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## Lexical properties: trademarks, dictionaries, and the sense of the generic

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### **Lexical properties: Trademarks, dictionaries, and the sense of the generic<sup>1</sup>**

The theme of this special issue invites reflection on the role played by techniques, practices or equipment of various kinds in the fabrication of intellectual property. Our contribution focuses on the fabrication of the legal form of the trademark. Leaving aside the case of pharmaceuticals, scholars interested in the commodification of scientific knowledge have not yet paid as much attention to trademarks as they have to patents, despite the fact that brands (and hence trademarks) often play a significant role in the constitution of corporate form and the securing of market positions. Here, we address the question whether or to what extent trademarks give their holders rights of ownership and control over ordinary language. Trademarks do not necessarily subtract from the available stock of words. A brand name such as 'Apple' adopts a common noun, but it does so without encroaching on the everyday use of that noun; indeed, if the dominant legal theory of trademarks is right, the transformation of 'apple' into a proprietary term adds a sense that is free for all to use (for non-commercial purposes). Trademarks are liable to lapse into genericity, and hence to become non-proprietary common nouns; the best examples are words such as 'thermos', 'cellophane', 'frisbee', and 'escalator'.

Trademark holders are obviously alert to the danger of a lapse into genericness, and this attentiveness gave rise to the particular co-implication of technique and property that we explore in this article. We focus on the story of how in the middle decades of the twentieth century the techniques of the modern discipline of lexicography were drawn into a debate over the rights of trademark holders. In doing so, we follow dictionaries rather than legal texts or jurisdictions, and the specific trajectories of Webster's International and the Oxford English Dictionary traverse the Atlantic, tacking between British and US trademark law.

### **The dictionary as law book**

Dictionaries, the end products of lexicographical technique, have long been an essential resource for trademark litigation and trademark bureaucracies. The recollection of a leading English intellectual property barrister, who apparently won a trademark case by finding a contested mark in the Webster's Dictionary, which he had "laboriously carted to Court and to the House of Lords,"<sup>2</sup> illustrates the authority that dictionaries could exercise in trademark cases.<sup>3</sup> The primary use of dictionaries was to determine whether a mark was, or had become, descriptive of goods and services, and some older English cases characterised that exercise in terms of a defence of the public domain of language.<sup>4</sup> More significant, perhaps, was the routine use of dictionaries in patent and trademark offices, where they were frequently consulted in the analysis of trademark applications, again to determine whether a term was sufficiently distinctive or 'fancy' to qualify as a trademark.<sup>5</sup> Intellectual property offices on both sides of the Atlantic were ergonomically designed in such a way that dictionaries were always ready to hand (see Fig 1).



**Fig 1: A Trademark Examiner at the Patent Office.**

**From *A Century of Trade Marks* (1976). Crown Copyright**

Given that objections raised by trademark examiners at the Patent Office could depend on which dictionary they consulted, practitioners in Britain became increasingly concerned to know which dictionaries were instituted as ‘works of reference’ in the Patent Office.<sup>6</sup> In the mid-1960s, the professional association of trademark agents in Britain, ITMA, complained to the Patent Office that its trademark examiners were overly dependent on *Webster’s International Dictionary*. The Office used *Webster’s* in order to maintain consistency,<sup>7</sup> but some trademark agents objected that *Webster’s* was “an American dictionary containing a very large number of words not in use in Britain and also containing definitions that were not in accordance with those contained in the *Oxford English Dictionary*.”<sup>8</sup> As we shall see, the distinguishing feature of *Webster’s Third* was that it purported to record language as it was actually used.<sup>9</sup> In January 1966, the Office reluctantly agreed to trial period in which the performance of *Webster’s* would be tested against that of the *Shorter Oxford English Dictionary*.<sup>10</sup> The ITMA facilitated the exercise by donating two copies of the *Shorter Oxford English Dictionary* to the Office.

There were some suggestions that the Office had not actually used the Oxford dictionaries,<sup>11</sup> but the assistant registrar of trademarks, RL Moorby, reported in the summer of 1966 that the trial of the two dictionaries had been concluded. The report suggested that ‘in approximately 85% of the cases examined the objections would have been the same, or broadly the same, whether based on *Webster’s* or on the *Shorter Oxford Dictionary*’.<sup>12</sup> Looking the remaining 15% of cases, he concluded that if examiners had used the Oxford dictionary they would either have missed pertinent objections or would have wasted time tracing the references they would have found. So *Webster’s* was simply the most efficient of the two dictionaries.<sup>13</sup> Over the next few decades, trademark agents were kept informed as to which dictionaries (and which editions) were used in the Office.<sup>14</sup> Incidentally, this ‘inside’ knowledge consolidated the claims to expertise of trademark agents, who were sensitive to the perception that

that they were second class citizens in the world of intellectual property law and practice.<sup>15</sup>

On the other side of the relation between lexicography and law, lexicographers had long been engaged with the question of whether or how to enter trademarks in dictionaries. In the early 1920s, Henry Watson Fowler, who was responsible for the celebrated *Dictionary of Modern English Usage* (eventually published in 1926), the first *Pocket Oxford Dictionary* (1924), and the second edition of the *Concise Oxford Dictionary* (1929), was developing a policy for dealing with ‘proprietary terms’; that is, patent names, proprietary names and registered trademarks. Fowler compiled a list of “dangerous words” that “ought to be” in every dictionary.<sup>16</sup> The list contained more than 80 words “of the patent and trademark kind” – including Bovril, aspirin, Harris Tweed, gramophone, helicopter and Oxo – which had to be treated cautiously because they might be “proprietary or not.” The exercise made Fowler feel “like a mouse conscious of traps on all sides’; “how,” he complained, “is the wretched lexicographer to know which of these may be safely touched and which may not?”<sup>17</sup> While the holder of a patent might relish the publicity that might come with being included in a dictionary, trademark holders would be concerned about genericness.<sup>18</sup> Although Fowler did not believe that editors had a duty to include ‘dangerous’ words, he generally thought it justifiable to do so. The risks were not inconsiderable. Lexicographers were conscious of the dangers of “declar[ing] a word to be proprietary when the Courts have not decided so,”<sup>19</sup> and the costs became apparent when the plates for the *Shorter Oxford English Dictionary* had to be altered after objections were made by the Kodak Company.<sup>20</sup>

Besides having to reckon with ‘dangerous words’, lexicographers were sometimes called upon to act as expert witnesses in trademark cases.<sup>21</sup> An exemplary figure here was Kemp Malone,<sup>22</sup> an American philologist who had collaborated with

Clarence Barnhart in the making of the first Random House dictionary in the 1940s.<sup>23</sup> His interest in how new words were added to the English language led him to study trademarks and cases concerning the meaning of words. His first lexicographical work on a legal case had to do with the definition of ‘mahogany’.<sup>24</sup> In common with many of his colleagues in mid twentieth-century lexicography, Malone took everyday usage as the best guide to meaning.<sup>25</sup> Malone acted as an expert witness in trademark cases over the course of more than four decades, including some of the most significant cases of ‘genericism’ in the US, notably ‘cellophane’,<sup>26</sup> ‘cola’,<sup>27</sup> ‘thermos’,<sup>28</sup> and ‘fritos’.<sup>29</sup> Although surveys and opinion polls had become important resources for trademark litigation,<sup>30</sup> they were often corroborated – or contested – by the testimony of experts such as Malone.<sup>31</sup> In his depositions, advisory notes and affidavits, Malone often referred to ‘word frequency lists’, newspaper usage and dictionary entries.<sup>32</sup> But dictionaries seem to have been his central forensic resource, and the expertise he deployed was derived from his work on dictionaries which sought to record contemporary language usage. He emphasised the fact that these dictionaries “ordered things differently.”<sup>33</sup> The “big Webster” – as he called to Webster’s *Third* – was his favoured source.<sup>34</sup> According to Malone, the *Third* had deservedly acquired “the reputation ... of being the most nearly complete dictionary of the English language published in this country” because it “covered more ground than an ordinary dictionary,”<sup>35</sup> and he took the fact that a word appeared in Webster’s as a sign that a mark might have become ‘generic’.<sup>36</sup> The very fact that the word thermos was *there*, in the dictionary, all but proved that it had become generic.<sup>37</sup>

### **Taking on lexicography**

For all these reasons, trademark holders kept a close watch on dictionary entries. In 1941, the Cracker Jack Company, which manufactured a brand of popcorn, objected to the entry for ‘crackerjack’ and ‘Cracker Jack’ in the *Dictionary of American English*. Observing that “Cracker Jack, when used as two words, is a fanciful, arbitrary and distinctive mark that we have used for very nearly fifty years for a popcorn confection, and it is our trademark, registered in the U.S. Patent Office a number of years ago,” the lawyer representing the Company wrote to the Chicago University Press insisting that the editors should “eliminate the description of the term CRACKER JACK.”<sup>38</sup> The Press ultimately acceded to these demands, but in the course of internal discussions the editors of the dictionary noticed that the generic definition had been withdrawn from the 1934 edition of Webster’s Unabridged Dictionary: “The method of handling the term in the 1934 Webster leads me to imagine that the Webster people had been protested to by the candy people and that as a result they took the easiest way out by omitting this sense from their dictionary.”<sup>39</sup>

The case of DuPont’s ‘cellophane’ trademark brought the question of genericity to the fore.<sup>40</sup> In support of its action against a competitor for infringements of its trademark for ‘cellophane’, DuPont relied on the results of a consumer survey carried out by an advertising agency, which asked 17 000 magazine subscribers to identify which of a list of ten terms were trademarks; seventy-two percent of respondents identified Cellophane as a trademark.<sup>41</sup> The defendants also commissioned a survey which suggested that consumers understood the refer to product qualities.<sup>42</sup> In finding for Du Pont, the trial judge disregarded both surveys but observed that “if any of the evidence of the surveys is admissible, then the plaintiff’s survey, which fairly presented the question, shows that an overwhelming number of those who answered knew of



“Cellophane” as a trade-mark.”<sup>43</sup> On appeal, it was held that the judge had been wrong to hold that the question of genericity ‘did not depend on what was in the consumer’s mind’, but rather on the question whether Du Pont had ‘abandoned’ its mark. The appeal court held that Du Pont’s own advertising strategy had resulted in the term ‘cellophane’ becoming a description of cellulose products in general rather than DuPont as a particular producer.<sup>44</sup> Du Pont was undone by its own promotional literature:

A survey by the defendant among retail dealers indicated that 88 per cent of them knew no other name than cellophane which they could use if they wished to buy the particular article. The accuracy of their answers is confirmed by the statement in the *DuPont Magazine* of June, 1929: “Say ‘Cellophane’ to the next person you meet, and the chances are he or she will at once think of a wrap for packages of candy, bacon and the like. This is because people readily associate the product with its best known use as a means of keeping merchandise protected and yet completely visible.”<sup>45</sup>

Neither decision turned on the dictionary definition of ‘cellophane’. However, the appeal court’s emphasis on the question of consumer usage or understanding highlighted the potential of dictionaries as resources for trademark litigation and alerted lawyers of the implications of the new lexicography.<sup>46</sup>

In 1957, the United States Trademark Association (USTA) formed a Dictionary Listings Committee.<sup>47</sup> Its remit was to survey the lexicographical presentation of trademarks, and to challenge publishers to remove or revise dictionary entries which suggested that trademarks had entered current usage as generic terms. The work of the committee was entirely consonant with the role that Association had assigned to itself

from its foundation in 1878,<sup>48</sup> and it can be seen as a complement to the broad strategy of trademark management and policing that characterised trademark law in the second half of the twentieth century.<sup>49</sup> The practical implications of this strategy were set out in the Association's influential guide for trademark holders: *Trademark Management, A Guide for Businessmen* (1955). The book offered practical advice on how to enhance the value of a brand name,<sup>50</sup> and it claimed that systematic policing and surveillance would give a trademark holder the ability to add value to their trademarks 'both at home and abroad'.<sup>51</sup> It may be that this idiom of management and policing encouraged trademark owners to believe that their legal rights were greater than they actually were.

The formation of the Dictionary Committee was not the Association's first engagement with lexicography. For example, cognisant of the dangers of genericity, the Association had successfully lobbied for the implementation of a recommendation of the Commissioner of Patents that trademark names should not be used in patent specifications unless proper credit was given to their owners.<sup>52</sup> The Association had also tackled lexicographers and their publishing houses on various occasions before 1955. In 1948 the Association pressed for corrections to be made to Random House's *American College Dictionary* (1947). This particular dictionary was edited by the lexicographer Clarence Barnhart, who had 'a keen interest in new words and new usage in the English language',<sup>53</sup> and it included a number of trademarks that were, according to the USTA, 'misused in a way to give these marks generic meanings'. Just a few months after the publication of the dictionary, the association secured the publisher's agreement to correct the relevant entries in all future editions.<sup>54</sup>

The USTA had also taken an interest in the work of lexicographers in Great Britain. In December 1933, the Association sent a letter to the *Oxford English Dictionary* offering a solution to the question of trademarks in dictionaries.<sup>55</sup> It asked the editor to include references to the ownership of trademarks so as to avoid any

implication that the words were in the public domain.<sup>56</sup> According to the Association, ‘the inclusion of a trademark in a dictionary, without explanation, stamped it as a generic term’.<sup>57</sup> The letter included a list of trademarks, which identified the owner of each mark and proposed a definition that was acceptable to the USTA. For some marks, such as ‘Vaseline’, the Association suggested that if the given definition was not satisfactory, the word should be eliminated entirely from the dictionary. The editors’ response was succinct and diplomatic, but contained a clear warning: ‘we are not willing to accept definitions from the firms concerned’.<sup>58</sup> Kenneth Sisam, who was in charge of developing lexicographic strategy at the Oxford University Press, was unimpressed by the deferential approach taken by Webster on the other side of the Atlantic.<sup>59</sup> Before he replied to the Association’s letter, Sisam confided to a colleague that he had been sent ‘a horrid list of trademarks’ and stated that ‘we refuse absolutely to take definitions which firms like the Vaseline concern try to impose upon us’.<sup>60</sup>

Suggesting that “it was Webster’s ignorance of the law which got us into so much trouble,”<sup>61</sup> Sisam observed that some firms had been able “to make Webster do pretty well what they liked, and compelled them to omit or to insert in a prescribed form.”<sup>62</sup> As it happens, the definition of ‘tabloid’ in Webster’s *New International Dictionary* was written by Burroughs Welcome, the pharmaceutical company, and had been included despite the editors’ initial doubts as to its quality.<sup>63</sup> Oxford University Press dictionaries, on the other hand, tried to avoid using the expression ‘registered trademark’ in their entries, since this was, according to Sisam, a “question of fact.”<sup>64</sup> They preferred to use the ambiguous term ‘proprietary’ on the basis that it was for the courts, not the editor, to decide on the legal status of words.<sup>65</sup> Sisam took particular notice of a patent and trademark medicine case decided in the House of Lords, *Irving’s Yeast-Vite Ltd v F A Horsenail* (1934), in which the exclusive use of a trademark was limited to its use “upon or in connexion with the goods in respect of which it is registered.”<sup>66</sup> The use of a competitor, inscribing his goods as “a substitute

for Yeast-Vite” was held to be legitimate. Sisam saw that decision as an indication that the Oxford dictionaries’ policy was correct, since the status of trademarks could be challenged and limited in court. Referring to trademark owners, he suggested that the Secretary of the Dictionary should not to bother about “the people who worry us.”<sup>67</sup>

The work of the Dictionary Listings Committee was not straightforward, not least because forthcoming dictionary entries were often kept confidential,<sup>68</sup> but it soon settled on a strategy for dealing with problematic dictionary entries. The first step was to send letters to dictionary publishers. The second was to arrange personal appointments with editors and publishers to discuss corrective measures: “to get lexicographers to properly list and designate trademarks.”<sup>69</sup> As a pre-emptive strategy, the committee embarked on an educational programme; it compiled a ‘master file’ which lexicographers could consult to ascertain the proprietary status of words that they proposed to list in their publications.<sup>70</sup> The primary objective of the committee was to persuade lexicographers to omit trademarks from their dictionaries. If they failed in that objective, they would try to convince editors to enter trademarks according to a formula prescribed by the Association; a mark should be listed as “a brand *of*,” and thereafter referred to as “a brand *for*.”<sup>71</sup>

### ***Webster’s Third***

The publication of Webster’s *Third New International Dictionary* in 1961 presented the committee with a defining challenge.<sup>72</sup> The third edition of *Webster’s*, which was compiled under the aegis of Philip Gove, exemplified a new style of lexicography, informed by the insights of ‘structural linguistics’, or the science of ‘observing precisely what happens when native speakers speak.’<sup>73</sup> In this spirit the compilers looked to newspapers, television shows and presidential speeches for evidence of the course of native speech.<sup>74</sup> The results did not meet with universal approval. In October 1961, two

months after the publication of the third edition, an editorial in the *New York Times* complained that “Webster’s has, it is apparent, surrendered to the permissive school that has been busily extending its beachhead on English instruction in the schools.”<sup>75</sup> Many critics were affronted by the inclusion of slang and vernacular terms – the entry for ‘ain’t’ attracted particular attention – and were disappointed that the compilers of *Webster’s Third* had not lived up to the duty of any responsible dictionary editor, which was to identify correct or proper usage.

Gove explained that the design of *Webster’s Third* was also based on practical – or ‘mechanical’ – considerations:

When it became practically indisputable that the physical bulk of the Second Edition with its 3393 pages and its thickness of five inches could not expand enough to take in 50,000 new words and 50,000 new senses of old words, a number of relevant editorial decisions had to be made.<sup>76</sup>

Gove’s conclusion was that the new edition could not be based on the earlier model of the ‘general dictionary’, incorporating historical, geographical, biographical, and literary material that might more properly belong to the province of the encyclopaedia: “a one-volume dictionary and encyclopedia combined is not feasible.”<sup>77</sup> The relative economy of the third edition – which managed to include 100 000 new words or senses in its 2,662 pages<sup>78</sup> - was achieved by including only ‘lexical’, as distinct from ‘non-lexical’, material. The preface to the new edition explained that it confined itself “strictly to generic words and their functions, forms, sounds, and meanings as distinguished from proper names that are not generic. Selection is guided by usefulness.” As Gove explained it, “If a dictionary restricts itself by design to the generic vocabulary, a consulter who looks in it for no generic information is asking it to perform a service for which it was not built.”<sup>79</sup>

Trademark lawyers immediately perceived this new lexicographical approach as a threat to leading successful marks. The difference between the proper and the generic in lexicography seemed to map almost exactly on to the difference between the brand name ‘for’ a product and the generic name of a product. The directive issued to the editorial staff of *Webster’s Third* stipulated that “brand names and trademarks that have not become generic will be arbitrarily omitted as nonlexical.”<sup>80</sup> Shortly before publication, Gove explained the policy to the Kemp Malone:

We plan not to enter into any of our [Merriam-Webster] dictionaries a trademark known to us to be such without identifying it in some way as a trademark. We intend however to reflect usage, and if we have evidence that seems to show wide current usage, we feel we must enter it whether or not the registered owner concurs.<sup>81</sup>

For the trademark holders and their legal representatives, the privileging of ‘usage’ threatened to dissolve their proprietary rights. The danger was inherent in the very form of the dictionary entries: “trademarks were lowercased to generic words.”<sup>82</sup>

When the Dictionary Listing Committee canvassed the members of the Association for advice on how to proceed, William Glasgow Reynolds, the legal representative of DuPont, recommended that a special team be appointed to review the trademarks included in *Webster’s Third*.<sup>83</sup> The members of the team drove out to Springfield, Massachusetts to meet Gove and members of the board of Merriam-Webster.<sup>84</sup> Both sides described the meeting as tense and difficult. The representatives of the Association expressed their unease at the idea that a dictionary could act as ‘judge and jury’; they argued that *Webster’s* was effectively “deciding the issue with respect to trademark use.”<sup>85</sup> They intimated that if *Webster’s* did not change its editorial policy,

the Association would convey its concerns to the courts, the Government Printing Office and other bodies that routinely consulted *Webster's* as an authority.<sup>86</sup>



**Fig. 2: Merriam-Webster's Offices (circa 1950s)**

In May 1962, the Association notified its members that its had reached a compromise with Merriam-Webster,<sup>87</sup> an outcome reported as follows:

The dictionary company was most cooperative, when protests were made to them, and, as result of excellent work by a special committee of the United

States Trademark Association, a compromise program was worked up so that future publications of this dictionary will include a treatment of trademarks quite different and much more acceptable than that which appeared in the first publication.<sup>88</sup>

The editors agreed to revise the preface, which disclaimed responsibility for any effect the dictionary might have on the validity of trademarks,<sup>89</sup> and they agreed to work with the Association to ensure that the definitions of trademark terms “will properly and lawfully reflect the trademark character of such trademarks as may be defined in that work.”<sup>90</sup> A few months later, the Association reported that it was satisfied with the presentation of trademarks,<sup>91</sup> which were now identified as such and restored to their capitalized form. The editors of Webster’s were accused of being “the most weaselly non-recorders of generic meanings of trademark terms,”<sup>92</sup> but the Association was fortified in its mission of securing trademark-friendly dictionary entries.<sup>93</sup>

Thirty years after it had been rebuffed by Kenneth Sisam, the Association made another approach to the Oxford University Press, this time by way of a letter from Harvey W. Mortimer, who introduced himself as a member of “an esoterically entitled committee, the Dictionary Listings.”<sup>94</sup> The committee’s work was, he explained, “of a missionary nature,” but its object was simply to initiate a discussion.<sup>95</sup> At the time, the Press was preparing the *Supplement* to the *Oxford English Dictionary*, edited by the New Zealander Robert Burchfield.<sup>96</sup> Unlike his predecessors, Burchfield was actually interested in trademarks. He wrote back to Mortimer saying that he “was very glad to have the material sent” because it arrived “in time to be considered for inclusion.”<sup>97</sup> Burchfield adopted the model proposed by the Association, and agreed that trademark terms would be entered “with a capital initial letter if we have ascertained that the registration [was] valid and [had] not lapsed.”<sup>98</sup> He subsequently became so interested



in trademarks that he began to investigate their history, searching the *Trademarks Journal* and the trademark register to ascertain the status of current marks,<sup>99</sup> corresponding with trademark lawyers, and publishing an essay in the *Transactions of the Philological Society* that touched on the topic.<sup>100</sup> A few years later he recalled the compromise reached between USTA and the Oxford University Press: “A fair balance was sought between etymological and definitional accuracy on the one hand and the legal property rights of owners of trademarks on the other.”<sup>101</sup> And the solution, according to Burchfield, was found because “we were prepared on our side to monitor the constantly changing status of particular trademarks in the appropriate patent offices and because the Association was willing to take a common sense view of linguistic facts.”<sup>102</sup>

### **The proper and the common**

What was really at stake in these skirmishes between law and lexicography? What was it about the mid-century turn to ‘everyday usage’ that engaged the trademark lawyer’s sense of genericity? One answer is that lexicography was in the front line of a contest over the public domain of ordinary language:

Dictionaries are responsible to the public for entering, defining, and illustrating words, and should do so in the public interest regardless of the harm it may do to a corporation’s profit or trademark ownership. A corporation can establish a right to use a word commercially, but it cannot own the word itself: the language’s users own the language; dictionaries simply register the deed.<sup>103</sup>

Some lexicographers understood things in these terms, even if their publishing houses were too readily intimidated by threats of legal action. For our purposes, however, the more interesting aspect of the encounter is the underlying structural tension between ‘genericity’ in law and the ‘genericity’ in lexicography. The new style of lexicography was dangerous not because the two senses of the generic were homologous, but because an apparent homology disguised a more fundamental difference.<sup>104</sup> The lexicographer’s sense of the generic, reinforced by the prestige that dictionaries had acquired in legal settings, threatened to short-circuit the more complex articulation of the singular and the generic that characterised trademarks.

According to Philip Gove, “the difference between the nonlexical and the lexical is chiefly the difference between the proper noun and the common noun.”<sup>105</sup> One way of making that difference was to distinguish “the meanings of *proper noun* (‘species of object containing only one specimen’) and *common noun* (‘species of object occurring in more than one specimen’).”<sup>106</sup> This division was carried through into the form of each individual entry; although a proper noun would rarely be entered as the definiendum [the term being defined] it might resurface as an ingredient of the definiens [the definition of the term].<sup>107</sup> Might it be overstating things to call this a ‘technique’? After all, the directive issued to the editors of Webster’s Third observed that the word ‘nonlexical’ had been “compounded, adopted, and manipulated arbitrarily as expedient editorial jargon to cover in its broadest sense all matter not accepted for inclusion in the 3<sup>rd</sup> ed.”<sup>108</sup> But this pragmatic distinction between the proper and common, the singular and the manifold, or the lexical and encyclopedic, threatened to occlude or supplant the trademark lawyer’s sense of signification.

In legal theory a trademark is an index of commercial provenance; a trademark tells the consumer that the product was produced under the auspices of a particular commercial operator. So a mark does not ‘describe’ the product to which it is apposed;

it functions as the commercial signature or “surrogate identity”<sup>109</sup> of its producer. On this basis, Gove characterized (non-generic) trademarks as non-lexical proper nouns; a species with one specimen. It followed that a mark became generic when in everyday speech it became a common noun, the name for a species with more than one specimen. But the logic of genericity in trademark law is more complex than this binary distinction between two species of noun allows. In legal theory, the commercial signature of the producer also denotes the product. A trademark also identifies a given product as the member of the ‘family’ of goods produced by the trademark holder, so that the mark is operates in two co-constitutive registers: “[T]he trademark does not identify or distinguish goods; it identifies and distinguishes the goods’ source, and identification of the goods’ source identifies and distinguishes in turn the goods themselves.”<sup>110</sup> And there is a broader purpose to this configuration. The object of twentieth-century branding and advertising was to offer “mass produced visions of individualism by which people could extricate themselves from the mass”,<sup>111</sup> and the legal theory of the mark honours that purpose by ascribing the aura of the unique to a multiplicity of identical manufactured artifacts. The double-jointed nature of the mark, as commercial signature and denotation of the product, allowed mass-produced consumer artefacts to be (in the lexicographical sense) both proper and common. This is what trademark scholars call the paradox of mimetic alterity,<sup>112</sup> or the logic through which individuals “distinguish themselves by means of the copies that they consume.”<sup>113</sup>

This paradoxical articulation was inherent in the basic legal test of genericity. One of the ironies of our story is that in the nineteenth century ‘Webster’s’ had itself become a generic term, but the ‘genericity’ to which Webster’s had succumbed was different from that which it was now supposed to be engendering.<sup>114</sup> According to the first major twentieth-century decision, which concerned the word ‘aspirin’, the question was “whether the buyers merely understood that the word ‘Aspirin’ meant this kind of drug, or whether it meant that and more than that; i.e., that it came from the same single,

though, if one please anonymous, source from which they had got it before.”<sup>115</sup> The crucial formula here – “that and more than that” – captures the double-jointed signification of marks. The case of aspirin was unusual because the American Medical Association’s rules concerning ‘ethical medicines’ meant that the drug was never advertised or sold to consumers as Bayer Aspirin, so the term had never functioned as a trademark.<sup>116</sup> The mark did not ‘lapse’ into genericity; as far as consumers were concerned, it had always been descriptive. The other leading twentieth-century cases, notably ‘cellophane’ and ‘thermos’, also had peculiar histories, so that although these cases conjured up the spectre of genericity, lawyers representing well-established and well-managed brands were probably less troubled by the jurisprudence underlying these decisions than by the prospect that dictionaries might consolidate their position as authorities on the definition of the generic.

The danger was compounded by another effect of the new lexicography. The ‘eavesdropping’<sup>117</sup> strategies of the new lexicography abstracted word marks from the signifiatory composites in which they were originally encountered or experienced. Words, the raw material of the lexicographer, are only one component of the ‘optical signature’<sup>118</sup> that expresses the contemporary brand. Even if a word is registered independently as a trademark, it will almost invariably be rendered as a logotype, or combined with one or more of the symbols, slogans, and jingles that go into the compose the advertised mark. Readers, listeners and viewers first encountered brands in this ‘original’ form, through the medium of advertisements. But brands also had another life in the mass media, which emerged from the ways in which they were noticed and glossed in newspapers, magazines and periodicals, recruited as components of the backdrop of reality against which novelistic fiction or satire could unfold,<sup>119</sup> or discussed in radio and television programmes. The lexicographical mid-century debate about ‘genericity’ was premised on this ‘second-order’ existence of brands in mass-medial culture, and this was precisely what Webster’s agents captured when they

listened in on broadcasts or scanned printed literature, or eavesdropped on the everyday conversations that had a similar abstractive effect on brands.

## **Conclusion**

From a sociological perspective, both trademark theory and lexicography offer only a partial understanding of how marks or brands function, precisely because they focus on semiosis or signification rather than social communication.<sup>120</sup> In the course of the twentieth century, trademarks came to ‘adhere’ to products not (only) because of their semiotic or semantic charge, but because the trademark was embedded in a complex social-technical configuration which articulated the relations between manufacturers, consumers, and mass-produced artifacts. What law and lexicography construed as relations of reference were actually ‘adherences’ generated by couplings between the vertically-integrated corporation, the production line, systems of long-range transport and distribution, techniques of packaging and labeling, and advertising as the means of ‘mass-producing’ consumers.<sup>121</sup> What is foreshadowed in the twentieth-century debate over genericity is the weaving of brands or logos into the very fabric of our medial-economic environment:

The mediatization of the life-world is nothing but a consequence of the process that Marx theorized as the ‘real subsumption’ of life under capital; the process in which capital enters the social fabric ‘vertically’ to penetrate its every fibre, to become part of the very basic, bio-political conditions of life itself. In this sense, the brand as a propertied frame of action is but one aspect of a general movement towards the commodification and capitalist appropriation of the bio-political framework in which life unfolds.<sup>122</sup>

Obviously, there is more to this than ‘genericity’, or everyday usage. ‘Meaning’ is not inherent in a mark or sign. It is produced by communicative processes or transactions that selectively draw brands out of the medial ‘commons’ into which they are woven, and use them as resources for self-presentation. Standardisation in this context is not an immediate effect of the semiotic form; it is a result of the routinisation of the ‘scripts’ that consumers use to ‘personalise’ mass-medial signs.<sup>123</sup>

In the latter part of the twentieth century, dictionaries became less prominent in cases concerning trademark genericity. The dictionary became a species of secondary evidence, the primary evidence being the consumer survey. The form of consumer surveys is itself interesting, notably the difference between a ‘Thermos survey’ and a ‘Teflon survey’. In one leading US decision, the difference is explained as follows:

[A] ‘Teflon survey’ [is] essentially a mini-course in the generic versus trademark distinction, followed by a test. That survey runs a participant through a number of terms (such as ‘washing machine’ and ‘Chevrolet’), asking whether they are common names or brand names. After the participant grasps the distinction, the survey asks the participant to categorize a number of terms, including the term at issue. A ‘Thermos survey’, on the other hand, asks the respondent how he or she would ask for the product at issue. If, to use the term under dispute in the case from which the survey gets its name, the respondents largely say the brand name (‘Thermos’) rather than the initial product category name (‘Vacuum Bottle’), the survey provides evidence that the brand name (‘Thermos’) has become a generic term for the product category. [The] term would be generic because the consumers would be using it to refer to the product category rather than a producer who makes products within that product category.<sup>124</sup>

It is unsurprising that the ‘Teflon survey’ should now be the more popular of these two forms, precisely because it teaches respondents to distinguish the two senses of a mark (producer signature and product denotation) and then to bring them together to form the trademark paradox of standardised uniqueness. And lexicographers have, it seems, found ways of reconstructing this paradox in linguistic or lexicographical terms. The theory is that ostensibly ‘generic’ terms actually have a synecdochal relation to the standardised product; the ‘part’ stands for the ‘whole’.<sup>125</sup> This is not to say that dictionaries no longer have a significant role to play in the law, management and bureaucracy of trademarks.<sup>126</sup> Although they play a lesser role in the adjudication of genericity, they are still an essential resource for the authors or composers of new marks, and for the examiners and tribunals that have to determine whether these new marks are true commercial signatures, or whether they might be taken as ‘descriptive’ of the goods themselves.

## Notes

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<sup>1</sup> The following abbreviations have been used: INTA (International Trademark Association, New York); ITMA (Institute of Trade Mark Agents, London); KM (Kemp Malone Papers; Stuart A. Rose Manuscript, Archives, and Rare Book Library, Emory University); KM2 (Kemp Malone Papers: Ms. 129; Milton S. Eisenhower Library, The Johns Hopkins University); NA (National Archives, Kew); RPC (Reports of Patent, Design and Trade Mark Cases); TMPDF Archives (Trade marks, Patents and Designs Federation

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Archives, London); OED (Oxford English Dictionary Archives; Oxford University Press); Wellcome (Archives and Manuscripts, Wellcome Library, London).

<sup>2</sup> Geoffrey Tompkin, *Chambers and Gossip* (London: unpublished paper, 1992), p.67. The case in question was *Electrolux Ld. v. Electrix Ld. And Another* [1953] RPC 70 (7), 127-140.

<sup>3</sup> See, for instance, *In the Matter of Lloyd and Sons' Trade Mark* [1893], RPC 10 (18): 281-283, at 282; *Burroughs Wellcome & Co.'s Trade Mark* [1904] RPC 21 (11): 217-230, at 221.

<sup>4</sup> *Paine's Trade Mark* [1892], RPC 9 (16): 130-134, 131 ["The words John Bull are part of the stock of the English language; the phrase might be found in any good dictionary"]; *Eastman Photographic Materials Company's Application* (1897) RPC 10 (18): 487-495, 489 ["The Act only aims at preventing any one from having a monopoly of words in the English language"]; see also Brewer & Son, *Property in Trade Marks* (London: Taylor & Francis, 1902), p.18.

<sup>5</sup> *Meyerstein's Application* [1890] RPC 7 (13): 114-116, at 115; *Bovril Trade Mark* [1896] RPC 13 (25): 382-392, at 390. In the UK, section 64(1)(c) of the 1883 Patents Act allowed "fancy words or words not in common use" to be registered. See also Jose Bellido and Hyo Yoon Kang, "In Search of a Trade Mark: Search practices and bureaucratic poetics" *Griffith Law Review* 25 (2016): 147-71. Similarly in the United States, it was considered that "the many advantages obtained by selecting an arbitrary and fanciful mark are at once apparent and avoid many of the difficulties which may arise in connection with 'weak' or descriptive marks," in J.H. Merchant "Trade-Marks – Past and Present" *Journal of the Patent Office Society* 36 (1954): 341-357, 350.

<sup>6</sup> In fact, many patent and trademark agencies developed libraries, clipping services and international bureaus that mirrored patent offices in order to construct business expectations around the acts of filing or opposing trademark applications; see Jose Bellido, "Towards a History of Trade Mark Watching," *Intellectual Property Quarterly* 2 (2015): 130-52.

<sup>7</sup> "Trade Marks Examination Section: Requirements of English and Other Dictionaries," 4 April 1962.

<sup>8</sup> GHS Ellis "Use of Webster's Dictionary at the Trade Marks Registry"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 25 May 1965; ITMA Archives.

<sup>9</sup> This difference was also made explicit in the framework of trademark litigation; see "TARZAN" Trade Mark [1969] FSR 271; 'Rotorake' Trade Mark' [1968] RPC 36.

<sup>10</sup> Meeting between J. Field (ITMA) and Ward Dyer (UK Patent Office) in "Webster's International Dictionary of the English Language"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 1 March 1966; ITMA Archives.

<sup>11</sup> "The Shorter Oxford Dictionary"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 12 July 1966; ITMA Archives.

<sup>12</sup> "Webster's International Dictionary of the English Language"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 27 September 1966; ITMA Archives.

<sup>13</sup> The predominant use of the *Webster's Third* as the basis for objections can be seen in many decisions from the 1960s; see, for instance, J. Owden O'Brien & Son (patent and trademark agents) to Taylor Reid & Co, 19 January 1961 ("we argued the application at some length with the Registrar but informed us that



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*Webster's International* defines the word 'Ductone' as denoting two colours or tones, and that therefore it was precluded from registering the mark, and accordingly the application was refused"); M471/3/1/52; Manchester Central Library.

<sup>14</sup> "Works of Reference"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 4 September 1979; ITMA Archives; see also "Trade Mark Registry – Works of Reference" *ITMA Newsletter* 60 (October 1979): 1. In fact, an updated version of the list of reference works offered parameters of a sort when it came to predicting the likely outcome of a trademark decision Works of Reference"; Minutes of Meeting of the Council of the Institute of Trade Mark Agents, 11 1979; ITMA Archives; see also 'Works of Reference' *ITMA Newsletter* 71 (December 1980): 1.

<sup>15</sup> While this is not the place to discuss this issue, such attitudes were often adopted towards and by patent agents and complicated the attempts of trade mark and patent practitioners to come together under a single professional body. See, for instance, M. K. Padmore "Letter to the Editorial Panel," *ITMA Newsletter* 10 (April 1975): 7-8.

<sup>16</sup> Note by HW Fowler, 6 March 1922, File Proprietary Names, OED Archives

<sup>17</sup> Note by HW Fowler, 12 March 1922, File Proprietary Names, OED Archives.

<sup>18</sup> Letter to CT Onions, 13 June 1922, File Proprietary Names, OED Archives.

<sup>19</sup> Letter from Humphrey Sumner Milford, 31 January 1930; File Proprietary Names, OED Archives.

<sup>20</sup> K. Sisam (Oxford University Press) to M. Strode (Patent Agent) 22 September 1933; OED Archives. It was a significant problem since "nowadays on account of printing costs alterations even on the galleys must be limited severely [...]." As cited in James Root Hulbert, *Dictionaries: British and American* (London: André Deutsch, 1955), p.84.

<sup>21</sup> Jerome Gilson, "Experts in Trademark Cases," *Litigation* 8 (1982): 40-57.

<sup>22</sup> Thomas Pyles, "Kemp Malone," *Language* 48 (June 1972): 499-505; T. Pyles, "Kemp Malone, Onomatologist," *Names* 21 (September 1972): 131-132.

<sup>23</sup> "Deposition of Dr Kemp Malone, 18 May 1970" in *Jay's Foods, Inc. v. Frito-Lay, Inc.*; p.29; Box 5 Folder 4; KM.

<sup>24</sup> *Black & Yates v. Mahogany Ass'n*, 34 F. Supp. 450 (D. Del. 1940). See also, for instance, Kemp Malone, "Observations on the Word 'Standard'," *American Speech* 17, no.4 (1942): 235-238; Kemp Malone, "Notes on the Word Mahogany," *Economic Botany* 19 (1965): 286-292.

<sup>25</sup> Compare Kemp Malone, "On defining Mahogany," *Language* 16, no.4 (1940): 308-318; "Deposition of Dr Kemp Malone, 18 May 1970" in *Jay's Foods, Inc. v. Frito-Lay, Inc.*; p.79; Box 5 Folder 4; KM.

<sup>26</sup> *Du Pont Cellophane Co., Inc. v. Waxed Prods. Co., Inc.*, 6 F. Supp. 859, 885 (E.D.N.Y. 1934), modified, 85 F.2d 75, 80 (2d Cir. 1936).

<sup>27</sup> *Dixi-Cola Laboratories v. Coca-Cola Co.*, 117 F.2d 352 (4th Cir. 1941). Although Coca-Cola paid Malone for the work, "they made no use of [his] results because it didn't fit in with what they wanted." "Deposition of Dr Kemp Malone, 18 May 1970" in *Jay's Foods, Inc. v. Frito-Lay, Inc.*; p.38; Box 5 Folder 4; KM.

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<sup>28</sup> *American Thermos Prod. Co. v. Aladdin Industries, Inc.*, 207 F.Supp. 9 (1962); see also Herbert C. Morton, *The Story of Webster's Third: Philip Gove's Controversial Dictionary and its Critics* (New York: Cambridge University Press, 1994), p.218.

<sup>29</sup> *Jay's Foods, Inc. v. Frito-Lay, Inc.*, 664 F. Supp. 364 (N.D. Ill. 1987).

<sup>30</sup> More than three decades after the famous cellophane trademark litigation, the last surviving attorney who represented DuPont, TW Stephenson, recalled how the litigation involved “two sets of public polls one from us and the other from the Waxed Products Company. Our poll showed that the public related the word – cellophane- solely to the DuPont Company and its transparent wrapping paper. The opposing poll showed that the public related the word solely to transparent wrapping paper regardless of who made it. The lower court chose our poll and declared the defendant to be an infringer of our valid trademark. The higher court took the position that the questions on our poll were couched in terms calculated to lead the witness into giving us favourable answers.” WG Reynolds to WH Depperman, 14 January 1970; DuPont Public Affairs Dept. Records (Acc 1410); Box 49, File “Cellophane Trademark Suit.”

<sup>31</sup> Malone's main professional contact with lawyers was established with Harry Nims, a New York lawyer who specialized in trademark law; see Paul David Blanc, *Fake Silk: The Lethal History of Viscose Rayon* (New Haven: Yale University Press, 2016), p.238.

<sup>32</sup> “Deposition of Dr Kemp Malone, 18 May 1970” in *Jay's Foods, Inc. v. Frito-Lay, Inc.*; p.130; Box 5 Folder 4; KM.

<sup>33</sup> These dictionaries frequently gave a first definition that was the one that fits “the most common use of the word” and they continued definitions following in descending order of frequency, and relegating etymology to the very end. Kemp Malone, ‘Dictionary Work’; Box 2; KM2.

<sup>34</sup> The third edition (1961) of *Webster's New International Dictionary of the English Language* was, according to him “a gigantic achievement in lexicography.” Kemp Malone, “Pronunciation in Webster's Third,” *Studies in Language and Literature in Honour of Margaret Schlauch* (Warsaw: PWN, Polish Scientific Publishers, 1966), 233-44. See also his continuing interest in this edition in VW Weidman to K Malone, 23 March 1962; Box 1; KM2.

<sup>35</sup> “Deposition of Dr Kemp Malone, 18 May 1970” in *Jay's Foods, Inc. v. Frito-Lay, Inc.*; p.53; Box 5 Folder 4; KM.

<sup>36</sup> “Defendant's Brief” in *The American Thermos Products Company v. Aladdin Industries, Inc* (1962); Box 5 Folder 7; KM.

<sup>37</sup> “Defendant's Brief” in *The American Thermos Products Company v. Aladdin Industries, Inc* (1962) p.28; Box 5 Folder 7; KM.

<sup>38</sup> Letter from Arthur L Stang, representing the Cracker Jack Company, to the University of Chicago Press, 28 April 1941, cited in Michael Adams, “Lexical property rights: trademarks in American dictionaries,” *Verbatim. The Language Quarterly* 30, no.4 (2005): 1-8, 8.

<sup>39</sup> Internal correspondence University of Chicago Press, cited in Adams, “Lexical property rights,” p.8 (note 38).

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<sup>40</sup> *Du Pont Cellophane Co., Inc. v. Waxed Prods. Co., Inc.*, 6 F. Supp. 859, 885 (E.D.N.Y. 1934), modified, 85 F.2d 75, 80 (2d Cir. 1936). The original suit run from 1932 to 1938 when the US Supreme Court refused to hear the case.

<sup>41</sup> The questionnaire included the following text: "I am trying to determine, for one of the leading advertisers of the country, how familiar our most intelligent magazine readers are with trade marked names. Will you help me by putting an `x' after each name given below which you look upon as a trade mark? You understand, of course, that a trade mark is a name or mark which indicates that the goods bearing this name or mark are manufactured or sponsored by one concern only." The terms were: Ammonia, Carbona, Cellophane, Cocomalt, Cologne, Iodine, Kodak, Silk, Postum, Vaseline. *Du Pont Cellophane v. Waxed Products* 6 F.Supp 859, 877 (1934), p.877.

<sup>42</sup> Householders were asked two questions: "(1) What does the word "Cellophane" mean to you? (2) Do you know of any other name than "Cellophane" which you could use if you wanted to buy that kind of material?" *Du Pont Cellophane v. Waxed Products* (1934), p.877.

<sup>43</sup> *Du Pont Cellophane v. Waxed Products* (1934), p.885.

<sup>44</sup> Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. I (Harvard University Press, 1975) p.1166. See also Ellis W. Leavenworth "Lost Monopolies" *Trademark Reporter and Bulletin* 32 (1937): 329. Leavenworth's article was reprinted in the *Trademark Reporter* after the second wave of case law on 'genericism' in the late 1960s; see *Trademark Reporter* 61 (1971), pp.28-35. What made Leavenworth's article attractive from the very beginning was that he had acted as lawyer for the defendant. DuPont was concerned by these partisan accounts of the case, which appeared not only in the *Trademark Reporter* but also in other newspapers; see Ellis W. Leavenworth, "Lost Monopolies of Names and Things," *Industrial and Engineering Chemistry*, September 1937, 1006; JK Hunt (DuPont's Publicity Department) to JW McCoy (vice-president), 20 September 1937; DuPont Public Affairs Dept. Records (Acc 1410); Box 49, File 'Cellophane Trademark Suit'.

<sup>45</sup> *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75, (2d Cir. 1936), p.80.

<sup>46</sup> *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75, (2d Cir. 1936) p 81.

<sup>47</sup> "Trademarks in Dictionaries," *The Trademark Reporter* 59 (1969): 735-753, 736-737.

<sup>48</sup> Now INTA (International Trade Mark Association). For a history of the association, see "INTA — 125 years of excellence," *Trademark Reporter* 93 (2003): 155; "Facts about USTA," in United States Trademark Association, *Trademark Management, A Guide for Businessmen* (New York: USTA 1955), p.120.

<sup>49</sup> See, for instance, Alan Brown, "The Trade Mark as an Instrument of Business Policy," *Journal of the Patent Office Society* 19 (1937): 96-107.

<sup>50</sup> John L. Esterhai and Norman St. Landau, "Proper Use of Trademarks," in United States Trademark Association, *Trademark Management, A Guide for Businessmen* (New York: USTA 1955), pp.43-56.

<sup>51</sup> Edgar S. Bayol, "Policing of Trademarks," in United States Trademark Association, *Trademark Management, A Guide for Businessmen* (New York: USTA 1955) pp.67-88.

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<sup>52</sup> Minutes of the United States Trademark Association, 4 January 1933; INTA Archives. See also Donald A. Kaul, “Trademarks and Trade Names in Patent Applications,” *Journal of the Patent Office Society* 45 (November 1963): 754.

<sup>53</sup> Wolfgang Saxon, “Obituary: Clarence Barnhart,” *The New York Times*, 26 October 1993. Interestingly, his son, David David K. Barnhart appeared as expert witness in some trademark cases; see *Blackhorse v. Pro-Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. June 18, 2014).

<sup>54</sup> Report of the President of USTA, 70th Annual Meeting; 23 April 1948; INTA Archives.

<sup>55</sup> A few months before the litigation arose in the United States, the Oxford University Press had received a letter from DuPont’s patent advisor, Frederick M. Pralatoski, 55 declaring that ‘Cellophane’ was a registered trademark of DuPont and soliciting cooperation in what he called “the proper use of the word.” He also recommended that the initial letter be “capitalized.” Frederick M. Pralatoski to Oxford University Press, 10 April 1931; OED Archives.

<sup>56</sup> L. E Daniels (USTA) to Clarendon Press, Murray’s English Dictionary Publishers, 4 December 1933; OED Archives.

<sup>57</sup> *Ibid.*

<sup>58</sup> K. Sisam to the Secretary (USTA), 16 December 1933; OED Archives.

<sup>59</sup> K. Sisam to Le Mesurier, 12 May 1938; OED Archives.

<sup>60</sup> K. Sisam to Le Mesurier, 15 December 1933; OED Archives.

<sup>61</sup> K. Sisam to Le Mesurier, 12 May 1938; OED Archives.

<sup>62</sup> *Ibid.*

<sup>63</sup> Their view was that it was defective “in not showing the etymology of the word or its etymological meaning.” G & C Merriam Company to Burroughs, Wellcome & Co, 16 November 1903; WF/L/06/194; Wellcome.

<sup>64</sup> K. Sisam to Le Mesurier, 16 May 1938; OED Archives.

<sup>65</sup> *Ibid.*

<sup>66</sup> *Irving’s Yeast-Vite Ltd v F A Horsenail* (1934) 51 RPC 110.

<sup>67</sup> K. Sisam to Wilford, 2 February 1934; OED Archives. Such a dismissive approach was, however, overridden by the enactment of the Trade Marks Act 1938, which, after successful lobbying by trademark owners, made comparative advertising illegal; see Robin Jacob, *IP and Other Things: A Collection of Essays and Speeches* (Oxford: Hart, Bloomsbury, 2015) p.81.

<sup>68</sup> Minutes of the Meeting, USTA, 7 December 1961; INTA Archives. The changes were introduced after the appointment of a new Executive Director, Miss Dorothy Fey, who, according to Robin Wolfe ‘was as instrumental in developing USTA from a “club” that assembled from time to time to address specific issues into a bona fide full-time association that actively promoted the role of trademarks as marks of trade in commerce’ in Robin Wolfe ‘In Memoriam: Dorothy Fey’ *INTA Bulletin*, Vol. 67 No. 18, 15

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October 2012; see also Dorothy Fey, 'Recollections of Daphne Robert Leeds' *Trademark Reporter* 72(1982): 454.

<sup>69</sup> Report of the USTA President, Annual Meeting, 1958; INTA Archives.

<sup>70</sup> Ibid.

<sup>71</sup> Report of the USTA President, Annual Meeting, 1959; INTA Archives.

<sup>72</sup> Minutes of Meeting, Executive Committee, 6 December 1961; INTA Archives.

<sup>73</sup> Philip B. Gove, "Linguistic, Advances and Lexicography," p. 66.

<sup>74</sup> "New Dictionary Breaks Sharply with Tradition," *The Sunday Bulletin*, 24 September 1961. In "Webster's Third New International Dictionary Clippings," Box 1, Folder 10; University of Chicago Libraries.

<sup>75</sup> "Webster's new word book," *The New York Times*, October 12, 1961. As cited in James Sledd and Wilma R. Ebbitt, (eds.) *Dictionaries and That Dictionary* (Chicago: Scott, Foresman and Company, 1962), pp.78-79, at p.78.

<sup>76</sup> Philip B. Gove, "The nonlexical and the encyclopedic." *Names* 13 (1965): 103-115, 103.

<sup>77</sup> Gove, "The nonlexical and the encyclopedic," 108 (note 76).

<sup>78</sup> Miles Smith, "Old Webster Gets New Meanings," *The Daily Reporter*, 7 October 1961. In "Webster's Third New International Dictionary Clippings," Box 1, Folder 7; University of Chicago Libraries. See also Sidney I. Landau, *Dictionaries. The Art and Craft of Lexicography* (Cambridge: Cambridge University Press 2001) p.29.

<sup>79</sup> Philip B. Gove, "The dictionary's function," in Philip B. Gove (ed.), *The Role of the Dictionary* (New York: Bobbs-Merrill, 1967) pp.5-7, 5.

<sup>80</sup> Letter from Gove to Kemp Malone, June 30, 1960, cited in Morton, *The Story of Webster's Third*, p.219 (note 28).

<sup>81</sup> Ibid.

<sup>82</sup> J. Wendell Sether, "Trade-marks," *Forbes*, 15 May 1962. In *Webster's Third New International Dictionary*. Clippings; Box 3, Folder 9; University of Chicago Libraries.

<sup>83</sup> Minutes of the Executive Committee Meeting, USTA, 6 December 1961; INTA Archives.

<sup>84</sup> Morton, *The Story of Webster's Third*, pp.220-221 (note 28) .

<sup>85</sup> Minutes of the Meeting, USTA 7 March 1962; Report of the Study Committee on Webster's Third New International Dictionary; INTA Archives.

<sup>86</sup> Ibid.

<sup>87</sup> Morton, *The Story of Webster's Third*, p.222 (note 28); see also Israel Shenker, *Words and Their Masters* (New York: Doubleday & Co, 1974) p.346.

<sup>88</sup> "Trademarks in the Marketplace," *The Trademark Reporter* 53 (1963): 687-735, 692.

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<sup>89</sup> Action of the Board of Directors of USTA with respect to Webster's Third New International Dictionary, 1962; INTA Archives; see also "Trademarks in Dictionaries," *The Trademark Reporter* 59 (1969): 735-753, 737 and 753.

<sup>90</sup> Action of the Board of Directors of USTA with respect to the *Webster's Third New International Dictionary*, 1962; INTA Archives.

<sup>91</sup> Morton, *The Story of Webster's Third*, p.222 (note 28).

<sup>92</sup> Morton, *The Story of Webster's Third*, p.223 (note 28).

<sup>93</sup> "Mr Kunin gave a status report on his Committee Activities and stated that there were, at the present time, concentrating on the trademark policies of six major publishers." In Minutes of Meeting, 19 March 1964; INTA Archives.

<sup>94</sup> Harvey W. Mortimer to John Brown (OUP) 18 August 1966; OED Archives.

<sup>95</sup> Harvey W. Mortimer to D.M. Martin (OUP) 9 September 1966; OED Archives

<sup>96</sup> Peter Gilliver, *The Making of the Oxford English Dictionary* (Oxford: Oxford University Press, 2016) pp.453-549; Charlotte Brewer, "The Oxford English Dictionary Supplements," in A. Cowie (ed.) *Oxford History of Lexicography* (Oxford: Oxford University Press, 2008) pp.260-78; Alan Bell, "Scholarly and Reference Publishing," in William Roger Louis (ed.) *History of Oxford University Press: Volume III: 1896 to 1970* (Oxford: Oxford University Press, 2013) pp.325-90.

<sup>97</sup> Burchfield to Mortimer, 21 July 1972; OED Archives.

<sup>98</sup> Burchfield to Mortimer, 23 March 1973; OED Archives.

<sup>99</sup> Note from Burchfield, 23 October 1972; OED Archives.

<sup>100</sup> Robert W. Burchfield, "The treatment of controversial vocabulary in The Oxford English Dictionary," *Transactions of the Philological Society*, 72, (1973): 1-28.

<sup>101</sup> Robert Burchfield, "EEC versus OUP," *The Times*, 25 June 1981, p.14.

<sup>102</sup> *Ibid.* The tension still persists today, as reflected in European Union trade mark law; see art 12 of the current EU Trade Mark Regulation 2017/1001 (previously Art 10, CTMR 2009) and art. 12 of the Directive (EU) No. 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

<sup>103</sup> Adams, "Lexical property rights," p.5 (note 38).

<sup>104</sup> Cf. the notion that "As a term of art in lexicography, the meanings of both *generic* (as applied to individual words) and *trademark* are essentially borrowed from law." Ronald R Butters and Jennifer Westerhaus, "Linguistic change in words one owns: How trademarks become 'generic'" in Anne Curzan and Kimberley Emmons (eds.), *Studies in the History of the English Language. Unfolding Conversations* (Berlin: De Gruyter, 2004), pp.111-24, 111.

<sup>105</sup> Gove, "The nonlexical and the encyclopedic," pp.110-111 (note 76).

<sup>106</sup> *Ibid.*

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<sup>107</sup> See Gove, “The nonlexical and the encyclopedic,” p.110 (note 76): “[Nonlexical matter] comes into critical question in two forms: either (1) as a term to go in or out as a definiendum or (2) as information to become part of the definiens.”

<sup>108</sup> Gove, “The nonlexical and the encyclopedic,” p.104 (note 76).

<sup>109</sup> Rosemary Coombe, “Embodied Trademarks: Mimesis and Alterity on American Commercial Frontiers.” *Cultural Anthropology* 11:2 (1996), 202-24, 205.

<sup>110</sup> Barton Beebe, “The Semiotic Analysis of Trademark Law,” 51 *UCLA L. Rev.* 51 (2004): 621-704, 653.

<sup>111</sup> Stuart Ewens, *Captains of Consciousness: Advertising and the Social Roots of Consumer Culture* (New York: Basic Books, 1986), p.45.

<sup>112</sup> “As the mass-produced stamp of an author/ized site of origin that authenticates mass-produced goods bearing the trademark owner’s singular distinction, the mark might be seen as channeling the cultural energy of mimesis into the form of the signature – an attempt to appropriate it under a proper name. A commercial surrogate identity, the trademark maintains and garners exchange value in the market, alluring consumers in its endless uniformity with paradoxical promises of standardization and distinction.” Coombe, “Embodied trademarks,” p.206 (note 109).

<sup>113</sup> Barton Beebe, “Intellectual Property Law and the Sumptuary Code,” *Harvard Law Review* 123 (2010): 809-89, 837.

<sup>114</sup> This is explained in one of the later decisions concerning the term ‘Webster’s’ as applied to dictionaries: “... though the name Webster’s as applied to the Merriam Company’s dictionary had acquired a secondary meaning, indicating a particular book published and sold by them, it became public property when the copyright expired.” *G & C Merriam Co. v. Ogilvie* (1908) 159 Fed. (C. C. A.) 638, 640. The judge observed that Merriam Company’s (lapsed) right to exclusive use of the name came “by virtue of copyright rather than by virtue of its use in publication and in trade.” *Ibid.*, 640.

<sup>115</sup> *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921), 509.

<sup>116</sup> Diarmuid Jeffreys, *Aspirin. The Remarkable Story of a Wonder Drug* (London: Bloomsbury, 2004).

<sup>117</sup> See Morton, *The Story of Webster’s Third*, pp.126-28 (note 28).

<sup>118</sup> Niklas Luhmann, *The Reality of the Mass Media* (Cambridge: Polity, 2000).

<sup>119</sup> The classic early twentieth century example of this is Sinclair Lewis’s *Babbitt* (New York: Harcourt, Brace & Co., 1922).

<sup>120</sup> See Alain Pottage, “No (more) logo: plain packaging and communicative agency,” *UC Davis Law Review* 47, no.2 (2013), 515-46.

<sup>121</sup> See Thorstein Veblen, “Manufacture and salesmanship” in S. Mestrovic (ed.), *Thorstein Veblen on Culture and Society* (New York: Sage, 2003), pp.133-51.

<sup>122</sup> Adam Arvidsson, *Brands. Meaning and Value in Media Culture* (Oxford: Routledge, 2006), p.13.

<sup>123</sup> See generally Arvidsson, *Brands* (note 122).

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<sup>124</sup> E.T. Browne Drug Co. v. Cococare Products, Inc., 87 U.S.P.Q.2d 1655 (3d Cir. 2008).

<sup>125</sup> See Butters and Westerhaus, “Linguistic change,” p.118 (note 104): “[S]peakers will sometimes say *Kleenex* to refer to a paper tissue and *Xerox* to refer to a photocopying machine, even though the speakers know full well that the terms they have employed are brand names which are technically inexact terms for the items to which they are referring. Such a speaker is not seriously mistaking the part (*Kleenex*, *Xerox*) for the whole (paper tissues, photocopying machines), any more than the speaker who says *threads* to mean *clothes* seriously believes that *threads* refers by definition to the entire universe of garments.”

<sup>126</sup> Cf. the role of dictionaries of meanings of claims made in advertisements. See Richard J. Leighton, “Making puffery determinations in Lanham Act false advertising cases. Surveys, dictionaries, judicial edicts, and materiality tests,” *Trademark Reporter* 95, no.3 (2005): 615-641.