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VISUAL METAPHOR AND TRADEMARK DISTINCTIVENESS

Dustin Marlan*

Abstract: Perhaps because words are the lawyer's principal instrument, the law gives too little attention to visual images. Invoking Justice Potter Stewart's infamous statement regarding the law's inability to define obscenity, "I know it when I see it" is the standard for interpreting images in the law. A greater understanding of the ways in which images make meaning is needed, however, including in trademark law given our increasingly visual economy.

This Article examines images in the context of trademark law's inherent distinctiveness doctrine. While trademark law still lacks a coherent, uniform, and predictable framework for deciding the distinctiveness of visual image marks—logos and product packaging—it has long used the "imagination" test to effectively determine a word mark's distinctiveness. Under the imagination test, immediately protectable word marks must operate in a metaphorical relationship to the words from which they are drawn (i.e., as figures of speech), requiring consumers to use their imagination to reach a conclusion as to the nature of the goods or services offered under the marks (e.g., "Klondike" for ice cream and "Greyhound" for a bus service). This makes sense because the first requirement of a valid trademark is that it be a "symbol," and, as this Article shows, the basic characteristic of any symbol is its figurative quality. Research in conceptual metaphor theory finds, though, that metaphor is "primarily a matter of thought and action and only derivatively a matter of language." Indeed, brands rely not just on *verbal* metaphor, but also on *visual* metaphor to differentiate themselves from competitors in the marketplace (e.g., Target's "bullseye" and Starbucks's "siren").

This Article thus claims that visual metaphor provides a figurative, cognition-based vehicle by which to extend trademark law's imagination test of inherent distinctiveness from words to images. In doing so, it conceives of metaphorical association as a central consideration in analyzing the inherent distinctiveness of both word and image marks.

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INTRODUCTION	768
I. CONCEPTUAL METAPHOR AND THE FIGURATIVE DIMENSIONS OF COMMERCE	776
A. Conceptual Metaphor Theory	778
B. Verbal and Visual Metaphor in Advertising and Branding	781
C. Trade Symbolism	789
II. VERBAL METAPHOR AND THE DISTINCTIVENESS OF WORD MARKS	794
A. The <i>Abercrombie</i> Spectrum	795
B. The Imagination Test	799
C. Alternative Tests for Determining Inherent Distinctiveness	802
III. VISUAL METAPHOR AND THE DISTINCTIVENESS OF IMAGE MARKS	804
A. Image Marks: Logos and Trade Dress	805
B. Current Tests for Determining the Inherent Distinctiveness of Image Marks Are Insufficient	807
C. Proposal: An Imagination Test of Visual Metaphor ..	814
1. The Representation of a Person, Place, Thing, or Idea	819
2. By Means of a Visual Image	820
3. That Suggests a Particular Association or Point of Similarity as to Its Underlying Goods or Services	821
IV. POTENTIAL OBJECTIONS	822
A. Abstraction	822
B. Import of the Imagination Test	823
C. Symbolic Consumption	824
CONCLUSION	825

What we call a symbol is a term, a name, or even a picture that may be familiar in daily life, yet that possesses specific connotations in addition to its conventional and obvious meaning.

—C.G. Jung¹

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.

—Frankfurter, J.²

INTRODUCTION

We live in an age where visual images dominate commerce and branding, yet trademark law fails to properly analyze image marks (e.g., logos and product packaging).³ The Patent and Trademark Office classifies all trademark applications into reductive word-based categories.⁴ Even the leading trademark treatise, invoking Justice Potter Stewart's infamous statement regarding the law's inability to define obscenity,⁵ resorts to "I know it when I see it" judgments in determining the similarity of appearance between image marks.⁶ Rebecca Tushnet, one of few intellectual property scholars to squarely address images, aptly

1. CARL G. JUNG, *MAN AND HIS SYMBOLS* 3 (5th prtg. 1971).

2. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 203 (1942).

3. See *infra* section III.B.

4. See, e.g., Donna K. Hopkins, *Searching for Graphic Content in USPTO Trademark Databases*, 25 *WORLD PAT. INFO.* 107, 107–08 (2003) (explaining the PTO's trademark classification system of design codes, which relies largely on using words to describe image marks); Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 *HOUS. L. REV.* 861, 873 (2011) ("Images enter into this legal system, not exactly as an afterthought, but as a category in need of discipline through words. Registration for trademarks, unlike that for copyrights, involves entry into a detailed classification scheme and, therefore, requires all marks to be described in words, at least in part.").

5. *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) ("I know [obscenity] when I see it.").

6. 4 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:25, at 23–166 ("Obviously, for picture and design marks (as opposed to word marks), similarity of appearance is controlling. There is no point in launching into a long analysis of the judicial pros and cons regarding visual similarity of marks. Regarding visual similarity, all one can say is 'I know it when I see it.'" (footnotes omitted)) [hereinafter 4 MCCARTHY]; see also *id.* at 23–165 ("Similarity of appearance between marks is really nothing more than a subjective 'eyeball' test." (footnote omitted)); cf. Tushnet, *supra* note 4, at 876 (remarking that the eyeball test "is a statement about power: it is infringement when the fact finder sees infringement. It's also, therefore, necessarily a statement about unpredictability").

notes that “images can make claims, just as words do.”⁷ Words, however, remain “the prototypical regulatory subjects for trademark and advertising law, despite our increasingly audiovisual economy.”⁸

As such, trademark law has long used the “imagination” test to distinguish descriptive word marks, which are unprotectable absent secondary meaning, from distinctive ones eligible for protection upon first use in commerce.⁹ Under the imagination test, a word mark is considered *inherently* distinctive if the mark is a *verbal* metaphor (i.e., a figure of speech) that suggests qualities, values, or aesthetics relating to its associated product or service.¹⁰ Examples include “Klondike” for ice

7. Tushnet, *supra* note 4, at 917; *see also* Rebecca Tushnet, *A Mask that Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157, 157–204 (2015) (explaining that the law, whose prototypical object of regulation is words, has difficulty when governing images—including in the context of the right of publicity); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 685 (2012) (“Taking words as the prototypical subject matter of copyright has continuing consequences for copyright law, which often misconceives its object, resulting in confusion and incoherence.”).

8. Tushnet, *supra* note 4, at 862; *see also* Elizabeth G. Porter, *Taking Images Seriously*, 114 COLUM. L. REV. 1687, 1699 (2014) (“Words, not images, are a lawyer’s most essential tool.”).

9. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 4–9 (2d Cir. 1976).

10. *See, e.g.*, *Synergistic Int’l, Inc. v. Windshield Doctor, Inc.*, No. CV 03-579 FMC (CWx), 2003 U.S. Dist. LEXIS 12660, at *13 (C.D. Cal. Apr. 28, 2003) (finding the mark “Glass Doctor” for glass installation and repair services to be suggestive given the “creative metaphorical combination of the terms ‘Doctor’ and ‘Glass’”); *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 196 (S.D.N.Y. 2000) (“When choosing what to call the article, the creator of the suggestive name meaningfully fixes upon associational terms that will identify the product figuratively and will appeal to the consumer by allusion and metaphor.”); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 671 (2004) (“Suggestive marks, such as ATLAS for moving services or ROACH MOTEL for insect traps, are textbook metaphors and are described as such by the doctrine.”); Laura A. Heymann, *A Name I Call Myself: Creativity and Naming*, 2 U.C. IRVINE L. REV. 585, 603 (2012) [hereinafter Heymann, *A Name I Call Myself*] (“[T]he inherent strength of a mark (and therefore whether it gets protection ab initio or requires additional evidence) depends on how creative the mark is. The mark might be a commonplace and dull description of the good’s qualities or characteristics (and therefore might need to be used by others), or use metaphor to suggest a good’s characteristics, or create a new meaning for an existing word.”); Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1330 (2010) [hereinafter Heymann, *The Grammar of Trademarks*] (“[T]he concept of metaphor is fundamental to how most trademarks work. Except for words invented to serve as trademarks—such as ‘Kodak’ and ‘Xerox’—all trademarks, being words in the English language, operate on a level other than a literal one in that they require consumers to use a familiar word or expression in a new and initially unfamiliar context.”); Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Marks*, 76 OHIO ST. L.J. 1367, 1372 n.29 (2015) (“Suggestive marks are . . . metaphorically related to the good or service sold, like using GLEEM to sell toothpaste indirectly invokes the bright, shiny quality one could expect from thoroughly cleaned teeth.”); *cf.* Alexandra J. Roberts, *How to Do Things with Word Marks: A Speech-Act Theory of Distinctiveness*, 65 ALA. L. REV. 1035, 1048 (2014) (arguing that “fact finders often focus unduly on mark selection, fixing on the employment of double entendre, incongruity, rhyme, metaphor, alliteration, or other rhetorical device as evidence that a mark is distinctive”).

cream and “Greyhound” for bus services. Because marks are symbols¹¹—and the sine qua non of a symbol is its figurative quality¹²—trademark law properly uses a figure of speech as its doctrinal trigger in evaluating the distinctiveness of word marks. Yet, despite our increasingly visual

11. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995) (explaining the “requirements for qualification of a word or symbol as a trademark are that it be (1) a ‘symbol,’ (2) ‘use[d] . . . as a mark,’ (3) ‘to identify and distinguish the seller’s goods from goods made or sold by others,’ but that it not be ‘functional’” (emphasis added) (citing 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.1 (4th ed. 2002) [hereinafter 1 MCCARTHY])); *see also*, e.g., *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (“The protection of trade-marks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.”); *Duraco Prods., Inc. v. Joy Plastics Enters., Ltd.*, 40 F.3d 1431, 1440 (3d Cir. 1994) (noting that a distinctive trademark or trade dress must be “a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product)”; *Deere & Co. v. MTD Prods., Inc.*, 860 F. Supp. 113, 120 (S.D.N.Y. 1994), *aff’d*, 41 F.3d 39 (2d Cir. 1994) (“Trademarks are symbols—symbols of products and their origins. When a trademark is successfully employed, favorable associations accrue not only to its referent—the product or source for which the trademark stands—but also to the trademark itself.”); Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 124 (1996) (noting author’s criticism of “case law for paying insufficient attention to the expressive dimension of trademarks, to their powerful role in the vocabulary as metaphors and symbols”). *See generally* Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301–40 (1992).

12. 4 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 17:1 (4th ed. 2002). Beyond the law of trademarks, the figurative requirement of the symbol is consistent across disciplines. Noteworthy definitions include the following by experts in hermeneutics, mythology, psychoanalysis, theory of metaphor, and narrative theory. *See* JOSEPH CAMPBELL, *THE SYMBOL WITHOUT MEANING* 153 (1958) (“[A] symbol, like everything else, shows a double aspect. We must distinguish, therefore between the ‘sense’ and the ‘meaning’ of the symbol.”); JOLANDE JACOBI, *COMPLEX/ARCHETYPE/SYMBOL IN THE PSYCHOLOGY OF C.G. JUNG* 77 (Ralph Manheim trans., 1959) (equating the terms “symbol” and “metaphor,” and noting that “[t]he word symbol (*symbolon*), derived from the Greek verb *symbollo*, has long been the object of the most diverse definitions and interpretations. But all these definitions and interpretations are agreed that symbols present an objective, visible meaning behind which an invisible, profounder meaning is hidden” (emphasis in original)); JUNG, *supra* note 1, at 3 (“What we call a symbol is a term, a name, or even a picture that may be familiar in daily life, yet that possesses specific connotations in addition to its conventional and obvious meaning.”); Paul Ricoeur, *Existence and Hermeneutics*, in *THE CONFLICT OF INTERPRETATIONS: ESSAYS IN HERMENEUTICS* 3, 12–13 (Don Ihde ed., Kathleen McLaughlin trans., 1974) (“I define ‘symbol’ as any structure of signification in which a direct, primary, literal meaning designates, in addition, another meaning which is indirect, secondary, and figurative and which can be apprehended only through the first.” (emphasis omitted)); HEINRICH R. ZIMMER, *PHILOSOPHIES OF INDIA* 1–2 (1951) (“Concepts and words are symbols, just as visions, rituals, and images are; so too are the manners and customs of daily life. Through all of these a transcendent reality is mirrored. They are so many metaphors reflecting and implying something which, though thus variously expressed, is ineffable, though thus rendered multiform, remains inscrutable.”).

economy, the trademark regime lacks a coherent, uniform, and predictable mechanism for deciding the distinctiveness of image marks.¹³

However, insights in cognitive linguistics and psychology reveal that “metaphor” does not refer merely to figurative language, but instead to a fundamental mode of thought characterized as understanding one concept “in terms of another.”¹⁴ And, in addition to verbal metaphor, modern brands rely heavily on *visual* metaphor—the visual representation of metaphorical concepts and thoughts—to differentiate themselves in the

13. See, e.g., *Forney Indus. v. Daco of Mo., Inc.*, 835 F.3d 1238, 1245 (10th Cir. 2016) (“The law relating to whether a trademark is inherently distinctive is more developed for word marks than it is for trade dress.”). Certain courts apply the *Abercrombie* spectrum to image marks. See, e.g., *McNeil Nutritionals, LLC v. Heartland Sweeteners LLC*, 566 F. Supp. 2d 378, 389 (E.D. Pa. 2008); *Best Cellars, Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431, 451 (S.D.N.Y. 2000). Other courts apply the *Seabrook* test. See, e.g., *Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312, 1323 (11th Cir. 2012); *Mattel, Inc. v. MGA Entm’t, Inc.*, 782 F. Supp. 2d 911, 1004 (C.D. Cal. 2010). Yet others apply both tests. See, e.g., *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 42 (1st Cir. 2001); *Ashley Furniture Indus. v. Sangiacomo N.A.*, 187 F.3d 363, 370–71 (4th Cir. 1999). Still others apply neither. See, e.g., *Forney Indus.*, 835 F.3d at 1245–46, 1252; *Mexican Food Specialties, Inc. v. Festida Foods, Ltd.*, 953 F. Supp. 846, 851 (E.D. Mich. 1997).

14. GEORGE LAKOFF & MARK JOHNSON, *METAPHORS WE LIVE BY* 5 (1980) (emphasis omitted); see also CHARLES FORCEVILLE, *PICTORIAL METAPHOR IN ADVERTISING* 4–6 (1996); Jacqueline C. Hitchon, *The Locus of Metaphorical Persuasion: An Empirical Test*, JOURNALISM & MASS COMM. Q. 55, 64 (1997); Edward F. McQuarrie & Barbara J. Phillips, *Indirect Persuasion in Advertising: How Consumers Process Metaphors Presented in Pictures and Words*, 34 J. ADVERT. 7, 9 (2005).

marketplace.¹⁵ Examples include Apple's logo,¹⁶ Starbucks's siren,¹⁷ and Nike's swoosh.¹⁸ As with verbal metaphor in the word mark context, use of visual metaphor enables an image mark to serve as an inherent source identifier by (1) denoting (referring literally to) a brand, as well as (2)

15. LAKOFF & JOHNSON, *supra* note 14, at 204; *see also* FORCEVILLE, *supra* note 14, at 5–7; Hitchon, *supra* note 14, at 74; McQuarrie & Phillips, *supra* note 14, at 9.

16.



Apple, Inc., Apple Logo, 1998; Tiziano Vecellio, *The Fall of Man*, 1550.

17.



Starbucks Corp., Starbucks Logo, 2011; Audio2Visual Contest, *A Siren's Call: A Little Bit Closer*, Contest Image, 2014, https://www.flickr.com/photos/rinoa_cathcart [<https://perma.cc/BV7Q-8ZLT>].

connoting (suggesting or implying, but not describing) characteristics associated with a marked product or service.¹⁹

This Article thus argues that visual metaphor provides a figurative, cognition-based vehicle by which to extend trademark law's imagination test from word to image marks. To this end, it proposes a test to decide the validity of an image mark—at least in part and where at issue—on whether the image contains a visual metaphor, i.e., able to convey one or more positive features or connotations about its associated product or service. In this way, the Article conceives of metaphor, in its conceptual aspect, as a central consideration in analyzing inherent distinctiveness regardless of the type of trade symbol at issue.

This Article proceeds as follows. Part I explains that metaphor is fundamental to thought and is used prominently in advertising. It first marshals cognitive linguistics and psychology research, finding that “metaphor” does not refer merely to figurative language, but rather to a phenomenon of thought capable of visual expression. It next demonstrates how conceptual metaphor, especially in its visual aspect, is used in advertising and branding as an attractive means of drawing consumer attention. Part I lastly discusses the function of the trademark as a symbol and thus its deep-seated connection to metaphor.

Part II examines verbal metaphor as it relates to the distinctiveness of word marks. It first demonstrates the *Abercrombie* spectrum to be a “hierarchy of figurativeness.” This Part next discusses the imagination test

18.



Nike, Inc., Nike Logo, 1995; *Nike, Goddess of Victory*, 500 B.C.E.

19. See Jake Linford, *Are Trademarks Ever Fanciful?*, 105 GEO. L.J., 731, 737–38 (2017) (“Trademarks operate on at least these two levels. First, the mark denotes source—it indicates ‘a single thing coming from a single source.’ Second, because the mark points to a consistent, if anonymous source, it also connotes or hints at qualities of the marked product. What the mark denotes and connotes in turn is determined in part by the symbol appropriated for use as a trademark.”).

as an implicit test of a word mark's metaphorical significance. Part II concludes by examining some lesser-used alternatives to the imagination test—the dictionary test and the competitor's need test.

Part III applies visual metaphor to image marks. It provides relevant background on image marks—logos and trade dress. It next describes current tests for the inherent distinctiveness of image marks and concludes that each is inadequate. Part III lastly proposes instead a test of threshold validity, when at issue, based on metaphor theory. To this end, it proposes that trademark law adopt a definitional test of visual metaphor to decide the validity of an image mark based, at least in part, on whether it is (1) the representation of a person, place, thing, or idea, (2) by means of a visual image, (3) that suggests a particular association or point of similarity as to its underlying product or service.

Part IV responds to three potential objections to the use of visual metaphor as a test for inherent image mark distinctiveness: that such a test (1) is unduly abstract and subjective, (2) seeks to extend an incoherent word mark framework, and (3) wrongly promotes “symbolic consumption,” or the tendency of consumers to focus on meanings beyond the tangible characteristics of goods and services to a deleterious effect on culture. Part V concludes the Article.

A note on terminology before proceeding. This Article uses the term “metaphor” in the spirit of conceptual metaphor theorists George Lakoff and Mark Johnson's formulation: “[t]he essence of metaphor is understanding and experiencing one kind of thing in terms of another.”²⁰ This broad conceptualization of metaphor involves comparisons or systems of concepts where one thing is understood in terms of another, or which are deviations from the literal use of a word or concept.²¹ These may also include analogy, simile, wordplay, and pun. An example of a conceptual metaphor employed as a trademark is the word mark GREYHOUND, or alternatively the visual image of a greyhound, for bus services. The term “greyhound” or its visual depiction each clearly suggest the efficient nature of the services offered. However, a conceptual metaphor in the trademark sense might also consist of an incongruity, as

20. LAKOFF & JOHNSON, *supra* note 14, at 5 (emphasis omitted); *cf.* *Metaphor*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/metaphor> [<https://perma.cc/Z6HD-5E8H>] (“[A] figure of speech in which a word or phrase literally denoting one kind of object or idea is used in place of another to suggest a likeness or analogy between them (as in drowning in money); broadly: figurative language—compare simile.”).

21. *See, e.g.*, McQuarrie & Phillips, *supra* note 14, at 9 (adapting this broad view of metaphor and applying it in the advertising context).

is typical of arbitrary marks. For example, consider the word mark CHERRY, or alternatively the visual image of a cherry, used in connection with hammers or other hand tools.²² In this way, figurative language or thought may be applied in branding, for rhetorical effect, in a manner that significantly departs from conventional usage.²³

I. CONCEPTUAL METAPHOR AND THE FIGURATIVE DIMENSIONS OF COMMERCE

This Part reviews conceptual metaphor theory and its application to advertising and branding and trade symbols. Section I.A examines metaphor as a phenomenon of thought rather than of figurative language. It lays foundation for the claim that trademark law's imagination test has applicability to image marks through use of visual metaphor. Indeed, metaphor has been called "the language of the imagination."²⁴ The word metaphor is derived from the Greek words "meta," meaning "over," and "pherein," or "to carry."²⁵ This "carrying over" describes the import of one concept to another, which results in a meaning that integrates the two. As the founders of conceptual metaphor theory, cognitive linguist George Lakoff and philosopher Mark Johnson, explain, "the essence of metaphor

22. Many thanks to Laura Heymann for suggesting this point of clarification.

23. The Article also draws a distinction between a metaphor and a metonym. Metonyms—like metaphors—are technically figurative rather than literal depictions. But, instead of understanding one thing in terms of another as with metaphor, a part stands for a whole or vice versa in metonymy. Examples of metonyms include the statements "the White House announced today . . ." and "she's just a pretty face," or referring to a business executive as a "suit." For a thorough discussion of the differences between metaphor and metonymy, see generally, for example, METAPHOR AND METONYMY AT THE CROSSROADS: A COGNITIVE PERSPECTIVE (Antonio Barcelona ed., 2003); METAPHOR AND METONYMY IN COMPARISON AND CONTRAST (René Dirven & Ralf Pörings eds., 2002). Research suggests that metonyms in trademark law can be equated at least roughly with descriptive—inherently non-distinctive—word marks that have a contiguous connection with their underlying product or service. While perhaps capable of serving as inherent source-identifying symbols due to their figurative nature, descriptive marks are thought under trademark law to be needed by market competitors, and are thus, at least for this reason, disallowed protection without first attaining secondary meaning in the marketplace. See Linford, *supra* note 10, at 1402 ("Selecting a descriptive mark, which is metonymically related to the product identified, or a suggestive mark, which is metaphorically related to the product, connects the mark to the product in a manner that will readily allow consumers to slip between source-signifying and product-designating meanings."). This Article does not endorse, nor challenge, the initial invalidity of descriptive word marks. For a challenge of this nature, see generally Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003).

24. Robert Lake, *Metaphor: The Language of the Imagination*, 9 J. IMAGINATION LANGUAGE LEARNING 125 (2011).

25. TERENCE HAWKES, METAPHOR 1 (1972).

is understanding and experiencing one kind of thing in terms of another.”²⁶ And, “[n]othing in the fundamental definition of a figure either requires a linguistic expression or precludes a visual expression.”²⁷

Section I.B examines the use of metaphor in advertising and branding. Brands rely heavily on both verbal and visual metaphors.²⁸ On a conceptual level, metaphors can be used to connect brand and product by creating linkages in meaning by mapping across source and target domains. More concretely, research in consumer psychology suggests that use of metaphor in a word or image mark’s design contributes to its (1) vividness, (2) differentiation in the marketplace, and (3) personality—and thus, as relevant for trademark law purposes, the mark’s source identification function.

Section I.C. discusses the role of trademarks as trade symbols. Trademarks are symbols.²⁹ The sine qua non of a symbol is its figurative quality.³⁰ With the exception of fanciful marks, distinctive trademarks function as source identifiers by *denoting* the source, as well as *connoting* qualities, values, or aesthetics of their associated product or service (or acquire secondary meaning in the marketplace such that it comes to acquire a connotation even lacking such figurative conceptual significance).³¹ In this way, metaphor enables word or image marks to

26. LAKOFF & JOHNSON, *supra* note 14, at 5 (emphasis omitted); *see also, e.g.*, STEVEN PINKER, *THE STUFF OF THOUGHT: LANGUAGE AS A WINDOW INTO HUMAN NATURE* 276 (2007) (“[M]etaphor really is a key to explaining thought and language.”); GERALD ZALTMAN & LINDSAY H. ZALTMAN, *MARKETING METAPHORIA* 38 (2008) (“In its earliest form, thought is dependent on metaphorical modes.” (quoting GERALD M. EDELMAN, *SECOND NATURE: BRAIN SCIENCE AND HUMAN KNOWLEDGE* (2006))).

27. Edward F. McQuarrie & David G. Mick, *Visual Rhetoric in Advertising: Text-Interpretive, Experimental, and Reader-Response Analyses*, 26 J. CONSUMER RES. 37, 39 (1999) (citing E.H. GOMBRICH, *ART AND ILLUSION: A STUDY IN THE PSYCHOLOGY OF PICTORIAL REPRESENTATION* (1960)); *see also* Linda M. Scott, *Images in Advertising: The Need for a Theory of Visual Rhetoric*, 21 J. CONSUMER RES. 252, 264 (1994) (noting that visual figures in advertising in fact have roots in art history).

28. *See, e.g.*, Se-Hoon Jeong, *Visual Metaphor in Advertising: Is the Persuasive Effect Attributable to Visual Argumentation or Metaphorical Rhetoric?*, 14 J. MARKETING COMMS. 59, 60 (2008) (citing Pradeep Sopory & James P. Dillard, *The Persuasive Effects of Metaphor: A Meta-Analysis*, 28 HUM. COMM. RES. 382 (2002)).

29. *See, e.g.*, *supra* note 11.

30. *See, e.g.*, *supra* note 12.

31. *See, e.g.*, Linford, *supra* note 19, at 731; Nabil Mzoughi & Samar Abdelhak, *The Impact of Visual and Verbal Rhetoric in Advertising on Mental Imagery and Recall*, 2 INT’L J. BUS. SOC. SCI. 257, 257 (2011) (explaining that an advertisement is composed of literal (denoted) and symbolic (connoted) dimensions and that therefore “creative advertising is based on the transposition of rhetorical figures to image advertising” (citing Jacques Durand, *Rhétorique et Image Publicitaire*, 15 COMM. 70, 70–95 (1970))).

create linkages between a product or service and its source. This allows the marks to function effectively as symbols and for consumers to then derive inherent meaning from them even at first use.

A. *Conceptual Metaphor Theory*

The traditional definition of metaphor is a figure of speech, where a word that literally means one idea or object is used in place of another word to suggest a likeness or analogy between the two ideas or objects.³² Examples of metaphors in this linguistic sense include “drowning in money” and “bleeding heart.”³³ However, as early as the 1930s, at least one scholar noted that “fundamentally [metaphor] is a borrowing between and intercourse of *thoughts*, a transaction between contexts. *Thought* is metaphoric, and proceeds by comparison, and the metaphors of language derive therefrom.”³⁴ In the 1980s, conceptual metaphor theorists began to define metaphor as an essentially cognitive phenomenon that structures much of human thought.³⁵ In conceptual metaphor theory, the focus of metaphor is no longer on words and language. Instead, it is on understanding how one idea or concept can be understood in terms of another one, i.e., “A is B.”³⁶ Hence, any form of communication may be seen as an instance of metaphor, provided that it induces metaphorical thought processes. This view of metaphor as a cognitive—rather than linguistic—occurrence also has empirical backing.³⁷

32. See, e.g., *Metaphor*, MERRIAM-WEBSTER, *supra* note 20. This definition can be traced back to Aristotle’s *Poetics*: “[m]etaphor is the application of an alien name by transference either from genus to species, or from species to genus, or from species to species, or by analogy, that is, proportion.” ARISTOTLE, *POETICS* (S.H. Butcher trans., 1902), <http://classics.mit.edu/Aristotle/poetics.mb.txt> [<https://perma.cc/Q6LH-UXVB>].

33. ARISTOTLE, *supra* note 32.

34. I.A. RICHARDS, *THE PHILOSOPHY OF RHETORIC* 94 (1965).

35. See generally LAKOFF & JOHNSON, *supra* note 14; see also MULTIMODAL METAPHOR 3 (Charles J. Forceville & Eduardo Urios-Aparisi eds., 1996); Hitchon, *supra* note 14, at 55; McQuarrie & Phillips, *supra* note 14, at 9 (“[S]ome researchers have hypothesized that metaphor does not occur at the surface level of representation (i.e., pictures versus words), but rather at the level of cognitive thought.”).

36. See Robin Coulter & Gerald Zaltman, *The Power of Metaphor*, in *THE WHY OF CONSUMPTION: CONTEMPORARY PERSPECTIVES ON CONSUMER MOTIVES, GOALS, AND DESIRES* 259, 262 (S. Ratneshwar, David Glen Mick & Cynthia Huffman eds., 2000).

37. See, e.g., Raymond Gibbs & Jennifer O’Brien, *Idioms and Mental Imagery: The Metaphorical Motivation for Idiomatic Meaning*, 36 *COGNITION* 35 (1990); Matthew S. McGlone & Jennifer L. Harding, *Back (or Forward?) to the Future: The Role of Perspective in Temporal Language Comprehension*, 24 *J. EXPERIMENTAL PSYCHOL.: LEARNING, MEMORY, COGNITION* 1211 (1998). Indeed, conceptual metaphor theory “has inspired conferences (e.g., those organized by the International Cognitive Linguistics Association and the association for Researching and Applying

Conceptual metaphors are metaphors where one idea, or conceptual domain, is understood in terms of another.³⁸ Metaphor occurs as a consequence of the pairing (i.e., connection) of two “domains”—the “source” and the “target.”³⁹ The source domain is one that is normally familiar whereas the target domain is typically unfamiliar.⁴⁰ Most often, conceptual metaphors result from our natural tendency to conceptualize an abstract idea or experience in terms of one that is more concrete, and thus more easily understood. Humans typically perceive concrete phenomena—what we can see, hear, smell, touch, or taste—as easier to make sense of and understand than more abstract phenomena—like the concepts of intellectual property or of metaphor, for example.⁴¹

Abstract concepts are often made more concrete by use of metaphor.⁴² As examples, consider the abstract concepts of life, emotions, and time. Life may be thought of as a *journey* (“I’m at a *crossroads* in my life”) or a story (“Tell me the *story* of your life”).⁴³ Emotions may be represented in terms of forces (“I was *overwhelmed* with grief,” or “I was *swept off* my feet”).⁴⁴ Time may be comprehended as spatial motion (“The time for action *has arrived*” or “Time is *flying by*”).⁴⁵ Each of these ideas is so embedded in our basic thought processes that it appears natural to us. That is, we instinctually and unconsciously move from the concrete source domain to the abstract target domain and vice versa.

The conscious *metaphorical expressions*—words, phrases, and sentences that are the surface realizations of the mappings between the target and source domains—may manifest either verbally or visually.⁴⁶ However, conceptual metaphor *itself* originates in unconscious cognition.⁴⁷ The prevailing consensus in the cognitive science and

Metaphor [RaAM]), journals (e.g., *Metaphor and Symbol* and *Cognitive Linguistics*), as well as empirical research.” See Charles Forceville, *Non-verbal and Multimodal Metaphor in a Cognitivist Framework: Agendas for Research*, in MULTIMODAL METAPHOR 19, 21 (Charles J. Forceville & Eduardo Urios-Aparisi eds., 2009).

38. George Lakoff, *The Contemporary Theory of Metaphor*, in METAPHOR AND THOUGHT 202, 206 (Andrew Ortony ed., 1993).

39. *Id.*

40. *Id.*

41. See MULTIMODAL METAPHOR, *supra* note 35, at 1–2.

42. LAKOFF & JOHNSON, *supra* note 14, at 5.

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.*

47. See Coulter & Zaltman, *supra* note 36, at 259–64.

neuroscience fields is that thought is mostly unconscious. Unconscious thought tends to be figurative rather than literal, with “metaphors and particularly systems of metaphors signal[ing] unconscious evaluations of things and processes.”⁴⁸ Thus, conceptual metaphors are articulated in conversation not in raw, figurative form, but as mere metaphorical expressions of deeper metaphorical thought.⁴⁹

To illustrate, let us consider a common example: the metaphor “Argument is War.” Here, the target domain—the concept trying to be understood by the metaphor—is “argument.” The source domain—the domain from which the relation or understanding is drawn—is the concept of “war.” The actual words and language used here are ancillary to the mode of thought employed. What matters, on a fundamental level, is the way that one concept is mentally conceptualized in terms of another concept. Many metaphorical expressions are used to support the conceptual metaphor “Argument is War,” including:

Your claims are *indefensible*.

He *attacked every weak point* in my argument.

His criticisms were *right on target*.

I *demolished* his argument.

I’ve never *won* an argument with him.

You disagree? Okay, *shoot!*

If you use that strategy, he’ll *wipe you out*.

He *shot down* all of my arguments.⁵⁰

These expressions are not considered to be poetic. Instead, they are just the basic method we describe when arguing with someone else. Lakoff and Johnson explain:

It is important to see that we don’t just *talk* about arguments in terms of war. We can actually win or lose arguments. We see the person we are arguing with as an opponent. We gain and lose ground. We plan and use strategies. If we find a position indefensible, we can abandon it and take a new line of attack. Many of the things we *do* in arguing are partially structured by the concept of war. Though there is no physical battle, there is a

48. *Id.* at 262.

49. *Id.*

50. LAKOFF & JOHNSON, *supra* note 14, at 4.

verbal battle, and the structure of an argument—attack, defense, counterattack, etc.—reflects this.⁵¹

In conceptual metaphor theory, a “mapping” breaks down the metaphor into a series of corresponding phrases that map how the knowledge about the source domain is applied to knowledge about the target domain.⁵² In the “argument is war” example, the mappings would include the following: (1) participants correspond to soldiers; (2) the discussion between participants corresponds to a battle; (3) points made by each participant are blows to one another; and (4) each participant’s goal is to defend and protect his or her territory.⁵³ These correspondences allow us to reason about argument using the same mode of thought that we use to reason about war. For instance, the “his argument was right on target” expression evokes knowledge about war (dealing a successful blow to an opponent) in order to conceptualize and understand how a particular analytical point (i.e., battle) affected the overall argument (i.e., war).

Further, Lakoff and Johnson propose that conceptual schemas are shaped by both cognitive and sensorimotor experiences.⁵⁴ For example, the metaphor “Affection Is Warmth” derives as a result of the feeling of warmth experienced while being held affectionately.⁵⁵ Other examples include “Knowing Is Seeing,” which comes as a result of our observing through our eyes, and “Difficulties Are Burdens,” which derives from our experience of having difficulty lifting heavy physical objects.⁵⁶ Indeed, Lakoff and Johnson claim that all of our reasoning about abstract concepts has roots in the nature of the body.⁵⁷ Put another way, the use of metaphor often manifests as a result of connecting the external, physical world with the inner world of the imagination.⁵⁸

B. Verbal and Visual Metaphor in Advertising and Branding

Given that metaphor is a fundamental thought process, metaphors appear not just in language, but also in visuals, sounds, music, gestures,

51. *Id.*

52. See Lakoff, *supra* note 38, at 208.

53. LAKOFF & JOHNSON, *supra* note 14, at 207.

54. See GEORGE LAKOFF & MARK JOHNSON, *PHILOSOPHY IN THE FLESH* 49–54 (1999).

55. *Id.* at 50.

56. *Id.* at 50, 53–54.

57. *Id.* at 53–54.

58. See LAKOFF & JOHNSON, *supra* note 14, at 134 (referring to metaphor as “imaginative rationality” because it unites imagination and rational thought).

and discourse, and have been studied in various media and genres, including—most relevantly here—advertising.⁵⁹ Conceptual metaphors are applied in the context of advertising and branding as (1) verbal, (2) visual (sometimes referred to as pictorial), or (3) multimodal metaphors.⁶⁰ The most traditional are verbal metaphors, which can be defined broadly as representing one thing in terms of another through use of an analogy or other implicit comparison.⁶¹ For example, common terms like “product life cycle” and “price war” are verbal metaphors.⁶² In branding, suggestive and other distinctive word marks—e.g., GLASS DOCTOR for glass installation and repairs, or GREYHOUND for bus services—are also verbal metaphors.⁶³ Yet, advertising and branding relies heavily on visual metaphor as well.

A visual metaphor is commonly defined as a “representation of a person, place, thing, or idea by way of a visual image *that suggests* a particular association or point of similarity.”⁶⁴ Charles Forceville, who has analyzed visual metaphor in the context of advertising, defines it as the replacement of an expected visual element by an unexpected one, i.e., there is no “preexistent or conventional” connection between the two elements.⁶⁵ Art historian E.H. Gombrich and film theorist Noël Carroll each describe it as a form of “visual fusion,” where elements from two

59. Charles Forceville, *Visual and Multimodal Metaphor in Advertising: Cultural Perspectives*, 9 *STYLES COMM.* 26, 26 (2017).

60. See *infra* notes 61–104 and accompanying discussion.

61. Charles H. Noble et al., *The Effects of Brand Metaphors as Design Innovation: A Test of Congruency Hypotheses*, 30 *J. PROD. INNOVATION MGMT.* 126 (2013).

62. *Id.*

63. *Synergistic Int'l, Inc. v. Windshield Doctor, Inc.*, No. CV 03-579 FMC (CWx), 2003 U.S. Dist. LEXIS 12660, at *13 (C.D. Cal. Apr. 28, 2003) (finding GLASS DOCTOR to be suggestive and thus distinctive due to metaphorical significance).

64. See, e.g., Noble et al., *supra* note 61, at 126. However, as one scholar writes, “[t]o understand visual metaphor is a difficult task; to explain it is more difficult. For how can one begin to do justice verbally to that which is by nature nonverbal and visual?” Hermine Feinstein, *Meaning and Visual Metaphor*, 23 *STUD. ART EDUC.* 45, 47 (1982).

65. FORCEVILLE, *supra* note 14, at 2. For example, in referring to a shoe advertisement displaying a male torso with a shoe in place of a tie, he describes visual metaphor (which he calls pictorial metaphor) as follows:

[T]he foregrounded object is a shoe. We immediately see that there is something odd about this shoe: it is located in a place where we would not ordinarily have expected it . . . We realize that the shoe is depicted in a place where we ordinarily would have expected something else, namely, a tie. Put differently, the viewer is invited to understand and perceive the phenomenon SHOE not in its usual, ‘literal’ sense, but in terms of the very different phenomenon TIE . . . The metaphor can be verbalized as SHOE IS TIE.

Id. at 109.

separate dimensions are fused into a single bounded entity.⁶⁶ Most broadly, it has been articulated along conceptual metaphor theory lines as “any image which is ‘intended to occasion a metaphoric thought.’”⁶⁷

A visual metaphor may simply be a color, like green, that is used to convey the environmentally friendly nature of an associated product, or a combination of colors, for example a red, white, and blue color scheme representing the United States.⁶⁸ Visual metaphors may also be used in more complex logos, product packaging, or other visual symbols—such as a restaurant’s décor—that convey information or suggest points of association or similarity as to a brand. For example, the Apple logo might convey, to some consumers at least, the enticing but “iconoclastic” nature of the Apple brand by invoking reference to the biblical story of Adam and Eve’s fall from grace after consuming an apple—the “forbidden fruit”—from the tree of knowledge of good and evil.⁶⁹

In the case of a visual metaphor, both the target and source domains are depicted pictorially.⁷⁰ Multimodal metaphors are “metaphors in which target, source, and/or mappable features are represented or suggested by at least two different sign systems (one of which may be language) or modes of perception.”⁷¹ Edward McQuarrie and Barbara Phillips, experts in the field of metaphor as applied to advertising and branding, explain that visual metaphor and multimodal metaphors are generally more powerful than verbal ones:

[T]he more deviant the metaphor, or the greater the discrepancy between the unlike things being equated, the more powerful it can be in changing meaning. Verbal metaphor suffers by comparison, especially when it rests on a single word: put a tiger in your tank, as the Esso gasoline ads used to urge. All words are alike, no

66. E.H. GOMBRICH, *MEDITATIONS ON A HOBBY HORSE AND OTHER ESSAYS ON THE THEORY OF ART* 134 (1971); Noël Carroll, *A Note on Film Metaphor*, 26 J. PRAGMATICS 809, 812 n.6 (1996) (“[I]n visual metaphor the fusion is literal.”). Carroll provides an example from the 1927 Fritz Lang film *Metropolis*, where a machine is transformed into a monster: “[t]he machine, or at least parts of it, have been transformed into parts of a monster, Moloch. Nevertheless, the machine is still recognizable as a machine. The monster elements and the machine elements are co-present—or homospatial—in the same figure.” *Id.* at 809–10.

67. Elisabeth El Refaie, *Understanding Visual Metaphor: The Example of Newspaper Cartoons*, 2 VISUAL COMM. 75, 81 (2003).

68. *Id.*

69. See MARGARET MARK & CAROL S. PEARSON, *THE HERO AND THE OUTLAW: BUILDING EXTRAORDINARY BRANDS THROUGH THE POWER OF ARCHETYPES* 24 (2001).

70. Cf. Forceville, *supra* note 37, at 19, 24.

71. Charles Forceville, *Metaphor in Pictures and Multimodal Representations*, in *THE CAMBRIDGE HANDBOOK OF METAPHOR AND THOUGHT* 462, 463 (Raymond W. Gibbs, Jr. ed., 2008).

matter how distant the concepts they invoke: an arbitrary arrangement of phonemes, similar in length, with tens of thousands constructed from the same few dozen available phonemes. The field of pictures is vastly larger and more varied, hence the unlikeness of two objects pictorially juxtaposed can be far greater.⁷²

While conceptual metaphor theory refers to the target domain as abstract and the source domain as concrete, that is not always the case in the advertising and branding context.⁷³ Instead, the target domain is seen to correspond with the product or service being advertised. The source domain—conveniently from a semantic standpoint—can be equated with the source (i.e., the brand or producer) of the product or service. Products or services are frequently depicted in advertising and branding in a concrete rather than abstract manner. Thus, the underlying schema is often CONCRETE A IS CONCRETE B (rather than Lakoff and Johnson's ABSTRACT A is CONCRETE B).⁷⁴ For example, a beer may be portrayed as a wine to show its sophistication, or an elegant watch is represented as a butterfly to allude to its beauty.⁷⁵ In the trademark context, Prudential Insurance's "Rock of Gibraltar" logo can be seen as a concrete visual representation of the abstract concept of stability—suggesting a characteristic of the brand's insurance-related services.⁷⁶ Regardless of concreteness versus abstraction, the metaphor invites a comparison of two objects—the product and the brand—by suggesting that they are like one another despite coming from different domains. The product is the target,⁷⁷ while the brand—including its associations, imagery, and archetypal significance—is the source.⁷⁸

72. EDWARD F. MCQUARRIE & BARBARA J. PHILLIPS, *VISUAL BRANDING: A RHETORICAL AND HISTORICAL ANALYSIS* 179 (2016).

73. For this reason and others, at least one scholar has argued that the conceptual metaphor framework is limiting in the advertising and branding context, and that metaphor can better be seen as part of a larger "metaphor scenario" in which consumer interpretations vary. *See Forceville, supra* note 37, at 19, 24.

74. Forceville, *supra* note 59, at 26–27.

75. *Id.*

76. *See* Barbara B. Stern, *Figurative Language in Services Advertising: The Nature of Uses of Imagery*, 15 *ADVANCES CONSUMER RES.* 185, 186 (1988).

77. FORCEVILLE, *supra* note 14, at 69 ("[I]n the case of advertising th[e] target domain is, or is connected to, the product advertised.").

78. JAMES GEARY, *I IS AN OTHER: THE SECRET LIFE OF METAPHOR AND HOW IT SHAPES THE WAY WE SEE THE WORLD* 72 (2011) ("An ad is a metaphor in which the product is the target and a set of affects—imagery, associations, archetypes—is the source.").

To decipher metaphors in advertising and branding, consumers must use “imagination, thought and perception” to draw inferences and find similarities between the target and source domains.⁷⁹ Based on findings in cognitive science, this occurs through a core process of cognitive thought separable into four mental steps: (1) the relevant terms are accessed from long-term memory; (2) the source is mapped to the target to identify correspondences; (3) analogical inferences are made about the target, thus creating new knowledge; and (4) learning occurs when new links in memory are created.⁸⁰ Gerald Zaltman writes about Budweiser as an example:

When a brand succeeds in establishing a basic association (literally, a neural pathway) in consumers’ minds, subsequent activations of this association increase the strength of the pathway so that an entire neural network eventually forms to reinforce it. The beer brewer Anheuser-Busch has repeatedly used the idea of connection as its deep metaphor in advertising its Budweiser brand over time, so that Budweiser owns that association. Consumers’ minds implicitly associate Budweiser and social connection. The association hinders other brands from making the same association, and when one of Anheuser-Busch’s competitors uses social connection, consumers will think of Budweiser as well.⁸¹

Use of metaphor has been found to draw consumer attention. Specifically, use of metaphor leads to increased (1) “vividness” and (2) “brand differentiation,” as well as (3) contributes to a brand’s “personality.”⁸²

First, metaphor has been found to make advertising and branding more vivid. Vividness has been defined as “emotionally interesting, concrete

79. See *infra* Parts II, III.

80. Barbara J. Phillips & Edward F. McQuarrie, *Beyond Visual Metaphor: A New Typology of Visual Rhetoric in Advertising*, 4 *MARKETING THEORY* 113, 119 (2004).

81. ZALTMAN & ZALTMAN, *supra* note 26, at 126–27.

82. Noble et al., *supra* note 61, at 126, 128; see also Katherine L. Spencer, Evaluating Trademark Design iv (May 2011) (Master’s Thesis, San Jose State University) (finding that “[t]rademarks with high subject-content compatibility and trademarks that use visual metaphor resulted in significantly higher comprehension (as measured by ability to match trademark to company description), indicating that the graphic design community may want to consider utilizing graphics with high subject-content compatibility or visual metaphor if comprehension is determined to be an important focus during the trademark design process”).

and imagery-provoking.”⁸³ It is the branding corollary to trademark distinctiveness.⁸⁴ A “fundamental goal of brand management is to develop a brand that is perceived by consumers as vivid.”⁸⁵ Vivid information in the form of metaphor has been shown to attract consumer attention and interest more so than pallid and abstract stimuli.⁸⁶ For example, use of the verbal metaphor “Today’s Slims at a very slim price” will likely engage consumers more than the literal statement “Today’s Slims at a very low price.”⁸⁷ In terms of visual metaphor, when Kellogg’s uses its Tony the Tiger trademark, “that act of personification invites the consumer to transfer meanings from . . . [a] very enthusiastic and youthful cartoon tiger to the brand and product.”⁸⁸ As Rebecca Tushnet notes, vividness is helpful in serving trademark law’s information function because “[a] term a consumer can’t remember is by definition not doing a good job as an indicator of source, and thus, can’t serve the functions we attribute to trademarks of protecting consumers from confusion and incentivizing producers to keep quality high.”⁸⁹

Second, metaphor has been linked to brand differentiation. For example, Iron Mountain⁹⁰ uses its name and logo as a means of expressing its superiority in the data and records management business.⁹¹ Similar to vividness, brand “[d]ifferentiation is an essential element of a brand that makes it noticeable in the marketplace and meaningful to consumers.”⁹² While vividness involves an isolated assessment of a single brand for clarity and strength, differentiation measures a brand in comparison to competitors as reference points.⁹³ Branding expert David Aaker has

83. Tushnet, *supra* note 4, at 869 (citing RICHARD E. NISBETT & LEE ROSS, HUMAN INFERENCE: STRATEGIES AND SHORTCOMINGS OF SOCIAL JUDGMENT 45 (1980)).

84. *Id.*

85. Noble et al., *supra* note 61, at 129 (citing R. E. Nisbett and L. Ross, *Assessing Weights to Data: The “Vividness Criterion,”* in HUMAN INFERENCE: STRATEGIES AND SHORTCOMINGS OF SOCIAL JUDGMENT 42, 42–62 (R. E. Nisbett & L. Ross eds., 1980)).

86. *Id.*; see also Feinstein, *supra* note 64, at 49 (“[M]etaphor, because it is not mediated by the verbosity of literal language, is closer to perceived experience. One’s sensory, emotional, and cognitive systems are readily engaged, allowing the most relevant experiential information to be transferred not only in rich and vivid detail, but in toto.”).

87. McQuarrie & Mick, *supra* note 27, at 38–39.

88. McQUARRIE & PHILLIPS, *supra* note 72, at 178.

89. Tushnet, *supra* note 4, at 870.

90. IRON MOUNTAIN, <http://www.ironmountain.com/> [<https://perma.cc/-XN5D-RCRM>].

91. Noble et al., *supra* note 61, at 130.

92. *Id.*

93. *Id.*

identified four factors that contribute to the distinctiveness and strength of a brand: (1) differentiation, which “[m]easures how *distinctive* the brand is in the marketplace”; (2) relevance, i.e., “whether a brand has personal relevance for the respondent”; (3) esteem, which “[m]easures whether a brand is held in high regard and considered the best in its class”; and (4) knowledge, which is “[a] measure of understanding as to what a brand stands for.”⁹⁴ Yet, Aaker notes that based on a structured survey of over 13,000 brands in more than thirty countries, “differentiation is the key to a strong brand, more so than esteem, relevance, and knowledge.”⁹⁵ Use of metaphor has been found to have a positive influence on brand differentiation. Indeed, research “stresses the importance of brand metaphors, particularly when used strategically and in combination, in order to create differentiated and desirable products in the marketplace.”⁹⁶

Third, metaphor has an influence on a brand’s personality. Consumers use brands as indicators of source and quality, but also as expressions of individuality, self-identity, and self-image.⁹⁷ Brands thus encompass a symbolic, emotional component that appeals to consumers through use of metaphor. This subjective, emotional, and aesthetic aspect of brands involves “more complex . . . characteristics . . . which are related to image building and include status/power, inherent value and finally, the development of brand personality.”⁹⁸ From a psychological perspective, brands act as subjective “vehicles for the transfer of meaning from a brand to the consumer,” who in turn engages in a process called symbolic consumption, using brands as “symbolic resources for the construction and maintenance of identity.”⁹⁹ The metaphorical meaning of brands is in

94. DAVID A. AAKER, *BUILDING STRONG BRANDS* 304 (1996) (emphasis added).

95. DAVID A. AAKER & ERICH JOACHIMSTHALER, *BRAND LEADERSHIP* 263 (2000).

96. Noble et al., *supra* note 61, at 139; *see also* Spencer, *supra* note 82, at 1, 6.

97. *See, e.g.*, Russell W. Belk & Gulnur Tumbat, *The Cult of Macintosh*, 8 CONSUMPTION MKTS. & CULTURE 205, 210 (2005); Tereza Kuldova, *Hells Angels Motorcycle Corporation in the Fashion Business: Interrogating the Fetishism of the Trademark Law*, J. DESIGN HIST. 1, 2 (2016) (noting that for Hells Angels “club members, the logos and insignia serve the functions of conserving the club’s power, of encouraging membership and support and of reproducing the organization on a daily basis through rituals associated with the marks”); John W. Schouten & James H. McAlexander, *Subcultures of Consumption: An Ethnography of the New Bikers*, 22 J. CONSUMER RES. 43, 55 (1995) (focusing on Harley-Davidson enthusiasts).

98. BRANDS, COMPETITION, AND IP 79 (Devan Desai et al. eds., 2015).

99. Veronika Koller, *Brand Images: Multimodal Metaphor in Corporate Branding Messages*, in MULTIMODAL METAPHOR 45, 51 (Charles J. Forceville & Eduardo Urios-Aparisi eds., 2009) (citing Majken Schultz, Mary Jo Hatch & Francesco Ciccolella, *Brand Life in Symbols and Artifacts: The LEGO Company*, in ARTIFACTS AND ORGANIZATIONS: BEYOND MERE SYMBOLISM 141, 150 (Anat Rafaeli & Michael G. Pratt eds., 2006)).

turn perceived by consumers as containing “emotional and self-expressive benefits.”¹⁰⁰

According to David Aaker’s brand identity theory, a brand starts with a corporate identity, which consumers then interpret as a brand’s image, or—metaphorically—as its personality. Personification of a brand means “to invoke a metaphor for it.”¹⁰¹ Since the 1980s, companies have sought to make their brands more accessible to consumers. To do this, many have conceptualized “their brands as living organisms . . . even endowing them with a quasi-human ‘personality.’”¹⁰²

As an example of brand personality, consider again Kellogg’s use of its Tony the Tiger mark in connection with its Frosted Flakes cereal. Cereal is nothing like a tiger in the literal sense. However, from a figurative lens, personification of the brand as a living thing allows consumers to see it as an “emotional partner” rather than “an inert thing.”¹⁰³ The Kellogg’s brand is therefore able to take on the characteristics associated with Tony the Tiger—perky, trustworthy, and energetic—and thus the consumer is able to relate to the brand as if it were a person.¹⁰⁴

In sum, use of verbal and visual metaphor has been found to increase a brand’s vividness, differentiation in the marketplace, and personality. As Charles Forceville notes:

Metaphors’ deviation from conventional usage makes them attractive means to draw consumers’ attention. Furthermore, one way of realizing the goal of making a claim for his/her product in a brief spatial or temporal span is for an advertiser to forge a link between the product and something that already possesses the characteristic(s) he desires to claim for the product. Now this closely echoes what happens in metaphor.¹⁰⁵

100. *Id.*

101. MCQUARRIE & PHILLIPS, *supra* note 72, at 178 (“In rhetorical terms, and consistent with a long tradition dating back to the Greeks, to personify a brand is to invoke a metaphor for it. More exactly, personification initiates a metaphorical transfer of meaning.”).

102. Koller, *supra* note 99, at 50. To this end, Jennifer Aaker has developed a theoretical and psychological framework of brand personality based on the “Big Five” personality model. Jennifer L. Aaker, *Dimensions of Brand Personality*, 34 J. MARKETING RES. 347, 352–55 (1997).

103. MCQUARRIE & PHILLIPS, *supra* note 72, at 178.

104. *Id.*

105. FORCEVILLE, *supra* note 14, at 69.

C. Trade Symbolism

Trademarks are symbols. In *Qualitex Co. v. Jacobsen Products Co.*,¹⁰⁶ the United States Supreme Court held that “the requirements for qualification of a word or symbol as a trademark are that it be (1) a ‘symbol,’ (2) ‘use[d] . . . as a mark,’ (3) to identify and distinguish the seller’s goods from goods made or sold by others,” but that it not be ‘functional.’”¹⁰⁷ The Court adopted this reformulation of the Lanham Act’s¹⁰⁸ definition of “trademark” from J. Thomas McCarthy’s leading trademark treatise:

The requirements for qualification of a word or symbol as a trademark can be broken down into three elements: (1) *the tangible symbol*: a word, name, symbol or device or any combination of these; (2) *type of use*: actual use in trade of the symbol as a mark by a seller of goods or services; (3) *the purpose*: to identify and distinguish the seller’s goods from goods made or sold by others.¹⁰⁹

What does it mean for a trademark to be “a symbol”? While the definition of symbol varies across disciplines, agreement generally is that the sine qua non of a symbol is that it contains not just a literal (i.e., denotative) aspect, but also a figurative (i.e., connotative) dimension that is expressed through metaphor.¹¹⁰ Consider the following prominent examples. Paul Ricoeur, the distinguished philosopher who studied phenomenology—the study of consciousness from the subjective, first-person viewpoint—defined a symbol “as any structure of significance in which a direct, primary, literal meaning designates, in addition, another meaning which is indirect, secondary, and *figurative*, and which can be apprehended only through the first.”¹¹¹ Carl Jung, the founder of analytical psychology—a field of study premised on understanding the meaning of the unconscious psyche—views the symbol as “a term, a name, or even a picture that may be familiar in daily life, yet that possesses specific *connotations* in addition to its conventional and obvious meaning.”¹¹² Mythologist Joseph Campbell notes that “a symbol, like everything else,

106. 514 U.S. 159, 166 (1995).

107. *Id.* (citing 1 MCCARTHY, *supra* note 11, § 3.1).

108. Lanham Act § 45, 15 U.S.C. § 1127 (2012).

109. 1 MCCARTHY, *supra* note 11, § 3.1.

110. JACOBI, *supra* note 12, at 77.

111. Ricoeur, *supra* note 12, at 12 (emphasis omitted).

112. JUNG, *supra* note 1, at 3.

shows a double aspect. We must distinguish, therefore between the ‘sense’ and the ‘meaning’ of the symbol.”¹¹³ In sum, a symbol must present both an objective, visible meaning and a *subjective*, hidden meaning as well.

Symbols are equated with, or are at least highly similar to, conceptual metaphors in that both terms involve comparisons where one thing is understood in terms of another.¹¹⁴ To this end, Heinrich Zimmer, a renowned historian who studied the symbolism of Indian art extensively, wrote of the relationship between symbolism and metaphorical thought:

Concepts and words are symbols, just as visions, rituals and images are; so too are the manners and customs of daily life. Through all of these a transcendent reality is mirrored. They are so many metaphors reflecting and implying something which, though thus variously expressed, is ineffable, though thus rendered multiform, remains inscrutable.¹¹⁵

Further, esteemed literary scholars Rene Wellek and Austin Warren describe the relationship between symbols, images, and metaphors in their seminal *Theory of Literature*:

Is there any important sense in which “symbol” differs from “image” and “metaphor”? Primarily we think, in the recurrence and persistence of the “symbol.” An “image” may be invoked once as a metaphor, but if it persistently recurs, both as presentation and representation, it becomes a symbol, and may even become part of a symbolic (or mythic) system.¹¹⁶

Trademarks—or trade symbols as they are sometimes called¹¹⁷—are part of a symbolic, and perhaps even mythic, system of commerce.¹¹⁸ As Barton Beebe has recognized, trademark law functions as a hybrid symbolic and economic doctrine that serves to elaborate the principles of symbolism in addition to those of the market economy.¹¹⁹ Invoking Saussurean semiotics and the work of French philosopher Jean

113. CAMPBELL, *supra* note 12, at 153.

114. *See, e.g., id.*

115. HEINRICH R. ZIMMER, *PHILOSOPHIES OF INDIA* 1–2 (Joseph Campbell ed., 1951).

116. RENE WELLEK & AUSTIN WARREN, *THEORY OF LITERATURE* 193–94 (1949).

117. *See, e.g.,* Ralph S. Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L.J.* 1165, 1167 (1948) (referring to trademark law as the law of trade symbols and analyzing their effect, as such, on the public interest); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717, 1723 (1999) (similarly referring to trademarks as “trade symbols” and analyzing trademark law’s effect on the public interest).

118. *See generally* Drescher, *supra* note 11, at 301–40.

119. Beebe, *supra* note 10, at 624; *see also* Dreyfuss, *supra* note 11, at 124–25.

Baudrillard,¹²⁰ Beebe theorizes that the “triadic structure” of the trademark consists of three elements: (1) the “signifier,” or tangible symbol “conveying into the mind something from without”; (2) the “referent,” “which can be a physical ‘object of the world’ or a mental entity “of the nature of thought or of a sign”; and (3) the “signified,” which constitutes the “proper significant effect . . . of the sign.”¹²¹ Under this semiotic theory, these elements are each one corner of the “semiotic triangle” that corresponds with trademark law’s “requirements for qualification of a mark or symbol as a [distinctive] trademark.”¹²²

This triadic structure model corresponds to the three elements of a trademark articulated by McCarthy and embraced by the Supreme Court in *Qualitex*. The first element—the tangible symbol—corresponds with the signifier as each refers to “the perceptible form of the mark.”¹²³ The second element—the type of use—corresponds with the referent in that it is needed to connect the marked goods and services (via the consumer’s imagination) with the tangible signifier.¹²⁴ Finally, the third element—the function of the mark—is associated with the signified, meaning (in the trademark context) the specific source of the goods or services.¹²⁵ As an example, the mark NIKE consists of a signifier (the mark NIKE), a signified (Nike, Inc., the entity, or alternatively one of its brands), and the referent (the goods—athletic wear).¹²⁶

To function as a symbol, a trademark must therefore operate on both literal and figurative levels so as to designate source as well as reveal information about a product or service.¹²⁷ Metaphor, by operating across two conceptual domains, mentally invokes both the signified and the referent. It thus can be seen to allow the trademark, as the signifier, to “mediate” between the signified (i.e., the source) and the referent (i.e., the product or service).¹²⁸ In this way, the trademark, as analogous to the

120. See, e.g., JEAN BAUDRILLARD, *THE CONSUMER SOCIETY: MYTHS AND STRUCTURES* (Chris Turner trans., 1998) (1970) (critiquing the symbolic meaning of consumption and mass media in modern culture); JEAN BAUDRILLARD, *SIMULACRA AND SIMULATION* (Sheila Faria Glaser trans., 1988) (examining the increasingly tenuous connection between symbols and reality).

121. Beebe, *supra* note 10, at 636, 646.

122. *Id.* at 645.

123. *Id.* at 646.

124. *Id.*

125. *Id.*

126. *Id.* at 654.

127. Linford, *supra* note 19, at 737–38.

128. *Duraco Prods., Inc. v. Joy Plastics Enters., Ltd.*, 40 F.3d 1431, 1440 (3d Cir. 1994); Beebe, *supra* note 10, at 653.

signifier, “is understood to function as the hinge within the sign”—the sign consisting of the commodity itself.¹²⁹ The trademark operates within a symbolic system by identifying and distinguishing the source of a good or service and the identification of this source in turn identifies and distinguishes a good or service itself.¹³⁰ Use of metaphor is particularly important in trademark law today given that the source of goods or services is often anonymous.

Indeed, trademark distinctiveness today is defined as the “tendency to identify the goods sold under the mark as emanating from a particular, *though possibly anonymous*, source.”¹³¹ This “anonymous source doctrine” holds that a mark must represent a single source, but consumers do not need to know its actual origin. The anonymous source doctrine is a departure from early trademark law in that it serves to link the concept of “source” with a particular product or brand rather than its specific origin.¹³² Thus, modern trademark law sees the mark itself, not the producer, as “a repository for meaning.”¹³³ In this regard, Beebe writes:

Even if consumers cannot identify precisely what factory or company a trademark refers, still, consumers will assume that a specific instance of a trademark is referring to the same source as are other instances of the trademark. This “anonymous source” will receive trademark protection. The tendency of consumers to construct an anonymous source, a model, from which is produced specific instances of a commodity, is not limited to conventional word or image marks, however. In the case of mass-produced commodities, consumers will also construct such a source for [trade dress].¹³⁴

129. Beebe, *supra* note 10, at 653.

130. *Id.*

131. *Paddington Corp. v. Attiki Imp. & Distribs., Inc.*, 996 F.2d 577, 585 (2d Cir. 1993) (emphasis added); *see also* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:8 (4th ed. 1996) [hereinafter 2 MCCARTHY] (explaining that to establish secondary meaning, a plaintiff needs to show “that the ordinary buyer of these goods or services associates the designation with a single, albeit anonymous, source”).

132. *See* *Zino Davidoff SA v. CVS Corp.*, 571 F.3d 238, 244 (2d Cir. 2009); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 467 (2005); Laura A. Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1381 (2005).

133. Heymann, *supra* note 132, at 1422; *see also* Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 417 (1999); Jessica Silbey, *The Mythical Beginnings of Intellectual Property*, 15 GEO. MASON L. REV. 319, 360 (2008).

134. Beebe, *supra* note 10, at 663.

The concept of source in trademark law is therefore often nothing but a legal fiction that equates to brand. For instance, the producer Altria Group, Inc. (formerly Phillip Morris Companies Inc.) sells wine under its Chateau Ste. Michelle brand and cigarettes under its Marlboro brand.¹³⁵ Yet, trademark law does not require that the mark owner use the Altria designation for either.¹³⁶ To illustrate this point, consider the analogy of a writer who is free to write under a pseudonym.¹³⁷ Indeed, as trademark luminary Frank Schechter pointed out almost a century ago, “[t]he modern manufacturer may use a mark or several marks or no mark just as he pleases.”¹³⁸

In this way, the anonymous source doctrine permits mark owners to choose a symbolic brand identity to be associated with each product or service offered.¹³⁹ As a result, marks often suggest qualities, values, or atmospherics relating to their corresponding products or services. The mark thus does not merely symbolize the underlying goodwill of a specific producer as it used to. Instead, it creates goodwill in and of itself.¹⁴⁰ Because consumers are aware of the mark and not necessarily the actual producer, the trade symbol must be distinctive (i.e., conceptually separate) vis-à-vis its underlying product or service.¹⁴¹

Using trademarks to link product and brand (rather than product to producer) allows for a level of creativity that was absent during the age where marks merely served to identify the producer.¹⁴² While creativity was formerly of little relevance, it is today required to establish the link between consumers and brands that mark owners want consumers to experience. As Irina Manta notes, trademarks now “must be linked . . . to

135. *Who We Are*, ALTRIA, http://www.altria.com/Careers/Who_We_Are/Altria_Family_Companies/Pages/default.aspx [https://perma.cc/3S6A-L8LQ].

136. Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 441 (2011).

137. For example, J.K. Rowling, the author of the Harry Potter book series, has written under the name Robert Galbraith so as not to reveal to readers her true identity. See generally, e.g., ROBERT GALBRAITH, *THE CUCKOO’S CALLING* (2013).

138. FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 122 (1925).

139. Heymann, *supra* note 132, at 1379.

140. See Jessica Silbey, *The Mythical Beginnings of Intellectual Property*, 15 GEO. MASON L. REV. 319, 360 (2008) (citing Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 815 (1927)) (“[T]oday, the trademark is not merely the symbol of good will but often the most effective agent for the creation of good will, imprinting upon the public mind an anonymous and impersonal guaranty of satisfaction, creating a desire for further satisfactions. The mark actually sells the goods.”).

141. See, e.g., *Duraco Prods., Inc. v. Joy Plastics, Enters., Ltd.*, 40 F.3d 1431, 1440 (3d Cir. 1994).

142. Irina D. Manta, *Branded*, 69 S.M.U. L. REV. 713, 715 (2016).

the underlying good to imprint it on the consumer's mind. Establishing this link is also an undertaking in creativity."¹⁴³

Such a creative link is one that often results from establishing a metaphorical connection between the mark and its product or service.¹⁴⁴ Laura Heymann explains that "the concept of metaphor is fundamental to how most [protectable] trademarks work."¹⁴⁵ Indeed, the vast majority of trademarks operate on a figurative level "in that they require consumers to use a familiar word or expression in a new and initially unfamiliar context."¹⁴⁶ For example, the mark BRAWNY for paper towels is designed to serve as a literal product name, but also to associate the brand, figuratively and symbolically, with human strength. Heymann writes:

[A] trademark works because it causes consumers to think of a particular lexical unit as a proper name in addition to whatever literal meaning the word holds. The lexical unit "camel" engenders no metaphorical associations when it is used in connection with the desert animal; the same word used in connection with cigarettes operates on an additional "dimension of meaning."¹⁴⁷

Thus, the inherent distinctiveness of word marks can be seen to depend simply on whether a mark operates on a strictly literal level as the name of a product or service, or on a metaphorical one as a term creatively linking a brand with its underlying product or service. However, as Part II explains, trademark law's inherent distinctiveness doctrine provides a somewhat more nuanced inquiry.

II. VERBAL METAPHOR AND THE DISTINCTIVENESS OF WORD MARKS

This Part explains that trademark law currently uses metaphor as its doctrinal trigger for deciding the inherent distinctiveness of word marks. Section II.A examines the inherent distinctiveness doctrine. It reviews the *Abercrombie* spectrum as a "hierarchy of figurativeness." In doing so, it

143. *Id.* at 727.

144. Heymann, *A Name I Call Myself*, *supra* note 10, at 603 ("[T]he inherent strength of a mark (and therefore whether it gets protection ab initio or requires additional evidence) depends on how creative the mark is. The mark might be a commonplace and dull description of the good's qualities or characteristics (and therefore might need to be used by others), or use metaphor to suggest a good's characteristics, or create a new meaning for an existing word.").

145. Heymann, *The Grammar of Trademarks*, *supra* note 10, at 1330.

146. *Id.* at 1330–31.

147. *Id.* at 1331–32.

notes that the binary, yes-no judgment for trademark validity differs from the tiered, scope-based evaluation of trademark strength.¹⁴⁸ Section II.B explains that trademark law’s primary test for determining the validity of word marks, the “imagination” test, is implicitly a test of metaphorical thought in that it seeks a figurative connection between a mark and its associated product or service.¹⁴⁹ The inherent distinctiveness of a word mark thus often hinges on the use of a verbal metaphor. Section II.C discusses other tests for inherent distinctiveness, though each lacks the conceptual significance that the imagination test—in testing for the symbolic connotation of a mark—carries.

A. *The Abercrombie Spectrum*

Judge Friendly, in his influential 1976 Second Circuit Court of Appeals decision, *Abercrombie & Fitch Co. v. Hunting World, Inc.*,¹⁵⁰ developed what is known today as the *Abercrombie* spectrum.¹⁵¹ Put simply, it is a “hierarchy of figurativeness.”¹⁵² Under this framework, word marks are divided into five categories, from least to most protectable: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful.¹⁵³ The spectrum is used to determine both a mark’s “eligibility to trademark status”—its inherent distinctiveness, or validity—and “the degree of

148. Beebe, *supra* note 10, at 670.

149. *Id.*

150. 537 F.2d 4 (2d Cir. 1976).

151. *See generally id.*

152. Beebe, *supra* note 10, at 670. Similarly, Jake Linford finds that categories of semantic shift correspond with the various classifications of word marks posited by the *Abercrombie* spectrum. Linford, *supra* note 10, at 1406–08. With certain exceptions, Linford equates fanciful marks—words coined for use as marks and not derived from preexisting words—with *monosemes*: words having only one meaning. *Id.* at 1406. Arbitrary marks—derived from a preexisting word allegedly having no connection with the product or service sold—are comparable to *homonyms*: words having no connection between an existing meaning and a new brand-related meaning. *Id.* at 1407. Suggestive marks—preexisting words requiring an “imaginative leap” between the mark and the product are *metaphors*: marks establishing a figurative connection between the existing meaning of the word and its new trademark-related meaning. *Id.* at 1408. Descriptive marks—preexisting terms directly describing a feature of an equated product or service—are roughly comparable to *metonyms*: terms having a contiguous connection between an already existing meaning and a new sense such as a part for a whole (e.g., “suit” used to describe a corporate employee). *Id.* Finally, generic marks are words restricted from trademark protection that are used to describe general categories or members of a specific category. *Id.* at 1404.

153. *Abercrombie*, 537 F.2d at 9. For a thorough scholarly review of the *Abercrombie* spectrum’s categories, see also Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1102–21 (2003).

protection accorded” it—the mark’s conceptual strength, or scope.¹⁵⁴ A determination of inherent distinctiveness involves a yes-no, *binary* judgment separate from the tiered, hierarchical evaluation of mark strength.¹⁵⁵ A mark is inherently distinctive when, at the time it is first used, “[its] intrinsic nature serves to identify a particular source.”¹⁵⁶ Mark strength, on the other hand, is a matter of *degree*.¹⁵⁷ Rather than its validity, the strength of a mark is used to determine the degree of protection a mark is afforded compared to other confusingly similar or diluting marks.¹⁵⁸

On one end of the *Abercrombie* spectrum sit generic marks, which define a class of things (e.g., BOOK STORE for a book store, BOTTLED WATER for bottled water, or LITE BEER for light beer).¹⁵⁹ Generic marks can never serve as protectable trademarks under the theory that they are unable to identify the source of a product or service.¹⁶⁰ Generic marks denote (rather than connote) the product or service, and do not denote the source at all.

Next, descriptive marks convey an immediate idea of the ingredients, qualities, or characteristics of a related product or service (e.g., AMERICAN AIRLINES for a U.S.-based airline, ENTREPRENEUR for a business-oriented magazine, or SALTY for anchovies).¹⁶¹ Descriptive marks are protectable only upon a showing of acquired distinctiveness—commonly referred to as secondary meaning in the marketplace, i.e., when

154. *Abercrombie*, 537 F.2d at 9.

155. See, e.g., Barton Beebe, *Search and Persuasion in Trademark Law*, 103 MICH. L. REV. 2020, 2028 (2005) (equating “source distinctiveness” with what “a trademark must possess to fall within the *subject matter* of trademark protection,” and “*differential distinctiveness*” with trademark strength, “the extent of which prescribes the *scope* of trademark protection when protection is given”); Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CALIF. L. REV. 351, 353 (2014) (“Whether a mark passes the distinctiveness threshold for validity is a binary yes-no question, but evaluating the *strength* of a mark—a critical issue in trademark infringement suits—requires evaluation of the *degree* of distinctiveness.” (citing *Abercrombie*, 537 F.2d at 9 (explaining that the *Abercrombie* spectrum reflects two discrete inquiries: “eligibility to trademark status” and “the degree of protection accorded”))).

156. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).

157. See *Abercrombie*, 537 F.2d at 9.

158. See *id.*

159. See *id.* (“A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.”).

160. See *id.* The prohibition on trademarking generic names is a longstanding one. See *Canal Co. v. Clark*, 80 U.S. 311, 323 (1871) (“Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trademark and the exclusive use of it be entitled to legal protection.”).

161. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792 (5th Cir. 1983).

the mark becomes sufficiently distinctive so as to establish “a mental association in the buyers’ minds between the alleged mark and a single source of the product.”¹⁶² Descriptive marks are metonymical rather than metaphorical—they typically have a literal or contiguous connection as to their marked product or service.¹⁶³

Nearing the center of the spectrum, suggestive marks are “textbook metaphors and are described as such by the doctrine.”¹⁶⁴ That is, they require “imagination, thought and perception” to reach a conclusion as to the nature of their associated products or services (e.g., KLONDIKE for ice cream, ROACH MOTEL for roach traps, or GREYHOUND for a bus service).¹⁶⁵ Unlike their descriptive brethren, suggestive marks are immediately protectable upon first use and without a showing of secondary meaning.¹⁶⁶

Next on the spectrum are arbitrary marks. Arbitrary marks are also protectable absent secondary meaning but are considered to be conceptually stronger than suggestive marks. While arbitrary marks have meaning in the everyday sense, that meaning bears no obvious, concrete connection to their associated product or service (e.g., NIKE for footwear, CAMEL for cigarettes, or APPLE for computers).¹⁶⁷ But, while not often recognized as such, arbitrary marks are also usually metaphorical. In evoking values or aesthetics associated with a product or service, they are *catachrestic* metaphors.¹⁶⁸ Catachrestic metaphors are metaphors used in a way that departs from conventional or traditional use.¹⁶⁹ The catachrestic metaphor differs from a typical figurative expression in that there is no

162. 2 MCCARTHY, *supra* note 131, § 15:5; *see also* Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 464 (4th Cir. 1996) (defining secondary meaning as existing when “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself” (quoting Dayton Progress Corp. v. Lane Punch Corp., 917 F.2d 836, 839 (4th Cir. 1990))).

163. *See* Linford, *supra* note 10, at 1369.

164. Beebe, *supra* note 10, at 671.

165. *See* 2 MCCARTHY, *supra* note 131, § 11:67; U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(a) (2015) [hereinafter TMEP].

166. *See* 2 MCCARTHY, *supra* note 131, § 11:67; TMEP, *supra* note 165, § 1209.01(a).

167. *See* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

168. *Compare* Beebe, *supra* note 10, at 671 (noting that in the case of “arbitrary marks such as APPLE for computers or SHELL for gasoline, the figurative relation is not so much metaphorical as it is catachrestic”), *with* ALAN SINGER, A METAPHORICS OF FICTION (1984) (defining “catachrestic metaphor” as “a trope that strayed beyond the field of contextual determinations warranting its usage” (emphasis added)).

169. ANSHUMAN SHARMA, THE IMPACT—THE ART OF COMMUNICATING ELOQUENTLY 78 (2014).

semantic connection between the term and its referent. Rather, it is a metaphorical form chosen for its rhetorical color and effect.¹⁷⁰

Finally, on the far end of the spectrum, fanciful marks are often considered to be the strongest marks because, under the theory of linguistic arbitrariness, their only linguistic function is to identify the source of the products or services with which they are associated (e.g., PEPSI for a soft drink, XEROX for document services, or KODAK for imaging products).¹⁷¹ Yet research finds that many so-called fanciful marks employ sound symbolism—i.e., a direct linkage between sound and meaning—and thus too have a sort of metaphorical connection to their underlying products and services.¹⁷² Jake Linford notes that studies of sound symbolism call into question the assumption that fanciful marks have no inherent meaning.¹⁷³ If individual syllables of words convey meaning, the owner of a fanciful mark may be communicating product qualities to consumers, just as do descriptive or suggestive marks.¹⁷⁴ For example, a seemingly “nonsense” word like SWIFFER may lack a definition in the dictionary, yet its component sounds may connote speed and ease of use. Research shows that brands purposefully use sound symbolism when choosing new trademarks.¹⁷⁵

Thus, inherently distinctive word marks—suggestive, arbitrary, and even many fanciful designations—are metaphorical in that they contain both denotative (literal) and connotative (figurative) dimensions of meaning. As Thomas Bell summarizes,

At root, the *Abercrombie* scale measures the metaphorical distance between the “sense” of a mark or trade dress and its “reference.” The sense of a symbol lies somewhere between the wholly subjective impressions that it arouses in each observer and the objective, external thing to which it refers. Thus, “morning star” has a different sense from “evening star” even though both

170. See Hugh C. White, *Metaphor as Performative*, in *READING COMMUNITIES READING SCRIPTURE* 66, 79–81 (Gary A. Phillips & Nicole Wilkinson Duran eds., 2002).

171. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995) (noting that arbitrary and fanciful marks are assumed to “almost automatically tell a customer that they refer to a brand”). But see generally Linford, *supra* note 19 (explaining that, contrary to the theory of linguistic arbitrariness, many or most fanciful marks rely on sound symbolism—a link between sound and word meaning—and thus connote product qualities like other categories of trademarks).

172. See generally Linford, *supra* note 19.

173. See *id.*

174. See *id.*

175. See *id.* at 730–32 (citing Richard R. Klink, *Creating Brand Names with Meaning: The Use of Sound Symbolism*, 11 *MARKETING LETTERS* 5 (2000)).

names refer to the same object: Venus. This abstract notion casts new light on the *Abercrombie* scale.¹⁷⁶

Within the *Abercrombie* spectrum, though, there exists a dichotomy between suggestiveness and descriptiveness that tends to be where arguments—battles—are fought in both the transactional law and litigation settings. The next section explains that the predominant test for inherent distinctiveness, the imagination test, tests for metaphorical significance as a binary threshold matter of validity, separate and apart from the sliding scale of trademark strength.

B. *The Imagination Test*

As just discussed, when evaluating a word mark's validity, trademark law uses the *Abercrombie* spectrum to decide whether a mark is "merely descriptive," and thus not eligible for trademark protection absent secondary meaning, or if it is suggestive and thus inherently distinctive and entitled to immediate protection at first use in commerce.¹⁷⁷ At least one commentator has referred to this dividing line as the "suggestive-descriptive dichotomy."¹⁷⁸ Courts use an "imagination" test as the "primary criterion" in making this determination.¹⁷⁹ According to the imagination test, a word mark is suggestive—and thus inherently distinctive rather than merely descriptive—if it requires "imagination, thought and perception" for consumers to reach a conclusion as to the nature of its corresponding product or service.¹⁸⁰ Less often, courts will also use the imagination test in deciding whether a word is arbitrary or fanciful.¹⁸¹ At a high level, "if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive."¹⁸² Yet, what the test seeks more precisely is a figure of speech—a metaphorical expression that denotes the brand and connotes qualities or values

176. Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 MD. L. REV. 384, 412 (1997).

177. See, e.g., *Cytosport, Inc. v. Vital Pharm., Inc.*, 617 F. Supp. 2d 1051, 1070 (E.D. Cal. 2009).

178. See Linford, *supra* note 10, at 1374.

179. *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1116 (9th Cir. 2010) (citing *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 903 (9th Cir. 1995)); see also Roberts, *supra* note 10, at 1057 ("The test used most often to determine whether a mark is merely descriptive, i.e. goods-constative, is known as the imagination test.").

180. 2 MCCARTHY, *supra* note 131, § 11:67; TMEP, *supra* note 165, § 1209.01(a).

181. See, e.g., *ToHo Co. v. William Morrow & Co.*, 33 F. Supp. 2d 1206, 1214 (C.D. Cal. 1998).

182. *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) (quoting ARTHUR H. SEIDEL, *TRADEMARK LAW AND PRACTICE* 77 (1963)).

associated with a product or service. In the terms of conceptual metaphor theory, a metaphorical mapping from the source (i.e., brand) to the target (i.e., product or service) domains is required.

Deciding whether a trademark is descriptive (i.e., initially invalid) or suggestive (i.e., valid immediately) is an important endeavor. In the litigation setting, proving that a plaintiff's mark is descriptive without it having established secondary meaning often spells victory for a defendant, whereas a showing that it is suggestive entitles the mark to protection and thus allows a trademark infringement or other cause of action to move forward.¹⁸³ In the transactional context, the suggestiveness determination is instrumental in deciding whether a particular mark is cleared for use as a brand.¹⁸⁴ Indeed, the act of acquiring secondary meaning in the marketplace is time-consuming (often taking five years or longer), expensive, and difficult to prove.¹⁸⁵ Thus, the suggestive-descriptive dichotomy is a frequent point of contention in trademark law.

The imagination test is a test of metaphorical significance. It requires an "imaginative leap" to connect the mark with the product.¹⁸⁶ The

183. See, e.g., Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1584 (2006) (finding that plaintiff win rates usually correspond with a mark's conceptual strength in accordance with their *Abercrombie* spectrum classification); Linford, *supra* note 10, at 1379 (remarking that "significant consequences turn on the suggestive-descriptive determination").

184. Specifically, issues of distinctiveness come up in four different ways: first, when an applicant files an application to register a mark with the PTO, the trademark examiner analyzes whether the mark is distinctive, merely descriptive, or generic; second, during an opposition proceeding (if a third party opposes a trademark application) or a petition to cancel (if a third party seeks to cancel an already issued registration); third, if a mark owner sues for infringement of a *registered* mark, the defendant may claim that the registered mark is not distinctive and thus unprotectable—barring a ruling of incontestability which is used to prevent a challenge as to distinctiveness; fourth, if an unregistered mark owner sues in federal court under Lanham Act section 43(a)(1)(A), the mark owner must establish distinctiveness or the claim will typically be dismissed. See MARK JANIS, TRADEMARK AND UNFAIR COMPETITION IN A NUTSHELL, 19–20 (2013).

185. TMEP, *supra* note 165, § 1212 (citing 15 U.S.C. § 1052(f) (2012)); see also Heymann, *supra* note 136, at 389 ("Indeed, it would not be surprising to learn that the marketing department and the legal department in a typical company find themselves frequently at odds—the legal department recommending more fanciful names so as to acquire trademark protection more easily, and the marketing department desiring a more descriptive name that efficiently conveys to consumers the product's qualities without the need to spend millions of advertising dollars in consumer education.").

186. To explain the imagination test, the examples of the marks ROACH MOTEL for a roach trap, and ENTREPRENEUR for a business-focused magazine, are illustrative. ENTREPRENEUR as used in connection with a business magazine is descriptive because consumers understand the term to refer in literal fashion to the business focus of the magazine. No imagination is required in making that connection. In comparison, consumers who see or hear the term ROACH MOTEL would think of a roach-infested motel room. They would not immediately jump to the realization that the product is a roach trap. Thus, unlike ENTREPRENEUR, ROACH MOTEL does not describe the product's

“imagination” needed to link a suggestive word mark with its corresponding product or service “refers to the mental process required to connect a name that is incongruous or figurative with the product (e.g., ‘Roach Motel’ with an insect trap or ‘TIDE’ with soap).”¹⁸⁷ The imagination test—not unlike the *Abercrombie* spectrum generally¹⁸⁸—has endured its fair share of criticism. Judge Learned Hand wrote that “[i]t is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.”¹⁸⁹ Others have since referred to the test, metaphorically, as “shadowy,”¹⁹⁰ “murky,”¹⁹¹ and “not always clear.”¹⁹²

But those who understand that what the imagination test seeks is metaphorical thought are better able to utilize and appreciate its depth. One court has articulated the imagination test in an especially complementary and eloquent manner:

[Suggestive word marks] generally do not, unlike the merely descriptive phrase, direct the consumer immediately to the producer by way of road signs that prominently advertise the goods. Instead, the journey to the market source leads them through an intermediate loop at the cloverleaf in thought. Where the descriptive common words lead the buyer by the hand, the rarer suggestive mark ushers through the mind. From the commercial name to the product or its market to its source, the suggestive term transports both through purposefully evocative words laden with intimation and through the contemplated imagery and associations the name conjures. That passage is

features metonymically; it instead hints at and suggests them metaphorically. *See* *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 (9th Cir. 2002); *Am. Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 107 (2d Cir. 1978).

187. *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989) (citing *G. Heileman Brewing Co. v. Anheuser-Busch Inc.*, 676 F. Supp. 1436, 1491 n.46 (E.D. Wis. 1987)).

188. *See, e.g.,* Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 *ARIZ. ST. L.J.* 1033, 1035 (2009) (criticizing the test’s effect on trademark law); Beverly W. Pattishall, *The Lanham Trademark Act—Its Impact Over Four Decades*, 76 *TRADEMARK REP.* 193, 220 (1986) (calling the *Abercrombie* spectrum “artificial and regrettable” and “[o]ne of the worst blights [on trademark law] . . . which has spread from the Second Circuit into others and now appears to be settling in generally”); Tushnet, *supra* note 4, at 865 (describing the *Abercrombie* spectrum test’s negative impacts on trademark law).

189. *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (S.D.N.Y. 1923), *aff’d per curiam*, 4 F.2d 1018 (2d Cir. 1925).

190. *See* Brown, *supra* note 117, at 1188.

191. *See* Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 *N.C. L. REV.* 471, 519 (1997).

192. *See* *Surgicenters of Am., Inc. v. Med. Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979).

neither linear nor strait. It demands a mental exercise, multiple bounds in a dual act of perception and imagination. A first stage is associated with the creative energy exerted by the maker of the mark. When choosing what to call the article, the creator of the suggestive name *meaningfully fixes upon associational terms that will identify the product figuratively and will appeal to the consumer by allusion and metaphor*. The second mental act closes that loop. It is that which occurs in the mind of the consumer allured to the product, and who may accept it in part on the strength of the purposeful imagery summoned by its name [S]uggestiveness is an artful quality of inherent imagery and obliqueness infused into a fine turn of a word or phrase which, at the moment of perception when it all clicks and the association intended becomes apparent, stirs the response often with admiration. “That’s it.” It is, for example, the roundabout recognition evoked by calling a computer clicker a “mouse,” or conceiving of the name “Big Star” to mark a small town in Bethlehem.¹⁹³

C. *Alternative Tests for Determining Inherent Distinctiveness*

While the imagination test is the primary criterion for deciding distinctiveness, courts do sometimes consider other tests in making validity determinations either in combination with or instead of the imagination test. These include (1) the “competitors’ need” test, and (2) the “dictionary” test.¹⁹⁴

The competitors’ need test “focuses on the extent to which a mark is actually needed by market competitors to identify their goods and services.”¹⁹⁵ If a trademark conveys information about goods or services that is “so direct and clear that competing sellers would be likely to need to use the term in describing their goods in advertising and promotion,” then it is merely descriptive.¹⁹⁶ From an economic perspective, granting exclusive rights to use of generic marks has long been thought to give

193. *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 196–97 (S.D.N.Y. 2000) (emphasis added).

194. For a comprehensive list of tests used by courts to measure distinctiveness, see Roberts, *supra* note 10, at 1056–76 (2012) (explaining that tests for distinctiveness include imagination, double entendre, incongruity, creative fallacy, dictionary, competitors’ need, competitors’ use, puffing, and intentional fallacy).

195. See *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987).

196. 2 MCCARTHY, *supra* note 131, § 11:68.

trademark owners a monopoly and thus hinder competition.¹⁹⁷ This logic provides the basis for the competitors' need test.¹⁹⁸

The dictionary test is at times used by courts and the Patent and Trademark Office along with, or instead of, the imagination test.¹⁹⁹ The test looks at the common usage of the term or terms comprising a mark for evidence of the mark's non-distinctiveness. If the word mark is used as, or as part of, the dictionary definition of the word at issue, it is typically considered descriptive rather than suggestive. Evidence that a mark is merely descriptive may be obtained from sources such as dictionaries, surveys, or newspapers.²⁰⁰ The dictionary test is essentially an inversion of the imagination test in that it tests for mere descriptiveness (concretely, by use of a dictionary or similar source) instead of inherent distinctiveness (abstractly, via metaphor and the consumer imagination).

In sum, while alternative tests do exist, the inherent distinctiveness and thus initial validity of word marks most often hinges on establishing a metaphorical connection with their underlying product or service. Word marks that have no metaphorical significance either because they are literal designations (generic marks) or metonymical representations (descriptive marks) are ineligible for initial trademark status. Word marks that are metaphorical, though, are deemed eligible for all of the benefits of trademark protection ab initio. This is consistent with the figurative quality of a symbol, and, as previously discussed in Part I, being a "symbol" is the first requirement of a valid trademark.

197. For example, granting a trademark for the word BANANA to a company selling bananas would force competitors to label their products as something else, which would perhaps raise transaction costs. *Cf.* Jake Linford, *A Linguistic Justification for Protecting Generic Trademarks*, 17 YALE J.L. & TECH. 110, 145–47 (2015) (arguing that competition can also be hindered when trademark doctrine fails to recognize a generic term that has acquired distinctiveness).

198. A similar test is the "third party's actual use" test. Instead of looking prospectively, this test seeks to determine whether third parties have actually used the term to describe the qualities of their own products or services. If so, the term is likely to be deemed merely descriptive.

199. *See, e.g.,* Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 116 (5th Cir. 1979); Xtreme Caged Combat v. ECC Fitness, No. 12–CV–3855, 2013 WL 6022135, at *5 (E.D. Pa. Nov. 14, 2013).

200. For example, the Trademark Trial and Appeal Board found the word COACH to be, [M]erely descriptive when used in connection with educational materials used to prepare students for standardized tests because it "immediately conveys to purchasers the purpose of the materials." In support of this finding, the Board pointed to the dictionary definitions of the word "coach," which include: (1) "a private tutor who prepares a student for an examination"; . . . and (3) "to give instruction or advice in the capacity of a coach; instruct."

Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1378 (2012) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600, 1617 (T.T.A.B. 2010)).

III. VISUAL METAPHOR AND THE DISTINCTIVENESS OF IMAGE MARKS

Though the inherent distinctiveness of word marks often turns on the use of metaphor, that figurative framework is all but abandoned in the context of image marks. There is no consistent, uniform, and predictable test for deciding the inherent distinctiveness of image marks in the form of logos and trade dress. Courts and the Patent and Trademark Office often use the *Seabrook* test, which is a multi-factor inquiry designed to ascertain whether an image mark is “commonplace” or unique in the field.²⁰¹ In other decisions, the *Abercrombie* spectrum is applied, often haphazardly, in the case of images.²⁰² Yet, only rarely does trademark law apply the imagination test in the image context.

The lack of clarity surrounding the determination of image distinctiveness is unsurprising given the conclusory treatment of images under the law more generally.²⁰³ Rebecca Tushnet explains that “images have a complex relationship to truth, reality, and deception, especially in the law. Western culture associates images with truth, but also with emotion, and, therefore, with dangerous subjectivity.”²⁰⁴ And Elizabeth Porter notes that the law lacks tools to deal sufficiently with images: “‘I know it when I see it’ is not merely an aphorism: It’s the reigning, if not sole, canon of visual interpretation under the law.”²⁰⁵

This Part attempts to make the case that in circumstances where the inherent validity of an image mark is at issue, trademark law would do well to look to whether the image in question²⁰⁶ contains a visual metaphor, i.e., that it is able to convey one or more positive features or

201. See *infra* section III.B.

202. See *infra* section III.B.

203. See, e.g., Porter, *supra* note 8, at 1696. And, as J. Thomas McCarthy, author of the leading—and usually otherwise very helpful—treatise, *Trademarks and Unfair Competition*, puts it:

Because a picture is worth a thousand words, there is little in the way of guidelines to determine the visual similarity which will cause a likelihood of confusion with buyers. Obviously, for picture and design marks (as opposed to word marks), similarity of appearance is controlling. There is no point in launching into a long analysis of the judicial pros and cons regarding visual similarity of marks. Regarding visual similarity, all one can say is “I know it when I see it.”

4 MCCARTHY, *supra* note 6, § 23.25.

204. Tushnet, *supra* note 4, at 862.

205. Porter, *supra* note 8, at 1696.

206. For the sake of simplicity, this Article will focus on logo mark examples. However, given the broad definition of conceptual metaphor as “understanding and experiencing one kind of thing in terms of another,” LAKOFF & JOHNSON, *supra* note 14, at 5, there is no principled reason why other forms of trade dress—or even more unusual marks like scents, sounds, or motion—cannot be understood in terms of metaphorical associations.

connotations relating to its associated product or service. Section III.A provides a description of the categories of image marks that are, under current law, eligible for trademark protection without secondary meaning—logos, product packaging, and services-related trade dress. Section III.B reviews the most prominent tests for deciding the inherent distinctiveness of image marks—the *Seabrook* test and the *Abercrombie* spectrum’s hierarchy of word mark strength—and concludes that they are at times ineffective. Section III.C proposes, in taking into account the research presented in the previous Parts of this Article, a definitional test of visual metaphor. According to the test proposed, the distinctiveness of an image mark would be based, at least in part, on whether the mark includes (1) the representation of a person, place, thing or idea, (2) by means of a visual image, (3) that suggests an *obvious* particular association or point of similarity as to its underlying product or service.²⁰⁷ Such a framework is conceptually coherent with the trademark’s status as a symbol and would mirror the predictability inherent in the word mark distinctiveness context.

A. *Image Marks: Logos and Trade Dress*

The Lanham Act’s definition of a trademark “includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”²⁰⁸ This definition makes clear that almost any symbol, including a visual image, capable of consumer perception may potentially function as a trademark. The simplest type of image mark is a logo or design mark. Consider the common examples mentioned in the Introduction: Starbucks’s siren logo, Nike’s swoosh, and the Apple logo. As a matter of law, logos, like word marks, may be inherently distinctive. But, the method for evaluating such validity remains less than clear.

More complex still is the issue of trade dress.²⁰⁹ Trade dress has in the past been defined as the overall appearance of labels, wrappers, and

207. See *infra* section III.C.

208. Lanham Act § 45, 15 U.S.C. § 1127 (2012).

209. For a scholarly analysis of distinctiveness and trade dress as set against the backdrop of the Supreme Court’s jurisprudence in the area, see generally Lars Smith, *Trade Distinctiveness: Solving Scalia’s Tertium Quid Trade Dress Conundrum*, 2005 MICH. ST. L. REV. 243.

containers used as product packaging.²¹⁰ Over time, that definition has broadened to include any elements that are used in the presentation of a good or service to a consumer.²¹¹ This includes elements used to identify the source of the goods or services associated with a trade dress, such as size, shape, color(s), textures, and graphics used on both the product and the packaging of the product.²¹² Like other types of marks, trade dress must be distinctive to be protectable.²¹³ Consistent with Supreme Court precedent, trade dress may be categorized into three basic areas: (1) product packaging, (2) product design, and (3) what Justice Antonin Scalia described as “tertium quid”—services-oriented and experiential trade dress like a restaurant’s distinctive décor.²¹⁴ For example, one court recognized trade dress protections in “the distinct building designs and interior and exterior color schemes” of Dunkin’ Donuts stores.²¹⁵

Some carve-outs to trade dress protection exist for conceptual and policy reasons. First, if trade dress is purely—or largely—“decorative” or “ornamental” (rather than source-indicating), it is not eligible for protection under the Lanham Act.²¹⁶ Examples of trade dress found to be “merely decorative” are designs on sweaters, arrangements of gems on rings, and means of displaying produce in grocery stores. Second, trade dress protection is generally not available for product design or product packaging that is “functional” to the product.²¹⁷ The rationale being that trade dress protection extended to the functional elements of a product could deprive consumers of the opportunity to purchase competing products, and marketplace competitors of the chance to create alternative product versions.

Certain types of trade dress may be inherently distinctive, whereas other types are only protectable upon a showing of secondary meaning. The Supreme Court has commented on the distinctiveness of trade dress in three cases: *Two Pesos, Inc. v. Taco Cabana, Inc.*,²¹⁸ *Qualitex Co. v.*

210. See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 (AM. LAW INST. 1995).

211. See 1 MCCARTHY, *supra* note 11, § 8:1.

212. *Id.*

213. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767 (1992).

214. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215 (2000).

215. *Dunkin’ Donuts Franchised Restaurants LLC v. D&D Donuts, Inc.*, 566 F. Supp. 2d 1350, 1362 (M.D. Fla. 2008).

216. See 1 MCCARTHY, *supra* note 11, § 8:1 n.17.

217. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001).

218. 505 U.S. 763 (1992).

Jacobsen Products Co., and *Wal-Mart Stores v. Samara Bros.*²¹⁹ In *Two Pesos*, having found no textual basis in the Lanham Act for treating trade dress differently than word marks or logos, the Court held that product packaging and similar trade dress can be inherently distinctive and thus registrable absent secondary meaning.²²⁰ In *Qualitex*, the Court held that a single color or a combination of colors could be a form of distinctive trade dress, but only after first acquiring secondary meaning.²²¹ Lastly, in *Wal-Mart Stores*, the Court carved out product design as a discrete category of trade dress incapable of protection without secondary meaning.²²² Roughly, the Court's rationale was that the purpose of product design is so often functional instead of source-identifying.²²³ Protection of product design from the outset would thus impair competition and make it difficult for new competing businesses to form.

In sum, logos, product packaging (minus color alone), and experiential trade dress—like the décor of a restaurant—remain eligible for protection upon a showing of inherent distinctiveness. Colors and product designs, though, must first acquire secondary meaning in commerce, and are therefore not considered as candidates for a visual metaphor-based test of inherent distinctiveness.

B. Current Tests for Determining the Inherent Distinctiveness of Image Marks Are Insufficient

Trademark law has no uniform test for evaluating the inherent distinctiveness of image marks. Most often, courts, the Patent and Trademark Office, and the Trademark Trial and Appeal Board use a test derived from *Seabrook Foods v. Bar-well Foods*²²⁴—the “*Seabrook*” test.²²⁵ Others use the *Abercrombie* spectrum without recognizing its figurative significance. Some courts use elements from both tests, while others use neither.

The most prominent test for evaluating the distinctiveness of image marks is the *Seabrook* test. *Seabrook* involved the appearance of product packaging trade dress, yet is now used in cases involving both logos and

219. 529 U.S. 205 (2000).

220. *See* 505 U.S. at 772.

221. *See* 514 U.S. at 519.

222. *See* 529 U.S. at 214.

223. *See id.*

224. 568 F.2d 1342 (C.C.P.A. 1977).

225. *Id.* at 1345.

various forms of trade dress. Under the *Seabrook* test, courts will consider the following factors:

[1] [W]hether [the logo or trade dress] was a “common” basic shape or design, [2] whether it is unique or unusual in a particular field, [3] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or [4] whether it was capable of creating a commercial impression distinct from the accompanying words.²²⁶

The *Seabrook* test does not refer to the symbolic dimensions of the mark at issue. Instead, the test factors amount to “variations on a theme rather than discrete inquiries,” each of which is used to ascertain whether an image mark is “commonplace.”²²⁷ For example, the Fifth Circuit applied the *Seabrook* test in *Amazing Spaces, Inc. v. Metro Mini Storage*²²⁸ in connection with a logo in the form of a “[s]tar [s]ymbol” used in connection with moving and storage services.²²⁹ Here, the mark at issue was stylized—shaded and set within a circle—and had been registered with the Patent and Trademark Office.²³⁰ Nonetheless, the Fifth Circuit held that these attributes did not sufficiently distinguish it from other star-formative logos.²³¹ The court thus held that the mark was not inherently distinctive, i.e., that it was not so “unique, unusual or unexpected” in the market that consumers would perceive it as identifying of source.²³² As evidence for its judgment, the Fifth Circuit cited McCarthy’s *Trademarks and Unfair Competition* treatise for the proposition that *Abercrombie* is typically ill-suited for application to images.²³³ The Court also cited a Restatement of Trademarks comment addressing symbols and graphic designs:

A symbol or graphic design is not inherently distinctive unless the nature of the designation and the manner of its use make it likely

226. *Id.* at 1344.

227. *See* *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 244 (5th Cir. 2010).

228. 608 F.3d 225 (5th Cir. 2010).

229. *See id.* at 240.

230. *See id.* at 245.

231. *See id.* at 246–47.

232. *See id.* at 247.

233. *See id.* at 241 (citing 2 MCCARTHY, *supra* note 131, § 11:7 (“Use of the spectrum of descriptive, suggestive, arbitrary and fanciful is largely confined to word marks. It is usually not suitable for nonword designations such as shapes and images . . . [which] must be judged by other guidelines.”)).

that prospective purchasers will perceive the designation as an indication of source. Commonplace symbols and designs are not inherently distinctive since their appearance on numerous products makes it unlikely that consumers will view them as distinctive of the goods or services of a particular seller. Thus, unless the symbol or design is striking, unusual, or otherwise likely to differentiate the products of a particular producer, the designation is not inherently distinctive.²³⁴

One issue with deciding whether a “symbol or design is striking, unusual, or otherwise likely to differentiate the products of a particular producer” is that it is entirely subjective and does not establish anything close to a bright-line rule.²³⁵ For instance, Lars Smith notes that the *Seabrook* test “puts the court in the position of having to make quasi artistic or design decisions, unrelated to the real issue of whether [the image] is functioning as a source identifier.”²³⁶ The test also conflates validity with scope of protection. Indeed, word marks often are protectable even if they are commonplace, provided that they are used in connection with goods and services dissimilar to other uses of the same or similar mark. Here, the star symbol was in use by numerous third-parties such as Wal-Mart and the Dallas Cowboys professional football team. Yet, those uses are outside of the moving and storage field, making consumer confusion unlikely. In fact, commonplace basic shapes—like a star—may be unusual in a particular field. And, coupled with their strong figurative connotations, commonplace images may therefore be powerful inherent source identifiers. Thus, the main inquiry under *Seabrook*—whether an image is “commonplace”—has certain merit but is not always sufficient in assessing the validity of image marks.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court noted (perhaps in dicta) that *Abercrombie* is directly applicable to evaluating the inherent distinctiveness of trade dress, yet provided no guidance on how to actually apply it.²³⁷ Courts are split as to whether to use *Abercrombie* for image marks. For instance, the Fifth Circuit in *Amazing Spaces* noted that the star symbol “resists categorization under the *Abercrombie* test.”²³⁸

234. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. d (AM. LAW INST. 1995).

235. *Id.*

236. See Lars Smith, *Trade Distinctiveness: Solving Scalia's Tertium Quid Trade Dress Conundrum*, 2005 MICH. ST. L. REV. 243, 299–300.

237. 505 U.S. 763 (1992).

238. *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 240 (5th Cir. 2010).

It was unwilling, though, “to hold that the *Abercrombie* test is eclipsed every time a mark other than a word is at issue.”²³⁹

When courts do apply *Abercrombie* to images—which occurs in a minority of the cases—they nearly always apply its degree-based hierarchy of strength (generic, descriptive, suggestive, arbitrary, and fanciful categories) rather than its binary judgment of validity by use of the imagination test. The result of this misapplication is that courts end up concluding that many logos and nearly all forms of trade dress—having nothing concrete and literal to do with the product or service—are “arbitrary,” and thus highly distinctive. When it comes to product packaging especially, the possibilities are virtually limitless and courts are quick to assume anything not resembling the product to be arbitrary.²⁴⁰ This potentially results in a wide scope of protection for many image marks, which can be seen as undesirable from a competition-oriented standpoint, and perhaps at odds with whether consumers actually perceive the trade dress to be inherently distinctive.²⁴¹

As a result, *Abercrombie* is not typically the exclusive test used to determine the inherent distinctiveness of images. In several cases, *Seabrook* is used as a supplement to *Abercrombie* (or vice versa) because a rote application of *Abercrombie* typically results in most images being classified as arbitrary. Yet, this perceived problem is the result of an incorrect interpretation of *Abercrombie*. In analogizing to word marks, the arbitrary classification is not truly arbitrary in the linguistic sense, i.e., having no meaningful semantic connection to the product or service. Instead, arbitrary marks, as noted in Part II, are generally catachrestic metaphors.²⁴² Thus, there is no literal connection between the signified (brand) and its referent (the product or service) in the case of an arbitrary

239. *Id.* at 243.

240. *See, e.g.,* *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) (“Since the choices that a producer has for packaging its products are, as the Fifth Circuit noted, almost unlimited, typically a trade dress will be arbitrary or fanciful and thus inherently distinctive” (citing *Chevron Chem. Co. v. Voluntary Purchasing Grps., Inc.*, 659 F.2d 695, 697 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982))). Note, however, that a recent empirical study suggests we may be running out of attractive word marks, and if that is true, one could imagine that we might also be running out of attractive trade dress elements. *See* Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 950 (2018).

241. *See, e.g.,* Vincent N. Palladino, *Trade Dress After Two Pesos*, 84 TRADEMARK REP. 408, 410 (1994).

242. *See supra* Part II; *infra* note 254 and accompanying discussion.

mark. Notably, though, there is typically a figurative connection between the two.

For example, *Abraham v. Alpha Chi Omega*²⁴³ involved a dispute over a manufacturer's purported use of several Greek organizations' word marks and crest logos.²⁴⁴ One issue involved the inherent distinctiveness of these fraternity and sorority crest logos. Here, the court applied both the *Abercrombie* and *Seabrook* tests to each organization's unique crest.²⁴⁵ The crests consisted of several symbols, including:

- A harp for Alpha Chi Omega;
- A lion's head for Alpha Delta Pi;
- A crescent moon and sickle for Alpha Gamma Rho;
- A sheaf of wheat and a rose for Alpha Omicron Pi;
- A cross for Alpha Tau Omega;
- A gryphon and shield for Beta Theta Pi;
- A cross and crescent moon for Lambda Chi Alpha;
- A twelve-pointed star for Chi Phi;
- A snake for Sigma Kappa; and
- An anchor with a shield for Delta Gamma.²⁴⁶

Under *Abercrombie*, the court believed each image to be "arbitrary":

[A]ll of the Greek Organizations' symbols consist of shapes or figures that have nothing to do with their status as fraternities or sororities. An image of a sheaf of wheat, knights' helmet, or arrow do nothing to signify a characteristic or quality of a fraternity or sorority organization. Therefore . . . the Greek Organizations' various symbols . . . cannot be given a classification of "generic" because they do not "connote the basic nature of articles or services" of fraternity or sorority organizations in general. Furthermore, the various symbols do not "identify a characteristic or quality" of fraternity or sorority organizations; therefore, a "descriptive" classification would also be inappropriate. Additionally, the various symbols do not "suggest an attribute" of fraternity or sorority organizations; therefore, a suggestive classification would also not be appropriate.²⁴⁷

243. 781 F. Supp. 2d 396 (N.D. Tex. 2011).

244. *See id.*

245. *See id.* at 411–12.

246. *See id.* at 413.

247. *Id.* at 414.

Given the so-called arbitrary status of the marks, the district court next turned to the *Seabrook* test to determine whether the marks were entitled to protection under the inherent distinctiveness doctrine. It reasoned:

[T]he Court shall evaluate the symbols under both the *Abercrombie* and *Seabrook Foods* tests. If the Court were to use the *Abercrombie* test, as promoted by the parties, it appears here that the symbols themselves are entitled to an “arbitrary” classification. The various symbols, such as a sheaf of wheat, arrow, knight’s helmet, lion’s head, rose, or cross, among others, have no relation at all to a fraternity or sorority organization. The use of such figures in association with these organizations that are in no way associated with the subject matter of the figures entitles these marks to an arbitrary classification.²⁴⁸

Applying *Seabrook*, the court held that the symbols were likewise inherently distinctive in that they could not be classified as “common.” According to the court:

While the symbols themselves largely are based upon commonly-known shapes or figures such as a rose, cross, or owl, they often have their own unique elements within their design; the arrow of Pi Beta Phi, for example, has a handle along its bottom, and the cross used by Sigma Chi has curved edges, unlike most crosses. Furthermore, one cannot say that these marks are commonly used amongst fraternity and sorority organizations; indeed, each Greek Organization has unique features by which it seeks to create a unique identity [A]mong the relevant base of customers . . . members of the Greek Organizations and their families, it is clear that the symbols are inherently distinctive To these customers, it is clear that they would recognize these symbols as by their intrinsic nature serving to identify a particular source because they are members of the Greek Organizations that they have designed them or adopted them as a symbol.²⁴⁹

While the district court ultimately came to the right result—the logos were inherently distinctive—they did so only after applying multiple tests, and the reasoning they used was thin. The court claimed that the various symbols “do not ‘identify a characteristic or quality’ of fraternity or sorority organizations,” when in fact they do.²⁵⁰ For instance, Chi

248. *Id.*

249. *Id.* at 415–16.

250. *Id.*

Omega's crest contains "the owl, a bird of wisdom, which reminds the membership of their responsibility to strive for knowledge and understanding throughout life."²⁵¹ Alpha Omicron Pi's golden sheaf of wheat "represents individuals bound together by ties of friendship and made stronger together than they are apart."²⁵² And, Lambda Chi Alpha's crescent is meant to signify "eternity, purity, fertility and growth, and submission to divine law."²⁵³ The images on the crests were not picked arbitrarily by the fraternity or sorority; each was picked to represent the core ideals embodied by the organization.²⁵⁴ Thus, each image can be said to require an imaginative leap on behalf of the consumer. Instead, invoking *Seabrook*, the court emphasized the design and artistic qualities of each symbol, like the handle of the Pi Beta Phi arrow and the curved edges of the Sigma Chi cross, rather than their underlying meanings. This rationale is a stretch, though, as some shapes—e.g., the Lambda Chi Alpha cross and crescent—are very basic.

Based on the research presented in Parts I and II of this Article, *Abercrombie* is perhaps a closer proxy for the distinctiveness of image marks than is *Seabrook*. However, when trademark law imports *Abercrombie* in the image context, it might better test for a metaphorical relationship between the mark and its product or service as a threshold matter, without rigidly applying *Abercrombie*'s scope-based strength inquiry.

Yet, trademark law only rarely applies the imagination test to non-verbal marks.²⁵⁵ At least one court has applied the imagination test to a composite mark, though. There, the logo consisted "of a stylized line

251. *History*, CHI OMEGA FRATERNITY, <http://chiomega.com/about-us/the-history-of-chi-omega/> [https://perma.cc/25A3-LFKV].

252. *Facts and Information*, ALPHA OMICRON PI, <https://www.alphaomicronpi.org/about/> [https://perma.cc/SBU8-W6KZ].

253. *Emblems of the Lambda Chi Alpha Fraternity*, ALPHA CHI LAMBA CORNELL, <https://www.iswza.org/ideals/emblems> [https://perma.cc/C2S4-V57A].

254. Arbitrary marks are usually chosen for rhetorical color and are a deliberate misuse of a term. Consider NIKE—classified as arbitrary under the *Abercrombie* spectrum. Consumers link the brand to the ideals of strength, victory, and ability. This connection from the brand to the athletic wear product is not arbitrary, but instead metaphorical. *See Nike, Inc. v. Leslie*, No. 85-960-Civ-T-15, 1985 WL 5251, at *2 (M.D. Fla. June 24, 1985). The Nike swoosh, too, is a visual metaphor (though in its simplicity perhaps not an obvious one). It is designed to perhaps represent one wing of Nike, the Goddess of Victory. This connotation contrasts with, for example, the metonymic NBA logo, depicting a basketball player and thus a part to a whole rather than an understanding of one thing in terms of another.

255. *See, e.g., Schiappa v. CharityUSA.com*, 2017 U.S. Dist. LEXIS 75771 (S.D. Fla. May 18, 2017) (finding an image mark consisting of a paw print shaped like a heart to be suggestive because it takes a leap of the imagination to go from a heart-shaped paw print to love of animals).

drawing on the back of an envelope, with a black keyhole design on the back flap of the envelope and the word ‘POSTX’ appearing below the flap.”²⁵⁶ The district court found that the logo did not literally describe the product. Instead, it functioned as a metaphor:

The court finds that plaintiff’s mark is suggestive. The drawing itself, an envelope containing a keyhole, suggests a concept of safe mail, though tying the design to plaintiff’s product requires some imagination. The word “POSTX” appearing on the envelope drawing is also [sic] suggestive of mail delivery, requiring, again, a certain degree of imagination to link it to the plaintiff’s email product. An envelope bearing a keyhole and the word “POSTX” does not literally describe plaintiff’s product, it suggests it by analogy and thereby requires that the viewer use some imagination.²⁵⁷

The Ninth Circuit then explained that the mark was suggestive and thus “moderately strong based on the design of the mark and the product it represents.”²⁵⁸ However, more fundamental to the mark’s protectability than its scope of protection is the binary distinctiveness threshold established by the mark’s metaphorical significance.

C. Proposal: An Imagination Test of Visual Metaphor

In light of the aforementioned, this section proposes that trademark law would do well to look to the metaphorical significance of an image or composite mark when evaluating its inherent distinctiveness, i.e., the mark’s initial validity as demonstrated by its conceptual, symbolic significance. Given that trademark law already does this in its evaluation of word mark distinctiveness, implementing such a test in the context of image marks, while challenging, should not be insurmountable. This proposed test places the burden on the mark owner—in cases where the distinctiveness of an image mark is not obvious—to provide an explanation of the metaphorical quality of the mark in mapping from the brand to the product. In other words, the imagination, thought, and perception necessary to connect the mark with its corresponding goods or services.

In the trademark prosecution setting, this explanation, by the mark applicant or its attorney correspondent, would be the equivalent of

256. See *PostX Corp. v. docSpace Co.*, 80 F. Supp. 2d 1056, 1058 (N.D. Cal. 1999).

257. *Id.* at 1060–61.

258. *Id.* at 1061.

overcoming a genericness or descriptiveness refusal issued by the Patent and Trademark Office for word marks.²⁵⁹ That is, trademark examiners could, if uncertain of the metaphorical quality of the image, issue an objection in the form of an Office Action to the trademark applicant for lack of distinctiveness. In response to the objection, the applicant would need to describe the figurative significance of the mark, i.e., that it both denotes source and connotes its related product or service. In the litigation context, if the validity of a mark is in dispute, both parties could provide arguments as to the image mark's metaphorical qualities or lack thereof.

Notably, this proposal utilizes *Abercrombie*'s imagination test, but does not rely dogmatically on its hierarchical classifications—generic, descriptive, suggestive, arbitrary, and fanciful.²⁶⁰ Other than the descriptive-suggestive dichotomy, the classifications are not needed for a threshold determination of the validity of images, just as they are not necessary to the yes-no validity judgment in the word mark context. While “[t]he strength of a given mark rests on its distinctiveness,”²⁶¹ the reverse is not true. The threshold showing of distinctiveness is binary. The suggestive-descriptive dichotomy centers only on whether a figurative connection exists between the mark and its corresponding product.

Thus, trademark law could use the imagination test as a binary measure of the inherent distinctiveness of images—removed from *Abercrombie*'s hierarchical, scope-based inquiry. As discussed in section II.C, the imagination test looks for the figurative, metaphorical nature of a mark, and thus the symbolic requirement of a valid trademark. If there is a metaphorical connection between an image and its marked product or service, then the image should be seen (at least from a conceptual lens) as inherently distinctive. In other words, its connotation is inherent by virtue of its symbolism, instead of having to be acquired through secondary meaning in the marketplace.

However, there may be reasons to restrict the protection of image marks even if they function in a metaphorical sense. For instance, consider the image of a heart-shaped candy box. It has inherent figurative significance but is so common as to perhaps be considered generic.²⁶² The

259. See Lanham Act, 15 U.S.C. § 1052(e)(1) (2012); TMEP, *supra* note 165, § 1209.

260. See *supra* section II.B.

261. *Miss World (UK) Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1448 (9th Cir. 1988).

262. *Author's Comment on "Aesthetic Functionality,"* in 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:81 (5th ed. 2017) (“A heart-shaped candy box is such a standard, oft-used shape as to be a ‘generic’ shape, incapable of trade dress status and certainly incapable of ever achieving a secondary meaning.”).

proposed test of visual metaphor need not function as an exclusive test for the inherent distinctiveness of images—just as the imagination test does not function as the exclusive test for word marks. Other tests are sometimes employed in tandem with it, like the competitor’s need test or the dictionary test.²⁶³ But, from a conceptual lens, the imagination test serves as an important “first cut” in satisfying the requirement that a valid trademark be “a symbol.”

At a high level, the author suggests only that trademark law would do well to look to whether a particular visual mark is *capable* of connotative significance in relation to its underlying product or service in cases when its inherent validity is at issue. This specific proposal—which should be seen as a preliminary possibility and begs future research—utilizes metaphor-in-advertising theorist Charles Forceville’s criteria for interpreting visual metaphors in advertising.²⁶⁴ As previously mentioned, most metaphors in commercial advertising use the product or service (or the brand more broadly) as the metaphor’s target domain. This is coupled with the “something else” that serves as the source domain, which in the trademark context is represented by the mark itself. The mark’s meaning can thus be mapped onto the target domain (the product or service).

Forceville suggests several elements to be analyzed in determining whether a visual metaphor exists in a given advertisement. First, Lakoff and Johnson’s definition of metaphor as “understanding and experiencing one kind of thing in terms of another” makes clear that the first criterion for interpreting something as a visual metaphor is that two “things” are involved.²⁶⁵ Thus, two things must be identified: (1) the product or service (i.e., the target) and (2) the “something else” connoted by the mark that is separate from the product or service (i.e., the source). Second, once it is determined that two “things” exist, it must be determined which is the target and which is the source.²⁶⁶ Because the target domain typically constitutes the product or service, we can look to the goods or services being used with the mark (perhaps identified by the federal trademark application, if one exists). Once the target domain is identified, the next step is identifying the source domain. This might be accomplished, in the trademark context, by looking at the image mark itself. Is the source

263. See *supra* section II.C.

264. See, e.g., FORCEVILLE, *supra* note 14, at 4; Forceville, *supra* note 59, at 26.

265. These two things are not reversible—a metaphor is considered TARGET IS SOURCE, and, in a given context, the two domains cannot be reversed. For example, ARGUMENT IS WAR is not the same metaphor as WAR IS ARGUMENT.

266. See *supra* notes 277–85.

domain—the image—“something else” as compared to the product? Or is it a literal (generic) or metonymical (descriptive) representation of the product itself? The final stage of visual metaphor interpretation involves “deciding which positive feature(s) or connotation(s) is/are to be mapped from source onto target (i.e., product).”²⁶⁷

Not all consumers need “to map the same features—for advertisers the attractiveness of using visual/pictorial metaphors presumably resides in a degree of ‘customization’ for individual viewers, who are after all aware they are invited to map positive connotations”²⁶⁸ from the marks to the product or service. And, in mirroring the suggestive versus arbitrary mark distinction, appropriate mappable features include “emotions, attitudes, and beliefs no less than more fact-oriented associations.”²⁶⁹ Thus, in deciding whether a mark utilizes visual metaphor (and therefore imagination, thought, and perception on the part of the consumer), three factors might include the following identified by Forceville: (1) what are the two dimensions of the metaphor?; (2) which is the target and which is the source?; and (3) what are the probable intended features to be mapped from source to target?²⁷⁰

Below are some thoughts as to how Forceville’s thoughts might be implemented as an imagination test for image marks. This proposal recommends separating a commonly used definition of visual metaphor—“the representation of a person, place thing, or idea by means of a visual image that suggests a particular association or point of similarity”²⁷¹—into elements, as is common among legal tests, so that each can be supported or attacked individually. Moreover, it adds to the end of the definition a trademark-related qualifier, “as to its underlying product or service.” This additional language references the need for “mapping” from source (brand) to target (product or service) domains discussed in Part I.

267. See generally Forceville, *supra* note 59.

268. *Id.*

269. *Id.*

270. *Id.*

271. See, e.g., Lenora Ledwon, *Understanding Visual Metaphors: What Graphic Novels Can Teach Lawyers About Visual Storytelling*, 63 DRAKE L. REV. 193 (2015); Richard Nordquist, *Visual Metaphor*, THOUGHTCO., <https://www.thoughtco.com/visual-metaphor-1692595> [<https://perma.cc/T5J6-RTNK>].

As illustrations, let us once more return to the examples presented in the Introduction: (1) the Apple logo,²⁷² (2) Starbucks's siren,²⁷³ and (3)

272.



Apple, Inc., Apple Logo, 1998; Tiziano Vecellio, *The Fall of Man*, 1550.

273.



Starbucks Corp., Starbucks Logo, 2011; Audio2Visual Contest, *A Siren's Call: A Little Bit Closer*, Contest Image, 2014, https://www.flickr.com/photos/rinoa_cathcart [<https://perma.cc/BV7Q-8ZLT>].

Nike's swoosh.²⁷⁴ For the sake of brevity, these examples focus on logo marks, but there may also be potential application of visual metaphor in the trade dress context given the metaphorical significance of product packaging and even services-related décor. As should perhaps be obvious, it is not implied that the examples that follow are the actual metaphorical connotations intended by these brands or perceived by all consumers. They are intended, rather, to show that some image marks are more capable of connotative significance than others.

1. *The Representation of a Person, Place, Thing, or Idea*

This first factor indicates that the image mark must be a clear representation of a person, place, thing, or idea to be subject to the test. It refers to the mark's denotative aspect. This factor alludes to the source domain—the mark itself as representative of a producer or, more often, a brand.²⁷⁵ What it seeks is a definable representation that can be used in commerce. The Apple logo is quite clearly a representation of an apple, and the Starbucks siren represents a mermaid, and each would meet this factor of the test. The Nike swoosh—while now famous as representative of the wing of the Goddess Nike, is less concretely a “person, place, thing, or idea,” and therefore in its abstraction means that an imagination test—typically used to determine the boundary between descriptive and suggestive marks—is unnecessary to deem it inherently distinctive. Again, what is important is that the mark consist of a concrete, obvious—i.e., easily perceived or understood—person, place, thing, or idea. This

274.



Nike, Inc., Nike Logo, 1995; *Nike, Goddess of Victory*, 500 B.C.E.

275. See *supra* section II.A.

establishes the need for the second and third factors. If the mark is not a concrete representation, it is per se inherently distinctive as a fanciful image mark.

2. *By Means of a Visual Image*

The second proposed factor requires that an inherently distinctive image mark contain a visual image separate from its wording or other non-visual elements. It largely tracks *Seabrook*'s fourth factor—that the image must create its own commercial impression apart from other verbal or non-verbal elements of the mark.²⁷⁶ This factor is helpful because an “image” may be classified in multiple ways; it is not limited to visual matters. First, imagery may refer to the basic “representation through language of sense experience.”²⁷⁷ In this sense, it is not limited to purely visual matters. Second, an image can exist as a figure of speech—a verbal metaphor where the image refers to “something else.”²⁷⁸ In fact, “it is at this point that image and symbol begin to merge.”²⁷⁹ Finally, a third category of images “emphasizes the capacity of an image to embody a symbolic division.”²⁸⁰

Because the definition of “image” is subject to multiple interpretations, this factor requires that image is interpreted narrowly to refer to a pictorial design containing a visual dimension. In the case of composite marks, the visual part of the mark must—without the assistance of the verbal portion—satisfy factors one and three of this test. Each of the prior factors meets this definition of image. The Apple logo is entirely a visual illustration of an apple (with a bite out of it). The swoosh is a rough sketch of the Goddess Nike's wing, and the Starbucks logo is a visual representation of a siren/mermaid. All three examples, in being entirely visual representations, would thus meet this second factor. Marks which are not images in this narrow sense are excluded from the test of visual metaphor.

276. See *supra* note 225 and accompanying discussion.

277. L. L. DICKSON, *THE MODERN ALLEGORIES OF WILLIAM GOLDING* 10 (1990).

278. See *id.*

279. *Id.*

280. *Id.*

3. *That Suggests a Particular Association or Point of Similarity as to Its Underlying Goods or Services*

The final factor requires that an image be able to connote its underlying product or service. In conceptual metaphor theory terminology, it requires conceptual mapping from the brand to the product. Consistent with the economic and psychological dimensions of trade symbols discussed in Part I, the image must therefore refer to qualities, values, or aesthetics relating to its marked product or service. Further, the inherently distinctive image mark cannot be metonymical. For example, if an image mark is for restaurant services, it could not be a utensil-formative logo. An inherently distinctive image mark associated with a coffee shop cannot be a coffee mug. If there are both metaphorical and metonymical parts to an image mark, it perhaps makes sense for the law to “disclaim” the metonymical aspects of the mark, thereby only allowing trademark protection for the metaphorical ones. Thus, in addition to being both a concrete and a visual representation, the image mark, as indicative of the source domain, must visually suggest—rather than describe—characteristics of its target domain. The Apple logo and Starbucks’s siren would each satisfy this final factor.

Apple’s logo mark, an apple with a bite out of it, has several possible connotations. In this regard, Forceville writes,

The word “apple” has as its denotation APPLE, (i.e., the concept “apple”) and among its possible connotations, say, “being a fairly ordinary kind of fruit,” “keeping you healthy,” “being tasty”, “being the fruit with which the serpent seduced Eve, and Eve in turn seduced Adam”, “being the fruit of which Paris had to present a golden specimen to one of the goddesses Hera, Athena or Aphrodite, by his decision indirectly causing the Trojan War”, etc. Similarly, a picture of an apple has the denotation APPLE and the same range of potential connotations as the word “apple”. This latter message of the picture is . . . its “connoted” or “symbolic” message.²⁸¹

Different consumers may conceive of different connotations for the Apple logo. What is important is that consumers see the Apple logo as connoting something apart from its computer and technology-related goods and services.

Likewise, Starbucks’s logo—a mermaid, or siren, with long, spiraling locks of hair—could be said to invoke the archetype of the explorer and

281. CHARLES FORCEVILLE, *ADVERTISING METAPHORS* 72 (1996).

the theme of the sea.²⁸² In myth, sirens have long been associated with luring sailors in with enchanting songs, and Starbucks similarly lures consumers in with the promise of a hot beverage and a recess from the daily grind.²⁸³ Starbucks's trade dress is likewise metaphorical. Its prominent green color evokes natural, ecological imagery, while its in-store décor combines wood and metal piping which contributes to its "voyaging ship" theme.²⁸⁴

Finally, it is important to reiterate that the figurative connection must be *plausible*. Many other figurative interpretations of the brands and products and services mentioned are possible. What is important is that a plausible—i.e., fair or reasonable—metaphorical connection is established, whether or not the exact connotations differ from consumer to consumer. The particular connotations are subjective, but the definitional test of visual metaphor is designed to create an objective measure of symbolic significance—like the imagination test in requiring a (any) clear "imaginative leap" on the part of consumers. In any case, in considering the way mark owners and consumers make symbolic meaning, trademark law would do well to consider more heavily the role of conceptual metaphor as a component, even if not a threshold requirement, in determining trademark distinctiveness, regardless of the type of mark at issue.

IV. POTENTIAL OBJECTIONS

Having examined how a test of visual metaphor might be implemented in trademark law, this Part briefly discusses three potential objections to such a test. These include (1) the abstract nature of the concept of metaphor, (2) criticisms of the *Abercrombie* spectrum and the imagination test in the word mark context, and (3) that the test would serve to incentivize symbolic consumption and therefore contribute to the dilution of culture through the commodification of numinous imagery.

A. *Abstraction*

At first blush, applying a test of visual metaphor may seem like an unworkable idea. The concept of metaphor is quite abstract, with the basic conceptual metaphor definition laid out in this Article as being the understanding of one thing or concept in terms of another. Yet, the

282. *Id.*

283. *Id.*

284. *Id.*

proposal just laid breaks the definition of visual metaphor into constituent parts. As discussed in section I.B, there is further an entire literature to fall back on that relates conceptual metaphor theory and similar theories to the branding context. The rules of trademark law—in filtering through millions of consumers’ subject mindsets—are bound to be amorphous.²⁸⁵ Yet, the test presented, even given its potential subjectivity, would likely be an improvement over the current judgments of commonality under *Seabrook*, or the confusion stemming from attempting to fit images into *Abercrombie*’s categorical framework in a literal, scope-based sense. As a binary judgment, the majority of cases seeking visual metaphor should be fairly obvious. Of course, at the margins there will be close calls, which is not unlike other doctrines in trademark law which likewise revolve around the consumer’s subjective mindset. However, the proposed test for visual metaphor, in seeking one or more features from the source domain as mapping onto the target domain, should serve as a useful heuristic for what consumers may be thinking in regard to a given image mark. Of course, “[w]e should never forget that relevance and meaning can never be measured objectively: relevance is always relevance to an individual.”²⁸⁶ Trademark—especially in its imaginal, inner, and subjective aspects—is unfortunately not a concrete area of the law.²⁸⁷

B. Import of the Imagination Test

The proposal may also be criticized based on its (partial) import of the *Abercrombie* spectrum, which has been oft-criticized in trademark law.²⁸⁸ For all its flaws, though, *Abercrombie* provides a certain amount of predictability and a general framework for evaluating a terribly difficult area—how marks are perceived by the consumer in his or her subjective imagination. Called “[t]he most ‘intellectual’ of the intellectual properties, trademarks are a property purely of consumers’ minds.”²⁸⁹

285. See, e.g., Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS U. L.J. 781, 784–85 (2008) (noting that “in trademark law, we are considering the (re)actions of potentially millions of consumers. So . . . trademark law must of necessity take certain shortcuts to ensure that litigation does not devolve into a morass of evidentiary issues; true, too, that in a field (law) that depends on precedent for efficient private ordering, there must be certain general rules that can be derived and followed” (citing Graeme B. Dinwoodie, *What Linguistics Can Do for Trademark Law*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 140, 148 (J. Ginsburg et al. eds., 2007))).

286. Forceville, *supra* note 59, at 38 (citations omitted).

287. See Beebe, *supra* note 155, at 2021.

288. See, e.g., Joseph Scott Miller, *Abercrombie 2.0—Can We Get There from Here? Thoughts on “Suggestive Fair Use,”* 77 OHIO ST. L.J. FURTHERMORE 1 (2016).

289. Beebe, *supra* note 155, at 2021.

From an economic perspective, it has been argued that abandoning the relative simplicity of the *Abercrombie* spectrum would have negative consequences:

Abandoning the simplicity of the *Abercrombie* spectrum will increase administrative costs, and increased administrative costs can serve as a barrier to entry for some plaintiffs. If a firm cannot protect a mark without presenting evidence of source significance, it will take the firm longer to settle its claim to the mark. The delay can be costly. In addition, amassing evidence of source significance is itself a costly endeavor. But the accuracy of the *Abercrombie* spectrum has recently been called into question. This is in part because judges with limited information designed the spectrum as a cost-saving mechanism, and in part because reduced administrative costs typically correlate with increased error costs. By definition, rules and rule-like proxies both over- and under-correct. The *Abercrombie* categories serve as a shortcut for the inquiry that we would prefer to pursue in a costless universe.²⁹⁰

And, from a practical lens, the *Abercrombie* framework is unlikely to change substantially, lest be eliminated entirely. As Joseph S. Miller notes, “the *Abercrombie* hierarchy of distinctiveness for trademarks—approaching its fortieth birthday with citations in more than 850 cases and more than 580 law review pieces, now the dominant framework for classifying the conceptual strength of word marks—looks more than stout enough to weather a pitched knife fight without a scratch.”²⁹¹

C. *Symbolic Consumption*

Commentators have increasingly debated the effect that the language of consumption—and, by extension, symbolic consumption in the image mark context—has on culture and thus the public interest.²⁹² Katya Assaf has written extensively on this issue and notes that commodification,

290. Linford, *supra* note 19, at 759–60.

291. Miller, *supra* note 288, at 1.

292. See, e.g., Brown, *supra* note 117, at 1183 (explaining that “[a]dvertising has two main functions, to inform and to persuade,” and that the law should not protect the latter because it disadvantages competition and gives to society no corresponding public benefit); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1735 (1999) (remarking that “[w]hile there is nothing wrong with encouraging Warner Brothers to sell the public on atmospherics and to devise clever ways to exploit those atmospherics commercially, neither incentive theory nor moral desert offers a reason to protect them from competition”).

especially in its figurative aspect, has deleterious effects on culture.²⁹³ Assaf points out that a trademark's meaning is most often created by metaphorically linking a mark to various cultural signs and symbols totally unrelated to its use in commerce.²⁹⁴ By incentivizing creativity with higher degrees of protection, trademark law, and the imagination test particularly, can be seen to encourage this practice. Often, trademarks absorb the meaning and values contained within symbols for no rational, economic reasons.²⁹⁵ According to Assaf, this leads to a diluted and commodified culture in the form of “brand fetishism”: the phenomenon of consumers perceiving brands and trademarks as “spiritual entities” rather than informational devices.²⁹⁶

Assaf's point is well taken. Extending such a legal framework to image marks—which are archetypal and deep-seated in the consumer imagination—would perhaps serve to further incentivize imaginative branding and hence consumers' “magical thinking” regarding trade symbols.²⁹⁷ Indeed, as Jean Baudrillard writes,

Like every great myth worth its salt, the myth of “Consumption” has its discourse and its anti-discourse. In other words, the elated discourse on affluence is everywhere shadowed by a morose, moralizing, “critical” counter-discourse on the ravages of consumer society and the tragic end to which it inevitably dooms society as a whole.²⁹⁸

CONCLUSION

This Article has envisioned metaphor as integral to the threshold determination of distinctiveness for both word and image marks. The current baseline for word mark validity is already metaphor—the imagination test used to determine inherent distinctiveness requires a verbal metaphor (i.e., a figure of speech) between the mark and its underlying product or service. From a doctrinal perspective, this is accurate given that trademarks must be symbols, and figurative significance is required to meet the definition of a symbol. Yet, there is

293. See Katya Assaf, *The Dilution of Culture and the Law of Trademarks*, 49 IDEA 1 (2008).

294. See *id.*

295. See *id.*

296. Katya Assaf, *Brand Fetishism*, 43 CONN. L. REV. 83, 147–48 (2010); see also Katya Assaf, *Magical Thinking in Trademark Law*, 37 L. & SOC. INQUIRY 595, 596 (2012) (likening the aesthetic function of trademarks to a form of magical thinking resembling a totemic religion).

297. Assaf, *Magical Thinking*, *supra* note 296, at 596.

298. See BAUDRILLARD, *THE CONSUMER SOCIETY: MYTHS AND STRUCTURES*, *supra* note 120, at 212.

no uniform, coherent test for evaluating the distinctiveness of image marks. In having noted that metaphor refers to a phenomenon of thought rather than merely of language, though, visual metaphor is an extension that seems to fit quite well into the distinctiveness framework.

This Article's intended contributions to the literature are threefold. First, it has conceived of metaphor as a central consideration in analyzing the inherent distinctiveness of both word and image marks. Second, from a doctrinal standpoint, the Article has attempted to replicate for images the modicum of predictability present in the *Abercrombie* spectrum's word mark framework as it pertains to a mark's validity. Finally, the proposal put forward in this Article is envisioned as a starting point, of which optimistically a more robust future dialogue on the meaning of images in trademark and advertising law will follow. But currently the law is encased in deep fog with respect to its understanding of images.²⁹⁹ It is hoped that this Article will lift a metaphorical layer of that fog.

299. See Porter, *supra* note 8.