

A Linguistic Look at Trademark Dilution

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Possible Applications of Linguistics to Trademark Dilution Cases

- 1. Fame**
- 2. Genericness Issues: Viability of the Mark**
- 3. Identity versus High Degree of Similarity of the
Marks at Issue**
- 4. Other Issues**

1. Fame

- Lexicographers historically have needed to be able to define such terms as *trademarks*, *service marks*, and *brand names* not only as dictionary entries but also as terms of art within the field itself.
- Furthermore, dictionary makers have needed to develop some sort of concept akin to the legal notion, important to dilution issues, of trademark fame.
- Dictionaries contain few trademarks (70,000 entries, only about 300 TMs), some selected for “fame” (*Band-Aid*, *Frisbee*, *Mace*, *Kleenex*, *Xerox*).) others because readers will need to look them up (*Pentothol*, *Butazolidin*, *Lastex*, *Mauser*, *Bondo*). Significant omissions: *Microsoft*, *Burger King*, *Apple*. Cf. also transparent omissions such as *American Airlines*.
- Thus presence or absence in a dictionary is not necessarily proof of “fame.”
- Even so, there is no reason in principle why a linguist could not rather easily construct, using the normal procedures of lexicography, an evaluation metric that would help a trier of fact to evaluate the degree of fame of a particular mark.

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2. Genericness Issues: Viability of the Mark

- *Beanie* and *Beanie Baby* (Ty Inc.'s soft plush pellet-filled doll toys) and *Screenie Beanie* (Softbelly's soft, plush, pellet-filled doll-like computer-screen wiping devices); *steakburger* (claimed as a common-law trademark by Steak N Shake); *kettle* as a potato-chip designator; *zinger* as a spicy chicken menu item, claimed as a common-law trademark by Florida Ale House).
- The word *generic* is a term of art in dictionary making as well as the law, and lexicographical methodology underlies the most robust applications of linguistics to strength-of-mark questions.

2. Genericness Issues: Viability of the Mark (continued)

Band-Aid

A trademark used for an adhesive bandage with a gauze pad in the center, employed to protect minor wounds. **This trademark sometimes occurs in print in figurative uses:** “True welfare reform is being bypassed for Band-Aid solutions” (*Los Angeles Times*). “These measures are mere Band-Aids” (*U.S. News & World Report*). [<http://www.bartleby.com/61/35/B0053500.html>]

Frisbee

A trademark used for a plastic disk-shaped toy that players throw and catch. **This trademark sometimes occurs in print meaning “a throw-and-catch game played with this toy”:** “The Mall is a better place to play Frisbee with a dog” (*Los Angeles Times*). [<http://www.bartleby.com/61/7/F0330700.html>]

2. Genericness Issues: Viability of the Mark (continued)

Mace

A trademark used for an aerosol used to immobilize an attacker temporarily. **This trademark often occurs in print in uppercase or lowercase as a verb and a noun:** “shouted at police after he was Maced when he rushed the fence” (David Shepardson, Detroit News June 23, 1996).

Xerox

A trademark used for a photocopying process or machine employing xerography. **This trademark often occurs in print in lowercase as a verb and noun:** “Letters you send should be xeroxed after you sign them” (*Progressive Architecture*). “He has four or five sheets of foolscap, xeroxes, I see, of court documents” (Scott Turow).
[<http://www.bartleby.com/61/59/X0005900.html>]

2. Genericness Issues: Viability of the Mark (continued)

- The use of such linguistic expertise about strength of mark will of course have to be limited in cases in which the plaintiff asserts dilution. Because marks about which the owners can assert dilution claims must by definition be “famous,” even descriptive marks in such cases would presumably have secondary meaning (or they could not be famous). Thus the issue of strength of mark arises only if the defendant claims that the mark is generic.
- However, it seems likely that in many instances of exceptionally famous marks, a genericness defense would be plausible. In *Ty Inc. v. Softbelly*, in which Ty in fact asserted that Softbelly was diluting its *Beanie* mark, the defendant makers of Screenie Beans did in fact assert just that—that *Beanie* had undergone genericide. A LexisNexis search demonstrated otherwise: writers very rarely used *Beanie* generically with the frequency that (it appears) the same writers do *Band-Aid*, *Frisbee*, *Mace*, *Xerox*, or *Kleenex*.

3. Identity versus High Degree of Similarity of the Marks at Issue

- The other subject about which linguists frequently give expert testimony in trademark cases involves evidence bearing on the issue of likelihood of confusion.
- *Car-X* versus *CarMax*; *CarMax* versus *AutoNationUSA*; *Aventis* versus *Advancis*.
- In most of these cases, dilution was not part of the plaintiff's complaint, and in no case (so far as I know) was the linguistic evidence brought to bear on the dilution complaint.
- The methodology here extends beyond lexicography, and also beyond phonology, morphology, and semantics, and into meaning in context and even the semiotics of colors and the form of logos.

3. Identity versus High Degree of Similarity of the Marks at Issue (continued)

- Just how similar two marks must be to trigger “tarnishment” and/or “blurring of identity”?
- Delta (faucets) versus Delta (airlines)
- *Victoria’s Secret* vs. *Victor’s Little Secret*
- *Lexis* versus *Lexus*

4. Summary and Other Issues

1. Fame

2. Genericness Issues: Viability of the Mark

**3. Identity versus High Degree of Similarity of the
Marks at Issue**

4. Other Issues

a. blurring

b. Tarnishment