

Is it Time to Overrule the Trademark Classification Scheme?

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Date : May 6, 2016

Jake Linford, *Are Trademarks Ever Fanciful?*, 105 **Geo. L.J.** (forthcoming), available at [SSRN](#).

Trademark law protects *distinctive* marks: ones that identify the source of goods or services and distinguish them from others in the marketplace. But how should courts determine whether consumers view a mark as distinctive? In an attempt to provide some analytical rigor to this essential question, courts have developed a complicated two-prong test: they look to both “inherent distinctiveness” (i.e., linguistic uniqueness) and “acquired distinctiveness” (i.e., whether consumers have come to see the mark as distinctive of source). Inherent distinctiveness for word marks is based on the so-called [Abercrombie spectrum](#) (named after the 1976 2d Cir. case that most famously articulated it), which classifies marks from most to least distinctive as *fanciful* (KODAK cameras), *arbitrary* (APPLE computers), *suggestive* (COPPERTONE suntan lotion), *descriptive* (AMERICAN airlines), or *generic* (“apple” for apples). Marks like AMERICAN can become strong, protectable marks only by developing “acquired distinctiveness”; marks like COPPERTONE and APPLE are presumed to be protectable at birth; and coined marks like KODAK are the strongest of all.

As [Barton Beebe notes in his casebook](#), *Abercrombie*’s “influence on U.S. and even foreign trademark law cannot be overstated.” But *Abercrombie*’s foundation has been slowly crumbling. For example, in a 2009 study, [Thomas Lee and colleagues found](#) that consumers are far more influenced by how and where a mark is placed on a box than by where the mark falls on the *Abercrombie* spectrum. [Rebecca Tushnet has explained](#) that *Abercrombie* “lacks empirical foundation” and is out of step with basic marketing knowledge, such as that an ostensibly fanciful mark like VIAGRA is already imbued with “suggestions of virility, viability, and Niagara Falls (a classic sexual image).” And now, in an impressive trifecta of recent articles, [Jake Linford](#) has further dismantled the key theoretical assumptions underlying the *Abercrombie* classification scheme for word marks.

Linford has tackled *Abercrombie* from all sides: First, in [A Linguistic Justification for ‘Generic’ Trademarks](#), Linford argued that categorically denying protection to “generic” marks ignores processes of language change through which once-generic terms can acquire source significance. He then moved to the middle of the spectrum with [The False Dichotomy Between Suggestive and Descriptive Trademarks](#), which drew on “semantic shift” research to explain that suggestive and descriptive marks are likely to confuse consumers in similar ways. Linford argued that suggestive marks, like descriptive marks, should be protected only upon a showing of acquired distinctiveness rather than receiving automatic protection. Most recently, in [Are Trademarks Ever Fanciful?](#), he attacks the other end of the spectrum, arguing that courts are wrong to assume that made-up words are empty vessels without source significance that should receive automatic, robust protection.

The key to Linford’s argument on fanciful marks is research on “sound symbolism,” or the strong connection between word sound and word meaning. For example, most people think that a table named MAL is larger than one named MIL, and that a product named TAKETE is spikier than one named MALUMA. Want your product to seem small and fast? Choose the vowel /i/ over /u/, voiceless consonants like /t/ over voiced ones like /d/, fricatives like /s/ over vocal stops like /k/. One recent review of this literature concluded that “the sounds of words can convey meaning apart from their actual definitions, and this meaning can systematically bias perceptions and judgments.”

Marketing research has demonstrated that sound symbolism can be used to choose more effective trademarks. Consumers prefer fictitious brand names that match perceived attributes of a product, such as GODAN over GIDAN for a dark beer, NELLAR over NULLAR for a fast Internet service, KUTUM over KITUM for male deodorant, GOMMEL

over GIMMEL for SUVs (but vice versa for convertibles). Marketers use this research when coining fanciful trademarks. By cataloging the sound symbolism literature, Linford makes a strong case that fanciful trademarks are not empty vessels: rather, they “trigger powerful associations in the minds of consumers, which can be used to transmit both source- and product-related information.”

What are the implications of sound symbolism for trademark law? As Linford explains, this research undermines the justifications courts have offered for granting strong protection to fanciful marks, and it can impose unjustified costs on competitors. “Courts often find similarity between a fanciful mark and a competitor’s mark to indicate bad faith adoption by the competitor,” but Linford argues that “sound symbolism provides a reason for the competitor to adopt a mark with some similar characteristics: to communicate product features to consumers.”

At the very least, in light of Linford’s work, courts should discount the use of similar sound symbols by alleged trademark infringers rather than presuming bad faith. Linford also tentatively proposes “[t]wo more radical shifts”: requiring every mark to show acquired distinctiveness in order to receive protection, and holding that some sound symbols are “essentially functional” and thus not protectable. He acknowledges the concern that weaker protection for fanciful marks would lead to more firms choosing descriptive marks, which might ultimately impose even greater costs on competitors, but he argues that “sound symbolism is a phenomenon with real power” such that there may be little competitive difference. And while abandoning *Abercrombie* would be a big change in practice, there are few trademark scholars who strongly defend this doctrine. Rather than advocating artificial linguistic distinctions, scholars have increasingly argued that trademark law should be more attuned to how consumers actually view different types of marks. (An excellent recent example is [Alexandra Roberts’s explanation](#) of why *Abercrombie* does not reflect consumer perceptions of whether hashtags like #IceBucketChallenge are source-indicating trademarks.)

Perhaps a bigger concern with Linford’s sustained attack on *Abercrombie* is that it would increase administrative costs. Under current law, choosing an “inherently distinctive” suggestive, arbitrary, or fanciful mark is a shortcut around the costs of developing evidence of acquired distinctiveness. And the categorical bar on generic marks makes it easy for courts to explain why certain marks are undeserving of protection no matter how much consumers have come to view them as source-indicating. But the lower administrative cost of a bright-line rule over a more flexible standard is of little comfort when the error costs associated with the rule outweigh that administrative cost savings, and Linford has provided numerous reasons to suspect high error costs at each point of the *Abercrombie* spectrum.

Would abandoning *Abercrombie* and just looking for evidence of acquired distinctiveness actually lead to lower error costs? It would at least focus courts on the right question, but trademark cases rarely involve reliable evidence for assessing how consumers actually view a mark. Consumer surveys are expensive and unreliable, so courts often turn to circumstantial evidence such as advertising spending on the asserted mark, but such evidence is only a very weak proxy for how distinctive the mark actually has become to consumers.

What courts really need is a simpler way to tell whether consumers associate a mark with a certain product. In [The Google Shortcut to Trademark Law](#), I argued that one cost-effective way to do this is to look at online search results, which allow us to collapse the two prongs of the distinctiveness test: if a word mark is distinctive (i.e., if consumers tend to primarily associate it with a certain product), then most of the top search results will use that mark to refer to that product. I don’t know whether this test will gain traction, or whether better consumer surveys will be developed, or whether creative scholars (or judges) will come up with an entirely new way to assess distinctiveness. But Linford does a terrific job explaining why it is a mistake to stick with the status quo.

Cite as: Lisa Larrimore Ouellette, *Is it Time to Overrule the Trademark Classification Scheme?*, JOTWELL (May 6, 2016) (reviewing Jake Linford, *Are Trademarks Ever Fanciful?*, 105 *Geo. L.J.* (forthcoming), available at SSRN, <http://ip.jotwell.com/is-it-time-to-overrule-the-trademark-classification-scheme/>).