

**ENTREPRENEURS TAKE HEED: IT'S NOT JUST ABOUT THE RESULTS:
RE-EVALUATING THE RESULTS TESTS USED IN
IDENTIFYING VALUABLE SUGGESTIVE TRADEMARKS**

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I. INTRODUCTION

A. The Purpose of this Article – Clearing our Path (Regarding Trademarks)

Where I come from in Minnesota, there are many ways to get from my family's farm over to the lake. There is one path in particular that I have used ever since I was a young boy. I never gave much thought to how the path got there. I only knew that it suited my purposes, particularly if it was a hot day and I was in a hurry to get to that lake.

Long before I was born, someone went to the trouble of creating that path. Each time someone used it, it seemed to define that path's existence against the wilderness of the countryside. As I grew older, I seemed to pick up this attitude of responsibility for the path. So, if a tree branch fell, blocking the way, you simply made it your business to move it, so that the next person who came along could get to where they were going.

On a particularly beautiful day, the kind of day that lends itself to expansive thinking, you might get the feeling as you were walking that you were a part of a long procession, following in the footsteps of those who preceded you, leading the way for those yet to come. From where I stand here today, representing this proud group of men and women, I can see that we've been shown the way of another path.¹

This article is devoted to clearing a branch from the part of our path devoted to trademarks. Although it is not widely understood, trademarks vary greatly in terms of distinctiveness and strength. Over the last century, the courts have begun categorizing the different kinds of marks encountered in commerce, and patterns have begun to emerge regarding the ease with which they are protected and enforced. Trademark practitioners have come to recognize that descriptive trademarks are generally weaker, less distinctive, and harder to enforce in the courts. Suggestive trademarks, by contrast, are stronger, more distinctive, and readily enforced in litigation.

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¹ Joe S. Landon, THE PAPER CHASE, GRADUATION (S.4, Ep.6, Aug. 9, 1986) (commencement speech of protagonist law student James T. Hart on the study and practice of law).

Determining whether a trademark will be treated by the courts as descriptive or suggestive is a delicate business, and numerous heuristics have been developed over the years for facilitating that call. The “Results or Effects of the Goods” test is used by practitioners for distinguishing between descriptive and suggestive trademarks. The rule has been used for many years, and has been quoted approvingly in the U.S. Patent and Trademark Office’s (PTO’s) own official manuals of procedure, despite the fact that the courts have implicitly rejected the rule on numerous occasions. However, the uncertainty created by the rule constitutes a tax on the business community generally and on entrepreneurial businesses particularly.

Part I of this article introduces the reader to several important foundational concepts regarding trademarks that are necessary to an understanding of the principal thesis of the paper. Specifically, it introduces the reader to a well-established categorization of four kinds of trademarks (generic, descriptive, suggestive, and arbitrary/fanciful) that practitioners and the courts have employed for a very long time.² It also highlights the critical practical importance of distinguishing between two of the categories: *descriptive* trademarks and *suggestive* trademarks.

Part II of this article is devoted to describing one of the many tests that have been developed over the years for distinguishing between these two categories of trademarks. The test of interest in this paper is known as the “Results or Effects of the Goods” test (the “REF” test), a test first described in the courts almost exactly 100 years ago (as of the date of this writing).³ Sadly, it is a poor test. It is also one that has been described and cited with approval⁴ in the lengthy public *Trademark Manual of Examining Procedure*⁵ published by the U.S. Patent and Trademark Office,⁶ so that, every day, trademark practitioners all across the country are encouraged to employ the test both in the courts and at the US PTO.

Part III of this article explains the problem. The REF test does an extremely poor job of distinguishing between descriptive trademarks and suggestive trademarks. It is logically flawed, and numerous court decisions over the last century have implicitly overruled it. A smaller number of court decisions have bravely and expressly rejected its reasoning. Yet, today, it still stands. It has never been expressly overruled.

Finally, Part IV of this article is a call to action. It encourages the courts to seize the next opportunity to expressly reject the REF test. It further invites the PTO to update the guidance it provides in its TMEP so that future practitioners, endeavoring to advance trademark applications through the Office, don’t waste time and money needlessly revisiting and rehashing the contours of an improvident test.

² See, e.g., *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4 (2d Cir. 1976) (the most famous appellate court decision, dated 1976, expressly articulating this specific four-part categorization for the very first time).

³ See *In re Irving Drew Co.*, 297 F. 889 (D.C. Cir. 1924) (the decision and test described in detail in Part II.D. hereinbelow).

⁴ See TMEP § 1209.01(a) (as discussed in detail in Part II.D. hereinbelow).

⁵ See *Trademark Manual of Examining Procedure Forward* (Jul. 2021) [hereinafter TMEP] (“The Manual is published to provide trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The Manual contains guidelines for Examining Attorneys...”).

⁶ 35 U.S.C. § 2 [hereinafter US PTO or PTO or the Office] (“Powers and Duties: (a) In General. The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce — (1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and (2) shall be responsible for disseminating to the public information with respect to patents and trademarks.”).

For a century, judges and practitioners have been dealing with (some occasionally tripping over) a particular branch that needlessly blocks the path. This article endeavors to clear the path once and for all.

B. Background: Managing a Healthy Ecosystem of Trademarks

The grant of rights in trademarks has been an important part of federal and state law in the United States for a very long time.⁷ And appropriately so. Our laws regarding trademarks enhance the quality of life in our society in many ways. To begin with, they have created a thriving ecosystem of symbols that help consumers to quickly spot and patronize unique sources of quality goods and services. Just as importantly, when trademarks are properly regulated in the courts (that is, when knock-offs are enjoined out of existence), consumers are less likely to be duped by unscrupulous vendors who hope to trade off of the goodwill of their more skilled competitors. Finally (though perhaps less widely appreciated), trademark law also serves to preserve free and fair competition in the marketplace. For example, the law ensures that descriptive or generic terms remain available to everyone – established competitors and entrepreneurial upstarts alike – for describing the goods and services they offer in the marketplace.

When the purposes described above are furthered, we all benefit. When they are undermined, we all suffer. And so the legislatures and the courts remain ever vigilant in monitoring the health of our trademark ecosystem. The legislatures define the frameworks and major standards for protecting and enforcing trademarks, and the courts apply and refine those works in adjudicating individual cases.

Specifically, in order to enhance the efficient adoption and use of trademarks in the U.S., the various states and the federal government have created trademark registration systems. The most prominent aspect of these systems (to the public) are the registries about which they operate. A good example of one of these registries is the largest one in widespread use in the United States today – the Principal Register⁸ of the US PTO.

Registries such as the PTO’s Principal Register provide the public a valuable and extremely convenient single “list” of trademarks, service marks, collective marks, and certification marks in which marketplace vendors have asserted proprietary rights. These highly visible and carefully maintained registries thus make it easier for businesses to make good decisions about the adoption of a new mark⁹ for a good or service.

⁷ Without belaboring this rather obvious point, it is noted that, in 1905, Congress passed the Trademark Act encompassing all interstate and foreign commerce, and, in 1947, Congress enacted the Lanham Act, the modern trademark registration scheme, which is still in force to this day. The Lanham Act appears in Title 15 of the United States Code. Lanham Act §1 appears at 15 U.S.C. §1051.

⁸ 15 U.S.C. § 1051(a)(1) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director...”).

⁹ It is commonplace for trademark practitioners to use the shorthand term “mark” to refer collectively to “trademarks” (for goods), “service marks” (for services), collective marks (of organizations), and certification marks (of certifiers), because most of the general legal principles applicable to one type of mark apply to the other kinds as well. *See generally, e.g.*, TMEP § 1300 (“The language of this Manual is generally directed to trademarks. Procedures for trademarks usually apply to other types of marks, unless otherwise stated.”). The principal theses of this paper apply to all kinds of marks, and so the more precise terms will only be employed herein when circumstances require. Also, this paper is focused principally upon what trademark practitioners often call “word marks” (marks that would be presented as “standard character” alphanumeric marks in a trademark application), rather than “logo marks” (marks that would be presented in a “special form” drawing featuring a visual design in a

The most common concern that a well-run business will typically have when considering a potential new mark is that the mark is *already in use* by one of its competitors or that, while the mark is not identical to a preexisting mark, perhaps it is similar enough to a preexisting mark that it is *likely to cause confusion* in the marketplace if the new mark were adopted.¹⁰ If a proposed new mark is likely to cause confusion among an appreciable number of consumers, then, under the law in the vast majority of states (and the federal government), its use may be enjoined.¹¹ The registry helps companies (guided by the advice they receive from their trademark attorneys) to avoid these unhappy and costly results by facilitating rapid, accurate, cost-effective searches of the registry as opposed to less-efficient, ad hoc canvassing of the marketplace of marks by other means.

The registries do more than just facilitate a company's selection and adoption of a new mark. They also help companies who need to assert their marks in litigation to establish a "prima facie" case for the validity of a mark that they have previously registered.¹² And, in the federal scheme, the registry also provides constructive notice that a registrant might, at any future time, expand his use of his mark to any region in the U.S.¹³ Ask any trademark litigator, and (s)he will happily catalogue the many practical benefits of participating in the trademark registration process.

But the price of registration is examination. That is, the examiners at the PTO will only grant a federal registration *after* they have performed a comprehensive examination of the trademark application and concluded that the mark does indeed merit registration under the

trademark application). *Cf.* 37 C.F.R. §2.52(a) ("An applicant may submit a standard character drawing if: The mark does not include a design element; All letters and words in the mark are depicted in Latin characters; All numerals in the mark are depicted in Roman or Arabic numerals; The mark includes only common punctuation or diacritical marks; and No stylization of lettering and/or numbers is claimed in the mark."); TMEP § 807.03(a) ("An applicant who submits a standard character drawing must also submit the following standard character claim: The mark consists of standard characters without claim to any particular font style, size, or color.").

¹⁰ 15 U.S.C. § 1125(a)(1) ("Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, ... which – (A) is *likely to cause confusion*, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.") (emphasis added); *and see* Hyson USA v. Hyson 2U, 821 F.3d 935, 939 (7th Cir. 2016) (citing *Sorenson v. WD-40*, 792 F.3d 712, 726 (7th Cir. 2015): "The keystone of trademark infringement is likelihood of confusion as to source, affiliation, connection, or sponsorship of goods or services among the relevant class of customers and potential customers.").

¹¹ *See, e.g., Register.com Inc. v. Verio Inc.*, 356 F.3d 393, 441-42 (2d Cir. 2004) (finding that a likelihood of confusion is "defined as a likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question, or ... confusion as to plaintiff's sponsorship or endorsement of the defendant's goods or services.") (internal quotes omitted).

¹² *See, e.g.,* 15 U.S.C. § 1057(b) ("A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.").

¹³ 15 U.S.C. § 1072 ("Registration of a mark on the principal register... shall be constructive notice of the registrant's claim of ownership thereof."); *and see* *Armand's Subway v. Doctor's Associates*, 604 F.2d 849, 850 (4th Cir. 1979) ("After the Lanham Act, nationwide protection was extended to registered marks, regardless of the area in which the registrant actually used the mark, because ... registration constituted constructive notice to competing users. ... However, ... the protection is only potential in areas where the registrant in fact does not do business. A competing user could use the mark there until the registrant extended its business to the area. Thereupon the registrant would be entitled to exclusive use of the mark and to injunctive relief against its continued use by prior users in that area.").

controlling legal tests.¹⁴ For example, by closely examining a proposed new mark and the goods and services to which it relates, the examiner is in a position to make a judgment as to whether the mark is confusingly similar to one or more preexisting marks currently in commerce.¹⁵ If it is, registration will be denied.

The courts similarly examine trademarks, but they do so only after a dispute has arisen. However, the substantive “likelihood of confusion” standard that they apply in adjudicating disputes is the functional equivalent to that applied by the PTO’s examiners.¹⁶ Thus, both the examiners and the courts have a healthy interest in the substantive standards of trademark law. If those standards are clear, examiners and jurists are able to make better decisions faster; if they are not clear, timeliness suffers.

C. “Descriptiveness” – A Key Basis for Refusing Registration or Defeating Claims

This article focuses upon the legal attributes of *descriptiveness* and *suggestiveness* in trademarks. Descriptiveness is one of the oldest and most important grounds for (a) refusing registration of a mark, (b) canceling registrations previously granted, and / or (c) defeating claims of infringement. The modern U.S. trademark statute, known as the Lanham Act,¹⁷ succinctly describes in Section 2 this basis for rejecting an application for registration of a mark:

*No trademark by which the goods of the application 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 ... of them, ...*¹⁸

The §2e1 descriptiveness inquiry empowers the trademark examiner to make a judgment about whether the new mark is actually nothing more than a collection of terms that are so descriptive, and so commonly employed, in relation to the relevant goods and services, that granting the registration would actually give the applicant a proprietary command over a portion of the English language that we should all enjoy.

¹⁴ The application provides a wealth of information to the examiners to facilitate their work. For example, it contains the details regarding the mark, the owner, the date upon which the mark was adopted and used in commerce, the goods and services to which the mark relates, and related matters. See 15 U.S.C. §1051(d)(1) (“Subject to examination..., the mark shall be registered in the Patent and Trademark Office...”); and see generally TMEP Ch. 800 (“Application Requirements”).

¹⁵ 15 U.S.C. § 1052(d) (“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 --- (d) [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be *likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...*”) (emphasis added).

¹⁶ Cf. *Octocom Sys. v. Houston Comp.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (finding that applicant’s mark so resembled an opposer’s previously registered mark as to be likely to cause confusion; when applicant argued the PTO erred by failing to consider evidence showing no likelihood of confusion *in the marketplace*, the court reminded the applicant that the likelihood of confusion test, as applied by the examiners *at the PTO*, is based on the potentially broader identification of goods specified (and sought) in the pending application for registration, and not on evidence of the mark’s potentially narrower actual current use in the marketplace).

¹⁷ The Lanham Act appears in Title 15 of the United States Code. Lanham Act §1 appears at 15 U.S.C. §1051.

¹⁸ 15 U.S.C. § 1052(e)(1) (emphasis added).

Consider the following mark:

**SPEEDY CLEANERS
for dry cleaning services**

[a descriptive mark]

The presentation above demonstrates the way most experienced trademark practitioners think about trademarks. They think of them as “doublets” – a *MARK for a set of goods or services*¹⁹ – so other examples would include the following marks for goods: *LEVI’S for blue jeans*; *COCA-COLA for soft drinks*; *NIKE for athletic shoes*; *EXXON for gasoline*; and *MICROSOFT for computer software*. And one could similarly consider the following marks for services: *BANK OF AMERICA for banking services*; *McDONALD’s for restaurant services*; *CENTURY 21 for real estate services*; and *UNITED AIRLINES for flight services*.²⁰

Reconsider *SPEEDY CLEANERS* for dry cleaning services above. If a business sought to *register* (establish a governmentally-sanctioned proprietary position in) this mark as a service mark for its dry-cleaning services, we would all object to the appropriation of this highly descriptive phrase (and appropriately so) even if the applicant was the first to think of registering it.²¹ Dry cleaners everywhere should be free to describe themselves as “speedy” unless it has become quite clear that a specific exceptional circumstance applies, namely, that the public has come to know (over time) that “Speedy Cleaners” does in fact refer to just *one specific* business.²²

The courts have been wrestling with the definition of descriptive marks and the problems they create for a very long time. “Descriptiveness” as an explicit ground for rejection of a trademark application has appeared – and been continued in almost identical form – in the U.S. federal trademark acts for almost 120 years. It was called out in the federal trademark statute of 1905,²³ again in the modernized federal trademark act (the Lanham Act) of 1946,²⁴ and it continues

¹⁹ It is also commonplace for practitioners, when writing in a text, brief, or article, to use CAPITALIZED letters to refer to a word mark, and to use either plain text or *italicized* text when referring to the goods or services to which the mark relates.

²⁰ If the engaged reader (Rick Reader) takes his favorite trademark practitioner (Bill Brandt) to lunch, Rick will observe that, even in casual conversation, Bill will rarely (if ever) refer to “the EXXON mark”. Rather, even when rushed, Bill will almost always refer to “EXXON for gasoline” or “the EXXON mark for petroleum”.

²¹ *KP Permanent Make-Up v. Lasting Impression I*, 543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”) (citations omitted).

²² Such a showing (that a descriptive mark has now (over time) acquired an *additional* meaning – a reference to a *single specific* business – in the eyes of the public) is known as a showing of “secondary meaning” or “acquired distinctiveness” under 15 U.S.C. § 1052(f). This carefully regulated exception to the general prohibition against registering descriptive marks is discussed in greater detail in the text accompanying note 49 below.

²³ 33 Stat. 724, 726 (1905) (“[N]o mark which consists... merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, ... shall be registered...”)

²⁴ 15 U.S.C. § 1052(e)(1), 60 Stat. 427, 428-29 (1946) (“No trade-mark 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 applied to the goods of the applicant is merely descriptive ... of them...”). The phrase “merely descriptive” (as distinguished from “descriptive”) has been construed as meaning that the mark is “only” descriptive; that is, that it entirely lacks distinctiveness. For example, the court in *In re Colonial Stores*, 394 F.2d 549, 551-553 (C.C.P.A. 1968) held that the mark SUGAR & SPICE as applied to bakery goods had

in effect in the latest revision of the Lanham Act today.²⁵ Thus, when one considers the meaning of descriptiveness, one can helpfully consider court decisions both before and after 1946, as the policy considerations that affect defining what *is* and *isn't* descriptive are (for the most part) the same today as they were a hundred years ago.

D. “Descriptiveness” in Context - The Abercrombie Continuum of Trademark Distinctiveness.

Since 1976, a great many courts, including the U.S. Supreme Court,²⁶ have referred to the *Abercrombie* decision or the “Friendly continuum” when placing descriptive marks in context. In *Abercrombie & Fitch Co. v. Hunting World*,²⁷ Judge Friendly identified four different categories of marks, arrayed in increasing order as regards their intrinsic distinctiveness and degree of protection afforded: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful.²⁸ To be clear, category (1) “generic” terms are the weakest / least distinctive (in fact, they are not viewed as marks at all), and category (4) “fanciful” / “arbitrary” marks are the strongest / most distinctive.²⁹

A presentation of these categories in tabular form helps the reader to fix their essential characteristics in mind. See the following table.

a separate, well-recognized, and paramount connotation (based on the nursery rhyme) that meant that the mark was NOT “merely descriptive”.

²⁵ 15 U.S.C. § 1052(e)(1) (“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 ... of them...”).

²⁶ *See, e.g.*, *Two Pesos v. Taco Cabana*, 505 U.S. 763, 768, 112 S.Ct. 2753, 2757 (1992) (“Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”); *USPTO v. Booking.com*, 140 S.Ct. 2298, 2302-03 (2020).

²⁷ *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4 (2d Cir. 1976).

²⁸ *Id.* at 9.

²⁹ *See, e.g., Id.*; *Two Pesos*, *supra* note 26, at 768; *Booking.com*, *supra* note 26, at 2302-03.

TYPE OF MARK	GENERIC TERMS	DESCRIPTIVE MARKS	SUGGESTIVE MARKS	ARBITRARY OR FANCIFUL MARKS
Legal STRENGTH	NO Legal Protection	Trademarks in these columns generally act as ADJECTIVES (telling us “Who Made This?”, “Which Brand is This?”).		
		Legally Weak	Legally Strong	Legally Strong
NATURE of Mark	<p>The mark is extremely highly descriptive name of a product.</p> <p>Generic Terms generally act as NOUNS (telling us “What is This?”). They are NOT Trademarks.</p>	The mark describes the goods or service using ordinary, logically applicable words.	The mark is distinctive because it suggests perhaps via a pun. To understand the mark and its relationship to the product, imagination or creativity is required.	The mark is distinctive because it is arbitrary (it consists of an arbitrarily chosen word) or fanciful (it consists of a meaningless collection of letters).
WHEN Is Protection Acquired?	Never	<p>Upon secondary meaning (acquired distinctiveness).</p> <p>The mark is protectable but only if secondary meaning can be shown by, for example, demonstrating constant exclusive use for 5 years, whereupon it is presumed that the public now connects the mark with this specific owner alone.</p>	Upon use	Upon use
Examples	<p><i>Premium Unleaded</i> for gasoline</p> <p><i>Whole Milk</i> for milk</p>	<p><i>Speedy</i> for dry cleaners</p> <p><i>Prompt & Dependable</i> for electrician services</p>	<p><i>Chicken o’ the Sea</i> for tuna fish</p> <p><i>Roach Motel</i> for insect traps</p>	<p><i>Shell</i> for gasoline (arbitrary words)</p> <p><i>Exxon</i> for gasoline (fanciful letters)</p>

It is critically important to understand that these categories are based on the intrinsic or acquired distinctiveness of the mark,³⁰ and intrinsic distinctiveness is almost invariably driven by the relationship of the mark to the goods or services to which it is applied.³¹ In evaluating that relationship, the courts look at *the precise meaning of the mark* quite closely, and they evaluate that in relation to *the precise nature of the goods or services* to which it is applied. Although dictionary definitions are not necessarily controlling, they are often consulted.³²

At the lowest end of the protectability continuum are generic terms, which aren't really marks at all. A generic term is the name of a product or product category ("product genus"),³³ and such terms cannot be validly registered at the PTO or validly asserted in the courts,³⁴ because the public is deemed to have an unfettered right to the use of such generic terms. Consider the following mark:

UNLEADED GASOLINE
for lead-free gasoline

[a generic mark]

The courts have long established that the public should be able to refer to "unleaded gasoline" (for lead-free gasoline) or "whole milk" (for fat-bearing milk) without fear of litigation. The long-established concept here is that a generic term is "the name of the thing". It is a noun such as SHOTGUN or AUTOMOBILE that answers the question "what is it?" for the public. Trademarks are usually adjectives, such as the word LEVI'S in the expression "Levi's bluejeans", that answer the question "who produced this?"³⁵ Generic terms are NOT valid trademarks.³⁶ If

³⁰ See *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131-1132 (2d Cir. 1979) ("Thus, while these categories can be useful for analytical purposes, the strength of a mark depends ultimately on its distinctiveness, or its 'origin-indicating' quality, in the eyes of the purchasing public. Two familiar examples suffice to illustrate this principle. A coined term, initially suggestive or even fanciful, can lose its full trademark status if it comes to signify to the public the generic name of an article rather than the source of a particular brand of that article. In contrast, a descriptive mark that is not distinctive on its face may acquire secondary meaning so as to identify the source of the goods and thus claim status as a valid mark deserving of registration and protection against infringement. In Judge Lasker's words, 'strength may derive from the intrinsic quality of a mark or from its public history.'").

³¹ *Abercrombie*, *supra* note 27, at 9 n.6 (providing an example of this: "To take a familiar example, IVORY would be *generic* when used to describe a product made from the tusks of elephants but *arbitrary* as applied to soap.") (emphasis added); *and cf.* *In re Abcor Development*, 588 F.2d 811, 814 (C.C.P.A. 1978) ("Appellant's proposed abstract test is deficient not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by the statute.").

³² See, e.g., *Vision Center v. Opticks, Inc.*, 596 F.2d 111, 116 (5th Cir. 1979) ("Webster's ... Dictionary defines the word 'vision' as the act or power of seeing; visual sensation or the capacity for it. The word 'center' means a concentration of requisite facilities for an activity, pursuit, or interest along with various adjunct conveniences (e.g., shopping center, medical center, amusement center). Used in combination, the words [VISION CENTER] imply a place where there is a concentration of requisite facilities relating to the power of seeing or the capacity for it.").

³³ *Abercrombie*, *supra* note 27, at 9.

³⁴ *Id.*

³⁵ See, e.g., *Elliott v. Google, Inc.*, 860 F.3d 1151, 1155-56 (9th Cir. 2017) ("We have often described this as a 'who-are-you / what-are-you test. If the relevant public primarily understands a mark as describing 'who' a particular good or service is, or where it comes from, then the mark is still valid. But if the relevant public primarily understands a mark as describing 'what' the particular good or service is, then the mark has become generic.").

³⁶ See, e.g., *Creative Gifts v. UFO*, 235 F.3d 540, 544 (10th Cir. 2000) ("When the relevant public ceases to identify a trademark with a particular source of a product or service but instead identifies the mark with a class of products or services regardless of source, that mark has become generic and is lost as an enforceable trademark.").

they are somehow registered, they are subject to a later cancelation at the PTO for genericness.³⁷ Similarly, if they are asserted in a trademark infringement lawsuit, the defendant may defend by invalidating the plaintiff's trademark rights on the basis of genericness.³⁸

At the opposite (highest) end of the protectability spectrum are fanciful marks, which are viewed as the most powerful, most readily registrable, and most amply protected marks of all.³⁹ Consider the following example:

EXXON
for petroleum products

[a fanciful mark]

The word “Exxon” simply didn’t exist in ordinary English usage until its owner invented the word to serve as its trademark. Because the mark is as unique as a fingerprint, it is registered easily (as the PTO Examiner will conclude that it is not confusingly similar to any prior marks of record). It is also protected amply in the courts as what effect could the adoption of such a unique mark (or one highly similar to it) by a second-comer have other than to cause confusion amongst customers?⁴⁰ These marks are so unique and so powerful that they are viewed as “inherently distinctive”.⁴¹

Standing instantly beside fanciful marks, at only a slightly junior location on the generic-descriptive-suggestive-arbitrary-fanciful continuum, are arbitrary marks. In a very real sense, arbitrary marks are “fanciful” too. Consider:

APPLE
for personal computers

[an arbitrary mark]

That is, while fanciful marks feature an arbitrary collection of *letters*, arbitrary marks feature an arbitrary use of *words* as trademarks. That is, the words have no logical relationship to

³⁷ 15 U.S.C. § 1064 (“A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed... (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered...”).

³⁸ See, e.g., *Papercutter v. Fay’s Drug*, 900 F.2d 558, 563 (2d Cir. 1990) (“[D] may petition for cancellation of [P’s] registration under [Lanham Act] § 14..., 15. U.S.C. § 1064, ‘either in a separate and independent action or as a counterclaim in an infringement suit,’ by rebutting the presumption of a plaintiff’s right to exclusive use of a registered mark by a preponderance of the evidence.”)

³⁹ See, e.g., *Booking.com*, *supra* note 26, at 2302-03 (Supreme Court: “Distinctiveness is often expressed on an increasing scale: Word marks may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *The more distinctive the mark, the more readily it qualifies for the principal register.* The most distinctive marks – those that are arbitrary (CAMEL cigarettes), fanciful (KODAK film), or suggestive (TIDE laundry detergent) – may be placed on the principal register because they are *inherently* distinctive.”) (emphasis added).

⁴⁰ See, e.g., *Lambert Pharmacal Co. v. Bolton Chem.*, 219 F. 325, 330 (S.D.N.Y. 1915 (L. Hand: “In choosing an arbitrary trade-name, there was no reason whatever why they should have selected one which bore so much resemblance to the plaintiff’s; and in such cases any possible doubt of the likelihood of damage should be resolved in favor of the plaintiff. ... He has the right to insist that others in making up their arbitrary names should so certainly keep away from his customers as to raise no question.”).

⁴¹ See *Booking.com*, *supra* note 39.

the goods with which they are used. The marks DOMINO'S for pizza and BEEFEATER for alcohol are good examples. Like fanciful marks, arbitrary marks are so unique and so powerful that they are viewed as inherently distinctive.⁴²

As indicated in the discussion of Lanham Act §2e1 above, descriptive marks are those marks which “merely describe” some characteristic of the goods or services with which they are used. The attentive reader will recall that (s)he has already been exposed to a fine example of a descriptive mark: SPEEDY (or SPEEDY CLEANERS) for dry cleaning services. Notice how each term in the mark uses ordinary vernacular to describe the nature of the relevant goods or services.

Given their placement on the lower end of the Friendly generic-descriptive-suggestive-arbitrary-fanciful continuum, it is no surprise that descriptive marks are viewed as being relatively weak. They are but one step removed from generic terms.

There is a critically important foundational reason for the widely-recognized weakness of descriptive marks. Descriptive marks are weak because the words they employ (in the context of the product or service at hand) are undeniably common. That is, descriptive marks use the same words any ordinary consumer might use to refer to the well-known ingredients, features, or characteristics of the goods. And, because these words are so commonly used in conjunction with the goods, marketers frequently employ them as well, and so it is often the case that there is a crowded field of businesses all using the same descriptive terms (or highly similar variations on them) for the same or similar goods. Thus, we see Speedy Cleaners, Speed Cleaning, Speedi Cleaners, Houston Speedy Dry Cleaning, etc.

Thus, one can now apprehend several distinct reasons to proscribe the use or registration of descriptive marks. First, there is a concern over *misappropriation from the public domain*. That is, because the use of descriptive terms is so commonplace, registering a descriptive mark is viewed as a misappropriation of a mark from one or more other prior users or even from the public at large.⁴³

Second, from a raw statistical standpoint, if appropriation of descriptive terms continues unchecked, there is a concern about *mark depletion*. The capture of descriptive marks depletes the available pool of ordinary descriptive terms that should be available to the relevant merchant class at large for selling their wares.⁴⁴ Thus, the more unique and unusual a mark is, when considered in the context of the goods, the more likely it is to be considered suggestive (or even arbitrary),⁴⁵

⁴² See *Booking.com*, *supra* note 39.

⁴³ See *Educational Development v. Economy Co.*, 562 F.2d 26, 28 (10th Cir. 1977) (“Merely descriptive terms may not be registered because they do not advise the buyer that the product comes from a single source and because trademark protection would infringe on common speech.”) (citations omitted).

⁴⁴ See *Telechron v. Telicon*, 198 F.2d 903, 906 (3d Cir. 1952) (“The basic reason for refusing to allow the exclusive appropriation of descriptive words in trademarks is the danger of depleting the general vocabulary available to all for description and denomination of articles of commerce.”); *Devcon Corp. v. Woodhill Chem. Sales*, 455 F.2d 830, 832 (1st Cir. 1972) (“We are deeply troubled to think that a party can seize upon one of the primary characteristics that make an unpatented commercial product marketable and preempt or limit competitor reference by registering it as a trademark.”).

⁴⁵ See, e.g., *Id.* at 905-06 (3d Cir. 1952) (“TELECHRON [for synchronous electric clocks] was formed by prefixing the Greek root ‘chron’ with ‘tele’... Thus the etymology of the coined word yielded a connotation of ‘time from a distance’. ... We are dealing with... a coined word with a penumbra of suggestion. ... But this idea was too imprecise for meaningful description of any article or object of commerce. ... The devising and registration of ‘Telechron’ created no ... danger of impoverishment of the language. ‘Telechron’ had no existence as a word before Warren devised it. ... Thus analyzed, any suggestiveness in ‘Telechron’ does not amount to that descriptiveness which invalidates a trademark.”).

and the more ordinary and common the mark is, when similarly considered, the more likely it is to be considered descriptive.

Third, descriptive marks make for *blurry intellectual property (“IP”) lines* which lead to confusion in the marketplace⁴⁶ and harassing lawsuits.⁴⁷ In many lawsuits involving descriptive marks, both the plaintiff and defendant come to court with weak proprietary claims, and it is not uncommon for settlements in these cases to essentially involve both companies discovering their mutual weaknesses, and calling a ceasefire, with the main loser being the public which has lost a valuable opportunity to have the invalidity (and public availability) of the descriptive terms at issue acknowledged.

The concern over the evils catalogued above is nothing new. Indeed, the 1905 trademark act held that a finding of descriptiveness meant that the term could not be validly registered or asserted as a mark *at all*.⁴⁸ However, under the modernized approach of the Lanham Act of 1946, if an applicant could marshal evidence demonstrating that, over time, the public had come to identify a descriptive mark as referring to a *single* source, then the mark would be viewed as having “become distinctive” (or, as having “acquired distinctiveness”) and thus be eligible for registration.⁴⁹

Acquired distinctiveness, more frequently referred to as “secondary meaning,”⁵⁰ can theoretically be proven using any relevant evidence. It is typically demonstrated by showing sufficient marketing, sales, and exclusive usage in commerce over a substantial period of time.⁵¹ In fact, the Lanham Act calls out that a *prima facie* case for acquired distinctiveness may be made

⁴⁶ See *Beckwith v. Commissioner*, 252 U.S. 538, 543 (U.S. 1920) (“It was settled long prior to the Trade-Mark Registration Act that the law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade; this for the reason that *the function of a trade-mark is to point distinctively*, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, *and words merely descriptive of qualities, ingredients, or characteristics, when used alone, do not do this.*”) (emphasis added).

⁴⁷ See *In re Abcor Development*, 588 F.2d 811, 813 (C.C.P.A. 1978) (stating that a major reason for not protecting descriptive marks is “to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when ... describing their own products.”) (citations omitted).

⁴⁸ 33 Stat. 724, 726 (1905) (“[N]o mark which consists... merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, ... shall be registered...”)

⁴⁹ 15 U.S.C. § 1052(f) (“Except as expressly excluded..., 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.”) (emphasis added).

⁵⁰ The idea is that the “primary meaning” of a descriptive mark, such as SPEEDY CLEANERS OF HOUSTON for dry cleaning services, is the meaning one would ascribe to the mark *based solely on its descriptive contents*. The “secondary meaning” of a descriptive mark is the meaning *beyond* or *in addition to* that descriptive content, the meaning that SPEEDY CLEANERS OF HOUSTON has, over time, come to refer in the minds of the public to *one specific* dry cleaning establishment (perhaps located at 1000 Main Street, Houston, TX).

⁵¹ See, e.g., *Department of Parks & Rec. v. Bazaar del Mundo Inc.*, 448 F.3d 1118, 1128 (9th Cir. 2006) (“To determine whether a descriptive mark has acquired secondary meaning, we consider: (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.”); *BigStar Entm’t v. Next Big Star*, 105 F.Supp.2d 185, 196 (S.D.N.Y. 2000) (“While [Lanham Act] §2f (15 U.S.C. 1052(f)) permits registration of merely descriptive terms, the corresponding protection it accords demands, as a precondition, proof that the mark has acquired secondary meaning in its market. This test refers to demonstrable evidence that the mark, by means of sufficient marketing, sales, usage, and passage of time, has established distinctiveness in commerce, measured by the extent to which it has become identified in the public mind with the particular source of the goods.”).

in the registration process by proof of substantially exclusive and continuous use for five years.⁵² Thus, in brief, today, registration of a descriptive mark is indeed possible (and many such marks are registered each year), but this occurs *only after* the substantial showing of acquired distinctiveness / secondary meaning is made.

The final category of marks, **suggestive marks**, feature a designation deriving from the notion that these marks *merely suggest, rather than directly describe*, the goods or services to which they are applied. The idea here is that suggestive marks require a degree of imagination and / or creativity in order to appreciate the relationship that exists between the mark and the relevant good or services. Consider the following mark:

CHICKEN O' THE SEA
for tuna fish

[a suggestive mark]

Another example might be ROACH MOTEL for insect traps. These marks, like fanciful / arbitrary marks on the generic-descriptive-suggestive-arbitrary-fanciful continuum, are so unique that they are viewed as inherently distinctive. But notice that they are not devoid of meaning. Rather, these marks (which are often puns, word twists, or double entendres) are unique *precisely because* the means by which meaning is communicated is so unusual.

Suggestive marks are often popular with *both* marketers and lawyers (and the courts!),⁵³ and it's easy to see why. Fanciful EXXONS and arbitrary APPLes are almost always extremely hard to remember after first contact unless they are backed up by multi-million-dollar advertising campaigns that repeat them to us so frequently that they become a part of our regular vocabulary. Ordinary entrepreneurs have far smaller budgets, and they'll never adopt BLUE TURTLE for dry cleaning no matter how legally strong their attorney says it is. But show them a mark like CHICKEN O' THE SEA for tuna fish, and their eyes light up. It's the kind of mark you can't get out of your head. Exactly what the marketers want.

***E. The Practical Importance of Distinguishing Between
"Descriptive" Marks and "Suggestive" Marks.***

"Suggestive" marks are exactly what the lawyers want too. That is, recall that suggestive marks are viewed as *inherently* distinctive, and they are accorded *instant protectability* and usually a fairly *broad* ambit of protection.⁵⁴ Descriptive marks, by contrast, are viewed as unregistrable /

⁵² 15 U.S.C. § 1052(f) ("The Director may accept as prima facie evidence that the mark has become distinctive, ..., 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.").

⁵³ See, e.g., *Van Camp Sea Food v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (stating, while holding that CHICKEN O' THE SEA for tuna fish is not descriptive, but, rather, is suggestive or greater: "It is well-settled in adjudicated cases that a valid trade-mark may be highly suggestive (in our opinion oftentimes the best ones are), without being offensively descriptive.").

⁵⁴ See, e.g., *American Home Products v. Johnson Chemical*, 589 F.2d 103, 106 (2d Cir. 1978) ("It appears to us most likely that an ordinary consumer having read or heard on television the words "ROACH MOTEL" would *remember the conception rather than the precise word*. He would be unlikely to differentiate between "Roach Motel" and "Roach Inn" in his recollection. We think it more likely that he would recall simply a fanciful abode for roaches in an establishment normally frequented by human travelers. Even the use of *different* words *with similar meaning* may

unprotectable unless and until they have acquired secondary meaning. And, even then, they are usually viewed as being weak, because, although they are valid, they still reside within a crowded field of similar marks which limits the scope of their enforcement.

Furthermore, due to their unusual nature, suggestive marks are frequently registered fairly quickly by the PTO, and their validity and presumed strength are also acknowledged quite readily by the courts. Descriptive marks, by contrast, are viewed with suspicion *ab initio*. PTO Examiners routinely initially reject trademark applications bearing descriptive marks, and the courts are careful to hold the trademark owners to proving up secondary meaning as a part of their prima facie case in litigation. In a nutshell, marks found to be descriptive are harder (and more expensive) to register and harder (and more expensive) to enforce than marks found to be suggestive.

With a distinction so consequential, the trademark bar and the courts have developed various heuristics for distinguishing suggestive trademarks from descriptive trademarks. Some are tried and true. Others have been proposed and discarded. Still others have been adopted but, despite numerous court decisions implicitly recognizing their inadequacy, still continue to be cited and asserted, resulting in an extraordinary amount of economic waste. (Entrepreneurs in particular suffer here, as they pay their legal bills from their scarcity and not their plenty.) It is to one of these failed rules – currently still actively promoted by the US PTO – that this paper is principally devoted.

II. THE PTO’S TRADITIONAL “RESULTS OR EFFECTS OF THE GOODS” TEST (THE “REF” TEST) FOR RECOGNIZING SUGGESTIVE TRADEMARKS

A. *The Important Role of the TMEP*

Although it is unknown to most members of the lay public, the U.S. Patent and Trademark Office’s (“PTO’s”) own Trademark Manual of Examining Procedure (“TMEP”) is one of the first, top-of-desk sources of guidance to which trademark practitioners⁵⁵ (and even, it seems, the courts⁵⁶) will refer. Much of the TMEP is devoted to the procedures used by the PTO in examining trademark applications, of course, but it also documents the substantive standards (including the case law) to be applied by the Office’s Examiners in evaluating whether a mark is suitable for registration.

The guidance and recommendations provided in the TMEP are important, as they provide touchstones to thousands of trademark practitioners all over the globe about the nature of, and the differences between, descriptive and suggestive marks (as those designations of origin are defined in the US courts and US PTO).

tend to confuse. One who adopts the mark of another for similar goods acts at his own peril and any doubt concerning the similarity of the marks must be resolved against him.”) (emphasis added; citations omitted).

⁵⁵ See TMEP Forward (Jul. 2021) (“The Manual is published to provide trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The Manual contains guidelines for Examining Attorneys...”).

⁵⁶ A 06/20/2022 Westlaw search for references to the “Trademark Manual of Examining Procedure” or “TMEP” in the federal courts produced evidence that it had been cited 7 times by the U.S. Supreme Court, 121 times by the U.S. Courts of Appeal, and 327 times by the U.S. District Courts.

B. *The TMEP's Plentiful Guidance regarding Descriptiveness.*

The TMEP's guidance regarding descriptive marks is plentiful. As stated,⁵⁷ objections to the use and / or registration of descriptive marks have been around for a long time. Although there is no need to exhaustively catalog the nature and types of these disapprobations, it is still worthwhile to briefly canvas them, as the best way to appreciate the unique nature of suggestive marks is to consider them in context adjacent their descriptive brethren. The court decisions characterizing the various species of descriptiveness are legion. Were one to endeavor to list them all here, the margins would consume the paper.

However, the TMEP provides a helpful tour. It opens its discussion of refusals based on descriptiveness by stating: "A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. Similarly, a mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services."⁵⁸

The factors listed above account for a large portion of the descriptiveness rejections emanating from the PTO. However, as if those factors weren't enough, the TMEP then catalogs for its Examiners and the public a lengthy non-exhaustive example listing⁵⁹ of *additional* ways in which a mark may be found to be descriptive. For example, any of the following terms in a mark may be found to be merely descriptive: (a) terms which constitute a phonetic equivalent (for example, a slight misspelling) of a descriptive term;⁶⁰ (b) terms which identify the function or purpose of a product or service;⁶¹ (c) terms which identify the source or provider of a product or service;⁶² (d) terms which identify a target group to whom the applicant directs its goods or services;⁶³ (e) terms which identify the name of an historic figure or fictional character when the figure or character is in the public domain;⁶⁴ (f) terms like NATIONAL and INTERNATIONAL which merely indicate whether a service provided is national or international in scope;⁶⁵ (g) terms which are merely laudatory / merely attributing quality or excellence to goods or services;⁶⁶ and

⁵⁷ See the text accompanying note 23 *supra*.

⁵⁸ TMEP § 1209.01(b) (entitled "Merely Descriptive Marks") (citations omitted) (emphasis added).

⁵⁹ *Id.* ("The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. See TMEP §§ 1209.03-1209.03(v) regarding factors that often arise in determining whether a mark is merely descriptive or generic.") (citations omitted).

⁶⁰ *Id.* at § 1209.03(p) (listing cases including, e.g., *In re Calphalon Corp.*, 122 U.S.P.Q.2d 1153, 1164 (T.T.A.B. 2017) (finding SHARPIN, the phonetic equivalent of "sharpen", to be merely descriptive of knife blocks with built-in sharpeners)).

⁶¹ *Id.* at § 1209.03(p) (listing cases including, e.g., *In re Orleans Wines, Ltd.*, 196 U.S.P.Q. 516, 517, 1977 WL 22593, *2 (T.T.A.B. 1977) (finding BREADSPRED merely descriptive of jams and jellies)).

⁶² *Id.* at § 1209.03(q) (listing cases including, e.g., *In re Major League Umpires*, 60 U.S.P.Q.2d 1059, 1061, 2001 WL 777067, *2 (T.T.A.B. 2001) (finding MAJOR LEAGUE UMPIRE to be merely descriptive of clothing, masks, chest protectors, and shin guards provided, designed, and used by major league umpires)).

⁶³ *Id.* at 1209.03(i) (listing cases including, e.g., *In re Camel Mfg.*, 222 U.S.P.Q. 1031, 1034, 1984 WL 63080, *3 (T.T.A.B. 1984) (finding MOUNTAIN CAMPER to be merely descriptive of retail mail-order services in the field of outdoor equipment and apparel)).

⁶⁴ *Id.* at § 1209.03(x).

⁶⁵ *Id.* at § 1209.03(o) (listing cases including, e.g., *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1302 (Fed. Cir. 2012) (finding NATIONAL CHAMBER to be merely descriptive of nationwide online directory services featuring information regarding local and state chambers of commerce and business and regulatory data analysis services for nationally promoting the interests of businesspersons or industry)).

⁶⁶ *Id.* at § 1209.03(k) (listing cases including, e.g., *In re Nett Designs*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) (finding THE ULTIMATE BIKE RACK to be merely descriptive)).

(h) terms which are foreign words from common, modern languages (currently in use) which, when translated, produce a term which is merely descriptive of the goods or services.⁶⁷

Relatedly, the TMEP also points out that: (a) the use of a common punctuation mark is not sufficient to negate the mere descriptiveness of a term,⁶⁸ (b) the mere repetition of a merely descriptive term generally does not negate the mere descriptiveness of the mark as a whole;⁶⁹ and (c) the combination of two or more descriptive terms, when each retains its descriptive significance in relation to the goods or services, is itself descriptive.⁷⁰

C. The TMEP's More Limited Guidance regarding Suggestiveness.

In contrast to the abundant guidance the TMEP offers regarding descriptive marks, its guidance regarding suggestive marks, and the distinctions between descriptive and suggestive marks, is a bit abridged. As a result, practitioners naturally pay close heed to the rather succinct guidance the Office provides in its Manual.

To its credit, the TMEP directs the reader to (and summarizes) the *Abercrombie* continuum,⁷¹ and this alerts the diligent practitioner to the fact that there is *a conceptual space to be comprehended between* descriptive marks on the one hand and arbitrary/fanciful marks on the other. That interstitial conceptual space is the field of suggestive marks. Distinguishing between suggestive marks (which invite creative thought as to the subtle nature of the relationship between the mark and the goods) and arbitrary/fanciful marks (which typically and instantly thwart such efforts) is easy. Not so for distinguishing between descriptive marks and suggestive marks.

The TMEP points the reader to a handful of touchstones for distinguishing between descriptive and suggestive marks.

D. A PTO Touchstone: The “Degree of Imagination” Test for Suggestiveness.

The TMEP initially and briefly distinguishes descriptive marks from suggestive marks using an oft-quoted passage of the courts:

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services.

⁶⁷ *Id.* at § 1209.03(k) (listing cases including, e.g., *In re Geo. A. Hormel & Co.*, 227 U.S.P.Q. 813, 813-14, 1985 WL 71942, *1-*2 (T.T.A.B. 1985) (finding SAPORITO, an Italian word meaning “tasty”, to be merely descriptive, because it described a desirable characteristic of applicant’s dry sausage)).

⁶⁸ *Id.* at § 1209.03(u).

⁶⁹ *Id.* at § 1209.03(t) (“The mere repetition of a merely descriptive term does not negate the mere descriptiveness of the mark as a whole, unless the combination is such as to create a new and different commercial impression from that which is engendered by the separate components.”).

⁷⁰ *Id.* at § 1209.03(d) (listing cases including, e.g., *In re Entenmann’s Inc.*, 15 U.S.P.Q.2d 1750, 1752, 1990 WL 354520, *2 (T.T.A.B. 1990) (finding OATNUT to be merely descriptive of a bread containing both oats and hazelnuts)).

⁷¹ *See Id.* at § 1209.01 (entitled “Distinctiveness / Descriptiveness Continuum”).

Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.⁷²

This longstanding test applies to prospective purchasers of the goods, not to the public in general,⁷³ and the decisions applying it are legion.⁷⁴ It's almost impossible to read any modern court decision regarding trademarks and not encounter a reference of some sort to the "degree of imagination" test for distinguishing descriptive from suggestive marks.

E. Another PTO Touchstone: The “Results or Effects” of the Goods Test (“The REF Test”) for Suggestiveness.

But the degree-of-imagination test isn't the only heuristic employed by the PTO and the courts for distinguishing descriptiveness from suggestiveness. For example, as will be seen hereinbelow, over the years, a number of courts have asserted that one easy way to distinguish descriptive marks from suggestive marks is the following:

A descriptive mark uses terms that describe one of the product's characteristics, features, purposes, or functions.

However, if a mark merely connotes **a desired result or effect** of using the product, then the mark is viewed as suggestive.

This particular touchstone of suggestiveness is referred to herein as the traditional “Results or Effects of the Goods” test (or “REF” test or “REF” rule), and, despite its faults, and the many times it has been implicitly repudiated, it has never been expressly overruled. Hopefully, that sad streak ends now.

In *In re Irving Drew Co.*,⁷⁵ we have one of the earliest appellate court decisions stating and applying the REF rule that marks which speak to the results or effects that the goods produce are suggestive (and therefore protectable) whereas marks that speak to the ingredients, qualities, or characteristics of the goods are merely descriptive (and therefore unprotectable).

In *Irving Drew*, the applicant's mark ARCH REST for boots, shoes, and slippers was refused registration by the PTO Examiner on the basis of descriptiveness.⁷⁶ On appeal, the court

⁷² See *Id.* at § 1209.01(a) (citations omitted); see also *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4, 11 (2d Cir. 1976) (citing *Stix Products, Inc. v. United Merchants & Manufacturers Inc.*, 295 F.Supp. 479, 488 (S.D.N.Y.1968)).

⁷³ See, e.g., *Educational Development v. Economy Co.*, 562 F.2d 26, 29 (10th Cir. 1977) (citations omitted); *In re Abcor Development*, 588 F.2d 811, 814 (C.C.P.A. 1978) (“However, implicit in this test [for descriptiveness] is the requirement that descriptiveness of a mark, when applied to the goods or services involved, is to be determined from the standpoint of the average prospective purchaser.”)

⁷⁴ See, e.g., *DuoProSS Meditech v. Inviro Med. Devices*, 695 F.3d 1247, 1251-52 (Fed. Cir. 2012) (“The line between a mark that is merely descriptive and may not be registered absent secondary meaning, and one that is suggestive and may be registered, is that a suggestive mark requires imagination, thought, and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods.”) (citations omitted); *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1378 (Fed. Cir. 2017); *Uncommon LLC v. Spigen Inc.*, 926 F.3d 409, 420-21 (7th Cir. 2019).

⁷⁵ *In re Irving Drew Co.*, 297 F. 889 (D.C. Cir. 1924).

⁷⁶ *Id.* at 890.

stated that that “‘Rest’ does mean, among other things, ‘a support, ... as a rest for a foot, a gun rest,’ and when ‘rest’ is used in that sense, and is the designation or part of the designation by which an article or part of an article is commonly known [such as footrest, headrest], it must be regarded as descriptive. There is, however, no part of boots, shoes, or slippers which is commonly known as the arch rest, and from that it follows that ‘arch rest’ cannot be considered as descriptive of such articles.”⁷⁷ The court then referred to cases wherein FLEXIBLE ARCH (referring to a part of a shoe) was found descriptive whereas ARCH BUILDER and HEEL LEVELER were found suggestive. The court summarized the unifying principle in the final line of the opinion: “The *description, the inherent qualities, the characteristics* of boots, shoes, and slippers is one thing, and the *effect* which the use of the articles may produce on the wearer is another.”⁷⁸

In *Allied Mills v. Kal Kan Foods*,⁷⁹ Kal Kan Foods petitioned the TTAB for cancellation of Allied Mills’ mark TAIL WAGGER for dog food on the ground that the mark was merely descriptive of the goods.⁸⁰ It argued: “[Allied Mills] obviously chose to use the words TAIL WAGGER in its advertising slogan and eventually on its packaging material to imply and connote to the public the idea that its dog food tastes so good that dogs will be happy when they eat it. Since dogs cannot actually smile, the way in which they would express this happiness is by wagging their tails.”⁸¹ The TTAB’s response invoked the traditional rule: “We reiterate that neither of [Allied Mills]’s registered marks is merely descriptive of dog food. [Allied Mills]’s marks, at worst, merely suggest one desirable result of feeding the product to a dog, that the dog will be happy and will signify its pleasure by wagging its tail. This is a far cry from mere descriptiveness of dog food.”⁸² Notice that the court did not find the mark suggestive through employment of the degree-of-imagination test; rather, it directly invoked the traditional REF rule.

The case *In re The Noble Co.*⁸³ takes us to the PTO’s active promotion of the REF rule. In the case, The Noble Company (“Noble”), filed a trademark application for NOBURST for nontoxic liquid antifreeze / rust inhibitor solutions.⁸⁴ The application was rejected because the mark was viewed as merely descriptive.⁸⁵ The Board, however, studied the mark closely and concluded that it was suggestive: “In our view, the term NOBURST does not perform as a descriptive term would. It is a shorthand way of suggesting that the product [in its end use] reduces the likelihood that pipes of a water system in which it is used will burst *as a result* of adverse conditions. We do not believe this conclusion is readily arrived at by merely observing the mark on the goods but that it requires interpretation by the viewer.”⁸⁶

⁷⁷ *Id.* at 891.

⁷⁸ *Id.* at 891-92 (D.C. Cir. 1924) (citations omitted, emphasis added).

⁷⁹ *Allied Mills v. Kal Kan Foods*, 203 U.S.P.Q. 390 (T.T.A.B. 1979).

⁸⁰ *Id.* at 390.

⁸¹ *Id.* at 395.

⁸² *Id.* at 396.

⁸³ *In re The Noble Co.*, 1985 WL 72017, 225 U.S.P.Q. 749 (T.T.A.B. 1985).

⁸⁴ *Id.* at *1.

⁸⁵ *Id.*

⁸⁶ *Id.* (emphasis added).

It is critically important to understand how *Noble* has been understood and used by the PTO since the decision was handed down. The TMEP to this day states the degree-of-imagination test and then cites *Noble* in support of the REF rule as follows:

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. ... *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute).⁸⁷

As a result of this characterization of *Noble* in the PTO's own Trademark Manual of Examining Procedure, countless advocates have sought to establish the suggestiveness of their clients' marks through employment of the REF test.

III. THE PROBLEMS WITH THE REF TEST FOR RECOGNIZING SUGGESTIVENESS OF TRADEMARKS.

The problems with the REF test are relatively easy to understand. First, the simple truth is that, as a historic practical matter, many consumers naturally and regularly *describe* products by referring to the "results" or "effects" those goods produce. Second, because trademarking these results / effects labels would implicate the same concerns over public domain misappropriation, term depletion, and IP blurring that are encountered for descriptive marks, the courts should err on the side of protecting the public and characterize these kinds of marks as descriptive (not suggestive). Thus, whether the attributes are described variously as the "results", "effects", "purpose", "function", "end use", "intended use", etc., of the goods, it doesn't matter. In this context, these are all distinctions without a difference.⁸⁸ They all describe an important common attribute of the goods from the vantage point of the consumer, and they should all be presumptively viewed (at least upon initial examination) as species of descriptiveness.

Hereinbelow, the author reviews court and agency decisions that expressly recognized the folly of endeavoring to distinguish between "results" or "effects" on the one hand and "functions," "end uses," "purposes," etc. on the other. A close inspection of these decisions reveals that the REF test longs to be put forcefully to rest.

In *Walgreen Co. v. Godefroy Mfg.*,⁸⁹ appellee Godefroy Mfg. had registered the mark PEAUDOUCE for skin cream, and appellant Walgreen Co. had sought to cancel the registration.⁹⁰ The court took great pains to clarify the two main points of disagreement of the parties. First, while

⁸⁷ See TMEP § 1209.01(a) (entitled "Fanciful, Arbitrary, and Suggestive Marks")

⁸⁸ Cf. Henry Fielding, THE HISTORY OF TOM JONES, A FOUNDLING, Book VI, Ch. 13 (Andrew Millar Publishers, 1749) ("distinction without a difference": one of the earliest uses of this turn of phrase, in one of the earliest English works to be characterized as a novel).

⁸⁹ *Walgreen Co. v. Godefroy Mfg.*, 74 F.2d 127 (C.C.P.A. 1934).

⁹⁰ *Id.* at 127.

appellee agreed that the French word⁹¹ “peau” means “skin”, it disagreed that “douce” means “soft.”⁹² Rather, it contended that the latter term meant “sweet, pleasant, or agreeable” and possibly even “tranquil, easy, affable, or pliant”, terms which would arguably be far less descriptive (and, arguably, far more suggestive).⁹³ Second, the court carefully noted appellee’s central contention: “[T]here is a clear legal distinction between marks which describe the goods themselves and marks which are indicative of results following the use of the goods.”⁹⁴

With the stage now set, and the rule of decision clearly front and center, the reviewing court concluded that the mark was descriptive as it spoke to the intended “purpose and function” of the goods.⁹⁵ Thus, as referenced hereinabove, the court implicitly did two things. First, it implied that there is often a *factual and legal equivalency* between the “results” of use of the goods on the one hand and the “purpose and function” of the goods on the other. In sum, as a practical matter, to the consumer, these often mean the same thing. Second, because it viewed the “purpose and function” of the goods as being *clearly descriptive* of the qualities or characteristics of the goods, it implicitly overruled the REF rule. In essence, it concluded that the interests of the public come first, overruling a putative rule that elevates form and labels (based on “results” or “effects”) over substance. This implicit two-step rejection of the REF rule appears time and again in the later cases closely analyzing the application of the rule.

In *Ex parte The Pennzoil Co.*,⁹⁶ the applicant, The Pennzoil Company (“Pennzoil”), applied to register TOUGH-FILM for lubricating oils, and the PTO rejected the application on the basis of descriptiveness.⁹⁷ The Examiner quoted technical reference works to the effect that it was known that satisfactory lubricants feature an inherent cohesion, surface tension, and / or viscosity that produces a film that resists a tearing apart or breaking in the context of frictionally moving parts that are slidably positioned in relation to one another.⁹⁸

Pennzoil was not deterred. As noted by the court, it argued forcefully as follows:

The appellant argues with considerable force that in view of the “Arch Rest” case, *In re The Irving Drew Co.*, 54 App. D. C. 310, 297 Fed. 889, that the descriptiveness, if any, does not apply to the goods on which the trademark is used, but rather to an effect, and further urges that the word ‘FILM’ has a fixed meaning in the arts and that there is nothing in the oil as sold that can be called film. Appellant says that ‘an article must be defined by what it is and not by what can be made out of it.’ In short, the position of the applicant is that it is apparent that neither the word ‘TOUGH’ nor ‘FILM’ are

⁹¹ The reader should note that the general rule of the U.S. Patent and Trademark Office (and the courts) in evaluating descriptiveness is that all foreign words and phrases are translated into English and then evaluated. The reason is simple. The people of the United States speak many languages, and many are bilingual. Thus, whether they encounter the mark SPEEDY CLEANERS or its Spanish equivalent LIMPIADORES RAPIDOS, the meaning of the mark and its relationship to the goods is the same. Terms from dead languages (such as Latin) that are not in actual current use in society often avoid this unhappy result.

⁹² Walgreen Co., *supra* note 89, at 127.

⁹³ *Id.* at 128-29.

⁹⁴ *Id.* at 128.

⁹⁵ *Id.* at 129.

⁹⁶ *Ex parte The Pennzoil Co.*, 36 U.S.P.Q. 109, 1937 WL 25849 (Com’r Pat. & Trademarks, 1937).

⁹⁷ *Id.* at *1.

⁹⁸ *Id.*

descriptive of oil, but ‘at most are merely suggestive of a desirable condition to be produced by use in connection with frictionally moving parts slidable with relation to each other.’ Applying the *Irving Drew Co.* case, appellant says that it may be paraphrased to fit the present case as follows: ‘The description, the inherent qualities, the characteristics of oil is one thing and the effect which the use of the oil may produce on working parts is another.’”⁹⁹

The court was unimpressed. It stated:

I cannot agree that this case nor the reasoning of the applicant is sufficient to overcome the impression I have that the words ‘TOUGH-FILM’ applied to motor oil are clearly descriptive within the meaning of the statute and must be refused registration. *In my opinion, descriptiveness may apply to use or results, as well as to the particular nature of the goods themselves.* ... In the present case, the oil sold does form a film when used and *the toughness of this film as understood by the purchaser is a desirable quality* and is a natural and apt term to apply to such a film.¹⁰⁰

Thus, in *Pennzoil*, one can argue that the court *expressly* adopted the two-step model (described above) for rejection of the REF rule. First, the court expressly called out the factual and legal equivalency (in the mind of the purchaser) between the “use” or “results” of the goods on the one hand and the “particular nature” of the goods on the other. It then noted that, to the purchaser, the resulting “toughness” of the film was indeed a “desirable quality” (a descriptive property) of the goods.

In *In re W.A. Sheaffer Pen Co.*,¹⁰¹ the applicant, W.A. Sheaffer Pen Co. (“Sheaffer”), applied to register FINELINE for mechanical pencils, and the PTO rejected the application on the basis of descriptiveness.¹⁰² As noted in the following passage, the court observed that Sheaffer’s counsel did an admirable job of forcefully arguing for the application of the REF rule and a finding of suggestiveness:

Appellant argues that its mechanical pencil, or the lead used therein, does not necessarily make a fine line, that FINELINE denotes an attribute which becomes apparent only when the article is used; and that a description of the goods does not by any stretch of the imagination include a line, fine or otherwise.

Appellant argues further in its brief that... Appellant’s pencils and leads may or may not make a line that could be described as “fine”, depending on the manner in which the pencil is manipulated, the

⁹⁹ *Id.* at *1-*2.

¹⁰⁰ *Id.* at *2.

¹⁰¹ *In re W.A. Sheaffer Pen Co.*, 158 F.2d 390 (C.C.P.A. 1946).

¹⁰² *Id.* at 390-91.

texture and hardness of the lead employed, and the standards of comparison used.¹⁰³

The court agreed in part: “It is true that appellant’s mark *does not describe* a mechanical pencil.”¹⁰⁴ However, the court then held:

The *purpose* for which it is used, however, is to make a written line, and it is clear from the facts presented in the record that appellant’s pencil, and the lead therein, *when used for its intended purpose*, does *produce* and include a line which by relative standards of comparison is properly described or characterized as ‘fine’. Appellant’s mark as correctly held by the Commissioner of Patents conveys the information that its pencil will produce that line.

Words which are merely descriptive of the goods with which they are used, or the character or quality thereof, or the *purpose* for which they are used, shall not be registered...¹⁰⁵

Thus, on the facts, the court simply rejected the applicant’s arguments that its pencils might be used to make lines that are either fine or coarse. Instead, it appeared to assign a purpose to the goods from a capability inherent in the goods as a result of their design.

More fundamentally and importantly, however, as in the case of *Pennzoil*, the *Sheaffer* court implicitly applied the two-step model (described above) for rejection of the REF rule. It equated the “purpose” of the goods with the “result” produced (the line “produced”) by the goods, and, because marks relating to the “purpose” of the goods are descriptive, it found FINELINE to be descriptive as well.

In *L’Erin Cosmetics v. Max Factor & Co.*,¹⁰⁶ L’Erin Cosmetics (“L’Erin”) used the mark LIP RENEWAL CRÈME for a cream applied to the lips before the application of lipstick, so as to moisturize and condition the lips and to prevent lipstick from running and bleeding.¹⁰⁷ Max Factor & Co. (“Max Factor”) later announced that it would be launching an identical product under the mark LIP RENEW.¹⁰⁸ During the litigation, L’Erin argued that LIP RENEWAL CRÈME was suggestive, while Max Factor argued that it was either descriptive or generic.¹⁰⁹ The court found a legal equivalency between the purpose or intended use of the product and the end result obtained: “When ‘renew’ is understood in this usual and normal sense, the mark Lip Renewal Creme provides an apt description of a product that, among other things, ‘repairs lips,’ ‘reduces tiny wrinkles around the mouth,’ ‘conditions lips to be softer and smoother,’ and ‘improves the appearance and texture of the lips.’ In short, Lip Renewal Creme conveys to consumers the *use* and qualities of the product. No imagination or thought is needed to understand that Lip Renewal

¹⁰³ *Id.* at 391.

¹⁰⁴ *Id.* (emphasis added).

¹⁰⁵ *Id.* (emphasis added).

¹⁰⁶ *L’Erin Cosmetics v. Max Factor & Co.*, 1984 WL 63635, 223 U.S.P.Q. 1301 (D. Del. 1984).

¹⁰⁷ *Id.* at *1.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

Crème is a product that revitalizes and restores the lips.”¹¹⁰ Thus, as stated, the court found L’Erin’s mark to be descriptive.

In *In re Reynolds*,¹¹¹ the PTO had rejected applicant Reynolds’ trademark application for the mark LOTSA SUDS for liquid dishwashing cleaner.¹¹² Reynolds pointed out on appeal to the TTAB that its goods were not suds, that suds are not useful in the washing of dishes, and that, as such, its mark is suggestive.¹¹³ The TTAB concluded that, whether suds are actually useful or not in the cleaning of dishes is irrelevant, because Reynolds had represented that they were: “[A]ppellant’s claim here... that the suds have no performance function at all in washing dishes appears to be inconsistent with its ‘extra sudsing power’ claim.”¹¹⁴ Thus, according to the TTAB, Reynolds had represented to its consumers that one function of dishwashing liquid is the production of suds, because that facilitates the cleaning of dishes. And, because the performance of this function is a characteristic – a descriptive characteristic – of the product, the mark is descriptive, not suggestive.¹¹⁵ Here, the legal equivalency was focused on function (rather than purpose) as contrasted with result, but the ultimate legal conclusion was the same.

IV. CONCLUSION / CALL TO THE COURTS AND THE US PTO.

The conclusion to be drawn from the case law, taken as a whole, could not be more clear. Even if one can fashion an argument that a mark speaks to the “results or effects” produced by the goods or services to which it is applied, it is often also the case that such a mark is primarily descriptive in character. That is, the mark is just as descriptive as those marks (also commonly characterized as descriptive) that speak to the “purpose, function, or intended use” of the goods or services.

The failure of the courts and the U.S. Patent and Trademark Office to forcibly renounce the REF test results in two separate kinds of harm. First, many unwitting applicants and less-experienced trademark practitioners see the guidance provided by the PTO, and they rely upon it, only to encounter a forceful rejection by experienced PTO examiners who aren’t fooled by the test (that is, examiners who ignore the guidance provided by the TMEP and issue a forceful descriptiveness rejection). If the guidance provided by the courts and PTO had been clearly, widely, and publicly corrected previously, the applicant would have saved a great deal of time, effort, and money. (This harm works perhaps its greatest injustice against our nation’s entrepreneurs who finance their trademark registration activities through the use of scarce funds.) Second, the dockets of PTO examiners are needlessly clogged, and the pace of application examination retarded, by the repeated, regularized flow of applications filed in reliance upon this hopelessly outdated and erroneous test.

The steps to be taken by the courts and the U.S. Patent and Trademark Office are manifest. When courts are confronted with REF test – based arguments for a finding of suggestiveness of a mark at issue, they should: (a) expressly reject the REF test as an improvident / misleading one; and then (b) conduct a tailored analysis of the nature of the mark and its associated goods and services based on the specific circumstances of the case. The U.S. Patent and Trademark Office

¹¹⁰ *Id.* at *3.

¹¹¹ *In re Reynolds*, 1986 WL 83683, 229 U.S.P.Q. 776 (T.T.A.B. 1986).

¹¹² *Id.* at *1.

¹¹³ *Id.* at *2.

¹¹⁴ *Id.*

¹¹⁵ *Id.*

should revise its Trademark Manual of Examining Procedure by removing / deleting the reference to the REF test in §1209.01(a) and anywhere else it appears.

To be clear, this article should NOT be construed as establishing the contrary rule, namely, that marks speaking to results or effects produced should *automatically* be categorized as descriptive. Such a proposal would effect a cure no less pernicious than the disease.

Rather, the best result is to recognize that, in the case of the REF test, the courts experimented with drawing a distinction between “purpose or function” on the one hand and “results or effects” on the other for the purpose of providing another useful guideline for distinguishing between descriptive and suggestive marks. While experimentation is indeed quite often the mother of progress, it is also true that not every experiment is a success. The use of the results or effects of the goods as a consistent touchstone for suggestiveness in trademarks is an experiment that has failed. Today, almost exactly 100 years since *Irving Drew* was first handed down, it is high time that the decisions of the courts and the U.S. Patent and Trademark Office’s official guidance in the TMEP officially and forcefully recognize that.

The author respectfully submits that we have followed our path and beheld a branch impeding our progress. It is now incumbent upon us to clear that obstacle for those that follow.