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## Abercrombie 2.0 - Can We Get There from Here? The Thoughts on 'Suggestive Fair Use'

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### Repository Citation

Joseph S. Miller, *Abercrombie 2.0 - Can We Get There from Here? The Thoughts on 'Suggestive Fair Use'*, 77 Ohio St. L.J. Furthermore 1 (2016),  
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## ***Abercrombie 2.0*—Can We Get There from Here? Thoughts on “Suggestive Fair Use”**

JOSEPH SCOTT MILLER\*

In response to Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367 (2015).

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There must be *some description in almost any suggestion* or the suggesting process will not take place. So what we have in any trade-mark case is a matter of judgment as to what side of the line the question mark falls upon.

– Q-Tips, Inc. v. Johnson & Johnson<sup>1</sup>

### I. INTRODUCTION

Professor Linford, unlike *Caesar’s* Antony, seeks not only to bury *Abercrombie*,<sup>2</sup> but to praise it,<sup>3</sup> at least in part. Using linguistic evidence, both historical and experimental, he would relocate a bobbled boundary—from the descriptive–suggestive transition to the suggestive–arbitrary transition—and thereby establish a reformed template for sorting word marks according to their source-signifying strength. The basic difference between acquired and inherent distinctiveness not only remains in Linford’s account, however; it draws new strength from insights about semantic change. Behold, *Abercrombie 2.0*! His

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<sup>1</sup> Q-Tips, Inc. v. Johnson & Johnson, 206 F.2d 144, 146 (3d Cir. 1953) (emphasis added) (concluding, at 146–47, that “Q-Tips” is a protectable mark for cotton-tipped swabs because “[t]he first [syllable], ‘Q,’ [is] purely arbitrary and fanciful; the second [is] closer to being descriptive but [is] still used, even in ordinary parlance, in an unusual way”); *see also* United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 F. 456, 461 (E.D.N.Y. 1915) (“Every good trade-mark is suggestive; once seen or heard, its association with the product is readily fixed in the mind. If there were no association of ideas between the two, it would require an independent effort of memory to recall the connection.”).

<sup>2</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976) (setting forth a hierarchy of distinctiveness for words claimed as trademarks eligible for protection against another’s confusingly similar use as a source signifier).

<sup>3</sup> *See* WILLIAM SHAKESPEARE, *JULIUS CAESAR* act 3, sc. 2 (S. P. Cerasano ed., W. W. Norton & Co. 2012) (1623) (“Antony: Friends, Romans, countrymen, lend me your ears. I come to bury Caesar, not to praise him.”).

recent article, which is both provocative and engaging, continues the reconstructive work Linford began in his critique of the conventional view that a generic word can never serve as a trademark, even if a substantial share of consumers have come to perceive it as a source signifier.<sup>4</sup>

Unlike Caesar, the *Abercrombie* hierarchy of distinctiveness for trademarks—approaching its fortieth birthday with citations in more than 850 cases and more than 580 law review pieces, now the dominant framework for classifying the conceptual strength of word marks<sup>5</sup>—looks more than stout enough to weather a pitched knife fight without a scratch.<sup>6</sup> Indeed, Linford prudently “acknowledge[s] the difficulty of implementing the [*Abercrombie*-reforming] proposals outlined” in his new article.<sup>7</sup> He describes various strategies, both legislative and judicial, for moving suggestive marks out of the “inherently distinctive” category to achieve *Abercrombie 2.0*.<sup>8</sup> Though I am not a professional linguist, and thus cannot judge the completeness of his discussion from that perspective, I find Linford’s account of the linguistic evidence, and its normative consequences for trademark law, cogent. At the very least, it “calls into question the current protection of a suggestive mark on its first use in commerce.”<sup>9</sup> His account prompts me to further explore matters of *doctrinal* shift, the form of change more familiar to those with legal training.

As I explain below, I am skeptical that trademark law will recategorize suggestive marks to require proof of acquired distinctiveness as a condition of protection, in the manner we now treat descriptive marks. In short, to quote another son of Maine, “you can’t get there from here.”<sup>10</sup> Perhaps, however, we *can* reach a nearby doctrinal destination, involving not the way one proves that a suggestive mark is distinctive (i.e., a source signifier in a given context), but the way one proves that the accused use of a word is illicitly confusing. In other words, we reconsider not the right’s validity, but its scope.<sup>11</sup> Yet, like the

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<sup>4</sup> See generally Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J.L. & TECH. 110 (2015).

<sup>5</sup> See Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1040 (2009) (“The foundation of the modern treatment of word marks is the now-settled classification system set forth in *Abercrombie* . . . [which] has become the dominant framework for evaluating the protectability of word marks.”).

<sup>6</sup> In fairness to Caesar, he never stood a chance, encircled as he was by the ring of dagger-thrusting assassins who had carefully plotted their attack. See BARRY STRAUSS, *THE DEATH OF CAESAR* 133–35 (2015) (describing the attack).

<sup>7</sup> Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367, 1420 (2015) [hereinafter Linford, *False Dichotomy*].

<sup>8</sup> *Id.* at 1415–20.

<sup>9</sup> *Id.* at 1420.

<sup>10</sup> ROBERT BRYAN & MARSHALL DODGE, *Which Way to Millinocket?, on BERT & I . . . AND OTHER STORIES FROM DOWN EAST* (Bert & I, Inc. 1958), <https://youtu.be/p6V2Ew1M0sE> [<https://perma.cc/328P-HZJE>].

<sup>11</sup> This has become a standard move in intellectual property analysis, moving among (or trading off between) the three major groups of policy levers we have: validity, scope, and

distinctiveness-focused change Professor Linford urges, the doctrinal change I explore takes as proved that “[a] suggestive mark is less likely to be perceived as a source signifier from the consumer’s first exposure, because the metaphoric connection between mark and product has a stronger effect than the law currently recognizes.”<sup>12</sup> One could capture the change I consider with the phrase *suggestive fair use*.

## II. LINFORD’S CRITIQUE OF SUGGESTIVE-MARK STRENGTH

As Professor Linford recounts, suggestive marks emerged from the conceptual space between descriptive and arbitrary marks: “Courts were split on what to do with terms that were not clearly arbitrary nor exactly descriptive.”<sup>13</sup> The uncertainty was consequential, given that, under the federal trademark regime of the time, arbitrary and fanciful marks could be registered and sued upon, and descriptive terms were left to a different body of law, unfair competition, with a different conceptual structure.<sup>14</sup> “When faced with marks that were on the borderline between the descriptive and arbitrary categories, the courts strained to uphold registrability by using the term ‘suggestive.’”<sup>15</sup> In effect, they developed the category to avoid forfeitures in cases where plaintiffs seemed to have fairness on their side, in part, one imagines, based on the lack of a procompetitive explanation for the accused’s choice of words for its own goods or services.<sup>16</sup>

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remedies. The *locus classicus* is Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575 (2003).

<sup>12</sup>Linford, *False Dichotomy*, *supra* note 7, at 1413; *see also id.* at 1409 (“[T]rademark law mistakenly exaggerates the difference between suggestive and descriptive marks. Semantic shift research indicates that a metaphoric polyseme like a suggestive trademark enhances the connection between mark and product through processing advantages similar to those provided by a metonymic polyseme like a descriptive mark.”).

<sup>13</sup>*Id.* at 1408.

<sup>14</sup>*See* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:63 (4th ed. 2008) (explaining “[w]hy the ‘suggestive’ category arose”). For a description of the conventional contrast from that era, *see* Milton Handler & Charles Pickett, *Trade-Marks and Trade Names—An Analysis and Synthesis: I*, 30 COLUM. L. REV. 168, 168–70 (1930).

<sup>15</sup>MCCARTHY, *supra* note 14, § 11:63. Judge Friendly described this history in *Abercrombie* itself, observing that “[t]he category of ‘suggestive’ marks was spawned by the felt need to accord protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other—a need that was particularly acute because of the bar in the Trademark Act of 1905 . . . on the registration of merely descriptive marks regardless of proof of secondary meaning.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

<sup>16</sup>*See* Carol M. Rose, *Crystals and Mud in Property Law*, 40 STAN. L. REV. 577, 601 (1988) (“Simple boundaries and simple remedies, it turns out, may yield radically unexpected results, and may destroy the confidence we need for trade, rather than fostering it. It is forfeiture, the prospect of dramatic or disproportionate loss, that brings this home; and forfeiture—and the detailed ways in which it might have been avoided—can only be

Suggestive words, straddling descriptive and arbitrary words as they do, occupy an inherently unstable space in trademark. One way to depict the instability, inspired by Linford’s analysis,<sup>17</sup> is to modify Table 2 in the Linford piece<sup>18</sup> to juxtapose the strength of the initial semantic connection between word and good on one axis, and the language depletion risk on the other. In this two-by-two arrangement, shown below, it is plain both that arbitrary and fanciful words belong in the upper left-hand box, and that descriptive and generic words belong in the lower right-hand box. Suggestive words, by contrast, are hard to place: they have a stronger semantic relationship to the target good than do arbitrary or fanciful words, which points to the upper right box; but, by virtue of that very fact, they also have a larger language depletion risk than do arbitrary or fanciful words, which points to the lower left box. (One can generate the instability from the other end just as readily: when compared to descriptive or generic words, suggestive words have both a weaker semantic relationship to the target good (pointing to the lower left-hand box) and, by virtue of that very fact, a smaller language depletion risk (pointing to the upper right-hand box).) Neither choice captures the full story, and thus neither is entirely satisfying.

Table 1: *Where Do Suggestive Words Belong?*

Language Depletion Risk	Initial Semantic Relationship to Target Good	
	Weaker	Stronger
Smaller	Arbitrary Words Fanciful Words	<i>Suggestive Words?</i>
Larger	<i>Suggestive Words?</i>	Descriptive Words Generic Words

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known to us ex post.”); *see also id.* at 597 (“A strong element of moral judgment runs through the cases in which mud supersedes crystal. These cases are often rife with human failings—sloth and forgetfulness on the one hand, greed and self-dealing on the other. These vices put pressure on our efforts to elaborate clear and distinct property specifications, and make judges and others second guess the deals that call for a pound of flesh.”). An illustrative case is *N. K. Fairbank Co. v. Central Lard Co.*, 64 F. 133 (C.C.S.D.N.Y. 1894), in which the court held that the defendant’s use of “Cottoleo” infringed the plaintiff’s mark “Cottolene,” used for a lard substitute comprising cotton-seed oil and beef fat. Given the defendant’s sharp practice, the court protected the mark notwithstanding its somewhat descriptive character: “It seems clear that ‘Cottolene’ is a proper and valid trade-mark. *Although it may suggest cotton-seed oil, it is not sufficiently descriptive to render it invalid* as a trade-mark under the recent decisions. The rule that names suggestive of the nature or composition of articles may be valid trade-marks if not too accurately descriptive of their character or quality has been applied in [several cases].” *Id.* at 134 (emphasis added).

<sup>17</sup> *See* Linford, *False Dichotomy*, *supra* note 7, at 1414 (observing that “the effectiveness of the metaphoric connection between suggestive mark and product may mean that suggestive marks benefit from some of the anti-competitive advantages that caution against automatic protection of descriptive trademarks”).

<sup>18</sup> *See id.* at 1383.

Professor Linford's critique of the current *Abercrombie* framework, which he firmly grounds in his elaboration of linguistics evidence about semantic change, or "shift," is, in a sense, an argument about the importance of putting suggestive words in the right-hand column, alongside descriptive and generic words. The legal change he urges would conform suggestive marks to descriptive marks, treating both as requiring proof of acquired distinctiveness before trademark protection attaches. (My alternative, by focusing on scope rather than validity, is, in a sense, an argument about the importance of putting suggestive words in the bottom row. In both accounts, however, trademark would treat suggestive more like descriptive marks.)

The key moves, at the core of his account, are these: to create a mark is to change semantic meaning, either by adding a new source-signifying meaning to an existing word or by coining an entirely new word to signify source. Evidence of etymological change and cognitive reception of new word meanings is therefore relevant to understanding trademark creation.<sup>19</sup> When we consider that evidence, we learn that, in contrast to fanciful marks (monosemy) and arbitrary marks (homonymy), both suggestive marks (metaphoric polysemy) and descriptive marks (metonymic polysemy) take cognitive advantage of existing meaning by embracing and extending it.<sup>20</sup> In short, "a suggestive mark, like a descriptive mark, trades on the relationship between existing product-related and new source-signifying meanings."<sup>21</sup> Trademark law fails to recognize that consumers adapt to suggestive marks in a manner highly analogous to the way they adapt to descriptive marks, and thus it improperly groups suggestive marks with arbitrary and fanciful marks as inherently distinctive source signifiers upon first use.<sup>22</sup> "Suggestive marks are not as naturally distinctive as the law presumes. . . . Thus, a suggestive mark should not be treated as inherently distinctive."<sup>23</sup>

How, then, does this correction to doctrine come about? Linford suggests a number of strategies, all of which focus directly on recategorizing suggestive words to alter the showing needed to earn valid trademark rights in them. First, he concludes that "[r]edrawing the suggestive–descriptive line would require a

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<sup>19</sup> *Id.* at 1393.

<sup>20</sup> *Id.* at 1394–1401.

<sup>21</sup> *Id.* at 1401.

<sup>22</sup> *Id.* at 1402–03, 1412–14; *see, e.g., id.* at 1414 ("The diachronic and cognitive research indicates that the suggestive mark is connected to the product offered through mechanisms that enhance product salience more than source significance. The law may thus err in presuming that a suggestive mark is inherently distinctive. If the economic search cost account favors marks that are inherently distinctive with relatively automatic protection, the law should not extend that favor to suggestive marks.").

<sup>23</sup> *Id.* at 1415; *see also id.* at 1421 ("The semantic shift literature provides evidence that arbitrary marks likely stand out as source-signifying from their first use in commerce. But the same is not true for suggestive marks. Suggestive and descriptive marks are not identical, but their similarities outweigh their differences, and those differences do not justify treating suggestive terms as inherently distinctive.").

statutory change,”<sup>24</sup> because the Lanham Act currently offers registered status to, *inter alia*, any word that is not “merely descriptive.”<sup>25</sup> As he explains, even if we agree that the law should not treat suggestive words as inherently distinctive, “courts and trademark examiners would balk at defining [a suggestive word] as ‘merely descriptive.’”<sup>26</sup> Even though *Abercrombie*’s hierarchy of distinctiveness is judge-made law, and thus judges could—purely as a matter of power, not prudence—unmake it as well,<sup>27</sup> I agree with Linford that, at a stroke, to move suggestive words entirely out of the group of inherently distinctive terms, and into the group requiring proof of acquired distinctiveness, is a job for Congress. He also suggests alternative, less dramatic legislative changes, such as “set[ting] a lower bar for suggestive marks to acquire distinctiveness than [for] descriptive marks” to do so<sup>28</sup>; or combining the distinctiveness recategorization with an offsetting change to the infringement inquiry, such that “the lack of *direct* connection between mark and product could serve as a thumb on the scale in favor of commercial strength grounded in conceptual strength.”<sup>29</sup>

These legislative changes to the Lanham Act are plainly possible, as a formal matter, especially if they were to be applied purely prospectively (removing even the possibility of a takings claim).<sup>30</sup> But are they *likely*? The answer turns not only on whether there is a strong, proper evidentiary basis to embody the policy change in an amendment to the statute. Let us assume that exists here. There is also the question of political economy. Can we envision a coalition of interests that would coalesce to bring about the legislative change(s) Linford describes, as well as an absence of sufficiently robust opposition to prevent the change(s)? I am no more a professional political scientist than I am a professional linguist. I cannot help but speculate, though, that the repeat

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<sup>24</sup> *Id.* at 1416.

<sup>25</sup> 15 U.S.C. § 1052(e)(1) (2012) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists of a mark which . . . when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . .”). One can sue for infringement of a registered mark. *See* 15 U.S.C. § 1114(1). Moreover, if one sues to enforce an *unregistered* mark, *see* 15 U.S.C. § 1125(a), its distinctiveness—its validity *as a mark*—is judged by the same standards applied to registrability. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210–13 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–69 (1992).

<sup>26</sup> Linford, *False Dichotomy*, *supra* note 7, at 1416.

<sup>27</sup> On the broader question of the nature and scope of the judicial role in trademark law, Professor Michael Grynberg’s work is indispensable. *See generally* Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283 (2011); Michael Grynberg, *Things Are Worse than We Think: Trademark Defenses in a ‘Formalist’ Age*, 24 BERKELEY TECH. L.J. 897 (2009).

<sup>28</sup> Linford, *False Dichotomy*, *supra* note 7, at 1417.

<sup>29</sup> *Id.* at 1417 (emphasis added).

<sup>30</sup> *See* Joseph Scott Miller, *Error Costs & IP Law*, 2014 U. ILL. L. REV. 175, 183–84 (discussing the Takings Clause question that may pertain to retroactive changes to intellectual-property interests).

players who now make such effective use of the trademark system as registrants and litigants—to say nothing of the many lawyers who represent them before the Trademark Office and the courts—would not sit idly by as a legislator intentionally and explicitly sought to make a commercially vital category of word marks<sup>31</sup> harder, more costly, to validly obtain. Professor Linford, as is the norm for law professors (including me), does not pair his normative recommendation for legislative change to an interest-group or other political-economy account for actually bringing about that legislative change. This is not something law professors typically do (to the frustration of some, I am sure); and thus I emphasize that I do not mean, in pointing it out, to criticize his piece. In any event, I cannot provide a scenario for actually enacting the legislative change for which Linford’s work would provide the evidentiary and normative foundations.<sup>32</sup>

What about the courts? There, again, I think Linford has it right. Even if we put aside the obstacle the text of the Lanham Act puts in the way of simple judicial abrogation of the *Abercrombie* hierarchy, decades of judicial practice treating suggestive marks as inherently distinctive create a habit that may be hard to resist. Linford opines—quite reasonably, I think—that it is “possible that courts would resist even a modest change to the status quo vis-a-vis suggestive marks,” even in the event that “Congress embraced one of the statutory revisions outlined” in his article.<sup>33</sup> Without that legislative push, it is that much more challenging for parties to overcome the force of judicial habit when determining the distinctiveness of suggestive marks under *Abercrombie*: “The law has treated suggestive marks as inherently distinctive for so long that the contours of a direct inquiry into [a mark’s validity] might continue to follow that predisposition.”<sup>34</sup>

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<sup>31</sup> See *Continental Scale Corp. v. Weight Watchers Int’l*, 517 F.2d 1378, 1380 (C.C.P.A. 1975) (“[A]s we have often pointed out and as is very well understood, suggestive words may be and frequently are very good trademarks.”); *Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (“It is well settled in adjudicated cases that a valid trade-mark may be highly suggestive (in our opinion oftentimes the best ones are), without being offensively descriptive.”); MCCARTHY, *supra* note 14, § 11:65 (“If a quantitative survey of all marks were taken, it would probably show that a substantial part, if not a majority, of all marks are suggestive of the product to some extent . . .”).

<sup>32</sup> My failure of imagination is equally applicable to national law and state law. Though trademark laws, including statutorily created registration systems, function in the states, *see generally* Mark P. McKenna, *Teaching Trademark Theory Through the Lens of Distinctiveness*, 52 ST. LOUIS U. L.J. 843, 844–46 (2008) (comparing the federal and state trademark systems), the same political-economy gap would confront a state system that was otherwise willing to engage in a bit of Brandeisian “laboratory of democracy” policy variation. *See New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting from the invalidation of an Oklahoma state ice-sales licensing statute).

<sup>33</sup> Linford, *False Dichotomy*, *supra* note 7, at 1419.

<sup>34</sup> *Id.*

Are we fated, then, to fail to adapt the law to the facts about suggestive words and semantic change that Professor Linford has ably marshalled? Perhaps we are, if we limit ourselves to adaptations that directly tackle the validity aspect of suggestive marks. But there is no reason to limit ourselves to that aspect, given that we can cash out the greater-than-recognized similarity to descriptive marks by focusing instead on doctrines of scope.

Step back and reconsider the competitive context within which we ask these questions about firms' varied uses of words (and other materials) to communicate with consumers. Giving one firm exclusive use of a term as a mark, merely on the basis of the firm's first use of it that way in commerce and *without* evidence that consumers actually perceive it as a source signifier, does not cause any competitive concern *unless* other firms use, or will surely want to use, that term to communicate about their own offerings but *not* using it as a source signifier.<sup>35</sup> But the linguistic evidence Professor Linford reviews gives us a strong basis—if any more were needed—to expect that sellers may well use suggestive language, as well as descriptive language, to highlight to customers salient aspects of their goods and services. There is thus a competitive concern to address.<sup>36</sup>

In the context of descriptive marks, we address that competitive concern in *two* ways. On the validity side, one cannot claim the descriptive term as a mark without proof of acquired distinctiveness among consumers,<sup>37</sup> whether direct (i.e., survey evidence) or circumstantial (i.e., duration and volume of sales, advertising expenditures, and the like).<sup>38</sup> It is on the validity question that Professor Linford focuses. On the scope side, which we can also consider, a descriptive mark cannot be used to prevent another party from using the same term in its descriptive sense, and not as a source signifier.<sup>39</sup> This is known both as “classic fair use” and “descriptive fair use.”<sup>40</sup> The Lanham Act codifies the defense for registered marks,<sup>41</sup> and courts have long applied it more generally

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<sup>35</sup> See generally WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 175, 187–97 (2003) (discussing the consequences for competition of protecting different word types as trademarks).

<sup>36</sup> Cf. *Blau Plumbing, Inc. v. S-O-S Fix-It, Inc.*, 781 F.2d 604, 609 (7th Cir. 1986) (Posner, J.) (“To allow a firm to use as a trademark a generic word, or a descriptive word still understood by the consuming public to describe, would make it difficult for competitors to market their own brands of the same product.”).

<sup>37</sup> See MCCARTHY, *supra* note 14, § 11:15.

<sup>38</sup> See *id.* § 15:30.

<sup>39</sup> See *id.* §§ 11:15, :45.

<sup>40</sup> *Id.* § 11:45.

<sup>41</sup> 15 U.S.C. § 1115(b)(4) (2012) (providing that “the right to use the registered mark . . . shall be subject to the following defenses or defects: . . . [t]hat the use of the . . . term . . . charged to be an infringement is a use, otherwise than as a mark, . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party”).

in federal actions to enforce unregistered marks and to common law claims.<sup>42</sup> A frequently cited authority for the descriptive-fair-use principle is *William R. Warner & Co. v. Eli Lilly & Co.*,<sup>43</sup> from the pre-*Erie* era. In *Warner*, the Supreme Court rejected the contention that plaintiff Lilly could use the mark “Coco-Quinine,” which the Court viewed as descriptive, to prevent competitor Warner’s use of the (equally descriptive) name “Quin-Coco.”<sup>44</sup> As the Court put it, “[t]he use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product.”<sup>45</sup>

Now reflect on the full range of application for this scope-limiting principle. As *Abercrombie* put it, “[w]hen a plaintiff has chosen a mark with some descriptive qualities, he cannot altogether exclude some kinds of competing uses.”<sup>46</sup> Suggestive words, too, have descriptive qualities. That is the linguistic evidence on which Linford’s critique turns: “a metaphoric polyseme like a suggestive trademark enhances the connection between mark and product through processing advantages similar to those provided by a metonymic polyseme like a descriptive mark.”<sup>47</sup> In other words, “[l]ike a descriptive mark, a suggestive mark is derived from a feature of the product sold.”<sup>48</sup> We should thus expect to see cases in which a defendant argues that its use of another’s suggestive mark is a descriptive fair use, as well as cases where a descriptive fair use is, frankly, of a more suggestive variety. Linford’s work provides a new, cogent basis for crediting those arguments, as well as for judges’ embracing them. And embrace them judges have.

### III. SUGGESTIVE FAIR USE

To successfully make out the affirmative defense of classic fair use, an accused infringer must prove “(1) the use of the mark is not a trademark use; (2)

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<sup>42</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 cmt. a (AM. LAW INST. 1995); MCCARTHY, *supra* note 14, § 11:49.

<sup>43</sup> *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924).

<sup>44</sup> *Id.* at 528.

<sup>45</sup> *Id.*; *see also* *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (“When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo.”); *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 327 (1871) (“True it may be that the use by a second producer, in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product, but if it is just as true in its application to his goods as it is to those of another who first applied it, and who therefore claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth.”).

<sup>46</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12 (2d Cir. 1976) (emphasis added).

<sup>47</sup> Linford, *False Dichotomy*, *supra* note 7, at 1409.

<sup>48</sup> *Id.* at 1413.

the use is fair and in good faith; and (3) the use is only descriptive.”<sup>49</sup> Courts have upheld the defense in contexts where the plaintiff’s mark is suggestive (thereby limiting the scope of such marks), and where the defendant’s use is arguably more suggestive than descriptive (thereby recognizing the way in which suggestion is semantically akin to description). Linford’s work indicates—to me at any rate—that these decisions accord with the linguistic evidence about semantic change and the cognitive similarity between metaphoric and metonymic extension, and thus between suggestive and descriptive reference. Indeed, in light of Linford’s account, parties could strengthen these green shoots in the trademark jurisprudence with more overt reliance on linguistics evidence.

Consider, first, the question whether a defendant can argue classic fair use in a case where the plaintiff’s mark is other than descriptive. The codified defense, as to federally registered marks, does not specify anything about the asserted mark’s grade of distinctiveness. Rather, it centers on the nature of the *defendant’s* use, requiring that it be (1) “otherwise than as a mark,” (2) “fair[] and in good faith,” and (3) “to describe the [accused’s] goods or services.”<sup>50</sup> From the perspective of both competitive concern and semantic operation, suggestive marks—like descriptive marks—should be limited by classic fair use. The U.S. Court of Appeals for the Third Circuit held to the contrary in 1991, concluding that categorizing a plaintiff’s mark as descriptive “was necessary before deciding whether defendants could avail themselves of the fair use defense.”<sup>51</sup> Other Courts of Appeals, however, have upheld the classic fair use defense against suggestive and other nondescriptive marks. For example, in upholding the denial of an injunction to the candy maker asserting the mark “*Sweet TARTS*” against Ocean Spray’s use of the phrase “sweet-tart” to describe its sweetened cranberry drinks, the Seventh Circuit observed that “[u]nder the Lanham Act it is irrelevant whether the *Sweet TARTS* mark is itself descriptive, and the district court did not need to pursue the question.”<sup>52</sup> Similarly, in

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<sup>49</sup> *Webceleb, Inc. v. Procter & Gamble Co.*, 554 Fed. Appx. 606, 607 (9th Cir. 2014). For an engaging analysis of the descriptive fair use defense, contextualized in a broader account of trademark fair use, see William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 82–88 (2008).

<sup>50</sup> 15 U.S.C. § 1115(b)(4) (2012).

<sup>51</sup> *Inst. for Sci. Info., Inc. v. Gordon & Breach, Sci. Publishers, Inc.*, 931 F.2d 1002, 1010 (3d Cir. 1991).

<sup>52</sup> *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1058 (7th Cir. 1995). In a more recent Seventh Circuit case, *Top Tobacco, L.P. v. North Atlantic Operating Co.*, 509 F.3d 380 (7th Cir. 2007), the court did not analyze the question in terms of descriptive fair use, but it easily could have done so. The plaintiff used “Top” as a mark for tobacco with a picture of a toy spinning top—in other words, as an arbitrary mark. *Id.* at 381. The defendant used “Top” as part of the phrase “Fresh-Top Canister”—in other words, as a description of its packaging. *Id.* at 381–82. Dispensing with the traditional multi-factor analysis of the central question in trademark infringement, likelihood of consumer confusion as to source *vel non*, the court of appeals simply held that consumer confusion was inherently incredible on the facts presented: “What Top Tobacco wants us to do is to ignore the pictures

overturning a district court's rejection of the fair use defense, the Second Circuit concluded that "it should make no difference whether the plaintiff's mark is to be classed on the descriptive tier of the trademark ladder."<sup>53</sup> The Second, Seventh, and Ninth<sup>54</sup> Circuits have the better side of this split than the Third Circuit, based on Linford's evidence and analysis. Happily, the statute permits what linguistics commends.

Consider, second, the more challenging question whether a defendant can argue classic fair use in a case where that use is not tightly descriptive, but rather trades on a looser semantic connection to the defendant's offering. In other words, posit a use that, were the defendant claiming the term as a source-signifier, it might with considerable merit argue that the use was suggestive (and thus inherently distinctive) because it takes some imaginative thinking to connect to the good or service.<sup>55</sup> Again, the codified defense requires, in relevant part, that the purportedly fair use "describe the [accused's] goods or services,"<sup>56</sup> but the statute does not prescribe, further, how tight or loose that description must be to qualify. The linguistic evidence that Professor Linford has canvassed should help us appreciate that there will be a host of difficult-to-categorize uses. The difficulty of sorting descriptive from suggestive marks at the validity stage, which Linford also reviews,<sup>57</sup> should do the same. Perhaps it is no surprise, then, that, as with the prior question, the Courts of Appeals have reached somewhat different answers.

The Second Circuit has, in a series of cases, accepted looser, more figurative descriptions as fair uses. In *Car-Freshner v. S.C. Johnson*, the owner of the pine-

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and the lack of any reason to believe that anyone ever has been befuddled. Like other courts, this circuit has articulated a multi-factor approach to assessing the probability of confusion. . . . But it's unnecessary to belabor the point. A list of factors designed as *proxies* for the likelihood of confusion can't supersede the statutory inquiry. If we know for sure that consumers are not confused about a product's origin, there is no need to consult even a single proxy." *Id.* at 383. The court could have reached the same holding—i.e., no liability—by treating the defendant's label information as descriptive fair use.

<sup>53</sup> *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995); *see also id.* ("Regardless whether the protected mark is descriptive, suggestive, arbitrary, or fanciful as used in connection with the product or service covered by the mark, the public's right to use descriptive words or images in good faith in their ordinary descriptive sense must prevail over the exclusivity claims of the trademark owner.").

<sup>54</sup> *See Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1039 (9th Cir. 2010) (concluding that "how [plaintiff] Fortune's DELICIOUS mark is categorized as a matter of conceptual strength has no bearing on whether Victoria's Secret is entitled to the fair use defense").

<sup>55</sup> *See MCCARTHY*, *supra* note 14, § 11:67 ("The most popular test with the courts is the 'imagination' test. The more imagination that is required on the customer's part to get some direct description of the product from the term, the more likely the term is suggestive, not descriptive. Thus, while a descriptive term directly and clearly conveys information about the ingredients, qualities or characteristics of the product or service, the 'suggestive' term only indirectly suggests these things.").

<sup>56</sup> 15 U.S.C. § 1115(b)(4) (2012).

<sup>57</sup> *See Linford, False Dichotomy*, *supra* note 7, at 1370, 1386.

tree shape as a mark for cardboard air fresheners for cars alleged that S.C. Johnson infringed its mark by using a pine-tree shaped plastic housing for its Christmas season “Plug-Ins” air freshener with pine scent.<sup>58</sup> The Court of Appeals overturned the district court’s rejection of Johnson’s descriptive fair use defense. Along the way, the court held that the pine-tree shape described not only the scent of the product (which seems quite direct), but because “a Christmas tree is traditionally a pine tree, the use of the pine-tree shape refers to the Christmas season, during which Johnson sells this item.”<sup>59</sup> That strikes me as a looser connection. Two years later, in a case about a promotional campaign for lipstick using the phrase “Seal it with a Kiss!!”—which the court deemed to be a descriptive fair use, rather than an infringement of the mark “SEALED WITH A KISS” for lip gloss—the Second Circuit discussed descriptive use and *Car-Freshner* this way:

Though the terms of the Act recognize the fair use defense where the name or term is used “to describe the goods,” that phrase has not been narrowly confined to words that describe a characteristic of the goods, such as size or quality. Instead, we have recognized that the phrase permits use of words or images that are used, in Judge Leval’s helpful expression [in *Car-Freshner*], in their “descriptive sense.” In *Car-Freshner*, though the image of a pine-tree shape communicated an aspect of the product, its pine scent, use of the image was also approved because the image referred to the Christmas season in which the product was sold. This description (by the suggestive use of the image) of the period in which the product was sold was deemed to be a “description of the goods” within the meaning of the fair use defense.<sup>60</sup>

Look at that phrase again: description “by the suggestive use of the image.” Description by suggestion is still description, the court concludes. And, semantically, so it is. The promotional phrase “Seal it With a Kiss!!” was loosely descriptive too: “Though the words . . . do not describe a characteristic of the defendants’ product, they surely are used in their ‘descriptive sense’—to describe an action that the sellers hope consumers will take, using their product.”<sup>61</sup> In the Second Circuit, at least, a “[d]efendant’s fair use . . . can fit within the statutory defense if its use is descriptive in a broader sense.”<sup>62</sup> The linguistics evidence supports this view.

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<sup>58</sup> *Car-Freshner Corp.*, 70 F.3d at 268.

<sup>59</sup> *Id.* at 270.

<sup>60</sup> *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997) (citations omitted).

<sup>61</sup> *Id.*

<sup>62</sup> MCCARTHY, *supra* note 14, § 11:49; *see also* Bell v. Harley Davidson Motor Co., 539 F. Supp. 2d 1249, 1258 (S.D. Cal. 2008) (“Although Bell protests that such a use does not describe a specific characteristic of Harley’s products or goods, courts do not interpret the Lanham Act’s fair use language so narrowly. To the contrary, courts have applied the

The Ninth Circuit, more recently, suggested a decidedly narrower view of descriptiveness in the fair use defense. In *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Management*, the plaintiff asserted its mark for footwear, “Delicious,” against Victoria’s Secret’s use of the same word printed on promotional tank-top shirts used in a campaign to launch a new cosmetics line.<sup>63</sup> The appellate court’s central focus in the case is the improvidence of the district court’s summary judgment ruling; it concluded that several genuine issues of material fact, both about the distinctiveness of the plaintiff’s mark and the nature of the defendant’s use, required trial. In analyzing the question of descriptive fair use, however, the Ninth Circuit made clear that it takes a narrower view than the Second Circuit’s on what counts as *descriptive* use. First, pointing to a supporting passage in the *Restatement of Unfair Competition*,<sup>64</sup> the court concluded that “the scope of the fair use defense *varies with* what we will call *the descriptive purity* of the defendant’s use and whether there are other words available to do the describing.”<sup>65</sup> The inverse relationship the court posits between “descriptive purity” and fairness of the use is quite unlike the Second Circuit’s embrace of description by suggestion. Then, by way of framing the fact question on the fairness of use that remained for the jury on remand, the court emphasized that “as a defendant’s use of a term becomes less and less purely descriptive, its chances of prevailing on the fair use defense become less and less likely.”<sup>66</sup> Again, this close calibration of descriptiveness to fairness is hard to square with express acceptance of description by suggestion. And though it hews closer to traditional doctrine, by equating description for distinctiveness with description for fairness, the Ninth Circuit’s approach draws little, if any, support from Professor Linford’s linguistics evidence and analysis.

In short, trademark law in the regional circuits already embodies—albeit within two circuit splits—constraints on the scope of suggestive marks of just

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fair use doctrine in situations where the defendant’s use of the trademarked phrase described a feeling inherently associated with the phrase or typically experienced by the consumer upon using defendant’s product. Applied to these facts, Harley-Davidson descriptively used ‘Ride Hard’ to capture the consumer’s intended reaction of vigor and energy to Harley-Davidson products and merchandise.” (citations omitted)).

<sup>63</sup> *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1029 (9th Cir. 2010).

<sup>64</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 cmt. c (AM. LAW INST. 1995) (“The scope of use permitted under the fair use defense should reflect the degree to which the descriptive meaning of the term is relevant to the goods, services, or business of the subsequent user. If the original meaning of the term is not in fact descriptive of the attributes of the user’s goods, services, or business, the defense is not applicable. If the term is only marginally descriptive or descriptive of only a relatively unimportant characteristic, the scope of fair use will be narrower than for terms that directly describe aspects or features of the goods or services that are of importance to prospective purchasers. Similarly, the absence of alternative terms capable of adequately describing the pertinent characteristic is also relevant in assessing the commercial justification for the use and hence the scope of permissible fair use.”).

<sup>65</sup> *Fortune Dynamic*, 618 F.3d at 1041 (emphasis added).

<sup>66</sup> *Id.* at 1042.

the sort that Linford's work could be taken to recommend. Moreover, if parties continue to urge courts to take a capacious view of what counts as descriptive use in the classic fair use context, and if court embrace that view, the cases may develop to the point where Congress could clarify and cement that view by codifying a new, suggestive variety of classic fair use. True to form, law professor that I am, I do not have a political-economy account of the legislative event. I simply note that, much as the current Lanham Act codifies a common-law descriptive fair use defense, Congress could amend the Lanham Act to embrace a suggestive fair use defense in parallel terms. It could, for example, shield from liability a use, otherwise than as a mark, of a term that is suggestive of, and used fairly and in good faith only to suggest, a commercially salient quality of the goods or services of the accused.<sup>67</sup>

To do so would, to be sure, leave intact the *Abercrombie* hierarchy of distinctiveness that Professor Linford has cogently critiqued. But perhaps a robust suggestive fair use defense can blunt the force of misclassifying suggestive marks as inherently distinctive on first use. And especially in its judicial variant, which needs little more than continued development under pressure from parties who show with care the descriptive sense in an otherwise suggestive phrase, it is easier to see how to get there from here.

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<sup>67</sup> Cf. 15 U.S.C. § 1115(b)(4) (2012).