in potential consumer confusion about Mattel's sponsorship of [defendant] Forsythe's works").

¹⁶*See* *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *see also* Graeme B. Dinwoodie, *The Story of Kellogg v. National Biscuit Company: Breakfast with Brandeis*, in *INTELLECTUAL PROPERTY STORIES* 220 (Dreyfuss and Ginsburg eds. 2005).

reconceptualize the parody defense, if such an autonomous defense exists, as recognition of the relatively small likelihood that a parody use of a mark would cause confusion on the part of consumers.¹⁷ Similarly, some scholars have aligned the fair use defense with the core objectives of trademark law by arguing that a non-trademark use will not cause confusion in the first place.¹⁸ Indeed, even if the objectives are truly competing—such as free speech and avoidance of consumer confusion in some instance—it might be inaccurate to characterize these additional objectives as departures from linguistic reality. To be sure, they represent a reduction in the solicitude typically shown by trademark law to the preservation of one marketplace function of words, namely, to identify source. But one might equally regard the decision of trademark law to temper its regard for the source-identification function of the word in question as respect for a more complex reality, namely, that the word is also serving other (associative or communicative) functions that also warrant respect.

Thus, one could view these additional considerations as competing or complementary; one could regard the tempering of protection for actual consumer association as either a sign that trademark law is unconcerned with that reality, or that trademark law is paying due regard to the multiple functions that the term is serving. Historically, as a matter of trademark practice, linguistic understandings have been used most directly within the rubrics of consumer association and consumer confusion, such that decisions to derogate from full protection of the source-identifying function are not always evident. But as the multiple uses of trademarks become better understood, and perhaps as those other uses become more economically significant, linguistics may provide the tools to help us better incorporate competing functions that words are in fact serving.¹⁹ Realities matter under either explanation; thus, as regards the protection of word marks, so do the insights that linguistics may have to offer.

2. *Efficiency Calculations*

Alternatively, efficiency calculations common to operation of administrative or judicial schemes may suggest that the law operate with a less calibrated view of reality.²⁰ The costs incurred in order for administrative and judicial institutions to make finely-grained, accurate assessments of consumer understanding, might surpass the social gains that such accurate assessments would capture.

¹⁷See e.g., *Jordache Enterprises v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1488 (10th Cir. 1987); see also Gary Myers, *Trademark Parody: Lessons From the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 J. LAW. & CONTEMP. PROBS. 181, 207 (1996).

¹⁸See, e.g., Stacey L. Dogan & Mark A. Lemley, *Trademark and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004).

¹⁹See *infra* Part III.

²⁰See generally Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004).

Those costs consist in part of the expense involved in adjudicating questions of consumer understanding. In order to contest the issue of secondary meaning, for example, litigants are likely to commission costly surveys of consumer understanding of words. The same is true of the primary enforcement question in trademark litigation, namely, the likelihood of consumer confusion. Although courts have been careful to deny that these studies are *required* in order to make out a trademark case, the existence of a survey is extremely strong evidence on both issues. Indeed, black-letter law in the United States suggests that the absence of a study demonstrating confusion would badly hamper a trademark infringement claim.²¹

If trademark law required courts to make assessments of understandings of words that varied from one group of consumers to another, as detailed linguistic analysis might enable it to do, the costs of litigating infringement suits would become prohibitive. Likewise, if in reflection of such detailed studies of marketplace reality, courts imposed relief requiring producers to use marks differently across different groups of consumers, the costs of doing business would skyrocket. Thus, on the whole, trademark law deals with a rough reality. Classic trademark infringement analysis enjoins third party uses that would confuse an “appreciable number of ordinarily prudent purchasers.”²² Indeed, that purchaser is in large part a legal fiction that implements a vision of the degree of consumer protection regulation that Congress and the courts think appropriate without rendering commerce inefficient.

To be sure, at some relatively high level of generality, trademark law might tailor relief to the realities of a more refined marketplace analysis. Thus, courts have recognized terms as generic in the consumer retail market but acting as a source-identifier in the wholesale market.²³ And the territorial scope of trademark rights means that courts might offer relief in one part of the country (or one country) and not another. But, on the whole, considerations of efficiency require that trademark law make less semantically-precise judgments about the function of words than linguistics might be able to venture.

That said, the starting point of trademark law is an understanding of how words (or other signs) actually work in context. If we can neither prove nor predict that a term will act as a source-identifier for consumers, there is no reason for trademark law to be in play. Linguistics is thus (along with other disciplines, such as marketing or cognitive psychology) one way of establishing the starting point. Indeed, to make calculations about whether the costs of ascertaining precise pictures of reality outweigh the gains of

²¹In the European Union in general, and in the United Kingdom in particular, the courts tend to shy away from surveys. See Jennifer Davis, *Locating the Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law* [2005] IPQ 183. Moreover, recent empirical studies of the multifactor test for likely confusion employed by U.S. courts to determine infringement, surveys are less important than doctrinal statements might suggest. See Beebe, *supra* note 3, at 1640-42.

²²See *Thompson Medical Co., Inc. v. Pfizer, Inc.*, 753 F.2d 208, 213 (2d Cir.1985).

²³See *Bayer Co. v. United Drug Co.*, 272 F.Supp. 505 (S.D.Y. 1921); see also *Dawn Donut Co. v. Hart Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

efficient, rougher justice, one needs to know more about how linguists would find the answer and what form (e.g., how certain, how nuanced, how helpful) that answer would take.

II. Linguistics Reinforcing Lessons for Legal Scholars

The notions of descriptiveness and distinctiveness are both crucial to trademark law. As suggested above, the terms have become legal terms of art. But both terms are words in everyday use. Durant persuasively demonstrates that the terms “descriptive” and “distinctive” can carry a number of quite different meanings when used in their ordinary everyday senses. In particular, both words could imply either value-neutral and value-laden understandings; trademark law, on the whole, would purport not to be making any value judgment about the term for which protection is sought, other than that it serves a particular function.

As Durant acknowledges, this might all mean nothing. After all, one can simply treat the legal understandings as terms of art quite apart from everyday understandings about which linguistics can inform. However, the divergence between common and legal understandings of terms such as “descriptive” and “distinctive” is important because trademark law (through its use of terms that do not *obviously* seem to be terms of art, and its superficially simple consumer protection rationale) is often thought to be quite intuitive. Copyright and patent law are far less intuitive and to the extent that they use key phrases that might seem to be capable of common-sense interpretation the more extensive statutory definitions make clearer that these concepts are terms of art implementing a range of prescriptive choices.²⁴

Showing the *different* understandings of terms such as “descriptive” is important precisely because it highlights that these are, to *some* extent, terms of art carrying more than a common meaning (if there is such a thing). In particular, courts often define the concept of distinctiveness in what might simply be described as “reactive” terms: courts are merely measuring what understanding exists, as one everyday meaning of the term “descriptive” would suggest. Of course, as noted above, much more is going on when a court labels a term “descriptive,” and that determination reflects a number of prescriptive policy choices. Highlighting that even the everyday use of the term “descriptive” is not necessarily value-neutral helps to reinforce a lesson that trademark law badly needs to take on board.²⁵

²⁴Moreover, trademark law often resorts to repositories of common understanding, such as dictionaries, to inform its application and interpretation of the legal term of art. For application, see *Zatarains, supra*. On interpretation, see *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), in which Justice Scalia offered an interpretation of the term “origin” that purported to be informed by everyday linguistic understandings of that term. Of course, perhaps the textualist philosophy of the current Supreme Court may make this concern more acute in a number of areas.

²⁵See Graeme B. Dinwoodie, *Trademark Law and Social Norms*, (Working Paper, March 2007), available at www.ssrn.com.

III. Linguistics Informing the Further Development of Trademark Thought

A. **The Role of Registration Systems**

One of the lessons that linguistics could teach lawyers and which is developed in Durant's paper is that there is less inherent meaning to words than commonly assumed by trademark law, even when coupled with goods or services. Context of use is required to get a grasp on meaning. As Durant neatly puts it, "the combination of signifier and signified as conventional semiotic sign, for trademarks as for all signs, significantly *underdetermines* use." Trademark law does of course already give great weight to context. But perhaps there are still lessons to be learned from heeding Durant's admonition that the functioning of trademarks should be seen as form of "language in use."

For example, this observation might suggest that the tort-based passing off model of preventing consumer confusion is more likely closely to mesh with real consumer understanding, with any analysis of consumer understanding at registration prior to use being too speculative to be useful. A broad reading of Durant's conclusion might question the wisdom of a registration system. A narrow, and better, reading might simply conclude that Durant's observation emphasizes the need to understand the development of registration systems as a function of other social and economic objectives.²⁶

Taking that lesson forward, international lawmakers increasingly focus on lubricating the system of international registration, which tends to favor the adoption and protection of marks that are claimed to be inherently distinctive. (Registration is needed to take advantage of the international protection systems, with the exception of the protection of well-known marks). But debates about the wisdom of registration systems should perhaps be conducted with candid reference to broader economic policy rather than under cover of enhanced protection of consumer understanding.

B. **Permissible Uses**

Another area of trademark law where linguistics may offer insights is with respect to permissible uses. Unlike copyright law, trademark law has historically included very few affirmative defenses. Most permissible uses could be justified because they did not create likely confusion, or (in countries such as the United Kingdom) were not uses in the course of trade. Yet, explicit development of permissible uses is a topic that is beginning to command the attention of courts and legal scholars. And it is likely to continue to do so given expansion in trademark subject matter, broader interpretation of the types of actionable confusion, and the widespread adoption of dilution law. In short, as trademark rights get stronger, the clamor for defenses to permit the continuation of behavior previously outside the scope of trademark law will become greater.

²⁶See Lionel Bently, *The Making of Modern Trade Marks Law: The Construction of the Legal Concept of a Trade Mark (1860-80)* in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE (Lionel Bently, Jennifer Davis & Jane Ginsburg, eds. 2007).

New business models will also make certain referential uses of marks more significant. Increasingly—and this is especially true online—many innovators are seeking to generate profits not by asserting rights in the primary content that they generate and distribute, but by offering content free and instead building business models around the provision of complementary or affiliated goods and services. Complementary products and services will be one of the keys in the economy of the next few years. The ability of competitors to make reference to the mark affixed to primary products and thus to compete in those complementary and service markets will depend upon whether the scope of trademark rights will extend to preclude even very loose senses of affiliation that consumers might develop between the respective goods. But it will also depend on whether trademark law will directly and expressly privilege certain uses that enable competition in those complementary markets.

Moreover, as so much of online activity comes to be framed by the use of search engines that use trademarks rather than content to structure targeted advertising, the regulation of such practices will shape consumer shopping habits and the availability of information about complementary products. It is in this context, in particular, that the purported trademark use requirement (or non-trademark use defense) is being most heavily litigated.

Again, Durant's analysis offers interesting lessons for legal scholars. The function that producers and consumers *want* marks to serve has changed. The mark VIRGIN applied to a telephone may tell consumers that the phone manufacturer in question is striving to appeal to, and values, hip, young tech-savvy consumers. It might also say to other members of the public that the person using the VIRGIN phone is a hip young tech-savvy consumer (even if he is not). Neither function is a classic naming function (as linguists would understand it). But the consumer understanding that has been engendered and that has been embodied in the term VIRGIN clearly comports with what some would call the “modern” notion of a mark, which is moving closer to what the marketing literature would call “brands”.

This evolution might, as Barton Beebe suggests, have come about as a result of the practice of using marks as properties in and of themselves detached from any goods in particular.²⁷ But it might also reflect that consumers no longer value information about the source of goods or even about the physical characteristics or quality of the goods, for which the name of the source vouches. Instead, consumers crave the emotive or associative understandings with which the mark has become imbued. Consumers want to buy “cool NIKE shoes”, not “sturdy NIKE shoes”, let alone “NIKE shoes made by Nike, Inc.” (Sometimes, “sturdy” and “made by Nike, Inc.” can be cool, of course, so these are not bright lines).

Durant astutely observes that, despite the attractions of securing a legally strong mark by adopting a term that is wholly arbitrary or coined, producers have a tendency to select marks at the margin of descriptiveness. They do so because they would like to appropriate not only the source-identifying capacity of the term, but any evocative power

²⁷ See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 U.C.L.A. L. REV. 704 (2004).

that the term might also provide. And, Durant explains, this is best achieved by selecting a mark close to the line between descriptive and suggestive marks. He analogizes the operation of such marks to the “abbreviated description” that Bertrand Russell thought may be active in the case of proper names, “which only denote because of a cluster of descriptions of the bearer activated in the mind, for which the name acts as a kind of shorthand.” As a result, Durant concludes that, when those marks are protected, “protection granted to acquired meaning will encroach into descriptive properties of a sign in which there is a legitimate public interest, as an ‘intellectual common’, unless clear boundaries govern precisely what ‘trade mark use’ (as opposed to more general, public use of protected verbal signs) will be.”

Some might propose, as a result, that descriptive terms should never be protected by trademark law.²⁸ Others might bemoan the strong reading given to the notion of incontestability in U.S. law.²⁹ What trademark law has in fact done, in different ways, is to begin to strengthen defenses to claims of infringement. Indeed, Durant’s conclusion about the operation of marks protected on the basis of secondary meaning supports the decision of the United States Supreme Court in *KP Permanent* that the fair use defense must encompass uses where some confusion is likely.³⁰

²⁸See Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003) (arguing that the First Amendment prohibits protection or registration of descriptive terms).

²⁹See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 201 (1985).

³⁰There is no identical fair use defense as such in EU law. To some extent, any requirement that a plaintiff must allege that a defendant has made a “trademark use” of the plaintiff’s mark in order to mark out a trademark infringement claim under the Trademark Directive might result in similar outcomes. However, it is not clear that the Trademark Directive mandates that the defendant make a trademark use. See Case C-245/02, *Anheuser-Busch, Inc. v. Budejovicky Budvar*, [2004] E.C.R. I-10989 (ECJ 2004) (EU); Case C-206/01, *Arsenal Football Club Plc v. Reed*, 2002 E.C.R. I-10273 (ECJ 2002) (EU); Case C-2/00, *Holterhoff v. Freiesleben*, [2002] E.C.R. I-4187 (ECJ 2002) (EU). In its most recent judgment, the European Court of Justice did not squarely address the argument that infringement depended on a trademark use and held instead that there is a prima facie case of infringement if the defendant’s use “affects or is liable to affect the functions of [the plaintiff’s] trademark.” See Case C48/05, *Adam Opel v. Autec AG*, (ECJ 2007) (EU), 2007 WL 187793, at ¶¶ 22–25. But to the extent that this does state a trademark use requirement, the Court effectively subsumed the trademark use analysis within the broader question of confusion (or antecedent notions of consumer association) by holding that the answer to that question depend upon whether “the relevant consumer perceive[d] the sign identical to the [plaintiff’s] logo appearing on the [defendant’s products] . . . as an indication that those products come from . . . [plaintiff] or an undertaking economically linked to it.” As a result, the European Court appears less willing to sanction permissible uses that cause confusion. Of course, even confusion determinations themselves reflect policy choices regarding permissible levels of confusion. See *Dinwoodie*, *supra* note 25; *Davis*, *supra* note 21. If the European courts were willing to acknowledge that reality, then EU law could approximate the position reached by U.S. law in *KP Permanent* under the rubric of actionable confusion. Alternatively, the European Court could develop a more vibrant version of the defense based on the defendant’s use of the mark in accordance with honest commercial practices. See *Trademark Directive*, *supra* note 5, art. 6. But, here too, the *Adam Opel* Court may suggest little room for judicial development, preferring instead a strict textual interpretation of Article 6 of the Directive. See *Adam Opel*, *supra* (offering relatively limited scope to Article 6 defenses in interpreting the Trademark Directive).

The justification for the fair use defense can easily be expressed in the vernacular of law and economics, the dominant contemporary rationale for U.S. trademark protection: use by a third party of the non-source-identifying (descriptive) aspects of a mark will not increase consumer search costs because such use will not interfere with the mark's source-identifying capacity.³¹ Thus, the fair use defense is intended to ensure that the trademark owner obtains protection not for the word in gross, but only for the source-identifying aspect of the term. This argument operates on the proposition that trademark law is able to separate the source-identifying aspects of the term from the other aspects of the term. However, while Durant appears to endorse this overall view, he nevertheless queries how easily the different aspects of the term can effectively be separated. It might thus be better to acknowledge, as the Supreme Court implicitly did in *KP Permanent*, that “descriptive uses” of trademarks by third parties might be interfere with consumer understandings of the term as a mark, but that such uses are still warranted for the competitive benefits they secure in light of the minimal confusion they cause.³²

Durant's conclusion about the inevitable intermingling of a word's descriptive and naming capacities suggests that the goal of ensuring continued public and competitor access to the functions of a term that do not implicate the legitimate purposes of trademark protection will have to be pursued aggressively. The most aggressive efforts to guarantee these permissible uses have taken the form in several countries of the argument that only a defendant's use of the plaintiff's mark “as a trademark” can give rise to prima facie liability.³³ Alternatively, some courts have begun to question whether certain forms of confusion currently giving rise to liability should be actionable.³⁴

Affording greater scope to affirmative defenses (such as fair use) will also be potentially important.³⁵ This may involve courts articulating more clearly the types of

³¹ See Dogan & Lemley, *supra* note 18, at 810-811.

³² See Dinwoodie & Janis, *Confusion Over Use*, *supra* note 4, at [122, 127-128].

³³ See Dinwoodie & Janis, *Confusion Over Use*, *supra* note 4; see also 1-800 Contacts, Inc. v. WhenU.com, Inc. 414 F.3d 400 (2nd Cir. 2005); Arsenal Football Club v. Reed, [2003] E.T.M.R. 73 (Court of Appeal 2003) (UK) (on remand from European Court of Justice) (merchandising); T v. Dr. R., LG Dusseldorf, No. 2a O 198/02 (Mar. 26, 2003) (Germany) (contextual advertising); Nation Fittings (M) Sdn Bhd v. Oystertec plc, (Singapore H.Ct. Jan. 4, 2006) (product design trade dress claim); Verimark (Pty) Ltd. v. BMW (AG), [2007] SCA 53 (Republic of South Africa, Court of Appeal, May 17, 2007); Case C48/05, Adam Opel v. Autec AG, (ECJ 2007) (EU), 2007 WL 187793; (TA) 506/06 Matim Li v. Crazy Line Ltd., O.M. [2006] (Dist. Ct. Tel Aviv., July 31, 2006) (Israel); R. v. Johnstone, [2004] E.T.M.R. 2 (H.L.) (Eng.); Dyer v. Gallacher, [2006] ScotSC 6 (Glasgow Sheriff Ct.) (Scot.), available at <http://www.bailii.org/databases.html#scot>. Whether a trademark use is required as an element of an infringement case is far from settled. See generally Dinwoodie and Janis, *Confusion Over Use*, *supra* note 4 (discussing US and EU law).

³⁴ See Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005); Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539 (6th Cir. 2005).

³⁵ See *KP Permanent*, *supra*; see also Dinwoodie and Janis, *Lessons*, *supra* note 4 (discussing expansive reading of the fair use defense).

third party uses that should be permitted, either because they only marginally implicate trademark interests or because they substantially affect other important communicative interests. Durant stresses that determining whether a defendant's use has evoked the source-identifying aspect of plaintiff's mark, as opposed to the descriptive properties of that term, can only be done by analyzing the "discourse 'setting' in which interpretations are constructed." He concludes that this involves more than examining the relationship between the sign and the plaintiff's goods; analyzing descriptive "uses" is a more complex assessment than a descriptive "term." More particularly, Durant suggests that attention must be paid to:

dimensions of communication that have received some attention in trade mark law but are arguably less clearly articulated than the sign's semiotic properties. These communicative dimensions include: what genre the trade mark is embedded in (e.g. conventional editorial, such as a news story; name or slogan of an advert; text used in labelling, etc); the level and type of cultural knowledge assumed on the part of the average consumer, as addressee (assumptions about commerce and communication, as well as general-knowledge assumptions that sponsor interpretive inferences); and the adopted mode of address (how the addressee is invited to view the discourse, including who to assume is its author or speaker-persona). How signs work in a given context of use also depends on intention and attribution of intention, as well as on the receiver's interpretive strategy. Enforcement must accordingly be similarly concerned with such aspects of use, if use considerations are not to be some sort of return of the repressed in relation to the semiotic framework that underpins trade mark law.

That is to say, the type of use will be relevant to infringement, but it must be a highly contextualized analysis of use type.

The trademark use requirement—one popular doctrinal candidate for ensuring socially useful third party uses—would deny such analysis, making the entire question (for other reasons, such as the belief that the rule would bring certainty) turn on whether the defendant used the plaintiff's mark "as a mark". For reasons that I have written about at length elsewhere, this is at once too blunt and too uncertain, given contested notions of what is a mark.³⁶ Resolving the extent of permissible uses within the rubric of confusion would offer such context, but current modes of analysis might be inadequate absent adaptation to guarantee permissible uses in the fashion thought necessary, because courts are often to reluctant to acknowledge the prescriptive choices bundled up in confusion analysis.³⁷

³⁶See Dinwoodie and Janis, *Confusion Over Use*, *supra* note 4.

³⁷See Dinwoodie, *supra* note 25; Davis, *supra* note 21.

This leaves the descriptive fair use defense.³⁸ At present, despite the opening provided by the United States Supreme Court in *KP Permanent*, courts have offered a very narrow reading of the defense.³⁹ Trademark lawyers have very little real understanding of what is a “descriptive use” because the issue has in the past been rarely litigated. Durant offers us a linguistic analysis that again might prove extremely useful. He explains that:

The frequency and significance of the word ‘describe’ in ‘non-trade mark use’ or ‘fair use’ defences is notable. This is despite the oddity of the word ‘describe’ in this context, since it can hardly be to do with specific properties of the goods. More likely in this context is one of the other senses of ‘describe’ and ‘descriptive’ outlined above: that of asserting something that may be true or false, or in some other way commenting rather than naming. The defendant’s use of the plaintiff’s mark is said to ‘describe’ the plaintiff’s product or to ‘describe’ their own product, rather than being an infringing use. This is a sense closer to ‘general communicative use’, and contrasts with specifically ‘naming’ use.

This is a much broader reading of the term “descriptive” than courts have offered, purporting to read fair use defenses quite literally. But, as Durant stresses, the term “descriptive” is an odd choice. That ambiguity allows rooms for the type of broad interpretation that Durant advances, building also on our earlier observation about the complex linguistic understanding of the term in the context of establishing rights.⁴⁰

Indeed, Durant concludes with discussion of linguistic classification that might provide focus to the more general approach suggested above. In particular, the divide in linguistics between “use” and “mention” or “reference” might be really helpful as we begin to develop an understanding of the types of use that should be permitted; our current legal vocabulary is very unhelpful. Interpreting the successful arguments of the defendant in *The Joy of Six* case, Durant suggests that:

‘The Joy of Six’ was viewed as being, in effect, a kind of quotation, the sort of echoic effect that a linguist might classify as ‘mention’ (or ‘interpretive use’) rather than mainstream ‘use’. What distinguishes ‘mention’ from ‘use’ in linguistics is that, in mention (or interpretive use), the speaker utters something as if with inverted commas round it, or quotes specific wording or seems to attribute chosen words to another

³⁸See Trademark Directive, *supra* note 5, art. 6; 15 U.S.C. § 1115(b)(4).

³⁹See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596 (9th Cir. 2005) (calling for courts to analyze, among numerous other contextual factors, “the degree of likely confusion. . .”); see also *Adam Opel*, *supra*.

⁴⁰It is important for the full vitality of defenses under U.S. law that courts can find a broad reading of descriptive uses, because the descriptive fair use defense is one of only a few defenses preserved after a plaintiff’s mark becomes incontestable. See *Dinwoodie and Janis, Lessons*, *supra* note 4; see also *Adam Opel*, *supra*.

voice. In doing so, the speaker seems to stand aside from the utterance, disclaiming or distancing herself from rather than affirming or certifying *in propria persona* what is said

This concept may be valuable because the concept of mention subsumes a number of ordinary everyday conversational uses of marks that we assume to properly be outside the the control of trademark owners, as well as parodic uses that have been vindicated in prior case law.

Conclusion

Linguistics has a lot to teach trademark law. It is surely a discipline relevant to the practice of trademark law. But, perhaps more importantly, linguistic understanding of key terms of art in trademark law illustrates the inevitable prescriptive content of supposedly descriptive assessments of trademark claims. And concepts that linguists have developed to classify and explain the use of language may prove helpful in providing a framework in which trademark law can grapple with developing rules that address the multiple functions that trademarks now serve.