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IF IT WALKS LIKE A DUCK AND QUACKS LIKE A DUCK, SHOULDN'T IT BE A DUCK?: HOW A "FUNCTIONAL" APPROACH AMELIORATES THE DISCONTINUITY BETWEEN THE "PRIMARY SIGNIFICANCE" TESTS FOR GENERICNESS AND SECONDARY MEANING

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I. INTRODUCTION

"Of each particular thing ask: what is it in itself? What is its nature? What does he do, this man you seek?"

A trademark identifies and distinguishes the goods of one manufacturer from the goods of another and indicates the source of the goods. This is its function—this is what a trademark does. Yet, ever since Judge Friendly first articulated that trademark status could be determined based on a term’s classification into one of four categories along a "spectrum of distinctiveness," courts have struggled to place terms in their appropriate positions along that spectrum. By classifying a term without evaluating what it does, courts have lost sight of the fundamental nature of the trademark.

A generic term cannot function as a trademark because it represents the name, rather than the source, of the goods. Moreover, through a process known as "genericide," a trademark may become a generic term when the public comes to view the trademark not as the source of the goods, but as the goods’ generic name. The courts’ justification for genericide stems from a perceived disadvantage to competitors, who, without the freedom to use the trademark, would be forced to use other, often less efficient, terms to describe their goods.

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2. See Trademark (Lanham) Act of 1946 § 46, 15 U.S.C. § 1127 (2000). The term "trademark" will be used herein to designate both trademarks and service marks. Trademarks identify and distinguish goods; service marks identify and distinguish services. Id.
3. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (defining the categories of distinctiveness); see also infra notes 44–47 and accompanying text.
4. See ANNE GILSON LALONDE ET AL., TRADEMARK PROTECTION AND PRACTICE § 2.02[1] (2006). "A generic name is the name of a particular genus or class of things or a member of such a class. It is denominative in character, is ordinarily a noun, and answers the questions 'What is it?' or 'What do you call it?'" Id. (citation omitted).
5. Id. § 2.02[4] (explaining that genericide is the "deterioration of a trademark into a generic name"); see also J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1 (2006) (stating that rights in a trademark cease and the trademark becomes a "victim of 'genericide'" when the public appropriates the trademark as the name of the product).
6. See infra notes 72–75 and accompanying text.
7. See infra notes 93–96 and accompanying text.
The determination that a term is or has become generic should be based on an analysis of that term's primary significance in the minds of the consuming public. Before addressing a term's primary significance, however, courts and the United States Patent and Trademark Office (PTO) tend to first designate the goods' product category or genus. This designation often leads to the conclusion that the term is generic without considering the primary significance of the term. Once a term has been designated as generic for particular goods, its status as generic is basically fixed, precluding it from ever attaining trademark status for those goods.

The preclusive effect of a term's prior generic designation eclipses any analysis by the courts concerning the term's actual function. Courts disregard evidence that the term is functioning as a trademark, dismissing such evidence as merely demonstrating de facto secondary meaning, which is insufficient for trademark status. The courts' result does not logically follow: If a term functions as a trademark—if it indicates a source and distinguishes goods—it is a trademark, notwithstanding any external label that has been attached to it.

A discontinuity exists between the tests for determining the primary significance of a term when it has been designated as generic versus when it has been designated as merely descriptive. This Article proposes a functional approach that harmonizes this discontinuity. First, in Part II, this Article explores the legal tests used to evaluate whether a term has become generic or whether it has acquired secondary meaning, and provides a background of traditional trademark forms and functions, highlighting the classification structure that segregates terms as "generic" and "merely descriptive" along the distinctiveness spectrum. In Part III, this Article explores two representative cases, the Murphy Door Bed case and the Canfield Diet Chocolate Fudge Soda case. In Part IV, this Article assesses the problems associated with the classification of terms and the primary significance tests evaluated in Part II and demonstrated through the representative cases in Part III. In Part V, this Article proposes a "functional" solution to the discontinuity between those tests. This Article ultimately concludes that if there are no functional reasons to prohibit exclusive rights and the term otherwise functions as a trademark, its designation as merely descriptive or generic becomes irrelevant.

II. UNITED STATES TRADEMARKS—FORM AND FUNCTION

Trademarks, though not specifically authorized by the United States Constitution, have achieved levels of recognition that most patents and copyrights

8. See infra note 108 and accompanying text.
10. See infra Part IV (discussing the problems with the traditional analysis for genericness).
11. See infra notes 188, 210 and accompanying text.
12. See infra notes 226–234 and accompanying text.
13. See infra note 236 and accompanying text.
14. The U.S. Constitution authorizes Congress to regulate patents and copyrights, but it is silent as to trademarks. See U.S. Const. art. I, § 8, cl. 8 ("The Congress shall have Power...[i]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").
(should they be able to do so) could only dream about. Yet trademarks are often viewed as the red-headed stepchildren of intellectual property. Many intellectual property scholars question the inclusion of trademarks within any category of property, intellectual or tangible. Business owners, however, tend to view trademarks as valuable corporate assets. Accordingly, business owners spend huge sums developing, disseminating, and protecting their trademarks. A trademark can be "lost"—no longer afforded protection under any regime—when consumers use the trademark indiscriminately to designate the type of goods rather than the source of the goods. While the loss of any trademark is likely to injure a company, the loss of a market-saturating, highly successful trademark is likely to devastate it.

The Lanham Act assists trademark owners in protecting their trademark rights by providing federal protection for both registered and unregistered trademarks. The intent of the Lanham Act is to protect both the public and the trademark owner. The Lanham Act makes actionable the deceptive and misleading use of marks in commerce.


17. See Ralph H. Folsom & Larry L. Tepley, Trademarked Generic Words, 89 YALE L.J. 1323, 1354 (1980) ("From an economic standpoint, any analysis that turns on the concept of 'property rights' has no place in the law of trademarked generic words.").


19. For a fascinating glimpse into the process of corporate branding, with case studies of the "BlackBerry," "Porsche Cayenne," and "Viagra" trademarks, among others, see ALEX FRANKEL, WORDCRAFT: THE ART OF TURNING LITTLE WORDS INTO BIG BUSINESS (2004).

20. See MCCARTHY, supra note 5, § 12:1; see also Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95 (2d Cir. 1989).


23. The Lanham Act provides:
   The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

commerce (which protects the public), \(^{24}\) protects persons engaged in commerce against some types of unfair competition (which protects trademark owners and the public alike), \(^{25}\) and seeks "to prevent fraud and deception in...commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks" (which protects both trademark owners and the public). \(^{26}\) The legislative history behind the Lanham Act supports this dual intent:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner. \(^{27}\)

Notwithstanding the express intent of the Lanham Act, jurists and scholars differ in their opinions about the justifications for protecting trademarks. \(^{28}\) For example, some justify trademark protection on the basis that strong trademark regimes increase economic efficiency. \(^{29}\) Others focus on the advantages that trademarks impart to the consumer, such as decreasing consumer search costs and consumer confusion. \(^{30}\) Still others justify trademark protection based on the property rights of the trademark owner, even to the detriment of competitors. \(^{31}\) Ultimately, however,
all of the justifications are subordinate to the primary purpose of the trademark itself: to distinguish and identify goods and indicate the source of the goods. Only a properly functioning trademark will increase economic efficiency, decrease consumer search costs, avoid consumer confusion, and provide a valuable property interest to the trademark holder.

A trademark, by definition, must be able to indicate the source of the goods. The trademark, however, need not indicate the source explicitly or exclusively. When the product is unique, trademarks may indicate simultaneously a product and a source. The underlying premise is that “the public may understand that all goods with a certain term originate from the same producer and at the same time understand the term to indicate particular product characteristics (or a combination of characteristics) that distinguish the product from others” based on the manufacturer’s unique marketing and promotion of its product. As long as a word distinguishes and identifies goods and indicates the goods’ source, even if that source is unknown, virtually any word, symbol, color, sound, or scent can because to do otherwise would deprive the owner of “the fruits of his efforts”.

33. Cf. Dinwoodie, supra note 30, at 629-30 (describing the purposes of trademark law).
34. The Lanham Act provides: “The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof...used by a person...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Lanham Act § 45, 15 U.S.C. § 1127.
35. A.J. Canfield Co. v. Honickman, 808 F.2d 291, 300 (3d Cir. 1986) (“A term may function as an indicator of source and therefore as a valid trademark, even though consumers may not know the name of the manufacturer or producer of the product.”).

In some cases a trademark may specifically identify the manufacturer of the goods or services, thus enabling consumers to base their purchasing decisions on the reputation of the business identified by the mark. Even when the trademark does not identify a particular business entity known to consumers, it can nevertheless indicate that the product emanates from the same source as other goods or services that bear the mark. The trademark thus informs consumers that the product shares a common even if anonymous source with other goods with which they may be familiar.

36. A.J. Canfield, 808 F.2d at 300. Trademarks of this kind are said to serve a “dual function—that of identifying a product while at the same time indicating its source.” Id. (citing S. REP. No. 98-627, at 5 (1984), as reprinted in 1984 U.S.C.C.A.N. 5718, 5722). Examples of trademarks as product and source that come to mind include those associated with the wide variety of candy bars (“Snickers,” “Kit-Kat,” “Almond Joy”), each trademark representing both a unique product and the source of the product.

37. Id. (citation omitted).
38. For the word “Vanessa” for “valves for industrial purposes,” see U.S. Trademark No. 1,527,795 (registered Mar. 7, 1989).
39. For the symbol “:-)” for “clothing, namely, men’s, women’s and children’s shirts, t-shirts, pants, shorts, jackets, sweaters, sweatpants, sweatshirts, caps and other headwear, sleepwear, ties, underwear,” see U.S. Trademark No. 3,068,503 (registered Mar. 14, 2006).
40. For the color “pink” for “[a]ir infiltration and moisture barrier for use in building construction, sold in rolls” (Owens-Corning’s pink fiberglass insulation), see U.S. Trademark No. 2,349,499 (registered May 16, 2000).
41. For the sound of “a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C, the ‘G’ being the one just below middle C, the ‘E’ the one just above middle C, and the ‘C’ being middle C” for “broadcasting of television programs” (NBC’s three-note chime), see U.S. Trademark No. 916,522 (registered July 13, 1971).
42. For the scent of “bubble gum” for “oil-based metal cutting fluid and oil based metal removal fluid for
function as a trademark. The more distinctive the trademark, the more effective it will be in identifying and distinguishing goods and indicating the source of the goods. The concept of distinctiveness has been articulated in the form of a spectrum that ranges from the most distinctive trademarks to terms that are so categorically descriptive that they cannot, through any amount of use, identify and distinguish goods or indicate the goods' source. Along the spectrum, terms that are suggestive, arbitrary, or fanciful are "inherently distinctive" and are automatically entitled to protection as trademarks. Terms that are "merely descriptive" are not inherently distinctive but are entitled to trademark protection upon a showing of acquired distinctiveness or "secondary meaning." Generic terms are never entitled to trademark protection.

The following subsections explore the legal and definitional boundaries between merely descriptive and generic terms.

A. Merely Descriptive Terms

A term is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product in a way that does not require any imagination. Such a term merely describes features or characteristics of the goods.
but does not function to identify and distinguish them from the goods of another manufacturer or to indicate their source and, thus, is not eligible for protection as a trademark. If a merely descriptive term acquires "secondary meaning," however, the term can be protected as a trademark. A merely descriptive term acquires secondary meaning when the term’s primary significance to the relevant public is to identify a product’s source rather than the product itself. When a merely descriptive term acquires secondary meaning it functions as a trademark. The term is "by definition no longer merely descriptive."

Secondary meaning is a question of fact. Evidence that may assist the finder of fact in determining whether a term has acquired secondary meaning includes the length and manner of use of the term, the extent and manner of advertising, and whether actual purchasers associate the term with the producer. As such, testimony from individual consumers, surveys, and proof of actual consumer confusion are probative. Actual confusion is particularly relevant—if the asserted trademark is not distinctive, then "use by another will not result in confusion."

B. Generic Terms

A generic term designates a class, or "genus," of goods. Generic terms, in contrast to fanciful, arbitrary, suggestive, or merely descriptive terms, can never function as trademarks. The definition of a trademark precludes a generic term to reach a conclusion as to the nature of goods [and a] term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods" (quoting Stix Prods., Inc. v. United Merchs. & Mfrs., Inc., 295 F. Supp. 79, 488 (S.D.N.Y. 1968)); see also Yellow Cab Co. of Sacramento v. Yellow Cab Co. of Elk Grove, Inc., 419 F.3d 925, 927 (9th Cir. 2005).

49. See Lanham Act § 2(f), 15 U.S.C. § 1052(f) (allowing registration when a mark "has become distinctive of the applicant’s goods in commerce.").

50. See Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (stating that a term has acquired secondary meaning when "the primary significance of the term in the minds of the consuming public is not the product but the producer"); see also Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 766 n.4 (1992) ("Secondary meaning is used generally to indicate that a mark or dress 'has come through use to be uniquely associated with a specific source.'" (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tentative Draft No. 2, 1990))); A.J. Canfield, 808 F.2d at 300 (explaining that a term has secondary meaning and functions as a trademark when the primary significance of the term is to identify a product that emanates from a particular source, known or unknown, because the term provides "assurance to the public 'that the product is of uniform quality and performance'" (quoting S. REP. No. 98-627, at 5 (1984), as reprinted in 1984 U.S.C.C.A.N. 5718, 5722)).

51. Secondary meaning has been viewed as a "synonym" for trademark status. See Marc C. Levy, From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine, 95 TRADEMARK REP. 1197, 1202 (2005).

52. Carter, supra note 18, at 772 (emphasis added) (explaining that the consumer is better off when the reduction in consumer search costs is greater than the increased costs to competitors who must use other terms to identify their goods).
from functioning as a trademark because a generic term does not serve to identify and distinguish the goods of one manufacturer from those of another, nor does it indicate the source of the goods. Rather, a generic term serves to name the goods themselves.59 According to the Restatement (Third) of Unfair Competition:

A designation that is understood by prospective purchasers to denominate the general category, type, or class of the goods, services, or business with which it is used is a generic designation. A user cannot acquire rights in a generic designation as a trademark, trade name, collective mark, or certification mark.60

Thus, one cannot appropriate for use as a trademark a truly generic term from the public domain, otherwise known as the “linguistic commons.”61 Such appropriation would harm competitors and consumers alike.62

The recognition of trademark rights in generic designations could significantly impede competition in the market for the goods or services denominated by the generic term. Competitors denied access to a term that denominates the goods or services to prospective purchasers would be at a distinct disadvantage in communicating information regarding the nature or characteristics of their product. Consumers would be forced either to expend additional time and money investigating the characteristics of competing goods or to pay a premium price to the seller with trademark rights in the accepted generic term.63

The difference between merely descriptive terms and generic terms is subtle but critical. To be sure, the placement of a term into one category over another has serious implications for the protectability of the term as a trademark.64 A term that

59. See GILSON LALONDE ET AL., supra note 4, § 2.02[1]. A term that does not serve to name the goods themselves but that indicates “some distinctive characteristic” of the goods can also be generic. See generally McCARTHY, supra note 5, § 12:10 (citing A.J. Canfield Co. v. Honickman, 808 F.2d 291, 298 (3d Cir. 1986) (determining that chocolate fudge for a diet chocolate soda was “so commonly descriptive of the name of the product” as to be considered generic); Mil-Mar Shoe Co. v. Sonac Corp., 75 F.3d 1153, 1157 (7th Cir. 1996) (rejecting the argument that a generic term cannot contain any “element of description”)). See also Miller Brewing Co. v. G. Heileman Brewing Co., 561 F.2d 75, 79 (7th Cir. 1977) (“A generic or common descriptive term is one which is commonly used as the name or description of a kind of goods. It cannot become a trademark under any circumstances.”). As discussed in more detail in Part IV infra, these cases illustrate how a court’s determination regarding the distinctiveness of the alleged trademark depends upon a court’s prior designation of the genus at issue.

60. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15(1).

61. Am. Online, Inc. v. AT&T Corp. 243 F.3d 812, 821 (4th Cir. 2001).

62. See GILSON LALONDE ET AL., supra note 4, § 2.02[2] (“Allowing protection for generic names would permit a monopoly on the name, undesirable because a competitor could not describe its goods or services as what they are.”); Carter, supra note 18, at 773 (explaining that the available market language would be “impoverished” if a firm were permitted to adopt a generic word as its trademark); see also In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1344 (Fed. Cir. 2001) (noting that allowing registration of a generic term “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are”); Merrill Lynch, Pierce, Fenner & Smith, Inc., 561 F.2d at 1567, 1569 (Fed. Cir. 1977) (“A generic or common descriptive term is one which is commonly used as the name or description of a kind of goods. It cannot become a trademark under any circumstances.”). As discussed in more detail in Part IV infra, these cases illustrate how a court’s determination regarding the distinctiveness of the alleged trademark depends upon a court’s prior designation of the genus at issue.

63. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. a.

64. See A.J. Canfield, 808 F.2d at 308 (determining that the genus in question for the asserted trademark “Diet Chocolate Fudge Soda” was diet sodas that taste like chocolate fudge soda). If the court had determined that the genus in question was soda, or even diet soda, it follows that the court would have found “diet chocolate fudge soda” to be merely descriptive of the genus. See infra notes 192–195 and accompanying text (discussing A.J. Canfield).
is descriptive may acquire trademark rights via secondary meaning,\textsuperscript{65} while a term that is generic may not.\textsuperscript{66} Yet, terms cannot always be classified into neat, well-defined categories.\textsuperscript{67} Neither the courts nor the PTO has provided any clear demarcation between a generic term and a descriptive term.\textsuperscript{68} Once a term is classified, however, a court may only alter that categorization upon a showing of clear error.\textsuperscript{69}

The classification is even more troublesome considering that not all generic terms start out as generic terms. Some generic terms actually originate as highly distinctive trademarks that would have enjoyed long life spans and protection from infringers.\textsuperscript{70} Instead, such trademarks become the generic terms for the goods at issue. Thus, a term can be designated as generic in one of two ways: a term may be generic from the start or may become generic over time.\textsuperscript{71}

\textsuperscript{65} See Lanham Act § 2(f), 15 U.S.C. § 1052(f) (2000); see also Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 766 n.4 (1992) (“Secondary meaning is used generally to indicate that a mark or dress ‘has come through use to be uniquely associated with a specific source.’” (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tentative Draft No. 2, 1990))).

\textsuperscript{66} See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. b.

\textsuperscript{67} Success in achieving an association between a generic term and a particular user will not overcome the prohibition against the recognition of trademark rights. In some instances, for example, the public may come to associate a particular product, and hence the name of that product, with its sole or principal producer. Evidence of such an association does not establish source significance for the term itself and will not support an assertion of trademark rights. In other instances, extensive promotion and commercial success may result in the creation of secondary meaning for a term that formerly had only generic significance. Prospective purchasers may come to understand the term, at least in some contexts, as an indication of source, and for some consumers its generic significance may become subordinate. The existence of such de facto secondary meaning, however, does not result in the acquisition of trademark rights. Although the beneficiary of such secondary meaning may be entitled to relief against misrepresentations of source..., the public interest in maintaining access to generic terms precludes the recognition of trademark rights.

\textsuperscript{68} See supra Part IV.B.1 (discussing "recapture").

\textsuperscript{69} But see infra notes 75–76 (aspirin and thermos), 100 (thermos and cellophane) and accompanying text.

\textsuperscript{70} Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4,9 (2d Cir. 1976) (explaining that "the lines of demarcation" between generic, descriptive, suggestive, and arbitrary or fanciful terms "are not always bright").

\textsuperscript{71} See Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 144 (2d Cir. 1997) (finding that the district court used the correct legal standard in determining that "Honey Brown" was generic).
There is a vast difference between the fundamental concept that a generic term is not properly registerable as a trademark, and the concept that a valid trademark, once properly registered, is subject to cancellation if it becomes the generic term for the goods that it represents.\textsuperscript{72} A trademark becomes the generic term for the goods when the public appropriates the trademark to designate a particular type of goods rather than the source of the goods.\textsuperscript{73} This process is known as trademark genericide.\textsuperscript{74}

C. Genericide: The Death of (an Otherwise Distinctive) Trademark

Trademark owners lose valuable rights when consumers adopt trademarks as the generic terms for goods (such as “aspirin” for acetyl salicylic acid\textsuperscript{75} and “thermos” for vacuum containers\textsuperscript{76}). As a result, the owners of popular trademarks like Xerox, Mace, and Day-Glo may spend millions of dollars in advertising and educational efforts in an attempt to prevent their trademarks from becoming generic.\textsuperscript{77}

Conventional wisdom dictates that a trademark becomes generic when the public employs the trademark as a noun,\textsuperscript{78} or even as a verb,\textsuperscript{79} when referring to the goods themselves, instead of as a proper adjective describing the goods.\textsuperscript{80} Some trademark

\textsuperscript{72} See Lanham Act § 14, 15 U.S.C. § 1064 (2000); see also Folsom & Teply, supra note 17, at 1327 (“[T]he federal registration of a word is subject to cancellation if at any time it "becomes the common descriptive name of an article or substance."”) (quoting Lanham Act § 14(c), 15 U.S.C. § 1064(c) (1976)).

\textsuperscript{73} See McCarthy, supra note 5, § 12:1; see also Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95, 97 (2d Cir. 1989) (holding that “‘Murphy bed’ is a generic term, having been appropriated by the public to designate a type of bed”).

\textsuperscript{74} See GILSON LALONDE ET AL., supra note 4, § 2.02[4]. “Genericide” is thought to have been first cited in the article written by Saul Lefkowitz and Barry W. Graham, Court Rules that “Monopoly” Has Suffered Genericide, LEGAL TIMES, Mar. 7, 1983. See Word Spy, Genericide, http://www.wordspy.com/words/genericide.asp (last visited Jan. 13, 2007).

\textsuperscript{75} See Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

\textsuperscript{76} See King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 581 (2d Cir. 1963).

\textsuperscript{77} See Shawn M. Clankie, Brand Name Use in Creative Writing: Genericide or Language Right?, in PERSPECTIVES ON PLAGIARISM AND INTELLECTUAL PROPERTY IN A POSTMODERN WORLD 253, 255-57 (Lisa Buranen & Alice M. Roy eds., 1999). As noted infra in this section, while these efforts can help educate the public, they in no way immunize the trademark holder from loss. The public decides, and its decision is final. Except, of course, for the rare cases of recapture. See infra Part IV.B.1.

\textsuperscript{78} It is not uncommon to hear people talking about their “Palm” or their “RollerBlades” when they really mean their “Palm” brand personal digital assistant or their “RollerBlade” brand in-line skates. See Folsom & Teply, supra note 17, at 1325 n.21 (referring to such use as “elliptical” use—omitting the generic term when it is understood). Note that Professor McCarthy explains that such use actually demonstrates the strength of the trademark in that it needs no generic name to convey its message. McCarthy, supra note 5, § 12:8.

\textsuperscript{79} People do not just search the Internet, they “Google” it. As such, the term “Google” was recently included as a transitive verb meaning “to search” in the Oxford English Dictionary. See The Top 100 Brands 2006, supra note 15. But see Merriam-Webster Online, Google, http://www.merriam-webster.com/dictionary/google (last visited Dec. 25, 2006) (limiting the scope of the verb “google” by defining it as “to use the Google search engine to obtain information about (as a person) on the World Wide Web”). The company was displeased when the Washington Post characterized the inclusion of the trademark in the dictionary as evidence that the word “Google” “now takes its place alongside the handful of proper nouns that have moved beyond a particular product to become descriptors of an entire sector—generic trademarks.” Frank Ahrens, So Google Is No Brand X, but What Is ‘Genericide’?, WASH. POST, Aug. 5, 2006, at D1 (quoting letter from Google lawyer).

\textsuperscript{80} But see Rose A. Hagan, The Myths of Genericide, 22 INTELL. PROP. NEWSL., Winter 2004, at 13 (discussing conventional wisdom but noting that the statutory definition only requires that the mark serve its source-identifying function, not that it be a particular part of speech). In fact, the PTO has registered a number of
owners use their own trademarks in this manner and even encourage such use in an attempt to transform their marks into household words.\textsuperscript{81} These trademark owners are seemingly oblivious to the fact that this may be a significant factor contributing to the genericide of their trademarks.\textsuperscript{82} Trademarks that attain prominence as household words walk a fine line between market dominance and generic status.\textsuperscript{83}

A trademark owner may further contribute to the genericide of a trademark by misusing it in advertising and labeling;\textsuperscript{84} failing to police trademark infringement and improper use;\textsuperscript{85} neglecting to provide a simple, generic name for the product that the trademark represents;\textsuperscript{86} and failing to educate the public concerning the product’s proper generic name.\textsuperscript{87} There may be little that a trademark holder can do, however, to prevent appropriation of her trademark.\textsuperscript{88} Members of the public may simply adopt the trademark because it is the “shortest and simplest word which will adequately communicate the idea or call to mind the object or product that they want to tell about.”\textsuperscript{89}

The potential loss of distinctiveness from the public’s indiscriminate use and the trademark owner’s misuse of a trademark effectively destroy all intellectual property rights the trademark owner has in that trademark for the goods at issue,\textsuperscript{90} thereby

\textsuperscript{81} For example, Research in Motion—the company that makes BlackBerry devices—asks on its Website “Which BlackBerry is right for you?” Research in Motion Ltd., BlackBerry, http://www.discoverblackberry.com (last visited Dec. 25, 2006). See also FRANKEL, supra note 19, at 67.

\textsuperscript{82} See Folsom & Teply, supra note 17, at 1324–25.

\textsuperscript{83} See FRANKEL, supra note 19, at 67 (discussing the dominance of household words like “Popsicle” and “Dumpster” and questioning their long term ability to remain trademarks).

\textsuperscript{84} See Folsom & Teply, supra note 17, at 1330 n.42 (remarking that case law “suggests that every instance of trademark degeneration is traceable to acts of omission or commission on the part of the trademark holder” (quoting Hearings on H.R. 3685 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the H. Comm. on the Judiciary, 96th Cong. 10 (1979))).

\textsuperscript{85} McCARTHY, supra note 5, § 12:1.

\textsuperscript{86} Professor McCarthy suggested that medical doctors could be trained to deal with “tongue-twisting generic terms” for drugs like dextroamphetamine sulfate or Oxytetracycline, “[b]ut the consumer may reject such terms and seize upon what the seller considers a trademark—such as DEXEDRINE or TERRAMYCIN.” Id. § 12:5.

\textsuperscript{87} Thus, the U.S. consumer who could not be trained to deal with “acetyl salicylic acid” had to seize upon the “aspirin” trademark to identify the goods. Id. § 12:9 (discussing Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921)).

\textsuperscript{88} One might find it remarkable how English speaking Canadians have had no trouble differentiating between “Aspirin” brand and generic versions of acetyl salicylic acid. (During a trip to Vancouver in June 2006, the author confirmed that the “Aspirin” brand of acetyl salicylic acid is alive and well in Canada.) Even Americans are able, somehow, to differentiate between generic designations for other common pain-relief medications such as acetaminophen and ibuprofen, and the enduring trademarks like “Tylenol” and “Advil” under which those medications are sold. Cf. Stuart Elliott, Networks Put Cap on Advil-Tylenol War, N.Y. TIMES, Mar. 9, 1996, § 1, at 48 (referring to both generic and brand-name pain relievers).

\textsuperscript{89} See Folsom & Teply, supra note 17, at 1327 (explaining that “[a] trademark holder has both the ability and responsibility to shape the public’s use and understanding of its trademark” (citing Hearings on H.R. 3685 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the H. Comm. on the Judiciary, 96th Cong. 10 (1979))).

\textsuperscript{90} See Restatement (Third) of Unfair Competition § 15(2) (1995).

If prospective purchasers have come to perceive a trademark, trade name, collective mark, or certification mark primarily as a generic designation for the category, type, or class of the goods,
devastating the trademark holder's investment in the trademark. Often the trademark holder spends a small fortune developing the trademark and its associated goodwill. When the public appropriates the trademark for use as a generic term, the trademark holder loses that investment. Thus, the public's appropriation is often the downside of a successful, market-saturating product that is first on the scene. As the United States Court of Appeals for the Second Circuit noted, genericide is "a harsh [doctrine] for it places a penalty on the manufacturer who has made skillful use of advertising and has popularized his product." 

Though devastating for the trademark holder, genericide is considered to be beneficial to competitors and the public domain. When the public appropriates a trademark to identify a class of goods and not the source of the goods, it is widely maintained that competitors would be at a disadvantage if they could not use the trademark to describe their own goods. In the case involving a dispute over the "Thermos" trademark, for example, the district court described the competitive disadvantage:

Because of the widespread generic use of the word "thermos", potential purchasers of vacuum-insulated bottles more often ask for a "thermos" than for a "vacuum bottle". Most of such requests are treated by the retail trade as orders for vacuum-insulated bottles manufactured by the plaintiff[,] because the trade uses "Thermos" solely as a trade-mark.

Thus, the trademark holder benefits by making sales to the consumer seeking a "Thermos" brand vacuum bottle, as well as the consumer simply seeking any brand of "thermos." In such a situation, prohibiting competitors' use of the trademark would be unfair.

Courts consistently allocate the burden associated with the loss of the trademark to the trademark holder and bestow the benefit to the trademark holder's competitors.
Once genericide occurs and the former trademark has become a generic term, anyone can use the generic term to describe her goods, and the trademark holder must “scramble” to find a new way to distinguish her goods from those of her competitors. Trademark lore is replete with examples:

Words such as “thermos,” “yo-yo,” “escalator,” “cellophane,” and “brassiere” started life as trademarks, but eventually lost their significance as source identifiers and became the popular names of the product rather than the name of the trademark owner’s brand, and when that happened continued enforcement of the trademark would simply have undermined competition with the brand by making it difficult for competitors to indicate that they were selling the same product—by rendering them in effect speechless.

A trademark that succumbs to genericide “reduces the costs of communication by making it cheaper for competitors to inform consumers that they are selling the same kind of product.” The public domain benefits by the addition to the English language of new, often more concise, terms for the goods at issue. Notwithstanding the potential benefits to competitors and the public, however, genericide does not occur lightly:

To determine that a trademark is generic and thus pitch it into the public domain is a fateful step... The fateful step ordinarily is not taken until the trademark has gone so far toward becoming the exclusive descriptor of the product that sellers

and a trademark for the article. Xerox is a mark for a kind of plain paper copier; Sanka is a mark for a kind of decaffeinated coffee; Vaseline is a mark for a kind of petroleum jelly. If a manufacturer fails to take such precaution and his mark becomes the common descriptive word for the article he sells, he loses the mark.

Such precautions, however, do not immunize a trademark from generic usage by the public. “Cotton swab” is the common descriptive name for the “Q-Tip” brand, but the availability of the common descriptive name has not prevented widespread generic use of the trademark. In the movie Prime, for example, an entire thread of a story-line revolves around a mother’s failure to provide her children with “Q-Tips” and the discovery of these amazing devices by her twenty-three-year-old son, who then stocks his bathroom with boxes of them, only to be mocked behind his back by his date. PRIME (Universal Studios 2005).

98. See Restatement (Third) of Unfair Competition § 15 cmt. c (1995) (explaining that “use of a generic term will not subject a subsequent user to liability for trademark infringement”).

99. Ty Inc. v. Softbelly’s, Inc., 353 F.3d 528, 531 (7th Cir. 2003).

100. Ty Inc. v. Perryman, 306 F.3d 509, 513 (7th Cir. 2002). Folsom and Teply maintain that the “public has an inherent ‘right’ to call a product by its name.” Folsom & Teply, supra note 17, at 1333. One wonders whether the public has a concomitant duty associated with that right not to call a product by its trademark.


102. See Ty Inc. v. Perryman, 306 F.3d at 514. The court explained that, although there is a social cost to the trademark holder in that she has to find a new trademark to identify her goods, there is a social benefit that derives from genericide, “namely an addition to ordinary language.” Id. This assumes, of course, that increasing the number of words in a language offers a social benefit. One could take the opposite position that what is actually occurring is a decrease in the depth of the language as people discard generic terms in favor of using the trademarks as shorthand referents for the goods at issue. If increasing the number of words in a language is a social benefit that outweighs the cost to the trademark holder of the loss of the trademark, it would be even more beneficial to force competitors to create new words to designate their goods rather than to permit them to use the trademark of another to do so. But see Rochelle Cooper Dreyfuss, Expressive Genericity: Trademarks as Language in the Pepsi Generation, 65 Notre Dame L. Rev. 397, 416–17 (1990) (advocating that the trademark owner should bear the burden of introducing alternative words into the public lexicon).
of competing brands cannot compete effectively without using the name to designate the product they are selling.\textsuperscript{103}

But how does one determine when a trademark has gone so far toward becoming the exclusive descriptor of the product? It is consumer perception that dictates whether a term has become generic.\textsuperscript{104} For example, in a case involving a dispute over the use of the term “aspirin,” Judge Hand indicated that the only question to consider is “[w]hat do the buyers understand by the word for whose use the parties are contending?”\textsuperscript{105} Similarly, in a case involving a dispute over the use of the term “cellophane,”\textsuperscript{106} the Second Circuit Court of Appeals explained, “In our opinion this case does not properly turn on...whether the word cellophane was at one time more than a descriptive term. The real problem is what it meant to the buying public during the period covered by the present suit.”\textsuperscript{107}

The principal legal test that has evolved is whether the primary significance of the trademark to the relevant public is the name of a brand or the name of the goods.\textsuperscript{108} If the relevant public\textsuperscript{109} no longer associates the trademark with the source of the goods, but rather associates it with the name of the goods themselves, then the primary significance of the trademark has become the generic term for the goods. The legal effect of genericide is that the trademark registration, if any, can be cancelled.\textsuperscript{110} The practical effect of such a shift in consumer perception is that competitors are able to use the trademark to describe their goods without reprisal from the trademark owner.\textsuperscript{111}

To ascertain whether a trademark has become generic, the PTO and the courts must determine what the public thinks—a difficult task by any measure. Dictionaries, publications, and consumer surveys are three of the most valuable resources for assisting the PTO and the courts with this task. Dictionaries “are influential because they reflect the general public’s perception of a mark’s meaning...”\textsuperscript{103}

\begin{thebibliography}{10}
\bibitem{103} Ty Inc. v. Softbelly’s, Inc., 353 F.3d at 531 (emphasis added).
\bibitem{104} Id. at 534 (explaining that “whether a term is generic depends on what consumers think.”).
\bibitem{105} Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).
\bibitem{106} DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 76 (2d Cir. 1936).
\bibitem{107} Id. at 77 (emphasis added).
\bibitem{108} Folsom & Teply, supra note 17, at 1327. See also Ty Inc. v. Softbelly’s Inc., 353 F.3d at 530–32; In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) 1030, 1033 (T.T.A.B. 1984) (noting that “the test of whether or not a word has a generic connotation is the primary significance that term has to the purchasing public”), rev’d, Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 687 F. Supp. 754 (E.D.N.Y. 1988), and aff’d in part, rev’d in part, 874 F.2d 95 (2d Cir. 1989). The “primary significance” of a term to the relevant public is also the test for determining whether a descriptive term has become protectable via acquired distinctiveness, or “secondary meaning.” See infra note 224 and accompanying text.
\bibitem{109} The relevant consumers, not professionals in the trade or the public in general, determine the status of the mark. See McCarthy, supra note 5, § 12-4.
\bibitem{111} This applies only to the extent that the competitors are not using the term in a way to imply false designation of origin. In Murphy Door Bed Co. v. Interior Sleep Systems, Inc., for example, the defendant was enjoined from using “Murphy bed” to identify its goods, even though the court determined that the trademark was generic, because the defendant had falsely implied that its goods were those of the plaintiff. 874 F.2d 95 (2d Cir. 1989).
\end{thebibliography}
and implication" and "its contemporary usage." Dictionaries demonstrate that a term has become a generic designation when the term is defined without reference to the term's identity as a trademark. Mere presence of a term in a dictionary, however, does not alone establish that the trademark has become generic, especially when the definition includes a reference to the trademark. Similarly, publications demonstrate the public's perception of a term. For example, in a dispute over the trademark status of "Murphy bed," the defendant introduced evidence of the use of "Murphy bed" in newspapers and magazines to describe a type of bed, generally, and not the plaintiff's bed in particular. The court explained that this evidence was "a strong indication of the general public's perception that Murphy bed connotes something other than a bed manufactured by the Murphy Co."

While no evidence is dispositive, consumer surveys offer the most specific, empirical evidence of what the public thinks. Survey results in which a majority of the relevant public considers the primary significance of the term to represent either the product or the producer are believed to be highly persuasive on the issue. For example, in a case concerning a dispute over the "Beanies" trademark for plush, bean-filled toys, the plaintiff provided survey evidence that at least sixty percent of the relevant public understood "Beanies" to be a brand name. These results indicate that although thirty-six percent of the relevant public believed that the term was generic, the primary significance of "Beanies" to the relevant public was as a brand name.

In the "Thermos" case, on the other hand, survey results indicated that about seventy-five percent of adults "who were familiar with containers that keep the contents hot or cold" considered such a container to be a "thermos," while only

112. See id. at 101 (citing Gimix v. JS & A Group, Inc., 699 F.2d 901, 905 (7th Cir. 1983)); see also In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) at 1031 (citing three different dictionaries, not one of which even suggested that the term "Murphy bed" was or had been a trademark).

113. See Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 810 (2d Cir. 1999).

114. See In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) at 1031–32 (explaining that dictionaries "are credible evidence going to the perception of the term by the public"). But see Folsom & Teply, supra note 17, at 1346–47 n.110 (noting that dictionaries are unreliable because their publishers are pressured to avoid including generic definitions for trademarks).

115. See GILSON LALONDE ET AL., supra note 4, § 2.02[8](c).

116. See Harley-Davidson, 164 F.3d at 811 (observing that "newspaper and magazine use of a word in a generic sense is 'a strong indication of the general public's perception' that the word is generic" (quoting Murphy Door Bed, 874 F.2d at 101)).

117. Murphy Door Bed, 874 F.2d at 101.

118. Id.

119. For a comprehensive coverage of consumer surveys, see Susan Sangillo Bellifemine, Primary Significance: Proving the Consumer's Perception, 14 SETON HALL L. REV. 315, 346 (1984). Consider the Teflon case, wherein the court found that "Teflon" was a valid trademark based on the fact that sixty-eight percent of the consumers surveyed recognized it as such, while only thirty-one percent thought it was a common name. E.I. DuPont de Nemours & Co. v. Yoshida Int'l, 393 F. Supp. 502, 519–20 (E.D.N.Y. 1975); MCCARTHY, supra note 5, §§ 12:6, 12:14.

120. See Ty Inc. v. Sofbelly's, Inc., 353 F.3d 528, 530 (7th Cir. 2003). The survey results also indicated that thirty-six percent of the relevant public believed the term to be generic. Id. See generally Bellifemine, supra note 119 (discussing the use of consumer survey evidence in several trademark cases).

121. Unfortunately for the trademark holder, the court notes that while it may have prevailed in this dispute, it "may be fighting a losing war to keep its 'Beanies' trademark from becoming 'beans' a generic term." Ty Inc. v. Sofbelly's, Inc., 353 F.3d at 532.
about twelve percent of adults knew that “thermos” had any trademark significance.\textsuperscript{123} The Second Circuit Court of Appeals found this evidence highly persuasive of the fact that the primary significance of “thermos” to the relevant public was as “its indication of the nature and class of an article rather than as an indication of its source.”\textsuperscript{124}

The next section highlights, via representative cases, the evidentiary analyses the PTO, the Trademark Trial and Appeal Board (TTAB), and courts must undertake to determine what the public thinks about a term. In particular, these representative cases illustrate how courts have dealt with trademarks that competitors have asserted lack trademark significance—based either on the asserted trademarks being generic from inception, or on the trademarks having become generic through the process of genericide.

III. DETERMINATION OF TRADEMARK STATUS—ILLUSTRATIVE CASES

A. A Case of Genericide—The Murphy Door Bed Case\textsuperscript{125}

At the beginning of the twentieth century, William Lawrence Murphy invented a type of bed that could be attached to a closet wall by way of a hinge mechanism.\textsuperscript{126} This arrangement permitted the bed, when not in use, to be concealed in the closet and then easily lowered from the closet wall as needed.\textsuperscript{127} In his patent application, Mr. Murphy used the term “pivot bed” to describe the invention.\textsuperscript{128} Mr. Murphy’s competitors used terms like “wall beds,” “concealed beds,” “disappearing beds,” and even “authentic adjustable hydraulic beds” to describe their competing wall-mounted, concealed beds.\textsuperscript{129} Thus, a number of alternative terms described the type of bed that Mr. Murphy chose to manufacture and sell under the trademark “Murphy bed.”\textsuperscript{130} Yet, by the time the Murphy Door Bed Company (Murphy) sought formal federal registration for its trademark—more than half a century after first selling the “Murphy bed” brand pivot bed—both the examining attorney and the TTAB determined that the trademark had become a generic term for the pivot bed.\textsuperscript{131}

\textsuperscript{123} King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579–80 (2d Cir. 1963).
\textsuperscript{124} Id. at 580–81.
\textsuperscript{125} Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95 (2d Cir. 1989).
\textsuperscript{126} Id. at 98.
\textsuperscript{127} Id.
\textsuperscript{128} Id.
\textsuperscript{129} Id.
\textsuperscript{130} Id. At least two competitors stopped using the description “Murphy beds” after Mr. Murphy complained to them. Id.
\textsuperscript{131} Id. Mr. Murphy originally sought trademark registration for the entire phrase “Murphy Bed.” See In re Murphy Door Bed Co., 223 U.S.P.Q (BNA) 1030 (T.T.A.B. 1984). During prosecution of the application with the PTO, Mr. Murphy deleted “Bed” from the drawing of the trademark that he submitted, leaving only “Murphy” as the asserted trademark for which he was seeking registration. The TTAB concluded that this was a distinction without a difference. “The point is that if it is determined that there is a type of bed known as a MURPHY BED or a MURPHY bed, it is irrelevant whether applicant seeks to register MURPHY BED or MURPHY. The meaning would be the same.” Id.
The examining attorney, relying on dictionary definitions and results from a "Nexis computer search," insisted that "Murphy bed" had come to mean a particular type of bed and was "embedded in the minds of the public" as such. On appeal, the applicant's arguments and evidence to the contrary failed to persuade the TTAB. In particular, the applicant argued that the omission of the term from other dictionaries not cited by the examining attorney indicated that the primary significance of "Murphy bed" was not generic. The TTAB disagreed and concluded that "the appearance of the term in at least half a dozen well-known dictionaries is more persuasive of the perception of the term to the public than its omission from others."

The applicant also submitted a number of exhibits purporting to demonstrate that its competitors recognized "Murphy bed" as a trademark given that the competitors used other terms to describe their pivot beds including "wall beds, cabinet beds, hinged beds and concealed beds." The TTAB discounted this evidence, stating that "the test is not the existence of other terms for the product or recognition of trademark significance by the trade. It is recognition by the purchasing public."

Thus, the TTAB affirmed the examining attorney's refusal to register "Murphy bed" as a trademark and explained, "[W]e are of the opinion that MURPHY bed has for a long period of time been used by a substantial segment of the public as a generic term for a bed which folds into a wall or a closet. The evidence is supportive of this conclusion."

The PTO's refusal to register a term does not prevent the applicant from using the term as a trademark; it only prevents the applicant from obtaining the rights and

132. See In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) 1030, 1031 (T.T.A.B. 1984), rev'd, Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 687 F. Supp. 754 (E.D.N.Y. 1988), and aff'd in part, rev'd in part, 874 F.2d 95 (2d Cir. 1989). The definitions that the examining attorney relied on included "a bed that may be folded or swung into a closet" from WEBSTER'S NEW COLLEGIATE DICTIONARY (1979); "a bed that folds or swings into a closet for concealment" from AMERICAN HERITAGE DICTIONARY (2d ed. 1982); and "a bed that may be folded or swung into a closet when not in use" from WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (1976).

133. See In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) at 1031. The computer search results that the examining attorney found persuasive included the following statements:

* "The 17th- and 18th-century press bed was the forerunner of the fold-against-the-wall type known in the 19th- and early-20th centuries as a Murphy bed." (from an article in the New York Times on June 6, 1982)

* "Hechinger's and other stores which carry kitchen ware are full of handy little stacking racks to fit under the sink. Nor should you ignore the Murphy bed approach. An ordinary, large bread board can be hinged so that it flops down when not needed." (from the Washington Post on March 1, 1982)

* "Furniture will have multiple uses, combining storage and seating, for example. Tabletops will slide back into walls when not in use, and the old Murphy bed, which folds into a wall or closet, will be commonplace." (from U.S. News & World Report on May 9, 1983).

134. Id. at 1032.

135. Id. at 1033.

136. See id. at 1032.

137. Id.


139. In re Murphy Door Bed Co., 223 U.S.P.Q. (BNA) at 1033.

140. Id. (emphasis added). The Board did not define precisely how it derived that a "substantial segment" of the public perceived the term, nor did the Board indicate whether its determination depended upon a "substantial" segment perceiving the term as generic, or whether it just so happened that a substantial segment so viewed the term, but a more trivial segment would have sufficed. See id.
remedies concomitant with federal registration. Thus, Murphy continued to use “Murphy bed” as a trademark for its pivot beds, which explains how, in a subsequent dispute between Murphy and one of its distributors, Frank Zarcone (Zarcone), the trademark status of the term “Murphy bed” was again at issue.

When the TTAB affirmed the PTO’s rejection of the “Murphy bed” trademark application, Zarcone began to use “Murphy bed” in ways that Murphy viewed as contrary to their distribution agreement.

First, Zarcone formed two companies, the Murphy Bed Company of America, Inc. in Georgia, and the Murphy Bed Company of America, Inc. in Florida, and used the name “Murphy Bed” in the company names without authorization from Murphy.

Second, Zarcone obtained a telephone listing for the “Murphy Bed Company” in New York City, also without authorization from Murphy.

Third, Zarcone filled orders for beds that were designated as “Murphy Bed Model SL 60/80” with beds that were not manufactured by Murphy, but instead by one of Zarcone’s companies. Zarcone had filled previous orders for this model for the same customer with beds from Murphy.

Murphy sued for breach of contract, unfair competition, and trademark infringement. With respect to the trademark infringement claim, the district court determined that “Murphy bed” was a valid trademark notwithstanding the rejection of the application as generic at the PTO.

The Court of Appeals for the Second Circuit disagreed. Instead, in accord with the PTO and the TTAB, the Second Circuit concluded that “the term Murphy bed, in the eyes of ‘a substantial majority of the public,’ refers to a species of bed that can fold into a wall enclosure.” Thus, the court held “Murphy bed” to be a generic term, “having been appropriated by the public to designate generally a type of bed.” Consequently, Zarcone was not liable for trademark infringement.


A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Id.

142. See Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95 (2d Cir. 1989).

143. Id. at 98–99.

144. See id. at 98.

145. See id.

146. Id. at 99.

147. Id.

148. Id.

149. Id. (citing Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 687 F. Supp. 754, 756 (E.D.N.Y. 1988)).

150. Id. (quoting Murphy Door Bed Co., 687 F. Supp. at 756).

151. Id. at 101 (emphasis added) (citation omitted) (quoting King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963)). The Second Circuit afforded “great weight” to the decisions of the PTO and TTAB and based its decision on the dictionary and printed publication evidence that had persuaded them. Id. The Second Circuit also deemed the Murphy Company’s efforts to police its trademark futile because “Murphy bed” had “‘entered the public domain beyond recall.’” Id. (quoting King-Seeley, 321 F.2d at 579).

152. Id. at 97.

153. Nevertheless, the Second Circuit affirmed the permanent injunction prohibiting Zarcone from using the term “Murphy bed,” even though the court concluded that such term was in the public domain. The Second Circuit explained that Zarcone freely and with adequate consideration contracted “to refrain from use of the Murphy name
B. Generic from the Start—The Canfield Diet Chocolate Fudge Soda Case

The A.J. Canfield Company (Canfield) swept the nation in the early 1980s with its innovative take on diet soda—it made diet soda taste like chocolate fudge. Canfield sought federal trademark protection for the designation “Chocolate Fudge” for its diet soda. The examining attorney denied the application, concluding that “chocolate fudge” was “incapable of distinguishing the source of the goods” because it simply designated a flavor.

Due to the success of the diet soda, others were quick to jump on the bandwagon. One competitor, Concord, attempted to obtain a license from Canfield to market Canfield’s Diet Chocolate Fudge Soda but failed to receive a positive response. So Concord began marketing its own version, calling it “Vintage Diet Chocolate Fudge Soda.”

Canfield attempted to enjoin Concord from calling its product “Diet Chocolate Fudge Soda.” The district court denied Canfield’s motion for a preliminary injunction because it concluded that Canfield would be unlikely to succeed on the merits. The court determined that the class of product at issue was “diet chocolate sodas” and found the phrase “chocolate fudge” to be descriptive of that class. After considering whether the descriptive phrase could be protected as a trademark via secondary meaning, the court concluded that there was insufficient evidence to support such a finding.

Canfield appealed, arguing that its asserted trademark was suggestive. Canfield claimed that “chocolate fudge” communicates the sensation that drinking its soda in the event of a termination of the distribution agreement and did not so refrain.” Id. at 102. The court did not believe that there had been any frustration of purpose in the distribution agreement because the agreement did not transfer any trademark rights to Zarcone, but simply provided him exclusive rights to sell Murphy’s products. Id. at 102–03. Zarcone, it seems, was being punished for unfair competition by misrepresenting that the beds he was selling came from Murphy. Id. at 102. The injunction appears to mean that Zarcone can never sell a folding wall bed and call it a Murphy bed, even though that is the name that, in the court’s view, a substantial majority of the public uses to designate a folding wall bed. Such an injunction would seem to place Zarcone at a significant competitive disadvantage, which is one of the rationales that courts and commentators typically offer for justifying genericide in the first instance.

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155. While Canfield had been producing the product since the early 1970s, it was not until a syndicated columnist wrote an article in 1985 titled Heaven for Dieters: Two Calorie Fudge Soda and described the soda as “[t]aking a sip is like biting into a hot fudge sundae,”’ that sales went through the roof. Id. at 293 (quoting Bob Greene, Chicago Tribune columnist). This author’s mother was particularly fond of the soft drink. This author, on the other hand, would have preferred actual chocolate fudge.

156. Id.

157. Id.

158. Id. at 293–94.

159. Id. at 294.

160. Id.


162. Canfield II, 808 F.2d at 298. The district court concluded that chocolate fudge as applied to diet soda was not generic because there was “no proof that the term has come to be understood as referring to the genus of all chocolate-flavored diet sodas.” Canfield I, 629 F. Supp. at 208.


164. Canfield II, 808 F.2d at 297–98.
is “similar in some way to the sensation of eating chocolate fudge,” which has a unique texture and combination of ingredients including “sugar, butter, chocolate and cocoa, none of which are contained in diet soda.” The link between the diet soda and the trademark was suggestive and required imagination, according to Canfield, “because diet soda obviously has neither the ingredients nor the texture of chocolate fudge,” and “because a fudge-like sensation is said to be difficult to imagine in a diet soda.” The United States Court of Appeals for the Third Circuit disagreed that the alleged trademark was suggestive. “Because chocolate fudge denotes a flavor, no imagination is required for a potential consumer to reach a conclusion about the nature of Canfield’s soda.”

The Third Circuit then questioned whether “diet chocolate fudge soda” simply described characteristics of the product or “whether it [was] so commonly descriptive of the name of the product that [the court] should consider it generic.” Such a determination was fundamental, according to the Third Circuit, because the question of whether an asserted trademark is merely descriptive or generic “precedes any examinations of secondary meaning.”

In determining whether the asserted trademark was generic or merely descriptive, the Third Circuit failed to engage in any analysis of the primary significance to the relevant public. Instead, the court concluded that “neither of the two dominant principles of genericness, the primary significance test and its related test of consumer understanding, directly provide[s] an answer to our question, for both tests become applicable only after we have determined the relevant genus.” The Third Circuit then determined that the relevant genus was diet soda that tastes like chocolate fudge—a product unique to its class. Thus, the Third Circuit refused to extend trademark protection to the asserted trademark and concluded that “Diet Chocolate Fudge Soda,” being essentially identical to the genus defined by the court, was generic for the class of goods.

IV. THE PROBLEM WITH “GENERICNESS” DETERMINATIONS

The tests for determining the trademark status of generic and merely descriptive terms focus on the “primary significance” of those terms, in what appears to be an inverse relationship. When dealing with alleged generic terms, however, courts...
have failed to employ the primary significance tests in a manner that reflects this relationship. As a result, courts have imposed undue complexity into “genericness” determinations.

A. Form over Function

Courts, commentators, and the PTO rather uniformly contend that a generic term can never attain source recognition, and thereby trademark status, through secondary meaning. This contention relies on an a priori determination of a term’s generic identity. In essence, the PTO or a court first decides that a particular term is generic and then concludes that the term cannot function as a trademark. The process is flawed for it fails to take into account whether the term actually functions as a trademark. By classifying a term without ever evaluating what it does, courts have lost sight of the fundamental nature of the trademark.

The Lanham Act does not expressly preclude generic terms from being registered per se. Terms become trademarks when they function as such. Any preclusive effect derives from the underlying consensus of the courts and the PTO that generic terms, by definition, cannot distinguish goods. The Lanham Act specifically permits registration of terms that have “become distinctive of the applicant’s goods in commerce.” Indeed, the Lanham Act permits registration of ordinary descriptive words that have attained secondary meaning.
Still, it is a term’s ultimate placement on the distinctiveness spectrum, and not its ability to function as a trademark, that establishes its potential for becoming a trademark.\footnote{182} A term that is "merely descriptive" may attain trademark protection via secondary meaning; a term that is generic may not.\footnote{183} The policy that precludes protection for generic terms depends upon one’s ability to differentiate between a term that is generic and one that is merely descriptive—a task that the courts and the PTO have been unable to accomplish with any precision.\footnote{184} Many terms blur the line between descriptive and generic,\footnote{185} and any categorization is subjective and imprecise.\footnote{186} Yet, the final determination of whether a term is generic or merely descriptive has a preclusive effect, and a court cannot overturn a prior determination that a term is generic, but for clear error.\footnote{187} When a term is deemed to be generic, its generic status is virtually immutable from that point on,\footnote{188} thereby precluding it from ever attaining trademark status for the goods at issue.\footnote{189}

Although the determination of a term’s generic identity ought to be based upon an analysis of the term’s primary significance in the minds of the consuming public,\footnote{190} courts and the PTO often forego that analysis. Instead, they attempt to designate the product category, or genus, of the goods at issue. Courts and the PTO consider such designation the first step in a two-step inquiry: “First, what is the

\begin{itemize}
\item \footnote{182} See A.J. Canfield Co. v. Honickman, 808 F.2d 291, 297, 307–08 (3d Cir. 1986).
\item \footnote{183} These distinctions are crucial. If we hold a term arbitrary or suggestive, we treat it as distinctive, and it automatically qualifies for trademark protection... If we hold a mark descriptive, a claimant can still establish trademark rights, but only if it proves that consumers identify the term with the claimant, for that identification proves secondary meaning... Finally, if we hold a designation generic, it is never protectable because even complete “success...in securing public identification...cannot deprive competing manufacturers of the product of the right to call an article by its name.”
\item \footnote{184} See Folsom & Teply, supra note 17, at 1327 n.2.
\item \footnote{185} Under current law, for example, generic words are viewed as incapable of identifying or distinguishing a producer's product and hence as incapable of acquiring "secondary meaning." The availability of proof of secondary meaning in order to secure exclusive rights is made to depend on how a word is classified—as "generic" or "merely descriptive."
\item \footnote{186} See supra id. (noting that the PTO has even attempted to classify terms as "generically descriptive"); see also A.J. Canfield, 808 F.2d at 296–97 (noting that “[c]ourts and commentators have recognized the difficulties of distinguishing between suggestive, descriptive, and generic marks” and citing Folsom and Teply for the proposition that “the distinction between descriptive and generic is ‘artificial and unworkable’”)
\item \footnote{187} One court may view a term as descriptive, while another may view the same term as generic. In the “Murphy bed” trademark cases, for example, the district court determined that the name Murphy was not generic because it had secondary meaning, while the court of appeals held that the term was generic. Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95, 100 (2d Cir. 1989). Similarly, in the “Diet Chocolate Fudge Soda” trademark cases, one district court found the asserted trademark to be merely descriptive, another found it to be generic, and even another thought there to be "a reasonable basis for considering the term suggestive.” A.J. Canfield, 808 F.2d at 292.  
\item \footnote{188} See Microsoft Corp. v. Lindows.com, Inc., 64 U.S.P.Q.2d (BNA) 1397, 1403 (W.D. Wash. 2002) (stating that the distinction between descriptive and generic terms “has proved particularly nettlesome for courts, as ‘the difference between a generic mark and weakest of descriptive marks may be almost imperceptible’” (alteration in original)) (quoting Filipino Yellow Pages, Inc. v. Asian J. Publ’ns, Inc., 198 F.3d 1143, 1151 (9th Cir. 1999)))
\item \footnote{189} See supra note 174 and accompanying text.
\item \footnote{190} See Carter, supra note 18, at 773 n.56.
\end{itemize}
GENERICNESS & SECONDARY MEANING

Having designated the product category, courts and the PTO may conclude that the term at issue is generic without considering the term’s primary significance. For example, in the case involving the trademark status for the asserted trademark “Diet Chocolate Fudge Soda,” the Third Circuit designated the genus at issue as “diet sodas that taste like chocolate fudge” before embarking on an investigation as to the primary significance of the asserted trademark to the consuming public. The court explained: “The primary significance test...cannot be applied until after we have decided the question that lies at the core of this case: whether the relevant product category or genus for purposes of evaluating genericness is chocolate soda or chocolate fudge soda.”

If the Third Circuit had designated the genus at issue as “soda” or even as “diet soda,” the asserted trademark “Diet Chocolate Fudge Soda” would have been merely descriptive of the genus. By narrowing the genus to “diet sodas that taste like chocolate fudge,” the court ensured that the phrase was generic and foreclosed any analysis of the phrase’s primary significance. The Third Circuit skipped the very analysis that should be used to determine whether a term is generic—the determination of the primary significance of the term to the consuming public.

Similarly, in the case in which Justice Brandeis first articulated the primary significance test, the United States Supreme Court defined the genus of the goods at issue as “shredded wheat.” By doing so, the Supreme Court foreclosed any analysis of the term’s primary significance to the consuming public. If the


193. Id. at 293. See infra note 203 and accompanying text.

194. See infra note 203 and accompanying text.

195. For example, in A.J. Canfield, the court refused to consider any evidence of secondary meaning because it had already concluded that the trademark constituted the genus: Notwithstanding the centrality of the primary significance test to the genericness doctrine, it does not enable us to determine the relevant product genus in this case because it only becomes applicable after we have distinguished product genus from product brand. Although a term may primarily signify source if it primarily signifies a product emanating from a single, albeit anonymous, source, it does not primarily signify source if the product that emanates from a single source, e.g., shredded wheat, constitutes its own product genus. In other words, the primary significance test is generally satisfied if a term signifies a product that emanates from a single source, i.e., a product brand, but it is not satisfied if the product that emanates from a single source is not only a product brand but is also a product genus. The primary significance test does not, in and of itself, tell us how to differentiate a mere product brand from a product genus. That, however, is the crucial question in this case. Once that question is decided, the resulting question often decides itself.

A.J. Canfield, 808 F.2d at 300-01.

196. Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (“But to establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”).

197. See id. at 116 (asserting that shredded wheat “is the generic term of the article, which describes it with a fair degree of accuracy,” and concluding, therefore, that Nabisco could not acquire exclusive rights in the term).
Supreme Court had designated the genus at issue as “cereal,” or even “cereal made from wheat,” then “shredded wheat” would have been merely descriptive of the product, and thus capable of acquiring secondary meaning. By simply defining the genus as narrowly as the asserted trademark itself, the Supreme Court determined the outcome of the case.

This is not to say that either the Kellogg or the A.J. Canfield decision was incorrect in its ultimate holding concerning the protection available for the asserted trademark at issue. An asserted trademark must be evaluated in the context of the goods to which it refers. It is simply disingenuous to maintain that the primary significance of a term to the consuming public determines its trademark status when, in fact, courts undertake a separate analysis to identify the genus of the goods at issue. The necessarily subjective results of that separate analysis eliminate any need for the courts to evaluate the primary significance of the term.

There is virtually always a genus that can be circumscribed around a more specific term. If a court construes the genus narrowly, an otherwise merely descriptive term will describe all members of the group, and thus will be generic. Furthermore, articulation of the boundary that separates a merely descriptive from a generic term can be a semantic game. The example of the “Deep Bowl Spoon” cited in Abercrombie & Fitch Co. v. Hunting World, Inc. helps to illustrate:

“DEEP BOWL identifies a significant characteristic of the article. It is ‘merely descriptive’ of the goods, because it informs one that they are deep in the bowl portion.... It is not, however, ‘the common descriptive name’ of the article [since] [t]he implement is not a deep bowl, it is a spoon.... ‘Spoon’ is not merely descriptive of the article—it identifies the article—and therefore the term is generic.” On the other hand, “Deep Bowl” would be generic as to a deep bowl.

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198. See supra notes 49–56 and accompanying text (explaining how words can acquire secondary meaning).
199. See MCCARTHY, supra note 5, §§ 11:11, 12:1. For example, a trademark like “Java” is arbitrary in the context of computers, but generic in the context of coffee.
200. See, e.g., Folsom & Teply, supra note 17, at 1351 (asserting that the central inadequacy of primary significance is its binary nature). But see John F. Coverdale, Comment, Trademarks and Generic Words: An Effect-on-Competition Test, 51 U. CHI. L. REV. 868, 884 (1984) (discussing that the first step in determining the status of an asserted trademark “must be to determine the relevant genus” because the court cannot properly determine whether a challenged term is generic “without first identifying the article or substance with which it is dealing”). Yet, Professor Coverdale goes on to explain that determining whether goods fall within a particular genus “is inherently linguistic and psychological, and hence cannot be determined without at least some recourse, if only by judicial notice in some cases, to consumer opinion and verbal behavior,” thereby, it seems, returning the inquiry back to the primary significance to the relevant public. Id.
201. For example, a highly specific designation like “microbrewed raspberry wheat beer” is a member of the genus of flavored microbrewed wheat beers, which is a member of the genus of microbrewed beers, which is a member of the genus of beverages, which is a member of the genus of alcoholic beverages, which is a member of the genus of microbrewed beers, which is a member of the genus of beverages, and so on, the author supposes, until one is faced with determining whether the universe is a member of an even larger genus—clearly an analysis that exceeds the scope of this Article.
202. Raspberry, wheat, and microbrew are descriptive when considered in the context of the genus but are generic when considered in the context of the genus microbrewed raspberry wheat beer.
Applying the format and logic of this illustration to the case of “Diet Chocolate Fudge Soda” reveals that “Chocolate Fudge” identifies a significant characteristic of the article. It is “merely descriptive” of the goods, because it informs one that they are the flavor of chocolate fudge. It is not, however, “the common descriptive name” of the article because the article is not chocolate fudge, it is a soda. “Soda” is not merely descriptive of the article—it identifies the article—and therefore the term is generic. On the other hand, “Chocolate Fudge” would be generic as to a piece of chocolate fudge.

In this example, “Chocolate Fudge” becomes merely descriptive of “soda” because the boundary defining the genus has been shifted. In cases in which merely descriptive terms have attained trademark status via secondary meaning, a slight shift in the boundary in the opposite direction would have resulted in those terms being generic designations for the goods at issue. For example, in the case concerning the “Honey Baked Ham” trademark, the court considered the genus of the goods at issue to comprise the broad category of ham prepared with honey, as opposed to the more narrow category of ham baked with honey. If the court had defined the genus to comprise this narrower category, the trademark would have been generic for the goods at issue. Instead, the court defined the genus to comprise the slightly broader category, rendering the asserted trademark merely descriptive of the genus and thus capable of acquiring secondary meaning.

Moreover, in their attempts to delineate logically the boundaries between generic and merely descriptive terms, some courts have formulated distinctions that tend to strain logic rather than to impart it. In Abercrombie, for example, the court determined that the asserted trademark “Safari” was generic as applied to hats, but that it was merely descriptive as applied to shirts. While the same term clearly can be generic for one type of goods and distinctive for another, the goods at issue are typically disparate: “apple” for a type of fruit versus “Apple” for a type of computer. It seems incongruous that “Safari” functions as a trademark when associated with shirts but not with hats any more than the term “cowboy” would.

The court in America Online, Inc. v. AT&T Corp. recognized the difficulty in drawing the boundary between merely descriptive and generic terms:

> When words are used in a context that suggests only their common meaning, they are generic and may not be appropriated as exclusive property. But a debate over whether a word or phrase is being used in a context that communicates

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204. See Schmidt v. Quigg, 609 F. Supp. 227, 229 (E.D. Mich. 1985) (explaining that the “core inquiry is whether "Honey Baked Ham" is generic for "hams prepared with honey").

205. Id. at 230-31 (finding the term “Honey Baked Ham” merely descriptive and protectable based on acquired distinctiveness); see also Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 581–82 (D.N.J. 1985) (finding the term “Honey Roast” to be descriptive (and thereby capable of acquiring secondary meaning) as applied to peanuts); Jeno’s, Inc. v. Comm’r of Patents & Trademarks of the United States, 227 U.S.P.Q. (BNA) 227 (D. Minn. 1985) (finding the term “Pizza Rolls” to be suggestive for snacks comprising rolled egg batter filled with pizza flavoring).

206. See Abercrombie & Fitch Co., 537 F.2d at 11–12 (explaining that the “safari hat” is part of a typical “safari outfit,” which also includes a “safari jacket” and which, when accompanied by pants, is called a “safari suit”).

207. See id. at 15.
merely its common meaning can quickly become as metaphysical as the study of language itself.208

Careful, thoughtful elucidation of the boundary between generic and merely descriptive terms is critical because the determination that a term is generic for particular goods virtually precludes that term from ever attaining trademark status for the goods at issue. In other words, even if consumers have come to associate the generic term with a particular source of goods, the term is still not eligible for protection as a trademark.209

Not only is the boundary itself critical, but also the timing for evaluating the status of a term. Categorizing a term as generic at an early point in time may preclude it from becoming a trademark if the court or the PTO bases the term’s present potential to function as a trademark on that prior generic status.210 For example, in a case involving a dispute over Microsoft’s “Windows” trademark, the court received extensive evidence that the term “windows” was generic long before Microsoft adopted it as a trademark and suggested that, in spite of evidence to the contrary, Microsoft could not remove it from the public domain.211 The dispute over the “Windows” trademark was merely at the preliminary injunction phase, and the court was not in a position to address the merits of the case.212 Nevertheless, the court was foretelling that it would overlook evidence of acquired distinctiveness because the term was generic.213

Similarly, in a dispute over the status of the trademark “HOG,” the Court of Appeals for the Second Circuit determined that the critical point in time for analyzing the generic status of the asserted trademark was before the trademark

210. See Microsoft Corp. v. Lindows.com, Inc., 64 U.S.P.Q.2d (BNA) 1397 (W.D. Wash. 2002). The PTO initially rejected Microsoft’s application to register “Windows” as a trademark: “[T]he term Windows is widely used, both by the public, consumers, and the relevant industry, to name a class of goods or a type of software, that is, a genus of goods, referred to as windows programs, or windowing software. The term Windows was in existence, and known, prior to adoption by the applicant. Since the term is a generic designation for the applicant’s goods, then, no amount of evidence of de facto secondary meaning can render the term registrable.”

Id. at 1400 (quoting a Feb. 17, 1993 PTO Office Action). Ultimately, the PTO withdrew its rejection and registered the trademark “with no analysis or explanation for [the] reversal,” but possibly based on survey evidence indicating that “67% of relevant consumers identified Windows as a brand name.” Id. at 1400–01. Also probative may have been that Berland International, one of Microsoft’s competitors, ceased its vigorous protest to the registration of the trademark after Microsoft purchased the company’s pending trademark applications for $1 million. See id.
211. Microsoft Corp., 64 U.S.P.Q.2d (BNA) at 1408. But see Yellow Cab Co. of Sacramento v. Yellow Cab Co. of Elk Grove, Inc., 419 F.3d 925, 928 (9th Cir. 2005) (noting that the “crucial date for the determination of genericness is the date on which the alleged infringer entered the market with the disputed mark or term”).
212. Microsoft Corp., 64 U.S.P.Q.2d (BNA) at 1410.
213. Id. at 1409 (agreeing that the “Windows” mark had acquired secondary meaning, but maintaining that “no degree of secondary meaning will save a generic mark”).
holder adopted it. As such, the court determined that because the asserted trademark was generic before the Harley-Davidson Company adopted it, "hog" could not be removed from the public domain. The court in *Harley-Davidson* refused to give credence to evidence that a "substantial segment of the relevant consumers" used the term "specifically to refer to Harley-Davidson motorcycles." According to the court in *Harley-Davidson*, the generic status of the term at any point in time precludes its ability to function as a trademark in the future unless the term retained no generic meaning: "The public has no more right than a manufacturer to withdraw from the language a generic term, already applicable to the relevant category of products, and accord it trademark significance, at least as long as the term retains some generic meaning." Such a conclusion directly contradicts the test for acquired distinctiveness, which requires only that the primary significance of the term to the relevant consumers is the producer and not the product.

Inasmuch as it is not the "ontological status" of a trademark as a word, color, sound, or symbol that determines its fate, but rather its ability to identify and distinguish the goods of one manufacturer from those of another and to indicate the source of the goods, the same should hold true for terms blurring the lines between "descriptive" and "generic" along the distinctiveness spectrum. If a term functions as a trademark, it should not matter that the PTO or a court has placed it at the generic end of the distinctiveness spectrum. Indeed, if a term functions as

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214. See Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 808 (2d Cir. 1999).
215. See id. at 810.
216. Id. at 812.
217. Id.
218. Cf. John T. Cross, *Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems*, 76 Neb. L. Rev. 95, 120 (1997) (suggesting that "barring rights in generic marks is misguided" if the primary meaning of the term changes such that buyers "come to perceive the mark as an indication of source rather than the name of the good").
219. Qualitex Co. v. Jacobsen Prods. Co., 514 U.S. 159, 164 (1995) (citing Landes & Posner, supra note 29, at 290). The Supreme Court explained, "[P]roviding] trademark protection for color was consistent with the 'jurisprudence under the Lanham Act developed in accordance with the statutory principle that if a mark is capable of being or becoming distinctive of [the] applicant's goods in commerce, then it is capable of serving as a trademark.'" Id. (quoting In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1120 (Fed. Cir. 1985)) (second alteration in original).
220. Cf. Dinwoodie, supra note 30, at 651.
221. In discussing the parallel use of trademarks in different contexts—"Star Wars" in the context of a film and "star wars" as a military strategy, SPAM as a brand of luncheon meat, spam as an unwanted barrage of email—Professor McCarthy explains the dynamic nature of modern language:

> [T]he meaning of a word or symbol is not necessarily fixed for all time as it is first used, or as it is defined in the dictionary, but may grow and develop new meaning and nuances according to its use. Although a word may have developed a new, generic meaning in a non-commercial, non-trade context, as long as it still functions in the commercial context to identify the good will of its source, it has meaning as a trademark....

MCCARTHY, supra note 5, § 12:3. Cf. Dinwoodie, supra note 30, at 679–80 (discussing the dynamic and
a trademark, then the term’s prior classification as generic was or has become incorrect.222 A term that consumers perceive as identifying and distinguishing the goods of one manufacturer from those of another and indicating the source of those goods is by definition not generic.223 Thus, the proper inquiry should be to first establish the function of a term, and then to classify it. Such a process unites the concepts of primary significance for secondary meaning and primary significance for generic determinations in a way that the courts and the PTO have failed to do.

B. Primary Significance Is Primary Significance

The primary significance of a term to the consuming public is (or should be) the main inquiry for determining both whether a term has become generic and whether a descriptive term has become protectable via acquired distinctiveness, or “secondary meaning.”224 There is no objective indication that primary significance has different meanings in the two different contexts.225 Yet, when a generic inquiry is at issue, courts fail to fully address the issue of acquired distinctiveness. Instead, courts simply foreclose the analysis completely226 or employ de facto secondary meaning227 to vitiate any evidence of consumer source recognition.

For example, in America Online, the district court explained that de facto secondary meaning exists where the public associates a generic term with a single source of origin, but the term, because of its generic nature, is not afforded evolutionary nature of trademarks). Justice Oliver Wendell Holmes, Jr. exquisitely expressed the dynamic nature of words (in the context of taxes, not trademarks): “A word is not a crystal, transparent and unchanged, it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.” Towne v. Eisner, 245 U.S. 418, 425 (1918).

222. The case involving Microsoft’s “Windows” trademark illustrates the point. Although there are numerous federal trademark registrations for “Windows” for software, the district court surmised that “windows” was generic before Microsoft entered the market in 1985 with Windows 1.0. Microsoft Corp. v. Lindows.com, Inc., 64 U.S.P.Q.2d (BNA) 1397, 1399 (W.D. Wash. 2002). As such, the court explained that even though it agreed that “the Windows mark has acquired secondary meaning, no degree of secondary meaning will save a generic mark.” Id. at 1409 (footnote omitted). The court implied that if windows has “ceased to have current generic meaning” it could be “infused with trademark significance.” Id. (quoting Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 811 (2d Cir. 1999)). But the court’s implication only further highlights the problem. If the court recognizes that the term has secondary meaning, the court cannot at the same time withhold trademark status based on its determination that the term at issue retains “some generic meaning.” Id.

223. But see Folsom & Teply, supra note 17, at 1339 (explaining that generic terms may “perform a variety of informational functions—ranging from the provision of pure commercial or source-related information to the provision of pure generic or product-category information—at the same time”). Folsom and Teply categorize these “hybrid” terms as “discontinuously hybrid” or as “simultaneously hybrid.” Id. Discontinuously hybrid terms have only source significance for some consumers, but only designate the product’s genus for others. Id. Aspirin is a discontinuously hybrid term in that it is a generic designation for the general public but is a recognized trademark of the Bayer Company for pharmacists. Simultaneously hybrid terms both indicate source and designate product class at the same time for the same consumer. A consumer may recognize that each of these terms has source significance but may also use these terms to designate the category of goods at issue. Id. For instance, when faced with a runny nose, a consumer would be unlikely to reject a tissue when she had requested a “Kleenex.”

224. Palladino, supra note 173.


226. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (explaining that “even proof of secondary meaning...cannot transform a generic term into a subject for trademark”).

227. For a detailed analysis of the de facto secondary meaning doctrine, see Levy, supra note 51, at 1207.
trademark protection.\textsuperscript{228} Similarly, in \textit{A.J. Canfield}, the court explained that although fifty-nine percent of respondents surveyed associated diet chocolate fudge soda with Canfield, "such a response does not necessarily prove that chocolate fudge soda is protectable because the public may identify the generic name for a product with a single manufacturer if that manufacturer has dominated the market."\textsuperscript{229}

The fundamental problem in a situation like the court faced in \textit{A.J. Canfield} is that the alleged trademark is simultaneously designating source and \textit{genus}; it may be designating source simply because there has been no other competing manufacturer of the goods. Rather than acknowledge the source association, however, courts in such situations tend to characterize the consumer source association as merely de facto secondary meaning and disregard it.\textsuperscript{230}

Further, though the same facts are said to support both secondary meaning and de facto secondary meaning\textsuperscript{231} courts vehemently resist permitting a term that has been pre-designated as generic from attaining trademark status through acquired distinctiveness.\textsuperscript{232} In a schizophrenic sort of way, however, courts recognize this disconnect. For example, in the "Murphy bed" case, the TTAB suggested that, but for the fact that "Murphy bed" was generic, it would have been registerable based on its secondary meaning.\textsuperscript{233} In addition, in the "Thermos" case, the court, after designating "thermos" as the generic term for a vacuum bottle, fashioned a remedy permitting the alleged infringer to use the term "thermos" with a lowercase "t" while retaining "Thermos" with a capital "T" exclusively for the trademark holder.\textsuperscript{234} This remedy, though allegedly justified in terms of avoiding consumer confusion and unfair competition, seems to disregard the fact that the court had just found the word "thermos" to be generic.\textsuperscript{235}

If the primary significance of a term to the consuming public is the test for both secondary meaning and genericness, then the "ontological status" of the term as "merely descriptive" or "generic" should not matter in applying the test. If

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\item \textsuperscript{228} Am. Online, Inc. v. AT&T Corp., 243 F.3d 812, 822 (4th Cir. 2001).
\item \textsuperscript{229} A.J. Canfield Co. v. Honickman, 808 F.2d 291, 294 n.2 (3d Cir. 1986).
\item \textsuperscript{230} In \textit{Kellogg}, the evidence indicated that, because of the long period in which there was only one manufacturer of the product, people had come to associate "shredded wheat" with that manufacturer. Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111, 118 (1938). The Supreme Court explained that while such evidence indicated a subordinate meaning, it did not demonstrate that the primary significance of the term to the consuming public was the producer. \textit{Id.}
\item \textsuperscript{231} See \textit{A.J. Canfield}, 808 F.2d at 297 (citing Folsom & Teply, supra note 17, at 1351).
\item \textsuperscript{232} See Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 374 (1st Cir. 1980) (noting that "[n]o amount of purported proof that a generic term has acquired a secondary meaning associating it with a particular producer can transform that term into a registrable trademark"), \textit{overruled on other grounds} by Miller Brewing Co. v. Falstaff Brewing Corp., 655 F.2d 5 (1st Cir. 1981); see also \textit{A.J. Canfield}, 808 F.2d at 304. But see Am. Aloe Corp. v. Aloe Creme Labs., Inc., 420 F.2d 1248, 1256 (7th Cir. 1970) (implying that the creation of secondary meaning in a generic term could give exclusive trademark rights in that term).
\item \textsuperscript{233} See \textit{In re Murphy Door Bed Co.}, 223 U.S.P.Q. (BNA) 1030, 1033 (T.T.A.B. 1984) (explaining that, if "Murphy bed" were not a generic term, "the evidence of secondary meaning (long years of use and volume of sales) would in the court's opinion be sufficient to allow the registration under Section 2(f)"), \textit{rev'd}, Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 687 F. Supp. 754 (E.D.N.Y. 1988), and \textit{aff'd} in part, \textit{rev'd} in part, 874 F.2d 95 (2d Cir. 1989).
\item \textsuperscript{234} King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 581 (2d Cir. 1963).
\item \textsuperscript{235} See also Nestle Co. v. Chester’s Market, Inc., 756 F.2d 280, 280-81(2d Cir. 1985) (vacating the district court's finding that the trademark "Toll House" was generic in light of a subsequent settlement agreement between the parties), \textit{overruled on other grounds as recognized in} \textit{In re Tamoxifen Citrate Antitrust Litigation}, 466 F.3d 187, 203 (2d Cir. 2006).
\end{itemize}
consumers recognize that a term from the public domain distinguishes goods and identifies source, then it is a trademark no matter what ontological label one wants to apply. 236 Certainly, the hesitancy in granting rights to such terms hinges upon the need to avoid removing terms from the public domain. 237 Yet the public domain is not inviolable. 238 In rare cases, trademark rights previously lost to genericide have "recaptured" from the public domain.

1. "Recapture" of a Trademark Right Lost to Genericide

Once upon a time, the trademark "Singer" was dedicated to the public as a generic term for a type of sewing machine. 239 However, only eleven years later, the PTO registered the term "Singer" as a trademark for sewing machines for the Singer Manufacturing Company. 240 When the question of the term's trademark status was again at issue in 1953, the United States Court of Appeals for the Fifth Circuit determined that Singer had "recaptured" its mark through its constant and exclusive use and advertising. 241

If "primary significance" is going to be the standard for both genericide and acquired distinctiveness, one might surmise that recapture of a trademark would be available upon the same showing required to prove that a merely descriptive mark has attained secondary meaning. The ultimate outcome of the Singer case seems to support this supposition:

Once SINGER had become generic for sewing machines offered by different companies, it stood on the same legal ground as any other generic term. Even if there was some residual goodwill, it was not enough to protect the mark while

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236. The author is not advocating that a truly generic term, i.e., one that is non-source identifying, be afforded trademark protection. To the contrary, the author is advocating that only those terms that are source identifying, and thus by definition not generic, be afforded trademark protection, and then only if those terms are "non-functional" in the sense outlined in Part V, infra. Trademark law needs to recognize the dynamic nature of language and shifting consumer preferences for product- and source-identifying terms. Cool new terms are constantly evolving for old products ("bling" for jewelry, "kicks" for sneakers), thereby paving the way for the possibility that outdated generic terms could become source-identifying. See infra Part IV.B.1-2 (examining the rare cases in which generic terms have been "captured" or "recaptured" from the public domain).

237. Marc Levy argues that there are two problems with this assumption. Levy, supra note 51, at 1213. First, "it is presumptuous to assume that a single corporation, even with a large marketing budget, has the ability to cause the majority of consuming America to forget that the mark is also a common name." Id. Second, any justification based on protecting competitors' rights to continue to use generic terms "suffers from... circularity. It assumes that the mark at issue is currently generic." Id. at 1215.

238. Trademarks that have been abandoned are said to "fall back into the public domain." Carter, supra note 18, at 777-78. Another user, however, may appropriate an abandoned trademark to identify the exact same goods as those of the former trademark holder. See Cal. Cedar Prods. Co. v. Pine Mountain Corp., 724 F.2d 827, 828 (9th Cir. 1984) (instructing that "the first party to use an abandoned trademark in a commercially meaningful way, after its abandonment, is entitled to exclusive use and ownership of the trademark and trade dress").

239. Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169 (1896). The Supreme Court determined that, during the life of the patent at issue, "Singer" had become the identifying and generic name of the patented sewing machine. Id. at 180-81. Thus, when the patent expired, the name passed to the public domain. Id. at 186.

240. For the trademark "Singer" for "sewing machines, parts and attachments," see U.S. Trademark No. 64,950 (registered Aug. 27, 1907).

241. Singer Mfg. Co. v. Briley, 207 F.2d 519, 520-21 n.3 (5th Cir. 1953). The court's description of the history of the trademark in this case is somewhat inaccurate in that it implies that the rights were recaptured after a long period of time and an extension of the product line. Id. In fact, the PTO granted registration only eleven years after the original decision from the Supreme Court concluding that the trademark had become generic. See supra notes 239-240.
it remained generic. Once language usage changed among relevant consumers such that SINGER was not primarily used generically, it could be protected as a trademark, without regard to that prior generic usage.\textsuperscript{242}

Despite the Singer holding, the burden for recapturing a trademark that has become generic is substantial,\textsuperscript{243} and the situation where it could occur is rare.\textsuperscript{244} In line with the discussion above, why would the evidence required to recapture trademark be more substantial than the evidence that demonstrated the loss in the first instance?

Recapture, while rare, supports the assertion that a trademark should be defined by its function and not by its prior designation along the distinctiveness spectrum. The rare cases illustrate that the public domain is not inviolable.\textsuperscript{245} Trademarks that once were generic and part of the public domain became distinctive again. Thus, all of the admonitions against removing from the public domain language that the public has come to rely on do not apply when the meaning of the term at issue actually changes. And if "recapture" is possible, "capture" should be as well.\textsuperscript{246}

2. "Capture" of a Generic Term\textsuperscript{247}

If the public domain is not inviolable, then even generic terms that were never trademarks should be able to attain secondary meaning, or to "capture" trademark rights.\textsuperscript{248} Marc Levy explains, "It would seem logical that the idea of 'capturing' a trademark that was once generic should be the mirror image of the more common situation of losing a trademark that has become generic."\textsuperscript{249} In rare cases, terms believed to have been generic at one time have obtained trademark registrations.\textsuperscript{250} The TTAB has taken the position that an applicant must demonstrate that "the generic use of the term is 'practically obsolete.'"\textsuperscript{251} The Second Circuit has taken the

\textsuperscript{242} Levy, supra note 51, at 1207 (emphasis added).
\textsuperscript{243} See GILSON LALONDE ET AL., supra note 4, § 2.02[5].
\textsuperscript{244} Professor McCarthy instructs: "Only in an extraordinarily rare case could a name once recognized in the past as a generic name be raised from the public domain to become a trademark by a change in consumer usage over a significant period of time." McCARTHY, supra note 5, § 12:11. The only other presently known case of recapture involves the "Goodyear" trademark. See Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co., 128 U.S. 598, 602 (1888) (finding that "Goodyear Rubber" had become a generic term); Goodyear Tire & Rubber Co. v. H. Rosenthal Co., 246 F. Supp. 724, 729 (D. Minn. 1965) (finding that "Goodyear" had acquired secondary meaning).
\textsuperscript{245} See supra notes 239–244 and accompanying text.
\textsuperscript{246} Levy, supra note 51, at 1208–12.
\textsuperscript{247} New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 306 n.4 (9th Cir. 1992) (pontificating that "[a]n interesting question is whether a word, although once generic, may become protectable").
\textsuperscript{248} Levy, supra note 51, at 1197.
\textsuperscript{249} Id.
\textsuperscript{250} Id. at 1209–10 (detailing how "SOFTSOAP" was "no longer a generic name because consumers at present regarded it primarily as a brand" and how, although "KISSES" may have once been generic for candies, it was not generic now).
\textsuperscript{251} Id. at 1212; see also GILSON LALONDE ET AL., supra note 4, § 2.02[5] (citing Miller Brewing Co. v. Falstaff Brewing Corp., 655 F.2d 5 (1st Cir. 1981)).

"Where a generic association of a word or term has become obsolete and is discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word."

Id. (quoting Miller Brewing Co., 655 F.2d at 8 n.2).
position that “if a generic word could ever be infused with trademark significance, the word must have ceased to have current generic meaning.” 252

Such a showing is unsound based on the statutory requirement for trademark protection. 253 If consumers recognize that a term from the public domain identifies and distinguishes goods and indicates source, then it is a trademark—period. 254

C. Principal Justification—Confusion or Competition?

Who benefits from a determination that an asserted trademark is generic? Is it the consumer who prefers the shorthand referent for the goods the trademark represents, or is it the competitor who is at a loss competitively without the free use of the trademark and its associated consumer recognition and acceptance? Consumer confusion, not competitive disadvantage, is thought to be the “grave iniquity against which trademark laws and jurisprudence are intended to guard.” 255 In fact, in trademark cases where consumer confusion is not at issue, competitors’ rights are said to be irrelevant. 256

If eliminating consumer confusion is a principal justification for genericide, then the genericide of a trademark may actually backfire. When a trademark holder is forced, through genericide, to find a new trademark, not all consumers will immediately recognize that genericide has destroyed the trademark at issue. Consumer confusion may occur when consumers encounter what they believe to be the trademark holder’s trademark on a competitor’s goods. 257 As a result, the original trademark holder may shoulder an additional burden of dealing with her

252. Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 811 (2d Cir. 1999) (emphasis added); see also Microsoft Corp. v. Lindows.com, Inc. 64 U.S.P.Q.2d (BNA) 1397, 1408 (W.D. Wash. 2002) (suggesting that, because the term “windows” retained some generic meaning, Microsoft had not reclaimed the term from the public domain).

253. See Levy, supra note 51, at 1212 (inquiring why the standard should be “exclusive significance” rather than “primary significance” for protecting a once-generic term).

254. See id. at 1198.

Once a mark has acquired sufficient secondary meaning such that its primary significance is to identify a producer, that mark is no longer generic. It has become a mark. There is no principled justification for denying trademark protection to a mark, the primary significance of which is to identify a particular producer, simply because that mark may have been generic sometime in the distant past. When evidence of secondary meaning reaches the level of primary significance, a trademark should be protective, regardless of its history. Genericness cannot be an immutable quality because actual language use, on which a determination of genericness should be based, is not immutable.

Id.


256. “If consumers are unlikely to be misled, trademark law provides no protection against harm to the seller’s product investments or related competitive advantage.” Chiappetta, supra note 30, at 42. But see RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 1 cmt. e (1995):

The rules governing the protection of trademarks must also be responsive to the public interest in fostering vigorous competition. In defining protectable subject matter and in delineating the scope of exclusive rights, the law cannot neglect the legitimate interests of other competitors. In some cases the recognition of exclusive rights in favor of a particular seller may undermine the ability of other sellers to communicate useful information to consumers or deprive competitors of access to product features necessary for effective competition.

257. The primary significance test takes this into account. See supra notes 108–112 and accompanying text. Because the test is based on a majority viewpoint, virtually forty-nine percent of the relevant public could be confused as long as fifty-one percent of the relevant public considered the asserted trademark to represent the product, not the source of the product.
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competitor's unsatisfied customers. The Murphy Door Bed Company, for example, regularly responds to customer complaints concerning "murphy beds" manufactured by its competitors. Customers expect the Murphy Door Bed Company to honor the warranties provided by those competitors because the customers believe that all "Murphy beds" originate from the Murphy Door Bed Company. Thus, the company gets none of the benefit of the trademark (exclusive use and actual source recognition with respect to the goods) but has to deal with the associated liabilities (complaints and repair requests).

Moreover, genericide may increase the cost of acquiring knowledge for some consumers. The Murphy Door Bed case is illustrative. Consumers are confused, thus they have to spend more time finding out which kind of "murphy bed" they are purchasing—one from the Murphy Door Bed Company or one from one of its competitors.

When a court justifies genericide as a means to avoid consumer confusion, the court also may be implying that the public cannot be educated about the difference between the asserted trademark and the product at issue. Professor Bartow discusses the misconception of the "idiot consumer" in detail and concludes that all consumers should be presumed "reasonably prudent." Unfortunately, though perhaps based on a time when information concerning products was much less available than it is today, consumers were deemed too unsophisticated to use the generic term for goods when the trademark was less complicated.

Yet, it is not consumer confusion that the courts view as paramount in cases concerning the generic status of an asserted trademark; rather, a virtually constant issue that courses through these cases is whether there is a competitive need for the term at issue. In terms of genericide, the basis for the competitive need stems from the public's widespread misuse of the mark. If the public did not misuse the trademark to identify the goods at issue, the competitors would have no basis to assert competitive disadvantage. Often the public's appropriation of a trademark is the result of a quality product coupled with a successful marketing campaign. Widespread adoption of a trademark by the public should be a benefit to the trademark holder and a burden to the competitor, not the other way around. The competitor who pleads competitive disadvantage is really seeking a court-sanctioned free ride on the good-will of the trademark holder. Were the competitor to expend...
the same resources on marketing and product development as the trademark holder, perhaps the competitor would be similarly situated in terms of good-will, product quality, and consumer perception.

Someone is always first. The first to market takes all of the risk—both of failure and success. The risk of failure, no surprise, is that the product bombs. The risk of success, however, is that the product becomes known by the trademark and the trademark holder has to expend additional marketing resources to compete and distinguish her products in the market she created. Her competitors, on the other hand, enter the market with reduced risk of failure (because the market has been tested) and without risk of loss of investment in a trademark.266

In balancing the interests, when a term has been designated as generic, notwithstanding any evidence of secondary meaning, the competitive need outweighs the interests of the trademark holder. In contrast, when the asserted trademark has been designated as merely descriptive, with evidence of secondary meaning, the interests of the trademark holder outweigh the competitive need.267 Thus, the rights of the trademark holder and her competitors with respect to a disputed term depend upon an accurate classification of the term. But as noted above, such classification is fraught with subjectivity.

Thus, a radical question emerges: Is it even necessary to classify terms as merely descriptive or generic? The classification structure along the distinctiveness spectrum is a difficult fit for symbols, colors, sounds, and scents. Courts have struggled, in particular, with categorizing trade dress.268 The Lanham Act protects as trademarks terms that identify and distinguish goods and indicate source,269 and thus defines terms not by where they fit on the distinctiveness spectrum but by their function (though the spectrum should illustrate that function by classifying how well a particular term can distinguish goods). Have courts been spinning their wheels trying to classify terms when there is a more fundamental question they could be asking? Does it matter how well a term can function as a trademark as long as competitors will not be significantly disadvantaged without it?

V. PROPOSED SOLUTION—A FUNCTIONAL APPROACH

The problems inherent in genericness determinations cannot be reconciled if courts refuse to consider the primary significance of the term at issue, or consider but discard it as demonstrating only de facto secondary meaning. This Part will

266. It is unlikely that a competitor's trademark would succumb to genericide for the same product. The author knows of no such cases. Aspirin, for example, is marketed by Bayer and Ecotrin. The likelihood that Ecotrin would become another generic term for aspirin is extremely slim.

267. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976) (asserting that, in the context of merely descriptive marks that have acquired secondary meaning, "the law strikes the balance, with respect to registration, between the hardships to a competitor in hampering the use of an appropriate word and those to the owner who, having invested money and energy to endow a word with the good will adhering to his enterprise, would be deprived of the fruits of his efforts"); see also Levy, supra note 51, at 1214 (explaining that, "[b]y allowing for the registration of descriptive (but not generic) marks upon proof of secondary meaning, trademark law sanctions and approves of the marketing investments of companies, which seek to change how we use language").

268. See Dinwoodie, supra note 30, at 644 (noting that the "analytical devices" of traditional trademark law have hampered the "rational development of product design trade dress protection").

demonstrate that a more logical, coherent structure exists in the functionality doctrine.

A. Traditional Functionality Doctrine

All trademarks, in addition to being able to identify and distinguish the goods of one manufacturer from those of another, and to indicate source, must also be non-functional. Traditionally, the "functionality doctrine" has limited the extent of exclusive trademark rights available for certain subject matter, such as color and product designs. In particular, the functionality doctrine is said to prevent trademark law from "inhibiting legitimate competition by allowing a producer to control a useful product feature." In Qualitex Co. v. Jacobson Products Co., the Supreme Court, using an imaginary example, illustrated how exclusive control of a useful product feature would negatively impact competition:

Even if customers have come to identify the special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition—not by protecting the reputation of the original bulb maker, but by frustrating competitors' legitimate efforts to produce an equivalent illumination-enhancing bulb.

Thus, the functionality doctrine attempts to balance the reputation-related interest of the trademark holder with the competitive interests of her competitors. When the asserted trademark comprises useful features of the product at issue, the balance falls on the side of the competitors. The Supreme Court in Qualitex explained:

The functionality doctrine...forbids the use of a product's feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is "essential to the use or purpose of the article" or "affects [its] cost or quality." The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation-related product features.

The test that has evolved for determining whether a product feature is functional asks:

1. Is the feature essential to the use or purpose of the article;
2. Does the feature affect the cost or quality of the article; or
3. Would the exclusive use of the feature put competitors at a significant non-reputation-related disadvantage?

272. *Id.* at 164.
273. *Id.*
274. *Id.* at 169 (alteration in original) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).
275. The structure is the author's per the U.S. Supreme Court decisions in *Traffic Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), *Qualitex*, 514 U.S. 159, and *Inwood Laboratories*, 456 U.S. 844. *Inwood* frames the first two questions as such. *Inwood*, 456 U.S. at 850 n.10. *Qualitex* recites the *Inwood* tests but then suggests that if the answer to questions (1) or (2) is "no," question (3) may still provide a basis for a finding of functionality.
In application, this test has focused on the needs of competitors. For example, in *Qualitex*, the green-gold color of a dry-cleaning press pad was held to be distinctive and non-functional.\(^{276}\) Though some color was necessary to cover stains, there was "'no competitive need in the press pad industry for the green-gold color, since other colors are equally usable.'"\(^{277}\) In contrast, competitors have been permitted "to copy the green color of farm machinery (because customers wanted their farm equipment to match)," and to copy the color black on outboard motors "(because black has the special functional attributes of decreasing the apparent size of the motor and ensuring compatibility with many different boat colors)."\(^{278}\)

In terms of the aesthetic value of the color in these cases, functionality depends on whether the design (the color), "confers a significant benefit that cannot practically be duplicated by the use of alternative designs."\(^{279}\) Thus, the availability of alternative designs factors into the analysis. The availability of alternative designs, however, may not factor into the analysis of functionality related to a purely *useful* product feature.\(^{280}\)

For example, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, the Supreme Court found the dual-spring design of a road sign to be functional, and thus not protectable as trade dress.\(^{281}\) The Court noted that the unique and useful design "serve[d] the important purpose of keeping the sign upright even in heavy wind conditions."\(^{282}\) In terms of the availability of alternative designs, the Court explained that the dual-spring design was the very reason the device worked.\(^{283}\) Thus, because the patent on the dual-spring had expired, competitors were free to copy it and did not have to explore ways to distinguish their designs from the original dual-spring design.\(^{284}\)

In a case like *TrafFix*, where the design at issue was the subject of a patent, consumers may come to associate the design with a single source, not necessarily based on any good-will associated with the design, but because during the term of the patent no competitors could legally sell the patented design without the patent holder's consent.\(^{285}\) The functionality doctrine recognizes that, although the design may be functioning as a trademark, the rights of competitors to copy the design are paramount after the patent expires. Thus, even though consumers may associate the design with one source and may even be confused when a copycat enters the
marketplace, that source association and consumer confusion is subsidiary to
competitive concerns.

Courts have faced similar concerns when dealing with the protectability of terms. When a product is unique to the marketplace, either because it is the subject of a patent or because it is simply first, consumers may associate the product's trademark with a single source, again not necessarily based on any good-will inherent in the trademark, but because no comparable product exists. Rather than acknowledge the source association, however, courts in such situations tend to characterize it as merely de facto secondary meaning and disregard it. Courts need not approach consumer source association by creating this legal fiction. They can acknowledge it and, when competitive concerns so dictate, use a functional approach to deny trademark rights to the term at issue.

B. Application of a "Functional" Approach to Terms

Traditionally, "functionality" has limited the extent of exclusive rights available for certain trademark subject matter, such as color and product designs, but has not been applied as the sole justification for limiting trademark protection for terms. This is likely because of the prevailing view equating function with design. But a functional approach to trademark protection does not have to be so limited. Such an approach serves as a better justification for limiting rights to a term that otherwise identifies and distinguishes goods and indicates source, but the exclusive use of which causes a significant non-reputation-related competitive disadvantage.

One of the fundamental disconnects with the primary significance test is that source identification may occur simply because the manufacturer is the first or only manufacturer in the marketplace with the product. Trademark protection in this case is said to impede competition by not allowing competitors to call their goods what the public has come to understand them to be called. A functional approach addresses this issue without having to ignore or dismiss evidence of secondary meaning. Thus, if a term "functions" as a trademark, it should be accorded trademark protection as long as it not "functional."

Courts already use an approach not unlike the traditional functionality test when attempting to categorize terms as "merely descriptive." In Zatarains, Inc. v. Oak

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286. See supra Part IV.B (discussing de facto secondary meaning).
287. The discussion that follows is intended not as a comprehensive treatment, but as an introduction to the use of a functional approach.

[T]rademark protection should depend upon whether the particular symbolic matter identifies the source of a product (i.e., whether the matter is "distinctive"), and upon whether protection of the particular symbol would accord the producer a practical monopoly and prevent effective competition by others (i.e., whether the matter is "functional"). Distinctiveness is a prerequisite for protection, and functionality restricts protection. Together, and applied with particularity, these inquiries into real-life effects—and not reliance upon generalized assumptions—should set the parameters of what protection trademark law should offer.

Id. (footnote omitted). See also Coverdale, supra note 200, at 886 (maintaining that "[a] showing that a trademark is commonly understood by consumers as the name of a genus should not...be dispositive...since such a showing does not necessarily indicate whether competitors and the public need access to the term").
Grove Smokehouse, Inc., for example, the court inquired, in terms of the protection available for descriptive terms, "'whether competitors would be likely to need the terms used in the trademark in describing their products.'" This approach for evaluating a descriptive mark parallels the functional inquiry into whether a feature is essential to the use or purpose of the product and whether the exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.

Other courts have danced around functionality, in terms of competitive need, in evaluating genericness. The court in A.J. Canfield, for example, explained:

If a producer introduces a product that differs from an established product class in a particular characteristic, and uses a common descriptive term of that characteristic as the name of the product, then the product should be considered its own genus. Whether the term that identifies the product is generic then depends on the competitors' need to use it.

The Second Circuit employed a similar approach in a case involving the trademark status of "Honey Brown" when it determined that the phrase was generic as applied to the defendant's product and, thus, the defendant was entitled to use the phrase to describe its ale. The court adopted the A.J. Canfield approach and concluded "that, when a producer creates a new product that differs from an established product class in a particular characteristic, the law of trademark will not grant the producer the exclusive right to label its product with words that are necessary to describe that new characteristic." In applying this rule, the court determined that "honey brown" was necessary to describe ales made with honey, and, thus, the defendant had a right to use the term, notwithstanding the fact that the plaintiff provided strong evidence of secondary meaning.

In a case involving the asserted trademark "You Have Mail," the United States Court of Appeals for the Fourth Circuit denied trademark protection for the phrase based on both functionality and a lack of distinctiveness. The court found the terms to be functioning within the "heartland of their ordinary meaning, and not distinctively," and explained that the phrase functionally announced to online

291. Id. (emphasis added) (quoting Union Carbide Corp. v. EverReady Inc., 531 F.2d 366, 379 (7th Cir. 1976). In Zatarains, one of the trademarks at issue, "Fish Fri," though descriptive for a batter mix for frying fish, was deemed protectable via secondary meaning. Id. at 794. The court dealt with the competitive need for the descriptive terms by focusing on the availability of descriptive fair use. See id. at 793. Competitors could use the terms descriptively to describe the fact that their products were used for frying fish. See id. In a purely functional approach to trademark protection, the terms would likely not be protectable because "fish" and "fry" (or "fri") are essential to identifying the use of the product.
293. Genesee Brewing Co., 124 F.3d at 140. "Honey Brown" may not be generic, however, for plaintiff's lagers because there was no recognized class of brown lagers, according to the beer experts. Id.
294. Id.
295. Id. at 149.
296. Id. at 143 n.4 (noting that survey evidence indicated that "81% of consumers associate 'Honey Brown' with beer from one source").
298. Id.
subscribers that they had mail in their electronic mailboxes.\(^{299}\) Notwithstanding evidence of secondary meaning, the court maintained that the trademark owner could not “exclude others from a functional use of the words.”\(^{300}\)

Moreover, scholars have suggested that common themes permeate genericism and functionality analyses, in particular the availability of alternatives. Jerre Swann, for example, explains:

Functionality, like genericism, is a pro-competitive limitation on “the public’s interest in [otherwise] not being misled,” but functionality does not dispense with any package or product design that has utility. Rather, the doctrine extends only to “the best, or at least one of a few superior designs for a de facto purpose.” Genericism likewise should not reach any genus-denoting term, but should be confined to core words to which all competitors may need access. If “effective competition is possible,” neither functionality nor genericism should preclude at least qualified protection for any symbol that generates, beyond a mere variety, an expectation of specific product characteristics—the attention-getting use of which by others might impair the efficient selection of goods.\(^{301}\)

Thus, it is not inconsistent with established trademark norms to move to a functional approach for evaluating the availability of trademark protection for terms. Instead of maintaining that genericness is determined by evaluating the primary significance of a term, when in practice evidence of primary significance is discarded if the court has predetermined that the term is generic, the analysis could be simplified into a straightforward determination that parallels the analysis used in a functionality determination:

1. Is the term essential to identifying the use, purpose, cost, or quality of the article; or
2. Would the exclusive use of the term by the trademark holder put competitors at a significant non-reputation-related disadvantage?\(^{302}\)

In other words, is the term one that competitors need in order to compete effectively?\(^{303}\) If not, the term is not functional. The determination that a term is functional, however, is not an abstract inquiry; it depends upon an evaluation of the term in the context of the goods at issue. The availability of alternative terms for the goods would be highly probative in this determination.\(^{304}\) For example, in the

\(^{299}\) Id. at 821–23.
\(^{300}\) Id. at 822. The court almost employed a purely functional approach but conflated the issues of functionality and primary significance, suggesting that if the court had considered the phrase to be distinctive, the functionality component would have been irrelevant. See id. at 821–23.
\(^{301}\) See Swann, supra note 263, at 649–50 (alteration in original) (footnotes omitted).
\(^{302}\) The author asserts that the first question could essentially be subsumed into the second. That is, if the term is essential to identifying the use, purpose, cost, or quality of the article, then the exclusive use of the term by the trademark holder would put competitors at a significant non-reputation-related disadvantage. But for purposes of conformity with traditional functionality doctrine, the author posits the questions separately.
\(^{303}\) Need in the sense that competitors cannot compete without the term, not in the sense that use of the term would make competition easier.
\(^{304}\) Cf. Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 148 n.13 (2d Cir. 1997) (“[T]he availability of alternative means of describing the product does not automatically preclude a finding that a trademark is generic. But the inverse proposition—that the lack of alternatives will render a mark generic—must be true, at least where a producer who has introduced a product that differs from an established class in one significant way attempts to trademark the only effective means of conveying that distinction.”) (citation omitted).
When a producer introduces a product that differs from an established product class in a significant, functional characteristic, and uses the common descriptive term of that characteristic as its name, that new product becomes its own genus, and the term denoting the genus becomes generic if there is no commonly used alternative that effectively communicates the same functional information.

In the context of diet sodas, how could competitors indicate that their soda tasted like chocolate fudge without using the phrase “chocolate fudge”? As such, “chocolate fudge” would be deemed “essential” to identifying the use, purpose, cost, or quality of the article, and trademark rights would be precluded.

In contrast, in the “Murphy bed” case, competitors used myriad alternative terms and did not need to use “Murphy bed” to identify the use, purpose, cost, or quality of their goods. In a functional approach, however, the mere availability of alternatives will not save an asserted trademark if the use of those alternatives would put competitors at a significant non-reputation-related disadvantage. Thus, one must also consider whether the exclusive use of “Murphy bed” would put competitors at a significant non-reputation-related disadvantage, notwithstanding the availability of alternative terms. Based on the number of competitors and different trademarks that they employed, it does not appear that competitors faced any significant non-reputation-related disadvantage by not being able to use the “Murphy bed” trademark.

One way to evaluate whether competitors would be so disadvantaged is to consider whether the alternatives are commercially reasonable. To be sure, a significant non-reputation-related disadvantage means that no reasonable alternatives exist for the competitor to identify her goods. If commercially
reasonable alternatives exist, however, the competitor should be required to shoulder the cost of developing her own distinctive brand. This serves to better equalize the parties in terms of competitive disadvantage because the trademark holder has already once shouldered that burden. Further, forcing competitors to use commercially reasonable alternatives, if they are available, advances the goal of increasing the lexicon because consumers are educated about different terms and brands for the same basic product.314

VI. CONCLUSION

A prior designation that a term is generic virtually forecloses any future analysis concerning that term’s ability to function as a trademark (for the goods at issue), notwithstanding the rare cases in which a trademark has been recaptured or a generic term has been captured from the public domain. This is due in large part to a discontinuity that exists between the tests for determining the primary significance of a term when it has been designated as merely descriptive versus when it has been designated as generic. Courts evaluate the primary significance of a term only after classifying it and then rely on de facto secondary meaning as a justification for barring protection for the term when the evidence of secondary meaning contradicts a prior generic classification.

An approach that investigates whether there are functional reasons not to permit exclusive rights for a term establishes a framework that does not depend upon a subjective evaluation of the genus of the goods at issue or upon a classification of the alleged trademark along the distinctiveness spectrum. When evidence of actual consumer source identification does not comport with a court’s determination that a term is generic, a functional approach solves the dilemma and does not require the court to resort to de facto secondary meaning to justify denying trademark rights.

A functional approach also harmonizes the present discontinuity between the primary significance tests for secondary meaning and genericness. If there are no functional reasons to prohibit exclusive rights, and the term otherwise functions as a trademark, then its designation as merely descriptive or generic becomes irrelevant. Such an approach better serves the goal of the Lanham Act that “a sound public policy requires that trade-marks should receive nationally the greatest protection that can be given them.”315


314. See FRANKEL, supra note 19, at 4 (noting that on average, a person learns ten new words a day—“the equivalent of a new word every two hours of waking life. And increasingly these words are brand names.”).