

The Meaning of a Patronymic Prefix

The courts have ruled that adding a suffix to a descriptive word will probably not render that word non-descriptive. McCarthy cites the addition of the suffix, "-ize" to a base form, as in Flexitized (collar stays) or Nylonized (nylon treated fabrics) as an example of a suffix that does not deprive the term of a descriptive connotation (p. 460). There is no mention of prefixes by McCarthy, but there is no reason to think that prefixes and suffixes do not operate the same way in terms of trademark law. Linguists lump both prefixes and suffixes into the same category, called affixes (which would include infixes if English used them). The questions in the following case include whether or not, by using a prefix found in another company's name constitutes a trademark infringement.

Quality Inns, International, Inc. v. McDonald's Corporation

In the fall of 1987, a large hotel chain, Quality Inns International (QI), made public its plan to create a new chain of inexpensive hotels to complement its other market categories. The name of this new brand was to be McSleep Inns. They planned to open some 200 McSleep franchises within three years. Three days after this initial announcement, the McDonald's Corporation, a fast-food marketer, sent a letter to QI alleging trademark infringement and demanding that QI not use the proposed McSleep name. QI responded by seeking a declaratory judgment that the mark did not so infringe, that it did not allege false description of origin, and that it did not infringe upon or violate any common-law rights that McDonald's might have. Preliminary maneuverings lasted for almost a year, culminating in a seven-day trial in Baltimore in July of 1988.

McDonald's had successfully sued a small restaurant in New York called McBagel's, a few years before this case. The judge ruled that using "Mc-" in combination with a generic food noun did indeed constitute infringement. Although it might seem that this settled the QI issue, there was one big difference. QI proposed to use "Mc-" in combination with a non-food product, in a hotel that did not even contain a restaurant. In fact, McSleep Inns were planned to be built near fast food restaurants so that patrons would have easy access to them. McDonald's countered that the name, McSleep Inn, would likely cause confusion and that QI had deliberately selected McSleep to trade on McDonald's reputation and goodwill, citing such evidence as their survey's report that 100% of American children aged two to eight know and recognize of Ronald McDonald, a statistic comparable only to their recognition of Santa Claus.

Precedents about "confusion" are many. The marks of Notre Dame University and Notre Dame cheese are permitted to coexist, as are the marks for Bulova watches and Bulova shoes and Alligator raincoats with Alligator shoes. Because these marks occur in

widely different fields of business, the public presumably does not make a connection between the two corporate entities. An important legal principle known as the Aunt Jemima Doctrine concerns related but noncompetitive markets. In a 1917 case, Aunt Jemima Mills Pancake Batter held the trademark against which Aunt Jemima Syrup was found to infringe. Syrup and flour were held to be food products that are commonly used together. The question in the QI v. McDonald's case was not one of products in competing areas but, rather, whether or not there is a connection between the food and lodging industries that, like Aunt Jemima, hold them together.

Also important in this case was the issue of genericness. When a trademark becomes so strong that it becomes the generic label for goods or services associated with another corporation, the owners of the trademark may still protect the mark from use by others but they have very little control over its use in everyday language. The public sometimes loses sight of the original corporate sources of certain terms, such as escalator, aspirin, and cellophane, because the owners of those marks surrender their rights to them. On other occasions, there are words that become generic while the owners are still protecting them, such as xerox for a photocopying process, kleenex for a facial tissue, q-tip for a cotton swab, cuisinart for a blender, and thermos for a cooling container.

The prefix, "Mc-," shows a mixture of both popular and corporate use. It is most common for trademark cases to center on the use of a protected word or phrase, not a prefix. But "Mc-" is neither a word nor a phrase. It is a bound morpheme and does not occur in isolation. It functions as a derivational prefix, and one that is very active and productive as well. At trial, McDonald's pointed out how in one of their advertising campaigns, their advertising icon, Ronald McDonald, had travelled around the country and actually taught children how to add the "Mc-" prefix before many different words, such as "McFries," "McShakes," and "McBest." McDonald's vice president for advertising testified that the purpose of this advertising campaign and its resulting commercials was to create a "McLanguage" that was specifically associated with McDonald's.

To counter McDonald's claim that they own complete rights to the formative "Mc-" when it is used before a generic word, QI presented four arguments. First QI argued that there is no likelihood of confusion between McSleep and McDonald's. Second, QI argued that the uses were not in competition: that McDonald's marks, developed for the fast food business, do not preclude the use of McSleep in the lodging business. These two defenses were debated as legal issues. For the third and fourth defenses, QI called on me as a linguist to help them.

Quality Inn's Linguist

QI's third argument concerned third-party uses of "Mc-." QI argued that it should not be denied the right to use McSleep since there was already in use a proliferation of

names containing "Mc-" combined with generic words. To help with this, QI's attorney, Lawrence Hefter, called me. We scoured telephone directories, credit reports, and media usage. The attorneys made phone calls and visited businesses for the purpose of verifying these uses of "Mc-."

In addition to what the attorneys gleaned from their initial list of telephone directories and credit reports, we made use of a computer search system called Nexis and a national clipping service to find a large corpus of words containing the "Mc-" prefix. This produced 150 articles in newspapers and magazines, all written between March and July, 1988. All were citations in which the writers used the prefix "Mc-" with a descriptive or generic term. Sources include magazines such as Forbes and Time, major newspapers such as the Washington Post and Los Angeles Times, local newspapers such as Maple Heights Press, and technical publications such as Rubber and Plastics News.

The majority of these uses, all unrelated to McDonald's or to the fast food industry, included the following:

McArt	McHospital	McOffice Supply
McBaby Factory	McJobs	McOil Change
McBook	McJournaled	McPaper
McCaviar	McLaw	McParticles
McChekov	McLife	McPost Office
McCinema	McLifestyle	McPrisons
McDigest	McLube	McProgram
McDome	McLunch	McPulitzer
McDrive-Thru	McMagazine	McRather
McDuck's	McMail	McReads
McEverything	McMarketing	McRobot
McFashion	McMedia	McShopping
McFood	McMedicine	McStory
McHairpiece	McMiz	McSurgery
McHealthcare	McMovie(s)	McSweater
McHistory	McNews	McTax
McTelecast	McTelevision	McVideo
McTelevangelism	McWidgets	McYear
McZippy's	McEconomics	

In categorizing these and other third-party citations by their meaning types, I separated them into seven divisions. (See Lentine and Shuy 1990).

1. proper names McGruff (the crime dog), MacThrift (a budget office supply store with a Scottish motif).

2. alliterative patternings based on a proper name, such as Jim McMyth (football player Jim McMahan), and McVeto McKernan (name given by protesting union workers to Maine governor John McKernan).

3. acronyms, such as McDap (Mason County Drug Abuse Program) and McRIDES (Morris County Rides, a ride-sharing program).

4. McDonald's product names, not analyzed here for obvious reasons.

I never disputed the fact that the "Mc-" morpheme has a strong association with McDonald's. Instead, I tracked its use into other domains. From the 150 articles gathered, I excluded 56 of them that were directly about McDonald's restaurants and/or about specific McDonald's products.

5. Macintosh Computer Products or Related Businesses, such as McTek (a computer discount store specializing in Macintosh products) and McToy (computer accessory for accelerating processing time). McDonald's and Macintosh had worked out their differences over these names in earlier agreements.

6. parodies of a fast food product or service, such as McChow Mein (hypothetical name for a Chinese fast food restaurant) and McMania (hypothetical drive-through therapy clinic).

7. words that carried the meaning of basic, convenient, inexpensive, and standardized, a very long list that included such terms as McArt, McBook, McCinema, McEconomics, McJobs, McLube, McMail, McMedicine, McNewspaper, McPrisons, McTelevangelism, McPaper, and McYear.

The attorneys used my categorization in their fourth argument, for which my testimony at trial was most central. QI maintained that the prefix "Mc-" had become generic, entering the lexicon of English with a recognized meaning of its own. That meaning is most notable in category 7 above: "basic, convenient, inexpensive, and standardized." If anything identifies McDonald's process of making, selling, and advertising its hamburgers, it is these four characteristics. Fast food is not gourmet food (basic). You can find McDonald's stores virtually anywhere in the world (convenient). The product is relatively inexpensive (at least in most places at the time of the litigation). If you've had one McDonald's hamburger, you know that the next one will be just like it (standardized). There was little debate about the first six categories but it was necessary to go through the process of categorizing all "Mc-" references in order to arrive at the crucial part of my testimony, category 7.

In my trial testimony I described my rationale for using this database as follows:

I wanted a body of data because I did not want to rely upon my own intuitions. I wanted to have an empirical base from which to do the analysis. In an analysis of any kind one can sit and think about it and say "here's what I know to be true because I am a native speaker of this language and here is how it works, and I know." Or, you can do experiments by, say, bringing people into a laboratory, sitting them down and asking them questions. Or, one can do empirical studies with actually existing natural events, in this case, articles in magazines....Here we have a body of citations and evidence from all over the country and in which the people who wrote it didn't know that they were going to be looked at with this case in mind.

The range of meanings found in the remaining 94 citations at first seemed very broad but was later narrowed down to these four basic meanings. It was also clear that this bound morpheme was active and productive. Writers attached "Mc-" to words referring to everything from automobile tune-ups to major surgery. I also found examples in which one use would spawn a subsequent use, such as McPaper (referring to USA Today) which then gave birth to McTelecast.

It was clear that this bound morpheme, originally only a Scottish patronym, had undergone, over time and with the nudging of McDonald's, the processes of lexical shift, lexical narrowing, and lexical generalization. Whatever "Mc-" once meant about family ancestry, it now also means speed, efficiency, consistency, and basic or standardized, for this is how contemporary writers were using the morpheme to convey the meanings in their articles. Not all the coined words carried all four meanings. For example, the budget office supply store, MacThrift, carried the meaning of inexpensive but not necessarily that of efficiency while "McLifestyle," was used by the press to refer to the qualities of speed and efficiency through easy access. But one or more of these meanings fit each of the 94 citations.

The important aspect about the 94 citations was that not one of them was about McDonald's or even about hamburgers. In reaching my decision about whether a "Mc-" citation meant speedy, efficient, consistent or basic, I grouped together key words and phrases in the articles that fit these designations. For example, an article in Forbes magazine was titled, McArt. It spoke of the "mass marketing" of art stores that were open seven days a week and "chains" that indicated how convenient it is to purchase these standard, mass market art products.

The expressions used in the articles defined the writer's own meaning of their uses of "Mc-." The title of an article in The California Law Review, called "McLaw: Lawyering for the Masses," describes the easily accessible and inexpensive basic legal

services (consultation fees of \$20 to \$25) that were cropping up around the country. Expressions such as "near-omnipresence," "franchise legal clinics," "serving the masses," and "drive-in windows," occur frequently in the article, with no mention of McDonald's, fast food restaurants, or hamburgers. One sentence in this article that suggests basic services is: "McLaw attorneys lack the prestige, comforts, and salary that come with other types of private practice." If one were to remove "Mc-" from this sentence, the rest of it would be nonsense, for attorneys certainly do not lack prestige, comforts, and good salaries. The presence of one bound morpheme creates a contrast in meaning from what we might otherwise expect.

Similarly, syndicated columnist Erma Bombeck used "Mc-" in its sense of mass-marketing when she referred to a "McStory on the paper's front page" in her column about the preoccupation of the media with the wardrobes of Nancy Reagan and Raisa Gorbachev. Bombeck relates that she read such a McStory, never mentioning fast food or McDonald's. Nor did Bombeck bother to put quotes around the expression, suggesting that she did not feel obliged to alert readers to any unusual use of it.

By pointing out the importance of context, I hoped to make clear that McDonald's claim that "Mc-" always means McDonald's is not true. At trial I went through these articles point by point, observing that the prefix "Mc-" acts like any ambiguous lexical item, in that a reader or hearer must rely on context to determine which of the possible senses the author intends. I emphasized that meaning is flexible and determined by context. I used the word, "green," as an example in the sentence, "Give me the green!" If this sentence is spoken by a speaker holding a bank teller at gun point, it means something quite different from what it would mean when an artist purchases oil paint at an art supply store. In the sentence, "The new mechanic was still a little green," we understand that "green" refers to inexperience, primarily from clues given by two other words in that sentence, "new," and "still." I also pointed out that the context of the sentence alone does not always disambiguate the meaning of "green." In the sentence, "The young sailor was green," we cannot know for sure whether he was seasick or inexperienced. In such cases we have to look for larger context clues found in the surrounding text.

I also made the point that there were several factors about the prefix "Mc-" that suggest that anyone reading the media articles I had cited could easily dismiss the possible association with McDonald's. By placing the prefix in the context of an actual usage situation unrelated to food, in this case, hotel marketing, it is unlikely that one would associate it with McDonald's. I argued that context clues provided by QI's marketing materials provided the same type of clues that were cited in the illustrations of the use of "green." These marketing materials included the QI four-brand, stylized logo that contextualized it as relating to hotels, not to hamburgers. Each hotel franchisee was required to have the words, Quality Inn, placed beneath each McSleep Inn logo on its exterior signage.

I pointed out that the combination of these elements acted in much the same way that it does in the prototypical sense of "green color" in the sentence, "The girl went green at the thought of drinking sour milk." Even though it may be true that the primary sense of "green" is a color, its use gives rise to the metaphorical extension of it to the sense of being nauseated. That is, we quickly move from the literal level and seek the metaphorical meaning when it becomes apparent that the literal meaning is not relevant. This metaphorical process is what I found overwhelmingly in the media citations using "Mc-." It would appear, in fact, the imagination test was appropriate here. A metaphorical leap must be made to achieve the intended meaning.

It is not possible for a linguist to say exactly what consumers understood by "Mc-," nor did I even try here. The data that a linguist works with is outside of the sender's intentions or the receiver's understandings. What the linguist uses is the language itself, what it could mean and what is possible for consumers to understand. As in other trade mark cases, surveys were taken to determine what consumers say about what they thought. McDonald's hired an advertising firm to survey the perception of the public to the "Mc-" formative. A survey was conducted at a McDonald's office, suggesting a marked bias in itself. The results done at McDonald's office that were reported at trial included the following:

"A kid's product...a product children will like better because it's associated with McDonald's."

"Reliable, at a good price."

"Prepackaged, consistent, fast, and easy."

"Processed, simplified, has the punch taken out of it."

"Junk food, processed, not real, pre-made, uniform, cheap, bland, a gimmick, etcetera."

These consumer comments were, in general, in agreement with the senses determined from my analysis of the media usage of "Mc-." Despite the occasional negativity of the consumers (twenty percent of those surveyed had very little good to say about the product), one of McDonald's own documents took a more positive view:

"By virtue of extensive advertising and sales effort and expense and maintenance of the highest standards of quality and service by McDonald's, 'McDonald's' and its 'Mc' formative marks have come to be so distinctive and well recognized that the vast majority of consumers upon seeing the marks identify them with McDonald's."

But it is the sheer market presence of McDonald's that keeps its name and all it stands for in the consciousness of consumers. In this, the above quotation from McDonald's is quite accurate. Secondary meaning is achieved through the massive spending on advertising and marketing, and secondary meaning often trumps everything else in trademark cases.

In contrast, the media writers that I found used "Mc-" in such a way as to suggest that the prefix had come develop its own meaning, with any metaphorical connection to McDonald's fading about as fast the its original patronymic meaning had slipped out of awareness. In fact, its use in these articles was often more pejorative than positive. It appeared that the prefix had broken loose from association with McDonald's and had taken on a life of its own, with the original literal connotation becoming considerably less strong. Language has a way of doing this.

Different ways of pronouncing "Mc-" were never a part of the linguists' presentations in this case. Attorney Hefter advised me, before deposition and trial, that the QI people had been pronouncing it "muck," while the McDonald's attorneys and witnesses had tried to stick with a pronunciation that carried a less negative connotation, "mack." Early in the trial it became clear that the judge had begun to follow the QI pattern, himself calling it "muck" regularly. I would assume that this was all a kind of subliminality game that had little to do with the facts of the case, but I followed Hefter's advice and called in "muck" myself. This seemed to be the proper pronunciation of "Mc-" anyway, as far as I could tell, since "mack" was the obvious way to pronounce the prefix, "Mac-."

Following the usual procedures in trademark cases, I was deposed by opposing counsel, who the next day called their own linguist to rebut my proposed testimony. This brought about a very interesting set of events, including that linguist's deposition and the testimony of both of us at trial.

McDonald's Linguist

In his deposition, the opposing linguist identified himself as a theoretical linguist, in contrast with other types of linguists, such as neurolinguists, psycholinguists, and sociolinguists. He repeatedly pointed out that theoretical linguistics has no relevance when determining the meaning of the prefix "Mc-" and that any opinions he might have are from his stance as a native speaker of English, not as a professional linguist.

Later in his deposition he also claimed that theories of semantics and pragmatics were also irrelevant to the goals of the case. The only way to discover the meaning of the "Mc-" prefix, he noted, was to ask people what they thought it meant. He agreed that sociolinguists deal with the meaning of language in various social contexts but that

linguistic theory deals with the meaning and use of words outside such contexts. Since he was a theoretical linguist, context played no role in the matter.

When confronted with the uses of "Mc-" by the media, the opposing linguist agreed that the context of the articles led to the reader's understanding of the meanings of "Mc-" as basic, convenient, inexpensive, and standardized. He held firm, however, that such meanings were merely contextually defined and that "Mc-" had no meaning in itself. He claimed that context is not a determiner of the meaning of an individual word, apparently overlooking the findings of specialists in pragmatics, whose work shows how inferential and indirect meaning is determined by context clues. Words in English, he claimed, have an innate core meaning independent of context and even words with multiple meanings still have an innate core meaning.

When asked about the meaning of "McLaw," he testified, again as a layman but not as a linguist, that he knew that it had something to do with law but did not know what the prefix intended. He agreed that "McArt" meant that it was mass produced and standardized and that "McThrift" could be understood to mean inexpensive. Perhaps realizing that he was agreeing with me, his objection then became that most English nouns have no more than three or four meanings and that in my early draft notes I had listed 27 different meanings.

This information came from the discovery of notes that I had made as I began my analysis. Later, as I dug further into the matter, I synthesized, labeled, and narrowed down the terms used to classify these meanings to basic, convenient, inexpensive and standardized. But at the request of McDonald's attorney, I made my notes available and he used them in a way for which they never had been intended. From this I learned something important about the danger of preserving my early thinking and notes. The odd thing about the opposing linguist's disagreement with me was that my findings actually supported his thesis that words have no more than three or four meanings. In this case these four meanings were basic, convenient, inexpensive, and standardized.

The gist of his testimony was that he was in general agreement with my analysis of the four meanings of "Mc-" as used by writers in the media. He agreed that context determined the meaning of "Mc-" in each case. His major disagreement was not with my findings, but that a theoretical linguist could reach them. In his view, linguistic theory could not get him there. During the trial, the judge summarized the differences between the opposing linguist as follows: "I think both Dr. Shuy and Dr. (name withheld here) performed the very same functions and performed the very same analysis. Dr. Shuy said it was within his discipline and Dr. (name withheld) said it doesn't fall within the discipline of linguistics...a difference of opinion."

In this conclusion, the judge overlooked an important distinction that the opposing linguist made. He did not say "it doesn't fall within the discipline of linguistics." He made

it very clear that his opinion was that such analysis does not fall within his own expertise as a theoretical linguist. But even this is debatable. Theoretical linguists tend not to use empirical data to reach their conclusions about how language works (even though at trial it was revealed that the opposing linguist had actually done so in his doctoral dissertation research). It would be difficult indeed to claim that the application of linguistic knowledge about semantics, pragmatics, speech acts and grammatical theory are irrelevant to a trademark case for, in doing so, one would have to say that there can be no application of linguistic knowledge to anything. If this is the case, one wonders why anyone would study it at all.

The opposing linguist's claim that meaning can only be found by asking people what they think something means also deserves comment. As noted earlier, there are at least three avenues open for discovering meaning. The senders of the message may have some idea of what they mean. The receivers of the message may have their own ideas about the meaning. Both can be asked, of course, but even then we have only their reports of what they meant. We cannot get into their heads to find out for sure. But it is the third perspective, that of the text itself, that is the subject of the linguist's attention. The linguist examines the message to determine all the reasonable possibilities that language offers about what the text could have meant and how it could have been understood. There is no leaping inside of anyone's mind in this kind of work. Nor is there made any absolute claim about the intention of the sender or the comprehension of the receiver. The text alone is the evidence of what the language use makes possible to have been meant or understood.

Thus our respective testimonies left the judge with no question about the correctness of my conclusions but, rather, about the differences in our academic specializations. It is an old and common technique used by attorneys to impeach the testimony of the other side. I had faced it before, in the litigation between ConAgra and Hormel (chapter 4), when the opposing linguist claimed that his qualifications as a "cognitive linguist" trumped my own. It is unfortunate that some linguists occasionally fall into the pernicious trap of being advocates for the side they represent. This is a role that only the attorneys should play. If the linguist for one side disagrees with the analysis done by the opposing linguist, the differences should be pointed out clearly. Differences between competing definitions of what a "real" linguist is may be appropriate at academic meetings but have little place in the courtroom. There the quality of the analysis and conclusions are the only issues.

Conclusion of the Case

This was a bench trial and the judge delivered his decision in favor of McDonald's some weeks after the trial ended. The surveys used by both sides appeared to be somewhat inclusive about the issue of confusion. QI's argument that the hotel business was not in competition with the restaurant business did not prevail. Nor was the

proliferation of the use of "Mc-" in the media apparently the convincing factor. The judge was apparently baffled by the competing testimony of the linguists, despite their agreement about the current meanings of the "Mc-" prefix. What was conclusive about the judge's decision was that McDonald's had spent millions of dollars on advertising and marketing their name, prefix included, and secondary meaning won the day. A recent book, *Fast Food Nation*, notes that McDonald's is the largest employer in America. One out of eight Americans has worked at McDonald's at one time or another. It is also among the largest buyers of beef, potatoes, pork and poultry.

Since this trial, McDonald's has gone on to apply for legal trademarks for many other words, including McSpace Station, McTime, McFamily, McMom, McSmile, McTravel, McMemories, McBaby, McProduct, and McBunny.