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Imaginative leaps in trademark law

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Abstract

In American courts, linguists are often called upon to testify about whether trademarks in litigation are best classified lexicosemantically as ‘suggestive’ or ‘descriptive’ (only the former category is afforded automatic legal protection). Legally, the central issue is **imaginativeness**: suggestive terms differ from merely descriptive ones in that they require a significant ‘cognitive’ or ‘imaginative’ ‘leap’ to connect the name with the referent. But **imaginativeness** is a seldom-addressed concept in linguistic science, and has been little discussed in the forensic linguistic literature. I suggest that precision in formulating the forensic linguistic concept of ‘imaginativeness’ lies in viewing putatively suggestive marks within the framework of linguistic notions of figurative language and phrasal anomalousness, drawing also upon cognitive linguistic concepts of ‘semantic leaps.’

Keywords: DESCRIPTIVE TRADEMARKS; LEXICOSEMANTICS; SEMANTIC LEAPS;
SUGGESTIVE MARKERS; TRADEMARKS

In determining intellectual property rights, trademarks are judged according to their ‘strength’, that is, where they can best be placed on a continuum of lexicosemantic categories from weakest to strongest. There are two categories of ‘weak’ marks:

generic, that is, the name of the kind of thing rather than the thing itself; for example, *package delivery service, bread*

descriptive, that is, terms that allude to some intrinsic and/or laudatory quality of the product or service; for example, *speedy delivery service, tasty bread*. The addition of geographical terms, general terms of praise (known as LAUDATORY terms), and words that name basic ingredients may sometimes be adjudged to rescue a descriptive mark from being generic; however, the law views such terms as likely to be merely descriptive themselves.

There are three categories of ‘strong’ marks:

suggestive, that is, terms with only an oblique semantic or pragmatic connection with the product or service; for example, *Federal Express, Panera Bread*

arbitrary, that is, terms with no apparent semantic or pragmatic connection with the product or service; for example, *Rainbow Delivery Service, Sunbeam Bread*

fanciful, made-up or coined terms; for example, *Purlator Delivery Service, Bimbo Bread*

Unlike the weak marks, suggestive marks are considered ‘imaginative’ in that speakers of English must make some mental effort to figure out the semantic connection between the mark and the service or product so named. Such an act of mental effort is described by the legal term of art, **imaginative leap**.

In general, only suggestive, arbitrary, or fanciful marks have full legal protection from infringement by competitors. (However, even if a trademark is fanciful or arbitrary, it may be

denied protection if it is adjudged to be obscene, scandalous, or disparaging). In contrast, those determined to be **generic** have no legal protection, and those determined to be **descriptive** are accorded protection only if they have been officially registered for a period of years and/or are adjudged to be **famous** enough to have acquired what the law terms **secondary meaning**—that is, a strong independent semantic association of the mark and the particular company that offers the product and service. **Fame** is a legal term of art used to describe marks that have acquired secondary meaning. For example, *Post Office* is arguably a descriptive mark, but in the United States it remains a protected, registered trademark of the United States Postal Service, owing to the secondary meaning that results from the public's longstanding strong association of the term with the owner. Likewise, assuming hypothetically that the following marks have not been registered long enough to be accorded protection by that criterion, *Best Foods*, *International Screw*, *Fluffy Bread*, *American Tool and Die*, and *United Parcel Service* are all descriptive terms that will have legal protection only if it can be demonstrated that they are sufficiently famous among the relevant public—i.e., that the relevant public associates the marks with particular companies.

As long as it remains legally **live** (the opposite of being legally **dead**, the term of art that is used to describe the state of a trademark that is no longer in commercial use), a legally protected trademark not only cannot be used by others in the same line of business, it also cannot normally be rescinded by legal action; if somebody else uses the mark in connection with products or services that are similar to the mark's owner's, the owner can sue the infringer for damages. However, alleged infringers sometimes mount a defense in which they allege that the mark does not actually belong in one of the three strongest categories of marks, but is really just descriptive (without secondary meaning) or even generic. If the defense is successful, the owner's mark is then subject to legal **cancellation**, which generally means that anyone can use it.

When an alleged infringer's defense is based on the putative genericness or descriptiveness of the owner's mark, the issue of the **imaginative leap** thus becomes critical. That is, the mark's owner will seek to demonstrate that the average potential purchaser of the goods or services in question will not instantly recognize the semantic link between the mark and the goods or services, but must instead perform some kind of a mental analysis—an 'imaginative leap'—to see the connection that relates the term and the referent. Linguists who are professionally qualified to opine on issues of lexis and semantics are therefore often retained to testify about aspects of a particular mark's meaning that may be relevant to determining whether the mark is descriptive or suggestive—that is, whether or not an 'imaginative leap' is required. Of course, the linguist does not testify as to the ultimate legal determination of which category the mark legally belongs in; that is up to the jury or judge. Rather, the linguist testifies as to what the meaning of the mark is, including most particularly the nature of the meaning connection between the mark and the putative commercial referent. I have testified, for example, about linguistic aspects of the meaning of the term *steakburger* (as applied to fast-food sandwiches) that bear on the issue of whether it is a generic, descriptive, or imaginative mark, but it was up to the judge to decide if there were considerations other than the linguistic which had bearing on their final decision.¹

As noted in Butters (2008a; 2008b), the linguistic concept of genericness, at least as used by lexicographers, is close enough to the legal definition that there is generally little problem for the linguist who testifies in genericness cases (and little else for the jury to consider). A problem arises, however, in the match-up between the legal and linguistic

¹ *The Steak N Shake Company, SNSTM, Inc., and Steak N Shake Operations, Inc., v. The Burger King Corporation and Burger King Brands, Inc.*, United States District Court for the Eastern District of Missouri, Civil Action No.4:2004-CV-00525-CDP, JULY 7, 2004.

concepts of categories of descriptiveness and suggestiveness, which are not terms of art at all in linguistics (at least not in the relevant sense). This problem, I believe, generally gets too little noticed in forensic linguistic theory. Shuy (2002) makes a good beginning, noting that there are four related legal tests for determining the difference between a suggestive mark and a merely descriptive one, ‘the most commonly used’ of which is ‘the imagination test’ in which the

more imaginativeness that is required by the consumer to get some direct description of the product from the mark, the more likely the term is to be considered suggestive. ... If the purchaser has to make use of mature thought and engage in a multistage reasoning process to connect the mark to the product or service, the term is judged to be suggestive. (p. 37—38)

Shuy rightly characterizes this as a ‘cognitive leap beyond the descriptive category’—a ‘leap of imagination’; ‘... if the ... [understanding of the meaning is] not instantaneous, then the word is suggestive’ (p. 65).

However, Shuy’s otherwise exemplary introduction does not take up the issue of the possible linguistic correlates of the ‘leap of imagination,’ which itself is not a concept that linguistic science has usually addressed. Rather, he reports, he gave legal testimony that begins to develop the notion of ‘leap of imagination’ within the general framework of ‘metaphor.’ In his view, the use of the trademark *Long Life* when applied to antifreeze (or garments such as ‘sox’ [sic]) is suggestive, not descriptive, because

‘long life’ refer[s] to animate existence, except in its metaphorical uses [in which it means ‘extended life’]; which, being metaphorical, could in no way be considered descriptive. ... [Moreover,] ‘extended life’ is not commonly used in reference to animate existence. ... [Although that] some elements of the antifreeze/coolant industry misused the term ‘long life’ ... is evident, ... [that] does not render ‘long life’ descriptive or generic. It remains metaphoric. (p. 67)

Aside from the oddly unscientific labeling of a usage as ‘misused,’ Shuy’s rationale here seems manifestly vulnerable, considering that established dictionaries give definitions of both *long* and *life* that indicate that the two are totally interpretable according to their ordinary usages. Here, for example, is the relevant portion of the definition for *long* found in the *New Oxford American Dictionary* (2001):

- lasting or taking a great amount of time: *a long and distinguished career* / *she took a long time to dress*
- relatively great in extent: *write a long report* / *a long list of candidates*

And here is the relevant portion of the same dictionary’s definition of *life*:

- the period during which something inanimate or abstract continues to exist, function, or be valid: *underlay helps to prolong the life of a carpet*

Thus bringing together the two words *long* and *life* in the context of ‘antifreeze’ requires no imaginative reading at all: the result is simply the construal of the two words according to ordinary lexicalized meanings that speakers will have recognized without thinking about it further. Indeed, ‘long life’ is being used to describe antifreeze in a laudatory way, which in

itself could be taken as arguing that the term is descriptive, since, as noted earlier, laudatory words are taken to be descriptive rather than suggestive.

It may well be that the etymology of *life* in the relevant contemporary sense originally came about through a process of metaphorical extension; that is, *long-life batteries* may be a **dead** metaphor. But a dead metaphor underlying *long-life batteries* does not require any greater ‘imaginative leap’ than the *New Oxford American Dictionary*’s example of the ‘long life of carpet’. It would be unfair to conclude that Shuy does not acknowledge the essential irrelevance of dead metaphors to synchronic analysis, much less that Shuy reverted to the rhetorical strategy of framing an explanation in terms of a ‘metaphorical’ reading here because a direct confrontation of the criterion of the imaginative leap would not yield the results he wanted to obtain. That is, it seems unlikely that one could convince a jury that the interpretation of *Long-Life Antifreeze* would require that, for speakers of the English language who are alive today, ‘the purchaser ... [must] make use of mature thought and engage in a multistage reasoning process to connect the mark to the product’ antifreeze any more than he or she would need to do so to connect *long-life* with carpet (or batteries, or suntan lotion).

A more likely reason why Shuy took the approach he did was that, in framing his argument as grounded in the concept of metaphor, as opposed to ‘cognitive leaps’ or ‘leaps of the imagination,’ he was on more familiar linguistic grounds. The terminology of tropes may arguably be more within the purview of literary studies than linguistic, yet it nonetheless bleeds over into linguistics as a part of semantic and pragmatic interpretation, and has been widely used in cognitive linguistics, beginning with Lakoff and Johnson (1980). There is also historically a considerable body of scholarship on the interpretation of compounding and so-called ‘deviant utterances’ (for example, see Butters, 1969 and the references therein).²

Although degree-of-imaginativeness has been a seldom-addressed concept in linguistic science, I believe that we can sharpen the forensic linguistic definition of *suggestive marks* by pursuing the concept of ‘imaginative leap’ within the framework of relatively recent cognitive linguistic research that focuses on figurative language and phrasal anomalousness. Coulson (2001: 2) defines *semantic leaps* as resulting in ‘natural language constructions that yield nonobvious meanings’; the figurative meanings become clear only after one expends significant conscious thought upon the constructions. Coulson summarizes this turn in theorizing about figurative language within cognitive linguistics as follows:

[C]ognitive semanticists ... have argued that metaphor is, in fact, a pervasive phenomenon in everyday language and, moreover, that it represents the output of a cognitive process whereby we understand one domain in terms of another. Cognitive linguists define metaphor as reference to one domain (known as the target, theme, or base domain) with vocabulary more commonly associated with another domain (known as the source domain, phoros, or vehicle). On this construal, metaphoric language is the manifestation of conceptual structure organized by a *cross-domain mapping*: a systematic set of correspondences between the source and the target that result from mapping frames or cognitive models across domains.

² Note that a standard work of reference in linguistics such as Crystal (2003) does not define *cognitive leap* or *imaginative* but does contain entries for *deviance* and *cognitive metaphor* (but in the sense of Lakoff and Johnson 1980).

On this view, ... a speaker invokes a metaphor whenever she refers to one domain, such as verbal argumentation, with vocabulary from another domain, such as physical combat³. (p. 162)

Colson notes, for example (p. 167), that for a hearer understanding for the first time the well-known recently coined compound, *computer virus*, the target domain ('a computer program written for the express purpose of damaging other peoples' computational resources') is conceptualized with source domain models (biological viruses). Although 'the two domains share structure and vocabulary' (e.g., both are 'invasive'; both 'attack' 'hosts'; both are 'unwanted', both 'replicate', both typically result in diminished capacity for the host) they also are significantly different in readily identifiable ways: in the end, 'a computer virus is a very different kind of entity from a biological virus.'

One advantage to referring to the work of Coulson and other cognitive psychologists in thinking about what constitute suggestive marks from a linguistic perspective is simply that it ties an important legal concept directly into a linguistic one. Courts are generally less comfortable, and rightfully so, when experts speak of legal concepts in ways that do not seem immediately relevant to legal concepts. More important, however, is that examining trademark strength from the perspective of the imaginative leap generates a kind of analysis the results of which offer greater scientific clarity.

By way of illustration, I will briefly outline arguments that emerged in a case in which I was a paid forensic linguistic consultant (the type of industry involved has been changed here for purposes of anonymity). The case involved whether or not *XX* and *XY* are descriptive or suggestive when used as trademarks applied to sports clothing and equipment for men and women (respectively). One can look at dictionaries and find generic definitions for *shoes*, *hats* and the like, and even *XX* 'symbol for female chromosome' and *XY* 'symbol for male chromosome', and conclude that the use of the terms as applied to garments would be 'metaphorical' rather than 'literal,' given that clothing does not directly involve chromosomes—and hence that the marks *XX BOWLING BALL* and *XY TENNIS SHOES* are suggestive rather than descriptive.

However, the dictionary definitions really don't inform us very well about the collocational possibilities and interpretations of *XX BOWLING BALL* or *XY TENNIS SHOES*. Even if we assume for the sake of argument that *XX* and *XY* in today's English centrally and lexically mean, for a number of speakers who are likely buy sports clothing and equipment, 'symbol for female chromosome' and 'symbol for male chromosome', it would still arguably be the case that the only-slightly-more-general meanings 'female' for *XX* and 'male' for *XY* are so obvious that the speakers will not require significant thought in order to interpret them in those senses, especially in contexts such as the terms used for products that normally are designed with the sex of the target customer very much in mind. Rather, one might argue that it is much more in accordance with psycholinguistic reality that such speakers will—without giving it much thought at all—recognize that *XX* and *XY* in the various brand names and discourse uses fit well within the understandable semantic boundaries of *XX* and *XY*. That is to say, we can in this way conclude that the necessity for an imaginative leap is not

³ Although cognitive linguists often stress the differences between their views of metaphor and more traditional views, in fact, at least in terms of discussing individual metaphorical constructs, the differences are not necessarily great. See, for example, Harmon and Harmon, (2000, s.v. **metaphor**): 'An analogy identifying one object with another and ascribing to the first object one or more qualities of the second. I. A. Richards' distinction between the **tenor** and the **vehicle** of a *metaphor* may be useful. The tenor is the idea being expressed or the subject of comparison; the vehicle is image by which the idea is conveyed or the subject communicated.'

particularly great, and that *XX BOWLING BALL* or *XY TENNIS SHOES* are essentially descriptive rather than suggestive.

Semanticists agree also that ordinary words co-exist with semantic border areas that are somewhat provisional—and overlapping with their neighbors'. Indeed, the meanings of words are characteristically so 'fuzzy' at the edges that *fuzzy* has become a well-known term of art for psycholinguists. Aitchison (1994) describes the nature of word meaning for normal speakers of a human language as follows:

Words cannot be assigned a firm meaning ... 'natural language concepts have vague boundaries and fuzzy edges' [quoting Lakoff, 1972]. Word meanings cannot be pinned down, as if they were dead insects. Instead, they flutter around elusively like live butterflies (p. 39—40). ... [Word meanings] have fuzzy edges in the sense that there is often no clear point at which one word ends and another [in the same family of words] begins (p. 46). ... [The majority of words have] one or more of the following problems: first, it may be hard to specify a hard core meaning at all. Second, it may be impossible to tell where 'true meaning' ends and encyclopedic knowledge begins. Third, the words may have 'fuzzy boundaries' in that there may be no clear point at which the meaning of one word ends and another begins. Fourth, a single word may apply to a 'family' of items which all overlap in meaning but do not share any one common characteristic (p. 48—49).

The sociolinguist William Labov illustrated the underlying principle involved here with words in the general category of containers (1973: 340):

In any kitchen, there are many containers that are obviously bowls, cups, mugs, and dishes. But there are others that might be called cups or might not; or might be a kind of cup, according to some, but a kind of bowl, according to others.

Thus the mental organization of words and meanings is not a set of sharply delineated entities in which each word has a unique set of defining elements all and only of which must be present in a real-world entity to qualify that entity to be legitimately named by that word. The connection between a brand name *XY* and the meaning 'for men' is an easy one because the semantic boundaries of the term *XY chromosome* are, like the boundaries for words in general, somewhat fuzzy.

In other cases involving the difference between descriptive and suggestive marks, the idea of 'metaphor' seems of little help, yet the idea of 'imaginative leap' seems at least somewhat illuminating. Suppose, for example, that a company calls itself *National Southern Trucking Company*.⁴ Is this a descriptive or a suggestive mark? Certainly, *trucking* and *company* are generic, and will afford no protection. And *national* and *southern* are in the law generally considered descriptive by virtue of falling into the descriptive class of general geographical terms. Only if the term *National Southern Trucking Company* requires some kind of metaphorical interpretation or cognitive leap will it satisfy the criteria for inclusion in the class of suggestive marks. However, while *National Southern* is not what one would usually describe as a metaphor, if one focuses on the apparent meaning of *National Southern*, one sees something of a semantic incongruity: while *Southern National* can readily be understood to mean 'the southern part of the nation', the parallel semantic interpretation of *National Southern*—'the national part of the South'—does not make much sense. A potential

⁴ Again, this example refers to issues about which I have consulted with attorneys; however, I am changing the names and the industries so as to preserve the anonymity of the proceedings.

customer of *National Southern Trucking Company* must give it some thought—must engage the imagination—and impose some kind of interpretation: perhaps it really means ‘southern national’, making use of a deviant syntax; or perhaps it means ‘characteristic of the South but extended throughout the nation’; or perhaps it means ‘national, but with especial emphasis on the South’. In short, the potential customer must make some kind of imaginative/cognitive leap to interpret the semantically anomalous phrase.

This is not to say that linguists ought not to introduce the concept of metaphor at all in discussing the intersection of genericness and descriptiveness. In many cases, the absence of a clear dictionary definition for a word or phrase is helpful in ascertaining the degree of mental effort that might be necessary to understand it. However, making use of the linguistic concept of the imaginative leap will, I think, become increasingly important in future linguistic consultation in trademark cases.

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