TRADEMARK HYBRIDITY AND BRAND PROTECTION

Timothy Denny Greene†

What’s in a word? As it turns out, quite a lot. The vast majority of words in our language, including trademarked terms, signify a variety of conceptual meanings and senses. This idea of splintered definition—described in the psycholinguistics literature as “semantic ambiguity” and offered in two flavors, “homonymity” (divergent and unrelated meanings) and “polysemousness” (divergent yet related senses)—is underrepresented in trademark law. As a result, there has been a proliferation of legal doctrines that fail to accurately describe our linguistic lives including, most notably, dilution and genericness. This article draws on the psycholinguistics literature to highlight these doctrinal failures and proposes several ways in which the law might account for polysemousness and homonymity. In addition to bringing the law into line with the lived experience of language, these changes have the added benefit of promoting the communicative and competition interests at the heart of trademark law.

INTRODUCTION

What does the word “fly” mean? It could mean beautiful (“Shorty stay fly, that’s why I keep her”),1 an insect of the order Diptera (a fruit fly), the opening on the front of a pair of pants (“zip your fly”), a ball hit into the air in baseball (a “pop fly”), or a particular route a wide receiver runs in football (“Vernon Davis is the NFL’s premier fly route runner”). These definitions are context dependent—linguistically, visually, and spatially. They are also minimally confusing when the context is clear. If someone says she “caught a fly,” she could mean different things. And whether you understand her to

† Fellow, Stanford Law School, Center for Internet and Society. Thanks to Jeff Wilkerson, James Tierney, Andrew Gilden, and Jonathan Masur for valuable comments, criticisms, and conversations regarding the arguments set forth in this article. Thanks to Micah Goldwater and Gregory Murphy for sharing their psycholinguistic expertise.

1 50 Cent, Do You Think About Me, BEFORE I SELF DESTRUCT (Aftermath 2009).
mean she trapped a bug or intercepted a baseball will depend on where she was, what she has in her hand (a baseball mitt or a bell jar), and so on.

This kind of context specific meaning is well recognized across academic domains. Yet (with certain exceptions discussed below) trademark law generally overlooks the idea that a term can connote separate concepts without confusing consumers. This overlooked idea has important implications for various trademark doctrines.

Most words are ambiguous. They are “polysemous” or “homonymous.” Homonymy is perhaps easier for the lay reader to understand—homonymy refers to words that have unrelated meanings by historical accident, more or less. To take one simple example, ‘bank’ may refer to a financial institution or, among other things, a river’s edge. Polysemy, by contrast, is a bit more difficult to understand but is, in fact, much more pervasive than homonymy. Polysemy refers to the phenomenon whereby words develop related meanings (“senses”), often through productive relationships found in most words in a semantic domain. For example, ‘paper’ may refer to, among other things, a material on which writers write (a piece of paper), a newspaper (I’m going to pick up the paper before heading into the office), an entity that runs a newspaper (the paper just fired five journalists), and so on. So, homonymy refers to unrelated meanings, while polysemy refers to related meanings, referred to as ‘senses.’

This article mines psycholinguistics research on how people actually resolve these ambiguities in real time to determine how this “semantic ambiguity resolution” is applicable to trademark law. To take a simple example, many firms make “thermoses,” including Stanley, Aladdin, and Thermos LLC (the successor to the original THERMOS mark) Although Thermos LLC cannot prevent Stanley and Aladdin from calling their products “thermoses,” Thermos LLC continues to operate a very strong brand using a stylized version of THERMOS as a trademark. In the market for vacuum bottles, Thermos LLC distinguishes its THERMOS brand from other producers’ vacuum bottles based on contextual features used with the term. If someone asks “can you get me a thermos?” your answer may depend on spatial clues. Are you online at Amazon.com, shopping a smorgasbord of vacuum bottles? You may be likely to order the THERMOS-brand bottle. Are you in a kitchen? You might reach for any brand vacuum bottle (THERMOS or not) rather than a coffee mug. And if you have a choice among vacuum bottles, you might select based on a visual cue: the particular stylized font Thermos LLC uses for its

---

2 See, e.g., LEXICAL AMBIGUITY RESOLUTION: PERSPECTIVES FROM PSYCHOLINGUISTICS, NEUROPSYCHOLOGY, AND ARTIFICIAL INTELLIGENCE (Steven L. Small, et al., eds. 1988). See also infra Section I.A.

3 Though the idea certainly hasn’t escaped scholars. See, e.g., Laura A. Heymann, The Grammar of Trademarks, 14 LEWIS & CLARK L. REV. 1313, 1342 (2010) (“The use of the lowercased (by implication in aural speech) ‘coke’ does not indicate that ‘Coke’ no longer serves as a proper name; rather, it simply means that the lowercased form is used to refer to a category of similar items (‘drinks that are like Coke’), just as ‘xerox’ is often used to refer to a category of photocopierns, of which ‘Xerox’ is one, and ‘tylenol’ is used to refer to the drug with the formulaic name of acetaminophen, of which “Tylenol” is a particular brand name.”); Rochelle Cooper Dreyfuss, We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent?: Deconstructing the Lanham Act and Rights of Publicity, 20 COLUM.-VLA J.L. & ARTS 123, 149 (1996) (“If, indeed, symbols are routinely assigned multiple meanings, the law ought to start from the premise that audiences have a great deal of experience with confusing signals and that, absent a specific reason to believe otherwise, the interpretive strategies that a listener ordinarily pursues will also be used in the marketplace.”).

4 One good example of polysemy’s natural occurrence is provided by Albert Hirschman, who traced the semantic drift of the term “interest” in the first chapter of his book The Passions and the Interests. See ALBERT O. HIRSCHMAN, THE PASSIONS AND THE INTERESTS 31–41 (1977). As Hirschman shows, the term “interest”—as in “self-interest” or “interest groups”—began as something of a catch-all for “a disciplined understanding of what it takes to advance one’s power, influence, and wealth.” Over time, “interest” took on a more constrained definition, connoting only “material, economic advantage.” Id. During this period of drift, various thinkers tried to tie down the word’s meaning to no avail.

5 King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963) (affirming the district court’s decision that “thermos” had become generic for vacuum flasks).
company logo. To take an example closer to this author’s heart, a trademark lawyer’s understanding of what a speaker means by “Abercrombie” will likely depend on whether the conversation is about trademark law or the lawyer’s teen daughter.⁷

We shouldn’t be surprised that terms can carry multiple significances—here, at least two: generic product and specific brand.⁸ Yet the law usually doesn’t recognize it. Ralph Folsom and Larry Teply recognized this false binary as early as 1980, but it still remains for the most part unaddressed in the law.⁹ Following their lead, in this article I use the term “trademark hybridity” to refer to trademarks’ ability to simultaneously connote a variety of meanings and senses. But trademark hybridity isn’t limited solely to product and brand significance¹⁰ as Folsom and Teply implied. In addition to trademarks’ value in signifying source and raising brand awareness, they are also used expressively,¹¹ nominatively,¹² and descriptively.¹³ Through their adoption as cultural signifiers, trademarks are necessarily infused with social meanings.¹⁴ A given term need not be understood only as a generic term or only as a source-identifier. Indeed, a term cannot merely be understood as such. Rather, all terms—and perhaps especially trademarks¹⁵—embody multiple concepts with little quantifiable (internal or external) confusion. People use context to provide semantically ambiguous words with meaning in every sentence we speak, hear, read, or write.

Legal scholarship has not addressed whether semantic ambiguity resolution in the trademark context follows the same model as regular language. Filling that gap, I propose here a hypothesis about trademarks and ambiguity resolution, as well as a preliminary sketch of a follow-on empirical research agenda. There are three elements to

---

⁸ Cf. ADAM ARVIDSSON, BRANDS: MEANING AND VALUE IN MEDIA CULTURE 8 (2006) (“[B]rands do not so much stand for products, as much as they provide a part of the context in which products are used. This is the core component of the use-value that brands provide consumers with.”).
¹⁰ For clarity, Folsom and Teply do not use “product” and “brand” significance to describe dual hybridity. Rather, they simply focus on a trademarked term’s “product” and “producer” senses.
¹¹ See ESS Entm’t. 2000 v. Rock Star Videos, 547 F.3d 1095, 1100 (9th Cir. 2008) (“[O]nly the use of a trademark with “‘no artistic relevance to the underlying work whatsoever’” does not merit First Amendment protection. . . . In other words, the level of relevance merely must be above zero.”) (quoting Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 902 (9th Cir. 2002); Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989)) (emphasis in original).
¹² See New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302 (9th Cir. 1992) (affirming district court’s judgment in favor of defendants based on the argument that “New Kids” was used to refer nominatively to the New Kids on the Block); Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350, 352 (9th Cir. 1969) (in “advertising [the repair of Volkswagen cars, if] would be difficult, if not impossible, for appellee to avoid altogether the use of the word ‘Volkswagen’ or its abbreviation ‘VW,’ which are the normal terms which, to the public at large, signify appellant’s cars.”). See also Prestonettes, Inc. v. Coty, 264 U.S. 359, 368 (1924) (Holmes, J.) (“When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.”).
¹⁴ Cultural studies scholarship has much to contribute to our understanding of how trademarks are reconstituted, reappropriated, and reused in culture. See, e.g., SARAH BANET-WIEBER, AUTHENTIC (2012) (illustrating the ways in which various cultures, such as contemporary religion and femininity are increasingly understood within the language of brands); ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW (1998) (describing how intellectual property protection both restricts and compels certain types of cultural appropriation).
¹⁵ See generally COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES, supra note ___ (discussing how trademarks and logos constitute an increasingly large part of contemporary cultural dialogue).
the hypothesis. First, word marks are linguistic, and there is little reason to think trademarks exhibit psycholinguistic characteristics that distinguish them fundamentally from all other words. Even if consumers process trademarks as proper nouns, they still use context to disambiguate such words. Second, semantic ambiguity resolution research reveals that context is king. Rarely (if ever) do consumers encounter trademarks acontextually, and it seems likely such contextualization works to allay any concerns we might have about genericness or dilution harms. Third, even if consumers experience statistically significant confusion when presented with appropriate context, it is less likely that those harms would be commercially significant—that is, that the effects would or might alter consumers’ decisionmaking.

Although trademark hybridity is barely recognized in the law, it is quickly becoming more important for commerce and communication. Markholders are aggressive and sometimes brazen in seeking broad protection for their marks, much more so than ever before. In so doing, markholders use the legal trademark monopoly in an effort to attain market monopoly status by controlling the conversations regarding their brands.16 This model of trademark protection assumes that diverse meanings will muddle those markholders’ brands to their detriment. But the science does not sufficiently support that assumption or the markholders’ view.

Instead, trademark has become a system in which Chipotle Mexican Grill, Inc. can credibly sue Jack in the Box for selling a “chipotle chicken club,” arguing Jack in the Box’s use will dilute the connection in consumers’ minds between “chipotle” and CHIPOTLE. This system stifles communication and competition. By recognizing trademark hybridity and tailoring trademark doctrine to fit its teachings, we can improve the system.

Section I builds off the brand theory of trademark law to describe trademark hybridity. It disaggregates the two primary types of legally relevant significances a term used as a trademark can hold: product significance and brand significance. Section II surveys several major doctrines where trademark hybridity remains unrecognized in trademark law—from flawed surveys to fractures in the foundation of dilution law, hybridity’s implications are legion. Section II further considers the consequences of courts’ neglect of trademark hybridity, and how they have thereby uncritically incorporated inefficient brand theory concepts into trademark law. Section III follows these criticisms by suggesting new avenues of thinking about how consumers actually deal with trademarks and language.

I. TRADEMARK HYBRIDITY

Trademark language is slippery. Judge’s, practitioners, and scholar use “trademarks” and “brands” interchangeably, often without a real understanding that “brands” is a different and considerably broader set. This is in part because scholars often apply marketing literature to trademarks without due care for systematically distinguishing between them.17 Judges apply rules to brands without regard to the fact

---

16 Mark A. Lemley & Mark P. McKenna, Owning Mark(et)s, 109 Mich. L. Rev. 137, 140 (2010) ("[U]ltimately, the free-riding claims [of markholders] are even more sweeping than ownership of marks: trademark owners sometimes are effectively asserting the right to own markets themselves because . . . the relevant market owes its origin to their brands."). See also Timothy Denny Greene & Jeff Wilkerson, The Circular Character of Trademark Control (unpublished manuscript 2013).

17 See, e.g., William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, 30 J.L. & Econ. 265, 270 (1987) ("The value of a trademark is the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand . . ."); Desai & Rierson, supra note __, at 1797 ("For if a brand is an
that what they are dealing with is only the trademarked term.\textsuperscript{18}

Trademark law’s origins lie in the control of commercial language.\textsuperscript{19} The law has since outgrown those origins, such that trademark’s scope now covers nearly anything that can signify some consistent source as a trademark.\textsuperscript{20} Courts and legislatures have consistently expanded the scope of trademark protection to incorporate brand concepts. Meanwhile, many trademarks contain vestigial remnants of their origins, when producers had limited means of differentiating their products from others. Back then, a trademarked term was the primary legally protectable means of differentiating one producer’s product from another’s.\textsuperscript{21}

This tension is a problem. A trademark is traditionally defined as a term—later, sounds, shapes, and so on—used in connection with goods or services that signifies their source. By contrast, branding refers to the “durable identity and [consumer] loyalty” developed through producers’ use of design, packaging, logos, graphics, marketing, and other related strategies.\textsuperscript{22} The durable identity and loyalty of branding, along with expressive social meanings that become attached to the identity and the mark over time, are what we refer to as the\textit{ brand}.\textsuperscript{23}

In addition to the simple source-identification character a term or logo may have, it may also be used for other purposes, such as signaling status or affinity with a social group.\textsuperscript{24} Understandably, markholders have long utilized the courts in an attempt to

---

\textsuperscript{18} See, e.g., Ty Inc. v. Softbells’s Inc., 353 F.3d 528, 531 (7th Cir. 2003) (Posner, J.) (on determining that a mark is generic, Judge Posner wrote: “[I]t may confuse consumers who continue to associate the trademark with the owner’s brand when they encounter what they thought a brand name on another seller’s brand”); E.I. Du Pont de Nemours & Co. v. Yoshida Int’l, Inc., 393 F. Supp. 502, 527–28 (E.D.N.Y. 1975) (in the paradigmatic TEFLO\textsuperscript{n} case, the court found persuasive a survey that asked respondents whether certain product names were “brand name[s] or trademark[s]” or generic names. See also In re Trek 2000 Int’l Ltd., 97 U.S.P.Q.2d 1106 (T.T.A.B. 2010) (despite significant evidence of consumer usage of THUMBDRIVE as a generic term, the T.T.A.B. credited evidence that “certain of the media outlets present in the examining attorney’s evidence have agreed to cease misuse of the term” and the absence of competitors using the term, and thereafter found that the mark was not generic).

\textsuperscript{19} Whether these origins were normatively propelled by consumer protection or producer protection is very much a subject of debate in trademark scholarship. Compare Mark P. McKenna, \textit{The Normative Foundations of Trademark Law}, 82 NOTRE DAME L. REV. 1839, 1849–96 (2007) (arguing early trademark law was premised on protecting producers against “unfair” competition) with Glynn S. Lunney, Jr., \textit{Trademark Monopolies, 48 EMORY L.J.} 367, 417 (1999) (“Ownership was assigned to the person who adopted the mark for her trade, not because she had created it or its favorable associations, but because such person was conveniently placed and strongly motivated to vindicate the broader public interest in a mark’s ability to identify accurately the source of the goods to which it was attached.”); William M. Landes and Richard A. Posner, \textit{The Economics of Trademark Law}, 78 TRADEMARK REP. 267, 267 (1988) (arguing trademark law “tr[ies] to promote economic efficiency”); Stacey L. Dogan & Mark A. Lemley, \textit{Trademarks and Consumer Search Costs on the Internet}, 41 HOUS. L. REV. 777, 778 (2004) (arguing the historic normative goal of trademark law is to reduce search costs by fostering information flow in markets).

\textsuperscript{20} See J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION Ch. 7 (4th ed. 2013) (outlining the variety of subject matter in which a trademark may be claimed, from words to color to fragrance and flavor). See also Qualitex Co. v. Jacobson Prods. Co., Inc., 514 U.S. 159, 162 (1995) (“Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”)

\textsuperscript{21} See Glynn S. Lunney, Jr., \textit{The Trade Dress Emperor’s New Clothes: Why Trade Dress Does Not Belong on the Principal Register}, 51 HASTINGS L.J. 1131 (1999) (describing the allowance of trade dress registration as an accident of history); McCARTHY, supra note \textsuperscript{18} at § 7.94 (recognizing Congress’s initial decision not to permit trade dress registration on the principal register). See also Lunney, \textit{Trademark Monopolies, supra note} \textsuperscript{18} at 373–91 (arguing that Congress did not intend to protect trade dress under the Lanham Act).


\textsuperscript{23} See Timothy Denny Greene & Jeff Wilkerson, \textit{The Circular Character of Trademark Control} (unpublished manuscript 2013). See generally COOMBE, \textit{THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES}, supra note \textsuperscript{22}.

\textsuperscript{24} See Barton Beebe, \textit{The Semiotics of Trademark Law}, 51 U.C.L.A. L. REV. 621, 624 (2004) (“In asserting that trademarks do no more than facilitate search and encourage quality, the [Law and Economics school] has long declined to
control these concepts. In myriad ways courts have helped markholders expand the law to govern these concepts without due regard for the implications of the approach. As a result, trademark law has become inefficient, frayed and unwieldy. Trademark hybridity offers one way of thinking about how to update trademark law to today’s brand practice.

As I explain here, trademark hybridity means that a given term can be understood to connote multiple separate, and, to some extent contradictory, ideas, persons, things, and so on. Later in this section, I draw on Deven Desai’s work on trademarks and brands to describe contemporary trademark law through a brand lens, showing how the law has come to protect “brands,” rather than “marks.” This development grants producers a broad protectable interest in the word marks they adopt. The inconsistency between this high level of protection and trademark hybridity may be descriptively acceptable, but is, for the reasons described below, normatively unworkable.

A. Semantic Ambiguity

Words nearly always refer to more than one concept, in which case they are semantically ambiguous. For example, much like the word “fly” above, the word “bank” has multiple definitions. As a noun, it can be a financial institution, river curtilage, or snow pile. As a verb, it can be a shot off the glass in basketball or a shot off the rail in pool. Semantically ambiguous words like “fly” and “bank” can be ambiguous in two ways: (1) they can have separate unrelated meanings (like “bank” for a financial institution or a snow pile); or (2) they can have separate related senses (like “fly” for the process by which an object moves through the air without direct support or a “fly,” an insect that “flies”). Again, words with separate unrelated meanings are homonymous, while words with separate related meanings (senses) are polysemous.

Trademarked terms (and words) are often—in fact, almost always—polysemous. BUICK may refer to a particular brand of car, but it is also a traditional Scottish surname, an English geographical place name, and an American slang term for vomit. Descriptive marks—like CLEAN & CLEAR—are explicitly polysemous; these terms correspond to preexisting terms and are adopted in senses adjacent to the original term’s definition (CLEAN & CLEAR will, hopefully, make your skin “clean and clear”). By contrast, arbitrary marks—like APPLE for computers—are homonymous; they create a new, typically unrelated meaning for the term apart from its original meaning.

Even sui generis marks—such as fanciful marks like KODAK for cameras or merged personal name marks like ROLLS-ROYCE for cars—often become polysemous over time as consumers come to utilize them in everyday language. For example, saying...
something is the “Rolls-Royce of its class” refers to the trademarked term, but also uses the term metaphorically in the sense of “high-quality.” This temporal tendency towards polysemy is the psycholinguistic process through which trademarked terms can become generic. For example, “thermos” may now refer to the product or the brand, although at the time the term was adopted, it presumably referred primarily to the term. Similarly, homonymy is the process through which trademarked terms are allegedly diluted. Dilution’s harm is said to arise from the creation of an alternate definition for the term—the paradigm example of dilution is where a producer adopts a preexisting well-known term (BUICK perhaps) for use on unrelated goods or services (aspirin). The producer’s worry is that consumers will unwittingly attribute positive or negative affective responses to undeserving producers—BUICK no longer refers just to cars made by one firm, but to medicine made by another as well.

But the advent of a new sense for a word does not necessarily crowd out the other senses. Rather the new definition becomes enmeshed in our mental representation of the term. These related senses (and, for that matter, unrelated meanings) remain representationally distinct in our minds despite their linguistic adjacency. Whether one sense (or meaning) or another is intended in a sentence depends on the context in which the term is used. When I ask for a “thermos,” the context in which I ask clarifies intended meaning and reduces ambiguity. Context, in other words, resolves the semantic ambiguity quickly and nearly effortlessly. This observation is quite important because trademarks are almost never encountered without some disambiguating

---

20 See Devorah E. Klein & Gregory L. Murphy, Paper Has Been My Ruin: Conceptual Relations of Polysemous Senses, 47 J. MEMORY & LANG. 548, 549 (2002). Klein and Murphy provide the example of “paper.”

As an example, paper originally referred to a writing material, but it has evolved to mean the substance normally used to make that material, the content of some writing, and even an oral presentation of that content—so that we can now deliver a paper without using any paper to do so. Other direction in which paper has been extended include the news source (newspaper), which has been stretched to refer to the company that publishes a paper, a representative of the company, and even the editorial policies of the company... The material sense has also expanded to encompass financial notes, wall coverings, and gift wrap. There is a continuum of polysemy, in which closely related senses can be repeatedly extended so that ‘adjacent’ senses are closely related, but the more distant ones have little apparent connection.

Id. (citing D.A. CRUSE, LEXICAL SEMANTICS (1986)). “Rolls-Royce” would not mean “high-quality” without some relationship between the term “Rolls-Royce,” the producer of Rolls-Royce automobiles, and those cars’ high quality.

21 “Thermos” also meant “temperature regulation” when the term was adopted as a mark. The trademark meaning can thus be understood as a sense related to the term’s underlying original definition.

22 See Klein & Murphy, Paper Has Been My Rain, supra note __, at 566-67 (”What is surprising about polysemy as a general phenomenon is that the great diversity of senses does not impair fluent understanding of everyday language.”).


24 See Rene Zeelenberg et al., Semantic Context Effects and Priming in Word Association, 10 PSYCHONOMIC BULL. & REV. 653 (2003) (reporting experimental findings showing that context can be—and is—used to disambiguate semantically ambiguous words such that these words are less likely to cue inconsistent homonymous meanings); Klein & Murphy, Paper Has Been My Rain, supra note __, at 564-69 (discussing experimental results showing that inappropriate senses are inhibited to below baseline levels to ensure proper interpretation is achieved when context is provided); S. Frisson & M.J. Pickering, The Processing of Metonymy: Evidence from Eye Movements, 25 J. EXPERIMENTAL PSYCH: LEARNING, MEMORY, AND COGNITION 1366, 1379 (1991) (“Once readers have used [an] underspecified meaning to assign a (rather abstract) semantic value to an expression, they can home in on the intended sense by instantiating any underspecified features” through use of context); L. Frazier & K. Rayner, Taking on Semantic Commitments: Processing Multiple Meanings vs. Multiple Senses, 29 J. MEMORY & LANG. 181 (1990) (same). The idea stated in Frisson & Pickering is called radical underspecification. In essence, radical underspecification is the process through which “a kind of neutral placeholder is activated until disambiguating information is encountered... [a]s later context emerges... then one sense would be selected.” Klein & Murphy, Paper Has Been My Rain, supra note __, at 567. Cf. S.A. Duffy, R.K. Morris, & K. Rayner, Lexical Ambiguity and Fixation Times in Reading, 27 J. MEMORY & LANG. 429 (1988) (suggesting that, in the context of homonyms, readers activate separate meanings and select one or the other based on the meanings’ usage frequency and overall sentence context).
This idea is generally overlooked in trademark law and has important implications for various trademark doctrines, as will be shown below.

The law misunderstands trademark hybridity, and the doctrine of ‘genericide’ provides a good example of why that’s so. Consider the figures below, which are simple, relatively decontextualized product boxes bearing the word "kleenex":

![Figure 1](image1.png)  ![Figure 2](image2.png)

You likely wouldn’t be surprised to find that the owner of the KLEENEX mark, Kimberly Clark, distributed the product in Figure 1. But you likely would be surprised to find that the grocery store Food Lion distributed the product in Figure 1 as its house brand. This is because of KLEENEX’s brand significance. When you see the term in isolation, you assume the term is being used as a badge for the brand you generally associate with the product. You assume the term is identifying source; you would be confused if it didn’t.

Now consider Figure 2. The question of confusion here might be a bit more difficult—maybe you more strongly equate KLEENEX with its brand significance and, as a result, you might intuit some level of sponsorship or affiliation. But most consumers who consider Figure 2 are unlikely to be confused as to what’s in the box. “FOOD LION” provides sufficient relevant context to resolve the ambiguity, and placement on the shelf next to KLEENEX-brand products would only make it less confusing. Consumers know that grocery stores sell generic products under their house brand, and there is little doubt that most consumers would understand what the packaging in Figure 2 contains: facial tissues. And consumers would likely be very confused if the box contained, for example, paper towels. This is KLEENEX’s product significance. The term is used in a sense related to, but separate from, its original brand significance.

In context, each type of significance is understandable. With some type of disambiguating context used with the term, such as a disclaimer or properly placed alternative source identifier (“Food Lion”), we most often will understand the term for its generic product significance; without a disclaimer or other clear notation that it’s distributed by someone other than the owner of the primary brand affiliated with the

---


35 For a discussion of the “great[] threats to speech interests” that permitting injunctive relief against sponsorship and affiliation confusion poses, see Mark A. Lemley & Mark McKenna, Irrelevant Confusion, 62 STAN. L. REV. 413, 438–43 (2010).
term, we understand it in its brand significance. The trademarked term is generic, but that does not necessarily mean the brand is. These separate senses are related—“kleenex” would not mean “facial tissue” but for the existence of the KLEENEX brand—but contextually unconfusing.

Indeed, companies often implicitly—and systematically—admit consumers can tell the difference between various senses without confusion. For example, company names are often used to refer to the company itself and to one—or a class—of its products. For example, “Ford has reached 75 percent of its goal to create 12,000 hourly jobs in the U.S. by 2015,”36 (Ford = company) and “There’s a Ford in your future with a future built in!”37 (Ford = vehicle made by that company). Nor do producer-product polysemies occur only in commerce. For example, take the two sentences “Dickens died in 1914” and “I love reading Dickens.” It’s highly unlikely that any substantial confusion is likely to arise from this type of polysemie given its prevalence in everyday language use.38

Trademark law doesn’t typically think in terms of brand and product significance or much recognize polysemy.39 Rather, trademark law thinks in terms of a term’s “primary significance.”40 In the Lanham Act, Congress provided “[t]he primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”41 Primary significance has generally been read to pose a binary question: is the term generic or does it retain source significance?42 This binary is an empirical question that can be measured on a spectrum: does a sufficient percentage of the relevant consuming public consider the term generic, or does the relevant public instead consider the term to identify source?

Both questions misunderstand how the public can—and does—understand brand and product significance together. Trademark hybridity, by contrast, recognizes that a term need not be understood for either its generic or its source-identifying function. Rather, both functions can coexist depending on context. We people (including we consumers) use context to provide semantically ambiguous words with meaning in nearly every sentence we speak, hear, read, or write without becoming overwhelmed by ambiguity.43 Consider one study that tested consumers’ ability to identify product

---

38 “You can read a person!” Thanks to Greg Murphy for the points raised in this paragraph.
39 But see notes __-__ [descriptive and nominative use cases] and accompanying text.
40 One exception to this general trend is the doctrine of descriptive fair use, which applies where a term or phrase that has been trademarked is used by a third-party for its descriptive content rather than as a source-identifier. See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 122 (2004) (noting the Lanham Act was not intended “to deprive commercial speakers of the ordinary utility of descriptive words.”); IA Apparel Corp. v. Abboud, 568 F.3d 490, 500 (2d Cir. 2009) (the use of a mark is descriptively fair if and only if the term or phrase was used “(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith.”) (internal quotation marks omitted). See also Kelly-Brown v. Winfrey, Case No. 12-1207-cv, slip op. at *33 (2d Cir. May 31, 2013) (Sack, J., concurring in the result) (“A perusal of the day’s headlines and magazine covers is, I think, likely to turn up the use of bona fide trademarks, bearing real secondary meaning to consumers, as a means of communication, but without trenching on the rights of the mark’s owner.”); id. at *34-36 (describing the different senses in which the word “own” was used in the instant case).
41 15 U.S.C. § 1064(3); Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (for a seller to prove trademark significance in a term challenged as generic, the seller must show that the “primary significance of the term in the minds of the consuming public is not the product but the producer”); McCARTHY, supra note __, at § 12.6 (collecting cases).
42 See supra note __ [13] and accompanying text.
43 Liina Pylkkänen, Rodolfo Llinas, and Gregory L. Murphy, The Representation of Polysemy: MEG Evidence, 18 J.
source based on the presence of the descriptive word mark, paired with varying amounts of non-linguistic cues for source. The study’s authors found that consumers identified source reliably (80%) when the word mark plus all non-linguistic cues were used, and less so (70%) when only two non-linguistic cues (large size and prominent location) were used. But when only the word mark was used—or only in conjunction with one non-linguistic cue—consumers identified source much less successfully (26.7% and 33.3% respectively). The authors concluded that, at least for descriptive word marks, the word mark is not sufficient to indicate source: “non-linguistic signs are necessary for a descriptive mark to be seen as source indicating.” Consumers therefore may not be confused by linguistically similar descriptive trademarks in the context of actual trademark use.46

But consumers seem equally unlikely to be confused by the use of certain terms that have become de facto generic for a broad swath of consumers—like ‘kleenex’ for tissues, ‘xerox’ for copiers, or ‘bic’ for inexpensive pens, lighters, and razors—on competing goods or services. We can expect that will be true so long as the terms are accompanied by an appropriate source disclaimer and positioned in a use-appropriate placement on the packaging. Courts have recognized for over a century that such source disclaimers can be effective for eliminating the risk of confusion or any prejudice to the original markholder.47 The question is why they have not expanded on the functional rationale underlying that rule: an implicit recognition that the relevant public can distinguish between a protected term that denotes source, and the same term in context that denotes a different source.

It might be tempting to consider whether the primary significance test could ask a narrower question: whether the term’s primary definition in a consumer’s mind is the brand or the product.48 That narrower question would pose a significant problem for trademark law, because it would acknowledge that the consumer’s mental map of the term contains both definitions. But the mental map is subjective and internal to the consumer; how could the answer be measured empirically?

---


44 Lee et al., Trademark Distinctiveness, supra note __, at 1096–99 (describing study method).

45 Id. at 1105 (“A key point of our analysis is that the non-lexical components of a descriptive mark may have a greater impact on consumers than its lexical signs. If that is so, it is entirely possible that a consumer encounters a descriptive word that is lexically similar (perhaps even identical) to the senior mark may nonetheless be unconfused in light of the differences between the non-lexical components of the two marks.”).

46 See, e.g., Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 204 (1896) (despite finding “singer” generic for sewing machines, directing the lower court to enter judgment in Singer’s favor and to permanently enjoin June “first, from using the word ‘Singer’ or any equivalent thereto, in advertisements in relation to sewing machines, without clearly and unmistakably stating in all said advertisements that the machines are made by [June], as distinguished from the sewing machines made by [Singer]; and second, also . . . from marking upon sewing machines or upon any plate or device connected therewith or attached thereto the word ‘Singer’, or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of [June] or other manufacturer, and therefore not the product of [Singer].”); King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 581 (2d Cir. 1963) (finding “thermos” generic for vacuum flasks, but nonetheless affirming the district court’s remedy, which required the defendant to attach its own trademarked name in front of the non-generic “thermos”); DuPont Cellophone Co. v. Waxed Prods. Co., 85 F.2d 75 (2d Cir. 1936) (same, for “cellophane”); Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921) (same, for “aspirin”).
Consider an idea from cognitive psychology, *spreading activation*, that some scholars have seized upon to argue in favor of trademark antidilution protection. In this idea, a consumer perceives a term and thereby activates cognitive connections between the term and related concepts. As described by Rebecca Tushnet:

In the cognitive model, blurring takes place when a single term activates multiple, nonconfusing associations in a consumer’s mind. Meanings or concepts, including sounds, images, and other sensory impressions, are linked by mental networks. Concepts are activated through links in the network, triggering related concepts. Activation happens very fast, and if it does not continue, an unreinforced word or concept can die away. For example, because we process sounds in sequence, neighborhoods of words starting with an initial *he* sound will be activated when we hear *he*. When we hear the rest of the word *hello, help* will die away and *hello*, with its attendant meanings, will be activated. . . . Like several pebbles thrown into a pond at once, activation of different meanings causes interference with each one.50

This model should apply equally generic word marks, which are purportedly standardized: the factors that make a mark very strong (thereby triggering dilution protection) also push it towards genericness. The primary difference is that a term’s generic sense was most likely developed gradually through linguistic usage rather than affirmatively adopted by a commercial entity.

The Lanham Act, the argument goes, requires the judge to choose one side of the binary: “brand” or “generic.” A survey that explicitly distinguishes “brand” from “generic” but does not include an option for “both,” then, is said to be a simple reflection of the law’s need to distinguish between the two poles. There are a few problems with this approach.

First, the approach will systematically underrepresent product (generic) significance at the expense of brand significance, thereby skewing the results in favor of markholders. This underrepresentation is borne out in the paucity of marks that have been found generic in the years since the Teflon and Thermos survey models, discussed below, came into vogue. A proper measure of the number of consumers who recognize brand or product significance would need to double-tally those consumers who recognize a hybridized mark: once on the “brand” side, once on the “generic” side.

Second, and broadening the scope to cover dilution, there is a central issue with distinguishing primary definitions from secondary ones, tertiary ones, and so on. Assuming they may be triggered by the switching on of a “primary” node and then spread to other, “secondary” nodes, there is no extant empirical measure to conclusively

---


51 See Tushnet, *Gone in Sixty Milliseconds, supra note __*, at 519, 520 (citing John R. Anderson, *Cognitive Psychology and Its Implications* 183–85 (4th ed. 1995); Christine A. Sevald & Gary S. Dell, *The Sequential Cuing Effect in Speech Production*, 53 Cognition 91, 110 (1994); Jerre B. Swann, *Dilution Redefined for the Year 2002*, 92 Trademark Rep. 585, 613 (2002)). See also Maureen Morrin & Jacob Jacoby, *Trademark Dilution: Empirical Measures for an Elusive Concept*, 19 J. Pub. Pol’y & Mktg. 265 (2000). In the above quotation, Tushnet sets forth the cognitive view tying spread activation to brand association. However, it should be noted that Tushnet puts forward the view in order to strike at its foundations throughout the rest of her article. My quotation of her, then, should not be read to ascribe to her these views.

52 See supra note [47].
establish which is the “primary” node. Rather, psycholinguistic researchers typically presume node primacy by relational frequency: between two senses, the sense that is more frequently used is presumed to be the “primary” sense. That presumption fits imperfectly in trademark law. A measurement that takes no account of hybridized marks will undervalue the term’s “generic” sense in determining relational frequency. But what result when 75% of the consuming public recognizes a particular term in both its “generic” and “brand” senses? Any fine distinction at that level would smack of arbitrariness. As for dilution, as Tushnet notes, no major brand names have high frequency levels in an absolute sense.\(^53\) The evidence, moreover, is unclear whether an increase in the number of associations attached to a brand name might burden consumers’ ability to retrieve or recognize the brand name.\(^54\) To the contrary, research suggests that such an increase may actually reinforce retrieval and recognition of the primary association.\(^55\) It may be too strong then to say the activation of different meanings interferes with each one.\(^56\) Rather, all we can say is different meanings may be activated, and this “interference” may be negative or positive in terms of brand name recall—we simply don’t have a conclusive answer yet.

Third, and perhaps most critically, Tushnet observes that much of the empirical work applying cognitive science to trademark law suffers from major measurement errors.\(^57\) Further, these cognitive science studies lack a standard, accepted, acceptable means of threshold-setting. Does an increased response time of .01s constitute an actionable level of dilution? How do we know when or if our threshold for significance is accurate or at least close to it? If context can clarify ambiguity so quickly even when the deck is stacked in favor of finding some measurable increase in response time, should we care at all? Especially where the work on the cognitive science’s relationship to trademarks and brands is so unsettled, we should be careful about granting property rights that may impinge on other interests we find important.

### B. Trademarks and Brands

Trademark law reflects a number of such other important interests, including generalized interests in promoting market competition and free communication both inside and outside the marketplace. These interests can be found in trademark law’s foundations. These traditional normative foundations lie in two related ideas. First, as Richard Posner and William Landes noted in their seminal work on the law and

---

53 Tushnet, Gone in Sixty Milliseconds, supra note __, at 535.

54 See id.

55 Joan Meyers-Levy, The Influence of a Brand Name’s Association Set Size and Word Frequency on Brand Memory, 16 J. CONSUMER RES. 197, 202–03 (1989). See also Tushnet, Gone in Sixty Milliseconds, supra note __, at 536 fn. 153 (“In the end, association-set size may simply not be all that important in real-world settings. Other studies suggest that context moderates any effect of association-set size.”) (citing Douglas L. Nelson et al., Interpreting the Influence of Implicitly Activated Memories on Recall and Recognition, 105 PSYCH. REV. 299, 301 (1998)).

56 See Zoolenberg et al., Semantic Context Effects, supra note __, at 658 (“[A] feature-based account [of language processing] needs to assume that not all semantic features of a word are activated or attended to on each occasion a word is encountered. Instead, the degree to which certain features are activated or attended to varies and depends on the context in which the word is presented.”) (citing L.W. Barsalou, Flexibility, Structure, and Linguistic Vogary in Concepts: Manifestations of a Compositional System of Perceptual Symbols in THEORIES OF MEMORY (1993); D.C. Morris et al., Levels of Processing Versus Transfer Appropriate Processing, 16 J. VERBAL LEARNING & VERBAL BEHAVIOR 519 (1977); D. Pecher et al., Does Pizza Prime Coin? Perceptual Priming in Lexical Decision and Pronunciation, J. MEM. & LANG. 401 (1998); H.L. Roediger & B. Adelson, Semantic Specificity in Cued Recall, 8 MEM. & COGNITION 65 (1980)).

57 See Tushnet, Gone in Sixty Milliseconds, supra note __, at 528–32 (noting the potential decontextualizing effects of Morrin and Jacoby’s attempts to empirically measure dilution). See also Daniel Klerman, Trademark Dilution, Search Costs, and Naked Licensing, 74 FORDHAM L. REV. 1759, 1765 (2006) (arguing Morrin and Jacoby’s findings, though potentially statistically significant—assuming the propriety of their measures—are not necessarily economically significant).
economics of trademark law, a trademark’s value lies in “the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand.”58 In this view, the trademark is an information vessel that eases the consumer’s burden in identifying and selecting preferred products. Second, and relatedly, the law protects trademarks as an incentive for producers to promote a consistent level of quality in their products.59 Both rationales are premised on benefitting consumers. Deven Desai has shown forcefully how, over the last century, courts have slowly moved away from these rationales without explicitly stating (or potentially even knowing) that they were doing so. This movement has resulted in a body of law that frequently runs counter to the ideas nominally at its heart.60

In place of the search costs and quality-control rationales, courts and legislatures have continuously expanded the domain of trademark law to prevent against harms not previously covered under the Lanham Act. Trademark infringement doctrine still pays lip service to the idea of “consumer confusion,” which was long thought to be the interest that the trademark infringement suit was designed to protect against. But nonetheless courts have recognized types of confusion, such as initial interest and post-sale confusion, that have little to do with consumer search costs or quality-control.61 State and federal legislatures have passed various laws regulating trademark dilution, which laws “seek[] to prevent diminution in the value of a famous mark stemming from the use of the mark by someone other than the trademark [h]older.”62 By contrast with the consumer-confusion-centered approach of traditional trademark doctrine, dilution law is explicitly premised on protecting producers’ interests.63

These shifts are best explained through brand theory. Desai identifies three strands

---

58 Landes & Posner, supra note __, at 270. See also Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 163–64 (1995) (“[T]rademark law, by preventing others from copying a source-identifying mark, reduces the customer’s costs of shopping and making purchasing decisions and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked in the past.”) (internal citations omitted); Bretford Mfg., Inc. v. Smith Sys. Mfg. Co., 419 F.3d 576, 579 (7th Cir. 2005).

59 Id. at 269–70. See also Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 198 (1985) (“National protection of trademarks is desirable. Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.”); MCCARTHY, supra note __, at § 2:4 (“If your mistakes and blunders are untraceable, there is little incentive to do a quality job.”).

60 Desai, From Trademarks to Brands, supra note __, passim.

61 Id. at 1025–26 (discussing initial interest and post-sale confusion). Initial interest confusion is aimed at a situation in which a consumer is initially drawn to Producer A’s goods or services because the consumer mistakenly believes Producer A to be Producer B. By the time the consumer purchases goods or services from Producer A, the consumer knows she is not dealing with Producer B, but decides to make the purchase anyway. The doctrine thus “has little to do with [the] rational choice problems that traditionally animate trademark law.” Id. at 1025 (citing Jennifer E. Rothman, Initial Interest Confusion: Standing at the Crossroads of Trademark Law, 27 CARDOZO L. REV. 105 (2005)). Post-sale confusion is aimed mostly at knock-off goods: the consumer purchases goods knowing that those goods are not made by Producer A, but uninterested third-parties, seeing the consumer using those goods, presumably will be dissuaded from making further purchases from Producer A. In addressing this situation, the law protects the mark’s prestige. See id. at 1026; Jeremy N. Sheff, Veblen Brands, 96 MINN. L. REV. 769 (2012); Barton Beebe, Intellectual Property and the Sumptuary Code, 123 HARV. L. REV. 809, 851–55 (2010).


in the marketing literature on brand theory: (1) the corporate view, in which the firm owns and controls the brand, with consumers passively receiving brand information;\(^{64}\) (2) the noncorporate view, in which consumers and communities construct brand value;\(^{65}\) and (3) a synthesized view, in which all these stakeholders co-create brand value by using the brand as a communal information resource.\(^{66}\) On this model, he argues courts have erroneously enshrined the corporate view to the exclusion of the noncorporate and synthesized views, leading to an overly producer-centric trademark law that must be recalibrated so trademarks can function as true information-transmission mechanisms.\(^{67}\)

The problem comes from adopting brand concepts without due concern for unintended consequences. First, as Desai and others note, the basic source-identification and quality-control theories cannot support many extensions of trademark law.\(^{68}\) As a result, trademark law has become increasingly doctrinally incoherent. At least since the rise of the law and economics movement, trademark law has been understood as part of a trade-off: the law protects the owner’s mark in order to ease the consumer’s psychological burden in searching for goods and to promote a consistent level of quality in goods bearing the trademark.\(^{69}\) But the law has moved away from those limitations.

\(^{64}\) See Desai, *From Trademarks to Brands*, supra note \_\_, at 992–99. Recent scholarly literature primarily characterizes the corporate view as anachronistic, developed in the early 20th century as an offshoot of Taylorist—that is, top-down—management theory. In the Taylorist mode, consumers passively accept brand information and their behaviors are allegedly molded to the manager’s ideal of efficiency. See, e.g., Arvidsson, *Brands*, supra note \_\_, at 41, 41–51 (“Taylorist management sought to discipline an unruly labour force into adopting certain pre-programmed forms of behaviour; Public Relations was about propagating a certain corporate ideology against public adversity to big business; marketing sought to make consumers behave and desire in a certain way; and design was about imposing more beautiful or rational objects on the recalcitrant masses. Today, in almost every case, it is the other way around.”). See generally Sarah Banet-Weiser, *Authentic: Ambivalence in a Brand Culture* (2012).

\(^{65}\) See Desai, *From Trademarks to Brands*, supra note \_\_, at 999–1005. The noncorporate view does generally recognize the producer’s contribution, but that contribution is usually characterized as minimal. The producer creates the ‘ambience’ within which consumers ‘perform’ the brand. See, e.g., Arvidsson, *Brands*, supra note \_\_, at 73–80 (describing brand managers’ relative passivity once they have set the ‘ambience’). See also id. at 82 (“Brand management contains a variety of techniques that all aim at controlling, pre-structuring and monitoring what people do with brands, so that what these practices do adds to its value.”).

\(^{66}\) See Desai, *From Trademarks to Brands*, supra note \_\_, at 1005–09. The synthesized view is very similar to a measured version of the noncorporate view. The producer generally does more than simply create an ‘ambience’—it actively manipulates that ambience to improve the value of its brand. But the synthesized view also recognizes the extent to which consumers do the same, by cocreating the ‘life-world’ in which they can act out their preferred view of the brand, a view that may differ from that put forth by the producer.

\(^{67}\) Id. at 1029–42. Desai’s overall conclusion is theoretically sound, but seems rather naïve from a practical perspective. While some markholders, including Google, have recognized the value of a synthesized approach, it is hard to imagine a world in which markholders voluntarily relinquish a significant measure of control over ‘their’ marks. At the most, we might imagine a world in which markholders relinquish control as a practical matter while exerting pressure to procure control over the ‘surplus value’ created by consumers in their interactions with brands. In other words, markholders may take a janus-faced approach: minimalism in practice, maximalism when representing their approach to the world.

\(^{68}\) Desai & Waller, supra note \_\_, at 1429 (“A successful brand, however, encompasses far more than merely indicating source and quality. Accordingly, trademark law is incomplete and regulates only a fraction of the relevant business behavior pertaining to brands.”). See id. at 1448 (“[T]he way in which the law was used to feed brand protection relied on the source/quality mantra. That foundation is, by definition, ill-equipped to address the brand functions that operate beyond the source/quality dimension.”).

\(^{69}\) Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 Hous. L. Rev. 777, 786–87 (2004) (“Rather than having to inquire into the provenance and qualities of every potential purchase, consumers can look to trademarks as shorthand indicators. Because information is less expensive, consumers will demand more of it and will arguably become better informed, resulting in a more competitive market.”); Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 289 (1975) (“A trademark does not necessarily guarantee good quality. What it does guarantee is consistency.”). See Qualitex, 514 U.S. at 163–64; Park’n Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 198 (1985) (“National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.”) (citing S. Rep. No. 1333, 79th Cong., 2d Sess., 3–5 (1946)). But see Desai & Waller, supra note \_\_, at 1447 (that marks reduce search costs “is merely a part of a mark’s function and, in fact, an unintended consequence. The desire to shape markets and generate
For example, the law has come to protect a markholder’s right to license its mark for use on goods it doesn’t produce but that simply bear the logo. This “merchandising” right is almost completely untethered from the traditional rationales undergirding trademark law. Yet courts appear unconcerned about that disconnect. When courts recognize the merchandising right, they often face head-on the fact that consumers are buying the products at issue not for their intrinsic quality, but for the signaling value of the logo. If you’re at Jimmy Buffett’s Margaritaville, you’re probably not going to care much whether your BUD LIGHT or CORONA logo-emblazoned sandals are cutting into your toes; you’re much more likely to care about the signal the fact of your wearing them sends to other patrons. And if you’re buying a Disney-branded MULAN t-shirt from Wal-Mart, you likely care about what the shirt says about you (whimsical, rural), rather than the fact that the shirt was produced by a foreign contractor under license and not by Walt Disney Co. itself.

Second, in adopting brand concepts, Desai notes that courts have allocated benefits mostly, if not entirely, to markholders at the expense of the consuming public. As noted above, courts have adopted the “corporate” view of brands, which essentially disregards consumers’ contribution to brand value. Rather, the corporate view sees brands as curated museum pieces, tended to only by the mark’s owner and deriving their value solely from the owner’s efforts. This view results in absurdity, providing markholders cover to engage in flagrantly anti-consumer behavior. For example, as Lawrence Lessig relates in Remix, at the turn of the millennium, Warner Brothers went to war with Harry Potter fans over those fans’ right to “explain and extend” the Harry Potter story. More recently, The Saul Zaentz Co., which holds trademark rights in various Lord of the Rings-related marks, has aggressively asserted those marks against,

---

20 See Irene Calboli, The Sunset of “Quality Control” in Modern Trademark Licensing, 57 AM. U. L. REV. 341, 350 (2007) (“[R]ather than indicating products’ commercial origins, the primary function of merchandising is to increase the attractive function of the marks themselves by providing consumers with a variety of items that, while satisfying common needs, function as brand builders and allow the public to identify with them.”); Stacey L. Dogan & Mark A. Lemley, The Merchandising Right: Fragile Theory or Fait Accompli?, 54 EMORY L.J. 461, 471–72 (2005) (“The mark in these cases is rarely serving the traditional function of a trademark. Rather than indicating something to the consumer about the source . . . of a product, the mark is the product . . . .”). Alex Kozinski, Trademarks Unplugged, 68 N.Y.U. L. REV. 960, 961 (1993) (describing the “growing tendency to use trademarks not just to identify products but also to enhance or adorn them, even to create new commodities altogether”); Robert C. Denicola, Institutional Publicity Rights: An Analysis of Merchandising of Famous Trade Symbols, 62 N.C. L. REV. 603, 604 (1984) (noting consumers’ willingness to pay more for products bearing certain logos).


22 See, e.g., Bos. Prof’l Hockey Ass’n v. Dall. Cap & Emblem Mfg., 510 F.2d 1004 (5th Cir. 1975), cert. denied, 423 U.S. 868 (1975) (enjoining the defendant from making and selling “embroidered cloth emblems” of the various NHL teams’ logos). See also Desai & Waller, supra note _, at 1458 (“Consumers can know full well that these items are not licensed. They are not confused nor do they lack information as they purchase. Still, trademark law will in some cases prevent unlicensed manufacturers from producing such goods.”) (citations omitted).

23 I assume the signal is “I’m a really relaxed guy who loves to chill on the beach, drinkin’ BUDS with the buds.”

24 See Desai & Waller, supra note _, at 1429 (“Neither advocates nor opponents of [the elevation of brands] appreciated the subtle shift from marks to brands. This blindness led to unintended (or at least misunderstood) change and one-sided expansion of the legal regime.”).

25 See infra Section _.


27 LAWRENCE LESSIG, REMIX: MAKING ART AND COMMERCE THRIVE IN THE HYBRID ECONOMY 205–13 (2008). To some extent the Harry Potter issues are more appropriately thought of as copyright issues—for example, whether fan fiction is “fair use”—but current trademark practices and copyright law have become inextricably bound together over the years. Companies’ soft IP protection practices usually fall under the heading of “brand protection” writ large.
for example, a local pub named The Hobbit in Southampton, UK\(^8\) and a luxury foods company that dared to release a line of duck products under the ROHAN mark (Rohan is a fictional location in the Lord of the Rings series).\(^7\) Similarly, the leaders of the venerable Chipotle franchise have brought suit against the fast-food chain Jack in the Box and the grocery chain Kroger, arguing that these companies’ descriptive uses of the word “chipotle” for spicy chipotle pepper-based food products are impermissibly free-riding on CHIPOTLE’s accrued brand value.\(^8\) Claims of confusion—much less dilution—in these circumstances strain credulity.

Third, and critically, from a psycholinguistic perspective there is neither an empirical basis nor a theoretical basis for trademark’s adoption of brand theory. Rather, markholders propose and then adopt baseless but facially plausible theories like the “internal search costs” model. As a result, consumers’ interests are continuously impinged on by markholders’ expansive, minimally-supported ideas about consumers’ inability to use context to distinguish one word mark from another. This state of affairs is an extended example of the “language monopoly” Landes and Posner warned of in the context of generic terms—the social cost of broad protection tends to exceed the informational benefits to consumers as other producers incur increased information costs in finding different ways to identify their products in an effort to enter the market.\(^8\) Whether a term is placed into the “brand” or “generic” bucket means little for the discerning consumer. So long as the context is clear—as it almost always is—actual confusion and dilution will remain empirically unlikely.

Recognizing the law’s expansion to permit control over brand concepts puts into perspective some of the thornier issues in trademark law. Markholders often send cease and desist letters to entities whose uses are very unlikely to suffer the traditional injury with which trademark is concerned; consumers are unlikely to confuse the product at issue with the markholder’s. These markholders, when called out on their conduct, often fall back on the law’s supposed requirement that they “police” their marks or risk losing them. For example, in February 2013, Chicago Public Media (“CPM”)—owners and distributors of the radio show This American Life—sent a cease and desist letter to Siouxsie Q, the host of This American Whore, a podcast about sex workers.\(^8\) After Siouxsie Q engaged in a small media campaign to call attention to the letter, Ira Glass, host of This American Life, issued a response that stated, in part:

[T]he way trademark law works is that we or any business with a

---


\(^9\) See Chipotle Mexican Grill, Inc. v. The Kroger Co., CV00930 (D. Colo., filed Apr. 5, 2012) (wherein Chipotle argues that Kroger’s use of the word “chipotle” on its frozen chicken entree packaging impermissibly infringes Chipotle’s rights in its CHIPOTLE mark); Chipotle Mexican Grill, Inc. v. Jack in the Box, Inc., No. 1:2012cv02511 (D. Colo., filed Sept. 21, 2012) (making similar claims with respect to Jack in the Box’s chipotle chicken club sandwich and, amusingly, use of the term “chipotload”). See also Jacob Gershan, Dr. Dre in Trademark Battle, WALL ST. J. (Mar. 6, 2013 4:50 PM) (detailing Beats Electronics’ efforts to challenge trademark applicants’ attempts to register “beat” or “beats” as a trademark—even when not used in connection with headphones or when in combination with other words—based on a purported likelihood of confusion with the company’s BEATS mark for headphones); Jacob Gershan, If You Take These Jeans’ Name in Vain, Prepare to Meet Their Maker, WALL ST. J. (Feb. 24, 2013) (detailing Jesus Jeans’ attempts to stop others from using “Jesus” on various types of apparel based on a purported likelihood of confusion with the company’s JESUS trademark).


A trademarked name has to protect that name. If you don’t take action when you hear about people knocking off your name, and get them to stop, you can lose your trademark rights. Whenever we find out about any podcasts with names similar to ours, our lawyers review what action would be appropriate. Some names and shows are parodies, which are a protected class under the law. Some have audiences that are so negligible that they pose no trademark threat.

The purported “requirement” of trademark policing is a phantom in this context. Trademark law requires markholders to police their brands by avoiding and preventing conduct that could plausibly be considered confusing as to source, affiliation, or sponsorship. But it doesn’t mean that all uses—including those that couldn’t reasonably be considered confusing—must be stopped. Mr. Glass can be forgiven for his somewhat confused understanding of trademark law’s intricacies (parodies are a “protected class?”). At its heart, his concern is not about protecting his trademark from falling into genericness or preventing a finding that CPM abandoned it. Rather, his concern is more plausibly aimed at ensuring the This American Life brand remains popular and culturally important.

While there’s nothing per se wrong with trying to popularize (and keep popular) one’s brand, we must understand the extent to which these efforts may have powerful distributional consequences—This American Whore, a podcast that focuses on the lives of marginalized sex workers, is targeted while This American Wife, a podcast that obviously spoofs This American Life’s public radio pretension, remains alive—and negatively impact citizens’ ability to speak with and through the culture surrounding them. These distributional consequences are not minor, but rather go to the heart of free expression and users’ ability to comment on the world around them using cultural touchstones.

II. TRADEMARK HYBRIDITY’S IMPLICATIONS

While trademark hybridity may seem relatively innocuous at first glance, the idea has very real relevance for many areas of trademark law. In this Section, I discuss trademark hybridity’s implications for genericness doctrine, stylized word marks, trademark surveys, dilution, and trademark law’s intersection with the First Amendment and competition policy.

A. Implications for Trademark Doctrine

1. The Outmoded Primary Significance Test

Aspirin, escalator, cellophane, thermos: these terms were once all very strong trademarks for use on their particular products. Over time, the factors that made these

84 See Bayer, 272 F. 505 (aspirin); Haughton Elevator Co. v. Seeberger, 85 U.S.P.Q. 80 (Comm’r Pat. 1950) (escalator); DuPont Cellophane Co. v. Waxod Prods. Co., 85 F.2d 75 (2d Cir. 1936), cert. denied, 299 U.S. 601 (1936) (cellophane); King-Seeley, 321 F.2d 577 (thermos). See also Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806 (2d Cir. 1999) (“hog” for motorcycles); Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95 (2d Cir. 1989) (murphy bed); Henry Heide, Inc. v. George Ziegler Co., 354 F.2d 574 (7th Cir. 1965) (pujubes); Dry Ice Corp. v. La. Dry Ice Corp., 54 F.2d 882 (9th Cir. 1931), cert. denied, 286 U.S. 558 (1932) (dry ice); Nissen Trampoline Co. v. Am. Trampoline Co., 193 F. Supp. 745 (S.D. Iowa 1961)
As I have explained elsewhere with Jeff Wilkerson, the doctrine of trademark strength—which encompasses genericness—depends on at least six factors. These factors are: (1) inherent strength; (2) fame; (3) third-party uses; (4) alternative generic signifiers; (5) brand extension and licensing; and (6) lack of competition. To oversimplify the analysis some, KLEENEX and VASELINE are relatively inherently strong, very famous marks. A review of federal trademark filings reveals that the marks are rarely, if ever, used on third-party products or services. Each product has a relatively strong alternative generic signifier—tissues for KLEENEX and petroleum jelly for VASELINE. Each brand has been extended by the owner into various adjacent product markets—hand towels, dinner napkins, and moist towelettes for KLEENEX and various types of lotions, lip balms, and the like for VASELINE.

But that leaves consumer practice. People commonly use “kleenex” and “vaseline” generically. This results in large part from ineffective competition in the relevant marketplace. A producer who creates a single-player market—or something akin to it—is much more likely to find her mark has come to be used as the generic signifier for the product on which the trademark is used. To analogize, there is little effective competition in the search engine market, and as a result of Google Inc.’s complete dominance, so Google Inc.’s complete dominance means that the verb “googled” may reflect making an internet search even apart from using Google Inc.’s search service.

(trampoline).

85 Greene & Wilkerson, Understanding Trademark Strength, supra note __, at __.
86 Id.
88 See, e.g., “Kleenex,” MERRIAM-WEBSTER DICTIONARY (“used for a cleansing tissue.”); “Vaseline,” OXFORD ENGLISH DICTIONARY (“A soft, greasy substance used as an ointment or lubricant, obtained by evaporating petroleum and passing the residuum through animal charcoal.”).
89 Greene & Wilkerson, Understanding Trademark Strength, supra note __, at __.
90 Id.
91 KLEENEX is likely suggestive (it suggests, for example, how your nose will feel after using one), and VASELINE is likely descriptive (it seems to be a combination of the ‘wasser,’ the German word for water, and ‘elaiion,’ the Greek word for oil, and the “scientific-sounding ending” ‘ine’). See “Vaseline,” 5 THE MONTHLY REVIEW OF DENTAL SURGERY 415, 416 (1877) (Oakley Coles, ed.)
92 See supra note __ [Interbrand] (listing KLEENEX among the world’s most valuable brands) and accompanying text. See also J.D. POWER & ASSOC., HOW THE VASELINE BRAND REMAINS RELEVANT AFTER 125 YEARS (2010), available at http://images.dealer.com/jdpa/pdf/10-Us-Vaseline-CS.pdf (utilizing social media research to discuss how the VASELINE brand remains successful).
But because there remain credible competitors in the marketplace, like Yahoo! and Microsoft’s Bing, the mark has not become completely standardized as a generic term for “search” or “search engine” despite its normalized usage as a verb. (It would be odd to say you “googled” something on Bing, for example.) To take a few more examples, that “vaseline” is synonymous with petroleum jelly is often taken for granted in the U.S., and indeed, in many countries throughout the world, “vaseline” is explicitly considered generic for petroleum jelly.97 The almost complete lack of branded competition for VASELINE in the U.S. contributes to its generic character in this country. Likewise, “kleenex” is routinely referred to in the popular press as a generic term for tissues.98 And this type of analysis is no less true with respect to terms like “teflon,” which was found to be not generic in the courts based on its brand significance, despite a substantial showing of generic significance.99

Recall from above that the primary significance test asks a binary question: is the term generic or does it signify source?100 Next, does a sufficient percentage of the relevant consuming public consider the term generic, or does the relevant public instead consider the term to identify source?101 But semantic ambiguity resolution research, as outlined above, casts doubt on this binary question. To assume that a given term may be used only in one sense or another is unnecessarily reductive and does not accurately characterize how people actually understand language. The test does not acknowledge that many consumers will recognize both a generic and a source-identifying meaning for a given term (in addition to expressive and descriptive meanings related to the term at issue).102 Just as we can understand the various meanings of “fly” given appropriate

97 See Vaseline | Unilever Global, available at http://www.unilever.com/brands/personalcarebrands/vaseline/index.aspx (last visited June 15, 2013) (“Vaseline and Vasemol products are available in over 90 countries around the world” (Vasemol is the alternative name for Vaseline in Portuguese and Spanish speaking countries)).

98 See, e.g., Bill Morris, Explosion of Brands and Erosion of Soul, N.Y. TIMES (Dec. 21, 2012) (“[T]he Independence Bowl became the Poulan/Weed Eater Independence Bowl, lovingly known as the Weed Whacker Bowl. . . . ‘Over all, it was a net benefit,’ Evin Ellis, the company’s marketing communications manager, [said]. ‘We consider Weed Eater the Kleenex of weed whacking.’”), available at http://www.nytimes.com/2012/12/22/sports/ncaafootball/putting-the-brand-before-the-football-game.html?_r=1&

100 See Folsom & Teply, Trademarked Generic Words, supra note __, at 1327–30 (surveying cases).

101 Butters, A Linguistic Look at Trademark Dilution, supra note __, at 514 n. 24. Butters argues that brand names used figuratively or in shorthand references to product-referents typically have not actually become generic. Rather, he argues marks that have fallen into genericness have done so because “consumers actually have lost all meaningful mental connection between the mark and the company that has been the source or origin of the product.” Id. He further notes, “[b]ecause of modern advertising and marketing techniques, as well as vigilant policing by trademark holders, genericide appears to be somewhat rare today.[1]” Id. But his assertion is not quite correct: there is little evidence that terms like “cellophane,” “shredded wheat,” or “thermos” retained only product significance in consumers’ minds. In fact, such a situation would be incredibly difficult, if not impossible, to prove through traditional survey evidence. We address this concern more deeply in Section ILC.

102 Nor do many prominent commentators or many courts. See, e.g., McCarthy, supra note __, at § 12:1 (“The name of a product or service itself—what it is—is the very antithesis of a mark. In short, a generic name of a product can never function as a trademark to indicate origin. The terms ‘generic’ and ‘trademark’ are mutually exclusive.”); Liquid Controls Corp. v. Liquid Control Corp., 802 F.2d 934, 936 (7th Cir. 1986) (“A generic term is one that is commonly used as the name of a kind of goods. . . . Unlike a trademark, which identifies the source of a product, a generic term merely identifies the genus of which the particular product is a species.”). But see Folsom & Teply, Trademarked Generic Words, supra note __, at
context, so too can we understand a trademarked term often used generically to signify both the product (a thermos) and the brand (THERMOS). Semantic and visual context will assist the consumer in choosing the correct interpretation, thereby reducing confusion to below actionable levels. The simple fact is that generic terms sometimes act as marks, and sometimes marks act as generic terms. Stylization and other context help the consumer determine which sense she’s dealing with.

We should thus consider what the law should protect under these conditions. A term can simultaneously connotate a variety of different meanings or senses, such as brand and generic (product) significance, as well as meanings completely outside the bounds of commerce. The question arises whether more (or fewer) marks should be held generic and thereby usable on competing products, subject to appropriate means of differentiation—including disclaimers and different stylizations—to mediate any potential confusion. Trademark hybridity might simply be a quick and simple argument for never finding any marks generic, unless they have completely lost all source-identifying capacity.

If that were how competitors acted in the marketplace, perhaps a trend against finding marks generic would not pose a problem. But in the context of monopolistic or nearly monopolistic markets—those in which a single producer using a single mark dominates the market—producers will generally take anticompetitive positions to solidify their marketshare and exclude new entrants. Even where the average consumer understands a trademarked term to refer to both a specific product created by a particular producer and the actual product itself (in addition to any other senses in which the word may be used), a rationally profit-maximizing producer will seek to expand its scope of protection, often in unexpected ways, to eliminate competition, much to the detriment of consumers.

In other words, the primary significance test is, in theory, both over- and underprotective of producers’ interests. The test will find some marks generic where they still maintain source-identifying capacity, and will protect many others where they are used

---

1339 ("[A] trademarked word may be simultaneously hybrid: that is, it may function for some consumers both as a generic term designating a product class and at the same time as a source-significant, commercial symbol.") (citations omitted, emphasis in original).

103 See supra Section I. For example, a consumer’s mental map for “Barbie” may include barbecues ("put another shrimp on the barbie") or a person who goes by that name.

104 This outcome is the practical effect of the increased communication costs between producers and consumers that the law and economics theory of trademark law attributes to standardized generic terms. See Nicholas S. Economistides, The Economics of Trademarks, 78 TRADEMARK REP. 523 (1988); Landes & Posner, supra note __. See also Giovanni B. Ramello, What’s in a Sign? Trademark Law and Economic Theory, 20 J. ECON. SURVEYS 547, (2006) (“Consumer inertia is a crucial side-effect of trademark, and can result in the erection of barriers to entry. Firms are well aware of these inertial effects, which are in fact the objective of creating brand loyalty, which seeks to endogenously generate and increase the switching costs of consumers in order to achieve lock-in. Such practices have clear beneficial effects on the profitability of firms which succeed in gaining market power, however their ultimate social welfare effects are not so obvious.”) (citing DAVID A. AAKER, MANAGING BRAND EQUITY (Free Press 1991), Paul D. Klempner, Competition When Consumers Have Switching Costs: An Overview with Applications to Industrial Organization, Macroeconomics and International Trade, 62 REV. ECON. STUD. 515 (1995)).

105 See Richard L. Schmalensee, Entry Deterrence in the Ready-to-Eat Breakfast Cereal Industry, 9 BELL J. ECON. 305 (1978) (discussing ‘brand proliferation’ in the corn flakes market, whereby several firms produced the same product under many different brands, thereby reducing the market’s potential profitability to competitors and effectively restricting their entry while capturing the profits for themselves). On ‘brand proliferation’ in the pharmaceutical market, see Aidan Hollis, How Do Brands’ Own Generics Affect Pharmaceutical Prices?, 27 REV. INDUS. ORG. 329 (2005); Ying Kong & James R. Seldon, Pseudo-Generic Products and Barriers to Entry in Pharmaceutical Markets, 25 REV. INDUS. ORG. 71 (2004).

106 See Lunney, Trademark Monopolies, supra note __, at 439 ("[U]nless some other efficiency gain can be tied to extending protection in such cases, protecting marks based on their value independent of their informational role risks creating monopolies, not merely in the neutral, descriptive sense, but in the ordinary and pejorative sense of unjustified and inappropriate market power.").
generically by a significant percentage of the consuming public. But in the first scenario, producers can still protect their interests through promoting the other non-lexical attributes of their brands. In the second scenario, producers are essentially given license to carve out a swath of protection larger than their mark merits. Consumers, on the other hand, gain nothing in the second scenario. Their search costs are not reduced; these costs may in fact increase as competing producers must come up with other ways to describe their products rather than using the term by which the public knows the product. In theory, consumers may have little to gain in the first scenario either if they were already disambiguating appropriately in the first instance. In practice though, consumers will undoubtedly find it easier to discover competing products previously undiscoverable due to producers’ extension of their trademark rights to maintain their marketshare. The threat of suit due to non-trademark uses of the mark will be reduced as well, likewise to consumers’ benefit.

It is inefficient to extend a non-time-limited artificial monopoly over a word that consumers use to refer to a class of products. That arises, in part, out of search cost theory: if consumers in fact use a term to describe a product within the class and care less—or not at all—about the source, then the law’s artificial monopoly doesn’t do any work. It does not reduce search costs in the market by distinguishing products, but rather by permitting only one distributor to offer the product. As the Second Circuit once explained: “no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” Competitors who cannot speak the language of their consumers are at a significant market disadvantage.

There is also a social cost. Our culture of relatively unconstrained communication is threatened when noncommercial users, such as artists and authors, are routinely subject to spurious threats from trademark owners. While producers may myopically prefer such an outcome in the short run as it allows them more control over their brand personas, producers may—and often do—practically prefer their marks to be used generically, considering that cognitive psychology research has shown that the more often we are exposed to a stimulus, the more likely we are to come to prefer it.

---

\[supra\] note __, at 291 (“If the producer of one brand could appropriate the name of the product, he would earn rents because of the added cost to his rivals of periphrasis—of describing their products as ‘heavier-than-air flying machines’ [airplanes] or ‘artificial-intelligence machines’ [computers]”). See also id. at 294-95 (discussing cost-benefit balancing in the context of generic terms).

\[supra\] note __, at 439.

See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 1, 9 (1976) (“[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name”).

\[supra\] note __, at 331 and accompanying text. See also John F. Coverdale, Trademarks and Generic Words: An Effect-on-Competition Test, 51 U. CHI. L. REV. 868 (1984); Mark A. Lemley & Stacey L. Dogan, Parody as Brand (unpublished manuscript 2013).

---

\[supra\] note __, at 291 (citing Jeremy N. Sheff, The (Boundedly) Rational Basis of Trademark Liability: Reconciling the Federal Trademark Dilution Act with the Lanham Act, 15 TEX. INT’L PROP. L.J. 331, 365 (2007)). See id. at n. 178 (citing Paul Slovic, Melissa F runcave, Ellen Peters & Donald G. MacGregor, The Affect Heuristic, in HEURISTICS AND BIASES: THE PSYCHOLOGY OF INTUITIVE JUDGMENT (2002), at 397 (“[W]hen objects are presented to an individual repeatedly, the ‘mere exposure’ is capable of creating a positive attitude or preference for these objects”); Jon
Further, even a mark that has fallen into genericness is still generally protectable against passing off\(^\text{113}\) and false advertising.\(^\text{114}\) (Technically, these claims require de facto secondary meaning, but that threshold would seem to be quite easily satisfied in the case of a hybrid mark.) Thus, while finding more marks generic may be tough medicine for producers in the short run, it may inure to consumers’ and producers’ benefit in the long run. The key to understanding why this is so is recognizing that the term is only a single piece of the brand: the VASELINE brand is not simply the term “kleenex” but the trade dress used with it—the squat jar, the blue label, the font—along with all of the positive associations attached to the brand.

2. The Impropriety of Prevailing Genericness Survey Models

The prevailing genericness survey models are based on the faulty binary understanding of trademarks illustrated above. Trademark hybridity highlights this flaw, which Folsom and Teply noted so presciently several decades ago.\(^\text{115}\)

The first type is the Thermos survey, the first of which was taken in American Thermos Prods. Co. v. Aladdin Industries, Inc. to show that “thermos” had become generic for vacuum flasks.\(^\text{116}\) The Thermos survey tells respondents to imagine walking into a store and asking for the product at issue. For example, the defendant’s survey asked questions like: “Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time? If you were going to buy one of these containers tomorrow—that is, the type that keeps food and beverages hot or cold—what type of store would you select to make your purchase? What would you ask for—that is, what would you tell the clerk you wanted?”\(^\text{117}\) Roughly three-quarters of the 3,000 respondents said “thermos,” while 11% said “vacuum bottle.”

These responses do not reflect what the respondents were asking for. Some of those who asked for a thermos might have preferred a THERMOS-brand vacuum bottle, but others might have preferred any vacuum bottle. As McCarthy explains, one “drawback of a ‘Thermos Survey’ is that for a very strong trademark, respondents with brand loyalty may answer with the trademark and drop what they consider to be a generic name, because it’s so obvious to them. For example, one of the 75% that answered ‘Thermos’ might say, ‘I said ‘Thermos’ because that’s the brand I would buy. I don’t like those

---

\(^\text{113}\) See, e.g., Blinded Veterans Ass’n v. Blinded Am. Veterans Found., 872 F.2d 1035, __ (D.C. Cir. 1989) (“[A] generic term with de facto secondary meaning may be protected against passing off, e.g., by requiring fair notice that a newcomer’s product or service does not come from the original source.”); PSK, L.L.C. v. Hicklin, 2010 WL 4978878 (N.D. Iowa 2010) (finding “overhead” generic in the context of garage doors and nonetheless refusing to bar plaintiff’s §43(a) passing off claim, reasoning relief may be appropriate if the copier has not taken reasonable measures to protect against de facto confusion). See also Mccarthy, supra note __, at § 12:48 (“In the author’s opinion, in order to obtain some form of relief on a ‘passing off’ claim, the user of a generic term must prove some false or confusing usage by the newcomer above and beyond mere use of the generic name. This might include, for example, packaging or advertising words or graphics which, in combination with the generic term, cause mistake or confusion as to source.”). Thanks to Mark Lemley for this point.

\(^\text{114}\) See, e.g., Mccarthy, supra note __, at § 12:48 (“In some cases, the kind of claim a company has against a new competitor is not a ‘passing off’ claim, but a false advertising claim. This occurs when a newcomer uses a generic term to falsely claim to be selling the same product or service identified by that term as does the established company.”) (citing E. Air Lines, Inc. v. N.Y. Air Lines, Inc., 559 F. Supp. 1270 (S.D.N.Y. 1983)).

\(^\text{115}\) See Folsom & Teply, Surveying ‘Genericness,’ supra note __; Folsom & Teply, Reply to Swann and Palladino, supra note __.

\(^\text{116}\) 207 F. Supp. 9 (D. Conn. 1962), aff’d, 321 F.2d 577 (2d Cir. 1963).

\(^\text{117}\) See Mccarthy, supra note __, at § 12:15 (providing an abridged version of the Thermos survey from which the above quotation is taken).
other inferior vacuum bottles.”” But “brand loyalty” may not operate as strongly as McCarthy suggests. And in any event, it may not be necessary to trigger this response. Rather, as trademark hybridity illustrates, it is entirely possible that the hypothetical respondent recognized “thermos” as both a brand and a generic term. “THERMOS-brand thermoses” may seem redundant on first view, but is completely comprehensible in context.119

The second type is the Teflon survey, the first of which was taken in *E.I. Du Pont de Nemours & Co. v. Yoshida Int’l Inc.* to assist in determining whether DuPont’s TEFLO N mark had become generic for non-stick pans.120 The Teflon survey is basically a mini-course in trademark genericness, followed by a series of questions to determine whether the consumer thinks a given name is a brand name or a generic name.121 The survey and results in *Yoshida Int’l* follow:122

I’d like to read 8 names to you and get you to tell me whether you think it is a brand name or a common name; by *brand* name, I mean a word like *Chevrolet* which is made by one company; by *common* name, I mean a word like *automobile* which is made by a number of different companies. So if I were to ask you, “Is Chevrolet a brand name or a common name?” what would you say?

Now, if I were to ask you, “Is washing machine a brand name or a common name?,” what would you say?

[If respondent understands, continue. If not understand, explain again.]

Now, would you say ----- is a brand name or a common name?

<table>
<thead>
<tr>
<th>Name</th>
<th>Brand %</th>
<th>Common %</th>
<th>Don’t Know %</th>
</tr>
</thead>
<tbody>
<tr>
<td>STP</td>
<td>90</td>
<td>5</td>
<td>5</td>
</tr>
<tr>
<td>THERMOS</td>
<td>51</td>
<td>46</td>
<td>3</td>
</tr>
<tr>
<td>MARGARINE</td>
<td>9</td>
<td>91</td>
<td>1</td>
</tr>
<tr>
<td>TEFLO N</td>
<td>68</td>
<td>31</td>
<td>2</td>
</tr>
<tr>
<td>JELLO</td>
<td>75</td>
<td>25</td>
<td>-</td>
</tr>
<tr>
<td>REFRIGERATOR</td>
<td>6</td>
<td>95</td>
<td>-</td>
</tr>
<tr>
<td>ASPIRIN</td>
<td>13</td>
<td>86</td>
<td>-</td>
</tr>
<tr>
<td>COKE</td>
<td>76</td>
<td>24</td>
<td>-</td>
</tr>
</tbody>
</table>

The Teflon survey utterly ignores trademark hybridity. Asking consumers to select between “brand” and “common” presents a false dichotomy. There is no reason why a given term, such as “teflon,” cannot coexist as both a brand and a product (or something else)123 in consumers’ minds. I would wager that, were the survey to account for hybridity, a much higher percentage of consumers than 31% would think “teflon” a generic term for non-stick pans or non-stick coating regardless of those consumers’...

118 Id.
119 This argument should not be read to imply that brand loyalty is worthless in business terms. Indeed, consumers often pay significantly more for brand name drugs despite the fact that chemically identical generic versions of the drugs are often available. Rather, my argument is that even the most loyal consumers are likely to recognize that a trademarked term’s meaning—in conversation and in commerce—will often depend on the context in which the term is used. I may love GOLD STAR-brand Cincinnati chili, but that doesn’t mean I’m necessarily going to be confused as to whether “Gold Star Studios” in Los Angeles or “Gold Star Bar” in Chicago are affiliated in any way with the company behind the chili.
120 393 F. Supp. 302 (E.D.N.Y. 1975)
121 MCCARTHY, supra note __, at § 12:16.
122 The survey and results are adapted from MCCARTHY, supra note ___, at § 12:16.
123 John Gotti was nicknamed “The Teflon Don” after being acquitted three times in the 1980s, presumably because charges couldn’t stick to him.
knowledge of the Teflon brand.

This observation, in turn, highlights the flaws in the typical standard applied to determine whether a term is generic: the court asks whether the generic meaning of the mark is its principal, or primary, significance.\textsuperscript{124} The test assumes that genericness and trademark (source) significance—or product and brand significance—are opposing ends of a spectrum, as illustrated below:

\textbf{Figure 4: An Improper View of Product vs. Brand Significance}

\begin{figure}
\centering
\begin{tikzpicture}
\draw[->] (0,0) -- (1,0);
\draw[->] (0,0) -- (0,1);
\draw[<->] (-0.5,0.5) -- (0.5,0.5);
\node at (0.5,0.5) {Brand};
\node at (-0.5,0.5) {Product};
\end{tikzpicture}
\end{figure}

That again misses the point: product and brand significance are not diametric opposites. Product and brand significance can coexist peacefully side-by-side in the individual consumer’s mind, alongside any number of other senses or meanings the term may have. This is why consumers do not become painfully confused when someone asks for a “kleenex” and there aren’t Kleenex-brand tissues on-hand, or why consumers will often ask for a “diet coke” when all they actually care about is receiving some kind of zero-calorie soft drink.\textsuperscript{125} Genericness surveys must be designed with trademark hybridity in mind.\textsuperscript{126}

By setting up the false dichotomy of “brand” and “product,” existing surveys systematically favor the owners of marks that may have become de facto generic at the expense of competitors and the consuming public. This favoring of existing producers has real costs. For example, trademarked terms are often used to stifle competition—and when the term is found generic, markets open up.\textsuperscript{127} The owners of the Monopoly trademark at one point effectively used their rights to restrict competition in the “monopoly game” market. When the Ninth Circuit found “monopoly” generic for use on board games in \textit{Anti-Monopoly, Inc. v. General Mills Fun Group},\textsuperscript{128} the market for these

\textsuperscript{124} Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (for a seller to prove trademark significance in a term challenged as generic, the seller must show that the “primary significance of the term in the minds of the consuming public is not the product but the producer”); \textit{McCARTHY, supra note _}, at § 12:8 (collecting cases); 15 U.S.C. § 1064(3) (“The primary significance of the registered mark to the relevant public shall be the test for determining whether the registered mark has become the generic name for the goods or services on or in connection with which it has been used”).

\textsuperscript{125} And surely this effect may differ in scope and kind from region to region. “Coke” is used generically for all soft drinks in the American South, but not often elsewhere in the U.S. Regardless, “diet coke” is, in my experience, used and understood generically in many places throughout the U.S. To tie this idea down a bit more cleanly, consider the patron who asks a waiter for a “diet coke.” The waiter will often respond “Is Diet Pepsi (or Diet Rite, etc.) okay?” Often the answer is no, often it is yes—the waiter’s question simply reduces the order’s potential ambiguity. (Not to mention that Coca-Cola and PepsiCo send out brand protection agents to restaurants to try to police this behavior.)

\textsuperscript{126} I would refer readers to Folsom and Teply’s model surveys for a discussion of how we could do so. See note _ and accompanying text. One could fairly easily design a questionnaire to discover whether a name is familiar as a brand, and a separate one to discover whether it is familiar as a generic product name in order to achieve independence on both meanings. Some words may be high on one scale and low on the other, some may be high on both (like Jello, Kleenex, Xerox, etc.), and some might be low on both if the term is unfamiliar to consumers. There’s no real principled reason to force consumers to choose between one meaning or the other.

\textsuperscript{127} See Coverdale, Trademarks and Generic Words, \textit{supra note _}, at 870 (“It would clearly thwart the pro-competitive purpose of trademark law to permit a producer to use trademarks to achieve monopolies over the production or sale of uncopyrighted and unpatented products.”).

\textsuperscript{128} 684 F.2d 1316 (9th Cir. 1982), \textit{cert. denied}, 459 U.S. 1227 (1983). The Trademark Clarification Act of 1984 amended the Lanham Act to repudiate the “consumer motivation” test adopted by the Ninth Circuit in \textit{Anti-Monopoly} but did not abrogate the court’s decision that “monopoly” was generic for board games. Pub. L. 98-620, 98 Stat. 3335 (Nov. 8, 1984). Though we note that, apparently, the Monopoly registrations were not actually canceled. See Parker Bros. v. Tuxedo Monopoly, Inc., 225 U.S.P.Q. 1222 (T.T.A.B. 1984), \textit{appeal dismissed}, 757 F.2d 254 (Fed. Cir. 1985) (“Notwithstanding the [Ninth Circuit’s] decision, [Parker Brothers’] registrations for the mark ‘MONOPOLY’ were not ordered to be cancelled and, according to [PTO] records, are still active registrations.”). In any event, Hasbro does not appear to be enforcing these registrations vigorously against various other O-POLY manufacturers.
games exploded. Amazon.com lists 1,333 results (and counting) for “monopoly” games, offered by a variety of producers, and including dozens of versions of the game created by Hasbro, the current owner of the MONOPOLY brand.\textsuperscript{129} When a producer monopolizes a mark that has become generic, competitors cannot find their consumers, and consumers cannot effectively find those competitors’ products. If a consumer is not sophisticated enough to know to look for a “real estate trading board game” rather than “monopoly,” then comparative searching becomes prohibitively difficult, if not impossible.

3. A Limited Argument in Favor of Stylized Generic Terms

The third implication arising from trademark hybridity is that there is no genuine legal reason to prevent potential stakeholders from using generic marks as brands or trademarks. Indeed, the law generally permits the protection of stylized generic terms to the extent of the stylization, which is precisely appropriate.\textsuperscript{130} The stakeholder can exclude confusingly similar stylizations of the term, but it cannot exclude descriptive uses of the term. For example, consider the figures below:

\begin{figure}[h]
\centering
\includegraphics[width=\textwidth]{apples_logos.png}
\caption{Apples Logos}
\end{figure}

Now imagine that all three figures are used on apples and that A, the owner of the first logo, is the senior user. A likely has a very strong claim for trademark infringement against B, the owner of the second logo. The flames surrounding the word APPLES have little to nothing to do with the product. Trademark theory tells us that consumers are likely to attribute some level of source significance to the flames. They are, therefore, likely to be confused if there are two competitors who use flaming APPLES to designate their respective brands of apples. By contrast, A has no claim against C, the user of the unembellished term. C is simply using the unadorned term “apples” to tell consumers what his product is (so long as the product is apples). Yet C has no claim against anyone. By using the generic term alone, C has no way to harvest consumer goodwill, and no way for consumers to attribute good (or bad) experiences to C’s good (or bad) products.

Markholder A should not adopt that mark. Spoken aloud, there is nothing to distinguish her mark from the apples sold by any other producer. (modern broadly protective trademark law might offer minimal protection to the spoken version only of the term “flaming apples.”) As a result, consumers may shy away from the product because it’s difficult or cumbersome to convey their experiences to others (“yeah, you

\textsuperscript{129} We searched for [MONOPOLY] in the Toys & Games > Games > Board Games section of Amazon.com on February 27, 2013. The first result was the classic Monopoly game, with many other options available on the first page, including Monopoly Nintendo, National Parks Monopoly, and Pirates of the Caribbean Monopoly.

\textsuperscript{130} These marks are, however, very weak and protectable against only exact copying. See Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1566 (Fed. Cir. 1987) (a logo registration “protects only the particular manner in which [the registrant] displays the word ‘sweats.’ . . . [T]he registrant’s rights would reside solely in the particular style of the display of the words”); In re Grant Metro. Foodservice, 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994) (permitting registration of a distinctive display of the word MUFFUNS for muffins); In re Venturi, Inc., 197 U.S.P.Q. 714 (T.T.A.B. 1977) (permitting registration of distinctive display of THE PIPE for smokers’ pipes); In re Trail-R-Van, Inc. 188 U.S.P.Q. 590 (T.T.A.B. 1975) (TRAIL-R-VAN in distinctive geometric design held registrable despite “trailer van” being generic for truck bodies). See also MCCARTHY, supra note __, at § 12:40.
know, APPLES? The one with the flames on the logo? Their apples are really good”) and the goods are difficult to search for (imagine trying to find A’s goods on the internet, or quickly in a supermarket).

In economic terms, the transaction costs and search costs arising out of A’s use of a stylized generic term may exceed the average consumer’s willingness to pay regardless of the quality of A’s products. Use of stylized generic terms as marks should be disallowed only to the extent necessary to deter the misuse (whether malicious or ignorant) of such a mark against others who merely use the mark descriptively. But as the Chipotle, Lord of the Rings, and BEATS examples suggest, the owners of descriptive, suggestive, and arbitrary marks are problem enough on this count. The attraction of overreach may be too enticing, and this risk may simply be too much to bear to permit the wide usage of stylized generic terms.

4. Dilution’s Theoretical Failure

The Lanham Act protects famous marks against two types of trademark dilution: (1) blurring; and (2) tarnishment.

Blurring reflects the idea that the presence of multiple uses of a term in commerce, even in diverse markets, will tend to decrease the consumer’s ability to recall the senior user’s mark. In other words, the consumer’s mental link between the term and the senior user’s mark is “blurred” by the existence of another user’s mark. The consumer whose mental representation of the term has been blurred must “think for a moment” before the senior user comes to mind. In other words, the consumer’s “imagination costs” have been raised, which is generally assumed to be inefficient. The intuition is very much tied up in the concept of free-riding. For example, if a restaurateur opens a Mexican restaurant and names it TIFFANY, the jewelry store may make two complaints: First, that the restaurateur is attempting to siphon off the jewelry store’s goodwill in lieu of developing its own through repeated consumer interaction. Second, the jewelry store

---

131 See, e.g., WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 167–68 (2003); Stacey L. Dogan & Mark A. Lemley, Trademarks and Consumer Search Costs on the Internet, 41 Hous. L. Rev. 777, 786–87 (2004) (“Rather than having to inquire into the provenance and qualities of every potential purchase, consumers can look to trademarks as shorthand indicators. Because information is less expensive, consumers will demand more of it and will arguably become better informed, resulting in a more competitive market”); Landes & Posner, supra note __, at 268–70.

132 See MCCARTHY, supra note __, at § 12:40 (“The potential competitive danger of such logo registrations of generic names is that the owners of such registrations sometimes have an inflated notion of the scope of their exclusive rights and assert them against competitors as if they owned the generic name displayed in the registration. Faced with such a registration, the businessperson who fails to seek competent legal advice may agree to cease use of the generic name, causing a significant and unnecessary impairment of the competitive process.”). See generally JASON MAZZONE, COPYFRAUD AND OTHER ABUSES OF INTELLECTUAL PROPERTY LAW (2011) (detailing the overreach of intellectual property law, whereby content owners claim overbroad ownership rights); Ridgway, Revitalizing the Doctrine of Trademark Misuse, supra note __, outlining a test for trademark misuse.


136 LANDES & POSNER, supra note __, at 207; Laura R. Bradford, Emotion, Dilution, and the Trademark Consumer, 25 Berkeley Tech. L.J. 1227 (2008). Beebe has argued that the “search costs” description of antidilution law is, ironically, not what the concept of “dilution” is all about. Rather, dilution is about maintaining trademarks’ (and other intellectual properties’) ability to manufacture social distinction. See Beebe, Intellectual Property Law and the Sumptuary Code, supra note __, at 845–68.
will complain that the existence of another TIFFANY blurs the consumer’s mental connection between the term and the jewelry store, making the association between the goodwill and jewelry weaker, and depleting the reservoir of goodwill.

Tarnishment is, in theory, much like blurring. The connotations the consumer develops, however, are explicitly negative rather than neutral.\footnote{See Landes, Posner on Beanie Babies, supra note \_\_, at 1768–69 (setting forth a formal economic model of tarnishment).} Thus, if instead of a restaurant, our entrepreneur opens up a TIFFANY (or maybe even TIFFANI) strip club, the jewelry store will argue that its mark is being tarnished by the term’s connection with a seedy strip club. Courts generally only find tarnishment when the junior user’s goods or services are related to sex.\footnote{See, e.g., V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 385 (6th Cir. 2010), cert. denied, ___ (creating a “rebuttable presumption” of tarnishment where the defendant has used the plaintiff’s mark or a similar mark in association with sex-related products).} But as Mark Lemley and Stacey Dogan have noted, many courts “seem to have misunderstood tarnishment as ‘saying something bad about the trademark owner,’ rather than its proper meaning of ‘branding your own inferior or noxious goods with the plaintiff’s mark.’”\footnote{Lemley & Dogan, Parody as Brand, supra note \_\_, ¶11. See also Mark P. McKenna, A Consumer Decision-Making Theory of Trademark Law, 98 Va. L. Rev. 67, 134–36 (2012) (arguing this misunderstanding of tarnishment is inherent in the concept itself).} Beebe has argued tarnishment has expanded to govern uses that simply lower the value of a mark’s goodwill or harm its reputation.\footnote{See Beebe, Intellectual Property Law and the Sumptuary Code, supra note \_\_, at 858 (“Such uses include, of course, dilutive copying that tarnishes the mark’s reputation for uniqueness, regardless of whether that copying takes the form of ‘shoddy’ copies, and regardless of whether that copying places the targeted mark in an ‘unwholesome or unsavory context.’”).}

As with generic terms, dilution’s alleged harms to consumers arise from semantic ambiguity.\footnote{Cf. Butters, A Linguistic Look, supra note \_\_, at 515–18 (tying together the harms arising from the fall into genericness and dilution).} The difference is, in most situations a mark’s fall into genericness happens gradually and naturally. The term develops additional senses through no particular affirmative acts of competitors, but instead through consumer linguistic usage over time. By contrast, dilution is said to occur when a separate business entity adopts another’s trademark as its own. In other words, the new entity creates out of whole cloth an association with sex that characterizes goods or services. Consumers are therefore constantly dealing with semantic ambiguity. We deal with it quite well given context.

That consumers are so used to dealing with this type of ambiguity should be a sign that dilution’s purported harms, if they exist, are relatively minor in empirical terms. Recall that research suggests that such an increase in semantic associations may, contrary to the internal search costs theory, reinforce rather than inhibit retrieval and recognition of the primary association.\footnote{See supra Section I.B.} Blurring and tarnishment imply interference, but it’s not so clear that the addition of new senses and meanings are negative; rather, they may be positive and productive.\footnote{See supra notes ___ and accompanying text.} The addition of new senses and meanings may

\footnote{See supra notes ___ and accompanying text.}
not be “death by a thousand cuts” then, but instead more akin to a snowball rolling down a hill.

And as noted above, the law lacks an account of what the threshold for “harm” should be, should such harm exist. An increased response time of .01s that does not result in any type of tangible harm like a lost sale seems rather de minimis. Further, the other aspects of the brand, including trade dress, logos, and positive (or negative) affective responses to that brand, are significant additional confounding factors. Even if we agree that .01s of increased response time is statistically—and economically—significant when controlling just for the word mark itself, researchers who find such an increase will tend to elide the distinctions consumers make that arise in the context of actual trademark use.

Cognitive science and psycholinguistics therefore do not provide the basis for a full-throated defense of dilution. This section is titled the dilution’s “theoretical” failure because the evidence on the internal search costs model simply doesn’t yet add up to a significant effect on consumer decisions (assuming it has any effect). Courts have, for the most part, recognized this theoretical failure and, according to Barton Beebe and others, have relegated dilution claims to the dustbin. But it’s not only at the level of the judicial system that antidilution law has an effect. Most overreaching behavior takes place in the shadow of the law through cease-and-desist letters and other bottom-up approaches. It is unlikely most recipients of an overbroad cease-and-desist letter would understand the nuanced approach—verging on outright hostility—courts have taken to dilution claims. Rather, they are likely to see the claim, the citation to and quotation of the statute, and simply fold because they cannot afford to challenge it or because their knowledge of the law is incomplete. The statute’s mere existence thus causes significant problems.

Efforts to protect the producers of products bearing famous marks should be explicit, acknowledging full-well what we are granting is a property interest in a word or phrase. And we should only grant such a right if we fully understand the extent to which those producers will, quite rationally, seek to expand it. We must also understand how that producers will use that expanded protection as a new lower baseline in order to continue expanding their scope of protection. In my view, the better approach would be to simply jettison this part of the statute given the high costs and potential for anti-consumer and anti-speech behavior on the part of markholders. Should future research bear out an actual harm, antidilution protection might then merit consideration.

146 See McCARTHY, supra note __, at __.
147 Accord Tushnet, Gone in Sixty Milliseconds, supra note __.
149 Cf. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES, supra note __, at 9 (“People’s imagination of what ‘the law says’ may be a shaping force in those expressive activities that potentially violate it and in those practices that might be considered protected acts of ‘speech,’ constitutionally defined. People’s anticipations of law . . . may actually shape law and the property rights it protects.”).
B. Implications for Trademark Theory

1. Communicative Costs: Chilling Effects and Overprotection

Trademark hybridity also raises questions about how trademark law protects free speech interests. When the line between trademark use and expressive use is blurry, doctrine creates chilling effects. These chilling effects arise from an unsavory combination of unpredictable trademark fair use law, sky-high legal bills, and rationally litigious trademark owners, who often file strike suits and send cease and desist letters “even when the complained-of expressive uses are almost certainly legal under the substance of current doctrine,” as Bill McGeveran has noted. When combined, would-be users quite rationally choose to avoid potential liability and limit their trademark-based expression. This risk avoidance on the part of would-be users is both entirely understandable and highly problematic from a distributive perspective—they who the fewest resources are the most likely to have their speech squelched. Few will litigate, finding the threat of liability exceeds the expected benefit of the expression. The courts will not develop precedent, and the line between trademark protection and expressive use will remain hazy.

Law’s failure to recognize trademark hybridity keeps that line hazy by mashing together a term’s varied conceptual definitions such that many uses will not be

---

151 While many scholars argue that the First Amendment does not permit the suppression of speech through trademark law, this argument often does not bear out in practice. Compare Robert C. Denicola, Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protections of Trade Symbols, 1982 WISC. L. REV. 158, 206 (1982) (“The First Amendment will not permit the trademark owner the power to dictate the form, and thus the effectiveness, of another’s speech simply because his trademark has been used to express ideas that he would prefer to exclude from the public dialogue.”) with Dr. Seuss L.P. v. Penguin Books, 109 F.3d 1394 (9th Cir. 1997) (affirming the district court’s issuance of an injunction related to the defendant’s release of a book entitled The Cat NOT in the Hat!, which satirized the O.J. Simpson trial by adopting the particular style of speech and design used by Dr. Seuss); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir. 1987) (“Mutant of Omaha”); Anheuser-Busch, Inc. v. Balducci, 28 F.3d 769 (8th Cir. 1994) (“Michelob Olly”). See also Dr. Seuss L.P., 109 F.3d at 1405 (“Some parodies will constitute an infringement, some will not. But the cry of “parody!” does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark. A non-infringing parody is merely amusing, not confusing.”) (quoting MCCARTHY, supra note __, § 31.38[1], at 31-216 (rev. ed. 1995)). Bill McGeveran notes that trademark fair use outcomes have stabilized over the last fifteen years and courts have increasingly favored defendants in cases involving the expressive use of trademarks. See William McGeveran, Rethinking Trademark Fair Use, 94 IOWA L. REV. 53, 59–61 (2008). Nonetheless, this stabilization has occurred on the “back end” in the form of defenses rather than on the “front end” in terms of definitional limits on liability. Id. at 61–66. Expressive uses thus remain incredibly risky.

152 McGeveran, Rethinking Trademark Fair Use, supra note __, at 64.

153 Id. (“Self-censorship of expressive uses in such circumstances is quite rational and apparently quite common.”).

This effect roughly tracks the economic idea of “activity level effects,” which is most often found in legal scholarship on tort liability. See, e.g., David Gilo & Ehud Guttel, Negligence and Insufficient Activity: The Missing Paradigm in Torts, 108 MICH. L. REV. 277 (2009) (arguing that negligence liability may cause parties to deliberately restrict activity levels in order to reduce risk when the costs of doing so is lower than the cost of welfare-enhancing precautions). The idea, broadly understood, is parties will modify their activities in response to their potential risk of liability. In this context, the haziness of the law along with the facial breadth of the claims may cause individuals to drastically lower their activity to suboptimal levels.

154 COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES, supra note __, at 78 (“[I]n most cases or politically creative cultural appropriations, freedom of expression arguments will never be asserted, and certainly not publicized. . . . Faced with the threat of litigation, most local parodists, political activists, and satirical bootleggers will cease their activities. . . . The more indigent [markholders’] opponents, the less likely it is that [the opponents] will have recourse to counsel sophisticated in intellectual property matters, and the more likely it is that intellectual property holders will be advised to project expansive claims about their own rights and threaten draconian measures of enforcement.”). Cf. LAWRENCE LESSIG, FREE CULTURE (2004) (“But fair use in America simply means the right to hire a lawyer to defend your right to create. And as lawyers love to do, our system for defending rights such as fair use is astonishingly bad—in practically every context, but especially here. It costs too much, it delivers too slowly, and what it delivers often has little connection to the justice underlying the claim. The legal system may be tolerable for the very rich. For everyone else, it is an embarrassment to a tradition that prides itself on the rule of law.”).
straightforward applications of one definition or another. For example, the group Outkast used Rosa Parks’ name in a song title. Assuming trademark law even applies—or should apply as a normative matter—to this problem, would that be something trademark law permits? \(^\text{155}\) Trademark hybridity bears on this question because it matters which definition of ‘Rosa Parks’ is at issue: does the use mean to refer to the person Rosa Parks? The idea of Rosa Parks, civil rights hero? Something else suggestive of Rosa Parks’ legacy? \(^\text{156}\)

Without clarity about the meaning behind Outkast’s use of the name, courts risk poorly reasoned—and unjust—outcomes. And if the party’s intent is not clear from the face of the use—that is, the meaning is contested—we should consider whether that fact alone should militate in favor of a finding of fair use. \(^\text{157}\) Trademark hybridity calls attention to the contestability of conceptual uses like Outkast’s use of “Rosa Parks” in a song title. There are varied reasons for calling the song “Rosa Parks,” and varied ways consumers of the song will conceive of the song’s title. Outkast’s use is not a paradigm trademark use, like COCA-COLA for soda. Instead, it’s a use of “Rosa Parks” in an expressive sense, incorporating her value as a marker for certain societal and cultural values. \(^\text{158}\)

By recognizing trademark hybridity and, in turn, the capacity for words to simultaneously signify a variety of concepts, we can drill down to the actual issues: is Outkast hoping to confuse fans of civil rights into buying the group’s music or seeking to trade on Rosa Parks’ goodwill, \(^\text{159}\) or instead seeking to repurpose Rosa Parks’ name to argue that Outkast is an agent of hip-hop change much like Rosa Parks was for the civil rights movement? Should it matter at all what the group’s intent was, so long as consumers are not confused? \(^\text{160}\) If we can agree that the answer is the latter rather than the former, then we should also be able to agree that the situation doesn’t necessarily fall within the bounds of trademark law’s traditional foci of source-identification and quality control. Perhaps we may take issue with Outkast’s use of Rosa Parks’ name for

\(\text{155}\) The Sixth Circuit thought not in invoking the Lanham Act as a quasi-right of publicity statute. See Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003) (reversing summary judgment in favor of defendants in case involving Outkast’s “Rosa Parks”).


\(\text{157}\) Cf. Rebecca Tushnet, Judges as Bad Reviewers: Fair Use and Epistemological Humility, 25 L. & LIT. 20, 28 (2013) (on copyright fair use, arguing “when reasonable audience members could discern commentary on the original work, a court should find favored ‘parody,’ even when other reasonable audience members could disagree.”).

\(\text{158}\) See generally COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES, supra note ___ (arguing intellectual property regimes unduly impede the people’s ability to reexamine and repurpose their culture for new expression or meanings).

\(\text{159}\) Goodwill is a slippery concept. Robert Bone has done an enviable job of taxonomizing it. He divides goodwill into three categories: 1) brand goodwill, which refers to “the positive information consumers have about a specific brand, such as its reliability, high quality, and the like[;]” (2) firm goodwill, which “extends beyond associations with a brand to include positive impressions of the firm that sells the brand[;]” and (3) inherent goodwill, which “inheres in the mark itself” and “has nothing to do with safeguarding the quality of consumer information.” See Robert G. Bone, Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law, 86 B.U. L. REV. 547 (2005). In other work, I have argued that goodwill is best understood as congealed affect. Greene & Wilkerson, Circular Character, supra note ___, at ___ n. ___ (“Whether consumers’ affective response is positive, negative, or ambivalent, that response is embodied in the ways in which those consumers interact with and understand the mark and the brand. Hand-in-hand with goodwill’s effect on consumptive behavior, then, go the expressive meanings the public develops in connection with the mark and brand. These meanings and affective responses congeal around the symbol, which is, in turn, used as shorthand for those meanings or responses.”).

\(\text{160}\) Cf. Laura A. Heymann, Everything is Transformative: Fair Use and Reader Response, 31 COLUM. J. L. & ARTS 445, 448 (2007) (“But the better test of whether a second work has contributed a ‘new expression, meaning, or message’ to the first [in the context of copyright fair use] is to turn to the reader, the one who ‘holds together in a single field all the traces by which the written text is constituted.’”) (citations omitted).
moral or other reasons, but that likely should not be a matter of trademark concern, but rather an issue for a state right of publicity or some other regime. (And even then, there are significant reasons to question restricting Outkast’s use.)

If we recognize the multitudes of concepts a given term could signify, we could also alleviate some of the burden imposed on competitors’ speech by the protection of certain types of trademarks. Descriptive marks are the most likely to trigger a competitor’s expressive interests, because descriptive marks “inherently convey information regarding the attributes [that is, qualities, characteristics, ingredients, subject matter, purpose, function, use, size, merit, quantity, capacity, class of intended purchasers, and so on] of a product.” In providing an effective monopoly over such terms, the law imposes costs on competitors (and non-competitors) seeking to describe their products. Moreover, the law prevents competitors from making true statements about their products.

This concern is not limited to descriptive marks. Similar concerns arise from the protection of some arbitrary and suggestive marks as well due to trademark law’s expansion to protect brands. Chipotle has sued the grocery chain Kroger and the fast-food chain Jack in the Box for using the term “chipotle” to describe an ingredient in their products, arguing that the chains are simply trying to free-ride on Chipotle’s reputation. Likewise, Dr. Dre’s Beats Electronics has begun challenging trademark registrations for variations on “BEAT” and “BEATS” in a variety of product and service classes based on the same argument. The more that courts, practitioners, and scholars realize that context— which would include logos, marketing, situational context, and product category—clarifies the ambiguity in various conceptions of a given term, the easier it should be to limit protection to those situations in which consumers are actually likely to be confused, and thus where producers and consumers may be likely to be harmed. In other words, the likelihood of confusion test must be recalibrated to focus more—that is, more than it currently does—on contextual use. This recalibration will be especially important in the registration context where text-only marks are compared almost entirely acontextually.

2. Competitive Costs: Creating and Prolonging Monopolies

As a body of law that is at least nominally pro-consumer, trademark law should serve at least two related goals. In addition to promoting communicative values, trademark law should also foster competition. Failing to recognize trademark

---

162 Id. at 1169.
163 Id. (“Every business should have the right to use terms that describe the attributes of a product.”). See also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 120 (2004) (recognizing that descriptive fair use may occasionally override a finding of liability where there exists a likelihood of confusion); Graeme Dinwoodie, What Linguistics Can Do For Trademark Law, in INTERDISCIPLINARY PERSPECTIVES ON TRADE MARKS 31 (J. Ginsburg, L. Bently, J. Davis, eds., 2007) (“[T]he competitive gains that flow from enabling rival producers to make use of essential descriptive terms may exceed the reduction in search costs that would be achieved by prohibiting the competitors’ somewhat confusing use.”), available at http://ssrn.com/abstract=1001455.
164 See supra note __ and accompanying text.
165 See supra note __ and accompanying text.
166 See Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002) (“Our likelihood-of-confusion test . . . generally strikes a comfortable balance between the trademark owner’s property rights and the public’s expressive interests.”).
167 See Coverdale, Trademarks and Generic Words, supra note __, at 879 (“Because the ultimate purpose of trademark law in general and the genericness doctrine in particular is to promote competition, the goal of the test for genericness
hybridity imposes significant economic costs on competitors and consumers, in addition to the communicative costs noted above. As Folsom and Teply noted—and as the Ninth Circuit recognized in the Anti-Monopoly cases—appropriation of a term that has a high level of product significance can create or prolong not only the artificial trademark monopoly, but also the resulting market monopoly.169 Folsom and Teply explained:

[Producers of goods are under a strong economic incentive to select a generic word as their trademark or to encourage consumers to adopt their trademark as a household term. Generic use of a trademark in advertising is thought to be a desirable marketing strategy because it excludes all mention of competing brands and even suggests their nonexistence. Moreover, the use of generic words as trademarks increases search costs because consumers may be unable to determine whether potentially competing products are within the same product category or whether they have the same general characteristics associated with the trademarked generic word. In this way, the use of generic words as trademarks creates an entry barrier that enhances the ability of the firm holding the generic mark to charge supracompetitive prices.169]

To blunt this tendency, many scholars have advocated a genericness doctrine focused on the competitive effects of allowing an allegedly generic word to continue to be used as a trademark.170 In the case of a hybridized word mark, then, a judge should separate the situations in which finding a hybridized mark generic would promote competition from those in which the opposite would be true and find marks generic appropriately. While I agree in principle, the fact remains that defining the market in a case in which a trademark has become generic over time is a Herculean task that may not be worth the effort.171 Louis Kaplow has argued that in order to properly define a market in the antitrust context, we must accumulate sufficient data to determine how price differences affect purchases of all other goods sufficiently close to be candidates for inclusion in the same market.172 At that point, a policy judgment should be made regarding “how much

---

169 See Folsom & Teply, Trademarked Generic Words, supra note , at 1340–46. Among other costs to competition, Folsom and Teply describe the difficulty of “assur[ing] consumers that [a competitor’s product is] in the product-category covered by the trademarked generic word, so that consumers’ search costs may be reduced, experience purchases encouraged, and the perceived risks decreased.” Id. at 1344. Remedies to these problems include adopting an alternative generic signifier (which often doesn’t work because the alternative names are too technical, unfamiliar, or simply cannot convey the level of information necessary), point-of-sale advertising and packaging (which doesn’t work when dealing with services and many other experience goods), and licensing. Id. at 1344–45. However all of the alternatives are very costly and potentially ineffective due to the same type of first-mover disadvantage problems that necessitate the class action system or that make many large-scale public-oriented innovations like the Google Book Project nearly impossible to accomplish. See Randal C. Picker, Access and the Public Domain, 49 SAN DIEGO L. REV. 1183, (2012) (“Of course, Google doesn’t want to face a first-mover disadvantage where it bears the cost of scanning and then second-movers free ride on those scans.”).

170 See, e.g., id. at 880–81 (“Rather than ending with the narrow lexicalological inquiry mandated by the primary significance test, a court faced with a genericness case should seek to balance the conflicting interests of the trademark holder, the alleged infringer, and the public in the manner that most tends to foster competition in the relevant product market.”) (citing Am. Chicle Co. v. Topps Chewing Gum, Inc., 208 F.2d 560, 562 (2d Cir. 1953)). See also Folsom & Teply, Trademarked Generic Words, supra note , at 1352 (“Will market transactions proceed more efficiently if the trademark holder is permitted exclusive use of the mark, or will they proceed less efficiently?”).


of a price increase we are willing to tolerate before defining the company that increases its price as a monopolist.” 173 But, as Lemley and McKenna note, “if we have that information, we can determine power over price directly, without ever having to define markets.” 174 A more finely tuned analysis, therefore, may be thrown out in favor of a rougher one. And this is assuming that this data can be collected and appropriately sorted.

Take Folsom and Teply’s approach as an example of the market-based approach. In lieu of the primary significance test, they suggest the following:

A better approach to this problem would be to recognize that a finding of one primary significance may not be possible: in other words, that the hybrid character or many trademarked words may create pluralities or coextensive majorities. Specific evidentiary survey questions, for example, should be directed to each relevant universe to identify the three categories of consuming persons likely to be present in any generic litigation. First, a survey should identify those persons who are unaware of any source-significance for the mark and who use the mark as a product-category word. Second, it should identify those persons who are aware of source-significance and who do not use the mark generically or understand it to refer to an entire product-category. Third, the survey should identify those persons who know that the mark has source significance and who also use the mark in a product category sense. . . . After these three categories . . . have been identified, courts and the Trademark Office should decide whether to permit exclusive rights to trademarked words based upon the following test: Will market transactions proceed more efficiently if the trademark holder is permitted exclusive use of the mark, or will they proceed less efficiently? 175

The practical implications of such an approach are to force onto courts an analysis they are poorly equipped to make. While Folsom and Teply may be right in saying that “the impact of the exclusive use of a trademarked word in the market . . . should be the most crucial factor in any litigation[,]” 176 the question remains whether that impact can be effectively measured with resort to the judicial toolkit. How is an individual judge to answer the question whether “market transactions [will] proceed more efficiently” if even the technocratic agencies that routinely engage in such analyses cannot do so consistently well or, in many cases, even logically? 177 Even if parties offer expert proofs that purport to answer that question, do we think courts will take seriously those proofs in the mine run of trademark disputes when each litigant has an incentive to choose an expert whose analysis will skew its way?

In addition, such an analysis may not appropriately account for individualized


173 Lemley & McKenna, Is Pepsi Really a Substitute for Coke?, supra note __, at 2098 (summarizing Kaplow’s arguments).
174 Id.
175 Folsom & Teply, Trademarked Generic Words, supra note __, at 1352.
176 Id. at 1353.
177 See Lemley & McKenna, Is Pepsi Really a Substitute for Coke?, supra note __, at 2100 (“[A]gencies and courts sometimes define ‘submarkets’ within an antitrust market. Alternatively, they speak of the ‘smallest relevant market’ that meets the [SSNIP] test. The ‘submarket’ concept makes no sense; if a market is a grouping of products that share high cross-elasticity of demand, a subset of that group shouldn’t have the power to raise prices without prompting consumers to switch to the other products in the larger market. If a submarket is properly defined, it means the market itself wasn’t properly defined.”). See generally Robert G. Bone, Enforcement Costs and Trademark Puzzles, 90 VA. L. REV. 2099 (2004).
brand protection measures. That Parker Brothers was able to profitably monopolize MONOPOLY through asserting its rights doesn’t tell us much about whether consumers would be better or worse off if Wham-O no longer controlled the FRISBEE trademark. Should it matter to the analysis that Wham-O doesn’t seem to assert its rights very often while Parker Brothers did? If it does and our determination of whether ‘frisbee’ is generic turns on how extensively Wham-O decides to litigate brand protection (or send out cease-and-desist letters), perhaps we should avoid the problem entirely and simply legally recognize the term’s de facto genericness.

At least in the realm of genericness, then, it may simply be less costly in an absolute sense—that is, to consumers, competitors, society, and even, to some extent, to producers—to put a thumb on the scale in favor of finding polysemous, hybridized marks generic given the low likelihood of confusion or dilution where appropriate context exists to disaggregate the various senses (or meanings) in which the word may be used. Properly-drawn survey evidence about actual consumer language patterns can give us all the information we need to know in order to determine whether a given trademark has become generic. In those cases in which the outcome is not clear-cut—for example, if the product and brand sense are more or less equally used—we should presume that the term is generic, thus freeing it for wider use by competitors and noncommercial users. By virtue of the protectability of other aspects of the brand, producers will still maintain some level of protection against legitimately confusing uses.

III. SOURCE IDENTIFICATION OR BRAND PROTECTION?

A. Producers or Consumers?

Trademark hybridity questions foundational aspects of trademark law. By accounting for trademark hybridity, scholars and courts can clarify the debate about what exactly it is the law seeks to protect through assertion of trademark rights.

Most trademark litigation—dilution litigation in particular—focuses on protecting a brand’s goodwill. Yet trademark protection is supposedly premised on search cost and quality-control theories. Once a word mark becomes generic, competitors may use it to describe their goods. This reduces communication costs by permitting competitors to inform the consumer that they sell a product that the consumer can readily identify, and also reduces rent-seeking costs.

But the real goals of trademark law appear to be the promotion of consumer wellbeing, defined as fostering active competition, minimizing search costs, and supporting consumers’ and competitors’ freedom of speech utilizing trademarks. And in practice, trademark law is also concerned with linguistic burdens on competitors, as a corollary to search costs: “band-aid” is easier to use than “adhesive bandage” and “yo-

\[178\] See supra Sections __ and __.

\[179\] Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 1, 9 (2d Cir. 1976) (“[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name”).

\[180\] Landes & Posner, supra note __, at 294. Landes and Posner also outline the costs of genericness doctrine; they argue that “[i]n principle, trademark protection should cease when the costs of continued protection (deadweight losses resulting from higher prices, higher costs to rivals in using alternative words, and the costs of licensing and defending trademarks) exceed its benefits (less consumer confusion, lower search costs, and the gains associated with the incentive of firms to develop high quality goods).” Id. at 294–95.
yo” conveys information to consumers better than “return top.”

If those are the goals, then courts should recalibrate their focus. When consumers are not confused by a competitor’s use of a trademarked term, and the term eases the competitor’s linguistic burden, then the mark at issue should be found generic. That is so regardless whether the hybrid term still maintains a high level of brand significance. Consumers are remarkably resilient and are more than capable of understanding hybrid trademarks given appropriate context.

Under current trademark doctrine, courts pay inadequate attention to these issues. Rather, they tend to focus on brand strength without an explicit recognition that they are doing so. Indeed, the entire idea of protection against dilution disregards consumer confusion and is premised on protecting brand strength: the stakeholder of a sufficiently strong or famous mark can obtain an injunction against non-confusing uses. As other scholars have shown, by adopting nontraditional confusion theories, courts have allowed dilution-style producer protection goals to bleed into the classic trademark infringement inquiry.

Whether this bleed is good or bad is a matter of policy priorities. If trademark protection is designed to protect consumers and encourage market competition, then the bleed is bad. On this view, courts should thus focus less on brand significance and spend more time ferreting out those situations in which consumers in fact use terms generically. Such ferreting may take the guise of a modified descriptive fair use inquiry—much like the analysis applied in KP Permanent Make-Up, focused on those situations in which a term is consistently used generically—or may involve identifying single-player market situations in which consumers searching for competing producers’ products in the marketplace have difficulty doing so. Shifting to these alternatives may be costly, but it’s not clear that these alternatives would be any more costly than current approaches to trademark litigation and survey-taking.

By contrast, if trademark protection is designed to protect stakeholders’ investments from free-riding, then the bleed is good. On this view, the cost-benefit calculus changes and courts would properly focus on brand strength. Shifting to such a focus would mean fewer marks will be held generic.

My own view tends to be that the bleed is bad, based on the anticipated

---

181 The existence of a reasonable alternative generic signifier is relevant to the question of trademark strength as well as the genericness inquiry, as I have argued elsewhere. See Greene & Wilkerson, Understanding Trademark Strength, supra note __, at __. However, whether an alternative generic signifier is “reasonable” will require an inquiry into consumer language patterns. “Return top” isn’t a reasonable alternative for “yo-yo” just because the plaintiff says it is. Properly developed survey evidence is absolutely crucial.

182 See Desai & Waller, supra note __, at 1458–60; id. at 1494–95 (“Insofar as the law champions a brand result, it should do so explicitly and be better equipped to say so. This, in turn, would permit clear, critical discussion regarding the normative desirability of such outcomes.”).

consequences of courts focusing on brand strength, which I illustrated above. Such a focus likely would not have salutary effects for competition, communication, and overall consumer wellbeing. This conclusion is especially true where other facets of trademark law like the so-called policing requirement create such perverse incentives.\footnote{See Cory Doctorow, Trademarks: The Good, the Bad, and the Ugly, THE GUARDIAN (UK) (Apr. 29, 2013 07:28 EDT) ("Trademark lawyers have convinced their clients that they must pay to send a threatening notice to everyone who uses a trademark without permission, even where there is no chance of confusion. They send letters by the lorryload to journalists, website operators, signmakers, schools, dictionary publishers—anyone who might use their marks in a way that weakens the association in the public mind. . . . When called out on policing our language, trademark holders and their lawyers usually shrug their shoulders and say, ‘Nothing to do with us. The law requires us to threaten you, or we lose our association, and thus our mark.’ This is a very perverse way of understanding trademark."). available at http://www.guardian.co.uk/technology/2013/apr/29/trademarks-good-bad-ugly?CMP=twt_gu.}

\textbf{B. Solving by Simplifying}

In this Section, I sketch the outlines of a solution, by its nature preliminary, to the problems set forth in this article. Given the existence of polysemousness and homonymity generally, and trademark hybridity specifically, we should reconsider the broad scope of exclusion granted to markholders over individual terms. I believe the best way to do this is to pare back the number and types of meanings we allow producers to regulate: word mark protection should be limited to a mark’s source-identifying meaning, the scope of which protection should vary with consumers’ understanding of the mark. Strong word marks may properly be allowed a broader scope of protection than weaker marks because consumers are generally more likely to become confused when strong marks are used on non-competitive goods and services than when weaker marks are so used. A proper acknowledgement of trademark hybridity would therefore focus on the following considerations:

1. \textit{Accurately measuring trademark strength.} Properly recognized, trademark strength is the means of measuring a mark’s scope of exclusion—that is, it’s a measurement of the markholder’s ability to prevent other producers from commercial use of the trademarked term.\footnote{Greene & Wilkerson, Understanding Trademark Strength, supra note \_, at \_.} In order to limit trademark law’s potential to stifle competition and communication, judges must not overestimate a trademark’s exclusive scope (except to the extent to which any judicial determination is necessarily inexact). In other work, I have developed a taxonomy for considering the interests and evidence relevant to determining a trademark’s exclusive scope.\footnote{See generally id.} By limiting the scope of the right to the minimum amount necessary to protect the producer’s interest in source-identification, we can also limit the producer’s incentive to engage in anticompetitive and anticomuncative activities.

2. \textit{Limiting control over a term’s emergent expressive meanings.} Trademarked terms almost always signify a variety of different meanings. Generally, one of these meanings will be the trademark’s traditional source-identifying meaning (Barbie = \textit{the fashion doll made by Mattel}). But, especially with respect to very well known marks, the term will often develop other related meanings, some of which may be relevant to trademark scope (for example, Barbie = \textit{any female fashion doll}), many of which may not (Barbie = \textit{the idea of a shallow, materialistic woman}). As
many scholars have noted, trademarks and logos are fundamental building blocks of modern cultural communication.190 We use trademarks and logos like we do other pop culture ephemera—to develop and maintain social relationships and to express ourselves through broadly understandable media. By adopting the corporate-based brand view of trademarks,191 which, as noted above, grants broad rights to producers at the consumer’s expense, we allow a climate of private censorship to develop. The theory developed in this paper contests the propriety of delegating such rights to markholders, buttressing the claims of other scholars who have questioned producer control over expressive meanings.

3. Properly designing consumer surveys. As noted above, trademark genericness surveys must be drafted with trademark hybridity in mind. A trademarked term need not be—in fact, cannot be—understood as either a source-identifying mark or a generic term for a particular type of product. Language isn’t that neat. Rather, surveys must be designed to elicit the range of meanings consumers attribute to a trademarked term. Folsom and Teply developed a very reasonable model in the mid-1980s.192 Perhaps it’s time to revisit that model.

CONCLUSION

In this article, I summarized the theoretical underpinnings of an empirical research agenda oriented towards the application of psycholinguistics to trademark law. Future research will pointedly examine how the theory works in practice and, hopefully, provide further insight for the ongoing debates regarding the internal search costs conception of dilution and genericness.

Trademark hybridity’s recognition of semantic ambiguity and its application to trademark law provides some very serious reasons to question the propriety of several longstanding, key features of trademark law. Conceptual meaning isn’t binary—a trademarked term isn’t merely a source identifier or not a source identifier. Rather, terms can signify many concepts simultaneously with little internal confusion when appropriate context is provided. In practice, context, whether explicit or implicit, is always available. In addition to questioning prevailing genericness and dilution doctrine, I also hope to spur a frank conversation about what we seek to protect in trademark law—not what we do protect, because that much is clear. Rather, if we really only care about source-identification and quality-control, then the law must be changed to reflect that. If we instead are happy with the extension of trademark protection to incorporate other interests, we should at least be clear about it and ensure that such a state of affairs is reflected explicitly in the law rather than imported into the law through subterfuge under other rationales.

***

190 There is a rich literature on this point. For particularly influential examples, see, e.g., COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES, supra note __. Rochelle Cooper Dreyfuss, Expressive Genericity: Trademarks as Language in the Pepsi Generation, 65 NOTRE DAME L. REV. 397 (1989); Kozinski, Trademarks Unplugged, supra note __; Jessica Litman, Breaksfast with Batman: The Public Interest in the Advertising Age, 108 YALE L.J. 1717 (1998).
191 See supra notes [50 = 60] and accompanying text.
192 See Folsom & Teply, Surveying ‘Genericness,’ supra note __; Folsom & Teply, Reply to Swann and Palladino, supra note __.