Trademarks and other proprietary terms

Ronald R. Butters
Duke University, Durham, North Carolina

Especially in North America, trademark litigation constitutes a prominent area of applied linguistics. As legal consultants, linguists bring their professional expertise to bear upon three issues: (1) likelihood of confusion of two marks; (2) categorization of the strength of a mark with respect to its place on a continuum of semantic/pragmatic categories technically labeled "generic," "descriptive," "suggestive," "fanciful," and "arbitrary"; and (3) propriety of a mark, that is, whether it is "scandalous," or "disparaging." Consulting linguists typically write descriptive reports that analyze the linguistic facts underlying the issues of particular cases — sometimes in rebuttal to other linguists' reports. Often, linguists are also called upon to give sworn testimony based upon the reports they have prepared.

1. Introduction

Trademarks are proprietary words, phrases, and images used in commerce to distinguish publicly offered products and services one from another. In American legal nomenclature, any sort of proprietary identifier may be referred to simply as a mark.1 Technically, the term trademark is reserved for products (e.g., Mustang automobiles), but the term is also used more generally (as it will be here) to refer as well to service marks (which name services, e.g., FedEx), proprietary slogans (e.g., Maxwell House's "Good to the Last Drop"), and even logos and designs (e.g., Apple Computer's stylized apple-with-the-bite-out-of-it).

1. The focus of this chapter will be upon the role of linguists in US trademark litigation. It is my understanding that linguists outside the United States, Canada, and Australia are rarely if ever called upon as expert consultants in trademark litigation. Several Japanese scholars have contributed conference papers and at least one doctoral thesis to the linguistic scholarship on trademark issues (see Shudo 2005; Hotta 2006; Hotta and Fujita 2006; Okawara 1999; and Okawara 2006), though linguistics experts in Japan are reportedly not allowed to present reports or testify in court.
Consumers rely on established marks in making purchasing decisions, and trademark owners therefore invest in advertising (in addition to product quality) so that the public will favorably identify their products and services and be able to distinguish them from those of competitors. For a mark's owner, however, protecting what is essentially a valuable property right can be legally complicated. Owners must be continually vigilant if they wish to prevent competitors from subverting their good name, appropriating or spoiling the good will of their customers, and even destroying completely their rights to a proprietary name. Trademark litigation most often stems from (1) conflicts between two companies who are competitors in a particular market or service and/or (2) governmental refusal to allow a company to register a trademark (often in response to the objections of a competing company).

In the United States, as well as in other countries such as Canada and Australia, linguists regularly offer expertise that is intended to be of assistance to a judge or jury in resolving some of the issues in trademark disputes about which the parties are in disagreement. In America, linguists have testified in court about trademark issues since long before the term forensic linguistics came into use. The late Raven I. McDavid, an eminent American dialectologist, reports that he testified for the winning side in a "trade-name" case on behalf of "Frito-Lay of Atlanta and Dallas" against "Joy's Potato Chips of Chicago," while an unnamed "distinguished colleague" testified for Jay's (1977: 126). In another case dating from approximately that same era, Fred Cassidy testified about the meaning of the word opry as used in the trademark Grand Ole Opry (WSM v. Hilton and Country Shindig, 1984). And Bailey (1984) summarizes the testimony of two eminent twentieth-century scholars, the lexicographers Allen Walker Read and Jess Stein, concerning linguistic issues underlying a lawsuit about the trademark Air Shuttle used to designate a type of airplane service. Eastern Air Lines claimed ownership of the term for its exclusive use and sued New York Air, which had begun using the term as well.

In the decades since McDavid, Cassidy, Read, and Stein did their legal consulting, law firms have engaged many other linguists for technical advice about the language of trademarks. Shuy (2002) discusses ten or so of the many cases that he has consulted on in the past 30 years, and I know of over a dozen other linguists, including myself, who have worked on one or more. Linguists have

2. Many of these scholars (and a few other linguists) have presented conference papers or brief online commentaries about their work (Adams 2006, Butters 1997, 2004a, 2004b, 2005a, 2005b, 2005c, 2007b; Butters and Hilliard 2003; Dumas 2003; Eggington 2004; Finegan 2001; Geis 1992; Horn 2006; McKean 2006; Nunberg 2001; Nunally 2000; Shuy 2004; Westerhaus Adams 2006; and Westerhaus and Butters 2003a, 2003b). As Gibbons (2004) notes, despite the

acted as consultants in trademark litigation on three issues: likelihood of confusion (discussed in Section 2 below), strength of the mark (Section 3), and propriety of the mark (Section 4). No linguist has yet, to my knowledge, dealt as an expert witness directly with a fourth issue of potential interest to linguists, dilution (see Shuy 2004; Butters 2007b, 2008). Legally defined as

the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of a famous mark and other parties, or (2) likelihood of confusion, mistake or deception [15 U.S.C. §1127]

dilution is a relatively new major concern in trademark law (The Federal Trademark Dilution Act was not added in America until 1995). For their part, linguists can assess professionally the relative importance of words and their meanings within various social realms; indeed, lexicographers must assess the relative "fame" of words in determining which words are so obscure and/or specialized that they may be safely left out of desk-top dictionaries. Moreover, ascertaining possible "lessening of the capacity . . . to identify and distinguish" is central to strength-of-mark litigation, which linguists have often addressed as expert consultants (see Section 3 below). Perhaps linguistics experts will soon more centrally engage dilution as a fourth trademark consulting area (for further discussion, see Butters 2008).

2. Likelihood of confusion

In likelihood-of-confusion cases, Company A generally owns proprietary rights to an established mark, while Company B wishes to create a new, junior mark that officials of Company A feel is confusingly close, in the three legally relevant categories of sight, sound, and meaning, to A's established or senior mark—so close that the public will mistake the products of A and B for each other, and A's business will suffer as a result.

For example, I was consulted by attorneys for the pharmaceutical firm Aventis who were attempting to prevent a start-up competitor from using the trademark
Although a layman can see that there is linguistic overlap between *Aventis* and *Advancis*, expert analysis can be helpful in demonstrating the factual bases underlying the similarities—in the three legally determinate categories of "sound," "sight" (that is, appearance) and "meaning." It is not the job of the linguist to determine whether the linguistic facts are legally significant enough to sustain or deny the lawsuit; that is a decision that only a judge or jury can make. Rather, the linguist's goal must be to assure that the court is given all of the relevant linguistic evidence upon which to base legal decisions. As is usually the case, I was asked first of all to write a report analyzing the two trademarks. Later, I would also be asked to testify about my linguistic conclusions if the case came to trial (which does not always happen in trademark cases; frequently, the parties settle out of court). Drawing upon my report and testimony in *Aventis v. Advancis*, the remainder of this section illustrates the use of linguistic expertise in approaching the legal considerations of sight, sound, and meaning.

### 2.1 The category of sight

This category embraces all aspects of the appearance of a trademark, beginning with spelling (but including also such semiotic features as color, typeface, and design).

Quantification is one approach much favored by the legal system. *Aventis* and *Advancis* share 5 of the 7 graphemes found in *Aventis* and 5 of the 8 found in *Advancis*. Thus 67% (10/15) are identical. Moreover, it is a well-accepted principle of linguistics that the beginnings and endings of words are the most important to recognition and memory. The two words begin with the same upper-case letter ("A") and end with the same two lower-case letters ("is"); in addition, the first two letters ("Av") of *Aventis* are found in the same order among the first three letters ("Adv") of *Advancis*, the letter "n" appears in exactly the same place in each trademark (the fourth letter from the end), and the two sets of variant letters also appear in exactly the same place, with vowel symbol paired with vowel symbol and consonant symbol paired with consonant symbol. In short, not only are the letters in the two words substantially the same (67%), but also the high degree of similarity in the identical placement of letters in the two marks greatly increases the difficulty that readers will have in distinguishing between them. Indeed, in terms of the selection and placement of the letters, they are quite close to being the same word.

### 2.2 The category of sound

In phonology, the two marks are even closer than their highly similar spellings indicate. I analyzed both OPTIMAL (slow and careful) and CONVERSATIONAL (or Allegro) pronunciation. While consumers will be influenced by optimal pronunciations when they think of the two words as spoken as slowly and syllable-by-syllable (as for example in saying the name of each word when reading two product labels placed side by side) the CONVERSATIONAL mode is that which is normally employed in actually speaking the names. The sequences of IPA symbols that represent the OPTIMAL pronunciations of the two marks are as follows:

\[
\begin{align*}
\text{[\textit{a\textipa{v\textipa{e\textipa{n\textipa{t\textipa{i\textipa{s}}}}}}]} \text{ for } \textit{Aventis} \\
\text{[\textipa{d\textipa{v\textipa{e\textipa{n\textipa{t\textipa{i\textipa{s}}}}}}]} \text{ for } \textit{Advancis}.
\end{align*}
\]

In CONVERSATIONAL mode, the first vowel of *Advancis* is reduced to a schwa and the [d] of *Advancis* is normally pronounced somewhat weakly, coming as it does at the end of the most weakly stressed syllable of the word and before the consonant that begins the syllable that has the primary stress. The sequences of IPA symbols that represent the Allegro pronunciations of the two marks are as follows:

\[
\begin{align*}
\text{[\textipa{a\textipa{v\textipa{e\textipa{n\textipa{t\textipa{i\textipa{s}}}}}}]} \text{ for } \textit{Aventis} \\
\text{[\textipa{d\textipa{v\textipa{e\textipa{n\textipa{t\textipa{i\textipa{s}}}}}}]} \text{ for } \textit{Advancis}.
\end{align*}
\]

In American criminal and civil law, defendants generally are allowed to waive their right to a trial by jury if they feel that it will be to their advantage. In such cases, the judge acts in effect as both judge and jury. Such trials are known as BENCH TRIALS, and they are common in trademark litigation.

3. Similarity with respect to sight, sound, and meaning is just one criterion among a number that a judge or jury must use to determine the degree of likelihood of confusion. For example, courts also may take into account the length of time the defendant has used the mark without evidence of actual confusion arising.

4. I omit throughout this chapter the large amount of explanation of technical terminology and fundamental linguistic concepts that were of necessity included in the original report and testimony.

5. In American criminal and civil law, defendants generally are allowed to waive their right to a trial by jury if they feel that it will be to their advantage. In such cases, the judge acts in effect as both judge and jury. Such trials are known as BENCH TRIALS, and they are common in trademark litigation.

6. In American criminal and civil law, defendants generally are allowed to waive their right to a trial by jury if they feel that it will be to their advantage. In such cases, the judge acts in effect as both judge and jury. Such trials are known as BENCH TRIALS, and they are common in trademark litigation.
Taking into account the stress patterns as well as the segmental phonemes, I considered a total of 19 phonemes in the two marks. In the optimal pronunciation of Aventis and Advancis, 12 – 63% – are identical. In conversational mode the number of shared phonemes increases to 14/19 = 73% (the schwa, the two primary stresses, /ɪ/ /ɪ/, two secondary stresses, /ɒ/ and /ʌ/).

Additional aspects of the phonology make the two marks even more closely alike. First, each member of the three contrasting pairs of phonemes is phonologically highly similar to its counterpart: schwa and [æː]; [e] and [æ]; and [ɪ] and [s]. The details of a distinctive feature analysis of the two marks (included in my report) are omitted here for reasons of space, but, in summary, in the highly conservative system that I employed, Aventis has 38 distinctive features: 6 for each of the 3 vowels and 5 for each of the 4 consonants; Advancis has 33, for a total of 81. Aventis and Advancis thus share at minimum 68 (81–13, or 84%) in optimal pronunciation and 72 (81–9, or 89%) in conversational pronunciation. And these percentages are even higher – between 90% and 95% for the conversational mode – if one takes into account the weak-to-nonexistent pronunciation of the [d]. Furthermore, the percentages will be even higher for speakers of dialects for whom the “e” of Aventis and the second “a” of Advancis are uttered alike.

Second, I did not consider in my account of distinctive features the important fact that the two words have exactly the same syllable count. If we replace the [d] of Advancis with the vowel [o] (and respell it Advancis) we will increase the number of syllables from three to four (and alter the stress pattern somewhat) – and we would greatly increase the phonological distinctiveness of the mark as compared to Aventis.

Yet another similar feature of the two marks is phoneme order. It would be much easier to hear and remember the difference between the two marks if the positionally identical phonemes (/ɪ/ /ɪ/, /ɒ/, /ʌ/) were arranged in different orders. For example, Aventis seems far more distinctive (in sight and sound) from Entisar, Ventisa, and Tsaven rather than from Advancis, despite the fact that these three pairs have exactly the same letters (and corresponding to the same phonemes) as Aventis.

All things considered, then, the phonology of Aventis and Advancis are extraordinarily close. The expert analysis gave the judge bases in linguistic fact upon which to base her conclusion – bases that she referenced in her written decision.

2.3 The category of meaning

Because Aventis and Advancis are recently coined words, they have no ordinary dictionary meanings in and of themselves. Courts, however, are not bound by dictionary meanings alone but rather by what the marks will mean to ordinary consumers of the products so described. Because Aventis and Advancis are pharmaceutical companies, those persons who were exposed to the two marks in commerce will most likely be doctors, potential investors, and professionals in the pharmaceutical industry and related fields, as well as patients and purchasers of drugs. The mark Aventis has been in use at least since late 1999, and the company manufactures the well-known allergy remedy Allegra and many other drugs and vaccines. Consumers and investors may therefore know Aventis as the name of a global pharmaceutical company. Advancis is an American pharmaceutical company; Advancis apparently began using the name in the fall of 2001. Advancis appears to be in the process of developing improved versions of antibiotics that the firm expects to market eventually under its Advancis mark. It thus seems clear that, while Aventis would be a familiar term to many consumers, many potential customers would not have been exposed to the term Advancis at all.

Whatever additional semantic associations speakers make with coined marks will depend largely on what ordinary words the marks remind them of. For some coined words there may be few such associations, and the hearer or reader may simply assume that the term has no meaning other than as a referent for the company that it is represented as signifying. Many made-up words can have connotations, however, and the greater the extent to which the connotations are similar, the more likely it is that the two marks will be confused. In the case of two words such as Aventis and Advancis that sound very much alike, readers or hearers may assume that the older, more familiar name is derived from the other.

Moreover, Aventis bears a connotative resemblance to words that contain the morpheme vent: adventure, advent, invent, venture, and vent itself, all of which are positive words suggesting forward motion and innovation, both metaphorical and real. In addition, it is well known that Latin and Greek are important source languages for scientific names; given that Aventis has a vaguely Latin look about it, speakers may conclude that Aventis is somehow derived from Latin. Similarly, Advancis bears a phonological and graphemic resemblance to the positive word advance, which also suggests forward motion and innovation both metaphorical and real. And Advancis likewise has a vaguely Latin look about it, so speakers may conclude that it, too, is derived from Latin.

The high degree of overlap in this common semantic core of meanings assignable to the connotations of Aventis and Advancis thus further serves to inhibit the hearer’s and reader’s use of meaning as a way of differentiating the two marks. Indeed, the connotations actually draw the two terms closer together in their common association with forward movement and innovation.

7 See the web sites of Aventis (http://www.sanoﬁ-aventis.us/live/usa/en/index.jsp) and Advancis (http://www.advancispharm.com/), now Middlebrook Pharmaceuticals, Inc.
2.4 Summary of the use of linguistic analysis in likelihood-of-confusion cases

The methodology used in the case just described is typical of that which consulting linguists use in ascertaining the bases for likelihood of confusion between a senior mark and a junior one. In this case, the discussion of sight issues centered largely upon comparisons of the spelling of the two marks. In some cases where brand names are given extensive public exposure through advertising, prominence in packaging, and internet addresses, it may be necessary for the linguist to take into account such sociolinguistic features as appeal to particular social groups and such semiotic display features as color, typeface, and package and logo design. In other cases, data for the treatment of sound may be found in spoken renditions of the trademarks as represented in advertising, films, and the like. Finally, the Aventis/Advancis case was relatively simple with respect to meaning, because the two marks are coined words, lacking in dictionary meaning but with fairly obvious connotations that further their confusability.

3. Strength of mark

In strength-of-mark cases, Company A (or, in registration disputes, the government) claims that Company B’s trademark (say, Steakburger or Kettle Potato Chips) is so basic and descriptively necessary that Company A will be unfairly constrained from advertising and promoting its own products. Suppose, for example, that The Walt Disney Company were allowed to register the term theme park as a service mark. Such a registration would work a precarious hardship on Sea World, Bush Gardens, Universal Studios, and other theme-organized amusement parks, who would find it next to impossible to accurately describe their own enterprises to the public without using the words theme park as a descriptor.

Courts and the United States Trademark Trial and Appeal Board evaluate how “strong” a trademark may be by determining its place on a semantic/pragmatic continuum of categories technically labeled (1) arbitrary, (2) fanciful, (3) suggestive, (4) descriptive, and (5) generic. The terms strong and weak refer to how safe a mark is from being challenged by a competitor on the basis of its place on the continuum of strength of mark. In such litigation, the parties are disputing which of categories (1)–(5) the mark falls in. Typically, one party will claim that its mark is suggestive (or at worst descriptive but famous); the other party will claim that the mark is generic (or at best descriptive but not famous).

Fanciful and arbitrary marks are the strongest because they have no core semantic relationship to the product or service at all. Fanciful marks are coined words – for example, Exxon, the brand name of a major oil company, and Aventis and Advancis (the marks discussed in Section 3 above). In contrast, arbitrary marks are real words, but ones that have no ordinary meanings that the speakers of the language can associate with the product or service, either denotatively or connotatively, except as a brand name. A frequently cited example is the use of Apple as a trademark for (1) a brand of computers and (2) a music recording company.

Suggestive marks are also considered strong in their own right. Trademarks in this class do not literally describe the product or service offered to the public, but they do have meanings that the purchasing public is likely to associate connotatively with the product or service so designated. For example, the trademark Mustang as the brand name for a type of automobile presumably conveys positive associations of swiftness and power that stem from the image of a horse that the word mustang can convey to speakers of English. Similarly, the names of sports teams, such as Redkings and Vikings, are intended to convey the positive image of powerful and dedicated warriors.

Membership in either of the other two categories puts a trademark in danger of being lost as a proprietary name. Descriptive marks are the weaker of this weak pair. Their meaning directly describes some important feature of the product or service, and according to law they may gain legal status as protectable trademarks only if they have become famous among the purchasing public. Technically, “fame” is achieved when a mark has acquired a great deal of what is called secondary meaning, i.e., the association in the public mind between the company and the brand name is so strong that it has characteristics of being a widely recognized lexical item in its own right. For example, General Motors is arguably a descriptive mark for an automobile manufacturer, since motors describes one of the most important features of the company’s products (and general is a vague and weak adjective that could apply to many commercial enterprises). Even so, General Motors clearly enough has secondary meaning for Americans to be protectable.

In other cases, however, fame is not so apparent. For example, I consulted several years ago on a case about the word zingers, which in American English can be a concrete noun meaning “food that has a piquant or spicy flavor.” It could thus be argued that zingers is descriptive of such food. Various businesses in the United States use the term zingers to designate piquant menu items, including pieces of chicken served in spicy hot sauce. The public does not, moreover, strongly associate this term with any particular commercial source; that is, the term has not acquired significant secondary meaning with respect to a particular seller. To the extent that no one is famous for their Chicken Zingers, it is merely a descriptive term, without legal secondary meaning, when applied to menu items.

Generic marks are impossibly weak: if judged to be a member of this class, a word can never be used as a trademark for the type of thing so designated. Such
words name not a brand of product or service but the kind of product or service itself. For example, automobile names a kind of product of which there are many brands, and so automobile cannot ever be a brand name for an automobile (though it could conceivably be so for a brand of toothpaste). The rationale for this is simple: if merchandisers were allowed to own generic terms, then there would be no straightforward way for their competitors to refer to their own products. This would not only be confusing to the purchasing public, but it would also give the owners of the generic mark an unfair advantage in the marketplace. In two cases in which I was a consultant, for example, courts ruled that both steakburger and kettle chips are generic terms because they mean, respectively, simply 'burgers (or ground meat) made from steak' and 'chips cooked (by hand) in a kettle or having the recognized qualities of chips cooked in this way.' Likewise, The Air Shuttle litigation (mentioned above, §1) involved that mark's alleged genericness. Basing his reasoning at least in part on Stein's testimony (and discounting Read's arguments), the judge in the case denied Eastern's claim to ownership, ruling that air shuttle as used in the airline industry has always been generic, and thus it is generally available for all airlines to use. Similarly, the alleged "genericness" of opry was at issue in the case in which Cassidy participated (see Section 1). Cassidy's testimony and report have not been preserved, but in his decision the trial judge noted that Cassidy testified that opry was "generic," a view that, while still subject to legal and linguistic debate, prevailed in that court, though not in others (see Butters and Jackson 2005).

The legal definition of genericness is somewhat different from the meaning usually assigned to the term in linguistics (or ordinary English), but the legal meaning can be readily understood in a sociolinguistic and lexicographical framework: a term is generic if, in the minds of the members of actual and potential consumers, the term denotes the product or service itself (e.g., aspirin, automobile, theme park), not the name of a brand of product or service (e.g., Bayer, Ford, Disneyland). The problem for courts thus becomes how to ascertain the linguistic knowledge of this relevant population. The law makes a distinction between the commercial meanings that typical consumers actually attach to a trademark and the shorthand (or, to use the technical linguistic term, synecdochically) uses that a consumer may make of that trademark. For example, speakers sometimes use Xerox, a famous brand name for photoduplicating machines and related products (paper, ink), to refer in general to photocopy machines or to the process of photocopying in general (or even to photocopying machines not marketed under the Xerox trademark). Similarly, users of internet search engines sometimes use the word Google as a verb in the sense of 'perform an internet search'—even when the search is carried out using a Google competitor such as Yahoo or Just Ask. These usages, however, do not necessarily denote that most internet users and photocopy customers do not know that Google and Xerox are trademarks. Of course—as has sometimes happened in the past—repeated synecdochical uses of a trademark may become so ubiquitous that a lexicosemantic change takes place in which consumers actually lose all meaningful connection between the mark and the company that has been the source of origin of the product. A host of trademarks evolved in this way in earlier days: aspirin, escalator, and trampoline, for example (in the United States, at any rate). Lawyers use the term genericide to denote the process whereby trademarks lose their identification as brand names and become generic. Because of modern advertising and marketing techniques, as well as vigilant legal policing by trademark owners, genericide is relatively rare today, though as recently as 1988 the mark Murphy Bed was found to have become generic.

Courts thus do not declare a term to be generic merely because speakers or writers may sometimes—or even frequently—use the term in a shorthand way. The legal question of concern in determining genericness is not simply, "What do people sometimes (or even frequently) say and write?" but rather, "What do people believe about the meaning of the words that they are saying and writing?" Unlike jurors and attorneys, linguists—especially those with expert knowledge of lexicography—have developed explicit methodologies for distinguishing between (1) the knowledge (conscious and unconscious) that speakers have of their language and (2) their actual linguistic behavior.

When linguists are engaged as experts in strength-of-mark litigation, the courts are usually being asked to determine the putative genericness or descriptiveness of a mark. The role of the linguistics expert is to gather the linguistic evidence that bears upon an assessment of the public's understanding of the mark in question with respect to the categories generic, descriptive, and suggestive, and

---

8. For the technical definition within the field of linguistics, see Crystal (2003, 159, GENERIC: "A term used in grammatical and semantic analysis for a lexical stem or proposition which refers to a class of entities," e.g., "the bat is an interesting creature, bats are horrid, the English/French, ..."

9. Marks often mentioned as strong candidates for contemporary understanding include Prisbee, Contact Paper, and even Band-Aid. Clankie (2002) presents a large list of trademarks that he concludes, based on anecdotal evidence, have become "generic." While it is true that many of the terms that he lists are sometimes used in a synecdochical way, in general they have not been seriously contested in courts of law, and thus no one has tried to establish that the public actually perceives them as unrelated to the businesses who own the trademarks. See also Landau (2001:405–408), who argues that, because Band-Aid is often used metaphorically and synecdochically, dictionary makers should treat it "generically." For discussion to the contrary, see Butters and Westerhaus (2004).
in the case of marks alleged to be descriptive, the relative fame of the mark. Frequently, the federal government will reject a proposed new mark on the grounds that it is merely descriptive or even generic, and the applicant will appeal the decision, either to the Trademark Board or in Federal Court. At other times, the holder of a senior mark may bring suit against what they feel to be an infringing mark, only to find that the putative infringer claims as justification that the senior mark is either generic or merely descriptive and without sufficient secondary meaning.

The law recognizes several sources of data in strength-of-mark cases, two of which are especially relevant to the expertise of linguists.

One is direct questioning of the relevant population, which in current legal practice is generally undertaken by market researchers who have typically had little or no linguistic training. Although linguists tend to be skeptical about marketing surveys, knowing that it is easy enough to ask questions that merely generate the answers that one wishes to generate, even so, survey methodology has been fruitful in such well-designed lexicographical projects as the *Dictionary of American Regional English* and other studies of social and regional dialect variation. Reputable market researchers can produce scientifically responsible work, and the involvement of linguists in designing market surveys can be especially fruitful.

The chief contribution of linguists to descriptiveness/genericness disagreements in trademark litigation, however, has come through employment of the traditional inductive, empirical methodologies of lexicographers and sociolinguists: one assembles a relevant and representative body of data and concludes, on the basis of the evidence found in that assembled data, what the meanings of the words are for those who generated the data. Because dictionaries are themselves based upon this methodology, it is understandable that dictionary evidence has long formed a part of what courts have considered valuable evidence. Likewise, courts today consider the rigorous application of lexicographical methodology to be usefully probative with respect to obtaining up-to-the-minute information and to narrowing the field of inquiry down to the relevant population.

Until recently, the problem for the linguistic expert has been how to find a source of reliable, relevant data beyond dictionaries themselves. Such pioneers as McDavid, Stein, Read, and Cassidy, working usually with access to the resources of a dictionary publishing firm, faced enormous difficulties in trying to put together adequate and reliable synchronic and diachronic data to form meaningful conclusions beyond what they could ascertain from dictionaries themselves. On their own, they could only carry out limited (and potentially biased and anecdotal) reading of current newspapers, magazines, and novels.

Computers and the internet, however, have changed all this. Linguists preparing reports on trademark issues now have a wealth of primary data that they can draw upon. These include millions of machine-searchable small-town newspapers available on web sites such as NewspaperArchive.com; nationally circulated newspapers and magazines that can be accessed using ProQuest and LexisNexis; the individual archives of most American newspapers and magazines, small and large, generalized and specialist; Google Book Search, which includes many historical dictionaries; a wide swath of scholarly journals that over the years have commented extensively on the changing vocabulary of American English; data banks of literary works; and archives of letters, diaries, journals, reports, and the like. In addition, one can also search the Internet itself for examples of contemporary usage: How, for example, do customers themselves use the term *kettle* on web sites dedicated to consumer commentary about potato chips? Where before the linguist researching trademark issues had too little data, now the chief difficulty is narrowing down what is available to the most relevant and reliable.

4. **Propriety of mark**

**Propriety-of-the-mark** cases are relatively rare in forensic linguistic work. According to federal statute, trademark registration is not allowed for any mark that "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute" [15 USC 1052]. Such cases thus usually stem from the government’s refusal to register marks that the United States Patent and Trademark Office’s Trademark Trial and Appeal Board concludes violate these provisions. When linguists were consulted in the three cases I know about, the government claimed that the trademark was scandalous (as in *Fat Bastard Wine*) or disparaging (as in the two cases I have worked on: *Redskins*, the name of a professional football team, and *Dykes on Bikes*, the name of a San Francisco lesbian motorcycle club).10

One issue is the legal meaning of the statute’s word *disparaging*, which in most dictionaries indicates intent to offend on the part of the user. Clearly, neither *Redskins* nor *Dykes on Bikes* is intended to offend. However, courts tend to see this distinction as hair-splitting: if the term in question is deemed significantly offensive to a large enough group of people, that in itself seems sufficient for courts to deem the term *disparaging*, especially if those who feel offended also offer

---

10. Although no professional organization of linguists has ever taken a position on the issue of disclosing one’s consulting history in discussion of cases in scholarly publication, I note here that I have consulted with the attorneys for the side that prevailed in court in all of the cases just referenced, except for *Fat Bastard Wine* (for which I had no role whatsoever).
evidence that the commercial use of the putatively offending term may "bring them into contempt, or disrepute."

A second issue is that of the strength of the offensiveness — in particular, whether the word is intrinsically offensive, or just offensive under certain circumstances. Virtually any epithet can be used in a offensive manner — liberal, for example, in recent American political utterances. While dyke, a colloquial synonym for lesbian, can be offensive when used as a contemptuous epithet, it is difficult to see how it could be seen as offensive when used by members of a lesbian motorcycle club in reference to themselves. Bowing to such explanations of the linguistics of pejorative terms, the Trademark Board eventually allowed the mark Dykes on Bikes to be registered.

The owners of the Redskins football team have also managed to preserve their trademark rights to the name, but only after the Trademark Board’s ruling against them was overturned in federal court. After years of legal wrangling, the case still goes on in various forms. On the challengers’ side, a linguistic expert put forth a number of examples of the use of redskin as an epithet in racist diatribes, and they also relied upon a telephone survey concerning the use of the term redskin in which nearly 50% of those questioned had some concerns about the offensiveness of the term redskin. The team’s side (for which I served as one of two linguistics experts), argued that the survey was defective and that the racist diatribes themselves were the cause of the offensiveness, not the word redskin per se; moreover, the use of a term by racists scarcely tells us what the general population thinks about a word. Further team arguments centered upon the lack of offensiveness within the specific context of the historic use of the name as a sports team name, noting also that sports teams are scarcely selected to convey anything other than positive images of those so named (e.g., Vikings, Yankees, Packers, Stealers). Numerous citations from literature and the media showed essentially benign uses, as in the classic children’s story, Peter Pan (a film version of which the opposing linguist testified he had watched more than once with his young daughter). Nor has the putative offensiveness of the word redskin forced the abandonment of the term in other uses (potatoes, peanuts) as is usually the case with seriously offensive terms (as when Brazil nuts replaced an especially hateful epithet for African Americans).

5. Conclusion

This chapter should only be a starting place for those who wish to become a consulting linguist and pursue the scholarly relationships between linguistics, lexicography, and trademark litigation. Two books should be the next stop for the

interested linguist. Shuy (2002) takes up a number of issues with respect to trademark consulting practice, many of which go beyond what I have addressed here. More recently, Shuy (2006) offers fundamental advice for anyone interested in a forensic linguistic career, whether in trademark litigation or in any other field.

I have no explanation for why the involvement of linguists in trademark cases is apparently confined largely to North America. It is to be hoped that this chapter will offer ideas to linguists in other venues so that applied linguistics can extend to the trademark courts of other countries as well.

References


