

HOW TO DO THINGS WITH WORD MARKS: A SPEECH-ACT THEORY OF DISTINCTIVENESS

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INTRODUCTION

Have you ever eaten a steak bomb? If the phrase “steak bomb” means anything to you, does it mean a submarine¹ sandwich stuffed with steak, salami, peppers, onions, mushrooms, and cheese, or does it refer to one particular purveyor of said sandwich? That question suddenly became relevant for the owner of a sub shop in New Hampshire when he received a cease-and-desist letter from a competitor.² The letter cited a federal trademark registration granting USA Subs exclusive rights to use the mark STEAK BOMB³ for steak sandwiches and demanded that Great American Subs cease using the phrase, which appeared on the latter’s menus, signage, and website. But as one patron remarked after learning of the dispute, “steak bombs are a staple of life in New England . . . This is right up there with trying to trademark ‘lobster roll.’”⁴ A local newspaper agreed, recounting conversations with “several local sub shop owners, all of whom carry their own versions of the steak bomb”⁵ and call it by the same name.

In order for a word or phrase to be legally recognized and protected as a trademark⁶ under federal law, it cannot be generic or “merely descriptive” for the goods or services with which it is used.⁷ Consumers must perceive the mark as an indicator of source, rather than as a description of the product itself: they must associate the phrase STEAK BOMB with a specific brand or restaurant, rather than with a type of sandwich available from various purveyors. Whether a trademark qualifies for registration or protection depends upon whether the mark is “distinctive”⁸ of the product—whether consumers perceive the mark as distinguishing source.

A trademark can be *inherently* distinctive, and thus protectable *ab initio*, or it can become protectable by *acquiring* distinctiveness based on its use in commerce. Marks that are fanciful (made up words, such as EXCEDRIN for aspirin), arbitrary (existing words applied to unrelated

1. Also known as a bomber, grinder, hero, hoagie, Italian sandwich, or torpedo. Frederic Gomes Cassidy & Joan Houston Hall, 2 *DICTIONARY OF AMERICAN REGIONAL ENGLISH* 5 (1991) (“dagwood”); Bert Vaux, *THE DIALECT SURVEY* 64, http://www4.uwm.edu/FLL/linguistics/dialect/staticmaps/q_64.html (mapping answers to the prompt “What do you call the long sandwich that contains cold cuts, lettuce, and so on?”).

2. Ray Duckler, *Scuffling over the Steak Bomb*, *CONCORD (NH) MONITOR*, Sept. 27, 2007.

3. STEAK BOMB, Registration No. 32,49292. Trademark registrations can be accessed via the website of the US Patent and Trademark Office at <http://tess2.uspto.gov>.

4. Jon Eick, *Steak Bomb War Still Red Hot*, *SO GOOD BLOG* (Sept. 10, 2007), <http://www.sogoodblog.com/2007/09/10/steak-bomb-war-still-red-hot/>.

5. Duckler, *supra* note 2.

6. This Article uses “trademark” or “mark” throughout to refer to both trademarks and service marks, and uses “goods,” “services,” and “products” interchangeably to refer to any goods or services offered for sale in connection with a given mark.

7. 15 U.S.C. § 1052(e)(1) (2006).

8. Trademark distinctiveness is discussed *infra* in Part II(a).

goods, such as PENGUIN for books), or suggestive (words that hint at characteristics of the goods or services, such as GREYHOUND for buses) are considered inherently distinctive and can be registered on the Principal Register or protected at common law without further indicia of distinctiveness. Marks that are characterized as descriptive, such as SAFETY for snow tires, are only registrable if they have become distinctive based on their use in commerce.⁹

The STEAK BOMB kerfuffle is far from the only example that illustrates how overprotecting descriptive marks enables mark owners to silence competitors' speech. A cosmetics company that registered PERFECTING SERUM for serum that purports to perfect the skin¹⁰ issued warnings to over a dozen competitors whose products used the same name, demanding they cease use of the phrase; the company is currently embroiled in litigation with those competitors that did not capitulate.¹¹ The producer of ENTREPRENEUR magazine, via a series of cease and desist letters and strike suits, persuaded more than forty other entities that used the term "entrepreneur" to end their use.¹² A rum maker registered PAINKILLER for a well-known mixed drink sold under that name and then threatened to sue two bartenders who opened a tiki bar named for the cocktail.¹³ Based on its registration of SMALLLAW for news about small law firms, a media company demanded a competitor refrain from using the phrase "small law" in discussing—what else?—small law firms.¹⁴

9. 15 U.S.C. § 1052(f) (2006).

10. PERFECTING SERUM, Registration No. 37,98129; *In re Murad, Inc.*, 2010 WL 667931 (T.T.A.B. 2010) (reversing § 2e(1) mere descriptiveness refusal).

11. Such "trademark bullying" has recently received increased attention among members of Congress as well as scholars. See Trademark Technical and Conforming Amendment Act of 2010, Pub. L. No. 111-146, § 4, 124 Stat. 66, 69–70 (2010). Leah Chan Grinvald defines bullying as "the enforcement of an unreasonable interpretation by a large corporation of its trademark rights against a small business or individual through the use of intimidation tactics." Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WISC. L. REV. 625, 642. William T. Gallagher asserts that "powerful IP rights owners, as sophisticated 'repeat players' in IP enforcement efforts against often 'one-shot' participants in the legal system, have strategic advantages that allow them to enforce IP rights beyond their proper scope." William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 453, 459 (2012). On the other hand, trademark holders may silence competitors based on rights they reasonably believe they possess when descriptive terms are incorrectly treated as inherently distinctive. While some enforcement campaigns qualify as "bullying," others may not.

12. Amy Zipkin, *Entrepreneurs Must Choose Their Words with Care*, N.Y. TIMES, Oct. 7, 2004, at C2; see also Gallagher, *supra* note 11, at 457 ("[M]ost IP disputes do not result in litigation, and most litigation settles well before trial.").

13. PAINKILLER, Registration No. 2,758,165; *Seattle Bartenders Boycott Pusser's Rum Following Painkiller Legal Action*, SEATTLE MET, June 9, 2011, <http://www.seattlemet.com/bars-and-nightlife/sauced/articles/seattle-bartenders-pained-about-painkiller-trademark-pursuit-by-pussers-june-2011>.

14. SMALLLAW, Registration No. 3,832,551; *Should Lawyerist Cave to Trademark Bullying?*, LAWYERIST, Feb. 28, 2011, <http://lawyerist.com/lawyerist-trademark-bullying-poll/>.

In each of these examples, a commercial actor has used trademark law to prevent competitors from describing their products in accurate ways. The right to wield a trademark offensively, engaging in self-help or enlisting the court system to stop others from using the same or a confusingly similar mark or term, must be predicated on the ownership and use of a valid mark, whether registered or not. The mark must only be asserted against a party making a trademark use¹⁵ that is likely to confuse consumers or dilute a famous mark. The requirement that the mark actually functions as a mark is critical. Of course, a descriptive term can *come* to serve as a mark over time, acquiring distinctiveness based on commercial use, advertising, publicity, and consumer engagement.¹⁶ Once marks become distinctive, protecting them against competitors makes sense. But when examining attorneys, the the Trademark Trial and Appeal Board (TTAB), and federal courts deem *inherently* distinctive¹⁷ marks that contain descriptive terms, in practice it empowers the owners of those marks to prevent competitors from using similar marks or marks containing some of the same terms regardless of whether consumers actually regard them as source indicators.

Fact-finders apply a variety of tests¹⁸ to determine whether a word mark is inherently distinctive. Such tests include the dictionary, puffery, competitors' need, competitors' use, and imagination tests. In addition, the incorporation of a rhetorical device, such as incongruity, musicality, or double entendre, is often treated as a proxy for distinctiveness. Those tests and proxies, discussed at length in Part III, lead fact-finders to incorrectly deem inherently distinctive marks like the alliterative CLASSIC COLA for a brand of cola,¹⁹ the anaphoric SPORTSWEAR FOR EVERYWEAR for

15. 15 U.S.C. § 1115(b)(4) (2006). A "trademark use" refers to the use of a mark as a source indicator in connection with goods or services. For example, if a water bottle is labeled "Dasani purified water," the company is likely making a trademark use of "DASANI" but not of "purified water."

16. *Id.*

17. Common law rights based on the use of a distinctive trademark are enforceable under the Lanham Act, although registration of a mark on the Principal Register provides additional rights and privileges. For example, registering a trademark gives rise to a rebuttable presumption of validity. 15 U.S.C. § 1115(a) (2006); *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504 (6th Cir. 2007). When an infringement plaintiff has not registered its mark, it bears the burden of persuasion that the mark is protectable. See Raymond I. Geraldson, Jr., Mark V.B. Partridge & Joseph N. Welch, *Developments in Trademark and Unfair Competition Law: In the Courts, the Patent and Trademark Office and Before the Trademark Trial and Appeal Board*, 24 J. MARSHALL L. REV. 1, 12 (1990), for a discussion of other benefits of registration.

18. The PTO and TTAB most often consider inherent distinctiveness in determining whether a mark may be registered on the Principal Register without a showing of secondary meaning. Federal courts typically consider it in the context of infringement litigation, where distinctiveness can have a substantial effect on the outcome of a likelihood of confusion analysis. See, e.g., Edward J. Heath & John M. Tanski, *Drawing the Line Between Descriptive and Suggestive Trademarks*, COM. & BUS. LIT., Sept. 2010, at 11.

19. *In re Classic Beverage, Inc.*, 6 U.S.P.Q.2d 1383, 1386 (T.T.A.B. 1988) (requiring disclaimer of "cola").

apparel,²⁰ or the ostensibly incongruous SNO-RAKE for a particular snow removal tool.²¹ When descriptive terms that lack secondary meaning are granted protection, that protection authorizes the owner to wield the mark offensively against new entrants before the mark has come to serve as a trademark to consumers. Such offensive use is the equivalent of a property owner erecting a “no trespassing” sign on a piece of land that he has not yet purchased (and may never come to own).²² USA Subs made precisely that type of offensive use when it demanded that Great American Subs cease using “steak bomb” despite copious evidence that consumers do not regard the phrase as a trademark.²³

The formal and informal tests for distinctiveness fail to provide objective guidelines for gauging consumer perception. Given the centrality of distinctiveness to trademark law, we might expect courts and agencies to have developed predictable, evidence-based standards for determining whether consumers perceive particular terms as trademarks. Instead, the tests invite fact-finders to privilege the perceptions of the producers who selected the marks over those of consumers. As a result, fact-finders reward producer ingenuity by overprotecting descriptive marks, needlessly handicapping competitor speech²⁴ and enabling owners to assert rights in trademarks when they don’t actually function *as* trademarks and may never come to indicate source.

20. *In re David Crystal, Inc.*, 145 U.S.P.Q. 95 (T.T.A.B. 1965).

21. SNO-RAKE, Registration No. 1,252,181; *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983).

22. *See* Jake Linford, *Trademark Owner as Adverse Possessor*, 63 CASE W. RES. L. REV. 703, 706 n.6 (2013) (arguing that the trademark doctrine providing for rights in descriptive trademarks resembles the real property doctrine of adverse possession and observing “the trademark owner takes a defensive posture against encroachment similar to that taken by a real property owner to forestall adverse possession” (citing Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1318 (2010))). Gallagher’s interviews with IP attorneys reveal that the language of real property often dominates discussions of trademark protection: “When referring to trademark examples, the most frequently used phrases [by interviewees] included the ‘need to build a fence around’ their client’s trademark, or to ‘wall off’ and protect a mark in order to keep it distinct in the marketplace.” *Supra* note 11 at 491.

23. On the contrary, blog comments and media coverage make abundantly clear that consumers do *not* perceive STEAK BOMB as an indication of source. *See* comments at Duckler, *supra* note 2; Eick, *supra* note 4; *N.H. Shop Claims Ownership of ‘Steak Bomb’ Sandwich*, BOS. HERALD, Aug. 29, 2007.

24. *See generally* Suman Naresh, *Incontestability and Rights in Descriptive Trademarks*, 53 U. CHI. L. REV. 953, 982 (1986) (“[M]onopolization of descriptive marks by particular sellers would seriously disadvantage their competitors by creating formidable informational barriers between the competitors and their potential customers.”). As a result, “buyers experience greater difficulty and incur higher costs in obtaining the information necessary to make optimal purchasing decisions among similar products.” *Id.* at 992; *see also* Maya Alexandri, *The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act*, 13 HARV. J.L. & TECH. 303, 327–28 (2000) (“[M]onopolies in descriptive marks can lead to increased start-up or marketing costs, endow one firm with an unfair competitive advantage, and, in extreme cases, enable a firm to engage in predatory pricing.”).

In order to correct this problem, USPTO trademark examining attorneys, the TTAB, and federal courts should require secondary meaning for a greater proportion of marks. Rather than granting immediate protection for marks that contain one or more descriptive terms, fact-finders must raise the bar on what constitutes inherent distinctiveness²⁵ in order to better serve the goals of trademark law and protect junior users' ability to compete freely. No change in the Lanham Act is necessary. Changing how the standard for distinctiveness is applied would help preserve competitors' ability to communicate information about their goods and protect consumers' access to knowledge about new or lesser-known products. This Article proposes a new test for inherent distinctiveness that asks simply whether a hypothetical competitor could use a term literally and in good faith to describe its own product.

In order to highlight deficiencies in the classification of descriptive marks and provide a better test for distinctiveness, this Article employs speech-act theory, drawing upon concepts first articulated by linguist and philosopher J. L. Austin in *How to Do Things with Words*.²⁶ Austin contrasts the "constative utterance," speech²⁷ that relates or reports, with the "performative utterance," speech characterized by *doing* in addition to describing. The phrase "I sentence you to five years in prison," uttered by a judge in the proper context, is an example of performative speech; it enacts the very sentence it articulates. In contrast, most speech is constative: it describes and can be judged true or false. Austin never mentioned trademarks in his famous William James lectures, but he certainly could have, as speech-act theory has a great deal of insight to offer trademark law. Speech-act theory provides a helpful lens for understanding how trademarks work and illustrates why overprotecting descriptive terms undermines the goals of trademark law and hurts competition. In so doing, it directs us to a clearer and more consistent test for protectability.

The first Part of this Article introduces speech-act theory as a framework for understanding trademark use as both speech and action. The second Part explores distinctiveness doctrine and the role of trademark law in fostering competition. The third Part discusses the tests and proxies courts use to determine whether a proposed mark is merely descriptive or

25. See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004) (discussing why trademark law has evolved to protect inherently distinctive marks without requiring proof that they function as source indicators).

26. J. L. AUSTIN, *HOW TO DO THINGS WITH WORDS* 25 (2d ed., William James Lectures, J. O. Urmson and Marina Sbisa, eds. 1962); see also JOHN R. SEARLE, *SPEECH ACTS: AN ESSAY IN THE PHILOSOPHY OF LANGUAGE* 54–55 (1969).

27. Despite the prevalence of terms like "utterance" and "speech" throughout Austin's work, speech-act theory can and has been applied to written language. *E.g.*, Kepa Korta & John Perry, *Pragmatics*, in *THE STANFORD ENCYCLOPEDIA OF PHILOSOPHY* (Edward N. Zalta ed., Summer 2011 ed.); Kent Bach, *Speech Acts*, in *ROUTLEDGE ENCYCLOPEDIA OF PHILOSOPHY* (2011).

inherently distinctive—whether it functions primarily to convey information about a product’s characteristics or primarily to communicate its source. The fourth Part draws on speech-act theory to generate a new test for inherent distinctiveness and applies that test to several of the examples that appear throughout the Article.

I. A SPEECH-ACT THEORY OF TRADEMARKS

Speech-act theory has received a great deal of attention over the years from scholars of linguistics, philosophy, theology, rhetoric, and literature, but lends itself perhaps most fruitfully—as Austin and his successors were well aware—to the study of law.²⁸ A statute does not merely make statements about the law; rather, in articulating the law, it creates it.²⁹ Contract disputes may hinge on whether a certain utterance constituted an “offer” or an “acceptance,” without which no contract was formed. Austin called these types of utterances “speech acts” or “performatives” because, unlike statements that primarily function to convey information, they primarily function to *alter* reality—they are noteworthy for “not merely[] saying something[,] but *doing* something.”³⁰ Performatives are “acts of language[] that . . . bring[] things into being, organizing the world rather than simply representing what is.”³¹ A judge who speaks the words “I sentence you to three years in juvenile detention” is, at that moment, enacting the sentence. Of course, the judge must also be authorized to perform the sentencing, and the context must otherwise be appropriate—if she speaks the words to her beagle at the dog park, or she is not a judge but an actress playing a role, the performative does not succeed: it is “infelicitous.”³²

28. See, e.g., Peter Meijes Tiersma, *The Language of Offer & Acceptance: Speech Acts & the Question of Intent*, 74 CAL. L. REV. 189 (1986); see also Janet E. Ainsworth, *In a Different Register: the Pragmatics of Powerlessness in Police Interrogation*, 103 YALE L.J. 259 (1993); Martin F. Hansen, *Fact, Opinion, & Consensus: The Verifiability of Allegedly Defamatory Speech*, 62 GEO. WASH. L. REV. 43 (1993); B. Jessie Hill, *Putting Religious Symbolism in Context: A Linguistic Critique of the Endorsement Test*, 104 MICH. L. REV. 491 (2005); Laura E. Little, *Hiding with Words: Obfuscation, Avoidance, & Federal Jurisdiction Opinions*, 46 UCLA L. REV. 75 (1998); Jonathan Yovel, *What is Contract Law ‘About’? Speech Act Theory and a Critique of ‘Skeletal Promises,’* 94 NW. U. L. REV. 937 (2000).

29. See Austin, *supra* note 26. Austin provides several illuminating examples of performatives: a ship owner announces, “I christen this ship the Harper’s Ferry” and kicks away the chocks; a dying man states, “I give and bequeath my watch to my brother”; an umpire pronounces a base-runner “out” at third base.

30. *Id.* at 25 (emphasis added).

31. JONATHAN CULLER, *LINGUISTIC THEORY: A VERY SHORT INTRODUCTION* 101–102 (2011).

32. AUSTIN, *supra* note 26. Austin uses the term “felicitous” (or “happy”) to describe a successful or effective performative utterance and “infelicitous” to characterize a performative utterance that fails to achieve its intended result.

Austin distinguished constative utterances, such as “New York City has five boroughs,” from performative utterances. Constative utterances “claim[] to represent things as they are, to name things that are already there.”³³ Trademark use is constative in one of two ways—it is either *source-constative* or *goods-constative*. Use is *source-constative* when consumers perceive the mark as primarily indicating the goods’ source, as when EXCEDRIN is used as a trademark in connection with aspirin. Use is *goods-constative* when consumers perceive the mark as primarily describing qualities or characteristics of the product or service itself,³⁴ as when, for example, a restaurant’s sign reads “Brick Oven Pizza.”

When trademark use is source-constative, law renders it simultaneously performative: the trademark use, with or without registration, generates enforceable legal rights and places competitors on notice of those rights. The constative speech is directed at consumers; the performative act, at competitors. A producer may intend its use of a mark to be source-constative, but if the mark is descriptive and lacks secondary meaning, consumers will perceive it as merely goods-constative—the use will suffer from an audience uptake error. Audience reaction is a contingency essential to the performativity of the mark. Just as the performative “I bet you the Red Sox will win tomorrow” is felicitous only if met with assent,³⁵ so is the performative function of trademarks supposedly contingent upon consumer perception. When a producer’s use of a distinctive word mark relates some information about a product to consumers, it simultaneously generates enforceable legal rights and places competitors on notice of those rights.

Consider an inherently distinctive mark like ADVIL. Because the mark does not exist as a word apart from its status as a mark, every utterance of the mark by the producer is source-constative and thus performative: it has the legal and ontological effect of creating the trademark and bestowing common law rights upon its owner and simultaneously putting competitors on notice of those rights. The primary attribute of performative speech acts is that they not only state something, but also do something. When Pfizer advertisements advise consumers to “choose ADVIL for pain,” or a supermarket circular notifies us that “ADVIL is on sale during the month of July,” the term “ADVIL” in the sentence—like Austin’s “I bequeath” or “I christen”—serves as both speech and act.³⁶ As directed at consumers, the

33. CULLER, *supra* note 31, at 101.

34. See 3 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES § 18:13 n.13 (4th ed. 2011) (comment by author Altman) (“The fundamental import of the term ‘descriptive’ . . . is antithetical to the notion of source-significance.”).

35. See AUSTIN, *supra* note 26, at 9 (“[F]or a bet to have been made, it is generally necessary for the offer of the bet to have been accepted by a taker (who must have done something, such as to say ‘Done’).”).

36. See Justin Hughes, *Group Speech Acts*, 7 LINGUISTICS AND PHIL. 379 (1984) (discussing performative utterances by groups).

use is source-constative, describing the product's brand or source. As directed at competitors, the use is performative, doing action: it puts competitors on notice that "ADVIL" is taken and forbids them from adopting "RAVDIL" for pain relievers, or any other mark that comes too close to treading on Pfizer's piece of semantic real estate. Existing tests for distinctiveness often lead fact finders to reach the wrong outcome for borderline marks because the tests do not adequately interrogate whether a proposed mark fulfills its source-constative, performative function.

Trademarks are typically categorized as either fanciful, arbitrary, suggestive, or descriptive.³⁷ Fanciful and arbitrary marks map neatly onto the speech-act schema: KODAK for cameras and BUMBLE AND BUMBLE for hairspray are innately source-constative precisely because they are never goods-constative. The adjective "bumble" has no definition that modifies the noun "hairspray" other than its source-indicating definition. Conversely, descriptive marks like TASTY SELECTIONS for cookie dough³⁸ or TRIPLE MOISTURE for hair conditioner³⁹ are, without secondary meaning, goods-constative—consumers have no inherent reason to perceive the terms as describing anything other than characteristics or aspirations of the products to which they are affixed.

As in the case of the judge who cannot sentence her pet beagle to life imprisonment, performatives require certain contextual elements in order for their use to be felicitous:

The uttering of the words is, indeed, usually a, or even *the*, leading incident in the performance of the act . . . the performance of which is also the object of the utterance, but it is far from being usually, even if it is ever, the *sole* thing necessary if the act is to be deemed to have been performed. Speaking generally, it is always necessary that the *circumstances* in which the words are uttered should be, in some way, or ways, *appropriate*, and it is very commonly

37. See *infra* Part II.A for a discussion of mark categories and the distinctiveness spectrum.

38. The application to register TASTY SELECTIONS for "[c]akes, cookie dough, and muffin batter" on the Principal Register was abandoned after the PTO issued a non-final office action refusing registration based on descriptiveness under 15 U.S.C. § 1052(e)(1). U.S. Trademark Application Serial No. 85,422,053 (filed Sept. 14, 2011), available at <http://tdr.uspto.gov>.

39. Neutrogena registered NEUTROGENA TRIPLE MOISTURE for "[h]air care preparations" but, at the PTO's instruction, disclaimed "the exclusive right to use TRIPLE MOISTURE apart from the mark as shown." NEUTROGENA TRIPLE MOISTURE, Registration No. 28,676,08. The PTO often requires a disclaimer as a condition of registration when a mark contains one or more terms that are descriptive or generic. See *In re Stereotaxis, Inc.*, 429 F.3d 1039, 1041 (Fed. Cir. 2005). According to the Trademark Manual of Examining Procedure [hereinafter TMEP], "[t]he purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark." TMEP § 1213 (9th ed. Oct. 2013); see also Ashlyn Lembree, *Marking Territory: An Empirical Study Concerning the Tightening of Trademark Claim Space on the USPTO Register*, INTELL. PROP. TODAY (May 2011).

necessary that either the speaker himself or other persons should *also* perform certain *other* actions, whether ‘physical’ or ‘mental’ actions or even acts of uttering further words.⁴⁰

Source-constative trademarks also require the presence of contextual elements. When Pfizer suggests that headache sufferers purchase ADVIL, its trademark use is likely to be felicitous because the fanciful mark always already functions as a mark, and will be perceived as such by consumers. But when PENGUIN is used as a mark for a publishing house, consumers remain aware of the term’s dictionary meaning; thus, “I can get the PENGUIN version of that book for half price” will be source-constative while “I can pet a penguin at the Mystic Aquarium” will not. The source-constative use of arbitrary or suggestive marks, then, is more context-dependent than that of fanciful marks, while the source-constative use of descriptive marks with secondary meaning is the most context-dependent.⁴¹

Austin describes various errors that can prevent a performative utterance from being successful, or in his terms, “felicitous.” The one most relevant to a discussion of trademark distinctiveness is the one I call “uptake” error. If I enter a colleague’s office and say, “I wonder if it would be cooler in here if you opened the window,” and my colleague opens the window, then my request succeeded—my performative utterance was felicitous. But if my colleague doesn’t hear me, or he believes I’m being sarcastic because it’s already fairly cool in his office, the instruction doesn’t take. I possessed the requisite intent to request his action, and I recited conventional words to do so, but I also needed a specific response from him; without it, the performative is infelicitous. The performative function of trademarks is likewise contingent upon audience perception.⁴² The mark owner’s intent to use its mark as a source indicator does not suffice to render that use source-constative; only the consumer’s perception of the mark as fulfilling a trademark function makes the use source-constative.

Speech-act theory teaches that words can constitute both speech and action simultaneously. As applied to trademark distinctiveness doctrine, it

40. AUSTIN, *supra* note 26, at 8.

41. See Thomas R. Lee, Eric D. DeRosia, & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033 (2004) (suggesting that consumers often perceive even merely descriptive terms as trademarks when they appear on product packaging with various non-semantic indicia of trademark use, such as large font size, prominent location, capitalization, and color).

42. Similarly, Jeanne Fromer points out that a trademark must be “socially appropriate” for the goods and services to which it is applied: “Once a mark is selected and used, society will find it either helpful and it will be a successful—and thus appropriate—mark or unhelpful as a source indicator. In the latter case . . . trademark law frequently steps in to deny protection for the link.” Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1906 (2011).

drives home the difference between distinctive and merely descriptive marks as a difference between words that perform action and words that simply provide information. Fact-finders tasked with evaluating whether a word mark is inherently distinctive often behave as though they are simply placing passive terms in various siloes as dictated by a set of rules. In fact, their task is to determine whether a mark is, by its nature, primed to serve as an active indicator of source. The speech-act model can thus guide us toward a more deliberate and conscientious approach to gauging distinctiveness.

II. INHERENT DISTINCTIVENESS

Protecting descriptive terms as inherently distinctive directly harms competitors and new entrants. Two of the chief policy justifications offered for trademark law are that it protects consumers from being misled, deceived, or confused and that it provides incentive for producers to ensure that the quality of the goods sold under the mark is consistent. Proponents of law and economics argue that another of the main benefits trademarks offer is their capacity to reduce consumer search costs, promoting marketplace efficiency.⁴³ Conversely, protecting producers' investment is touted as the "second goal of trademark law" by some,⁴⁴ and its primary and original goal by others.⁴⁵ Different trademark doctrines prioritize different policy goals and values:⁴⁶ the consumer perspective reigns supreme in theories about infringement and motivates the bars against registering deceptive⁴⁷ and scandalous⁴⁸ marks; producer protection, on the other hand, provides the basis for anti-dilution laws. Most positive theories

43. See generally WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 173 (2003) ("[In t]he implicit economic model that guides that law . . . trademarks lower consumers' search costs by providing them with valuable information about brands and encourage quality control . . ."); William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267 (1988); see also, e.g., *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) ("The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods," giving producers an incentive to invest in products and maintain quality.).

44. Greg Lastowka, *Trademark's Daemons*, 48 HOUS. L. REV. 779, 785 (2011).

45. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1858–60 (2007), (arguing that trademark law was designed to protect producers, rather than consumers); see also Fromer, *supra* note 42, at 1891 ("[Nineteenth-century trademark law] focused primarily on protecting producers from competitors' illegitimate interference with their trade rather than on the consumer."); Lastowka, *supra* note 44, at 785.

46. Mark P. McKenna, *Teaching Trademark Theory Through the Lens of Distinctiveness*, 52 ST. LOUIS U. L.J. 843, 847 (2008).

47. 15 U.S.C. §§ 2(a), 2(e)(1), 2(e)(3) (2006).

48. *Id.* at § 2(a)

of trademark law focus on consumers and mark owners,⁴⁹ with a nod to “competition” but little emphasis on competitors themselves.⁵⁰

But the speech-act theory of trademarks demonstrates that trademark use has two target audiences. As directed at consumers, it serves to indicate source and consistency and reduce search costs. As directed at competitors, it provides notice that a term or phrase is being used as a mark and that infringement, dilution, cyber-squatting, and other behaviors that violate the perceived rights associated with the mark owner’s use will not be tolerated.

Whose interests are served and whose subordinated when the PTO grants registration of marks that contain goods-constative terms? In such cases, the producers have not yet invested sufficient time and money to create an association between the mark and the product, rendering the mark source-constative; if they had, secondary meaning would serve as a basis for registration. Consumers have not yet been conditioned to associate the mark with a particular producer or its goods; if they had, secondary meaning would exist. When applications to register marks that contain non-disclaimed descriptive terms are denied registration unless the owner can demonstrate secondary meaning, neither producers nor consumers are harmed. Consumers are not misled; search costs do not increase; producers are not deprived of valuable goodwill because they have not yet acquired it.⁵¹ In the converse scenario, however, arguably descriptive marks are protected without secondary meaning, and competition is stifled. Junior users are more likely to avoid using terms similar to those that compose the mark—terms they might find useful or desirable in marketing their competing goods. Competitive speech is chilled without the justification of either preventing consumer confusion or protecting producer goodwill.

49. *E.g.*, *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (citation omitted), *superseded by statute*, Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1730 (2006) (codified at 15 U.S.C. § 1125 (2006)) (“[Trademark law] protects consumers from being misled by the use of infringing marks[.]”); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (explaining that trademark protection “reduce[s] the customer’s costs of shopping and making purchasing decisions” and ensures mark owners “reap the financial, reputation-related rewards associated with a desirable product”); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992) (noting that the purpose of trademark protection is “preventing deception and unfair competition”); *see also* S. REP. NO. 79-1333, at 3 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274 (“The purpose underlying any [trademark] statute is . . . to protect the public so that it may be confident . . . it will get the product which it asks for and wants to get . . . [and to] protect[] [a mark owner] in his investment from its misappropriation by pirates and cheats.”); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:1, at 2–3 (4th ed. 2011) (explaining that the basic policy behind trademark law is to protect consumers from deception but that a producer’s “interest in not having the fruit of his labor misappropriated should not be disregarded”); Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1287 (2011) (“The view that trademark law vindicates both buyer and seller interests is old.”); McKenna, *supra* note 46, at 847 (“Trademark law has long struggled to balance the interests of consumers and producers.”).

50. Genericism doctrine, on the other hand, prioritizes competition.

51. Requiring applicants to demonstrate secondary meaning in order to register or enforce an arguably descriptive mark often increases costs for those applicants, however.

Despite the harm to competitors and consumers, neither constituency is likely to be effective in blocking the registration of descriptive marks. Consumers share with competitors a general desire to keep descriptive terms in the pool for use by others, but their interest in preventing registration of a specific descriptive mark is rather attenuated. When they have the motivation, they typically lack the means to block registration.⁵² Competitors' perspectives warrant even greater attention than consumers' perspectives in connection with the decision to register an arguably descriptive mark before it acquires secondary meaning. When descriptive marks are registered without acquired distinctiveness, the chilling effects on competitor speech are significant, yet competitors are not well-positioned to object to it. If the PTO passes an applied-for mark to publication, it appears among the thousands of entries published in the Official Gazette each week.⁵³ A competitor can then oppose the mark in an *inter partes* proceeding before the TTAB within thirty days⁵⁴ or seek to cancel the mark within five years of registration.⁵⁵ But the sheer volume of marks in each Gazette makes it unlikely that any mark owner will be able to review it each week to decide whether to oppose any of the published marks.⁵⁶ Producers are motivated to seek maximal protection for their marks, and consumers and competitors have little opportunity to push back. The PTO and TTAB face only producer pressure to grant registration, with little countervailing pressure from those with opposing interests.

52. Consumers have no standing to oppose or cancel the registration of a mark on the basis that it is merely descriptive. As Michael Grynberg has argued, consumers aren't technically represented in infringement litigation either, yet their interests are front and center as fact finders seek to gauge the likelihood of their confusion. Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. REV. 60, 73 (2008).

53. The Official Gazette is available in PDF form at the USPTO official website, http://www.uspto.gov/news/og/trademark_og/index.jsp.

54. In order to show standing, a petitioner must allege that it has a direct stake in the outcome and could be harmed by the registration of the mark it seeks to cancel.

55. After five years have elapsed, marks can still be canceled on certain grounds, but many marks achieve incontestable status five years after registration and are then protected from challenge based on mere descriptiveness. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985).

56. See Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1165 (2003) ("Although competitors have five years to challenge a registered descriptive mark before it can become incontestable, time and money are required to monitor trademark registrations and file opposition proceedings with the PTO. It is even more unlikely that general members of the public and possible future competitors will monitor PTO registrations to ensure that descriptive words remain available for use by everyone in a particular industry."). While some large firms retain a third party to monitor the Gazette for trademarks that might be confusingly similar to those in their portfolios, merely descriptive marks are harder to screen, and potential new entrants who have not yet begun to compete with a mark holder are unlikely to be attuned to the process. See U.S. PATENT & TRADEMARK OFFICE, DEP'T OF COMMERCE, TRADEMARK LITIGATION TACTICS AND FEDERAL GOVERNMENT SERVICES TO PROTECT TRADEMARKS AND PREVENT COUNTERFEITING 7 (Apr. 2011), available at http://www.uspto.gov/ip/TMLitigationReport_final_2011April27.pdf.

Whether a proposed trademark is inherently distinctive is an important determination. Yet that determination is often botched by fact finders, as evidenced by a plethora of decisions that overprotect descriptive marks based on vague, misapplied, and ill-fitting tests. Distinctiveness purports to be a question of consumer perception, but because the existing tests⁵⁷ provide scant guidance for the PTO, TTAB, and federal courts, fact finders often focus unduly on mark selection, fixing on the employment of double entendre, incongruity, rhyme, metaphor, alliteration, or other rhetorical device as evidence that a mark is distinctive.

Rewarding mark owners for the use of such devices without regard to the goods-constative nature of specific terms often creates problems. It can result in deeming marks suggestive when they're actually merely descriptive and removing from the pool of available words many that competitors ought to remain free to use.⁵⁸ When courts overprotect descriptive marks *ex ante*, they supplant the goals of open competition and economic efficiency with a scheme that prizes owners' natural rights and, in so doing, chill commercial expression.⁵⁹ What's more, they specifically disadvantage competitors, precluding second comers from using descriptive and laudatory terms to position their products as viable alternatives to those already in the marketplace.

A. *Defining Distinctiveness*

Distinctiveness refers to a trademark's serving as an indication of source to consumers—i.e., functioning as a trademark. A distinctive mark need not tell consumers who or what the source of a product actually is but merely that the product will be consistent because the source is consistent. The source-indicating function of trademarks enables the consumer to rest assured that a STARBUCKS iced doppio she buys on West Street in Annapolis will be nearly identical to the STARBUCKS iced doppio she buys at John F. Kennedy airport outside of gate forty-six.

57. The tests and heuristics used to evaluate distinctiveness and descriptiveness are discussed *infra* at Part III.

58. See Bone, *supra* note 25, at 2114 (noting that when trademark law protects a descriptive word, such as FISH-FRI for a batter mix used to fry fish, there is a risk that competing firms will have difficulty finding other words to use as trademarks to describe the same features of their products. A trade-mark like FISH-FRI is more than a device to communicate to consumers product information acquired through advertising, experience, or word of mouth; the word itself communicates information directly. A firm with exclusive rights to a descriptive word like FISH-FRI therefore gets an immediate advertising advantage.); see also Michael S. Mireles, Jr., *Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law*, 44 IND. L. REV. 427, 448 (2011).

59. See Ramsey, *supra* note 56 (arguing that granting exclusive rights in descriptive trademarks violates the First Amendment and asserting that the government should protect trademark rights only in inherently distinctive marks).

Courts and the PTO categorize word marks⁶⁰ along a spectrum of least to most distinctive, including generic, descriptive, suggestive, arbitrary, and fanciful marks.⁶¹ Fanciful, arbitrary, and suggestive marks are considered inherently source-indicating and thus automatically protectable, while descriptive marks are only protected if they possess secondary meaning, and generic terms cannot be protected as trademarks. Fanciful or “coined” marks like CLOROX for bleach are created solely to serve as trademarks. Arbitrary marks are existing words used as trademarks for supposedly unrelated products, such as AARDVARK for graphic design or, in the example most often cited by courts in recent years, APPLE for computers.⁶²

While arbitrary and fanciful marks ostensibly bear no relation to the goods or services on which they’re used,⁶³ suggestive marks suggest or “subtly connote”⁶⁴ information about the qualities or nature of the product to which they are affixed without directly describing it, such as CHICKEN OF THE SEA for tuna fish⁶⁵ or COPPERTONE for suntan oil. In contrast, a descriptive mark imparts information about the goods or services directly⁶⁶ and immediately. Descriptive marks communicate some feature of, or information about, a product, such as its ingredients,⁶⁷ characteristics,⁶⁸ color,⁶⁹ odor,⁷⁰ flavor,⁷¹ shape,⁷² function,⁷³ intended

60. Designs, colors, scents, packaging, product configuration, and other non-semantic elements that indicate source can also be protected as trademarks or trade dress. While “descriptiveness” and “distinctiveness” are not without meaning in assessing non-semantic marks, this Article focuses on word marks. Some of its principles, however, may apply with equal force to non-semantic marks.

61. TMEP § 1209.01 (9th ed. Oct. 2013). *But see* Barton Beebe, *Search and Persuasion in Trademark Law*, 103 MICH. L. REV. 2020, 2029 (2005) (“As perceived by a given consumer, a trademark either is or is not source distinctive; it either qualifies for protection or it does not. The difference between the mark which is source distinctive and the mark which is not is a difference of kind, not degree.”).

62. *See, e.g.*, *Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 19 (1st Cir. 2004); *First Sav. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 655 (10th Cir. 1996); *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996).

63. Many commentators have questioned this assumption in recent years. *See, for example*, Rebecca Tushnet’s discussion of the mark VIAGRA, ostensibly a fanciful mark but carefully architected to connote virility and vigor and to conjure images of Niagara Falls. Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 HOUS. L. REV 861, 871–72 (2011).

64. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979).

65. *Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 977 (C.C.P.A. 1931).

66. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 952 (7th Cir. 1992) (“[I]f the mark imparts information directly it is descriptive.” (quoting *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976))); *Field of Screams, L.L.C. v. Olney Boys and Girls Cmty. Sports Ass’n*, No. DKC 10-0327, 2011 WL 890501, at *5 (D. Md. Mar. 14, 2011).

67. *E.g., In re Gagliardi Bros., Inc.*, 218 U.S.P.Q. 181, 184 (T.T.A.B. 1983) (BEEFLAKES merely descriptive for thinly sliced beef).

68. *Levi Strauss & Co. v. Plushbottom & Peabody, Ltd.*, 212 U.S.P.Q. 296, 298 (T.T.A.B. 1981) (STRAIGHTS merely descriptive for straight-legged jeans).

users,⁷⁴ purpose,⁷⁵ mechanism of action,⁷⁶ or effect.⁷⁷ A word mark need not describe all of the characteristics of a product to be deemed merely descriptive—it is enough that it describe one significant function or attribute.⁷⁸ Prior to the 1900s, descriptive marks could not receive protection as trademarks;⁷⁹ today, descriptive marks can only be enforced or registered on the Principal Register if they possess acquired distinctiveness (as opposed to the inherent distinctiveness that arbitrary, fanciful, and suggestive marks are presumed to possess).⁸⁰

While descriptive terms identify qualities of the goods, generic terms convey their “nature and class.”⁸¹ Generic phrases, like “computer store” for a store that sells computers or “strawberry milk” for strawberry-flavored milk, are neither inherently distinctive nor capable of acquiring distinctiveness, and thus cannot become source-constative and earn

69. *E.g.*, *W. Publ'g. Co. v. Rose Art Indus.*, 733 F. Supp. 698, 700 (S.D.N.Y. 1990). *But see* *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 835 (T.T.A.B. 1985) (BIG RED inherently distinctive for a large bottle of a red soft drink).

70. *E.g.*, *In re Gyulay*, 820 F.2d 1216, 1218 (Fed. Cir. 1987) (APPLE PIE merely descriptive for potpourri); *Am. Greetings Corp.*, 226 U.S.P.Q. 365, 366 (APRICOT merely descriptive for apricot-scented dolls).

71. *L.P. Larson, Jr., Co. v. Wm. Wrigley, Jr., Co.*, 253 F. 914, 915 (7th Cir. 1918) (SPEARMINT merely descriptive for spearmint-flavored chewing gum.); *In re Andes Candies Inc.*, 478 F.2d 1264, 1267 (C.C.P.A. 1973) (CRÉME DE MENTHE for candy not inherently distinctive).

72. *In re Invue Sec. Prods. Inc.*, 2008 WL 5256384, at *3 (T.T.A.B. Dec. 8, 2008) (PUCK merely descriptive for puck-shaped anti-shoplifting devices).

73. *Express Diagnostic Int'l v. Tydings*, No. C 06-01346 JW, 2009 WL 111736, at *3-5 (N.D. Cal. Jan. 15, 2009) (DRUGCHECK not inherently distinctive for urine collection cups for detecting drugs).

74. *Shaw-Barton, Inc. v. John Baumgarth Co.*, 313 F.2d 167, 168-69 (7th Cir. 1963) (HOMEMAKER for calendars merely descriptive of target audience of product); *In re Major League Umpires*, 60 U.S.P.Q.2d 1059, 1060 (T.T.A.B. 2001) (MAJOR LEAGUE UMPIRE merely descriptive for clothing and protective gear).

75. *E.g.*, *In re L.R. Brock Ind. Inc.*, 218 U.S.P.Q. 1055, 1056 (T.T.A.B. 1983) (POOPSCOOP non-distinctive for dog excrement scooper).

76. *E.g.*, *In re Aid Labs, Inc.*, 223 U.S.P.Q. 357, 358 (T.T.A.B. 1984) (BUG MIST for insecticide merely descriptive because it conveys “the product may be used in mist form on bugs”).

77. *In re MBAssociates*, 180 U.S.P.Q. 338, 339 (T.T.A.B. 1973) (STUN-GUN merely descriptive for a weapon that stuns its target).

78. TMEP § 1209.01(b) (9th ed. Oct. 2013).

79. The Trademark Act of 1920 first provided that merely descriptive marks could become registrable if they had acquired distinctiveness. *See* *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 329-30 (1938).

80. 15 U.S.C. § 1052 (2006). Merely descriptive marks capable of becoming distinctive may, however, be registrable on the Supplemental Register before they acquire distinctiveness. 15 U.S.C. § 1091; TMEP § 1209.01 (9th ed. Oct. 2013).

81. 1 MCCARTHY, *supra* note 49 § 12.51, quoting *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (2d Cir. 1963).

protection as trademarks.⁸² The phrase “computer store” functions not as an indication of source for the store or the computers it offers for sale, but simply as the most obvious way to refer to any store that sells computers. Marks initially registrable on the Principal Register or protectable under common law can become generic over time. Formerly source-constative trademarks that are now considered generic and incapable of serving a source-indicating function include “thermos,”⁸³ “trampoline,”⁸⁴ “yo-yo,”⁸⁵ and “cellophane.”⁸⁶

The determination of whether a mark is inherently distinctive is not made in the abstract, but in the context of the goods or services to which it is affixed.⁸⁷ For example, DELICIOUS might be generic for a particular cultivar of apple and thus incapable of becoming a source indicator.⁸⁸ Yet DELICIOUS would be descriptive if used in connection with ice cream or potato chips because it functions as a laudatory term boasting their superior taste. DELICIOUS would be arbitrary for copy machines or snowplow services because it has no goods-constative meaning as applied to them. The Ninth Circuit, faced with determining whether DELICIOUS was suggestive or descriptive for footwear, left the question for the jury.⁸⁹

B. Policy Goals

Why protect fanciful, arbitrary, and suggestive marks without requiring registrants to establish secondary meaning? Theorists have rationalized that those categories of words and phrases will be source-constative as soon as they are used in commerce, precisely because they bear little or no logical, goods-constative relationship to the goods or services with which they are used.⁹⁰ As Robert Bone notes, characterizing a subset of marks as inherently distinctive and protecting them without requiring owners to establish acquired distinctiveness is an efficient shortcut because it minimizes administrative costs by capitalizing on our knowledge about how trademarks accrue meaning:

82. See 3 ALTMAN & POLLACK, *supra* note 34 § 18:13 (“[M]ere descriptiveness . . . includes [both] genericism and descriptiveness”; “genericism is the extreme form of ‘mere descriptiveness.’”).

83. King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963).

84. Nissen Trampoline Co. v. Am. Trampoline Co., 193 F. Supp. 745, 749 (S.D. Iowa 1961).

85. Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655, 668 (7th Cir. 1965).

86. DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 80 (2d Cir. 1936).

87. TMEP § 1209.01(b) (9th ed. Oct. 2013); Unleashed Doggie Day Care, LLC v. Petco Animal Supplies Stores, Inc., 828 F. Supp. 2d 384, 391 (D. Mass. 2010).

88. See, e.g., Walters Gardens, Inc. v. Pride of Place Plants, Inc., 2008 WL 902844, at *12 (T.T.A.B. March 4, 2008) (PIILU generic for a specific cultivar or varietal of Clematis plant and thus unregistrable).

89. Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc., 618 F.3d 1025, 1031 (9th Cir. 2010) (declining to determine the precise category of the mark on summary judgment).

90. Bone, *supra* note 25, at 2130–35.

Because the symbol has no other meaning to consumers (or in the case of suggestive marks, no other obvious meaning), consumers, who are accustomed to seeing source identifiers on labels, are very likely to assume that the symbol is a trademark and use it as such. Thus, the probability is extremely high (though not certain) that an inherently distinctive mark will become a source identifier, and in a reasonably short period of time.

....

... Because of the high probability that these marks already have or will soon acquire secondary meaning, the conclusive presumption is very likely to be correct most of the time. Moreover, the conclusive presumption saves the litigation costs of actually proving secondary meaning in individual cases.⁹¹

Conversely, descriptive marks are less certain to acquire secondary meaning⁹² and apt to take longer to acquire it if they do. The risks of presuming secondary meaning in descriptive marks are far higher than those of presuming secondary meaning in inherently distinctive marks because, before and after they are trademarks, descriptive marks are simply words. Further, they are words understood to convey information about the goods and services with which they are used. In order to warrant protection as trademarks, marks must function *as* trademarks, i.e. as source indicators. When they do not, public policy favors ensuring those words remain available to the public and to other producers.⁹³ The Court of Customs and Patent Appeals (CCPA), the predecessor to the Court of Appeals for the Federal Circuit,⁹⁴ has identified two “major reasons” for declining to protect merely descriptive marks without a showing of secondary meaning: “to prevent the owner of a mark from inhibiting competition in the sale of particular goods,” and “to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or

91. *Id.* at 2130–32 (internal citation omitted).

92. While fanciful, arbitrary, and suggestive marks are considered inherently distinctive, they can also accrue secondary meaning over time, strengthening their protectability against infringing or diluting uses. See *infra* note 109.

93. *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974) (“[O]thers should be equally entitled to use such nondistinctive words.”); see also 3 ALTMAN & POLLACK, *supra* note 34 § 18:15 (protecting descriptive terms as inherently distinctive is in tension with “the policy of allowing wide use of widely-useful words.”).

94. In 1982, the Federal Courts Improvement Act (Pub. L. No. 97-164, 96 Stat. 25) abolished the CCPA and the U.S. Court of Claims, reassigning the judges from both courts to the newly created Court of Appeals for the Federal Circuit [hereinafter CAFC]. The CAFC adopted the decisions of its predecessor courts as its own binding precedent. See *S. Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982).

describing their own products.”⁹⁵ Justice Stevens in his dissent in *Park 'N Fly* noted the “well-recognized public interest in prohibiting the commercial monopolization of [descriptive] phrases” and cautioned that “[l]anguage, even in a commercial context, properly belongs to the public.”⁹⁶

As those opinions acknowledge, competition can be inhibited where competitors are not free to draw from the complete pool of possible terms and phrases to describe their products. If a new entrant to the field of portable music players devised a way for multiple users to listen to a single player simultaneously, it might want to advertise the new player using the phrase “share music with your friends!” But once the new entrant learns of the registration for SHAREMUSIC under § 2(e),⁹⁷ it may feel constrained in its use of that descriptive phrase. Competition is also inhibited when the pool of descriptive terms has been depleted and competitors cannot—or believe they cannot—incorporate certain descriptive or generic terms into their trademarks. For example, the determination that XTREME HEAT is inherently distinctive for cheese curls⁹⁸ will likely lead the makers of other snacks to steer clear of marks like XTREME CHEESE or EXTRA HEAT, even though “cheese” and “heat” describe the chips’ flavor and “xtreme” or “extra” serve to modify or amplify those descriptors. In theory, the PTO, TTAB, and courts treat flavors and laudatory terms as merely descriptive, but they often allow those default rules to be trumped by the application of various tests and proxies. The PTO also applies a “rule of doubt” in close questions of distinctiveness, resolving borderline cases in favor of applicants.

Of course, infringement suits are not the only means of aggressive policing by trademark owners. Some large companies send out hundreds of “cease and desist” letters per year,⁹⁹ each designed to intimidate its recipient into choosing a different mark because the letter writer deems the

95. *In re Abcor Dev. Co.*, 588 F.2d 811, 813 (C.C.P.A. 1978), cited in TMEP § 1209 (9th ed. Oct. 2013).

96. *Park 'N Fly, Inc. v. Dollar Park 'N Fly, Inc.*, 469 U.S. 189, 214–15 (1985) (Stevens, J., dissenting).

97. See *In re Dana Innovations*, 2007 WL 466797 (T.T.A.B. Feb. 6, 2007).

98. Serial No. 85/027087 was published in the Principal Register on August 28, 2012, after the TTAB held the mark not merely descriptive. *In re HEB Grocery Co.*, 2012 WL 2930644, at *5 (T.T.A.B. June 29, 2012).

99. Letter from Kenneth L. Port to David Kappos, Dir. of the U.S. Patent & Trademark Office 17 (2011), available at <http://openwmitchell.edu/facsch/203>. The NFL estimates that it sends out 80 to 100 cease-and-desist letters each year regarding unauthorized use of its SUPER BOWL trademark. Robert Channick, *Defense Rules in Guarding Super Bowl Name*, CHICAGO TRIBUNE, Feb. 1, 2012, http://articles.chicagotribune.com/2012-02-01/business/ct-biz-0201-big-game-20120201_1_nfl-shield-official-pizza-sponsor-nfl-sponsors. For a helpful discussion of trademark bullying, including the use of cease and desist letters, see Grinvald, *supra* note 11.

recipient's use infringing.¹⁰⁰ Often such letters are sent from large companies with legal teams to junior users who lack expertise in trademark law and cannot afford litigation.¹⁰¹ When a firm successfully registers a descriptive term as a mark by persuading the trademark examining attorney that the mark is inherently distinctive, it may succeed in discouraging others from employing that descriptive term.¹⁰² The statutory fair use defense to a claim of infringement does not sufficiently mitigate the harm to competition because it is not actual infringement liability that chills the use of descriptive terms, but the specter of litigation.

Federal courts have long acknowledged "the danger of depleting the general vocabulary available to all for description and denomination of articles of commerce."¹⁰³ Sixty years ago, the Third Circuit Court of Appeals warned against excluding commercial actors from "us[ing] apt normal words or phrases in depicting or characterizing articles because of language preemptions by others."¹⁰⁴ About thirty years after that, the Seventh Circuit similarly opined:

The rationale for prohibiting the appropriation of . . . a descriptive term as a trademark rests upon the equal right of another individual producing and marketing a similar product to describe his or her product with similar accuracy. Were this right not protected by the law, elements of the language could be monopolized in such a way as to impoverish others' ability to communicate.¹⁰⁵

Descriptive terms used in conjunction with the sale of goods or services, such as NO MORE TANGLES for a hair detangling spray or

100. See generally CHILLING EFFECTS, www.chillingeffects.org (last visited Jan. 2, 2014), for examples of cease and desist letters alleging trademark infringement.

101. See Grinvald, *supra* note 11, at 628 & n.13. See also Department of Commerce letter to Congress on Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting at 18 (April 2011), written in response to Public Law 111-146, which required a study and report on the effect of abusive trademark litigation tactics on small businesses:

With respect to cease-and-desist letters, many of the comments acknowledged regular use of these letters in the trademark field. A handful of small business owners explained that they withdrew their trademark applications after receiving a cease-and-desist letter because they lacked the time or financial resources to litigate against a larger, wealthier company. This imbalance of resources was a common theme among many of the comments . . .

102. For example, the owner of the VILLAGE VOICE trademark has accused of infringement the proprietors of various other publications that use the term "voice," including the *Cape Cod Voice*, the *Bloomington Voice*, and the *Tacoma Voice*. Zipkin, *supra* note 12. Over a ten year period, the owner of the mark ENTREPRENEUR for magazine services "resolved or settled about forty instances of actual or potential trademark infringement," the majority likely via cease-and-desist letters or informal communications. *Id.*

103. *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 906 (3d Cir. 1952).

104. *Id.*

105. *Gimix, Inc. v. JS & A Grp., Inc.*, 699 F.2d 901, 907 (7th Cir. 1983).

QUICK COPIES for a photocopying service, may be perceived by consumers only as goods-constative—conveying a feature of the product, rather than source-constative—communicating a brand name or consistent source. If the PTO and courts overprotect descriptive marks by allowing their registration and enforcement without secondary meaning, they risk depleting the language available to competitors and chilling speech by granting a property right in a term that serves no trademark function.

To determine whether a trademark that is merely descriptive has acquired secondary meaning and thus warrants registration or protection under federal law, trademark examining attorneys and courts look to various indicia of secondary meaning,¹⁰⁶ including the nature, expense, and amount of advertising; length, exclusivity, and manner of use; total sales; consumer or dealer statements of recognition of the mark as a source identifier; survey evidence; and unsolicited media coverage.¹⁰⁷ A court's inquiry with regard to secondary meaning focuses on the effectiveness of promotional efforts in altering the mark's meaning to consumers.¹⁰⁸ The goal is to determine whether, based on the use of a mark in commerce, an initially goods-constative mark has become source-constative.

Determining whether a word mark is inherently distinctive or merely descriptive¹⁰⁹—what McCarthy has called the “[d]escriptive”–“suggestive”

106. Three basic types of evidence may be used to establish acquired distinctiveness under § 2(f): (1) ownership of prior registrations on the Principal Register of the same mark for goods that are the same as or related to those named in the pending application (37 C.F.R. § 2.41(b) (2006)); TMEP §§ 1212.04–1212.04(e) (9th ed. Oct. 2013)); (2) a statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use for the five years before the claim of distinctiveness is made (37 C.F.R. § 2.41(b); TMEP §§ 1212.05–1212.05(d) (9th ed. Oct. 2013)); and (3) actual evidence of acquired distinctiveness (37 C.F.R. § 2.41(a); TMEP §§ 1212, 1212.06–1212.06(e)(iv) (9th ed. Oct. 2013)).

107. See 37 C.F.R. § 2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 1337–41 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 U.S.P.Q. 957 (T.T.A.B. 1979); 3 ALTMAN & POLLACK, *supra* note 34 § 20:29; TMEP § 1212.06 (9th ed. Oct. 2013).

108. *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970).

109. Distinctiveness is evaluated in several different contexts. When a mark owner files a use-based application to register her mark on the Principal Register, an examining attorney determines whether the mark is registrable on a § 2(e) basis as inherently distinctive or only on a § 2(f) basis, in which case proof of secondary meaning is required. When the application is filed on an intent-to-use (“ITU”) basis, a descriptive mark will usually be rejected because the owner has not yet begun to use the mark in commerce, and secondary meaning is thus unlikely to exist. An applicant can challenge a refusal by filing an *ex parte* appeal with the TTAB. If the PTO is sufficiently convinced of a mark's inherent distinctiveness and has not rejected the mark on any other basis, the mark will be published in the Gazette. Third parties can then bring *inter partes* proceedings before the TTAB to oppose registration of a mark within thirty days of publication or to cancel a mark after the opposition period has closed. When federal courts consider distinctiveness, they do so most frequently in infringement cases, either during a preliminary determination of whether a plaintiff owns a valid and legally protectable trademark or as part of a likelihood of confusion analysis. In many jurisdictions, the multifactor test for likelihood of confusion considers the strength of the plaintiff's mark, which has two components: conceptual strength, typically equated with the mark's inherent distinctiveness, and commercial strength, a concept more akin to secondary meaning. *E.g.*, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). Some courts explicitly consider mark strength among the most

battle line”¹¹⁰—often triggers in fact-finders a “know it when I see it” attitude that reflects their personal impressions of a mark, rather than gauging the perception of the relevant group of consumers. Calling the determination “fuzzy,”¹¹¹ “tricky,”¹¹² “blurred,”¹¹³ “hazy,”¹¹⁴ and “difficult,”¹¹⁵ and the distinction¹¹⁶ between descriptive and suggestive marks “inarticulable,”¹¹⁷ judges have repeatedly acknowledged that intuition plays a large role in evaluating distinctiveness.¹¹⁸ While a number of so-called “tests” are recited and ostensibly applied, the results are inconsistent both across and within the TTAB, PTO, federal district courts, and circuit courts of appeal. The unsatisfactory tests and inconsistent results leave applicants and litigants ill-equipped to predict how their marks will be categorized, raising administrative costs and failing to serve the signaling function that should guide firms in selecting marks.¹¹⁹

III. TESTS FOR DISTINCTIVENESS

Skeptics need not look far to find examples of inconsistent outcomes. The Eighth Circuit held “LA” suggestive for low-alcohol beer,¹²⁰ while the Seventh Circuit held the same mark merely descriptive¹²¹ within the same

important factors in determining the likelihood of confusion, *e.g.*, *Aronowitz v. Health-Chem Corp.*, 513 F.3d 1229 (11th Cir. 2008), and a recent empirical analysis led three scholars to conclude that the strength of the plaintiff’s mark was the second most important factor in predicting a finding of infringement. *See* Kevin Blum, Ariel Fox, Christina J. Hayes & James (Hanjun) Xu, *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. 3, 33 (2010). Courts adjudicating claims of trademark dilution may also consider whether or not a mark is distinctive.

110. 2 MCCARTHY, *supra* note 49 § 11:22 (“Generally, litigation over descriptiveness resolves into a dispute as to whether a given mark should be put into one of two pigeonholes: (1) the ‘descriptive’ category or (2) the ‘suggestive’ category.”).

111. *Decatur Fed. Sav. & Loan Ass’n. v. Peach State Fed. Sav. & Loan Ass’n.*, No. C-78-904-A, 1978 WL 21348, at *1 (N.D. Ga., Dec. 29, 1978).

112. *Lahoti v. VeriCheck, Inc. (Lahoti I)*, 586 F.3d 1190, 1195–96 (9th Cir. 2009).

113. *SiLite Inc. v. Creative Bath Prods. Inc.*, 33 U.S.P.Q.2d 1308 (N.D. Ill. 1994).

114. 2 MCCARTHY, *supra* note 49 § 11:66.

115. *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980).

116. The Federal Circuit has opined that “a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories.” *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001).

117. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (quoting RESTATEMENT (FIRST) OF TORTS § 721 cmt. a (1938)).

118. *See Lahoti I*, 586 F.3d at 1197–98; *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 858 (3d Cir. 1992); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1528 (4th Cir. 1984); *Educ. Dev. Corp. v. The Econ. Co.*, 562 F.2d 26, 29 (10th Cir. 1977); *Anheuser-Busch, Inc. v. Holt*, 2009 WL 4086585 (T.T.A.B. Sept. 16, 2009); *see also* Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 738 (2004).

119. *Bone*, *supra* note 25.

120. *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 224 U.S.P.Q. 657 (8th Cir. 1984).

121. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 10 U.S.P.Q.2d 1801 (7th Cir. 1989).

five-year period. One trademark practitioner points out the inexplicability of the PTO's classifying SUPER MOIST as suggestive for cake mix while deeming MOIST SUPREME and MOIST DELUXE merely descriptive for similar products.¹²² Another notes the PTO's bafflingly inconsistent treatment of nineteen similar "The [noun] People" marks for retail, distribution, or educational services,¹²³ including its deeming THE TUNA PEOPLE and THE HARDWARE PEOPLE suggestive and THE SHRIMP PEOPLE and THE TOOL KIT PEOPLE merely descriptive.¹²⁴ The PTO, TTAB, and federal courts have applied a number of formal and informal tests to guide fact-finders in determining distinctiveness. This Part explores each in turn, revealing both their inconsistent application and their inappropriate emphasis on producer creativity and intent rather than consumer perception or competitor speech.

A. *Imagination*

The test used most often to determine whether a mark is merely descriptive, i.e. goods-constative, is known as the imagination test. It asks how much imagination a consumer must use to glean from the word mark a description of the goods or services in question—in other words, how direct and immediate the link is between the mark and a characteristic of the goods.¹²⁵ Under the imagination test, a "term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods."¹²⁶ For example, a district court recently held LOVELY SKIN merely descriptive for skin care products, finding "that no imagination, thought, or perception is needed to reach a conclusion as to the nature of goods sold under the name Lovely Skin. The goods . . . are designed to produce . . . exactly what the name describes."¹²⁷ Another district court held GROUT SHIELD merely descriptive for products that clean grout and enhance its color, opining that it "does not require 'imagination, thought

122. Stephen R. Baird, *Taking the Cake with Suggestive Trademarks?*, DUETS BLOG (Dec. 30, 2009), <http://www.duetsblog.com/2009/12/articles/trademarks/taking-the-cake-withsuggestivetrademarks/>.

123. Morris Turek, *When Trademark Searches Go Wild!*, YOUR TRADEMARK ATTORNEY (Jan. 8, 2012), <http://www.yourtrademarkattorney.com/blog/people-trademarks/>.

124. *Id.*

125. 2 MCCARTHY, *supra* note 49 § 11:67.

126. *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 544 (1st Cir. 1995) (quoting *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1040 (D.C. Cir. 1989)). A Westlaw search for cases containing the phrase "imagination, thought and perception" in the same sentence as the term "suggestive" generates over four hundred results.

127. *Lovely Skin, Inc. v. Ishtar Skin Care Prods., LLC*, No. 8:10CV87, 2012 WL 379930, at *5 (D. Neb. Feb. 6, 2012) (internal quotations and citations omitted).

and perception' to reach a conclusion that plaintiff's products are intended to protect grout."¹²⁸

The Ninth Circuit calls the imagination test the "primary criterion" for evaluating whether a mark is suggestive or descriptive.¹²⁹ Nonetheless, the imagination test is less a test than an application of the definitions of the "descriptive" and "suggestive" categories of marks. Vague and subjective as it appears—a fact-finder purports to measure the extent of imagination a *consumer* would use in gleaning information about goods—courts and the TTAB have held myriad marks suggestive based on the imagination test alone. Yet the test maps poorly onto the speech-act theory of trademarks. Under that theory, if a mark primarily functions to communicate a feature rather than a source, the fact that it requires imagination to glean the description does not necessarily render it source-constative.

A related approach to the imagination test is to conceptualize it as a "multi-stage"¹³⁰ or "inferential"¹³¹ reasoning test, "mental leap,"¹³² or "mental hiccup."¹³³ In accordance with that approach, the TTAB reasoned that

some degree of thought or imagination must be used to get from BRIDAL KEEPSAFE to the concept "keeps bridal gowns safe" [T]here is an element of incompleteness which we believe an individual encountering the mark must interpret in order to arrive at the conclusion that applicant's boxes are used for holding wedding gowns after cleaning.¹³⁴

Based on this logic, a mark is suggestive if a consumer "must exercise 'mature thought or follow a multistage reasoning process' to determine attributes of the product or service" based on the mark.¹³⁵ The mark

128. Grout Shield Distribs., LLC v. Elio E. Salvo, Inc., 824 F. Supp. 2d 389, 409 (E.D.N.Y. 2011). *See also, e.g.*, Half Price Books, Records, Magazines, Inc. v. Barnesandnoble.com, No. Civ. A. 302CV2518-G, 2003 WL 23175436 (N.D. Tex. Aug. 15, 2003) ("The public needs no imagination to conclude from the mark 'Half Price Books' that Half Price sells discounted books.").

129. Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902, 911 (9th Cir. 1995); *Lahoti I*, 586 F.3d 1190, 1198 (4th Cir. 2009).

130. *See* 2 MCCARTHY, *supra* note 49 § 11:71.

131. Tumblebus Inc. v. Cranmer, 399 F.3d 754, 760–61 (6th Cir. 2005).

132. *See* Bone, *supra* note 25 at 2132 (characterizing "the so-called 'leap of imagination' test" as "the most common test used to distinguish descriptive from suggestive marks.").

133. *In re* TCL Govideo, 2006 WL 2558017, at *4–5 (T.T.A.B. 2006) (YOURDVD inherently distinctive for consumer electronic devices).

134. *In re* Cleaner's Supply, Inc., 2003 WL 169796 (T.T.A.B. 2003).

135. Heartland Animal Clinic, P.A. v. Heartland SPCA Animal Med. Clinic, LLC, 861 F. Supp. 2d 1291, 1300 (D. Kan. 2012); *see, e.g.*, Anheuser-Busch, Inc. v. Holt, 2009 WL 4086585, at *7 (T.T.A.B. 2009) ("We find that only after some degree of thought, imagination or a multistage reasoning process would a purchaser encountering beer sold under the mark ONE BEER, BEER 1 believe, if then, that the mark merely describes something specific about applicant's beer."); *In re* Dana

MAILROOM TOOLKIT was found to be distinctive for a toolkit designed to create “‘mailroom friendly’ database programs” on the basis that it “requires imagination or cogitation as an additional mental step in order for applicant’s customers to perceive [w]hat it is.”¹³⁶

Likewise, the TTAB held the mark APPLIANCE STATION suggestive because a multistage reasoning process

is necessary in order to ascertain the precise nature of applicant’s services. . . [S]tation describes the system in applicant’s retail stores by which a customer may order or obtain information about the products sold therein; appliances are among the products sold in applicant’s stores; thus a customer may order or obtain information about the appliances sold in applicant’s stores at the “appliance station.”¹³⁷

Compare the excerpt above with the following discussion from a district court, finding PET PALS merely descriptive for a pet health and safety program based on the imagination test:

The dictionary defines “pal” as “a close friend.” Thus, the literal interpretation of “pet pal” is one who is a friend to his or her pet. It is a common and distinctive quality of friendship to care for and seek the well-being of one’s friend. Thus, it takes no imagination or perception to conclude that a program called “Pet Pals” is one that promotes the well-being of pets.¹³⁸

Multistage reasoning is a concept that, like imagination, seems to contract or expand in order to rationalize what is often an intuition-based result. Yet even if it takes multiple stages to translate “appliance station” into a direct description of the service provided, courts offer no reason to presume that such a multistage process transforms a goods-constative phrase to a source-constative one.

Innovations, 2007 WL 466797 (T.T.A.B. 2007) (“If[,] . . . when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive.”).

136. *In re Satori Software*, 2002 WL 1485321 (T.T.A.B. 2002). *See also, e.g.*, *Marketquest Group, Inc. v. BIC Corp.*, No. 11-CV-618JLS(WMC), 2011 WL 5360899, slip op. at *7 (S.D. Cal. Nov. 7, 2011) (quoting *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 (9th Cir. 1999)) (district court held ALL-IN-ONE not merely descriptive for customized imprinting services on promotional merchandise because it “requires a mental leap from the mark to the product”).

137. *In re Circuit City Stores W. Coast, Inc.*, 1998 WL 611614, at *2 (T.T.A.B. 1998).

138. *P.A.W. Safety Charities v. Petco Animal Supplies, Inc.*, No. CV-0212-P, 2000 WL 284193, at *3 (N.D. Tex. Mar. 15, 2000) (internal citations omitted).

Beyond asking fact-finders to determine whether relevant consumers use multistage reasoning, imagination, cogitation, additional mental steps, or even mere perception, the test provides little concrete guidance. Instead, it supplies the requisite language for courts, the PTO, and the TTAB to justify their determinations post-hoc. Viewed from another angle, some of these decisions appear flat-out wrong: MAILROOM TOOLKIT for a toolkit for creating mailroom programs, BRIDAL KEEPSAFE for a box that keeps a bridal gown safe, and APPLIANCE STATION for a station where appliances are sold not only “convey[] an immediate idea” about the goods or services offered, the goods and services can scarcely be explained without the very words the marks comprise. What would a competitor call a new and better toolkit for creating mailroom programs without risking trademark infringement—SYSTEM FOR CREATING VIRTUAL ROOMS FOR DISTRIBUTION OF MAIL?

When determining whether a word mark is suggestive or merely descriptive, ostensibly “the mentality used is that of an ordinary prospective purchaser who, seeing the mark for the first time, is only generally apprised as to the service and not specifically as to the particular qualities, features, characteristics or aspects of the service.”¹³⁹ In some cases, courts overzealously misapply the imagination test, defining descriptiveness in a way that is too narrow to be meaningful. In one such approach, the viewer attempts to deduce the product from the mark as a test for distinctiveness,¹⁴⁰ deeming a mark merely descriptive only if it describes *all* characteristics of the product in question, rather than one.¹⁴¹ For example, the Eleventh Circuit declined to overturn a jury’s finding that LASERSPECIALIST.COM was suggestive, finding it “requires a leap of the imagination to deduce that a ‘laser specialist’ is a[n] oculoplastic surgeon.”¹⁴² Likewise, the Second Circuit held WET ONES inherently distinctive for individual moist towelettes:

while the plaintiff acknowledged that “Wet Ones is descriptive in the sense that each of the words describes an attribute of the

139. Aetna Health Care Sys., Inc. v. Health Care Choice, Inc., No. 84-C-642-E, 1986 WL 84362, at *15 (N.D. Okla. May 15, 1986); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 699–700 (2d Cir. 1961).

140. See 3 ALTMAN & POLLACK, *supra* note 34 § 18:13 n.44.

141. *E.g.*, Lahoti v. Vericheck, Inc. (*Lahoti II*), 636 F.3d 501, 506 (9th Cir. 2011) (lower court erred when it “seemed to require that, in order to be considered descriptive, the VERICHECK mark would have to describe the ‘broad array of electronic transaction processing services that Vericheck provides.’”).

142. St. Luke’s Cataract & Laser Inst., P.A. v. Sanderson, 573 F.3d 1186, 1208 (11th Cir. 2009); *but see* Fancaster, Inc. v. Comcast Corp., 832 F. Supp. 2d 380, 416 (D.N.J. 2011) (“[W]hile the name ‘fancaster’ may not perfectly describe the nature of each and every video on fancaster.com, it fairly describes certain distinct characteristics of the overwhelming majority of them—namely, a sports or other type of fan broadcasting via a microphone.”).

product—it is wet and it is dispensed one by one [T]he term ‘Wet Ones,’ without more, does not itself conjure up the image of a towelette . . . [but] could plausibly describe a wide variety of products.¹⁴³

The Federal Circuit has also fallen prey to this backward application of the imagination test. In one case it held LOAD-CARRIER was not merely descriptive for load-supporting units for automobiles because it was “equally suggestive of many other things—e.g., wheel barrows, dump trucks, freight cars, steamships, and elevators.”¹⁴⁴

The TTAB appears less prone to engage in this type of reasoning, noting that a descriptiveness refusal does not require

that it is possible for a blindfolded consumer who has been given only the proposed mark to enumerate the exact features, technologies or methodologies employed in the goods. Rather, the question is whether someone who knows what the goods are will understand the term or phrase to convey significant information about them¹⁴⁵

The distinction is crucial, given that fact-finders applying the “blindfold” test would adjudge so few marks descriptive that the test would eviscerate the category of descriptive marks. Under the logic of the Federal Circuit in *Maremont*, DELICIOUS DESSERT for ice cream would not be descriptive because it could refer just as easily to brownies or banana bread as it could to ice cream. It is difficult to posit a real or hypothetical descriptive mark that could pass the “blindfold” test because if a phrase embodies the

143. *Playtex Prods. Inc. v. Ga.-Pac. Corp.*, 390 F.3d 158, 164 (2d Cir. 2004). *See also, e.g.*, *BIC Corp. v. Far E. Source Corp.*, No. 99 Civ. 11385, 2000 U.S. Dist. LEXIS 18226, at *3 (S.D.N.Y. Dec. 19, 2000) (WITE-OUT held suggestive; “[M]ost of the WITE-OUT products are white in color and used to take ‘out’ a mistake. However . . . the phrase without more does not imply a correction product.”); *Field of Screams, LLC v. Olney Boys & Girls Cmty. Sports Ass’n*, No. DKC10-0327, 2011 WL 890501, at *6 (D. Md. Mar. 14, 2011) (FIELD OF SCREAMS inherently distinctive for a Halloween-themed attraction; the mark “does not flatly describe the venue because that venue is alleged to be more than a simple field; rather, it is allegedly an entertainment complex [Screams] might be elicited by any number of things unrelated to a Halloween-themed attraction (such as a rollercoaster, for instance)”).

144. *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 1116–17 (C.C.P.A. 1972).

145. *In re Holmes*, 2004 WL 256176 (T.T.A.B. 2004) (holding INFIDELITYKIT merely descriptive for a kit used in detecting semen); *see also In re Identity Sciences*, 2010 WL 3351820 (T.T.A.B. 2010) (“The proto-typical consumer of our legal test for mere descriptiveness is not blindfolded, but knows full well [the purpose of applicant’s goods.]”); *In re Tower Tech. Inc.*, 64 U.S.P.Q.2d 1314, 1316–17 (T.T.A.B. 2002) (“The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.”), *cited in DuoProSS Meditech Corp. v. Inviro Med. Devs., Ltd. (DuoProSS II)*, 695 F.3d 1247, 1254 (Fed. Cir. 2012).

product so completely as to leave no question about its characteristics, it's likely generic, and if it describes only one or a subset of features, the blindfold test would deem it suggestive.

B. Double Entendre

Courts treat double entendre in a mark as signaling suggestiveness¹⁴⁶ and often categorize marks that employ double entendre as suggestive.¹⁴⁷ In the words of one treatise writer, "If a mark projects a double meaning, it is not merely descriptive."¹⁴⁸ Courts, the PTO, and the TTAB, in assessing inherent distinctiveness, often give a pass to a phrase that qualifies as a double entendre, even when it comprises one or more literally descriptive terms. But double entendres are indicia of mark owner creativity, not consumer perception. Case law offers no evidence that employment of double entendre elevates a mark containing descriptive terms from goods-constative to source-constative.

A "double entendre," old French for "twofold meaning,"¹⁴⁹ is defined as "a word or expression capable of two interpretations"¹⁵⁰ or one "that can be interpreted in two ways."¹⁵¹ The TMEP defines the term as "an expression that has a double connotation or significance as applied to the goods or services."¹⁵² The TTAB has deemed suggestive, based on their use of double entendre, marks including SHEER ELEGANCE for pantyhose;¹⁵³ SUGAR & SPICE for bakery products;¹⁵⁴ THE FARMACY for retail store services relating to dietary supplements and nutrition;¹⁵⁵ THE SOFT PUNCH for a noncarbonated soft drink;¹⁵⁶ NAPSACK for a

146. 3 ALTMAN & POLLACK, *supra* note 34 § 18:15.

147. *E.g.*, *In re Computer Bus. Sys. Grp.*, 229 U.S.P.Q. 859, (T.T.A.B. 1985).

148. 1 TRADE LAW PRAC. FORMS § 8:38.20.

149. *Double entendre*, ONLINE ETYMOLOGY DICTIONARY, http://etymonline.com/index.php?term=double+entendre&allowed_in_frame=0 (last visited Jan. 20, 2014).

150. MERRIAM-WEBSTER ONLINE DICTIONARY, <http://www.merriam-webster.com/dictionary/double+entendre?show=0&t=1390253327> (last visited Jan. 20, 2014).

151. COLLINS ENGLISH DICTIONARY ONLINE, <http://www.collinsdictionary.com/dictionary/english/double-entendre> (last visited Jan. 20, 2014).

152. TMEP § 1213.05(c) (9th ed. Oct. 2013).

153. *No Nonsense Fashions, Inc. v. Consol. Foods Corp.*, 226 U.S.P.Q. 502, 506 (T.T.A.B. 1985) ("Sheer Elegance" for pantyhose suggestive because it describes the texture and also suggests the "ultimate in elegance").

154. *In re Colonial Stores Inc.*, 394 F.2d 549 (C.C.P.A. 1968), *cited in* TMEP § 1213.05(c) (9th ed. Oct. 2013).

155. *In re Tea and Sympathy, Inc.*, 88 U.S.P.Q.2d 1062 (T.T.A.B. 2008), *cited in* TMEP § 1213.05(c) (9th ed. Oct. 2013).

156. *In re Del. Punch Co.*, 186 U.S.P.Q. 63 (T.T.A.B. 1975) (mark "possesses a degree of ingenuity in its phraseology which is evident in the double entendre that it projects"), *cited in* TMEP § 1213.05(c) (9th ed. Oct. 2013).

baby carrier with straps;¹⁵⁷ HAY DOLLY for a dolly for carrying hay;¹⁵⁸ CHIC for jeans;¹⁵⁹ MUFFUNS for mini-muffins;¹⁶⁰ and L'EGGS for pantyhose.¹⁶¹ Federal courts have followed suit, applying the double entendre rule to hold distinctive marks including CHOICE for a health care plan;¹⁶² 100% TIME RELEASE MOISTURIZER for skin moisturizer;¹⁶³ and POLY PITCHER for a pitcher made of polyethylene.¹⁶⁴ A district court credited a double entendre argument sufficiently to leave for a jury the question of whether THE PINT was inherently distinctive for a urinal that only requires one pint of water to flush.¹⁶⁵

Practitioners are well-versed in the double entendre exception¹⁶⁶ and often make a point to assert the existence of a double entendre when arguing before the TTAB or responding to an office action from the PTO, whether or not the word play is an obvious and intended feature of the mark.¹⁶⁷ As one district court explained, “a mark that consists of a double or triple entendre, at least one meaning of which is suggestive, is protectable without proof of secondary meaning.”¹⁶⁸ Some of the courts that apply this rule interpret the phrase “merely descriptive” quite literally to mean “*only* descriptive,” such that the Lanham Act’s prohibition on registering descriptive marks without secondary meaning does not apply if a mark possesses both a descriptive interpretation and an additional, non-descriptive interpretation.¹⁶⁹

157. *In re Happy Baby Carrier Co.*, 179 U.S.P.Q. 864 (T.T.A.B. 1973).

158. *In re Priefert Mfg. Co., Inc.*, 222 U.S.P.Q. 731, 733 (T.T.A.B. 1984).

159. *Henry Siegel Co. v. M & R Int'l Mfg. Co.*, 4 U.S.P.Q.2d 1154, 1159 (T.T.A.B. 1987).

160. *In re Grand Metro. Foodserv. Inc.*, 30 U.S.P.Q.2d 1974, 1975 (T.T.A.B. 1994).

161. *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 465 (4th Cir. 1996).

162. *Aetna Health Care Sys., Inc. v. Health Care Choice, Inc.*, No. 84-C-642-E, 1986 WL 84362, at *16 (N.D. Okla. May 15, 1986) (explaining that the mark CHOICE constituted a double entendre and thus was inherently distinctive or, in the alternative, had acquired secondary meaning).

163. *Estee Lauder, Inc. v. The Gap, Inc.*, 932 F. Supp. 595, 609 (S.D.N.Y. 1996), *rev'd on other grounds*, 108 F.3d 1503 (2d Cir. 1997).

164. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961) (holding that the mark qualified as a double entendre because it was “reminiscent or suggestive of Molly Pitcher of Revolutionary time”).

165. *Zurco, Inc. v. Sloan Valve Co.*, 785 F. Supp. 2d 476, 490–91 (W.D. Pa. 2011).

166. *Joshua M. Dalton & Ilisa Horowitz, Funny When You Think About It: Double Entendres and Trademark Protectability*, 88 J. PAT. & TRADEMARK OFF. SOC'Y 649 (2006).

167. *E.g., In re Art Jewdaica LLC*, 2011 WL 3533289, at *2 (T.T.A.B. Jan. 28, 2011).

168. *Estee Lauder*, 932 F. Supp. at 609. The TMEP recites the same rule, stating that a “mark that comprises [a] ‘double entendre’ will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.” TMEP § 1213.05(c) (9th ed. Oct. 2013).

169. *In re Midmark Corp.*, 2010 WL 667929, at *4 (T.T.A.B. Jan. 25, 2010) (“Section 2(e)(1) prohibits the registration of marks which are ‘merely descriptive’ . . . and [the CCPA has] indicated that ‘merely’ means ‘only.’ Thus . . . if either of the two proposed meanings offered by the examining attorney is not merely descriptive, we must reverse the refusal [to register . . .]” (citation omitted)). *See also Hercules Powder Co. v. Newton*, 266 F. 169, 172 (2d Cir. 1920) (“‘Merely descriptive’ means only descriptive, or nothing more than descriptive.”); BARRY KRAMER & ALLEN D. BRUFKY. 1

C. *Incongruity*

Courts and examining attorneys also treat incongruity as “a strong indication that a mark is suggestive rather than merely descriptive.”¹⁷⁰ A conclusion that a mark is incongruous may result from the unusual combination of two or more words together, in the form of “internally incongruous” marks like REBEL DEBUTANTE for clothing¹⁷¹ or CORPORATE FUEL for business consulting services.¹⁷² Alternatively, it may result from the use of a term or phrase that is unexpected given the goods in question, “contextually incongruous” marks like CRAZY GOOD for toaster pastries¹⁷³ or SNO-RAKE for a tool for removing snow.¹⁷⁴ Fact-finders have identified incongruity based merely on the use of descriptive terms in an unexpected order; the Second Circuit held SEASON-ALL inherently distinctive for aluminum storm windows despite acknowledging that ALL-SEASON would be merely descriptive.¹⁷⁵ Incongruity apparently can lift a mark into the category of suggestive and thus inherently distinctive marks even when the mark comprises words that might be characterized as descriptive or generic in isolation, as in examples like DESIGNERS PLUS+ for sweaters,¹⁷⁶ BRANTREATS for biscuits made with bran,¹⁷⁷ GRAPE RANCH for wine,¹⁷⁸ and PERFECTING SERUM for moisturizer.¹⁷⁹

Incongruity is not considered its own separate test; rather, incongruous marks are usually regarded as suggestive based on the imagination test. For example, the TTAB held SNO-RAKE inherently distinctive for a tool used

TRADEMARK LAW PRACTICE FORMS § 8:38.20 (2d ed. 2002) (citing *In re Quick-Print Copy Shop, Inc.*, 616 F.2d 523 (C.C.P.A. 1980) (“To be ‘merely’ descriptive, the term must be ‘only’ descriptive, i.e., the term serves no purpose other than to describe the goods or services.”)).

170. TMEP § 1209.01(a) (9th ed. Oct. 2013); *see also* 3 ALTMAN & POLLACK, *supra* note 34 § 18:15 (“Common signals of suggestiveness include incongruity[] and double entendre.”); *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 379 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976).

171. *Rebel Debutante LLC v. Forsythe Cosmetic Grp., Ltd.*, 799 F. Supp. 2d 558, 569 (M.D.N.C. 2011) (“[T]he term ‘Rebel Debutante’ on its face appears suggestive, juxtaposing . . . the formal, reserved debutante with rebelliousness.”).

172. *In re Corporate Fuel Partners, LLC*, 2010 WL 3501479, at *1 (T.T.A.B. Aug. 27, 2010).

173. *In re Kellogg N. Am. Co.*, 2008 WL 2675685, at *7, *11 (T.T.A.B. June 30, 2008) (“[T]he incongruity of using [‘crazy’] in connection with ‘good’ indicated that the mark was inherently distinctive for pastries.”).

174. *In re Shutts*, 217 U.S.P.Q. (BNA) 363 (T.T.A.B. 1983), *cited in* TMEP § 1209.01(a) (9th ed. Oct. 2013).

175. *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 316 (2d Cir. 1958).

176. *In re Hampshire-Designers, Inc.*, 199 U.S.P.Q. 383, 384 (T.T.A.B. 1978).

177. *In re YZ Enters., Inc.*, 2000 WL 1125563, at *2 (T.T.A.B. July 28, 2000) (“BRANTREATS is an incongruous term when used in connection with a biscuit made of a cereal by-product.”).

178. *In re Whiteman*, 2005 WL 2543637, at *1 (T.T.A.B. Sept. 28, 2005).

179. *In re Murad*, 2010 WL 667931, at *1 (T.T.A.B. Feb. 4, 2010).

to remove snow, opining that “the idea of a ‘rake’ or ‘raking’ . . . sit[s] strange in terms of application to snow.”¹⁸⁰ It noted that the concept of descriptiveness “should not penalize coinage of . . . incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’”¹⁸¹ The TMEP cites several instructive examples of incongruous marks: TENNIS IN THE ROUND for tennis facilities;¹⁸² FRANKWURST for hot dogs;¹⁸³ TINT TONE for hair coloring;¹⁸⁴ and PARIS BEACH CLUB for t-shirts.¹⁸⁵ Here again, the Board’s analyses give no real reason to expect an incongruous mark will be source-constative without secondary meaning based on use.

D. Creativity Fallacy

The express goal of the fact-finder assessing a mark’s distinctiveness, whether in the context of registration or litigation, is gauging consumer perception of the mark. Yet time and again, trademark examining attorneys, the TTAB, and federal courts are influenced by the perceived creativity of the producer who selected the mark.¹⁸⁶ Of course, corporations often invest substantial money and time into devising the perfect mark; they expect it will serve as a source indicator for their goods, and fact-finders may find themselves itching to reward that investment on a theory of desert or natural rights.¹⁸⁷ But it is inappropriate for producer selection to influence evaluation of a borderline mark.

Fact-finders applying some of the tests and proxies discussed above are often seduced by the “creativity fallacy.” The semantic gymnastics that enable courts to equate “mere” descriptiveness with a determination that a mark has only one descriptive meaning and no other meanings represents

180. *In re Shutts*, 217 U.S.P.Q. 363, 364 (T.T.A.B. Feb. 25, 1983), *cited in* TMEP § 1209.01(a) (9th ed. Oct. 2013).

181. *Id.* at 364–65.

182. *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978), *cited in* TMEP § 1209.01(a) (9th ed. Oct. 2013).

183. *In re Vienna Sausage Mfg. Co.*, 156 U.S.P.Q. 155, 156 (T.T.A.B. 1967), *cited in* TMEP § 1209.01(a) (9th ed. Oct. 2013).

184. *In re John H. Breck, Inc.*, 150 U.S.P.Q. 397, 398 (T.T.A.B. 1966), *cited in* TMEP § 1209.01(a) (9th ed. Oct. 2013).

185. *In re Sharky’s Drygoods Co.*, 23 U.S.P.Q. 2d 1061 (T.T.A.B. 1992), *cited in* TMEP § 1210.01(a) (9th ed. Oct. 2013).

186. *See* Fromer, *supra* note 42, at 1902 (arguing that creativity is more central to trademark law than has been appreciated and “encouraging creativity lies at the heart of trademark law and theory”).

187. *See* Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 482 (2005) (criticizing line of merchandising rights cases as “stem[ming] from the unjust enrichment instinct that ‘if value, then right’”); *see also* Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990), *cited in id.* at 481 n.81.

the creativity fallacy at work.¹⁸⁸ In other cases, fact-finders are unduly swayed by mark owners' use of sophisticated rhetorical devices, from rhyme and allusion to assonance and alliteration. The TTAB, for example, has held not merely descriptive the rhyming marks AIR CARE for maintenance of medical equipment used for administering oxygen,¹⁸⁹ BEST REST for mattresses,¹⁹⁰ ACTION SLACKS for stretchy pants,¹⁹¹ and STRIPE WRITER for pens and markers.¹⁹²

Alliteration has also nudged marks from the category of merely descriptive to that of suggestive for some fact-finders. The TTAB has held distinctive COLOR CARE for laundry bleach that protects colored fabrics,¹⁹³ CLASSIC COLA for a beverage,¹⁹⁴ TINT TONE for hair coloring,¹⁹⁵ MASTER MECHANIC for tools,¹⁹⁶ FAST FEATURE PLATFORM for telecommunications hardware and software,¹⁹⁷ and SNAP SIMPLY SAFER for medical syringes.¹⁹⁸ Characterizing LIGHT 'N LIVELY for yogurt as inherently distinctive, the TTAB credited the mark's "alliterative lilting cadence."¹⁹⁹ Marks that employ metaphor, synecdoche, and related figures of speech, such as CHICKEN OF THE SEA for canned tuna²⁰⁰ and PC ON A STICK for flash drives²⁰¹ have also been deemed inherently distinctive. The Fifth Circuit held EXTEND YOUR BEAUTY suggestive for eyelash extensions, relying in part on a belief that the term

188. Greg Lastowka has identified a "creativity daemon" that overemphasizes creativity at the expense of trademark doctrine, leading in some cases to unexpected and insupportable results. Lastowka, *supra* note 44, at 791.

189. *Airco, Inc. v. Air Prods. & Chems., Inc.*, 196 U.S.P.Q. 832 (T.T.A.B. 1977).

190. *Dreamwell, Ltd. v. Kittrich Corp.*, 2011 WL 1495462 (T.T.A.B. Mar. 29, 2011).

191. *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q.2d 1464, 1471 (T.T.A.B. 1993).

192. *In re JPI Colorworkshop, Inc.*, 2005 WL 1822541, at *1 (T.T.A.B. July 26, 2005); *but see In re Ginc UK Ltd.*, 90 U.S.P.Q.2d 1472, 1477 (T.T.A.B. 2007) (holding that rhyme of ZOGGS TOGGS "does not infuse TOGGS with any separate and distinct meaning apart from its generic meaning").

193. *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791, 792 (T.T.A.B. 1981).

194. *In re Classic Beverage Inc.*, 6 U.S.P.Q.2d 1383, 1387 (T.T.A.B. 1988) (reversing § 2(e)(1) refusal to register).

195. *In re John H. Breck, Inc.*, 150 U.S.P.Q. 397, 398 (T.T.A.B. 1966), *cited in* TMEP §1209.01(a) (9th ed. Oct. 2013).

196. *In re True Value Co.*, 2008 WL 4674589, at *2 (T.T.A.B. Sept. 26, 2008).

197. *In re Siemens Stromberg-Carlson*, 1999 WL 1062812, at *3 (T.T.A.B. Nov. 19, 1999).

198. *Inviro Med. Devices Ltd. v. DuoProSS Meditech Corp. (DuoProSS I)*, No. 92046702, Dkt. 52, at *23 (T.T.A.B. 2011), *rev'd*, *DuoProSS II*, 695 F.3d 1247, 1257 (Fed. Cir. 2012). The Federal Circuit took exception to the TTAB's comment that "the combination of the terms SIMPLY and SAFER 'creates a rhyming pattern that results in a distinctive impression,'" asserting that "[t]he Board's observation about the alliteration . . . [is] not a finding about the commercial impression that the mark conveys to a consumer based on evidence in the record."

199. *In re Kraft, Inc.*, 218 U.S.P.Q. 571, 573 (T.T.A.B. 1983).

200. *Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 977 (C.C.P.A. 1931).

201. *In re Lockheed Martin Corp.*, 2012 WL 5902074, at *5 (T.T.A.B. Nov. 15, 2012) ("The term PC is used elliptically to stand in for 'all of the data and software content of a PC.'").

“beauty serves as a metaphor for eyelashes” and “metaphorical usage means the mark is arguably suggestive.”²⁰²

While the creativity fallacy usually strikes fact-finders unawares, occasionally its application is explicit. The Fifth Circuit characterized its attention to creativity as the converse of the imagination test, suggesting that the selection of a clever mark correlates with the perception that the mark requires consumer imagination:

The imagination test might usefully be reversed by inquiring whether the first user has devised a term of some creativity or cleverness, as opposed to merely selecting a term that anyone might readily have chosen. (Any dunce could come up with a generic term, for example.) Creativity on the part of the mark’s inventor is a correlative of imagination on the part of the consumer.²⁰³

But does “[c]reativity on the part of the mark’s inventor” really correlate with or indicate whether a mark is goods-constative or source-constative? The court gives no reason to believe it does. Whether the marks discussed above are goods-constative or not, focusing on the producer’s mark selection process distracts the court from the ultimate issue of consumer perception. The goals of trademark law are better served when fact-finders focus on consumers and competitors in their evaluations of distinctiveness and registrability.

E. Dictionary

The “dictionary test” refers generally to the practice of considering a mark’s dictionary definitions in gauging its distinctiveness.²⁰⁴ According to the Fifth Circuit, in determining whether a mark is inherently distinctive, “[a] suitable starting place is the dictionary, for [t]he dictionary definition of the word is an appropriate and relevant indication of the ordinary significance and meaning of words to the public.”²⁰⁵ Some define the test more specifically to refer to the question of whether “the mark’s dictionary definition corresponds with its meaning and context,” rendering it merely

202. *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 233 (5th Cir. 2009).

203. *Sec. Ctr., Ltd. v. First Nat’l Sec. Ctrs.*, 750 F.2d 1295, 1299 (5th Cir. 1985).

204. *See Janes v. Watson*, No. SA-05-CA-0473-XR, 2006 WL 2322820, at *5 (W.D. Tex. Aug. 2, 2006) (“The first test [for descriptiveness] is the ‘dictionary test,’ under which the dictionary definition of the mark is considered.”).

205. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792 (5th Cir. 1983), *abrogated by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

descriptive when applied to the mark holder's goods.²⁰⁶ For example, a district court held MICROTHIN merely descriptive for condoms, citing a dictionary that defined the term as "extremely or, sometimes, microscopically thin."²⁰⁷ The court noted that "[d]ictionary definitions are relevant to determining the placement of a mark on the spectrum of generic to fanciful," and in the case of MICROTHIN, the mark "immediately convey[ed] the intended meaning as to the type of condom sold—one that is extremely thin."²⁰⁸

When a mark consists of two or more words, some courts consider the dictionary definition of each component term.²⁰⁹ A district court assessing the distinctiveness of the mark WEBSITE GADGET, for example, cited dictionary definitions for both "gadget" and "website" and concluded that the two terms' definitions were equivalent to the definition of the phrase at issue. The dictionary test thus "indicate[d] ['website gadget'] is a term of ordinary significance and meaning to the public," providing "at least preliminary evidence" of descriptiveness.²¹⁰ Other courts query whether the entire phrase is listed in a dictionary and view its absence as an indication that the mark is not merely descriptive²¹¹ or disregard the test if the phrase is not found.²¹² The Fifth Circuit, considering whether the mark EXTEND

206. *Xtreme Lashes*, 576 F.3d at 232; *see also, e.g., USA Football Inc. v. Robinson*, 74 U.S.P.Q.2d 1646, 1653–61 (S.D. Tex. 2004) (deeming mark "USA Football" merely descriptive and discussing judicial formulations invoked to support descriptiveness, including "the dictionary test"); *Chi. Reader, Inc. v. Metro Coll. Pub. Co.*, 218 U.S.P.Q. 804 (N.D. Ill. 1982), *aff'd*, 711 F.2d 801 (7th Cir. 1983) (court may rely on dictionary for common usage of word); Bone, *supra* note 25, at 2130–35 ("[T]he dictionary test [refers to] looking the word mark up in the dictionary to see if its primary meaning is descriptive of the product . . ."). *But see In re Phase Dynamics, Inc.*, 2010 WL 985332, at *4–5 (T.T.A.B. Mar. 4, 2010) ("Although dictionary evidence may certainly be used to prove a mark is merely descriptive, we are not aware of any case law that actually sets out a 'dictionary test.'"); *Sec. Ctr.*, 750 F.2d at 1298 n.4 ("Dictionaries lag behind linguistic realities . . . so the dictionary test may be of questionable validity in many instances.").

207. *Church & Dwight Co., Inc. v. Mayer Labs., Inc.*, 868 F. Supp. 2d 876, 925 (N.D. Cal. 2012).

208. *Id.*

209. *E.g., Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1015 n.11 (9th Cir. 1979); *In re World Internet Inc.*, 2007 WL 1620775, at *8 (T.T.A.B. May 31, 2007) (holding WORLD INTERNET SUMMIT merely descriptive for Internet marketing seminars).

210. *Firefly Digital Inc. v. Google Inc.*, 817 F. Supp. 2d 846, 862 (W.D. La. 2011) (internal quotation marks omitted).

211. A TTAB panel held CRAZY GOOD suggestive for toaster pastries in *In re Kellogg*, 2008 WL 2675685, at *13 (T.T.A.B. June 30, 2008). In his concurring opinion, Judge Bucher applied the dictionary test to the entire phrase and counted its absence as evidence of distinctiveness. *See also In re Strategic Weather Servs., LP*, 2000 WL 1853498, at *3 (T.T.A.B. Nov. 30, 2000) (applicant argued that the absence from dictionaries of composite terms including "boatingweather," "fishingweather," and "golfweather" suggested the marks were not merely descriptive; Board reversed refusal for eleven of the seventeen marks).

212. *Blenco, Inc. v. Conagra Foods, Inc.*, 132 F. App'x 520, 521–22 (5th Cir. 2005). *See also Janes v. Watson*, No. SA-05-CA-0473-XR, 2006 WL 2322820, at *5 (W.D. Tex. Aug. 2, 2006) ("Because 'FineArtStudioOnline' is not a standard dictionary term, [the dictionary] test is inapplicable."). *But see In re Petroglyph Games Inc.*, 91 U.S.P.Q.2d 1332, 1341, (T.T.A.B. 2009) (Where the component terms "battle" and "cam(era)" were descriptive for the goods at issue, "the

YOUR BEAUTY was descriptive or distinctive for eyelash extensions, found the dictionary test weighed toward suggestiveness because “[t]he three-word mark, viewed as a whole, has no dictionary meaning.”²¹³ The same court, evaluating the distinctiveness of the mark BETTER-N-BUTTER, recalled the ‘dictionary test’ it applied in *Zatarains*, but concluded it was “inapplicable because ‘Better-N-Butter’ is not a standard dictionary term.”²¹⁴

Dictionary definitions of a mark’s component terms may have some relevance in determining whether a mark is goods-constative or source-constative, as discussed further below. But a dictionary alone does not suffice to establish contemporary usage by consumers and competitors. To better measure whether a given term is used descriptively by a particular group or within a specific industry, fact-finders should consider sources such as consumer reviews, auction websites, search engine queries, social networking platforms, reader comments in response to media coverage, and online message boards, which provide a more complete understanding of a term’s meaning to the relevant public.

F. Competitors’ Need

The “competitors’ need” test²¹⁵ evaluates the extent to which a term or phrase is needed by competitors to identify their goods or services. For example, the mark WEBSITE GADGET was deemed merely descriptive in part because the district court deemed the component terms “virtually indispensable to the vocabulary of the website industry.”²¹⁶ According to McCarthy, if a trademark conveys a message about goods that is “so direct and clear that competing sellers would be likely to need to use the term in describing their goods in advertising and promotion,” it indicates that the mark is merely descriptive.²¹⁷ Conversely, if competitors do not need the

absence of [the composite term] BATTLECAM from the dictionary . . . does not dictate, as applicant contends, that we find the term to be a fanciful mark, rather than a descriptive term.” (citation omitted)).

213. *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 233 (5th Cir. 2009). *But see In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694 (T.T.A.B. 2002) (WORKMASK found descriptive despite absence from dictionaries); *In re Energy Prods. of Idaho*, 13 U.S.P.Q.2d 2049, 2052 (T.T.A.B. 1989) (“The absence of [WASTE-TO-ENERGY] from the dictionary is not, contrary to applicant’s argument, ‘persuasive evidence’ that the term is not merely descriptive of applicant’s services.”); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564 (Fed. Cir. 1987) (absence of term “sweats” from dictionary insufficient to preclude summary judgment “in the face of the strong evidence showing that ‘sweats’ is commonly used as a descriptive name for . . . sweatshirts and sweatpants.”).

214. *Blendco*, 132 F. App’x at 521–22.

215. This test has also been called the “competition test” or “the necessity standard.”

216. *Firefly Digital Inc. v. Google Inc.*, 817 F. Supp. 2d 846, 862 (W.D. La. 2011).

217. 2 MCCARTHY, *supra* note 49 § 11:68; *see also Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 793 (5th Cir. 1983) (finding competitors would need to use the phrase “fish fry” to describe batter for use in frying fish).

term or phrase to describe their goods, the mark is less likely to be descriptive. Some courts have asserted an inverse relationship between the imagination test and the competitors' need test: the more imagination required to deduce characteristics of the goods or services, the less likely competitors need to use the same terms within their own trademarks.²¹⁸

Of the existing tests for descriptiveness, the competitors' need test comes closest to considering offensive use against competitors and is most closely aligned with the test this Article proposes. Its fatal flaw lies in construing narrowly the question of whether competitors *need* to use the term or terms in describing their goods and services²¹⁹—whether they are “indispensable to the industry”²²⁰—rather than whether competitors might choose to use the terms or ought to be free to use them. The Ninth Circuit in *Zobmondo*, for example, applied the competitors' need test in determining whether the mark WOULD YOU RATHER . . . ? is merely descriptive for a board game that asks players to choose between two alternative scenarios. The court found the mark distinctive because “competitors do not *need* to use ‘WOULD YOU RATHER . . . ?’ to describe their products. They can say ‘Would you prefer’ or ‘Would you most like’ or use some other verbal formula to convey a choice of alternatives.”²²¹ Of course, WOULD YOU MOST LIKE is a rather artless name for a game. Requiring a second-comer to sidestep straightforward terms that describe its goods when the senior user has not instilled those terms with a source-indicating function does not seem justifiable based on the policy goal of avoiding consumer confusion. It simply rewards the first mover for primacy. Protecting descriptive terms without secondary meaning triggers concerns about the land-grab nature of trademark registration.

Another of the pitfalls of the competitors' need test is that courts applying it, like those applying the dictionary test, often consider a phrase in its entirety rather than asking whether competitors might need to use one or more component terms to describe their goods. The Fifth Circuit in *Blendco* deemed the mark BETTER-N-BUTTER for butter-flavored oil suggestive in part because competitors “would not likely need or even find

218. *Miss World (UK), Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988); *see also Marketquest Grp., Inc. v. BIC Corp.*, No. 11-CV-618JLS(WMC), 2011 WL 5360899, at *7 (S.D. Cal. Nov. 7, 2011).

219. *E.g., In re Kellogg N. Am., Co.*, 2008 WL 2675685, at *14 (T.T.A.B. June 30, 2008); *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1118 (9th Cir. 2010); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1034 (9th Cir. 2010); *Reynolds Metals Co.*, 480 F.2d 902 (C.C.P.A. 1973); *Marketquest*, 2011 WL 5360899, at *7.

220. *Ice Cold Auto Air of Clearwater, Inc. v. Cold Air & Accessories, Inc.*, 828 F. Supp. 925, 933 (M.D. Fla. 1993).

221. *Zobmondo*, 602 F.3d at 1118 (reversing summary judgment, finding issue of fact remained as to mark's distinctiveness) (emphasis added).

useful the exact term ‘Better-N-Butter’ or a similar term in its name. ‘Liquid margarine,’ ‘buttery blend,’ ‘I can’t believe it’s not butter,’ or many other terms could be used.”²²² Given the richness of the English language, fact-finders who want to offer synonyms for competitors’ use will always be able to do so unless the mark or its components are actually generic.²²³ As the *Zobmondo* and *Blendco* courts make abundantly clear, hypothetical trademarks for potential competitors always exist, although they may be less appealing or effective than the marks at issue. Laudatory terms, for example, will always fail the competitors’ need test due to the wealth of alternative laudatory words.

Members of Congress considered competitors’ needs in the context of the fair use defense to allegations of trademark infringement²²⁴ and reached a similar conclusion. Where a prior draft of the law suggested that fair use required necessity, a committee member from the House of Representatives articulated the problem of requiring that an infringement defendant show he *needed* to employ a particular term to describe his own goods, rather than that he merely chose to do so:

If, for example, someone should register the term “jackknife,” and secure an incontestable right after five years’ continuous use, and somebody else came along and in a normal way in his business used the term “jackknife” and this man sued him, and the defendant said, “Why, I am just using the English language,” the plaintiff could say, “No; under this provision here you cannot use that term “jackknife” because I have an incontestable right in it.” “But,” he says, “I am not using it as a trademark. I am using it in a normal way to describe this product.” And the plaintiff says, “But it is not necessary to use that word to truthfully describe it. You can use ‘Pocket knife.’” Now, if you go along that line and somebody else registers “pocket knife,” it would not be long until that man would have a lot of trouble describing his product.²²⁵

222. *Blendco, Inc. v. Conagra Foods, Inc.*, 132 F. App’x 520, 522 (5th Cir. 2005).

223. Even generic terms may have synonyms, as several courts have acknowledged. *See, e.g.*, *Loctite Corp. v. Nat’l Starch and Chem. Corp.*, 516 F. Supp. 190 (S.D.N.Y. 1981) (that synonyms exist for a generic or descriptive term, such as “instant glue” or “ten second glue” for “super glue,” does not establish that Super Glue is not generic or descriptive); *In re Diamond Comm’n Prods. Inc.*, 1999 WL 180802, at *1 (T.T.A.B. Mar. 30, 1999) (“That other generic words like ‘strap’ or ‘fastener’ might also be used to name such products does not make ‘cable tie’ or its equivalent any less generic.”).

224. 15 U.S.C. § 1115(b)(4) (2006). The Supreme Court has summarized the four elements of statutory fair use as “the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004).

225. *Hearings on H.R. 102, H.R. 5461, and S. 895 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 77th Cong. 67 (1941), cited in 4 ALTMAN & POLLACK, *supra* note 34 § 22:64.

That “jackknife” has not only a finite number of synonyms but a very small number, and that it is a noun rather than an adjective, suggests the possibility that it is generic, rather than descriptive. Yet the same principle applies to flatly descriptive terms like “tasty” for food products, “miracle” for slimming apparel, or “non-stick” for cookware. Whether a given concept has three synonyms or three hundred, a mark owner should not be able to corner the market on a descriptive term and exclude competitors from using it unless and until he can establish that the once goods-constative term has become source-constative.

G. Competitors’ Use

The “competitors’ use” test, also called the “actual use,” “common use,” or “extent-of-use” test, asks whether others marketing similar goods or services already use the designation; if they do, the mark is more likely to be found descriptive.²²⁶ The competitors’ use and competitors’ needs test are complementary²²⁷—just as actual confusion between two marks is regarded as strong evidence of likelihood of confusion in an infringement analysis, actual use by competitors is regarded as an indication of competitor need.

The Fifth Circuit discussed the policy underlying the competitors’ use test in assessing the mark SECURITY CENTER:

We look into actual and likely use of a mark in order to determine whether its protection, i.e., its exclusion from the language freely available for commercial use, interferes with competition among providers of the same product or service. The more users there are of a term, the more its protection in a given case would be commercially disruptive and unfair to competitors.²²⁸

226. *E.g.*, *Sec. Ctr., Ltd. v. First Nat. Sec. Ctr.*, 750 F.2d 1295, 1300 (characterizing “security center” as descriptive in part based on “the number of enterprises throughout the nation that use ‘security center’ in some form”); *Fortune Dynamic v. Victoria Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1034 (9th Cir. 2009) (“[W]e are aware of no other shoe companies . . . that use the word ‘delicious’ to describe their product”); *Peoples Fed. Sav. Bank v. People’s United Bank*, 672 F.3d 1, 6 (1st Cir. 2012) (“[F]requent use of the term ‘People’ in connection with banking services cuts in favor of defining the mark as descriptive. . . . ‘[P]eople’ ranks as the twelfth most commonly used word in bank names on the FDIC’s website, appearing in the names of 159 banks in the United States.”); *In re Panera*, 2002 WL 31536505, at *2–3 (T.T.A.B. 2002).

227. Courts often consider both tests together or treat the dual considerations as two halves of the same test. *See, e.g.*, *Sec. Ctr.*, 750 F.2d at 1300 (“We turn now to the issue whether those engaged in similar businesses have used the phrase, or are likely to do so.”); *In re Siemens Stromberg-Carlson*, 1999 WL 1062812, at *3 (T.T.A.B. 1999).

228. *Sec. Ctr.*, 750 F.2d at 1300.

Like the competitors' need test, the competitors' use test is often applied too narrowly to preserve the ability of future competitors to rely on descriptive terms. The TTAB found the competitors' use test supported reversal of the USPTO determination that the mark CRAZY GOOD was merely descriptive for baked goods. In so doing, the Board interpreted the test to implicate only uses of the phrase by competitors selling the very same type of goods as the applicant and ignored uses in connection with other types of goods.²²⁹ The TTAB deemed the mark suggestive even though the record showed that "several sellers of other, largely unrelated products may have made trademark use of this term."²³⁰ Such an interpretation is problematic for terms of praise or superiority that could be applied to a variety of goods and services. The use of "crazy good" as slang for "great" by third parties, even if they are non-competitors, indicates that the phrase is laudatory and thus merely descriptive for all goods. Other marks that are not technically descriptive of goods have been deemed insufficiently distinctive based on competitors' use, such as PEOPLES for banks,²³¹ LABRADOR for software,²³² BLISS for beauty salons or spas,²³³ and puns that play on the term SHEAR for hair cutting services.²³⁴

The competitors' use test will also fall short when the mark at issue is used by the first producer to launch or popularize novel goods, such as APP STORE for an online store selling wireless applications,²³⁵

229. *In re Kellogg N. Am. Co.*, 2008 WL 2675685, at *14 (T.T.A.B. 2008); *see also* Heartland Animal Clinic, P.A. v. Heartland SPCA Animal Med. Clinic, LLC, 861 F. Supp. 2d 1293 (D. Kan. 2012) (holding HEARTLAND ANIMAL CLINIC suggestive for veterinary services even though Google Maps and local phonebook showed hundreds of businesses using "heartland" in geographic area).

230. *In re Kellogg*, 2008 WL 2675685, at *14.

231. *Peoples Fed. Sav. Bank v. People's United Bank*, 672 F.3d 1, 15 (1st Cir. 2012) (PEOPLES merely descriptive for banking services).

232. *Labrador Software, Inc. v. Lyvos, Inc.*, 32 F. Supp. 2d 31, 33 (D. Mass. 1999) (holding LABRADOR marks and dog images descriptive for information retrieval software in light of frequent use by competitors of terms "Labrador" and "retriever").

233. *Bliss Salon Day Spa v. Bliss World LLC*, 268 F.3d 494, 498 (7th Cir. 2001) (affirming denial of injunctive relief for Bliss Salon against Bliss World, noting that "BLISS marks are a glut on the market in hair styling and beauty care.>").

234. *Pullan v. Fulbright*, 287 Ark. 21, 23 (Ark. 1985) (SHEAR PLEASURE descriptive for hair salon).

235. U.S. Trademark Application Serial No. 77,525,433 (filed July 17, 2008). Apple initially attempted to register APP STORE under § 2(e) but was unable to persuade the trademark examining attorney that the mark was inherently distinctive for the services in question. *See* Office Action from U.S. Patent and Trademark Office to Apple, Inc. (Sept. 24, 2008), *available at* TSDR, tsdr.uspto.gov (search "77525433," click "DOCUMENTS," click "Sep. 24, 2008 Offc Action Outgoing"); Response to Office Action from Apple, Inc. to U.S. Patent and Trademark Office (Feb. 18, 2009), *available at* TSDR, tsdr.uspto.gov (search "77525433," click "DOCUMENTS," click "Feb. 18, 2009 Response to Office Action"); Office Action from U.S. Patent and Trademark Office to Apple, Inc. (Mar. 19, 2009), *available at* TSDR, tsdr.uspto.gov (search "77525433," click "DOCUMENTS," click "Mar. 19, 2009 Offc Action Outgoing").

BLUBLOCKER for sunglasses that block blue light,²³⁶ or BEANIE BABIES²³⁷ for plush animals stuffed with pellets. Some courts have thus rightly questioned the premise that competitors' non-use of a term indicates or reflects consumer perceptions.²³⁸ As with the other tests, the competitors' use test offers no evidence that consumers will understand a descriptive mark as goods-constative simply because others don't use the same mark. When numerous competitors use the same terms on similar goods—as Murad, Guerlain, Kinerase, and Lancome all use “perfecting serum” in connection with competing cosmetic products—it provides evidence that the phrase is goods-constative, but we have no reason to believe the converse also holds true. Use by competitors may therefore be helpful in *disproving* distinctiveness, but its mere absence does not prove a mark source-constative.

H. Puffing

It seems reasonable that terms and phrases that are either needed by competitors or are actually used by them should not receive protection without secondary meaning. Those tests will not, however, filter out all goods-constative terms. Laudatory or “puffing” marks are widely recognized as merely descriptive,²³⁹ even where competitors do not use, and do not necessarily need to use, the same laudatory terms that their competitors use to describe competing products. The Trademark Manual of Examining Procedure provides that “[l]audatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under [§ 2(e)(1)].”²⁴⁰ The Federal Circuit regularly applied the same rule, holding that “[m]arks that are merely laudatory and descriptive of the alleged merit of a product” are not inherently distinctive; “puffing marks are regarded as a condensed form of describing the character or quality of the goods.”²⁴¹ In one recent case, the Federal Circuit reversed the TTAB and held that it

236. BLUBLOCKER, Registration No. 1,504,627. BLUBLOCKER was registered based on a § 2(f) showing of acquired distinctiveness.

237. BEANIE BABIES, Registration No. 2,049,196. BEANIE BABIES was registered under § 2(e).

238. *E.g.*, Decatur Fed. Sav. & Loan Assoc. v. Peach State Fed. Sav. & Loan Assoc., No. C-78-904-A, 1978 WL 21348, at *1 (N.D. Ga., Dec. 29, 1978).

239. *But see* Gary J. Sosinsky, Note, *Laudatory Terms in Trademark Law: Square Pegs in Round Holes*, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 725, 729 (1999) (observing courts' inconsistency in proposing laudatory terms be treated as “suggestive in a literal sense yet needing secondary meaning to be protected”).

240. Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1045 n.39 (2009).

241. *In re Bos. Beer Co.*, 198 F.3d 1370, 1373 (Fed. Cir. 1999) (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 11:17 (4th ed. 1996)); *see also* Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 1360 (Fed. Cir. 2001).

“legally erred when it concluded that puffery could render [a particular] mark more than descriptive.”²⁴²

Puffing marks include terms like “best,” “superior,” and “preferred.”²⁴³ The TMEP cites exemplars including THE BEST BEER IN AMERICA for beer;²⁴⁴ THE ULTIMATE BIKE RACK for bike racks;²⁴⁵ QUESO QUESADILLA SUPREME for cheese;²⁴⁶ and ORIGINAL BLEND for cat food.²⁴⁷ Numerous federal courts purport to apply the same rule; the Ninth Circuit opined that when a word mark constitutes “self-laudatory advertising,” that advertising weighs against a finding that the mark is suggestive,²⁴⁸ while an S.D.N.Y. opinion states definitively that “laudatory and descriptive words . . . do not qualify for trademark protection.”²⁴⁹ Other laudatory marks held merely descriptive include SUPER LAUNDRY for laundry-related services;²⁵⁰ NUMBER ONE IN FLOORCARE for vacuum cleaners;²⁵¹ TASTEMAKERS for a publication;²⁵² TRADITIONAL for feta cheese;²⁵³ and THE GREATEST BAR for bar and restaurant services.²⁵⁴

Categorizing laudatory marks as descriptive appears to comport with the various tests used to determine distinctiveness—laudatory terms purport to directly describe the goods or services (whether they do so accurately or not). Laudatory marks convey their desired message without requiring much imagination; competitors often use the same terms for their own products; and laudatory terms should remain “freely available to all competitors in any given field to refer to their products or services.”²⁵⁵ Ultimately, though, the “rule” cannot accurately guide applicants and litigants in predicting outcomes, because the same courts that recite it

242. *DuoProSS II*, 695 F.3d 1247, 1256 (Fed. Cir. 2012) (“[O]ur precedent clearly indicate[s] that puffing . . . is more likely to render a mark merely descriptive . . .”).

243. *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1117 (6th Cir. 1996) (district court erred in holding CHAMPIONS arbitrary for golf club services).

244. *In re Bos. Beer Co.*, 47 U.S.P.Q.2d 1914 (T.T.A.B. 1998), *aff'd*, 198 F.3d 1370 (Fed. Cir. 1999); TMEP § 1209.03(k) (9th ed. Oct. 2013).

245. *In re Nett Designs, Inc.*, 236 F.3d 1339 (Fed. Cir. 2001); TMEP § 1209.03(k) (9th ed. Oct. 2013).

246. *In re Dos Padres Inc.*, 49 U.S.P.Q.2d 1860 (T.T.A.B. 1998); TMEP § 1209.03(k) (9th ed. Oct. 2013).

247. *Gen. Foods Corp. v. Ralston Purina Co.*, 220 U.S.P.Q. 990 (T.T.A.B. 1984); TMEP § 1209.03(k) (9th ed. Oct. 2013).

248. *Fortune Dynamic v. Victoria’s Secret Stores Brand Mgmt.*, 618 F.3d 1025, 1034 (9th Cir. 2009).

249. *Eaton Allen Corp. v. Paco Impressions Corp.*, 405 F. Supp. 530, 532–33 (S.D.N.Y. 1975).

250. *In re Coinmach Corp.*, 2002 WL 31651718 (T.T.A.B. 2002).

251. *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357 (Fed. Cir. 2001).

252. *Advance Magazine Pubs., Inc. v. Norris*, No. 04 Civ. 7877 (RJS), 2008 WL 5336468 (S.D.N.Y. Dec. 15, 2008).

253. *Kangadis, Inc. v. Euphrates, Inc.*, 378 F. Supp. 2d 162 (E.D.N.Y. 2005).

254. *In re The Place Inc.*, 76 U.S.P.Q.2d 1467 (T.T.A.B. 2005).

255. *In re Boston Beer Co.*, 198 F.3d 1370, 1372 (Fed. Cir. 1999) (quoting the TTAB’s decision and affirming refusal to register THE BEST BEER IN AMERICA for beer).

regularly defy it. In recent years, the following apparently—often admittedly—laudatory marks have been held inherently distinctive: BEER 1 for beer;²⁵⁶ SUPER IRON for iron supplements for soil;²⁵⁷ RAPID-SHAVE for shaving cream;²⁵⁸ HEARTWISE for low-cholesterol foods;²⁵⁹ MASTER MECHANIC for tools;²⁶⁰ BEST REST for mattresses;²⁶¹ BETTER-N-BUTTER for a butter substitute;²⁶² ULTRACATH for catheters;²⁶³ and STEAK UMM for meat.²⁶⁴ The general rule that laudatory marks are not inherently distinctive is consistent with the speech-act theory of distinctiveness, but the problem lies in fact-finders' lack of adherence to it.

I. *Intentional Fallacy*

The creativity fallacy has a counterpart in the intentional fallacy.²⁶⁵ Theoretically, as the Third Circuit has noted, “In classifying a mark, the Court does not look to the intent of the party choosing that mark. Instead, the impact of the mark on the minds of prospective consumers is controlling.”²⁶⁶ Nonetheless, a number of courts and boards seeking to determine whether a mark is inherently distinctive or merely descriptive have explicitly weighed the intent of the mark owner in selecting the mark,

256. *Anheuser-Busch, Inc. v. Holt*, No. 91180119, 2009 WL 4086585 (T.T.A.B. 2009).

257. *In re Occidental Petroleum Corp.*, 167 U.S.P.Q. 128 (T.T.A.B. 1970).

258. *Colgate-Palmolive Co. v. House for Men, Inc.*, 143 U.S.P.Q. 159 (T.T.A.B. 1964).

259. *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1435 (S.D. Ohio 1990).

260. *In re True Value Co.*, 2008 WL 4674589, at *1 (T.T.A.B. Sept. 26, 2008).

261. *Dreamwell, Ltd. v. Kittrich Corp.*, No. 91188186, 2011 WL 1495462, at *7 (T.T.A.B. Mar. 29, 2011) (dismissing § 2(e)(1) opposition).

262. *Blendco, Inc. v. Conagra Foods, Inc.*, 132 F. App'x 520, 522 (5th Cir. 2005).

263. *In re Advanced Neuromodulation Sys., Inc.*, 2006 WL 2850875, at *5 (T.T.A.B. Sept. 14, 2006) (holding the mark inherently distinctive while acknowledging the “unmistakable feeling of puffery”).

264. *Steak Umm Co. v. Steak 'Em Up, Inc.*, 868 F. Supp. 2d 415, 422 (E.D. Pa. 2012) (“[T]he word ‘Umm’ sounds like ‘mmm,’ a suggestion that the [steak] tastes good.”).

265. “Intentional fallacy” is a term used in literary criticism to describe the practice of interpreting a work of art based on the intent or purpose of its creator, “the popular belief that to know what the author intended . . . was to know the correct interpretation of the work.” *ENCYCLOPEDIA BRITANNICA, Intentional Fallacy*, available at <http://www.britannica.com/EBchecked/topic/289889/intentional-fallacy>. For a related discussion, see Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS U. L.J. 781, 782 (2008) (“[T]he meaning of a trademark is, at heart, an interpretive exercise, and as reader-response theory tells us, there is no reason to prefer any particular interpretation of a text over any other, least of all the author’s.”).

266. *Steak Umm Co.*, 868 F. Supp. 2d at 427; *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000). See also Thomas L. Casagrande, *A Verdict for Your Thoughts? Why an Accused Trademark Infringer’s Intent Has No Place in Likelihood of Confusion Analysis*, 101 TRADEMARK REP. 1447, 1465 (2011) (noting that in the infringement context, courts, commentators, and the Restatement have acknowledged that the alleged infringer’s intent is “imperceptible to the ordinary consumer, and, therefore has no bearing on what that consumer perceives in the marketplace and whether he or she is likely to be confused.”).

using intent as a proxy for consumer perception. Underlying the intentional fallacy is the rationale that “if the proponent of trademark status himself uses the mark as a descriptive term, [it] is strong evidence of descriptiveness,”²⁶⁷ and perhaps vice-versa.

Evidence of the intentional fallacy abounds. The First Circuit found “5 Minute” epoxy descriptive based in part on testimony by the company’s president that “he called his product ‘5 Minute’ epoxy because [the company was] trying to give the customer an idea that it sets up in about five minutes’ time.”²⁶⁸ A district court in the same circuit held UNLEASHED merely descriptive for dog-walking services, citing the defendant’s statement that “‘Unleashed’ was meant to be ‘a description of what we were doing and what we felt described the services and products we offered.’”²⁶⁹ Another district court held SINU CLEANSE merely descriptive based on testimony that the company selected the mark because it “described better the cleaning or cleansing process.”²⁷⁰ Yet another based its finding of descriptiveness in part on deposition testimony that the mark owner considered the mark descriptive.²⁷¹

While it may seem rational to be guided by a company’s understanding of its own mark in determining that mark’s distinctiveness, that consideration offers no insight as to whether a mark is goods-constative or source-constative to consumers. The intentional and creativity fallacies exemplify the “uptake error”: just as some performatives require audience reaction, a mark cannot be source-constative without consumers perceiving it as an indication of source. A term or phrase is not an effective or ineffective trademark as a result of the wishes or mental processes of the person who devised it, but only as a result of how consumers view it.

IV. THE SPEECH-ACT TEST FOR INHERENT DISTINCTIVENESS

The tests discussed in the preceding section fail because they privilege producers’ interests over those of competitors, because they inappropriately reward producers for creating clever word combinations out of descriptive and generic terms, and because they are simply too vague and ill-defined to provide clear and consistent guidance to courts, the TTAB, trademark examining attorneys, and new entrants. The speech-act test for inherent distinctiveness offers a single question that prizes competition and clarity

267. *Unleashed Doggie Day Care, LLC v. Petco Animal Supplies Stores, Inc.*, 828 F. Supp. 2d 384, 391 (D. Mass. 2010) (citing 2 MCCARTHY, *supra* note 49 § 11:69).

268. *Devcon Corp. v. Woodhill Chem. Sales Corp.*, 455 F.2d 830, 832 (1st Cir. 1972).

269. *Unleashed Doggie Day Care, LLC*, 828 F. Supp. 2d at 391.

270. *Water Pik, Inc. v. Med-Sys., Inc.*, 848 F. Supp. 2d 1262, 1277 (D. Colo. 2012).

271. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1256 (Fed. Cir. 2012); *Firefly Digital Inc. v. Google Inc.*, 817 F. Supp. 2d 846, 862 (W.D. La. 2011).

and directs fact-finders' attention to contemporary consumer usage of descriptive terms. It simply asks whether a hypothetical competitor could use one or more of the trademark's component terms in good faith to describe its own product if the term is defined in accordance with contemporary usage. This test borrows from existing fair use doctrine to bring fair use concerns to the forefront of the distinctiveness analysis. I first describe the fair use defense and then propose an adaptation to remedy the above-described pathologies of existing approaches.

A. *The Statutory Fair Use Defense*

Section 33(b)(4) of the Lanham Act provides a fair use defense to an allegation of infringement where "the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party."²⁷² A junior user charged with trademark infringement who pleads statutory fair use²⁷³ argues that the word or phrase is used to describe the product, geographic origin, creator, or some other aspect of the junior user's goods or services and not used as a mark.²⁷⁴ For example, when a party described its comfortable women's dress shoe by telling consumers that the shoe "feels like a sneaker," the Second Circuit affirmed that such a descriptive use did not infringe plaintiff's registered mark LOOKS LIKE A PUMP, FEELS LIKE A SNEAKER because the defendant's use qualified as a fair use under the Lanham Act.²⁷⁵ Likewise, the Seventh Circuit held that the use of the term "sweet-tart" to describe the flavor of cranberry juice did not infringe the trademark SWEETARTS for candy,²⁷⁶ and the Fifth Circuit held a defendant's use of "fish fry" to describe a batter coating for fish non-

272. 15 U.S.C. § 1115(b)(4) (2006). The defense has been recognized at common law and under § 43(a) of the Lanham Act, with respect to both registered and unregistered trademarks. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 cmt. a (1995); see also Margreth Barrett, *Reconciling Fair Use and Trademark Use*, 28 CARDOZO ARTS & ENT. L.J. 1, 47 (2010) ("Courts and commentators routinely note that the Lanham Act fair use defense is substantively equivalent to the common-law 'use for secondary meaning' limitation . . .").

273. This type of use is also called "classic" or "descriptive" fair use.

274. See Peter M. Brody & Alexandra J. Roberts, *What's in a Domain Name? Nominative Fair Use Online After Toyota v. Tabari*, 100 TRADEMARK REP. 1290, 1292 (2010); see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12 (2d Cir. 1976).

275. *U.S. Shoe Corp. v. Brown Grp., Inc.*, 740 F. Supp. 196, 198 (S.D.N.Y. 1990), *aff'd*, 923 F.2d 844 (2d Cir. 1990); see also Barrett, *supra* note 272, at 47 (citing *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir. 1995) ("[E]ven if the word or symbol is inherently distinctive as to the plaintiff's goods or services, a defendant may still use it fairly to describe its own" goods or services.)).

276. *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1061 (7th Cir. 1995).

infringing, despite the plaintiff's rights in the mark FISH-FRI for a competing batter.²⁷⁷

Courts have construed the statutory fair use defense to comprise three elements: the defendant must use the term or phrase (1) other than as a trademark or service mark; (2) "fairly and in good faith"; and (3) "only to describe" its goods or services.²⁷⁸ Thus, in considering whether the use of the phrase "thirst aid" as part of the slogan "Gatorade is thirst aid" infringed the plaintiff's THIRST AID trademark, the Seventh Circuit considered the prominence of the phrase and the use of rhyme in creating a catchy slogan and held that the defendant's use of "thirst aid" constituted use as a mark, rendering the defendant ineligible for the fair use defense because its use failed to satisfy the first element of the test.²⁷⁹ The good faith required by the second element has been interpreted to require that the defendant did not intend to create source confusion or capitalize on the plaintiff's goodwill.²⁸⁰

The third element, whether a mark is used to describe the goods, is construed broadly. According to McCarthy, a fair use defendant's use of a term "need not literally describe a characteristic of the goods, but can fit within the defense if its use is descriptive in a broader sense."²⁸¹ For example, the Second Circuit held that a lipstick seller could use the phrase "Seal it with a kiss!" on a countertop display that invited consumers to kiss a postcard without infringing on plaintiff's trademark SEALED WITH A KISS for lip gloss.²⁸² Likewise, the maker of beauty products could use "love potion" to describe the effects of its products on others without infringing the plaintiff's mark LOVE POTION for perfume.²⁸³ The Ninth Circuit held an apparel manufacturer could sell tank tops featuring the word "delicious" without infringing plaintiff's mark DELICIOUS for shoes.²⁸⁴

277. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792 (5th Cir. 1983), *abrogated by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

278. *Seaboard Seed Co. v. Bemis Co.*, 632 F. Supp. 1133, 1138 (N.D. Ill. 1986) (breaking statutory fair use into these three elements).

279. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 951 (7th Cir. 1992).

280. *E.g., Int'l Stamp Art, Inc. v. U.S. Postal Serv.*, 456 F.3d 1270, 1274–75 (11th Cir. 2006); *EMI Catalogue P' ship v. Hill, Holliday, Connors, Cosmopolus Inc.*, 228 F.3d 56, 66 (2d Cir. 2000). *But see* 2 MCCARTHY, *supra* note 49 § 11:49 (noting "[t]he meaning of [the good faith] element . . . is somewhat unclear" and cataloguing applications of the good faith requirement by numerous courts).

281. 2 MCCARTHY, *supra* note 49 § 11:48.

282. *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997).

283. *Dessert Beauty, Inc. v. Fox*, 568 F. Supp. 2d 416, 423 (S.D.N.Y. 2008), *aff'd*, 329 F. App'x 333 (2d Cir. 2009).

284. *See* *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1044 (9th Cir. 2010). The holding was contingent on the jury finding that the word "delicious" was used to describe the wearer and not as a trademark. *Id.* at 1044.

As William McGeeveran and other commentators have argued, the safeguards for fair use offer too little protection, and come into play too late, to adequately protect speech.²⁸⁵ High-profile infringement cases involving fair use almost always reach the correct outcome; when courts consider the merits, “the defendant’s free speech arguments ultimately carry the day.”²⁸⁶ And yet we cannot be lulled into a false sense of complacency based on those outcomes:

[O]nly a tiny fraction of disputes actually reach litigation and become eligible for a happy ending Considerable anecdotal evidence suggests that the real action occurs outside the courthouse: markholders send cease-and-desist letters and threaten legal action against those using trademarks to facilitate speech, and the recipients frequently capitulate. We need not devote too much energy to improving the courts’ ability to reach the correct substantive outcomes in the final judgment at the end of a lawsuit. They already do. Rather, the priority should be restructuring the relevant doctrines to reduce the pre-litigation chilling effect.²⁸⁷

McGeeveran focuses his attention primarily on restructuring the fair use doctrine and refining its application by courts, working toward “clearer rules and faster adjudication.”²⁸⁸ The speech-act theory of trademark distinctiveness advocates addressing the problems McGeeveran identifies by intervening at the outset, incorporating fair use goals into the registration process. The pre-litigation chilling effect²⁸⁹ can impact a potential new entrant as early as the mark selection stage, all because a producer succeeded in registering a mark with descriptive components without being required to demonstrate acquired distinctiveness.²⁹⁰ Cease and desist letters

285. William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1205 (2008).

286. *Id.* at 1206.

287. *Id.* at 1206–07 (internal footnote omitted).

288. *Id.* at 1227.

289. See Gallagher, *supra* note 11, at 456 (“[M]ost enforcement of IP rights takes place *not* in court, but in the everyday practices of IP owners and their lawyers. ‘Cease and desist’ letters, phone calls, and negotiations with alleged infringers constitute the bulk of IP enforcement efforts in trademark and copyright practice. To be sure, these efforts take place in the ‘shadow’ of IP law and are therefore influenced by it. But it is in these everyday practices—and not in trial or appellate courts—that most IP rights are asserted, resisted, and negotiated.”).

290. Of course, mark owners that do demonstrate acquired distinctiveness may also wield their registrations offensively to quash others’ legitimate uses of descriptive terms that would constitute protected fair use. Raising the bar for inherent distinctiveness is not a complete cure that would stop bullies from silencing fair-use competitors, which is why some scholars have called for an end to the protection of descriptive marks regardless of the extent or duration of their use. See, e.g., Ramsey, *supra* note 56, at 460.

posted to the Chilling Effects Clearinghouse²⁹¹ reflect the frequency of this scenario, and they likely represent only a very small fraction of the letters producers send each year.

Rather than fine-tune the fair use test as a defense to an allegation of infringement, this Article proposes moving it up in time, applying some of its elements when owners initially apply to register trademarks. While the existing approach to categorizing distinctive marks emphasizes only producer interests, putting fair use first will help ensure that useful descriptive terms remain available to second comers, which in turn serves competition by maximizing both competitors' ability to effectively explain what they're selling, and consumers' access to information about alternatives.

B. Fair Use First

The Subparts above have detailed the ways in which the existing formal tests and informal proxies for gauging distinctiveness tend to overprotect descriptive terms, handicapping competitors' ability to compete fairly. A speech-act approach to distinctiveness would preclude some of those problems by refocusing the distinctiveness inquiry on more appropriate questions, such as how the public views and uses the term and whether granting trademark rights in it would affect competitors.

The speech-act distinctiveness inquiry closely resembles the statutory fair use defense. It borrows two of three elements from that defense: the descriptive and good faith elements.²⁹² The test simply asks whether a hypothetical competitor could use any of the terms that compose the producer's mark (1) in good faith and (2) descriptively in connection with the competitor's own product. If the answer to both questions is "yes," the original mark is not inherently distinctive and should not be registered without a showing of secondary meaning. Simply stated, words that are descriptive enough to be used by a junior user on or in connection with related goods, without the junior user seeking to pass off its goods as those of the senior user, belong in the pool for competitors to use until the senior user has made use sufficient to lead consumers to view the mark as an indication of source. The descriptive or laudatory terms must remain available for new entrants until the producer has invested sufficient time,

291. The organization Chilling Effects invites those who receive cease and desist letters to submit them. Chilling Effects posts the letters online and provides general information to aid recipients in assessing and responding to them. *See* CHILLING EFFECTS, <http://www.chillingeffects.org> (last visited Jan. 21, 2013).

292. The third element, the requirement of non-trademark use by the junior user, is irrelevant at the trademark prosecution stage.

money, and effort to create a source-constative mark. Until then, competition should take priority.

The rule of doubt that mandates holding a mark inherently distinctive where the mark appears to occupy the liminal space between descriptiveness and distinctiveness must be reversed. When in doubt, the PTO, TTAB, and federal courts should categorize such marks as non-distinctive. Descriptive terms communicate information, which is nonrival.²⁹³ Laudatory terms constitute puffery and are not inherently source identifying, but rather serve to advertise the product. The option to oppose a mark on the grounds of mere descriptiveness after it passes to publication is rarely exercised by small business owners and places too great a burden on competitors to act as watchdogs. Rather, producers should bear the burden of either establishing that a mark is clearly distinctive or demonstrating secondary meaning. The harm to competition when goods-constative marks are granted protection is far greater than the harm to producers when a borderline mark is deemed descriptive and secondary meaning required. If the mark indeed has the capacity to function as a source identifier, a producer need merely proceed to market and advertise its goods in the ordinary course of business, and it will soon be able to demonstrate secondary meaning.

It's crucial that the determination of whether a hypothetical competitor could use a given term descriptively in connection with its own product be based on evidence of whether and how the trademark term is used by the public. Consulting only dictionaries and prior registrations—as several of the current tests advocate—doesn't suffice. Fortunately, fact-finders have access to a wealth of evidence with which to catalogue usage. In recent cases, trademark examining attorneys have looked to online message boards,²⁹⁴ blogs,²⁹⁵ consumer reviews,²⁹⁶ auction sites, industry or community norms,²⁹⁷ periodicals,²⁹⁸ and Twitter to gauge whether a term is

293. See YOCHAI BENKLER, *THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS & FREEDOM* 36 (2006) (“When economists speak of information, they usually say that it is ‘nonrival.’ We consider a good to be nonrival when its consumption by one person does not make it any less available for consumption by another.”).

294. *E.g.*, *In re Petroglyph Games, Inc.*, 2009 WL 1759327, at *11–12 (T.T.A.B. July 19, 2009) (citing user reviews and gaming websites to support refusal to register BATTLECAM as merely descriptive for a feature of computer game software).

295. *E.g.*, *In re ZeroNines Tech., Inc.*, 2010 WL 2783883 (T.T.A.B. June 22, 2010).

296. *E.g.*, *In re Murad*, 2010 WL 667931 (T.T.A.B. Feb. 4, 2009).

297. *Birmingham v. Mizuno USA, Inc.*, No. 5:09-CV-0566 (GTS/GHL), 2011 WL 1299356 (N.D.N.Y. Mar. 31, 2011) (finding SOFTHANDS descriptive for a product that absorbs the impact of a ball to the hands because it conveys characteristics of the product and “because it uses a term of art commonly used within the baseball community”).

298. *E.g.*, *In re Diamond Comm. Prods. Inc.*, 1999 WL 180802, at *1 (T.T.A.B. Mar. 30, 1999) (affirming refusal to register CABLE-TY based on evidence from periodicals that “cable tie” is generic or descriptive for the goods at issue).

descriptive for a given product category. The speech-act model demonstrates why that type of evidence is necessary to determine whether a phrase is source-constative and merits protection.

Consider earlier examples. In the case of PERFECTING SERUM, the TTAB acknowledged use by competitors but dismissed it, noting “there are only two other users of the term at issue.”²⁹⁹ But if a prospective purchaser runs a search for “perfecting serum” on a popular site geared toward consumer reviews of beauty products and finds that users’ posts discuss three or more different brands of products called “perfecting serum”³⁰⁰ or use the phrase to refer to a whole class of products, then “perfecting serum” is functioning as a goods-constative phrase. Consumers understand it and use it to describe a product, not that product’s source, so competitors should be free to use the term descriptively under the speech-act test. Instead, the registration for PERFECTING SERUM³⁰¹ empowers its owner to use the mark offensively, suing any competitors that use the phrase, which is exactly what Murad has done and continues to do.

BRANTREATS was also among the marks allowed registration without a showing of secondary meaning, and neither “bran” nor “treats” is disclaimed in the registration.³⁰² But “bran” is an ingredient, and “treat” is laudatory. Could a new entrant use “bran” or “treats” (or both) for its cookies in good faith, without attempting to pass off its product as Almondina’s? A quick search shows that the general public indeed uses both terms, sometimes at the same time, to describe baked goods: Google results for the search “bran treats” returns recipes for homemade “bran treats,”³⁰³ “peanut butter bran treats,”³⁰⁴ “sweet pecan bran treats,”³⁰⁵ “blueberry bran breakfast treats,”³⁰⁶ “all bran treats,”³⁰⁷ “chocolate bran

299. *In re Murad*, 2010 WL 667931, at *4.

300. For example, a search for “perfecting serum” on [makeupalley.com](http://www.makeupalley.com), a site that hosts product reviews and receives over 25,000 visitors a day, results in reviews for “Murad perfecting serum”; “Guerlain Issima Secret Divin[e]-Skin perfecting serum Anti-ag[jing]”; “L’Oreal Liss Extreme Reflexium Shine perfecting serum”; “Superdrug Optimum Advanced Firm and Lift perfecting serum”; “Kinerase Dr. Lewinn Skin Tone perfecting serum XK”; and “Sunday Riley Stimulant III perfecting Stem Cell serum.” MAKEUPALLEY, <http://www.makeupalley.com> (last visited Mar. 20, 2014).

301. Murad registered PERFECTING SERUM on the Supplemental Register (Registration No. 2,148,418) and later on the Principal Register (Registration No. 3,798,129).

302. BRANTREATS, Registration No. 2,533,197.

303. Cecily Brownstone, *Bran Treats*, GADSDEN TIMES, June 21, 1978, <http://news.google.com/newspapers?nid=1891&dat=19780621&id=Xt8pAAAAIAAJ&sjid=XNYEAAIAIAAJ&pg=3850,3516193>.

304. *Peanut Butter Bran Treats*, LIVESTRONG, <http://www.livestrong.com/thedailyplate/meals/emys13/peanut-butter-bran-treats/> (last visited Jan. 22, 2014).

305. *Sweet Pecan Bran Treats*, KRUSTEAZ, <http://www.krusteaz.com/muffins-and-crumb-cake-recipes-89/sweet-pecan-bran-treats-1521> (last visited Jan. 22, 2014).

306. *Blueberry Bran Breakfast Treats Recipe*, YUMMLY, <http://www.yummly.com/recipe/Blueberry-Bran-Breakfast-Treats-Recipezaar> (last visited Jan. 22, 2014).

treats,”³⁰⁸ “bran muffin treats,”³⁰⁹ and many more. The use of both terms in those recipes belies the TTAB’s assertion that “BRANTREATS is an incongruous term when used in connection with a biscuit made of a cereal by-product”³¹⁰ unless the Board defines competitors’ use so narrowly that the goods must be nearly identical—flat, crispy, biscotti-shaped cookies—to qualify as competitive products. BRANTREATS is thus goods-constative unless and until it becomes source-constative through use.

When the owner of a winery in Oklahoma³¹¹ applied to register GRAPE RANCH for wine, the examining attorney issued multiple office actions, denying registration on the basis that the mark was merely descriptive.³¹² She appended over a dozen Internet screenshots demonstrating that numerous other wineries used the words “ranch” or “grape” on their wine bottles’ labels or websites and at least two sources used the phrase “grape ranch” in a descriptive or generic sense.³¹³ She also appended a number of prior registrations reflecting disclaimers of exclusive rights to “ranch” or “grape” as part of a word mark for wine.³¹⁴ The applicant appealed and the TTAB reversed the refusal, holding the mark inherently distinctive because it was incongruous as applied to wine.³¹⁵ But if the TTAB had applied the speech-act test rather than the imagination test, it would have affirmed the trademark examining attorney’s refusal based on the latter’s own evidence. Hypothetical users could—and in fact already do—use each component term descriptively and in good faith in connection with their own wines.

Finally, we return to SNO-RAKE. A search for “snow rake” on amazon.com returns hundreds of results, including an Avalanche! brand

307. *All Bran Treats Recipe*, SPARKRECIPES, <http://recipes.sparkpeople.com/recipe-detail.asp?recipe=252253> (last visited Jan. 22, 2014).

308. *Chocolate Bran Treat*, SPARKPEOPLE, http://www.sparkpeople.com/secrets.asp?tip=22919_chocolate_bran_treats (last visited Jan. 22, 2014).

309. *Bran Muffin Treats*, COOKS.COM, <http://www.cooks.com/recipe/4d9y87rh/bran-muffin-treats.html> (last visited Jan. 22, 2014).

310. *In re YZ Enters.*, 2000 WL 1125563, at *2 (T.T.A.B. July 28, 2000).

311. The makers of GRAPE RANCH wine later relocated their winery from Oklahoma to Texas. *Grape Ranch Winery Chooses Texas over Oklahoma*, OKLAHOMA WINE NEWS, Oct. 15, 2010, <http://oklahomawine.blogspot.com/2010/10/grape-ranch-winery-chooses-texas-over.html>.

312. The Examining Attorney initially also refused registration on the grounds of likelihood of confusion with another registered mark but later withdrew that basis for refusal. The file wrapper for GRAPE RANCH can be accessed at the USPTO Trademark Status and Document Retrieval System (TSDR) at <http://tsdr.uspto.gov/> by entering “78281418” in the search box labeled “US Serial No.”

313. For example, an author’s byline describes him as “operat[ing] a wine grape ranch in California’s Napa Valley.” Office Action from U.S. Patent and Trademark Office to Jack D. Whiteman (June 24, 2005), available at TSDR, tsdr.uspto.gov (search “78281418,” click “DOCUMENTS,” click “Jun. 24, 2005 Offc Action Outgoing”).

314. *Id.*; see also *In re Whiteman*, 2005 WL 2543637, at *3 (T.T.A.B. Sept. 28, 2005).

315. *In re Whiteman*, 2005 WL 2543637, at *5.

“snowrake,” a Garelick brand “snow roof rake,”³¹⁶ a Sno-Knife brand “snow removal tool rake,”³¹⁷ a Suncast brand “snow roof rake,”³¹⁸ a Midwest Rake brand “aluminum snow removal roof rake,”³¹⁹ and a Garant brand “Poly Blade Aluminum Handle Snow Roof Rake With 16-Foot Reach.”³²⁰ In fact, Amazon features an entire product category called “snow rakes.” The TTAB speculated that no one uses “rake” as his verb or noun of choice for snow clean-up, but it did not offer any evidence for its assertion.³²¹ At least today, competitors and consumers clearly use “snow rake” goods-constatively. A competitor could thus use “rake,” with or without “snow,” in good faith to describe its own snow removal products, rendering the mark merely descriptive under the speech-act test.

CONCLUSION

Commentators have described the anti-competitive and chilling effects of granting extensive protection to owners of trademarks that comprise descriptive or generic terms.³²² It is clear, however, that the tests for descriptiveness and distinctiveness often lead trademark examining attorneys, the TTAB, and federal courts to protect as inherently distinctive marks that are purely descriptive or contain descriptive elements and lack both secondary meaning and appropriate disclaimers. Because the tests are ill-defined and haphazardly-applied, their use “exacerbate[s] rather than ameliorat[es] the chilling effect.”³²³ The Supreme Court has acknowledged that “Competition is deterred . . . not merely by successful suit but by the

316. *Garelick 89421 21-foot Aluminum Snow Rake with 24-inch Blade*, AMAZON, http://www.amazon.com/Garelick-89421-21-Foot-Aluminum-24-Inch/dp/B0000BYCD5/ref=sr_1_2?ie=UTF8&qid=1390411421&sr=8-2&keywords=snow+rake (last visited Jan. 22, 2014).

317. *Sno-Knife Roof Snow Removal Tool Rake*, AMAZON, http://www.amazon.com/Sno-Knife-Roof-Snow-Removal-Tool/dp/B000E9J2BK/ref=sr_1_1?ie=UTF8&qid=1390423109&sr=8-1&keywords=snow+rake+knife (last visited Jan. 22, 2014).

318. *Suncast SR2100 Snow Roof Rake with 20-foot 3-3/8-inch Reach*, AMAZON, http://www.amazon.com/Suncast-SRR2100-24-Inch-Shovel-20-Foot/dp/B0007NY3DA/ref=sr_1_4?ie=UTF8&qid=1390411421&sr=8-4&keywords=snow+rake (last visited Jan. 22, 2014).

319. *Midwest Rake 96022 22-inch Aluminum Snow Removal Roof Rake with 16-foot Reach (Discontinued by Manufacturer)*, AMAZON, http://www.amazon.com/Midwest-Rake-96022-Discontinued-Manufacturer/dp/B0002DQ2CK/ref=sr_1_10?ie=UTF8&qid=1390411421&sr=8-10&keywords=snow+rake (last visited Jan. 22, 2014).

320. *Garant GPRR24U Yukon 24-Inch Poly Blade Aluminum Handle Snow Roof Rake With 16-Foot Reach*, AMAZON, http://www.amazon.com/Garant-GPRR24U-24-Inch-Aluminum-16-Foot/dp/B000A16VS4/ref=sr_1_13?ie=UTF8&qid=1390411421&sr=8-13&keywords=snow+rake (last visited Jan. 22, 2014).

321. *In re Shutts*, 217 U.S.P.Q. (BNA) 363 (T.T.A.B. 1983).

322. *See, e.g., McGeveran, supra* note 285, at 1208 (“Expansive trademark protection for common words and phrases can effectively remove them from our language . . . [which] has significant anticompetitive effects.”).

323. *Id.* at 1214.

plausible threat of successful suit.”³²⁴ In fact, competition is also deterred by the threat of expensive and lengthy litigation, even when plaintiffs are ultimately unlikely to succeed.³²⁵

Speech-act theory offers the crucial insight that a trademark is not just a word; it’s also an action. Trademarks have both semantic force and legal force, and the latter is too often used to silence competitors by forcing them to sidestep the clearest and most obvious terms in describing and marketing their goods. Protecting descriptive terms as marks when they lack secondary meaning divorces action from speech. It enables a producer to exploit the benefits of mark ownership without the mark having legally earned protection.

In order to safeguard competitors’ rights, we must repair the speech-act connection by ensuring that descriptive terms remain in the pool for use by competitors, with a narrow exception³²⁶ for those marks that have become source-constative through use. The best way to accomplish that goal is to bring concerns about competitor speech to the fore when evaluating trademarks that contain descriptive terms. Could a hypothetical competitor use one or more of the trademark’s component terms, defined in accordance with contemporary usage, literally and in good faith to describe its own product? If it could, the mark remains goods-constative until its owner can establish that it has become source-constative. Only then does the Lanham Act empower the mark owner to use the mark performatively.

324. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000).

325. As Gallagher’s interviews demonstrated, “asserting even weak claims can be quite effective for the trademark and copyright owners.” Gallagher, *supra* note 11, at 475.

326. *See Two Pesos, Inc. v. Taco Cabana*, 505 U.S. 763, 769 (2003) (characterizing secondary meaning as a “narrow exception” to the rule that descriptive trademarks do not receive protection under trademark law).