The Death of De Facto Secondary Meaning

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ABSTRACT

A trademark is created when a new meaning is added to an existing word or when a new word is invented in order to identify the source of a product. This Article contends that trademark law fails in critical ways to reflect our knowledge of how words gain or lose meaning over time, and how new meanings become part of the public lexicon, a phenomenon commonly referred to as semantic shift. Although trademark law traditionally turns on protecting consumers from confusing ambiguity, some of its doctrines ignore consumer perception in whole or in part. For example, the doctrine of trademark incapacity – also known as the de facto secondary meaning doctrine – denies trademark protection to a term that was once a generic product designation, even if consumers now see the term as a source signifying trademark.

Analyzing trademark acquisition through the lens of semantic shift sheds light on how the trademark incapacity doctrine misunderstands both the nature of language and the role of consumer perception in shaping trademark’s competition policy. Courts and scholars suggest a generic term will rarely acquire source significance, and even if it does, there are competitive, conceptual, and administrative grounds for denying trademark protection. The standard account is mistaken: restriction of meaning – like the change from a generic product designation to a source signifier – happens frequently across time and across languages. In addition, understanding how and why restriction occurs highlights flaws in common justifications for trademark incapacity. Recognizing how language changes will enable effective legal reform that better reflects the consumer protection and competition concerns at the heart of the trademark

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system. To that end, this Article proposes replacing the doctrine of trademark incapacity with the primary significance test already applied at other stages of trademark litigation.

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INTRODUCTION

A term that designates a singular source for goods and services, rather than the goods themselves, qualifies for protection as a trademark. Trademark law thus turns in large part on when a word or symbol acquires and loses source-signifying meaning in the eyes of consumers. While linguistics – the study of symbols and their meanings – has made limited inroads in the analysis of trademark law and policy,¹ the existing scholarship has yet to mine a cornerstone

¹ See, e.g., Barton Beebe, The Semiotic Analysis of Trademark Law, 51 UCLA L. REV. 621, 624 (2004) (hereinafter Beebe, Semiotic) (applying a branch of linguistics, semiotics – the study of signs – to trademark law, and arguing that the
concept in linguistics: semantic shift. The study of semantic shift in historical and cognitive semantic literatures is the study of how a given word changes over time – first by entering the public lexicon, and then by gaining or losing meanings. These new words and meanings enter the lexicon as speakers search for new ways to express themselves. As Professor Stephen Ullmann recognized half a century ago, “The need to find a new name is [ ] an extremely important cause of semantic changes.”

Trademark acquisition is also a form of semantic shift. Like semantic shift, investing a trademark with meaning adds a new entry to the commercial lexicon. The process of creating a trademark shares many of the same characteristics as other types of semantic shift. For instance, sometimes source-signifying meaning is added to an

“grammar [of trademark law] must be understood not simply in economic, but also in linguistic terms”), Laura A. Heymann, The Grammar of Trademarks, 14 LEWIS & CLARK L. REV. 1313, 1320-21 (2010) (arguing that incorporating linguistic theory on language formation can help trademark law better reflect consumers’ perceptions of language); Thomas R. Lee, Eric D. DeRosia, & Glenn L. Christensen, An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness, 41 ARIZ. ST. L.J. 1033, 1068-69 (2009) (applying psychological and brand perception literature to challenge Beebe’s semiotic analysis); Regan Smith, Note, Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007) (applying semiotic theory to argue for reforming the scandalous marks prohibition in trademark law); Graeme B. Dinwoodie, What Linguistics Can Do For Trademark Law, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 140, 157 (J. Ginsburg, L. Bently & J. Davis eds., 2007) (arguing that while trademark law should not become beholden to linguistics, linguistic principles are somewhat embedded in trademark law, and linguistic theory can provide a means for uncovering “the inevitable prescriptive content of supposedly descriptive assessments of trademark claims”); Alan Durant, How Can I Tell the Trade Mark on a Piece of Gingerbread from All the Other Marks On It? Naming and Meaning in Verbal Trade Mark Signs, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 107, 132 (J. Ginsburg, L. Bently & J. Davis eds., 2008) (suggesting that pragmatics and discourse analysis, the branches of linguistics that investigate language in use, are most likely to contribute to our understanding of the important issues in trademark law).

Other scholars refer to these phenomena as semantic change, semantic progression or semantic drift. See e.g., ELIZABETH CLOSS TRAUGOTT & RICHARD B. DASHER, REGULARITY IN SEMANTIC CHANGE 1 (2002) (semantic change is a shift “from one linguistically coded meaning to another.”).

Stephen Ullmann, Semantics: An Introduction to the Study of Meaning 209-10 (1957) (hereinafter Ullmann, Semantics) (“Whenever a new name is required to denote a new object or idea, we can do one of three things: form a new word from existing elements; borrow a term from a foreign language or some other source; lastly, alter the meaning of an old word.”)

Ullmann, supra note 3 at 210.
existing word. The Beatles plucked APPLE from among many pre-existing options as a trademark for their record label, while Steve Jobs and Steve Wozniak picked APPLE as a trademark for personal computers. Trademark creation also overlaps semantic shift when a new word is created to sell a product or service. The word XEROX did not exist before it was coined as a designation for photocopiers. In either case, language changes to accommodate new terms or new meanings for existing terms. Thus, incorporating theories of semantic shift into trademark law will clarify how consumers process changes in language as a trademark is acquired, matures, and sometimes expires. Theoretical and cognitive findings regarding how language changes, and how speakers and listeners process linguistic ambiguity, apply in helpful ways to the trademark regime at every phase in the lifecycle of a trademark. This Article focuses on the semantic shift that occurs as a particular term acquires source-signifying meaning.

Trademark acquisition is often understood by considering the relationship between the claimed mark and the word(s) in the lexicon from which it was derived. That relationship is mapped out along a spectrum of inherent strength, most famously articulated in *Abercrombie & Fitch Co. v. Hunting World, Inc.* At each stop on the *Abercrombie* spectrum, a mark is treated as inherently protectable or not based on intuitions of how likely consumers will be able to invest it with source-signifying meaning. While scholars have criticized the *Abercrombie* spectrum as inaccurate, or an unwelcome distraction from more crucial inquiries, these categories generally reflect regular forms of semantic shift. But the synchronicity between theories of semantic shift and the legal reality of trademark acquisition breaks down when we reach the treatment of “generic” terms – words that identify or identified a good or service – that have subsequently acquired source-signifying meaning. Under the doctrine of “trademark incapacity,” courts dismiss evidence that consumers perceive a term as source signifying, cabining said evidence as an

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5 537 F.2d 4 (2d Cir. 1976).
6 See infra Part II.B; Linford, Semantic Shift and the Abercrombie Spectrum (on file with author).
7 Louis Altman coined the phrase “trademark incapacity.” LOUIS ALTMAN & MALLA POLLACK, CALLMANN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:33. This process goes by other names, including the better known but unwieldy “de facto secondary meaning doctrine.” This article primarily uses trademark incapacity.
indication merely of de facto – *i.e.*, legally insignificant – secondary meaning.\(^8\)

The doctrine of trademark incapacity is inconsistent with semantic shift in one of its most standard formations: *restriction*. When a word is restricted, it undergoes a shift in meaning from a broad designator for any of a number of things within a category, to a prototypical member of the category. For example, *hound* once meant any kind of dog, but the meaning has been restricted to long-eared hunting dogs.\(^9\) A generic term acquiring source significance is another manifestation of restriction in meaning, but the doctrine of trademark incapacity requires ignoring restriction when it happens.

Why does the law ignore evidence of restriction? Courts and scholars have suggest that the restriction of a generic term to a source signifying meaning happens infrequently. If this were so, then we might prevent costly error by ignoring the occasional case where a generic term undergoes restriction. This assumption, however, is incorrect. The case law provides multiple examples where courts have ignored evidence that consumers perceive an ostensible generic product designation as a source-signifying trademark.\(^10\) In addition, the best analysis of the historical record to date makes plain that restriction happens frequently – indeed, more frequently than any other form of semantic shift.\(^11\) The doctrine of trademark incapacity thus increases the risk of costly error by ignoring evidence of consumer perception solely because the term at issue was once generic.

It might nevertheless be appropriate to eschew an inquiry into whether a generic designation has acquired source significance if refusing to recognize de facto secondary meaning prevented other serious harms. Scholars and courts have identified several interlaced justifications for applying trademark incapacity to generic word marks: concerns about granting mark owners monopoly power or causing language depletion; a general distrust of trademark-owning incumbents; an application of the functionality doctrine due to a

\(^8\) *Abercrombie*, 537 F.3d at 9 (describing a generic term as “one that refers, or has come to be understood as referring, to the genus of which the particular product is a species” and holding that proof of source significance in the eyes of consumers, “by virtue of which some ‘merely descriptive’ marks may be registered, cannot transform a generic term into a subject for trademark.”).

\(^9\) See infra notes 166, 180, 190-191, 207 and accompanying text.

\(^10\) See infra Part I.B.

\(^11\) See infra Part II.C.
perception that generic terms are immutable like more tangible essential product features; or a fear of increasing consumer search costs.12 Understanding how trademark acquisition should fit within the broader phenomena of semantic shift provides an avenue for refuting those justifications.13

The Article proceeds in three Parts. Part I outlines trademark law’s commitment to consumer search and consumer perception, before turning to the conflict between that ostensible commitment and the doctrine of trademark incapacity. Scholars have offered critiques of trademark incapacity, recognizing the problem of ontological rejections of source significance, without providing a theory for why it is important to acknowledge language change in the ex ante generic context as well as in other contexts. Part II offers such a theoretical basis, beginning with a brief discussion of the motivations for semantic shift before describing how trademark acquisition is a form of semantic shift. While trademark law reflects many regular forms of semantic shift, the doctrine of trademark incapacity drives a wedge between trademark acquisition and the broader phenomenon of semantic shift. The shift of a generic term to a source-signifying trademark is an example of restriction, the most frequently occurring form of semantic shift, and one that increases the information conveyed the restricted form.14 Part III makes the case for abandoning the doctrine of trademark incapacity in favor of the primary significance test already applied in cases of an ex post slide into genericness.

I. CONSUMER PERCEPTION AND TRADEMARK INCAPACITY

The dominant rationale for trademark protection is reducing consumer search costs.15 Protecting a trademark as a source signifier allows the mark to signify that trademarked products originate from a single seller.16 Consumers can thus rely on the trademark to identify products they wish to buy, which reduces the cost of finding those

12 See infra Part I.C.
13 See infra Part III.A.
15 Cf. Greg Lastowka, The Trademark Function of Authorship, 85 B.U. L. REV. 1171, 1241 n.93 (2005) (“[I]f trademark law were to abandon consumer benefit as a foundation, there could simply be no plausible theoretical foundation for trademark regulation.”).
products. Although scholars have criticized the consumer search cost account, it currently remains the dominant rationale for trademark protection. While there are other accounts justifying trademark protection, this article will critique trademark incapacity from within the dominant account.

Questions of whether a trademark qualifies for protection and whether a trademark has been infringed are answered by assessing consumer perception. Some trademarks are treated as inherently capable of distinguishing the goods or services of one producer from those of others, and it is presumed the consumers see them as source signifying. Other trademarks are designated as merely descriptive of some quality or feature of the product or service, and protection extended only if the mark acquires a secondary, source-signifying meaning.

Distinguishing a term that is merely descriptive (and is thus unprotectable) from one that in inherently distinctive or has acquired secondary meaning (and is thus protectable) requires assessing whether consumers better understand a given term to describe a

17 See, e.g., Jeremy N. Sheff, Biasing Brands, 32 CARDOZO L. REV. 1245 (2011) (arguing that psychological and marketing research can manipulate consumer perception, weakening the consumer search account); Mark P. McKenna, Trademark Use and the Problem of Source, 2009 U. ILL. L. REV. 773, 821 (criticizing the failure of the consumer search cost theory to limit the expansion of trademark rights); Barton Beebe, Search and Persuasion in Trademark Law, 103 MICH. L. REV. 2020, 2025 (2005) (proposing two varieties of consumer sophistication: search sophistication, the ability of consumers to distinguish between similar trademarks; and persuasion sophistication, their capacity to choose products independently of marketer influence).

18 See, e.g., Jake Linford, Trademark Owner as Adverse Possessor, 63 CASE W. RES. L. REV. 703 (2013) (describing how trademark law bases protection on the productive use by the mark owner); Mark P. McKenna, The Normative Foundations of Trademark Law, 82 NOTRE DAME L. REV. 1839, 1841 (2007) (arguing that “trademark law, like all unfair competition law, sought to protect producers from illegitimate diversions of their trade by competitors.”).

19 G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 873 F.2d 985, 995 n.10 (7th Cir. 1989) (“[C]onsumer perception should be measured by considering the mark as applied to the product in question and the reaction of the consumer audience to which the trademark is directed in the marketplace.”) (internal citations omitted); In re Bayer Aktiengesellschaft, 488 F.3d 960, 966 (Fed. Cir. 2007) (discussing the use of online resources to determine consumer perception); Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1395 (9th Cir. 1993) (“Consumer perceptions are relevant in determining whether a non-inherently distinctive mark has acquired secondary meaning and should therefore be treated as a strong mark.”) (internal citations omitted).

20 See infra notes 153-154 and accompanying text.
characteristic of a product, or to signify the source of the product itself. It is the perception of “the average potential consumer in the context of the existing marketplace and exposed to the information currently available in the marketplace” that matters most in assessing whether a mark merits protection, or whether confusion has occurred.

Trademark law likewise aims to prevent or correct “confusion among consumers regarding the origin of the goods [or services] offered” to the public. When a junior user adopts a mark identical or sufficiently similar to the mark of a senior user, to identify the same or similar products or services, consumer confusion can result. That confusion can increase consumer search costs. Trademark law thus bars not only the use of a mark identical to that of the senior user, but also use of a mark that is confusingly similar to the senior user’s mark. The next Section describes how some trademark doctrines ignore evidence of consumer perception in a manner inconsistent with this goal of preventing consumer confusion.

A. Trademark Law’s Disconnect from Consumer Perception and Consumer Confusion

While the dominant rationale for trademark protection is to prevent consumer confusion, there are aspects of trademark law surprisingly disconnected from consumer perception. For example, in cases that turn on whether a putative trademark has acquired secondary meaning, one might imagine that courts would require

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23 See, e.g., Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539, 551 (6th Cir. 2005); Ann Bartow, Likelihood of Confusion, 41 San Diego L. Rev. 721, 722 (2004) (“Confusion among consumers is the grave iniquity against which trademark laws and jurisprudence are intended to guard”).
24 Stacey L. Dogan & Mark A. Lemley, The Merchandising Right: Fragile Theory or Fait Accompli?, 54 Emory L.J. 461, 482 (2005) (“An infringement of a trademark is one that increases consumer search costs, normally by confusing consumers.”).
25 James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 274 (7th Cir. 1976) (“The trademark laws exist not to ‘protect’ trademarks, but, as above indicated, to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.”)
evidence of consumer perception. Courts instead lean heavily on evidence of what the producer has done “to impress his identity or that of his goods upon the purchasing public,” and grant protection or relief to mark owners without direct evidence of consumer confusion. Fact-finders may consider direct testimony, survey evidence, and proof of actual confusion, but none of these are actually required to establish likelihood of confusion, even though courts sometimes state that consumer surveys are “the most direct evidence” of secondary meaning. In fact, secondary meaning surveys are often seen as problematic. Courts openly express concern that experts are frequently capable of obtaining the results they seek with survey evidence. While secondary meaning is defined as “trademark significance to the public,” the fact-finder is nevertheless permitted to look exclusively at the producer’s efforts when determining whether a mark is source signifying, and thus protectable. Fact-finders may consider evidence of length of the owner’s use, the manner in which the mark was used, the nature and extent of advertising efforts, and other efforts made to promote a connection, in the minds of consumers, between the mark and a single

(“Secondary meaning is the connection in the consumer’s mind between the mark and the product’s producer, whether the producer is known or unknown.”).

28 See, e.g., Premier-Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754, 760 (D. Conn. 1935) (noting that testimony from members of the public or retailers on the question of acquired distinctiveness “is evidence of slight weight” due to problems of sample size and bias).

29 Id.

30 Durant, supra note 1 at 116.

31 See, e.g., Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 1583 (Fed. Cir. 1988) (TTAB’s decision that applicant’s design for guitar peg heads acquired secondary meaning was not clearly erroneous, even though “the record is lacking in direct evidence of consumer testimony or perceptions as to whether the specific guitar heads employed by Hoshino function as significant indications of source”).


33 See, e.g., Maya Alexandri, The International News Quasi-Property Paradigm and Trademark Incontestability: A Call For Rewriting the Lanham Act, 13 HARV. J.L. TECH. 303, 347 (2000) (citing several cases for the proposition that secondary meaning surveys “are often a statistical joke.”).

34 Indianapolis Colts, Inc. v. Metro. Baltimore Football Club Ltd. P’ship., 34 F.3d 410, 414-15 (7th Cir. 1994) (Posner, C.J.) (“The battle of experts [over consumer surveys in trademark disputes] is frequently unedifying. Many experts are willing for a generous (and sometimes for a modest) fee to bend their science in the direction from which their fee is coming.”) (internal citations omitted).

source. The same holds true for likelihood of confusion analysis, although recent empirical research also suggests that surveys are introduced into evidence in a surprisingly small number of cases.

This ostensible disregard for consumer comprehension manifests in another way at trademark creation. Trademark law has developed a doctrine of “trademark incapacity.” If a court concludes the mark was ever a generic term for the type of product or good sold, any source-signifying meaning is dismissed as mere “de facto secondary meaning” bearing no legal significance. A term the court concludes is generic ex ante cannot acquire trademark protection, even if consumers have come to perceive it as a source-signifying mark. The next Section describes the doctrine of trademark incapacity and explains how that doctrine is disconnected from the consumer search and consumer perception justifications for trademark law.

B. Trademark Incapacity

Under the doctrine of trademark incapacity – also called the doctrine of de facto secondary meaning – a term which is generic ex ante for a genus of goods or services cannot be transformed or claimed by the commercial behavior that typically provides a basis for acquiring secondary meaning. As stated by the court in

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36 RESTATEMENT (THIRD) UNFAIR COMPETITION § 13 cmt. c; Altman and Pollack, 3 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES, § 20:29.
38 Robert C. Bird & Joel H. Steckel, The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts, 14 U. PA. J. BUS. L. 1013, 1035 (2012) (reporting that “[o]ut of the 533 cases reviewed … only eighty-nine (16.6%) discuss survey evidence … [which] seem[s] to contradict the exhortation by some courts and commentators that consumer survey evidence is necessary or even strongly recommended to prove trademark infringement”). Surveys may drive outcomes in likelihood of confusion analysis only when other evidence is mixed. Id. at 1041-43
39 See CALLMAN § 20:33.
41 See, e.g., In re Minnetonka, Inc., 212 U.S.P.Q. 772, 782 (T.T.A.B. 1981) (defining a generic term as one “so highly descriptive that no quantum of evidence of acquired distinctiveness is sufficient to qualify it for registration under Section 2(f).”). See also REST. 3d UNFAIR COMPETITION § 15, cmt. b (year) (“[T]he public interest in maintaining access to generic terms precludes the recognition of trademark rights”).

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Abercrombie & Fitch Co. v. Hunting World, Inc.,\textsuperscript{42} generic terms, which “refer, or ha[ve] come to be understood as referring, to the genus of which the particular product is a species,” cannot acquire trademark protection.\textsuperscript{43} The rationale for trademark incapacity, as stated in Abercrombie, is that “no 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.”\textsuperscript{44}

While “descriptive” symbols can acquire secondary meaning, the trademark incapacity doctrine denies protection to a term that has ever served as a product designation, even when the term has developed actual (de facto) secondary meaning among consumers.\textsuperscript{45} Evidence that consumers have come to understand the term as a trademark is discounted. This bar against a generic term acquiring distinctiveness is easiest to understand at the extreme. For example, there should be little concern about a hypothetical attempt by a seller of computers to secure COMPUTER as a mark for its goods. It is in fact difficult to imagine that a producer could persuade a critical mass of consumers that COMPUTER designates only the computers marketed by that particular producer.

There are, however, many cases where semantic shift has been measured, secondary meaning acquired, and evidence of consumer perception nevertheless ignored. For example, in Harley Davidson v. Grotanelli, the court marshaled the ex ante bar in dismissing evidence that 98% of consumers viewed the term HOG as a source signifier for Harley-Davidson’s motorcycles, rather than a generic designation for large motorcycles.\textsuperscript{46} In another case, Hotels.com, L.P., applied to register HOTELS.COM as a service mark for its online hotel booking services.\textsuperscript{47} Hotels.com presented survey evidence indicating that 76% of respondents identified HOTELS.COM as a brand name instead of a common or generic name. Concluding that the HOTELS.COM

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\item \textsuperscript{42}537 F.2d 4 (2d Cir. 1976).
\item \textsuperscript{43}Id. at 9.
\item \textsuperscript{44}Id.
\item \textsuperscript{45}A.J. Canfield Co. v. Honickman, 808 F.2d 291, 304 (3d Cir. 1986) (“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.”).
\item \textsuperscript{46}See also infra note 177 and accompanying text.
\item \textsuperscript{47}In re Hotels.com, L.P., 573 F.3d 1300, 1301 (Fed. Cir. 2009).
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\end{footnotesize}
mark could not be registered, the Trademark Trial and Appeal Board discounted the survey. The TTAB reasoned that “consumers may automatically equate a domain name with a brand name,” affirming the decision to refuse registration because hotels must be a generic designation for the provision of hotel booking services, and adding .com could not change that reality. The Board noted, however, that should the applicant persuade a court on appeal that the mark was not ex ante generic, Hotels.com, L.P. had presented sufficient evidence of acquired distinctiveness to support registration. Thus, the Board’s determination of ex ante genericness was fatal to registration of the mark even in the face of otherwise persuasive evidence of secondary meaning.

Additionally, compound words often tempt courts to invoke the ex ante bar, despite the well-established rule that trademarks are protected as a whole and thus should be evaluated as a whole. A court should not break the mark at issue down into its component parts when determining whether the mark qualifies for trademark protection. For example, in Union Carbide Corp. v. Ever-Ready Inc., the Second Circuit found the decision by the district court to break the EVEREADY mark down into its component pieces was clearly erroneous. Nevertheless, courts continue to apply the ex ante bar to compound marks whose components appear clearly generic or “highly descriptive,” even if the compound term itself has not been


Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark. In those rare instances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a TLD, such as “.com,” “.net,” etc. In those unusual circumstances, the addition of the TLD can show Internet-related distinctiveness, intimating some “Internet feature” of the item.

49 Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366 (7th Cir. 1976).

50 Id. at 370 (“Dissecting marks often leads to error. Words which could not individually become a trademark may become one when taken together.”).

51 Under § 2(f) of the Lanham Act, a descriptive term can be presumed to have acquired distinctiveness upon a showing of five years of “substantially exclusive and continuous use.” 15 U.S.C. § 1052(f). That presumption was historically relaxed for marks that are “so highly descriptive” they were deemed incapable of acquiring secondary meaning. See e.g., In re Institutional Investor, 229 U.S.P.Q. 614, 617-18 (C.C.P.A. 1966) (affirming decision by the examiner that the mark INTERNATIONAL BANKING INSTITUTE for international banking seminars was “so highly descriptive or generic that it is utterly incapable of functioning as a
used to designate the product in the past. For example, in *J. Canfield Co. v. Honickman*, the Court of Appeals for the Third Circuit held that the term CHOCOLATE FUDGE for soda was generic for a rich, chocolate-flavored soda, although CHOCOLATE FUDGE had never before been used in that combination for that purpose. Likewise, TURBODIESEL was held generic for diesel engines even though the compound had not previously been used by competitors or consumers.

At its extreme, the doctrine of trademark incapacity is absurd. In the middle ages, “code” was a term both for a baptism robe or chrism cloth, and for pitch or cobbler’s wax. These meanings are obsolete and have been for centuries. It would thus be odd for a court to conclude that CODE is generic if used as a trademark for baptistery clothing or for a sealant, even though as a historical matter “code” was once a term used to describe both things, and the trademark incapacity doctrine could apply to such a mark.

Although the trademark incapacity doctrine has not been uniformly applied, the exceptions prove the rule. On occasion, the Trademark Trial and Appeal Board has recognized acquired trademark or acquiring distinctiveness, no matter what quantity of evidence of alleged distinctiveness or secondary meaning is submitted.”). Some opinions suggest a relationship between the descriptiveness of the proposed mark and the proof required to establish secondary meaning. See, e.g., Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 1581 (Fed. Cir. 1988) (“[T]he more descriptive the term, the greater the evidentiary burden to establish secondary meaning”), quoting 1 McCarthy, § 15:10, at 683.

The CHOCOLATE FUDGE case was a close call. The Seventh Circuit initially affirmed a preliminary injunction against a competitor’s use of the CHOCOLATE FUDGE designation, A.J. Canfield Co. v. Vess Beverages, Inc., 796 F.2d 903 (7th Cir. 1986), but later held that collateral estoppel precluded reconsideration of the Third Circuit’s finding of genericness. See 859 F.2d 36 (7th Cir. 1988). The Third Circuit created its own genericness test outside of the primary significance test:

We might call it a new product test, but it posits that when a producer introduces a product that differs from an established product class in a significant, functional characteristic, and uses the common descriptive term of that characteristic as its name, that new product becomes its own genus, and the term denoting the genus becomes generic if there is no commonly used alternative that effectively communicates the same functional information.


distinctiveness in a formerly generic term. For example, in an unpublished opinion, the TTAB reversed a refusal by the Trademark Office to register the mark KISSES for chocolate candy. 56 There, the Board recognized that Hershey Foods Corp. had acquired distinctiveness in KISSES for chocolate candy, building up secondary meaning over 90 years. 57 This secondary meaning was reflected in a survey where 80 percent of respondents identified KISSES as a trademark. 58 Secondary meaning was recognized despite substantial evidence amassed by the examiner indicating that kiss started out as a generic designation for a small piece of confectionery or chocolate candy. 59

There is at least one other limited exception to the trademark incapacity doctrine. Marks that lose protection because of a slide into genericness have occasionally reacquired distinctiveness and thus regained protection. Both SINGER for sewing machines and GOODYEAR RUBBER for “goods produced by the processes known as Goodyear’s invention” were found generic by the Supreme Court in the 19th century, 60 but secondary meaning was reacquired in both marks in the 20th century. 61 These trademark resurrection cases are perhaps outliers, because such restorations have occurred infrequently. 62 The trademark resurrection cases nevertheless indicate that the ex ante bar is not uniformly applied, at least in cases

56 In re Holmstead, Inc., No 75/183,278 (TTAB Apr. 2000).
57 Id. at 11.
58 Id. at 8. As the Board noted, 16.5 percent of respondents identified the KISSES mark as a generic term, compared with 9 percent who identified MILK DUDS as a generic term, and 4.4 percent who identified M&M’s as a generic term.
59 Id. at 4. See also Hershey Co. v. Promotion in Motion, Inc., CIV.A. 07-1601 SDW, 2011 WL 5508481 (D.N.J. Nov. 7, 2011) (unpublished) (“Hershey’s multiple Teflon surveys offering direct evidence of the primary significance of KISSES as a brand to consumers” lead the Court to conclude “that a reasonable fact finder could not find the KISSES mark generic.”).
61 Singer Mfg. Co. v. Briley, 207 F.2d 519, n.3 (5th Cir. 1953) (affirming district court decision that “by the constant and exclusive use of the name ‘Singer’ in designating sewing machines and other articles manufactured and sold by it and in advertising the same continuously and widely—recaptured from the public domain the same ‘Singer’”); Goodyear Tire & Rubber Co. v. H. Rosenthal Co., 246 F. Supp. 724, 729 (D. Minn. 1965) (holding that while the Supreme Court found “Goodyear Rubber” was descriptive and could not be appropriated as a trademark, that case had “no bearing on the issue of secondary meaning.”).
62 Deven R. Desai & Sandra L. Rierson, Confronting the Genericism Conundrum, 28 CARDOZO L. REV. 1789, 1832 (2007); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:30 (4th ed.).
where the mark acquired secondary meaning before falling into
genericness. The trademark incapacity doctrine thus appears not to
consistently reach marks that held secondary meaning before they
became generic.

Why apply the doctrine of trademark incapacity? The next
Section summarizes standard justifications for trademark incapacity
as well as critiques of the doctrine. This summary lays the
groundwork for a discussion in Part II of what theories of semantic
shift can teach us about trademark acquisition.

C. Standard Justifications for and Prior Critiques
   of Trademark Incapacity

The standard justifications for trademark incapacity,
discussed in more detail in Part III.A infra, fall into five overlapping
categories. First, granting protection in “the common name of an
article” has the potential to provide the first entrant with something
approaching monopoly power to sell that product.63 This concern is
sometimes articulated as unease about “language depletion,”64 that
too many common terms might be appropriated as property, leaving
the public and competitors with too few ways to say what they need
to. Trademark protection of a formerly generic term may thus increase
the cost for competitors and new entrants to communicate with
consumers.65 Second, trademark incapacity turns in part on a distrust
of trademark-owning incumbents.66

63 See, e.g., Am. Aloe Corp. v. Aloe Creme Labs., Inc., 420 F.2d 1248, 1252 (7th
Cir. 1970). See also infra notes 203, 211-216 and accompanying text.
64 See e.g., New Kids on the Block v. News Am. Publ’g Inc., 971 F.2d 302, 306 (9th
Cir. 1992) (stating that generic trademarks receive no protection and that the holder
of such a mark receives no exclusivity in the generic mark, to allay “fears that
producers will deplete the stock of useful words by asserting exclusive rights in
them”). But cf. Qualitex, 514 U.S. at 169(rejecting a similar “color depletion” theory
as a basis for denying trademark protection for the use of a particular color on a
good).
65 Laura R. Bradford, Emotion, Dilution, and the Trademark Consumer, 23
66 Professor McCarthy has theorized that courts may apply trademark incapacity out
of fear that producers will succeed in securing trademark rights in generic names
“based on shaky and unreliable evidence of customer perception.” 2 MCCARTHY
ON TRADEMARKS AND UNFAIR COMPETITION § 12:47 (4th ed.). Cf. Barton Beebe,
(raising questions about the “persuasion sophistication” of consumers). See also
infra notes 217-223 and accompanying text.
Third, the trademark incapacity doctrine is seen by some as a facet of the functionality doctrine, which bars trademark protection in product features that are essential elements of a given product. Fourth, if a legitimate shift from a generic term to a source-signifying trademark happens rarely, the trademark incapacity doctrine might serve as a prophylactic rule which prevents the courts from erroneously finding a source-signifying shift that doesn’t exist while avoiding the administrative costs that come with a costly inquiry into the alleged change. Fifth and finally, protecting generic terms may increase consumer search costs because, in the words of one opinion, a generic term may “communicate more information about the product to consumers, thus” using the generic term will “lower[ ] consumer search costs.”

Competition policy is often seen as directly connected with lowering consumer search costs, but competition policy and consumer confusion can pull in different directions. In almost any case, some consumers are confused. Trademark law nevertheless ignores the confusion of those consumers unless the mark has sufficient distinctiveness to justify concluding that many consumers see it as source signifying, or in cases where the limited numbers of consumers have testified of confusion but a plaintiff’s case is otherwise not particularly strong. Thus, even if some consumers are confused by multiple uses of a generic term because they have come

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69 Union Nat. Bank of Texas, Laredo, Tex. v. Union Nat. Bank of Texas, Austin, Tex., 909 F.2d 839, 847 n.18 (5th Cir. 1990). See also Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431, 1442 (3d Cir. 1994) (“What is ‘generic’ in trademark law is a word with so few alternatives (perhaps none) for describing the good that to allow someone to monopolize the word would debilitate competitors.”).
70 See, e.g., Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 14 (1st Cir. 2008); Stacey L. Dogan & Mark A. Lemley, Grounding Trademark Law Through Trademark Use, 98 TRADEMARK REP. 1345, 1373-74 (2008) (“[T]he ultimate purpose of reducing consumer search costs is to facilitate the operation of [the] marketplace. If trademark law interferes with competition, trademark law must give way, or it will end up destroying the village in order to save it.”).
to see the term as source signifying, competition law might require tolerating some level of confusion\textsuperscript{72}

Critiques of trademark incapacity have taken different positions on the justifications outlined above.\textsuperscript{73} Scholars like Graeme Dinwoodie have noted the problem of handling trademarks ontologically.\textsuperscript{74} Indeed, the doctrine of trademark incapacity empowers a court to “assume that which is to be decided” in the words of Professor McCarthy.\textsuperscript{75} But even Professor McCarthy falls prey to the mistaken notion that a shift from a generic designation to a source-signifying designation is, by nature, vanishingly rare.\textsuperscript{76} Louis Altman, another treatise writer, urges courts to inquire whether “there has been a complete transformation of [generic into source-signifying] meaning,”\textsuperscript{77} in essence requiring a complete abandonment of any generic meaning before secondary meaning can be recognized.

Some critics see genericness and source significance, or secondary meaning, as flip sides of the same coin.\textsuperscript{78} This binary view of genericness and secondary meaning misapprehends the issue. As discussed in more detail in Part II, a word can have multiple senses or even conflicting meanings. Likewise, a term used as a trademark has the potential to bear product identifying and source-signifying

\textsuperscript{72} See Soc’y of Fin. Examiners v. Nat’l Ass’n of Certified Fraud Examiners Inc., 41 F.3d 223, 225 (5th Cir. 1995) (vacating summary judgment and injunctive relief in plaintiff’s favor because a question of fact remained on whether the purported mark was generic, and noting “[e]ven total confusion, however, is irrelevant if [the purported mark] constitutes a ‘generic’ mark.”); Cf. Stacey L. Dogan & Mark A. Lemley, Trademarks and Consumer Search Costs on the Internet, 41 HOUS. L. REV. 777, 793 (2004) (“[T]he generiness doctrine can impose search costs on consumers, particularly when a once-famous mark such as ‘aspirin’ or ‘thermos’ becomes generic.”).

\textsuperscript{73} See supra notes 69-227 and accompanying text.

\textsuperscript{74} Dinwoodie, Ontology, supra note 40 at 729.

\textsuperscript{75} 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:47 (4th ed.). See also 3 CALLMANN § 20:33.

\textsuperscript{76} 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:47 (4th ed.) (“The only purpose is to accommodate the rare and extraordinary event that a generic name over a period of years loses it[s] generic significance and achieves trademark significance.”). Compare infra Part II.C.

\textsuperscript{77} 3 CALLMAN ON TRADEMARKS, UNFAIR COMPETITION, AND MONopolies § 20:33.

Altman nevertheless concedes the anti-competitive argument “if the mark retains a substantial vestige of its original generic or descriptive meaning.” Id.

\textsuperscript{78} See e.g., Marc C. Levy, From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine, 95 TRADEMARK REP. 1197, 1202 (2005) (“[T]here is no such thing as a ‘generic’ word with secondary meaning”) (quoting 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)).
meanings, at least in the minds of different consumers, and perhaps in the mind of the same consumer at different times, or nearly simultaneously.79 The binary view thus misses some of the complexity that semantic shift theories can help us appreciate.

Others scholars see trademark incapacity as a subset of functionality. For example, Vanessa Bowman Pierce has argued that the genericness inquiry should be subsumed into a functionality inquiry.80 Pierce’s concept of functionality, however, is confined to preventing the protection of “core words to which all competitors may need access.” Thus, if “effective competition is possible” without the use of the term, “neither functionality nor genericism should preclude at least qualified protection” of the term.81 Vincent Palladino, on the other hand, expresses concern that at least “for products that are not unique, [equating] functionality and genericness seems unsound” because a competitor always needs to copy a functional element in order to compete, but does not need to use a word to compete “when the word has become associated with the products of only one producer.”82 Palladino’s argument is somewhat conclusory, and he buys into the same binary structure that plagues other critiques, but he points in the direction of the real conundrum, one that focuses on the importance of change.83 Functional features do not change, but language does.

These critiques nevertheless fail to account for is why it is important to focus on current rather than historic language usage. To encapsulate the argument that follows, language is dynamic, and language change appears to occur more rapidly now than at any point in history.84 Part II lays out in detail how those changes typically

80 Vanessa Bowman Pierce, If It Walks Like A Duck and Quacks Like A Duck, Shouldn’t It Be A Duck?: How A “Functional” Approach Ameliorates the Discontinuity Between the “Primary Significance” Tests for Genericness and Secondary Meaning, 37 N.M. L. REV. 147, 185 (2007)
81 Id.
83 See also MCCARTHY § 15:24 (recognizing the inherent “fluidity” of trademark rights in his criticism of the strong form of de facto secondary meaning).
84 The editors of the Barhart Dictionary of New English reported 5,000 new words, or neologisms, between 1963 and 1972, roughly 500 per year. See John Algeo, Where Do All the New Words Come From?, AM. SPEECH 267 (1980). But in the
occur. In particular, Part II.C explains how restriction – a narrowing shift in the meaning of a word from any member of a broad category to a prototypical member of that category is the most typical form of semantic shift. In Part III, the article applies these findings to the trademark incapacity doctrine, refuting the functionality and error cost rationales that are presumed to provide a basis for the doctrine.

II. TRADEMARK ACQUISITION AS SEMANTIC SHIFT

This Part has three principal aims. First, in Part II.A, I explain how semantic shift is motivated by two critical needs – the need to communicate and the need to resolve lexical ambiguity. The effectiveness of the attempted communication, and the ease of processing the ambiguity, depends largely on the nature of the relationship between a new word or meaning and the older word(s) from which it is derived. Second, trademark acquisition is a form of semantic shift driven by the need to communicate, with rules for how to resolve ambiguity. My argument from another article is summarized in Part II.B. Finally, Part II.C describes the dominant or “regular” shifts that historical linguists identify as occurring repeatedly over time and across languages, focusing on restriction and its opposite, widening. While trademark incapacity treats the shift from genericness to source significance as a forbidden and extremely rare type of shift, the evidence suggests it is actually the most frequent type of semantic shift, or at least as common as shifts that are acknowledged (and perhaps created) by trademark law.

A. Motivations for Semantic Shift

Living languages are not static. The lexicon of a given language – the total number of words available to speakers of that language – must continually make room for new entries. Two

1989 edition of the OED, Editor John Simpson in the preface stated that “[t]he pace of inclusion of new words has been increased to a rate of about 4,000 per year.” John Simpson, Introduction to THE OXFORD ENGLISH DICTIONARY (2d ed. 1989). Other authors have noted spikes in neologism during periods of great creative and literary output. See, e.g., JOHN LERNER or GEOFFREY HUGHES (identifying a spike in neologisms at the turn of the 17th century). Communication technology also increases the rate with which new words are adopted. See, e.g., ALVIN TOFFLER, FUTURE SHOCK 151-154 (1970) (describing how A-OK effectively entered the lexicon overnight as the American public heard an astronaut use it during a televised flight).

85 DIRK GEERAERTS, THEORIES OF LEXICAL SEMANTICS 26-27 (2010) [hereinafter GEERAERTS, LEXICAL SEMANTICS].

86 See, e.g., omnishambles, a new word coined in an episode of British television satire In the Thick of It (“n., British slang, a situation that has been comprehensively
motivations drive this creation of new meaning, or semantic shift.\textsuperscript{87} On the one hand, as discussed in the next Subsection, a speaker wants to express new things. Offering a new word, or adding a new meaning to an old word, is often a desirable method of achieving that goal. On the other hand, as discussed in Part II.A.2, introducing new meanings to a given lexeme can also introduce confusing ambiguity into that term,\textsuperscript{88} and some semantic shift occurs to reduce that ambiguity. Old meanings sometimes disappear to reduce ambiguity and increase the efficiency of language.\textsuperscript{89} In other cases, listeners navigate the ambiguity in language through contextual interpretation.

1. Individual behavior drives communal language change.

Semantic shift is motivated by the speaker’s need to say new things and communicate more effectively, which encourages the speaker to “risk” a semantic innovation.\textsuperscript{90} For instance, the torpedo, a self-propelled submarine explosive, was named for a type of stingray.\textsuperscript{91} Professor Andreas Blank proposes that the inventor called it a torpedo “because he thought that this was a pretty convincing metaphor” for the way the explosive device moved through the water and could surprise its target.\textsuperscript{92} Blank identified the specific motivation as “the need for a new name in a concrete situation.”

A generation prior, Hermann Paul observed that individual behavior drives general language change over time.\textsuperscript{93} At any given point in time, the lexicon will hold what Paul called “usual” meanings of words – meanings commonly shared or understood.\textsuperscript{94} Speakers will

\textsuperscript{88} \textit{Id.}
\textsuperscript{89} \textit{See infra} notes 63-65, 98-99, and accompanying text.
\textsuperscript{91} \textit{Id.}
\textsuperscript{92} \textit{Id.} at 62.
\textsuperscript{93} Dirk Geeraerts, \textit{Theories of Lexical Semantics} 14-16 (2010) (\textit{Citing Hermann Paul, Prinzipien der Sprachgeschichte} (5th ed. 1920)).
\textsuperscript{94} William Croft referred to this two-stage process as innovation (first new usage) and propagation (spread to other members of the speech community). \textit{William Croft, Explaining Language Change: An Evolutionary Approach} (2000). Occasional or innovative uses that become popular enough become usual meanings.
then innovate, making modulations that occur during speech. Whether these “occasional” meanings are sensible to listeners typically depends on the context in which they were used, but an occasional meaning can enter common parlance through frequent use and thus become a usual meaning. A usual meaning is thus consistent across various contexts. Recently, Elizabeth Traugott and Richard Dasher have demonstrated that this production-oriented or speaker-driven language change is a phenomenon that cuts across multiple languages.

Semantic change can happen in a variety of ways. Sometimes a speaker makes up a whole new word. At other times, an existing word can be pressed into service for new purposes. Changes can start small but expand outward. For example, a shift in application is a minor change, like use of the adjective “healthy” in an expansion from “healthy climate” to “healthy complexion,” which does not necessarily destroy “the fundamental unity” or core meaning of “healthy,” but allows it to be applied in a new context.

Significant changes can destroy that fundamental unity and create multiple related polysemous senses for a word. Linguists posit that polysemes are interrelated in such a way that the reader or listener generates multiple meanings from a single or central sense. The extension of a word – the addition of new polysemous senses – is not an accidental process. Indeed, the historical progression is often clear. For example, a bank is simultaneously a financial institution, the building in which the financial institution is housed, any number of institutions which store things (like a blood bank), and a synonym

Those that don’t propagate broadly enough are referred to by historical linguists as “nonce-formations.” Willem B. Hollmann, Semantic Change, in ENGLISH LANGUAGE: DESCRIPTION, VARIATION AND CONTEXT, 525, 535 (Jonathan Culpeper, et al., eds., 2009).

Traugott & Dasher refer to these occasional meanings as “subjectification” which enter the lexicon as usual meanings when they “have come to be fairly wide spread.” TRAUGOTT & DASHER, supra note 2 at 32.

Id. at 7.

ULLMANN, supra note 3.

Allan defines polysemy as “the property of an expression with more than one meaning.” I KEITH ALLAN, LINGUISTIC MEANING § 3.3.1 at 147 (1986).

Ekaterina Klepousniotou & Shari R. Baum, Disambiguating the Ambiguity Advantage Effect in Word Recognition: An Advantage for Polysemous but not Homonymous Words, 20 J. NEUROLINGUISTICS 1, 4 (2007) [hereinafter Klepousniotou & Baum, Disambiguating] (polysemes have a single core meaning from which interrelated senses are derived).

for “rely upon,” i.e., “You can bank on it.”101 All those meanings derived from the Italian term for bench, which was “extended in Italian to that of ‘tradesman’s stall, counter, money changer’s table,’” & etc.102 Polysemous senses are thus related, stemming from a common source, much like two branches splitting from the same source river. Polysemous shifts often occur in two subtypes; metaphor and metonymy.103

Homonyms are words that look and/or sound the same,104 but are etymologically distinct, coming from different roots. Homonyms often come to resemble one another due to a historical accident,105 and their meanings are therefore unrelated.106 For example, while the lexeme bank can be used to describe a financial institution or the bank of a river, those lexemes are homonymous, stemming from independent sources.107 Formerly distinct words can also collapse into identical sounds or spellings as pronunciation changes over time. In other cases, speakers with different languages or dialects cohabitate over time, and homonymous meanings are introduced. It is difficult, but not impossible, to simultaneously construe a given use of the word using two or more homonymous meanings.108

103 See infra notes 125-126 and accompanying text.
104 For the sake of simplicity, I include within homonymy both homophones, lexemes that sound the same but have different written forms and different meanings, and homographs, lexemes with the same written form but different pronunciations and meanings. See also generally Ekaterina Klepousniotou, The Processing of Lexical Ambiguity: Homonymy and Polysemy in the Mental Lexicon, 81 Brain & Language 205 (2001) [hereinafter Klepousniotou, Processing].
105 Grzega and Schoner identify several reasons for such a change: speakers drop sounds at the end of words, or certain sounds are abandoned from language over time, causing previously distinguishable words to become indistinguishable. Grzega & Schoner, Material for Onomasiology Seminars at 32.
106 Allan defines homonymy as “the relation between two or more expressions which have the same form but different meanings.” I ALLAN, supra note 98 at 147.
107 As discussed above, bank as an institution derives from the Italian term for bench. See supra note 102 and accompanying text. The meaning of bank as the side of a river, or other raised shelf of ground, on the other hand, stems from Scandinavian sources. “bank,” n.1, OED.COM (viewed May 19, 2014). The two terms collapsed into the same word, banke, in early modern English. Id.
108 See, e.g., CROFT & CRUSE, supra note 101 at 112; Klepousniotou & Baum, Disambiguating, supra note 99 at 4 (homonyms have mutually exclusive meanings, one of which must be selected before further processing can occur).
Finally, while many words have multiple meanings, some words are monosemes, having a singular – and often technical – meaning. The term monoseme came into common usage to describe technical medical terms at the turn of the 20th century, but has also been applied to certain prominent brands. For example, David Crystal points to Microsoft as an example of a monosemous term. Polysemes and homonyms are lexemes that exist in relationships with other lexemes, while a monoseme is seen to stand apart from other lexemes. Any new word made up whole cloth will be a monoseme, at least at first.

This creation of new meaning often introduces confusing ambiguity. As described in the next Subsection, scholars have identified processes for resolving this ambiguity.

2. Semantic shift resolves ambiguity.

The expressive drive to say new things can increase ambiguity in the language, at least when new meanings are added to old words. Such a semantic shift has a tendency to create ambiguity as to the meaning of a given word. When such ambiguity arises, it can create what scholars call homonymic tension or semantic overload. A listener or reader faced with conflicting meanings can face difficulty processing such language.

When semantic overload occurs, the meanings of ambiguous terms can come into conflict. As Professor Ullmann notes, language evolves “curative devices …to resolve ‘intolerable’ conflicts.” To the extent confusing ambiguity has arisen, there is a tendency over time for earlier senses to disappear as newer extensions are added to an existing term. For example, the Latin persona gradually

109 David Crystal, How Language Works 191 (2005) (pointing to “Microsoft” as an example of a monosemous term). See also mononym, n. OED. Chiefly Med. Obs., A technical name consisting of one word only. Monosemy is a circumstance where words or phrases have a single meaning, or where there is an absence of ambiguity. Charles Ruhl, On Monosemy: A Study in Linguistic Semantics (1989).
110 Id.
111 Homonymic tension can arise over polysemous senses as well as homonymous meanings.
114 Robert J. Menner, Multiple Meaning and Change of Meaning, 21 Language 59, 61 (1945) (hereinafter Menner, Meaning). See also id. at 67 (describing how the
extended from ‘mask’ to ‘individual human being,’ and then branched off to ‘parish priest.’ The ambiguity was subsequently resolved by adopting the variant *parson* for ‘parish priest,’ and abandoning *persona* for the same. Homonymic tension can thus force meanings out of the lexicon altogether. Language tends to shift towards singular meaning because it reduces ambiguity. Ambiguity can increase the cost of communicating, and from that perspective, is inefficient. In a lexicon where each word has a single meaning, confusing ambiguity would theoretically be kept to a minimum.

While homonymic conflict can force a given meaning out of the lexicon, not all conflict is fatal to a given word. First, it is not unusual for two or more ambiguous meanings to coexist for a time before one of the meanings is forced out of the word. But even when a word is not forced out, semantic overload is resolved as conflicting words abandon potentially conflicting meanings or are otherwise narrowed. For example, since *light* (from Old English, meaning bright, brilliant, or shining) and *light* (from German, the antonym of heavy) coexist in English, it is difficult to use a phrase like “light materials” without resorting to a compound like “light weight.” Likewise, *sand* in Old English meant both the strip of land next to a body of water and the particulate matter common to that land. When the German word *shore* was borrowed to refer to the body of land, *sand* was narrowed to mean only the granular particles. The semantic overload created by the ambiguity resulted in the narrowing of both terms.

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118 See e.g., TRAUGOTT & DASHER, supra note 2 at 12; LYONS, 2 SEMANTICS § 10.4 at 397 (context in which an ambiguous word is presented can be “such that all but one of the possible interpretations are irrelevant or relatively improbable.”).
119 Id. See also Menner, *Homonyms*, supra note 116 at 241-42.
121 As discussed in another article, this same effect can arise in cases where confusing use is tolerated in the trademark context. See Jake Linford, *Trademark Infringement and Semantic Shift*, draft to come.
As described above, semantic shift happens as speakers seek new means of expression. In addition, semantic shift occurs in ways that prioritize resolving at least some confusing ambiguity. The next Subsection identifies regular, or commonly occurring forms of semantic shift. A detailed discussion of restriction – by some accounts the most common form of semantic shift – follows in Part II.C

3. Semantic shift exhibits regularity

Words add and lose meaning in predictable patterns across languages,122 and those patterns shape the acquisition of trademark meaning, which at its base is a form of semantic shift.123 There are six standard categories of semantic change: restriction, widening, metaphor, metonymy, amelioration, and pejoration.124 I briefly discuss metaphor and metonymy below. Part II.C describes restriction and widening in more detail.

Semantic shift often begins as a new occasionally used sense is added as a common or usual sense of an existing word. Those polysemous extensions are of two regular types: metaphoric (for example, lip for ‘part of the body around the mouth’ extended to ‘edge of a cup’) or metonymic (for example, rabbit for ‘kind of animal’ extended to ‘meat of the animal’).125 In both cases, the speaker perceives some similarity between two concepts, and uses the word for the first to talk about the second. For example, TV-chef Gordon Ramsey calls contestants on his cooking show doughnuts when they perform poorly – a meaning clearly figurative rather than literal.126 These occasional uses of metaphor and metonym can become “usual,” or understandable independent of context.127

As I discuss in more detail in another article,128 these historical and theoretical accounts of semantic shift are supported by

122 TRAUGOTT & DASHER, supra note 2 at 3.
123 See infra Part II.B.
125 Ekaterina Klepousniotou, Reconciling Linguistics and Psycholinguistics: On the Psychological Reality of Linguistic Polysemy, 27 in THE COGNITIVE BASIS OF POLYSEMY: NEW SOURCES OF EVIDENCE FOR THEORIES OF WORD MEANING (Rakova et al., eds. 2007) [hereinafter Klepousniotou, Reconciling].
126 See Hollmann, supra note 94 at 528.
127 See supra notes 93-97.
128 Jake Linford, Semantic Shift and the Abercrombie Spectrum (draft on file with author).
recent cognitive research. This cognitive research has detected statistically significant differences in the way listeners and readers access and process different categories of ambiguous words. The experimental evidence suggests listeners and readers confronted with ambiguous words rely on distinct processing mechanisms to access polysemous senses and homonymous meanings.129 In other words, studies have identified, directly or indirectly, differences in cognitive processing between homonymy and polysemy.130 These effects extend to differences in processing metaphorical and metonymous ambiguous words.131 Indeed, as discussed in the next Section, this continuum of lexical ambiguity shares key features with the periodically maligned Abercrombie spectrum of conceptual trademark strength. In fact, as the next Section explains, trademark acquisition is properly understood as a form of semantic shift.

B. Trademark Acquisition as Semantic Shift

Semantic shift is speaker-driven,132 exhibits regular behavior, and appears to be shaped by settled processing patterns used by listeners and readers when construing lexical ambiguity.133 These same phenomena can be perceived as producers seek to develop source-signifying trademarks. As I describe in more detail in another article, trademark acquisition is simply another form of semantic shift.134

Reconsider Blank’s description of how the torpedo was named:135 the same motivations inform the efforts of the trademark owner to innovate. Each trademark is a symbol, indicating goods or services sold under that mark will be of a consistent quality and from a consistent source.136 Some trademarks are formed from preexisting words while others are completely new additions to the lexicon. Even where the acquisition of the mark is easiest, it requires the transformation of language, building new word from the catalogue of available morphemes.137 Just as language changes over time, words

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129 Klepousniotou, Reconciling, supra note 125 at 46.
130 Id. at 25.
131 Klepousnitou, supra note 125 at 29.
132 See supra Part II.A.1.
133 See supra Part II.A.2-3.
134 Jake Linford, Semantic Shift and the Abercrombie Spectrum (draft on file with author).
135 See supra note 90 and accompanying text.
136 Beebe, Semiotic, supra note 1 at 621.
137 Id. at 744.
with source-signifying senses or meanings can undergo experience semantic shift and change over time.138

We see in the torpedo example a typical form of semantic shift. A speaker needed a new way to express himself, and appropriated an existing word to do so. In Abercrombie & Fitch Co. v. Hunting World, Inc.,139 the Second Circuit provided a spectrum of conceptual trademark strength based on the relationship of the new trademark and the branded product to existing meanings of the appropriated word. As Judge Friendly articulated in Abercrombie, the more inherently distinctive a mark is, the more readily it can bear source significance, and the easier it is for the hopeful mark owner to acquire trademark protection.140 While the Abercrombie spectrum has been criticized as an acontextual distraction from the key inquiries in trademark law,141 the spectrum mirrors commonly understood forms of semantic shift ... for the most part.142

Starting at the strong end of the spectrum, a fanciful mark, like XEROX for photocopiers,143 is a word that is invented to serve as a


As one court put it in a famous and important nineteenth century opinion:
The alphabet, English vocabulary, and Arabic numerals, are to man, in conveying his thoughts, feelings, and the truth, what air, light, and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind, in which all have an equal share and character of interest. From these fountains whosoever will may drink, but an exclusive right to do so cannot be acquired by any.

Avery & Sons v. Meikle & Co., 81 Ky. 73, 86, 90 (1883) (concluding that descriptive terms “are common property which all may use, but which none may exclusively appropriate”).


140 537 F.2d at 9.

141 See, e.g., Lee et al, supra note 1 at 1078 (“[T]he Abercrombie classification system is built on a faulty theoretical notion that semantic meaning is the determinant of the extent to which consumers will esteem a mark to be a source-indicator.”); but see Linford, Semantic Shift and the Abercrombie Spectrum (draft on file with author).


143 The term XEROX is ostensibly drawn from the technical name for the photocopying process, xerography, itself derived from Greek words for “dry” and
source signifier that has no other preexisting meaning. A fanciful mark is considered the most inherently distinctive trademark, because the fanciful mark is a made up word, and cannot have a prior relationship to another concept because the new mark did not previously exist. Thus, the fanciful mark is a monoseme (at least initially) designating only the source for the good because it is devoid of any other meaning.

Arbitrary marks are the next strongest mark on the spectrum. An arbitrary mark is a mark drawn from an existing word that lacks any connection to the product sold. For example, APPLE for computers is an arbitrary mark. Before Steve Jobs and Steve Wozniak used the word as a source signifier for personal computers, it held no such meaning. Here, the desire of the Apple founders created a new meaning for an old word, one that the public has now fully embraced. As historical and cognitive research suggest, readers and listeners process the unrelated meanings of homonymous words as if they were completely different words (unlike polysemous words with multiple related meanings). The disconnect between old and new meanings makes the arbitrary mark clearly distinctive. This is so because the addition of an unconnected meaning to a preexisting word seems somewhat unnatural, not unlike the scene in the movie Mean Girls where one member of a clique tries to start the trend of using “fetch” in the phrase “That is so fetch,” as a synonym for “cool” or “awesome.” She is quickly shot down by the alpha-female of the clique with a frosty “Stop trying to make ‘fetch’ happen. It’s not going to happen.” The unnaturalness does not make the creation of the homonymous mark unacceptable, but the homonymous addition is jarring in nature, and thus clues the audience of the mark into its source-signifying nature.


See supra notes 109-110 and accompanying text.

RONALD W. LINZMAYER, APPLE CONFIDENTIAL: THE REAL STORY OF APPLE COMPUTER, INC.; Stephen Wozniak, Homebrew and How the Apple Came to Be, DIGITAL DELL. See also Trademark Reg. No. 1,078,312 (Nov. 29, 1977) (APPLE for computers and computer programs recorded on paper and tape).

Klepousniotou, Reconciling, supra note 125 at 29.

MEAN GIRLS (Paramount Pictures 2004).

Marketers counsel against homonymous marks because they are difficult to infuse with meaning. See Chiranjeev Kohli & Rajneesh Suri, Brand Names That Work: A Study of the Effectiveness of Different Types of Brand Names, 10 MARKETING MANAGEMENT J. 112 (2000) (concluding that descriptive and suggestive marks are generally liked more and are easier to independently recall
Suggestive marks are next on the scale, and the creation of a suggestive mark mirrors another common form of semantic shift. Suggestive marks operate in metaphoric relationship to the words from which they are drawn.\footnote{Metaphoric extensions are based on a specific analogous similarity between concepts. GEERAERTS, LEXICAL SEMANTICS, supra note 85 at 26-27. For instance, broadcast originally meant to “scatter[ seed] abroad over the whole surface, instead of [ ] sow[ing] in drills or rows,” then to “scatter[ something] widely abroad,” and later came to mean “disseminate[ ] by means of radio or television.” “broadcast,” A.1.a., A.2.a, A.3.a, OXFORD ENGLISH DICTIONARY, 2014, online at http://www.oed.com/view/Entry/23507?rskey=8Deiyh&result=1&isAdvanced=false#eid (viewed June 3, 2014).} Suggestive marks “require[] the consumer to exercise his imagination to reach a conclusion as to the nature of the [ ] goods [offered]” under that mark.\footnote{Synergistic Int’l, L.L.C. v. Korman, 470 F.3d 162, 171 (4th Cir. 2006) (quoting Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1528 (4th Cir. 1984)). See also T.M.E.P. § 1209.01(a) (“Suggestive marks . . . when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. . . . [A] descriptive term . . . immediately tells something about the goods or services.”).} For example, SKINVISIBLE for transparent bandages is a coined word that conveys a characteristic of the product (transparency) but in a way that hints at, rather than expressly states, the connection.\footnote{Minnesota Min. & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179, 1180 (C.C.P.A. 1972) (reversing decision of the Trademark Trial & Appeal Board which sustained an opposition to the application to register SKINVISIBLE on grounds of mere descriptiveness under § 2(e)(1) of the Lanham Act).}

Descriptive marks are also related to the word(s) from which they are drawn, but the relationship is even closer that for suggestive marks – metonymic instead of metaphoric. The descriptive mark builds on a characteristic of the good or service offered, while a metonymic shift is a change based on contiguity (connection) between concepts or an understood association.\footnote{See TRAUGOTT & DASHER, supra note 2 at 28. For instance, horn for “animal horn” added the sense of horn for “musical instrument,” due to the use of some animal horns as musical instruments or warning devices. Andreas Blank, Co-Presense and Succession: A Cognitive Typology of Metonymy, in METONYMY IN LANGUAGE AND THOUGHT 169, 182 (Klaus-Uwe Panther and Günter Radden ed., 1999).} For example, a term like SEALIGHT for fasteners describes the qualities a fastener would likely have, and is thus descriptive in nature. The Abercrombie scale posits a distinct difference between suggestive and descriptive than arbitrary or fanciful marks, and that arbitrary marks are more difficult to recognize, i.e., distinguish from other similar marks, than marks in the other categories).
marks. Suggestive marks are considered inherently distinctive because of the necessary leap required for the metaphoric understanding. Thus, like arbitrary and fanciful marks, a suggestive mark can be protected without any evidence of secondary meaning. Before a descriptive mark can be protected, however, the claimant must establish that the mark has acquired distinctiveness. To determine whether it has done so, courts and examiners look for evidence of secondary meaning – that the mark at issue points not only to the quality or characteristic of the good or service, but also come to represent the good or service.

This difference between suggestive and descriptive marks has been sharply criticized, in part because the line between the two is particularly fuzzy, but is consistent at least in part with cognitive research into language change. As Ekaterina Klepousniotou has reported, several cognitive studies have measured significant advantages in recognizing and processing a metonymic sense when the study participant is presented with another metonymic sense. There is no processing advantage for different homonymous meanings. Metaphoric senses confer recognition and processing advantages in some studies, but not in others. The position of metaphoric senses at a midpoint supports earlier theories that there is a continuum of lexical ambiguity between metonymic polysemy and homonymy. Suggestive marks thus may properly fit in a middle

153 “Secondary meaning need only be shown if a mark [ ] is found to be or is conceded to be descriptive.” Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 380 (7th Cir. 1976).
154 For the rationale for using the term “descriptive mark” instead of other more accurate but unwieldy options, see Linford, supra note 19 at 711 n.32.
156 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2
158 Klepousniotou, Reconciling, supra note 125 at 29; see also Rodd et al, Making Sense of Semantic Ambiguity: Semantic Competition in Lexical Access, 46 J. MEM. & LANG. 245 (2002) (finding a significant ambiguity advantage in lexical decision tasks for polysemous words with multiple related senses, and a delay for homonymous words with multiple unrelated meanings).
159 See supra note 146 and accompanying text.
160 Klepousniotou, Reconciling, supra note 125 at 29.
161 Id. (citing J. Apresjan, Regular Polysemy, 142 LINGUISTICS 5 (1974)).
ground between descriptive and arbitrary marks, but questions remain about whether they should be treated as inherently distinctive.162

At each of these points along the Abercrombie spectrum, the creation of the mark tracks a form of semantic shift with which we are familiar. We can see another relationship manifest in the way a trademark can lose source significance if its primary meaning becomes the generic designation of a product or service. For example, the CELLOPHANE mark lost source significance when a court concluded the mark had primarily become a generic designation for a transparent sheet of semi-viscous paper ideal for preserving food.163 Linguists refer to this type of shift as widening, where the name of a prototypical member of a category is widened to represent the whole category.164 It happens frequently, but with less frequently than its opposite, restriction.

Restriction of meaning occurs when the meaning of a word designating a category of things is narrowed to designate a prototypical member of the category.165 For example, hound was once the generic designation for any dog, but has narrowed to a group of long-eared hunting dogs.166 But the doctrine of trademark incapacity rejects restriction of meaning that happens when a word that was once generic acquires source significance.167

<table>
<thead>
<tr>
<th>Semantic Category (relationship between existing words/meanings/senses and new word/meaning/sense)</th>
<th>Abercrombie Spectrum (relationship between mark and product or good offered)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Monoseme (only one meaning)</td>
<td>Fanciful mark – XEROX for photocopiers (coined for use as a trademark, not a preexisting word)</td>
</tr>
</tbody>
</table>

162 See Trademark’s Metaphoric Ambiguity (Semantic Shift and the Abercrombie Spectrum) (draft on file with author) for a more complete consideration of this question.
164 See infra notes 168-170, 192-195 and accompanying text.
165 See infra notes 190-192 and accompanying text.
166 See infra note 180 and accompanying text.
167 See supra Part I.B.
As the table above illustrates, most aspects of trademark acquisition reflect concepts of semantic shift. But trademark incapacity drives a wedge between trademark acquisition and the phenomenon of semantic shift of which it is a part. While trademark acquisition is semantic shift, the doctrine of trademark incapacity discounts what might reasonably be the most common form of semantic shift. We consider the evidence regarding the frequency of restriction, and how restriction occurs, in Part II.C. In Part III, we

<table>
<thead>
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</tr>
</thead>
<tbody>
<tr>
<td>Homonym (no connection between existing meanings and the new meaning)</td>
<td>Arbitrary mark – APPLE for computers (selected, but having no preexisting connection with the good or service sold)</td>
</tr>
<tr>
<td>Polyseme – Metaphor (figurative connection between existing meanings and the new sense)</td>
<td>Suggestive mark – SKIN-VISIBLE for transparent adhesive bandages (some connection to the mark, via an imaginative leap)</td>
</tr>
<tr>
<td>Polyseme – Metonym (part for the whole; count – mass – some connection, but not one to one)</td>
<td>Descriptive mark – STRONGHOLD for fasteners (clear connection, describes an aspect of the product).</td>
</tr>
</tbody>
</table>
| Restriction (word used to describe general category used for a prototypical member of the category) | **Not** HOG for Harley Davidson motorcycles, despite existence of shift, on grounds of trademark incapacity  
**Not** HOTELS.COM for a website providing hotel search and booking services, despite existence of shift, on grounds of trademark incapacity  
**But** KISSES for Hershey’s chocolate candy |
consider whether the justifications for trademark incapacity hold water in light of what we have learned, and how we might change trademark law to more closely match our best understanding of how language really changes.

C. Regularity of Restriction in Semantic Shift

Restriction and widening are both examples of semantic change that occurs because of a focus by speakers and listeners on a prototypical member of a group.168 Professor Andreas Blank notes that a significant amount of semantic shift is driven by the focus on a prototypical example of a given category.169 Thus, some scholars identify restriction and widening as the most important processes of semantic change.170

Michel Bréal, one of the founders of semantic linguistics, first posited that restriction is the most frequently occurring regular semantic shift.171 Historical accounts bear that out. For example, the shift from Old English to Middle English is replete with instances of semantic restriction and loss of Old English vocabulary.172 Much of that restriction occurred as new “loanwords” were introduced from other languages, and the meanings of both old and new terms were narrowed as they came into conflict. For instance, while the Old English word *goma* once referred broadly to ‘jaw, palate, and inside of the mouth,’ the introduction of *palate* from the Latin and *jaw* from

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168 Restriction is also called narrowing or specification, while widening is also called generalization and broadening. Geeraerts.
169 Blank, supra note 90 at 62-63.
171 Bréal, supra note 170 at 106. See also April M.S. McMahon, Understanding Language Change 178-79 (1994) (restriction is the most natural form of language change, particularly when a loan word is introduced, and the old word must “recoil” to stay relevant). Compare Robert P. Stockwell & Donka Minkova, English Words: History and Structure 158 (2001) (arguing that restriction is an unnatural change but conceding that restriction happens “quite frequently” in some contexts).
172 C.M. Millward & Mary Hayes, A Biography of the English Language 205 (3d ed. 2012) (“The type of semantic change easiest to find between OE and ME (and during ME) is narrowing of meaning... many OE words acquired narrower, more specific meanings in ME as a direct result of loans from other languages.”).
an undiscovered source coincides with a restriction of *goma*, or *gum*, to refer only to the connective tissue surrounding the teeth.\(^{173}\) Cultural and technological change also explains some semantic change, as OE vocabulary was lost due to irrelevance. For example, no one walks around with a body of retainers anymore so a word like *folgoped* has been rendered obsolete.\(^{174}\)

Sometimes, a term designating the category as a whole is narrowed or restricted to the prototypical member of the category.\(^{175}\) For example, *meat* once meant ‘food’, but has narrowed to ‘edible flesh’.\(^{176}\) The shift of a generic term to a trademark, which most courts reject even when there is evidence that the term has acquired source significance – like the shift from *hog* from any large motorcycle to a Harley Davidson motorcycle – is another example of restriction.\(^{177}\)

There are multiple examples through history of semantic restriction to a prototypical member. For example, ‘corn’ stems from the Latin word for grain. In a given locale, the term will adopt a usual meaning corresponding to the dominant crop in the region. ‘Corn’ is narrowed in the U.S. to mean maize, while in most of England, ‘corn’ refers to what U.S. consumers would call wheat, and in northern England and Ireland, ‘corn’ identifies what U.S. residents call oats.\(^{178}\) Other examples include ‘skyline’ narrowing from any horizon to a horizon decorated by skyscrapers;\(^{179}\) ‘hound’ narrowing from the Old English *hund* for any dog to a species of long-eared hunting dog;\(^{180}\) ‘wife’ narrowing from woman to woman of humble rank or low employment to married woman or spouse.\(^{181}\) The Old English

\(^{173}\) Id.

\(^{174}\) Id. at 203.

\(^{175}\) BRÉAL, *supra* note 170 at 106.

\(^{176}\) LEONARD BLOOMFIELD, *LANGUAGE* 426 (1933).

\(^{177}\) See Harley Davidson, Inc. v. Grotanelli, 164 F.3d 806 (2d Cir. 1999). In *Grotanelli*, the court refused to award trademark protection in the term “hog,” despite the fact that consumers had begun to associate the term “hog” with Harley-Davidson motorcycles in particular.


steorfan, meaning to die, narrowed in Modern English to *starve*, to
die of hunger.\textsuperscript{182} *Art* originally had general meanings connected to
‘skill,’ but is now primarily related to aesthetic skill.\textsuperscript{183} *Accident* was
narrowed from any unforeseen event to an unfortunate one.\textsuperscript{184} *Fowl*
in Old English referred to any bird, but narrowed to a domesticated
bird raised for food or a wild hunted for sport.\textsuperscript{185} The meaning of *girl*
also narrowed from ‘child or young person of either sex’ in Middle
English to ‘female child’ or ‘young woman.’\textsuperscript{186}

Restriction does not necessarily force old meanings out of the
lexicon entirely. As described above, the Old English words for light
and sand were narrowed when the German words light and shore were
introduced into the lexicon.\textsuperscript{187} But the meanings of the older words
were narrowed due to the encroachment of new homonyms that
introduced new meanings, and the meanings of new homonyms were
also restricted by the existing words. Other words add new restricted
meanings without the loss of older meanings. *Glass*, for example,
added a restricted meaning as an abbreviated form of ‘hourglass.’\textsuperscript{188}

In addition, restriction increases the information conveyed by
the restricted form, compared to the more general form. This is so
because as the meaning restricts, the term can be applied more
precisely, and requires less contextual processing.\textsuperscript{189} Think back to
the restriction of *hound* from designating any dog to designating a
long-eared hunting dog.\textsuperscript{190} If I’ve lost my dog, you might ask me what
type of dog he is before undertaking to find him. When *hound* meant
any dog, it did not convey much information. However, when the
meaning of hound is restricted to large dogs used for hunting, the
word conveys more information. Compare the way a child first
learning English may use a word like “dog” to represent any four-
legged mammal.\textsuperscript{191} The use of an overgeneralized word conveys relatively little information to the listener.

Restriction is not the only documented form of semantic shift. At other times, the term designating the prototypical member is widened or generalized to represent the category as a whole.\textsuperscript{192} Dog used to refer to specific large or strong breeds of domesticated canines (and still does in Danish), but has since been broadened to include any domesticated canine regardless of size.\textsuperscript{193} The (potential) shift of a term from a trademark into a generic product designation can also be understood as an instance of widening. For example, the adjectival trademark Kleenex, a ‘proprietary name of an absorbent disposable cleansing paper tissue’\textsuperscript{194} has ostensibly broadened over time to add a second, nominative polysemous meaning as a designation for ‘any ‘disposable cleansing paper tissue, regardless of brand.’\textsuperscript{195}

Semantic shift is a natural phenomenon with regular behavior, but in the trademark context, it is also a phenomenon with legal consequences.\textsuperscript{196} When a brand name is widened to represent the product category as a whole, the mark owner can lose protection in the mark.\textsuperscript{197} Consumers who continue to rely on the mark as a source signifier will be confused,\textsuperscript{198} but consumers who have adopted the new meaning might welcome cheaper competition by a free-riding new entrant who uses the former trademark to designate competing products or services.\textsuperscript{199} Likewise, should a generic term become source signifying, and recognized as such,\textsuperscript{200} competitors who plan to

\begin{footnotesize}
\begin{enumerate}
\item I ALLAN, LINGUISTIC MEANING 103.
\item GEERAERTS, LEXICAL SEMANTICS supra note 85 at 26-27; BRÉAL, supra note 170 at 115-121.
\item Hollmann, supra note 37 at 528.
\item Kleenex, n., OED.COM (viewed Feb. 22, 2014).
\item ROBERT J. JEFFERS & ILSE LEHISTE, PRINCIPLES AND METHODS FOR HISTORICAL LINGUISTICS 129 (1979).
\item See supra notes 169-195 and accompanying text.
\item See infra note 266 and accompanying text.
\item Stacey L. Dogan & Mark A. Lemley, A Search-Costs Theory of Limiting Doctrines in Trademark Law, 97 TRADEMARK REP. 1223, 1241 (2007) (noting that doctrines like abandonment “present ‘hard cases’ precisely because there are search cost rationales on both sides of the argument,” and recognizing that from an economically-grounded “search costs perspective, the automatic preference given to one group of consumers over another can be troubling.”).
\item See generally Michael Grynberg, Trademark Litigation as Consumer Conflict, 83 NYU L. REV. 60 (2008); Eric Goldman, Deregulating Relevancy in Internet Trademark Law, 54 EMORY L.J. 507 (2005).
\item As described in Part I.B, courts currently discount evidence of acquired secondary meaning when the proposed mark was once a generic term.
\end{enumerate}
\end{footnotesize}
use the term to designate their own products will find a mark owner backed with legal authority to secure injunctive relief and, sometimes, damages against the competitor’s confusing use. Consumer interests with regard to the restricted generic term will mirror the interests of listeners and speakers in the widening context. Consumers who would not be confused by the competition may pay more for the products they desire, while consumers who have adopted the narrowed meaning will have lower search costs to find the products they desire.

As discussed in Part I.C, above, under the doctrine of trademark incapacity, restriction is given no legal significance when the term that has acquired a new secondary meaning was once a generic product designation. The doctrine is out of step with the best current understanding of how semantic shift occurs. It appears somewhat lopsided as well, because widening is given legal significance while restriction is not—a trademark owner can lose protection in a mark that becomes a generic product designation in the eyes of a critical mass of consumers.\(^{201}\) There might nevertheless be reasons for ignoring this fundamental form of semantic shift. Part III considers those reasons and refutes them before proposing an adaptation to bring trademark law in line with our best understanding about how restriction occurs in language change.

### III. TRADEMARK (IN)CAPACITY AND THE MYTH OF SHIFT-RESISTANT TERMS

In Part II we considered the continuing validity of the *Abercrombie* spectrum and how trademark law handles differences between categories of marks. We now turn to the generic term and the doctrine of trademark incapacity. Part III.A explains why, in light of the semantic shift literature, the law should abandon the trademark incapacity doctrine. In particular, competition justifications for trademark incapacity miss the mark precisely because they purport to divorce competition concerns from consumer confusion, even though consumer confusion is the sine qua non of trademark infringement. In addition, the functionality and error cost justifications for trademark incapacity is inapt in light of what we know about how language changes. To the extent we hope our trademark law will more accurately reflect consumer concerns and reduce consumer search costs, we should embrace a doctrine that better reflects regularity in semantic shift. Part III.B argues for moving away from the trademark incapacity doctrine by applying a primary significance standard for the acquisition of trademark protection, treating a term for which the

\(^{201}\) *See infra* notes 261-266 and accompanying text.
primary meaning is source signifying as a trademark, whether or not the term was a once a generic designation.

A. Recognizing Trademark’s Capacities

In Parts I.C & D, we considered trademark incapacity as it currently operates, and outlined several justifications for the doctrine. We now turn the argument, grounded in the semantic shift literature, for why the law should abandon the trademark incapacity doctrine in favor of recognizing the capacity of any term to serve as a trademark, where the appropriate semantic shift has in fact occurred.

First, we must separate questions of trademark incapacity from the general inquiry that a fact finder must make into whether a mark is source signifying. If a term is currently generic, or even descriptive, the term does not merit trademark protection, because there is no source significance and therefore no trademark right to enforce. Trademark incapacity adds another layer to the inquiry. Instead of asking whether a term is source signifying, the doctrine of trademark incapacity requires the fact finder to determine whether the term was ever a generic designation for the product category, regardless of current source significance. Thus, in Grotanelli, the court granted greater weight to dictionary evidence that “hog” was used to designate any big motorcycle, rather than evidence that 98% of surveyed consumers associated the term “hog” with Harley Davidson motorcycles.202

What harm requires this linguistic grave digging? This second level of inquiry requires justification above and beyond the obvious harm of granting trademark protection to a term that the majority of consumers see as a generic product designation. If there is no separate justification, then we should simply handle the analysis as we do for descriptive marks, and look for secondary meaning as measured by consumer perception, claimant’s efforts, and other relevant proxies.

With regard to proposed justifications for trademark incapacity, the doctrine is often grounded in competition policy, in a variety of formulations. For example, courts frequently observe that allowing a claimant to “convert common names, which belong to the public, to their own exclusive use”, as one court phrased it,203 could provide the claimant with something approaching monopoly power. But if one believes, as scholars like Professor McCarthy have said, and as I argued in more detail in Part II, that meaning in language is

202 See supra note 177 and accompanying text.
203 Weiss Noodle Company v. Golden Cracknel & Specialty Company, 280 F.2d 845, 848 (year).
subject to persistent if not continual change, one might be puzzled by this sentiment about common names. Such a construction presumes either that “common names” cannot acquire source-signifying meaning, or that they should not be treated as source signifiers, even if they have become such in the eyes of consumers.

Courts often state the first presumption unequivocally, but it is not literally true. If trademark incapacity applied in every case, then trademark resurrection would not have occurred in cases like Singer and Goodyear. In fact, the doctrine of trademark incapacity is also called the de facto secondary meaning doctrine precisely because it is a doctrine pursuant to which the court is allowed to ignore evidence of semantic shift because it has concluded the mark fits into the generic box ex ante.

The presumption that shifts from generic to source-signifying meaning never happen is also belied by the historical account discussed in Part II.C. To summarize, the best evidence we have from historical accounts of language change is that restriction, where a word once used to refer to any member of a broad category is restricted over time to refer primarily or only to a prototypical member of that category, happens all the time. Recall, for example, how the meaning of hound shifted over time from a generic designation for any domesticated canine to a restricted category of

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204 See e.g., In re Hotels.com, L.P., 573 F.3d 1300, 1302 (Fed. Cir. 2009) (“generic terms by definition are incapable of indicating source”); In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1569 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.”). At other times, courts have phrased the trademark incapacity doctrine in a manner that might leave room for a source-significance-acquiring semantic shift. See, e.g., H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc., 782 F.2d 987, 989 (Fed. Cir. 1986) (emphasis added): A generic term is the common descriptive name of a class of goods or services, and, while it remains such common descriptive name, it can never be registered as a trademark because such a term is “merely descriptive” within the meaning of § 2(e)(1) and is incapable of acquiring de jure distinctiveness under § 2(f).

205 See supra notes 60-61 and accompanying text.

206 Compare Am. Aloe Corp. v. Aloe Creme Labs., Inc., 420 F.2d 1248, 1252-53 (7th Cir. 1970) (reversing, on trademark incapacity grounds, a district court decision that Aloe Creme Labs.’ family of ALO- marks for products containing aloe vera gel had acquired secondary meaning) with Aloe Creme Labs., Inc. v. Milsan, Inc., 423 F.2d 845, 849 (5th Cir. 1970) (criticizing the Seventh Circuit’s decision to reverse the district court based on “the application of an appropriate epithet” without considering evidence of secondary meaning).
large hunting dogs. A shift from a generic product designation to a source-signifying trademark would be a prototypical example of such a restriction. Thus, the trademark incapacity doctrine is troublingly inconsistent with historical and cognitive linguistic accounts of semantic shift. The trademark incapacity doctrine is an unfortunate static outlier in an otherwise dynamic system. While secondary meaning is both bestowed by consumers and acquired by the trademark owner, courts refuse to allow the acquisition of trademark protection in a symbol the court concludes was once generic, even when there is evidence that consumers have in fact bestowed source significance on that symbol. Rejecting acquired distinctiveness in ex ante generic terms as mere de facto secondary meaning ignores semantic shifts that have actually occurred. Even if restriction were no more common than any other form of semantic shift, there is no reason from a linguistic standpoint to think terms cannot change, or that consumers cannot process the restriction.

Perhaps courts are instead justified in ignoring restricting shift in the trademark space on normative grounds. There are multiple shades of the normative argument, all of which the semantic shift literature assists us in refuting. First, let us return to this notion that protecting a previously generic term as a trademark conveys something akin to monopoly power. At the extreme, the argument is likely correct much of the time. For example, if we all use the word “computer” to refer to our personal information processing devices, sellers will likely need to use the word “computer” to sell competing devices to us. If one seller is allowed to secure trademark rights in COMPUTER as a mark, other sellers may not be able to tell us what we need to know about their own offerings without exposing themselves to damages and injunctive relief. Trademark rights in COMPUTER seem offensive because we are in the midst of an era where it seems, in America at least, like nearly everyone owns or has

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207 See supra notes 166, 180, 190-191 and accompanying text.
208 See supra notes 171-174 and accompanying text.
209 See Folsom & Teply, supra note 79 at 1323 (positing two types of generic terms: “[(1)] a term that [initially] refers, or [(2)] has come to be primarily understood by the consuming public as referring, to a product category.”). But see Dogan & Lemley, supra note 72 at 793-94 (observing that courts sometimes protect de facto secondary meaning by requiring the second user to mitigate potential confusion with the first user, even though the mark at issue is generic).
210 See STOCKWELL & MINKOVA, supra note 171 at 158.
211 See supra note 63 and accompanying text.
access to a computer. There is no more ubiquitous product designation. Trademark incapacity’s static view seems sensible at that extreme end of the scale, at least at first, although it ignores changes that happen all around us.

Some of the purported harm remedied by trademark incapacity can be couched in terms of language depletion.\(^\text{212}\) If one imagines a static lexicon, it must be the case that allowing a trademark owner to secure rights in a term that is generic is problematic precisely because language doesn’t change, and it is impossible to imagine other generic designations rising to the surface. Trademark incapacity would thus prevent the removal of words from common language.

In the absence of lexical stasis, the language depletion rationale is significantly weaker.\(^\text{213}\) Imagine this contrasting take on the computer hypothetical. One of the first “computers” was imagined by Charles Babbage, who called his conceptual device an “analytical engine.”\(^\text{214}\) If you were to offer a new line of computing devices under the mark ANALYTICAL ENGINE, the term would be unfamiliar to most consumers, if admittedly descriptive. But the etymology would be problematic. The term would have a history, known to those familiar with Babbage’s work. If you try to enforce your rights against me when I sell computers under something like the ANALYTICAL ENGINE mark, a court may reject your claim in accordance with the trademark incapacity doctrine, solely because at some point in time the first computer imagined was known as an analytical engine. Thus, regardless of any evidence of source significance in the eyes of

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\(^{213}\) The depletion or word scarcity justification has more traction in the color depletion context. Despite innovations in the color naming department – for example, Farrow & Ball offers paint in such obfuscatory varieties as babouche, pelt, and brinjal – we tend to think of colors as coming in three primary and three tertiary shades. In fact, many consumers cannot discern subtle differences in shade. The author, for example, scored a 31 on an online color-acuity test, suggesting a less than perfect ability to distinguish between similar shades. Colors can be, and are frequently renamed, but for many consumers, eggplant is just purple. The underlying color perceived does not change.

consumers, or any productive use on my part, your claim against me would fail. Rejecting your claim would also be problematic for consumers who look to the mark ANALYTICAL ENGINE as a source for your computers, and who will be confused by my use of the same term for roughly the same products.

Furthermore, rejecting semantic shift based on the history of the word is a fallacy common to scholars of language and lexicographers more generally. On occasion, new meanings are rejected based on the fallacy known as “argument from etymology.” An argument from etymology refutes a semantic shift, or the growth of a new sense, based on the perceived conflict between the new sense and earlier senses. As C.S Lewis once trenchantly observed, however, the resistance to the new terms often springs up precisely because established words are taking on new meanings.

Second, trademark incapacity might instead be grounded in a different sort of competition analysis, based on a perceived right of competitors that trumps both the right of a putative mark owner and the understanding of consumers. We might call it a preference for

215 See, e.g., GEOFFREY HUGHES, A HISTORY OF ENGLISH WORDS 27 (2000).
216 C.S. LEWIS, STUDIES IN WORDS 18 (1960):

   Statements that honour, or freedom, or humour, or wealth ‘do not mean’ this or that are proof that it was beginning to mean, or even had long meant, precisely this or that. We tell our pupils that deprecate does not mean depreciate or that immorality does not mean simply lechery because these words are beginning to mean just those things. We are in fact resisting the growth of a new sense.

217 See supra notes 66 and accompanying text. Rebecca Tushnet has argued that the point of the functionality and de facto secondary meaning doctrine is to “encourage competition by preventing a single producer from obtaining rights in a phrase that is necessarily generic even if consumers associate the phrase with the market leader – as with AOL’s use of ‘You’ve Got Mail.’” Tushnet might also embrace trademark incapacity for the same reason she criticizes the dilution doctrine: “a doctrine that favors meanings approved by established producers above meanings offered by challengers … is anticompetitive.” Tushnet, Gone in Sixty Milliseconds, 86 TEX. L. REV. at 561. Cf. Irina D. Mantra, Bearing Down on Trademark Bullies, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 853, 853-54 (2012) (“[T]rademark bullying has become a persistent problem achieving anti-competitive results.”). In Abercrombie, for example, the court identifies a competitor’s “right to call an article by its name.” Abercrombie, 537 F.2d at 9. Cf. Stephanie M. Greene, Sorting Out “Fair Use” and “Likelihood of Confusion” in Trademark Law, 43 AM. BUS. L.J. 43, 70-71 (2006) (arguing that allowing a monopoly of a descriptive term creates a barrier to entry because a potential competitor cannot use the descriptive term and therefore must expend more effort to communicate with and attract consumers). See also Linford, supra note 18 at 721-26 (responding to critiques of protection of descriptive terms from a productive use framework).
disruption, an assumption that any communication that cross-cuts a
dominant market player is valuable in and of itself. This disruption
rationale is not entirely inconsistent with the marketplace of ideas
rationale for the First Amendment, which posits that the more speech
we receive (collectively), the more likely that truth will win out.218
But the current incapacity doctrine takes as its default an assumption
that the harm from recognizing trademark rights to consumers and
producers who use the term as a product designation is so great that it
must trump any benefit to consumers who have come to see the mark
as source signifying, or to the producer who has invested in creating
source significance. Thus, the ex ante bar against generic trademarks
is packaged as a competition policy, but nonetheless grounded in the
assumption that some competitors, and some consumers, merit
protection over others.

A doctrine favoring the junior user in the trademark incapacity
context may do so because of a general distrust of trademark owners
and the “black arts” of marketing. Recent trends include
neuromarketing, which purports to make advertisement more
effective by targeting subconscious, rather than conscious
responses.219 If marketers hold the power to shift consumer
perception at a subconscious level, perhaps we should distrust
evidence of shift in consumer perception entirely.220 Unfortunately,
discounting all evidence of consumer perception would effectively
unravel the secondary meaning inquiry entirely. But presuming that
marketers engage in emotional, rather than practical appeals,
consumers might still prefer to purchase products to which they feel
an emotional connection. 221 Furthermore, it is also not clear why we

218 See, e.g., Red Lion Broad. Co. v. FCC, 395 U.S. 367, 390 (1969) (“It is the
purpose of the First Amendment to preserve an uninhibited marketplace of ideas in
which truth will ultimately prevail, rather than to countenance monopolization of
that market ....”).
219 See e.g., Natasha Singer, Making Ads That Whisper to the Brain, N.Y. TIMES
220 But see Marc C. Levy, From Genericism to Trademark Significance:
Deconstructing the De Facto Secondary Meaning Doctrine, 95 TRADEMARK REP.
1197, 1213 (2005):
While corporations with large marketing budgets undoubtedly
have a great deal of power as language users, it is presumptuous
to assume that a single corporation, even with a large marketing
budget, has the ability to cause the majority of consuming
America to forget that the mark is also a common name. It stands
to reason that other forces are likely in play.
221 Bone, Goodwill, supra note 138 at 602-03, citing Phillip Nelson, The Economic
Consequences of Advertising, 48 J. BUS. 213, 213 (1975) (summarizing Nelson’s
should assume marketing tricks are employed exclusively by the senior user, and not the junior user. Questions of the persuasion sophistication of consumers, as Beebe called it, is a problem that applies to any interactions between consumers and any seller, whether that seller is the first entrant, or the most recent entrant. Finally, top-down language shift is limited. For example, MTV used an ad campaign in New York City in a failed attempt to insert new terms into the language, like round as a synonym of cool. If the new terms were adopted, the changes didn’t last, leading at least one scholar to conclude “You cannot sell a language.”

A third way to articulate the justification for trademark incapacity is as part of a broader functionality doctrine. While the Supreme Court’s functionality jurisprudence has been less than clear, it may only slightly oversimplify to say the functionality doctrine prevents the incumbent producer from barring new entrants from selling a product with a given feature unless the product feature is clearly source signifying. Furthermore, some product features are never protectable as source signifying because they are essential features that a competitor needs to use in order to compete. For example, if a product feature like a dual spring design on a traffic sign is considered an essential feature of the product, then a putative mark owner cannot secure trade dress protection – protection for packaging and designs, rather than words or symbols – in the feature, whether or not consumers perceive it as source signifying.

argument that critics lack a normative basis for distinguishing between good (properly adopted) and bad (advertising induced) preferences).

222 See Beebe, Search and Persuasion, supra note 17 at 2025.
223 SETH LERNER, INVENTING ENGLISH 259 (2007).
224 See supra note 67 and accompanying text.
226 See e.g., Wal-Mart Stores, 529 U.S. at 213 (“Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic Trademark Puzzles, 90 VA. L. REV. 2099, 2180 (2004) (“The goal of the functionality doctrine is to strike a balance between limiting the acquisition of market power and reducing information-related consumer harms.”).)
227 But see Dinwoodie, supra note 225 (arguing that the Court has not been clear on whether patented product features are functional because the quid pro quo of patent protection requires those features to be thrust into the public domain, creating a right to copy, or because copying the features is necessary to sell the product and thus necessary to maintain a competitive infrastructure).
229 See supra notes 226-227 and accompanying text.
On the surface, the functionality inquiry (is the product feature claimed one that any competitor would need to use to compete) seems to map closely on to the trademark incapacity inquiry. But trademark incapacity should not fall within the umbrella of functionality for two interconnected reasons. First, the connection between functionality and trademark incapacity is due in part to a misreading of the Supreme Court’s decision in *Kellogg Co. v. National Biscuit Co.* The decision in *Kellogg*, which has an important functionality aspect, is also mistakenly treated as a progenitor of trademark incapacity. In *Kellogg*, the Court denied relief to National Biscuit, which sought to prevent Kellogg from selling a competing breakfast cereal in the same “pillow” shape as National Biscuit (the functionality issue), and using the name “shredded wheat” to do so (the ostensible trademark incapacity issue). The blend of the two concepts in the Court’s regrettably unclear opinion has naturally led some courts and commentators to think the same concerns animate both functionality analysis and application of the incapacity bar. That is unfortunate. As I explain below, understanding semantic shift helps us understand how trademark incapacity and functionality are driven by different concerns. As for *Kellogg*, the case actually turns on whether the term “shredded wheat” had become or was currently operating as a generic designation, rather than its etymology as a generic term in the first instance.

In *Kellogg*, National Biscuit sought to bar Kellogg’s sale of pillow-shaped breakfast cereal biscuits on the ground that both the shape of the biscuits and the name “shredded wheat” were distinctive source signifiers, identifying the product as coming from National Biscuit. The Court denied National Biscuit trademark protection in the pillow shape. National Biscuit’s predecessor in interest held a patent in the pillow shaped biscuits, and the machinery to make

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231 *Id.* at 122. (holding that defendant was entitled to make the biscuits at issue in a “pillow-shape”, because the shape “is functional – [ ] the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.”).
233 *Kellogg*, 305 U.S. at 119-122.
234 *Id.* at 117-119, 121.
236 *Kellogg*, 305 U.S. at 115.
237 *Id.* at 119-20.
them. 238 The patents expired in 1912, thrusting the production method into the public domain. 239 If the shape of the biscuits were treated as a protected source signifier, Kellogg could be barred from practicing the patent and offering the biscuits for sale. The Court instead applied earlier precedent, Singer Mfg. Co. v. June Mfg. Co., in which it had declared that “on the expiration of a patent… there passes to the public the right to make the machine in the form in which it was constructed during the patent.” 240 As the biscuit patents had expired, Kellogg held a right to copy the shape and the method for making the biscuits. 241 However, the Court also acknowledged that the right to copy came with a duty to label the product to clearly identify the competitor as the source of the product. 242

The Court in Kellogg also held that National Biscuit held no exclusive right to use “shredded wheat” as a source signifier. While that part of the holding is cited as an early example of the trademark incapacity doctrine, 243 it instead turns primarily on the Court’s perception that National Biscuit never established that “shredded wheat” had acquired source significance. Trademark incapacity is applied to discount evidence of secondary meaning, 244 but the Court in fact discounted evidence of secondary meaning that National Biscuit presented as insufficient. 245 The Court never opined on whether source significance in the term would be recognized had National Biscuit acquired it. This is a peculiar starting place for the doctrine of trademark incapacity, as the central feature of doctrine is to deny protection to terms that were once generic, whether or not they later acquire source significance. In addition, the Court noted that

238 Dinwoodie, Kellogg, supra note 225 at 239.
239 Kellogg, 305 U.S. at 114 (“[The district court] held that upon the expiration of the [patent], the name of the patented article passed into the public domain.”). See also Dinwoodie, Kellogg, supra note 225 at 11.
240 163 U.S. 169, 185 (1896).
241 Kellogg, 305 U.S. at 119.
242 Id. at 118 (citing Singer).
243 See e.g., A.J. Canfield Co. v. Honickman, 808 F.2d 291, 297 (3d Cir. 1986); Graeme W. Austin, Trademarks and the Burdened Imagination, 69 Brook. L. Rev. 827, 922 (2004) (“The leading case on de facto secondary meaning is the Supreme Court’s decision in Kellogg…, which held that there was no trademark rights in “shredded wheat,” despite the fact that consumers recognized that there was a single source of the product.”).
244 See supra Part I.C.
245 Id. (“[T]o establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer. This it has not done.”).
Kellogg’s right to make the article included “the right to use the term by which the public knows it.” 246 The present tense of “knows” here is telling. As the Court articulates it, “shredded wheat” was at that point in time a generic designation for the product in question,247 and even if it hadn’t become a generic designation, National Biscuit’s evidence of secondary meaning was insufficient.248 Kellogg has simply been misunderstood by many courts as a trademark incapacity case.

Restrictive change happens all the time, while a shift in the necessity of offering a particular product or product feature most likely does not. Functionality assumes (correctly, I think) that the core aspects of products do not change over time.249 When a product or process has been patented, the public and competitors get the promise of eventual open competition after the patentee’s window of protection closes. That is the quid pro quo built into the offer of patent rights to inventors. When the patent expires, the product, or the process of making it, becomes part of the public domain. Any competitor can produce and sell the product, and competition between multiple sellers should drive prices toward the marginal cost of production (what it costs to make the product). This competition saves consumers money. Likewise, in the absence of patent rights over the product or the process of making the product, multiple parties should be allowed to offer the product for sale. For products and product features in the public domain, the features do not change. However, their popularity might change. For example, there is limited (but growing!) demand for vinyl record players and fixed-gear bicycles, because most producers offer different, if not advanced technologies, and most consumers prefer them. When market demand changes, producers offer updated products to meet that demand. Sometimes, the new product will be subject to a patent term, and sometimes it will not, but competitors enter the market in the way described above.250

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246 Kellogg, 305 U.S. at 118 (citing Singer); see also id. (use of the name SHREDDED WHEAT “was essentially necessary to vest the public with the invention that became theirs on the expiry of the patent”).

247 In addition, the Court concluded that Kellogg clearly met that obligation, making “every reasonable effort to distinguish its product” from National Biscuit’s product. Kellogg, 305 at 120-21. See also infra notes 291-304 and accompanying text (describing the limits of unfair competition protection in trademark incapacity cases).

248 Kellogg, 305 U.S. at 118-19.

249 Cf. Joseph Miller, Error Costs & Functionality Exclusions (the presumption that trademark protection is weaker than other regimes may hold true for word marks, but not for product design) (draft on file with author).

250 Cf. Bone, Enforcement Costs, supra note 68 at 2157 (“[T]here is a special
The availability of that product feature or process in public domain for copying does not change because the product is no longer as popular as it once was, although the lack of popularity may well discourage copying.

As I explained in detail in Part II, language is different. Stasis is a feature of dead languages, but not living ones. The meaning of words, as well as the number of words in the lexicon, are in persistent flux. New words are continually added, and old meanings are lost to time as semantic overload pushes speakers away from extreme homonymic conflict. Restriction, the narrowing of meaning of a general term to a prototypical representation, is a frequent form of language change, and by some accounts, the most frequent form. 251 The stasis that drives the functionality analysis for product features is suboptimal in the context of word marks. Trademark law has, to date, artificially hampered recognition of this fundamental change when it occurs, but that puts the law in tension with realities of semantic change in a way that can impose real costs on consumers, costs that trademark law is ostensibly designed to mitigate.

A fourth justification for trademark incapacity might instead turn on enforcement costs. 252 Enforcement costs come in two general varieties: administrative costs, i.e., the cost of getting an answer; and error costs, i.e., the costs imposed on litigants and society if a court reaches the wrong answer. 253 If the majority of trademark incapacity cases are like the COMPUTER hypothetical above, we could conclude that a shift in meaning from computer as generic product designation to COMPUTER as a source signifier is so unlikely to happen that we should avoid the administrative cost of finding out whether it does. The trademark incapacity doctrine may alternately presume that the harm from a false positive (the shift has not occurred, but the court concludes the mark can be protected) is greater than the harm from a false negative (the shift has occurred, but the court concludes the mark cannot be protected). Thus, denying protection problem with protecting trade dress that does not apply to word marks. Enjoining other firms from using a design feature can impede competition in the product market when the design feature serves an important function for the product itself.”).

251 See supra Part II.C.
252 See supra note 68 and accompanying text.
253 See Bone, Enforcement Costs, supra note 68 at 2123 (“In general, there are two types of enforcement cost: administrative (or process) costs and error costs.”).
under the doctrine may turn on a perceived imbalance in error costs.\textsuperscript{254}

Both the administrative and error cost analyses turn in part on the relative frequency with which we should expect restricting shifts.\textsuperscript{255} While our intuitions might suggest caution at the extreme, applying the trademark incapacity doctrine likely increases error costs in many cases. The error cost account does not support the doctrine of trademark incapacity. Restrictive change is a fundamental, frequently occurring type of semantic shift. A trademark regime that ignores this reality introduces error into its structure. In fact, the doctrine may be error creating because it misapprehends how commonly restriction occurs. If restriction happens as often, more often, or more naturally than widening, our current trademark law introduces error by pretending restriction cannot happen or happens so rarely that it should be ignored. In addition, the doctrine drives courts to (look for doubt) in the historical record, to ignore evidence of language change, and to engage in “faulty” compartmentalization of marks comprised of two or more words (like HOTELS.COM, CHOCOLATE FUDGE SODA or TURBODIESEL).\textsuperscript{256} Likewise, an error cost analysis must turn in part on whether the consumers confused by a false negative are harmed to a greater or lesser extent than those harmed by a false positive. In a way, this resonates with the test for injunctive relief, which requires courts to balance not only harms to the litigants, but to the public at large. These concerns are critical in the trademark context, because the harm the system is supposedly optimized to prevent is harm to consumers.

We can understand the error cost analysis better as we consider a final purported justification for trademark incapacity. Some have suggested that allowing a generic term to acquire source significance will increase consumer search costs.\textsuperscript{257} In a way, that argument mirrors the monopoly power argument from above. Consumers who can find only one type of computer because of the trademark rights of the company marketing COMPUTER brand computers, might miss a product they would prefer to buy if only competitors could use the term “computer” to sell it to them. But if

\textsuperscript{254} Cf. Joseph Miller, \textit{Error Costs & IP Law}, 2014 U. ILL. L. REV. 175 (describing how in close cases, courts should put a thumb on the scale against interpreting IP provisions broadly, because the cost of a false positive is higher than the cost of a false negative).

\textsuperscript{255} Id.

\textsuperscript{256} See supra notes 47-48, 52-54, and accompanying text.

\textsuperscript{257} See also supra note 69 and accompanying text.
the proper scope of trademark law focuses on minimizing consumer search costs and providing them with the ability to rely on representations about goods and services, then it is the trademark incapacity doctrine that should give us pause.

If consumer confusion and consumer search costs are phenomena we hope to mitigate, if not eliminate, trademark incapacity is the wrong approach because it will exacerbate confusion in many instances. While courts have posited that protecting a descriptive or generic term increases consumer search costs because it prevents competitors from providing consumers with information they need about the products offered that is the case so long as the term is generic or merely descriptive, but has little to do with whether the term was once generic or merely descriptive, or may become so. The search cost problem applies less strongly in those cases where the number of consumers who see a term as generic is small.

The consumer search cost problem is most readily understood by considering how a trademark loses protection. A mark can lose trademark protection if it ceases to serve as a source signifier. Recall that SINGER and GOODYEAR RUBBER were both marks that fell out of protection, but subsequently re-acquired source significance. This slide out of protection (which elsewhere I have called “generislide”) has happened to multiple brands over the years, including aspirin, cellophane, and escalator. Courts do not ask whether every consumer sees the mark as a generic designation. Rather, courts considering a claim of ex post genericness look for

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259 See, e.g., Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 14 (1st Cir. 2008) (“[I]n accord with the primary justifications for protecting trademarks—to aid competition and lower consumers’ search costs—the law does not grant any party exclusive rights to use generic terms as trademarks.”).

260 Cf. generally Grynberg, supra note 199 (arguing that defendants in trademark litigation may serve as proxies for consumers who are not confused by, and may prefer the information conveyed by, the allegedly confusing use); Goldman supra note 199 (describing multiple constituency problems in the internet search context).


262 See supra notes 60-62, 204-206, and accompanying text.

263 Linford, Semantic Shift and Trademark Expiration (draft on file with author).

264 Bayer Co. v. United Drug Co. 272 F. 505, 512 (S.D.N.Y. 1921) (holding that aspirin had become a generic mark to consumers, but not pharmacists, who were familiar with the chemical name acetylsalicylic acid); Du Pont Cellophane Co. v. Waxed Products Co., 6 F. Supp. 859 (E.D.N.Y. 1934); Haughton Elevator Co. v. Seeberger, 85 U.S.P.Q. (BNA) ¶ 80 (Apr. 3, 1950).
evidence that a majority of the relevant consumer base now uses the mark as a generic product designation. Once a majority of consumers see the mark as a product designation, it no longer retains its source significance as a legal matter. Mark Lemley and Stacy Dogan have noted the law is willing to “sacrifice” the interests of consumers who still see a mark as source signifying “as soon as a critical mass of consumers treats the term as generic,” because “the harm to consumers who associate the term with the entire class of goods outweighs the harm to the diminishing number who view it only as a mark.” This primary significance standard suggests a majority wins rule for how the law should handle a shift from protectable source signifier to unprotectable product designation.

However, this primary significance standard is not applied when ex ante generic terms add source significance. The trademark incapacity doctrine tolerates consumer search costs that are discouraged in other areas of trademark law. The rationale underlying the doctrine is generally couched in terms of competition policy – competitors cannot effectively enter the market if they cannot identify to consumers that their product or service is a potential substitute for the products or services of prior market entrants. The concern is that if a prior entrant secures rights in a generic term, one that is the “language word” for the product or service, the prior entrant holds an effective monopoly and competitors will be hard-pressed to accurately or adequately identify themselves to consumers.

This apprehension drove the Supreme Court’s analysis in Kellogg, a generislide case. There, the Court contemplated the competitive impact of granting National Biscuit an exclusive right to

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265 See also infra notes 276-279 and accompanying text. The Xerox Corporation has been fighting the trend for decades. See, e.g., Linford, Semantic Shift and Trademark Expiration (draft on file with author) (describing Xerox’s efforts). As described above, the marks SINGER for sewing machines and GOODYEAR for rubber products experienced generislide, and later reacquired distinctiveness. See supra notes 60-61.
266 Dogan & Lemley, supra note 72 at 793 (“[T]he genericness doctrine can impose search costs on consumers, particularly when a once-famous mark such as ‘aspirin’ or ‘thermos’ becomes generic.”). Courts do not always leave those confused consumers, and the producers who sell to them, without remedy. See infra notes 278-282 and accompanying text.
268 Id.
use the term “Shredded Wheat” when that was the term by which consumers had come to identify the product sold by both parties.\textsuperscript{271} Denying Kellogg the right to refer to the product by name, limits its ability to communicate with interested consumers. This results in an increased price for the “official” shredded wheat product line as competitors struggle to find a different, but sufficiently similar name by which to identify their competing products. However, this harm to competition turns on the needs of consumers to refer to a given product as shredded wheat. If the primary meaning of the commonly known has changed, competition is not necessarily endangered by granting trademark protection for terms that have acquired distinctiveness.\textsuperscript{272} In a counterfactual world where the majority of consumers see shredded wheat not as a product category but instead as a brand name, the competitive harm story is as not persuasive.\textsuperscript{273}

The counterfactual helps us see that competition analysis cannot be cleanly divorced from consumer confusion. Generislide is justified on the ground that the majority of consumers see the term as a designation for a type of product, even though some consumers will find it more difficult to locate the product they want if, for example, they think of XEROX as a particular brand of photocopier. In such a situation, the mark must fall into genericness so that competitors can sell their own branded ‘xerox’ machines. The same search cost problem presents itself when a formerly or potentially generic term acquires a source-signifying meaning for a majority of consumers, but under the trademark incapacity doctrine, courts and examiners are required to discount it. The trademark incapacity doctrine thus appears driven by the notion that the use of a term as a nominative product designator always trumps adjectival trademark use, even if a majority of the public sees the term primarily as a trademark, rather than a generic designation.

It may be instead be the case that the junior user stands as a proxy for consumers who benefit from potentially confusing speech, or who easily overcome confusing information. Michael Grynberg, for example, has argued that courts should more expressly recognize that the defendant in a trademark lawsuit may serve as a proxy for

\textsuperscript{271} Id. at 118.
\textsuperscript{272} Scholars engaging in economic analyses of trademark law argue the trademark incapacity doctrine is likely inefficient. See e.g., Desai & Rierson, supra note 62 at 1832-33; Bone, Enforcement Costs, supra note 68 at 2124.
\textsuperscript{273} But see Lisa P. Ramsey, Descriptive Trademarks and the First Amendment, 70 Tenn. L. Rev. 1095 (2003) (arguing on First Amendment grounds that descriptive marks do not merit trademark protection).
consumers who benefit from the junior user’s entry. Such a focus, from Grynberg’s perspective, would minimize problematic trademark expansion.274 Eric Goldman has made a similar argument in the internet search context, arguing that at least some consumers benefit from search results for a given brand that present competing brands (for example, presenting results for Adidas shoes when a searcher types in Nike), in part because searchers are not adept at selecting search terms.275

But if there is clear evidence about the relative size of the constituencies, then the proper test of acquired distinctiveness, at least for an ex ante generic term, should be primary significance. If we buy into the consumer search cost / consistent message arguments in favor of trademark protection, we might seek to minimize confusing ambiguity, deception, and even some level of free riding because free riding inevitably introduces some level of confusion. Primary significance is the standard already applied by courts to determine whether a mark has become generic and is therefore legally abandoned.276 The next Section operationalizes a primary significance standard for ex ante generic terms, and provides two alternative proposals: a replacement rule, and stronger unfair competition protection for “generic” terms with a strong showing of de facto secondary meaning.

B. Embracing Semantic Shift and Locating Primary Significance

As discussed above, courts faced with a genericness challenge to a protected mark apply a primary significance test to determine if the mark retains distinctiveness. As one court recognized, “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”277

276 15 U.S.C. § 1127 (“A mark shall be deemed “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.”).
The primary significance rule is consistent with how a court determines a mark has fallen out of protection. As discussed above, if the majority of consumers see a particular term as a brand rather than a product category, generislide has not occurred. But if the majority see the term as a product designation instead of a brand, the producer loses the right to the mark. The traditional TEFLON and THERMOS surveys applied in generislide disputes seek to ascertain how consumers perceive and use the challenged mark. For terms that have been generic designations at some point in time, the primary significance standard would be sufficient to indicate a significant shift in meaning among the population measured. Courts are familiar with the primary significance standard used currently in generislide disputes, and could easily apply the same standard on the ex ante side of the genericness inquiry.

The primary significance standard is also consistent with other inquiries into the protectability and strength of trademarks. Generally, in secondary meaning surveys, 50 percent recognition of a mark by consumers "is regarded as clearly sufficient to establish secondary meaning." On the other hand, courts have held that a trial court’s description of 15 percent confusion as “small” was in error, concluding that the responses indicated sufficient confusion, mistake, or deception to “establish the [mark owner’s] right to relief.” While primary significance might seem like a relatively low bar for a generic term to acquire distinctiveness, it is a higher bar than the law currently requires for protecting other categories of marks.

278 See supra notes 261-266 and accompanying text. See also Palladino, Assessing Trademark Significance, 92 TRADEMARK REP. at 877 et seq.
279 See AmCan Enters., Inc. v. Renzi, 32 F.3d 233, 234 (7th Cir.1994) (denying trademark protection in the term “yellow pages,” noting that the term had fallen into generic usage among consumers over time).
280 See generally Linford, Semantic Shift and Trademark Expiration (draft on file with author)
281 Spraying Systems Co. v. Delavan, Inc., 975 F.2d 387, 394 (7th Cir. 1992). See also Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 381 (7th Cir. 1976) (responses to a likelihood of confusion survey indicated that over 50% of respondents identified plaintiffs products with defendant’s mark, from which the court concluded that “an extremely significant portion of the population associates [plaintiff’s] products with a single anonymous source.”).
282 James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 279 (7th Cir. 1976). See also Union Carbide, 531 F.2d at 386. (survey results showing confusion levels of 11.4% to 25% have been considered significant); McDonough Power Equip., Inc. v. Weed Eater, Inc., 208 U.S.P.Q. (BNA) ¶ 676 (Trademark Tr. & App. Bd. Jan. 15, 1981) (significant confusion where 11% of respondents associated plaintiff’s and defendant’s marks with a common company).
Applying the primary significance rule would not even require a change to federal trademark law. The Lanham Act includes language which embraces the concept of semantic shift. For example, a registered trademark can be cancelled if it “becomes the generic name for the goods or services … for which it is registered.” Textually, the Act requires cancellation if a mark becomes generic, but not if a mark is currently source signifying, even if it was generic at one point. In essence, the standard prescribed by Congress for determining whether the mark has become generic is the primary significance standard. The Act also specifies grounds on which the Trademark Office may reject an application, including a determination that the mark “is merely descriptive” of the goods or services of the applicant. The statute does not grant refusal based on whether the mark was ever descriptive, but instead merely inquires whether the mark is descriptive at the time of application. While the statute does not compel this Article’s preferred rationale, it provides no obstacle to it.

If a broad primary significance standard is too radical, a replacement rule could be used for generic terms instead. Under such a replacement rule, a generic term could only acquire trademark protection if the old meaning is virtually undone. This result would

283 See also Marc. C. Levy, From Genericness to Trademark Significance: Deconstructing the De Fact Secondary Meaning Doctrine, 95 TRADEMARK REP. 1197, 1211 (2005); 3 CALLMANN ON UNFAIR COMP., TR. & MONO. § 20:33 (4th Ed.) (describing in detail how “[t]he Lanham Act does not appear to compel the retention of the trademark incapacity doctrine.”).


285 Id. In 1984, Congress passed the Trademark Clarification Act, P.L. 98-260, to reverse the effect of the decision in Anti-Monopoly, Inc. v. General Mills Fun Group, Inc. 611 F.3d 296 (9th Cir. 1979) and restate the traditional test for ex post genericness, which inquired into the primary significance of the term to the purchasing public. The primary significance test is now part of the statutory language, at least with regard to the generislide of a registered mark. 15 U.S.C. § 1064(3) (“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.”).


287 See, e.g. Ex Parte Pocket Books, Inc., 91 U.S.P.Q. (BNA) 182, 185-86, 1951 WL 4315 (Chief Examiner 1951) (refusing registration for Pocket Book for pocket-sized books and noting “[i]t would appear that before the word could be considered a trade mark, it must become practically obsolete as a generic name for the article and must be recognized by the public as a trade mark rather than as a generic term of the English language …. In a case of this kind, it is believed that distinctiveness as a trade mark should not be recognized without complete overwhelming proof.”).
be in line with the Restatement (Third) of Unfair Competition, which proposed that when a term has a preexisting generic meaning, a seller cannot acquire trademark rights in the designation, unless the preexisting generic meaning has become obsolete.288 At least one court reads Singer as a case where the trademark resurrection occurred precisely because the Singer mark “had wholly lost in then contemporary public usage its generic meaning”.289

Applying this replacement rule would avoid the most absurd results of the trademark incapacity doctrine. For example, a producer could secure protection in the mark CODE for a line of clothing, perhaps even baptismal or ceremonial clothing, without running afoul of a historic generic meaning that no longer has any currency with the public. However, the replacement rule would likely leave marks like KISSES without trademark protection, where nearly 17 percent of survey respondents identified KISSES as a generic term, even though 80 percent perceived KISSES as source signifying.290

Another possibility would be to provide greater unfair competition protection for “generic” terms with a strong showing of de facto secondary meaning on unfair competition grounds, pursuant to section 43(a) of the Lanham Act. Courts have recognized this as a possibility in cases where the trademark incapacity doctrine is seen to bar protecting a term as a trademark. Courts have applied unfair competition remedies to create some distance between senior and junior users of generic terms, where the senior user has acquired de facto secondary meaning. The rationale is that the senior user’s claim to a mark is weak, and thus the senior user is entitled only to that “relief that will eliminate public confusion over … sponsorship.”291 For example, in Genesee Brewing Co. v. Stroh Brewing Co.,292 the Court of Appeals for the Second Circuit noted that a junior user is obligated to use “every reasonable precaution to prevent confusion or the practice of deception in the sale of its product,”293 even when using a generic product designation.294 Perhaps the common law of

289 Miller Brewing Co. v. Falstaff Brewing Corp., 655 F.2d 5, 7 n.2 (1st Cir. 1981).
See also CALLMANN § 20:33.
290 See supra note 58 and accompanying text.
291 Home Builders Ass’n of Greater St. Louis v. L&L Exhibition Mgmt., Inc., 226 F.3d 944, 950 (8th Cir. 2000).
292 Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137 (2d Cir. 1997) (holding HONEY BROWN generic as applied to ales and affirming denial of plaintiff’s motion for preliminary injunction).
293 Id. at 151 (quoting Kellogg, 305 U.S. at 122).
294 Id. at 150. See also Gaylord Entm’t Co. v. Gilmore Entm’t Grp., 187 F. Supp.
unfair competition, and its statutory embodiment in Section 43(a) of the Lanham Act, is sufficient to protect the secondary meaning acquired in a generic mark, even though courts refuse to recognize evidence of secondary meaning and thus deny protection to those marks.

There are two problems with the unfair competition remedies. First, some cases call into question whether courts will apply unfair competition protection, even in light of evidence of consumer confusion. For example, in BellSouth Corp. v. White Directory Publishers, Inc., the court discounted evidence of consumer confusion on the ground that a mark, once dedicated to the public, could never be pulled back into trademark protection.

Second, even when courts provide unfair competition relief to senior users, courts have relied primarily on disclaimers requiring the junior user to disavow connection with the senior user. These disclaimers are likely ineffective. Rebecca Tushnet notes that prominent disclaimers might work when research respondents encounter “tombstone ads” – print only ads that are highly informational – but they rarely work in the context in which they are encountered. Other research suggests that disclaimers actually have a reverse effect. Consumers presented with disclaimers are in many

2d 926, 951 (M.D. Tenn. 2001) (stating a trier-of-fact could determine that the defendant engaged in unfair competition in its activities related to the adoption, promotion, and solicitation sales of the disputed mark, even if the term “Opry” were generic, so long as the unfair competition claim was not predicated solely on the defendant’s use of the term “Opry”).


42 F. Supp. 2d 598, 612 (M.D.N.C. 1999) (“Where the record so conclusively establishes that a term was placed in the public domain as a generic symbol by its creator and has been so used for over thirty years by all in the industry, including the proponents of the mark and its predecessors, survey evidence such as that presented by BellSouth cannot serve even to create a genuine issue as to the status of the mark.”).

cases more likely to associate the product sold with the source disclaimed.298

The failure of disclaimers to clear up confusion has been observed in other contexts as well. One FDA study indicates that in some cases, survey respondents were more confident that food provided health effects when the statement of the health effect was qualified or somewhat disclaimed than when the health claim was unqualified.299 Text only disclaimers were unsuccessful at indicating different levels of scientific support for certain health claims.300 In addition, disclaimers didn’t change the positive view of the health claim when consumers held an existing, erroneous belief in the health claim.301

A better response under § 43(a) might be something like a strong form of the remedy ordered in King-Seeley Thermos Co. v. Aladdin Indus., Inc.302 There, the court concluded that while King-Seeley’s mark THERMOS for vacuum bottles had fallen into generic usage in the minds of most consumers, some segment of the market still recognized THERMOS as a mark for King-Seeley’s goods.303 Thus, the court ordered injunctive relief requiring Aladdin to precede any use of the word ‘thermos’ with its house mark, to confine its use of ‘thermos’ to the lower-case ‘t,’ and never to use the words ‘original’ or ‘genuine’ in describing its product.304

The prescription preferred by this article is to do away with the per se bar against acquiring distinctiveness in generic terms. Instead, the proper rule should be a primary significance rule. If there is evidence that the majority of consumers have come to see the term

300 Id.
301 Id. The value of the FDA study in describing behavior of disclaimers more generally may be mitigated in part by a strong tendency of consumers to believe in spurious health effects. See Ben Goldacre, BAD SCIENCE or BAD PHARMA, (consumers “invite [magical claims about health benefits] because we want to live in a simple universe of rules with justice, easy answers, and predictable consequences.”).
302 321 F.2d 577, 581 (2d Cir. 1963).
303 Id. at 579 (“[T]here is an appreciable, though minority, segment of the consumer public which knows and recognizes plaintiff’s trademarks).
304 Id. at 581.
as source signifying rather than product designating, the term should be treated like any other trademark. Whether one embraces replacing the primary significance test, the higher bar of the replacement rule, or strengthening unfair competition protection in trademark incapacity cases, any of these moves would be an improvement over the status quo, which leaves the public and the mark owner at the mercy of ineffective disclaimers and the occasional judicial outlier.

CONCLUSION

Semantic shift – an addition to the public lexicon – is driven simultaneously by a need to communicate and a need to resolve confusing ambiguity. Investing a mark with source significance is a type of semantic shift. Like any other entry into the creative lexicon, trademarks are created to fill a communicative need. But the doctrine of trademark incapacity simultaneously disregards a common form of semantic shift and exacerbates consumer confusion.

Seeing trademark creation as semantic shift reminds us that sound competition policy cannot neglect the importance of producer activity or consumer comprehension. Instead, proper functioning trademark law must take into account consumer perception and properly weight consumer confusion. The doctrine of trademark incapacity does neither. Instead, we should adopt a primary significance test for determining whether a mark that was once generic has acquired sufficient distinctiveness to merit trademark protection. Then trademark law would better match its accepted rationale, and trademark acquisition would function more properly as a form of semantic shift.