# Screening Meaning

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## ABSTRACT

Trademark law exists to promote competition. If consumers know which companies are responsible for which products, they can more easily find the products they actually want to purchase, and companies will have incentives to cultivate reputations for high quality. Trademark law has long treated "source significance"—the fact that a particular trademark is identified with a particular producer—as both necessary and sufficient for establishing a valid trademark. That is, trademark law has traditionally viewed source significance as the only necessary precondition for a trademark being pro-competitive. In this paper, we establish that this equation of source significance and pro-competitiveness is misguided. Some marks use words and images that are so closely connected with the product being branded that giving just one firm a monopoly over those words and images provides that firm with a meaningful competitive advantage—an artificial advantage granted by the state. This problem becomes worse as the number of firms producing (and branding) a type of product increases.

The more words cordoned off by trademark law, the more trouble a new entrant will have in describing or attracting attention to its product. Trademark law is thus being hijacked by strategic firms for anti-competitive purposes. Traditional doctrinal tools are inadequate to address this problem because the goal is to limit the number of such trademarks rather than eliminate them completely. However, costly screens could be used to impose a form of congestion pricing on trademarks, eliminating them in all but the most worthwhile cases. In this paper, we develop a theory of the anti-competitive nature of certain trademark rules. We then propose a series of overlapping doctrinal rules and costly screens to address the problem of rampant anticompetitive trademarks.

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## Introduction

Imagine that the electronics firm Persimmon, Inc. begins selling a new fitness tracker that it calls ActivTrak. The firm is trying to enter a crowded market for consumer electronics, and it has some new technology that it hopes will set its ActivTrak device apart. Persimmon spends substantial sums of money advertising its device on television and online, to the point that if you took a survey of consumers and asked them about the "ActivTrak," a large number of them would remember that it's the new type of fitness tracker made by Persimmon. The firm registers the name ActivTrak as a trademark. Now, no other firm can use those words for similar products without violating Persimmon's trademark rights.[1]

It is presumably good for consumers to have another fitness tracker on the market.[2] But what about Persimmon's branding and marketing strategy? Will it have positive or negative (or negligible) consequences for consumers in the electronics market? On the one hand, consumers now know that if they see a fitness tracker with the name ActivTrak on it, that device was made by Persimmon.[3] If a consumer thinks that Persimmon generally produces products of high (or low) quality, the trademarks can help her to purchase (or avoid) Persimmon products in the future. And because Persimmon alone will reap the reputational benefits (or bear the reputational costs) of its products, it has an incentive to maintain consistent product quality.

But from a competition perspective, there is a darker side to this branding. Because "active" is an obvious word to associate with fitness trackers, giving Persimmon the exclusive right to use "ActivTrack" could give it a significant market advantage.[4] And that advantage will likely extend beyond preventing competitors

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[1] We address some of trademark's limiting doctrines below. *See infra* Part II.A.

[2] *But see* BARRY SCHWARTZ, THE PARADOX OF CHOICE: WHY MORE IS LESS (2004) (discussing social science evidence that more choices can, in some circumstances, lead to worse outcomes).

[3] Or at least they should know that all devices bearing those marks come from the same source, even if they don't know that Persimmon is the source. This is trademark law's anonymous source rule. *See* Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 844 n.70 (2004) (citing Manhattan Shirt Co. v. Sarnoff-Irving Hat Stores, Inc., 164 A. 246, 250 (Del. Ch. 1933))

[4] Notice, by contrast, that the brand "Persimmon" causes substantially less competitive risk. Because persimmons have nothing to do with electronics, the exclusive use of the term to sell electronics

from using the term "ActivTrack" as a whole; indeed, there's a meaningful risk that rights in that composite mark will be used to bar others from identifying their own devices (or similar products) using the word "active" (and maybe even "track"). Competitors unwilling to risk litigation will have to find other evocative words and phrases to identify their own fitness trackers. But how many other signifiers have the power of the word "active?" That term immediately summons the idea of fitness, and Persimmon's ActivTrak may come to the minds of consumers more quickly and easily than the names of competing products. And the alternatives available to competitors are not unlimited in number.[5] Once firms have snapped up "active," "fit," and "run," the available store of evocative brand names will diminish relatively rapidly. The latest firm to try and enter this crowded marketplace might find itself climbing a steep hill, so to speak.

The types of competitive advantages associated with exclusive control of particularly powerful words have real costs for consumers. If Persimmon can limit the words that competitors can use, it can make it harder for those competitors to reach consumers. This may mean that consumers are steered toward Persimmon's products when they would otherwise prefer another brand, or it might just mean other brands have a harder time gaining traction in the market and therefore can't compete as effectively with Persimmon. As a result, Persimmon may be able to charge higher prices. And, critically, those advantages do not accrue because Persimmon's product is better. They accrue because the law gives Persimmon the right to limit others' use of the word "active" in connection with their competing fitness trackers.[6]

Trademark law should be attuned to these competition concerns. Indeed, these are the *principal* concerns to which trademark law should be attuned. Trademark law exists to promote fair competition, which ultimately benefits consumers. If

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imposes no real harm on competitors while generating considerable benefits for consumers and for the firm itself. *See infra* Part II.A.

[5] The electronic device category is one of the most cluttered fields of trademark registrations. Barton Beebe & Jeanne C. Fromer, *Are We Running out of Trademarks: An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 1017 (2018).

[6] Depending on the nature of the designs of the firm's logo or product packaging, the same concerns might apply equally, if not more, to exclusive rights in those features.

certain types of trademarks tend to inhibit competition, to the detriment of consumers, those are the types of trademarks that the law should screen out.

Trademark law purports to address those concerns by distinguishing between marks based on their meaning. The law makes it harder to acquire trademark rights in descriptive terms, which it deems not inherently distinctive, than it does in suggestive, arbitrary, or fanciful terms, which it treats as inherently distinctive. But courts and the PTO can't consistently identify words that have gained the kind of source significance that purportedly justifies their protection. And even if the doctrines worked better, they wouldn't solve the whole problem. For one thing, they draw the line at descriptive terms, ignoring altogether the potential costs of suggestive terms, which are protected automatically upon use. More fundamentally, trademark doctrine reflects its concerns about the costs of protection primarily by demanding more evidence of source significance.[7]

But as the ActivTrak example makes clear, source significance is not the whole story in terms of the competitive consequences of recognizing trademark rights. Protection of some terms that indicate source will still have an overall anticompetitive effect because those terms have distinct competitive advantages. Trademark doctrine is thus ineffective at screening out harmful marks because it focuses only on source significance and not on broader issues of competition.

This is not inevitable. Indeed, there are a variety of doctrinal changes that could help cure trademark law's myopia and more effectively focus its gaze on issues of competition, rather than merely source significance. It could do that with doctrinal screens that more categorically prohibit trademark protection of the kinds of marks that are likely to cause competitive harm. But no doctrinal screen is perfect. Doctrinal screens are inevitably porous; they fail to screen out some socially harmful marks.[8]

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[7] Trademark law also permits others to make non-trademark use of descriptive terms even if a party is able to prove secondary meaning and therefore acquire trademark rights in those terms. We discuss descriptive fair use in Part II.C below. It also refuses protection to functional features even if those features indicate source. *See* TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 28 (2001).

[8] *See* Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75 (2018); Jonathan S. Masur, *Costly Screens and Patent Examination*, 2 J. LEGAL ANALYSIS 687 (2010).

Accordingly, we propose implementing costly screens to complement trademark law's existing doctrinal screens. A costly screen is a cost that a private actor, such as a firm like Persimmon, must pay before acquiring a particular legal right or entitlement—here, valid trademark rights. A costly screen forces private parties to decide how much they value the particular legal right and how much they're willing to pay to obtain it. By increasing the price of obtaining the kinds of trademarks that are most likely to produce anticompetitive results, costly screens can channel firms towards selecting less harmful alternative marks.

Using costly screens is a second-best alternative in a world where doctrinal screens are imperfect. Costly screens inevitably create wealth effects, and applying them to highly dynamic product markets can be challenging. But a well-structured costly screen can ultimately aid new entrants and improve competition. It can screen out rights that would do more harm than good while still allowing private parties to obtain rights that will do more good than harm. Here, well-structured costly screens could eliminate many anticompetitive trademarks while preserving pro-competitive ones. Or so we shall argue.

This article proceeds in four parts. In Part I, we describe the way trademark law is meant to operate. In Part II, we explain and analyze the law's shortcomings—how its focus on source significance has obscured greater questions of anticompetitive advantage. In Part III we limn the operation of doctrinal and costly screens. We demonstrate that, despite superficial appearances to the contrary, trademark law lacks a meaningful costly screen that might deter private parties from seeking anticompetitive trademarks. Finally, in Part IV we explain how these shortcomings of trademark law could be alleviated with more effective doctrinal and costly screens.

## I. Trademarks and Competition

The standard account of the way that giving firms[9] or other organizations certain exclusive rights in names, symbols, or designs can improve markets and competition is well known, and we won't rehearse it at great length here.[10] As is often true in the law, understanding trademark law's competition benefits is easier when contemplating the doctrine's nonexistence.

Imagine that a winery has adopted the name SHEEP to identify and label the products that it makes. The winery sells a bunch of bottles so labeled, and people like it and want to buy more SHEEP wine. But when they return to the market, shoppers see four different bottles of wine all labeled SHEEP.[11] The different bottles all look basically the same, and there is no way, short of opening each one, for consumers to determine which one or any may be made by the winery that made the first bottle they tried. Goods like wine are valued primarily for their "experience" qualities—aspects of the goods that consumers can't discover merely by looking at them but have to actually experience.[12] But when several bottles all have the SHEEP mark, the consumers can't figure out which of the bottles might offer the same pleasures as the first SHEEP wine, so they choose randomly. Unhappily, three of four consumers won't get the wine that they want and instead will purchase a wine made by a different winery.

This is unfair competition. When we say that the wineries that bottled the other SHEEP wines did so "unfairly," what we mean is that they have created a meaningful risk of consumer harm and prevented the first winery from making sales

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[9] Throughout this Article we refer to "firms" and their behaviors, because firms or other corporate entities are the most important actors in trademark regulation. We recognize, though, that individuals and other entities also use trademarks.

[10] *See* Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010), William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

[11] This is a serious risk in some wine regions. *See* Christopher Buccafusco, Jonathan S. Masur & Ryan Whalen, *Measuring Brand Congestion in Bordeaux Wines: Too Many Towers, Hills, and Crosses?*,. J. WINE ECON. (forthcoming 2022) at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3903323.

[12] On the distinction between search goods and experience goods, see Phillip Nelson, *Information and Consumer Behavior*, 78 J. POL. ECON. 311 (1970).

that it had earned. Some of the people who wanted to buy wines with the qualities that they associated with the producer initially using the SHEEP name on its wines didn't get the wines that they wanted. They didn't necessarily get worse wine; they just didn't get the wine they were hoping for. They were deceived into purchasing wine from other producers rather than the one with whom they had positive associations.

Trademark law exists to prevent this risk of consumer deception. The law gives the first winery to use the word SHEEP on its products the exclusive right to do so, at least within that category of goods.[13] Now, having formed a positive association with wines labeled SHEEP or having been told to seek out wines so labeled, consumers can reliably obtain the products that they desire. Having identified a particular product with a particular source, consumers can feel confident, in a world with trademark law, that they will be able to use particular symbols as indicators and guarantors of source.[14]

Understood this way, trademark law has significant benefits for consumers.[15] It enables people to buy the products they think they're buying with less risk of being deceived. But trademark law has benefits for producers too, and courts and commentators frequently describe trademark law in dual-benefit terms.[16] Most directly, giving firms exclusive rights ensures that the consumer confidence we described translates into sales for the first user and that those sales aren't diverted to others who act deceptively. Less directly, trademark rights can allow producers to capture the value of investments in product quality.

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[13] Thus, for example, a producer of women's clothing might also adopt the mark SHEEP for its goods. *See* www.sheepofficial.com.

[14] *See* Landes & Posner, *supra* note 10, at 275.

[15] Laura A. Heymann, *The Public's Domain in Trademark Law: A First Amendment Theory of the Consumer*, 43 GA. L. REV. 9 (2009).

[16] United States Patent and Trademark Office v. Booking.com BV, 140 S.Ct. 2298, 2302 (2020) ("Guarding a trademark against use by others, this Court has explained, "secure[s] to the owner of the mark the goodwill" of her business and "protect[s] the ability of consumers to distinguish among competing producers.") *quoting* Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985). Commentators have long debated which interests trademark law primarily serves. *Compare* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839 (2013) *with* Robert G. Bone, *Hunting Goodwill: A History of The Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547 (2006). At its core, however, consumer and competitor interests will tend to converge.

Consider the winery example again. Imagine that a winery believes that if it ages its wines in new oak barrels, the resulting product will be superior to those of its competitors. The barrels and aging cost money, though, and the winery will have to charge more for the wine in order to offset the expense of these improvements. Now, again, the winery sells its wine using the name SHEEP on its labels, and some consumers taste the wine and appreciate the added flavor and richness that the oak barrels contribute. In a market without trademark law, though, other producers could use the same SHEEP mark on their bottles and price them more cheaply, because they did not invest in expensive aging.[17] The same problem reemerges. Consumers who are willing to pay more for oak aging cannot use brand names to reliably determine which products are so treated, and knowing this, the wineries are discouraged from making improvements in product quality, because they will not recoup their investments.[18] So trademark law, by helping consumers find the products that they want, can enable socially valuable competition.[19]

But consider a different situation. Because of an error at the winery, after a batch of white grapes is pressed, the juice is left to linger on the grape skins for several weeks. The resulting wine has a much darker amber color than a standard white wine along with a richer, fuller flavor. It turns out that people like the wine, and the winery bottles it, calling it "orange" wine.[20] Because of its popularity, other wineries also want to make this style of wine, and the initial winery doesn't have a

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[17] McKenna, *supra* note 16, at 1865.

[18] Sellers that age their wine could, of course, say so on their labels (describing their wine as "oak aged"), but consumers wouldn't be able to use the trademark as a shortcut for those characteristics and couldn't know exactly what characteristics "oak aged" referred to without tasting the wine. And they may not even know that the characteristics they liked were due to the oak aging; they just liked the SHEEP wine.

[19] *See also* S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946) (trademark statutes aim to "protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get"). *Booking.com*, 140 S.Ct. at 2302 ("We have recognized that federal trademark protection, supplementing state law, "supports the free flow of commerce" and "foster[s] competition.").

[20] *See* Orange Wine, WIKIPEDIA, https://en.wikipedia.org/wiki/Orange_wine.

patent that prevents them from doing so.[21] The other wineries also want consumers to be able to find their wines and understand what they are buying, so they too use the term "orange" to describe their wines. From the perspective of the initial winery, allowing others to use the term "orange" feels like unfair competition, because it's going to lose sales to its rivals or be forced to reduce its prices. But from consumers' and rivals' perspectives, this is the essence of fair competition.[22] Consumers get a range of options in a particular category, and they can choose the one that best aligns with their preferences for quality and price. And competitors are able to accurately describe competing products without having to resort to alternative terms.[23] If competitors were barred from using the word "orange" to describe their orange-tinged wine, they would not be able to accurately convey to consumers that they are making a similar product in a similar way.[24]

Thus, although trademark law can have important pro-competitive benefits, the recognition of exclusive rights to words, symbols, or designs can also have harmful effects on competition and, thus, on consumers, if those rights aren't appropriately tailored. For instance, if a winery were allowed to choose as its mark terms like WINE, RED WINE, or OAK AGED, other wineries would face enormous hurdles trying to describe their products without infringing the initial firm's rights. These words are so closely tied to the product at issue—red wine—that giving a single firm an intellectual property right over one or more of the words would bestow upon that firm a substantial competitive advantage.

These are the types of harms that trademark law should be trying to avoid. As we detail below, existing doctrine is not ignorant of these concerns. Indeed,

[21] In this case, it couldn't obtain a patent since the methods for making orange wine have been known for centuries. Id.

[22] Robert C. Denicola, *Freedom to Copy*, 108 YALE L.J. 1661 (1999).

[23] Landes & Posner, *supra* note 10, at 290.

[24] This is one of the challenges posed by geographic indication laws that prohibit use of certain geographic terms even when those terms are treated as generic for certain categories of goods. *See* Kal Raustiala & Stephen R. Munzer, *The Global Struggle Over Geographic Indications*, 18 EUR. J. INT. L. 337 (2007).

trademark doctrine purports to avoid them. But as we will explain, it has fallen notably short.

## II. The Shortcomings of Trademark Doctrine

In the prior Part, we briefly explained both the necessity of trademark rules and the possible pitfalls of granting trademark rights. In theory, well-crafted trademark law doctrine would permit trademarks that inform consumers and promote competition while screening out trademarks that award anticompetitive advantages and diminish consumer choice. But that is not how the law has developed, as the following Part explains. Here, we describe how flaws in trademark law's fundamental assumptions have allowed anticompetitive marks to proliferate.

### A. The Advantages of Certain Words

Word marks are the paradigmatic example of how firms and consumers communicate about product source and the paradigmatic form of trademark around which the eligibility rules were developed. But not all word marks are equivalent from a competition perspective. In some cases, a firm's choice of a particular word mark may give it undue competitive advantages over its rivals, enabling it to engage in rent seeking behavior that lowers consumer welfare.[25] In other circumstances, the sheer volume of claimed word marks may be substantially increasing the costs of entry for new firms, because too many of the "good" word marks are already claimed in a given field.[26]

It is an axiomatic principle of trademark law that different kinds of word marks have different impacts on competition.[27] Trademark law understands these differential effects primarily through the lens of "distinctiveness." As a matter of

[25] *See infra* notes 61-73.
[26] *See infra* notes 99-106.
[27] Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More than the Weak*, 92 NYU L REV. 1339, 1341 (2017).

current doctrine, signs that indicate source—that is, signs that indicate to consumers which producer is responsible for the goods—are called "distinctive," and distinctive signs are, by definition, trademarks.[28] That is, distinctiveness is treated as both necessary and sufficient for trademark validity.[29] But not all words or phrases are treated the same in terms of how the law assess their potential distinctiveness.

Trademark law has long evaluated words' distinctiveness by categorizing them along the famous *Abercrombie* spectrum.[30] That approach treats terms differently depending upon the amount of information the terms provide about the products or services with which they're used.[31] Arbitrary terms (terms that have existing meanings that are unrelated to the goods, like Apple for computers of Sheep for wine) and fanciful terms (coined terms, like Exxon) are considered inherently distinctive, which means they are protected as trademarks immediately upon use, without need for evidence that consumers actually associate the terms with particular producers.[32] That legal treatment is based in part on an empirical assumption that consumers will

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[28] Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2003). That distinctive terms qualify as trademarks doesn't necessarily mean they are protected irrespective of their use. Courts and especially the Trademark Office also insist that the mark be used in a way that it functions as a mark, though as Alex Roberts has detailed at length, the relationship between failure to function and distinctiveness is underdeveloped and the doctrine is often ad hoc. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977 (2018).

[29] Saying that distinctiveness is both necessary and sufficient for trademark status is not to say that distinctiveness is sufficient for registration. Section 2 of the Lanham Act details the bases on which marks can be denied registration, and those bases include but are not limited to distinctiveness. *See* 15 USC § 1052. The fact that registration can be refused on other grounds does not undermine our point, because registration is not necessary for trademark protection. There are benefits to registration, but unregistered marks are enforceable under section 43(a) of the Lanham Act on largely the same terms. *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) ("it is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)").

[30] *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) ("Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."); *Two Pesos, Inc.*, 505 U.S. at 768 (approving of the *Abercrombie* spectrum as the "classic formulation" of distinctiveness).

[31] *Abercrombie*, 537 F.2d at 9.

[32] *Two Pesos, Inc.*, 505 U.S. at 768; Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210-11 (2000) (citing Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10-11 (2d Cir. 1976)).

automatically treat arbitrary and fanciful terms *as trademarks*.[33] Because those terms provide no information about the nature or characteristics of the goods or services with which they're used, consumers are presumed to have no way to understand their use except as trademarks. Why else would someone put the word "Apple" on a computer?[34]

Trademark law also treats so-called "suggestive" terms, like "Igloo" for coolers, as inherently distinctive and protected as marks immediately upon use.[35] Unlike arbitrary and fanciful terms, suggestive terms relate to the goods they're used with. Igloo doesn't describe coolers, but it evokes something cold, so the connection is obvious once the goods are known. Suggestive terms provide indirect information about the goods, which distinguishes them from arbitrary terms. But precisely because the information that suggestive terms provide is indirect, trademark law treats them more like arbitrary terms than descriptive ones.[36] Just as with other inherently distinctive terms, the assumption is that consumers will be predisposed to understand suggestive terms as brand names rather than descriptions of the product.[37]

In addition to the assumptions about consumer understanding that underlie the treatment of arbitrary, fanciful, and suggestive terms as inherently distinctive, courts have long assumed that other parties have no real need to use those terms for their own goods because those terms provide no information about the goods or

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[33] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162-63 (1995) (contrasting color with "fanciful," "arbitrary," or "suggestive" words or designs, which "almost *automatically* tell a customer that they refer to a brand"); id. at 163 ("The imaginary word "Suntost," or the words "Suntost Marmalade," on a jar of orange jam immediately would signal a brand or a product "source"; the jam's orange color does not do so."); Two Pesos, Inc. v. Taco Cabana, 505 U.S. 763, 768 (1992) (Suggestive, arbitrary, and fanciful marks "because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection").
[34] It does not matter whether consumers know that an APPLE computer is manufactured by the Apple Computer Company, only that they believe all computers that bear the word APPLE come from the same source. *See* Austin, *supra* note 3.
[35] *Two Pesos, Inc*., 505 U.S. at 768; *Wal-Mart Stores, Inc*., 529 U.S. at 210-11.
[36] *Id*.
[37] 2 THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:4

services they're associated with.[38] Indeed, the belief that there was no legitimate explanation for using an arbitrary or fanciful term previously adopted by a competitor was the justification for treating those terms as trademarks and enforcing them as intellectual property rights.[39] Because competitors could choose from an nearly infinite variety of other terms, the law has assumed that automatically treating suggestive terms as trademarks imposes little to no competitive harm.[40]

Other kinds of words convey more information about the goods or services with which they're used. Descriptive terms convey direct information about the qualities or characteristics of goods.[41] When consumers see the word "tasty" on a food product they might think that word is a trademark, but they might just as easily (and even more plausibly) think that term simply describes the food product as "tasty."[42] The same can be said of geographic terms, which are treated like descriptive terms.[43] "Milwaukee's Best" might be a brand of beer; but, depending on how it's used, it might also just be a laudatory description of beer from Milwaukee.

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[38] Zobmondo Entertainment, LLC v. Falls Media, LLC, 602 F.3d 1108, 1117 (9th Cir. 2010); *see also* MCCARTHY, *supra* note 37, at § 11:68.

[39] Goldsmith Silver Co. v. Savage, 229 F. 623, 627 (1st Cir. 1915) ("In the case of infringement of a technical trade-mark the intention of the infringer is immaterial, as the essence of the wrong lies in the injury to a property right; while in the case of unfair competition the intention is material, to establish fraud on the part of the defendant in the use of the imitative device to beguile the public into buying his goods as those of his rival."); Scriven v. North, 134 F. 366, 375 (4th Cir. 1904); ("There are certain elements of property right in a technical trade-mark . . . ."); Church & Dwight Co. v. Russ, 99 F. 276, 279 (C.C.D. Ind. 1900) ("It is commonly said that there is a right of property in a technical trade-mark, and an infringement of it is spoken of as a violation of a property right."). For a more thorough description of the traditional relationship between trademark and unfair competition and its evolution over time, see Mark P. McKenna, *Property and Equity in Trademark Law*, 23 MARQ. INTELL. PROP. L. REV. 117 (2019).

[40] Landes & Posner, supra note 10, at 289 ("There are 450,000 words in Webster's Third New International Dictionary, and although they are not freely substitutable if one is trying to say something that will be understood, they are freely substitutable if one is uninterested in meaning.").

[41] MCCARTHY, *supra* note 37, at § 11:16

[42] *See* Wal-Mart Stores, Inc., 529 U.S. at 213 ("And where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source—where, for example, the affixed word is descriptive of the product ("Tasty" bread) or of a geographic origin ("Georgia" peaches)—inherent distinctiveness will not be found."). In reality, consumer understanding of that term probably depends significantly on how and where the term appears on a package. *See* Tom Lee et al. But distinctiveness, as opposed to failure to function, considers the meaning of terms in relation to goods and (usually) not based on particular use context.

[43] MCCARTHY, *supra* note 37, at § 14:1

Precisely because descriptive terms convey information about the goods or services, protecting them as trademarks also comes at greater cost to competitors who also need to convey information to consumers.[44] Giving one party exclusive rights to use the term "tasty" for food products limits competitors' ability to communicate that their products are also tasty.[45] Likewise, giving one party exclusive rights to "Milwaukee's Best" limits other Milwaukee-based beer producers' ability to inform consumers where their beer is made.

Because consumer understanding is not a given, and because of the potential competitive costs of exclusive rights, descriptive terms (and geographic terms) have to earn their way into trademark status by acquiring distinctiveness.[46] Specifically, those terms are protected as trademarks only when consumers have come to understand that, in addition to conveying information about the goods, the terms identify source.[47] Trademark law calls this "secondary meaning"—secondary not in the sense of being of secondary importance, but in the sense of being second in time to the primary, descriptive meaning.[48] "Best Buy" might once simply have described a store with good deals, but over time consumers have come to associate that phrase with a particular company, at least in the context of retail stores selling electronics.

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[44] It turns out arbitrary marks may also be in short supply, as Barton Beebe and Jeanne Fromer have shown. Beebe & Fromer, *supra* note 5. And even fanciful marks may be more constrained than we assume. *See infra* notes 99-105

[45] MCCARTHY, *supra* note 37, at § 11:18. *See also* Educational Development Corp. v. Economy Co., 562 F.2d 26, 28 (10th Cir. 1977); Telechron, Inc. v. Telicon Corp., 198 F.2d 903, 906 (3d Cir. 1952); W. E. Bassett Co. v. Revlon, Inc., 354 F.2d 868, 871 (2d Cir. 1966); Gimix, Inc. v. JS & A Group, Inc., 699 F.2d 901, 907 (7th Cir. 1983).

[46] Those terms used to be excluded from trademark subject matter. Parties claiming that their competitors were misusing descriptive or geographic terms (or surnames) in order to pass off their goods as those of the claimant could seek relief under the common law of unfair competition. *See* McKenna, *supra* note 39. Unfair competition remedies were more limited—the claimant typically could not get an injunction against use of the descriptive or geographic term altogether, but only limitations on the manner of the defendant's use.

[47] 15 U.S.C. §§ 1052(e), (f); *Two Pesos, Inc*., 505 U.S. at 769; *see also Park 'N Fly, Inc.*, 469 U.S. at 194. The owners of registered marks that are not yet incontestable can also face descriptiveness challenges, though the registration affords the registrant a presumption of validity, putting the burden on the defendant to show descriptiveness. *See* 15 U.S.C. § 1057(b); *Park 'N Fly, Inc*., 469 U.S. at 196.

[48] For that reason, "acquired distinctiveness" might be a better term.

Courts commonly say that secondary meaning may be proven by both direct and circumstantial evidence.[49] But while "the authorities" [may be] "in agreement that survey evidence is the most direct and persuasive way of establishing secondary meaning,"[50] in fact courts most often focus on circumstantial evidence such as the "amount and manner of advertising, volume of sales, and length and manner of use."[51] The idea is that consumers' exposure over time trains them to regard an otherwise descriptive term as having an additional, source-related meaning.[52] Having acquired distinctiveness, descriptive terms become trademarks, and competitors are substantially limited in the ways they can use those terms to describe their own goods.

Finally, terms that simply name a relevant category of product or service are deemed "generic" and can never be trademarks.[53] The primary significance of the term to the relevant consuming public controls,[54] but courts have articulated the test of genericness in several similar ways. In the recent *Booking.com* case, the Supreme Court defined a generic term as one that "names a 'class' of goods or services, rather than any particular feature or exemplification of the class,"[55] and it emphasized that the only relevant meaning was the meaning to consumers. Hence, "whether

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[49] MCCARTHY, *supra* note 37, at §15:30; *see also* Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC, 259 F.3d 25, 43 (1st Cir. 2001); Nola Spice Designs, L.L.C. v. Haydel Enterprises, Inc., 783 F.3d 527, 546 (5th Cir. 2015); Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc., 270 F.3d 298, 315 (6th Cir. 2001).

[50] Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 795 (5th Cir. 1983).

[51] *Id.* See MCCARTHY *supra* note 37, at § 15:48 ("The easiest and least expensive manner of proving secondary meaning is to introduce evidence of the amount and nature of advertising of the mark; the length of time the mark has been in use; and the amount of goods or services sold under the mark.").

[52] MCCARTHY *supra* note 37, at § 15:48.

[53] *Booking.com*, 591 U.S. at 2303 ("The name of the good itself (*e.g.*, "wine") is incapable of "distinguish[ing] [one producer's goods] from the goods of others" and is therefore ineligible for registration. Indeed, generic terms are ordinarily ineligible for protection as trademarks at all.") (internal citations omitted). 2 MCCARTHY *supra* note 37, at§ 12:1, at 12–5 ("Of course, to properly be called an unprotectable 'generic name' in trademark law, the designation must be the name of the same product or service which it is alleged to identify the source of.").

[54] *See* 15 U.S.C. § 1064 par. 3 (2006) ("The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.").

[55] *Booking.com*, 591 U.S. at 2303 *citing Park 'N Fly*, 469 U.S. at 194 ("A generic term is one that refers to the genus of which the particular product is a species.").

'Booking.com' is generic turn[ed] on whether that term, taken as a whole, signifie[d] to consumers the class of online hotel-reservation services."[56]

The exclusion of generic terms from protection can be explained in two different ways, and both policy justifications are frequently noted by courts. One explanation focuses on consumer understanding: generic terms do not do the job of a trademark because they do not indicate source.[57] But another explanation offered with similar frequency focuses on the costs of protecting a generic term. Here courts often characterize protection of a generic term as conferring a sort of monopoly on the claimant.[58] Because a generic term names a relevant product category, giving a particular producer exclusive rights to that term would give that producer a significant advantage over competitors who would be unable to signal to consumers that their products competed in that same market. That helps explain the concept of "genericide," in which once-valuable trademarks that clearly did (and likely still do) indicate source to some consumers are nonetheless denied future protection because a majority of the consuming public has come to associate the term with the entire class of goods.[59]

In sum, the process of determining the distinctiveness of purported word marks is a categorization exercise, where the categories reflect the extent to which

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[56] *Booking.com*, 591 U.S. at 2303.

[57] *See id.* (protection depends on capacity to indicate source); Am. Cyanamid Corp. v. Connaught Labs., Inc., 800 F.2d 306, 308 (2d Cir. 1986) ("Trademark protection benefits consumers by enabling them to select products on the basis of their origin. This encourages sellers to create and maintain good will by marketing products of reliable quality that consumers associate with their mark. Consumers will not benefit, however, if trademark law prevents competitors from using generic or descriptive terms to inform the public of the nature of their product.").

[58] *See, e.g.*, A.J. Canfield Co. v. Honickman, 808 F.2d 291, 305 (3d Cir. 1986) ("The genericness doctrine prevents trademarks from serving as the substitutes for patents, and protects the public right to copy any non-patented, functional characteristic of a competitor's product."); *Abercrombie & Fitch*, 537 F.2d at 10 (to protect a generic name would be to "confer a monopoly" on one seller in the sale of the named product); *see also* Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1819 (2007) ("Modern courts refuse to extend trademark protection to generic words or terms because they are concerned that doing so would negatively impact competition.").

[59] *See, e.g.*, King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577 (2d Cir. 1963) (finding "thermos" to be a generic term for vacuum-insulated containers); DuPont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2d Cir. 1936) (finding "cellophane" to be a generic term for transparent cellulose film); Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921) (finding "aspirin" to be a generic term for acetyl salicylic acid).

the claimed term gives information about the goods. The primary legal distinction is between terms that are inherently distinctive (fanciful, arbitrary, and suggestive terms) and those that are not. Inherently distinctive terms are automatically treated as trademarks; some non-inherently distinctive terms (descriptive terms, geographic terms, surnames) can earn their way into trademark status by developing secondary meaning. Terms that name a relevant category of products or services are deemed generic and can never serve as trademarks.[60]

## B. Word Marks and Communicative Competition

While it certainly makes sense for trademark law to approach validity taxonomically rather than trying to adjudicate the competitive effects of each claimed mark, its taxonomy must reflect the realities of language usage and market competition. Yet there are good reasons to believe that the law systematically underestimates the challenges that trademark creates for new market entrants.

Begin with suggestive terms. The law treats suggestive terms as inherently distinctive on the twin assumptions that (a) those terms don't provide direct information about the goods, and (b) that their exclusive control doesn't produce significant competitive harms. Both of those assumptions are at least overstated if not flatly wrong in many cases.

First, it's simply not true that exclusive use of suggestive terms imposes *de minimis* competitive harm. Rather, those terms often offer real advantages to mark owners. For example, people might pay more for a white wine that is branded as BUTTER[61] than they would an otherwise identical product, simply because the name has positive connotations for them.[62] But the wine is not made of butter, so even

[60] Almost never. There are small number of cases in which formerly generic terms have been reclaimed as trademarks, but those are decidedly the exception to the rule.
[61] Maria Dinzeo, *Jury Will Decide Winemaker Clash Over 'Buttery' Chardonnay*, COURTHOUSE NEWS, Apr. 20, 2020, https://www.courthousenews.com/jury-will-decide-winemaker-clash-over-buttery-chardonnay/.
[62] Although not necessarily for the authors of this Article.

though white wines are often described as "buttery,"[63] the Trademark Office treated BUTTER as inherently distinctive and registered it without requiring evidence of secondary meaning.[64] Similarly, the Sixth Circuit held that the mark 5-HOUR ENERGY was suggestive rather than descriptive, because the kind of energy and the method of its transference were ambiguous.[65] But granting the claimant an immediately valid trademark in such a term gives it a substantial competitive advantage.[66] Even if that term doesn't describe everything about the relevant product, it clearly identifies some of the product's most important qualities. Consumers may wonder if competitors' products will provide an equivalent period of energy.[67]

Again, there is nothing wrong with one party obtaining a competitive advantage by virtue of having created a better product. That is in the nature of competition. The problem arises because firms are using government-sanctioned monopolies on language to gain competitive advantages that have nothing to do with the quality of their products or identification of their source. This is a strategic distortion of market competition.

One likely cause of the law's insensitivity to these issues is its focus on the needs of competitors rather than on competitive benefits trademarks are conveying to claimants. Courts assume that granting rights in inherently distinctive marks imposes little or no cost on competitors who are free to choose from a nearly infinite dictionary of alternative options to brand their goods. According to Landes and Posner: "There are 450,000 words in Webster's Third New International Dictionary,

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[63] White wines that undergo malolactic fermentation, which converts malic acid into lactic acid, may have flavors that people describe as "buttery." F. Sauvageot & P. Vivier, *Effects of Malolactic Fermentation on Sensory Properties of Four Burgundy Wines*, 48 AM. J. ENOLOGY & VITICULTURE 187 (1997).

[64] U.S. Reg. No. 3,999,253

[65] Innovation Ventures, LLC 6 v. N.V.E., Inc., 694 F.3d 723, 730 (6th Cir. 2012). Jake Linford, *The False Dichotomy between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367, 1380-81 (2015).

[66] Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 434 (1999).

[67] Jake Linford, *The False Dichotomy between Suggestive and Descriptive Trademarks*, 76 OHIO St. L.J. 1367, 1415 (2015).

and although they are not freely substitutable if one is trying to say something that will be understood, they are freely substitutable if one is uninterested in meaning."[68] They assume, as do most courts, that word marks at the top of the *Abercrombie* distinctiveness spectrum are basically fungible and unlimited.

The trouble is, almost no one else thinks so, including the professionals hired to help firms choose brand names.[69] As Jake Linford has recently argued, certain sounds seem to attach more naturally to some goods than to others.[70] Marks like SWIFFER for a sweeping device or VIAGRA for an erectile disfunction medication rely on sound symbolism to create, perhaps unconsciously, associations between a product and its desirable attributes.[71] Because trademark law's evaluation of those terms focuses exclusively on semantic meaning, it pays no attention to sound symbolism or other ways marks convey information. It therefore underestimates the true competitive effects of exclusive rights in suggestive terms.[72] Although a winery may not *need* to describe its Chardonnay using the term "butter" or a caffeine shot may not *have to* refer to the precise period of energy it provides, being able to use those terms is enormously beneficial.[73]

Consider a mark like "Igloo" for coolers. If we focus on the needs of competitors, we might think that exclusive rights in the term do little to harm them, because they are free to adopt any number of alternative terms that might be available. But if we instead think about the competitive benefits that trademark rights provide, we "Igloo" may prove enormously beneficial. Consumers might think that Igloo-branded coolers keep their drinks colder than ones without the brand.[74] The name might be

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[68] Landes & Posner, *supra* note 10, at 289.

[69] Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 770 (1990) ("The immediate difficulty with any theory premised on the IM assumption, however, is that virtually no one involved in the selection and testing of marks seems to think that IM presents a useful picture of the world.").

[70] Jake Linford, *Are Trademarks Ever Fanciful*, 105 GEO. L.J. 731, 756 (2017) ("But creating a new word to serve as a trademark is presumed to have almost entirely salutary effects.").

[71] Beebe & Fromer, *supra* note 5, at 966 ("VIAGRA calls to mind, all at once, 'vigor,' 'vitality,' 'aggression,' and 'Niagara' (suggesting both water and honeymoons).").

[72] Linford, *supra* note 70, at 758.

[73] Linford, supra note 67, at 1385.

[74] Of course the term "igloo" as a symbol for products that keep things cold is odd, given that igloos are supposed to keep their occupants warm.

more memorable and therefore might be front of mind for consumers looking for a cooler, even compared to functionally superior coolers. Thus, competitors will have to work harder and spend more on advertising to offset the advantage of a memorable name. Or they might have to lower their prices to compete on another dimension. If any of those things are true, competitors are at a disadvantage because of the exclusive rights that trademark law bestows cheaply and easily. Courts have been quick to make the illogical leap from the fact that competitors don't *need* to use the mark (which might be true) to the conclusion that allowing one firm to control the mark imposes no competitive harm. That simply does not follow.[75]

The situation with descriptive marks is yet worse, because trademark law treats secondary meaning as both a necessary and sufficient condition for a descriptive term having net pro-competitive effects.[76] Yet even when a descriptive term has acquired secondary meaning and now signifies source, exclusive rights to that term may still confer substantial competitive benefits on the firm that owns the mark. Take, for example, Milwaukee's Best. Even though that brand name has become associated with a particular producer and acquired secondary meaning, that *does not* mean that it has lost its descriptive value. The existence of the trademark still prevents competitors from identifying their own beer as the best that is brewed in Milwaukee. Only one company can call its beer Milwaukee's Best, and that has ramifications for the beer market to the extent that at least some consumers identify Milwaukee with high-quality brewing.

## C. The Excessive Scope of Descriptive Trademarks

These competitive effects are exacerbated by the difficulty of drawing lines between categories of marks and even between marks themselves. As the examples

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[75] To be more precise, when courts focus on competitive need, they tend to set a high threshold and do not recognize need unless there are very few alternatives available to competitors. Because they ignore important benefits, they misjudge the number of real alternatives and too readily conclude that the benefits to the mark claimant don't come at the expense of others.
[76] *See supra* notes 46-52.

above reflect, the line between descriptive and suggestive terms is notoriously unclear.[77] All categorization schemes have boundary problems, of course, but trademark law draws a fundamental legal distinction on the basis of a factual distinction that approaches arbitrariness.[78] Take, for example, the recent lawsuit filed against Ford by Cruise LLC and General Motors. Cruise and GM claim that Ford's use of BlueCruise for an automated driving system infringes their rights in the marks CRUISE and SUPER CRUISE and several CRUISE-related marks for automated driving technology.[79] It's hardly a stretch to connect the term Cruise to automatic driving technology—"cruise control" has long been the generic term for the feature that maintains a car's speed without need for manual operation, and automated driving is simply a technological extension of that feature. Nevertheless, both Cruise and GM have successfully registered several Cruise-formative marks.[80] Indeed, Cruise overcame an initial descriptiveness refusal for the original CRUISE application simply by highlighting that its software for automated driving was not a "device[] used to operate at a predetermined speed by use of a regulating mechanism," but instead "covered far more aspects or driving than speed and the speed of the vehicle is not necessarily constant."[81] On that basis, it was able to register the mark without evidence of secondary meaning.

One of the things the Cruise case highlights is that descriptive marks are often asserted against non-identical marks that have only the descriptive component in common. Cruise and GM asserted their Cruise marks against Ford's BlueCruise. So it's often more than just control over the descriptive term that is at stake—protection

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[77] MCCARTHY, *supra* note 37, at § 11:71 ("One important point is that lawyers and judges should not deceive themselves into conceiving the descriptive-suggestive dichotomy as some kind of concrete and objective classification system. It is no more objective and free of personal predilections than a test which asks persons to divide all color shades into "light" and "dark." The psychological bent of the observer obviously plays a role in both cases.").
[78] *See id.* (listing marks held descriptive vs. suggestive).
[79] Cruise LLC and General Motors v. Ford Motor Company, Case 3:21-cv-05685 (N.D. Cal. July 23, 2021). According to the complaint, a subsidiary of GM acquired Cruise LLC in 2016, and in 2018 it transitioned to a majority-owned subsidiary of GM. Complaint para 21.
[80] *Id.*
[81] Response to Office Action, App. Ser. No. 87010961 (January 23, 2017).

of those terms often translates into control over adjacent terms with a descriptive component.[82]

Enforcement of the other Cruise-related marks reflect the similar problem of granting protection to compound marks. Those marks often contain words that, on their own, would be highly descriptive of the goods with which they're used. But under existing doctrine, marks must be evaluated as a whole rather than broken into their individual parts.[83] As a result, many longer phrases wind up qualifying for trademark protection despite the risks associated with the descriptive parts. That might be fine if the rights granted those mark owners were limited in scope, such that infringement were only found when the defendant used the *entire phrase*. But that often does not happen, which means that parties are able to use trademark law to control the descriptive terms within longer phrases.[84]

The rules regarding secondary meaning are perhaps even worse, in large part because it's not actually even clear that anyone knows what secondary meaning is. According to the Supreme Court, "[t]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product

[82] The other Cruise-formative marks reflect the similar problem of granting protection to compound marks. Those marks often contain words that, standing on their own, would be highly descriptive of the goods they're used with. But under existing doctrine, marks must be evaluated as a whole rather than broken into their individual parts. That means that many longer phrases wind up qualifying for trademark protection despite the risks associated with the descriptive parts.

[83] This is often called the "anti-dissection" rule. McCarthy § 11:27 ("Under the anti-dissection rule, a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts.").

[84] Indeed, they sometimes struggle even with short terms. In a recent case, the owner of the VAGISIL mark, which it registered for various vaginal-health products, was able to prevent registration of VAGISAN for various similar pharmaceutical preparations. Combe Inc. v. Dr. August Wolff GMBH & Co Arzneimittel (4th Cir., April 13, 2021). It did so despite the obvious genericness of the "vagi" component of the marks. Indeed, the court specifically rejected the idea that greater emphasis should be placed on the other parts of the respective marks ("SIL" and "SAN"). According to the Fourth Circuit, courts should not focus on dominant portions of single word marks; for those marks, "the proper analysis compares whole words, not parts." Comparing the whole words at issue, the court believed the district court correctly concluded that the marks were closely similar—emphasizing the similar, generic components.

itself."[85] But it's unclear whether that means that the majority of consumers must recognize the source significance (so that "primary" is a measure of quantity), or that the source meaning must have eclipsed the original meaning in the minds of consumers (so that primary means dominant meaning), or some combination of both or those things.

Professor McCarthy says that "the terms have only a temporal significance."[86] In his view, "'[s]econdary' meaning is so-called only because it is created second in time, not because it is necessarily secondary in importance or significance in customers' minds."[87] He specifically rejects the idea that the claimant must prove that the "most important meaning of the designation is as a source identifier—a trademark or service mark." McCarthy continues, "[T]he legal terms of art "primary" and "secondary" meaning do not refer to relative magnitude or prominence, but only to meanings that were created first and second in time."[88] But it can't be that there is no threshold for this "second in time" meaning, in either the quantitative or qualitative sense.[89] If the three of us, but no one else, came to associate a term with a particular producer, that couldn't possibly be enough for secondary meaning, no matter how clearly that meaning was second in time for us.[90] Nor could it be enough that some people think products bearing the word "tasty" usually come from Frito-Lay if those people recognize that Frito Lay is just describing its chips.

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[85] Qualitex, 514 U.S. at 163, quoting Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851 n.14, (1982) ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.").
[86] MCCARTHY, *supra* note 37, at §15:6.
[87] *Id*.
[88] *Id*.
[89] In another part of his treatise focused on surveys, McCarthy says that "[t]here would seem to be no logical reason to require any higher percentage to prove secondary meaning than to prove a likelihood of confusion." *Id*. at § 32:190. In that view, there are no reasons to refuse to recognize trademark rights if 15% of people might be confused.
[90] McCarthy says "[it is not necessary that each and every member of the buyer class associate the mark with a single source. Nor is it necessary that a majority of that group do so. It is only necessary that a "substantial part" of the buying class make such an association." *Id*. at § 15:45.

The complete lack of clarity about the relevant thresholds makes secondary meaning a matter of intuition more than evidence. Maybe because courts so often infer secondary meaning from circumstantial evidence, they don't even consider the threshold question (or maybe they rely on circumstantial evidence in order to avoid hard threshold questions). But without any identifiable goalposts, even surveys—which would otherwise seem like the best form of secondary meaning evidence, if there were a reliable methodology available[91]—can't really give clear answers.[92] That's a serious problem for the doctrine that is supposed to be the means of balancing competitive concerns by making it harder for parties to claim descriptive terms.

Trademark law accounts for the competitive importance of descriptive terms in one other way. Under the doctrine of descriptive fair use, it is a defense that use of the term "otherwise than as a mark" is "of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin."[93] So, for example, even if one party is able to establish trademark rights in "Fish-Fri" for batter for frying fish, other companies are still allowed to use "fish fry", not as their own trademark, but for the purpose of describing their own batter for frying fish.[94]

But descriptive fair use is notoriously fact intensive and difficult to apply,[95] not least because of the difficulty of determining when a use is "otherwise than as a mark" and how that inquiry differs from the likelihood of confusion test.[96] Firms that should qualify for descriptive fair use are frequently denied the defense—or at least face expensive litigation to establish their right to use the term—due to the confusion and shortcomings of the doctrine.[97] So there are competitive consequences to awarding

[91] There probably isn't. All of the available options have serious flaws.
[92] *Id*. at 15:45 ("Courts have been vague and uncertain in defining what is the minimum acceptable percentage of persons who have a secondary meaning in their minds.").
[93] 15 USC 1115(b)(4).
[94] *See* Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (1983).
[95] William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008).
[96] *See* William McGeveran & Mark P. McKenna, *Confusion isn't Everything*, 89 NOTRE DAME L. REV. 253 (2013).
[97] *Id*.

trademark rights in descriptive terms that aren't fully resolved by making room for descriptive fair use.[98] And, of course, that doctrine only makes room for other parties to make non-trademark use of the descriptive terms. It still allows one party to get the benefits of using the descriptive term as a brand.

### D. Markets, Entrants, and Competitive Costs

Precisely because not all marks are equally good, recent evidence that new entrants, across a number of industries, face increasing difficulties finding high quality trademarks is deeply concerning. A massive study from Barton Beebe and Jeanne Fromer finds evidence of both trademark "depletion"—a decreasing number of unclaimed useful trademarks, both in general and even within product categories—and trademark "congestion"—an increasing number of marks claimed by more than one owner in different product categories.[99] According to the authors' analysis of PTO registration data, many of the "best" trademarks are already claimed in many industries, including standard English words, short pronounceable neologisms, and popular American surnames.[100] It's not just that the "best" marks are claimed by someone in some industry.[101] Rather, Beebe and Fromer demonstrate depletion *within* product categories, where the competitive consequences of having to choose a "worse" trademark are sharpest.[102] Given the ease with which initial entrants in a market can claim the most valuable suggestive and descriptive terms, later entrants will be shunted off to marks that are less advantageous.

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[98] Deborah R. Gerhardt, *A Masterclass in Trademark's Descriptive Fair Use Defense*, 52 AKRON L. REV. 4 (2019).
[99] Beebe & Fromer, *supra* note 5, at 951.
[100] *Id*.
[101] Co-existence by users in different markets is a celebrated reflection of the limitations of trademark rights, and there are many well-known examples of the same mark being used by multiple parties for different goods or services (Delta Airlines and Delta Faucets, Apple Computers and Apple Vacations, etc.).
[102] *Id*. *See also* Zahr K. Said, *Craft Beer and the Rising Tide Effect: An Empirical Study of Sharing and Collaboration among Seattle's Craft Breweries*, 23 LEWIS & CLARK L. REV. 355 (2019).

The consequences of increasing "congestion"—firms increasingly having to accept sharing the same word mark in different markets—are less straightforward.[103] Sharing is simply a result of the limited nature of trademark rights, so congestion may not initially seem like a competition problem.[104] But in a world of ever-expanding trademark rights, where mark owners assert claims against a wider range of uses and where market organization and promotional activity make the boundaries between markets less clear, congestion means conflict. To take one recent example, when the team formerly known as the Cleveland Indians announced that they would become the Cleveland Guardians, people were quick to criticize them for failing to do their due diligence: it turns out there's already a professional roller derby team called the Cleveland Guardians.[105] But as the team made clear, there were legal landmines everywhere: "You're not going to find a name that someone's not using today," said the team president. "You've got to work through agreements with others."[106]

Word mark depletion and congestion across the *Abercrombie* spectrum impose substantial costs on new entrants to crowded fields. New firms have to select from a competitively weaker range of options—longer or harder to pronounce words, words that are farther from the semantic core of the field, or words that are already used by other parties.

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[103] Beebe & Fromer, *supra* note 5, at 952-53.
[104] *See supra* note 101.
[105] https://www.cleveland19.com/2021/07/31/cleveland-guardians-roller-derby-team-files-trademark-application/
[106] The "others" included Marvel, with which the team reportedly worked something out. Trademark issues loomed large in consideration of several other names. The team ruled out the Spiders because it's the nickname of the University of Richmond. *See* https://www.cleveland.com/tribe/2021/07/inside-story-of-how-cleveland-indians-became-the-cleveland-guardians-terry-pluto.html ("But a key factor was the University of Richmond has the Spiders nickname. That created branding issues. It could be expensive."). They also ruled out Rockers in part for legal reasons. *Id.* ("The Guardians, Spiders and Rockers seem to be the first three names rumored. The Rockers were the name of the former WNBA franchise in Cleveland. Then there are the Colorado Rockies in the National League. All that was a negative.").

Our argument to this point might suggest that courts should simply revise the doctrine to ban suggestive and descriptive marks.[107] Perhaps all putative mark owners should be channeled towards fanciful and arbitrary marks, which do not create the same types of competition concerns. After all, the supply of those marks is not infinite, but it is much less limited than the supply of useful descriptive and suggestive terms. And arbitrary and fanciful marks generally do not convey inherent competitive advantages in the same manner as descriptive and suggestive marks.

Yet there is a consideration on the other side. Despite the many problems with descriptive and suggestive marks, those marks can have some value to consumers. It is easier for consumers to connect suggestive and descriptive marks to particular products, and this minimizes the cognitive burdens that they face.[108] Suggestive and descriptive marks reduce the amount of work that consumers must do to find a suitable product or remember what they have purchased in the past. For instance, consumers might have an easier time remembering that Lyft is a ride-sharing company because that name is at least suggestive of the services.[109] It is useful to have a company that provides topical pain relief called IcyHot.[110] This is, of course, why firms desire these marks in the first place—and it's why exclusive control of those terms provides competitive benefits.

In contrast, the fact that an arbitrary or fanciful mark is not well-connected to the product means that firms must expend resources on advertising to make that connection. We will describe these advertising costs in Part III.D below. This advertising is arguably wasteful. Every time Xfinity runs a commercial to remind consumers that it is providing wifi, it is expending resources that might be put to some more socially valuable use. If the firm were instead called "Fast Wifi Company," it might not need to spend so much on advertising, or it could devote its advertising

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[107] "Ban" here might mean denying trademark status to descriptive and suggestive terms, but allowing for some more limited unfair competition remedies. That would resemble the system we once had, which distinguished technical trademarks and other signs. *See* McKenna, *supra* note 39, at 326.
[108] Daniel J. Hemel & Lisa Larrimore Ouellette, *Trademark Law Pluralism,* 88 U. CHI. L. REV. 1025 (2021).
[109] *Id*.
[110] *See id.* at 1039-46 (describing "distance costs" to consumers and their relation to trademarks).

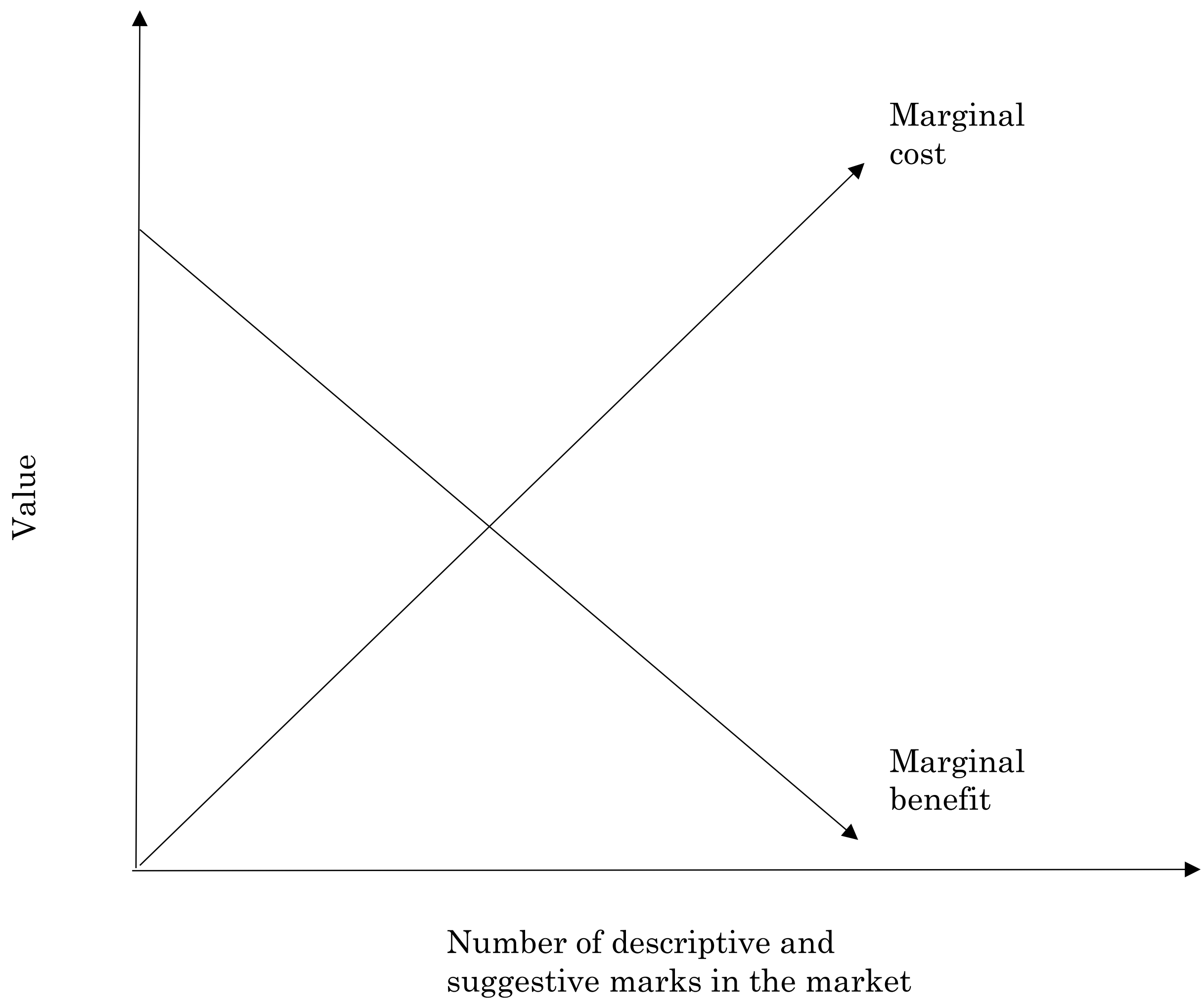
budget to more socially useful activities, such as informing consumers of the useful aspects of its products. These advantages of descriptive and suggestive marks, and those marks' anticompetitive effects, are two sides of the same coin. It is precisely because consumers can more easily find a brand, and precisely because establishing source significance is less expensive, that descriptive and suggestive marks confer anticompetitive advantages.

Critically, however, the competition costs of suggestive and descriptive marks are not constant. Each additional mark in a given industry is more harmful to competition than the last, because each additional mark swallows up more of the diminishing linguistic space. For instance, it does not necessarily create significant competitive problems if there is a single cooler company called "Igloo," or even a second one called "Yeti." There are still a wide variety of other terms available to other producers to describe their coolers: "polar," "artic," and so forth. But if fifteen cooler companies snagged all of the most valuable marks, the sixteenth firm would find itself facing much tougher sledding.[111] This is to say: as the number of descriptive and suggestive marks in a given market increases, the marginal competitive cost of each additional mark increases.

At the same time, the value to consumers of descriptive and suggestive marks decreases as the number of such marks increases. It is useful for there to be one ride-sharing service named "Lyft" so consumers can remember it more easily. But once Lyft exists, it's less important that there be a second service called "Karpool," a third named "Ridez," and so forth. In other words, as the number of descriptive and suggestive marks in a given market increases, the marginal benefit of each additional mark decreases. Figure 1 depicts this relationship graphically:

[111] Thus, we are substantially less concerned about search engine firms claiming descriptive marks than we are clothing, electronics, or brewing companies.

*Figure 1: Marginal Costs and Benefits of Descriptive and Suggestive Marks*




Ideally, then, a social planner would set the total number of descriptive and suggestive marks in any market at the point where the marginal cost and marginal benefit curves cross. That means that the optimal number of descriptive and suggestive marks is not zero. Thus, a complete bar on suggestive and descriptive marks would likely throw out too much baby with the bathwater.[112] Instead, a mechanism that limits the number of descriptive and suggestive marks but does not completely eliminate them is called for. The next Part describes such a mechanism.

[112] Suggestive and descriptive marks can, as we explain above, produce net social value, so excluding them entirely and forcing firms to adopt arbitrary or fanciful marks is not warranted.

## III. Doctrinal and Costly Screens

As the preceding sections have made clear, trademark law's goal should be to allow pro-competitive trademarks while eliminating (to the greatest extent possible) anticompetitive ones. That is, the law should engage in *screening* of trademarks. This is, of course, one of the primary functions of law, a function that it performs across many domains. For example, unpatentable inventions are screened out from among the many patent applications that have been filed.[113] Invalid claims to social security disability benefits are screened from among the many claims asserted.[114] Ornamental designs that do not qualify for design patent protection are screened out from amongst the many design patent applications filed.[115] And so forth.

This screening process represents the normal functioning of law, and so it is rarely noticed or remarked upon as such. But it is critical to observe that screening can take place in two different ways. First, law can use substantive doctrinal rules to screen.[116] An invention is patentable only if it is "novel" and "nonobvious." Title to land is only valid if it was properly registered at the time of transfer. Etc. The legal rule sets some condition that must be met before the screen is satisfied. We refer to these types of barriers as "doctrinal screens," in that it is legal doctrine and the decisions of legal actors (i.e., judges, jurors, administrators, or clerks) that are performing the screening function.[117]

In the alternative, law can use prices to screen.[118] In order to obtain a patent, it is not enough that the applicant's invention be novel and nonobvious—the applicant must also pay a fee.[119] For that matter, the process of patent examination itself is costly: the applicant is typically represented by an attorney or patent agent who

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[113] *See* Jonathan S. Masur, *Costly Screens and Patent Examination*, 2 J. LEGAL ANALYSIS 687 (2010).
[114] *See* Donald O. Parsons, *Self-Screening in Targeted Public Transfer Programs*. 4 J. POLIT. ECON. 859 (1991).
[115] Buccafusco, Lemley & Masur, *Intelligent Design*, *supra* note 8, at 79.
[116] *Id.*
[117] *Id.*
[118] *See generally,* Michael A. Spence, *Job Market Signaling*. 87 Q. J. ECON. 355 (1973).
[119] Masur, *supra* note 113, at 687.

charges thousands of dollars.[120] In order to sponsor an employee for an H1-B visa, a company must pay a substantial fee and must run costly advertisements to determine if there is an American worker who is willing to take the same job. Obtaining benefits from the government typically requires filling out substantial amounts of paperwork, which generates costs for applicants.[121] Design patents require application fees as well, as does registering title to a piece of land.[122]

At first blush, perhaps these fees and expenses would seem to be merely costs to the applicant. They might be necessary (someone has to pay the lawyer!) but otherwise wasteful—to be minimized whenever possible. Yet that is not their only function. The fees and expenses also operate as screens: they will screen out some potential rights claimants who are unwilling or unable to pay them. We refer to them as "costly screens."[123] Although they share a screening function with doctrinal screens, costly screens shift the locus of decision making from courts and agencies to individuals. Applicants must choose whether they are willing to pay the necessary costs.

Doctrinal screens and costly screens are thus two mechanisms by which law separates and categorizes. Sometimes they function as complements; sometimes as substitutes; sometimes they work at cross purposes. In the following sections we describe their operation and explain the principles that should guide policymakers in the design of systems of screens. We then examine the role that costly screens might play in the trademark context, as well as the manner in which they actually function.

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[120] *Id.*
[121] Claus Thustrup Kreiner & Torben Transes, *Optimal Workfare with Voluntary and Involuntary Unemployment*. 107 SCAND. J. ECON. 459 (2005).
[122] Buccafusco, Masur & Lemley, *supra* note **Error! Bookmark not defined.**.
[123] Joseph Stiglitz & Andrew Weiss, *Sorting out the Differences Between Screening and Signaling Models, in* PAPERS IN COMMEMORATION OF THE ECONOMIC THEORY SEMINAR AT OXFORD UNIVERSITY. (Michael Dempster ed., 1989).

## A. Categories of Rights and Behavior

Any type of action produces both costs and benefits for the person taking the action and costs and benefits for society at large.[124] The costs and benefits for the person taking the action are *private* costs and benefits, because they are realized by this individual. Some actions have positive private value—they produce net benefits for the individual. Extracting and selling oil that a person has found on their land generates positive private value for that individual. Other actions have negative private value—they produce net costs for the individual. Similarly, some actions have positive social value and others have negative social value. If the three co-authors of this paper were to donate all of their life savings to charity, that would generate positive social value. If the three co-authors of this paper were to form a boy band, that would generate negative social value.[125]

These two dimensions—private value and social value—operate independently.[126] Dumping toxic waste into a waterway (and getting away with it) generates positive private value and negative social value; donating all of one's money to charity likely generates net negative private value and positive social value. We can thus think of all actions as falling somewhere within a two-by-two matrix: they produce either positive private value and positive social value, negative private value and positive social value, positive social value and negative private value, or negative private value and negative social value. Figure 2 displays this graphically.

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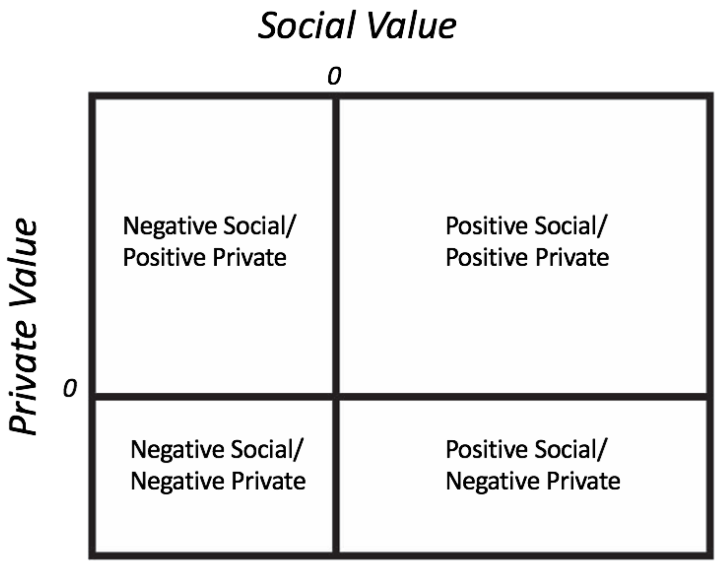
[124] David Fagundes & Jonathan S. Masur, *Costly IP*, 65 VAND. L. REV. 677 (2012).

[125] *See* Christopher Buccafusco & Jonathan S. Masur, *Drugs, Patents, and Well-Being*, 98 WASH. U. L. REV. 1403 (2021). One of us (McKenna) disputes this claim, or at least attributes the negative social value to the other two. Indeed, it is possible that one of us has performed as a member of a boy band, at least at a law school talent show.

[126] Most approaches to considering social value would count the positive private value that an individual gets from an action even if the net effects of the action are negative. *See* MATTHEW D ADLER & ERIC A. POSNER, NEW FOUNDATIONS OF COST-BENEFIT ANALYSIS (2006).

*Figure 2: Mapping Social and Private Value*




One of the primary goals of law—if not the principal goal—is to improve human welfare.[127] Law should encourage behaviors that improve welfare for oneself or others and discourage behaviors that diminish welfare for oneself or others.[128] Accordingly, social value is what policymakers—courts, legislatures, and others—should care about.[129] The two sections that follow detail the ways in which doctrinal and costly screens can be used to separate welfare-enhancing activities from welfare-diminishing ones, permitting the former while allowing the latter.

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[127] Christopher Buccafusco & Jonathan S. Masur, *Intellectual Property Law and the Promotion of Welfare*, *in* ECONOMICS OF INTELLECTUAL PROPERTY – VOL. I THEORY, 98 (Ben Depoorter & Peter Menell, eds., 2019); John Bronsteen, Christopher Buccafusco & Jonathan S. Masur, *Well-Being Analysis vs. Cost-Benefit Analysis*, 62 DUKE L.J. 1603 (2013).

[128] These aren't the only goals that law could or does have. Intellectual property law, including trademark law, is generally understood to exist to solve particular economic problems that relate to consumer and producer welfare. See supra Part I. But trademark law might also care about issues of fairness or distributional concerns beyond welfare maximization. We address some of these issues below.

[129] On the relationship between welfare and social policy generally see Matthew Adler & Marc Fleurbaey, *Introduction*, *in* OXFORD HANDBOOK OF WELL-BEING & PUBLIC POLICY 1 (Matthew Adler & Marc Fleurbaey, eds., 2016).

## B. Doctrinal Screens

If a principal goal of law is to increase human welfare, in an idealized world—one without information costs—law could be written to permit activities that would enhance welfare and restrict activities that would not. In the context of intellectual property, this means that law would protect trademarks (or copyrights, or patents) where doing so will increase welfare and deny protection where it will not. Of course, legal doctrine is never written to say, "protect a trademark when doing so will increase welfare." This would be an impossible standard for any decisionmaker to adjudicate.[130]

Rather, substantive legal doctrines—and thus doctrinal screens—can operate as proxies for the ultimate quantity of interest, namely welfare. Consider patent law as an example. It is unlikely that granting a patent on an invention that is well-known or obvious will be welfare-enhancing. The patent didn't encourage any new innovation—the invention is well-known—but granting it may create a quasi-monopoly and raise prices for consumers.[131] The patent requirements of novelty and nonobviousness thus operate as reasonable doctrinal screens, selecting against welfare-diminishing inventions.[132] Similarly, it is unlikely that giving trademark rights to a generic term (e.g., "Vacuum") would enhance welfare. It would have strong anticompetitive effects on other market participants while doing little to inform consumers.

Accordingly, a well-calibrated doctrinal screen would draw a line separating the positive social value behaviors from the negative social value behaviors, permitting the former and blocking the latter.[133] Figure 3 displays this graphically, where the shading represents activities that are eliminated by the action of the doctrinal screen.

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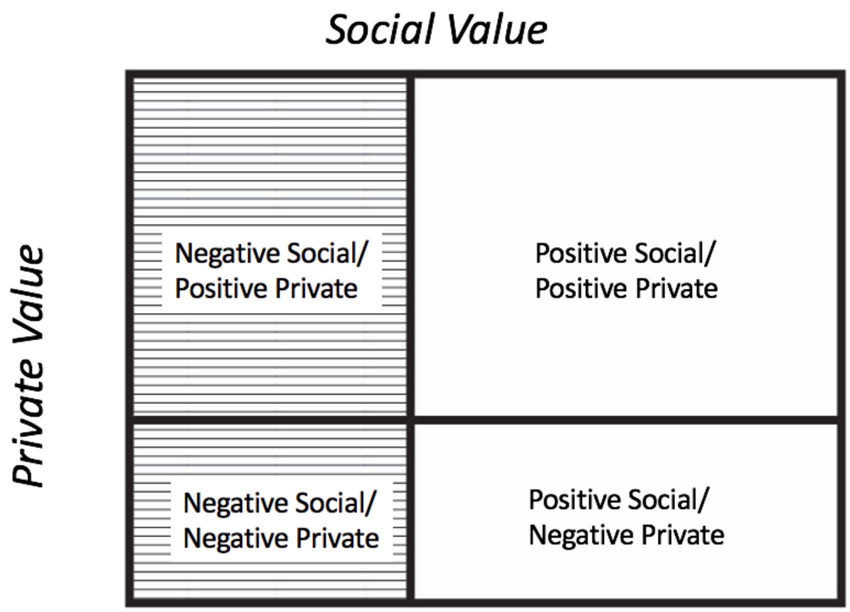
[130] Buccafusco & Masur, *supra* note 127, at 104.
[131] W. Nicholson II Price, *The Cost of Novelty*, 120 COLUM. L. REV. 769, 782 (2020).
[132] Masur, *supra* note 113, at 168.
[133] Buccafusco, Lemley & Masur, *supra* note **Error! Bookmark not defined.**.

*Figure 3: Idealized Doctrinal Screen*




In reality, doctrinal screens are never perfect. Novelty and nonobviousness are imperfect proxies for identifying inventions for which granting a patent will generate positive social value;[134] the fact that a worker meets the statutory requirements to qualify for an H-1B visa is an imperfect proxy for whether hiring that worker will generate positive social value.[135] In reality, then, doctrinal screens often exclude some activities that would generate positive social value and permit some activities that would generate negative social value. That is, they are both overinclusive and underinclusive. This might arise because the screens themselves are imperfect proxies for social value, or because the actors applying the screens do so in imperfect ways. Figure 4 displays these imperfections graphically. The shading indicates that some negative social value behaviors will not be screened out, while some positive social value behaviors will be.

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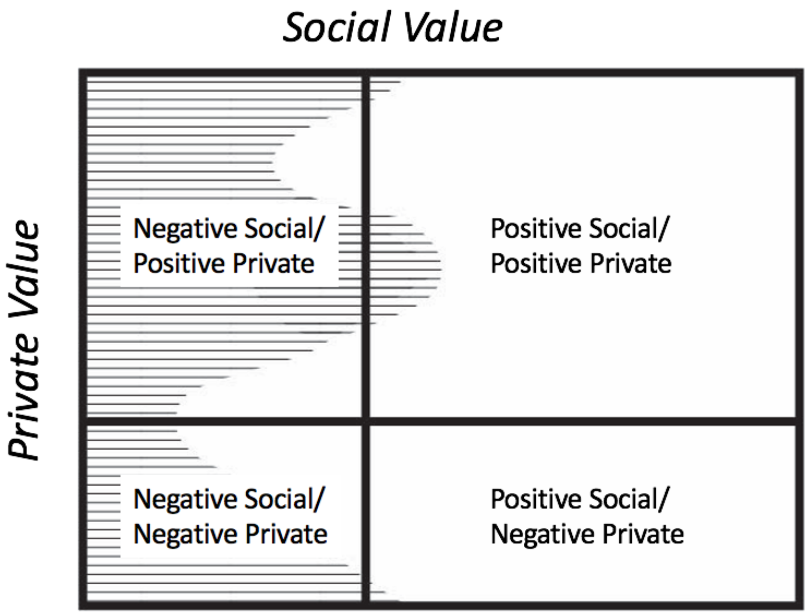
[134] *Id.*

[135] *See* H-1B Specialty Occupations, DOD Cooperative Research and Development Project Workers, and Fashion Models, https://www.uscis.gov/working-in-the-united-states/temporary-workers/h-1b-specialty-occupations-dod-cooperative-research-and-development-project-workers-and-fashion.

*Figure 4: Realistic Doctrinal Screen*




Importantly, doctrinal screens necessarily rely on information that is available to both the private party (in this example, the patent applicant) and the decision-maker (here, the court or the patent examiner).[136] The requirement of novelty would be unworkable if either the patent applicant or the patent examiner could not determine whether the invention was novel. The applicant would never know which patent applications to file or not file; the examiner would never know which applications to reject or not reject.[137]

## C. Costly Screens

As we noted above, substantive doctrinal rules are not the only mechanism for sorting activities or rights. Law sometimes also uses prices: a private party is required to pay some amount of money before obtaining a legal right or

[136] Stiglitz, *supra* note 123.

[137] On the quality of granted patents see Michael D. Frakes & Melissa F. Wasserman, *Does the U.S. Patent and Trademark Office Grant Too Many Bad Patents: Evidence from a Quasi-Experiment*, 67 STAN. L. REV. 613 (2015).

entitlement.[138] A costly screen is simply a legal rule that uses price to sort private parties. Land registration fees, patent application fees (and attorneys' fees), fees for H1-B visa applications, the time and effort required to fill out government forms—these are all costly screens.[139] Importantly, a fee or a cost can function as a costly screen even if it was not intended to do so. Any mechanism that has the effect of using price to sort between different types of activities or rights functions as a costly screen.

Costly screens can be employed to curb harmful activities of all types. Take, for instance, the burning of natural gas to produce electricity. Burning natural gas produces harm through the emission of harmful air pollutants, not least of all carbon dioxide.[140] But burning natural gas also produces benefits by yielding electricity. In theory, it is preferable if electricity generating plants burn natural gas only when the value of the electricity outweighs the harm from the emission of air pollution.[141] One way to manage this tradeoff is through traditional regulation: the Environmental Protection Agency could create a rule that limits the amount of electricity that can be produced using natural gas, or that allows it in only certain circumstances, and so forth.[142]

But an alternative approach would be to simply charge electricity producers a tax equal to the amount of harm they are producing when they burn natural gas. If a ton of natural gas produces air pollution that causes $20 in harm, then electricity

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[138] Albert L. Nichols & Richard J. Zeckhauser, *Targeting Transfers through Restrictions on Recipients*. 72 AM. ECON. REV. 372 (1982).

[139] *E.g.*, Andrew Weiss, *Human Capital vs. Signaling Explanations of Wages.* 9 J. ECON. PERSPECT. 133, 135 (1995) ("The relationship between wages and education could be the outcome of either students choosing an education program to signal their ability, or students choosing education levels in response to the relative wage offers of firms, in which case wages would serve to screen workers.").

[140] Steven Ferrey, *Unforced Errors, Legal Fulcrum & International Climate*, 20 MINN. J.L. SCI. & TECH. 115, 128-29 (2019) (describing the benefits and harms of natural gas as an energy source).

[141] *See generally* Jonathan S. Masur & Eric A. Posner, *Toward a Pigouvian State*, 164 U. PENN. L. REV. 93 (2015).

[142] For an example of this type of regulation, though not directed in particular at natural gas emissions, see EPA, National Emission Standards for Hazardous Air Pollutants From Coal- and Oil-Fired Electric Utility Steam Generating Units and Standards of Performance for Fossil-Fuel-Fired Electric Utility, Industrial-Commercial-Institutional, and Small Industrial-Commercial-Institutional Steam Generating Units, 77 Fed. Reg. 9304 (2012).

producers could be taxed $20 per ton of natural gas they produce.[143] In theory, the electricity producer would elect to burn natural gas only when the electricity produced had a value greater than $20. The tax would thus screen out all of the negative-value uses of natural gas (where the harms outweigh the benefits), leaving only net positive-value uses (where the benefits outweigh the harms).

Costly screens operate along the dimension of private value. A costly screen reduces the private value of taking a particular action, because the party that wishes to take the action must pay for the screen. If the government imposes a fine for dumping toxic waste, that costly screen alters the private costs and benefits for the firm that might engage in dumping.[144] This is a powerful policy tool because most private parties will make decisions largely on the basis of private value, not social value. If a firm thinks that it can get away with dumping toxic waste into a waterway, it will tend to take this action notwithstanding its social impact.[145] But if the firm will be heavily fined for dumping toxic waste, then the action is more likely to generate net negative private value and the firm is more likely to refrain from engaging in it.[146]

This means that whether a particular action has negative or positive private value can be endogenous to the existence of a costly screen. Dumping toxic waste has positive private value for a firm in the absence of a costly screen, but once the government threatens a heavy fine, it has negative private value. Costly screens can thus be used to turn some actions that would otherwise generate positive private value into actions with negative private value. The effect is to deter private parties from engaging in these actions.[147]

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[143] This is known as a Pigouvian tax: a tax on a harmful activity, set at a level equivalent to the harm produced by that activity. *See* Jonathan S. Masur & Eric A. Posner, *Toward a Pigouvian State*, 164 U. PENN. L. REV. 93 (2015).
[144] *Id.*
[145] *But see* Michael E. Porter & Mark R. Kramer, *Strategy & Society: The Link Between Competitive Advantage and Corporate Social Responsibility*, HARV. BUS. REV., Dec. 2006, at 78.
[146] Masur & Posner, *supra* note 141.
[147] Vivi Alatas, Abhijit Banerjee, Rema Hanna, Benjamin A. Olken & Julia Tobias, *Targeting the Poor: Evidence from a Field Experiment in Indonesia.* 124 J. POLIT. ECON. 371, 372 (2016).

Instead of simply deterring the firm from engaging in the harmful activity entirely, the imposition of a costly screen could also encourage the firm to adopt other options that are less socially costly. In the toxic waste example, a fine for dumping doesn't just deter the firm from dumping; it also encourages it to invest in technologies that might reduce the amount of waste it produces. That is, the costly screen can help channel actors' behavior towards less socially costly activities.

Because they operate on private value, costly screens, unlike doctrinal screens, can rely on information that may only be available to the private party.[148] The policymaker must be able to determine where to set the costly screen—how much additional cost should be added to the activity in question. This depends in part upon the potential harm caused by that activity, as in the natural gas example above. But the other side of the equation is the value to the private party of taking the action (dumping waste, etc.). That value may be entirely nontransparent and unknown to the policymaker. That is not a barrier to using a costly screen. So long as the private party knows the magnitude of the costly screen and can gauge the value that it places on the activity in question, it can act accordingly. Costly screens are thus useful in situations where the regulated party has critical information, such as information regarding their eligibility for a benefit or entitlement, that the government cannot access.[149]

The critical insight from this analysis is that there is no necessary correlation between social value and private value. Policymakers wish to promote positive *social value* activities. But a costly screen will deter relatively low *private value* activities by making them net negative. Therefore, the key question is: within a particular legal

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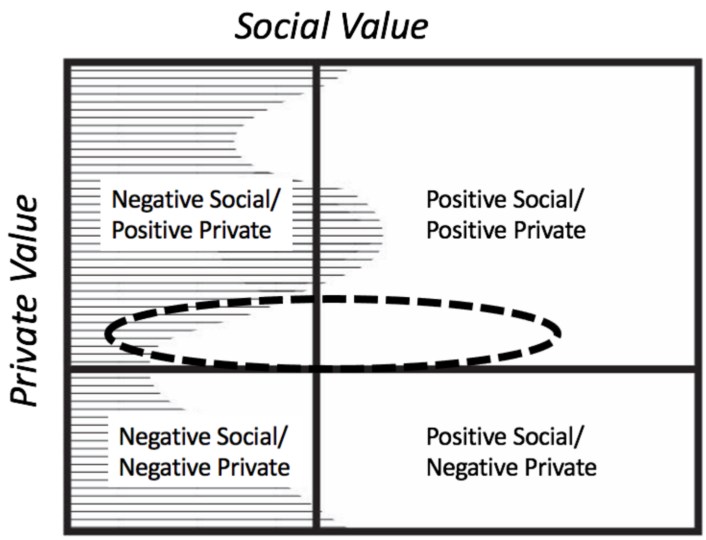
[148] Stiglitz, *supra* note 3, at 287 ("There are some conditions under which even the most able may not be willing to pay for a 'general screening"- namely, situations where "individuals are perfectly certain of their ability, and . . . it is possible for their ability to be costlessly observed 'on the job[.]' [T]hen the individual would offer to absorb all the risk involved in hiring and training cost. There are obviously instances of this sort, individuals who persuade the employer to hire them at low wages until they can 'prove themselves'" – i.e., undergo an on-the-job substantive test to objectively and credibly demonstrate their worth.).

[149] *See, e.g.*, Henrik Jacobsen Kleven & Wojciech Kopczuk, *Transfer Program Complexity and the Take-Up of Social Benefits.* 3 AM. ECON. J. ECON. POL. 54 (2011).

context, will the activities deterred by a costly screen—those that are transformed into negative private value actions—have positive or negative *social* value? If there are actions that have low private value but positive social value—such as donating blood, for instance—imposing a costly screen would be counterproductive.[150] The costly screen will make these into negative private-value activities and potentially eliminate them.[151] But if there are actions that have low private value and negative social value, a costly screen could have salutary effects by dampening activity.[152] The dashed oval in Figure 5 represents the area of concern.

*Figure 5: Assessing Costly Screens*

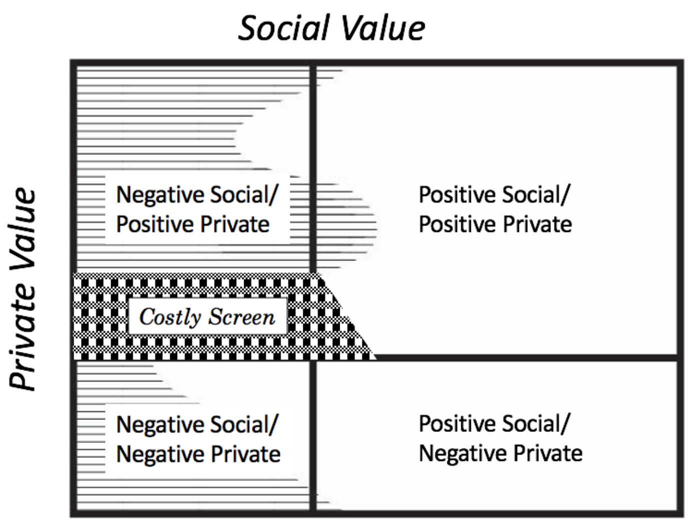



Finally, doctrinal and costly screens can be used in combination.[153] The costly screen will eliminate negative private value activities; the doctrinal screen will eliminate negative social value activities, with some degree of over- and under-

[150] *Cf.* Fagundes & Masur, *supra* note 124.
[151] Sometimes even very low costs, like opting out of a default rule, can meaningfully undermine pro-social behavior. *See* Eric J Johnson & Daniel Goldstein, *Do Defaults Save Lives?,* SCIENCE 1338 (2003).
[152] *See* Hugo Benítez-Silva, Moshe Buchinsky, Hiu Man Chan, Sofia Cheidvasser & John Rust, *How Large Is the Bias in Self-Reported Disability?* 19 J. APPL. ECON. 649 (2004) (estimating that in the US Social Security context, the award error rate is about 20 percent and the rejection error rate about 60 percent); Jean-Yves Duelos, *Modelling the Take-up of State Support*. 58 J. PUBLIC ECON. 391(1995) (finding that in the U.K. Supplementary Benefits scheme, providing means-tested cash benefits to the poor, the award error rate was 18.8 percent and the rejection error rate was 18.1 percent).
[153] *See* Buccafusco, Lemley & Masur, *supra* note **Error! Bookmark not defined.**.

inclusion. Again, it is the possibility of this under- and over-inclusion from the doctrinal screen that makes the costly screen potentially useful. If doctrinal screens were perfect, there would be no need for costly screens—the doctrinal screens would do all of the work. But doctrinal screens will inevitably allow some socially harmful activities to slip through the cracks. Accordingly, costly screens will be a valuable additional tool in the policymaker's toolkit if the condition described in the prior paragraph is met: if the costly screen will eliminate more negative social value activities than positive social value activities. Figure 6 illustrates the two screens in combination. The shaded region again represents the doctrinal screen, and the gingham box represents the costly screen. Some of the activity that would have provided positive private value to the actor will now produce negative private value.

*Figure 6: Doctrinal and Costly Screens in Combination*




The application of costly screens thus requires highly context-specific analysis. Before implementing a costly screen, the policymaker must determine whether the doctrinal screen is inadequate, and then whether the screen will affect positive or negative social value activities.[154] The answer to this latter question will itself sometimes depend on the stringency of the screen—that is, how costly it is to overcome the screen—because the decision to implement a screen is not binary.

[154] Masur, *supra* note **Error! Bookmark not defined.**, at 168.

Policymakers must also consider distributional concerns, to the extent that they are relevant, when implementing costly screens. By conditioning rights or resources on parties' willingness to pay for them, costly screens can also interact with those parties' ability to pay. Thus, in certain situations, parties might not obtain rights or resources that they would have been willing to pay for if only they had enough money to pay for them. Charging people to vote, for example, might screen out people with weak preferences between candidates, but it would also screen out people with strong preferences but not enough money.[155] Accordingly, policymakers must be sensitive to a costly screen's wealth effects. The next section undertakes this type of context-specific analysis with respect to trademark law.

### D. Trademark Law's Costly Screens

In Part II, we analyzed a number of trademark law's doctrinal screens that are meant to exclude negative social value rights from accruing, and we found them wanting. But doctrinal screens aren't the whole story. Trademark law imposes two expenses on claimants that, at first glance, might appear to be costly screens.

First, trademark law imposes a costly screen for applicants who wish to register their trademarks. Registration costs money, both in the form of fees and (usually) attorneys' fees. But registration isn't mandatory, and indeed under modern law, unregistered marks can be protected under federal law on largely the same terms as registered marks. There are benefits to registration, to be sure, but registration remains distinctly less important than in patent and even than copyright, where registration isn't mandatory but one can't file a lawsuit unless and until the copyright is registered.[156] Thus, trademark registration doesn't create much of a costly screen.

In addition, trademark law occasionally imposes a separate costly screen that can be both mandatory and expensive: the secondary meaning requirement for marks that aren't inherently distinctive. Establishing and proving secondary meaning can

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[155] RAYMOND E. WOLFINGER & STEVEN J. ROSENSTONE, WHO VOTES? 13-36 (1980).

[156] According to the Copyright Act of 1976, 17 U.S.C. § 411, a copyright lawsuit cannot be brought until "registration of the copyright claim has been made in accordance with this title."

be very costly for claimants, and, depending on how high those costs are, the secondary meaning requirement could serve to exclude low-private-value descriptive marks. In this section, we first explain the costs and benefits of trademark registration before turning to our larger contribution: analyzing secondary meaning as a costly screen. We conclude that the requirement of secondary meaning is similarly imperfect as a costly screen because it imposes only small marginal costs on putative mark holders.

1. Registration

Parties that have made use of a mark may register that mark with the United States Patent and Trademark Office.[157] To be registrable, the claimed mark must be capable of identifying the source of the applicant's goods and services and must not run afoul of any of the substantive grounds for refusal articulated in section 2 of the statute.[158] Among other things, the claimed mark must not be likely to cause confusion with a mark previously registered or in use, and it must not be descriptive of the applicant's goods or services, unless the applicant can also prove secondary meaning.[159] The applicant must also pay registration fees, and in most cases, the fees of the attorneys who prosecute their applications. Registration fees range from $250 to $350, and attorneys' fee can add an additional thousand dollars or more.[160] Because the statute provides the opportunity for third parties to oppose registration, applicants also sometimes have to pay the costs of opposition proceedings (which operate like federal civil litigation in most respects) to see their application through to registration.[161]

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[157] Parties can also apply to register on the basis of a bona fide intent to use the mark, but those marks will not be registered unless and until the applicant can demonstrate that it has actually made use of the mark. 15 U.S.C. § 1051(d).
[158] 15 U.S.C. § 1052.
[159] *Id.* at § 1052(c), (d).
[160] https://www.richardspatentlaw.com/faq/how-much-does-a-trademark-cost/ (mentioning $1000-$2000 in fees for relatively complex registration issues).
[161] Registrations can also be cancelled on petition of third parties. The grounds for cancellation become more limited after 5 years, but some grounds (including genericness and functionality but not including descriptiveness) remain forever. 15 U.S.C. § 1065.

Yet federal registration has never been mandatory in the United States, and that remains true today. Indeed, under current law, unregistered marks are enforceable under federal law on largely the same terms as registered marks.[162] That's not to say that registration doesn't have significant benefits.[163] Most importantly, federal registration confers nationwide priority,[164] and registrations can become incontestable, a benefit that is particularly valuable for descriptive marks.[165] Those benefits are good incentive for parties to seek registration, at least of marks they know they will be using for longer periods of time. But because unregistered marks are enforceable under federal law, the costs of registration aren't mandatory, and in many cases parties do not pay them. Most trade dress, for example, is never registered.[166] The costs of registration thus function only very weakly as a costly screen, at least as currently constituted.

### 2. Secondary Meaning as Costly Screen

As we explained above, for all trademarks that are not inherently distinctive, claimants must show that they have developed secondary meaning.[167] Unlike

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[162] 15 U.S.C. § 1125(a). That has not always been true. Every federal trademark statute prior to the Lanham Act made enforcement in federal court contingent on federal registration. Act of March 19, 1920, ch. 104, 41 Stat. 533, *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946); Trade-Mark Act of 1905, ch. 592, § 16, 33 Stat. 724, 728 (creating a cause of action for infringement of registered marks), *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946); *see also id.* § 17 (granting federal courts jurisdiction in cases involving use of a registered mark in interstate commerce).

[163] *See, e.g.*, B&B Hardware, Inc. v. Hargis Indus., Inc., 575 U.S. 138, 142 (2015) ("Registration is significant.").

[164] Under the Lanham Act as originally passed, registration served as constructive notice and constructive nationwide use. Lanham Act, Pub. L. No. 489, § 22, 60 Stat. 427, 435 (1946) (current version at 15 U.S.C. §§ 1051 *et seq*. (2018)) ("Registration of a mark on the principal register provided by this Act . . . shall be constructive notice of the registrant's claim of ownership thereof."). As of November 16, 1989, the effective date of the Trademark Law Revision Act, contingent on registration, the application date serves as the constructive notice and constructive use date. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, sec. 109, § 7, 102 Stat. 3935, 3938–39 (current version at 15 U.S.C. § 1057(c) (2018)).

[165] 15 U.S.C. § 1065 (2018). Incontestable marks can no longer be challenged on certain grounds, including descriptiveness.

[166] Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867 (2017).

[167] *See supra* Part II.A.

inherently distinctive signs, which the law treats as trademarks immediately upon use, non-inherently distinctive marks are subject to a separate criterion of validity. But unlike the functionality rules, for example, the secondary meaning requirement isn't only, and maybe isn't even really, a doctrinal screen. Instead, making claimants of non-inherently distinctive marks establish and prove secondary meaning is best understood as a costly screen. Here we consider the extent of the rule's costs and its effectiveness as screening tool.

If we are to believe the standard trademark story, the first cost associated with the secondary meaning requirement involves developing secondary meaning in the first place. This is because, as we are repeatedly told, consumers are not predisposed to treat descriptive words, single colors, or product designs as source indicators.[168] When consumers see a geographic term on a product, such as Nantucket Reds trousers, or when they perceive the design of a product, like a penguin shaped cocktail shaker, the law assumes that consumers interpret the word or shape in a non-trademark way.[169] To the extent that this is true, a firm that wants to use a non-inherently distinctive sign must first teach consumers to treat that sign as a mark.[170] Enough consumers must learn to make the semantic switch from the mark's primary meaning—these are red trousers made in Nantucket—to the mark's secondary meaning—these trousers made by a particular company that is using Nantucket Reds as a trademark.[171] In most cases, this will require substantial expenditures on advertising.[172] The first time that consumers interact with the jeweler Tiffany & Co., they presumably won't think that the robin's egg blue color of its packages is anything

[168] *See* cases cited *supra* notes 33-37.
[169] *Wal-Mart Stores, Inc*., 529 U.S. at 209.
[170] Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1110 (2003).
[171] *See* Murray's Toggery Shop, The Nantucket Reds Collection, www.nantucketreds.com.
[172] Northam Warren Corp. v. Universal Cosmetic Co., 18 F.2d 774 (7th Cir. 1927) ("The spread of an advertisement among people is like everspreading ripples from a pebble thrown into still water. The ripples go out and out in an ever-increasing circle from a common center, long after the pebble is lost to sight. … Throwing pebbles into water is child's play, but knowledge of a trademark, through advertising and as carried by the people, is an important, valuable business asset, gained at much expense.").

more than an elegant color for boxes. But through repeated exposure to Tiffany's advertisements, consumers have learned to connect the color with the Tiffany brand.

Once a firm believes it has developed secondary meaning for its non-inherently distinctive trademark, it must next prove that it has done so, either to the PTO or to the courts, if it wants to enforce its exclusivity. Legally proving secondary meaning could make the screen costlier. The best evidence of secondary meaning is direct evidence that a sufficient percentage of relevant consumers treat the mark as having acquired distinctiveness.[173] While direct evidence can come from the testimony of random buyers,[174] many courts say that the most persuasive evidence of secondary meaning comes from consumer surveys conducted by experts.[175] Courts admit various types of surveys aimed at showing that consumers treat a term as a trademark,[176] but all of those surveys are expensive. Estimates of the cost of a professional trademark survey range from the high five figures well into six figures.[177] Accordingly, the best proof of secondary meaning is also very expensive proof.

Given this expense, most claimants attempt to prove secondary meaning via circumstantial evidence.[178] In such cases, claimants must raise an inference that a non-inherently distinctive sign has acquired distinctiveness by way of proxy.[179] Courts and the PTO consider many kinds of evidence in evaluating circumstantial proof of secondary meaning including:

1. Length and manner of use;
2. Amount and manner of advertising;
3. Amount of sales and number of customers; and

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[173] MCCARTHY, *supra* note 37, at § 15.30.
[174] *Id.*
[175] Vision Sports, Inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989)
[176] MCCARTHY, *supra* note 37, at § 32.191; Irina D. Manta, *In Search of Validity: A New Model for the Content and Procedural Treatment of Trademark Infringement Surveys*, 24 CARDOZO ARTS & ENT. L.J. 1027, 1036 (2007).
[177] Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CAL. L. REV. 351, 361 (2014) and sources cited.
[178] Barton Beebe, *An Empirical Study of The Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1641 (2006) (finding that only 20% of litigated cases addressed survey evidence).
[179] MCCARTHY, *supra* note 37, at § 15.51.

4. Recognition by the trade, media, or potential customers.[180]

Of course, obtaining credible information of these types will be at least somewhat expensive for firms trying to prove secondary meaning. But it is worth noting that many of the most relevant factors require proving that the claimant spent money on its trademark or trade dress. McCarthy explains courts' inferences about advertising expenses and secondary meaning: "The seller spent a large amount of money on advertising. The larger the amount spent, the greater the exposure of buyers to this symbol as a trademark: The greater the exposure, the greater the likelihood that buyers will associate this symbol with one seller in a trademark sense."[181]

It is difficult to specify the amount of advertising expenditures that courts or the PTO will treat as persuasive of secondary meaning, because it is "the likely effect rather than the effort invested in such activities that is determinative."[182] That is to say, courts claim to care about more than the sum of advertising expenditures but rather whether those expenditures raise an inference that the way in which the mark or dress was used will cause it to be treated as source-identifying.[183] Nonetheless, all else being equal, a claimant is more likely to succeed if it spends millions of dollars on advertising than if it spends tens of thousands of dollars.

Relative to other costly screens in IP law, the secondary meaning requirement appears, at first glance, to create an extremely expensive hurdle to the acquisition of exclusive rights in non-inherently distinctive trademarks and trade dress. Obtaining a utility patent, for example, typically costs about $35,000, including filing fees and attorneys' fees.[184] Compare that to the hundreds of thousands or even millions of dollars that firms must spend on advertising to establish and prove secondary meaning.

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[180] *Id*. at § 15.30.
[181] *Id*. at § 15.51.
[182] RESTATEMENT UNFAIR COMPETITION, § 13, cmt. 3. *See also* Alyssa Morrison, *The Advertising Factor in the Secondary Meaning Instruction*, 19 J. CONTEMP. LEGAL ISSUES 296, 300 (2010).
[183] MCCARTHY, *supra* note 37, at § 15.52.
[184] Masur, *Costly Screens*, *supra* note 113, at 527.

But when it comes to understanding the magnitude of a costly screen, the issue is not merely the gross sum of money expended. Rather, what matters is the *marginal* cost added by the costly screen, above and beyond what the right-seeker would otherwise have spent. In other words: how much must a firm pay to obtain trademark rights in a descriptive term, compared with what it would otherwise have spent? This raises two problems. First, as should be obvious, firms aren't spending large sums on advertising only in order to establish valid trademarks. They're spending the money because they believe it will generate private value for the firm by encouraging people to purchase the firm's products. Firms invest money in advertising because doing so can be profitable. Tiffany & Co. doesn't spend hundreds of millions of dollars annually advertising with its blue color[185] solely to obtain valid trade dress rights in it; it does so because it hopes that positive associations between the blue color and the brand will give it a competitive advantage in the market.[186] More importantly, even if there were no prospect of acquiring trademark rights in the color blue, and even if that meant Tiffany wouldn't spend any money trying to build the positive associations with that color, that wouldn't mean Tiffany would spend less on advertising. It would just advertise differently and focus on different things.

Because firms don't treat advertising expenses as pure costs, the magnitude of the secondary meaning requirement's costly screen is substantially lower than it seems. Unlike the filing and attorneys' fees that a firm must pay to obtain a patent, the costs associated with advertising usually are willfully undertaken irrespective of trademark validity. Of the total that a firm spends on advertising its products, it seems likely that very little money is spent solely for purposes of establishing proof of secondary meaning. Put another way, if trademark law allowed Tiffany & Co. to establish exclusive rights in its blue color automatically with use, we do not think that Tiffany would reduce its advertising expenditures to any meaningful degree.

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[185] Tiffany & Co.'s advertising spend worldwide from 2015 to 2019 (in million U.S. dollars), https://www.statista.com/statistics/857617/global-advertising-spend-of-tiffany-and-co/

[186] Ann Bartow, *The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues*, 97 KY. L.J. 263 (2008).

Second, the costs of establishing an arbitrary or fanciful mark are high as well. This matters for how well the costly screen channels parties towards less socially costly behavior. There is of course no statutory requirement that an arbitrary or fanciful mark have secondary meaning, so the issue is not so much connecting the mark to the firm. Rather, the point is that the owner of an arbitrary or fanciful mark will have to spend more than the proponent of a descriptive or suggestive mark to connect its mark to the product being sold.[187] That is, it will likely cost ADT more in advertising to cause consumers to identify its company with home security than it would cost SimpliSafe to achieve the same identification. This is, of course, one of the main reasons why firms often opt for descriptive and suggestive marks in the first place.

Accordingly, the true measure of the secondary meaning screen is reflected in the relationship between two costs: (1) the cost of getting consumers to treat a term as a trademark (source significance), and (2) the cost of getting consumers to associate the term with the product (product significance). The magnitude of the costly screen, then, is the difference between how much the owner of a non-inherently distinctive mark will have to pay to establish both (1) source significance and (2) product significance, and how much the owner of an inherently distinctive mark will have to pay to establish the same. Quantity (1) is likely somewhat larger for descriptive and suggestive marks because of the doctrinal screen embedded in trademark law. Claiming a non-inherently distinctive mark requires expending money creating and proving secondary meaning. But quantity (2) is likely larger for arbitrary and fanciful marks, because firms need to spend money getting consumers to connect the mark to the product.

It is difficult to know for which type of mark the sum of the costs (1) + (2) will be larger. But our point is not necessarily that descriptive and suggestive marks will be cheaper to obtain than arbitrary and fanciful ones. Rather, the point is that the

[187] Hemel & Ouellette, *supra* note 108, at 1039.

gap in cost will be relatively small, not large enough to establish a costly screen that will effectively eliminate negative social value/low private value marks.

## IV. Aligning Trademark Validity and Competition

As currently constituted, trademark law's combination of doctrinal and costly screens is insufficiently sensitive to competition concerns. The law's doctrinal screen between inherently distinctive and non-inherently distinctive marks is ill-drawn and difficult to apply. Too often, firms can easily obtain trademark rights that produce anticompetitive effects. This wouldn't be as much of a problem if the law's costly screens—registration and secondary meaning—were better at excluding negative social value marks. But those screens are simply too inexpensive. In this Part, we offer a series of proposals for each trademark domain that would more clearly align doctrinal and costly screens with trademark law's competition goals.

### A. Screening Trademarks

The problems we have noted with word marks apply particularly to descriptive and suggestive marks. The supply of fanciful and arbitrary marks is much greater than the supply of suggestive and descriptive marks; for any given product, there will always be more invented words or words that have nothing to do with the product than there will be unused words that are associated with the product. We are also less concerned about owners of arbitrary marks gaining anticompetitive advantages by preventing others from referencing the type of product at issue using the arbitrary mark, precisely because arbitrary and fanciful marks often have no connection with the product other than source significance.[188] And so long as arbitrary marks do not resemble one another too closely—which should be avoidable, given the array of options available—they are unlikely to create too much clutter or consumer

[188] As we discussed in Part II, there are marks that the law treats as arbitrary but, because of sound significance, operate as suggestive marks (e.g. Swiffer and Viagra). *Supra* note 71. We would treat those as suggestive marks.

confusion. But descriptive and suggestive marks, by contrast, raise all of these concerns in spades. When marks group around the thing they are meant to describe, concerns of clutter, anticompetitive behavior, and consumer confusion are at their apex.

As we have suggested, one solution is to impose a costly screen. This costly screen, if appropriately applied, would serve two purposes. First, it would make it costlier for firms to acquire potentially anticompetitive marks. Again, a firm always has the option of electing an arbitrary or fanciful mark, which are less likely to be anticompetitive.[189] If a descriptive or suggestive mark becomes more costly to acquire, a firm seeking a competitive advantage will face a higher bar to acquire that advantage. This will channel more firms toward acquiring arbitrary and fanciful marks, while forcing firms that elect marks that provide competitive advantages to pay for those advantages.[190] Second, and relatedly, imposing a substantial costly screen will act as a type of congestion pricing. The number of potential mark holders who will be willing to pay the steep fees to obtain the relevant marks will be lower than the number of people who might otherwise try to claim those marks.[191] This will help address the twin concerns of congestion and depletion of word marks.[192]

As we explained above, the usefulness of a costly screen is determined by the proportion of negative social value/low private value activities to positive social value/low private value activities it will screen out. If a costly screen will screen out significant numbers of positive social value activities, compared with the number of negative social value activities it will eliminate, then it is counter-productive and will likely be welfare diminishing. If, on the other hand, the screen will largely eliminate negative social value activities, and the number of positive social value activities that will be affected is low, then the screen should be welfare-enhancing. It will curb

[189] Though, as we noted earlier, those marks can have clear advantages when taking into account sound symbolism and non-semantic meaning. *See supra* notes 67-73.
[190] In particular, the costly screen will use firms' private information about the tradeoff between competitively harmful suggestive and descriptive marks and competitively benign arbitrary and fanciful marks.
[191] Beebe & Fromer, *supra* note 5, at 953
[192] *Id.*

harmful actions without meaningfully reducing the number of socially beneficial ones.

There is little question that large numbers of negative social value/low private value descriptive and suggestive trademarks could proliferate, absent any sort of screen. That is, the lower-right-hand box (box 4) of Table 1 could be heavily populated. It would include marks that firms had no intention of using or that weren't being used as trademarks but rather for their informational value,[193] as well as descriptive terms that are important for competitors to use. If firms were able to protect those terms as trademarks, they could deprive competitors of the ability to adequately describe their products to consumers, lead to competitive advantages that distort competition, and redound to the detriment of consumers.[194] The existence of these potential harms, and the inability of doctrinal screens to adequately police this boundary, is the prima facie case for a costly screen.

What about positive social value/low private value trademarks? Would a costly screen bar many of these types of marks? The answer is that marks in this category are unlikely to exist, or at least to exist in meaningful numbers. To understand why, first consider the potential social value of such marks. As we have explained, the social value of a trademark lies in the fact that it signals source to consumers.[195] It is socially valuable for consumers to understand that a particular pair of shoes comes from Nike, or a particular refrigerator from Whirlpool, because it allows them to assess the quality of these goods based on past experiences or existing reviews before purchasing them. That is to say, the value to the consumer of identifying marks is the additional consumer surplus they will obtain from being able to confidently purchase the refrigerator they want, rather than getting some other refrigerator or having to use other information to figure out which refrigerator is which.

The key point is that much of this value is likely to be captured by the firm producing the product. If there are customers who prefer Whirlpool refrigerators and

[193] Roberts, *supra* note 28, at 313.
[194] *See supra* notes 66-69.
[195] *See supra* notes **Error! Bookmark not defined.-Error! Bookmark not defined.**.

are willing to pay extra to obtain Whirlpool refrigerators, Whirlpool will understand this fact and be able to charge them accordingly. That is, some of the surplus created when a consumer who wants a Whirlpool refrigerator is able to purchase a Whirlpool refrigerator will be shared with the producer. This means that any positive social value mark should have positive private value as well—both the consumer (the "social" component of this analysis) and the firm (the "private" component) will benefit. In turn, that means that there should be vanishingly few positive social value/low private value marks. This is in contrast to many other areas of law, including copyright law, where high social value/low private value works abound.[196] And that, in turn, means that this is an area of law ripe for the imposition of a costly screen.

## B. The Mechanics of a Costly Screen

As we explained in Part III, trademark law already employs two price screens that could, in theory, serve to weed out negative social value marks—registration/maintenance fees and the secondary meaning requirement. Registration and maintenance fees are voluntary and very low when they are paid, and they apply irrespective of the anticompetitive risk associated with a particular mark. Secondary meaning, while it appears to set a large costly screen, in fact, imposes little marginal cost on claimants of descriptive terms. The solution is to raise the costly screens against descriptive and suggestive marks. This would have the effect of creating some distance between the costs of acquiring those marks and the cost of acquiring arbitrary and fanciful marks. To create this necessary distance, the additional cost would need to be some multiple of the existing costs of registration and creating and proving secondary meaning. Here we propose alternatives to both screens that will align them more closely with competitive concerns. Our goal is to use costly screens to encourage firms to adopt arbitrary or fanciful marks when doing so will produce

[196] *See* Fagundes & Masur, *supra* note 124, at 254. Authors produce numerous works that may generate significant but diffuse social value that they cannot fully and easily capture.

less social cost.[197] In addition, boosting the costly screens may help cut down on the number of marks that firms are willing to claim.[198]

As a general matter, it is preferable that costly screens are imposed in the form of fees or fines, rather than expenditures made for other purposes. The expense associated with creating secondary meaning is a social cost—once spent on advertising, the dollars cannot be recovered. That is necessary in the context of secondary meaning, because without source significance there is little social value to trademarks. But here the goal is simply to raise costs on owners of descriptive and suggestive marks in order to deter anticompetitive behavior. Accordingly, it would be preferable if the costly screen were simply paid to the federal government to be used for other purposes, such as improved registration processes.[199] In light of this, we focus first on creating a costly screen with registration fees.

1. Registration

For registration fees to serve as a costly screen they must be far higher than current rates, which allow claimants to register a mark for a few thousand dollars. Further, in order to appropriately incentivize behavior, registration fees should be calibrated by competitive harm. It should cost far more to register a suggestive mark than an arbitrary or fanciful mark and even more to register a descriptive mark. The significantly higher fees wouldn't simply screen out firms with low willingness (or

[197] As Hemel and Ouellette note, forcing firms to choose marks far from what they call the "semantic core" can also impose costs on society, as firms must spend more money to create associations and because consumers may struggle to recognize unusual marks. Hemel & Ouellette, *supra* note 108, at 35. One major benefit of a costly screen is that it relies on firms' private knowledge about the costs and benefits of choosing marks that are further from the semantic core.

[198] Sometimes firms may desire the opportunity to claim exclusive rights in additional marks, but those additional marks may create little consumer value. Consider the situation with craft beer names. Yuengling Brewing may want to claim the term "golden" as a brand name for its pilsner style beer. But if Yuengling only makes one pilsner style beer, the additional name isn't giving consumers any additional information, but it is affecting the ability of other breweries to describe their beers. *See* Said, *supra* note 102.

[199] On the role of user fees at the PTO see Michael D. Frakes & Melissa F. Wasserman, *The Failed Promise of User Fees: Empirical Evidence from the U.S. Patent and Trademark Office*, 11 J. EMPIRICAL LEG. STUD. 602 (2014).

ability) to pay these costs; they would also serve as an explicit signal that other, less socially costly marks can be had for much cheaper.[200] Further study is warranted to determine the level of registration fees that would generate optimal channeling and deterrence, especially in light of potential distributive concerns discussed below.[201]

Registration is, of course, voluntary in the U.S., so firms might simply try to avoid these screens if the prices get too high.[202] There are several solutions available to this concern. First, trademark law might try to further increase the benefits of associated with registration. In particular, the law might treat arbitrary and fanciful marks as incontestable at the time of registration, rather than requiring the mark owner to wait five years before applying for incontestable status.[203] While registration gives the mark owner prima facie evidence of exclusive rights to the mark, incontestability gives the owner conclusive evidence thereof, subject to some limited defenses.[204] In addition, trademark law could condition the availability of certain remedies, including injunctive relief[205] or attorneys' fees,[206] on registration of the mark.

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[200] The U.S. is allowed to substantially raise its registration fees and remain in compliance with its international obligations. Article 6 of the Paris Convention gives each country the right to determine the conditions for riling and registering trademarks in its domestic legislation. According to the World Trade Organization, "an applicant who chooses to seek registration of a trademark in a particular foreign country under Article 6 must comply with the conditions for filing and registration specified in that country's legislation." Agreement on Trade Related Aspects of Intellectual Property (Apr. 15, 1994).

[201] *See infra* Part IV.A.3

[202] In some respects, of course, that is our goal. We want firms to instead choose arbitrary and fanciful marks rather than suggestive or descriptive ones.

[203] Under current law, a registrant can seek incontestability by filing an affidavit "within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce," and meeting the other requirements of 15 U.S.C. § 1065.

[204] 15 U.S.C.A. § 1115. For example, a defendant can still challenge an incontestable mark as functional and thus invalid.

[205] Injunctive relief is standard in trademark infringement cases irrespective of registration. Mark A. Lemley, *Did* eBay *Irreparably Injure Trademark Law*, 92 NOTRE DAME L. REV. 1795 (2017).

[206] Attorneys' fees are currently available in "exceptional" cases under the Lanham Act. Christopher P. Bussert, *Interpreting the "Exceptional Cases" Provision of Section 1117(a) of the Lanham Act: When an Award of Attorney's Fees is Appropriate*, 92 TRADEMARK REP. 1118, 1119 (2002). Typically, this means willful or intentionally deceptive infringement. We could relax that requirement to treat all infringements as exceptional if we wanted to further incentivize registration.

Another possibility is to make registration a condition of federal enforcement of trademarks.[207] That requirement could be tailored to the specific costs of descriptive terms by making federal jurisdiction unavailable to unregistered descriptive terms.[208] There would be costs to that approach, since it would make categorization of the claimed mark a jurisdictional question even though it would require factual development. But that cost might be a virtue from the perspective of costly screens—claimants of potentially descriptive unregistered terms would run the risk of having their cases dismissed after having had to litigate the classification issue, which should do more to encourage registration.[209] The goal is to make it almost essential that firms register marks in order to force those firms that wish to use descriptive or suggestive marks to pay the required costly screen.[210] If enforcement were conditioned on expensive registration, claimants would be discouraged from asserting rights in marks in anticompetitive strike suits if the fees are set high enough to make such actions net negative value.

2. Tying Secondary Meaning to Registration

Making registration more valuable or a precondition to filing suit could also be used to boost the costly screen associated with proving secondary meaning for descriptive marks. As we argued in Part III, in most cases, the secondary meaning requirement for descriptive marks adds little to firms' marginal costs. Because they can rely on circumstantial evidence of advertising expenditures, and because they would tend to spend that money anyway, the secondary meaning requirement isn't

[207] That was the way things worked before courts reinterpreted the Lanham Act to find unregistered marks enforceable under § 43(a). *See* Mark P. McKenna, *Registration and Federalization*, CARDOZO ARTS & ENT. L. J. (forthcoming 2021). Claimants still might bring lawsuits alleging violations of state unfair competition laws, but those are will be much less valuable than federal litigation.
[208] This approach is not dissimilar to copyright law's treatment of registration, where registration is necessary to file a federal lawsuit even though a copyright is valid from the moment of fixation.
[209] And registration has substantial social benefits generally, because it improves competitors' notice of claimed marks.
[210] A different approach would require firms to pay a huge fee before filing a federal lawsuit on descriptive or suggestive terms. There might still be an adjudication challenge, however, and we would lose the notice benefits that registration provides.

generating any news costs.[211] If anything, it may be increasing costs for competitors whose litigation expenses include contesting secondary meaning. If more descriptive marks were required to be registered, however, the PTO could condition validity on better quality and more expensive proof of secondary meaning as a condition of registration.

For example, the PTO could require claimants of descriptive marks to establish secondary meaning with direct survey evidence rather than with circumstantial evidence. Although survey methods are far from perfect,[212] mandating them for registration would have numerous benefits. First, requiring this evidence for registration might push the Trademark Office to help develop better methodologies with the help of non-partisan experts. If such surveys could be developed, they would almost certainly provide better evidence than the circumstantial evidence that is currently offered for secondary meaning. In addition, from the perspective of costly screening, quality doesn't matter as much because surveys, unlike circumstantial evidence, impose meaningful marginal costs on claimants. As we mentioned, expert surveys can cost $100,000 or more.[213] The advantage of imposing these additional costs at the time of registration—rather than litigation—is that trademark defendants would not be forced to conduct their own competing surveys and expend their own resources providing evidence of the lack of secondary meaning. The costs would fall entirely on trademark owners. As defendants' litigation costs go down, so should their willingness to settle anticompetitive lawsuits. At the same time, the downside to this approach is that the PTO would be adjudicating secondary meaning *ex parte*, without the benefit of the adversarial process. Poorly executed surveys and marks that only debatably have secondary meaning might be more likely to slip through.

Nonetheless, increasing the magnitude of the costly screen for descriptive marks would generate benefits across the spectrum of marks. Obviously, by making

[211] *See supra* Part III.C.
[212] Barton Beebe, Roy Germano, Christopher Jon Sprigman, & Joel H. Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611 (2019).
[213] *See supra* notes **Error! Bookmark not defined.**-51.

descriptive marks much more expensive, firms will be encouraged to choose marks that won't face these costs. But, because of the uncertainty and inconsistency of the suggestive/descriptive line, risk averse firms would move even further out the distinctiveness spectrum. Thus, a firm considering using the term BUTTER on its Chardonnay would now have to worry that the PTO would determine that its mark is descriptive rather the suggestive, requiring it to pay a higher registration fee and expend substantial sums proving secondary meaning. Instead, it might simply choose an arbitrary or fanciful term, avoiding the higher costs and, importantly for society, imposing less competitive harm on consumers and other firms.

### C. The Distributive Consequences of Costlier Screens

Substantially raising registration fees or increasing the expenses associated with proving secondary meaning will, of course, produce a disproportionate impact on poorer firms than on rich ones. As we mentioned in Part III, wealth effects are unavoidable consequences of using prices as a sorting mechanism. This is one of the reasons why costly screens are an imperfect solution to the limitations of doctrinal screens. Ultimately, though, we believe that our proposal will tend to help small businesses and new entrants.

Our animating concern is that current trademark law makes anticompetitive behavior far too easy, limiting the ability of smaller and newer firms from entering markets. By raising the costs of anticompetitive behavior, we hope to even the playing field for new entrants. Relative to the status quo, our proposal should reduce the number of descriptive and suggestive marks in a given field, making it easier for new entrants to reach consumers and sell their goods. Currently, initial market entrants combine first-mover advantages with cheap and easy access to anticompetitve trademarks. Costly screens are an option for addressing the latter concern.

Importantly, the costly screens that we propose for certain trademarks are unlike other costly screens that condition rights on payments. If a person can't afford a poll tax, she doesn't get to vote. If a firm can't pay to obtain a patent, it simply does not get one. By contrast, if a relatively poor firm determines that it cannot afford to pay for a suggestive or descriptive trademark, it can instead choose an arbitrary or fanciful one and avoid the costly screen. As we explain in Part III.C, those marks aren't costless, because they require advertising to establish product significance. But the firm is not categorically excluded from claiming and asserting trademark rights. Although some firms may get priced out of using marks that they would prefer, we believe that new entrants should prefer costlier screens for terms that will be anticompetitive.

## Conclusion

At its core, trademark law is about competition. Trademarks exist to promote fair and effective competition by allowing firms to identify the source of their products to consumers. This enables consumers to purchase the goods they want from the firms they trust, and it creates incentives for firms to build and maintain reputations for quality, which similarly redounds to the benefit of consumers. But the law as it stands has lost track of this goal. The law makes it too easy—and too cheap—for firms to acquire trademarks that afford significant competitive advantages by their very nature. The problem is that the law focuses only on whether a trademark signifies source while ignoring whether the trademark simultaneously affords competitive advantages.

Yet when a firm acquires and asserts a descriptive or suggestive trademark, it gains an edge over competitors who can no longer use those terms to describe their own products. This advantage has nothing to do with the underlying merits of the products in question. Rather, it is driven by the fact that the government has awarded a monopoly over certain words to one firm and not another. The situation is even worse in crowded areas of commerce where trademarks proliferate and limit the options available to everyone, including new entrants. This type of monopoly-driven power will lead to less robust competition, higher prices, and losses for consumers.

It does not have to be this way. Trademark law's doctrinal screens are not effective at weeding out anticompetitive marks and preventing the linguistic space from being overrun by too many marks. What is needed is a more robust costly screen, one that imposes substantial costs on putative owners of suggestive and descriptive marks. Such a costly screen would operate as a form of congestion pricing, reducing trademark overcrowding and freeing up linguistic space for competition. It would also help channel firms away from anticompetitive marks and toward marks that do not offer competitive advantages. This more robust costly screen could be coupled with doctrinal changes that further limit firms' ability to strategically leverage trademarks as state-sponsored monopolistic tools. Some of these changes would require legislative action; others could be implemented by the PTO. But all of them would help reorient trademark law back toward the pro-competitive role it was always meant to occupy.