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TRADEMARKS AND THE LANDSCAPE OF IMAGINATION

*Alan L. Durham**

I. INTRODUCTION

Korean automobile manufacturer Kia does not offer a Seoul Minivan, nor has rival Hyundai commemorated its Alabama assembly plant with a Montgomery Sedan. Triangulation based on model names would place the heart of the Korean automobile industry somewhere in the deserts of the southwestern United States, between Sedona (the name of Kia's minivan), Santa Fe (a Hyundai SUV), and Tucson (another Hyundai). These model names reflect what marketers have known for generations—the power of certain places to stir the imagination of consumers, even when the association of product and place exists, as in these instances, in name only.

For well over a century, trademark laws, and the courts interpreting them, have treated geographic terms as a subject of special concern.¹ They have been sympathetic to the desire of marketers to describe the physical origin of their products, unhindered by the claims of a manufacturer who has adopted a geographic term as its brand name.² But sometimes they conclude that denying exclusivity to a trademark rooted in geography could cause unacceptable harm to the owners of the brand or to consumers.³ Resolution of the conflict may depend on such factors as whether the geographic allusion is obvious or obscure,⁴ whether it is accurate or inaccurate,⁵ whether consumers would be moved by it to make a purchase,⁶ and whether the geographic term has been

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1. See *infra* Part II for a detailed history of the law relating to geographic trademarks.

2. See *infra* notes 55-56, 59, 63-65, 68, and accompanying text.

3. See *infra* notes 60, 62, 69, and accompanying text.

4. Marks that consumers do not recognize as referring to a place are not treated, under the federal Lanham Act, as “primarily” geographically descriptive or geographically deceptively misdescriptive. See *infra* text accompanying notes 132-37.

5. The Lanham Act refers separately to marks that are “primarily geographically descriptive” and “primarily geographically deceptively misdescriptive.” 15 U.S.C. § 1052(e)(2), (3) (2000). The consequences of description and misdescription may be significantly different. See *infra* Part II.B.

6. As the United States Court of Appeals for the Federal Circuit currently interprets the Lanham Act, a mark may be denied registration as “primarily geographically deceptively misdescriptive” only if consumers would regard the misdescription as material to their purchasing decision. *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1340-41 (Fed. Cir. 2003).

used as a brand name for so long, or with such impact, that consumers would perceive the term primarily as a brand name rather than as a place name.⁷

Although, in some respects the issues have changed little since 1872 when the Supreme Court addressed the use of the term "Lackawanna" as a brand name for coal,⁸ the treatment of geographic names under the trademark laws has experienced unusual bouts of revision, uncertainty, and pendulum swings.⁹ One thing that has remained relatively constant is an implicit assumption that the message to consumers in a geographical trademark, if there is any message at all, tends to be a literal one—these goods come from this place.¹⁰ That message may be true, or it may be false. When no such message is conveyed because, in spite of the name, consumers would not expect such goods to come from that place (e.g., "Alaska bananas"¹¹), courts treat the geographic term as benignly "arbitrary."¹²

That kind of analysis threatens to miss the point of a name like Kia "Sedona." Of course, consumers who are familiar with Sedona would not expect a vehicle to be manufactured there; the "new age" resort community in Arizona is not known for its heavy industry. Nor does the name "Sedona" communicate, even indirectly, something specific about the features of the minivan, such as a powerful air conditioner for arid climates or a capacious gasoline tank for long desert journeys. On the other hand, the name "Sedona" is not "arbitrary" in the sense that it was selected at random. No doubt Kia chose it carefully. Kia selected the name, probably, because for consumers familiar with the resort, the name evokes ideas with which the Korean manufacturer would like to associate its brand—leisure, extravagance, fashion, even spiritual fulfillment.

Geographic terms may convey, or may seem to convey, important concrete information about the goods with which they are associated. An Oregon pinot noir, if it is genuinely from Oregon, may taste different than a South African pinot noir, due to differences in climate where the grapes are grown or differences in the techniques used by vintners in the region. Yet, as production becomes more globalized, mechanized, and standardized, such physical differences become less common. In functional terms, it has never mattered less whether a watch called "Swiss" was manufactured in Geneva or Taipei. The

7. The development of a secondary meaning may allow a mark to be registered when it otherwise would have been denied registration as "primarily geographically descriptive." 15 U.S.C. § 1052(e)(2), (f).

8. *See Canal Co. v. Clark*, 80 U.S. 311, 328 (1871) (holding that coal from the Lackawanna region could be sold as "Lackawanna coal," even though the term had been associated with a particular brand of coal).

9. *See infra* Part II.

10. *See, e.g.*, 15 U.S.C. § 1052(e) (categorizing geographical indications as descriptive or deceptively misdescriptive).

11. Courts often provide "Alaska bananas" as an example of a trademark based on geographic location that would suggest to no one a genuine connection between the place and the goods. *E.g., In re Nantucket, Inc.*, 677 F.2d 95, 98 n.5 (C.C.P.A. 1982).

12. *See infra* Part II.B.2.

significance of geographic terms, when attached to goods, is increasingly symbolic.

Marketers today emphasize the importance of emotion or fantasy in selling even ordinary goods, and geographic names are a potent source of ready-made associations. When General Motors names a vehicle “Tahoe” or “Sierra,” it has already taken an important step in “positioning” the product in the symbolic landscape where consumers shop. A Manhattan pickup might be physically identical to the GMC Sierra, but its selling proposition would be significantly different. In the realm of meaning, it would be a different truck—trading ruggedness for sophistication. At least that is what marketers, and scholars who study marketing, would maintain.¹³ So as courts and lawmakers struggle with geographic trademarks that may be taken literally, it is important also to consider geographic trademarks that are conceived, and interpreted, symbolically. Should the community of Sedona, for example, have some control over the borrowing of its evocative name? To whom does that symbolic luster belong?

Part II of this Article surveys the treatment of geographic terms under the trademark laws of the United States, particularly in those cases where the term does not literally describe the place of origin of the associated product. Recent decisions by the United States Court of Appeals for the Federal Circuit have made it more difficult to challenge the trademark status of such terms. Part III examines contemporary theories of marketing and consumerism, which suggest (1) that the symbolic or emotional aura imparted to goods through advertising serves to distinguish successful products from their physically identical competitors, and (2) that such symbolism adds genuine value to goods by enhancing the experience of consumption and by contributing meaning to the lives of consumers. Part IV discusses whether the symbolic value of geographic trademarks, as applied to goods from other places, justifies policies that encourage their adoption, or whether the use of such trademarks should be curtailed, even if consumers are neither confused nor deceived. I conclude that symbolic geographic trademarks may do *some* harm by weakening or commercializing the meanings associated with culturally significant places. The value of metaphor, however, even in a commercial context, and the complex ways in which meanings are created, counsel against any dramatic measures to restrict the use of evocative trademarks in order to protect the symbolic value of geography.

II. GEOGRAPHIC TERMS AS TRADEMARKS

The United States Trademark Act,¹⁴ commonly known as the Lanham Act, defines a “trademark” as “any word, name, symbol, or device, or any combination thereof [used] to identify and distinguish . . . goods . . . from those

13. See *infra* Part III.

14. 15 U.S.C. §§ 1051-1129 (2000).

manufactured or sold by others and to indicate the source of the goods.”¹⁵ For centuries, producers of goods have used some form of symbol or hallmark to distinguish their goods from those of other producers. Identifying marks allow producers to reap the rewards of a reputation for quality, and they protect consumers who might otherwise mistake the inferior goods of one producer for the sought-after goods of another. In this respect, trademarks encourage the production of higher quality products.¹⁶ Trademark owners may sue to prevent the unauthorized use of their mark, or a similar mark, under circumstances likely to lead to confusion.¹⁷

The symbol adopted to identify the source of a product often communicates other messages as well—a fact that greatly complicates the situation. Consider the name “Hawaiian Punch.” “Hawaiian Punch” is a brand name, signifying that the associated goods are produced by Dr Pepper/Seven Up, Inc., a division of Cadbury Schweppes.¹⁸ Few consumers may be aware of its corporate ownership, or know that it had earlier passed through the hands of Del Monte and Procter & Gamble, but that history is immaterial to the status of “Hawaiian Punch” as a trademark.¹⁹ If the producers of a similar beverage were to use that well-known name, consumers would likely be misled into believing that this Hawaiian Punch came from the usual source. But corporate origin is not all that the name “Hawaiian Punch” communicates to the consumer. Because the name has been used consistently over many decades to refer to a particular type of beverage—a sweet, red, fruit-juice concoction—a consumer would also expect the name to indicate that type of beverage. A consumer who, for example, ordered “Hawaiian Punch” from a restaurant menu would be disappointed at receiving a Schweppes ginger ale.

Even a consumer who had never experienced Hawaiian Punch before could infer something about the product from its name. Originally, the name alluded to the importation from Hawaii of some of the tropical juices—pineapple, passion fruit, papaya, and guava—that give the beverage its distinctive flavor. Although the juices might now have a different source, the name “Hawaiian Punch” still suggests a tropical-fruit beverage. In a less literal fashion, the word “Hawaiian”

15. 15 U.S.C. § 1127. The term “service mark” refers to “any word, name, symbol, or device, or any combination thereof [used] to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services.” *Id.* There is little difference in the legal treatment of trademarks and service marks, so I will use the term “trademark” in the looser sense that includes service marks.

16. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:5 (2006) (“If there were no way to tell good products from the poor products, why bother to sell anything but the poorest? . . . Without trademarks and the identifying function they serve, competition in product quality could not exist.”).

17. See 15 U.S.C. § 1114 (infringement of registered trademark); 15 U.S.C. § 1125(a) (infringement of unregistered trademark).

18. Hawaiian Punch, http://www.cadburyschweppes.com/EN/Brands/About/Beverages/factsheet_hawaiianpunch.htm (last visited Apr. 15, 2007).

19. The definitions of “trademark” and “service mark” in the Lanham Act admit the possibility that the source of the product or service is unknown. 15 U.S.C. § 1127.

also evokes certain associations that would be useful in marketing the product—images, perhaps, of surf, sunshine, informality, and ease. Finally, and most importantly from the perspective of a long-established name like “Hawaiian Punch,” the words trigger a host of product-related memories for consumers conditioned by experience and advertising. It is the keystone of the brand.²⁰ The brand identifies the product in a competitive marketplace and serves as the locus of its good will. The brand name “Hawaiian Punch” is the reason that Cadbury Schweppes paid \$203 million to Proctor & Gamble for the privilege of selling a fruit drink.

When a trademark communicates nothing but brand origin, as may be true of certain manufactured terms like “Exxon” or “Kodak,” trademark rules can be relatively uncomplicated. When a trademark communicates several messages at once, however, the law cannot overlook either the interest of consumers in receiving accurate information or the legitimate need of competitors to communicate their own, similar messages. If the juices do not come from Hawaii, but the name makes it appear that they do, or if another beverage producer wants to communicate, through its brand name, that its fruit punch also features the flavors of Hawaii, the objective of avoiding confusion as to source by securing exclusive rights to the trademark must be balanced against other necessities of a fair and competitive marketplace.

One of the ways the Lanham Act deals with this is by categorizing potential trademarks according to their “distinctiveness.”²¹ The most distinctive marks are those symbols, like the word “Kodak,” created simply to be trademarks. These marks are “fanciful.”²² Only slightly less distinctive are symbols drawn from existing lexicons but used to identify products with which the symbols have no natural or obvious relationship.²³ These “arbitrary” marks might include “Penguin Books” or “Apple Computer.” Terms that are not so arbitrary, but that communicate, indirectly, something about the characteristics of the product are “suggestive.”²⁴ The name “Irish Spring” for soap suggests a fresh, invigorating scent. “Descriptive” marks communicate information about the goods more directly. “One-A-Day” vitamins are taken once a day, and “Chunky Soup” describes the nature of the product. Finally, the least distinctive terms are those that refer categorically to the type of product with which they are

20. See generally Tom Blackett, *What is a Brand?*, in BRANDS AND BRANDING 13, 17-18 (Rita Clifton & John Simmons with Sameena Ahmad et al. eds., 2004) (discussing how “underlying appeals” of brands draw consumers to purchase certain brands).

21. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (describing five categories of trademark distinctiveness).

22. See 2 MCCARTHY, *supra* note 16, §§ 11:5-11:6 (describing “fanciful” marks as strongest trademarks due to their novelty).

23. See *id.* § 11:11 (“Arbitrary marks comprise those words, symbols, pictures, etc., that are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.”).

24. *Id.* § 11:62.

associated—e.g., “thermos.”²⁵ Some of these “generic” terms, such as “aspirin,” “cellophane,” and “thermos,” were once distinctive trademarks but through indiscriminate use came to symbolize the type of product more than its source.²⁶

The most distinctive marks—fanciful, arbitrary, and suggestive marks—are most easily registered as trademarks and are afforded the strongest protection.²⁷ Descriptive marks are protected more reluctantly because consumers are less likely to perceive them as brands and because competitors have a greater need to adopt similar marks.²⁸ Descriptive marks are only protected as trademarks when they have developed “secondary meaning.”²⁹ Secondary meaning arises when, through extensive use of the term as a brand, consumers understand as an indication of source a term that originally was only descriptive.³⁰ For instance, when the vitamins were first introduced, consumers might have perceived the term “One-A-Day” as descriptive, but after many years of advertising, consumers would likely perceive the term today primarily as a brand name. In contrast, generic terms cannot be protected as trademarks at all, regardless of secondary meaning, because competitors need ample freedom to refer to their products by their generic name.³¹

These categories are difficult to separate, even though the consequences matter. One could describe “Light Beer,” for example, as either descriptive or

25. *See id.* § 12:1 (noting that generic names of products and services are “antithesis” of a trademark).

26. *See* King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 580 (2d Cir. 1963) (holding that the term “thermos” had become generic); 2 MCCARTHY, *supra* note 16, § 12:1 (outlining transformation from distinctive trademark to generic term).

27. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Whether a mark is strong or weak, however, depends not only on the type of mark, but also on its strength in the marketplace. Marks that are well-known and unusual are stronger, more distinctive marks likely to be afforded broader protections. *See* McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1131 (2d Cir. 1979) (“[W]hile these categories can be useful for analytical purposes, the strength of a mark depends ultimately on its distinctiveness, or its ‘origin-indicating’ quality, in the eyes of the purchasing public.”).

28. *Two Pesos*, 505 U.S. at 769.

29. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000); *see also* 15 U.S.C. § 1052(e)-(f) (2000) (providing that descriptive marks may not be registered *unless* mark “has become distinctive of the applicant’s goods in commerce”). After a trademark becomes “incontestable,” which occurs after five years of continuous postregistration use in commerce, a descriptive mark can no longer be challenged on the ground that it lacks secondary meaning. 15 U.S.C. § 1065; *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 197 (1985).

30. 2 MCCARTHY, *supra* note 16, §§ 15:5-15:6.

31. For example, the Second Circuit has stated:

It is a bedrock principle of the trademark law that no trader may acquire the exclusive right to the use of a term by which the covered goods or services are designated in the language. . . . This rule protects the interest of the consuming public in understanding the nature of goods offered for sale, as well as a fair marketplace among competitors by insuring that every provider may refer to his goods as what they are.

Otokoyama Co. v. Wine of Japan Import, Inc., 175 F.3d 266, 270 (2d Cir. 1999).

generic.³² The categories of distinctiveness are “central tones in a spectrum.”³³ In addition, other principles may temper the effects of categorization. For example, competitors who are permitted to use generic terms that were originally adopted by others as brand names (e.g., “thermos”³⁴ or “shredded wheat”³⁵), may still be required under principles of unfair competition to adopt “every reasonable means” to distinguish their product from the original.³⁶ On the other hand, competitors may still use terms protected as trademarks so long as the use is a “fair use.” The Lanham Act defines “fair use” as the good-faith use of a trademarked term, by someone other than the owner of the trademark, not as a trademark but simply to describe that person’s own goods.³⁷ The judicious balancing of these principles should minimize consumer confusion as to source while maximizing competition on the merits.

In the case of geographic terms used as trademarks, achieving that equilibrium has proven particularly difficult. For many centuries, certain nations, regions, or cities have been known for goods of higher quality or distinctive characteristics. Venice was famous for glass, Sheffield for steel, Bordeaux for wine. Local reputations might arise from such factors as climate, available materials, skilled workforces, or the luck that one or more producers of distinctive goods happened to be located in a particular locality. Naturally, when goods from a particular area command a premium, sellers marketing those goods call attention to their origin—sometimes integrating that information into their brand name. Dealers in products from less respected regions, if unscrupulous, may use their trademark to suggest a more desirable origin. If either successfully claims the geographic term as a trademark, other sellers are restricted. Dealing with geographic terms descriptive, or misdescriptive, of the origins of the goods is much like dealing with terms descriptive, or misdescriptive, of other aspects of the associated product. In this case, however, issues of fair competition mix with heightened considerations of tradition, heritage, and local pride. People care profoundly about place, particularly if it is the place where they live and work. That deep regard may be why, as discussed in the next section, the law of geographic trademarks has changed repeatedly.

32. See *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th Cir. 1977) (holding that “Lite” is a generic term for beer).

33. *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1537 (11th Cir. 1986) (citations omitted).

34. See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963) (finding “thermos” generic).

35. See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 116-17 (1938) (finding “shredded wheat” generic).

36. *Kellogg*, 305 U.S. at 121 (maintaining that even though “shredded wheat” is generic, Kellogg must still “use every reasonable means to prevent confusion”); see also *King-Seeley*, 321 F.2d at 581 (limiting Aladdin’s use of “thermos” to lowercase letters and following name “Aladdin”).

37. 15 U.S.C. § 1115(b)(4) (2000).

A. From "Mischievous Monopolies" to "Secondary Meaning"

*Canal Co. v. Clark*³⁸ is an important early case on geographic trademarks. For an extended period, the plaintiff had been the sole producer of coal from the Lackawanna Valley of Pennsylvania. Eventually, other producers mined coal from the same strata, but only Canal Company used the term "Lackawanna coal" as a brand name.³⁹ Others adopted names like "Pittston coal" and "Scranton coal."⁴⁰ Although the other coal was so similar that it could not easily be distinguished,⁴¹ the original "Lackawanna coal" carried the best reputation for quality.⁴² Clark, a dealer in coal, advertised his Pittston and Scranton coal as "Lackawanna coal," leading to the dispute.

The Supreme Court observed that geographic terms, like generic names, do not indicate any particular firm or individual, and they can be used with equal right by any producer of goods from the same region: "They point only at the place of production, not to the producer . . ."⁴³ Moreover, if geographic terms were subject to exclusive rights, the result would be "mischievous monopolies":

Could such phrases, as "Pennsylvania wheat," "Kentucky hemp," "Virginia tobacco," or "Sea Island cotton," be protected as trademarks; could any one prevent all others from using them, or from selling articles produced in the districts they describe under those appellations, it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many.⁴⁴

Even if the use of the geographic term led to *mistake* on the part of consumers, the Court implied that nothing could be done. If the geographic label is "just as true in its application to [the defendant's] goods as it is to [the plaintiff's] . . . there is no legal or moral wrong done."⁴⁵ Put simply—perhaps too simply—"equity will not enjoin against telling the truth."⁴⁶

Although any harm suffered by Canal Company could be blamed on its lack of foresight in choosing an unimaginative trademark, it is still surprising to see the Court dismiss the interests of consumers so easily. The coal sold by the defendant might have been "Lackawanna coal" in a literal sense, without being what the customers thought they had purchased.

38. 80 U.S. 311 (1871).

39. *Canal Co.*, 80 U.S. at 313-14.

40. *Id.*

41. *Id.* at 322.

42. *Id.* at 314.

43. *Id.* at 324.

44. *Canal Co.*, 80 U.S. at 324.

45. *Id.* at 327.

46. *Id.*; see also *id.* at 328 ("If the public are led into mistake, it is by the truth, not by any false pretence. If the complainants' sales are diminished, it is because they are not the only producers of Lackawanna coal, and not because of any fraud of the defendant."). The court found "no evidence that [the defendant] has attempted to sell his coal as and for the coal of the plaintiffs," even though the use of the name "Lackawanna coal" seems itself to constitute some evidence. *Id.*

Some years later, the Supreme Judicial Court of Massachusetts adopted a different point of view in *American Waltham Watch Co. v. United States Watch Co.*⁴⁷ The plaintiff, the first manufacturer of watches in Waltham, Massachusetts, originally used the term “Waltham” in its geographical sense, but with the passage of time the public came to understand the term as signifying watches made by the plaintiff.⁴⁸ “Waltham,” in other words, had developed “a secondary meaning.”⁴⁹ The defendant, who also made watches in Waltham, claimed equal right to advertise its place of business, including marking its watches with its address, as was customary.⁵⁰ The defendant argued that whatever its intent in using the name “Waltham,” and whatever effect that use might have in diverting trade from the plaintiff, it was the “plaintiff’s folly” to “associate[] the fame of its merits with the city where it makes its wares, instead, of with its own name.”⁵¹ Having acted foolishly, the plaintiff could not restrict the defendant’s freedom to advertise its goods or burden it with the costs of a disclaimer (which, the defendant said, would “discredit” the defendant’s watches “in advance”).⁵² The Court disagreed, stating:

Whatever might have been the doubts some years ago, we think that now it is pretty well settled that the plaintiff, merely on the strength of having been first in the field, may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names and advertisements from deceitfully diverting the plaintiff’s custom.⁵³

In 1901, the United States Supreme Court, considering the application of the word “Elgin” to watches, adopted a similar position.⁵⁴ The Court acknowledged the “general rule” that words describing the place of manufacture cannot be reserved as trademarks⁵⁵ and adhered to the principle of *Canal Co. v. Clark* that first comers cannot deny others the right to advertise the geographic origins of their goods.⁵⁶ The Court nevertheless held that if the term had developed a secondary meaning as a brand, the use of the term could be limited under principles of unfair competition, so as to avoid deceiving the public.⁵⁷ The defendant in such a case could be required to use the geographic term only in its primary sense to avoid confusion with respect to the product’s origin.⁵⁸

These four essential points—the general rule that geographic terms cannot be protected as trademarks, the exception for terms that have developed

47. 53 N.E. 141 (Mass 1899). Judge Holmes authored the opinion.

48. *Am. Waltham*, 53 N.E. at 142.

49. *Id.*

50. *Id.*

51. *Id.*

52. *Id.*

53. *Am. Waltham*, 53 N.E. at 142.

54. *Elgin Nat’l Watch Co. v. Ill. Watch Case Co.*, 179 U.S. 665, 673-74 (1901).

55. *Id.* at 673.

56. *Id.*

57. *Id.* at 673-74.

58. *Id.* at 674.

secondary meaning, the potential restraint under principles of unfair competition when trademark rights are not available, and, when trademark rights *are* available, the continued freedom of others to use a geographic term in its geographic sense—would all be embodied in the Lanham Act. Section 2(e) of the Lanham Act denies trademark protection, as a general rule, to a mark that is “primarily geographically descriptive.”⁵⁹ Section 2(f), however, allows such a mark to be registered if it has “become distinctive of the applicant’s goods in commerce”—the Act’s reference to secondary meaning.⁶⁰ Yet, registration does not bar all use by rivals. Even a term registered as a trademark can be used by someone else, so long as it is used fairly and in good faith, and not as a trademark but only to describe the geographic origin of that person’s goods.⁶¹ If a geographic term has not developed secondary meaning, its use in a deceptive manner may still be restricted under principles of unfair competition embodied in section 43(a) of the Lanham Act. Section 43(a) permits a civil action to prevent the use of any word or symbol in a manner likely to cause mistake as to the origin, sponsorship, or affiliation of goods.⁶²

Some potential ambiguity lies in the term “primarily geographically descriptive.” The 1905 Trademark Act barred the registration of marks that were “merely a geographic name or term.”⁶³ This language was interpreted to ban registration even of geographic names that were not well-known, or that had alternative nongeographic meanings.⁶⁴ If the term submitted as a trademark could be found in an atlas, anywhere in the world, the Patent and Trademark Office (“PTO”) would reject the application, even if few consumers would be aware of such a place (e.g., “Kem”), or if consumers would never assume that the term (e.g., “Antarctica”) was to be understood as the place where the goods originated.⁶⁵ Although this “gazetteer method” had the benefit of clarity, the Lanham Act demands a more subtle analysis.

*In re Charles S. Loeb Pipes, Inc.*⁶⁶ concerned the term “Old Dominion,” a long-used nickname for the state of Virginia, but perhaps not a term whose geographical connotation would be recognized by all consumers.⁶⁷ The Trademark Trial and Appeal Board (“TTAB” or “Board”) held that such a term could be considered “primarily geographically descriptive” under the Lanham Act if it “primarily or immediately” conveyed geographical meaning to

59. 15 U.S.C.A. § 1052(e) (West 1997 & Supp. 2006). The Lanham Act makes an exception for collective marks and certification marks, discussed *infra* at Part II.D.

60. 15 U.S.C. § 1052(f) (2000).

61. 15 U.S.C. § 1115(b)(4).

62. 15 U.S.C. § 1125(a).

63. Trademark Act of 1905, ch. 592, § 5(b), 33 Stat. 724, 725-26 (1905), *amended by* Lanham Act, ch. 540, 60 Stat. 427 (1946).

64. *See In re Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. (BNA) 238, 242-43 (T.T.A.B. 1975) (refusing to trademark any geographic name under Trademark Act of 1905).

65. *See id.* at 243 (citing cases in which obscure geographic terms were precluded from registration).

66. 190 U.S.P.Q. (BNA) 238 (T.T.A.B. 1975).

67. *Loeb*, 190 U.S.P.Q. (BNA) at 241-43.

customers, and the goods in fact came from that place.⁶⁸ If so, the term could be registered as a trademark only upon the demonstration of secondary meaning.⁶⁹ On the other hand, “[i]f the notation in question does not convey an immediate or readily recognizable geographical significance to the average consumer,” the mark is not geographically descriptive but “manifestly arbitrary.”⁷⁰ Terms whose geographic sense is “minor or obscure and would not be known to the average purchaser of the goods”⁷¹ fall into the latter category.⁷² But having referred to the “average consumer,” the TTAB shifted its focus to a hypothetical “segment of the purchasing public” whose understanding might be easier to hypothesize:

Obviously, not all people throughout the country are aware of this significance of “OLD DOMINION”, and manifestly it is doubtful that many know the nicknames for all or even a portion of the fifty states. But, this is of no moment . . . for it is sufficient for our purposes that it is an accepted nickname for a state and would be recognized as such by a segment of the purchasing public.⁷³

Because a “meaningful segment of the purchasing public” in Virginia and surrounding areas would identify “Old Dominion” with the state of Virginia, the TTAB treated the term as one having a primary geographical significance.⁷⁴

B. “Deceptive” and “Deceptively Misdescriptive” Geographic Marks

For our purposes, the most important geographic marks are those identifying a place from which the goods *do not* originate. Such uses of geography have long been regarded with suspicion. As a Michigan federal court observed in 1897, “where the name is appropriated by a manufacturer who resides at a different place, it very naturally starts an inquiry as to what is the motive—what is the object—which the party sought to attain.”⁷⁵ When the name “Chicago Waists” appears on corsets from California and Kalamazoo, one can surmise that the purpose is to take advantage of someone else’s reputation.⁷⁶

Section 2(e) of the Lanham Act originally afforded the same treatment to terms that, when used in connection with the goods of the applicant, were “primarily geographically descriptive” of them, or “primarily geographically deceptively misdescriptive.” In each case, registration of the term as a trademark

68. *Id.* at 244.

69. *Id.*

70. *Id.*

71. *Id.* at 243. (“The word ‘primarily’ [in section 2(e) of the Lanham Act, 15 U.S.C. § 1052(e)] should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote, or unconnected with the goods.” (quoting *World Carpets, Inc. v. Dick Littrell’s World Carpets*, 168 U.S.P.Q. (BNA) 609, 612-13 (5th Cir. 1971)).

72. *In re Dixie Ins. Co.*, 223 U.S.P.Q. (BNA) 514, 516 (T.T.A.B. 1984).

73. *Loeb*, 190 U.S.P.Q. (BNA) at 245.

74. *Id.* at 246.

75. *Gage-Downs Co. v. Featherbone Corset Co.*, 83 F. 213, 215 (W.D. Mich. 1897).

76. *Id.*

would be denied *unless* secondary meaning was established under section 2(f).⁷⁷ Once a term had been used sufficiently as a brand name to create a public impression, the term might be registrable as a trademark even though it was, in geographic terms, “deceptively misdescriptive.”⁷⁸

Originally, the TTAB adopted the same test, traceable to *In re Charles S. Loeb Pipes*, to determine if a mark was “primarily geographically descriptive” or “primarily geographically deceptively misdescriptive”—the difference being only whether the goods did or did not come from the place indicated by the geographic term.⁷⁹ In either case, the question was whether the term primarily or immediately conveyed to the average consumer (or a “meaningful segment” of the public) a geographic significance.⁸⁰

In *In re Nantucket, Inc.*,⁸¹ the United States Court of Customs and Patent Appeals (“CCPA”)⁸² found it necessary to add a further element to identifying a “primarily geographically deceptively misdescriptive” mark. Although the TTAB’s test was easy to administer, it did not take into account the nature of the applicant’s goods as required by section 2(e).⁸³ Nor did it “give appropriate weight to the presence of ‘deceptively’” in section 2(e)’s reference to geographically misdescriptive marks.⁸⁴ A term like “Alaska” might immediately convey a geographic significance in any context, but whether it could be characterized as *deceptively* misdescriptive as applied to goods not from Alaska would depend on the nature of the goods. Applied to salmon it might be deceptively misdescriptive, but applied to bananas it would deceive no one.⁸⁵

The missing element was consideration of “whether the public associates the goods with the place.”⁸⁶ If the public makes no “goods/place association,” the public is not deceived. In such cases—e.g., “Alaska bananas”—the public does not perceive the mark as descriptive of geographic origin, and it is not deceived.⁸⁷ The disputed term in this case was “Nantucket” as applied to men’s shirts made somewhere other than Nantucket Island in Massachusetts.⁸⁸ Absent evidence that consumers seeing “Nantucket” on such a shirt would expect it to have come from the island, registration of the mark could not be refused under section 2(e) of the Lanham Act.⁸⁹

77. *Loeb*, 190 U.S.P.Q. (BNA) at 242.

78. *Id.* at 244.

79. *In re Amerise*, 160 U.S.P.Q. (BNA) 687, 691 (T.T.A.B. 1969).

80. *Loeb*, 190 U.S.P.Q. (BNA) at 244; *In re Amerise*, 160 U.S.P.Q. (BNA) at 691.

81. 677 F.2d 95 (C.C.P.A. 1982).

82. The United States Court of Appeals for the Federal Circuit is the successor of the United States Court of Customs and Patent Appeals. United States Court of Appeals for the Federal Circuit, About the Federal Circuit, <http://fedcir.gov/about.html> (last visited Apr. 16, 2007).

83. *In re Nantucket*, 677 F.2d at 98.

84. *Id.*

85. *Id.* at 98 n.5.

86. *Id.* at 99.

87. *Id.* at 98 n.5, 99.

88. *In re Nantucket*, 677 F.2d at 95-96.

89. *Id.* at 101.

Judge Nies, who concurred in the result, agreed with the necessity of a goods/place association but cautioned that the place did not have to be “noted for” the goods in question for such an association to be found.⁹⁰ A consumer might expect a shirt with a “Chicago” brand name to come from that city, even if Chicago is not famous for shirts, simply because so many manufactured items *do* come from Chicago.⁹¹

1. Distinguishing “Deceptive” and “Deceptively Misdescriptive” Marks

The renewed emphasis on the “deceptive” element of “primarily geographically deceptively misdescriptive” leads to its own problems. Section 2(a) of the Lanham Act denies registration to any “deceptive” term.⁹² At first blush, “primarily geographically deceptively misdescriptive” terms, as described in section 2(e), would seem to be a subset of those barred under section 2(a). Unlike section 2(e), however, section 2(a) bars “deceptive” marks absolutely, regardless of the development of secondary meaning. Because section 2(a) and section 2(e) seem to contemplate different results, one of the difficulties in applying the Lanham Act, at least until recently,⁹³ has been to distinguish between geographically deceptive and geographically deceptively misdescriptive marks.

The TTAB took up the challenge in *In re Amerise*,⁹⁴ where the applicant sought to register the name “Italian Maide” together with a drawing of a woman in peasant costume posed against a banner suggesting the Italian flag. The applicant’s goods, including tomatoes, spaghetti sauce, herbs, and grated cheese, were not made in Italy. The PTO had denied registration under section 2(a) on the ground that “Italian Maide” was deceptive.⁹⁵ The Board held that the creators of the Lanham Act must have “attributed different meanings to the terms ‘deceptive’ and ‘primarily geographically deceptively misdescriptive’ and intended these terms to be applied in different situations involving different sets of circumstances.”⁹⁶ The difference, the Board said, is that a geographic mark is “deceptive” under section 2(a), and therefore beyond the help of secondary meaning, only if it “involves a false assertion calculated, either planned, designed, or implied to deceive the public as to the geographical origin of the

90. *Id.* at 104 (Nies, J., concurring). The Sixth Circuit endorsed this approach, stating:

Though more than a geographic name is required in order to meet the “primarily geographically descriptive” category, there is no requirement that the challenger to a trademark demonstrate that the area is noted for the goods in question. . . . The District Court properly found that a goods/place association is made by the term regardless of whether the area was noted for the production of those goods.

Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 595 (6th Cir. 1989).

91. *In re Nantucket*, 677 F.2d at 102-03 (Nies, J., concurring).

92. *In re Amerise*, 160 U.S.P.Q. (BNA) 687, 690 (T.T.A.B. 1969) (citing 15 U.S.C. § 1052(a)).

93. See *infra* Part II.C for a discussion of changes in the Act after NAFTA.

94. 160 U.S.P.Q. (BNA) 687 (T.T.A.B. 1969).

95. *In re Amerise*, 160 U.S.P.Q. (BNA) at 689.

96. *Id.* at 690.

goods bearing the mark.”⁹⁷ Although including the word “implied,” the Board seemed to contemplate only deliberate acts of deception as the province of section 2(a)—that is, “situations where a party applies a geographical designation to a particular product knowing that it will bestow upon the product an appearance of greater quality or saleability not actually possessed by it with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product.”⁹⁸

Geographic names that mislead consumers, but that are not *intended* to mislead, can be left to section 2(e). While bad intent is difficult to prove, it might be inferred when an applicant seeks to register the name of a destination that is renowned for a particular product or service.⁹⁹ The Board did not find that “Italian Maide” was calculated to deceive, in part because some of the goods covered by the registration (e.g., sauerkraut) were not known for their Italian origins.¹⁰⁰ As for the rest, consumers were accustomed to seeing American-made tomato pastes and spaghetti sauces sold under Italian names, and they would not immediately assume that the products came from Italy.¹⁰¹

This emphasis on the trademark owner’s intent was not destined to last. In *In re House of Windsor, Inc.*,¹⁰² the examiner rejected the term “Bahia” as a trademark for cigars, holding it “deceptive” under section 2(a).¹⁰³ As found by the examiner, “Bahia” is the name of a province in Brazil noted for tobacco and cigars, and purchasers of cigars marked “Bahia” would conclude that they had been made in Bahia or from tobacco grown there.¹⁰⁴ This conclusion would be false because the applicant’s cigars, in fact, had no connection with Bahia.¹⁰⁵ On appeal, the TTAB reviewed once again the distinction between “deceptive” and “primarily geographically deceptively misdescriptive” trademarks.¹⁰⁶ The legislative history of the Lanham Act provided little guidance, suggesting that some of the drafters perceived no distinction, but “basic rules of statutory construction” required that some difference be found.¹⁰⁷ Yet the Board rejected the *In re Amerise* approach:

[I]t seems to us that intent of the user of the mark should not be an element of a case of geographical deceptiveness. In the first place, establishing the intent of the user of the mark is a difficult proposition, particularly at the examination level, where the Examining Attorney is unlikely to adduce evidence of applicant’s intent. Moreover, an intent test could, conceivably, lead to the incongruous result of denying

97. *Id.* at 691.

98. *Id.*

99. *Id.*

100. *In re Amerise*, 160 U.S.P.Q. (BNA) at 691-92.

101. *Id.* at 692.

102. 221 U.S.P.Q. (BNA) 53 (T.T.A.B. 1983).

103. *In re House of Windsor*, 221 U.S.P.Q. (BNA) at 54.

104. *Id.*

105. *Id.* at 55.

106. *Id.* at 55-56.

107. *Id.* at 56.

registration to one party where evidence of intent to deceive is present but allowing registration of the same mark for the same goods to another party where the evidence fails to show intent to deceive.¹⁰⁸

A better distinction would be to limit irremediable deceptiveness under section 2(a) to those cases in which the deception was “material to the purchasing decision.”¹⁰⁹ If cigar consumers were led to believe that “Bahia cigars” were from Brazil, but *did not care*, the mark would be only deceptively misdescriptive under section 2(e).¹¹⁰ On the other hand, if Bahia had a reputation for cigars that moved consumers to buy these cigars in the false belief that they came from Bahia, then “Bahia” would be a deceptive mark under section 2(a).¹¹¹ An important consideration would be whether the goods in question were “a principal product of the geographic region.”¹¹² If the region was sufficiently “renowned” that purchasers might assume the goods to have come from that region even though few such goods were produced there (as might be the case for “Chicago shirts”), the deception would not likely be considered material.¹¹³ Bahia, on other hand, produced many cigars and was known for doing so, which was enough to show that the deception implicit in “Bahia cigars” would be material.¹¹⁴

The materiality test is consistent with the treatment of other “misdescriptive” trademarks that might be barred under section 2(a),¹¹⁵ and the Federal Circuit has endorsed it for geographic marks challenged as “deceptive.”¹¹⁶ As discussed *infra* in Part II.C, this became particularly significant when the Federal Circuit determined that changes to the statute had elevated the standard under section 2(e) to match that of section 2(a), in so far as geographically misdescriptive marks are concerned.

2. “Arbitrary” Geographic Marks

When goods are actually made in the place indicated by a geographic trademark, one naturally concludes that the mark was chosen for its descriptive

108. *In re House of Windsor*, 221 U.S.P.Q. (BNA) at 56.

109. *Id.*

110. *Id.*

111. *Id.* at 57.

112. *Id.*

113. *In re House of Windsor*, 221 U.S.P.Q. (BNA) at 57.

114. *Id.*

115. See *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (indicating that general test for deception under section 2(a) involves three questions: “(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods? (3) If so, is the misdescription likely to affect the decision to purchase?”).

116. See *Institut National des Appellations d’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1580 (Fed. Cir. 1992) (“A mark may be established as a geographically deceptive mark under section 2(a) by showing that it is primarily geographically deceptively misdescriptive under section 2(e)(2), and additionally showing that the geographic misrepresentation is material to the decision to purchase the goods so marked.”).

quality and that it is likely to be interpreted as such.¹¹⁷ Why else would watches made in Waltham have been named "Waltham" watches?¹¹⁸ But when the goods are not from the place indicated by their trademark, one must consider not only the possibility of fraud, but the possibility that the name was never meant to be taken in a literal, descriptive sense.

Some words of geographic origin are generic when coupled with certain classes of goods—e.g., "Bermuda" shorts or "English" muffins. They cannot be reserved as trademarks, but not because any consumer would believe that the shorts really came from Bermuda or the muffins from England. They cannot be reserved as trademarks because they are understood as naming a variety of goods, and anyone selling that variety of goods must have an equal right to use the term.¹¹⁹ Some pseudogeographic terms might be categorized as fanciful because no such place exists, except in the mythology of advertising. "Nature Valley" probably falls in this category. Other such terms might be deemed suggestive.¹²⁰ Section 2(e) of the Lanham Act refers to marks that are "*primarily geographically deceptively misdescriptive.*"¹²¹ Hence, names having geographic significance should be denied trademark protection only if consumers would perceive them, incorrectly, as descriptive of the geographic origins of the goods—if, in other words, there is a "goods/place association."¹²²

Some geographic references are too obscure to be understood as such by consumers. On one occasion, the Federal Circuit determined very few American consumers would recognize "Vittel" as a town in the Voges mountain region of France.¹²³ Consequently, consumers would perceive the name "Vittel" used on a skin lotion simply as a trademark.¹²⁴ The goods/place association must be judged from the perspective of the relevant public, "in this case the mill-run of cosmetic purchasers, not . . . the unusually well-travelled, the aficionados of European watering places, or . . . computer operators checking out the meaning of strange words on NEXIS."¹²⁵ Courts have often classified obscure geographic terms as "arbitrary" rather than "misdescriptive."¹²⁶

Consumers may recognize a geographic term but not take the reference literally because, as in the case of "Alaska bananas," the goods and the place are unrelated. Courts often mention such "unconnected" terms in the same breath as

117. *In re Cal. Pizza Kitchen Inc.*, 10 U.S.P.Q.2d (BNA) 1704, 1706 (T.T.A.B. 1988).

118. *See Am. Waltham Watch Co. v. U.S. Watch Co.*, 53 N.E. 141, 142 (Mass. 1899) (stating that trademark holder originally used "Waltham" name to indicate geographic origin).

119. *See supra* note 31.

120. *See In re Int'l Minerals & Chem. Corp.*, 147 U.S.P.Q. (BNA) 262, 262 (T.T.A.B. 1965) (concluding that "Kentucky Turf" fertilizer did not indicate product was made in Kentucky; rather, it suggested that using product would produce desirable result—presumably the kind of lush grass for which Kentucky is famous).

121. *In re Amerise*, 160 U.S.P.Q. (BNA) 687, 690 (T.T.A.B. 1969) (emphasis added).

122. *See supra* notes 86-91 and accompanying text.

123. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959 (Fed. Cir. 1987).

124. *Id.*

125. *Id.*

126. *In re Nantucket*, 677 F.2d 95, 99 (C.C.P.A. 1982).

those that are “minor” or “obscure,”¹²⁷ dismissing them all as “arbitrary.”¹²⁸ Some “unconnected” geographic trademarks may indeed be arbitrary in the sense that they seem chosen without any conscious design.¹²⁹ The conjunction of “Alaska” and “bananas,” for example, is so incongruous that it is essentially meaningless.¹³⁰ As in the case of “Penguin Books,” any other name would do just as well. But “Alaska bananas” is only a popular hypothetical. Genuine “unconnected” trademarks often reveal more deliberate origins.

Consider some of the geographic trademarks described by the Sixth Circuit as “entirely arbitrary”: “European” health spas, “Nantucket” shirts, and “Dutch” paint.¹³¹ The United States District Court for the District of South Dakota deemed “European health spas” an “arbitrary” trademark, but explained that it was used “primarily to convey romantic overtones.”¹³² In *In re Nantucket*, the registrant argued that the name “Nantucket” was “suggestive of fashionable summer resort stylishness.”¹³³ The CCPA seemed to agree.¹³⁴ In *National Lead Co. v. Wolfe*,¹³⁵ the Ninth Circuit approved the terms “Dutch” and “Dutch Boy” as trademarks for paint.¹³⁶ Although the court did not speculate on the reason for the name, finding only that it would not be taken literally,¹³⁷ it is difficult to imagine that “Dutch” was chosen with any less care than “European” or “Nantucket.” “Dutch” communicates a feeling that

127. *E.g.*, *In re Hiromichi Wada*, 194 F.3d 1297, 1300 (Fed. Cir. 1999) (“A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods.” (citing *In re Nantucket*, 677 F.2d at 99)); *In re House of Windsor*, 221 U.S.P.Q. (BNA) 53, 55 (T.T.A.B. 1983) (holding that geographical meaning of “Bahia” is not “minor, obscure, remote, or unconnected with applicant’s goods”).

128. *See, e.g.*, *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 594 (6th Cir. 1989) (noting that unconnected geographic terms are “entirely arbitrary”); *In re Nantucket*, 677 F.2d at 99 (“[I]f there be no connection of the geographical meaning of the mark with the goods in the public mind, that is, if the mark is arbitrary when applied to the goods, registration should not be refused . . .”).

129. WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE 110 (2002) provides several definitions of “arbitrary.” The meaning seemingly meant in this context is “based on random or convenient selection or choice rather than on reason or nature.” *Id.* at 110.

130. *See In re House of Windsor*, 221 U.S.P.Q. (BNA) at 55 (discussing “Alaska bananas” hypothetical).

131. *Burke-Parsons-Bowlby*, 871 F.2d at 594. The court also mentioned “Touraine” coffee and “World” carpets but these need not be considered geographic terms at all—“Touraine” because its geographic origins would be unknown to most American consumers, *La Touraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 117 (2d Cir. 1946), and “World” because it is too broad to refer to any particular region, *World Carpets*, 438 F.2d at 486. As Judge Nies remarked in her *In re Nantucket* opinion, “Names such as SUN, WORLD, GLOBE, MARS, or MILKY WAY are . . . arbitrary, not informational; competitors do not need to use the terms to compete effectively.” 677 F.2d at 105 (Nies, J., concurring).

132. *Health Indus., Inc. v. European Health Spas*, 489 F. Supp. 860, 868 (D.S.D. 1980).

133. *In re Nantucket*, 677 F.2d at 101 n.10.

134. *See id.* at 101 (finding no evidence that consumers would take “Nantucket” literally).

135. 223 F.2d 195 (9th Cir. 1955).

136. *Nat’l Lead*, 223 F.2d at 200.

137. *Id.*

“Chinese” does not, even if it is difficult to put one’s finger on what that feeling is. The terms “fanciful,”¹³⁸ “fictitious,”¹³⁹ or “suggestive”¹⁴⁰ for such uses of geographic names come nearer to the truth than “arbitrary.” A Restatement hypothetical, quoted at length in *In re Nantucket*, provides helpful examples:

Thus Gibraltar may be a trade-mark for automobiles since there is no likelihood that such use of the name would lead purchasers to suppose that there is any particular relation between the automobiles and the geographical locations known by that name, or any likelihood that it would seriously interfere with the freedom of merchants at Gibraltar to use that name. Again, Ethiopian may be a proper trade-mark for ladies’ stockings; for, while suggestive of a certain color and sheen, it is only fancifully so and there is no likelihood that other merchants may have occasion properly to use the name Ethiopia on stockings since there is no factor of importance associating stockings with Ethiopia. Such is also the case of Pacific for bread or Arctic for refrigerators.¹⁴¹

Note that the absent “relation” between automobiles and Gibraltar is a *physical* relation. A *symbolic* relationship is another matter. Just as Prudential Insurance promises a metaphorical “piece of the rock,” a “Gibraltar automobile” suggests a product as enduring as granite. “Arctic Refrigerator” is enough to make one shiver. When courts describe a geographic name as “unconnected with the goods,” they plainly speak in the context of something equally literal—a “logical connection” based on the physical location where the goods are produced or seem to be produced.¹⁴² They do not speak of a symbolic connection that might be formed in the imagination of the consumer.

In one sense, the distinction is unimportant. The Lanham Act treats fanciful, arbitrary, and suggestive marks in essentially the same way,¹⁴³ so a seemingly random choice like “Pacific bread” would carry the same consequences as a more evocative choice like “Gibraltar automobile.” I will argue in Part II.C, however, that the symbolic use of geography is an increasingly significant aspect of contemporary marketing, and that ignoring nonliteral, but quite meaningful, connections between place and product threatens to obscure some important matters of policy, particularly in the era of upheaval following the post-North American Free Trade Agreement (“NAFTA”) amendments to the Lanham Act.

138. *E.g.*, *In re Jacques Bernier, Inc.*, 894 F.2d 389, 391 (Fed. Cir. 1990); *Nat’l Lead*, 223 F.2d at 199; *In re Int’l Minerals & Chem. Corp.*, 147 U.S.P.Q. (BNA) 262, 262 (T.T.A.B. 1965).

139. *E.g.*, *In re Nantucket, Inc.*, 677 F.2d at 100; *Nat’l Lead*, 223 F.2d at 199; *La Touraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 116 (2d Cir. 1946).

140. *E.g.*, *Health Indus., Inc. v. European Health Spas*, 489 F. Supp. 860, 868 (D.S.D. 1980); *In re Int’l Minerals*, 147 U.S.P.Q. (BNA) at 262.

141. *In re Nantucket*, 677 F.2d at 100 n.8 (quoting RESTATEMENT OF TORTS § 720 cmt. d (1938)).

142. *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 595 (6th Cir. 1989) (finding that term is geographically descriptive where court can make logical connection between product and geographical term).

143. 15 U.S.C. § 1052 (2000).

C. *Geographic Trademarks After NAFTA*

European nations, having long histories of regional industry and countless local reputations to celebrate, often use place names to differentiate one type of product from another. Popular varieties of wine and cheese, for example, are commonly named for the European cities or regions where they are produced. Immigrants to the new world, bringing European culture with them, sometimes named American products after fondly remembered European predecessors¹⁴⁴—e.g., burgundy wine or limburger cheese—leading to embarrassing situations. For example, from the French perspective, “Chablis” denotes a town in France and the fine wines for which it is known. But a United States court must find “Chablis” a generic term for wine because in the United States the term has neither brand nor geographic significance.¹⁴⁵ Europeans regard such uses as misappropriation.¹⁴⁶

The United States, for many decades, declined to join in international agreements that would have restricted the use of foreign geographic names used generically in this country.¹⁴⁷ Following a World Trade Organization (“WTO”) agreement, however, Congress amended section 2(a) of the Lanham Act to bar registration of “a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods.”¹⁴⁸ While this will not prevent an American vintner from calling its wine “Chablis,” it will prevent such names from being adopted as trademarks and wielded as such. With wider implications, Congress changed sections 2(e) and 2(f) after NAFTA. Section 2(e) now divides marks that are “primarily geographically descriptive” (section 2(e)(2)) and marks that are “primarily geographically deceptively misdescriptive” (section 2(e)(3)). The former, as before, can be registered if they have “become distinctive of the applicant’s goods in commerce”—in other words, if they have developed secondary meaning.¹⁴⁹ But

144. Burkhart Goebel, *Geographical Indications and Trademarks – The Road from Doha*, 93 TRADEMARK REP. 964, 988 (2003).

145. See *Institut National des Appellations d’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1582 (Fed. Cir. 1992) (“[N]o reasonable factfinder could have found the term ‘Chablis’ to be used in the United States as anything other than a generic name for a type of wine with certain general characteristics.”).

146. See 2 MCCARTHY, *supra* note 16, § 14:18 (describing European Union efforts to “claw back” generic terms).

147. See, e.g., *id.* § 14:1.50 (describing Lisbon Agreement of 1958, which United States did not join).

148. 15 U.S.C. § 1052(a) (2000); 19 U.S.C. § 3501(9) (2000). The amendment became effective on January 1, 1996. See Uruguay Round Agreements Act, Pub. L. No. 103-465, § 523, 108 Stat. 4809, 4982 (1994) (codified as amended 15 U.S.C. § 1052(a) (2000)) (indicating that amendment is effective one year after WTO Agreement becomes effective in United States); Proclamation No. 6780, 60 Fed. Reg. 15,845 (Mar. 23, 1995) (stating that WTO Agreement became effective in United States on January 1, 1995).

149. 15 U.S.C. § 1052(e), (f).

the latter cannot be registered unless they developed secondary meaning before December 8, 1993.¹⁵⁰

The apparent effect of this change is to narrow the range of geographic trademarks eligible for protection by denying “primarily geographically deceptively misdescriptive” marks the saving grace of secondary meaning. Subsequent Federal Circuit decisions discovered no change in the definition of a “primarily geographically deceptively misdescriptive” mark. For example, in *In re Save Venice New York, Inc.*,¹⁵¹ the court reviewed the rejection of trademarks consisting of “The Venice Collection,” “Save Venice Inc.,” and an image of the winged lion of St. Mark. The marks were used by a nonprofit New York corporation dedicated to the preservation of Venice, Italy, but few of the goods it sold actually came from Venice.¹⁵² The court affirmed the rejection under section 2(e)(3) of the Lanham Act, applying the same test developed before the post-NAFTA revisions.¹⁵³ That test denies registration to a mark if “(1) the mark’s primary significance is a generally known geographic location; and (2) consumers would reasonably believe the applicant’s goods are connected with the geographic location in the mark, when in fact they are not.”¹⁵⁴ By demonstrating that Venice is known for producing the kinds of goods sold by the applicant, or at least related goods, the examiner had supplied the necessary goods/place association.¹⁵⁵

In 2003, matters changed abruptly when the Federal Circuit decided *In re California Innovations, Inc.*,¹⁵⁶ where the applicant sought to register the mark “California Innovations” for backpacks, tote bags, and similar gear. Reviewing the history of judicial and PTO implementation of the Lanham Act, the court found that prior to the NAFTA amendments it was much easier for the PTO to reject applications as “primarily geographically deceptively misdescriptive” under section 2(e) than as “deceptive” under section 2(a).¹⁵⁷ Section 2(e) focused on the “distinctiveness” of the mark (i.e., whether it was descriptive or misdescriptive) rather than on its tendency to mislead.¹⁵⁸ The latter was the province of section 2(a) and burdened the PTO with demonstrating that the

150. *Id.*

151. 259 F.3d 1346 (Fed. Cir. 2001).

152. *In re Save Venice N.Y., Inc.*, 259 F.3d at 1349-50.

153. *Id.* at 1352, 1356.

154. *Id.* at 1352.

155. *Id.* at 1354-55.

156. 329 F.3d 1334 (Fed. Cir. 2003).

157. *In re Cal. Innovations, Inc.*, 329 F.3d at 1337.

158. See *id.*, explaining that:

In the pre-NAFTA era, the focus on distinctiveness overshadowed the deceptiveness aspect of § [2(e)(2)] and made it quite easy for the PTO to deny registration on the principal register to geographically deceptively misdescriptive marks under § [2(e)(2)]. On the other hand, the deception requirement of § [2(a)] protected against fraud and could not be overlooked. Therefore, the PTO had significantly more difficulty denying registration based on that higher standard.

deception was *material*.¹⁵⁹ The possibility of redemption through secondary meaning, an escape unavailable to marks rejected under section 2(a), counterbalanced the relative ease with which a mark could be rejected under section 2(e). Nevertheless, “NAFTA and its implementing legislation obliterated the distinction between geographically deceptive marks and primarily geographically deceptively misdescriptive marks.”¹⁶⁰ By removing the benefit of secondary meaning from the latter, the changes refocused attention on the “deceptive” component of “primarily geographically deceptively misdescriptive.”¹⁶¹

If the consequences of disqualification under section 2(e)(3) now are just as dire, and just as irreversible, as disqualification under section 2(a), then, the court reasoned, the test should be the same.¹⁶² Now one has to demonstrate, under section 2(e)(3), that the deception inherent in the false goods/place association “is material to the consumer’s decision to purchase those goods.”¹⁶³ In other words, Congress’s post-NAFTA amendments made challenging “primarily geographically deceptively misdescriptive” marks *more difficult*.

Professor Mary LaFrance has advanced a number of arguments against the Federal Circuit’s interpretation of the NAFTA revisions.¹⁶⁴ At least one curious result is worth pointing out here.¹⁶⁵ Because the grandfather clause of section 2(f) allows “primarily geographically deceptively misdescriptive” marks to be registered if they developed secondary meaning before December 8, 1993,¹⁶⁶ one must conclude either (1) that such marks are registrable even though they are deceptive under section 2(a), which was not the case before the NAFTA revisions and still is not the case for other deceptive marks; (2) that the term “primarily geographically deceptively misdescriptive” means different things in section 2(e)(3) and section 2(f)—*materially* deceptive in the first instance but not

159. *Id.* (distinguishing finality of decision under section 2(a) of Lanham Act with temporary nature of section 2(e)(2), which could be challenged based on acquired distinctiveness).

160. *Id.* at 1338.

161. *Id.* at 1339-40.

162. *In re Cal. Innovations, Inc.*, 329 F.3d at 1340. The court explained:

Because both of these categories are subject to permanent denial of registration, the PTO may not simply rely on lack of distinctiveness to deny registration, but must make the more difficult showing of public deception. In other words, by placing geographically deceptively misdescriptive marks under subsection (e)(3) in the same fatal circumstances as deceptive marks under subsection (a), the NAFTA Act also elevated the standards for identifying those deceptive marks.

Id.

163. *Id.*

164. *See generally* Mary LaFrance, *Innovations Palpitations: The Confusing Status of Geographically Misdescriptive Trademarks*, 12 J. INTELL. PROP. L. 125, 141-48 (2004) (arguing that the Federal Circuit’s interpretation is contrary to the intent of the legislative and standard rules of statutory construction).

165. *See id.* at 146 (discussing grandfather clause in section 2(f) of Lanham Act, which applies to primarily geographically deceptively misdescriptive marks under section 2(e)(3) but not deceptive marks under section 2(a)).

166. 15 U.S.C.A. § 1052(f) (West 1997 & Supp. 2006).

in the latter; or (3) that the grandfather clause is meaningless because any mark it saves must be struck down under section 2(a). None of these alternatives seems plausible. Nevertheless, even if the intent of the NAFTA amendments was to make trademark protection for borrowed geographic names less available, the result, barring further action by Congress, review by the Supreme Court, or an en banc change of direction by the Federal Circuit, has been just the opposite.

D. Claims of Trademark Infringement or Unfair Competition Based on the Use of Geographic Terms

So far we have discussed the registrability of geographic trademarks, which generally tracks the enforceability of geographic trademarks against others. Failure to grant affirmative rights to a geographic trademark does not, however, prevent the use of the term as a brand name. The Save Venice Corporation, for example, still can sell its merchandise under that name even though its trademark was refused. The corporation is simply limited in its ability to prevent others from using a similar name. Because businesses prefer to use names that they can reserve to themselves, preventing the registration of geographic trademarks should discourage their selection as brand names. Yet one must look elsewhere to *force* a business to discontinue the use of a trademark.

One way is to register the mark first, perhaps as a certification mark. A certification mark is a word or symbol used by persons other than the owner of the mark to certify characteristics such as “regional . . . origin.”¹⁶⁷ Section 4 of the Lanham Act provides for the registration of certification marks, including indications of regional origin, by individuals or governments that exercise legitimate control over the marks.¹⁶⁸ The state of Wisconsin, for example, could register a mark for “Wisconsin Cheese.” In this case, registration would not be hampered by its geographic descriptiveness. Certification marks may hold less attraction for private interests because only parties who *do not* produce the goods in question can own them, and permission to use the certification mark must be granted to anyone whose product meets the certification criteria.¹⁶⁹

Private organizations might consider a collective mark, defined in the Lanham Act as a mark “used by the members of a cooperative, an association, or other collective group.”¹⁷⁰ Section 4 of the Lanham Act authorizes collective marks indicating regional origin,¹⁷¹ and such a mark might be used, for example, by an association of Wisconsin cheese producers. The power of collective marks and certification marks is limited in some respects. The fair use defense still allows others to describe, in good faith, the geographic origin of their goods.¹⁷²

167. 15 U.S.C. § 1127 (2000).

168. 15 U.S.C. § 1054.

169. 3 MCCARTHY, *supra* note 16, § 19:92; *see also* 15 U.S.C. § 1064(5) (allowing filing of petition for cancellation of registration where registrant produces or markets goods or services under certification mark).

170. 15 U.S.C. § 1127.

171. 15 U.S.C. § 1054.

172. 15 U.S.C. § 1115(b)(4).

Collective marks and certification marks also are limited, like any other mark, to the class of goods specified in the application for registration.¹⁷³

Another way to control the use of geographic terms in brand names and advertising is through an action claiming unfair competition. A federal claim of unfair competition may be brought under section 43(a) of the Lanham Act “by any person who believes that he or she is or is likely to be damaged,” when a term has been used to misrepresent the geographic origins of a product.¹⁷⁴ Several jewelry manufacturers located in the Black Hills region of South Dakota, who sold their distinctive style of gold jewelry as “Black Hills Gold Jewelry,” successfully invoked section 43(a) to prevent the sale, using the same name, of similarly styled gold jewelry manufactured elsewhere.¹⁷⁵ This outcome did not require proof that “Black Hills Gold Jewelry” had developed secondary meaning as a brand name.¹⁷⁶ It was enough that the defendants’ use of “Black Hills” conveyed a false sense of geographic origin, a problem exacerbated by advertising calling attention to South Dakota traditions and employing images of Mount Rushmore.¹⁷⁷ The plaintiffs succeeded because the term “Black Hills” conveys a geographical meaning.¹⁷⁸ If “Black Hills” primarily referred to a style of jewelry, then the term would not have misdescribed the defendant’s product.¹⁷⁹ Thus, in *Forschner Group, Inc. v. Arrow Trading Co.*,¹⁸⁰ the traditional Swiss manufacturers of the “Swiss Army Knife” failed to prevent the use of that term for a knife manufactured in China because “Swiss” indicated a type of knife (the type favored by the Swiss Army), rather than a place of manufacture.¹⁸¹

Although neither “Black Hills” nor “Swiss” were used as brand names, nothing in section 43(a) prevents its application to geographic terms embedded in trademarks where the term misrepresents the geographic origin of the goods. Where the geographic term would not be understood in a literal sense, however, (e.g., “Alaska bananas”) or where the development of secondary meaning has overcome the original geographic meaning of the term, the element of “misrepresentation” would be absent.

III. EMOTION AND SYMBOLISM IN CONTEMPORARY MARKETING

When courts reflect on the messages conveyed by geographic trademarks, they tend to think in literal terms. If a geographic trademark invokes a well-known place—a place consumers are likely to associate with this type of goods—

173. 15 U.S.C. § 1051(a)(2).

174. 15 U.S.C. § 1125(a)(1).

175. *Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746, 747-48 (8th Cir. 1980).

176. *Id.* at 750.

177. *Id.* at 752.

178. *Black Hills Jewelry Mfg. Co.*, 633 F.2d at 752.

179. *Id.* at 751-52.

180. 30 F.3d 348 (2d Cir. 1994).

181. *Forschner*, 30 F.3d at 350, 356.

consumers will conclude that the product comes from that place. If consumers do not draw that conclusion, the usage is “arbitrary” and readily dismissed, as though it was meaningless. Yet those who practice and study the art of marketing do not confine their interest to messages that are so solidly grounded in fact. Increasingly, they emphasize the importance of symbolism, both in motivating consumers to choose a brand and in enhancing the value of products. Because geographic terms are so rich in symbolism, it is important to consider how trademarks rooted in geography may communicate on a more abstract level.

A. *Selling Through Fact and Fancy*

A classic approach to marketing emphasizes “features and benefits.”¹⁸² Features and benefits advertising for a BMW sedan might stress the car’s superior acceleration, leather trim, traction control, and resale value. The assumption underlying such marketing is that potential consumers will weigh those features against the features offered by other vehicles and, taking into account their needs, choose the product offering the greatest utility.¹⁸³ This kind of marketing appeals to the intellect and calls on the consumer to make rational choices based on the information conveyed through various media. Even if one could question the accuracy of the message, selective and biased as it is certain to be, the ostensible purpose is to communicate definite, concrete information about the product. Such advertising is said to appeal most to “[h]ighly involved and motivated buyers” and it succeeds through “strong, rational arguments.”¹⁸⁴ This method of advertising is still common today, and some experts suggest that brand names should contribute by signaling desirable product attributes.¹⁸⁵

On the other hand, advertisers have long recognized that consumers can be reached by other means than rational argument. One of the first academic studies of advertising, Walter Dill Scott’s *The Psychology of Advertising*, first published in 1903, recognized the power of suggestion.¹⁸⁶ Appropriate images in one’s advertising, Scott argued, could trigger favorable associations and link them, consciously or otherwise, to the featured brand.¹⁸⁷ Successful advertising, in Scott’s view, created the right kinds of associations.¹⁸⁸ Including an image of

182. BERND H. SCHMITT, *EXPERIENTIAL MARKETING* 13 (1999).

183. *Id.* Price, of course, would be one of the factors influencing the consumer’s decision.

184. Joanne Lynch & Leslie de Chernatony, *The Power of Emotion: Brand Communication in Business-to-Business Markets*, 11 J. BRAND MGMT. 403, 406 (2004).

185. *E.g.*, JOE MARCONI, *THE BRAND MARKETING BOOK* 30 (2000) (“Try to show a benefit in your name. *Easy, quick, fresh, safe, rapid, instant, and sure* are some examples of words used commonly in brand names to suggest benefits.”).

186. “We are not cold, logical machines, who take data in and then, by a logical process, come to a reasonable conclusion.” WALTER DILL SCOTT, *THE PSYCHOLOGY OF ADVERTISING* 89 (Small, Maynard & Co. 1917) (1903). Instead, we are susceptible to the power of suggestion, whether supplied by peers or through advertising. *Id.* at 186.

187. *Id.* at 107.

188. *See id.* (suggesting merchant is successful if advertising produces habitual, recent, and vivid associations with product); Paul Feldwick, *Brand Communications*, in *BRANDS AND BRANDING*, *supra* note 20, at 127, at 133-34 (discussing Scott’s perspective on associative power of advertising and its

an affluent couple in an advertisement for a railway would tell consumers nothing specific about the service, but by a process of association it might leave them with the feeling that the railroad was a desirable way to travel.¹⁸⁹

At about the same time that Scott published his study, advertising executive Charles Hopkins popularized “Reason Why” advertising. As one historian notes, “Reason Why” advertising is anything but rational: “Hopkins refused to appeal to a buyer’s reason by listing a product’s qualities; on the contrary he addressed nonrational yearnings by suggesting the ways his client’s product would transform the buyer’s life.”¹⁹⁰ Hopkins’s form of advertising shifted attention from the product toward the “promise of a richer, fuller life.”¹⁹¹ To put it in terms of contemporary beer advertising, he deemphasized the refreshing taste of the beverage in favor of the vibrant social life enjoyed by those who partake. Like advertising that works by association, “Reason Why” advertising relies on the power of emotion.¹⁹²

Although emotional appeals in marketing are nothing new, it may be that their importance has increased.¹⁹³ As production technologies have advanced

ability to influence attitudes). Scott contrasted “sympathetic” advertising images (e.g., images of tasteful, satisfied customers) with images of unattractive people with whom Scott, and presumably other consumers, would not wish to identify themselves. SCOTT, *supra* note 186, at 38-50. Scott was also critical of an advertisement for White Star Coffee illustrated with images of frogs, which he found “in every way disgusting.” “Frogs are inherently uncanny to most persons, and to see them here as the representatives of a particular brand of coffee serves but to instill a dislike and even abhorrence for the product. This advertisement never made anyone eager for a cup of coffee.” *Id.* at 209-11.

189. See SCOTT, *supra* note 186, at 41 (“The two persons here represented approximate my ideals. They seem to be enjoying the train immensely. I believe that they have good taste and if they choose the California Limited for their wedding trip that train would certainly be desirable for my trips too.”).

190. T.J. Jackson Lears, *From Salvation to Self-Realization: Advertising and the Therapeutic Roots of the Consumer Culture, 1880-1930*, in THE CULTURE OF CONSUMPTION: CRITICAL ESSAYS IN AMERICAN HISTORY, 1880-1980, at 1, 18 (Richard Wightman Fox & T.J. Jackson Lears eds., 1983).

191. *Id.*

192. Scott was aware of “Reason Why” advertising, but thought that “suggestion” was at least as important as “persuasion.” See SCOTT, *supra* note 186, at 83 (recognizing strong power of suggestion from both friends and experts).

193. Many students of marketing find “features and benefits” advertising to be of decreasing importance. See, e.g., SCHMITT, *supra* note 182, at xiii (“More and more, marketers are moving away from traditional ‘features-and-benefits’ marketing toward creating experiences for their customers.”). Consumers are said to be less interested in facts and more interested in emotional fulfillment. See MARC GOBÉ, EMOTIONAL BRANDING: THE NEW PARADIGM FOR CONNECTING BRANDS TO PEOPLE, at xiii (2001) (“Over the last fifty years the economic base has shifted from production to consumption. It has gravitated from the sphere of rationality to the realm of desire: from the objective to the subjective; to the realm of psychology.” (quoting Herbert Muschamp, *Seductive Objects with a Sly Sting*, N.Y. TIMES, July 2, 1999, at E35)); Lears, *supra* note 190, at 27 (“The clearest illustration of this change appeared in automobile advertising. Pre-World War I advertisements were nearly all based on the straightforward presentation of technical details. By the twenties they were virtually devoid of information; instead they promised style, status, or escape to an exotic ‘real life’ far from the reader’s ordinary experience. The earlier ads assumed a knowledgeable, rational audience; the later ones offered therapeutic fulfillment of nonrational longings.”); Sidney J. Levy, *Symbols by Which We Buy*, in ADVANCING MARKETING EFFICIENCY 409-16 (L.H. Stockholm ed., 1958), reprinted in CONSUMER BEHAVIOR, 55, 55 (James F. Engel ed., 1968) (“The great multiplicity of goods, the burgeoning of new

and matured, many products have reached a state of “parity” where there is little differentiating one product from another.¹⁹⁴ Quality is always high, and new features are soon imitated.¹⁹⁵ The rational consumer, the intended target of features and benefits advertising, is hard-pressed to decide between one brand of laundry detergent and another when all can claim essentially the same functionality. In this environment, the brand assumes a higher level of importance. “Brands are the solution to what Tom Peters has dubbed ‘the blight of sameness.’”¹⁹⁶ How can a marketer successfully promote a brand when other brands offer indistinguishable features? By appealing to emotion. In the words of Marc Gobé, author of *Emotional Branding*:

What is the difference between Ralph Lauren’s new fragrance Romance and Estée Lauder’s Pleasure? . . . between one cola and another cola? . . . a particular sneaker and its competitor? . . . or many different kinds of jeans, coffees, or gas stations? Or between one beauty Web site and another? In this ocean of offerings, all fighting for the same consumer dollar, the emotional connection is what makes that all-important, essential difference. The emotional element is what gives a brand both the foundation and fuel for future business strategies—consumer-driven strategies.¹⁹⁷

When tangible features no longer distinguish products, “emotional augmentation” must do the job.¹⁹⁸ Emotional augmentation is what turns the “fizzy sugar water” known as Coca-Cola into “the real thing.”¹⁹⁹

products, and their eager fruition in the consumers’ homes, have moved our society to a point where practical considerations in the purchase of goods are often not given the central attention that was true in the past.”).

194. See DARYL TRAVIS, *EMOTIONAL BRANDING: HOW SUCCESSFUL BRANDS GAIN THE IRRATIONAL EDGE* 3 (2000) (“I described to my client how today’s marketplace is so crowded that very few people have the time or the inclination to search through claims of product superiority. By now, they’ve seen it all. Parity rules and acceptable performance is the price of entry.”). Advertising is the most important when objects are functionally interchangeable. JAMES B. TWITCHELL, *LEAD US INTO TEMPTATION: THE TRIUMPH OF AMERICAN MATERIALISM* 92-93 (1999) (“[A]dvertising is invoked when the objects are interchangeable. Such objects, called parity items, constitute most of the commercial stuff that surrounds us, from toothpaste to beer to cars to airlines. What they have in common is that they are all machine made. There is really no discernable difference between Colgate and Crest, Miller and Budweiser, Ford and Chevrolet, Delta and United. In fact, the only difference is usually in the advertising.”).

195. See JACKSON LEARS, *FABLES OF ABUNDANCE: A CULTURAL HISTORY OF ADVERTISING IN AMERICA* 289 (1994) (“As technological developments were incorporated into the manufacturer’s merchandising plan, it became more and more difficult for him to differentiate his product from those of his competitors. In 1890, soda crackers in sealed packages were a novelty; ten years later dozens of such brands were available.”).

196. Jonathan Knowles, *The Role of Brands in Business*, in *BRANDS: VISIONS AND VALUES* 21, 22 (John Goodchild & Clive Callow eds., 2001). Management expert Tom Peters is the author of the 1982 bestseller *In Search of Excellence*.

197. GOBÉ, *supra* note 193, at xxvi. It may be a sign of the times that *two* books entitled *Emotional Branding* have been published since 2000. *Id.*; TRAVIS, *supra* note 194.

198. Knowles, *supra* note 196, at 21-23.

199. *Id.* Branding has been described as “the central activity creating differing values for such commonplace objects and services as flour, bottled water, cigarettes, denim jeans, razor blades,

The stories told through advertising, and the emotional connections made with consumers, are an important part of “positioning” one’s brand in the marketplace. “Positioning” means creating a brand identity—a set of associations that separates one brand from another, particularly when the differences in the goods themselves are relatively minor.²⁰⁰ The clothing stores Banana Republic, The Gap, and Old Navy, all owned by the same company, are “positioned” to attract consumers of different ages, wealth, and aspirations.²⁰¹ Although positioning a product so that it appeals to the targeted consumer is a task with many dimensions—involving such things as store and product design, packaging, and advertising—the selection of a brand name is an important component. One author advises: “Choose a name or change to a name that distinguishes you from the pack in the most favorable possible way. In an ad-heavy, information-heavy environment, few choices you make will tell your public so much or carry so much currency over time as your brand name.”²⁰²

A British corporation chose the name “Goldfish” for a new credit card, a selection that might seem so unconnected to the goods as to be genuinely arbitrary. In fact, it was a carefully considered step in “positioning” the product:

Why Goldfish? Because goldfish are the perfect symbol for the key messages about the brand. Goldfish are domestic and the brand’s proposition is about saving on home essentials; everyone can own goldfish and the brand is about inclusiveness; goldfish bring a splash of colour to a financial world that’s predominantly grey. Just as important, their warm colour provides a visual link to the main benefit – money off your gas bill – and a tonal link to the warmth of the home. The surprising name reinforces the message that this card is designed to change your ideas about credit cards: “You’ll be surprised what you can do with a Goldfish.”²⁰³

A mobile phone company chose the name “Orange” with similar thoughts. Orange is “the colour of optimism and the rising sun, underlining an optimistic

domestic beers, batteries, cola drinks, air travel, overnight couriers, and telephone carriers.” JAMES B. TWITCHELL, *ADULT USA: THE TRIUMPH OF ADVERTISING IN AMERICAN CULTURE* 13 (1996).

200. CELIA LURY, *BRANDS: THE LOGOS OF THE GLOBAL ECONOMY* 80 (2004); *see also* MARCONI, *supra* note 200, at 44 (“To position a product can mean to attempt to conjure an image or an association in a mental frame of reference . . .”). Advertisers also speak of developing a “Unique Selling Proposition,” often, in the words of James Twitchell, by staking out a distinct “emotional territory” on the “map of other similar products.” TWITCHELL, *supra* note 199, at 129.

201. Mercedes and BMW are both German producers of high-performance luxury cars, but even they have “positioned” their products in slightly different ways to appeal to a slightly different consumer.

BMW has taken physical performance and used it to communicate a form of emotional aggression. BMW is for people who are on their way somewhere. A product for people who live in life’s metaphorical fast lane. BMW is a statement about how far and fast your career is going. Mercedes has taken that powerful reliability and used it to communicate a form of emotional reassurance. Mercedes offers comfort for people who have made it. A product for people who are already at the top. Mercedes is a statement about achievement rewarded.

Knowles, *supra* note 196, at 45.

202. MARCONI, *supra* note 185, at 28.

203. Knowles, *supra* note 196, at 52.

view of technology.”²⁰⁴ Oranges are simple, everyday items accessible to everyone—as the telephone service is meant to be perceived.²⁰⁵ One of the most famous of recent brands is Amazon.com. Founder Jeff Bezos chose Amazon over alternatives such as “cadabra,” and his choice reaped the benefits of positive associations: a suggestion of immense size combined with “so much third-world, underdog, eco-conscious goodwill that every click on Amazon.com feels like a vote for the rainforest.”²⁰⁶ Of course, these associations are most important at the critical time when a new brand is launched. Eventually, consumers will think less of rivers or rainforests when they encounter Amazon.com and more of their experience with the company itself.

One could regard this use of associations as a kind of trick played on the consumer. After all, the consumer who chooses Amazon.com because of some sympathy for the rainforest receives no corresponding benefit. Jeff Bezos’s company really has nothing to do with the Amazon. Yet the once fashionable conception of advertising as a tool for manipulating helpless consumers, for playing on their fears and desires in ways they do not comprehend,²⁰⁷ seems to have given way to the idea that consumers are, in fact, willing participants in the game. Why do they play along? Perhaps because, as discussed in the next section, the symbolic association of goods with other ideas adds a dimension to consumption that would otherwise be missing.

B. *The Meaning in Consumer Goods*

In his 1959 article *Symbols for Sale*, Sidney J. Levy argued that goods are “essentially psychological things . . . symbolic of personal attributes and goals and of social patterns and strivings.”²⁰⁸ Consumers, he said, “buy things not only for what they can do, but also for what they mean.”²⁰⁹ While some possessions—diplomas, wedding rings, trophies—are overtly symbolic, even those with more obvious functions may be valued for what they symbolize. A consumer buys a Rolex watch as much for what it says, to himself and others, about his taste, status and means, as for its ability to keep time. Acquiring meaningful goods “demonstrate[s] that one is alive, that one matters, that one makes a difference in the world.”²¹⁰ The meaning found in possessions may even substitute, in the

204. *Id.* at 54.

205. *Id.*

206. TRAVIS, *supra* note 194, at 160 (quoting Peter de Jonge, *Riding the Wild, Perilous Waters of Amazon.com*, N.Y. TIMES, Mar. 14, 1999, § 6 (Magazine), at 36).

207. The best-known exposition of this point of view is VANCE PACKARD, *THE HIDDEN PERSUADERS* (1957).

208. Sidney J. Levy, *Symbols for Sale*, HARV. BUS. REV. July-Aug. 1959, at 117, 119; accord GRANT McCracken, *CULTURE AND CONSUMPTION: NEW APPROACHES TO THE SYMBOLIC CHARACTER OF CONSUMER GOODS AND ACTIVITIES* 71 (1988) (noting ability of consumer goods to carry and communicate cultural meaning apart from their commercial and utilitarian values).

209. Levy, *supra* note 208, at 118.

210. MIHALY CSIKSZENTMIHALYI & EUGENE ROCHBERG-HALTON, *THE MEANING OF THINGS: DOMESTIC SYMBOLS AND THE SELF* 27 (1981).

impersonal setting of the industrialized world, for the symbolic values once supplied by social institutions.²¹¹

Meaning is not inherent in physical objects. Meaning generally begins in the culturally constituted world of abstract values and distinctions. Certain objects acquire meaning—they come to embody, in physical form, some cultural ideal—and they transfer that meaning, ultimately, to the consumers who purchase them.²¹² The object of a great deal of advertising is to imbue objects with the kind of meaning that adds marketable value and distinguishes one product from another.²¹³ Advertising does this by suggesting equivalence between the goods and the abstract value the consumer desires²¹⁴—between, for example, a Rolex watch and enhanced social status. Purchase this watch, and you will have prestige; drink this beer, and you will fit in; wear these clothes, and you will be fashionable. If the advertising succeeds, convincing consumers that the equivalence is real, the goods become meaningful and the sales pitch is, to a degree, self-fulfilling. Consumers can be elevated, socially, by their possessions, and sometimes they feel their lives enriched.²¹⁵

That is not to say goods always deliver the more satisfying life promised by advertising. But even when the reality falls short of the ideal, goods still can

211. See KEVIN DRAWBAUGH, *BRANDS IN THE BALANCE: MEETING THE CHALLENGES TO COMMERCIAL IDENTITY* 231 (2001) (“Traditional institutions take time, effort and stability to maintain. Sadly these qualities are in short supply. As a result, in some lives, the bulwarks of non-market-based culture are eroding. In their place, more people are seeking meaning in the ideas and symbols that the market economy makes so very prominent and so effortlessly attainable – commercial brands.”); TWITCHELL, *supra* note 194, at 12 (“What sets American culture of the late twentieth century apart is not avarice, but a surfeit of machine-made things. What is clear is that most of these things in and of themselves simply do not mean enough. So we have developed very powerful ways to add meaning to goods. . . . Consumption of things and their meanings is how most Western young people cope in a world that science has pretty much bled of traditional religious meanings.”).

212. See MCCRACKEN, *supra* note 208, at 71-72 (“Meaning is constantly flowing to and from its several locations in the social world, aided by the collective and individual efforts of designers, producers, advertisers, and consumers. There is a traditional trajectory to the movement of this meaning. Usually it is drawn from a culturally constituted world and transferred to the consumer good. It is then drawn from the object and transferred to the individual consumer.”).

213. See *id.* at 79 (“Advertising is a kind of conduit through which meaning is constantly being poured in its movement from the culturally constituted world to consumer goods.”); TWITCHELL, *supra* note 199 at 13 (describing advertising as one of several ways to give meaning to objects).

214. MCCRACKEN, *supra* note 208, at 77. Specifically, in the words of Grant McCracken:

Advertising works as a potential method of meaning transfer by bringing the consumer good and a representation of the culturally constituted world together within the frame of a particular advertisement. The creative director of an agency seeks to conjoin these two elements in such a way that the viewer/reader glimpses an essential similarity between them. When this symbolic equivalence is successfully established, the viewer/reader attributes certain properties he or she knows to exist in the culturally constituted world to the consumer good. The known properties of the world thus come to be resident in the unknown properties of the consumer good. The transfer of meaning from world to good is accomplished.

Id.

215. See TWITCHELL, *supra* note 199, at 4 (stating that advertising gives our lives value by imbuing objects with value).

serve as what anthropologist Grant McCracken calls “bridges to displaced meaning.”²¹⁶ In a disappointing world, he writes, individuals often cope by imagining a better, more fulfilling existence in some distant time or place.²¹⁷ Advertising conjures up that better world and offers the product as a bridge: own this, and you will be that much closer to the life you imagine. McCracken explains:

[G]oods help the individual contemplate the possession of an emotional condition, a social circumstance, even an entire style of life, by somehow concretizing these things in themselves. They become a bridge to displaced meaning and an idealized version of life as it should be lived. When called to mind, these objects allow the individual to rehearse a much larger set of possessions, attitudes, circumstances, and opportunities. A simple example of this is the use of a “rose-covered cottage.” The individual reflects on the eventual possession of such a cottage and in the process reflects upon the possession of an entire way of life that specifies more or less explicitly a certain kind of livelihood, spouse, domestic arrangement, and so on. The cottage becomes the “objective correlative” of this diverse package of displaced meaning.²¹⁸

The idea of seeking fulfillment through consumption can paint a rather bleak and materialistic picture. McCracken writes of “pathologies” wherein consumers rely too much on material goods to satisfy deeper needs.²¹⁹ In its proper place, however, a glimpse of a better life is something that consumers enjoy, and consumers reward marketers who encourage their fantasies.

Advertising promises more than one version of the good life. As previously discussed,²²⁰ marketers position their brands to appeal to different notions of the ideal. Advertising for one brand of breakfast cereal might conjure up something close to the world of the “rose-covered cottage”; advertising for another brand, perhaps aimed at teenagers, could paint a different picture. By generating a symbolic depth and diversity sometimes lacking in the goods themselves, advertising creates additional opportunities for self-expression.²²¹ If one’s

216. MCCracken, *supra* note 208, at 109.

217. *Id.* at 110.

218. *Id.* It works, McCracken explains, because any disappointment following purchase does not discredit the ideal:

What is being bought is not the whole bridge but a small part of it. Indeed the purchase has a quality of rehearsal to it. It is consumption in training. The individual clearly understands that he or she is not laying claim to the whole parcel of displaced meaning that has been transported to another time and place, but merely a small, anticipatory part of it. This gives another virtue for the concrete and discrete nature of the good. It can be broken off and used to anticipate the larger purchase.

Id. at 112.

219. *Id.* at 88.

220. See *supra* notes 200-07 and accompanying text.

221. See CSIKSZENTMIHALYI & ROCHBERG-HALTON, *supra* note 210, at 93 (arguing that we now define ourselves through consumption rather than production and that things “send messages about who we are”); MCCracken, *supra* note 208, at 88 (“One of the ways individuals satisfy the freedom and responsibility of self-definition is through the systematic appropriation of the meaningful

resources permit, one can choose to be the kind of person who buys a Volvo or the kind of person who buys a Cadillac. The mythology of the brand, cultivated through advertising, gives one's choice more significance in developing a sense of self and more power to express one's values through consumption.

At the same time, associative marketing adds an element of fantasy to shopping, purchasing, and owning that would be absent if advertisers confined themselves to facts and figures. Some argue that the straightforward marketing of goods and services is giving way to the "staging of experiences"²²²—experiences that begin with promoting the brand. Successful brands "go way beyond the confines of their product dimensions. They create their own mind space. They give you not just a physical product or service, but an experience that engages your imagination."²²³ Advertising that positions the product in a rich symbolic context enhances the experience. Arguably, consumers desire the emotional connection, or the symbolism, more than they desire the goods themselves. According to James Twitchell, it is not the product we buy but "the aura around it," and it may be the "sizzle," not the "steak," that satisfies our needs.²²⁴ In short, marketing adds meaning to goods beyond their physical attributes because the public craves meaning and is willing to pay for it.²²⁵ Consumers understand, at some level, that the fantasies promoted through marketing must be taken with a grain of salt, but that does not eliminate the satisfaction they find in the process.²²⁶

properties of goods."); Knowles, *supra* note 196, at 42 (contending that consumers often choose one brand over another due to intangible features relating to how product makes them feel); Levy, *supra* note 193, at 56 (concluding that modern goods are primarily symbolic of personal attributes and social status).

222. TRAVIS, *supra* note 194, at 86-87; see also SCHMITT, *supra* note 182, at 22 ("Today, customers take functional features and benefits, product quality, and a positive brand image as a given. What they want is products, communications, and marketing campaigns that dazzle their senses, touch their hearts, and stimulate their minds. They want products, communications, and campaigns that they can relate to and that they can incorporate into their lifestyles. They want products, communications, and marketing campaigns to deliver an experience.").

223. TRAVIS, *supra* note 194, at 78.

224. TWITCHELL, *supra* note 194, at 73. "We might consider that the customer often drinks the advertising, not the beer; drives the name-plate, not the car; or smokes the advertising, not the cigarette." *Id.* at 73-74.

225. See Knowles, *supra* note 196, at 21 ("Brands' ability to communicate meaning is important because, as humans, we like to perceive meaning in what we do. Brands allow us to imbue our actions with a sense of added significance. Simple decisions—such as the jeans we wear or the beer we drink—become opportunities for self-expression, for adding symbolic significance to an otherwise functional decision.").

226. T.J. Jackson Lears has suggested that many consumers cannot help but get caught up in these fantasies:

No doubt many ordinary [twentieth-century] Americans refused to embrace this world [of advertising] literally, but they were drawn into it for its entertainment value—the sensual appeal of its illustrations, the seductiveness of basking (however briefly) in the promise of self-realization through consumption. Many advertisements took their place along side other mass diversions—the amusement park, the slick-paper romance, the movies. None demanded to be taken literally or even all that seriously; yet all promised intense "real life" to their clientele, and all implicitly defined "real life" as something outside the individual's

C. *The Symbolic Value of Geography*

Geographic associations are a powerful tool for marketers. Advertising the place where a product was made “can provide interest, energy, and differentiation to a target brand.”²²⁷ It conveys a sense of local pride and the promise of a unique experience. When goods come from a region with a reputation for quality, the benefits are obvious.²²⁸ Yet the symbolic value of geography may be a more important factor in marketing than anything specific one can deduce about the goods by knowing where they were made.²²⁹ For example, few consumers could say how linens made in Ireland differ from linens made in Vietnam, even if local materials or production techniques did set them apart. But one suspects that the *feeling* of tradition associated with Ireland, which may have more to do with castles and meadows than with textile manufacture, would make Irish linens more valuable to some consumers than Vietnamese linens. Famous place names are charged with ready-made associations, ripe for exploitation by marketers. They are a shortcut to the better world of displaced meaning. By invoking the name of Ireland, a marketer can immediately conjure up a host of images useful in “positioning” a product in the symbolic landscape.

That is why famous geographic names, at least those with marketable associations, are so tempting to borrow. For example, by naming its domestically produced cookies after such old-world cities as Brussels, Milan, and Bordeaux, Pepperidge Farm—an American brand evoking an image of old-fashioned rural wholesomeness—acquires an extra dimension of symbolism.²³⁰ Indeed, the packaged food industry is particularly conscious of the benefits of association with remote lands and cultures. As Marc Gobé writes with reference to naming and packaging:

everyday experience.

Lears, *supra* note 190, at 28.

227. DAVID A. AAKER, BRAND PORTFOLIO STRATEGY: CREATIVITY, RELEVANCE, DIFFERENTIATION, ENERGY, LEVERAGE, AND CLARITY 179 (2004).

228. *Id.* at 179 (noting that associating a brand with a region that has the “heritage of making the best within that product class” adds the benefit of “credibility”); SIDNEY J. LEVY, *Marketing Stages in Developing Nations* (1991), reprinted in BRANDS, CONSUMERS, SYMBOLS, & RESEARCH 164, 169 (Dennis W. Rooked ed., 1999) (“There is the kind of general reputation for optical equipment associated with Germany, perfume and wine from France, linen from Ireland, woolens from Scotland, and so on, as shown in many studies of imagery and countries of origin.”); Simon Anholt, *Branding Places and Nations*, in BRANDS AND BRANDING, *supra* note 20, at 213, 215 tbl.14.1 (“A powerful, distinctive, broad-based and appealing national brand is the most valuable gift which a country or region can give to its exporters: think what ‘Made in Japan’ does for electronics, or ‘Made in Italy’ for fashion.”). In marketers’ lingo, some regions are said to “own” a product category. See Knowles, *supra* note 196, at 46-47 (“Japan owns consumer electronics, Germany owns engineering prowess, France owns fashion and luxury goods, Spain and Italy own passion, and the US owns information technology, entertainment and mass consumerism.”).

229. AAKER, *supra* note 227, at 179.

230. See GOBÉ, *supra* note 193, at 212 (suggesting that the names of Pepperidge Farm cookies lead consumers to view them as “international delicacies, inciting our imaginations and taste buds”).

Some products gain enormous credibility if they are associated with a specific culture. Russian vodka is still the authentic one, and we would have a hard time buying Irish pasta—even if it were the best in the world! Hershey's Ronzoni pasta brand communicates with its graphics and packaging the authenticity of an Italian product. The old-world typography and décor pictured is clearly European, and the name Ronzoni places the brand in the geographic area of the known specialists. Häagen-Dazs has a Scandinavian name even though it is made in New Jersey. Godiva, owned by Campbell's Soup, still trades on its original European aspirational image with stores and packaging styles that reflect the elitist nature of European gourmet foods. Most mustard preparations reflect a French heritage.²³¹

Note Gobé's use of "credibility" and "authenticity" in this passage. In a literal sense, the products seeking those qualities have no claim to authenticity if they are not produced in the place their marketing evokes. Yet Gobé does not find the practice deceptive or manipulative:

*I doubt that anybody is really duped by these marketing efforts. Instead we are enticed by and want to participate in these aspirational stories which are more fun than a generic, utilitarian product experience because they help us to dream. Most people are quite willing to let Ronzoni pasta be "Italian" in their minds!*²³²

In other words, evoking a sense of place adds value to the product, even if the link is only imaginative. It *feels* more authentic.

Many of the geographic trademarks challenged as deceptive or deceptively misdescriptive are chosen, at least in part, in order to borrow a sense of style associated with a fashionable place.²³³ For example, the name "Hotel Monaco," adopted by a California corporation and challenged in *In re Kimpton Hotel & Restaurant Group, Inc.*,²³⁴ alluded to the principality of Monaco, a place known for its luxurious hotels and casinos. The San Francisco hotel underscored the implied European connection with architecture, paintings, furnishings, and accessories in the French or European style.²³⁵ The brochure promised to transport guests, in their imaginations, to a better place:

With its French-inspired architecture and sensually rich décor, the newly restored Hotel Monaco is very clear in its intentions. The idea is to seduce and pamper—to surround guests with a sense of escape to far away places, and to do it in the style to which the savviest of travelers have become accustomed.²³⁶

231. *Id.* at 216.

232. *Id.*

233. Referring to the use of famous artworks in advertising, James Twitchell refers to "value by association, what in advertising is called borrowed interest"—a suggestion that juxtaposition alone accomplishes transfer of meaning. TWITCHELL, *supra* note 199, at 43; *see also id.* at 186 ("When you want to borrow value for an object, you insert it near objects already certified as valuable. Value leaks.").

234. 55 U.S.P.Q.2d (BNA) 1154 (T.T.A.B. 2000).

235. *Kimpton Hotel & Rest.*, 55 U.S.P.Q.2d (BNA) at 1156.

236. *Id.* at 1156 n.2.

Nevertheless, the TTAB found sufficient evidence that guests would take the name “Monaco” literally and believe that the hotel had more than metaphorical connections to the principality.²³⁷

In *In re Fashion Group*,²³⁸ an Italian clothing manufacturer adopted the name “NoLIta,” a reference to a fashionable shopping district (North of Little Italy) in New York City.²³⁹ The manufacturer argued that it did not intend to conceal the Italian origins of its goods.²⁴⁰ Italy has a strong reputation for stylish clothing. Nevertheless, the PTO rejected the application for a “NoLIta” trademark, finding both a sufficient goods/place association to mislead consumers as to the origin of the clothing,²⁴¹ and the element of materiality necessary to satisfy the *In re California Innovations*²⁴² standard of deception.²⁴³

On the other hand, in *In re Jacques Bernier*,²⁴⁴ the Federal Circuit reversed the TTAB’s rejection of “Rodeo Drive” as a mark for perfume that was neither manufactured nor sold on Beverly Hills’ fashionable street.²⁴⁵ In this case, the court found no evidence that any consumer would take Rodeo Drive as a literal indication of origin.²⁴⁶ The cases may be distinguishable. Consumers may take NoLIta for clothing more literally than they would take Rodeo Drive for perfume. But in each case the manufacturer’s intent was probably the same: to position its product with certain stylish associations. Other trademarks evoking places better known for vacation travel than for manufacturing—for example, Nantucket²⁴⁷ and Sea Island²⁴⁸—fall in the same category.

237. *Id.* at 1158.

238. 2004 TTAB LEXIS 688 (T.T.A.B. Dec. 3, 2004) (nonprecedential opinion).

239. *In re Fashion Group*, 2004 TTAB LEXIS 688, at *4-6.

The evidence submitted by the examining attorney shows that the neighborhood known as “NoLIta” is associated with various things: narrow streets and smaller buildings than in nearby neighborhoods, which mean less vehicle traffic; easy pedestrian access to boutiques and specialized shops and cafes; and that the boutiques and shops may market clothing, shoes, jewelry, handbags, cosmetics, or housewares.

Id. at *23-24.

240. *Id.* at *7 n.4.

241. *Id.* at *24.

The record in this case establishes much more than a tenuous connection between “NoLIta” and clothing items. Instead, the record establishes that clothing designers are concentrated in the neighborhood and that it is known for its trend-setting and unique clothing boutiques. Some of the evidence speaks directly to consumers’ recognition that “NoLIta” is noted for its fashionable clothing.

Id. at *27.

242. 329 F.3d 1333 (Fed. Cir. 2003).

243. *In re Fashion Group*, 2004 TTAB LEXIS 688, at *29-30; *see also In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1337 (Fed. Cir. 2003) (stating that a deceptively misdescriptive mark must materially impact consumers’ decision to buy goods).

244. 894 F.2d 389 (Fed. Cir. 1990).

245. *In re Jacques Bernier*, 894 F.2d at 390-91.

246. *Id.* at 391.

247. *In re Nantucket, Inc.*, 677 F.2d 95, 106 (C.C.P.A. 1982) (Nantucket shirts); *In re Nantucket Allserve*, 28 U.S.P.Q.2d (BNA) 1144, 1145 (T.T.A.B. 1993) (Nantucket Nectars).

If it is true that traditional “features and benefits” marketing is giving way to more emotional appeals, one could expect a trend away from the use of place names in a literal sense and toward their use to evoke a range of feelings and associations. Moreover, as businesses become more complex and geographically dispersed, the place of origin for goods, in any literal sense, becomes more elusive. A soft drink might be bottled in America, under the authority of a company headquartered in Britain, using ingredients supplied from Canada and a recipe developed in France. Would it be descriptive or misdescriptive to describe that product as American, British, Canadian, or French?²⁴⁹

Some geographic names already stand as much for an idea as for a place. “Hollywood” means the motion picture industry;²⁵⁰ “Cooperstown” means the Baseball Hall of Fame.²⁵¹ Perhaps, in time, consumers will come to interpret all geographic allusions less literally. Perhaps they will interpret “Monaco” more often as a symbol or a theme than as a literal place of origin that might suggest something distinctive about the goods. This treatment is, at least, a possibility, and one that current trademark law, in its literal-mindedness, may be ill equipped to address. In Part IV, I consider how geographic trademarks interpreted symbolically might be treated under current law and whether anything further should be done to restrict such uses.

248. *Sea Island Co. v. Kroehler Corp.*, 2005 TTAB LEXIS 158, at *49 (T.T.A.B. Mar. 31, 2005) (nonprecedential opinion). In *Sea Island*, a furniture manufacturer named its collections after various picturesque localities, including Savannah, Santa Fe, and Carmel. *Id.* at *25. The American Signature Sea Island Collection, named after an exclusive resort community, was “[i]ntended to evoke a casual, carefree style of living.” *Id.* at *26. Curiously, the party opposing registration of the trademark challenged “American” rather than “Sea Island” as the geographically misdescriptive term. *Id.* at *48-49.

249. Courts have already faced the difficulty of pinning services to a specific geographic location. In *In re Les Halles*, 334 F.3d 1371 (Fed. Cir. 2003), the Federal Circuit extended the *In re California Innovations* standard of materiality for a geographically deceptively misdescriptive mark to services—in this case, kosher restaurants named “Le Marais” after the Jewish quarter of Paris. *In re Les Halles*, 334 F.3d at 1374-75. Clearly, patrons of the New York Le Marais restaurant would know they had not been transported to France. They might believe, however, that “the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris, or that the New York menu is identical to a known Parisian menu,” or that some other literal connection with Paris explained the Parisian name. *Id.* at 1374. Any mistake of this kind, if caused by the name “Le Marais,” might render the trademark deceptive. Similarly, in *In re Consolidated Specialty Restaurants, Inc.*, 71 U.S.P.Q.2d (BNA) 1921 (T.T.A.B. 2004), the TTAB rejected the name “Colorado Steakhouse” for restaurants located in Indiana and Illinois and serving steaks from places other than Colorado. The applicant argued that the name “Colorado” accurately described the origin of the style or atmosphere offered by the ski-lodge-themed restaurants. *In re Consolidated Specialty Rests.*, 71 U.S.P.Q.2d (BNA) at 1925. The TTAB found consumers might take “Colorado” to be a literal reference to the source of the meat served at the restaurants, a conclusion reinforced by evidence that Colorado is known for the quality of its beef. *Id.* at 1927-28. Whether consumers would or would not take the geographic reference as literally as the TTAB supposed, the difficulty is plain: The services supplied by a restaurant may have many origins. The same is increasingly true of products.

250. *In re Int'l Taste, Inc.*, 53 U.S.P.Q.2d (BNA) 1604, 1605 (T.T.A.B. 2000).

251. *In re Mun. Capital Mkts. Corp.*, 51 U.S.P.Q.2d (BNA) 1369, 1371 (T.T.A.B. 1999).

IV. REGULATING THE USE OF GEOGRAPHICALLY EVOCATIVE TRADEMARKS

If a court were to consider the registrability of the name “Tucson” as a trademark for Hyundai’s SUV, it would attempt to place the mark on the spectrum of distinctiveness discussed in Part II.²⁵² “Tucson” is not generic for automobiles, nor is it fanciful in the sense that it was coined by Hyundai for use as a mark. It might be categorized as arbitrary, suggestive, descriptive, or misdescriptive. Assuming that the product has no literal connection with Arizona eliminates descriptive. Under the standard of *In re California Innovations, Inc.*,²⁵³ the mark could be considered misdescriptive if consumers would believe that the product came from Tucson (because of a known association between Tucson and automobiles) but could be denied as *deceptively* misdescriptive only if consumers were moved by their misconception to purchase the vehicle.²⁵⁴ Let us assume, for purposes of argument, that Arizona is not associated with automobile manufacturing. The mark could not be classified as arbitrary on grounds of obscurity; for most consumers, the name “Tucson” should have geographic significance.

By the process of elimination, a court would likely categorize the mark as arbitrary or suggestive. The name “Tucson” is not “connected with the goods” in any literal sense, but it is not arbitrary in the same way that “Alaska bananas” is arbitrary.²⁵⁵ The name is not meaningless. It conjures up a host of associations, based on all of the impressions and memories that would come to mind, or stir in the subconscious, of consumers who have heard of Tucson, Arizona. Indeed, those associations might influence consumers to choose the vehicle, even if they know perfectly well that the Tucson SUV was made somewhere else. Agencies would not be paid large sums to devise brand names if manufacturers did not believe that the names made a difference, and one can be sure that Hyundai would not have considered “Cleveland” or “Milwaukee” equally suitable. “Suggestive” might seem the most fitting category, but putting “Tucson” there would group it with marks that are descriptive by indirection—like “Downy,” which suggests the softness of clothes treated with fabric softener. It would be difficult to say what specific characteristics “Tucson” suggests about the SUV. Although there is little doubt of the outcome—“Tucson” would almost certainly be granted registration—the analysis would suffer from the absence of a well-defined characterization of the trademark.

252. See *supra* notes 21-37 and accompanying text.

253. 329 F.3d 1334 (Fed. Cir. 2003). See *supra* notes 156-63 and accompanying text.

254. See *supra* notes 102-14 and accompanying text.

255. See *supra* note 130 and accompanying text.

A. “Evocative” Trademarks

Names like “Tucson” may demand a new category on the spectrum of distinctiveness—a category I will call “evocative” marks.²⁵⁶ An evocative mark might be defined as one that spurs meaningful associations without suggesting anything definite about the nature of the product.²⁵⁷ Trademarks may be evocative without being geographical—the name “Lincoln,” for example, evokes historical associations—but geographic names, because of their symbolic potency, would account for many evocative marks. How should such marks be treated? They would seem to fit most comfortably between arbitrary and suggestive marks. They are not as meaningless as arbitrary marks are assumed to be, but their exclusive appropriation is even less threatening to competition than the exclusive appropriation of suggestive marks. If no competitive need prevents “Downy” from being reserved as a trademark because competitors can still describe softness in literal terms or through other allusions,²⁵⁸ it would appear that evocative marks, even less definite in their message, would be fair game. Hence, one would expect an evocative mark, as I have described it, to be allowed trademark status without evidence of secondary meaning, whether or not a court or the Trademark Office troubled to draw the distinctions made here.

If the thought processes of consumers followed the logical progression often suggested by the courts,²⁵⁹ one could dismiss evocative trademarks as meaningless. Imagine a consumer, shopping for an SUV, who first encountered the Hyundai Tucson. Let us assume that he is familiar with the city of Tucson, Arizona. He would ask himself whether the mark is to be taken literally—in other words, was the vehicle manufactured, or possibly designed, in Tucson? He would search his memory for recollections of an automobile industry in Arizona. If nothing came to mind, he would conclude, correctly, that the SUV was not connected with Tucson. At that point, the name “Tucson” would play no further part in his decision making, even if he had positive thoughts about the city. It is unlikely, however, that this scenario fully accounts for the ways consumers process the messages conveyed through trademarks.

Let us imagine a more plausible consumer. This consumer, a Michigan resident, also desires an SUV. Perhaps it is the “rose-covered cottage” of her imagined better life. She pictures herself enjoying more travel and impressing her acquaintances with a concrete expression of a freer and more affluent lifestyle. Flipping through a magazine, she encounters an advertisement for the Hyundai Tucson. She has heard of Tucson, Arizona. If she were asked what Tucson brought to mind, she would mention that it was warm, open, out West

256. “Fictitious” could be an alternative characterization. See *supra* note 139 and accompanying text.

257. Arguably, any “arbitrary” mark drawn from an existing vocabulary—even “Alaska bananas”—brings with it a set of associations, regardless of the product with which it is connected. If this is the case, it might be best simply to rename the “arbitrary” category to reflect this and cease pretending that anything other than a coined trademark could be *truly* arbitrary.

258. See *supra* note 26 and accompanying text.

259. See *supra* Part II.B.

where she would like to travel, and a prosperous, fashionable place to be. But no one asks her that question as she reads the advertisement, so those associations hardly rise to the level of conscious thought. Nor does she ask herself where the vehicle is made. She may know that Hyundai is a Korean company, but automobile manufacturing is so internationalized that speculation about geographic origin, or what it might mean to the quality of the vehicle, is not what occupies her thoughts. Instead, she is imagining herself owning the vehicle, and the name “Tucson,” together with other messages delivered by the advertisement—text promising a generous warranty and a photograph of the vehicle speeding down a desert highway—help her to imagine owning the vehicle as the fulfillment of her dream. The name “Tucson” contributes to this emotional appeal.

Yet even if there is more to evocative trademarks than the traditional analysis allows, they can still be considered harmless. The promises made by an evocative trademark are too vague to be the cause of much disappointment. Indeed, they are so vague that it would be difficult to categorize the emotional message of “Tucson” as true or false. Probably few Tucson owners would be surprised to learn that the trademark is only a name, even if pointing that out might cause them to consider whether they had been manipulated. Most Tucson owners probably never give it a second thought. At the same time, no Hyundai competitors would have reason to complain that exclusive use of the term “Tucson” had denied them any significant opportunity.

Hence, the dominant themes of the trademark laws—protecting consumers from confusion and ensuring a competitive marketplace—are entirely consistent with permitting exclusive rights to evocative trademarks like “Tucson.” In fact, if consumers seek emotional fulfillment in the things they buy, evocative trademarks actually add value to products through the addition of positive associations. The Tucson delivers more satisfaction, perhaps, than it would if it were named the “Hyundai Model 3.” Why discourage a bit of constructive fantasy that harms no one? But there is a reason to hesitate. No one can claim a personal interest in the idea of “downiness,” unless it is other fabric softener manufacturers who, if “Downy” were a trademark, might be limited in their freedom to describe their own products. Tucson is another matter. People live there and take pride in their community. Businesses operate there and benefit from positive feelings about Tucson. They might resent other businesses encroaching on their “territory,” even if the invasion is purely symbolic.

B. Restrictions Modeled on the Right of Publicity

An individual whose identity has been exploited for commercial gain may bring an action to defend his “right of publicity,”²⁶⁰ a right that might provide a model for limiting the symbolic use of geographic terms. Originally grounded in

260. In the introduction to his treatise of the rights of publicity and privacy, Professor McCarthy describes the former, though now in its fourth decade, as “still a relatively raw and brash newcomer.” 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY*, at v (2d ed. 2000).

the common law right of privacy,²⁶¹ the right of publicity is now protected by statute in a number of states.²⁶² The right of publicity allows a famous person to object to, among other things, the unauthorized use of his name as a trademark.²⁶³ In some cases, preventing the unauthorized use of a celebrity's name serves the traditional trademark objective of protecting consumers from deception. For example, allowing a sporting goods manufacturer, without Tiger Woods's permission, to sell a line of "Tiger Woods" golf clubs might create the false impression that the product had been endorsed by the famous athlete. There are other mechanisms, however, such as an action under section 43(a) of the Lanham Act, for dealing with such confusion.²⁶⁴ The right of publicity may be violated even where there is no false impression to remedy, perhaps because the otherwise misleading use of the famous name has been counteracted with prominent notices denying the celebrity's sponsorship or approval.²⁶⁵

In such cases, the rationale for barring the unauthorized use is more difficult to articulate. The best theories focus either on a visceral feeling of unfairness associated with the commercial exploitation of someone else's hard-won fame,²⁶⁶ or the concern that unauthorized exploitation will deny the celebrity an important source of compensation, thereby undermining the financial incentive to become famous.²⁶⁷ Neither theory is unassailable. The first depends on an emotional reaction that some do not share. When celebrities benefit, financially

261. William Prosser identified the right of publicity as one of the four distinct causes of action hitherto grouped under the general common law heading of privacy. See William Prosser, *Privacy*, 48 CAL. L. REV. 383, 401-07 (1960) (describing common law rights against invasion of privacy and against appropriation of identity).

262. See, e.g., CAL. CIV. CODE § 3344(a) (West 1997) (stating that one who uses another's "name, voice, signature, photograph, or likeness" on goods for "advertising or selling," without consent, is liable for resulting damages).

263. The right of publicity may also prohibit the use of other identifying characteristics, such as an individual's voice or likeness, to promote a product. California Civil Code section 3344(a), for example, encompasses the unauthorized use of an individual's "name, voice, signature, photograph or likeness." *Id.*

264. See 15 U.S.C. § 1125(a) (2000) (establishing civil liability of those who use confusing or deceptive marks conveying a "false designation of origin, false or misleading description of fact, or false or misleading representation of fact").

265. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 231 (1993).

266. See 1 MCCARTHY, *supra* note 260, § 2.2 (describing right of publicity as "self-evident natural right" grounded on "visceral impulses of 'fairness'"). But see *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 975 (10th Cir. 1996) (discounting McCarthy's analysis as a "blind appeal[] to first principles [that] carr[ies] no weight in our balancing analysis").

267. 1 MCCARTHY, *supra* note 260, § 2.6. In contrast to other causes of action relating to "privacy," the right of publicity has little to do with avoiding embarrassment. Usually those who sue to defend their right of publicity are pleased by public exposure; they simply wish to be paid for it. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) ("[I]t is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.").

and otherwise, through their constant exposure to the public eye, it is perhaps not unfair to treat their identities as a part of the cultural commons, so long as consumers are in no way deceived. The second theory suffers from practical limitations. Some people become famous without effort, or through acts that society would not wish to encourage.²⁶⁸ Even celebrities who deserve some reward often receive more than enough compensation through other sources. Sports figures and movie stars, for example, are so highly paid for their services that the additional revenue achieved by enforcing the right of publicity could not be expected to alter their behavior.²⁶⁹ Yet, in spite of these objections, the right of publicity, for famous individuals, is now firmly established as an independent branch of intellectual property law.

A parallel "geographic right of publicity" might be devised, barring the unauthorized exploitation for commercial gain of the name of a famous place, even if no consumer would be misled into believing that the product had been produced there. This would make trademarks like "Hyundai Tucson" or "Nantucket shirts," clearly meant to exploit the positive images of famous places, subject to attack.²⁷⁰ Those who regard as self-evident the exclusive right of an individual to market his own identity, or who bridle at the injustice of profiting from another's fame, might conclude that geographic restrictions are equally justified. Why should Hyundai profit from goodwill that it did not earn? In this case, however, the issue of fairness is more elusive. If a region owed its positive aura entirely to the labor of its inhabitants, it might seem unjust for outsiders to appropriate that value. If Monaco, for example, had positive associations for travelers because of the efforts of local businesses to pamper tourists, perhaps no San Francisco hotel would be justified in exploiting Monaco's goodwill, even through a strictly imaginative association. But many locations have symbolic value because of attractive scenery, historical associations, literary connections, or other phenomenon from which the residents benefit, but for which they cannot claim credit.

Moreover, even the benefits of an earned reputation are enjoyed by some local residents who did nothing to contribute. A newly opened boutique on Beverly Hills' Rodeo Drive would benefit from the neighborhood's reputation for stylishness. Such local businesses are no less "free riders" than businesses that appropriate a place name without locating their business there. Consequently, the unequal treatment of residents and outsiders, equally undeserving of the benefits of regional goodwill, might in the end seem more unfair than the current situation. One answer might be to require *any* business to

268. See, e.g., *Maritote v. Desilu Prods., Inc.*, 345 F.2d 418, 419-20 (7th Cir. 1965) (dismissing action brought by administratrix of Al Capone's estate, alleging misappropriation of his name, likeness, and personality, since appellants were not "named or referred to" in broadcasts in question and since broadcasts occurred more than one decade after death of Capone).

269. See *Cardtoons*, 95 F.3d at 974 ("[T]he inducements generated by publicity rights are not nearly as important as those created by copyright and patent law.").

270. An immediate difficulty would be identifying the appropriate plaintiff. For practical reasons, local governments, which could best represent the interests of the entire community, seem best suited to assert rights associated with a place, rather than an individual.

pay a license fee to the community (e.g., the city of Tucson) to secure the right to use the name. Then residents and outsiders would be treated equally, and all could claim some contribution to the community through, if nothing else, their license fee. One could expect considerable resistance from local businesses, however, and the “fairness” of requiring such a fee is less than obvious, even if it could be worthwhile as a source of revenue.

The economic incentives rationale, often problematic in the case of an individual’s right of publicity, would be at least as dubious here. It presupposes that the fame and good reputation of places turns on the investments of residents, rather than accidental factors, such as the natural setting, over which they have no control. Even if local investments did matter, it would be difficult to devise any scheme that would return the value of those investments, as reflected in the positive image of the region, to the particular individuals who had earned it. Finally, one can just imagine that a person like Tiger Woods would see his dreams of fortune significantly reduced if businesses could use his name to attract attention without paying him for the privilege. But it is most unlikely that denying Tucson, or any other place, the revenue that might be generated through a community-based right of publicity would cause the inhabitants to scale back their efforts and investments and languish in comparative obscurity. Thus, while it is not too far-fetched to contemplate a geographic right of publicity—in the field of intellectual property, new rights are frequently discovered—the rationale for such a right would be debatable.

C. *Restrictions Modeled on Trademark Dilution*

An alternative approach to limiting the symbolic use of geography could rely on the concept of “dilution,” a comparatively recent addition to the lexicon of trademark law.²⁷¹ Whether similar trademarks pose a likelihood of confusion often depends on whether the products on which they appear are similar or different.²⁷² Consumers might conclude, incorrectly, that Lipton Coffee is made by the producers of Lipton Tea because the products are similar enough to infer a connection. But even if there is no confusion, a famous trademark may be diluted by its use on a product of a different kind—Buick Aspirin or Kodak Pianos.²⁷³ One kind of dilution is tarnishment by the association of the famous trademark with goods that are inferior or distasteful.²⁷⁴ Another form of dilution is blurring—the loss of distinctiveness, an impact said to occur when a trademark

271. The addition of section 43(c) to the Lanham Act established a federal remedy for the dilution of famous trademarks. 15 U.S.C. § 1125(c) (2000).

272. Courts consider a number of factors in determining whether there is a likelihood of confusion, one of those factors being the similarity of the products. *E.g.*, *Polaroid Corp. v. Polaroid Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (referring to the “proximity of the products”).

273. *See Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (noting that House Judiciary Intellectual Property Subcommittee reports provided Buick Aspirin and Kodak Pianos “[a]s examples of dilution”).

274. *Id.* at 431-32.

is overused, even on dissimilar goods.²⁷⁵ If “Tiffany,” for example, were used on all manner of products unrelated to the jewelry store, the uniqueness of the name and its prestige would be gradually reduced, even if in no particular instance would consumers believe that the latecomers were associated with the original.²⁷⁶

If the theory that protects trademarks like “Tiffany” from overexposure is correct, a similar destructive effect could be predicted from the indiscriminate use of famous geographic names. As commercial interests adopt the names of famous places in order to borrow their positive associations, those associations may gradually erode. A name like “Yosemite,” for example, which immediately conjures up images of spectacular natural scenes, might do so less readily if we routinely encountered Yosemite motorcycles, Yosemite cereal, Yosemite jeans, and Yosemite soap. The meaning of “Yosemite” would be changed and its emotional appeal subverted.

Restrictions on the use of famous individuals’ identities can be defended as proof against a “tragedy of the celebrity commons,” wherein a celebrity’s fame is exploited so often that, through overexposure, it ceases to have any value.²⁷⁷ Michael Madow questioned the premise that sheer repetition devalues celebrity; a Madonna T-shirt, he argued, might be worth *more* precisely “because ‘everybody’s got one.’”²⁷⁸ In the context of geographic references, the argument may be stronger. The places that resonate with consumers may do so because they are perceived as unspoiled or exclusive. The unlimited commercialization of those places (or, at any rate, of the names of those places) may detract from the very associations responsible for their emotional appeal. Madow also questioned whether celebrity should be treated as an exhaustible resource. If the value of one celebrity’s identity was bled dry, advertisers could always resort to a “fresh face.”²⁷⁹ But the atlas of culturally or emotionally significant places may not be as limitless as the Who’s Who of individual celebrity, and even if it were, the idea of spoiling one place before moving on to another is no more attractive in a symbolic than in a physical environment.

The injury would not be confined to those who actually live or do business in the affected places. In a sense, the injury would be to anyone for whom the place once held a different meaning. In *The Culture of Consumption*, T.J. Jackson Lears describes how the efforts of advertisers to manipulate emotions lead them “to a nether realm between truth and falsehood.”²⁸⁰ They promise

275. See *Savin Corp. v. Savin Group*, 391 F.3d 439, 449 (2d Cir. 2004) (defining dilution by blurring as “the gradual diminution or whittling away of the value of the famous mark by blurring uses by others” (quoting 3 MCCARTHY, *supra* note 16, § 24:94)).

276. See 15 U.S.C. § 1125(c) (providing that in action for dilution, owner of famous mark need not prove likelihood of confusion).

277. Madow, *supra* note 265, at 220-21.

278. *Id.* at 222.

279. See *id.* at 224 (noting that “[b]ecause celebrity is a societal creation,” when one celebrity’s status is no longer exploitable, there will always be newly created celebrities to exploit (quoting Tim Frazer, *Appropriation of Personality—A New Tort?*, 99 LAW Q. REV. 281, 303 (1983))).

280. Lears, *supra* note 190, at 21.

consumers “relief from feelings of unreality” but exacerbate such feelings “by hastening what the French sociologist Henri Lefebvre has called ‘the decline of the referentials’—the tendency, under corporate capitalism, for words to become severed from any meaningful referent.”²⁸¹ Lears discusses the depreciation of overused words such as “revolutionary” and “personality.”²⁸² Similarly, when companies selling goods that lack prestige try to gain it by appropriating the name of a culturally significant locale, the name of a special place ends up referring to not-so-special goods. Thus, the landscape of advertising can “acquire[] an Alice-in-Wonderland quality,”²⁸³ in which the least exclusive products may bear the most exclusive names, and the efforts of advertisers to “help us dream” (about their products) may undermine our dreams in the end.²⁸⁴

These effects might be slowed either by prohibiting the registration of geographic names as trademarks except when they are literally descriptive, or, more directly, by requiring the approval of some licensing authority before they could be exploited commercially. This would, however, prompt a number of objections. First, it would raise geographic names above other culturally significant references that might suffer in similar ways through associative advertising. When Ford adopted “Mustang” as its trademark, or General Motors “Saturn,” those terms lost some of their original significance. On the other hand, perhaps geographic allusions are particularly meaningful and their appropriation particularly damaging—something that the special treatment traditionally given to geographic terms used as trademarks would support. The more fundamental problem is the likely futility of attempting to control, though trademark laws, the complex processes through which meaning is created.

Although it is often the case that marketers appropriate meaning from culture and turn it to commercial uses, it would be oversimplifying to view the movement as unidirectional. Like it or not, marketing is a part of culture itself, and the stories it tells are some of the most ubiquitous, indeed unavoidable, ingredients of our intellectual and emotional environment.²⁸⁵ Marketing takes from culture, but contributes to it as well. A famous example is the modern image of Santa Claus, shaped through images developed by the Coca-Cola Company in advertising designed to associate soda consumption with the cold winter months.²⁸⁶ Part of the meaning one attempted to protect from the cheapening effects of advertising might owe its very existence to advertising.

Some places hold meaning for individuals because of what they, as individuals, have experienced there. The attachment felt to one’s hometown may fall in that category. But it is safe to say that the most widely held meanings are the products of culture. People who have never been to Las Vegas, Beverly Hills, or Cape Cod have strong impressions of those places because of the stories they

281. *Id.*

282. *Id.*

283. *Id.* (referring to general tendency in advertising for words to lose their meaning).

284. See *supra* notes 216-19 and accompanying text.

285. TWITCHELL, *supra* note 199, at 2-3, 16-18.

286. *Id.* at 175.

have heard, and the images they have been presented, over the course of their lives. These stories and images determine what these places symbolize. Travel writer Paul Theroux described the literary baggage that could distort visitors' perceptions of places in Britain.²⁸⁷ Even for people who had not read R.D. Blackmore's *Lorna Doone*, the novel invested the place where it was set with a special significance.²⁸⁸ Perhaps some places have meaning because marketing has created or reinforced it. Perhaps selling a Tucson SUV and implying that "Tucson" is a name to be reckoned with actually generates prestige for the city. Proving otherwise would be impossible.²⁸⁹

V. CONCLUSION

Trademark law in the United States has too much ignored the powerful symbolic uses of geography in marketing goods and services. Its focus on the informational use of geographic terms, whether to instruct or to mislead, overlooks what may be the most compelling reason to evoke geography in choosing a trademark—the opportunity to enhance the allure of the product by associating it, loosely and nondescriptively, with a meaningful place. Marketers have long been aware of the selling power of fantasy, and, as functional differences between products become less significant,²⁹⁰ increasingly the role of geographic references in trademarks will be to position the product not in the physical landscape of geographic origins but in the symbolic landscape of imagination.

When the symbolism of place is appreciated as a valuable marketing tool, one has to ask whether it should be available to anyone or whether the right to evoke geographic associations should be limited to those whose products actually come from those places. One could justify restrictions on the symbolic use of geographic names by economic arguments focusing on "free rider" externalities or on the corrosive effects of overexposure. Moral arguments have a place as well. Without a doubt, marketers have exploited and subverted the cultural significance of geography for their own profit-motivated reasons. A "geographic right of publicity" or protections against "geographic symbolic dilution" would appeal to many.

287. See PAUL THEROUX, *KINGDOM BY THE SEA* 343 (1983) ("[A]liens usually missed the point about England by investing its landscape with the passions of its great literature, and it had so seldom been seen plainly, without literary footnotes.").

288. See *id.* at 128 ("No one here had read *Lorna Doone*, but that didn't matter, because the district had already been hallowed by it, and now it was seen in a kind of blurred and respectful way. How could you possibly disparage a place that had inspired a famous novel?").

289. The same argument might be made with respect to famous trademarks. Perhaps borrowing those marks for use on vastly different products works as an homage to the original. Consumers might actually think better of Kodak cameras if a piano manufacturer paid tribute by adopting the same name. Yet, dilution laws assume a contrary effect. See *supra* notes 271-79 and accompanying text for a discussion of the possibility of marks becoming diluted when they are indiscriminately used to represent a wide variety of products.

290. See *supra* notes 193-99 and accompanying text.

Yet, I am inclined to agree with Michael Madow, who wrote that “property rights in our culture’s basic linguistic, symbolic, and discursive raw materials should not be created unless a clear and convincing showing is made that very substantial social interests will thereby be served.”²⁹¹ The shared meaning of geography is one of those cultural “raw materials.” However well-intentioned, attempts to preserve meaning by restricting cultural discourse, even commercial discourse, are a dangerous undertaking.

Meanings inevitably evolve. As businesses evoke and recode geography—enhancing, embroidering, reinforcing, or redirecting meaning—perhaps they are not exploiting culture but extending it. Perhaps they even improve our lives by adding a dream-like significance to our possessions. One can easily exaggerate, or overromanticize, in attacking such practices or in defending them. In the end, it is difficult to say whether life is cheapened or enriched by this kind of metaphorical discourse in the commercial sphere. Hence, while it is important that the law acknowledge the symbolic dimension of geography more candidly than it has, it is doubtful that restrictions on geographically evocative trademarks would produce the clear benefit we seek.

291. Madow, *supra* note 263, at 239.

