

Trademark Hybridity and Brand Protection

Timothy Greene*

What’s in a word? As it turns out, quite a lot. The vast majority of words in our language, including trademarked terms, signify a variety of conceptual meanings and senses. This idea of splintered definition—described in the psycholinguistics literature as “semantic ambiguity” and offered in two flavors: “homonymy” (divergent and unrelated meanings) and “polysemy” (divergent yet related senses)—is underrepresented in trademark law. As a result, there has been a proliferation of legal doctrines that fail to accurately describe our linguistic lives, most notably including dilution and genericness. This Article draws on psycholinguistics literature on semantic ambiguity resolution to highlight these doctrinal failures and proposes several ways in which the law might better account for polysemy and homonymy. In addition to bringing the law into line with the lived experience of language, these changes have the added benefit of promoting the communicative and competitive interests at the heart of trademark law.

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* Nonresidential Fellow, Center for Internet and Society, Stanford Law School. Thanks (and apologies) to the many friends and scholars who reviewed drafts of this Article. All errors in the text are mine.

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INTRODUCTION

What does the word “fly” mean? It could mean beautiful (“Shorty stay fly, that’s why I keep her”),¹ an insect of the order *Diptera* (a fruit fly), travel through the air, the opening on the front of a pair of pants (“zip your fly”), a baseball hit into the air (a “pop fly”), or a particular route a wide receiver runs in football (“Vernon Davis is the NFL’s premier fly route running tight end”). These definitions are context dependent—linguistically, visually, and spatially. They are also minimally confusing when the context is clear. If someone says she “caught a fly,” she could mean different things. And whether the listener understands her to mean she intercepted a baseball or captured a bug will depend on circumstances including where she was or what she had in her hand (a baseball mitt or a bell jar).

This kind of context-specific meaning is well recognized across academic domains.² Yet (with certain exceptions discussed below), trademark law generally overlooks the idea that a term can connote separate concepts without confusing consumers (or harming producers).³ This overlooked idea has important implications for

1. 50 CENT, *Do You Think About Me*, on BEFORE I SELF DESTRICT (Aftermath 2009).

2. See, e.g., LEXICAL AMBIGUITY RESOLUTION: PERSPECTIVES FROM PSYCHOLINGUISTICS, NEUROPSYCHOLOGY, AND ARTIFICIAL INTELLIGENCE (Steven L. Small et al. eds., 1988).

3. Though the idea certainly hasn’t escaped scholars, especially those with a cultural or semiotic bent. See, e.g., Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent?: Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 149 (1996) (“If, indeed, symbols are routinely assigned multiple meanings, the law ought to start from the premise that audiences have a great deal of experience with confusing signals and that, absent a specific reason to believe otherwise, the interpretive

various trademark doctrines.

Most words are ambiguous. They are “polysemous” or “homonymous.” Homonymy is perhaps easier to understand, and more or less refers to words that have *unrelated* meanings by historical accident.⁴ To take one simple example, “bank” may refer to a financial institution or, among other things, a river’s edge.

Polysemy, by contrast, is a bit more difficult to understand, but is, in fact, much more pervasive than homonymy. Polysemy refers to the phenomenon whereby words develop *related* meanings (“senses”), often through productive relationships found in most words in a semantic domain.⁵ For example, “paper” may refer to, among other things, a material on which writers write (a piece of paper), a newspaper (“I’m going to pick up the paper before heading into the office”), or an entity that runs a newspaper (“the paper just fired five journalists”). So, homonymy refers to *unrelated* “meanings,” while polysemy refers to *related* meanings, referred to as “senses.”

This Article mines psycholinguistics research on how people actually resolve these semantic ambiguities in real time in order to place some thorny issues in trademark law into perspective. For example, many firms make “thermoses,” including Stanley, Aladdin, and Thermos LLC (the successor to the original THERMOS mark). Although Thermos LLC

strategies that a listener ordinarily pursues will also be used in the marketplace.”); Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1342 (2010) (“The use of the lowercased (by implication in aural speech) ‘coke’ does not indicate that ‘Coke’ no longer serves as a proper name; rather, it simply means that the lowercased form is used to refer to a category of similar items (‘drinks that are like Coke’), just as ‘xerox’ is often used to refer to a category of photocopiers, of which ‘Xerox’ is one, and ‘tylenol’ is used to refer to the drug with the formulaic name of acetaminophen, of which ‘Tylenol’ is a particular brand name.”); see also Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 413 (1990) [hereinafter Dreyfuss, *Expressive Genericity*] (“[S]ome words have core denotations . . . and a set of connotations that depend upon their history, derivation, and identification with users.”).

4. A quick disclaimer: many homonyms can be traced back to semantic drift that has taken place over the course of hundreds of years. The key thing to remember is that, for the average person encountering these terms, they will not easily recognize those connections. Thus, for all practical purposes, the words’ meanings are unrelated.

5. One good example of polysemy’s natural occurrence is provided by Albert Hirschman, who traced the semantic drift of the term “interest” in the first chapter of his book *The Passions and the Interests*. See ALBERT O. HIRSCHMAN, *THE PASSIONS AND THE INTERESTS* 31–41 (1977). As Hirschman shows, the term “interest”—as in “self-interest” or “interest groups”—began as something of a catch-all for “a disciplined understanding of what it takes to advance one’s power, influence, and wealth.” Over time, “interest” took on a more constrained definition, connoting only “material, economic advantage.” *Id.* During this period of drift, various thinkers tried to tie down the word’s meaning, to no avail. As a result, these thinkers often talked past one another when detailing the costs and benefits of using “interest” talk as a guide to the good life.

can't prevent Stanley and Aladdin from calling their products "thermoses,"⁶ Thermos LLC continues to operate a very strong brand using a stylized version of THERMOS as a trademark. In the market for vacuum bottles, Thermos LLC distinguishes its THERMOS brand from other producers' vacuum bottles based on contextual features⁷ used with the term. If someone asks "can you get me a thermos?" your answer may depend on spatial clues. Are you online at Amazon.com, shopping a smorgasbord of vacuum bottles? You may be likely to order the THERMOS-brand bottle. Are you in a kitchen? You might reach for any brand vacuum bottle (THERMOS or not) rather than a coffee mug. And if you have a choice among vacuum bottles, you might select based on a visual cue: the particular stylized font Thermos LLC uses for its company logo.⁸ To take an example closer to this author's heart, a trademark lawyer's understanding of what a speaker means by "Abercrombie" will likely depend on whether the conversation is about trademark law or the lawyer's teenage daughter.⁹

We should not be surprised that terms can carry multiple significances—here, at least two: generic product and specific source.¹⁰ Yet the law usually does not recognize this except in haphazard and inconsistent ways. Professors Folsom and Teply recognized the false binary between "source" and "generic" as early as 1980, but it still remains for the most part unaddressed in the law.¹¹ Following their

6. King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963) (affirming the district court's decision that "thermos" had become generic for vacuum flasks).

7. Throughout this Article, I use the term "context" to refer broadly to those elements that lend texture to our experiences. For example, context might include visual indicators such as color, shape, size, typeface, and logo location on packaging, spatial indicators like geographic closeness—where is the product placed on the shelf?—or linguistic context such as spelling, punctuation, location within a phrase or sentence, and so on.

8. See Thomas R. Lee et al, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1099 (2009) (discussing how customers rely primarily on non-linguistic, visual cues rather than a mark's semantic meaning).

9. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (establishing a taxonomy of word mark types).

10. Cf. ADAM ARVIDSSON, *BRANDS: MEANING AND VALUE IN MEDIA CULTURE* 8 (2006) ("[B]rands do not so much stand for products, as much as they provide a part of the context in which products are used. This is the core component of the use-value that brands provide consumers with.").

11. See Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1350 (1980) [hereinafter Folsom & Teply, *Trademarked Generic Words*] (arguing the binary categorization of "common" and "brand name" is the largest problem with then-current approaches to trademark genericness); see also Ralph H. Folsom & Larry L. Teply, *Surveying 'Genericness' in Trademark Litigation*, 78 TRADEMARK REP. 1 (1988) [hereinafter Folsom & Teply, *Surveying 'Genericness'*] (setting forth a model for more accurately surveying genericness and accounting for hybridity); Ralph H. Folsom & Larry L. Teply, *A Reply to Swann and*

lead, in this Article I use the term “trademark hybridity” to refer to a trademark’s ability to simultaneously connote a variety of meanings and senses. But trademark hybridity isn’t limited solely to product (generic) and source significance¹² as Professors Folsom and Teply implied. A rich literature has developed around the premise that, in addition to trademarks’ value in signifying source and raising brand awareness, they are also used expressively,¹³ nominatively,¹⁴ and descriptively.¹⁵ Through their adoption as cultural signifiers, trademarks are necessarily infused with social meanings.¹⁶

A given term need not be understood *only* as a generic term or *only* as a source identifier. Indeed, a term *cannot* merely be understood as such. Rather, all terms—and perhaps *especially* words used as trademarks¹⁷—embody multiple concepts with little quantifiable (internal or external) confusion. People use context to provide semantically ambiguous words with meaning in every sentence we speak, hear, read, or write. Trademarks are source identifiers, but what is often overlooked is how

Palladino’s Critique of Folsom and Teply’s Model Survey, 78 TRADEMARK REP. 197 (1988) [hereinafter Folsom & Teply, *A Reply to Swann*].

12. For clarity, Folsom and Teply do not use “product” and “source” significance to describe dual hybridity. Rather, they describe a trademarked term’s “product” and “producer” senses.

13. See *E.S.S. Entm’t 2000 v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (“[O]nly the use of a trademark with “no artistic relevance to the underlying work *whatsoever*” does not merit First Amendment protection In other words, the level of relevance merely must be above zero.” (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989))).

14. See *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 309 (9th Cir. 1992) (affirming district court’s judgment in favor of defendants based on the argument that “New Kids” was used to refer nominatively to the New Kids on the Block); *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969) (“[In] advertising [the repair of Volkswagen cars, it] would be difficult, if not impossible, for [appellee] to avoid altogether the use of the word ‘Volkswagen’ or its abbreviation ‘VW,’ which are the normal terms which, to the public at large, signify appellant’s cars.”); see also *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (“When the [word] mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.”).

15. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 115–16 (2004) (discussing “microcolor” permanent makeup); *Schmid Labs. v. Youngs Drug Prods. Corp.*, 482 F. Supp. 14, 17–20 (D.N.J. 1979) (discussing “ribbed” condoms).

16. Cultural studies scholarship has much to contribute to our understanding of how trademarks are reconstituted, reappropriated, and reused in culture. See, e.g., SARAH BANET-WEISER, *AUTHENTIC(TM)* (N.Y.U. Press 2012) (illustrating the ways in which various cultures, such as contemporary religion and femininity, are increasingly understood within the language of brands); ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW* (Duke Univ. Press 1998) (describing how intellectual property protection both restricts and compels certain types of cultural appropriation).

17. See generally COOMBE, *supra* note 16 (discussing how word marks and logos constitute an increasingly large part of contemporary cultural dialogue).

they identify source. It is not just *the term* used that signifies source, but the term when used in combination with relevant disambiguating context, such as colors, typefaces, product packaging, logos, logo placement on packaging, product categories, and so on.

Though trademark scholars have brought various strands of cognitive psychology scholarship to bear on questions in trademark law, the research on semantic ambiguity resolution has not yet been addressed, despite its rather obvious relevance. Filling that gap, I propose a hypothesis about trademarks and semantic ambiguity resolution, as well as provide a preliminary sketch of a follow-on empirical research agenda. There are three elements to the hypothesis. First, a premise: word marks are linguistic, and there is little reason to think trademarks exhibit psycholinguistic characteristics that distinguish them fundamentally from all other words. Even if consumers process trademarks as proper nouns, they still use context to disambiguate such words. Second, consistent with other lines of cognitive and consumer psychology research previously mined by scholars like Professors Tushnet and Lee, semantic ambiguity resolution research reveals that “context is king.”¹⁸ Rarely (if ever) do consumers encounter trademarks acontextually, and it seems likely such contextualization allays any concern we might have about genericness or dilution harms. Third, as Professor Klerman has argued, even if consumers experience *statistically* significant confusion when presented with appropriate context, it is less likely that those harms would be *commercially* significant—that is, that the effects would or might alter consumers’ decision-making.¹⁹ This Article is intended to set forth the psycholinguistic case for these assertions.

Although trademark hybridity is barely recognized in the law, it is quickly becoming more important for commerce and communication. Mark holders are aggressive and sometimes brazen in seeking broad protection for their marks, and far more than ever before. In so doing, mark holders use the legal trademark monopoly in an effort to attain market monopoly status by controlling the conversations regarding their brands.²⁰ This model of trademark protection assumes that diverse

18. Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 529 (2008); see also Lee et al., *supra* note 8, at 1057 (describing “contextual markers,” such as distinctive print and prominent placement of a logo on the product or its packaging, used by marketers and consumers to lend source-significance to products).

19. Daniel Klerman, *Trademark Dilution, Search Costs, and Naked Licensing*, 74 FORDHAM L. REV. 1759, 1765 (2006).

20. Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 140

meanings will muddle those mark holders' brands to their detriment. But, as explained in more detail throughout this Article, a significant amount of relevant psychological research does not sufficiently support that assumption or the mark holders' view.

Instead, trademark law and practice has developed into a system in which Dr. Dre's Beats Electronics can credibly file oppositions against producers of a wide variety of goods for seeking to procure trademark registrations for iterations of the words "beat" and "beats," arguing those uses will confuse consumers into thinking the goods came from Beats Electronics, or dilute the connection in consumers' minds between the word "beat" and BEATS.²¹ This system stifles communication and competition, as described below. By recognizing trademark hybridity and tailoring trademark doctrine to fit its teachings with respect to the importance of context and the complexity of the marketplace, we can improve the system.

Part I's purpose is two-fold. First, in Part I.A., this Article describes the traditional theoretical bases for trademark protection, noting how the law has steadily moved away from those bases. Second, in Part I.B., this Article describes the current psycholinguistics research on semantic ambiguity resolution and applies it to trademark law. Together, Parts I.A and I.B illustrate how courts and the Trademark Office place an undue amount of weight on trademarks' lexical aspects, when the traditional source-identification rationale is best served by more constraints on individual trademark scope. In Part II, this Article applies the observations made in Part I to several doctrinal and theoretical issues in trademark law, finding trademark law wanting in its recognition of context as the prime mover of semantic ambiguity resolution. In Part III, this Article concludes with several proposals for reform based on the observations set forth in this Article. These proposals include reexamining the basis for protecting plain word marks, refocusing aspects of the likelihood of confusion tests in order to improve their sensitivity to context, recalibrating genericness surveys to be more attentive to context, and limiting producers' control over

(2010) ("[U]ltimately, the free-riding claims [of mark holders] are even more sweeping than ownership of marks: trademark owners sometimes are effectively asserting the right to own markets themselves because . . . the relevant market owes its origin to their brands.").

21. See Jacob Gershman, *Dr. Dre in Trademark Battle*, WALL ST. J. L. BLOG (Mar. 6, 2013 4:50 PM), <http://blogs.wsj.com/law/2013/03/06/dr-dre-in-trademark-beat-down/> (detailing Beats Electronics' efforts to challenge trademark applicants' attempts to register "beat" or "beats" as a trademark—even when not used in connection with headphones or when in combination with other words—based on a purported likelihood of confusion with the company's BEATS mark for headphones and speaker systems).

emergent expressive meanings.

I. TRADEMARK HYBRIDITY

Trademark language is slippery. Judges, practitioners, and scholars use “trademark” and “brand” interchangeably, often without a real understanding that “brand” is a different and considerably broader set. This is in part because scholars often apply marketing literature to trademarks without due care for systematically distinguishing between them.²² Judges apply rules to brands without regard to the fact that what they are dealing with is only the trademarked term.²³

Trademark law’s origins lie in the control of commercial language.²⁴

22. See, e.g., William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) (“The value of a trademark is the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand . . .”). The key here is not that these scholars don’t understand the difference, but rather that they tend to assume that the word mark is the primary value-driver rather than the overarching brand itself. Or, more sanguinely, they simply slip into using the terms interchangeably in order to mix up the monotony of continually writing “trademark” or “mark.”

23. See, e.g., *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531 (7th Cir. 2003) (on determining that a word mark is generic, Judge Posner wrote: “[I]t may confuse consumers who continue to associate the trademark with the owner’s brand when they encounter what they thought a brand name on another seller’s brand”); *E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 527–28 (E.D.N.Y. 1975) (regarding the paradigmatic TEFLON case, the court found persuasive a survey that asked respondents whether certain product names were “brand name[s] or trademark[s]” or generic names); see also *In re Trek 2000 Int’l Ltd.*, 97 U.S.P.Q.2d (BNA) 1106, 1112, 1114 (T.T.A.B. 2010) (ignoring significant evidence of consumer usage of THUMBDRIVE as a generic term, the T.T.A.B. credited evidence that “certain of the media outlets present in the examining attorney’s evidence have agreed to cease misuse of the term” and the absence of competitors using the term, and thereafter found that the word mark was not generic).

24. Whether these origins were normatively propelled by consumer protection or producer protection is very much a subject of debate in trademark scholarship. Compare Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1849–96 (2007) (arguing early trademark law was premised on protecting producers against “unfair” competition), with Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 778 (2004) (arguing the historic normative goal of trademark law is to reduce search costs by fostering information flow in markets) [hereinafter Dogan & Lemley, *Trademarks and Consumer Search Costs*]; William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 267 (1988) (arguing trademark law “tr[ies] to promote economic efficiency”), and Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 417 (1999) (“Ownership was assigned to the person who adopted the mark for her trade, not because she had created it or its favorable associations, but because such person was conveniently placed and strongly motivated to vindicate the broader public interest in a mark’s ability to identify accurately the source of the goods to which it was attached.”). I tend to side with Professor Bone in this particular battle. In his view, American trademark law has always contained producer-protective and consumer-protective strands. See generally Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547 (2006). The question, then, is a normative one: whose interests *should* trademark law promote, under what circumstances, and to what extent?

The law has since outgrown those origins, such that trademark's scope now covers nearly anything that can signify some consistent source as a trademark.²⁵ Courts and legislatures have consistently expanded the scope of trademark protection to incorporate brand concepts.²⁶ Meanwhile, many trademarks contain vestigial remnants of their origins, when producers had limited means of differentiating their products from others'. In the early days of U.S. trademark protection, a trademarked term was the primary legal protection for differentiating one producer's product from another's.²⁷

This tension is a problem. A trademark has been traditionally defined as a term—later, sounds, shapes, and so on—used in connection with goods or services that signifies their source. By contrast, branding refers to the “durable identity and [consumer] loyalty” developed through producers' use of design, packaging, logos, graphics, marketing, and other related strategies.²⁸ The durable identity and loyalty of branding, along with expressive social meanings that become attached to the identity and the mark over time, are what I, following Professors Desai and Waller, refer to here as the *brand*.²⁹

In addition to the simple source identification character a term or logo may have, it may also be used for other purposes, such as signaling status or an affinity with a social group.³⁰ Understandably, mark

25. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION ch. 7 (Clark, Boardman, Callaghan 4th ed. 2013) (outlining the variety of subject matter in which a trademark may be claimed, from words to color to fragrance and flavor); see also *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 162 (1995) (“Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”).

26. See generally Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981 (2012); see also Laura A. Bradford, *Emotion, Dilution, and the Trademark Consumer*, 23 BERKELEY TECH. L.J. 1227, 1243 (2008).

27. Trade dress protection came much later, and, as Professor Lunney shows, the extension of Lanham Act protection to trade dress is not supported by the Act's legislative history. See Glynn S. Lunney, Jr., *The Trade Dress Emperor's New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 HASTINGS L.J. 1131, 1134–35 (2000) (describing the allowance of trade dress registration as an accident of history); MCCARTHY, *supra* note 25, § 7:94, at 7-379 to -380 (recognizing Congress's initial decision not to permit trade dress registration on the principal register); see also Lunney, *supra* note 24, at 373–91 (arguing that Congress did not intend to protect trade dress under the Lanham Act).

28. Deven R. Desai & Spencer Waller, *Brands, Competition, and the Law*, 2010 B.Y.U. L. REV. 1425, 1431.

29. See generally COOMBE, *supra* note 16.

30. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 624 (2004) [hereinafter Beebe, *The Semiotic Analysis of Trademark Law*] (“In asserting that trademarks do no more than facilitate search and encourage quality, the [Law and Economics school] has long declined to acknowledge what is obvious: that firms produce trademarks as

holders have long utilized the courts in attempts to control these concepts.³¹ In myriad ways, courts have helped mark holders expand the law to govern these concepts without due regard for the implications of the approach. As a result, trademark law has become inefficient, frayed and unwieldy. Trademark hybridity offers one way of thinking about how to update trademark law to today's brand practice.

As I explain in this Article, trademark hybridity means that a given term can be understood to connote multiple separate, and—to some extent contradictory—ideas, persons, or things. In Part A, I describe the traditional theoretical bases of trademark protection—source identification and quality control—and briefly describe how brand protection has seeped into the analysis. In Part B, I describe the psycholinguistics literature on semantic ambiguity resolution. This literature illustrates how individuals process language in order to make sense out of the world. Brand protection is problematic in large part because factfinders do not assiduously distinguish a word mark's linguistic aspects from the contextual factors that serve to practically disambiguate it from other similar terms. As a result, the level of protection granted to word marks vastly outstrips trademark's traditional justifications.³²

The inconsistency between the high level of protection granted to brands and trademark hybridity might be descriptively acceptable, but is, for the reasons described below, normatively unworkable.

A. *The Traditional Theoretical Bases of Trademark Protection*

Trademark law reflects a number of important interests, not the least of which are generalized interests in promoting market competition and free communication both inside and outside the marketplace. These

status goods, that consumers consume trademarks to signal status, and that courts routinely invest trademarks with legal protection in an effort to preserve this status-signaling function.”); *see also* Barton Beebe, *Intellectual Property and the Sumptuary Code*, 123 HARV. L. REV. 809 (2010) [hereinafter Beebe, *Intellectual Property and the Sumptuary Code*]. *See generally* THORSTEIN VEBLEN, *THE THEORY OF LEISURE CLASS* (1899).

31. *See generally* Desai, *supra* note 26.

32. For example, in 2013, the fast food restaurant Chick-Fil-A, which holds a registered trademark in the phrase “Eat mor chikin” for use with restaurant services, filed an opposition with the U.S. Patent and Trademark Office in an attempt to prevent folk artist Robert Muller-Moore from registering the phrase “Eat More Kale” for use on t-shirts and other apparel. *See, e.g.*, Caroline Kim, ‘Eat More Kale’ Company Losing Against Chick-Fil-A, *The Exchange*, YAHOO! FINANCE (Apr. 25, 2013 5:21 PM), <http://finance.yahoo.com/blogs/the-exchange/eat-more-kale-company-losing-against-chick-fil-212157027.html>.

interests can be found in the foundations of trademark law. First, as Judge Posner and Professor Landes noted in their seminal work on the law and economics of trademark law, a trademark's value lies in "the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand."³³ In this view, the trademark is an information vessel that eases the consumer's burden in identifying and selecting preferred products. Second, the law protects trademarks as an incentive for producers to promote a consistent level of quality in their products.³⁴ Producers, the theory goes, have little incentive to invest in developing quality products without a way to capture that value. Trademark law provides that mechanism. Both rationales are premised on benefitting consumers, though they undoubtedly benefit producers as well.³⁵

While producers have long used many types of marketing to generate

33. Landes & Posner, *supra* note 22, at 270; *see also* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) ("[T]rademark law, by preventing others from copying a source-identifying mark, 'reduc[es] the customer's costs of shopping and making purchasing decisions' . . . for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past." (internal citations omitted)); *Bretford Mfg., Inc. v. Smith Sys. Mfg. Co.*, 419 F.3d 576, 579 (7th Cir. 2005) ("Trademark law is designed to reduce the cost customers incur in learning who makes the product, and this also helps sellers obtain rewards from producing goods of consistent quality, for customers will find it easier to find and buy goods with which they have been satisfied in the past.").

34. Landes & Posner, *supra* note 22, at 269–70; *see also* *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."); MCCARTHY, *supra* note 25, § 2:4, at 2-8 ("If your mistakes and blunders are untraceable, there is little incentive to do a quality job.").

35. Scholars have justified trademark law on other theoretical grounds such as, for example, Kantian deontology. *See, e.g.*, Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761 (2013). The law and economics view—search costs and quality-control—is, however, the current dominant theoretical justification for trademark law and for that reason it is the view with which I primarily deal here. *See, e.g.*, Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 289 (1975) ("A trademark does not necessarily guarantee good quality. What it does guarantee is consistency."); Dogan & Lemley, *Trademarks and Consumer Search Costs*, *supra* note 24, at 786–87 ("Rather than having to inquire into the provenance and qualities of every potential purchase, consumers can look to trademarks as shorthand indicators. Because information is less expensive, consumers will demand more of it and will arguably become better informed, resulting in a more competitive market."); *see also* *Qualitex*, 514 U.S. at 163–64; *Park 'N Fly*, 469 U.S. at 198 ("National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.") (citing S. REP. NO. 79-1333 at 4 (1946)). *But see* Desai & Waller, *supra* note 28, at 1447 (claiming that marks reducing search costs "is merely a part of a mark's function and, in fact, an unintended consequence. The desire to shape markets and generate demand, at work during the early history of trademarks, runs contrary to the neoclassical model of markets on which the search costs theory is based.").

consumer knowledge of, and (hopefully) demand for, their products—for example, distinctive product packaging and commercial advertising—the use of word marks to identify source was the primary method by which producers protected their interests in the early days of trademark law. But times have changed. As Professor Desai has illustrated, more than simple product market dominance, today’s mark holders are often more interested in developing the “aura” around their trademarks, and the prestige value associated with that aura, as a way to maximize returns.³⁶ Source identification is an argumentative means to that end, as trademark law’s subject matter has experienced significant scope creep. Courts have adopted new theories of confusion, such as post-sale and initial interest confusion, and have recognized a merchandising right as well—none of these extensions can be justified by the traditional rationales.³⁷ Trademarks have become more garish as well—rarely, if ever, is a word mark seen in the market context disembodied from its stylized typeface and logo. Constant repetition of aural and visual stimulants, in addition to the consistent use of a word mark, is necessary for today’s brand manager to create value.

Recognizing this shift, courts and the Trademark Office have considerably broadened trade dress protection. Mark holders can now claim a protectable interest in, among other things, color³⁸ and shape. And the logic of trademark’s expansion to govern trade dress—anything that “signals source” can be protected under the Lanham Act—has also

36. See generally Desai, *supra* note 26.

37. See *id.* at 1025–26 (discussing initial interest and post-sale confusion). Initial interest confusion is aimed at a situation in which a consumer is initially drawn to Producer A’s goods or services because the consumer mistakenly believes Producer A to be Producer B. By the time the consumer purchases goods or services from Producer A, the consumer knows she is not dealing with Producer B, but decides to make the purchase anyway. The doctrine thus “has little to do with [the] rational choice problems that traditionally animate trademark law.” *Id.* at 1025 (citing generally Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105 (2005)). Post-sale confusion is aimed mostly at knock-off goods: the consumer purchases goods knowing that those goods are not made by Producer A, but uninterested third-parties, seeing the consumer using those goods, presumably will be dissuaded from making further purchases from Producer A. In addressing this situation, the law protects the mark’s prestige. See Beebe, *Intellectual Property Law and the Sumptuary Code*, *supra* note 30, at 851–55; Rothman, *supra* note 37, at 1026; Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769 (2012).

38. See, e.g., *Qualitex*, 514 U.S. at 174 (holding that “a color may sometimes meet the basic legal requirements for use as a trademark”); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012) (explaining, in a case involving a trademark claimed in red shoe soles, that “limit[ing] the trademark to uses in which the red outsole contrasts with the remainder of the shoe”).

allowed mark holders to seek protection for buildings—both interior³⁹ and exterior⁴⁰—as well as vehicles,⁴¹ clothing,⁴² sounds,⁴³ fragrances,⁴⁴ flavors,⁴⁵ and tactile feelings.⁴⁶ Though individually protectable—at least in theory—each of these elements *together* combine with a word mark or logo to create the “experience” of an individual brand.

As I have argued in other work, and as I argue in more detail below, the loss of any individual element—including the word mark through genericness, or a particular design feature through functionality—does not imperil “the brand.” Rather, the remaining aspects are still protectable and, at least with respect to word marks, the overall presentation of the mark remains protectable against confusing uses via unfair competition and false advertising law. As I describe below, this observation is important because it provides a rather significant reason to push back against the expanding scope of certain types of “irrelevant confusion.”⁴⁷ The mark holder has plenty of tools at its disposal. There is no need to create or expand doctrines to push the expansion any further than it already is, and there is, in fact, good reason to reel back much of this expansion.

39. See, e.g., *Happy Sumo Sushi, Inc. v. Yapona, Inc.*, No. 2:08-CV-348 TS, 2008 WL 3539628, at *3–4 (D. Utah Aug. 11, 2008); *Warehouse Rest., Inc. v. Customs House Rest., Inc.*, No. C 80 3054, 1982 WL 51043, at *3 (N.D. Cal. June 17, 1982); see also MCCARTHY, *supra* note 25, § 7:100; Jerre B. Swann, *The Design of Restaurant Interiors: A New Approach to Aesthetic Functionality*, 76 TRADEMARK REP. 408 (1986).

40. See, e.g., *House of Hunan, Inc. v. Hunan at Pavilion*, No. 85-1591, 1985 WL 72671, at *2–3 (D.D.C. Oct. 17, 1985) (finding that decorative, outdoor lion statues constituted a valid service mark); *Assoc. Hosts of Cal., Inc. v. Moss*, No. C-C-79-254, 1979 WL 24962, at *2 (W.D.N.C. Nov. 2, 1979) (noting that the interior and exterior restaurant designs constituted distinctive trade dress); see also MCCARTHY, *supra* note 25, § 7:100.

41. See MCCARTHY, *supra* note 25, § 7:102 (describing cases involving yellow cabs).

42. See, e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, No. 88 Civ. 6444(RJW), 1989 WL 282850 (S.D.N.Y. Apr. 20, 1989), *aff'd in part, rev'd in part*, 988 F.2d 1117 (Fed. Cir. 1993); *In re Jockey Int'l, Inc.*, 192 U.S.P.Q. (BNA) 579 (T.T.A.B. 1976); see also MCCARTHY, *supra* note 25, § 7:103.

43. See, e.g., *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560 (T.T.A.B. 1978); see also MCCARTHY, *supra* note 25, § 7:104, at 7-417 to -419 (noting registrations and describing cases).

44. See, e.g., *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990); see also MCCARTHY, *supra* note 25, § 7:106, at 7-425 (“The design of a customized and distinctive scent for a business has grown into new enterprise. The use of such ‘signature scents’ is expanding.”).

45. See, e.g., *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1650–51 (T.T.A.B. 2006) (denying registration of orange flavor for dissolving antidepressant tablets on functionality grounds, but noting that flavor may be protectable on a showing of secondary meaning); see also MCCARTHY, *supra* note 25, § 7:107.

46. See MCCARTHY, *supra* note 25, § 7:108 (noting registrations).

47. See Mark A. Lemley & Mark P. McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 427 (2010) (distinguishing material from immaterial confusion).

Nonetheless, mark holders continue to try to tie down individual words, regardless of the impact disambiguating context has on whether consumers see these terms as a lone signifying source. As noted in the Introduction, source identification requires more than simply identifying the term. Rather, source identification is a combination of the term and its context, including: colors, typefaces, product packaging, logo placement on packaging, or product category, among other factors.⁴⁸

*B. Semantic Ambiguity (and How We Resolve It Through Context)*⁴⁹

1. The Basics: Polysemy and Homonymy, Senses, and Meanings

Words nearly always refer to more than one concept, in which case they are semantically ambiguous.⁵⁰ For example, much like the word “fly” discussed above,⁵¹ the word “bank” has multiple definitions. As a noun, it can be a financial institution, river curtilage, or snow pile. As a verb, it can be a shot off the glass in basketball or a shot off the rail in pool. Semantically ambiguous words like “fly” and “bank” can be ambiguous in two ways: (1) they can have separate unrelated *meanings* (like “bank” for a financial institution or a river’s edge); or (2) they can have separate related *senses* (like “fly” for the process by which an object moves through the air without direct support or a “fly,” an insect that “flies”).⁵² Again, words with separate *unrelated* meanings are *homonymous*, while words with separate *related* meanings (senses) are

48. See Lee et al., *supra* note 8, at 1077 (discussing source identification in the context of a hypothetical distinctive word mark).

49. This Part describes a line of research regarding the cognitive processes that occur during reading. This line, of course, is not the only line of cognitive psychology research that bears on how we understand trademarks in the context of actual trademark use. See, e.g., Lee et al., *supra* note 8 (providing results of visual cuing experiments); Sven L. Mattys, *Speech Perception*, in OXFORD HANDBOOK OF COGNITIVE PSYCHOLOGY 391 (Daniel Reisberg ed., 2013).

50. See Jennifer Rodd et al., *Making Sense of Semantic Ambiguity: Semantic Competition in Lexical Access*, 46 J. MEMORY & LANGUAGE 245, 250 (2002) (citing R.H. BAAYEN ET AL., LINGUISTIC DATA CONSORTIUM, U. PA. (The CELEX Lexical Database CD-ROM, 1993) (noting, of the 4930 entries in The Online Wordsmyth English Dictionary-Thesaurus with word-form frequencies of greater than ten per million, only 7.4% of the word-forms correspond to more than one entry in the dictionary, 84% have more than one sense, and 37% have more than five senses). For discussions of semantic ambiguity resolution, see generally EVA M. FERNANDEZ & HELEN SMITH CAIRNS, FUNDAMENTALS OF PSYCHOLINGUISTICS 190 (2011); LEXICAL AMBIGUITY RESOLUTION, *supra* note 2; Keith Rayner & Alexander Pollatsek, *Basic Processes in Reading*, in OXFORD HANDBOOK OF COGNITIVE PSYCHOLOGY 442 (Daniel Reisberg ed., 2013).

51. See *supra* note 1 and accompanying text.

52. Rodd et al., *supra* note 50, at 245.

polysemous.

Trademarked terms (and words) are often—in fact, almost always—polysemous. BUICK may refer to a particular brand of car, but it is also a traditional Scottish surname, an English geographical place name, and an American slang term for vomit.⁵³ Descriptive marks—like CLEAN & CLEAR—are explicitly polysemous; these terms correspond to preexisting terms and are adopted in senses adjacent to the original term’s definition (CLEAN & CLEAR will, presumably, make your skin “clean and clear”). By contrast, arbitrary marks—like APPLE for computers—are homonymous; they create a new, typically unrelated meaning for the term completely apart from its original meaning(s).

Even *sui generis* marks—such as fanciful marks like KODAK for cameras or merged personal name marks like ROLLS-ROYCE for cars—often become polysemous over time as consumers come to utilize them in everyday language. For example, saying something is the “Rolls-Royce of its class” implicates two senses of “Rolls-Royce.” The phrase refers to the trademarked term, but also uses it metaphorically in the sense of “high-quality.”⁵⁴ Even the homonymous, unrelated meaning can develop further polysemous senses as consumers interact with and interpret the term in new ways.

I propose that the temporal tendency towards polysemy is the psycholinguistic process through which trademarked terms can become generic. For example, “thermos” may now refer to the product or the brand, although at the time the term was adopted, it presumably referred primarily to the brand.⁵⁵ Similarly, homonymy can be conceived as the

53. RICHARD A. SPEARS, *DICTIONARY OF AMERICAN SLANG AND COLLOQUIAL EXPRESSIONS* 49 (4th ed. 2007).

54. See Deborah E. Klein & Gregory L. Murphy, *Paper Has Been My Ruin: Conceptual Relations of Polysemous Senses*, 47 *J. MEMORY & LANGUAGE* 548, 549 (2002). Klein and Murphy provide the example of “paper”:

As an example, *paper* originally referred to a writing material, but it has evolved to mean the substance normally used to make that material, the content of some writing, and even an oral presentation of that content—so that we can now deliver a paper without using any paper to do so. Other direction in which *paper* has been extended include the news source (newspaper), which has been stretched to refer to the company that publishes a paper, a representative of the company, and even the editorial policies of the company The material sense has also expanded to encompass financial notes, wall coverings, and gift wrap. . . . There is a continuum of polysemy, in which closely related senses can be repeatedly extended so that “adjacent” senses are closely related, but the more distant ones have little apparent connection.

Id. (citations omitted). “Rolls-Royce” would not mean “high-quality” without some relationship between the term “Rolls-Royce,” the producer of Rolls-Royce automobiles, and those cars’ high quality.

55. “Thermos” also meant “temperature regulation” when the term was adopted as a word

process by which trademarked terms are allegedly diluted. Dilution's harm is said to arise from the creation of an alternate definition for the term—the paradigm example being where a producer adopts a preexisting well-known term (BUICK perhaps) for use on unrelated goods or services (aspirin). The producer's worry is that consumers will unwittingly attribute positive or negative affective responses to undeserving producers—BUICK no longer refers just to cars made by one firm, but to medicine made by another as well.

But the advent of a new sense or meaning of a word does not necessarily crowd out the other senses or meanings. Rather, the new definition becomes enmeshed in our mental conception of the term.⁵⁶ These related senses (and, for that matter, unrelated meanings) remain representationally distinct in our minds, despite their linguistic adjacency.⁵⁷ Whether one sense (or meaning) or another is intended in a sentence depends on the context in which the term is used. When I ask for a “thermos,” the context in which I ask clarifies intended meaning and reduces ambiguity.⁵⁸ What you will hand me when I ask

mark. The trademark meaning can thus be understood as a *sense* related to the term's underlying original definition.

56. See Klein & Murphy, *supra* note 54, at 566–67 (“What is surprising about polysemy as a general phenomenon is that the great diversity of senses does not impair fluent understanding of everyday language.”).

57. See Klein & Murphy, *supra* note 54, at 564–66 (explaining why different senses are not lexically distinguished); Devorah E. Klein & Gregory L. Murphy, *The Representation of Polysemous Words*, 45 J. MEMORY & LANGUAGE 259, 262–66 (2001) (providing evidence that polysemous words have different representations for each sense and that any core meaning is minimal).

58. See Klein & Murphy, *supra* note 54, at 564–69 (discussing experimental results showing that inappropriate senses are inhibited to below baseline levels to ensure proper interpretation is achieved when context is provided); Rene Zeelenberg et al., *Semantic Context Effects and Priming in Word Association*, 10 PSYCHONOMIC BULL. & REV. 653, 655–56 (2003) (reporting experimental findings showing that context can be—and is—used to disambiguate semantically ambiguous words such that these words are less likely to cue inconsistent homonymous meanings); see also Lyn Frazier & Keith Rayner, *Taking on Semantic Commitments: Processing Multiple Meanings vs. Multiple Senses*, 29 J. MEMORY & LANGUAGE 181, 191 (1990) (“[The data] suggests that readers do commit themselves to a particular sense of a word when the intended sense is implied by the content of prior context.”); Steven Frisson & Martin J. Pickering, *The Processing of Metonymy: Evidence from Eye Movements*, 25 J. EXPERIMENTAL PSYCH.: LEARNING, MEMORY, & COGNITION 1366, 1379 (1999) (“Once readers have used [an] underspecified meaning to assign a (rather abstract) semantic value to an expression, they can home [sic] in on the intended sense by instantiating any underspecified features” through use of context). The idea stated in Frisson & Pickering is called *radical underspecification*. In essence, radical underspecification is the process through which “a kind of neutral placeholder is activated until disambiguating information is encountered . . . [a]s later context emerges . . . then one sense would be selected.” Klein & Murphy, *supra* note 54, at 567; cf. S.A. Duffy et al., *Lexical Ambiguity and Fixation Times in Reading*, 27 J. MEMORY & LANGUAGE 429, 442 (1988)

for an “apple” will depend on whether we’re at an electronics store or a supermarket. Where confusion remains, it is generally of a type that causes no legally cognizable harm in the sense of lost profits or harm to reputation. Context, in other words, resolves the semantic ambiguity quickly and nearly effortlessly.

Indeed, companies often implicitly—and systematically—admit that consumers can tell the difference between various senses without confusion. For example, company names are often used to refer to the company itself and to one—or a class—of its products. For example, “Ford has reached 75 percent of its goal to create 12,000 hourly jobs in the U.S. by 2015,”⁵⁹ (*Ford* = company) and “There’s a Ford in your future with a future built in!”⁶⁰ (*Ford* being a vehicle made by that company). Nor do producer-product polysemies occur only in commerce. For example, take the two sentences “Dickens died in 1914” and “I love reading Dickens.” It’s highly unlikely that any substantial confusion, much less dilution, is likely to arise from this type of polysemy given its prevalence in everyday language use. If that is the case, then we should be more careful about implying some sort of cognizable harm in analogous situations.

These observations are quite important because word marks are almost never encountered without some disambiguating context aside from in a lab.⁶¹ Contextual primacy is often overlooked in trademark law, particularly with respect to surveys, and has important implications that are discussed in the next Part.

(suggesting that, in the context of homonyms, readers activate separate meanings and select one or the other based on the meanings’ usage frequency and overall sentence context).

59. Press Release, Ford Motors, Ford Adding 2,000-Plus Jobs at Kansas City Assembly to Support Surging F-150 Demand, Ford Transit Launch (May 2, 2013), *available at* <http://corporate.ford.com/news-center/press-releases-detail/pr-ford-adding-2000plus-jobs-at-37994>; *see also* Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1847 (2007) (identifying “Do you Yahoo!?” and “Dude, you’re getting a Dell,” which are further examples of this phenomenon).

60. HEON STEVENSON, *AMERICAN AUTOMOBILE ADVERTISING, 1930–1980: AN ILLUSTRATED HISTORY* 144 (McFarland 2008); *cf.* *FIRST BLOOD* (Orion Pictures 1982) (Rambo: “. . . He’s saying, sayin’ ‘I wanna go home! I wanna go home!’ He keeps calling my name! ‘I wanna go home, Johnny! I wanna drive my Chevy!’”).

61. *See* ROGER W. SHUY, *LINGUISTIC BATTLES IN TRADEMARK DISPUTES* 7 (2002) (“Context is very important in accusations of dilution. Words in isolation seldom occur in our lives, except in spelling bees and grocery lists.”); Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 530–32 (discussing context effects in relation to trademark dilution).

2. Definitional Issues: “Primary” Meanings and “Interference”

As discussed more fully below, the “primary significance” test is used by factfinders to determine whether a term is or has become generic. In the Lanham Act, Congress provided that “[t]he 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.”⁶² Primary significance has generally been read to pose a binary question: is the term generic or does it retain source significance?⁶³ This is an empirical question that can be measured on a spectrum: does a sufficient percentage of the relevant consuming public consider the term generic, or does the relevant public instead consider the term to identify source? Both questions misunderstand how the public can, and does, understand source and product significance together. Trademark hybridity, by contrast, recognizes that a term need not be understood for *either* its generic *or* its source identifying function. According to hybridity, both functions can, and do, coexist—depending on the context in which the term is used.

It might be tempting to consider whether the primary significance test could ask a narrower question: whether the term’s *primary* definition in a consumer’s mind is the source or the product.⁶⁴ That narrower question would pose a significant problem for trademark law, because it would acknowledge that the consumer’s mental map of the term contains both definitions.⁶⁵ But because the mental map is subjective and internal to the consumer, how can the answer be measured empirically?

62. 15 U.S.C. § 1064(3) (2012); *see also* Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (holding for a seller to prove trademark significance in a term challenged as generic, the seller must show that the “primary significance of the term in the minds of the consuming public is not the product but the producer”); 2 MCCARTHY, *supra* note 25, § 12:6, at 12-23 to -24 (collecting cases).

63. *See supra* note 12 and accompanying text.

64. *See* Jerre B. Swann & Vincent N. Palladino, *Surveying “Genericness”: A Critique of Folsom and Teply*, 78 TRADEMARK REP. 179, 181 (1988) (critiquing Folsom and Teply’s survey model on the ground that “[t]he law requires that the trier of fact make [a choice between “brand” or “generic”] in seeking to determine the primary significance of a disputed term.”); *see also* E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TRADEMARK REP. 1118, 1137 (2009) (same).

65. *See* Folsom & Teply, *Trademarked Generic Words*, *supra* note 11, at 6–7 (describing the potential of consumers that mentally apply both definitions); *see also* Desai & Rierson, *supra* note 59, at 1803–05 (discussing Folsom & Teply’s hybrid marks thesis).

Several prominent practitioners and scholars have proposed *spreading activation*—an idea taken from cognitive psychology—to advocate for antidilution protection.⁶⁶ The model would seem to provide a sketchy theory on which to base such empirical measurements. Professor Tushnet gamely describes the theory as follows:

In the cognitive model, blurring takes place when a single term activates multiple, nonconfusing associations in a consumer's mind. Meanings or concepts, including sounds, images, and other sensory impressions, are linked by mental networks. Concepts are activated through links in the network, triggering related concepts. Activation happens very fast, and if it does not continue, an unreinforced word or concept can die away. For example, because we process sounds in sequence, neighborhoods of words starting with an initial *he* sound will be activated when we hear *he-*. When we hear the rest of the word *hello*, *help* will die away and *hello*, with its attendant meanings, will be activated. . . . Like several pebbles thrown into a pond at once, activation of different meanings causes interference with each one.⁶⁷

First, there is a central issue with distinguishing primary definitions from secondary ones, tertiary ones, and so on. Assuming they may be triggered by the switching on of a “primary” node and then by spreading to other, “secondary” nodes, there is no extant empirical measure to conclusively establish which node is “primary.” Rather, psycholinguistic researchers typically presume node primacy by relational frequency: between two senses or meanings, that which is more frequently used is presumed to be the “primary” sense or meaning. That presumption fits imperfectly in trademark law in both the dilution and genericness contexts.

With respect to genericness, it fits imperfectly, if only because a measurement that takes no account of hybridized word marks will generally undervalue the term's “generic” sense in determining

66. See Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion, and Dilution*, 91 TRADEMARK REP. 1013, 1019–20 (2001); Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, 946–47, 950 (2006).

67. Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 519–20 (citing, *inter alia*, JOHN R. ANDERSON, *COGNITIVE PSYCHOLOGY AND ITS IMPLICATIONS* 183–85 (4th ed. 1995)). In the above quotation, Tushnet sets forth the cognitive view tying spread activation to brand association. However, it should be noted that Tushnet puts forward the view in order to discredit it throughout the rest of her article. My quotation of her, then, should not be read to ascribe these views to her. See also Christine A. Sevald & Gary S. Dell, *The Sequential Cuing Effect in Speech Production*, 53 COGNITION 91, 110 (1994); Jerre B. Swann, *Dilution Redefined for the Year 2002*, 92 TRADEMARK REP. 585, 613 (2002).

relational frequency. As discussed below, genericness surveys typically ask consumers whether a given term is generic *or* source identifying, presuming that a consumer who falls into one group does not fall into the other. Like a set of hydraulic pistons, when one meaning goes up, it is presumed that the other goes down. Hybridity illustrates the falsity of this binary. But even if hybridity is accounted for, what results when 75% of the consuming public recognizes a particular term in both its generic product and specific source senses?⁶⁸ Any fine distinction at that level would smack of arbitrariness.

One encounters similar problems with dilution. We could likely establish relational primacy as between senior and junior mark holders with respect to an individual term, but it is unclear why that should override all the other senses and meanings a term carries. For example, APPLE for computers may be first among mark holders, but it is certainly not first among all meanings, or potentially even first within all the markets in which the electronics company operates. (The Beatles' publishing arm, Apple Corps, might qualify in the music market.) Things get even dicier when trying to deal with *similar*, as opposed to the same, terms. Establishing primacy and tying it to dilution and the primary significance test, then, is more fraught with difficulty than it might seem.

Second, it is almost certainly far too strong to say that additional senses or meanings "interfere" with others.⁶⁹ Professor Tushnet, relying on psychological research on linguistic association sets, notes that no major brand names have high frequency levels in an absolute sense.⁷⁰ Moreover, the evidence is unclear whether an increase in the number of associations attached to a brand name might burden consumers' ability to retrieve or recognize the brand name.⁷¹ To the contrary, research

68. As possibilities for this hypothetical scenario, I suggest "vaseline," "kleenex," and "xerox."

69. See Zeelenberg et al., *supra* note 58, at 658 (citing L.W. Barsalou, *Flexibility, Structure, and Linguistic Vagary in Concepts: Manifestations of a Compositional System of Perceptual Symbols*, in THEORIES OF MEMORY 29 (Alan Collins et al. eds., 1993)) ("[A] feature-based account [of language processing] needs to assume that not all semantic features of a word are activated or attended to on each occasion a word is encountered. Instead, the degree to which certain features are activated or attended to varies and depends on the context in which the word is presented."); see also C. Donald Morris et al., *Levels of Processing Versus Transfer Appropriate Processing*, 16 J. VERBAL LEARNING & VERBAL BEHAVIOR 519 (1977); Diane Pecher et al., *Does Pizza Prime Coin? Perceptual Priming in Lexical Decision and Pronunciation*, 38 J. MEMORY & LANGUAGE 401 (1998); Henry L. Roediger III & Beth Adelson, *Semantic Specificity in Cued Recall*, 8 MEMORY & COGNITION 65 (1980).

70. Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 534–35.

71. See *id.*

suggests that such an increase may actually reinforce the retrieval and the recognition of the primary association.⁷² Rather, all we can say is that different meanings or senses may be activated, and this “interference” may be negative or positive in terms of brand name recall—we simply do not have a conclusive answer yet.

To some extent, the “interference” issue may simply be a failure of language to accurately describe experience. Particularly in the legal and scientific spheres, narrative structure and the process of measurement force us to speak in terms of temporal sequence—first this happens, then that. But it is not actually clear that is how the brain maps words to meanings and senses, or senses to other senses.

3. Extrapolating Out: Measurement Issues and Threshold Setting

With respect to dilution, there are at least three more related issues. First, there is no convergence on whether certain measurements, such as increased response time, are good proxies, if indeed they are proxies at all, for increased “internal search costs.” Professor Tushnet describes how “[u]nexpected results in studies of concrete versus abstract words . . . show that there is a lot we still don’t know about what response times mean and about the relationships between recall, recognition, and production of words.”⁷³

Second, assuming increased response time is an accurate proxy for increases in internal search costs, current studies do a poor job of accounting for the complexity of the relationship between context, meaning, and these proxies—in Professor Tushnet’s words, extrapolating “from lab to store.”⁷⁴ In order to measure dilution in the lab, researchers have found it necessary to decontextualize their experimental scenarios.⁷⁵ But these efforts inevitably end up missing the point; because consumers almost always encounter trademarks in

72. Joan Meyers-Levy, *The Influence of a Brand Name’s Association Set Size and Word Frequency on Brand Memory*, 16 J. CONSUMER RES. 197, 202–03 (1989); see also Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 536 n.153 (citing Douglas L. Nelson et al., *Interpreting the Influence of Implicitly Activated Memories on Recall and Recognition*, 105 PSYCH. REV. 299, 301 (1998)) (“In the end, association-set size may simply not be all that important in real-world settings. Other studies suggest that context moderates any effect of association-set size.”).

73. Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 527–28 (citing Elizabeth Gudrais, *Neurons Sort Nouns*, HARV. MAG., July–Aug. 2006, at 15, 16 (internal citations omitted)); see also Simon Dennis & Michael S. Humphreys, *A Context Noise Model of Episodic Word Recognition*, 108 PSYCHOL. REV. 452, 464 (2001)).

74. See Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 527.

75. See *id.* at 528–32 (describing the decontextualizing effects of Morrin and Jacoby’s attempts to measure dilution).

context, finding dilution measurable in the lab in a decontextualized scenario does not necessarily lead to the conclusion that dilution is measurable in the real world.

Finally, assuming away the previous two issues, policymakers and factfinders have not set a threshold for what might constitute actionable dilution. As Professor Klerman has noted, even if we can agree that studies showing increased response times have results that are *statistically* significant (and, consistently replicable), and that these studies are reliable proxies for increases in internal search costs, it does not necessarily follow that these findings would be *economically* significant.⁷⁶ In other words, how might the harm of “whittling away” goodwill be quantifiable such that harm could be proven? Brand valuers have not been able to reliably measure goodwill writ-large despite years of trying; it seems odd to say that, despite this fact, we think it appropriate to base a legal claim on minute variations in goodwill. Without a threshold, there is no baseline for harm, and without a baseline for harm, there is no basis for distinguishing winning and losing claims.⁷⁷

II. DOCTRINAL AND THEORETICAL IMPLICATIONS

A. “Sound, Sight, and Meaning”

The standard test for trademark infringement is whether the defendant’s mark creates a “likelihood of confusion” in consumers’ minds with respect to the plaintiff’s mark.⁷⁸ Per the Lanham Act, confusion as to “affiliation, connection, or association” is actionable, as is confusion as to “origin, sponsorship, or approval.”⁷⁹

76. Klerman, *supra* note 19, at 1765 (arguing that a 125 millisecond increase in response time is not economically significant); see DAVID W. BARNES, STATISTICS AS PROOF: FUNDAMENTALS OF QUANTITATIVE EVIDENCE 143–44 (1983) (distinguishing statistical and practical significance), cited in Tushnet, *Gone in 60 Milliseconds*, *supra* note 18, at 528 n.105.

77. This claim is no less true with respect to confusion. To say that “likely” confusion or dilution is actionable requires that we set some consistent standard for measurement, no matter how arbitrary it might be. See *infra* Part III.B.

78. See, e.g., *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (setting forth a multifactor test to determine likelihood of confusion); *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (same); see also 4 MCCARTHY, *supra* note 25, § 23.

79. 15 U.S.C. § 1125(a)(1)(A) (2012). Many scholars have become increasingly convinced that the basis for providing protection against many of these types of confusion is normatively suspect. See, e.g., Lemley & McKenna, *supra* note 47; Mark P. McKenna, *Testing Modern Trademark Law’s Theory of Harm*, 95 IOWA L. REV. 63, 83 (2009) (“[R]ecent research casts serious doubt on a number of the assumptions on which the arguments [regarding confusion harms] were based.”); see also Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2119–22 (2009) (discussing extensions in actionable confusion).

However, “likelihood of confusion” only makes sense if we have a very tight conception of what “confusion” is, and how it arises. Because the external search costs theory bears out fairly well empirically,⁸⁰ it seems acceptable as a measure of what *actual* confusion is, but courts often get mixed up when trying to deal with context. To their credit, courts try to incorporate examinations of various types of context through the circuits’ various multifactor tests. For example, the physical proximity of goods in the marketplace, as well as the similarity of marketing channels—both of which are best understood within the context of the single “proximity of goods” factor—expressly deal with the physical and visual contexts in which consumers are likely to encounter goods.

Drawing on Professor Beebe’s empirical work on the various trademark infringement tests, it seems clear that there are only five factors in these multifactor tests that actually affect trademark infringement outcomes: similarity of the marks, proximity of the goods, strength of the marks, intent, and actual confusion.⁸¹

Factfinders analyzing the similarity of the marks factor typically use the “sound, sight, or meaning” test, which, in other words, compares the marks with respect to similarity of “pronunciation, appearance, and verbal translation.”⁸² When put together, this test is a fairly good way to examine how similar marks might be through separate, but related, inquiries. However, there are at least three issues with the test. First, the test is disjunctive: similarity as to any one of sound, sight, *or* meaning may suffice to support a finding of likelihood of confusion.⁸³

80. See, e.g., Jean-Noel Kapferer, *Brand Confusion: Empirical Study of a Legal Concept*, 12 PSYCH. & MARKETING 551, 551, 564 (1995) (relying on the operational definition of confusion used by courts to determine the likelihood of consumer confusion); Vincent-Wayne Mitchell & Vassilios Papavassiliou, *Marketing Causes and Implications of Consumer Confusion*, 8 J. PRODUCT & BRAND MGMT. 319, 319 (1999) (explaining consumer confusion based on stimuli overload).

81. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1646–47 (2006) [hereinafter Beebe, *Multifactor Tests*].

82. See *Watkins Prods., Inc. v. Sunway Fruit Prods., Inc.*, 311 F.2d 496 (7th Cir. 1962); *Sleeper Lounge Co. v. Bell Mfg. Co.*, 253 F.2d 720 (9th Cir. 1958); *May Dep’t Stores Co. v. Schloss Bros. & Co.*, 234 F.2d 879 (C.C.P.A. 1956); see also *Libman Co. v. Vining Indus.*, 69 F.3d 1360 (7th Cir. 1995). See generally Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS U. L.J. 781 (2008) (discussing vagaries in how factfinders view the sound, sight, and meaning inquiries). For an illuminating discussion of the relationship between the “sound, sight, or meaning” test and semiotic theory, see Beebe, *The Semiotic Analysis of Trademark Law*, *supra* note 30, at 653–56.

83. See, e.g., *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 U.S.P.Q.2d (BNA) 1511 (T.T.A.B. 2009); *Interstate Brands Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d (BNA) 1910, 1913 (T.T.A.B. 2000); *In re White Swan, Ltd.*, 8 U.S.P.Q.2d (BNA) 1534, 1535 (T.T.A.B. 1988).

Because a finding of similarity between the marks will often drive the outcome of the overall likelihood of confusion inquiry,⁸⁴ the standard for finding similarity must be more attuned to how individuals actually see these marks in circumstances of actual trademark use, rather than abstracted from reality. Second, the meaning prong is far too malleable.⁸⁵ As hybridity illustrates, terms can carry a wide variety of sometimes-conflicting meanings and senses, and consumers are more than able to consistently disaggregate these meanings and senses where appropriate context is provided. Finally, Professor Tushnet has described how trademark law, and particularly the “sound, sight, or meaning” test, exalts words over images in ways that both directly affect how trademark images are perceived and distract from the reasons marketers actually adopt particular marks.⁸⁶

The “meaning” prong of the “sound, sight, or meaning” test should be excised for the reasons stated above. Of the two remaining factors, sight should be required to satisfy the plaintiff’s requirement to show a similarity of the marks. As Professor Heymann has described, “functionally illiterate consumers may not treat a mark as a word but rather as a pictorial image, recognizable in subsequent encounters only if the mark appears in the same color and font as in the previous encounter.”⁸⁷ With respect to literate consumers, and as described above in Part I.B, we very often use visual keys to distinguish word marks from each other. For example, laudatory and geographic word marks, such as ACME and AMERICAN, respectively, are distinguishable from each other not only by the markets in which they are used, but also by the actual typefaces and colors used, as well as the logos in which

84. See Beebe, *Multifactor Tests*, *supra* note 81, at 1607.

85. See, e.g., *Blue Cross & Blue Shield Ass’n v. Harvard Cmty. Health Plan, Inc.*, 17 U.S.P.Q.2d (BNA) 1075, 1078 (T.T.A.B. 1990) (holding that THE CURE FOR THE BLUES was confusingly similar to BLUE CROSS/BLUE SHIELD on the grounds that the marks conveyed the same meaning to consumers); *S.C. Johnson & Son, Inc. v. Morton-Norwich Prods., Inc.*, 185 U.S.P.Q. (BNA) 573, 575 (T.T.A.B. 1975) (finding RAIN FRESH liquid detergent and RAIN BARREL fabric softener confusingly similar); *Kraft-Phenix Cheese Corp. v. R.E. Robertson, Inc.*, 9 F. Supp. 125, 125–26 (D. Mich. 1934) (determining WONDER MIX and MIRACLE WHIP, both for salad dressing, were confusingly similar).

86. See Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 HOUS. L. REV. 861, 865–83 (2011); see also Ann Bartow, *The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues*, 97 KY. L.J. 263, 267 (2009) (“Mark holders typically use word marks in tandem with colors because language facilitates certainty in ways that are useful for commerce.”).

87. Heymann, *supra* note 82, at 791 (citing Madhubalan Viswanathan et al., *Decision Making and Coping of Functionally Illiterate Consumers and Some Implications for Marketing Management*, 69 J. MARKETING 15, 21, 27 (2005)).

the terms are embedded. More detail means more capacity for source identification. With respect to design and picture marks, including stylized terms, similarity of appearance already controls.⁸⁸ Therefore, there would not be much of a change if my proposal set forth below⁸⁹ regarding registration and protection of stylized terms were adopted. Assuming that proposal is not adopted, requiring visual similarity and broadly defining it to include the actual typefaces or coloring used by the parties in actual trademark use scenarios could achieve similar results.

B. Primary Significance and Genericness Surveys

Aspirin, escalator, cellophane, thermos: these terms were once all very strong trademarks for use on their particular products.⁹⁰ Over time, the factors that made these marks strong eventually pushed them into genericness.⁹¹ We usually use these terms to describe the fall into genericness because they are iconic,⁹² but there are many more marks we could add to this list. Although courts do not seem to have examined the questions whether either KLEENEX or VASELINE are generic, it seems fairly obvious that consumers actually consider these terms to have a very high level of product significance even though each has substantial source significance as well.⁹³ This state of affairs, I

88. See, e.g., *Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc.*, 470 F.2d 1385, 1386 (C.C.P.A. 1972) (finding differences in “tulip” designs control); *Alpha Corp. v. Columbia Broad. Sys., Inc.*, 463 F.2d 1098, 1101 (C.C.P.A. 1972) (noting the differences in “eye” design control); *Lacoste Alligator S.A. v. Everlast World’s Boxing Headquarters*, 204 U.S.P.Q. (BNA) 945, 948 (T.T.A.B. 1979) (finding a flying dragon for judo uniforms not confusingly similar to an alligator for clothing); see also 4 MCCARTHY, *supra* note 25, § 23:25. Notably, the Trademark Trial and Appeal Board uses an “eyeball” test to determine whether design marks are similar. See Tushnet, *Looking at the Lanham Act*, *supra* note 86, at 876.

89. See *infra* Part III.A.

90. See, e.g., *King-Seeley Thermos Co., v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (thermos); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75 (2d Cir. 1936) (cellophane); *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (aspirin); *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BNA) 80 (Dec. Comm’r Pat. 1950) (escalator). See generally *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999) (“hog” for motorcycles); *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95 (2d Cir. 1989) (murphy bed); *Henry Heide, Inc. v. George Ziegler Co.*, 354 F.2d 574 (7th Cir. 1965) (jujubes); *Dry Ice Corp. of Am. v. La. Dry Ice Corp.*, 54 F.2d 882 (5th Cir. 1932) (dry ice); *Nissen Trampoline Co. v. Am. Trampoline Co.*, 193 F. Supp. 745 (S.D. Iowa 1961) (trampoline).

91. See generally Timothy Denny Greene & Jeff Wilkerson, *Understanding Trademark Strength*, 16 STAN. TECH. L. REV. 535 (2013) (arguing for a more analytical theory for understanding acquired trademark strength to provide guideposts for judges and eliminate inconsistencies between jurisdictions).

92. See *id.*

93. See *Best Global Brands 2012*, INTERBRAND, <http://www.interbrand.com/en/best-global->

argue, has likely pushed these terms into *de facto* genericness.

As I have explained elsewhere, the doctrine of trademark strength—which encompasses genericness—depends on at least six factors.⁹⁴ These factors are: (1) inherent strength; (2) fame; (3) third-party uses; (4) alternative generic signifiers; (5) brand extension and licensing; and (6) lack of competition. To oversimplify the analysis some, KLEENEX and VASELINE are relatively inherently strong⁹⁵ and very famous word marks.⁹⁶ A review of federal trademark filings reveals that the terms are rarely, if ever, used on third-party products or services. Each product has a relatively strong alternative generic signifier—tissues for KLEENEX and petroleum jelly for VASELINE. Each brand has been extended by the owner into various adjacent product markets—hand towels, dinner napkins, and moist towelettes for KLEENEX⁹⁷ and various types of lotions, lip balms, and the like for VASELINE.⁹⁸

But consumer practice significantly minimizes those factors. People commonly use “kleenex” and “vaseline” generically, and not simply to describe things like KLEENEX or VASELINE.⁹⁹ This is caused in large part by ineffective competition in the relevant marketplace. A producer who creates a single-player market—or something akin to it—is much more likely to find her word mark has come to be used as the generic signifier for the product on which the term is used. To analogize, there is little effective competition in the search engine market, and as a result

brands/2012/Best-Global-Brands-2012-Brand-View.aspx (last visited Sept. 22, 2014) (listing KLEENEX as the eightieth most valuable global brand).

94. Greene & Wilkerson, *supra* note 91, *passim*.

95. KLEENEX is likely suggestive (it suggests, for example, how your nose will feel after using one), and VASELINE is likely descriptive (it seems to be a combination of “wasser,” the German word for water, and “elaion,” the Greek word for oil). See *Vaseline*, 5 MONTHLY REV. DENTAL SURGERY 415, 415–416 (1877).

96. See INTERBRAND, *supra* note 93 and accompanying text (listing KLEENEX among the world’s most valuable brands); J.D. POWER & ASSOCS., HOW THE VASELINE BRAND REMAINS RELEVANT AFTER 125 YEARS (2010), available at <http://images.dealer.com/jdpa/pdf/10-US-Vaseline-CS.pdf> (utilizing social media research to discuss how the VASELINE brand remains successful).

97. See *Select a Product Category*, KLEENEX, <http://www.kleenex.com/Products.aspx> (last visited Sept. 22, 2013) (listing products marketed under the KLEENEX brand).

98. See Find the Right Products for Your Skin Care Needs: from the Vaseline Brand, <http://www.vaseline.us/products/default.aspx> (last visited Sept. 22, 2014) (listing products marketed under the VASELINE brand).

99. See Ronald R. Butters, *A Linguistic Look at Trademark Dilution*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 507, 514 (2008) (noting the phenomenon and dubbing terms like “band-aid,” “kleenex,” and “xerox” *pseudogenerics*). The “things like” description is likely more appropriate to describe terms like “google” used for searching, “scrabble” for a crossword board game, or possibly “tetris” for a particular type of puzzle video game.

of Google Inc.'s complete dominance, the verb "google" may reflect making an internet search even apart from using Google Inc.'s search service.¹⁰⁰ But because there remain credible competitors in the marketplace, like Yahoo! and Microsoft's Bing, the word mark has not become *completely* standardized as a generic term for "search" or "search engine" despite its normalized usage as a verb. (It would be odd to say you "googled" something on Bing, for example.)

To take a few more examples, that "vaseline" is synonymous with petroleum jelly is often taken for granted in the U.S., and indeed, in many countries throughout the world, "vaseline" is explicitly considered generic for petroleum jelly.¹⁰¹ The almost complete lack of branded competition for VASELINE in the U.S. contributes to its *de facto* generic character in this country. Likewise, "kleenex" is routinely referred to in the popular press as a generic term for tissues.¹⁰² In fact, "kleenex" seems to be the news industry's go-to example for describing a term that has fallen into genericness.¹⁰³ This analysis is no less true with respect to terms like "teflon," which was found to be *not* generic by a court based on its source significance, despite a substantial showing of product significance.¹⁰⁴ The following Subparts will address how this

100. "Google" used as a verb was named the American Dialect Society's "Word of the Decade (2000–2009)." *All of the Words of the Year, 1990 to Present*, AM. DIALECT SOC'Y, <http://www.americandialect.org/woty/all-of-the-words-of-the-year-1990-to-present#2009> (last visited Sept. 22, 2014).

101. See *Vaseline*, UNILEVER GLOBAL, <http://www.unilever.co.za/brands-in-action/detail/Vaseline/294658/> (last visited Sept. 22, 2014) ("Vaseline is still one of the best known and best loved brands in the world. With products available in over 111 countries . . .").

102. See, e.g., Lionel Atwill, *Get a Grip*, FIELD & STREAM, Sept. 1997, at 76–78 ("The 'thing' [the Leatherman multi-tool] carried the name of its inventor, Tim Leatherman, and soon, like Kleenex, the brand name became a generic term."); Ian Crouch, *A Word From Our Sponsors*, NEW YORKER, Jul. 13, 2012, <http://www.newyorker.com/books/page-turner/a-word-from-our-sponsors?mobify=0> ("For years, brand names have become absorbed into the language, shifting from discrete proper nouns to regular common ones: Frisbee, Kleenex, Xerox, Band-aid."); John F. Infanger, *Making Sims Affordable*, AIRPORT BUS., Oct. 2010, at 16–17 ("We view simulator more as a generic term now; like Band Aid or Kleenex. And really, it was a generic term until FAA got a hold of it."); Daniel McGinn, *Setting a New Course*, NEWSWEEK, Nov. 19, 2007, at E10 (describing Garmin's marketing strategy: "The company's executives . . . say that by continually upgrading their devices, they'll be able to defend their premium position, the same way Apple's IPOD far outsells lesser-known, less-expensive MP3 players. It's reinforced this message using advertising taglines like 'Grab a Garmin' and 'Give a Garmin,' which try to cast its name, like Kleenex, as a generic term for the entire product category."); Bill Morris, *Explosion of Brands and Erosion of Soul*, N.Y. TIMES, Dec. 21, 2012, at D1 ("[T]he Independence Bowl became the Poulan/Weed Eater Independence Bowl, lovingly known as the Weed Whacker Bowl. . . . 'Over all, it was a net benefit,' Evin Ellis, the company's marketing communications manager, [said]. 'We consider Weed Eater the Kleenex of weed whacking.'").

103. See Crouch, *supra* note 102.

104. *E.I. DuPont de Nemours & Co. v. Yoshida Int'l*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975).

state of affairs has come to be, and offer some observations on the particular problems of the primary significance test and the way in which courts address it through survey evidence.

1. Primary Significance

Recall from above that the primary significance test asks a binary question: is the term generic or does it signify source?¹⁰⁵ Next, does a sufficient percentage of the relevant consuming public consider the term generic, or does the relevant public instead consider the term to identify source?¹⁰⁶ But semantic ambiguity resolution research, as outlined above, casts doubt on this binary question. To assume that a given term may be used only in one sense or another is unnecessarily reductive and does not accurately characterize how people actually understand language. The test does not acknowledge that many consumers will recognize both a generic and a source identifying meaning for a given term (in addition to expressive and descriptive meanings related to the term at issue).¹⁰⁷ Just as we can understand the various meanings of

105. See Folsom & Teply, *Trademarked Generic Words supra*, note 11, at 1327–30 (surveying cases). For a great discussion of the historical origins of the primary significance test, see Desai & Rierson, *supra* note 59, at 1820–25. As Professors Desai and Rierson note, some courts have adopted the “who are you/what are you” test as an additional means of determining whether a term is generic. See *id.* at 1825 (citing *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999); *Soc’y of Fin. Exam’rs v. Nat’l Ass’n of Certified Fraud Exam’rs*, 41 F.3d 223, 227 (5th Cir. 1995); *CES Publ’g Corp. v. St. Regis Publ’ns*, 531 F.2d 11, 13 (2d Cir. 1975); *Van Well Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1328 (E.D. Wash. 2006); *Eagle Snacks, Inc. v. Nabisco Brands, Inc.*, 625 F. Supp. 571, 581 (D.N.J. 1985)).

106. Butters, *supra* note 99, at 514 n.24. Butters argues that brand names used figuratively or in shorthand references to product-referents typically have not actually *become* generic. Rather, he argues word marks that have fallen into genericness have done so because “consumers actually have lost all meaningful mental connection between the [word] mark and the company that has been the source of origin of the product.” *Id.* He further notes, “[b]ecause of modern advertising and marketing techniques, as well as vigilant legal policing by trademark holders, genericide appears to be somewhat rare today.” *Id.* But his assertion is not quite correct: there is little evidence that terms like “cellophane,” “shredded wheat,” or “thermos” retained *only* product significance in consumers’ minds. The data from the first *Teflon* survey renders that argument unpersuasive.

107. Nor do many courts or prominent commentators. See, e.g., *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936 (7th Cir. 1986) (“A generic term is one that is commonly used as the name of a kind of goods. . . . Unlike a trademark, which identifies the source of a product, a generic term merely specifies the genus of which the particular product is a species.”); 2 MCCARTHY, *supra* note 25, § 12:1, at 12-4 to -5 (footnotes omitted) (“The name of a product or service itself—what it is—is the very antithesis of a mark. In short, a generic name of a product can never function as a trademark to indicate origin. The terms ‘generic’ and ‘trademark’ are mutually exclusive.”). But see Folsom & Teply, *Trademarked Generic Words, supra* note 11, at 1339 (footnote omitted) (“[A] trademarked word may be *simultaneously* hybrid: that is, it may function for some consumers both as a generic term designating a product class and

“fly,” given the appropriate context, so too can we understand a trademarked term often used generically to signify both the product (a thermos) and the brand (THERMOS). Semantic and visual context will assist the consumer in choosing the correct interpretation, thereby reducing ambiguity. The simple fact is that generic terms sometimes act as marks, and word marks sometimes act as generic terms; stylization and other context help the consumer determine which sense or meaning she’s dealing with.

One might dispute this line of argument by differentiating *knowledge* and *use*. That is, one could say even though a person—or a particular community—calls all soft drinks “cokes,” she knows in her heart of hearts that the term is not the actual generic descriptor for soft drinks. Rather, it is instead a simple shortcut that eases the flow of communication.¹⁰⁸ Or even though she calls all copiers “xeroxes,” she knows deep down that XEROX is a particular brand of copiers. The problem with this line of argument is a general one with subjective tests in various areas of the law: how can we ever *really* know what someone’s level of knowledge is, or what the contents of their brain are? Even neural scans can only tell us that a certain part of a person’s brain was activated when some activity happened. In general, use is a good proxy for knowledge in large part because people in most contexts will not be “lying” about how to properly use a particular term. Further, this argument also assumes that we can all agree that a single term either is or must be *the sole term* for a particular product. But again, this diverges from consumer practice. Is soft drink the only legitimate term for “coke?” What about cola, pop, soda, and soda pop?

We should thus consider what the law should protect under these conditions. A term can simultaneously connote a variety of different meanings or senses, such as brand and generic (product) significance, as well as meanings completely outside the bounds of commerce.¹⁰⁹ The question arises whether more (or fewer) word marks should be held generic and thereby usable on competing products, subject to appropriate means of differentiation—including clear designations of source and different stylizations—to mediate any potential confusion. Trademark hybridity might simply be a quick and simple argument for

at the same time as a source-significant, commercial symbol.”).

108. Query why calling all soft drinks “cokes” would ease that flow if it were not a widely used generic descriptor for the product.

109. See *supra* Part I.B. For example, a consumer’s mental map for “Barbie” may include barbecues (“put another shrimp on the barbie”) or a person who goes by that name as well as the doll made by Mattel.

never finding *any* word marks generic unless they have completely lost all source identifying capacity.¹¹⁰

If that were how competitors acted in the marketplace, perhaps a trend against finding marks generic would not pose a problem. But in the context of monopolistic or nearly monopolistic markets—those in which a single producer using a single word mark dominates the market—producers will generally take anticompetitive positions to solidify their market share and exclude new entrants.¹¹¹ Even where the average consumer understands a trademarked term to refer to both a specific product created by a particular producer and the actual product itself (in addition to any other senses in which the word may be used), a rationally profit-maximizing producer will seek to expand its scope of protection—often in unexpected ways¹¹²—to eliminate competition, much to the detriment of consumers.¹¹³

In other words, the primary significance test is a hammer when a chisel is needed. The test, applied as a binary, may either over or under-protect producers' interests. The test will (a) find some word marks generic where they still maintain source-identifying capacity and (b) protect many others where they are used generically by a significant

110. See Desai & Rierson, *supra* note 59, at 1844–53 (proposing this outcome).

111. This outcome is the practical effect of the increased communication costs between producers and consumers that the law and economics theory of trademark law attributes to standardized generic terms. See Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523 (1988); Landes & Posner, *supra* note 22, at 295-96; see also Giovanni B. Ramello, *What's in a Sign? Trademark Law and Economic Theory*, 20 J. ECON. SURVEYS 547, 558–59 (2006) (“Consumer inertia is a crucial side effect of trademark, and can result in the erection of barriers to entry. Firms are well aware of these inertial effects, which are in fact the objective of creating brand loyalty, which seeks to endogenously generate and increase the switching costs of consumers in order to achieve lock-in. Such practices have clear beneficial effects on the profitability of firms which succeed in gaining market power, however their ultimate social welfare effects are not so obvious.”) (citing DAVID A. AAKER, *MANAGING BRAND EQUITY* (Free Press 1991); Paul D. Klempere, *Competition When Consumers Have Switching Costs: An Overview with Applications to Industrial Organization, Macroeconomics and International Trade*, 62 REV. ECON. STUD. 515–39 (1995)).

112. See Richard L. Schmalensee, *Entry Deterrence in the Ready-to-Eat Breakfast Cereal Industry*, 9 BELL J. ECON. 305 (1978) (discussing “brand proliferation” in the corn flakes market, whereby several firms produced the same product under many different brands, thereby reducing the market’s potential profitability to competitors and effectively restricting their entry while capturing the profits for themselves). On “brand proliferation” in the pharmaceutical market, see Aidan Hollis, *How Do Brands’ “Own Generics” Affect Pharmaceutical Prices?*, 27 REV. INDUS. ORG. 329 (2005); Ying Kong & James R. Seldon, *Pseudo-Generic Products and Barriers to Entry in Pharmaceutical Markets*, 25 REV. INDUS. ORG. 71 (2004).

113. See Lunney, *supra* note 24, at 439 (“[U]nless some other efficiency gain can be tied to extending protection in such cases, protecting marks based on their value independent of their informational role risks creating monopolies, not merely in the neutral, descriptive sense, but in the ordinary and pejorative sense of unjustified and inappropriate market power.”).

percentage of the consuming public.

Walking through the implications of each scenario makes obvious the harms of overprotection and the banality of under-protection. In scenario (a), producers can still protect their interests through promoting the other non-lexical attributes of their brands. Further, they generally maintain protection against unfair competition and false advertising when competitors attempt to appropriate those non-lexical attributes. Consumers will undoubtedly find it easier to discover competing products previously undiscoverable due to producers' extension of their trademark rights to maintain their market share. The threat of a suit due to non-trademark uses of the term will be reduced as well, likewise to consumers' benefit.¹¹⁴

In scenario (b), producers are essentially given license to carve out a swath of protection larger than their word mark merits. Consumers, on the other hand, gain nothing. Their search costs are not reduced. These costs may in fact increase, as competing producers must come up with other ways to describe their products rather than using the term by which the public knows the product.¹¹⁵ A consumer who does not know how to ask for a "flying disc" will generally ask for a "frisbee," thereby potentially shifting profits from would-be competitors to the rights holder and chilling competition in the market for frisbees.

It is inefficient to extend an artificial monopoly of indefinite duration over a word that consumers use to refer to a class of products.¹¹⁶ That arises, in part, out of search costs theory: if consumers in fact use a term to describe a product within the class and care less—or not at all—about the source, then the law's artificial monopoly does not do any work. It does not reduce search costs in the market by distinguishing products, but rather by permitting only one distributor to offer the product at the expense of potential competitors. As the Second Circuit once

114. This refocusing on consumer welfare echoes the Chicago School's approach to antitrust law, which, to brutally oversimplify, focuses primarily on protecting competition writ-large rather than individual competitors. *See, e.g.*, ROBERT BORK, *THE ANTITRUST PARADOX* (1978); RICHARD A. POSNER, *ANTITRUST LAW* (2d ed. 2001); RICHARD A. POSNER, *ECONOMIC ANALYSIS OF THE LAW* (7th ed. 2007); *see also* Daniel A. Crane, *Reviews, Chicago, Post-Chicago, and Neo-Chicago*, 76 U. CHI. L. REV. 1911 (2009) (discussing the rise of the Chicago School); Richard A. Posner, *The Chicago School of Antitrust Analysis*, 127 U. PA. L. REV. 925 (1979).

115. Landes & Posner, *supra* note 22, at 291 ("If the producer of one brand could appropriate the name of the product, he would earn rents because of the added cost to his rivals of periphrasis—of describing their products as 'heavier-than-air flying machines' [airplanes] or 'artificial-intelligence machines[]' [computers]"); *see also id.* at 294–95 (discussing cost-benefit balancing in the context of generic terms).

116. *See, e.g.*, Lunney, *supra* note 24, at 439.

explained:

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.¹¹⁷

Competitors who cannot speak their consumers' language are at a significant market disadvantage.

There is also a social cost. Our culture of relatively unconstrained communication is threatened when noncommercial users, such as artists and authors, are routinely subjected to spurious threats from mark holders.¹¹⁸ While producers may myopically prefer such an outcome in the short run as it allows them more control over their brand personae, producers may—and often do—practically prefer their word marks to be used generically, considering that cognitive psychology research has shown that the more often we are exposed to a stimulus, the more likely we are to come to prefer it.¹¹⁹ Further, even a word mark that has fallen into genericness is still generally protectable against passing off¹²⁰ and

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

118. See Kim, *supra* note 32; see also John F. Coverdale, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHI. L. REV. 868 (1984); Desai & Rierson, *supra* note 59; Mark A. Lemley & Stacey L. Dogan, *Parody as Brand* (Stanford Public Law, Working Paper No. 2170498, 2013), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2170498.

119. Jeremy N. Sheff, *The (Boundedly) Rational Basis of Trademark Liability: Reconciling the Federal Trademark Dilution Act with the Lanham Act*, 15 TEX. INTELL. PROP. L.J. 331, 365 (2007); see also *id.* at 365 n.178 (citing Paul Slovic, Melissa Finucane, Ellen Peters & Donald G. MacGregor, *The Affect Heuristic*, in HEURISTICS AND BIASES: THE PSYCHOLOGY OF INTUITIVE JUDGMENT 397 (2002); Jon D. Hanson & Douglas A. Kysar, *Taking Behavioralism Seriously: Some Evidence of Market Manipulation*, 112 HARV. L. REV. 1420 (1999)). This argument's impact is blunted, though not completely, by marketing studies finding that visual complexity of the stimulus directly affects consumers' preferences for that stimulus. See Dena Cox & Anthony D. Cox, *Beyond First Impressions: The Effects of Repeated Exposure on Consumer Liking of Visually Complex and Simple Product Designs*, 30 J. ACAD. MARKETING. SCI. 119 (2002) (reporting a study finding that consumers' aesthetic preferences for "visually complex" product designs tended to increase with repeated exposure to the stimulus, while the opposite occurred for "visually simple" product designs).

120. See, e.g., *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 150 (2d Cir. 1997) (finding that, although the HONEY BROWN ALE [word] mark was generic, defendant could still be liable if it did not use "every reasonable means to prevent confusion" as to source (quoting *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 115 (1938))); *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1045 n.22 (D.C. Cir. 1989) ("[A] generic term with de facto secondary meaning may be protected against passing off, e.g., by requiring fair notice that a newcomer's product or service does not come from the original source."); *PSK, L.L.C. v. Hicklin*, 757 F. Supp. 2d 836, 858 (N.D. Iowa 2010) (finding "overhead" generic in the context of garage doors and nonetheless refusing to bar plaintiff's § 43(a) passing off claim, reasoning relief may be appropriate if the copier has not taken reasonable measures to protect against de facto

false advertising.¹²¹ (Technically, these claims require *de facto* secondary meaning, but that threshold would seem to be quite easily satisfied in the case of a hybrid word mark.) Thus, while finding more word marks generic may be tough medicine for producers in the short run, it may inure to the benefit of consumers *and producers* in the long run.¹²² The key to understanding why this is so is recognizing that the term is only a single piece of the brand¹²³: the VASELINE brand is not simply the term “vaseline” but all the other things that go with it—the squat jar, the blue label, the typeface—along with all of the positive (or negative) associations attached to the brand.¹²⁴ Broader use of the term in diverse markets—or even in competitive markets—simply does not pose much of a problem when other producers must still distinguish the visual aspects of their marks from the initial producer’s mark.

confusion); 2 MCCARTHY, *supra* note 25, § 12:48, at 12-201 to -202 (footnote omitted) (“In the author’s opinion, in order to obtain some form of relief on a ‘passing off’ claim, the user of a generic term must prove some false or confusing usage by the newcomer *above and beyond* mere use of the generic name. This might include, for example, packaging or advertising words or graphics which, in combination with the generic term, cause mistake or confusion as to source.”); Desai & Rierson, *supra* note 59, at 1816–20 (cataloguing early cases and describing the doctrine in more detail); Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 TRADEMARK REP. 1223 (2007).

121. See, e.g., 2 MCCARTHY, *supra* note 25, § 12:48, at 12-202 (citing *E. Air Lines, Inc. v. N.Y. Air Lines, Inc.*, 559 F. Supp. 1270 (S.D.N.Y. 1983)) (“In some cases, the kind of claim a company has against a new competitor is not a ‘passing off’ claim, but a false advertising claim. This occurs when a newcomer uses a generic term to falsely claim to be selling the same product or service identified by that term as does the established company.”).

122. This argument directly contravenes accepted wisdom. See, e.g., BARTON BEEBE, ET AL., TRADEMARKS, UNFAIR COMPETITION, AND BUSINESS TORTS 73 (2010) (“When a court declares a trademark generic, it destroys a right built up with considerable investment.”). For further elucidation of the majority view, see Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2124 (2004) (arguing that the cost of a ruling that errantly denies trademark protection is “much greater than the cost of a false positive error” because “erroneously failing to protect the word when it in fact serves as a source-identifying mark might be very costly if consumers end up confused about a competing firm’s product”); see also Desai & Rierson, *supra* note 59, at 1833, 1844, 1846–49 (citing Professor Bone and making a similar argument). Two points in response: First, as Professor Desai notes in his later work, trademarks are not brands, and brands are where the value is. Rather, even if the term is held generic, the other aspects of the brand remain protectable. Second, as noted above, the producer that markets its goods under a generic trade name still retains protection against confusing uses via claims for false advertising and passing off. As I argue below, the limited scope of protection afforded to these terms is actually much better than the typical word mark from a speech and competition perspective and should be adopted more broadly.

123. Google presumably recognized this when the company decided to “open-source[.]” the Android logo in order to promote consumer collaboration and engagement. Pagan Kennedy, *Who Made That? (Android Logo)*, N.Y. TIMES MAG., Oct. 11, 2013, at MM17.

124. See *supra* text accompanying notes 95–96.

2. Genericness Surveys

The prevailing genericness survey models, the *Thermos* and *Teflon* models, are based on the faulty binary understanding of word marks illustrated here and by Professors Folsom and Teply several decades ago.¹²⁵ In this Subpart, I briefly summarize both models and make observations on where hybridity can help fill in gaps in the analysis.

The first type is the *Thermos* survey, the first of which was taken in *American Thermos Products Co. v. Aladdin Industries, Inc.* to show that “thermos” had become generic for vacuum flasks.¹²⁶ The *Thermos* survey tells respondents to imagine walking into a store and asking for the product at issue. The defendant’s survey asked questions like:

Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time?

If you were going to buy one of these containers tomorrow—that is, the type that keeps food and beverages hot or cold—what type of store would you select to make your purchase?

What would you ask for—that is, what would you tell the clerk you wanted?¹²⁷

Roughly 75% of the 3000 respondents said “thermos,” while 11% said “vacuum bottle.”

These responses do not necessarily reflect what the respondents were actually requesting. Some of those who asked for a thermos might have preferred a THERMOS-brand vacuum bottle, but others might have preferred any vacuum bottle. As Professor McCarthy explains:

[One] drawback of a “Thermos Survey” is that for a very strong trademark, respondents with brand loyalty may answer with the trademark and drop what they consider to be a generic name, because it’s so obvious to them. For example, one of the 75% that answered “Thermos” might say, “I said ‘Thermos’ because that’s the brand I would buy. I don’t like those other inferior vacuum bottles.”¹²⁸

But “brand loyalty” may not operate as strongly as Professor McCarthy suggests for the reasons described above. And in any event, it may not be necessary to trigger this response. Rather, as trademark hybridity illustrates, it is entirely possible that the hypothetical

125. See Folsom & Teply, *Surveying ‘Genericness,’ supra* note 11; Folsom & Teply, *A Reply to Swann, supra* note 11.

126. *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d sub nom. King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963).

127. See 2 MCCARTHY, *supra* note 25, § 12:15, at 12-55 (providing an abridged version of the *Thermos* survey from which the above quotation is taken).

128. *Id.* § 12:15, at 12-56 (footnotes omitted).

respondent recognized “thermos” as *both* a brand and a generic term. “THERMOS-brand thermoses” may seem redundant on first view, but is completely comprehensible in context.¹²⁹

The second type is the *Teflon* survey, the first of which was taken in *E.I. Du Pont de Nemours & Co. v. Yoshida International Inc.* to assist in determining whether DuPont’s TEFLON word mark had become generic for non-stick pans.¹³⁰ The *Teflon* survey is basically a mini-course in trademark genericness, followed by a series of questions to determine whether the consumer thinks a given name is a brand name or a generic name.¹³¹ The survey and results in *Yoshida International* follow:¹³²

I’d like to read 8 names to you and get you to tell me whether you think it is a brand name or a common name; by *brand* name, I mean a word like *Chevrolet* which is made by one company; by *common* name, I mean *a word like automobile* which is made by a number of different companies. So if I were to ask you, “Is Chevrolet a brand name or a common name?” what would you say?

Now, if I were to ask you, “Is washing machine a brand name or a common name?,” what would you say?

[If respondent understands, continue. If not understand, explain again.]

Now, would you say — is a brand name or a common name?

Name	Brand %	Common %	Don’t Know %
STP	90	5	5
THERMOS	51	46	3
MARGARINE	9	91	1
TEFLON	68	31	2
JELLO	75	25	1
REFRIGERATOR	6	94	-
ASPIRIN	13	86	-
COKE	76	24	-

129. This argument should not be read to imply that brand loyalty is worthless in business terms. Indeed, consumers often pay significantly more for brand name drugs despite the fact that chemically identical generic versions of the drugs are often available. Rather, my argument is that even the most loyal consumers are likely to recognize that a trademarked term’s meaning—in conversation and in commerce—will often depend on the context in which the term is used. I may love GOLD STAR-brand Cincinnati chili, but that doesn’t mean I’m necessarily going to be confused as to whether “Gold Star Studios” in Los Angeles or “Gold Star Bar” in Chicago are affiliated in any way with the company behind the chili.

130. *E.I. DuPont de Nemours & Co. v. Yoshida Int’l*, 393 F. Supp. 502 (E.D.N.Y. 1975).

131. 2 MCCARTHY, *supra* note 25, § 12:16, at 12-57.

132. The survey and results are adapted from 2 MCCARTHY, *supra* note 25, § 12:16, at 12-57 to -58.

The *Teflon* survey utterly ignores trademark hybridity. Asking consumers to select between “brand” and “common” presents a false dichotomy. There is no reason why a given term, such as “teflon,” cannot coexist as both a brand and a product (or something else)¹³³ in consumers’ minds. Were the survey to account for hybridity, a much higher percentage of consumers than 31% would think “teflon” is a generic term for non-stick pans or non-stick coating regardless of those consumers’ knowledge of the TEFLON brand.

More generally, these surveys mistake language for being the sole locus of interest in the analysis¹³⁴ without appreciating the importance of visual, spatial, and other contexts for distinguishing various senses or meanings of the term at issue from each other. Southerners might think “coke” is a perfectly acceptable generic term for all soft drinks, but nonetheless may not find the meaning of “coke” ambiguous when displayed in the flowery cursive script the company always uses on its products. The surveys as designed are completely insensitive to this type of context.

Even Professors Folsom and Teply’s models are relatively insensitive to context, though they do a much better job of getting the linguistic aspects of the inquiry correct.¹³⁵ As they illustrate, it is fairly easy to design a more accurate survey. Litigants should design a questionnaire to discover whether a name is familiar as a brand, and a separate one to discover whether it is familiar as a generic product name in order to achieve independence on both meanings. Some words may be high on one scale and low on the other, some may be high on both (like JELLO, KLEENEX, XEROX, etc.), and some might be low on both if the term is unfamiliar to consumers. There is no principled reason to force consumers to definitively choose one meaning among multitudes.

By setting up the false dichotomy of “brand” and “product,” existing surveys systematically favor the owners of word marks that may have become de facto generic at the expense of competitors and the consuming public. This preference for existing producers has real costs. For example, trademarked terms can be used to stifle competition, and

133. John Gotti was nicknamed “The Teflon Don” after being acquitted three times in the 1980s, presumably because charges couldn’t stick to him.

134. *Accord* Desai & Rierson, *supra* note 59, at 1826 (“[T]he current doctrine over-emphasizes the etymological categorization of words, rather than the core questions of (1) whether the mark functions as a source-identifier in a commercial context, and (2) whether trademark protection will help or hinder competition.”).

135. See Folsom & Teply, *Surveying ‘Genericness,’ supra* note 11; Folsom & Teply, *Reply to Swann, supra* note 11.

when the term is found generic, markets open up.¹³⁶ The owners of the MONOPOLY word mark at one point effectively used their rights to restrict competition in the “monopoly game” market. When the Ninth Circuit found “monopoly” generic for use on monopoly games in *Anti-Monopoly, Inc. v. General Mills Fun Group*,¹³⁷ the market for these games exploded. Amazon.com lists 1705 results (and counting) for “monopoly” games, offered by a variety of producers, and including dozens of versions of the game created by Hasbro, the current owner of the MONOPOLY brand.¹³⁸

When a producer monopolizes a word mark that has become generic, competitors cannot find their consumers, and consumers cannot effectively find those competitors’ products. If a consumer is not sophisticated enough to know to look for a “real estate trading board game” rather than “monopoly,” then comparative searching becomes prohibitively difficult, if not impossible. *Anti-Monopoly*’s consumer motivation test may have shot wide of the target, for reasons beyond this Article’s scope,¹³⁹ but it is difficult to question the benefits consumers have realized on the backend.

As illustrated above, the *Teflon* and *Thermos* survey models make no sense in light of trademark hybridity’s existence.¹⁴⁰ Rather than outline

136. See Coverdale, *supra* note 118, at 870 (“It would clearly thwart the pro-competitive purpose of trademark law to permit a producer to use trademarks to achieve monopolies over the production or sale of uncopyrighted and unpatented products.”).

137. *Anti-Monopoly, Inc. v. Mills Fun Grp., Inc.*, 684 F.2d 1316, 1327 (9th Cir. 1982). The Trademark Clarification Act of 1984 amended the Lanham Act to repudiate the “consumer motivation” test adopted by the Ninth Circuit in *Anti-Monopoly* but did not abrogate the court’s decision that “monopoly” was generic for “monopoly games.” Trademark Clarification Act of 1984, Pub. L. 98-620, 98 Stat. 3335 (Nov. 8, 1984) (amending 15 U.S.C. § 1051 (2012)). Apparently the MONOPOLY registrations were not actually canceled. See *Parker Bros. v. Tuxedo Monopoly, Inc.*, 225 U.S.P.Q. (BNA) 1222, 1224 (T.T.A.B. 1984), *appeal dismissed per stipulation*, 757 F.2d 254 (Fed. Cir. 1985) (“Notwithstanding the [Ninth Circuit’s] decision, [Parker Brothers’] registrations for the mark ‘MONOPOLY’ were not ordered to be cancelled and, according to [PTO] records, are still active registrations.”). In any event, Hasbro does not appear to be enforcing those registrations vigorously against various other -OPOLY manufacturers.

138. I searched for [MONOPOLY] in the Toys & Games > Games > Board Games section of Amazon.com on February 27, 2013, and found 1333 results. The first result was the classic *Monopoly* game, with many other options available on the first page, including *Monopoly Nintendo*, *National Parks Monopoly*, and *Pirates of the Caribbean Monopoly*. The result in the text of this Article is current as of September 20, 2014.

139. For a discussion, see, e.g., Wayne F. Osoba, *The Legislative Response to Anti-Monopoly: A Missed Opportunity to Clarify the Genericness Doctrine*, 1985 U. ILL. L. REV. 197 (1985).

140. *Accord* Folsom & Teply, *Trademarked Generic Words*, *supra* note 11; Folsom & Teply, *Surveying ‘Genericness,’ supra* note 11; Folsom & Teply, *Reply to Swann, supra* note 11.

in detail here what an ideal genericness survey might look like, I leave that to future work, keeping in mind that a proper survey must balance competing policy concerns, such as the level of liability risk we expect mark holders to bear and the pro-competitive purpose of trademark law.¹⁴¹

C. Dilution

The Lanham Act protects famous marks against two types of trademark dilution: (1) blurring; and (2) tarnishment.¹⁴² As some scholars have noted, the alleged harms that arise from genericness and dilution are thematically intertwined.¹⁴³

Blurring reflects the idea that the presence of multiple uses of a term in commerce, even in diverse markets, will tend to decrease the consumer's ability to recall the senior user's word mark. In other words, the consumer's mental link between the term and the senior user is "blurred" by the existence of another user's use of the term.¹⁴⁴ The consumer whose mental representation of the term has been blurred must "think for a moment"¹⁴⁵ before the senior user comes to mind. In other words, the consumer's "imagination costs" have been raised, which is generally assumed to be inefficient.¹⁴⁶ The intuition is very much tied up in the concept of free riding. For example, if a restaurateur opens a Mexican restaurant and names it TIFFANY, the

141. Professor Craswell has examined similar issues in the false advertising context. See Richard Craswell, "Compared to What?" *The Use of Control Ads in Deceptive Advertising Litigation*, 65 ANTITRUST L.J. 757 (1997).

142. 15 U.S.C. § 1125(c) (2012). For arguments that dilution should not be actionable, see Lunney, *supra* note 24; Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 85 TRADEMARK REP. 525 (1995); Tushnet, *Gone in 60 Milliseconds*, *supra* note 18.

143. See, e.g., Butters, *supra* note 99, at 515–18 (tying together the harms arising from the fall into genericness and dilution); Desai & Rierson, *supra* note 59, at 1842–44 (discussing dilution and "genericide").

144. See, e.g., Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291, 313 (2003) (citing *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.2d 157 168 (3d Cir. 2000)) ("Blurring occurs when the defendant's use of its mark causes the public to no longer associate the plaintiff's famous mark with its goods or services . . ."); Stacey L. Dogan, *What is Dilution, Anyway?*, 105 MICH. L. REV. FIRST IMPRESSIONS 103, 105 (2006) (discussing blurring in the context of the "likelihood of dilution" test); William M. Landes, *Posner on Beanie Babies*, 74 U. CHI. L. REV. 1761, 1765–68 (2007) (setting forth a formal economic model of blurring).

145. Richard A. Posner, *When is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 75 (1992).

146. Bradford, *supra* note 26, at 1278; Landes & Posner, *supra* note 22, at 207. Beebe has argued that the "search costs" description of antidilution law is, ironically, not what the concept of "dilution" is all about. Rather, dilution is about maintaining trademarks' (and other intellectual properties') ability to manufacture social distinction. See Beebe, *Intellectual Property and the Sumptuary Code*, *supra* note 30, at 845–68.

jewelry store may make two complaints: First, that the restaurateur is attempting to siphon the jewelry store's goodwill in lieu of developing its own through repeated consumer interaction. Second, the jewelry store will complain that the existence of another TIFFANY blurs the consumer's mental connection between the term and the jewelry store, making the association between the goodwill and jewelry weaker, and depleting the reservoir of goodwill.

Tarnishment is, in theory, much like blurring. The connotations the consumer develops, however, are explicitly negative rather than neutral.¹⁴⁷ Thus, if instead of a restaurant, our entrepreneur opens up a TIFFANY strip club, the jewelry store will argue that its mark (read: brand image) is being tarnished by the term's connection with a seedy strip club. Courts generally only find tarnishment when the junior user's goods or services are related to sex.¹⁴⁸ But as Professors Lemley and Dogan have argued, many courts "seem to have misunderstood tarnishment as 'saying something bad about the trademark owner,' rather than its proper meaning of 'branding your own inferior or noxious goods with the plaintiff's [word] mark.'"¹⁴⁹ Professor Beebe similarly describes how tarnishment has expanded to govern uses that simply lower the value of a producer's goodwill or harm its reputation.¹⁵⁰

Tarnishment is tricky because the paradigmatic case of tarnishment—the residual harm arising from an affective association between a term or brand image and other irreconcilable or disagreeable values or images—has at least some empirical basis.¹⁵¹ Professor Bradford, drawing on cognitive psychology research, has argued that, while the risk of negative perception may be heightened where consumers

147. See Landes, *supra* note 144, at 1768–69 (setting forth a formal economic model of tarnishment).

148. See, e.g., *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 385 (6th Cir. 2010) (creating a "rebuttable presumption" of tarnishment where the defendant has used the plaintiff's mark or a similar mark in association with sex-related products).

149. Lemley & Dogan, *supra* note 118, at 483; Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 134–36 (2012) (arguing this misunderstanding of tarnishment is inherent in the concept itself).

150. See Beebe, *Intellectual Property and the Sumptuary Code*, *supra* note 30, at 858 ("Such uses include, of course, dilutive copying that tarnishes the mark's reputation for uniqueness, regardless of whether that copying takes the form of 'shoddy' copies, and regardless of whether that copying places the targeted mark in an 'unwholesome or unsavory context.'").

151. See Jennifer Aaker et al., *When Good Brands Do Bad*, 31 J. CONSUMER RES. 1, 13 (2004); Laura R. Bradford, *Parody and Perception*, 46 B.C. L. REV. 705, 743 (2005) (citing JOHN O'SHAUGHNESSY & NICHOLAS JACKSON O'SHAUGHNESSY, *PERSUASION IN ADVERTISING* 64–65 (2004)).

attribute the inconsistent message to the senior user, this is not always the case.¹⁵² Consumers may develop negative perceptions even when they do not attribute the message to the senior user. To the extent that tarnishment is limited to such harms, I have no conceptual issue with its use.¹⁵³ But when taken more broadly in the way Professors Dogan, Lemley, and Beebe describe, tarnishment falls prey to the same issues described below with respect to dilution by blurring.

As with generic terms, blurring's alleged harms to consumers arise from semantic ambiguity. The difference is that in most situations, a word mark's fall into genericness happens gradually and naturally.¹⁵⁴ Usually, the term develops additional senses through no particular affirmative acts of competitors, but instead through consumer linguistic usage over time. By contrast, dilution by blurring is said to occur when a separate business entity adopts another's word mark as its own. In other words, the new entity creates out of whole cloth an additional meaning—a homonym—for the preexisting term. Recall the earlier discussion of spreading activation.¹⁵⁵ This theory posits that when a term is heard or read, multiple meanings (or senses) of the term are activated—most wrong, at least one right. The research described above shows people resolve these semantically ambiguous situations by using contextual clues to make a particular judgment about how to interpret the term, often before the sentence is even finished.¹⁵⁶ Consumers are therefore *constantly* dealing with semantic ambiguity. And they deal with it quite well given detail and context.

That consumers are so accustomed to dealing with this type of ambiguity should be a sign that blurring's purported harms, if they exist, are relatively minor in empirical terms. Recall that research suggests that such an increase in semantic associations may, contrary to the internal search costs theory, reinforce rather than inhibit retrieval and recognition of the primary association.¹⁵⁷ Blurring and tarnishment imply interference, but it is not so clear that the addition of new senses

152. *Id.* at 756.

153. Although I note that, notwithstanding such actual harm, there may be other normative reasons such as our commitment to freedom of expression that may call into question the desirability of providing producers recourse against tarnishment.

154. Recognizing the market gains to be had, many mark holders try to render their word marks de facto generic. See *supra* note 102 and accompanying text (describing the marketing approaches taken with respect to the Leatherman multi-use tool and Garmin GPS).

155. See *supra* Part I.B.

156. See, e.g., Stephani Foraker & Gregory L. Murphy, *Polysemy in Sentence Comprehension: Effects of Meaning Dominance*, 67 J. MEMORY & LANGUAGE 407 (2012).

157. See *supra* text accompanying notes 55–77.

and meanings are negative; rather, they may be positive and productive.¹⁵⁸ The addition of new senses and meanings may not be “death by a thousand cuts”¹⁵⁹ then, but instead more akin to a snowball forever rolling down a hill.

Indeed, even if the internal search costs model bears out empirically, it is not clear whether the law should care. Trademark law allows businesses to broadly adopt laudatory word marks, such as “Acme” or “Gold Star,” and geographic word marks, such as “American,” which complicates the case for dilution by blurring. American Airlines maintains a very strong brand in the airline industry, as does American Recordings in the music industry. So, we broadly permit multiple “American” marks in various industries, as well as a variety of businesses using terms like “Gold Star.” Is the issue that we do not care whether there is blurring in these situations, or is it that we do not know how blurring will affect business? As Professor Tushnet notes, studies on brand extensions that flopped have borne out the conclusion that consumers’ mental conceptions of individual brands are remarkably robust, which suggests these conceptions have little effect on future purchasing decisions.¹⁶⁰ If blurring occurs, then, we would have to see it happen en masse with dozens, possibly even hundreds or thousands of businesses adopting the same term before seeing any major effect on purchasing decisions. And as noted below, this has not occurred yet—and in any event seems unlikely to occur.

The case is further complicated when we consider the case of arbitrary word marks. Do my bad experiences with royal gala apples taint my relationship with my iPod? Does my palpable dislike of the

158. *See id.*

159. *See* 4 MCCARTHY, *supra* note 25, § 24:120, at 24-415 to -416 (“Like being stung by a hundred bees, significant injury is caused by the cumulative effect, not by just one. Or, that like a death by a thousand small cuts, or the wood worker whittling, the first small cut will necessarily be the first of many that will whittle away the strength of the famous mark.”).

160. *See* Anna Kirmani et al., *The Ownership Effect in Consumer Responses to Brand Line Stretches*, J. MARKETING 88, 99 (1999); Deborah Roedder John et al., *The Negative Impact of Extensions: Can Flagship Products Be Diluted?*, J. MARKETING 19, 20 (1998); Tushnet, *Gone in Sixty Milliseconds*, *supra* note 18, at 543 & nn.176-77 (citing, *inter alia*, Stephen J. Hoch, *Product Experience Is Seductive*, 29 J. CONSUMER RES. 448, 451 (2008); Nicole L. Votolato & H. Rao Unnava, *Spillover of Negative Information on Brand Alliances*, 16 J. CONSUMER PSYCHOL. 196, 201 (2006)) (describing research showing “that dilution by tarnishment through the use of a similar mark on a shoddy product is unlikely in the absence of source confusion because consumers have robust mental concepts of strong brands. If consumers are given a reason to distinguish an authorized extension or cobranded product from the core brand . . . they will do so, and negative opinions about the extension will not return to harm opinions of the core brand”).

Phoenix Suns¹⁶¹ make me less likely to use software developed by Sun Microsystems? Extending the argument outside of trademark law makes clear just how banal the purported dilution harm actually is. Does the fact that I have ten friends named John necessarily mean that I cannot help but constantly confuse them with each other, or have my negative experiences with one contaminate my feelings for the others? The simple term itself—“apple,” “sun,” or “John”—isn’t adequate to capture the full measure of our experiences.

Hybridity bears on these questions because their relatively obvious absurdity illustrates this Article’s key point: context matters. In order to “whittle away” at a brand’s goodwill, the alleged diluter’s trademark must bear a much tighter resemblance to the famous mark in every way rather than simply being a use of the same or a similar term. And even then, the robustness Professor Tushnet describes may render the harm illusory.

Finally, as noted above, the law has no threshold for what “harm” should be, should such harm exist. An increased response time that does not result in any type of tangible harm like a lost sale seems rather *de minimis* in the larger scheme of things. Further, the other aspects of the brand, including trade dress, logos, and positive (or negative) affective responses to that brand are significant additional confounding factors. Even if we agree that some particular threshold of increased response time is statistically—and economically—significant when controlling just for the word mark itself, researchers who find such an increase will tend to elide the distinctions consumers make that arise in actual trademark use in order to isolate the harm for measurement.¹⁶² But by taking away the context, these researchers also render toothless the quality of those measurements as means of proving real harm.

Dilution by blurring can be justified as a bulwark against unfair competition, but realistically it can only be done to the extent that there is *confusion* due to the contextual proximity of the trademarks in terms of typeface, term, product category, or design, among others. Blurring

161. Author’s Disclosure: I’m a Golden State Warriors fan.

162. See Tushnet, *Gone in Sixty Milliseconds*, *supra* note 18, at 531 n.123 (critiquing other studies on similar grounds). Compare Maureen Morrin & Jacob Jacoby, *Trademark Dilution: Empirical Measures for an Elusive Concept*, 19 J. PUB. POL’Y & MARKETING 265 (2000) (conducting a stylized experiment in which exposure to dilutive ads led to an average of 770 milliseconds before respondents could recognize the senior mark as fitting within a product category, as opposed to 748 milliseconds for the control group), with Tushnet, *Gone in Sixty Milliseconds*, *supra* note 18, at 531 (critiquing Morrin & Jacoby’s experiment on the grounds that the environment potentially “was itself decontextualizing, depriving subjects of the cues they would ordinarily use to distinguish a dilutive use from a senior mark.”).

thus unravels into confusion, which itself breaks down under linguistic analysis into a simple claim for passing off as unfair competition. Clear context delivers us from ambiguity; unclear context results in harm, but the harm arises from consumers thinking Producer A's goods came from Producer B (or vice versa). Unfair competition law is already around to deal with that harm.

None of the above should be taken as absolute proof against the existence of some type of dilution-like harm. Rather, the claim is a more limited one: for the reasons stated above, cognitive science and psycholinguistics do not provide the basis for a full-throated defense of dilution by blurring.¹⁶³ The current legal framework does not sufficiently describe what dilution is, how to measure it, or how much of it is necessary to support a cause of action. Courts have, for the most part, implicitly recognized the claim's theoretical failure and, according to Professor Beebe and others, have relegated these claims to the dustbin.¹⁶⁴ But antidilution law has effects beyond the judicial system. Most overreaching behavior takes place in the shadow of the law through cease-and-desist letters and other bottom-up approaches. It is unlikely most recipients of an overbroad cease-and-desist letter would understand the nuanced approach—verging on outright hostility—courts have taken to dilution claims. Rather, they are likely to see the claim, the citation to and quotation of the statute, and simply fold because they cannot afford to challenge it or because their knowledge of the law is incomplete.¹⁶⁵ The statute's mere existence thus causes significant problems.

Efforts to protect the producers of products bearing famous marks, should we find them necessary, should be explicit, acknowledging full-

163. *Accord* Tushnet, *Gone in Sixty Milliseconds*, *supra* note 18.

164. *See* Beebe, *Intellectual Property and the Sumptuary Code*, *supra* note 30, at 849 nn.202–03 (citing Barton Beebe, *The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 449 (2008); William Michael Darling, *Depreciation in Canadian Trade-Mark Law: A Remedy in Search of a Wrong*, 21 INTELL. PROP. J. 49, 72 (2007); Dev Gangjee, *The Polymorphism of Trademark Dilution in India*, 17 TRANSNAT'L L. & CONTEMP. PROBS. 611, 611 (2008); Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029 (2006); Kenneth L. Port, *Trademark Dilution in Japan*, 4 NW. J. TECH. & INTELL. PROP. 228, 231 (2006)). Beebe argues that this failure to garner favor is due to the “economistic” turn in trademark law and the seeming insignificance of whatever effects an increase in “internal search costs” might have on consumer decision-making. *Id.* at 849.

165. *Cf.* COOMBE, *supra* note 16, at 9 (“People’s imagination of what ‘the law says’ may be a shaping force in those expressive activities that potentially violate it and in those practices that might be considered protected acts of ‘speech,’ constitutionally defined. People’s anticipations of law . . . may actually shape law and the property rights it protects.”).

well what we are granting is a strong, broad, exclusive property interest in a word or phrase.¹⁶⁶ And we should only grant such a right if we fully understand the extent to which those producers will, quite rationally, seek to expand it. We must also understand how producers will use that expanded protection as a new lower baseline in order to continue expanding the scope of protection afforded their marks. In my view, the better approach would be to simply jettison this part of the statute given the high costs and potential for anti-consumer and anti-speech behavior on the part of mark holders. Should future research bear out an actual harm that is consistently replicable, if scientists, factfinders, and policymakers can agree on an appropriate threshold for the claim, and, perhaps most importantly from a practical perspective, these surveys can be run cost effectively in the course of the average litigation, antidilution protection might *then* merit consideration. In the alternative, we can at least push for a clearer understanding of what dilution is, how much is necessary to support a suit, and how we measure that amount.

D. Market Competition

Many scholars have argued that permitting exclusive control over generic and hybridized word marks¹⁶⁷ can impose significant societal costs, including the creation (or prolonging) of a market monopoly.¹⁶⁸

166. Property-like exclusive rights are not *inherently* problematic. However, they *are* problematic where they are broad and relatively unlimited. On this point, see Michael A. Carrier, *Cabining Intellectual Property Through a Property Paradigm*, 54 DUKE L.J. 1 (2004).

167. This Subpart focuses primarily on the competitive effects of protecting generic or hybridized word marks against a finding of genericness. Antidilution protection's effect on the overall product market is less direct because, at least in theory, the cause of action provides recourse primarily against non-competitors. And where the market is, again in theory, for the particular brand itself rather than the products either producer makes, the calculation of efficiency gains and losses become murkier, and the moral rights concerns that seem to drive antidilution protection become more obviously salient. As this Article demonstrates, the "efficiency gains" netted by the internal search costs theory are more ephemeral than real. A formal economic analysis of antidilution protection's effect on market competition in light of hybridity is beyond the scope of this Article, if only for space reasons. Nonetheless, the concerns voiced in the latter half of this Subpart apply equally in the dilution context.

168. See Folsom & Teply, *Trademarked Generic Words*, *supra* note 11, at 1340–46. Among other costs to competition, Folsom and Teply describe the difficulty of "assur[ing] consumers that [a competitor's product is] in the product-category covered by the trademarked generic word, so that consumers' search costs may be reduced, experience purchases encouraged, and the perceived risks decreased." *Id.* at 1344. Remedies to these problems include adopting an alternative generic signifier (which often doesn't work because the alternative names are too technical, unfamiliar, or simply cannot convey the level of information necessary), point-of-sale advertising and packaging (which doesn't work when dealing with services and many other experience goods), and licensing. *Id.* at 1344–45. However all of the alternatives are very costly

As Professors Folsom and Teply explained:

[P]roducers of goods are under a strong economic incentive to select a generic word as their trademark or to encourage consumers to adopt their trademark as a household term. Generic use of a trademark in advertising is thought to be a desirable marketing strategy because it excludes all mention of competing brands and even suggests their nonexistence. Moreover, the use of generic words as trademarks increases search costs because consumers may be unable to determine whether potentially competing products are within the same product category or whether they have the same general characteristics associated with the trademarked generic word. In this way, the use of generic words as trademarks creates an entry barrier that enhances the ability of the firm holding the generic mark to charge supracompetitive prices.¹⁶⁹

To blunt this tendency, many scholars have advocated a genericness doctrine focused on the competitive effects of allowing an allegedly generic term to continue to be used as a trademark.¹⁷⁰ This conceit should be no less applicable in those situations where a particular word mark carries different meanings in different contexts.¹⁷¹ But nearly all words—trademarks or not—carry varied meanings and senses. Privileging some meanings or senses over others makes little sense outside of a pure investment protection rationale.

Most scholars would likely agree that creating and prolonging market monopolies is a net negative, and that in those circumstances where consumers literally do not know how to ask for a product without using a term that has been granted trademark status—“monopoly,” “yo-yo,” “thermos,” among others—the answer to the question whether finding a

and potentially ineffective due to the same type of first-mover disadvantage problems that necessitate the class action system or that make many large-scale–public-oriented innovations like the Google Book Project nearly impossible to accomplish. See Randal C. Picker, *Access and the Public Domain*, 49 SAN DIEGO L. REV. 1183, 1206 (2012) (“Of course, Google doesn’t want to face a first-mover disadvantage where it bears the cost of scanning and then second movers free ride on those scans.”).

169. Folsom & Teply, *Trademarked Generic Words*, *supra* note 11, at 1337.

170. See, e.g., Coverdale, *supra* note 118, at 880–81 (citing *Am. Chiclé Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 562 (2d Cir. 1953)) (“Rather than ending with the narrow lexicological inquiry mandated by the primary significance test, a court faced with a genericness case should seek to balance the conflicting interests of the trademark holder, the alleged infringer, and the public in the manner that most tends to foster competition in the relevant product market.”); see also Folsom & Teply, *Trademarked Generic Words*, *supra* note 11, at 1352 (“Will market transactions proceed more efficiently if the trademark holder is permitted exclusive use of the mark, or will they proceed less efficiently?”).

171. See Desai & Rierison, *supra* note 59, at 1849 (“[T]he issue raised in allowing one company to claim a [generic or hybrid] term as its trademark is better addressed by focusing on the way language evolves and whether the term is necessary for competition.”).

word mark generic will improve competition in the marketplace should be relatively simple. Unfortunately, it is not.

As Professors Lemley and McKenna argue, as well as Professor Kaplow, on whose work many of their arguments are based,¹⁷² line-drawing is so difficult as to lead to conclusions that seem not so much reasoned as entirely arbitrary.¹⁷³ When does “monopoly” become a specific type of game as opposed to just another board game?¹⁷⁴ When is a “ring pop” a particular type of lollipop as opposed to just another entrant in the greater lollipop market?¹⁷⁵ Comparative advertising should be able to take care of the problem by permitting competitors to note that their products are similar to others’ (house brands often do this, as any visit to Walgreen’s or CVS Pharmacy will show the reader) or in the style of others’, but it often doesn’t help much in the real world where legal threats generally occur in the shadow of the law.

As Professors Desai and Rierson note, unambiguously generic terms are not often identified or involved in litigation.¹⁷⁶ As a result, the question of whether a particular term is “necessary for competition” or whether finding a term generic would generally improve competition still requires factfinders to make a policy decision as to the breadth of the market. And even then, goods and services often compete across product categories—cinnamon rolls are in some sense competing with danishes in the “breakfast dessert” category, as well as ice cream in the overall “dessert” category, not to mention banana bread in the “baked goods” category. As Professors Lemley and McKenna note, plaintiffs will generally argue for broad market definitions, defendants for narrow ones.¹⁷⁷ How can we draw the line consistently?

172. See Louis Kaplow, *Market Share Thresholds: On the Conflation of Empirical Assessments and Legal Policy Judgments*, 7 J. COMPETITION L. & ECON. 243 (2011); Louis Kaplow, *Why (Ever) Define Markets?*, 124 HARV. L. REV. 437 (2010).

173. See Mark A. Lemley & Mark P. McKenna, *Is Pepsi Really a Substitute for Coke? Market Definition in Antitrust and IP*, 100 GEO. L.J. 2055, 2066–68, 2075–77 (2012).

174. See *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 459 U.S. 1227 (1983) (discussing whether, as applied to board games, the word “Monopoly” had become “generic”).

175. See *Topps Co., Inc. v. Gerrit J. Verburg Co.*, No. 96 CIV. 7302 (RWS), 1996 WL 719381, at *7 (S.D.N.Y. Dec. 13, 1996) (finding, in a case involving an aesthetic functionality defense, that “[d]iamond engagement [ring] shaped lollipops do not constitute a distinct product line within the candy industry”).

176. See Desai & Rierson, *supra* note 59, at 1827; George L. Priest & Benjamin Klein, *The Selection of Disputes for Litigation*, 13 J. LEGAL STUD. 1, 4 (1984) (describing case selection effects, and noting that the cases that make it to verdict or appeal are neither “a random nor a representative sample of the set of all disputes”).

177. See generally Lemley & McKenna, *supra* note 173.

The fact of the matter is that much of current trademark enforcement is focused on carving up markets, rather than reducing consumers' search costs. The advent of the coexistence agreement provides a particularly compelling example of this fact. A coexistence agreement is an agreement between two mark holders using the same or a similar term on different goods or services.¹⁷⁸ Usually, depending on which party has priority—and thus increased bargaining power—the parties will divide up their existing and potential markets. The typical example is the erstwhile coexistence agreement between Apple Inc., the computer and electronics company, and Apple Corps, the Beatles' record label, which limited Apple Inc.'s ability to move into the music business.¹⁷⁹

Though coexistence agreements have been held not to violate the Sherman Act, and despite the Second Circuit's characterization of such agreements as "a means by which parties agree to market products in a way that reduces the likelihood of consumer confusion,"¹⁸⁰ they often pay little more than lip service to consumer interests. A particularly ripe example that puts the lie to the Seventh Circuit's characterization is the case of *California Fruit Growers Exchange v. Sunkist Baking Co.*¹⁸¹ In this case, the Seventh Circuit addressed the impact of a coexistence agreement on third party litigation. Two parties, one that used SUNKIST on citrus fruit and one that used SUN-KIST on canned fruit and vegetables, entered into a coexistence agreement in which they consented to the other's usage of the term on their respective goods. Together, they filed suit against a bakery using the word mark SUNKIST for bread. The panel relied in part on the consent agreement to support its finding of no likely confusion.¹⁸²

178. See 3 MCCARTHY, *supra* note 25, § 18:79, at 18-200 to -04 (describing "consent to use" agreements).

179. Though once Apple Inc. started to do so with the iPod and iTunes, the parties' agreement fell apart and the parties entered litigation. See *id.* at 202 n.3 (describing Apple Inc. and Apple Corps' contentious litigation and later settlement).

180. See *Clorox Co. v. Sterling Winthrop, Inc.*, 117 F.3d 50, 60 (2d Cir. 1997). The Court of Appeals also noted that coexistence agreements are also used as cost-saving efforts to avoid—or quell—disputes between the parties.

181. See *Cal. Fruit Growers Exch. v. Sunkist Baking Co.*, 166 F.2d 971 (7th Cir. 1947).

182. Judge Minton's opinion is worth quoting at length:

We are supposed to believe that when a customer bought fruits or vegetables under the name "Sunkist," he was not confused as to whether the fruit came from the California Fruit Growers Exchange or the vegetables from the California Packing Corporation; but if he bought a loaf of bread under the name "Sunkist," he was likely to think that he bought it from one or the other of the plaintiffs because they sold fruits and vegetables, but never bread. . . . [W]e shall ask to be excused when we are admonished by these

Given the prevalence of arms-length contracting that takes little actual account of consumer confusion—or dilution—except as a proxy for reducing competition between the parties by clearly dividing up markets, we might worry about those same parties paying similar lip service to consumer interests in litigation as well.

This is all to say that determining whether one outcome or another promotes or harms competition is fraught with difficulty and plagued by producer self-interest. As a result, I propose limiting the scope of trademark subject matter protection for word marks to stylized terms, or alternatively, requiring exact linguistic identity as a prerequisite for a finding of confusing similarity with a strict market requirement, as I describe in more detail below.

III. FURTHER IMPLICATIONS AND PROPOSALS FOR REFORM¹⁸³

In addition to the proposals made throughout this Article, there are at least two more ways trademark law can account for hybridity. First, by rethinking the basis for registering and protecting plain word marks unconnected to a design or logo. Second, by limiting the type and scope of control a mark holder can claim to hold over the expressive meanings that may have attached to a particular mark.

A. *Rethinking Registration and Protection of Plain Word Marks*

Given that word marks are parts of language writ-large, most, if not all, word marks are understandable as source identifiers only in connection with the context in which they arise.¹⁸⁴ If an Australian immigrant visiting your house for a backyard party asks you where the “barbie” is, you are not likely to point him toward your daughter’s dollhouse. To better address the importance of context, I propose that registration should be allowed only for stylized terms.¹⁸⁵ Litigants should be subject to the added requirement of illustrating, among other

dividers of confusion by contract to hear their vice president and advertising manager shout confusion on behalf of the purchasing public.

Id. at 975.

183. I do not include here a formal proposal to get rid of trademark dilution merely because that argument has been made continuously throughout this Article.

184. *See supra* Part I.

185. *See Lee et al., supra* note 8, at 1059 (noting that when courts examine marks for distinctiveness, they tend to disregard contextual indicators and focus solely on semantic distinctions).

things, how the stylized term/logo is used on actual packaging and how it is displayed in the store. Allowing registration or protection of the term alone simply grants far too broad of an exclusive right to justify the costs imposed on competitors and consumers, borne in the form of overbroad cease and desist letters and threats of litigation. Coupled with a stronger trademark misuse doctrine¹⁸⁶ and more vigorous fee shifting for unmeritorious claims, such an approach could go a long way toward reducing overbroad claims.

In the alternative, trademark law should at least require exact linguistic identity for confusion with respect to plain word marks, and only with respect to directly competitive goods.¹⁸⁷ By limiting opportunities to find a likelihood of confusion to those situations in which consumers are most likely to be confused, the law can avoid much of the mischief that accompanies a muddier, more uncertain approach to these questions. This more moderate proposal also finds support in the broader, non-registration-based case law.¹⁸⁸

186. See William E. Ridgway, *Revitalizing the Doctrine of Trademark Misuse*, 21 BERKELEY TECH. L.J. 1547 (2006) (arguing for the implementation of the doctrine of trademark misuse and permitting liability to fall on both the alleged infringer and the trademark holder).

187. This is the approach the Trademark Trial and Appeal Board has taken with respect to stylized generic terms. *E.g.* *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1566 (Fed. Cir. 1987) (“[A logo registration] protects only the particular manner in which [the registrant] displays the word ‘sweats.’ . . . [T]he registrant’s rights would reside solely in the particular style of display of the words.”); *In re Grand Metro. Foodserv.*, 30 U.S.P.Q.2d (BNA) 1974, 1976 (T.T.A.B. 1994) (permitting registration of a distinctive display of the word MUFFUNS for muffins); *In re Venturi, Inc.*, 197 U.S.P.Q. (BNA) 714, 718 (T.T.A.B. 1977) (permitting registration of distinctive display of THE PIPE for smokers’ pipes); *In re Trail-R-Van, Inc.*, 188 U.S.P.Q. (BNA) 590, 591 (T.T.A.B. 1975) (TRAIL-R-VAN in distinctive geometric design held registrable despite “trailer van” being generic for truck bodies); see 2 MCCARTHY, *supra* note 25, § 12:40, at 12-159 to -68. Moreover, courts and the Trademark Trial and Appeal Board often apply a similar rule when applying the “sound, sight, and meaning” test discussed below. See, e.g., *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (noting that a word mark must be considered as a whole, rather than as dissected into individual parts); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

188. See *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1150 (9th Cir. 1999) (reaffirming the Ninth Circuit’s “anti-dissection” rule for evaluating the trademark validity of composite terms); *Cal. Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985) (“California Cooler’s mark is a composite term, and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark as a whole. . . . Thus, the composite may become a distinguishing mark even though its components individually cannot.”). This change would also return trademark infringement to its early twentieth-century roots. See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1167 n.13 (2006) (citing *Borden Ice Cream Co. v. Borden’s Condensed Milk Co.*, 201 F. 510 (7th Cir. 1912)) (noting that early trademark infringement doctrine “requir[ed] not only that the mark at issue qualify as a trademark, but also that the infringer use a virtually identical mark on a directly competing product”).

One major counterargument to this proposal is the risk of a slippery slope: won't everyone move quickly to register a famous term in diverse areas in an attempt to free ride off of the famous user's goodwill? To counter this counterargument, I make four points.

First, strong word marks may properly be allowed a broader scope of protection than weaker marks because consumers are generally more likely to become confused when those marks are used on less directly competitive goods and services than when weaker marks are so used. For example, while Google may properly be granted a large scope of exclusion in search and adjacent internet markets, the company's ability to preclude other users from using similar terms would not alone extend to the Mexican restaurant market, absent other indicia of passing off, such as a similar typeface or rainbow coloring for letters in the term. Who thinks the Mexican restaurant is affiliated with Google unless it takes on the entire image? As strong word marks would seem to be those at most risk of being free-ridden upon, any worries about boxing in the competition would likely be misdirected.

Second, the slippery slope does not happen in practice, and did not happen even when most state and federal laws did not offer antidilution protection. As Professors Heald and Brauneis have shown through extensive empirical research, prior to Congress' passage of the Federal Trademark Dilution Act in 1996, there is no evidence that unauthorized uses of famous word marks as product names—such as BUICK aspirin—were ever a problem.¹⁸⁹

Third, as addressed above and more fully in Professor Desai's work, today is an age of branding, where the prime value is in developing an affective connection with the consumer, thereby promoting brand loyalty.¹⁹⁰ Businesses that are not trying to pass off their goods as those of others—which, again, violates the Lanham Act and state unfair

189. Paul J. Heald & Robert Brauneis, *The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names*, 32 CARDOZO L. REV. 2533 (2011). The authors did find some evidence of unauthorized uses of famous word marks as trade names, such as ROLLS ROYCE REALTY, but these uses were "sporadic" and "local." The "death by a thousand cuts" world proposed by antidilution proponents simply never happened, even in the cases of CADILLAC and HARVARD, which were by far the most often used of the word marks studied. Further, as Professors Heald and Brauneis note, most of the uses of this kind were of terms that could quite clearly be seen as self-laudatory—that is, "Rolls Royce" used in the sense of "high-quality" rather than "the car company." Hypotheticals are great for some purposes, but not as an allegedly empirical basis for justifying broad exclusive property rights. Useful perhaps for delineating the scope of a right already justified by other means, but not for deciding whether to grant the right in the first place.

190. See Desai, *supra* note 26.

competition laws—will tend to avoid overgrazing already popular terms if only because many mark holders commonly misconceive of hybridity. That is, they think it becomes harder to internalize the value arising from consumers' accruing brand loyalty when another producer has already adopted the term for use on its own goods or services. Thus, there is—or at least, there is seen to be—value in differentiation for differentiation's sake.

Finally, the slippery slope argument simply misunderstands hybridity and how language works. As illustrated above, additional senses and meanings are added into our mental conceptions of individual terms and do not crowd out preexisting meanings and senses.¹⁹¹ New meanings and senses instead become enmeshed in that mental conception. This is why the existence of dozens of different AMERICAN or GOLD STAR (or SMITH) word marks is not terribly confusing, even if the impetus behind limiting the scope of geographical and laudatory marks does not come from a place of reducing confusion. Rather, trademark law constricts the scope of protection afforded to these terms to very constrained markets, and often to particular stylizations of those terms. The sky has not fallen, nor is it likely to. This approach should be applied more broadly.

B. Limiting Control over Emergent Expressive Meanings

Trademarked terms almost always signify a variety of different meanings. Generally, one of these meanings will be the trademark's traditional source-identifying meaning (Barbie being *the fashion doll made by Mattel*). But, especially with respect to very well known marks, the term will often develop other related senses, some of which may be relevant to trademark scope (for example, Barbie being *any female fashion doll*), many of which may not (Barbie being *the idea of a shallow, materialistic woman*). As many scholars have noted, trademarks and logos are fundamental building blocks of modern cultural communication.¹⁹² We use trademarks and logos like we do other pop culture ephemera: to develop and maintain social relationships and to express ourselves through broadly understandable

191. See *supra* Part I.B.

192. There is a rich literature on this point. For particularly influential examples, see COOMBE, *supra* note 16; Dreyfuss, *Expressive Genericity*, *supra* note 3, at 406–10 (noting the shift in trademark protection to a property approach, and describing how this shift legally limits opportunities for expressive use of trademarks); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999); see also Desai & Rierson, *supra* note 59.

media. By adopting the corporate-based brand view of trademarks¹⁹³—which, as noted above and as illustrated more fully by Professor Desai, grants broad rights to producers at the consumer’s expense—we allow a climate of private censorship to develop. I am certainly not the first to make these arguments, but the theory developed in this Article further contests the propriety of delegating such rights to mark holders, thereby buttressing the claims of other scholars who have questioned producer control over expressive meanings.¹⁹⁴

CONCLUSION

In this Article, I summarized the theoretical underpinnings of an empirical research agenda oriented towards the application of psycholinguistics to trademark law. Future research will pointedly examine how the theory works in practice and, hopefully, provide further insight for the ongoing debates regarding the internal search costs conception of dilution and genericness.

Trademark hybridity’s recognition of semantic ambiguity and its application to trademark law provides some very serious reasons to question the propriety of several longstanding, key features of trademark law. Conceptual meaning is not binary—a trademarked term is not merely a source identifier or not a source identifier. Rather, terms can signify many concepts simultaneously with little internal confusion when appropriate context is provided. In practice, context—whether explicit or implicit—is always available. In addition to questioning prevailing genericness and dilution doctrines, I also hope to spur a frank conversation about what we seek to protect in trademark law—not what we *do* protect, because that much is clear. Rather, if we really only care about source identification and quality control, then the law must be changed to reflect that. If we instead are happy with the extension of trademark protection to incorporate other interests, we should at least be clear about it and ensure that such a state of affairs is reflected explicitly in the law rather than imported into the law through subterfuge under other rationales.

193. See *supra* text accompanying notes 36–48.

194. See, e.g., Desai & Rierison, *supra* note 59, at 1838–42 (describing the negative effects of such producer control).