



Forensic Linguistics and Trademark Infringement

Ahmed Nouredine Belarbi

**Department of English , faculty of Letters & Languages , Kasdi
Merbah Ouargla University**

blrbhmd@gmail.com

Reçu le: 02-12-2019

Accepté le: 18-05-2020

Abstract -

Trademark infringement, notwithstanding its importance as a motive of action in trademark regulation, has not unfortunately been as sufficiently as should have been in the linguistic area and particularly in forensic linguistics.

We try through this paper shed light on the contributions of forensic linguistics in an attempt to identify how do forensic linguists deal with linguistic issues related to the law.

We also aim at defining the different methodologies by which forensic linguists may be of help in such trademarks disputes .

Keywords -

Infringement . Forensic linguistics. Trademark. Ownership. Product.

المخلص -

إن مسألة انتهاك العلامة التجارية و على الرغم من أهميتها كدافع مهم لتنظيم العمل القانوني للعلامات التجارية ، لم تلق للأسف الشديد القدر الكافي من الاهتمام كما ينبغي أن يكون في اللسانيات وخاصة في اللسانيات القضائية.

نحاول من خلال هذه الورقة إلقاء الضوء على مساهمات اللسانيات القضائية و ذلك لتحديد كيف يتعامل اللسانيون القضائيون مع القضايا اللسانية المتعلقة بالقانون.

نهدف أيضاً إلى تحديد المنهجيات المختلفة التي ساهم بها اللسانيون القضائيون في فهم نزاعات العلامات التجارية و تقديم يد المساعدة للقضاة بشأنها.

الكلمات المفتاحية -

مخالفة . لسانيات قضائية . علامة تجارية . ملكية . منتوج

Language is in everything and everything cannot be expressed and transmitted without language; it is deemed nothing without. In this regard, a word uttered or written down can be of critical importance when is taken from its functional and pragmatic dimension. One of the most recent issues that is more and more given deeper attention at the forensic linguistic level is the trademark dilution or infringement. This issue is totally ignored in the Algerian context though practiced and frequently seen. However, in this paper, we try check the way forensic linguistics deals with such a forensic (linguistic + legal) issue and how has contributed to better understand it.

It is justifiable that such an issue is examined at courts as Goodwin says “Lawyers’ training, concepts, and content cause them to think about and deal with categories such as trademarks, product liability, contracts, wills, copyrights, defamation, bribery, murder, and other types of cases that they learned in law school”. He added that linguists in the other hand deal with or think about the linguistic

categories of syntax, phonology, semantics, speech acts, discourse analysis or dialects in the same way linguists think about and use them. The forensic linguist is one in two ; they do combine the lawyers' task to the linguists' analysis and examination to identify the linguistic dimension legally and that is why linguists have to begin with (and first learn about) the way lawyers think, their language, their assumptions, and even their professional vision. (Goodwin, 1996, p. 606)

Trademark: the first thing that we all notice before we buy anything is their trade marks; there are some which globally known and other that are less known. Some of the new products or services prefer be at reach by just imitating or simply taking the famous and globally known trade mark , making them more visible and hence good sellers. But what is legally this mark? “It is a recognizable insignia, phrase, word, or symbol that denotes a specific product and legally differentiates it from all other products of its kind. A trademark exclusively identifies a product as belonging to a specific company and recognizes the company's ownership of the brand.” We take as an example the word (Aljazeera) the way it is written in Arabic. Whenever we see its logo or we read its title, we directly thing of the information institution in Qatar or any other related to it. Here in Ouargla for instance we have a lot of shops with this very logo and all work within the same field “ Sat and sports”. (Carla, 2019)

The trade mark distinguishes a given product from other ones and makes it easy to identify. It also associates a given service for instance to a given function and hence facilitates choosing for the clients . In this regard , this mark has functions to do that we may cite herein

Functions of the trade marks

Trade marks do play a primordial role in the marketing dimension ; they usually are the first thing the clients meet when decide to buy . The roles can vary according to the context and the function. However , we can put all of them in two main functions:

Distinctive associating functions : Blacketts sees the trademark as “ a distinctive sign associating and distinguishing of a product or service that indicates its commercial origin” (Blackett ,1998, p.1) .By distinctive we mean that a product or service is distinguished from other ones by simply being related to a given mark. Associating , in the other hand is seen when a given product is

associated to a particular field or area being associated to a mark. When we say “ It is a sony product” , we straightforward think of an electronic and or electric device.

Protecting function

Trademark law tries to protect the owner of the mark from “referential confusion” (Tiersma, 1999,p. 121). We all prefer ,when think to buy an electronic device for instance, choose a good reliable mark as *SONY* the Japanese vision corporation , but in a world full of competeting rivals , we may find a lot of similar marks as in *SONNY* , *SOONY*, *SUNNY* or *SUNY* that try all deceive the clients in being the real *SONY* they look for . Unless the mark is lost through lack of use, the owners have a property right that is perpetual. Trademarks “play a central role in defining corporate personality through image-manipulation or ‘branding’” (Hutton, 2009,p. 121).

Strength of Trademarks

The invention or creation and designing of a trade mark is not simply an easy task as may be usually thought. A trade mark refers to a particular entity and hence should be better a unique distinctive one . This means , it should be that strong . This strength depends on how unique it is. The five categories of trademarks, from strongest to weakest, are:

1. Fanciful marks

Fanciful trademarks are made-up words that only mean something in relation to a particular product. This type of mark is the strongest because of its absolute distinctiveness. *GOOGLE* for online services, *ROLEX* for watches, and *XEROX* for copiers.

2. Arbitrary marks

Arbitrary trademarks are real words with a meaning that's usually connected with a different class of products. "Apple" is an arbitrary trademark, because it's a real word but the brand relates to computers, not fruit.

3. Suggestive marks

Suggestive marks are hinting made-up words that suggest a quality of the product. An example is Microsoft, that sells software for computers.

4. Descriptive marks

Descriptive marks aren't simply suggestive but actually describe the product or service. Companies can't register descriptive marks as

trademarks unless these have a secondary meaning. An example of a merely descriptive mark would be COLD AND CREAMY for ice cream

5. **Generic marks**

Generic marks are the weakest type of marks, and in fact, they can't be registered as trademarks in any case. Examples include names like Vaseline, Cellophane, Trampoline and Yo-Yo ("Generic Trademark: Everything You Need To Know", 2019)

Trademark categories

Trade marks are categorized as to function and influence to many other sub-categories :

Generic marks

According to Collins online dictionary "A generic is a product that does not have a trademark and that is known by a general name, rather than the manufacturer's name. " And since they are labeled with this general titles they are "often cheaper than products branded with the manufacturer's name".

It is mainly a term that is typically used as the emblem of the varieties of goods or services to which it is referring , but nobody can take them or use them as trademarks Those marks are of no legal protection and consequently can be adopted by anyone to describe their own goods they buy.

Examples can include a brand of shoes that someone would try to call "shoes" or a haircutting establishment that would be called barber (What is generic trademarks. .2012).

Category shift

Sometimes a given category that is actually deemed strong may be after a while change its category and may be exposed to dilution or loses its mark strength that has long enjoyed.

"Over time, a brand can be so famous and so ubiquitous that people associate that with the action," said Michael N. Cohen, an intellectual property lawyer in Los Angeles. "In everyday usage, people start using that term." (Whitson, 2019)

"When something becomes so pervasive in everyday society as a result of its own fame, there's an argument that it no longer represents the brand, it almost represents the action," Mr. Cohen said. "So as a result of that, in trademark law, you cannot trademark things that are descriptive or generic in nature."

Bayer Co. v. United Drug Co. was a seminal case in which Bayer lost its trademark for Aspirin to what experts now refer to as “genericide.” That 1921 case set the table for the modern standard that courts currently follow: If a brand name is understood by the public to refer broadly to a category of goods and services rather than a brand’s specific good or service, a company may be at risk of losing its trademark. Yoyo, cellophane, and Clinix have all lost their trademark status to genericide. (Whitson, 2019)

Genericide:

Once this mark is very strong and at reach of all and besides, used as a lexical word by those who buy it or those who have yet not, it loses this advantage and can be used by any as their trade mark! This phenomena is called by the specialists “genericide”, or the conversion of a trademark into a generic one. Legally talking, this happens when a given trade mark loses its commercial and marketing status and becomes a generic word as any other lexical word (common word). We can cite here some of the examples related to this type:

Examples of Genericide

We often use words that are now part of our common language but were born as trademarks.

A lot of words are originally trade marks that are now used as any lexical common word. Few examples of genericide are:

The trade mark	Its origin
Aspirin	Aspirin is a pain relief drug that contains acetylsalicylic acid. Bayer AG combined two German words and trademarked the term in 1917. Aspirin lost its trademark status in 1919, and now it's used in a generic way.
Cellophane	Cellophane is a made-up word that comes from the combination of "cellulose" and "diaphane" (transparent). Chemist Jacques E. Brandenberger trademarked the term in 1912. Cellophane is now a generic word in the USA but still holds its trademark status in other countries.
Escalator	Otis Elevator Co. trademarked the term in 1900. "Escalator" became a generic term when the USPTO ruled that Otis itself used the term in a generic way in its own patents.
Heroin	Bayer AG also trademarked the word heroin in 1898. The name of this drug comes from the German word for <i>strong</i> , "heroisch".
Linoleum	Frederick Walton, the Linoleum inventor, never trademarked its mark when he first created it in 1864. Genericide was fast: by the late 1870s, the term was already in common use.

Table 1: Examples of Genericide
("Generic Trademark: Everything You Need To Know" 2012)

If we apply what have already been said , we can also consider the trade mark "GOOGLE" as a generic one, for every body now days are using it as a lexical common word for any search of a something on the net. However, this mark is not forensically a generic element

In a very recent case before the Ninth Circuit, the court decided that "google" was not a generic term and hence was a trademark that should be protected by the law . This of course tells something : that though this trademark is commonly -used by all as both a noun or and verb, that does not make of it a generic one.

The Plaintiff, David Elliot, purchased more than 700 domain names with the word "Google" in them. After Google successfully won a domain name dispute, Elliot filed to cancel Google's trademarks. The district court dismissed the claims and the Ninth Circuit affirmed the dismissal.

("Court: 'GOOGLE' Not A Generic Trademark. Lessons Trademark Owners Should Learn About Genericide. 2017)

Descriptive marks

A descriptive trade mark is a given word that shows what a product is made for. It acts exactly like an adjective in giving details about the noun. If we take "SHARP" as an example , we can say that the tv set is qualified actually as a sharp one and this why it is said to be as such.

It is necessary for any trademark owner to become aware of what the mark is and even the how strong is it due to the fact descriptive mark are not entitled trademark protection and all of the advantages associated to it. A descriptive trademark is generally not a strong one at all because it describes the product or and the service being offered and or made by the producer and owner . (Hall, 2012)

Descriptive marks describe the qualities, ingredients, and characteristics of a product or service, such as SMARTTOWER merely descriptive of highly automated cooling towers. Since its name

is descriptive, the producer cannot prevent other cereal makers from using the same name. (for more details <http://merelydescriptive.com/examplesmerelydescriptive.html>)

Forensic linguists see descriptive marks as weak unless they become well known among consumers.

Suggestive marks

A suggestive trademark does often suggest the quality or nature of the products , but does not do it directly , it leaves this to the consumer's imagination and intelligence to get what is it and what is it for. We can mention here some examples of this type : (Netflix , Microsoft, KitchenAid, jaguar...etc) Netflix is related to the net , microsoft is related to softwares , kitchenAid is something used at kitchen and jaguar is more related to race and speed) ("Use your imagination: Suggestive trademarks" (2018)

Unlike descriptive marks , suggestive marks are more protected . Compared to fanciful or arbitrary suggestive trade marks are actually less protected . These latter suggest something other than the denotation of the words used as their marks. Besides , they came later than descriptive, fanciful and arbitrary in categorization and emergence.

A suggestive trademark distinguishes the products or the services it refers to but does not describe them at all ; it suggests or references it, making consumers to be more active in trying to depict it and links the mark with the product.

For more examples, consider the word "Penguin." If used as a descriptor in the name of a shop that specialized in the sale of accessories for cold weather pets, it could be descriptive. If it was used as part of the name of an air conditioning company, it could certainly be suggestive. As the name of a well-known publishing company, it's arbitrary.

("Generic Trademark: Everything You Need To Know", 2019)

Trademark dilution

Despite that the worries about the issue of the uniqueness of trade marks were expressed as early as 1927(Schechter ,1927), trademark dilution laws are relatively recent (The Federal Trademark Dilution Act of 1995; The Trademark Dilution Revision Act of 2006).

It is verily a bit difficult for the owner of an allegedly diluted mark to prove that such dilution has taken place, and that is why dilution is not mostly charged in trademark cases. Some unresolved issues are cognitive and linguistic in nature, including ways to measure what is meant by “similar,” how degrees of alleged dilution can be measured, and what role language context plays in making such distinctions (Shuy, 2003, p. 13.1-13.19).

Forensic linguists when examine the dilution in trade marks often ask three main questions and then work to answer them relying upon some forensic tools:

1_Do the marks sound alike?

2-Do they mean the same thing?

3-Do they look alike?

To prove the answers, scientific measurements are always reliable.

These measurements are not adopted exclusively by forensic linguists for sounds and meaning are the clear territory of linguistics but the similarity of the way trademarks look is often a question for semioticians, particularly when the “look alike” question is addressed by non-linguistic issues such as the colors used, and packaging. But the study of letters and symbols (graphemics) also falls within the scope of linguistics and can provide reliable answers to questions about whether they are similar or not.

Forensic linguistic tools adopted in trademark infringement

1- Phonetic measurement

The intellectual property glossary on the net sees Similarity in sound as one factor in determining whether the marks are confusingly similar.

- XCEED and X-SEED
- ISHINE and ICE SHINE
- SYCOS and SEIKO
- CRESCO and KRESSCO
- ENTELEC and INTELECT

A well-trained phonetician can distinguish between two trade marks and decides whether they are alike or not , but unfortunately most people cannot enjoy this ability. For most of us sounds are similar when they have similar letters to be represented by.

Forensic linguists have developed a tool known as *distinctive feature analysis* used for the first time in a dispute in 1988 dispute between the owners of a factory called Little Dolly which

make cupcakes and another factory Little Debbie ,which also makes the same product. Analyzing the phonetic elements of the consonants and vowels of the two names (Little Dolly & Little Debbie) the linguist Jerry Sadock testified that those two marks contained many distinctive features according to the main phonetic distinctive features of the English sounds : on consonantality, vocality, relative fronting or backing, articulation at a high or low point in the mouth, coronal or grave quality, voice or voicelessness, and stridence.

Another case in which this tool was successfully used was in 2006 when a forensic linguist Ronald Butters used *distinct feature analysis* in the case of pharmaceutical product , Aventis vs. Advantis, (Butters, 2008,p. 233-237).

He asked the consumers of this product to utter the two names in isolation and then within a given context (regular conversation) . He then transcribed phonetically the two nouns when said in isolation and compared them to the way they are said in a continuous utterance. This test showed up to 63% similarity in the first and 73% of similarity in the continuous utterance. But when he used the distinctive feature analysis tool, he found up to 84% of the phonetic features in the two trade marks similar in the isolation and up to 84% in the continuous mode.

This proves that this tool “ Distinctive Feature Analysis” can be reliable in checking phonetic similarity in any trade mark dispute.

Using grammar

We can cite here the example of two companies’ trademarks specialized in microwavable lunch cups:

The company	ConAgra
The product	microwavable lunch cup
The trade mark	Health Selections

Table 2: ConAgra’s trade mark

The company	Hormell
The product	microwavable lunch cup
The trade mark	Healthy Choice

Table 3: Hormell’s trade mark

Grammatically talking , if any layperson was asked to identify how similar or different these two trade marks are , they would certainly talk about the letter “Y” at the end of HealthY and the plural bound morpheme in selectionS. However, if a forensic linguist is called for analysis he or she may read more differences or similarities. Healthy in healthy Choice acts as an adjective noun phrase + a noun which is Choice , but Health in “Health Selections” is not an adjective at all it is called the head since it is an integral part of the compound noun. The first one describes , but the second names.

Using

semantics

The same example above provides us also with a semantic distinctive feature. The dispute between the two trade marks “ConAgra” & “ Hormell “marks as well a good example of a forensic linguistic issue. The choice between the two words in the trade marks (choice) and (selections) is actually problematic . ConGra may be right in claiming that consumers might be confused in believing that ConGra is a branch of Hormell for instance.

Using graphemics

Graphemics is a bit different from any written or spoken material and hence may be deemed as too far from linguistics . However, it verily has to do with linguistics .In such a dispute , forensic linguists use the way the marks are written (the form ,shape , color and thickness of the letters , font size, typeface, and overall design ...etc) to say whether the marks look alike or not.

There is a forensic case between Warren & Prestone which can serve as a good example of how graphemic can be reliable in settling such a dispute. effectively (Shuy 2002: 56- 68).Both companies produce antifreeze/coolant products for motor vehicles. Warren called its antifreeze, LongLife. Somewhat later, Prestone named its product LongLife 460. In this dispute, two common English words, “long” and “life,” were combined into a single word without the usual spacing between them. In both names the second word was capitalized in midword position. This much alone constituted graphemic evidence that 73% of the two names were identical. It is true that Prestone added “460” to its LongLife mark, but researchers show the beginning portions of words are very crucial in word identification and memory storage (Cutler, 1982,p. 573). This suggests

that Prestone's added "460" played only a minor role in consumers' ability to distinguish between the two marks.

Conclusion

Forensic linguists have provided lawyers and judges with a lot of help in such issues by linguistically examining the written material of the trade marks which are possibly infringed. This experience may be of help too to forensic linguists all around the world , particularly, in the Arab dimension and more particularly in the Algerian context where we are actually in need for a real independent body that takes care of these potential infringement that take place all the time in a world of an ongoing commercial competition.

Bibliography

- 1- Blackett, Tom. 1998. Trademarks. London: Macmillan.
- 2- Butters, Ronald R. 2008. "Trademarks and other proprietary terms." In John Gibbons and Teresa Turrell (eds.) Dimensions of Forensic Linguistics. Amsterdam: John Benjamins Publishing Company.
- 3- Cutler, Anne. 1982. "The Reliability of Speech Error Data." In Anne Cutler (ed.) Slips of the Tongue and Language Production. The Hague: Mouton, 561-582.
- 4- Goodwin, Charles. 1996. "Professional vision." American Anthropologist 96, no. 3:606-633.
- 5- Hutton, Chris. 2009. Language, Meaning and the Law. Edinburgh: Edinburgh University Press.
- 6- Schechter, Frank I. 1927. "The Rational Basis of Trademark Protection." Harvard Law Review, 813.
- 7- Shuy, Roger W. 2002. Linguistic Battles in Trademark Disputes. Basingstoke: McMillan Palgrave.

- 8- Tiersma, Peter. 1999. Legal Language. Chicago: U of Chicago Press.

Webography

- 1- Carla , T . (2019). Trademark. Retrieved from <https://www.investopedia.com/terms/t/trademark.asp>
- 2- Generic Trademark: Everything You Need To Know (2012) .Retrieved from <https://www.upcounsel.com/generic-trademark>
- 3- What is generic trademarks. (2012) .Retrieved from <https://www.traverselegal.com/blog/what-is-a-generic-trademark/>
- 4- Whitson , C.(2019) How a Brand Name Becomes Generic . retrieved from <https://www.nytimes.com/2019/06/24/smarter-living/how-a-brand-name-becomes-generic.html>
- 5- Court: ‘GOOGLE’ Not A Generic Trademark. Lessons Trademark Owners Should Learn About Genericide.(2017) retrieved from <https://www.gerbenlaw.com/blog/court-google-not-a-generic-trademark-lessons-trademark-owners-should-learn-about-genericide/>
- 6- Hall,B . (2012) WHAT IS A DESCRIPTIVE TRADEMARK? Retrieved from <https://www.traverselegal.com/blog/what-is-a-descriptive-trademark/#>
- 7- Use your imagination: Suggestive trademarks . (2018) Retrieved from <https://musa-trademark.com/trademark-blog/suggestive-trademark/>