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Using Linguistics in Trademark Cases

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1. Linguistics and law

When linguists apply their knowledge and skills to another field, it is prudent for them to begin with the problems, assumptions, perspectives, and specialized language of that other field. In the relationship of linguistics and law, this means that linguists need to begin with the lawyers where they are and to not expect lawyers to begin where linguists are.

Lawyers' training, concepts, and content cause them to think about and deal with categories such as trademarks, product liability, contracts, wills, copyrights, defamation, bribery, murder, and other types of cases that they learned in law school. It is safe to say that they are not dealing with or even thinking about the linguistic categories of syntax, phonology, semantics, speech acts, discourse analysis or dialects in the same way linguists think about and use them. Linguists have to begin with (and first learn about) the way lawyers think, their language, their assumptions, and even their professional vision (Goodwin 1996: 606-33).

One of the current useful applications of linguistics to law is in trademark disputes, where the legal issues offer a good fit for linguistic tools. So far, at least, linguistic contributions to trademark disputes seem to have surfaced primarily in North America and Australia, although there has been some activity in Japan as well (Okdawara, 2008).

The ongoing efforts of The International Trademark Association show hopeful signs that lawyers are making steady progress toward standardizing trademark law and procedures through out the world, making this a fruitful area for international applications of linguistics. But first we should know how lawyers view their trademark cases.

2. Perspectives on trademarks

A trademark is a distinctive sign associating and distinguishing a product or service that indicates its commercial origin (Blackett 1998:1). Trademark law tries to protect the owner of the mark from “referential confusion” (Tiersma 1999, 121). Unless the mark is lost through lack of use, the owners have a property right that is perpetual. Trademarks “play a central role in defining corporate personality through image-manipulation or ‘branding’” (Hutton 2009, 121).

In most jurisdictions, trademark law deals with the proprietary use of product names, services, logos, and slogans, using categories to describe them such as *generic*, *descriptive*, *suggestive*, *fanciful*, *arbitrary*(McCarthy 1984, 436-502). More recently, focus on these categories has been accompanied by the trademark concept of *dilution*. Cases that utilize these trademark categories offer the potential for linguistic interest and are capable of being analyzed and measured linguistically.

The focus of most trademark disputes is whether consumers will become confused about the origin and ownership of a product or service. To resolve this question, lawyers focus attention on the relative strength of the marks. Strong marks are protected from use by others because they do not confuse consumers about the quality, nature, and manufacturer of the product or service, while weak marks are not protected. But many marks fall between the polarities of strong vs. weak and invite litigation. In many such cases, lawyers argue about whether a mark is either

descriptive or generic, therefore weak, or suggestive, therefore strong (McCarthy 1984: 434). In contrast, linguistics and other social scientists view trademarks as a prescriptive form of language planning with the admirable purpose of bringing order to otherwise chaotic business practices (Shuy 2002: 3). The basic assumptions of linguists are sometimes very different from those of lawyers, especially about who owns language, about who has or does not have the power to use it, and about who has the authority to control natural language variation, change, and diversity (Hutton 2009: 126-127). From the perspective of the legal system a basic purpose of trademark law is to protect the consumer (Westerhause 2003: 295), and to ensure that the products they buy are authentic. In contrast, the linguist's common concern is about the consumer's right to use the language freely, whether trademarked or not (Shuy 2002: 55,199).

Because both fields have compelling reasons for believing as they do, linguists who decide to work with lawyers in trademark infringement cases need to be aware not only of these differing disciplinary assumptions and perspectives, but also of their need to focus attention on only the linguistic relevance to the case, not on their conflicting ideologies (Shuy 2002: 192). Otherwise, their efforts to assist lawyers can be counterproductive.

2.1 Trademark categories

Although it might seem that trademark categories are well-defined pigeon-holes, it is prudent to understand that trademark categories exist on a continuum that has less-than-sharp boundaries.

2.1.1 Generic marks

Generic is a category name borrowed from the fields of logic and biology, in which the noun, *genus*, is a term used to depict a major class or kind of things that includes several subclasses

called *species*. The corresponding adjective forms are *generic* and *specific*. For example, the applicable laws regard trademarks as a species within the genus of intellectual property. A mark like *Bicycle* for the name of a wheeled vehicle called a bicycle is an example of generic name because it depicts a *genus*, a major class of self-propelled vehicles. But when a manufacturer uses *Bicycle* as a trademark for a brand of playing cards, the word is no longer used generically, opening the door to being labeled suggestive.

2.1.2 Descriptive marks

Descriptive marks describe the qualities, ingredients, and characteristics of a product or service, such as *Raisin Bran* cereal, which contains raisins and bran in the form of small flakes. It's hard to imagine anything more descriptive. Since its name is descriptive, the producer cannot prevent other cereal makers from using the same name. Laudatory names also are considered descriptive, such as *Gold Medal* flour and *Blue Ribbon* beer, since they describe the character or quality of their products. A rule of thumb is that descriptive marks convey information directly with no denotative or connotative association required that might suggest any other possible meaning.

Trademark lawyers consider descriptive marks weak unless these marks have achieved fame among consumers. Many descriptive trademarks that are protected have achieved secondary meaning, which means that the owners of the product or service have used the name exclusively and successfully for a long time or have promoted their products or services so vigorously that the public does not register their literal meaning in their minds and therefore associate the mark with only that product or service.

2.1.3 Suggestive marks

| Suggestive marks are protected more than descriptive marks, but less than fanciful or arbitrary ones. They suggest or connote something other than the denotation of the words used as their marks. In the history of trademark categories, the suggestive designation came later than descriptive, fanciful and arbitrary.

According to trademark law and practice, suggestive marks require consumers to make an instantaneous “mental leap” in order to associate the product or service with the name. For example the name of *Tide* laundry soap is said to be suggestive. The common noun, “tide,” does not denote a soap product, but when it’s used as the name for one, it calls up the image of a large, active body of water, such as the ocean that washes onto the shore. It’s not clear how an oceanic flow causes customers to imagine a positive image of a soap product, but somehow they do. Perhaps the suggestion of water washing onto the shore is the clue, but whatever mental process is involved, marks like *Tide* cause consumers to make a “mental leap,” a process requiring them to make use of their imaginations.

Despite the efforts of international trademark law conventions to determine what makes a mark distinctive, the law is still a long way from being clear (Ladas, 1995:974).

But context plays an important role in distinguishing between things that are descriptive and suggestive. For example, *Brilliantis* considered descriptive as a name for diamonds but suggestive when used in the context of a furniture polish. The name of a bus service called *Greyhound* recalls the attributes of the type of dog that runs very fast. Associating bus service with fast dogs may be an incongruous interconnection of the thought processes but its incongruity makes an effective claim of suggestiveness. The more incongruous the connection, the more the mental process has to work to find it, thus creating a strong reason to call it suggestive.

In disputes about whether a mark is suggestive, lawyers often use three tests: the imagination test, the competitors' use test, and the dictionary test. Linguists can offer help in all three of these tests.

2.1.3.1 The imagination test

The “mental leap” that consumers have to make in order to associate a product or service with its name is measured by the imagination test (McCarthy 1984: 491-92). The more that imagination is required by the consumer to get some connection between the product's name (or service) and the product, the more likely that mark can be judged suggestive. While descriptive names directly convey the ingredients, qualities or characteristics of the named product (*Raisin Bran Flakes*, *Tasty Bread*, *Yellow Pages*), suggestive marks indirectly suggest these things in some kind of rapid, multi-stage processes of the mind, as with *Greyhound* bus line and *Tidelaundry* soap. The question often comes down to how immediate this imaginative mental process is from the moment when consumers first see the mark to imagining its particular characteristic or service.

2.1.3.2 The competitors' use test

The competitors' use test grows out of the imagination test (McCarthy 1984: 493). The more imagination is required to associate the mark with the product, the less likely are competitors to use that mark when they describe their own products. Mentioning it would seem to strengthen their competition but it implies that this mark actually might be descriptive. For example, if *Ricoh* photocopiers described their product as “the best way to xerox,” this could be evidence that *Xerox* is descriptive, with only a weak claim to protect to its mark. But *Ricoh* is unlikely to

even say this because doing so could advertise its competitor, *Xerox*. Despite this possibility, some manufacturers occasionally use their competitors' marks in their own advertisements and promotions to borrow their prestige or to portray the competitor's mark as merely descriptive.

2.1.3.3. The dictionary test

Since dictionaries are often revered as authoritative, they are frequently cited in trademark trials in the dictionary test (McCarthy 1984: 493-95). Trademark lawyers frequently rely on dictionaries to determine the meaning and pronunciation of words used in marks or slogans.

Although dictionaries may do a fine job providing general information, they cannot capture all of the ways a word is used or said, all of its possible meanings, or all the contexts in which a word can appear. Some dictionaries are better than others at this, some are outdated, and some are too abridged to be authoritative. Linguists who are knowledgeable about the quality and usefulness of dictionaries can serve as quality control experts in trademark cases and also provide ways to find useful lexicographical information not provided by many dictionaries.

2.1.4 Fanciful and arbitrary trademarks

These marks are distant from any imaginative connection with their products. Fanciful marks are coined words, such as *Exxon* (the oil company), while arbitrary marks are existing words that convey meanings very different from their usual senses, such as *Shell* (gasoline and oil), and *Camel* (cigarettes). Although it requires a leap of imagination to associate a suggestive mark with its qualities, the process of associating the products with arbitrary names such as *Exxon*, *Xerox*, or *Kodak* requires more than imagination. Owners who select fanciful or arbitrary marks risk placing their name so far away from its association with their product or service that consumers may not see any connection at all. When *Xerox* and *Kodak* first created their names,

consumers had no easy way to associate *Xerox* with photocopying machines or *Kodak* with camera products. But these manufacturers found that after consumers began to associate those names with their products, there were business advantages created by fanciful and arbitrary names. Fanciful and arbitrary marks can become far stronger than the names of competitor's marks, thereby protecting them against any efforts to infringe them.

2.1.6 Trademark dilution

Although concerns about preserving the uniqueness of marks were voiced as early as 1927 (Schechter 1927), trademark dilution laws are relatively recent (The Federal Trademark Dilution Act of 1995; The Trademark Dilution Revision Act of 2006). These acts require mark owners to prove that the quality and reputation of their marks have been diluted, tainted, blurred, or eroded by another mark, thereby causing consumers to be confused about the quality and ownership of the original mark (Butters 2008: 101-113). Blurring is said to involve the activation of two different referents for the mark if and until the consumer sorts out the proper referent, a process that can diminish the sales power of the original mark. Tarnishment is the persistent negative association caused by blurring (Beebe 2006:1147-1151). That is, the blurred mark remains active in the consumer's mind and tarnishes it. Obviously, the junior mark would need to be similar enough to the original mark for the latter to be able to claim that its name had suffered dilution through blurring or tarnishment (Swann 2003:585-625).

It is difficult for the owner of an allegedly diluted mark to prove that such dilution has occurred, which may be the reason dilution is not often charged in trademark cases. In 2003 *Victoria's Secret*, a manufacturer of ladies' sexy garments, charged a pornography shop named, *Victor's Little Secrets*, with dilution. This case went all the way to the US Supreme Court,¹ but many questions remain unresolved, leading Beebe to observe that dilution "is probably the most

muddled concept in all trademark doctrine” (Beebe 2006: 1144). Some unresolved issues are cognitive and linguistic in nature, including ways to measure what is meant by “similar,” how degrees of alleged dilution can be measured, and what role language context plays in making such distinctions (Shuy 2003: 13.1-13.19). To my knowledge, linguists have not yet been involved in trademark dilution cases.

3. The major questions in trademark disputes

In most trademark disputes there are three standard questions. Do the marks sound alike? Mean the same thing? Look alike? To prove the answers, scientific measurements are always helpful. Often these proof measurements are accomplished by linguist’s phonetic, grammatical, semantic, and graphemic analyses. Sounds and meaning are the clear territory of linguistics but the similarity of the way trademarks look is often a question for semioticians, especially when the “look alike” question is addressed by non-linguistic issues such as trade dress, the colors used, and packaging. But the study of letters and symbols (graphemics) also falls within the scope of linguistics and can provide helpful answers to questions about whether marks look alike.

3.1. Using phonetics

A well-trained in phonetician can make distinct contributions to the question of whether marks sound alike. Many people have no idea, for example, that a letters such as “s,” can represent more than one spoken sound. To them, the “s” at the end of Bran Flakes, /s/, is the same as the “s” at the end of Boston Baked Beans, /z/.

One tool used by linguists is called distinctive feature analysis. It appears that the first time this

analysis was applied to a trademark case was in a 1988 dispute between the manufacturers of the competing cupcake products called *Little Dolly* and *Little Debbie*. Analyzing the phonetic components of the consonants and vowels of the two names, linguist Jerry Sadock testified that these two marks contained many different distinctive features based on consonantality, vocality, relative fronting or backing, articulation at a high or low point in the mouth, coronal or grave quality, voice or voicelessness, and stridence. Sadock demonstrated clearly how such analysis provides useful quantitative comparisons of what otherwise would look like only four words, two of which are the same.²

I followed Sadock's example in 1991, when ConAgra, the producer of *Healthy Choice* microwave lunches, challenged the trademark of its competitor, Hormell, producer of a similar microwave lunch called *Health Selections* (Shuy 2002: 69-80). There are some obvious phonetic similarities in the first words of the two names but totally different phonetics in the second words of each. Distinctive feature analysis of the two names showed 228 phonetic features, 89% of which were different. Although to the average listener, the two names would appear to be rather similar, distinctive feature analysis measures the degree of similarity or difference in a more detailed and scientific manner, where an 89% difference argued strongly for Hormell's position.

Similarly, in 2006 linguist Ronald Butters used distinctive feature analysis in the case of two pharmaceutical companies, *Aventis vs. Advantis*, in a creative way (Butters 2008: 233-237). Consumers can say the names either as isolated words or in normal conversational sentences. Butters first transcribed the marks in a conventional phonetic transcription and compared the slowly isolated pronunciations with their pronunciations in a continuous conversational mode. He found 63% similarity in the isolated mode and 73% similarity in the conversational mode. He then used distinctive feature analysis and found that 84% of the phonetic features in the two marks were the same in the isolated mode and 89% were the same in the conversational mode.

Distinctive feature analysis can be a very powerful instrument for measuring the similarity or difference in trademark sounds.

3.2. Using grammar

The grammatical differences between ConAgra's microwavable lunch cup, *Health Selections*, a pluralized noun phrase, and Hormell's similar product, *Healthy Choice*, with an adjective modifier preceding a singular noun, can be apparent to laypersons in a surface way at least. They can see two differences: the "y" at the end of *Health* and the "s" at the end of *Selections*. But was this difference of two consonants enough for consumers to consider the products as separate and different? Linguistic analysis showed that these two consonants represented much more than letters. They also convey grammatical differences. *Healthy Choice* is an adjective noun phrase while *Health Selections* is a compound noun phrase. We stress the first word of compound noun phrases, and the second word of noun-adjective phrases. Many people might see the similarities of the two words without understanding that they contain very different grammatical constructions.

3.3 Using semantics

The dispute between ConAgra and Hormell also provides an example of the way linguists employ semantics. Hormell disputed ConAgra's claim that "choice" and "selections" have identical meanings. If its claim was accurate, ConAgra could have said that consumers would be confused, believing that ConAgra was the manufacturer of Hormell's microwave lunch cup, or *vice versa*.

I pointed out that there is a semantic difference between the noun, "choice," which conveys

making a decision between two things, and “selection,” which signals a decision to be made between an array of things (more than just two). To make this clear, I called attention to the exclusively different prepositions that normally occur before “choose” and “select.” One chooses *between* good and evil, *between* two boyfriends, and many other groups of two. In the movie, *Sophie’s Choice*, the mother had to choose *between* her two children, not *amongher* two children.

In contrast, we select from *amongan* array of more than two things. The lyrics of one formerly popular song include the lyrics, “I find a broken heart among my souvenirs.” Unless this song was about only two items in a collection of memorabilia, it would be ludicrous to sing, “I find a broken heart between my souvenirs.” Even brilliant lawyers do not usually consider the way “between” and “among,” which were not even present in the trademarks, can play a role in determining the differences between *Healthy Choice* and *Health Selections*.

3.4. Using graphemics

Graphemics, an area of language that borders on and complements document design, is a tool that some say is different from linguistics. But graphemics is an integral part of linguistics. In trademark disputes, linguists use graphemics to address the issue of whether marks look alike. Characteristics such as spelling, font size, typeface, and overall design are used to compare and quantify disputes about the similarity or difference.

Because linguistics has more detailed units of measurement than are familiar to most lawyers, there are distinct advantages to using a forensic linguist in such cases. The case of *Warren v. Prestone* provides an example of how graphemic analysis was used effectively (Shuy 2002: 56-68). Both companies produce antifreeze/coolant products for motor vehicles. Warren called its antifreeze, *LongLife*. Somewhat later, Prestone named its product *LongLife 460*.

Writing systems are, in every sense, language systems. It is linguistically significant, therefore, when two trademarks use the same graphemes similarly or identically, such as capitalizing where lower case is common, the size and font of the letters, and the spacing in the words. These graphemic features also can signal similar kinds of features that intonation, loudness and pauses convey in spoken language.

In this dispute, two common English words, “long” and “life,” were combined into a single word without the usual spacing between them. In both names the second word was capitalized in mid-word position. This much alone constituted graphemic evidence that 73% of the two names were identical. It is true that Prestone added “460” to its *LongLife* mark, but researchers show the beginning portions of words are very crucial in word identification and memory storage (Cutler 1982: 573). This suggests that Prestone’s added “460” played only a minor role in consumers’ ability to distinguish between the two marks.

Butters provided a similar graphemic measurement in the case of *Aventis vs. Advancis* in 2006, showing not only that the two names were 67% the same, but also that there was a high degree of similarity in the placement of the letters in the two marks (Butters, 2008: 234-37).

4. Analyzing generic, descriptive and suggestive marks

Having outlined the categories commonly used by trademark law and some examples of how linguistic analysis can help resolve disputes, I now offer case examples in more detail.

4.1. Generic vs. descriptive marks

The case of Warren v. Prestone pitted against each other two manufacturers of antifreeze/coolant products for vehicles. Relying on a twenty-year-old compact dictionary, Prestone's lawyers attempted to show that the name, *LongLife*, was generic. They cited the definitions of "long" and "life" separately, primarily because they could not locate dictionary entries for either the compound noun, "longlife," or for the adjective/noun combination, "long life." Nor could they find these in any other dictionaries. The single words, "long" and "life" are undoubtedly generic, but that was not the real issue here. Warren had created a new compound noun phrase with no space between the two words and with capitalization in both morphemes, exactly what Prestone did.

Not only did Prestone's lawyer select only those senses of "long" and "life" in their compact dictionary, but they also selected only those senses of those words that best suited their case. They cited only one of the 12 senses of "long." Their first problem was that when lawyers use the dictionary test for meaning (noted earlier) it is not prudent to use only the one sense that they prefer. This constitutes selective bias. They have to tell the whole lexical story if they're going to tell the story at all.

Things got even more difficult for Prestone when their lawyers used that same selectivity in their compact dictionary's senses of "life." By contrast, in all of the *Oxford English Dictionary's* eighteen senses of "life," only one part of one of the senses was in any way related to an inanimate object. All the rest refer to living things, like people or animals. It's obvious that antifreeze is an inanimate object and the *OED's* single subsection with an animate sense was metaphoric: "he was the life of the party."

Clearly "life" primarily refers to living things. All else is metaphoric. Since Prestone's lawyers cited only the single, highly selective and metaphoric sense of "life," their argument collapsed,

because the law's major definition of suggestive marks is that they require a leap of imagination. And what better motivator for such a leap can there be than a metaphor?

Webster's Third International Dictionary included two subparts of the eighteen senses that were in any way associated with animate existence, confirming my thesis that Warren had used "life" metaphorically. This case was a good example of how the opposing lawyers tried to capitalize on the dictionary test, but failed miserably in the attempt.

After Prestone's lawyers failed to establish that Warren's *LongLife* was a generic mark, they then tried to show that the mark was generic because "long life" was used to describe a class or type of things—the class of all antifreeze/coolant products containing newer additives that extend the engine's life. Trying to prove this, Prestone cited some of Warren's advertisements that referred to its new and improved *LongLife* as a product that would give "a long life" to the engines of vehicles that used it. If "long life" were the actual name for this class or type of antifreeze, Prestone could claim that Warren's *LongLife* was a generic mark.

My broad Lexis/Nexis search yielded all the expressions and names used by the industry to describe this class or type of antifreeze in its advertisements, bulletins, correspondence, and brochures. It produced 32 references to "extended life antifreeze" as the type and class of this product. Two other competitors actually used "extended life antifreeze" as part of their brand names. "Extended life" also was used in some of Prestone's own advertisements and even in its own catalogue, all of which clearly used "extended life" to refer to this type or class of antifreeze product. Prestone's claim that "long life" was the generic name of a type or class of antifreeze was defeated.

Another case in which a mark was a linguistically tested as generic was the 1987 case of

McDonald's Restaurants v. Quality Inns International (Lentine and Shuy 1990: 349-366; Shuy 2002: 95-109). For reasons that seem illogical and counterproductive (to me at least), Quality Inns wanted to name a new hotel chain "McSleep Inns," and asked for linguistic help.

The dispute was whether McDonald's had the sole right to use the patronymic prefix, "Mc-" in names of retail businesses of all kinds. Most trademarks are words or phrases, but in this case McDonald's lawyers claimed that only McDonald's could use the bound morpheme prefix, "Mc-" when it is used before a generic word or personal name.

A linguist first collects data about how this "Mc-" prefix was currently being used. In this case, a Lexis/Nexis computerized search, along with results from a national clipping service, creating a large corpus of words containing the "Mc-" prefix. All were published at around the time of the trial. In all of the 150 articles, none of which were about McDonald's or hamburgers, the writers used "Mc-" before a generic or descriptive word many times, including these examples: McArt, McBook, McCinema, McFashion, McFood, McHistory, McTelevision, McHospital, McLaw, McJobs, McMedicine, McOil Change, McPaper, and many others.

This list excluded all media articles specifically about McDonald's and all instances in which Mc- was used in front of proper names or as acronyms. Nor did it include articles about MacIntosh brand computers, simply because McDonald's and Apple Computers previously had worked out an arrangement for peaceful co-existence.

The next step was to determine the semantics of "Mc-" in the long list of media uses. The writers actually did this themselves. They made it very clear that by using "Mc-" before art, surgery, lawyers, newspapers, jobs, etc., they meant basic, convenient, inexpensive, and standardized. If anything identifies the product and characteristics of McDonald's method of making, selling, and

advertising its food, it is these four characteristics. Fast food is basic (not gourmet). The stores are everywhere (convenient). Their food is said to fit any budget (inexpensive). And if you ever bought one McDonald's hamburger, you know that the next one you eat will be just like it (standardized).

In terms of the defining qualities of generic words, this little bound morpheme, "Mc-", was extremely active, productive, flexible and recent, covering everything from automotive tune-ups to major surgery. Surprisingly, McDonald's own marketing expert supported this redefinition of "Mc-" when he testified that the company's advertising icon, Ronald McDonald, had gone around the country teaching children to add "Mc-" before many words, such as McFries, McShakes, and McBest. McDonald's Vice-President testified that the purpose of this campaign was to create a "McLanguage" that would dominantly associate the prefix with McDonald's. It was obvious that McDonald's had encouraged the wide extension of "Mc-", but apparently the company had not anticipated that the new meaning of "Mc-" would embrace the company's characteristics of standard, basic, convenient, and inexpensive. No one can challenge the success of McDonald's huge promotion and advertising program. It also extended far beyond the children that Ronald McDonald taught, and encouraged the media to do the same—only with unintended consequences.

It was clear to Quality Inns that McDonald's played a major role in "Mc-" becoming generic. It had entered into the lexicon of English with a new recognized meaning of its own—basic, convenient, inexpensive, and standardized. The exclusivity of "Mc-" referring to McDonald's alone was fading fast because of McDonald's own promotion and advertising.

Before the trial, McDonald's hired an advertising firm to survey the public's perception of the "Mc-" prefix. Among this survey's major findings were that the terms, "reliable,"

“prepackaged,” “consistent,” “fast,” “processed,” “simplified,” “uniform,” “cheap,” and “easy” were characteristic of the way the public viewed McDonald’s. These results confirmed my own analysis of the lexical shift reflected in the media’s four main meanings of “Mc-.”

Despite my linguistic testimony at trial, the judge did not agree that “Mc-“ had become generic. He invoked another concept in trademark cases: secondary meaning. In his decision, the judge considered the famousness of McDonald’s, due in part to the millions of dollars it spent on promotion and advertising. He also opined that if Quality Inns were to adopt the name, McSleep Inn, this would be likely to confuse the public into thinking the hotels were owned or operated by McDonald’s.

So Quality Inns lost the case and had to choose another name instead. The company quickly dropped the “Mc-“ and decided on Sleep Inns, which would have been a better choice in the first place. Ironically, this hotel-chain is now thought to provide rooms that are basic, convenient, inexpensive, and standardized.

4.2. Descriptive vs. suggestive marks

In *ConAgra vs. Hormell* one issue was whether ConAgra’s product, *Healthy Choice*, was descriptive or suggestive. Hormell’s lawyers claimed it is descriptive because it informs the buyer about the quality of the product and wouldn’t help consumers distinguish between different products. ConAgra countered that its mark was suggestive. If the Court ruled that the name was descriptive, ConAgra would then claim that the two names are so similar that consumers would be confused or deceived about their source and sponsorship.

The judge ruled that *Healthy Choice* was a laudatory mark (“puffing”), which is one

characteristic of being descriptive, meaning it was not strong. The judge ruled: “In this case I conclude that the ‘mental leap’ between the words and the product’s attributes is almost instantaneous.” The judge also found that *Healthy Choice* and *Health Selections* sounded significantly different (supporting my testimony) but that they meant essentially the same things (supporting the opposing linguist’s testimony). However, his ruling on the similarity of meaning did not support ConAgra’s claim that Hormell had infringed ConAgra’s trademark. He ruled that there was little chance of consumer confusion.

4.2 Suggestive marks

In most trademark cases the dispute is over whether the product names and services are generic or descriptive, illustrated by the cases described above. It’s easier to see the effects of the mental leap that defines a mark as suggestive than to convincingly identify the process of imagination that allegedly takes place. This points out that considerably more research is needed about the workings of the mind.

This suggests that linguists need to learn more about the sequential steps consumers must process when they infer. For example, perhaps in the LongLife dispute consumers might have gone through something like the following mental processes after they encountered the word, “LongLife:”

1. they imagine human life, such as a baby;
2. they imagine the baby living to adulthood, a long time;
3. they imagine how this antifreeze is like the old person;
4. they imagine antifreeze living a long time; and
5. they may also imagine antifreeze giving a long life to their engine.

We have no idea whether or not consumers go through these or other imaginative leaps in this or any other sequence. If we want to describe the difference between a small or large “imaginative leap,” we need more cognitive and linguistic research to provide some answers, making it possible, for example, to compare a mark that causes a five-step mental leap of imagination with one that causes only a two-step leap. Until something like this can be shown, trademark cases will have to slog along as best they can. Fortunately for linguists, trademark litigation still needs their help.

5. Objections

Linguists' efforts to work on trademark cases, however, have met with criticism. Some critics would discard linguistic analysis entirely in trademark cases: “The pronouncements of linguists about language are not likely to be of much use to the practice of trademark law” (Davis 1996:261). Three specific objections are commonly made about using linguistics in trademark disputes. While considering these objections, it is useful to recognize that a trademark is the message in the communication context of a sender, a message, and a receiver.

One objection is that linguists can not aid in determining whether consumers will be confused: “The judgments of linguists as to what are identical or similar linguistic forms (e.g. in arguments about confusion of trademarks) are of no relevance unless they can claim to mimic the perception of ordinary consumers” (Hutton 2009: 129-130). Most trademark cases use survey experts to address consumer perceptions. Although there is no way that linguists can prove consumer confusion, it is equally questionable that anyone else can do [so](#) with certainty, including survey experts commonly used in trademark cases, and it is unclear why surveys are generally acceptable while linguistics deserves criticism.

Surveys normally focus on a sample of representative receivers of the message who self-report their possible confusion with the product's name, manufacturer, and uses. In contrast, linguists focus on the illocutionary force of the message itself as well as on its possible perlocutionary effect on its receivers (Austin 1962: 99-108). It is noteworthy that linguists have made similar points about language evidence in other types of cases, including defamation (Tiersma 1987:54-71).

Properly conducted consumer surveys can provide useful clues about *possible* confusion by representative sample of receivers of the message. This is exactly what linguistic analysis provides about the language of the message. It seems prudent for trademark lawyers to use both types of analysis. The decision about whether or not consumers are actually confused must be made only by the triers of the facts, not by either type of experts, whose only job is to provide whatever clues in the language of the actual message and through their surveys of representative consumer/receivers. Gilson and Lalond make this point specifically: "it is the understanding of the public and not that of the linguist or other language expert which is controlling" (Gilson and Lalond 1999:26).

A second objection to linguistic experts is that they analyze language out of context, "effectively removing this time and perception element" (Hutton 2009: 129-130). It is difficult to understand what Hutton means here, since the language of the trademark (its message) is timeless and its form creates the receiver's perception. Hutton further claims that the linguist's use of synonymy is "an artifact of linguistic theory" (Hutton 2009: 129). This odd observation seems to say that the existing synonymy of a trademark (context) is not important as readers try to understand its message.

A third objection, also made by Hutton, is that the ideology of linguists differs from the ideology of law. Linguists clearly recognize this difference (Philips 1998:116-123; Shuy 2002: 2-3), although they are certainly not alone in believing that language is owned by the people who use it. Even trademark lawyer Westerhaus comments on the danger of trademark law's control of language use: "But if law is indeed king over language, it is important to remember that sometimes the subjects revolt" (Westerhaus 2003:295). My point, however, is that ideological differences about the ownership of language are irrelevant to the use of linguistics in analyzing trademarks. Linguists' ideology may differ from that of lawyers, but the three major questions of trademark cases (sound alike, mean alike, look alike) are clearly unaffected by this. The linguist's only concern is to help lawyers sort out and measure the linguistic characteristics of the marks, not to change their belief systems.

Linguists can work effectively with lawyers in their trademark cases, but they need to take the lawyer's perspectives and steer clear of conflicting ideologies. All applied linguists need to do this. Linguists need to know and select appropriately from among the standard tools in which they are well trained and competent.

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Endnotes

Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003).

2 McKee Baking Co. v. Interstate Brands Corp., 738 F. Supp. 1272 (E.D.Mo.,1990).