

5. Distinctiveness

All material in this chapter by Michael Grynberg
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5.1. Discussion of distinctiveness

Trademark protection begins with selecting a trademark that is eligible for protection. To be protected a trademark must be distinctive, that is, it must be capable of identifying and distinguishing the product or service in the marketplace. Accordingly, Section 45 of the Lanham Act (15 U.S.C. § 1127) defines a trademark as “any word, name, symbol, or device, or any combination thereof [used] . . . to identify and distinguish [goods or services] from those manufactured or sold by others and to indicate the source of the goods [or services], even if that source is unknown.” The *Restatement of Unfair Competition* requires that a mark be “distinctive of a person’s goods or services and . . . used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”

Note that neither of these definitions limits a trademark to words. As we will see, trademark rights have been claimed in a range of subject matter, including logos, symbols, product packaging, product design, color, sounds, and expressive works. This reading focuses on trademark protection for words.

What does it mean to be distinctive? Trademark law sees certain marks as *inherently distinctive*. That means that by their very nature, the marks are

perceived as performing a trademark function when paired with a product or service. Note that this is an empirical assumption, which may not necessarily be true. If a court treats a mark as inherently distinctive, the mark holder need not show that consumers *actually* treat the word as a trademark.

On the flip side of the coin, some would-be marks are not inherently distinctive but remain eligible for protection. These source identifiers are treated as trademarks only if the trademark holder can establish *secondary meaning*. For protection, the mark holder must show that consumers have come to treat the word or device in question as a trademark. In other words, the primary significance of the word (in context) with the relevant consuming public must be as a source identifier rather as a descriptor of the product. *See, e.g., Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 113 (1938) (when “the primary significance of the term in the minds of the consuming public is not the product but the producer”). As you will see when you read the *Zatarains* case, words that are deemed descriptive of a product are not inherently distinctive for trademark purposes, while arbitrary words are. Thus APPLE computer is an inherently distinctive mark, while TASTY hamburgers is not. But if the consuming public comes to associate TASTY with a particular source of hamburgers, the TASTY mark may be protected. Secondary meaning has its limits. Some words may never be trademarked regardless of what consumers think. Generic marks, words that are descriptive of product *categories*, are ineligible for protection regardless of secondary meaning. APPLE cannot be a trademark for a brand of apple.

The distinction between distinctive and non-distinctive marks also applies to trademark registration. Section 2 of the Lanham Act, 15 U.S.C. § 1052, makes this distinction and gives some clues on ways to establish secondary meaning. It provides that:

. . . Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially

exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

A well-known classification case follows:

5.2. Case: *Zatarains v. Oak Grove Smokehouse* (Fish-Fri, Chick-Fri) (5th Cir. 1983)

Zatarains, Inc. v. Oak Grove Smokehouse, Inc.

698 F.2d 786 (5th Cir. 1983)

GOLDBERG, Circuit Judge:

This appeal of a trademark dispute presents us with a menu of edible delights sure to tempt connoisseurs of fish and fowl alike. At issue is the alleged infringement of two trademarks, “Fish-Fri” and “Chick-Fri,” held by appellant Zatarain’s, Inc. (“Zatarain’s”). The district court held that the alleged infringers had a “fair use” defense to any asserted infringement of the term “Fish-Fri” and that the registration of the term “Chick-Fri” should be cancelled. We affirm.

I. FACTS AND PROCEEDINGS BELOW

A. THE TALE OF THE TOWN FRIER

Zatarain’s is the manufacturer and distributor of a line of over one hundred food products. Two of these products, “Fish-Fri” and “Chick-Fri,” are coatings or batter mixes used to fry foods. These marks serve as the entree in the present litigation.

Zatarain’s “Fish-Fri” consists of 100% corn flour and is used to fry fish and other seafood. “Fish-Fri” is packaged in rectangular cardboard boxes containing twelve or twenty-four ounces of coating mix. The legend “Wonderful FISH-FRI ®” is displayed prominently on the front panel, along with the block Z used to identify all Zatarain’s products. The term “Fish-Fri” has been used by Zatarain’s or its predecessor since 1950 and has been registered as a trademark since 1962.

Zatarain’s “Chick-Fri” is a seasoned corn flour batter mix used for frying chicken and other foods. The “Chick-Fri” package, which is very similar to

that used for “Fish-Fri,” is a rectangular cardboard container labelled “Wonderful CHICK-FRI.” Zatarain’s began to use the term “Chick-Fri” in 1968 and registered the term as a trademark in 1976.

Zatarain’s products are not alone in the marketplace. At least four other companies market coatings for fried foods that are denominated “fish fry” or “chicken fry.” Two of these competing companies are the appellees here, and therein hangs this fish tale.

Appellee Oak Grove Smokehouse, Inc. (“Oak Grove”) began marketing a “fish fry” and a “chicken fry” in March 1979. Both products are packaged in clear glassine packets that contain a quantity of coating mix sufficient to fry enough food for one meal. The packets are labelled with Oak Grove’s name and emblem, along with the words “FISH FRY” OR “CHICKEN FRY.” Oak Grove’s “FISH FRY” has a corn flour base seasoned with various spices; Oak Grove’s “CHICKEN FRY” is a seasoned coating with a wheat flour base.

Appellee Visko’s Fish Fry, Inc. (“Visko’s”) entered the batter mix market in March 1980 with its “fish fry.” Visko’s product is packed in a cylindrical eighteen-ounce container with a resealable plastic lid. The words “Visko’s FISH FRY” appear on the label along with a photograph of a platter of fried fish. Visko’s coating mix contains corn flour and added spices.

Other food manufacturing concerns also market coating mixes. Boochelle’s Spice Co. (“Boochelle’s”), originally a defendant in this lawsuit, at one time manufactured a seasoned “FISH FRY” packaged in twelve-ounce vinyl plastic packets. Pursuant to a settlement between Boochelle’s and Zatarain’s, Boochelle’s product is now labelled “FISH AND VEGETABLE FRY.” Another batter mix, “YOGI Brand® OYSTER SHRIMP and FISH FRY,” is also available. Arnaud Coffee Corporation (“Arnaud”) has manufactured and marketed “YOGI Brand” for ten to twenty years, but was never made a party to this litigation. A product called “Golden Dipt Old South Fish Fry” has recently entered the market as well.

B. OUT OF THE FRYING PAN, INTO THE FIRE

Zatarain’s first claimed foul play in its original complaint filed against Oak Grove on June 19, 1979, in the United States District Court for the Eastern District of Louisiana. The complaint alleged trademark infringement and unfair competition under the Lanham Act §§ 32(1), 43(a), 15 U.S.C. §§ 1114(1), 1125(a) (1976), and La.Rev.Stat.Ann. § 51:1405(A) (West

Supp.1982). Zatarain's later amended its complaint to add Boochelle's and Visko's as defendants. Boochelle's and Zatarain's ultimately resolved their dispute, and Boochelle's was dismissed from the suit. The remaining defendants, Oak Grove and Visko's, filed counterclaims against Zatarain's under the Sherman Act § 2, 15 U.S.C. § 2 (1976); the Clayton Act § 4, 15 U.S.C. § 15 (1976); La.Rev.Stat.Ann. § 51:1401 (West Supp.1982); the Fair Packaging and Labeling Act, 15 U.S.C. §§ 1451-1461 (1976); and the Food, Drug, and Cosmetic Act § 403, 21 U.S.C. § 343 (1976). The defendants also counterclaimed for cancellation of the trademarks "Fish-Fri" and "Chick-Fri" under section 37 of the Lanham Act, 15 U.S.C. § 1119 (1976), and for damages under section 38 of the Lanham Act, 15 U.S.C. § 1120 (1976).

The case was tried to the court without a jury. Treating the trademark claims first, the district court classified the term "Fish-Fri" as a descriptive term identifying a function of the product being sold. The court found further that the term "Fish-Fri" had acquired a secondary meaning in the New Orleans geographical area and therefore was entitled to trademark protection, but concluded that the defendants were entitled to fair use of the term "fish fry" to describe characteristics of their goods. Accordingly, the court held that Oak Grove and Visko's had not infringed Zatarain's trademark "Fish-Fri."

With respect to the alleged infringement of the term "Chick-Fri," the court found that "Chick-Fri" was a descriptive term that had not acquired a secondary meaning in the minds of consumers. Consequently, the court held that Zatarain's claim for infringement of its trademark "Chick-Fri" failed and ordered that the trademark registration of "Chick-Fri" should be cancelled.

Turning to Zatarain's unfair competition claims, the court observed that the evidence showed no likelihood of or actual confusion on the part of the buying public. Additionally, the court noted that the dissimilarities in trade dress of Zatarain's, Oak Grove's, and Visko's products diminished any possibility of buyer confusion. For these reasons, the court found no violations of federal or state unfair competition laws.

Finally, the court addressed the counterclaims asserted by Oak Grove and Visko's. Because no evidence was introduced to support the defendants' allegations of monopolistic behavior, fraud, and bad faith on the part of Zatarain's, the court dismissed the federal and state antitrust and unfair trade practices counterclaims. The court also dismissed the counterclaim based on

Zatarain's allegedly improper product identity labelling. Both sides now appeal to this court.

II. ISSUES ON APPEAL

The district court found that Zatarain's trademark "Fish-Fri" was a descriptive term with an established secondary meaning, but held that Oak Grove and Visko's had a "fair use" defense to their asserted infringement of the mark. The court further found that Zatarain's trademark "Chick-Fri" was a descriptive term that lacked secondary meaning, and accordingly ordered the trademark registration cancelled. Additionally, the court concluded that Zatarain's had produced no evidence in support of its claims of unfair competition on the part of Oak Grove and Visko's. Finally, the court dismissed Oak Grove's and Visko's counterclaims for antitrust violations, unfair trade practices, misbranding of food products, and miscellaneous damages.

Battered, but not fried, Zatarain's appeals from the adverse judgment on several grounds. First, Zatarain's argues that its trademark "Fish-Fri" is a suggestive term and therefore not subject to the "fair use" defense. Second, Zatarain's asserts that even if the "fair use" defense is applicable in this case, appellees cannot invoke the doctrine because their use of Zatarain's trademarks is not a good faith attempt to describe their products. Third, Zatarain's urges that the district court erred in cancelling the trademark registration for the term "Chick-Fri" because Zatarain's presented sufficient evidence to establish a secondary meaning for the term. For these reasons, Zatarain's argues that the district court should be reversed. . . .

III. THE TRADEMARK CLAIMS

A. BASIC PRINCIPLES

1. Classifications of Marks

The threshold issue in any action for trademark infringement is whether the word or phrase is initially registerable or protectable. Courts and commentators have traditionally divided potential trademarks into four categories. A potential trademark may be classified as (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful. These categories, like the tones in a spectrum, tend to blur at the edges and merge together. The labels are more advisory than definitional, more like guidelines than pigeonholes. Not surprisingly, they are somewhat difficult to articulate and to apply.

A *generic* term is “the name of a particular genus or class of which an individual article or service is but a member.” A generic term connotes the “basic nature of articles or services” rather than the more individualized characteristics of a particular product. Generic terms can never attain trademark protection. Furthermore, if at any time a registered trademark becomes generic as to a particular product or service, the mark’s registration is subject to cancellation. Lanham Act § 14, 15 U.S.C. § 1064(c) (1976). Such terms as aspirin and cellophane have been held generic and therefore unprotectable as trademarks. *See Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y.1921) (aspirin); *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir.1936) (cellophane).

A *descriptive* term “identifies a characteristic or quality of an article or service,” such as its color, odor, function, dimensions, or ingredients. Descriptive terms ordinarily are not protectable as trademarks, Lanham Act § 2(e)(1), 15 U.S.C. § 1052(e)(1) (1976); they may become valid marks, however, by acquiring a secondary meaning in the minds of the consuming public. *See id.* § 2(f), 15 U.S.C. § 1052(f). Examples of descriptive marks would include “Alo” with reference to products containing gel of the aloe vera plant and “Vision Center” in reference to a business offering optical goods and services. As this court has often noted, the distinction between descriptive and generic terms is one of degree. The distinction has important practical consequences, however; while a descriptive term may be elevated to trademark status with proof of secondary meaning, a generic term may never achieve trademark protection.

A *suggestive* term suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services. A suggestive mark is protected without the necessity for proof of secondary meaning. The term “Coppertone” has been held suggestive in regard to sun tanning products.

Arbitrary or *fanciful* terms bear no relationship to the products or services to which they are applied. Like suggestive terms, arbitrary and fanciful marks are protectable without proof of secondary meaning. The term “Kodak” is properly classified as a fanciful term for photographic supplies; “Ivory” is an arbitrary term as applied to soap.

2. Secondary Meaning

As noted earlier, descriptive terms are ordinarily not protectable as trademarks. They may be protected, however, if they have acquired a secondary meaning for the consuming public. The concept of secondary meaning recognizes that words with an ordinary and primary meaning of their own “may by long use with a particular product, come to be known by the public as specifically designating that product.” In order to establish a secondary meaning for a term, a plaintiff “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” The burden of proof to establish secondary meaning rests at all times with the plaintiff; this burden is not an easy one to satisfy, for “ ‘[a] high degree of proof is necessary to establish secondary meaning for a descriptive term.’ ” *Vision Center*, 596 F.2d at 118 (quoting 3 R. Callman, *supra*, § 77.3, at 359). Proof of secondary meaning is an issue only with respect to descriptive marks; suggestive and arbitrary or fanciful marks are automatically protected upon registration, and generic terms are unprotectible even if they have acquired secondary meaning.

3. The “Fair Use” Defense

Even when a descriptive term has acquired a secondary meaning sufficient to warrant trademark protection, others may be entitled to use the mark without incurring liability for trademark infringement. When the allegedly infringing term is “used fairly and in good faith only to describe to users the goods or services of [a] party, or their geographic origin,” Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (1976), a defendant in a trademark infringement action may assert the “fair use” defense. The defense is available only in actions involving descriptive terms and only when the term is used in its descriptive sense rather than its trademark sense. In essence, the fair use defense prevents a trademark registrant from appropriating a descriptive term for its own use to the exclusion of others, who may be prevented thereby from accurately describing their own goods. The holder of a protectable descriptive mark has no legal claim to an exclusive right in the primary, descriptive meaning of the term; consequently, anyone is free to use the term in its primary, descriptive sense so long as such use does not lead to customer confusion as to the source of the goods or services. *See* 1 J. McCarthy, *Trademarks and Unfair Competition* § 11.17, at 379 (1973). . . .

B. “FISH-FRI”³

- ³ We note at the outset that Zatarain’s use of the phonetic equivalent of the words “fish fry”—that is, misspelling it—does not render the mark protectable.

1. Classification

Throughout this litigation, Zatarain’s has maintained that the term “Fish-Fri” is a suggestive mark automatically protected from infringing uses by virtue of its registration in 1962. Oak Grove and Visko’s assert that “fish fry” is a generic term identifying a class of foodstuffs used to fry fish; alternatively, Oak Grove and Visko’s argue that “fish fry” is merely descriptive of the characteristics of the product. The district court found that “Fish-Fri” was a descriptive term identifying a function of the product being sold. Having reviewed this finding under the appropriate “clearly erroneous” standard, we affirm.

We are mindful that “[t]he concept of descriptiveness must be construed rather broadly.” 3 R. Callman, *supra*, § 70.2. Whenever a word or phrase conveys an immediate idea of the qualities, characteristics, effect, purpose, or ingredients of a product or service, it is classified as descriptive and cannot be claimed as an exclusive trademark. *Id.* § 71.1. Courts and commentators have formulated a number of tests to be used in classifying a mark as descriptive.

A suitable starting place is the dictionary, for “[t]he dictionary definition of the word is an appropriate and relevant indication ‘of the ordinary significance and meaning of words’ to the public.” *Webster’s Third New International Dictionary* 858 (1966) lists the following definitions for the term “fish fry”: “1. a picnic at which fish are caught, fried, and eaten; 2. fried fish.” Thus, the basic dictionary definitions of the term refer to the preparation and consumption of fried fish. This is at least preliminary evidence that the term “Fish-Fri” is descriptive of Zatarain’s product in the sense that the words naturally direct attention to the purpose or function of the product.

The “imagination test” is a second standard used by the courts to identify descriptive terms. This test seeks to measure the relationship between the actual words of the mark and the product to which they are applied. If a term “requires imagination, thought and perception to reach a conclusion as to the nature of goods,” it is considered a suggestive term. Alternatively, a term is descriptive if standing alone it conveys information as to the characteristics of the product. In this case, mere observation compels the conclusion that a

product branded “Fish-Fri” is a prepackaged coating or batter mix applied to fish prior to cooking. The connection between this merchandise and its identifying terminology is so close and direct that even a consumer unfamiliar with the product would doubtless have an idea of its purpose or function. It simply does not require an exercise of the imagination to deduce that “Fish-Fri” is used to fry fish. Accordingly, the term “Fish-Fri” must be considered descriptive when examined under the “imagination test.”

A third test used by courts and commentators to classify descriptive marks is “whether competitors would be likely to need the terms used in the trademark in describing their products.” A descriptive term generally relates so closely and directly to a product or service that other merchants marketing similar goods would find the term useful in identifying their own goods. Common sense indicates that in this case merchants other than Zatarain’s might find the term “fish fry” useful in describing their own particular batter mixes. While Zatarain’s has argued strenuously that Visko’s and Oak Grove could have chosen from dozens of other possible terms in naming their coating mix, we find this position to be without merit. As this court has held, the fact that a term is not the only or even the most common name for a product is not determinative, for there is no legal foundation that a product can be described in only one fashion. There are many edible fish in the sea, and as many ways to prepare them as there are varieties to be prepared. Even piscatorial gastronomes would agree, however, that frying is a form of preparation accepted virtually around the world, at restaurants starred and unstarred. The paucity of synonyms for the words “fish” and “fry” suggests that a merchant whose batter mix is specially spiced for frying fish is likely to find “fish fry” a useful term for describing his product.

A final barometer of the descriptiveness of a particular term examines the extent to which a term actually has been used by others marketing a similar service or product. This final test is closely related to the question whether competitors are likely to find a mark useful in describing their products. As noted above, a number of companies other than Zatarain’s have chosen the word combination “fish fry” to identify their batter mixes. Arnaud’s product, “Oyster Shrimp and Fish Fry,” has been in competition with Zatarain’s “Fish-Fri” for some ten to twenty years. When companies from A to Z, from Arnaud to Zatarain’s, select the same term to describe their similar products, the term in question is most likely a descriptive one.

The correct categorization of a given term is a factual issue; consequently, we review the district court's findings under the "clearly erroneous" standard of Fed.R.Civ.P. 52. The district court in this case found that Zatarain's trademark "Fish-Fri" was descriptive of the function of the product being sold. Having applied the four prevailing tests of descriptiveness to the term "Fish-Fri," we are convinced that the district court's judgment in this matter is not only not clearly erroneous, but clearly correct.⁴

- ⁴ Oak Grove and Visko's argue in a conclusory manner that the term "fish fry" is a generic name for the class of substances used to coat fish prior to frying. We are unable to agree. No evidence in the record indicates that the term "fish fry" is the common, recognized name for *any* class of foodstuffs. The district court specifically rejected the contention that the term "Fish-Fri" was generic. This finding was not clearly erroneous and must be affirmed.

Zatarain's urges that its "Fish-Fri" mark is suggestive rather than descriptive, and our lengthy discussion in text addresses this contention fully. We pause here, however, to speak to Zatarain's argument that certain survey evidence introduced at trial proves the suggestive nature of the term "Fish-Fri." Just as the compleat angler exaggerates his favorite fish story, so Zatarain's overstates the results of its consumer survey. We consider the survey unpersuasive on the issue of suggestiveness for several reasons.

First, the survey was not intended to investigate the term's descriptiveness or suggestiveness. Rather, as expert witness Allen Rosenzweig testified, the survey was designed to explore two completely different issues: likelihood of confusion in the marketplace and secondary meaning. Furthermore, the district court prohibited Rosenzweig's testimony as to whether the survey data showed Zatarain's term to be suggestive or descriptive.

Second, a glance at the survey itself convinces us that, regardless of its purpose, the questions were not framed in a manner adequate to classify the mark properly. Respondents were asked the following questions: "2. If you planned to fry fish tonight, what would you buy at the grocery to use as a coating? 3. Are you familiar with any product on the market that is especially made for frying fish?" If these questions were to test the

associational link between the mark “Fish-Fri” and Zatarain’s product, they should have been devoid of such broad hints as the place of purchase (“grocery”), the nature of the product (“coating”), and the purpose or function of the product (“to fry fish”). Furthermore, we caution that survey samples such as these-100 women in each of four randomly selected cities-may not be adequate in size to prove much of anything.

Survey evidence is often critically important in the field of trademark law. We heartily embrace its use, so long as the survey design is relevant to the legal issues, open-ended in its construction, and neutral in its administration. Given the admitted purposes of this survey and its obvious design limitations, it is rather disingenuous of Zatarain’s to assert that the survey provided conclusive evidence of suggestiveness. We therefore reject Zatarain’s contention in this regard.

Finally, Zatarain’s urges that it is entitled to a legal presumption of suggestiveness by virtue of its federal registration of the term “Fish-Fri.” The Lanham Act provides that:

[Registration] shall be prima facie evidence of registrant’s exclusive right to use the registered mark in commerce on the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered.

Lanham Act § 33(a), 15 U.S.C. § 1115(a) (1976). *See also id.* § 7(b), 15 U.S.C. § 1057(b). This statutory presumption can be rebutted by establishing the generic or descriptive nature of the mark.

Zatarain’s maintains that Oak Grove and Visko’s failed to show that the term “Fish-Fri” is a descriptive one. We cannot agree. As our discussion in text indicates, ample evidence supports the appellees’ contention that “Fish-Fri” is descriptive of a coating used to fry fish. This evidence is sufficient to rebut the presumption that the term is suggestive rather than descriptive

2. Secondary Meaning

Descriptive terms are not protectable by trademark absent a showing of secondary meaning in the minds of the consuming public. To prevail in its trademark infringement action, therefore, Zatarain's must prove that its mark "Fish-Fri" has acquired a secondary meaning and thus warrants trademark protection. The district court found that Zatarain's evidence established a secondary meaning for the term "Fish-Fri" in the New Orleans area. We affirm.

The existence of secondary meaning presents a question for the trier of fact, and a district court's finding on the issue will not be disturbed unless clearly erroneous. The burden of proof rests with the party seeking to establish legal protection for the mark—the plaintiff in an infringement suit. The evidentiary burden necessary to establish secondary meaning for a descriptive term is substantial.

In assessing a claim of secondary meaning, the major inquiry is the consumer's attitude toward the mark. The mark must denote to the consumer "a single thing coming from a single source," to support a finding of secondary meaning. Both direct and circumstantial evidence may be relevant and persuasive on the issue.

Factors such as amount and manner of advertising, volume of sales, and length and manner of use may serve as circumstantial evidence relevant to the issue of secondary meaning. While none of these factors alone will prove secondary meaning, in combination they may establish the necessary link in the minds of consumers between a product and its source. It must be remembered, however, that "the question is not the *extent* of the promotional efforts, but their *effectiveness* in altering the meaning of [the term] to the consuming public."

Since 1950, Zatarain's and its predecessor have continuously used the term "Fish-Fri" to identify this particular batter mix. Through the expenditure of over \$400,000 for advertising during the period from 1976 through 1981, Zatarain's has promoted its name and its product to the buying public. Sales of twelve-ounce boxes of "Fish-Fri" increased from 37,265 cases in 1969 to 59,439 cases in 1979. From 1964 through 1979, Zatarain's sold a total of 916,385 cases of "Fish-Fri." The district court considered this circumstantial evidence of secondary meaning to weigh heavily in Zatarain's favor. Record on Appeal, Vol. I at 273.

In addition to these circumstantial factors, Zatarain's introduced at trial two surveys conducted by its expert witness, Allen Rosenzweig. In one survey, telephone interviewers questioned 100 women in the New Orleans area who fry fish or other seafood three or more times per month. Of the women surveyed, twenty-three percent specified *Zatarain's* "Fish-Fri" as a product they "would buy at the grocery to use as a coating" or a "product on the market that is especially made for frying fish." In a similar survey conducted in person at a New Orleans area mall, twenty-eight of the 100 respondents answered "*Zatarain's* 'Fish-Fri'" to the same questions.⁸

- ⁸ The telephone survey also included this question: "When you mentioned 'fish fry,' did you have a specific product in mind or did you use that term to mean any kind of coating used to fry fish?" To this inartfully worded question, 77% of the New Orleans respondents answered "specific product" and 23% answered "any kind of coating." Unfortunately, Rosenzweig did not ask the logical follow-up question that seemingly would have ended the inquiry conclusively: "Who makes the specific product you have in mind?" Had he but done so, our task would have been much simpler.

The authorities are in agreement that survey evidence is the most direct and persuasive way of establishing secondary meaning. The district court believed that the survey evidence produced by Zatarain's, when coupled with the circumstantial evidence of advertising and usage, tipped the scales in favor of a finding of secondary meaning. Were we considering the question of secondary meaning *de novo*, we might reach a different conclusion than did the district court, for the issue is close. Mindful, however, that there is evidence in the record to support the finding below, we cannot say that the district court's conclusion was clearly erroneous. Accordingly, the finding of secondary meaning in the New Orleans area for Zatarain's descriptive term "Fish-Fri" must be affirmed.

3. The "Fair Use" Defense

[The court concluded that the defendant's use of the term "Fish-Fri" was a "fair use" for purposes of trademark law and did not create liability.]

C. “CHICK-FRI”

1. Classification

Most of what has been said about “Fish-Fri” applies with equal force to Zatarain’s other culinary concoction, “Chick-Fri.” “Chick-Fri” is at least as descriptive of the act of frying chicken as “Fish-Fri” is descriptive of frying fish. It takes no effort of the imagination to associate the term “Chick-Fri” with Southern fried chicken. Other merchants are likely to want to use the words “chicken fry” to describe similar products, and others have in fact done so. Sufficient evidence exists to support the district court’s finding that “Chick-Fri” is a descriptive term; accordingly, we affirm.

2. Secondary Meaning

The district court concluded that Zatarain’s had failed to establish a secondary meaning for the term “Chick-Fri.” We affirm this finding. The mark “Chick-Fri” has been in use only since 1968; it was registered even more recently, in 1976. In sharp contrast to its promotions with regard to “Fish-Fri,” Zatarain’s advertising expenditures for “Chick-Fri” were mere chickenfeed; in fact, Zatarain’s conducted no direct advertising campaign to publicize the product. Thus the circumstantial evidence presented in support of a secondary meaning for the term “Chick-Fri” was paltry.

Allen Rosenzweig’s survey evidence regarding a secondary meaning for “Chick-Fri” also “lays an egg.” The initial survey question was a “qualifier:” “Approximately how many times in an average month do you, yourself, fry *fish or other seafood*?” Only if respondents replied “three or more times a month” were they asked to continue the survey. This qualifier, which may have been perfectly adequate for purposes of the “Fish-Fri” questions, seems highly unlikely to provide an adequate sample of potential consumers of “Chick-Fri.” This survey provides us with nothing more than some data regarding fish friers’ perceptions about products used for frying chicken. As such, it is entitled to little evidentiary weight.¹⁰

¹⁰ Even were we to accept the results of the survey as relevant, the result would not change. In the New Orleans area, only 11 of the 100 respondents in the telephone survey named “Chick-Fri,” “chicken fry,” or “Zatarain’s ‘Chick-Fri’ “as a product used as a coating for frying chicken. Rosenzweig himself testified that this number was inconclusive for sampling purposes. Thus the

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survey evidence cannot be said to establish a secondary meaning for the term “Chick-Fri.”

It is well settled that Zatarain’s, the original plaintiff in this trademark infringement action, has the burden of proof to establish secondary meaning for its term. This it has failed to do. The district court’s finding that the term “Chick-Fri” lacks secondary meaning is affirmed.

3. Cancellation

Having concluded that the district court was correct in its determination that Zatarain’s mark “Chick-Fri” is a descriptive term lacking in secondary meaning, we turn to the issue of cancellation. The district court, invoking the courts’ power over trademark registration as provided by section 37 of the Lanham Act, 15 U.S.C. § 1119 (1976), ordered that the registration of the term “Chick-Fri” should be cancelled. The district court’s action was perfectly appropriate in light of its findings that “Chick-Fri” is a descriptive term without secondary meaning. We affirm

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5.3. Notes

5.3.1. The Abercrombie spectrum

The Abercrombie spectrum. The spectrum of distinctiveness is sometimes referred to as the *Abercrombie* spectrum after *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), which set out the points on the spectrum in an opinion by Judge Henry Friendly. *Id.* at 9.

Questioning fanciful marks. Ever use a SWIFFER mop? The word “swiffer” is invented, but is it really fanciful? Jake Linford notes that a “nonsense word like Swiffer may lack a dictionary definition, but the component sounds in the word communicate speed and ease of use, independent of whether the word resembles other known words.” Jake Linford, *Are Trademarks Ever Fanciful?*, 105 Geo. L.J. 731, 734 (2017).~

Does this call into question the treatment trademark law gives to fanciful marks?

5.3.2. Irresistible marks

Irresistible marks. It's easy to come up with an inherently distinctive term, isn't it? Why then do trademark holders insist on adopting descriptive marks? Judge Learned Hand mused,

I have always been at a loss to know why so many marks are adopted which have an aura, or more, of description about them. With the whole field of possible coinage before them, it is strange that merchants insist upon adopting marks that are so nearly descriptive. Probably they wish to interject into the name of their goods some intimation of excellence, and are willing to incur the risk.

Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc., 297 F. 247 (S.D.N.Y. 1923), *aff'd*, 4 F.2d 1018 (2d Cir. 1925). The temptation to advertise while branding is a strong one. Is such advertising just about claiming a feature? Or something more?

5.3.3. Context matters

Context matters. Note that a mark's classification depends on the product, so in *Abercrombie & Fitch Co. v. Hunting World, Inc.* the Second Circuit found that the mark SAFARI was generic for certain types of clothing, including a broad flat-brimmed hat with a large band, a belted bush jacket with patch pockets, and clothes with khaki coloring, but descriptive or suggestive for boots and shoes. Of course for web browsers, it is arbitrary (or perhaps suggestive), thus Apple's use of the name for its SAFARI browser.

Relatedly, in determining whether a mark is descriptive, one cannot consider the term in the abstract. As the Trademark Trial and Appeal Board has explained:

the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or

services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 U.S.P.Q.2d 1537, 1539, 1998 WL 970180 (T.T.A.B. 1998). So suppose you had a soda branded THICK. Liquid is not thick, so one might think that the mark is not descriptive, but suppose further that the soda's flavor had a very thick mouthfeel. Were that the case, a court could find that the term in context connotes flavor and not viscosity and would therefore be descriptive. *See, e.g., A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986).

5.3.4. Anti-dissection

Anti-dissection. Sometimes would-be marks combine elements that would be ineligible for protection if used individually. The rule is to consider the marks as a whole and not their component parts. "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545–46 (1920). This is sometimes referred to as the anti-dissection rule. Thus COCA-COLA is a valid mark notwithstanding the generic element COLA.

This is not to say that having non-protectable elements in a would-be mark is irrelevant. As the Federal Circuit has explained: "In considering the mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components." *In re Oppedahl & Larson LLP*, 373 F.3d 1171 (Fed. Cir. 2004). There, the court affirmed a ruling by the TTAB that PATENTS.COM was merely descriptive notwithstanding the addition of the .com top-level-domain name to the word patents. Sometimes the whole is just the sum of its parts. *See, e.g., Arizona Int'l, Ltd. v. Merrill Lynch Realty Operating Partnership*, 1991 WL 407023 (D. Ariz. 1991) (rejecting ARIZONA REALTY as a generic composite of the product category of Arizona property services).

Anti-dissection principles also apply in considering whether a trademark is infringing.

5.3.5. Foreign words

Foreign words. The “doctrine of foreign equivalents” calls for words in foreign languages to be treated as if they were translated into English. Thus the French word “vin” would still be rejected as generic for a brand of wine. The TTAB has explained:

The doctrine of foreign equivalents ... extends the protection of the [Lanham] Act to those consumers in this country who speak other languages in addition to English At least one significant group of ordinary American purchasers is the purchaser who is knowledgeable in English as well as the pertinent foreign language.

In re Spirits International N.V., 86 U.S.P.Q.2d 1078, 1083–1085, 2008 WL 375723 (T.T.A.B. 2008). That said, the Federal Circuit has stated that the doctrine is not a rigid rule but should be applied in a contextual manner. Given the product’s marketing, would a reasonable consumer familiar with both English and the foreign word make the translation? *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). Courts also refrain from applying the doctrine to dead or obscure languages.

5.3.6. Disclaimers

Disclaimers. Because marks will often include non-protectable elements, it is common for trademark registrants to “disclaim” an effort to capture the non-protectable word. This does not preclude a rejection if the mark as a whole is descriptive. Nor does it preclude the registrant from claiming the disclaimed matter in an action based on common law use rights. *See generally* 15 U.S.C. § 1056.

5.3.7. Does the mark function as a mark?

Does the mark function as a mark? How a mark is used also affects whether consumers perceive it as performing a trademark function. If you look at, say, a box of cereal, you’ll see that the brand name is set off in any manner of ways, including font size and style, graphic elements, and packaging position. These design choices also affect whether consumers perceive the mark as performing a trademark function. For empirical

research on this point, *see* Thomas R. Lee, Eric D. DeRosia, & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 Ariz. St. L.J. 1033, 1097-98 (2009) (varying uses testing hypothetical WONDERFUL mark for chocolate coconut macaroons).

If it is the case that trademark placement can make consumers see descriptive terms as trademarks, does that cast doubt on trademark law's skepticism of descriptive marks? Or is the effect on competition the more important concern? Or is what matters non-label uses (e.g., hearing the trademarked word in advertising, e.g., "try our wonderful cereal!")?

Courts and the PTO sometimes refuse to protect claimed marks that fail to function as marks (considering questions like placement of the mark, whether it is set off from other elements, whether the matter is informational, etc.). For an argument that this trademark use question should matter more and integrate considerations of distinctiveness, *see* Alexandra J. Roberts, *Trademark Failure to Function*, 104 Iowa L. Rev. 1977 (2019).

5.3.8. Use as a mark and scope of protection

Use as a mark and scope of protection. We will not cover trademark infringement for a while yet, but note how issues of distinctiveness and trademark use naturally raise questions about the scope of trademark rights. For example, the Trademark Office will sometimes refuse to register a mark that is merely used as a slogan on a t-shirt.

An ornamental refusal is when the USPTO refuses registration of your mark because the sample of how you actually use the applied-for mark (the "specimen") or other information in the record shows use of your mark merely as an ornamental or decorative feature on the goods and not as a trademark to indicate the source of the goods. For example, a slogan prominently displayed on the front of a t-shirt may be considered merely ornamental use and not trademark use. That is, most purchasers of the t-shirts would not automatically think the slogan identified the source of the

goods but would view the slogan only as a decoration on the goods.

USPTO, “‘Ornamental’ Refusal and How to Overcome This Refusal,” <https://www.uspto.gov/trademark/laws-regulations/ornamental-refusal-and-how-overcome-refusal-0>. Fair enough. So suppose the t-shirt entrepreneur uses the slogan on the front of the shirt *and* the collar tag (where trademarks on clothing are often found). That seems enough for trademark protection. Suppose then that a competitor comes along who uses the same slogan on the front of the t-shirt, but has an entirely different (non-infringing) trademark inside the collar? Will an infringement claim based on the front be possible? As we will see, the answer is often yes.

5.3.9. Enough marks?

Enough marks? Trademark law assumes that the costs of protection are generally low given that there is a functionally inexhaustible supply of marks. For research suggesting this may not be so in practice, 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, 953 (2018) (“New market entrants face significant barriers to entry in the form of the cost of searching for an unclaimed mark and in the ongoing cost of using a less effective mark.”).

5.3.10. What’s in a name?

What’s in a name? REX Real Estate has a founding partner named Rex Glendenning. Does that make the mark descriptive? The traditional approach is that first names and surnames are treated as descriptive marks and require secondary meaning for protection. But consumers might perceive a word like “Rex” as having a royal connotation, creating the possibility that the mark is inherently distinctive. The answer in cases like this will therefore depend on the record created by the litigants. See *Rex Real Estate I, L.P. v. Rex Real Estate Exchange, Inc.*, 80 F.4th 607 (5th Cir. 2023) (concluding that the district court erred by resolving the question as a matter of law); see generally 2 MCCARTHY § 13.2.

5.3.11. Fair use

Fair use. You may have noticed the reference in *Zatarains* to “fair use” as excusing the defendants’ potential liability. Those of you who have studied copyright may be familiar with the fair use defense in copyright. Fair use means something different in trademark law (as indicated by its description in *Zatarains*). We will cover trademark fair use in greater detail later in the course.

5.4. Problems

5.4.1. Strisk computers

Your law firm has been hired to give trademark advice to Strisk Technologies, a computer manufacturer. Strisk has a new computer line that will be marketed as providing faster performance than Strisk’s competitors, particularly when the computer is turned on. The marketing department suggested the following names:

- Laptop
- QuickStart
- Computer
- Computadora (Computer in Spanish)
- Ordinateur (in French)
- Kompyuta (in Swahili)
- Ordenagailu (in Basque)
- Pluto
- Flizzasp
- Strisk
- Sprinter
- Zips
- A logo that looks like the silhouette of a computer
- A logo that looks like the silhouette of an alligator

Which, if any, of these names could secure trademark protection? Which names would work best from a marketing perspective? You may assume that none of these options infringe any existing trademarks.

5.4.2. FICO

The Fair Isaac Corporation (FICO) developed a system of rating the credit worthiness of borrowers. FICO rates potential borrowers on a 300-850 point scale (with higher ratings indicating better credit risks). May FICO trademark “300-850” for its credit rating services? What kind of mark would it be? Is there any harm to allowing protection for this kind of mark?

5.4.3. CASH4GOLD, DOLLARS4GOLD

Some years ago, CASH4GOLD sponsored a Super Bowl ad. Soon after, DOLLARS4GOLD, in the same line of business, put up advertising asking consumers if they had seen its Super Bowl ad. How might DOLLARS4GOLD, which in fact had no Super Bowl ad, defend against a trademark infringement suit?

Credit/licensing notes

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