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# A LINGUISTIC LOOK AT TRADEMARK DILUTION

Ronald R. Butters<sup>†</sup>

## *Abstract*

*Trademark dilution, despite its significance as a cause of action in trademark law, has not been as heavily analyzed by scholars within the field of linguistics and law as one might expect. This article reviews contributions that linguists have made to trademark law and suggests that established linguistic methodologies might assist legal practitioners in formulating causes of actions based on trademark dilution.*

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## I. INTRODUCTION

Trademark dilution is a topic that has rarely been engaged within the specialized field of linguistics and law,<sup>1</sup> even by those scholars who regularly consult with law firms on trademark issues and on occasion testify as expert witnesses in trademark litigation.<sup>2</sup> “Forensic linguists” have long been accepted as legitimate social-science expert witnesses on such trademark matters as strength of mark and likelihood of confusion,<sup>3</sup> but very rarely have they opined directly on dilution issues. This essay (1) reviews the types of contributions that linguists have commonly made with respect to trademarks (including a look at two cases in which the testimony of linguists may have had some effect on the determination of dilution); and (2) presents some suggestions about how established methodologies of linguistics might be of service to legal professionals in construing dilution in theory and practice.

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1. The scholarly organizations most centrally concerned with the field of Language and Law are the International Association of Forensic Linguists and the International Association for Forensic Phonetics and Acoustics, which jointly publish a scholarly journal devoted to the field, *The International Journal of Speech, Language, and the Law*. Another international scholarly group, The Law and Society Association, regularly offers sections on language-and-law topics at its annual meetings. In North America, papers in the field are presented at meetings of—and published in the scholarly journals of—the American Dialect Society, the American Name Society, The Dictionary Society of North America, and the Linguistic Society of America.

2. See Roger W. Shuy, *Linguistic Thoughts on Trademark Dilution* (Jan. 2004) (unpublished manuscript of a conference presentation, on file with author); Roger W. Shuy, *Linguistics and Trademark Dilution*, TRADEMARK DILUTION F. 2003, available at [http://www.rogershuy.com/download.php?file=RWS\\_article\\_trademark\\_dilution.pdf](http://www.rogershuy.com/download.php?file=RWS_article_trademark_dilution.pdf); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004) (discussing dilution within a broad linguistic framework).

3. Raven I. McDavid, Jr., *Evidence*, in PAPERS IN LANGUAGE VARIATION: SAMLA-ADS COLLECTION 125 (David L. Shore & Carole P. Hines eds., 1977) (discussing one such apparent likelihood-of-confusion case against Jay’s Potato Chips of Chicago on behalf of Frito-Lay of Atlanta and Dallas in which the author had served as an expert linguistic consultant); *E. Air Lines, Inc. v. N. Y. Air Lines, Inc.*, 559 F. Supp. 1270 (S.D.N.Y. 1983) (a case in which the linguist Allen Walker Read and the lexicographer Jesse Stein took opposite sides in giving testimony with respect to the alleged genericness of the mark *Air Shuttle* used to designate a type of airplane service); Richard Bailey, *Dictionaries and Proprietary Names: The Air-Shuttle Case*, 6 DICTIONARIES 53 (1984) (publication of the experts’ reports from *E. Air Lines*). Concerning more recent cases, see the works listed *infra* at note 4; see also Janet E. Ainsworth, *Linguistics as a Knowledge Domain in the Law*, 54 DRAKE L. REV. 651, 662-63, 669 (2006); Blake Stephen Howald, Comment, *Comparative and Non-Comparative Forensic Linguistic Analysis Techniques: Methodologies for Negotiating the Interface of Linguistics and Evidentiary Jurisprudence in the American Judiciary*, 83 U. DET. MERCY L. REV. 285, 288-289 n.14 (2006).

## II. TRADEMARK DILUTION AND LINGUISTIC MEASURES OF “FAME”

Apart from the specialized field of linguistics and law, conceptualizing trademarks as linguistic objects has been almost entirely in the service of the linguistic subspecialty known as lexicography or dictionary making.<sup>4</sup> Because trademarks are in most respects full-fledged words in the language, lexicographers have needed to be able to define such terms as *trademark*, *service mark*, and *brand name* not only as dictionary entries but also as terms of art within the field itself.

Furthermore, dictionary makers have needed to develop concepts akin to the legal notion, important to dilution issues, of trademark fame. Even unabridged dictionaries cannot possibly list and define all of the words that speakers of English use—let alone all of the trademarks. Thus dictionary makers have had to find some principled means for ranking words according to their lexicographical importance—so as to be able to exclude some and include others. The criteria that have evolved require something of a lexicographical balancing act: (a) special consideration is given to relatively arcane terms that the general user of a dictionary might nonetheless have occasion to look up (for example, brand names for pharmaceuticals); yet (b) terms must also be included that are so frequent in occurrence and central to the ordinary speaker’s knowledge of the language that they belong in every dictionary as a matter of record—what to the lexicographer are, in effect, “famous” words.

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4. Outside the field of lexicography, the most in-depth overview of linguistic work on trademarks is ROGER W. SHUY, *LINGUISTIC BATTLES IN TRADEMARK DISPUTES* (2002) [hereinafter SHUY, *LINGUISTIC BATTLES*]. See also Michael Adams, *Lexical Property Rights: Trademarks and American Dictionaries*, *VERBATIM*, Winter 2005, at 1; Michael Adams & Jennifer Westerhaus Adams, *Surnames and American Trademark Law*, 53 *NAMES* 259 (2005); Dennis Baron, *Word Law*, *VERBATIM*, Summer, 1989, at 1; Ronald R. Butters, *Changing Linguistic Issues in US Trademark Litigation*, in *PROCEEDINGS OF THE SECOND EUROPEAN IAFL CONFERENCE ON FORENSIC LINGUISTICS/LANGUAGE AND THE LAW* 29 (M. Teresa Turell et al. eds., 2007); Ronald Butters, *Sociolinguistic Variation and the Law*, in *SOCIOLINGUISTIC VARIATION: THEORIES, METHODS, AND APPLICATIONS* 318 (Robert Bayley & Ceil Lucas eds., 2007); Ronald R. Butters, *Trademarks and Other Proprietary Terms*, in *DIMENSIONS OF FORENSIC LINGUISTICS* 318 (John Gibbons & M. Teresa Turell eds., forthcoming) (manuscript on file with author); Ronald R. Butters & Jennifer Westerhaus, *Linguistic Change in Words One Owns: How Trademarks Become “Generic,”* in *STUDIES IN THE HISTORY OF THE ENGLISH LANGUAGE II* 111 (Anne Curzan & Kim Emmons eds., 2004); SHAWN M. CLANKIE, *A THEORY OF GENERICIZATION ON BRAND NAME CHANGE* (2002); Genine Lentine & Roger W. Shuy, *Mc-: Meaning in the Marketplace*, 65 *AM. SPEECH* 349 (1990) (describing Shuy’s testimony in *Quality Inns Int’l, Inc. v. McDonald’s Corp.*, 695 F. Supp. 198, 215-16 (D. Md. 1988)).

Thus the notion of the relative fame of a trademark, so important to determination of the legal potential for dilution, intersects with the lexicographical necessity for taking into account the degree to which a word might be considered well known. Within the legal framework, such evaluation cannot of course be a simple matter of (a) declaring a trademark “famous” that appears in standard dictionaries and (b) giving an automatic lesser status to trademarks that do not appear therein—if for no other reason than that standard dictionaries find room for very few trademarks at all. For example, *The American Heritage Dictionary of the English Language* has over 70,000 entries, only about 300 of which are defined as active trademarks.<sup>5</sup> Moreover, of the listed live trademarks, a number appear to be relatively obscure—the kind of words that are listed because the dictionary maker may well have concluded that the general public will not be familiar with them (for example, *Pentothol*, *Butazoladin*, *Lastex*, *Mauser*, *Bondo*).<sup>6</sup> Others appear intuitively to be so famous that portions of the public may need to be instructed that they are trademarks and not generic terms (for example, *Band-Aid*, *Frisbee*, *Mace*, *Kleenex*, *Xerox*).<sup>7</sup> Still others that one might well expect to be in a list of “famous” marks are not entered in *American Heritage* (e.g., *Microsoft*, *Burger King*, *Apple*; some of these, such as *American Airlines*, may be omitted because they are so transparent in meaning).<sup>8</sup>

Dictionary making is an empirical science, based upon data collected from the actual use of the language by ordinary speakers and writers. Lexicographical methodology in large part involves the surveying of large samples of printed material from which definitions are inductively constructed. In principle, therefore, a linguist could readily construct, using the normal procedures of lexicography, an evaluation metric that would help a trier of fact to evaluate the degree of fame of a particular mark. As has been noted above, sheer quantity of occurrence already is one of the metrics that must be used when lexicographers do their word-exclusion tasks. Adapting the extant

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5. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2000).

6. *Id.* at 1302, 253, 989, 1082, 209.

7. *Id.* at 139, 705, 1047, 968, 1989.

8. *Transparent* is a term of art in linguistic semantics, used to describe words whose meaning is fully determined by the meaning of the component parts. For example, *dog food* ‘food for a dog’ is more transparent than *comfort food* ‘food which people eat when they are unhappy’, which in turn is more transparent than *soul food* ‘food that is characteristic of African-American culture in the United States’. The technical antonym for *transparent* is *opaque*. See DAVID CRYSTAL, A DICTIONARY OF LINGUISTICS & PHONETICS 474 (5th ed. 2003), (defining the term “transparent” and contrasting it to “opaque”).

lexicographical methodology to compare, for example, the relative frequency of occurrence in a LexisNexis search for instances of *Burger King*, *Apple*, and *Microsoft* versus *Kleenex*, *Xerox*, and *Frisbee* will yield a useful linguistic measure of relative “fame.”

### III. GENERICNESS ISSUES: VIABILITY OF “FAMOUS” MARKS

Historically in trademark litigation, expert linguistic opinion about trademarks concerns itself in large part with two areas: strength of mark and likelihood of confusion.<sup>9</sup> In my own consulting work, I have researched perhaps two dozen marks with respect to linguistic evidence relevant to the generic-descriptive-imaginative-arbitrary-fanciful continuum—for example, *Beanie* and *Beanie Baby* (Ty Inc.’s soft plush pellet-filled doll toys) and *Screenie Beanie* (Softbelly’s, Inc.’s soft, plush, pellet-filled doll-like computer-screen wiping devices);<sup>10</sup> *steakburger* (claimed as a common-law trademark by Steak n Shake);<sup>11</sup> *kettle* as a designator for a type of potato chip;<sup>12</sup> *zinger* as a spicy chicken menu item (claimed as a trademark by a restaurant chain).<sup>13</sup>

The word *generic* is a term of art in dictionary making as well as the law,<sup>14</sup> and lexicographical methodology underlies the most knowledgeable applications of linguistics to strength-of-mark questions. When dictionary makers find, in the objective data of everyday speech and published writing, widespread use of well-known brand names in a fashion that has technical earmarks of genericness, they may incorporate their findings in their dictionary

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9. Linguists are sometimes also called upon to trace the history of a word or phrase whose viability as a trademark has been challenged on historical grounds; for example, I carried out such a study for the defendants’ attorneys with respect to the phrase *whisper quiet*, used for decades to describe the noise-free qualities of various machines (e.g., automobiles, refrigerators, dishwashers, electric clothes driers). See *Whirlpool Props., Inc., v. LG Elec., Inc.*, No. 1:03-cv-414, 2005 U.S. Dist. LEXIS 30311, \*30-31 (W.D. Mi. Nov. 17, 2005). In addition, linguists consult in cases concerning marks that had been challenged as socially unacceptable; see discussion *infra* at notes 40-41.

10. *Ty Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 536 (7th Cir. 2003).

11. *Steak n Shake Co. v. Burger King Corp.*, 323 F. Supp. 2d 983, 985 (E.D. Mo. 2004).

12. *Classic Foods Int’l Corp. v. Kettle Foods, Inc.*, 468 F.Supp.2d 1181 (C.D. Cal. 2007)

13. Complaint at 3, *Ale House Mgmt., Inc. v. Raleigh Ale House, Inc.*, No. 5:02-CV-709-BO(3) (E.D.N.C. 2002).

14. See SIDNEY I. LANDAU, *DICTIONARIES: THE ART AND CRAFT OF LEXICOGRAPHY* 405 (2d ed. 2001) (defining *trademark* as “a symbol or name used by a maker of a product to distinguish the product from others of its kind”). Landau distinguishes trademarks from generic words, which are ordinary words “commonly used . . . not for a brand of a kind of thing but for the kind of the thing itself.” *Id.* at 406.

entries, generating definitions such as the following from *The American Heritage Dictionary of the English Language*:

### **Band-Aid**

A trademark used for an adhesive bandage with a gauze pad in the center, employed to protect minor wounds. This trademark sometimes occurs in print in figurative uses: “*True welfare reform is being bypassed for Band-Aid solutions*” (Los Angeles Times). “*These measures are mere Band-Aids*” (U.S. News & World Report).<sup>15</sup>

### **Frisbee**

A trademark used for a plastic disk-shaped toy that players throw and catch. This trademark sometimes occurs in print meaning “a throw-and-catch game played with this toy”: “*The Mall is a better place to play Frisbee with a dog*” (Los Angeles Times).<sup>16</sup>

### **Mace**

A trademark used for an aerosol used to immobilize an attacker temporarily. This trademark often occurs in print in uppercase or lowercase as a verb and a noun: “*shouted at police after he was Maced when he rushed the fence*” (David Shepardson, Detroit News June 23, 1996).<sup>17</sup>

### **Xerox**

A trademark used for a photocopying process or machine employing xerography. This trademark often occurs in print in lowercase as a verb and noun: “*Letters you send should be xeroxed after you sign them*” (Progressive Architecture). “*He has four or five sheets of foolscap, xeroxes, I see, of court documents*” (Scott Turow).<sup>18</sup>

While not actually using the term *generic* to characterize these marks, the *American Heritage* editors make use of well-known legal earmarks of genericness in describing the cited usages, commenting variously (1) that the marks sometimes appear in print in lower case, (2) that they function as nouns and verbs,<sup>19</sup> (3) that they are used

15. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 139 (4th ed. 2000) (underlining added).

16. *Id.* at 705 (underlining added).

17. *Id.* at 1047 (underlining added).

18. *Id.* at 1989 (underlining added).

19. In law, trademarks are often referred to as “adjectives” (a linguist would be more apt to term them “noun adjuncts”) since their full-phrase use is technically as modifiers of generic

“figuratively,” and even (4) (in the case of *Frisbee*) that they occur in print with what appear to be, in effect, generic meanings. Clearly, lexicographers understand the legal concept of genericness, but they avoid explicitly labeling listed terms as “generic” so as to exempt themselves from what might be construed as the drawing of legal conclusions (thus avoiding the threat of legal action from the trademark owners).<sup>20</sup>

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terms (e.g., *Charmin toilet paper*). See Gregory H. Guillot, A Guide to Proper Trademark Use, <http://www.ggmark.com/guide.html> (last visited Jan. 17, 2008):

Marks are adjectives, and should be used only as such. Marks never should be used as nouns or verbs. Nor should marks be pluralized, or used in the possessive form. Non-adjectival uses of marks, over time, can result in genericness, or a finding of unintentional abandonment -- even when such use emanates from the public, rather than a trademark owner. For this reason, the owners of marks such as Coke<sup>®</sup>, Kleenex<sup>®</sup>, Xerox<sup>®</sup>, and FedEx<sup>®</sup>, expend considerable efforts to educate the public concerning the proper use of marks.

One way to ensure that a mark is used in proper adjectival context, is to follow each use with the generic noun for the product identified. For example, generic terms for the trademarked products and services mentioned in the preceding paragraph, are “soft drink,” “facial tissue,” “photocopier,” and “overnight courier service.”

Using these terms after the marks makes them adjectives rather than nouns.

Using the word “brand” after a mark, and before the generic product name, further guards against non-adjectival use.

*Id.* Regardless of the advice of Guillot and others, trademarks frequently appear in print without the accompanying generics, even in use by their trademark owners (e.g., *Please don't squeeze the Charmin!*). Thus any such instance would appear to be of minor linguistic significance to the mark's genericness status unless the instance also does not capitalize the mark. The use of a mark as a verb, on the other hand, would appear to be far more robust linguistic evidence that the user does not think of the term as a brand name but rather as a generic, even if (in this era of automatic spell-checks) the user capitalizes the term (e.g., *Please Xerox this letter for me!*).

20. Indeed, many dictionaries publish disclaimers in their front matter that explicitly deny that the definitions given therein constitute any legal claims about words, especially not about the strength of any trademark. For example, the disclaimer of the *New Oxford American Dictionary* reads as follows:

This book includes some words that are, or are asserted to be, proprietary names or trademarks. Their inclusion does not imply that they have acquired for legal purposes a nonproprietary or general significance, nor is any other judgment implied concerning their legal status. In cases where the editors have some evidence that a word is used as a proprietary name or trademark, this is indicated by the designation TRADEMARK, but no judgment concerning the legal status of such words is made or implied thereby.

NEW OXFORD AMERICAN DICTIONARY iv (2001). While I know of no case in which trademark holders have brought suit against dictionary makers for any claims the dictionary makers may have made with respect to the putative genericness of marks (and even if such legal action could not possibly be successful), it is reported that dictionary publishers do frequently receive complaint letters from the trademark holders' attorneys, letters that the lexicographers would rather not have to explain to their in-house legal departments. See LANDAU, *supra* note 14, at 406–09.

It is also an established principle of trademark law that a mark will not be considered generic if the public in general—and potential purchasers in particular—know and recognize it as a brand name, i.e. if “the primary significance of the term in the minds of the consuming public is not the product but the producer.”<sup>21</sup> This holds true even if consumers sometimes use the brand name figuratively or in shorthand (i.e., synecdochical) reference to the type of goods or service that each brand represents.<sup>22</sup> It thus seems reasonable to conclude that such extraordinarily famous brands as *Band-Aid*, *Kleenex*,<sup>23</sup> and *Xerox*, which (as the dictionaries report) sometimes exhibit in print overt features of genericness, have not in fact undergone *genericide*—assuming that the relevant public still recognizes them as brand names. Such trademarks have recently been termed *pseudogenerics*.<sup>24</sup>

Regardless of the special treatment of the features of genericness in dictionaries, the lexicographical methodology generates data that speak explicitly to strength-of-mark issues, and this is what the linguistic expert draws upon in offering testimony bearing on

21. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938).

22. See Butters and Westerhaus, *supra* note 4 (arguing that linguists (e.g., CLANKIE *supra* note 4; SHUY, LINGUISTIC BATTLES, *supra* note 4, at 55) and lexicographers (LANDAU *supra* note 14, at 406–09) have failed to take this important legal (and sociolinguistic) principle into account when assuming that many famous brands should properly be labeled “generic”).

23. Perhaps somewhat surprisingly, the *American Heritage* dictionary does not cite any of the usual legal earmarks of genericness in its definition of *Kleenex*, writing simply that it is “A trademark used for a soft facial tissue.” THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 968 (4th ed. 2000) (1969).

24. Ronald R. Butters, *Genericness in Lexicography, General Linguistics, and American Trademark Law* (July 2001) (unpublished conference presentation, Fifth Biennial Conference, International Association of Forensic Linguists, University of Malta) (on file with author); Jennifer Westerhaus and Ronald R. Butters, *Trademark Genericide in Specialized Communities*, (July 2003) (unpublished conference presentation, Sixth Biennial Conference, International Association of Forensic Linguists, University of Sydney, Australia) (on file with author); Ronald R. Butters, *Linguistic Issues in American Trademark Law*, (Sept. 2006) (unpublished presentation, Sixth International Summer School in Forensic Linguistic Analysis, Birmingham, England) (on file with author). The term *genericide* is sometimes used to describe situations in which, usually because of frequent shorthand and figurative use, consumers actually have lost all meaningful mental connection between the mark and the company that has been the source of origin of the product. Many trademarks were declared to have become generic in this way in earlier days—for example, *aspirin*, *cellophane*, and *shredded wheat*. See, e.g., *Bayer Co. v. United Drug Co.*, 272 F. 505, 514–15 (S.D.N.Y. 1921); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938). Because of modern advertising and marketing techniques, as well as vigilant legal policing by trademark holders, genericide appears to be somewhat rare today, though such terms as *murphy bed* and *trampoline* were in relatively recent times declared to have lost their status as trademarks. See, e.g., *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 100–01 (2d Cir. 1989); *Nissen Trampoline Co. v. Am. Trampoline Co.*, 193 F. Supp. 745, 749 (S.D. Iowa 1961).

strength-of-mark questions, particularly in cases where genericness is at issue.

In cases in which the plaintiff asserts dilution, the use of such linguistic expertise about the strength of marks will arise, at least occasionally. Because marks about which the trademark holders can assert dilution claims must by definition be “famous,”<sup>25</sup> even descriptive marks in such cases would presumably have secondary meaning (or they would not be “famous”). Thus the issue of strength of mark arises in dilution cases only if the defendant claims that the plaintiff’s mark is generic.

It seems likely that in some instances of famous marks, a genericness defense would be plausible (if sometimes meretricious). That is, if a putatively diluted mark is generic, and hence not a legitimate mark at all, then it could scarcely be defended, regardless of how “famous” it might be.<sup>26</sup> In *Ty Inc. v. Softbelly*, in which Ty complained that Softbelly was diluting its *Beanie* mark, the defendant makers of Screenie Beans did in fact assert just that—that *Beanie* had undergone genericide.<sup>27</sup> Our analysis, conducted following lexicographical methodology, was based upon both a LexisNexis search and an online search using the Google search engine. We concluded that *Beanie* was not generic (and submitted our findings to the court, and presented them to the jury in testimony): unlike what lexicographers found for even such pseudogenerics as *Band-Aid*, *Frisbee*, *Mace*, *Xerox*, or *Kleenex*, standard written sources contain very few uses of *Beanie* and *Beanie Baby* that meet any of the standard legal criteria for genericness (e.g., lower-case representation, figurative usage, use in general reference, and use as a verb).

If dilution litigation continues to increase, the genericness defense will no doubt come forth again and again—whenever the defendant feels that it is a legitimate counter to the dilution claim. If so, then there will be cause to call upon linguists in such dilution cases.

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25. 15 U.S.C.A. § 1125(c)(1) (West Supp. 2007)

26. The discussion here in some ways parallels Shuy’s discussion of the “origins” of dilution: “attorneys would be prudent to find out who caused the dilution and when it started. . . . The senior owners of famous marks can create dilution all by themselves.” Shuy, *Linguistics and Trademark Dilution*, *supra* note 2, at 5.

27. *Ty Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 530-36 (7th Cir. 2003).

## IV. BLURRING AND SIMILARITY OF THE MARKS

The other subject about which linguists frequently give expert testimony in trademark cases involves evidence bearing on the issue of likelihood of confusion. I have been a consultant in a number of cases involving alleged likelihood of confusion of two marks (e.g., between CarMax and AutoNationUSA<sup>28</sup> and between Aventis and Advancis).<sup>29</sup> In most of these cases, dilution was not part of the plaintiff's complaint, and to my knowledge the linguistic evidence was not ever brought to bear on the dilution complaint.

Even though "likelihood of confusion" as such is explicitly ruled out by statute as a determining factor in dilution litigation, a question nevertheless does arise as to just how similar two marks must be to trigger "tarnishment" and/or "blurring."<sup>30</sup> Obviously, if the two marks are identical, as in, say, Delta (faucets) and Delta (airlines), then there is little that a linguist (or anyone else) can say about the likelihood that one mark might remind the members of the public of the other based strictly on phonological, morphological, and semantic grounds.<sup>31</sup> On the other hand, when two marks are NOT absolutely identical, significant questions may arise. In the case of *Victoria's Secret* and *Victor's Little Secret*, the courts were at least willing to entertain the notion that the linguistic similarity of the two could trigger significant blurring and tarnishment—significant enough to be of detriment to the senior mark.<sup>32</sup> Thus analysis of the kinds and amounts of phonological, morphological, and semantic similarity of two contesting marks could conceivably be of use in such cases.

In at least one case in which the issue of dilution was part of the complaint, linguistic-issue testimony concerning the similarities and differences of the two marks at issue appears to have been influential. In one well-known case the plaintiff's mark, *Lexis*, was already in use

28. *AutoNation, Inc. v. Acme Commercial Corp.*, No. 98-5848 (S.D. Fla., Dec. 9, 1999). The marks in this case were CarMax's *Automation* and AutoNation, Inc.'s, *AutoNationUSA*.

29. *Sanofi-Aventis v. Advancis Pharm. Corp.*, 453 F.Supp. 2d 834 (D. Del. 2006).

30. 15 U.S.C.A. § 1125(c).

31. However, forms of sociolinguistic analysis—pragmatics, discourse analysis, and semiotics—could prove useful in approaching such questions as trade dress, advertising, and market overlap. As Roger Shuy notes, "Context is very important in accusations of dilution. Words in isolation seldom occur in our lives, except in spelling bees and grocery lists"; "Is there any reason to believe that the human mind would have difficulty keeping straight several different products . . . in their distinct and unique linguistic and commercial contexts?" SHUY, *LINGUISTIC BATTLES*, *supra* note 4, at 7, 8.

32. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 423-35 (2003). Linguists apparently did not examine these issues, and the linguistic basis for the court's judgment is not clear.

for an information-processing web site, and the defendant intended to use the mark *Lexus* for luxury automobiles.<sup>33</sup> The case was decided in favor of the defendant, at least in some part because of supposed major differences in pronunciation between the words *Lexis* and *Lexus*. The alleged crucial difference was asserted in the testimony of a professor of medieval literature from the Columbia University English Department, which was quoted as follows in the majority opinion:

[A]nyone can pronounce “lexis” and “lexus” the same, either both with an unstressed I or both with an unstressed U, or schwa—or with some sound in between. But, properly, the distinction between unstressed I and unstressed U, or schwa, is a standard one in English; the distinction is there to be made in ordinary, reasonably careful speech.<sup>34</sup>

Unfortunately, the professor’s testimony runs contrary to the linguistic reality: for most Americans, the pronunciations of *Lexus* and *Lexis* are so close as to be virtually indistinguishable, and for many they are in fact identical; not only is it neither “standard” or inherently “proper” to distinguish “unstressed I” and “unstressed U,” the two are normally interchangeable variants, and attempts at distinguishing them in uttering the two marks will sound highly artificial and unnatural. Still, right or wrong, *Mead* presents an instance in which testimony, admitted as “expert,” about the linguistic phonological differences between two marks at least marginally affected the decision in a dilution case—and was considered important enough to be quoted in the majority opinion.

In a second case,<sup>35</sup> decided in favor of the plaintiff on trademark infringement grounds shortly before the passage of the Trademark Dilution Revision Act of 2006 (TDRA), Judge Sue L. Robinson found in addition that there was a likelihood of dilution under Delaware law—though she found no demonstrable actual dilution, which the United States Supreme Court had ruled in *Moseley v. V Secret Catalogue, Inc.* was necessary under the pre-revision version of the federal dilution laws.<sup>36</sup> In her published opinion, Judge Robinson incorporated elements of my expert linguistic testimony on behalf of the plaintiff concerning “degree of similarity of the two marks”

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33. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026 (2d Cir. 1989). I was not a consultant in this case.

34. *Id.* at 1029-30.

35. *Sanofi-Aventis v. Advancis Pharm. Corp.*, 453 F.Supp. 2d 834 (D.Del. 2006).

36. *Moseley*, 537 U.S. at 433.

*Aventis* and *Advancis*.<sup>37</sup> Judge Robinson was persuaded by the plaintiff's arguments that the two marks were confusingly similar, and this view in turn formed a fundamental basis for her decision in favor of the plaintiff.<sup>38</sup> Moreover, the view that *Aventis* and *Advancis* are confusingly similar in sound and meaning appears to have been instrumental in her conclusion concerning "likelihood of dilution" under Delaware trademark law:

In order to prevail on a claim brought pursuant to the [Delaware Trademark Act], a plaintiff must demonstrate that there is a likelihood of dilution, not actual dilution. Likelihood of dilution requires "some mental association between the marks" and can be defined as a "blurring of a mark's product identification or the tarnishment of the affirmative associations a mark has come to convey." *Barnes Group*, 793 F. Supp. at 1304.

As discussed above, the court concludes that a likelihood of some mental association between the marks exists based upon the testimony of plaintiffs' witnesses. Accordingly, the court concludes that defendant's mark causes dilution pursuant to the DTA.<sup>39</sup>

In light of the 2006 revision to federal trademark law, Judge Robinson's opinion would surely extend now to federal trademark law as well.

## V. CONCLUSION

The considerable experience that linguists have had in thinking about trademarks can, I believe, be brought to bear in dilution cases in the ways that I have discussed here:

1. Providing evidence for the determination of one dimension of fame.
2. Providing evidence with respect to the validity of the mark where genericness issues are raised by the defendants.
3. Determining the likelihood of blurring and tarnishment with respect to the phonological, morphological, and semantic characteristics of the mark.

These are rather conservative goals. One might well also consider whether linguistics can shed light on the nature of

37. Judge Robinson also noted that the linguistic testimony of the defendant's linguistics analyst (who was the same Columbia University medievalist who testified for the defendants in *Mead*) supported the plaintiff's case. *Sanofi-Aventis*, 453 F.Supp. at 848-49.

38. *Id.*

39. *Id.* at 855 (emphasis added).

tarnishment. Linguistic expertise has sometimes been brought to bear upon questions of legal defamation;<sup>40</sup> linguists have also testified about whether trademarks violate federal trademark law forbidding “immoral, deceptive, or scandalous matter; or matter which may disparage.”<sup>41</sup> The methodology in such cases might also be brought to bear upon the determination of tarnishment. Time will tell if clever attorneys will find ways of making use of the expert testimony of bone fide linguists in taking on this issue.

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40. See Peter Meijes Tiersma, *The Language of Defamation*, 66 TEX. L. REV. 303 (1987); HANNES KNIFFKA, *WORKING IN LANGUAGE AND LAW* 113 (2007).

41. 15 U.S.C. § 1052 (2000). See, e.g., DYKES ON BIKES, U.S. Trademark Serial No. 78/281746 (filed July 31, 2003), Office Action from Sharon A. Meier, Trademark Attorney (Feb. 20, 2004) (denying the application initially, but finally allowing it after the applicant filed an appeal supported by my affidavit and that of numerous social scientists, including linguists and lexicographers). In another case that began in the late 1990s, the USPTO denied renewal of the trademark *Redskins* (use for generations as the professional name for the Washington, DC, football team) on grounds that the mark was disparaging and therefore in conflict with the explicit prohibition of federal trademark law. The lexicographer David K. Barnhart and I testified on behalf of Pro-Football, Inc. The linguist Geoffrey Nunberg testified on behalf of Harjo et al. The decision to deny renewal was overturned in 2003 by the United States District Court for the District of Columbia. See *Pro-Football, Inc. v. Harjo*, 284 F.Supp. 2d 96, 107-09 (D.D.C. 2003), *reh'g denied*, No. 03-7162, 2005 U.S. App. LEXIS 19603 (D.D.C. 2005) (*per curiam*).

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