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Language of the law: The special role and trademarks, trade names, and other trade emblems.

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Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems

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I. INTRODUCTION

In 1979, the United States Supreme Court decided *Friedman v. Rogers*, a case involving a First Amendment challenge to a Texas statute that prohibited optometrists from practicing under an assumed trade name.¹ Although an important case, *Friedman* certainly is not one of the major milestones of First Amendment jurisprudence. Prior Supreme Court decisions established that although commercial speech is protected by the First Amendment, government may regulate speech to prevent deception or confusion.² Because a majority in *Friedman* found a possibility of deception, the Court held that Texas could constitutionally prohibit the use of a trade name.

Friedman becomes much more interesting if one considers what the Court is saying about trade emblems.³ The Court did not simply find that the particular trade name used by the optometrist was mis-

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1. *Friedman v. Rogers*, 440 U.S. 1 (1979). The provision in question, the Texas Optometry Act § 5.13(d), allowed an optometrist to practice using the personal name under which he had been licensed. The Act further allowed partnerships of optometrists to practice using names comprising some of the partners. All other forms of trade names were prohibited.
 2. The leading pre-*Friedman* cases include *Bates v. State Bar of Arizona*, 433 U.S. 350 (1977), and *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976).
 3. This Article uses the term "trade emblem" to refer to any word or symbol that a seller employs to identify the seller or the seller's products to shoppers. The term therefore includes trademarks, service marks, collective marks, and certification marks, all of which identify the source of a good or service offered for sale in the marketplace. It also includes "trade names," the name by which a firm identifies itself. The term, however, does not include "product names," the names of goods and services. Although the analysis employed in this Article will sometimes apply to product names, see, e.g., *infra* note 107, product names present enough unique considerations to warrant separate treatment.

leading.⁴ Instead, it held that *all* trade names have an inherent capacity to deceive.⁵ Texas could therefore enact a blanket ban on all trade names without having to demonstrate whether a particular name might be misleading.

The suggestion that all trade emblems are potentially deceptive clashes with a basic precept of intellectual property law: trade names and other trade emblems help to *reduce* confusion in the marketplace. Admittedly, trade emblems often are used as instruments of deception. Case reports are filled with situations in which one company uses a competitor's trademark or trade name to pass off its goods to unsuspecting buyers. The current legal rules, however, are designed to prevent, not foster, this sort of deception. A party with a protected trade name can utilize the courts to thwart any impostors. By denying optometrists their ability to use trade names, the Texas statute may have removed a very important control, thereby resulting in more, rather than less, deception.⁶

Deception is a failure of communication. And communication ordinarily is carried out by means of language. When buyers and sellers communicate in the market, they make extensive use of trade emblems as part of their language. A trade name is much more than a simple identification badge that allows people to distinguish sellers. It is instead an entire array of different messages, all condensed into a single word, a short phrase, or a symbol. Those myriad messages comprise the definition of the trade emblem. A potential for purchaser deception exists whenever any of these messages contain false information. What makes *Friedman* noteworthy is the majority's recognition that even when a trade emblem correctly names the source of goods or services, it can still contain false and deceptive information.⁷

Acknowledging that trade emblems serve as "words" in the lexicon of the market forces one to view the law governing trade emblems in an entirely new light. Most attorneys perceive of trade emblem law as

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4. This, however, would have been an easy way for the Court to dispose of the case. The actual trade name used in the case, TEXAS STATE OPTICAL, could have been interpreted as a representation that the stores either were run by the state or enjoyed some special state imprimatur.
 5. *Friedman v. Rogers*, 440 U.S. 1, 12-13 (1979).
 6. Indeed, Justice Blackmun argued in his separate opinion that because the statute might well result in more customer confusion, denying optometrists the opportunity to use trade names could not be justified as a measure intended to control deception. *Id.* at 25-26 (Blackmun, J., concurring and dissenting).
 7. For example, the majority opinion notes that a trade name may convey price and other information about the firm's product. *Id.* at 11. Of course, the name TEXAS STATE OPTICAL said nothing on its face about price or quality. The majority nevertheless recognized that people who regularly deal with the company will eventually develop certain expectations concerning price and quality. Such an imprecise means of communication was, in the majority's view, what gave rise to the risk of deception. *Id.* at 11-13.

occupying a distinct niche in the realm of intellectual property law. Its closest jurisprudential cousins include copyright, patent, and misappropriation. Like these areas, the main concern in trade emblem law is how to allocate the intellectual property rights among various contenders.

Lumping trade emblem law with the other areas of intellectual property law is nearsighted, however. The law of trade emblems actually forms part of the much broader and more difficult question of how the law should interact with language. Although the law usually does not purposefully interfere with language, exceptions exist. The most common exception allows the law to interfere when speech is used to deceive. The law of trade emblems is therefore merely one of several means by which the law regulates the truth of language in the marketplace.

Of course legislatures and courts frequently recite the mantra that one of the main purposes of trade emblem law is to prevent consumer deception. Governing statutes do contain certain rules that directly serve this end.⁸ In practice, however, this ideal tends to be overlooked. Most of the judicial and legislative debate focuses on defining the rights of the sellers, not on the effect that various contending rules will have on the efficiency and accuracy of communication in the market.⁹

The rules of trade emblem law need to be reevaluated to determine whether they are effective rules of language. A language approach suggests that the primary focus of the law should be the overall process of communication, not merely one of the communicating parties.

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8. The legislative history of the Lanham Act explicitly indicates that one of the two main purposes of the statute is to protect purchasers from deception. S. REP. NO. 79-1333 (1946). This purpose manifests itself in various provisions of the statute. See, e.g., the following sections of the Lanham Act: § 2(a), 15 U.S.C. § 1052(a) (1994)(refusing registration to "deceptive" marks); § 32(1)(a), 15 U.S.C. § 1052(d) (1994)(creating a cause of action when someone uses a registered mark in a fashion that is "likely to cause confusion, or to cause mistake, or to deceive"); and § 43(a), 15 U.S.C. § 1114(1) (1994)(creating a cause of action when someone makes any claim in advertising or promotion that is "likely to cause confusion, or to cause mistake, or to deceive").
 9. An excellent example of this phenomenon is the debate concerning whether purchasers can bring claims under Lanham Act § 43(a). As discussed in *supra* note 8, § 43(a) clearly deals with purchaser deception. Nothing on the face of the statute limits the provision to claims brought by competitors. Nevertheless, most courts that have faced the question have refused to allow the purchaser's suit, concluding that Congress intended the Lanham Act to protect only competitors. *Barrus v. Sylvania*, 55 F.3d 468 (9th Cir. 1995); *Serbin v. Ziebart Int'l Corp.*, 11 F.3d 1163 (3rd Cir. 1993); *Dovenmuehle v. Gildorn Mortgage Midwest Corp.*, 871 F.2d 697 (7th Cir. 1989); *Colligan v. Activities Club*, 442 F.2d 686 (2nd Cir. 1971). By refusing to allow the victims of deception to sue, the courts seem to have overlooked their own mantra about how the Lanham Act was enacted to control deception.

The law should abandon its traditional "intellectual property" paradigm, which concentrates on allocating rights in creations, and should substitute a paradigm with a core principle of preventing deception. This new paradigm may, in turn, result in some changes in the governing law.

Part I of this Article addresses whether the basic principles of trade emblem law make sense as rules of language. Although the new perspective certainly requires a rethinking of the existing rules, Part I demonstrates that most of the basic principles are valid as rules of language. The linchpin of the entire system—the grant of exclusive rights to one seller—will generally encourage efficient communication and limit deception. Similarly, the rules of priority, registration, and infringement serve these same ends.

Part II explores some of the more difficult questions of trade emblem law, such as dilution, reverse palming-off, and succession to rights. It is here that a language-based analysis has the most to offer. Much of the current confusion is created by legislatures and courts that have not fully recognized that trade emblems convey several distinct messages. Recognizing the multiple messages in a trade emblem makes it possible to take a reasoned approach to these difficult issues. This reasoned approach, in turn, reveals significant flaws in the current rules.

Much of the discussion in this Article emphasizes United States trademark law. The analysis is not limited to trademarks, however. The principles of a language analysis fully apply to service, collective, and certification marks, and in large part, to trade names. Further, a language analysis is confined neither to the United States legal system nor the English language. It extends to all legal systems that follow the basic model of providing exclusivity in trade emblems.¹⁰

II. TRADE EMBLEMS AS LANGUAGE

A. How Trade Emblems Convey Information

A market can function effectively only if purchasers can make informed choices. Most purchasers are not armed *a priori* with perfect knowledge about the goods and services that they are considering. Purchasers must instead obtain that information by inspecting the commodity and communicating with the potential seller or with third parties.¹¹ In most cases, it is quite costly for the purchaser either to

10. The Article's emphasis on United States trademark law is due to two practical considerations: first, the Author's own familiarity with United States law, and second, the law of trademarks is clearly the most highly developed area of trade emblem law.

11. Purchasers are becoming increasingly reliant on communication to obtain needed information. The traditional methods of deriving quality information—personal

undertake a comprehensive inspection or to engage in an in-depth conversation with the seller.¹² The market can function more efficiently if sellers have a shorthand way of communicating the standard information that purchasers need to make an informed choice. Trade emblems constitute one of these shorthand methods.¹³

Trade emblems often are defined as words or symbols that identify a particular seller.¹⁴ Identifying the seller is an important consideration and has been recognized by societies throughout history.¹⁵ Yet identifying the seller is by no means the sole function of a trade emblem.¹⁶ Most shoppers in today's vast national economy do not know personally the source of the myriad goods and services they purchase. Therefore, most purchasers are not motivated by any sense of per-

inspection and questioning the seller—often are no longer as useful. Modern purchasers must select from a much wider array of products and services than were available a generation ago. In addition, most products and many services are becoming more complex. Moreover, products today are increasingly sold in packaging, making detailed inspection difficult or impossible. Finally, the increased prevalence of large discount "chain" stores, which often hire clerks who know little about the myriad products sold in the store, makes it more difficult to derive information from the seller itself. As a result, purchasers increasingly find that they simply lack the knowledge needed to evaluate many goods and services.

12. ARMEN ALCHIAN & WILLIAM R. ALLEN, *EXCHANGE AND PRODUCTION: COMPETITION, COORDINATION, AND CONTROL* 193, 294-95 (2d ed. 1977); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987).
13. Trade emblems, however, are not the only method of communication. Many sellers rely on mass advertising campaigns to convey specific ideas to a large number of potential purchasers. Purchaser-oriented magazines like *Consumer Reports* are another means by which purchasers can acquire needed information.
14. A trade name is a term used to identify the seller itself. A trademark or service mark, by contrast, identifies a particular commodity as originating from that source. Lanham Act § 45, 15 U.S.C. § 1127 (1994). This Article will employ the modern terms for product and firm names. The common law used different terminology, a fact that sometimes results in confusion. At common law, the terms trade name and trademark both applied to goods. The difference between the two is that while a trademark was automatically protected, a trade name could be protected only with secondary meaning.
15. In ancient Egypt, for example, each brickmaker was required to stamp his product with a unique symbol. Likewise, members of the medieval guilds also marked their products in unique ways, although they were not required to do so by law. Edward S. Rogers, *The Lanham Act and the Social Function of Trade-marks*, 14 LAW & CONTEMP. PROBS. 173, 173 (1949).
16. In fact, if the only concern was identifying the seller, the law would protect only sellers who used their own personal or corporate names as trade emblems. Current trade emblem law, however, is void of any preferences for parties who use their personal names. In fact, the Lanham Act expressly prohibits the registration of any trademark or service that is "primarily merely a surname." Lanham Act § 2(e)(4), 15 U.S.C. § 1052(e)(4) (1994). Courts apply a similar rule in infringement cases.

sonal friendship with the companies that provide products.¹⁷ Instead, the main motivations usually include the impersonal factors of price and quality.

This does not mean that purchasers have no interest in knowing the source of what they are buying. Their interest is more than mere curiosity. Identifying the source of a product provides purchasers with a great deal of other relevant information.¹⁸ First, such information reveals available recourse options should the product fail to perform as expected. Second, and more importantly, distinguishing various sources helps shoppers choose among competing products. A shopper may have had an experience, either good or bad, with the goods or services of a particular seller. Absent additional information, most shoppers assume that other products from that source will be of like quality. Trade emblems provide a ready way to identify different items that emanate from the same source, making it easy for the shopper to tap into this prior experience. Saying that a trade emblem identifies a "source" is really a shorthand way of saying that an emblem conveys all information that purchasers may associate with a source.¹⁹

17. 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 1.03[3], at 1-23 to 1-24 (Jeffrey M. Samuels ed., 1996); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.03[2], at 3-13 (3d ed. 1995); Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927). Also, in *Celanese Corporation of America v. E.I. DuPont de Nemours & Co.*, 154 F.2d 143 (Ct. Cust. App. 1946), the court held that defendant's mere addition of "DuPont" to plaintiff's mark did not alleviate the likelihood of confusion. If knowing the source was all that mattered, however, the defendant should have prevailed in this case.

Admittedly, for some products knowledge of the source is the consumer's main criterion, especially when personal services are involved. Consumers often will ignore considerations such as price or quality in the interest of doing business with a friend or family member. In other cases, purchasers buy products or services because they agree with a seller's environmental or social policy. Other preferences simply defy cold logic. For example, this Author continues to root for the Minnesota Twins baseball club even though the team exhibits little that can be called quality under any objective criteria. But these cases are the exceptions, not the rule. Most shoppers are more concerned with the nature of the good or service than they are with the identity of the seller.

18. Of course, this Article is by no means the first to recognize that trade emblems do more than merely identify source. The Supreme Court's analysis in *Friedman v. Rogers*, 440 U.S. 1, 11 (1979). Many other courts and commentators have discussed at length the various functions that trade emblems can perform. For a sampling, see *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 635 (7th Cir. 1993); GILSON, *supra* note 17, § 1.03[6], at 1-33; 1 MCCARTHY, *supra* note 17, § 3.03, at 3-3 to 3-21. Although many have recognized the various roles that trade emblems play in market communication, few have explored the implications.

19. See Schechter, *supra* note 17, at 818-19.

Trade emblems also may convey relevant information that has nothing to do with the source. Many sellers borrow existing words as marks. These words will have a literal meaning to shoppers who spot them in the market. If shoppers connect the preexisting meaning to the good or service, a trade emblem can operate as a form of informational advertising.

In essence, a trade emblem becomes part of the vocabulary of the marketplace. A seller who coins a new word or symbol like XEROX or KODAK adds a word to the vocabulary. A seller who adopts a recognized word or symbol, by contrast, modifies the definition of that term, at least in the context of a certain good, service, or seller. Hence, trade emblems allow sellers to express a number of complex ideas in a single word, phrase, or symbol.²⁰

B. The Various Messages that a Trade Emblem May Convey

Although trade emblems become part of the market lexicon, they are not the exclusive means by which sellers and shoppers communicate. Trade emblems cannot convey all of the information that shoppers need to make their decision. Determining how the law should deal with trade emblems requires an understanding of the limits on the types of information emblems can convey.

Basically, trade emblems can convey up to four distinct messages: the denominative message, the associative message, the descriptive messages, and the allusive message. Few trade emblems, however, will actually convey all four of these messages. In addition, although distinct, these messages are not entirely independent. Changes in the content of one message may affect the strength or meaning of others.²¹ Because each of the four messages can affect shoppers, each will be discussed in depth.

20. This is not an uncommon occurrence in language. As cultures encounter new concepts, they create new words to describe those concepts. F.R. PALMER, *SEMANTICS* 17-24 (2nd ed. 1981); Landes & Posner, *supra* note 12, at 271-72. This phenomenon is essential to the way we view reality. Not all languages assign words to the same concepts. If the language of a given culture does not have a word for a concept, that concept may not be recognized in the world view of that culture. Thus, language affects the way a culture perceives reality. ANNA WIERZBICKA, *SEMANTICS, CULTURE AND COGNITION* 6-10 (1992); Albert Heinrich, *Some Notes on Central Eskimo Color Terminology*, in *LANGUAGE AND THOUGHT: ANTHROPOLOGICAL ISSUES* 45 (William C. McCormack & Stephen A. Wurm eds., 1977).

21. For an example of how this may occur, see the discussion of "tarnishment" in section II.D.

1. *Denominative Message*

Sellers use trade emblems to identify themselves to shoppers.²² This function of trade emblems is widely known.²³ Nevertheless, it is worthwhile to explore exactly what it means to "identify" a seller. A trade emblem does not identify the source in the same fashion as, for example, someone's signature on a birthday card. Instead of "identifying" the seller as someone personally known to the buyer, a trade emblem merely declares that the seller is a distinct entity that competes in the market for a particular good or service.

Although impersonal, this form of identification is nevertheless important to shoppers. Most shoppers who spot a trade emblem will make two significant assumptions. First, shoppers will assume that similar products bearing the same emblem will exhibit some degree of consistency because a single firm tends to produce goods and services of roughly *uniform quality*. For example, a shopper who spots two cartons of milk bearing the same trade emblem will assume that both are approximately the same. This consistency appeals to shoppers because the process of shopping becomes more predictable. Second, shoppers will also assume that a good or service sold under a trade emblem is of a certain *minimum level of quality*. Shoppers experience a basic level of comfort in seeing a trade emblem on a product.

Moreover, shoppers assume that name brand goods and services are generally of a higher quality than generics.²⁴ If the emblem remains in the market for some time, shoppers may assume a still higher minimum level of quality, even if the shoppers have never tried the product. Because sellers of low-quality products generally quickly

22. A trade name directly serves this purpose by giving shoppers a name by which to refer to the seller. With a trademark or service mark, the identification is less direct. BIG MAC is not the name of the seller; rather, it is a symbol that people may come to associate with McDonald's.

23. 1 GILSON, *supra* note 17, § 1.03[1]; 1 MCCARTHY, *supra* note 17, § 3.01[3], at 3-5 to 3-7.

24. Marshall I. Goldman, *Product Differentiation and Advertising: Some Lessons from Soviet Experience*, 68 J. POL. ECON. 346 (1960), discusses a Soviet study that demonstrated that when goods were sold without any means of identifying the seller, the quality would often decline. Rogers, *supra* note 15, at 175-76, argues that this occurs because, if sellers cannot use trade emblems, the only way to distinguish their goods from competitors is by price. If price is the only way to distinguish products, purchasers will be interested in buying the cheapest of comparable goods. To keep price low, sellers have an incentive to cut costs, which can result in lower quality. Other reasons may explain why shoppers assume that branded products are of higher quality. For example, purchasers may reason that a seller would remain anonymous unless it wanted to claim credit for the products it sells.

exit the market, a shopper who continues to see a mark may assume that the product is satisfactory to some purchasers.²⁵

Of the four messages, only the denominative is conveyed in every valid trade emblem.²⁶ Unlike the associative message, the denominative message does not depend on whether anyone has actually purchased the goods or services.²⁷ Unlike the descriptive and allusive messages, a trade emblem will send a denominative message regardless of the word, phrase, or symbol chosen for the emblem. Any emblem can denominate a seller as long as shoppers recognize that the emblem is used as an indication of source.²⁸

2. Associative Message

Shoppers rely on many sources of information when making purchasing decisions. These sources include advertising and independent evaluations. Nevertheless, a shopper's own past experience with a particular seller usually is the most influential factor.²⁹ A shopper who has had a bad experience with a particular seller's product will be unlikely to buy from that seller again. Conversely, it can be quite difficult to convince a shopper who has had a very positive experience

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25. These assumptions need not be true. The fear that sellers might take advantage of these assumptions is the basis for the Supreme Court's ruling in *Friedman* that a trade name is inherently deceptive. *Friedman v. Rogers*, 440 U.S. 1, 12-13 (1979).
 26. Although every trade emblem has the potential to denominate source, shoppers may fail to interpret the emblem in that fashion. Because an emblem can send multiple messages, shoppers often will let a message other than the denominative prevail. For discussion of one important example of this phenomenon—the case of descriptive and generic marks—see *infra* text accompanying notes 73-83.
 27. This does not mean that experience is irrelevant to the denominative message. Shopper experience with a trade emblem can often create a denominative message by allowing it to develop a “secondary meaning.” See *infra* text accompanying notes 73-83.
 28. Not all words and symbols are recognized as indications of source. In *Western Publishing Co. v. Rose Art Industries, Inc.*, 910 F.2d 57 (2nd Cir. 1990), the court indicated that the word GOLDEN was particularly ineffective in indicating source because it was used by so many sellers. In one of the more curious cases on this point, *In re Diamond Hill Farms*, 32 U.S.P.Q.2d (BNA) 1383 (1994), the court held that the company could not register its own name as a trademark for potatoes it had grown. The reason was that the applicant had not used the mark as a trademark, but instead as a phrase that distinguished its potatoes from those of other growers. The court's distinction makes little sense because the purpose of *all* trade emblems is to distinguish sellers.
 29. Experience is influential because it is a quick, easy, and effective way to ascertain quality. Admittedly it is not the most accurate method, as shoppers can use source as a basis for judging quality only for previously used goods and services, not for new goods that they may encounter. In addition, shoppers who use past experiences to gauge present quality make a significant assumption that the quality remains unchanged. Notwithstanding these limitations, relying on experience essentially is costless and makes it more efficient to judge quality than either inspection or investigation.

rience to buy from a different seller. Although experience is most influential when the shopper contemplates purchasing the same product, experience may also be a factor when the shopper is considering a different product.³⁰ Trade emblems make it possible for shoppers to tap into this experience. By providing a quick and relatively sure way to distinguish sellers, trade emblems allow shoppers to sort and categorize their own experiences and to recall the relevant experiences when they again venture into the market.³¹

The associative message of a particular trade emblem is the collection of the past experiences that a shopper associates with goods or services sold under that trade emblem.³² The associative message is the strongest of a trade emblem's four messages. Shoppers tend to trust their own experience more than claims made by sellers in the marketplace. Not all trade emblems convey an associative message, however. Essentially, the associative message is entirely dependent on the denominative. Unless shoppers can attribute their actual personal experiences to a particular seller, shoppers will be unable to use that experience in deciding among competing commodities in the market.

The associative message differs from the other three messages in one important aspect. Because it depends on actual experience, it almost always will vary from shopper to shopper.³³ Shoppers who have never dealt with the emblem, or who have no memory of any dealings, will not derive an associative message from the trade emblem. Even shoppers familiar with the mark may have had varying experiences with the commodity.

Purchasers who buy a product based on personal positive experience make an assumption that the product is approximately as good as it was in the past. The associative message of the mark used on

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30. It is increasingly common for a manufacturer of a successful branded product to "branch out" to other products that it sells under the recognized trade emblem. Shoppers who consider these new products often use their experience with the original good when evaluating the commodity.
 31. This is another reason why shoppers tend to prefer branded products over generics. Purchasing a commodity with a trade emblem is an investment for it gives shoppers the opportunity to use their experiences in later excursions into the market. Purchasing a generic, on the other hand, offers no potential for future savings.
 32. In the case of a trade name, the purchaser will rely upon his or her experience with the firm itself.
 33. There may be circumstances in which the other three messages also will be interpreted differently by various shoppers. For example, a trademark can be comprised of a foreign word, a situation discussed in greater depth *infra* at text accompanying notes 127-40. To the shopper who does not understand the language, the emblem will convey only a denominative message. A shopper who is familiar with the language, however, will interpret the emblem as conveying either an allusive or a descriptive message, depending on the word chosen and the context in which it is presented. See *infra* text accompanying note 134.

that good is false if the quality of the product is significantly different. If the associative message often proves inaccurate, purchasers may become less willing to rely on their own experiences, thereby undercutting an efficient means of reducing information costs. As such, the associative message can be false even when the other messages are true.

3. *Descriptive Message*

Neither the denominative nor the associative messages are directly affected by the intrinsic meaning of the word or symbol chosen as the trade emblem.³⁴ Indeed, some emblems with the strongest denominative and associative messages, such as KODAK, XEROX, and the golden arches of McDONALD'S, simply are coined words or symbols. Most trade emblems, however, are not original. Sellers tend to borrow words and images that already have some meaning to the purchasing public.

This tendency to borrow existing words is not due to lack of creativity. Sellers often choose existing words to communicate more than just denominative and associative messages. Descriptive emblems, like THRIFTY and BUDGET for car rentals, SUPER BUY for cigars,³⁵ CONSISTENTLY SUPERIOR for bakery products,³⁶ EVEREADY for batteries,³⁷ QUIK-PRINT for copy shops,³⁸ and BLUE RIBBON for condiments,³⁹ send strong, yet subtle, signals to the shopper. These emblems provide information about the good or service under consideration. When the marks relay such information, these signals operate as a form of advertising.

Descriptive emblems convey product information. As a result, they can be very effective in reducing a purchaser's costs of gathering information.⁴⁰ Nevertheless, descriptive trade emblems can be among the most difficult to protect. If a seller adopts as a trade emblem the common descriptive name for a product, the emblem will be refused protection on the basis that it is generic.⁴¹ If the trade emblem describes

34. As discussed *infra* text accompanying notes 73-76, a descriptive word may not be understood as conveying a denominative message. However, that word can become distinctive by acquiring "secondary meaning." When this occurs, shoppers interpret the word as including a denominative message.

35. *In re Consolidated Cigar Co.*, 35 U.S.P.Q.2d (BNA) 1290 (1995).

36. *In re Duvernoy & Sons, Inc.*, 212 F.2d 202 (C.C.P.A. 1954).

37. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366 (7th Cir. 1976).

38. *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523 (C.C.P.A. 1980).

39. *Richard Hellman, Inc. v. Oakford & Fahnstock*, 54 F.2d 423 (C.C.P.A. 1932).

40. *Landes & Posner*, *supra* note 12, at 276.

41. *See San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987)(dicta); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3rd Cir. 1986); *In re Seats Inc.*, 757 F.2d 274 (Fed. Cir. 1985); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5 (1st Cir. 1981); 1 GILSON, *supra* note 17, § 2.02, at 2-19 ("A common descriptive or generic name is thus virtually impossible to re-

a feature or quality of the product, it may be labelled descriptive and protected only upon proof of secondary meaning.⁴² Thus, the current law is less accommodating to the descriptive message than it is to the associative and denominative.⁴³

4. *Allusive Message*

Like the descriptive message, the allusive message stems from the preexisting meaning of the chosen word or symbol. However, the word refers to the product only obliquely. Grocery store shelves are filled with products bearing labels such as BETTY CROCKER, AUNT JEMIMA, MRS. BUTTERWORTH'S, and the image of the Quaker on QUAKER OATS cereals. As fictional characters, these emblems indicate source only in the most indirect way. On the other hand, such emblems do convey a subtle message of hominess and comfort to shoppers. Similarly, the trade emblem CITGO for gasoline stations expresses a vague, but positive notion of being energetic, an especially valuable idea in the gasoline market.⁴⁴ Other trade emblems tap into other emotions. For example, HAAGEN-DAZ ice cream and PREGO pasta sauce suggest a foreign flair, even though a quick scan of the labels indicates that both products are domestic. Sellers hope that this foreign flair will appeal to consumers who consider imported

move from the public domain, and no amount of advertising or other evidence of secondary meaning is likely to succeed.”). For additional discussion of this issue, see note 70.

The concept of genericness applies to trade names, but in a somewhat different manner. Obviously, a trade name is the “common descriptive name” of the company. But a party cannot protect a trade name that is the generic name for the type of business in which the company engages. For example, a doughnut seller could not protect the trade name DONUT SHOP.

42. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992), *reh'g denied*, 505 U.S. 1244 (1992); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983); 1 GILSON, *supra* note 17, § 2.03, at 2-58 to 2-59.
43. As discussed *infra* text accompanying notes 73-81, trade emblems with a descriptive message may be refused protection because they are either “generic” or “primarily merely descriptive.” Other barriers may impede protection of these emblems. A trade emblem that uses a geographic term may be refused protection as geographically descriptive or misdescriptive. Lanham Act § 2(e), 15 U.S.C. § 1052(e) (1994). Other descriptive terms may be held to be “immoral” or “scandalous” under Lanham Act § 2(a), 15 U.S.C. § 1052(a) (1994).
44. Conversely, other companies change their names to avoid sending a negative allusive message. For example, KENTUCKY FRIED CHICKEN recently changed its name to the more neutral KFC, thereby avoiding the negative connotation of the word “fried.”

goods either superior or more exotic.⁴⁵ If any of these feelings are pleasant to shoppers, they may result in increased sales.⁴⁶

Although purchasing a product because of a vague sense of comfort is perhaps irrational, it commonly occurs. Therefore, both the descriptive and the allusive message can be important advertising tools. Both are especially valuable to first-time shoppers. When faced with a choice, many shoppers will opt for a familiar name instead of an arbitrary name. This gives a seller who uses a familiar emblem a head start in developing customer loyalty, for only by actually purchasing a product can a purchaser develop the experience necessary to generate the more influential associative message.

Unlike the descriptive message, little attention has been paid to the allusive. Admittedly, courts and commentators have on occasion acknowledged emblem marks' subtle power to influence purchasing decisions.⁴⁷ Similarly, the Federal Trade Commission has claimed in several cases that the descriptive or allusive message in a trade emblem could be a source of deception in the market.⁴⁸ These cases, how-

45. For example, restaurant chains are particularly fond of using names that express vague moods or attitudes as evidenced by T.G.I. FRIDAY'S and RALLY'S. Another common form of allusion is the use of geographic terms, not to suggest that the good or service originated in that locale, but to invoke purchasers' attitudes toward the place. Examples of this practice include LONDON FOG outerwear; THE OLIVE GARDEN and OUTBACK STEAKHOUSE restaurants; and OLD MILWAUKEE beer.

Sometimes the association is unintended. For example, NOKIA electronic products are made in Finland. Many Finns joke that the company's success is attributable to the name NOKIA (which is actually a small town in southern Finland), which sounds Japanese and therefore attracts purchasers who consider Japanese-made electronics superior.

46. On the other hand, when appealing to a particular segment of the public, a seller sometimes chooses a symbol that might be unattractive to the general population. How else can one explain the dispute in *Death Tobacco v. Black Death USA*, 31 U.S.P.Q.2d 1899 (C.D. Cal. 1993), in which the seller of BLACK DEATH vodka succeeded in preventing another company from selling DEATH cigarettes?

47. Perhaps the most eloquent discussion of the allusive message is in the Supreme Court's 1942 *Mishawashka Rubber* decision:

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential consumers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value.

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205 (1942). See also Schechter, *supra* note 17, at 818-19.

48. See *infra* notes 101-02 and accompanying text.

ever, fail to recognize the full implications of the powerful advertising messages inherent in these trade emblems.

A seller accordingly can pack up to four different messages in a single trade emblem. Of course, as with any form of shorthand, trade emblems have their drawbacks. Because most emblems are a word, short phrase, or image, they can lack precision. Much of the information contained in a trade emblem must be implied and may vary according to the individual shopper's own life experience.

Despite their potential inaccuracy, trade emblems nevertheless are useful communication devices. Obtaining information about a good or service takes time and effort that the buyer could expend in other efforts. While a trade emblem is perhaps not as accurate as a complex verbal description, it does quickly convey a rough sense of the relevant information. Buyers often are willing to forego a certain degree of accuracy in exchange for the tremendous reduction in their costs of gathering information.⁴⁹

The remainder of this Article will explore the significance of acknowledging that trade emblems are complex and important parts of a market language. The first issue that must be addressed is whether the current law of trade emblems is an effective way to deal with language. Second, even if the basic parameters of the system make sense, a language analysis may provide insight on some of the more troubling issues of trade emblem law.

C. Evaluating the Law of Trade Emblems in Light of the Principles of Language

Law cannot exist independent of language. As a social control mechanism, law depends on language to communicate important ideas to all members of society. Language affords the lawgiver the ability to operate proactively, communicating the social etiquette to all members of society in advance, instead of sitting in judgment after a breach of that etiquette has occurred.

But the traditional relationship between law and language is one way. Law ordinarily takes language as a given. A lawmaker attempting to draft an effective statute searches the existing lexicon for the proper combination of words that best expresses his idea. Even laws attempting to regulate the use of language, such as defamation and false advertising, do not attempt to define the words that comprise the language; instead, these laws are designed to prevent people from using the existing lexicon for improper purposes. Language in all of these cases is an extralegal axiom.⁵⁰

49. See *supra* text accompanying notes 18-20.

50. Of course, statutes often define certain key terms. As discussed *supra* note 20, languages use words only to express concepts that are familiar to the underlying

Nor does the law ordinarily stand in the way of change in the language. Authors such as Lewis Carroll and Dr. Seuss have sprinkled their works with coined words and phrases without any fear of legal retribution. These coined words often fall into common usage and thereby become part of the lexicon. Similarly, courts and legislatures rarely intervene to prevent the natural changes in the meanings of some words that occur over time.

The law will become directly involved with the content of language when language is used to deceive.⁵¹ People generally are free either to coin new words or to seek changes in the definitions of existing words. Creating a new word rarely will result in deception. Listeners can be fooled, however, if a person uses an existing word in a new way because the listeners may rely on the earlier definition. When reliance on the preexisting meaning injures listeners, the law often will intervene. Yet there are limits to what the law is willing to do, even in cases of deception. If society eventually adopts the new and changed meaning of the word, then the law too will accept that definition.⁵²

1. *The Basic Paradigm: Exclusivity in Trade Emblems*

Countless courts and commentators have analyzed the reasons for protecting trade emblems. Although their conclusions vary in some particulars, all agree that information is a primary concern.⁵³ Trade emblems provide a way of significantly increasing the amount of information available to shoppers at a relatively low cost.⁵⁴ That informa-

culture. Because statutes tend to change the existing order, often no existing word will precisely express the new concept created by the statute. Instead of coining an entirely new word for the new concept, legislators tend to take the closest word from the existing lexicon and give it a new meaning. This new meaning applies only for purposes of the existing statute, not for other forms of communication.

In a few situations, these statutes have changed the underlying language. It is possible for the "legal" definition of the word to overwhelm the lay definition, thereby becoming the primary meaning of the word in all communication. This is especially likely when the statute in question regulates common activities so that the legal definition will be used frequently.

51. See Landes & Posner, *supra* note 12, at 271.

52. A law that is codified in written form does not automatically change with changes in the language. Therefore, the words used in statutes may not always reflect modern parlance. For example, the United States Constitution gives Congress the power "[t]o promote the Progress of Science and the useful Arts" by enacting, respectively, copyright and patent laws. U.S. CONST. art. I, § 8, cl. 8. Translated into modern parlance, "Science" actually means art and literature, while the phrase "useful Arts" refers to science and technology.

53. For some of the better known examples, see 1 GILSON, *supra* note 17, § 1.03[2], at 1-22; 1 MCCARTHY, *supra* note 17, § 2.01[1], at 2-3; Schechter, *supra* note 17.

54. Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 762 (1990); Jerre B. Swann, *The Economic Approach to Genericism: A Reply to Folsom and Teply*, 70 TRADEMARK REP. 243, 244 (1980).

tion, however, is valuable only if it is accurate. Because unrestricted use of emblems can result in purchaser deception, the law allows only a single seller use of a given trade emblem.⁵⁵

It may seem that limiting the use of a trade emblem is a curious way to deal with deception. The linchpin of trade emblem law is its grant of a limited monopoly on language. This approach deviates remarkably from the way that the law and language normally interact. Although the law does not afford Dr. Seuss any exclusive right to the words he created,⁵⁶ the law does allow for ownership of coined words and symbols such as KODAK, XEROX, and McDonald's golden arches.⁵⁷

This limited ownership also can have a direct effect on the *content* of language. Unlike other people who coin words, the owner of a trade emblem has a considerable degree of legal control over the meaning of the word or symbol. The owner may employ society's legal machinery to prevent others from changing the meaning.⁵⁸ In these respects, trade emblem law differs from other laws dealing with deception.

Notwithstanding these quirks, the basic model of trade emblem law satisfies the core principles that should govern any law of language. Even though the system focuses on the "rights" of the seller, its overall effect is to protect shoppers from deception. A system of exclusive rights is especially useful given the nature of the message that the law seeks to regulate. Because the message deals in part with source, granting the actual source the power to police its message will help to control deception and thereby facilitate market communication.

Further, the law of trade emblems is not redundant within the context of other laws dealing with deception. The true source's strong

55. Restricting use to one seller limits deception by ensuring that commodities originate from the same source that shoppers have dealt with in the past. S. REP. NO. 79-1333 (1946).

56. Copyright does not protect individual words, short phrases, or simple designs. DONALD S. CHISUM & MICHAEL A. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW 4-31 & n.96 (1992). Copyright law can be used to protect more complex pictorial trade emblems, however.

57. On rare occasions, courts have invoked the policy disallowing ownership of the language to deny trade emblems rights to a seller. For example, in *Different Drummer, Ltd. v. Textron, Inc.*, 306 F. Supp. 672 (S.D.N.Y. 1969), the court refused to extend trademark protection to Thoreau's phrase "The man who hears a different drummer drumming" because it considered the phrase "the property of all English-speaking peoples." *Id.* at 674.

58. The law does more than simply provide the owner of a trade emblem a cause of action for damages. The Lanham Act, for example, provides for the seizure and destruction of infringing items, Lanham Act § 36, 15 U.S.C. § 1118 (1994), and orders customs officials to seize any imported products that infringe a United States mark, Lanham Act § 42, 15 U.S.C. § 1124 (1994). These provisions demonstrate that society will support a trade emblem owner's power to control the language.

financial incentive to protect its position makes the law of trade emblems equally or more effective than other laws regulating deception. If the owner of a trade emblem polices the area of market communication, the government is free to deal with other forms of deception. A language analysis therefore supports the fundamental scheme of exclusive rights.

2. *Basic Rules*

A system of exclusive private rights requires some sort of mechanism to determine which of the various claimants receives the exclusive right. In addition, it is necessary to determine the scope of these rights, including the sorts of trade emblems in which the rights exist, the geographic reach of the rights, and identifying acts that infringe on those rights. Courts and legislatures have responded to these needs by developing certain basic rules. Many of these rules, however, were developed without full consideration of the implications of language. Thus, it is necessary to determine how these rules affect communication in the marketplace. Although this Article casts these rules in a new light, the basic principles of trade emblem laws are essentially sound rules of language.

a. *Emblems That Can Be the Subject of Exclusive Rights*

Most legal systems protect a wide variety of trade emblems. In addition to words, the law will protect phrases,⁵⁹ drawings, and even product attributes, such as shape and color.⁶⁰ Generally, the law requires only that the seller use an emblem that shoppers will recognize as referring to a unique entity in the marketplace. The seller need not

59. *Roux Lab., Inc. v. Clairol, Inc.*, 427 F.2d 823 (C.C.P.A. 1970)(protecting "Hair Color So Natural Only Her Hairdresser Knows For Sure"); Application of *E. Kahn's Sons Co.*, 343 F.2d 475 (C.C.P.A. 1965)(protecting "The Weiner the World Awaited"); *Allstate Ins. Co. v. Allstate, Inc.*, 307 F. Supp. 1161 (N.D. Tex. 1969)(protecting "You are in good hands with ALLSTATE"). See generally 1 *Mc-CARTHY*, *supra* note 17, § 7.20-7.23, at 7-26 to 7-33 for other examples.

60. *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S. Ct. 1300 (1995)(protecting color); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), *reh'g denied*, 505 U.S. 1244 (1992)(protecting "trade dress"); *Kohler Co. v. Moen Inc.*, 12 F.3d 632 (7th Cir. 1993)(protecting product shape). However, because shoppers are more likely to assume that shape and color are functional parts of the product itself, it can be more difficult to prove that these trade emblems are distinctive indications of source. *Versa Prods. Co., Inc. v. Bifold Co., Ltd.*, 50 F.3d 189 (3rd Cir. 1995), *cert denied*, 116 S. Ct. 54 (1995); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16, cmt. b (1995). Indeed, even though the United States Supreme Court held in *Two Pesos* that distinctive trade dress could be protected without showing secondary meaning, its opinion in *Qualitex* assumes, without discussion, that secondary meaning must be shown in the case of color. See *Qualitex Co.*, 115 S. Ct. at 1303.

prove that shoppers can recall having seen the emblem before, nor that they can name the seller associated with the emblem.⁶¹

How this broad rule fits within the principles of language may not be obvious. Although it is easy to justify the inclusion of drawings, color, and other devices capable of communicating a message, a language analysis supports a seller's exclusive rights in such symbols only if the emblem will somehow reduce the amount of deception in the marketplace. The possibility of deception is clear when emblems have been used widely by purchasers and have developed a strong associative message. Shoppers who spot a familiar trade emblem will expect that the good or service associated with that emblem will be of approximately the same quality as it was in the past. Purchasers will be deceived if the emblem is used by a different seller because the actual quality of what they purchase may fail to meet their expectations.⁶² Therefore, allowing only the true source to use the emblem helps to prevent an emblem from conveying false associative and denominative messages.

But the law also protects emblems that have not developed an associative message. Such an emblem will not mislead shoppers because they have not yet formed any expectations concerning the product or service. Under this view, protecting these emblems cannot be justified as a means of policing the misuse of language in the market.

Nonetheless, even absent an associative message, a trade emblem may convey up to three other messages to shoppers. A shopper who spots a trade emblem will likely assume that the good or service is of a certain minimal quality, even if she has never before encountered the trade emblem. Moreover, an emblem that describes the good or suggests superiority will convey its message to all shoppers who are familiar with the preexisting meaning of the word. The current rules protecting trade emblems without secondary meaning can pass muster as rules of language only if the rules help reduce deception caused by other messages.

The descriptive message cannot serve as the basis for protection. First, because descriptive messages exist only in preexisting words, coined words and symbols will have no descriptive message. Yet, under the current scheme, coined trade emblems are the easiest to protect. More importantly, however, granting exclusive rights in an emblem based upon the descriptive message would defeat the basic goal of increasing efficient and accurate market communication. If one seller has exclusive rights to a descriptive term, competitors will

61. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992).

62. The law allows a party to recover for infringement without demonstrating that the infringer intended to deceive anyone or even knew that anyone else was using the emblem.

be precluded from using that term in connection with their commodities. Yet as long as the description is accurate, there is no reason why other sellers should be precluded from informing shoppers of that accuracy, even if they use the same words.⁶³ In fact, allowing competitors to use the same words to describe similar product features may actually improve the accuracy of communication by establishing some uniformity, which simplifies product comparisons. Like any prohibition of truthful advertising, granting exclusive rights in a descriptive emblem may impair the already limited flow of information in the marketplace.

It is more difficult to determine whether the allusive message is a basis for protecting trade emblems. Unlike the descriptive message, the allusive message relates only vaguely and indirectly to the commodity. It is more persuasive than informative. Moreover, there are usually multiple ways to express the same or similar sentiment, especially in a language as wordy as English. Therefore, in many cases the law could grant one seller exclusive rights to an allusive emblem without significantly impairing competitors.

Although such a rule may satisfy the needs of competition, it is much more troubling when viewed as a law of language. Granted, no great injury results if the law grants a seller an exclusive right in an allusive emblem. The lack of injury to competitors, however, is not itself a reason to grant exclusive rights. Outside the realm of trade emblems, the law does not afford a monopoly in a word merely because a party can show that word has numerous synonyms.⁶⁴ The party must instead demonstrate that the grant of exclusivity meets some other social goal, such as reducing deception or encouraging innovation. Limiting the ability of competitors to convey vague, yet true ideas about themselves, their good, or their service does not cure deception. Therefore, the allusive message cannot serve as a basis for exclusive rights in a trade emblem.

It is the denominative message that justifies granting exclusive protection to sellers. Unlike the descriptive and allusive messages, all trade emblems convey a denominative message. In addition, the denominative message will be false if more than one seller uses that emblem. Shoppers make certain basic assumptions about quality when they spot a trade emblem in the market. Hence, allowing a second company to sell the same product under the same emblem can deceive

63. See Landes & Posner, *supra* note 12, at 290.

64. The law of copyright also allows a party to gain exclusive rights in words and symbols. However, as discussed *supra* note 56, copyright is unavailable in single words, short phrases, and many of the simple symbols used as trade emblems. Even when the two areas of law do overlap, the purpose of copyright law is quite different. Traditional copyright law has little to do with deception. Instead, its purpose is to encourage the creation of new expressive works by ensuring that artists and authors can reap the financial benefits of their creations.

customers if each seller's product differs in quality. Granting one party an exclusive right in a particular trade emblem reinforces the denominative message by ensuring that all commodities bearing the same emblem do indeed originate from the same source. The denominative message supports the grant of exclusive rights in all words or symbols that shoppers recognize as trade emblems, regardless of whether they have yet developed an associative message.⁶⁵

In addition, granting exclusive rights in trade emblems conveying a denominative message will increase the total amount of information conveyed by trade emblems. First, granting exclusivity to a specific emblem will make it easier for that emblem to acquire an associative message because an emblem cannot convey an associative message unless shoppers have consistent experiences with the product. By ensuring that a single emblem is always connected with a single source, a grant of exclusive rights helps purchasers develop these associations between the emblem and quality. Second, granting exclusive rights increases the strength of all trade emblems. Unless shoppers know that they can depend on a one-on-one connection between a trade emblem and a source, they are not likely to trust their experience as a basis for making purchasing decisions. The current rule verifies the denominative message, encouraging shoppers to buy other branded products and develop other associative messages.

This rationale is quite different from the arguments used to support exclusive rights in other forms of intellectual property. Unlike patent and copyright law, society is not rewarding the seller for creating something new. Trade emblem law instead gives rights in trade emblems out of a recognition that the seller's adoption of a trade emblem may make communication in the market more efficient. As a corollary, rights in a trade emblem should exist only as long as the emblem continues to convey accurate information.

b. Seniority and Ownership

A language analysis also supports the basic means by which ownership rights in trade emblems are allocated. Most legal regimes assign the exclusive rights to whomever first "adopts" the emblem. In some situations, such as corporate-name laws and many foreign trademark systems, adoption occurs when the party registers the emblem with a government agency. Other laws, such as the common law rules governing trademarks and trade names, require actual use of the emblem.⁶⁶

65. This assumes that the emblem is recognized as conveying a denominative message. As discussed *infra* text accompanying note 76, certain descriptive phrases may not be perceived as sending a denominative message.

66. Although the trademark systems of Canada and the United States descend from the common law tradition, both are now hybrids that determine rights based on

It may seem that language analysis would not mandate a system based on seniority. The denominative message will be accurate as long as the law guarantees that the emblem is used by only one seller. If the only goal is to ensure an accurate denominative message, *which* seller receives the mark is not particularly important. Nevertheless, the seniority rule does further the considerations relevant to language.⁶⁷ Society maximizes the amount of information conveyed by a trade emblem by allowing that emblem to develop an associative message. That message can develop only if the emblem indicates only one level of quality to shoppers. Because at least some purchasers will have dealt with the entity who first uses the emblem, it follows that giving exclusive rights to that entity will best protect any nascent associative message.⁶⁸

c. *Categories of Trade Emblems*

A language analysis also supports and even offers additional insight into some of legal distinctions regarding trade emblems. These distinctions are the most developed in trademark law, which divides marks into five different categories: fanciful, arbitrary, suggestive, descriptive, and generic. Fanciful, arbitrary, and suggestive marks are protectable immediately upon adoption. Descriptive marks, by contrast, receive no protection until they acquire secondary meaning.⁶⁹

both registration and actual use. This is largely in response to the Paris Convention for the Protection of Industrial Property, March 20, 1883, 25 Stat. 1372, 13 U.S.T. 1, which requires signatories to honor rights that are based on domestic registration.

67. Copyright, the other major legal regime providing exclusive rights in words and images, also bases rights on seniority. However, the reasons for a seniority rule in copyright are clear. Unlike trade emblem rights, copyright is a reward for creativity. Therefore, only the creator—the “senior user”—should qualify for legal rights.
68. A registration-based system accomplishes the same end. As first used at common law, a seller who registers a trade emblem has the exclusive right to use it in a given market. This helps the associative message develop by ensuring that the word or symbol will always refer to only one seller. Trade emblem law differs only in that the seller in a registration-based system can “reserve” the emblem, which provides some flexibility to decide where and how to present it to shoppers. In some ways, a registration-based system is more effective than a use-based system. Such a system can help prevent wasteful disputes among sellers by providing a quick and easy way for them to determine whether someone else has claimed the word or symbol.

Basing trade emblem marks on seniority may help feed the notion that trade emblem law is a subset of intellectual property law. Patent and copyright protection similarly vest in the first person either to create or to file. However, as the text demonstrates, although both trade emblem and intellectual property law consider seniority, they do so for very different policy reasons.

69. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), *reh'g denied*, 505 U.S. 1244 (1992); *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938); *Talk to Me Prods., Inc. v. Larami Corp.*, 992 F.2d 469 (2nd Cir. 1993);

Generic marks can never be protected in most jurisdictions in the United States.⁷⁰

These distinctions accord with the principles of language. The only reason for society to afford a seller exclusive rights in a trade emblem is to foster accurate associative and denominative messages. Protecting fanciful marks easily satisfies this standard. A fanciful mark is a word or symbol that has been coined by the seller. Because it has no intrinsic meaning, the only messages it can convey are associative and denominative. The seller who adopts a fanciful mark has added a new word with a single definition to the vocabulary of the market.

In each of the other four categories, however, the word or symbol has a preexisting meaning. Depending on that meaning, these marks may also convey an allusive or descriptive message. If the allusive or descriptive messages are strong, they may predominate in market communication. Accordingly, the distinction between arbitrary, suggestive, descriptive, and generic marks can be explained only by evaluating the respective strength of the various messages conveyed by the mark. The law should protect a mark with a preexisting meaning only if the seller demonstrates that shoppers recognize the denominative message in the mark.

Arbitrary marks are the easiest to analyze. These marks convey neither an allusive nor a descriptive message. Although the mark is a recognized word, that word is not used in its normal context. In fact, the use of the word falls so far outside its normal context that shoppers do not perceive it as conveying any information concerning the good or service. Thus, for example, when the seller of COMET cleanser first used the mark, it conveyed only a denominative message and accordingly could be protected immediately.

Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947 (7th Cir. 1992); Holeproof Hosiery Co. v. Wallach Bros., 172 F. 859 (2nd Cir. 1909). *See generally* 1 GILSON, *supra* note 17, § 2.03, at 2-58-73.

70. *See supra* note 41. *See also* Aloe Creme Lab., Inc. v. Milson, Inc., 423 F.2d 845 (5th Cir. 1970)(suggesting that granting exclusive rights in a common product name would violate public policy); Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292 (N.D. Cal. 1991)(holding that "386" is the generic name for a type of microprocessor); First Nat'l Bank v. First Nationwide Bank, 15 U.S.P.Q.2d 1457 (W.D. Mo. 1990)(holding that FIRST NATIONAL BANK can never be protected).

Gilson also indicates, however, that some types of generic marks can be "recaptured" by showing secondary meaning. 1 GILSON, *supra* note 17, § 2.02[7], at 2-49. Recapture cases involve the special situation where a mark, although originally a suggestive, arbitrary, or fanciful term, gradually comes to be considered by consumers as the generic name for the product. If those terms later regain their distinctive meaning, the courts will protect them. The doctrine of recapture ordinarily does not apply to trade emblems comprised of inherently generic words.

A similar rationale supports the protection of suggestive marks. Since shoppers make some connection between the mark and the commodity, shoppers will receive either an allusive or a descriptive message. For example, while the mark UPTOWN on records may convey an allusive message,⁷¹ the same mark on a taxi service might be descriptive. A mark will be labelled suggestive, however, only if the connection between the mark and the commodity is not facially obvious, requiring shoppers to use their imagination to make the connection.⁷² Because the connection is less direct, the mark will likely be interpreted by shoppers as more than just a description of the good or service. This additional meaning is a denominative message, which allows shoppers to use the mark as a repository for their experience.

Descriptive and generic marks, in contrast, represent a shift in this balance. A generic mark ordinarily is a noun⁷³ for which the preexisting meaning is the name of the product or service. For example, although the mark APPLE may be arbitrary for computers, it is generic for apples. A descriptive mark is an adjective that explicitly describes some aspect of the good or service. In the case of an apple, RED, SWEET, and FRESH would be descriptive.⁷⁴

Both generic and descriptive marks convey strong descriptive messages.⁷⁵ Unlike suggestive marks, however, the descriptive message overwhelms the denominative. If shoppers do not perceive a denominative message, protection of these marks is unjustified. In

71. *Sunenblick v. Harrell*, 895 F. Supp. 616 (S.D.N.Y. 1995), *aff'd*, 101 F.3d 648 (2nd Cir. 1996), *cert. denied*, 117 S. Ct. 386 (1996).

72. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983); *General Shoe Corp. v. Rosen*, 111 F.2d 95 (4th Cir. 1940), *reh'g denied*, 112 F.2d 561 (4th Cir. 1940). See generally 1 GILSON, *supra* note 17, § 2.04, at 2-74 to 2-78.

73. Courts, however, are more frequently finding that even adjectives can become generic. For example, the court in *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75 (7th Cir. 1977), found that the term LITE, when used in connection with beer, had become the generic name for a particular subcategory of beer. For a criticism of this trend, see 1 GILSON, *supra* note 17, § 2.02, at 2-16 n.2. The Seventh Circuit also expressed some discomfort with the reasoning in *Miller* in its opinion in *Henri's Food Products, Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303 (7th Cir. 1987).

74. As used in this Article, the term "descriptive message" is not meant to be coextensive with descriptive marks. Although descriptive marks will convey descriptive messages, they are not the only category of trade emblems that can do so. A suggestive mark such as PIZZA ROLLS for snack food also conveys a descriptive message. *Jeno's, Inc. v. Commissioner*, 227 U.S.P.Q. 227 (D. Minn. 1985). In this case, however, the description is less direct.

75. Descriptive marks may also convey allusive messages. For example, the mark YESTERYEAR, although descriptive when used on tapes of old radio programs, also invokes a vague sense of nostalgia. *Premier Elec. Lab v. Aston*, 686 F. Supp. 815 (C.D. Cal. 1987), *vacated*, 914 F.2d 1496 (9th Cir. 1990). In that case, the descriptive message overwhelmed the allusive, and the court therefore found the mark descriptive. However, in trade emblems where the allusive message prevails, the emblem will likely be suggestive.

fact, granting exclusive rights in descriptive and generic marks will impair, rather than facilitate, communication. Returning to the earlier example, the only denominative message that shoppers derive from the mark APPLE on apples is that the product is indeed an apple. This may distinguish the commodity from a pear or nectarine, but not from apples sold by other sellers. Similarly, although shoppers can use the word SWEET to distinguish the seller's apples from other varieties, shoppers cannot use the term to distinguish this particular SWEET apple from other melliferous apples. As a result, purchasers will not perceive the term SWEET as denominating a single source.

Yet, a seller with a descriptive mark is not absolutely precluded from protection. A descriptive mark can be protected by showing that it has acquired secondary meaning.⁷⁶ The doctrine of secondary meaning or "acquired distinctiveness" recognizes that although a mark is not inherently distinctive, over time shoppers may come to associate it with a single source.⁷⁷ Secondary meaning develops through shopper experience. This is not the same as the associative message, however. Shoppers will develop an associative message only if they actually obtain and use the commodity. Secondary meaning can develop merely if shoppers repeatedly see the emblem on the store shelves.⁷⁸ Therefore, secondary meaning is part of the denominative, rather than the associative, message.⁷⁹

From a language perspective, calling this shopper experience a secondary meaning is particularly ironic. The acquisition of "secondary" meaning is really a change in the *primary* definition of the word, at least when that word is used in the context of a particular good or service.⁸⁰ This change in definition occurs as purchasers begin to rec-

76. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *cert. denied*, 116 S. Ct. 1044 (1996). The Lanham Act does not use the term "secondary meaning," but instead speaks in terms of marks that have "become distinctive of the applicant's goods." Lanham Act § 2(f), 15 U.S.C. § 1052(f) (1994).

77. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (1995). See also *G. & C. Merriam Co. v. Saalfeld*, 198 F. 369, 373 (6th Cir. 1912).

78. Of course, secondary meaning can also develop if shoppers purchase and use the commodity. In fact, secondary meaning is likely to develop more rapidly when shoppers purchase the good because they are likely to pay more attention to the branding of something that they purchase.

79. This distinction becomes clearer when one considers the content of the message. The message inherent in secondary meaning is simply that the commodity comes from a single source. Unlike the associative message, it has nothing to do with the actual quality of the commodity.

80. Courts also have recognized the problems with the term secondary meaning. See, e.g., *Coca-Cola Co. v. Seven-Up Co.*, 497 F.2d 1351 (C.C.P.A. 1974)(holding a trademark that has acquired secondary meaning has a new primary meaning); *Spang v. Watson*, 205 F.2d 703 (D.C. Cir. 1953)(same).

In terms of a language analysis, the current concept of "secondary meaning" is actually a hybrid of two logically distinct ideas. First, if a seller borrows a word

ognize the mark as denominating a single source. The newly recognized denominative message replaces the descriptive message as the primary meaning of the emblem. Because this new meaning relates to source, the law is justified in giving exclusive rights to marks with a primary meaning made up of denominative, and in some cases associative, messages.⁸¹

These same principles, however, suggest that barring rights in generic marks is misguided. A generic mark transmits primarily a descriptive message. Although change in that message certainly is less likely than in the case of descriptive marks, shoppers might nonetheless come to perceive the mark as an indication of source rather than the name of the good.⁸² If the primary meaning does change, courts should acknowledge that the denominative message prevails over the descriptive and should protect the mark.⁸³

Aside from the question of secondary meaning for generic marks, the five categories of marks help courts accommodate the different messages encompassed in different marks. Fanciful, arbitrary, and suggestive marks can be protected from the moment of adoption be-

as a trade emblem from the existing vocabulary, that word will have a preexisting primary meaning. If shoppers recognize that the word is an indication of source, however, that word will have a "secondary" meaning when used in the context of the seller's specific good or service. This version of secondary meaning does not require purchasers to have any experience with the good. Second, secondary meaning can refer to the overall message that shoppers receive when viewing the emblem, a composite of the four component messages. Two of these messages, the denominative and the associative, will gain in strength as shoppers are continually exposed to the emblem. If shoppers have had experience with a branded product, the denominative and associative messages may override the descriptive and allusive messages so that shoppers will interpret the emblem as indicating a single source. To buyers without that experience, however, the descriptive or allusive messages may prevail.

81. The same conclusion applies to misdescriptive trade emblems. These emblems convey a predominantly descriptive message that happens to be false. If that descriptive message predominates, the emblem should be unprotected. In fact, because the message may deceive shoppers, the case for denying protection to misdescriptive emblems is even stronger. On the other hand, a misdescriptive trade emblem should qualify for protection if it acquires secondary meaning. Because the denominative message is so strong, shoppers will ignore the content of the descriptive message and construe the emblem solely as a means to differentiate the seller from its competitors.
82. A generic term is more likely to acquire secondary meaning if it has one or more synonyms. If a single seller adopts one of the synonyms, shoppers could readily come to associate the term with that seller.
83. In fact, from the perspective of language, it is an oxymoron to speak of a "generic" term with "secondary" meaning. As noted above, the acquisition of secondary meaning results in a change in the primary meaning of the emblem, at least when it is used in market communication. If the primary meaning of the term now relates to a particular seller, the term is no longer interpreted by shoppers as a product name. Courts should therefore admit evidence of secondary meaning in all cases to determine the real meaning of the word in the market lexicon.

cause such marks convey a clear denominative message. Generic and descriptive marks, on the other hand, convey a predominantly descriptive message. Until continued experience with the mark causes shoppers to revise the mark's definition, the law should not provide exclusive rights in such a mark. Generic and descriptive marks should be like all other words in the lexicon of the market—free for all to use.

d. Defining the Market Itself: Geographical Limitations

Common law rights in a trade emblem are limited geographically. For most trade emblems, the owner is entitled to exclusive rights only within a given market.⁸⁴ This market is the geographic area where the commodity using the emblem is sold or, in the case of a trade name, where the firm does business.

A language analysis supports limiting trade emblem rights to identifiable markets. After all, trade emblem rights are an exception to the general policy against granting exclusive rights in language. Any grant of exclusivity should be no greater than necessary to prevent deception. Granting exclusive rights in trade emblems certainly helps to check deception within the market where the seller does business. If multiple sellers use the same emblem, the denominative message and any associative message conveyed by that emblem will be false. Extending exclusive rights beyond that market, however, will not further reduce deception. Outside of the owner's market, none of the four messages are false because the emblem has no accepted definition.⁸⁵

84. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

85. To illustrate, suppose that a seller wants to adopt a trade name identical to the name already used by a different firm engaged in a similar business but in a different market. Suppose further that this particular trade name conveys all four of the possible messages. The law would be justified in preventing the seller from using the mark if any of the four messages conveyed by the seller prove to be false.

The associative message presents the easiest question. That message depends on purchaser familiarity with products from a given source. Even if purchasers in the owner's market have gained familiarity, purchasers in the other market who have not dealt with the owner cannot mistakenly rely on their past experiences. Therefore, forbidding the junior user from using the trade name is unnecessary to prevent a false associative message. In fact, inefficiency results because the new user is prohibited from using the mark to develop its own associative message.

The other three messages, however, do not depend on whether shoppers have used the product. In each market, a purchaser who sees the trade name will receive precisely the same denominative, descriptive, and suggestive messages. None of these messages is "false," however. As long as the two firms are engaged in the same business activity, the descriptive and suggestive messages are equally valid from each seller. Likewise, because the prior user is not participating in the seller's market, the trade name is accurate because it denominates only a single firm in each market. If all three of these messages are true in both mar-

Therefore, confining rights to the area where the trade emblem is used represents the correct balance between the interest in developing accurate and efficient communication and the countervailing interest of ensuring that the language is as free as possible for all to use. In terms of language, each market can develop its own dialect, comprised of the words and symbols used in that market.⁸⁶ If multiple sellers use the same emblem in different markets, the same word can develop different meanings in each market, depending on the associative message that each seller develops. Because each dialect is in essence the official language of that market, no real purchaser confusion results.

Nevertheless, the common law principles that confined trade emblem rights to markets is increasingly the exception rather than the rule. State and federal trademark laws often define rights in terms of political rather than economic regions. The Lanham Act, for example, affords nationwide rights to trademark owners. Similarly, corporate name laws give a company the exclusive right to use a name throughout an entire state or nation. Neither the trademark nor the corporate name laws require that the trade emblem actually be used throughout the entire area.

Although significantly expanding the range of the exclusive rights, these statutes do facilitate market communication. In essence, they represent a concession to modern realities. Markets are no longer the relatively static entities that they were in the 19th century. Advances in technology, especially in travel and communication, have led to rapid fluctuations. Today it is quite common for a purchaser who usually shops in one market to travel to, and buy in, a different market. If the same words have different meanings because of the "dialect" of the market, cross-border purchasers are likely to make erroneous purchasing decisions. At the same time, firms are continually expanding, thereby resulting in market growth. Even in countries as large as Canada and the United States, nationwide distribution is increasingly common and has become the norm in many industries. Similarly, recent trade agreements such as the European Union and NAFTA allow for transnational markets.

kets, a prior user should be unable to prevent another seller from adopting the name in a different market.

86. This analysis admittedly is quite simplified insofar as it focuses on the market for a single good or service. In the real world, of course, shoppers purchase a vast array of different goods and services. Each good and service actually involves a submarket. Because each good and service will be distributed in different areas, the boundaries of different submarkets will likely differ. Therefore, the overall vocabulary of the market will vary from place to place depending upon the boundaries of the submarkets. Although this Article simplifies the issue by focusing on a single product, its conclusions apply with equal force to a multiproduct market.

In recognition of this trend, a trade emblem statute like the Lanham Act attempts to define a national dialect that everyone in the national market will understand. Registration provisions are the crux of these statutes. In a sense, registration is akin to the creation of a dictionary that standardizes the vocabulary of the national market. Following registration, the registrant can prevent others from using the emblem on similar commodities anywhere in the nation. As a result, a given trade emblem can acquire only one associative message for the entire nation.⁸⁷ In addition, because the registries are public records, shoppers can quickly ascertain the content of the denominative message.

A uniform market vocabulary helps prevent the confusion that might otherwise arise because of regional market dialects. It also reinforces the general assumptions of quality and consistency that shoppers connect with trade emblems. In this way, registration statutes increase the overall accuracy and efficiency of trade emblems better than the common law rules.

e. Infringement

Infringement is the primary means of enforcing trade emblem rights. To prevail on an infringement claim, the owner of a trade emblem must prove that the defendant's use is likely to result in purchaser confusion. Courts determine likelihood of confusion by referencing to a number of factors.⁸⁸

A language-based analysis suggests a similar approach. Because the law grants trade emblem rights only as a means to prevent purchaser misunderstanding, the owner should have a right to sue only in cases where misunderstanding is likely to occur. Determining likelihood of confusion presents certain special considerations. A trade emblem is especially vulnerable to shopper misunderstanding because its most important advantage—its ability to convey a great deal of information in a small package—is also one of its major weaknesses. Confusion of any one of the four messages of a trade emblem can cause the purchaser to misinterpret the overall message. Therefore, the law needs the flexibility to recognize errors in any of the component messages.

In any communication, the likelihood that a reader or listener will confuse one word for another depends on several factors. The key factor is the similarity between the words themselves. Determining simi-

87. The trademark registration symbol helps in this regard. When purchasers observe the symbol, they know that the trade emblem has a national, rather than a local, definition.

88. United States courts do not entirely agree on the factors that should enter into a determination of likelihood of confusion. For an excellent comparison of the leading views, see 1 GILSON, *supra* note 17, § 5.01[3][i], at 5-16 to 5-29.

larity is not a mechanical comparison, but a flexible analysis that must consider a variety of factors, such as spelling and pronunciation. Similarities in meaning or connotation may also cause readers or listeners to confuse otherwise dissimilar terms. Finally, because words gain meaning from the contexts in which they are used, the context in which a word appears may affect the possibility of misinterpretation.

The "likelihood of confusion test" in trade emblem law follows the same approach, comparing the marks and their respective markets. The primary factors are the visual and aural similarity of the marks.⁸⁹ Courts also look to similarities in the meanings of words, even when the appearance and pronunciation are markedly different.⁹⁰ Because many trade emblems are existing words, this factor recognizes that purchasers may use the descriptive or allusive messages to help distinguish emblems. Finally, the analysis also considers the "context" by focusing on similarities or differences in the commodities with which the emblem is used.⁹¹ Therefore, the likelihood of confusion test is flexible enough to recognize the different means by which purchasers may confuse consumers.

In virtually all respects, then, the basic principles of trade emblem law fare remarkably well when subjected to a language analysis. Although a trade emblem is a word in the vocabulary of the market, giving the person who first adopts an emblem a limited exclusive right in that word provides a means to police market deception. To be fully effective, that exclusive right should extend to all situations in which a seller uses a trade emblem to convey essentially the same messages. The right to exclude, however, should be limited geographically to the area in which the trade emblem has a denominative message. Although this normally will include areas in which the emblem is used, a legislature may expand this zone of exclusivity to deal with situations of expanding markets or porous market boundaries. Finally, the likelihood of confusion test limits the seller's exclusive rights to situations where shoppers may be deceived.

These basic rules represent merely the skeleton of trade emblem law. Legislatures and courts have fleshed out these principles with

89. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. c (1995) ("The starting point in any infringement case is a comparison" of the marks.). Although most cases involve a defendant who uses a trade emblem, confusion can also occur in other ways. For example, in *Dial A Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989), the plaintiff was allowed to challenge the defendant's phone number. The defendant's number, 628-8737, spelled "MATTRES," a term almost identical to the plaintiff's trade name.

90. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21(a)(v) (1995) (indicating that courts should look to the "suggestions, connotations, or meanings" of words).

91. American consumers, for example, have little trouble recognizing that the mark DELTA has very different meanings depending upon whether they see it used in connection with airlines, plumbing fixtures, or dental plans.

detailed rules and tests. Most of these rules and tests were developed without any conscious consideration of the effects that trade emblem law has on communication in the market. Therefore, each of the many specific rules of trade emblem law needs to be reevaluated from the perspective of language.

A comprehensive review of trade emblem law is far beyond the scope of this Article. It will take the judiciary a number of years to explore whether various rules of trade emblem law facilitate communication. Nevertheless, this Article facilitates such a review in two ways. First, it demonstrates how some of the "problem" areas of trade emblem law can be analyzed as questions of language. Second, it places the law of trade emblems in its broader context by identifying legal rules that, although generally considered to be outside the realm of "trade emblem law," nevertheless work with trade emblem law to regulate communication in the market.

III. APPLYING THE PRINCIPLES OF LANGUAGE: PROBLEM AREAS IN THE USE OF TRADE EMBLEMS

Part I of this Article demonstrated that the traditional paradigm of trade emblem law fails to recognize that trade emblems often convey several different messages. Admittedly, legislatures and courts operating under the traditional paradigm have established a basic infrastructure that satisfies the principles of language. Yet the devil is in the details; use of the traditional paradigm has caused many problems. Some problems arise because the traditional paradigm fails to acknowledge the complex ways in which trade emblems communicate information. Other problems arise because courts and legislatures have failed to recognize that trade emblem law does not stand alone, but is merely one of several ways that the law affects the language of the market.

The remainder of this Article will explore a few of these questions. Resolving these various problems by using an approach that focuses on the various messages in trade emblems helps illustrate the comprehensive nature of that approach.

A. False Advertising in the Use of Trade Emblems

The law protects trade emblems because of their important role in increasing the amount of information conveyed in the market. But information is valuable only if it is accurate. Therefore, although the law encourages the use of trade emblems, it also includes devices to ensure their accuracy.

The law of trade emblems certainly helps in this endeavor. As demonstrated above, the basic claim of infringement is a means of controlling false information. Use of similar emblems on similar products

may convey a false denominative message and possibly a false associative message. Granting the right to bring legal action in such situations preserves the accuracy of these messages.

Many emblems also send descriptive or allusive messages. These messages provide relevant information about the product or service being sold. Many shoppers rely on the descriptive and allusive messages when making purchasing decisions, particularly when they have not developed an associative message with the emblem. That descriptive or allusive message can be false if the product lacks the characteristic suggested by the emblem. Because shoppers may rely on the information conveyed by the emblem, using a trade emblem that conveys a false descriptive or allusive message can lead to considerable deception in the market.⁹²

Trade emblem law provides some means for dealing with this problem. The Lanham Act, for example, commands the Patent and Trademark Office to deny registration to marks that are "deceptive"⁹³ or "deceptively misdescriptive."⁹⁴ Yet, the PTO's power to control false

92. Although the allusive message can lead to deception, the vast majority of deception is attributable to false descriptive messages. Because the allusive message is so vague, it is unlikely to create any clear expectations in purchasers concerning the product.

93. Lanham Act § 2(a), 15 U.S.C. § 1052(a) (1994).

94. *Id.* § 2(e). The Patent and Trademark Office has relied on both provisions to refuse registration to marks that convey false information. *See, e.g.*, *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786 (C.C.P.A. 1964)(refusing to register DURA-HYDE for artificial leather); *Singer Mfg. Co. v. Biringal-Bigsby Corp.*, 319 F.2d 273 (C.C.P.A. 1963)(refusing to register AMERICAN BEAUTY for sewing machines made in Japan); *Caldwell Lane Leather Co. v. Western Filament, Inc.*, 173 U.S.P.Q. 695 (Trademark Tr. & App. Bd. 1972)(refusing to register NEO-HIDE for artificial leather). *But see* *Scotch Whiskey Ass'n v. Majestic Distilling Co.*, 958 F.2d 594 (4th Cir. 1992)(using BLACK WATCH on whiskey will not deceive purchasers into thinking that the product comes from Scotland); *Fleischwaren-Export-Gesellschaft M.B.H. v. Columbia Packing Co.*, 177 U.S.P.Q. 220 (Trademark Tr. & App. Bd. 1973)(allowing registration of DEUTSCHMACHER ("German maker") for meat products not made in Germany).

Many courts have found it difficult to distinguish § 2(a) and § 2(e) of the Lanham Act. One author has suggested that the distinction turns on whether the representation is material. Kenneth B. Germain, *Trademark Registration Under Sections 2(a) and 2(e) of the Lanham Act: The Deception Decision*, 44 *FORDHAM L. REV.* 249, 267 (1975). According to this theory, a deceptively misdescriptive mark misleads consumers, but does not cause them to purchase the product. A deceptive mark, by contrast, does influence the purchase. Although this theory fits well with the statutory language in most respects, it inadequately explains why § 2(e) refuses registration to a mark that causes no purchaser injury.

In addition to its other advantages, a language analysis of the law of trade emblems offers another way to distinguish § 2(a) and § 2(e). A trademark, like any trade emblem, can convey multiple messages. Deception in any of the messages is possible. A "deceptively misdescriptive" mark could incorrectly describe some aspect or feature of the good or service. Although any false descrip-

information is limited. Although it can deny registration, the PTO lacks any authority to order anyone to cease using a misleading mark.

The law of trade emblems also calls upon private parties to police this form of deception.⁹⁵ In addition to the infringement provisions, which allow private parties to police false denominative and associative messages, a seller may sue a competitor who engages in false advertising under § 43(a) of the Lanham Act, analogous state statutes, or at common law.⁹⁶ These causes of actions often have been employed against sellers who use trade emblems that send false descriptive messages.⁹⁷ Likewise, shoppers who are induced by a misleading trade emblem to purchase the seller's goods or services may bring suit

tive message can be misdescriptive, it becomes "deceptively" misdescriptive only if consumers purchase the product in reliance on the representation. A "deceptive" mark could make a representation unrelated to quality or features. For example, in *Goodman v. Federal Trade Commission*, 244 F.2d 584 (9th Cir. 1957), the Federal Trade Commission obtained a cease and desist order against a seller who did business under the trade emblem WEAVER'S GUILD, arguing that use of the term was misleading where no such guild actually existed. This representation differs from the typical case because the mark did not describe the product itself. Therefore, use of the WEAVER'S GUILD emblem was "deceptive" without being "misdescriptive."

The difference between § 2(a) and § 2(e) is more than mere form. A "deceptive" mark can never be registered. However, § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1994), allows the owner of a deceptively misdescriptive mark to register it upon proof of secondary meaning. The suggested distinction supports this rule. If a mark acquires secondary meaning, it acquires a strong associative message based on consumer distinction. Because purchasers who use a product know its features, secondary meaning will overcome any deception that may be generated by a deceptively misdescriptive mark. The types of representations involved in a deceptive mark, however, cannot be verified by experience. A consumer might purchase WEAVER'S GUILD products for years and yet never determine whether such a guild existed. Because experience cannot overcome the falsity in a deceptive message, merely because the emblem has acquired secondary meaning should not make a difference.

95. It is interesting to note that trade emblem law approaches the issue of false advertising in an entirely different way than it approaches confusion as to source. Instead of giving one party an exclusive right to police the market, the law enlists the help of all competitors.
96. The leading state statute is the Uniform Deceptive Trade Practices Act, which at least 11 jurisdictions have adopted in some form. A few states have adapted the Uniform Trade Practices and Consumer Protection Law, a very popular consumer protection statute, by extending its protections to competitors. The two main common law actions are deception and disparagement.
97. See, e.g., *Nester's Map & Guide Corp. v. Hagstrom Map Co.*, 760 F. Supp. 36 (E.D.N.Y. 1991)(using the word OFFICIAL on a guide book falsely implies the book was endorsed by a public authority); *Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, 559 F. Supp. 1270 (S.D.N.Y. 1983)(calling an airline service a SHUTTLE implies certain characteristics that defendant's airline did not offer).

under federal and state law, although curiously not under the Lanham Act.⁹⁸

Even with these safeguards, trade emblem law cannot always ensure accurate information. A variety of reasons explain why competitors and purchasers may be unwilling or unable to sue a seller who is deceiving purchasers by use of a trade emblem.⁹⁹ Unless competitors and purchasers cooperate, the law of trade emblems cannot itself control the truth of the descriptive and allusive messages.

Of course the law has a variety of tools other than trade emblem law to control false information. Some mechanisms follow the model of trade emblem law and rely on private individuals. For example, someone injured by a false statement may be able to recover for defamation. Similarly, the law of express warranty gives purchasers the right to recover for injuries caused by their reasonable reliance on a false representation by the seller. In addition, the law sometimes enlists the aid of government, especially when speech in the market is involved. In the United States, the Federal Trade Commission is the main government agency charged with controlling market deception.¹⁰⁰ Unlike the PTO, the FTC has the authority to order a seller to stop a deceptive trade practice.¹⁰¹ Although the vast majority of cases involve claims made in advertising, the FTC has on occasion used its authority to challenge the use of trade emblems.¹⁰²

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98. The Magnuson-Moss Warranty Act, 15 U.S.C. § 2301 (1982), protects consumers against sellers. Consumers may also look to state contract law, as modified by the state's version of Uniform Commercial Code, for relief. However, as explained in *supra* note 9, most courts prohibit use of § 43(a) of the Lanham Act to sue sellers engaged in false advertising.
 99. For a discussion of some reasons why private remedies may prove ineffective, see Robert Pitofsky, *Beyond Nader: Consumer Protection and the Regulation of Advertising*, 90 HARV. L. REV. 661 (1977).
 100. The Federal Trade Commission is not the only agency involved in this task. The Securities and Exchange Commission, the Food and Drug Administration, and a number of state agencies also police deception.
 101. 15 U.S.C. § 45(a)(2), (b) (1994).
 102. Most reported decisions involve trademarks and service marks. Indeed, one of the best known FTC cases dealt with a misleading trademark. In *Charles of the Ritz Distributors Corp. v. Federal Trade Commission*, 143 F.2d 676 (2nd Cir. 1994), the defendant used the mark REJUVENESCENCE on a facial cream. The FTC claimed that the mark, coupled with an extensive advertising campaign, falsely implied that the cream could actually restore skin. *Charles of the Ritz* is best known for its discussion of the "fool's test," applied by the FTC until 1984, to determine whether an ad was deceptive. The case is also notable because it involved a deceptive trademark.

The FTC has declared trade emblems deceptive in several other cases. See, e.g., *Arrow Metal Prod. Corp. v. FTC*, 249 F.2d 83 (3rd Cir. 1957)(selling plastic-coated products as PORCENAMEL is deceptive because it implies a porcelain enamel coating); *FTC v. Good-Grape Co.*, 45 F.2d 70 (6th Cir. 1930)(holding imitation fruit drink sold as GOOD-GRAPE is deceptive); *Stanley Labs. v. FTC*, 138 F.2d 388 (9th Cir. 1943)(using MD in trademark for powder is deceptive because

Although the law has a variety of tools to deal with deceptive trade emblems, none were designed to deal with the unique language problems posed by trade emblems. To satisfy the criteria of a language analysis, the law of deception must be sensitive to the various messages conveyed by a trade emblem. A trade emblem that misdescribes a good or service may still send an accurate denominative and associative message to shoppers who recognize that the word or symbol is used as a means of identification. These messages may affect the strength of the descriptive message that shoppers actually perceive. Therefore, before concluding that an emblem is deceptive because of a false descriptive or allusive message, a court needs to consider *all* of the messages conveyed by that emblem and determine the total packet of information that purchasers derive from that emblem. A strong denominative or associative message may override any false descriptive or allusive message, thereby preventing deception.

Courts applying trade emblem law do not completely recognize this possibility. Under the Lanham Act, a *deceptively misdescriptive* mark can be registered if the applicant demonstrates that the mark has acquired secondary meaning.¹⁰³ *Deceptive* marks, on the other hand, cannot be registered even upon proof of secondary meaning. Even assuming that it is possible to distinguish deceptive and deceptively misdescriptive marks,¹⁰⁴ there is no reason to treat them differently once they acquire secondary meaning. Regardless of the reason why the descriptive or allusive message is false, purchasers who develop an associative message will allow their own experience override any representations received from the trade emblem.

The various private remedies for false advertising also acknowledge to some extent the different messages contained in a trade emblem. In general, a competitor or purchaser bears the burden of proving that the defendant's claim is false. The plaintiff normally will attempt to show falsity by a survey or other evidence that reveals shoppers' overall impressions of the message.¹⁰⁵ This requirement, however, is relaxed in some cases brought under § 43 of the Lanham

it implies endorsement by doctors); *Masland Duraleather Co. v. FTC*, 34 F.2d 733 (3rd Cir. 1929)(holding it is deceptive to sell artificial leather as DURALEATHER even when accompanied by the phrase "durable leather substitute"). See also 1 GILSON, *supra* note 17, § 1.03[8][c], at 1-44 to 1-45. Although the cases all involve marks, the FTC's § 45 mandate is broad enough to reach any deceptive trade emblem.

103. Lanham Act § 2(f), 15 U.S.C. § 1052(f) (1994). This provision, however, does not apply to primarily *geographically* misdescriptive marks. Section 2(f) was amended to exclude these marks in response to a provision of the recent North American Free Trade Agreement.
104. For a discussion of the difference between deceptive and deceptively misdescriptive marks, see *supra* note 94.
105. For an extensive discussion of the many facets of proving falsity, see 2 MCCARTHY, *supra* note 17, § 15.

Act, the most widely used private remedy. When a competitor can demonstrate that a seller's claim is "explicitly false," it is unnecessary to proffer proof of how purchasers perceive the message.¹⁰⁶ Like the absolute bar on deceptive marks in § 2(a), the explicit falsehood rule in a trade emblem case focuses only on descriptive and allusive messages. As a result, courts may find a mark deceptive when it actually does not fool shoppers.

The Federal Trade Commission also considers only the descriptive and allusive messages of a mark. In cases dealing with deceptive trade emblems, the Commission has insisted that the descriptive message be entirely accurate. In some of these cases, however, evidence showed that the emblem had acquired an associative message that overrode the descriptive.¹⁰⁷ The Federal Trade Commission's insistence on technical accuracy could be justified only as an attempt to protect shoppers who had not developed this associative message in the product name.¹⁰⁸ Even under this rationale, the Commission's approach focuses exclusively on the descriptive message, thereby failing to consider the entire message conveyed by trade emblems. In fact, the FTC may have actually generated additional consumer confusion in these cases. By forcing sellers to change the name of their trade emblem, the Commission denied shoppers the benefit of any associative message that had developed.

Although the rules governing deceptive trade emblems fill a definite need, they fail to entirely satisfy the principles of a language analysis. To compound the problem, courts sometimes have looked myopically at only the descriptive and allusive message, thereby overlooking the denominative and associative messages. By failing to consider all of the messages, these courts may have prohibited the use of trade emblems that caused little, if any, purchaser deception.

106. See *Coca-Cola Co. v. Tropicana Prods. Inc.*, 690 F.2d 312 (2nd Cir. 1982).

107. This is perhaps most evident in a pair of decisions involving the lumber industry. In the first half of this century, types of woods unknown to the public often were labelled with a familiar name. Typically, the chosen name was botanically inaccurate. The Commission invoked this technical inaccuracy in several cases challenging the industry practice. In two cases, the court agreed. In *In re Leask*, 56 F.T.C. 946 (1960), the court ordered a seller of eucalyptus to stop selling it as "Australian Oak" or "Tasmanian Oak." In *Federal Trade Commission v. Algoma Lumber Co.*, 291 U.S. 67 (1934), the Court ordered sellers of a yellow pine to stop marketing it as "California white pine." Evidence in both cases demonstrated that a significant portion of the public used "Australian/Tasmanian Oak" and "California white pine" as the common names for the products. In other words, the technically inaccurate names developed an associative message. Shoppers in these markets were not fooled by the false descriptive message. In both cases, however, the courts required the sellers to use the unfamiliar botanical name instead of the familiar nickname.

108. In *Federal Trade Commission v. Algoma Lumber Co.*, 291 U.S. 67, 80 (1934), evidence showed that sellers were starting to sell the wood in new markets.

B. Trade Emblems as Warranties of Quality

1. *What a Trade Emblem Says About Quality*

Viewed together, infringement and false advertising laws cooperate in addressing the means by which a trade emblem can convey false information to shoppers. As discussed in section II.A of this Article, false advertising law is best equipped to deal with misleading descriptive and allusive messages. Courts typically use the law of infringement, however, when the problem results from a false denominative or associative message.

On the other hand, the law of infringement cannot deal with all types of deception caused by denominative and associative messages. In some cases, it is possible for a seller to convey false denominative and associative messages without infringing on someone else's mark. Because false advertising law does not cover these situations, the law has no ready cure for some forms of deception.¹⁰⁹

Denominative and associative messages are important to buyers because they suggest certain basic ideas about the quality of a commodity. Shoppers' expectations regarding quality will not be met if a seller changes the product's quality. To prevent this sort of deception, the law should restrict a seller's ability to change the quality of the commodities sold under a trade emblem. Otherwise, shoppers cannot be sure that a trade emblem's denominative and associative messages are valid.¹¹⁰

As the law currently stands, a seller can protect a trade emblem merely by registering or using the trade emblem. The seller need not demonstrate that the commodity meets any base standard of quality or that the quality will remain consistent. As a result, sellers can protect trade emblems with a false denominative message.

109. Conceivably, some forms of false advertising law, especially the FTC Act, could be used to deal with false denominative and associative messages. Misleading purchasers as to source certainly qualifies as an "unfair or deceptive" practice within the meaning of § 45 of the FTC Act, codified at 15 U.S.C. § 45 (1994). The Commission has not used its authority to deal with false designations of origin, perhaps because it recognizes that the private enforcement system of trademark law was designed to deal with that problem.

110. Of course, there is a very strong economic motivation to maintain quality. To maximize the return on the investment in a trade emblem, the seller must develop a strong and favorable reputation, which is achieved only by selling goods of consistently high quality. This economic incentive, however, is an insufficient control. First, fluctuations in the quality of one seller's product affect more than just that seller's goodwill. If purchasers' expectations consistently are unmet, purchasers may lose confidence in trade emblems as a means of communication and turn instead to other, less efficient means. Second, the law of trade emblems results in a form of monopoly in a word or symbol. That limitation may affect the ability of other competitors to communicate and therefore is justified only if it reduces deception.

Certain rules purport to deal with this problem. For example, courts often compare the quality of the owner's and infringer's goods when determining whether an infringement has occurred.¹¹¹ This rule, although useful in some cases, falls far short of a general requirement of consistent quality. In addition, it is hornbook trademark law that a seller abandons a mark if the quality significantly deteriorates.¹¹² In practice, however, this rule has been applied almost exclusively in cases involving an owner who transfers a mark to a licensee or assignee without taking any measures to ensure continuing quality control.¹¹³ Aside from these cases, only a few relatively old cases discuss whether a party's unilateral decrease in quality results in abandonment.¹¹⁴ In all of these cases, the courts held that the change was too insignificant to result in a loss of rights.

Even stricter application of these rules would do little to remedy the basic communication problem and, in fact, may increase deception. Any competitor, including the original owner, could adopt an abandoned mark and gain exclusive rights. Abandonment simply erases priority in the emblem. Except in the rare case where the new owner's products happen to be of the same quality as the original owner's, purchasers who buy in reliance on the associative message will be deceived.

Of course, the law of trade emblems is not the only means of dealing with the problem of quality. False advertising laws arguably are more effective in dealing with this particular type of deception, especially considering that false advertising laws focus on the message instead of the privileges of the messenger. Courts, however, generally do not consider that a trade emblem use itself involves any actionable representation of the quality of the good or service unless the emblem itself is misdescriptive of quality.¹¹⁵

111. See, e.g., *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2nd Cir. 1979); 1 GILSON, *supra* note 17, § 5.01[3], at 5-19.

112. Elmer Hanak, III, *The Quality Assurance Function of Trademarks*, 43 *FORDHAM L. REV.* 363 (1974), is perhaps the most comprehensive discussion of this doctrine.

113. See, e.g., *Pepsico, Inc. v. Grapette Co.*, 416 F.2d 285 (8th Cir. 1969) (holding that a trademark and its goodwill cannot be assigned unless the mark is used by assignee on products having substantially the same characteristics).

114. The case most commonly cited for this proposition, *Independent Baking Powder Co. v. Boorman*, 175 F. 448 (C.C.D.N.J. 1910), actually was a case involving an assignment of the mark. Courts dealing with unilateral changes of quality have been remarkably lenient. For example, in *Royal Milling Co. v. J.F. Imbs Milling Co.*, 44 App. D.C. 207 (1915), the court allowed a seller to substitute hard wheat flour in a product that traditionally had been made with soft wheat flour. The court in *Beech-Nut Packing Co. v. P. Lorrillard Co.*, 299 F. 834 (D.N.J. 1924), *aff'd*, 7 F.2d 967 (3rd Cir. 1925), *aff'd*, 273 U.S. 629 (1927), went so far as to allow a seller to make any product changes that might improve sales.

115. There is one notable exception. In *Federal Trade Commission v. Royal Baking Powder*, 4 F.T.C. 1 (1921), the Federal Trade Commission used § 5 of the Federal Trade Commission Act to prohibit a seller who had altered a product from contin-

Contract law provides another possible means to deal with the issue of quality. The growing law of warranty, especially the various "implied" warranties, provides purchasers with some assurance concerning the base quality of goods. Yet, warranty law also is incapable of dealing with the problem of trade emblems. First, it does not deal with false associative messages. Absent some other express representation by the seller, merely labelling a good does not constitute a warranty that the good is of the same quality as in the past. Second, most of the significant increases in warranty law have involved goods, not services.¹¹⁶ Finally, warranty law only cures part of the harm caused by decreased quality. Although it allows the aggrieved purchaser to recover its loss, it does not restore general shopper confidence in the denominative and associative messages.

Therefore, to preserve the accuracy of denominative and associative messages, the law needs a means to correct the deception that occurs when a seller adjusts the quality of its product. The best approach would combine false advertising and trade emblem law. In addition to eliminating the original owner's exclusive rights, the law should preclude *any* seller from using the trade emblem in connection with the same commodity until shoppers realize that commodities of the quality they expect are no longer available in the market.¹¹⁷

2. Increasing Quality

The discussion of quality to this point has assumed that the trade emblem owner is selling a product of inconsistent or poor quality. In either situation, purchasers will receive some products that are unsatisfactory. Because purchaser dissatisfaction will directly affect the associative message and indirectly affect the denominative, the law should have some means to ensure uniformly acceptable quality.

In actuality, many sellers increase the quality of their products. Like any change in quality, an increase will disrupt the denominative and associative messages. That does not necessarily mean that the principles discussed above should govern. A language analysis helps to point out the unique considerations involved in these cases.

Unlike the seller who decreases quality, the seller who improves its product should be neither deprived of its exclusive rights nor sub-

uing to use the same trademark on that product. For an excellent discussion of how Lanham Act § 43(a) might be used as a means of policing quality, see Hanak, *supra* note 112, at 368-70.

116. The Uniform Commercial Code's implied warranty provisions and the federal Magnuson-Moss Warranty Act apply only to goods.

117. A prohibition against using a trade emblem could be enforced most easily by a government agency such as the Federal Trade Commission. Of course, regardless of how the prohibition is enforced, the law should include a way to notify sellers of which marks are unavailable.

jected to false advertising laws. Although misinformed, shoppers do not suffer any direct injury from the inaccurate information. If they buy the product or service, they will find it to be well above the base level of quality that they associate with branded goods or services of that nature, reinforcing their general faith in denominative messages.¹¹⁸ Admittedly, because the associative message understates the actual level of quality, the misinformation is more likely to cause purchasers to buy other sellers' products. This false message is inefficient because purchasers may end up with inferior products. Nevertheless, that is no reason to take away the exclusive rights of a seller who increases the quality of its product. Although in a less-than-optimal situation, purchasers are still receiving products that meet or exceed their expectations.

Similarly, depriving the owner of its rights could directly injure purchasers by allowing another seller to adopt the mark. Purchasers will continue to interpret the trade emblem using the associative message they developed for the original owner. This message will be deceptive if the new seller's product is of lower quality. Therefore, because a seller whose goods are of higher quality than suggested by the associative message does not deceive purchasers to their detriment, increases in quality should not result in a loss of rights.

This argument raises other considerations. For example, it is no defense to an infringement action that the defendant's product is better than the trade emblem owner's. Regardless of the quality of the infringer's commodity, the infringer is not the trademark "owner" and therefore should be unable to use the trade emblem to make shoppers believe otherwise. In essence, shoppers have a right not to be misled even if they would be better off with the misleading information.

Even though language analysis recognizes that a trade emblem contains several different messages, this same analysis actually supports the current rule. Because the trade emblems of the owner and infringer are identical or very similar, the infringer's descriptive and allusive messages basically are as accurate or inaccurate as the

118. Purchasers conceivably could be injured even in this situation. If product quality increases steadily over a long period of time, purchasers might develop an expectation that the quality will always be better than it was in the most recent purchase. Once the quality levels out, purchaser expectations might be frustrated.

owner's.¹¹⁹ Yet, the denominative and associative messages conveyed by the infringer will be false.¹²⁰

The real issue, however, is whether shoppers are deceived to their detriment. A purchaser is not likely to complain if the commodity turns out to be better than expected. Without purchaser injury, it is not readily apparent why the trade emblem owner should recover for the deception. Allowing a suit for infringement in this situation rewards the seller of lower-quality commodities at the expense of a seller who tries to improve quality.

Nevertheless, false information can injure purchasers even if they receive a higher-quality good. First, "quality" does not mean the same thing to all purchasers. Rather, the concept of quality is quite amorphous. Most goods and services have many separate features that may appeal to purchasers, each of which exhibits its own level of quality. Different purchasers may be drawn to different features.¹²¹ Similarly, some purchasers may not define quality in terms of the product, but instead by reference to the producer.¹²² These purchasers also will be injured by the competitor's use of the original trade emblem.

Second, there is no consensus on quality. Even when shoppers agree on what features constitute quality, they may disagree on whether a particular commodity is of "high" or "low" quality. For example, virtually every shopper would agree that taste is an important factor in choosing food products. Taste, however, is purely subjective.

119. As always, there could be exceptions. For example, if a competitor sells premium quality goods under the mark BASIC (a mark currently in use for cigarettes), the descriptive message in that emblem is technically false. Similarly, a seller who charges high prices would deceive shoppers by using the mark THRIFTY (a mark currently in use for car rental services).

120. The denominative message is false because the emblem fails to indicate a single source. Similarly, if an associative message exists, the infringer's use of the emblem falsely suggests to shoppers that the infringer's goods are of the quality that shoppers have come to expect when dealing with the owner of that emblem.

121. To illustrate, suppose that an oil company derives a formula for gasoline that dramatically increases both vehicle performance and mileage. Should this seller be entitled to sell the product as SHELL or some other brand name, under the argument that consumers will be better off? A loyal SHELL customer who judges gasoline based on performance and mileage certainly would be happy to be the "victim" of deception because the new product is superior. Other purchasers, however, may judge quality by other criteria. If the new gasoline increases vehicle emissions, for example, a purchaser whose primary criterion is pollution will consider the new product to be worse than SHELL.

122. Some people may prefer SHELL gasoline because of a basic affinity for Shell Oil, perhaps because of the company's philanthropic activities or because a relative or friend works for the company. Perhaps a better known example is BEN & JERRY'S ice cream. This company is attractive to purchasers not only because of the high quality of its ice cream and frozen yogurt, but also because of its widely publicized, fairly progressive corporate policy. Although these sorts of preferences may seem unreasonable when measured in the light of logic, they are nevertheless a very real motivation for a significant percentage of purchases.

tive.¹²³ While many or most purchasers may conclude that the taste of one company's food product is of higher quality, others may disagree.¹²⁴

Third, allowing a defense of superior quality in an infringement case could cause other sorts of purchaser injury. If the defense was available, a junior user would be free to use the emblem when competing with the original owner. Purchasers could randomly buy a number of the infringer's goods, thereby developing a higher expectation of quality. If those same purchasers subsequently purchase the original owner's goods, purchaser's inflated expectations would be left unsatisfied. To prevent such confusion, the owner should have a right to prevent the infringing use.¹²⁵

123. Taste certainly is generated by tangible stimuli. However, the individual's idiosyncratic reaction to those stimuli determines taste. Moreover, even though the things we enjoy can be dictated by external factors such as culture and upbringing, the concept of taste is still fundamentally subjective.

124. Of course, both parties conceivably could sell products of equal quality. For example, if the trademark owner obtains its product from a third party, a defendant who buys from that same source is, by definition, supplying a product of exactly the same quality as the owner's. Because the owner's trade emblem indicates a certain level of quality, the defendant might argue that it too should be entitled to use the emblem to convey that associative message.

Nevertheless, the owner should prevail. First, some purchasers may determine overall quality based not only on the product itself, but also on the seller's post-sale policies, such as service (admittedly unlikely in the case of apples). Second, other purchasers may prefer a particular seller for reasons totally unrelated to the commodity. These purchasers will be deceived to their detriment if a defendant is free to use the owner's emblem. This result does not place any significant restrictions on the defendant's ability to compete. As long as the law allows comparative advertising, a defendant is free to tell shoppers that its apples are of the same quality as the owner's. If the law also provides a "nominative fair use" defense, the defendant may even use the owner's mark when making the comparison.

125. The obvious counterargument, of course, is why the seller of the *lower* quality product should be entitled to prevail merely because it is senior. After all, it was the lower quality of the senior user's products that caused purchasers to be disappointed. In this case, the law might choose to give the exclusive right to the junior user who at least benefits consumers by increasing the overall quality of goods.

The current approach to the problem, however, is a superior rule of language. Viewed from a language perspective, the cause of action for infringement is not intended solely for the benefit of sellers. The law gives rights to sellers merely to enlist their aid in policing market deception. Although the law could in theory appoint *any* seller to this role, it selects the senior seller to encourage the most rapid development of associative messages. Because purchasers most likely have associated with the senior seller, any associative message that they have developed is most likely to relate to that seller. Moreover, the *actual* quality of the seller's goods fails to affect how quickly the associative message develops. A trade emblem will acquire an associative message as long as the level of quality of the products sold under the emblem remains fairly consistent.

Therefore, although there is some logical support for a "superior quality" defense, a language analysis supports the majority view. Parties who compete with the owner certainly should be encouraged to develop superior products. The law, however, should also encourage newcomers to use new and unique trade emblems with their products. The new trade emblem will allow purchasers to associate the higher level of quality with a second, clearly distinguishable, trade emblem. This result preserves the strength of the denominative message. In addition, because there will be two trade emblems with two separate associative messages, requiring the newcomer to adopt a new emblem maximizes the potential for efficient market communication.¹²⁶

C. Borrowing a Foreign Term as an Emblem

Markets convey information using one or a very few "official" languages. Sellers who borrow terms generally take the word from this official language. Sometimes, however, sellers borrow words from foreign languages.¹²⁷ These cases present unique considerations when viewed from the perspective of a language analysis.

Most courts apply a fairly mechanical rule to foreign trade emblems. If the language from which the word is borrowed is dead or extremely obscure, courts generally will allow the seller to protect the trade emblem.¹²⁸ Because shoppers are unlikely to understand the word, they are similarly unlikely to rely upon the prior existing meaning. Courts essentially treat these emblems as fanciful.¹²⁹

126. In addition, as noted *supra* note 124, the junior party ordinarily will have the right to engage in comparative advertising, possibly even using the owner's mark as a means of referring to the owner.

127. In addition to the cases cited *infra* notes 128-132, see *Skol Co. v. Olson*, 151 F.2d 200 (C.C.P.A. 1945), where the seller had adopted a variation of the Swedish term "skål" as its trade emblem.

In all of the cases involving foreign trade emblems, a seller has borrowed a foreign word. Conceivably, a seller could also borrow a symbol or image with a particularly strong meaning to a certain foreign culture. In a sense, using non-Latin alphabets is analogous to using a "symbol" that has a particular meaning to another culture. See, e.g., *In re Oriental Daily News, Inc.*, 230 U.S.P.Q. (BNA) 637 (1986)(refusing to protect Chinese characters that translate into "Oriental Daily News"). Because people also communicate through symbols, these cases should be resolved under the same basic analysis that applies to words.

128. See *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903 (3rd Cir. 1952)(classic Greek); *McKesson & Robbins, Inc. v. Charles H. Phillips Chemical Co.*, 53 F.2d 1011 (2nd Cir. 1931)(Patagonian); *William Waltke & Co. v. Geo. H. Shafer & Co.*, 263 F. 650 (D.C. Cir. 1920)(Latin).

129. Of course, if the borrowed word is spelled or pronounced like an English word, it will be treated as a variation on that English word even if the meaning is different. See *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213 (7th Cir. 1978)(holding that although based on a classical Greek root, TELEMED is descriptive for telephone medical services). Compare *Telemed Corp.* with *Telechron, Inc. v. Telicon*

For words borrowed from most recognized modern languages, however, the analysis requires a second step. A seller can protect an English term only if it is used in an arbitrary or suggestive fashion. Descriptive emblems can be protected only upon a showing of secondary meaning, and generic emblems usually are denied protection under any circumstances. Likewise, courts hesitate before protecting a seller who has adopted a mark that is a foreign translation of either a descriptive or generic English word.¹³⁰ Most courts apply the "doctrine of foreign equivalents" to borrowed foreign terms. Under this approach, the court translates the word into English and then determines whether the *English* word qualifies for protection.¹³¹

The doctrine of foreign equivalents has often been criticized.¹³² Most of the criticism focuses on the application of the rule, especially when it is used to deny protection to foreign words that the vast majority of shoppers do not understand. More serious questions arise when the issue is considered from the broader perspective of a language analysis. Indeed, language analysis suggests that the law should contain a presumption in favor of protecting foreign terms,

Corp., 198 F.2d 903 (3rd Cir. 1952)(holding TELECHRON for electric clocks to be arbitrary).

130. A foreign trade emblem may itself become a generic English term, especially when the product or service to which the emblem is attached is unique. Thus, the German term "Bundt" has come to identify a unique product sold in the United States, not a single source for that product. *In re Northland Products, Inc.*, 777 F.2d 1556 (Fed. Cir. 1985). A foreign word can become a generic English term regardless of whether it was a generic term in the mother tongue, like Bundt, or whether it was a trademark. Purchasers adopt the term as the English generic because the product or service previously was unknown to the market and accordingly no English term readily describes it. A foreign trademark like BUNDT is no different than NYLON and CELLOPHANE, which similarly describe products that were at one time unique. The language of the market can adopt fanciful and foreign terms as product names with equal ease.
131. *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522 (4th Cir. 1984)(Italian); *Volkswagenwerk Aktiengesellschaft v. Church*, 256 F. Supp. 626 (S.D. Cal. 1966)(German), *aff'd*, 411 F.2d 350 (9th Cir. 1969); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961)(Hungarian); *Nestle's Milk Prods., Inc. v. Baker Imports Co.*, 82 F.2d 193 (C.C.P.A. 1950)(French); *In re Oriental Daily News, Inc.*, 230 U.S.P.Q. (BNA) 637 (1986)(Chinese); *In re New Yorker Cheese*, 130 U.S.P.Q. (BNA) 120 (1981)(Polish); *In re Westbrae Natural Foods, Inc.*, 211 U.S.P.Q. (BNA) 642 (1981)(Japanese); *In re Bagel Nosh, Inc.*, 193 U.S.P.Q. (BNA) 316 (1976)(Yiddish); *In re Garcia*, 175 U.S.P.Q. (BNA) 732 (1972)(Spanish); *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. (BNA) 598 (1967)(Serbian).

For a variation on the theme, see *In re AGE Bodegas Unidas, S.A.*, 192 U.S.P.Q. (BNA) 326 (1976), where the Board denied registration to the mark RIOJA SIGLO under Lanham Act § 2(d). Although the English translation of the term was neither generic nor descriptive, the court held that the *translation* was confusingly similar to the mark CENTURY, which already was used for whiskey.

132. The most persuasive criticism appears in 1 McCARTHY, *supra* note 17, § 11.14[2][b].

even when they are widely recognized translations of descriptive or generic English terms.

First, depending on the word, some percentage of the population will not recognize the meaning of the foreign term. To this group, the word conveys no descriptive or allusive messages whatsoever. Even shoppers who know the translation of the term will detect something out of the ordinary when they encounter a foreign term on a good or service. Shoppers are accustomed to product names and descriptions in the official language of the market. A foreign term will therefore stand out and may be recognized by shoppers as a seller's attempt to identify itself to the market.¹³³ Unlike the generic English translation, the foreign equivalent may convey a recognizable denominative message.

Second, foreign terms may convey other messages to purchasers. Without secondary meaning, the only message that an English descriptive or generic term will convey is descriptive. Foreign or foreign-sounding terms, however, may also impart an abstract, vague sense of mystery or quality to a product.¹³⁴ This is the allusive message.¹³⁵ The allusive message will attach even if the chosen term is a foreign translation of a generic or descriptive English word. Regardless of whether shoppers know the translation, a seller's use of the Swedish term CHOKLAD will create an impression that the English equivalent CHOCOLATE will not.¹³⁶

An allusive message is not itself a sufficient reason to protect a trade emblem. The existence of an allusive message, however, may

133. Certain factors may increase the likelihood of the foreign term having a denominative message. For example, if only one seller uses the term, then shoppers are more likely to recognize it as an indication of source. In addition, purchasers are more likely to derive a denominative message from a foreign adjective than from a foreign noun. Finally, as with all marks, the presentation of the word may affect the shopper's impression. A word that is presented in stylistic print, with other features, is easier to distinguish than one in plain type.

134. Sometimes, however, borrowing a foreign term would prove deceptive. If purchasers recognize the term, they might take it as a representation that the product actually comes from the area in which the foreign language is spoken. If the product does not come from that location, purchasers are deceived. In this sense, all foreign trade emblems should be evaluated to determine whether they are geographically misdescriptive.

135. See *supra* text accompanying notes 45-48.

136. In fact, this allusive message may be even stronger to the purchaser who is familiar with the foreign language. Many words cannot be precisely translated into other languages because they have shades of meaning peculiar to one language and its culture. See, e.g., WIERZBIKA, *supra* note 20, for a fascinating discussion of one such word, the Russian term *Duša*. Shades of meaning will carry over when those terms are used as a trade emblem and will have an effect on those purchasers who are familiar with that language. Use of the foreign term suggests not only the vague sense of foreignness, but also those subtle shades of meaning that do not exist in the English translation.

make it easier for purchasers to distinguish the foreign term from its English equivalent. If the law provided exclusive rights in the foreign term, it might become an efficient indication of a single source much more quickly than its English counterpart.

Third, foreign terms do not involve the same issues of need that are present in English descriptive and generic terms. The foreign term is unnecessary for competitors to communicate ideas in the marketplace. Competitors are always free to use the descriptive and generic terms of the official language to describe their products.¹³⁷ Alternatively, competitors also may appropriate descriptive and generic terms from third languages as trade emblems.

The result is that the doctrine of foreign equivalents, in its current form, is too strict. Rarely are foreign terms merely the "equivalent" of their English translation. Even if most purchasers understand the foreign term, purchasers are more likely to recognize that a foreign word is used as a trade emblem. On the other hand, this does not mean that foreign equivalents of English descriptive and generic terms automatically deserve protection. Foreign terms present their own unique considerations, which in certain cases might warrant refusal of protection.¹³⁸ The problem, however, is that the current law focuses too narrowly and should be reevaluated as a question of language. At the very least courts should consider evidence of how purchasers actually perceive a foreign trade emblem.¹³⁹

137. Even if both parties were selling chocolate from Sweden, the junior user would be free to describe his product as SWEDISH CHOCOLATE. In most cases, however, the junior user could not use the foreign term in descriptive fashion, for example, by calling the product something like XYZ CHOKLAD. With respect to an English descriptive mark that has acquired secondary meaning, courts would apply the doctrine of fair use to allow competitors to use the same mark in a descriptive fashion. However, a junior user's descriptive use qualifies as fair only if it will not result in shopper confusion. Because of the allusive messages in such a mark, use of a foreign descriptive or generic term in descriptive fashion would probably prove confusing to a significant percentage of consumers. It would be especially confusing to shoppers who did not know the language. In such a case, shoppers would have to distinguish between CHOKLAD and XYZ CHOKLAD, neither of which has any inherent meaning to them.

138. In some cases, a product with a foreign trade emblem will be marketed only to shoppers who speak that particular language. In this case, it is more likely that those shoppers will perceive of the mark as a descriptive, rather than a denominative, message. In addition, as discussed *supra* in note 135, foreign terms are more likely to be interpreted as representations concerning geographic origin.

139. See 1 MCCARTHY, *supra* note 17, § 11.14[2][b]. The need for a more flexible approach is even stronger in the case of more obscure languages. Suppose, for example, that a United States seller called its chocolate SUKLAA. Few shoppers will recognize this as the Finnish generic equivalent for chocolate. Because Finnish terms are rarely used in the language of the market, this term could quite easily function as a mark, even to those few purchasers who speak Finnish.

D. Dilution

In an extremely influential article, Frank Schechter argued that the only "rational" basis for protecting trademarks is preserving their distinctiveness.¹⁴⁰ Schechter realized that this distinctiveness allowed purchasers to differentiate between competing products. These arguments, augmented by other influential scholars,¹⁴¹ laid the groundwork for today's antidilution statutes.¹⁴² Unlike most other trademark laws, antidilution statutes allow the owner of a trademark to recover without showing that purchasers are likely to be confused. This often allows the owner to recover against anyone who uses the mark, even on noncompeting goods. The theory underlying the antidilution laws is that by preventing widespread use of a mark, the laws preserve the distinctiveness of the seller's mark.

Dilution has always shared an uneasy relationship with the rest of trademark law. A language analysis sheds considerable light on the issue of whether it is desirable to protect the distinctiveness of a mark. Courts have considered some of the language implications in their efforts to apply the antidilution laws. In so doing, courts have identified two main varieties of dilution.¹⁴³ The first, sometimes called "blurring," occurs when a mark with a strong secondary meaning loses that meaning after the mark is used on noncompeting goods.¹⁴⁴ "Tarnishment," by contrast, arises when a seller uses the owner's mark in a way that causes purchasers to think of the owner, but in a negative or humorous way.¹⁴⁵

140. Schechter, *supra* note 17.

141. Two of the more influential articles on the concept of dilution include Beverly W. Pattishall, *The Dilution Rationale for Trademark-Trade Identity Protection, Its Progress and Prospects*, 71 NW. U. L. REV. 618 (1976), and Walter J. Derenberg, *The Problem of Trademark Dilution and the Anti-dilution Statutes*, 44 CAL. L. REV. 439 (1956).

142. Until 1996, protection against dilution came entirely from state law. Approximately half of the states have adopted anti-dilution statutes. See CAL. BUS. & PROF. CODE § 14330 (West 1987 & Supp. 1997); ILL. ANN. STAT. ch. 765 para. 1035/15 (Smith Hurd 1993); MASS. GEN. L. Ann. ch. 110B § 12 (West 1990); ME. REV. STAT. ANN. tit. 10, § 1530 (West 1980); N.Y. GENERAL BUSINESS LAW § 368-d (McKinney 1996); 54 PENN. CONS. STAT. Ann. § 1124 (1996). In 1996, Congress amended § 43 of the Lanham Act to add a federal cause of action for dilution. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 985 (1996). This new law undoubtedly will frame the continued debate in this area.

143. The court in *Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39 (2nd Cir. 1994), identified other categories of dilution. However, these simply involved variations on the basic themes identified in the text.

144. See *Mead Data Cent., Inc. v. Toyota Motor Sales, USA, Inc.*, 875 F.2d 1026 (2nd Cir. 1989). Had the mark been used on competing goods, the owner could sue for infringement.

145. See, e.g., *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316 (4th Cir. 1992),

A language analysis reveals a third, as yet unacknowledged, category of dilution that can be dubbed "descriptive use." In this category, a competitor who is trying to mimic the owner's unique good or service uses the mark in comparative advertising to refer to the original product.¹⁴⁶ Descriptive use threatens the distinctiveness of a mark by making it easier for the mark to become the generic name of the unique good or service.

Antidilution statutes protect owners by allowing them to recover without proving purchaser confusion. Typically, all that the owner must demonstrate is a likelihood that the mark will in some way lose its distinctive quality. Courts generally have used antidilution laws to protect strong marks from the potential loss of their selling power.¹⁴⁷

In terms of a language analysis, the distinctiveness of a trade emblem is determined by its denominative and associative messages. Purchasers look for unique emblems to identify particular sellers. This allows purchasers to sort and store their personal experiences with the product or service for use in later purchasing decisions. Therefore, a language analysis supports Schechter's fundamental conclusion that preserving a trade emblem's capacity to distinguish constitutes the main reason to afford legal protection.¹⁴⁸

While the basic concepts are the same, Schechter's arguments in favor of protecting the distinctiveness of marks differ in several respects from language analysis. Language analysis involves considerations that are not present in Schechter's reasoning. Once it is recognized that trade emblems may contain an entire packet of information, the arguments in favor of antidilution laws lose much of their persuasive force.

As demonstrated in Part I, two related considerations support exclusive rights in trade emblems. The first is the need to limit the purchaser confusion that might occur if multiple sellers use the same identifying markers.¹⁴⁹ Second, if a trade emblem acquires a strong

cert. denied, 506 U.S. 872 (1992); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

146. The classic trademark case, *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968), involved this sort of use. For a case discussing fair use in a context other than comparative advertising, see *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992).
147. The statutes generally apply only to strong marks. For example, in *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 369 N.E.2d 1162 (N.Y. 1977), the court refused to protect the mark ALLIED under the New York antidilution statute because it concluded that the mark was not distinctive. Similarly, the new federal antidilution law applies only to "famous" marks.
148. As discussed *supra* text accompanying notes 62 and 65, a language analysis supports trade emblem rights to protect the associative and denominative messages. These messages together are roughly the same as Schechter's concept of distinctiveness.
149. See *supra* text accompanying notes 62-65.

and clear associative message, a tremendous efficiency in communication can result.¹⁵⁰

A cause of action for blurring may satisfy the first criterion of preventing deception, but only in some cases. A trade emblem loses its significance when it ceases to convey a denominative message. Absent a denominative message, purchasers will fail to recognize that the emblem indicates an identifiable source and therefore will be unable to use their past experiences with the emblem in deciding whether to purchase. That inability to recall may injure purchasers if their past experience with a product was largely negative because purchasers are more likely to try the unsatisfactory product again. On the other hand, if past experience was generally positive, shoppers will be less inclined to purchase the product if the emblem is no longer distinctive. Although perhaps inefficient, the seller has no opportunity to use the trade emblem to deceive shoppers to their detriment.

In theory, a cause of action for blurring prevents deception only if more purchasers have had experiences with an emblem than positive experiences. Even if this is true, providing a claim to these sellers makes neither political nor practical sense. As a matter of policy, it is difficult to justify creating a cause of action that would benefit only sellers of low-quality products. Even if the cause of action existed, few sellers would actually bring suit. The seller of low-quality goods may in fact welcome dilution of its mark because it might erase purchasers' negative impressions of the goods.¹⁵¹

Efficiency, the second rationale for protecting trade emblems, likewise does not support a cause of action for blurring. The antidilution statutes generally apply only to marks with a well developed associative message. It is difficult to see how use of a strong mark on non-competing goods could ever diminish a strong mark's associative message.¹⁵² For example, shoppers' experiences with both DELTA airlines and DELTA faucets are quite distinct, and the goodwill purchasers feel for one is not intertwined with the goodwill for the other.¹⁵³

150. See *supra* text accompanying notes 64-68.

151. In fact, a seller whose goods or services have developed a bad reputation often will simply adopt a new trade emblem for those services on the theory that no goodwill is better than negative goodwill. Dilution of that seller's existing trade emblem would have the same effect.

152. The only situation where use on noncompeting goods could decrease strength is where purchasers actually confuse the two sources. In this case, however, an antidilution statute is unnecessary because the senior party can sue for infringement.

153. In this respect, antidilution laws would make more sense if applied solely to weak marks. Although there is little fear that strong marks will lose their associative messages, weak marks often need help in acquiring that message. A purchaser who encounters a new mark will develop an associative message more quickly if no other seller—competing or noncompeting—can use the mark. This would al-

The overall effect on competition is also an important consideration. A cause of action for dilution involves a trade-off. Even assuming that it protects one seller's goodwill, the cause of action prevents other sellers from using the same mark to convey information concerning their commodities.¹⁵⁴ In the case of competing goods, that trade-off is acceptable because of the need to ensure that shoppers receive accurate information. The antidilution statutes, however, do not require a showing that purchasers are receiving false information. In effect, these statutes create a more expansive monopoly in a part of the market vocabulary than that created by traditional trade emblem law. Because this broader monopoly runs counter to the general policy that language is free for all to use, there are serious implications in applying antidilution laws to situations of blurring.

Tarnishment, the second type of dilution, has been less widely accepted by the courts. The primary objections to tarnishment involve significant free speech implications.¹⁵⁵ These implications aside, a language analysis actually provides more support for tarnishment than for blurring.

The typical tarnishment case involves a defendant who uses a trade emblem that, because of its similarity to the owner's, leads purchasers to think of the owner.¹⁵⁶ There is no likelihood of confusion in the traditional sense, for everyone realizes that the defendant and the owner are separate entities. However, because the defendant has used the trade emblem in a context that causes shoppers to think less favorably of the owner, there is a fear that the goodwill that the owner has developed in the emblem will be diminished. Antidilution laws attempt to preserve that goodwill.

A language analysis makes it clear that although blurring and tarnishment both deal with goodwill in the general sense, each involves different aspects of the information conveyed by a trade emblem. Blurring involves a reduction in the *strength* of goodwill, which, in the terminology of a language analysis, is the clarity of the associative message. Blurring affects the associative message by attacking it at its foundation—the denominative message. If shoppers lose their ability to use the mark to distinguish between sellers, shoppers cannot invoke their experience when choosing among competing products in the market.

low the purchaser to form a clear association between the new word and the personal experience that the purchaser will use to define the meaning of that word.

154. Of course, sellers are always free to use other marks. Again, however, that begs the question. Giving exclusive rights in a word to any one person runs counter to the general policy against monopolies in language. A monopoly is warranted only if it will actually reduce deception.

155. For a discussion of these issues, see *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

156. In many cases, the defendant will use a mark identical to the owner's.

Tarnishment, on the other hand, deals with a loss in the positive value of goodwill. This is the actual *content* of the associative message. Although the mark is equally effective in causing shoppers to think of the owner, the defendant's message has changed the shopper's overall impression of the owner for the worse. The defendant affects that change quite subtly. Unlike infringement, the defendant does not offer competing goods that shoppers confuse with the owner's. Instead, the defendant's use of the mark in a tarnishment case sends an allusive message to shoppers, which in turn affects the content of the associative message. Many sellers use trade emblems that allude to certain ideas to generate a favorable response to their commodities. Similarly, a defendant's use of the owner's mark in the context of a criticism or parody conveys ideas that purchasers may associate directly with the owner's product. These allusive messages may affect purchaser goodwill, the overall impression that purchasers have of the owner's product.

In this respect, tarnishment is closer to the law of false advertising than the law of trade emblems. Once tarnishment is properly categorized, it is possible to take a reasoned approach to the serious free speech concerns that surface in tarnishment cases. Any representation made by one party concerning another's goods or services can affect the seller's reputation regardless of whether it involves ordinary speech or the use of trade emblems. The law may step in to protect the seller's reputation when the representations are false. From this perspective, tarnishment is an indirect form of trade libel. The difficult issues in a tarnishment case include (1) whether an allusive message can be false and (2) whether purchasers actually rely on that message in forming their goodwill for the products or services that are the subject of the allusion. If both are satisfied, however, the cause of action for tarnishment helps to ensure accurate communication.

The third variety of dilution, descriptive use, ordinarily is not recognized as a situation covered by the antidilution laws. Yet, from the perspective of a language analysis, descriptive use poses possibly the most serious threat to a mark's associative message. To illustrate, suppose an ink manufacturer has developed a unique smear-proof ink sold under the mark PEERLESS. Unless the manufacturer has obtained a patent, other companies are free to sell ink that is chemically identical to PEERLESS. If those companies call their products "PEERLESS-style ink" or "a perfect copy of PEERLESS ink,"¹⁵⁷ purchasers may over time redefine the word PEERLESS as the descriptive name for smearless inks rather than smearless ink from a particular source.

157. See, e.g., *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968).

Descriptive use poses a difficult issue because it involves two different tiers of communication. It is efficient if PEERLESS has a strong associative message because shoppers can rely on their experiences as an indication of expected quality. It is also efficient, however, if sellers and shoppers have a single universal term to refer to a unique variety of ink, the variety popularized by the original seller of PEERLESS. This tension can be resolved only on a case-by-case basis by determining whether the need for uniform product names outweighs the efficiency offered by a strong trademark.

Overall, a language analysis offers varying degrees of support for allowing a cause of action in the three varieties of dilution. Although the answers are far from clear, the analysis is useful because it helps identify the communication trade-offs involved in these laws. Courts and legislatures need to consider these trade-offs, not just the plight of the trademark owner, when dealing with the problem of dilution.

E. Succeeding to Trade Emblem Rights

Trade emblems often comprise a significant portion of a company's assets. It is therefore not surprising that a purchaser of an ongoing business is vitally interested in succeeding to the trade emblem rights of the seller. Generally, the law accommodates the purchaser by allowing rights in trade emblems to be transferred. The only requirement is that the transfer cannot be "in gross," but instead must be accompanied by a transfer of the goodwill connected with that emblem.¹⁵⁸ As long as the successor continues to sell the same products in the same markets, courts will honor the transfer of rights.

A language analysis supports this rule. As a practical matter, requiring the transfer of goodwill means that parties can convey emblems only when they also convey the means to produce a commodity of equal quality.¹⁵⁹ This rule prevents purchaser deception by maximizing the likelihood that the goods will continue to be the same quality that purchasers have come to associate with the trade emblem.¹⁶⁰ In terms of language, requiring the transferee to purchase the means of production helps preserve the accuracy of the associative message.

158. CHISUM & JACOBS, *supra* note 56, at 5-374 to 5-380.

159. Of course, marks that have not acquired goodwill are likely to be of little value and are therefore rarely sold.

160. For some products, purchasers may be motivated mainly by the personal skills of a person affiliated with the seller. Unless that person continues to work for the successor, purchasers who buy in reliance on the trade emblem may be misled to their detriment. These considerations may support the decision in *Menendez v. Saks & Co.*, 485 F.2d 1355 (2nd Cir. 1973), *rev'd sub nom on other grounds*, *Alfred Dunhill of London, Inc. v. Republic of Cuba*, 425 U.S. 682 (1976), in which the court held that owners of a Cuban cigar firm whose operations were seized by the Cuban government nevertheless retained their rights to use the trademark, notwithstanding that they were forced to use non-Cuban tobacco in their cigars.

A language analysis also helps resolve some of the issues that can arise in transfers. One particularly vexing issue is family names. Many sellers have claimed the right to use their own name in connection with business activities, even though that name is owned by someone else as a trade emblem. In some of these cases, the junior claimants are the descendants of a transferor who previously owned the emblem, but later conveyed the business and the emblem to a subsequent owner. Courts in these cases almost universally have decided in favor of the transferee, although sometimes with extensive discussions of the plight of the claimants who have lost their identity.¹⁶¹

What makes the issue of family names troubling is the persistence of the notion that a trade emblem is primarily an indication of source. For example, it appears less misleading for the Smith family to use the mark SMITH than it would be for some impersonal corporation to do so. Yet, a language analysis reveals that the majority view is correct. Although a trade emblem identifies a source, the actual identity of the source is usually unknown to the shopper. Shoppers want to identify the source to incorporate their own experiences in choosing among competing commodities. It is irrelevant whether the trade emblem is SMITH or some arbitrary word like GRYX, as both words are capable of identifying a single source.¹⁶² Therefore, because the actual successor to the original business is more likely to provide consistent quality, the law correctly affords it superior rights to someone who simply has the fortune of bearing a name that is the same as a famous mark.

A second problem arises in cases where there is no clear successor in interest. Several cases deal with a partnership that has dissolved with each of the partners continuing in the same line of business.¹⁶³ Because the partnership's trade emblems are well known to purchasers, each of the competing factions wants the exclusive right to use those trade emblems in its business. These cases prove difficult only because the courts proceed from the wrong paradigm. Here, the culprit is the urge to treat trade emblems as a form of "intellectual property," which must be allocated along with the other partnership assets. Although treating a trade emblem as "property" may make sense in some contexts, it creates problems in the context of a partner-

161. See, e.g., *Dovenmuehle v. Gildorn Mortgage Midwest Corp.*, 871 F.2d 697 (7th Cir. 1989); *Taylor Wine Co., Inc. v. Bully Hill Vineyards, Inc.*, 569 F.2d 731 (2nd Cir. 1978); *John T. Lloyd Labs., Inc. v. Lloyd Bros. Pharmacists*, 131 F.2d 703 (6th Cir. 1942).

162. Certain names, however, may by their very nature generate vague, but positive, responses in consumers. These names are more valuable than a purely fanciful term because of their allusive message.

163. See, e.g., *Yankelovich, Skelly & White, Inc. v. White, Yankelovich, Skelly Consulting Group, Inc.*, 14 U.S.P.Q.2d (BNA) 1384 (S.D.N.Y. 1989); *Perl Brand Foods Corp. v. Deli Direct from Perl, Inc.*, 14 U.S.P.Q.2d (BNA) 1569 (N.D. Ill. 1989).

ship split. The purpose of granting exclusive rights in trade emblems is not to reward the owner, but rather to ensure that shoppers receive accurate and efficient information to guide them when shopping. As such, the real goal in partnership split cases should be to reach a result that best ensures the accuracy of the trade emblem.

It will often be clear that one faction of the partnership was primarily responsible for the quality of the product. In those cases, that faction is most likely to continue meeting purchasers' expectations. Courts therefore should grant to that party exclusive rights because allowing any of the other factions to use the trade emblem will likely deceive purchasers.

On the other hand, it may be that none of the factions can produce a similar product. In these cases, the best solution may be an outcome that the courts generally do not consider—namely that *none* of the factions should succeed to the original partnership's rights. Unlike the partnership's other assets, the trade emblem rights would simply disappear because none of the factions can use the emblem without causing purchaser deception.¹⁶⁴ Only in this fashion can the courts prevent the sort of purchaser deception that should be central to the law of trade emblems.¹⁶⁵

F. Reversing the Law's Priorities: The Problems of Reverse Confusion and Reverse Passing Off

The traditional model of trade emblem law focuses on allocating rights in a word, phrase, or symbol. One party, normally the senior user, has the exclusive right to use that emblem on certain commodities. Sometimes, however, courts are asked to reverse these basic principles. Many cases involve situations of "reverse confusion." In these situations, shoppers identify more strongly with the junior than

164. The law of trade emblems would ordinarily respond to this type of situation by declaring the trade emblem abandoned. For the reasons discussed *supra* text accompanying note 114, however, abandonment could lead to deception in this case.

165. Some of the more interesting cases of this genre involve groups of performing artists who decide to dissociate. *See, e.g.,* Grondin v. Rossington, 690 F. Supp. 200 (S.D.N.Y. 1975); Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); Rare Earth, Inc. v. Hoorelbeke, 401 F. Supp. 26 (S.D.N.Y. 1975); Noone v. Banner Talent Assoc., Inc., 398 F. Supp. 260 (S.D.N.Y. 1975); HEC Enterprises, Ltd. v. Deep Purple, Inc., 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980). *See also* Elizabeth Williams, *Trademark Protection Under Lanham Act (15 USCS §§ 1501 et seq.) of Name of Musical Group*, 115 A.L.R. FED. 171 (1993). What makes these cases special is the importance of personality to the success of a popular musical group. Unlike most goods, purchasers of popular music identify quite strongly with the various personae that comprise the group. To the extent that different members of the group have this sort of personal draw, the "goodwill" that different purchasers have in the original group may continue in different factions. This phenomenon presents the courts with the intractable problem of tracing this widely varying goodwill to the different factions of the group.

the senior user. Other courts have faced claims of "reverse passing off." These cases involve both a junior and senior user who sell goods from the exact same source, but use different marks. Both of these problems of trademark law can benefit from a language analysis.

1. *Reverse Confusion*

A language analysis supports the grant of exclusive rights in a trade emblem to the senior user. Other factors being equal, it is most likely that any associative message conveyed by that emblem will refer to the senior user simply because its commodity has been offered to the public for a longer period of time. Other factors, however, often are not equal. In many situations, a junior user will make a massive investment in its commodity. If the senior user is relatively small, purchasers quite possibly will develop an associative message in the junior user's emblem rather than the senior user's. In several cases in which this has occurred, the junior user has argued that this secondary meaning should preclude the senior user's infringement claim.

Courts generally have allowed the senior user to recover in these cases.¹⁶⁶ They recognize that the likelihood of confusion is "reversed": shoppers who see the trade emblem will assume that the products come from the junior rather than the senior user. Nevertheless, courts uphold the rights of the senior user on the theory that it would be unfair for a large company to usurp the established rights of the senior user merely by investing large sums in its own infringing product.¹⁶⁷

The law, however, should not grant exclusive rights to senior users merely because of some vague sense of fairness. Instead, the main concern should be the amount and accuracy of communication in the marketplace. Granting recovery to the senior user will deceive purchasers insofar as they will receive an associative message that invokes their experiences with the products of the larger, junior firm. Forcing the junior user to change its trade emblem will temporarily disrupt market communication.

This does not necessarily mean, however, that courts are mistaken in allowing senior users to recover for reverse confusion. Focusing only on the case at hand is myopic. If one considers the situation as it existed *before* the junior user adopted the emblem, it becomes apparent that allowing the junior user to usurp the rights of the senior is, in

166. See also *Minnesota Pet Breeders, Inc. v. Schell & Kampeter, Inc.*, 41 F.3d 1242 (8th Cir. 1994); *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466 (3rd Cir. 1994); *Universal Money Centers, Inc. v. American Telephone & Telegraph Co.*, 22 F.3d 1527 (9th Cir. 1994); *Sands, Taylor & Wood, Co. v. Quaker Oats Co.*, 978 F.2d 947 (7th Cir. 1992).

167. *Fisons Horticulture Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 475 (3rd Cir. 1994); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91 (2nd Cir. 1988).

a sense, "unfair." The unfairness, however, is with respect to the proper objects of trademark law—the purchasers of that commodity. The large, junior user should certainly be allowed to compete in the sale of the commodity. However, like any company hoping to enter the market, the junior user could have selected any of a virtually infinite supply of words or symbols for that commodity. If the junior user had selected its own unique emblem, and purchasers developed an associative message in that emblem, the junior user would have increased the efficiency of communication in the market by adding another clearly defined trade emblem. On the other hand, if the junior user adopts the same word or symbol as the senior user, a less-than-optimal amount of communication will occur because there will be only one new term where there could have been two. Some purchasers will be confused regardless of which user develops secondary meaning.¹⁶⁸ A better option is to force every junior user to adopt a distinct mark, thereby increasing the number of potentially efficient trade emblems.¹⁶⁹

2. *Reverse Passing Off*

In the typical trademark infringement case, the defendant has "passed off" its goods or services as that of the trademark owner by employing a mark that is confusingly similar to the owner's. "Reverse passing off," by contrast, occurs when the defendant sells goods, marketing the goods as his own, when the goods actually originate from the same source as those sold by the trademark owner.¹⁷⁰ Although many trademark owners do not mind if the same goods are sold under a different name, others want the entire goodwill generated by the product.¹⁷¹

168. In addition, a few purchasers may have started to develop a nascent associative message referring to the senior user. Those purchasers will be confused if the emblem now refers to another seller.

169. This analysis certainly supports a cause of action for reverse confusion in the case where a junior user purposefully adopts an identical or confusingly similar emblem. The result may be different, however, when the junior user's infringement was unintentional. The deterrence arguments are weaker in this situation. In addition, allowing the senior user to prohibit use of the emblem will cause a significant, albeit temporary, disruption in market communication. The best way to deal with these cases is for courts to make judicious use of their discretion in granting injunctions. Instead of barring the junior user, the court could require it to adopt a statement that distinguishes it from the senior user.

170. The doctrine of reverse passing off applies only to trademarks. It is difficult to conceive of a situation where two sellers could sell the same service. Similarly, a party could not engage in reverse passing off of a trade name.

171. A number of these cases have been brought by artists and authors, parties who are understandably concerned with receiving credit. *Waldman Publishing Corp. v. Landoll Inc.*, 43 F.3d 775 (2nd Cir., 1994); *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981)(holding that actor's complaint stated cause of action under § 43(a) of the Lanham Act when another actor was given credit for his work in a motion

Courts have proven relatively sympathetic to claims of reverse passing off.¹⁷² The perceived problem is not the sale of the goods itself, for absent a contractual restriction a retailer is generally free to sell any products it can obtain. Rather, requiring the seller to use the mark associated with the actual source ensures that any goodwill will attach to the actual source.

A language analysis reveals that the standard arguments are too simplistic. Cases of reverse passing off certainly involve purchaser confusion because purchasers are ignorant of the "true" source's identity. Yet this alone is not a basis for recognizing a cause of action. People generally do not buy products because of any affinity for the person of the manufacturer. They instead buy certain goods and services because they hope that those goods and services will satisfy their needs. Trademarks allow the identification that shoppers need to make informed choices concerning competing commodities.

In a case of reverse passing off, the denominative message will exist regardless of what mark appears on the commodity.¹⁷³ The only possible problem is the associative message. If the true source is well known to purchasers, its mark will convey a clear associative message. Defendant's use of a different mark will not convey the same information and therefore will deprive purchasers of the benefit of their personal experiences with the true source.

It is difficult, however, to label this situation as "deceptive." A shopper who has had no experience with the defendant's mark will have no expectations for the product. That shopper will assume only the base level of quality that is conveyed by the denominative message, not any higher level that may come from experience. Admittedly, the defendant's use of a new mark is inefficient because it deprives purchasers of the benefit of experience. Yet, as long as they are not deceiving purchasers, sellers are not required to make the most efficient use of trademarks. A seller is free to change its mark at any time, even if it has acquired a strong secondary meaning. Similarly, a

picture); *Dodd v. Fort Smith Special Sch. Dist. No. 100*, 666 F. Supp. 1278 (W.D. Ark. 1987)(holding author entitled to injunction where a book was published without the author's name); *Morita v. Omni Publications Int'l. Ltd.*, 741 F. Supp. 1107 (S.D.N.Y. 1980).

172. See, e.g., *Cleary v. News Corp.*, 30 F.3d 1255 (9th Cir. 1994); *Roho, Inc. v. Marquis*, 902 F.2d 356 (5th Cir. 1990). But see *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434 (9th Cir. 1993)(finding in favor of the defendant, but only because the products that the defendant sold were significantly different than those sold by the plaintiff). For a general discussion of reverse passing off, including analysis of some of the cases, see William M. Borchard, *Reverse Passing Off—Commercial Robbery or Permissible Competition?*, 67 TRADEMARK REP. 1 (1977); Lori H. Freedman, *Reverse Passing Off: A Great Deal of Confusion*, 83 TRADEMARK REP. 305 (1993).

173. The discussion in the text assumes the defendant has not chosen a mark that is similar to some other seller's.

seller is free to sell the same product under multiple trademarks. These cases present the same likelihood of customer confusion as a case of reverse passing off, and yet no liability results.¹⁷⁴

Therefore, a language analysis suggests that a cause of action for reverse passing off should not be recognized under the law of trade emblems. Purchasers can never be injured by a mark without an associative message because the mark conveys no information to purchasers other than a denominative message. The cause of action also presents serious difficulties even if the mark of the true source has developed an associative message. Although inefficient, this situation presents little opportunity for deception.

This does not mean that the owner should have no rights whatsoever in these cases. Other considerations outside of trade emblem law may justify such a cause of action. Some courts have suggested, for example, that "reverse passing off" really involves the complex and controversial tort of "misappropriation."¹⁷⁵ In cases involving artists, a claim of reverse passing off might be justified as a form of the "moral right" of paternity, a right that the United States is obligated to provide under the Berne Convention.¹⁷⁶ This Article merely suggests

174. There are certain rare cases in which purchaser deception will arise from reverse passing off. One example is when a defendant's trade emblem has its own preexisting associative message that developed in connection with goods from a different source. If the defendant now changes to a new product line, purchasers will be injured if the new product is not of the quality associated with defendant's emblem. A separate cause of action for reverse passing off is unwarranted in this situation, however. Instead, the situation is merely a variation on the question of whether a trade emblem should be treated as creating an actionable "warranty," an issue discussed *supra* text accompanying notes 109-116.

Second, some sellers might choose not to use the mark of the true source in an effort to mislead purchasers. If purchasers have had bad experiences with the product and therefore have developed a negative associative message, a seller may actually be better off using a new and unfamiliar mark. Many purchasers will be more willing to take a chance on an unknown mark than to deal again with a seller with whom they have had bad experiences. In this situation, denying shoppers their past experience may actually increase the possibility of injury. However, unless the law is willing to prohibit *all* sellers from changing their trade emblems to avoid their past, there is no clear reason to single out the defendant who engages in reverse passing off for such treatment.

175. *Summit Machine Tool Mfg. Corp. v. Victor CNC Systems, Inc.*, 7 F.3d 1434, 1441 (9th Cir. 1993).

176. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, revised in Paris on July 24, 1971, S. Treaty Doc. No. 27, 828 U.N.T.S. 221. The treaty requires signatory nations to supplement their copyright laws with additional authors' rights. The key section is Article 6*bis*:

ARTICLE 6*bis*

(1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

lawmakers need to recognize the problem for what it really is and not use the law of trade emblems to accomplish ends for which it was not designed.

IV. CONCLUSION

Many consider trade emblem law to be narrow, technical, and highly specialized. Although the rules may be difficult, the law of trade emblems actually is concerned with the very important and wide-ranging problem of language. Communication is crucial to most of life's affairs, including the mundane day-to-day dealings that we call the market. Because communication is costly, a market imperfection can result from inefficiency. Trade emblems improve efficient market communication by allowing sellers to convey many different ideas to purchasers in a short word, phrase, or image.

The law protects trade emblems because it recognizes their tremendous importance in facilitating efficient communication. Yet, such communication is effective only if it is accurate. Although the law has many means of ensuring accuracy in market speech, granting exclusive rights to particular sellers is a useful way to enlist the aid of private parties to police certain types of deception.

Nevertheless, legislators and courts have largely failed to recognize that the law of trade emblems forms a part of the broader question of communication. Lawmakers are more accustomed to dealing with convenient labels, such as "property," than they are to forming a

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification of or accession to this Act, does not provide for the protection of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

Id. The "right to claim authorship" is commonly known as the right of "paternity."

The United States ratified the Berne Convention in 1988, and therefore is obligated by Article 6*bis* (3) to afford authors and artists a right of paternity. Congress' initial response, the Visual Artists' Act, Pub. L. No. 101-650, § 106A, ___ Stat. ___ (1990), does not provide such a right. This does not necessarily mean that the United States has failed to meet its obligations. During the debates preceding the United States' accession to Berne, many of the opponents of the Convention claimed that Article 6*bis* would require major revisions of United States law. To counter these claims, those favoring accession argued that the moral rights were in practice not all that different than rights that authors already possessed under current United States law, in particular § 43(a) of the Lanham Act. See, e.g., *Gilliam v. American Broad. Co., Inc.*, 538 F.2d 14 (2d Cir. 1976).

law of language. Unless those who create the legal rules recognize the broad implications those rules have for language, the resulting laws may impair, rather than facilitate, accurate communication in the market.

Fortunately, a review of the law of trade emblems from the perspective of language reveals that most of the basic principles are fundamentally sound. Problems begin to arise only when one approaches the fringe issues of the law. It is telling that courts have often disagreed on these fringe issues, even when they approach the question according to the standard doctrine. This suggests that the interrelationship between the law of trade emblems and language is intuitively apparent, even if language considerations have not yet been a formal part of the analysis.

In closing, this Article does not pretend to be the last word on the question. The issues discussed constitute only a small portion of the many issues in trade emblem law that might benefit from a language analysis. The goal of the Article is to open a door to a new way of thinking about trade emblem law and to provide a few illustrations of how the approach might work. If this analysis is helpful, the principles of language can eventually assume their proper place in the law of trade emblems.