Word Law

Dennis Baron
University of Illinois

I saw an ad once in the back of a magazine promising that if I sent in some money, I could have a star in the firmament named after me. For the same low price I would receive a certificate and a photograph of the galaxy where my star was located. I might even be able to see that star if I possessed suitable magnifying equipment. I was not tempted by the offer, but it did occur to me that while I would not like to have a star, as a wordsmith I might like to own my own word.

Is it possible to own your very own word? The English language may belong to all of us, but some of its words are the property of individuals or, in most cases of lexical ownership, of corporations. I am referring to the registered trademarks and service marks protected under federal law from the infringement of unscrupulous competitors. Now, I am a language professional, not a manufacturer or a lawyer, so if you want competent advice in the latter areas you should supplement the summary of the complex trademark picture that follows.

The law of trademarks, which fills more than two volumes of the Annotated U.S. Code in the local law library—the source of the following information—gives us some guidance as to what words can and cannot be staked out as private property and what that notion of privacy really means when it comes to the use of language.

For one thing, you cannot simply coin a word and lay claim to it. You must also sell the goods named by your trademark or perform services named by your service mark. In law, a trademark is a name, logotype, design, or any combination thereof adopted and used by a manufacturer to identify its goods and distinguish them from articles sold by others. A service mark identifies you as a provider of specific services rather than of vendable articles. For example, Kodak is a trademark, Fotomat, a service mark. Your trademark or service mark may be registered, but you may have rights to the mark even if you have not registered it. The symbol you choose for your mark may be pictorial, as the bearded representation of the Smith Brothers of cough-drop fame, who, as some would have it, are named, respectively, Trade and Mark. But a trademark may also be a word or a group of words.

Sounds simple, really. You come up with a no-nonsense product designed to remove widgets, patent it, and market it under the straightforward name Widget Terminator. Maybe the Widget Terminator does its job well, finds a niche in the market, and over the years even makes a little money for you. Only now your brother-in-law decides he is going to get into the act and beat your price. Of course he calls his knock-off the WidgetBuster, a much snappier moniker, and he packages the product behind a picture of a widget inside a barred red circle. Since his product works differently from yours, you cannot get him for violating patent law, so you haul him into court and sue the pants off him for infringing on the implied trademark you have established with your Widget Terminator.

Keeping it all in the family, you get your cousin Benny, fresh out of law school and eager for work, to argue that the public has come to love and trust the Widget Terminator and that people will be confused and deceived by the similarity of the name of the rival WidgetBuster. As a result of this confusion of products, your reputation will be damaged and your sales hurt. You ask that the WidgetBuster be withdrawn from the market and that your brother-in-law pay you treble damages and that he pay your cousin Benny, as well.

Do you think you will win? That depends on how well Benny did in his Intellectual Property Law course. The law recognizes two basic kinds of trademark, though it allows for a measure of degree in their definition: a “strong trademark” is one used only in a fictitious or fanciful manner, while a “weak trademark” is a meaningful word in common usage that doubles as a suggestive or descriptive trademark. Weak trademarks are more difficult to establish, and they are entitled to narrower protection than strong ones. Your brother-in-law’s counsel will argue that you may have an invention, but its name is not a trademark, because a trademark cannot be an ordinary word, particularly a descriptive one, if that word is used in its ordinary sense. Both widget and terminator are common English words—a widget is a ‘gadget, or gizmo,’ in case you did not know—and they literally describe the function of the product, which is to remove pesky widgets, so you cannot claim them as your own or prevent others from using them.

Of course, if you have ever talked to a lawyer you know that things are never what they appear when it comes to the law. There have been trademarks that were fairly literal, for example, Coca-Cola. Coca-Cola, which is a trademark of long standing, originally contained both cocaine and an extract from the cola nut. The cocaine went out when it was declared a controlled substance early in this century. Interestingly, the makers of Coke (which is also a registered mark) once sought to prohibit the marketing of something called Taccola-Cola, as well as any other drink with the word cola in its name. But the courts ruled that because cola was a common word describing what was in the beverage, any soda containing cola derivatives could be called a cola. Coke’s trademark was upheld
SIC! SIC! SIC!

"The family said they would try to bury him again tomorrow." [Dan Rather, CBS Evening News, 7 April 1987. Submitted by Dorothy Branson, Kansas City, Missouri.]

At 7:35 a.m., Ron Steelman of National Public Radio said: "For the second time in two weeks a Galena Park school teacher was found murdered." At 8:26 a.m., Sam Saezco of Channel 11 News said, "For the second time in two weeks a Galena Park school teacher has been murdered." [Submitted by Graciela S. Daliehman, Rice University.]

against Chero-Cola, Clio-Cola, Coca and Cola, and El-Cola; ruled to be non-infringing were Coke, Dope, Cherry-Cola, Roxa-Cola, and Dixie-Cola. As for other sodas, Moxie won its case against Noxie, but Pepsi-Cola lost against Pep, as did Seven-Up against Cheer Up.

On the other hand, if the name of your product is a common word which is applied in an arbitrary or fanciful sense, you should be able to claim it as a trademark. The courts have ruled that Cyclone, when naming a fence, and Innocent, as a brand of hair coloring (suggesting, as the ruling noted, "the very antithesis of innocence") are legitimate trademarks; but while Yellow Pages was found to be a trademark although it is clearly descriptive, raisin bran and spearmint were not granted exclusive status.

Manufacturers are fond of deforming the spelling of an ordinary word to make it distinctive, for example NU for new, KWIK for quick, or Bons for bones (unfortunately, this last, a dog food lacking the so-called silent e, is frequently mispronounced). But a clever or phonetic spelling of a common descriptive word does not entitle you to own it as a trademark. Rather, a common word can become a trademark only if it acquires a "secondary meaning," if, in other words, it is used so long and so exclusively by one producer that it has come to signal to the general public that the product in question is made by that producer, and that producer alone. (The courts have insisted repeatedly that to be a trademark, a word or symbol must call up not the product or service but its source, the producer or provider.) If your brother-in-law can afford to wait, time may be on his side in the battle against widgets. If you stop selling a product for two or more years, you may lose the right to its trademark. The courts frown on manufacturers who pretend to sell a few samples of a product each year just to hold on to the name for future use. But you may be able to withhold the product from the market while you experiment with ways to improve it, and you can change the product significantly and still retain possession of its name, as the makers of Tabasco did when they altered the formula of their hot sauce but successfully defended their right to exclusive use of the trademark.

Under the former trademark law, shredded wheat was considered a generic term and, hence, not registrable. But because the process for making it was patented, no other company could produce it, hence the patent holder had exclusive rights to the name of a unique product. When the patent expired, new manufacturers simply used shredded wheat as a descriptive term. And although dictionary maker Noah Webster was instrumental in passing our first federal copyright laws to protect an author's intellectual property, the name Webster ceased to function as an exclusive trademark when the original Webster's copyright ran out. As early as 1904, G. & C. Merriam, of Springfield, Massachusetts, who claimed to be the literal publishing descendants of Noah Webster's lexicographical projects, attempted to restrain the sale of other dictionaries with Webster in the title. In a series of decl-
sions—Merriam v. Ogilvie (170 F. 167), Merriam v. Saalfield (190 F. 927; 198 F. 369)—the U.S. Circuit Court of Appeals ruled partly for Merriam, partly for the competition: Merriam lost its right to the exclusive use of the name Webster, but since that company had become known to the public as the publisher of Noah Webster’s dictionaries, would-be Websters were ordered to disclaim on their title pages any connection with the original word book. In the early 1940s, World Publishing Company, producer of Webster’s New World dictionaries, obtained a ruling to quash the disclaimer requirement. In a more recent action, initiated by Merriam in 1981, the Court of Appeals again affirmed the right of other publishers to use Webster in dictionary titles and enjoined the defendants from using any variation or combination of the words world-famous, authentic, original, genuine, or re-nowned to suggest a connection between their product and the Merriam-Webster line of dictionaries (Merriam v. Webster Dictionary Co. 639 F. 2d 29). It is clear that for many, Webster’s has become a generic word. Despite the fact that this synonymy is one that the courts have repeatedly upheld, no dictionary is willing to define Webster’s simply as ‘dictionary.’

Normally, a title cannot function as a trademark, which is why different books can have the same title, as long as their contents are different and there is no intent to deceive the public. Two manufacturers may be allowed access to the same trademark if their products are so different that their markets will not overlap and if there is no indication that the public will be confused by the names. Thus Condé-Nast, the publishers of the magazine Vogue, which is a trademark, were unsuccessful in a suit to force the owners of the Vogue School of Fashion Modeling to change its name. And Verbatim, the language quarterly, registered as a trademark in 1974, failed in its suit against the manufacturer of Verbatim floppy disks, introduced in 1977, though the Verbatim (disk) company agreed never to produce anything but blank recording media, while Verbatim is enjoined only from producing blank media. The owners of the popular 1984 movie title Ghostbusters have extended the range of their trademark with a television show, toys, and other licensed products bearing its name and distinctive logo, and Verbatim, the language quarterly, is free to do likewise.

Ironically, success can sometimes weaken your right to a trademark, particularly if your product name has become a generic term. Cellophane failed to protect itself in an infringement suit when the defense attorney asked the Cellophane representative for the generic name of the product. Unable to come up with a synonym for cellophane, the manufacturer lost its trademark. Celluloid remained a trademark much longer, though it too has now become a generic term.

Thermos and Zipper were both originally trademarks. But both products became so popular that their names began to function as generics in the public mind, and because of that the courts have ruled that other companies could use these words, uncapsitlized, so long as they did not attempt to confuse or deceive the public. However, a design or distinctive style of typography can be a trademark, and the distinctive manner of printing Thermos as a symbol remains protected.

Federal law regulates only in the broadest sense what words can or cannot serve as trademarks. Prior decisions have little value in trademark claims, and each case must be argued on its own merits. As a result, trademark rulings may seem idiosyncratic or contradictory. The law clearly specifies, though, that a trademark cannot be immoral, deceptive, scandalous, or disparaging. Glass Wax, a glass cleaner which contains no wax, successfully defended its trademark against a charge that the name was deceptive, but in the early 1900s the courts refused to recognize Madonna as a trademark for wine because it was ruled scandalous. (The soft drink Old Monk, which was not perceived to threaten public morality, was permitted.) Tastes change of course, in wines as well as scandals, and though Old Monk is gone from the shelves, today’s courts seem not to be offended by the brand of wine known as Blue Nun.

Foreign words can serve as trademarks in the United States, but their legal status is determined the same way as that of English words. Thus Selchow & Righter, makers of the game Parcheesi, could not prohibit other manufacturers from selling games under such names as Pachisi, Parchisi, or Parcheesi, variant spellings of the common Hindi word for the old Indian pastime. Similarly, Duncan was unable to retain exclusive rights to the name yo-yo because the toy is called that in the Philippines, where it originated, and because it has no synonyms. On the other hand, both Scrabble and Monopoly are trademarks for games. Despite the fact that both are ordinary English words, they meet the secondary meaning test, being easily recognized as exclusive product names, although the court also upheld the trademark rights of a game called Anti-Monopoly over the objection of Monopoly owner, Parker Brothers. That decision remains confused.

A trademark can be longer than a word, or even a pair of words. You can lay claim to an entire slogan if it has become widely enough identified with your product, but the courts do not let you monopolize the language. They will limit your power to control sentences similar to yours, just as they stymied Anheuser-Busch, the owners of the slogan, “Where there’s life, there’s Bud,” who failed in their attempt to prevent use of all slogans beginning, “Where there’s life . . . .” including, as far as I know, the age-old proverb, “Where there’s life, there’s hope.”

At any rate, it seems that where there’s a trademark, there’s hope for a lawsuit. The Xerox Corporation, recognizing the potential danger of success, has in the past gone out of its way to protect its right to the words it owns. Though I have found no reference to any trademark suits brought by Xerox against other manufacturers, the company has tried to regulate the use of its trademark in ordinary English. For example,
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23324. A. Name Into Word. A tawdry piece of jewelry was named after Aunt Audrey; there are many more of these names, such as the warm cardigan and the delicious sandwich. They are explained in this talk. B. Changing Words. Words change their meanings all the time: for instance, a glamorous girl used to be a girl who could read and write (she knew her "grammar"). Many such are discussed on this cassette.

23325. Winged Words. Proverbs contain the wisdom of many different nations and groups. Usually no one knows who created them, but, once heard, they stick in the mind. How about the Russian proverb "Long hair, short brain?" B. The Anatomy of Slang. Slang words and slang phrases twist and deform ordinary language, but they make it livelier. Where do they come from? How are they invented?

23326. A. Sense and Nonsense and B. Complete and Utter Nonsense. Some things which look sensible turn out to be crazy or non-sensical when we look at them more closely. What is the difference between sense, and almost-sense, and meta-sense, and nonsense, and what does it matter?

23327. A. One Kind of Glory. This is a talk about the men and women who—although they themselves are forgotten—saw and wrote things which have been remembered forever. B. Tell Me a Story. Somerset Maugham said that the best of good story was one that could be told to strangers in a ship's smoking room or a bar car in a train, and hold their attention. Here are three stories by unknown authors which prove that Maugham was right: they are all miniature masterpieces.

23328. A. The Art of Inective. How to make a speech or write a newspaper piece that utterly crushes your opponent. B. A Bouquet of Poison Ivy. The art of parody: how to point out the ridiculous in speeches and poems and novels which are overblown and absurd: the needle point deflating the balloon.

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some years ago the xerography pioneer took out half-page ads in the New York Times to remind us that Xerox is a trademark to be used only as a proper noun, as in Xerox machine, or a proper adjective, as in Xerox copy. In either case, warned the ad, we must capitalize Xerox. Despite such entreaties, the word xerox seems to have become generic, if not according to the courts, then at least according to current American usage, where it occurs freely as noun, adjective, and even verb, with or without capitalization. Xerox persists because unregulated use by others may cause a trademark to be deemed abandoned.

Many publishers, either fearing litigation or simply because they are sensitive to questions of ownership of the printed word, prefer to take a cautious approach to trademarks, capitalizing words like Xerox, Coke, and Formica in print, though at least one major dictionary recognizes the uncapsulated form of xerox, and allows it to function as a verb. But no contemporary lexicon, either desk-sized or unabridged, records for Webster's the commonly-found meaning 'an English dictionary, even one not actually attributable to the lexicographer Noah Webster.'

But back to the hypothetical case of Widget Remover Mfg. Co. of North America v. WidgetBuster, S.A. While you may not be able to restrain your brother-in-law's trade, you can hope that his market share will become so large as to draw the attention of the owners of the Ghostbusters trademark and that their battery of high-priced studio lawyers might be able to get the injunction that your cousin could not.

Clearly, owning a trademark can be worth so much that a manufacturer will object willy-nilly to any and every use of it by another. In one case the court told a manufacturer that there can be no monopoly on love: "No one may preempt the field with respect to marks having 'love' as a portion thereof and thus exclude all others from the use of any mark composed in part of such word." But owning a word can do little for a writer like me, except perhaps in the ego department, since according to the law, a word can be a trademark only if such status does not deprive others of their right to the normal use of the English language. So if you were planning to give someone a word for his birthday, think again. Words that do not fit cannot be returned. And owning a word is not like owning a ball: even if the game is not going the way you planned, you cannot just pick up your word and go home.

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