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Acquired Distinctiveness of Source

A descriptive, and thus non-inherently distinctive, mark may qualify for protection if it is shown to have developed “acquired distinctiveness” or “secondary meaning” (the two terms mean the same thing) as a designation of source. For example, though the term “American Airlines” is highly descriptive of an airline service based in the U.S., the term has developed enormous secondary meaning as a designation of source through use and advertising. As the Supreme Court commented in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), the term “secondary meaning” is not as clear as it could be:

The phrase “secondary meaning” originally arose in the context of word marks, where it served to distinguish the source-identifying meaning from the ordinary, or “primary,” meaning of the word. “Secondary meaning” has since come to refer to the acquired, source-identifying meaning of a nonword mark as well. It is often a misnomer in that context, since nonword marks ordinarily have no “primary” meaning. Clarity might well be served by using the term “acquired meaning” in both the word-mark and the nonword-mark contexts—but in this opinion we follow what has become the conventional terminology.

Id. at 211 fn. Indeed, most trademark practitioners still continue as a matter of tradition to use the term “secondary meaning” rather than “acquired distinctiveness.”

Each circuit typically uses its own multifactor test to determine if a mark has developed secondary meaning. They are generally quite similar. Here are some examples of these tests:

- Second Circuit: “(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark’s use.” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 143 n.4 (2d Cir. 1997).
- Third Circuit: “We have identified an eleven-item, non-exhaustive list of factors relevant to the factual determination whether a term has acquired secondary meaning: (1) the extent of sales and advertising leading to buyer association; (2) length of use; (3) exclusivity of use; (4) the fact of copying; (5) customer surveys; (6) customer testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and, (11) actual confusion.” *E.T. Browne Drug Co. v. Cococare Products, Inc.*, 538 F.3d 185, 199 (3d Cir. 2008).
- Ninth Circuit: “Secondary meaning can be established in many ways, including (but not limited to) direct consumer testimony; survey evidence; exclusivity, manner, and length of use of a mark; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying by the defendant.” *Art Attacks Ink, LLC v. MGA Enter., Inc.*, 581 F.3d 1138, 1145 (9th Cir. 2009). See also *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 62 U.S.P.Q.2d

1593 (9th Cir. 2002) (listing secondary meaning factors as “(1) whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer, (2) the degree and manner of advertising under the claimed trademark, (3) the length and manner of use of the claimed trademark, and (4) whether use of the claimed trademark has been exclusive.”).

The three opinion excerpts that follow offer examples of courts’ analyses of whether a non-inherently distinctive mark has developed sufficient secondary meaning to qualify for protection. Each of these opinions addresses facts involving non-verbal marks, but they are included here because the secondary meaning analysis of verbal and non-verbal marks operates in essentially the same way. In reading these excerpts, consider the following questions:

- What proportion of consumers in the relevant population should courts require to perceive the mark as possessing secondary meaning for the mark to qualify for protection? 25%? 50? 75%? Relatedly, how should courts determine what constitutes the relevant population of consumers?
- How would you devise a survey to test for secondary meaning?
- Why should “length and exclusivity of use” matter for purposes of establishing secondary meaning?
- Imagine a situation in which Company David, after a great deal of market research, adopts an especially good descriptive mark and initiates a small-scale launch of the descriptive mark in the marketplace. Company Goliath then becomes aware of Company David’s mark, adopts the mark as its own, and immediately spends enormous resources building up secondary meaning in the mark, so that when consumers see the mark, they think of Company Goliath. Which company should be granted rights in the mark? And is this in your view an equitable or efficient outcome?

The following case involved two main questions. The first was whether a combination of design elements incorporated into the design of boots had acquired distinctiveness. The case is included here because of the court’s rich analysis of this issue. But the case also involved the question of whether the combination of design elements was functional. Because we will address the issue of functionality in more detail in Classes 6 and 7, the court’s discussion of that issue has been largely edited out of the opinion excerpt below. In any event, as you will see, the court ultimately determined that it did not need to decide the issue of functionality because of how it ruled on the issue of acquired distinctiveness.

[The opinion in *TBL Licensing, LLC v. Vidal* is available separately.]

[The opinion in *Cartier, Inc. v. Four Star Jewelry Creations, Inc.* is available separately.]

In the following case, *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), the plaintiffs Louisiana State University, the University of Oklahoma, Ohio State University, the University of Southern California, and Collegiate Licensing Company (the official licensing agent for the universities) brought suit against defendant Smack Apparel for its unauthorized sale of apparel bearing the universities' colors and various printed messages associated with the universities (but not bearing the universities' names or mascots). The Eastern District of Louisiana granted the plaintiffs' motion for summary judgment on the issue of trademark infringement. Excerpted below is the Fifth Circuit's discussion of whether the universities' colors carry secondary meaning as designations of source.

Note that we will soon return to the protectability of colors as trademarks when we consider *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995).

[The opinion in *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.* is available separately.]

[The opinion in *United States Patent and Trademark Office v. Booking.com B.V.* is available separately.]

[The opinion in *Snyder's Lance, Inc. v. Frito-Lay North America, Inc.* is available separately.]

[The opinion in *Elliott v. Google, Inc.* is available separately.]

Comments and Questions

1. *Necessary proportion of relevant consumer population perceiving secondary meaning.* Courts generally require that a "substantial" proportion of the relevant consumer population perceive the descriptive mark as a designation of source for that mark to qualify for protection. See, e.g., *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir. 1991) ("The plaintiff is not required to establish that *all* consumers relate the product to its producer; it need only show that a substantial segment of the relevant consumer group makes this connection."). But what proportion is substantial? If survey evidence is presented, courts have generally been satisfied, as in the *Cartier* case above, with a proportion at or above 50%. See, e.g., *Harlequin Enterprises, Ltd. v. Gulf & Western Corp.*, 644 F.2d 946 (2d Cir. 1981) (finding 50% association to be probative of secondary meaning).

in book cover design); *Spraying Systems Co. v. Delavan*, 975 F.2d 387, 394 (7th Cir. 1992) (“While a 50-percent figure is regarded as clearly sufficient to establish secondary meaning, a figure in the thirties can only be considered marginal.”); *Boston Beer Co. Ltd. Partnership v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 183 n.5 (1st Cir. 1993) (characterizing a 36% showing of association as “hardly overwhelming”). See also *Zatarain’s Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (affirming district court’s finding that FISH-FRI possessed secondary meaning on the basis of survey showing 28% consumer association and other, circumstantial evidence, but calling the issue “close” and suggesting that “[w]ere we considering the question of secondary meaning *de novo*, we might reach a different conclusion than did the district court”).

More generally, courts may require more compelling evidence of secondary meaning for marks that are highly descriptive. See MCCARTHY § 15:28 (“[A]s a general rule of thumb, the more descriptive the term, the greater the evidentiary burden to establish secondary meaning. That is, the less distinctive the term, the greater the quantity and quality of evidence of secondary meaning needed to prove the requisite degree of distinctiveness.”).

2. *The statutory mechanism for registration of descriptive marks with secondary meaning.* Lanham Act §§ 2(e) & 2(f), 15 U.S.C. §§ 1052(e) & (f), provide for the registration of descriptive marks with secondary meaning. The relevant portions of § 2 read as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . .

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.

15 U.S.C. § 1052.

3. *The prima facie presumption of acquired distinctiveness after five years of exclusive and continuous use.* In the registration context, Lanham Act § 2(f), 15 U.S.C. § 1052(f), establishes that “The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” Courts have emphasized the “may” in “may accept.” See *Heritage All. v. Am. Pol’y Roundtable*, 133 F.4th 1063, 1070 (Fed. Cir. 2025) (affirming the TTAB’s finding that the asserted marks “iVoterGuide” and “iVoterGuide.com” had not acquired distinctiveness after five years of continuous use and noting that § 2(f) “indicates that the Board has

discretion not to accept such evidence as prima facie evidence, much less as ultimately persuasive evidence, on a case-by-case basis.”).

Generic Marks

Trademarks may be deemed generic either (1) because they are born generic or (2) because they lose their source distinctiveness through a process of “genericide.” The following are examples of marks born generic:

- *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 79 U.S.P.Q.2d 1790 (8th Cir. 2006) (finding BRICK OVEN for frozen pizza to be generic);
- *Ale House Management, Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 54 U.S.P.Q.2d 1040 (4th Cir. 2000) (finding ALE HOUSE for chain of restaurants serving food and beer to be generic);
- *Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385, 1999 WL 1421649 (TTAB 2000) (finding E-TICKET for electronic ticketing services to be generic);
- *Nat’l Conf. of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 487 (7th Cir. 1982) (finding MULTISTATE BAR EXAMINATION for legal testing services to be generic).

The following are examples of marks that have fallen to genericide:

- *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (Comm’r Pat. 1950) (cancelling registration of ESCALATOR for moving staircases);
- *Duncan F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 662 (7th Cir. 1965) (finding that the term “yo-yo” had long since become generic despite plaintiff’s “herculean efforts to fasten upon the toy the generic term, ‘return top’”);
- *Bayer Co. v. United Drug Co.*, 272 F. 505, 510 (D.N.Y. 1921) (finding as to the mark ASPIRIN for acetylsalicylic acid that “[a]mong consumers generally the name has gone into the public domain”).

The following are examples of marks that have not (yet?) been held to be generic and remain registered trademarks at the PTO:

- BAND-AID for “protective surgical dressing in the form of a bandage” (U.S. Reg. No. 194,123, Jan. 13, 1925);
- REALTOR for real estate brokerage services (U.S. Reg. No. 519,789, Jan. 15, 1950);
- STYROFOAM for “multicellular expanded synthetic resinous material” (U.S. Reg. No. 539,147, March 13, 1951).

A leading test for genericism is the *Marvin Ginn* test: “Determining whether a mark is generic . . . involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Ginn Corp.*

v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990 (Fed. Cir. 1986). Though the *Marvin Ginn* test is formulated here in terms of registrability, its approach works well enough in determining if unregistered marks are generic.

There are a variety of simple rules of thumb that inform courts' determination of whether a mark is generic or descriptive. *Abercrombie* outlined a genus/species distinction akin to that implied in *Marvin Ginn*: "A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). There is also the "who-are-you/what-are-you" distinction:

In determining whether a term is generic, we have often relied upon the "who-are-you/what-are-you" test: "A mark answers the buyer's questions 'Who are you?' 'Where do you come from?' 'Who vouches for you?' But the [generic] name of the product answers the question 'What are you?'" *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993) (quoting 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 12.01 (3d ed. 1992)). Under this test, "[i]f the primary significance of the trademark is to describe the *type of product* rather than the *producer*, the trademark [is] a generic term and [cannot be] a valid trademark." *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 304 (9th Cir. 1979) (emphases added)

Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc., 198 F.3d 1143, 1147 (9th Cir. 1999). Courts will also rely on the proposition that a mark is generic if it is the "common descriptive name" of the good or service to which it is affixed. See, e.g., *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 532 n. 7 (1987) ("A common descriptive name of a product or service is generic. Because a generic name by definition does not *distinguish* the identity of a particular product, it cannot be registered as a trademark under the Lanham Act." (emphasis in original)).

But while the basic principles underlying the genericness analysis are straightforward, distinguishing between a highly descriptive mark and a generic mark can be exceedingly difficult in close cases, and the stakes in such cases can be exceedingly high.¹ Recall that even a "highly descriptive" mark will qualify for protection upon a showing of secondary meaning. A generic mark, by contrast, is unredeemable; it will never receive protection under any circumstances. Genericness doctrine, meanwhile, can be quite malleable.

The following three cases offer different views of trademark genericism. The first is the Supreme Court case *United States Patent and Trademark Office v. Booking.com B.V.*, 591

¹ Is "App Store" a generic term for an online platform selling apps? See *Apple, Inc. v. Amazon.com Inc.*, No. 11 Civ. 1327, 2011 WL 2638191, at *7 (N.D. Cal. July 6, 2011) ("The court assumes without deciding that the 'App Store' mark is protectable as a descriptive mark that has arguably acquired secondary meaning." But the court found, on Apple's preliminary injunction motion, that Amazon's use of "App Store" to describe its app store did not create a likelihood of confusion.).

U.S. 549 (2020). In analyzing whether the mark BOOKING.COM is generic, the three opinions in the case engage a variety of overarching questions in genericism doctrine, such as whether the facts of consumer perception or the goals of competition policy should drive the genericism analysis. The second case emerged out of a dispute between the giant snack food maker Frito-Lay North America, Inc. and an upstart competitor, Princeton Vanguard LLC (subsequently purchased by Snyder's Lance, Inc.), who introduced "pretzel crisps" into the market and sought to trademark the term. The *Snyder's Lance* opinion is quite lengthy but useful for our purposes because it shows the wide variety of evidence that parties may present in a hard-fought genericism dispute. It will be of special interest to students interested in the nuts-and-bolts of frontline genericism litigation. The third opinion, *Elliott v. Google, Inc.*, engages the question of whether the mark GOOGLE has fallen victim to genericide. Remarkably, the court reasons that even if the public uses the verb "google" in a generic sense to describe the act of "searching on the internet without regard to the search engine used," that would not support a finding that GOOGLE has become generic for internet search services.

[The opinion in *United States Patent and Trademark Office v. Booking.com B.V.* is available separately.]

[The opinion in *Snyder's Lance, Inc. v. Frito-Lay North America, Inc.* is available separately.]

[The opinion in *Elliott v. Google, Inc.* is available separately.]

Comments and Questions

1. *What is the appropriate level of abstraction?* With respect to the genus/species distinction, how does one establish the appropriate level of abstraction at which one defines the genus, the species, and even the subspecies (or, for that matter, the family above the genus)? What prevents a plaintiff from claiming that the genus is, for example, beer, and the plaintiff merely wants rights in the name of a species of beer, which is "light beer"? See *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75 (7th Cir. 1977) (finding LIGHT and LITE for beer to be generic).

2. *"Aisle search" versus "shelf search."* In a thoughtful opinion, Magistrate Judge Steve Kim of the Central District of California cited approvingly an additional way of thinking about generic versus non-generic designations:

Because "conceptually" consumers do an "aisle search" for "the type of good they want" in the market and a "shelf search" for "the particular brand of that good," the "genericism inquiry is therefore about assessing terms to determine

whether they are related to an aisle search or a shelf search.” Laura A. Heymann, *Trademarks in Conversation: Assessing Genericism After Booking.com*, 39 Cardozo Arts & Ent. L.J. 955, 958 (2021). “Competitors, for their part, need to be able to use the term that will allow them to be grouped with comparable goods in the aisle search and to use trademarks as one method of winning the competition in the shelf search.” *Id.*>

Snap Inc. v. Vidal, 750 F.Supp.3d 1120, 1139–40 n. 12 (C.D. Cal. 2024).

3. *Surveying for genericism: the “Thermos” survey method.* In *American Thermos Products Co. v. Aladdin Industries, Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d*, 321 F.2d 577 (2d Cir. 1963), the defendant argued that the term “thermos” had lost its significance as a designation of source and become a generic term for vacuum-insulated containers. To support this argument, the defendant submitted a survey whose method has been copied in many subsequent genericism cases. See, e.g., *E.T. Browne Drug Co. v. Cococare Products, Inc.*, 538 F.3d 185, 87 U.S.P.Q.2d 1655 (3d Cir. 2008) (evaluating *Thermos*-type survey). See also MCCARTHY § 12:15. In essence, a *Thermos* survey (1) asks the survey respondent whether they are familiar with the general product at issue (e.g., “the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time”), (2) asks the respondent to imagine him/herself walking into a store and asking for that product, and then (3) inquires “What would you ask for—that is, what would you tell the clerk you wanted?” The survey will then typically ask some form of the question “Can you think of any other words that you would use to ask for the product?” In *American Thermos Products*, 75% of the 3,300 respondents answered “Thermos” to the “what would you ask for” question. *American Thermos Products*, 207 F. Supp. at 21-22. The court found that the term “thermos” had become generic for vacuum-insulated bottles.

The *Thermos* survey method has been criticized on the ground that “for a very strong trademark, respondents with brand loyalty may answer with the trademark and drop what they consider to be a generic name, because it’s so obvious to them.” MCCARTHY § 12:15. Imagine you walk into a fast food restaurant in order to purchase a carbonated cola-flavored beverage. What would you ask for? What do you think the results of such a survey of 100 respondents would be, and do they support McCarthy’s criticism?

4. *Surveying for genericism: the “Teflon” survey method.* In *E. I. DuPont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975), Dupont, producer of TEFLON resins, brought a trademark action against the defendant Yoshida, producer of EFLON zippers. In response to Yoshida’s argument that TEFLON had become generic, DuPont submitted two surveys, one of which was a telephone survey in which respondents were first given what was essentially a mini-course in the difference between “brand names” and “common names” and then asked if “teflon” was a brand name or a common name. The core of the survey script proceeded as follows:

I'd like to read 8 names to you and get you to tell me whether you think it is a brand name or a common name; by *brand* name, I mean a word like *Chevrolet* which is made by one company; by *common* name, I mean a word like *automobile* which is made by a number of different companies. So if I were to ask you, "Is Chevrolet a brand name or a common name?," what would you say?

Now, if I were to ask you, "Is washing machine a brand name or a common name?," what would you say?

[If respondent understands continue. If not understand, explain again.]

Now, would you say _____ is a brand name or a common name?

McCARTHY § 12:16. In one evening, 514 men and 517 women were surveyed in 20 cities. The survey results were as follows:

NAME	BRAND/%	COMMON/%	DON'T KNOW/%
STP	90	5	5
THERMOS	51	46	3
MARGARINE	9	91	1
TEFLON	68	31	2
JELLO	75	25	1
REFRIGERATOR	6	94	-
ASPIRIN	13	86	-
COKE	76	24	-

Interestingly, Yoshida submitted a *Thermos* survey to support its claim that TEFLON had become generic. As the court explained, this survey

was conducted among adult women, 90.6% of whom expressed awareness of 'kitchen pots and pans that have their inside surfaces coated by chemical substances to keep grease or food from sticking to them.' Of the aware respondents, 86.1% apparently mentioned only 'TEFLON' or 'TEFLON II' [DuPont's mark for an improved means of applying its resin to metal surfaces] as their sole answer when asked, 'What is the name . . . or names of these pots and pans . . .?' Further, 71.7% of the aware women gave only 'TEFLON' or 'TEFLON II' as the name they would use to describe the pots and pans to a store clerk or friend.

E. I. DuPont de Nemours & Co., 393 F.Supp. at 525.

The court ultimately found DuPont's brand name vs. common name survey to be the more persuasive. In Yoshida's *Thermos* survey (as in other surveys in the case not discussed here), the court found, "respondents were, by the design of the questions, more often than not focusing on supplying the inquirer a 'name', without regard to whether the principal significance of the name supplied was 'its indication of the nature or class of an article,

rather than an indication of its origin.” *Id.* at 527 (quoting *King-Seeley Thermos Co.*, 321 F.2d at 580). Only DuPont’s brand name vs. common name survey

really gets down to the critical element of the case. . . . {T}he responses of the survey reveal that the public is quite good at sorting out brand names from common names, and, for TEFLON, answers the critical question left unanswered by the ambiguities inherent in {the other surveys}—that of the principal significance of the TEFLON mark to the public. Not only have defendants failed to show that TEFLON’s principal significance is as a common noun, plaintiff has succeeded in showing it to be a ‘brand name’—an indicator, in the words of DuPont’s questionnaire, of a product ‘made by one company.’”

E. I. DuPont de Nemours & Co., 393 F.Supp. at 527.

Do you agree that the *Teflon* survey method is superior to the *Thermos* survey method for assessing whether a mark is generic?

5. *What proportion of relevant consumers is sufficient to qualify the asserted mark as non-generic?* In keeping with the statutory language that “[t]he primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services,” 15 U.S.C. § 1064(3), courts generally require that survey evidence show that a majority of consumers, i.e., above 50%, recognize the asserted mark as a designation of source rather than a generic term. See MCCARTHY § 12:6. *Interprofession du Gruyere v. U. S. Dairy Exp. Council*, 61 F.4th 407, 416 n. 4 (4th Cir. 2023); *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007). *Cf. Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (“substantial majority”).

6. *Surveying for genericism: secondary meaning surveys?* In a portion of the *Snyder’s Lance* opinion not excerpted above, the district court quoted and endorsed the TTAB’s analysis of a secondary meaning survey that Princeton Vanguard had submitted in an effort to prove that PRETZEL CRISPS had acquired secondary meaning. The TTAB interpreted the survey evidence rather differently. As quoted by the *Snyder’s Lance* district court, the TTAB explained:

The {Mantis Survey} was conducted via online participation, between August 26 and August 30, 2011. There were 400 survey participants. Respondents were invited by email to participate in the survey and were told it was about “salty snack foods.” Individuals were then asked prescreening questions. To be included in the survey, individuals had to, among other things, be the “primary grocery shopper,” be “between the ages of 24 and 39,” and “have purchased crackers and pretzels in the past month and will purchase crackers and pretzels in the next month.”

Survey respondents were informed during the screening process about the difference between “brand” and “common” names and then allowed to proceed

with the survey only if they correctly associated BAKED TOSTITOS with “only one company” and TORTILLA CHIPS with “more than one company.” For those who proceeded with the study, two control names were given, and the same questions were asked. The results are shown as follows:

NAME	Only One Company	More	Don't Know
SUN CHIPS	96.5%	3%	.5%
ONION RINGS	23.8%	72%	4.3%
PRETZEL CRISPS	38.7%	47.8%	13.5%

Based on the survey, Mr. Mantis found that 38.7% of the respondents associated the name “PRETZEL CRISPS” with only one company. On that basis, he stated: “It is my opinion that the name ‘PRETZEL CRISPS,’ used in conjunction with a salty snack food product, has acquired secondary meaning.”

Plaintiff retained Dr. Ivan Ross to rebut the findings of Mr. Mantis. Keeping in mind that the rebuttal was as to a survey offered to show acquired distinctiveness, Dr. Ross’ main objection to the Mantis survey is that although Mr. Mantis said that he conducted the survey for the purpose of establishing secondary meaning, Mr. Mantis’s methodology actually analyzes genericness. Plaintiff specifically argues that the Mantis survey was conducted in the manner of a Teflon-style survey, in that participants were asked whether they associate each term with one company or with more than one company. In this regard, during the initial mini-course, participants were specifically instructed as to the differences between “brand” and “common” names:

Some names are brand names. A brand name refers to a product associated with one particular company. Other names are common names. A common name refers to a type of product associated with more than one company.

As such, participants were told that if they associated a term with “one particular company” then it is a “brand name,” and vice-versa. With this instruction given to all participants in the survey, we find it logical to consider all those who said they associated the term “PRETZEL CRISPS” with “one particular company” thus also found the term “PRETZEL CRISPS” to be a “brand name” rather than a “common name,” and that all those who said they associated the term “PRETZEL CRISPS” with “more than one company” thus also found the term “PRETZEL CRISPS” to be a “common name” rather than a “brand name.” In this regard, only 38.7% of participants, which is rather less than 50%, found the term to be a brand name.

Accordingly, we find that although the Mantis survey was conducted and offered for the purpose of showing secondary meaning, if we had considered the

other two surveys on the question of genericness, the Mantis survey should also have been considered on the issue of genericness. Since substantially less than half of the Mantis survey respondents associated the term “PRETZEL CRISPS” with a single source, this survey weighs in favor of finding genericness. We note, in this regard, that even if we were to split the 13.5% percent of “don’t know” responses, as suggested by Defendant with regard to the Simonson survey, then adding 6.75% to each of the “only one company” and “more than one company” tallies, we still have less than a majority who associate the term with one company, and more than half who associate the term with more than one company, and so we have the same result.

Snyder’s Lance, Inc. v. Frito-Lay North America, Inc., 542 F.Supp.3d 371, 402–03 (2021) (quoting *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 U.S.P.Q.2d 1184, 1191–1201 (TTAB 2017)).

7. *Corpus linguistics evidence of genericism?* The edited-down version of *Snyder’s Lance* appearing above does not include the court’s detailed review of the plaintiff’s own attempts to read and classify each of the thousands of media, Google, and social media references to “pretzel crisps.” In essence, the plaintiff had attempted to develop “corpus linguistics evidence” (empirical data derived from very large, systematic collections of human-authored texts, or corpora) to show non-genericness. But the plaintiff used non-attorney, administrative employees of its law firm to develop this evidence. The court was highly critical of this effort on the ground, among others, that the law firm employees did not explain how they reached their decisions and often failed to record how they classified particular uses. An emerging mode of genericism evidence seeks to overcome these kinds of objections to corpus linguistics evidence by employing credentialed linguists to prepare reports that classify all relevant uses of a term in a corpus. See James A. Heilpern et al., *Going Generic: A Linguistics Approach to Genericide in Trademark Law*, 50 *BYU L. REV.* 81 (2024). For an example of the use of machine-learning methods to classify corpus usages, see Barton Beebe, Sibio Ma, & Julian Nyarko, “Benchmarking Trademark Genericide” (working paper, June 14, 2026).

8. *Is WINDOWS for a computer operating system generic?* On December 20, 2011, Microsoft filed suit against Lindows.com (“Lindows”) alleging that Lindows’ mark LINDOWS for a Linux-based operating system infringed Microsoft’s WINDOWS mark. Lindows argued that WINDOWS was generic at the time that Microsoft first began to use it in 1985. In *Microsoft Corp. v. Lindows.com, Inc.*, No. 01 Civ. 2115C, 2002 WL 31499324 (W.D.Wash., Mar. 15, 2002), the district court denied Microsoft’s motion for a preliminary injunction, finding that there were “serious questions regarding whether Windows is a non-generic name and thus eligible for the protections of federal trademark law.” *Id.* at *18. The case eventually settled—with Microsoft agreeing to pay Lindows \$20 million to change its name (to Linspire) and cease using the LINDOWS mark on any of its products.

After *Booking.com*, would a secondary meaning survey showing that an otherwise generic term has substantial secondary meaning be enough to justify a finding that the mark is not generic? For example, if a litigant can produce a survey showing that 60% of consumers believe the term WINDOWS for computer operating systems is used by only one company, should that justify a finding of distinctiveness?

9. *Usage policies.* Owners of very well-known marks are especially wary of their marks' falling prey to genericide through widespread generic usage. They typically develop and seek to enforce strict policies on how their marks are used. See, e.g., Google, Rules for proper usage, <http://www.google.com/permissions/trademark/rules.html> ("Use a generic term following the trademark, for example: GOOGLE search engine, Google search, GOOGLE web search"; "Use the trademark only as an adjective, never as a noun or verb, and never in the plural or possessive form."; "If you do not capitalize the entire mark, always spell and capitalize the trademark exactly as they are shown in the Google Trademarks and Suggested Accepted Generic Terms.").

10. *Source-denotative in American English, but generic elsewhere?* Sheepskin boots with a tanned outer surface, fleece interior, and synthetic soles are generically known as "ugg boots" or "uggs" in Australia and New Zealand, where they were originally developed and where a variety of companies use the term "ugg" to describe the boots they manufacture. In the United States, by contrast, UGG is a registered trademark for such boots, owned by Deckers Outdoor Corp. (U.S. Trademark Reg. No. 4,234,396, Oct. 30, 2012). When an Australian company sought to sell what it called "ugg boots" in the United States, Deckers sued. The Australian company argued that the term was generic. It lost. In granting summary judgment to Deckers on the issue, the court explained:

Australian Leather has evidence that ugg is generic in Australia, but there is no evidence that Americans familiar with Australian usage (or Australian visitors to the United States) would be misled into thinking that there is only one brand of ugg-style sheepskin boots available in this country. Australian Leather needed to come forward with some evidence that would allow a jury to conclude that the term ugg has a generic meaning to buyers in the United States; its Australian and surf-shop evidence does not suffice.

Deckers Outdoor Corp. v. Australian Leather Pty. Ltd., 340 F. Supp. 3d 706, 716 (N.D. Ill. 2018).

For an interesting comparison, the Swiss and French associations representing the makers of Gruyère cheese filed in 2015 an application at the PTO to register the term GRUYERE (without the accent) as a certification mark. GRUYÈRE is a protected geographic indication in the European Union and Switzerland. Various American dairy interests opposed the registration. The TTAB refused registration on the ground that the term was generic. It found that American consumers "understand the term 'gruyere' as a designation that primarily refers to a category within the genus of cheese that can come from anywhere."

Int'l Dairy Foods Ass'n v. Interprofession Du Gruyere, 2020 TTAB LEXIS 268, *82, 2020 U.S.P.Q.2D 10892 (TTAB August 5, 2020).

What about “Coke” in the American South? See Valerie Fraser Luesse, *Why Southerners Refer to All Soft Drinks as ‘Coke,’* SOUTHERN LIVING, June 22, 2025 (“Native Texans (like most native Southerners) call all soft drinks ‘coke’—a generic use of Coke.”) Should regional genericness make any difference?

11. *Can a color be generic?* In *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, Cancellation Nos. 92,059,634 & 92,059,637 (TTAB Dec. 2, 2019) [precedential], the TTAB found that the color red was generic when covering the surface of saw blades:

This evidence overwhelmingly demonstrates that the color red on saw blades is so common in the industry that it cannot identify a single source for saw blades for power woodworking machines or saw blades for reciprocating power saws. What is more, because the evidence establishes that the color red was widely used by others at the time Freud filed the underlying applications for each of its subject registrations and third-party use continues to the present day, the color red was generic for power saw blades when Freud applied for both of its marks and remains so now.

Id. at *67. See also *In re PT Medisafe Techs.*, 134 F.4th 1368 (Fed. Cir. 2025) (finding the color dark green to be generic for medical gloves).

Most commentators would likely agree with the proposition that “[g]enericness seems . . . to be the wrong pigeonhole for a proposed color mark.” John L. Welch, *Precedential No. 37: TTAB Rules that the Color Red is Generic for Saw Blades*, THE TTABLOG, Dec. 9, 2019. But what other options are available in trademark doctrine to deny protection to such marks?

12. *Can a product shape be generic?* In *In re Jasmin Larian, LLC*, 2022 TTAB LEXIS 99 (TTAB Jan. 19, 2022) [precedential], the applicant sought to register as a trademark the configuration of its “Ark” handbag, shown below. The TTAB held that the configuration had long since become a commonplace design originating from multiple sources and was thus generic. It reasoned: “In the context of product design, genericness may be found where the design is so common in the industry that it cannot be said to identify a particular source.” *Id.* at *8. See also *Deckers Outdoor Corp. v. Last Brand, Inc.*, No. 23 Civ. 04850, 2025 WL 2822685, at *4 (N.D. Cal. Oct. 2, 2025) (finding certain Ugg boot designs to be generic).



Failure to Function as a Mark

In recent years, trademark applicants have increasingly sought to register cultural memes or other commonplace slogans as trademarks for various merchandise. The PTO has rejected such applications on the ground that the applied-for marks are not perceived by consumers as designations of source. See, e.g., *In re Texas With Love, LLC*, Serial No. 87793802 (TTAB October 29, 2020) [precedential] (refusing to register TEXAS LOVE for “hats, shirts” on ground that because the phrase “only serves as an expression of a concept or sentiment, and is widely used by third parties, it would not be perceived as an indicator of source in the context of Applicant’s identified goods.”); *In re Gillard*, Serial No. 87469115 (TTAB Jan. 11, 2019) (not citable as precedent) (refusing application of one John Gillard to register #COVFEFE on ground that “because hashtags are commonly employed to facilitate categorization and searching of topics of public discussion, and the record makes it clear that #COVFEFE has served that purpose in promoting discussion of the mystery word in the President’s tweet, the public will not understand #COVFEFE to identify one, and only one, source of clothing, and to recognize Applicant as that source, when it appears on Applicant’s goods”); PTO Office Action, U.S. Application Serial No. 86,506,015, Mar. 25, 2015 (refusing registration of JE SUIS CHARLIE for various goods on ground that “[b]ecause consumers are accustomed to seeing this slogan or motto commonly used in everyday speech by many different sources, the public will not perceive the motto or slogan as a trademark that identifies the source of applicant’s goods but rather only as conveying an informational message”); PTO Office Action, U.S. Application No. 88579771, Sept. 11, 2019 (refusing basketball player LeBron James’s application to register TACO TUESDAY in connection with podcasting and other related goods and services); PTO Office Action, U.S. Application No. 86,479,784, Mar. 4, 2015 (refusing registration of I CAN’T BREATHE for clothing). In the opinion below, the Federal Circuit affirmed the TTAB’s refusal to register the mark EVERYBODY VS RACISM. In failure to function analysis, are courts essentially engaging in a secondary meaning analysis or are their concerns broader?

[The opinion in *In re GO & Associates, LLC* is available separately.]

[The opinion in *In re Lizzo* is available separately.]

Comments and Questions

1. For more on the “failure to function as a mark” bar to protectability, see Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977 (2019). See also Lucas Daniel Cuatrecasas, *Failure to Function and Trademark Law’s Outermost Bound*, 96 N.Y.U. L. REV. 1312 (2021) (describing numerous inconsistencies in TTAB failure to function case law and urging that failure to function doctrine be replaced by aesthetic functionality doctrine to focus not on consumer perception, but on whether exclusive rights in the asserted mark “would significantly hinder competition in the relevant market”); Lisa P. Ramsey, *Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law*, 104 IOWA L. REV. ONLINE 70, 89 (2020) (“Allowing trademark registration and protection of puns, political and social messages, culturally important terms or images, and other common words or designs for expressive merchandise can chill and suppress the speech of competing manufacturers, print-on-demand companies, and others who want to display this language on products sold to people who desire these goods because of the ideas they convey.”).

2. Can survey evidence overcome a failure to function refusal? What survey format would be appropriate? See R. Charles Henn Jr., *Survey Methodologies to Overcome “Failure to Function” Refusals in the U.S. Patent and Trademark Office*, 114 TRADEMARK REP. 560 (2024).

Further Examples of Abercrombie Classifications

Provided here are numerous examples of courts’ classification of trademarks’ distinctiveness along the *Abercrombie* spectrum. You are very strongly encouraged to determine your own view on the appropriate classification before you consult how the court ruled. Do any of the following classifications strike you as incorrect?

- TIDE for laundry detergent. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210 (2000) (giving TIDE for laundry detergent as an example of a suggestive mark).
- SERIAL for “entertainment in the nature of ongoing audio program featuring investigative reporting, interviews, and documentary storytelling.” See *In re Serial Podcast, LLC*, 126 U.S.P.Q.2d 1061 (TTAB 2018) (finding the applied-for standard character mark to be generic but finding the applied-for logos incorporating the term to possess acquired distinctiveness and qualify for protection)
- THE STORK CLUB for a restaurant. See *Stork Restaurant v. Sahati*, 166 F.2d 348, 355 (9th Cir. 1948) (finding the stork club to be arbitrary as to a restaurant and reasoning that “[i]t is in no way descriptive of the appellant’s night club, for in its primary significance it would denote a club for storks. Nor is it likely that the sophisticates who are its most publicized customers are particularly interested in the stork.”).

- GOOGLE for internet search service. See GILSON § 2.04 (giving GOOGLE for search engine as an example of a fanciful mark).
- SNAKELIGHT for a light with a flexible neck. See *Black & Decker Corp. v. Dunsford*, 944 F. Supp. 220 (S.D.N.Y. 1996) (finding the mark to be descriptive and reasoning that “Snakelight” is just what it says: a ‘snake-like’ light. In this context, the word ‘snake’ functions as an adjective, modifying the principal term, the generic noun ‘light.’ Taken as a whole, the name conveys the ‘immediate idea’ of the ‘characteristics’ of the product [citing *Abercrombie*]).
- CLOROX for bleach. See *Clorox Chemical Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702, 705 (D.N.Y. 1938) (“‘Clorox’ is a fanciful word, arbitrarily selected in no wise describes its ingredients.”).
- STREETWISE for street maps. See *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998) (“The district court ranked the Streetwise mark as suggestive, meaning that the term ‘suggested’ the features of the product and required the purchaser to use his or her imagination to figure out the nature of the product. We agree.”).
- SUPREME for vodka. See *Supreme Wine Co. v. American Distilling Co.*, 310 F.2d 888, 889 (2d Cir. 1962) (finding SUPREME for vodka to be descriptive on the ground that “[m]erely laudatory words, such as ‘best’, ‘outstanding’, or ‘supreme’ cannot of their own force indicate the source or origin of the labeled goods”).
- PLAYBOY for a men’s magazine. See *Playboy Enters., Inc. v. Chuckleberry Pub., Inc.*, 687 F.2d 563, 566-67 (2d Cir. 1982) (finding the mark to be suggestive and reasoning that “Playboy is defined in the Random House Dictionary of the English Language (unabridged ed. 1966) as ‘a wealthy, carefree man who devotes most of his time to leisure, self-amusement, and hedonistic pleasures, conventionally frequenting parties and night clubs, romancing a rapid succession of attractive young women, and racing speedboats and sports cars.’ Although the word may signify the aspirations of PLAYBOY’s readership, it does not describe the product or its contents.”).
- NO NAME for meat and other food products. See *J&B Wholesale Distributing, Inc. v. Redux Beverages, LLC*, 85 U.S.P.Q.2d 1623, 1626 (D. Minn. 2007) (“[S]tanding alone, ‘No Name’ does not bear any relation to the product—that is it does not tell the consumer anything about the product. The Court thus finds that ‘No Name’ is an arbitrary mark that is entitled to protection.”).
- BAIKALSKAYA for vodka produced in the Lake Baikal region of Russia, where “Baikalskaya” means “from Baikal” in Russian. See *In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305 (TTAB 2006) (finding BAIKALSKAYA for vodka to be primarily geographically descriptive).

- KODAK for photographic film. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210 (2000) (giving Kodak for film as an example of a fanciful mark).
- GLOW for fragrance, shower gel, and body lotion products. See *Glow Indus., Inc. v. Lopez*, 252 F. Supp. 2d 962, 978 (C.D. Cal. 2002) (finding GLOW suggestive as to perfume and reasoning that “[t]he mark does not directly describe the attributes of Glow, Inc.’s perfume. Indeed, words other than the GLOW mark are used on the packaging to convey the fact that the perfume is a sandalwood scent. The mark thus appears to refer suggestively to the positive feeling one will achieve by using the product.”); *id.* at 979 (finding GLOW suggestive as to shower gel and body lotion and reasoning that “‘Glow’ is not descriptive of the qualities or characteristics of shower gels or body lotions. Indeed, one who hears the word does not immediately think of such products. Rather, some amount of association is required to link the concept of glowing skin to use of a particular gel or lotion.”).
- BRICK OVEN PIZZA for frozen pizza. See *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971 (8th Cir. 2006) (citing industry usage, media usage, and PTO rulings to find the term generic for pizza that is or appears to be baked in a brick oven).
- CITIBANK for banking services. See *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 222 U.S.P.Q. 292 (11th Cir. 1984) (approving of the district court’s finding that CITIBANK is suggestive for banking services).
- ODOL for mouthwash. See *In re Odol Chemical Corp.*, 150 U.S.P.Q. 827 (TTAB 1966) (finding ODOL for mouthwash to be fanciful).
- MORNINGSIDE for financial services. See *Morningside Group Ltd. v. Morningside Capital Group L.L.C.*, 182 F.3d 133 (2d Cir. 1999) (finding MORNINGSIDE to be arbitrary as to financial services).
- EAST END for vodka distilled in the East End of Houston, Texas. See *In re Buffalo Bayou Distilleries, LLC*, Serial No. 86,583,137 (TTAB July 30, 2018) (not citable as precedent) (“In this case, the record reflects that ‘East End’ can refer to numerous geographic locations, suggesting that its primary significance is not referring to the area in Houston, Texas. Also, the quantity and nature of the evidence regarding the East End of Houston does not establish that it is generally known to U.S. consumers. . . . The first prong of the inquiry under Section 2(e)(2), that the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, is not satisfied.”).
- NUMBER ONE IN FLOOR CARE for vacuums. See *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1360, 57 U.S.P.Q.2d 1720 (Fed. Cir. 2001) (finding the mark NUMBER ONE IN FLOOR CARE for vacuums to “generally laudatory . . . and thus . . . not inherently distinctive”).

- MARCH MADNESS for annual basketball tournament. See *March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786 (N.D. Tex. 2003) (finding without analysis the mark MARCH MADNESS to be descriptive of an annual basketball tournament).
- SPEEDY for bail bond services. See *Lederman Bonding Co. v. Sweetalia*, 83 U.S.P.Q.2d 1660, 2006 WL 2949290, at *3 (D. Colo. 2006) (finding SPEEDY for bail bond services to be descriptive “because it describes the quality of the bail bond services offered”).
- BEAR for cold-weather outerwear. See *Bear U.S.A., Inc. v. A.J. Sheepskin & Leather Outerwear, Inc.*, 909 F.Supp. 896, 904 (S.D.N.Y. 1995) (“The word ‘bear, especially in conjunction with the image of a polar bear, is connected with the concept of cold weather and protection from the elements. It suggests that the type of outerwear and boots sold by plaintiff offer the sort of protection afforded by bears’ skins. The imagination and thought process involved in this mental association supports the conclusion that plaintiff’s bear marks are suggestive, particularly as used in connection with boots and cold weather outerwear.”).
- QUANTUM for a health club. See *Quantum Fitness Corp. v. Quantum Lifestyle Ctrs.*, 83 F. Supp. 2d 810, 820 (S.D. Tex. 1999) (finding QUANTUM to be arbitrary for health club and reasoning, in part, that “[t]he absence of a connection between the term ‘quantum’ and the plaintiff’s products is evidenced by the frequent use of the word by third parties in a variety of different, unrelated lines of business”).
- VIAGRA for an erectile dysfunction drug. See *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 520 (S.D.N.Y. 2009) (“The Viagra mark is fanciful, because the word ‘Viagra’ was coined specifically for purposes of this trademark and has no meaning outside this context.”).
- Each of 928, 924, 944, 911, 911S, and 911SC for automobiles. See *Porsche Cars N. Am., Inc. v. Lloyd Design Corp.*, 2002 U.S. Dist. LEXIS 9612 (N.D. Ga. Mar. 26, 2002) (“[M]ost courts have held that model numbers, whether numbers or alphanumeric designations, are generally considered descriptive for the purposes of trademark protection. Although they may be ‘arbitrary’ in the sense ‘that they do not refer directly to a characteristic of the products, model numbers are generally intended merely to distinguish one specific product from another by a particular source, and are not intended to distinguish products from totally different sources.”).