

A LINGUISTIC STUDY OF THE DISTINCTIVENESS OF A TRADEMARK

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ABSTRACT

This article investigates the distinctiveness of a trademark from the perspective of linguistics. Recently, the high-profile case of the trademark “MISS WU” sparked a chorus of disapproval among the public. Claiming that the mark is too generic since “Wu” is a fairly common surname in Taiwan and cannot be exclusively associated with the designer Jason Wu, the Intellectual Property Court (IP court) rejected the trademark registration. Given the surprising furor over the rejection of a trademark, it is clear that the general population does not fully understand the official meaning of a trademark. Since linguistics is an ideal approach when examining the merits of an application to register a trademark, we will employ a mixture of linguistic approaches, including phonetics, corpus linguistics, and semiotics, to analyze whether or not “MISS WU” is distinctive. The history, categories, distinctiveness and regulations related to trademarks are introduced to clarify the picture of trademarks.

Keywords: Trademark, distinctiveness, linguistic approaches, semiotics, sign

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I. Introduction

When a company plans to introduce a new product, it selects a name or slogan for the product, and then registers that name with the trademark office.¹ On occasion, the name or slogan will not be approved by the trademark office, primarily because it lacks distinctiveness. One of the principle requirements for a mark to be eligible for trademark registration is distinctiveness, which means that the mark enables consumers to distinguish the product manufactured or sold by a source from products sold by other sources.

Recently, the rejection of Jason Wu's registration of his trademark "MISS WU" aroused a frenzy of criticism and discussion among the public. Jason Wu designed First Lady Michelle Obama's gown for President Barack Obama's first and second inauguration balls. The Taiwan Intellectual Property Office (TIPO) rejected his application, and the Taiwan Intellectual Property Court (IP Court) later affirmed TIPO's decision, stating that the mark is too generic because "Wu" is a fairly common surname in Taiwan and cannot be exclusively associated with the designer Jason Wu. Put simply, the mark is devoid of distinctiveness.

Many people questioned the reasoning of the court and criticized its standards. In particular, people in the fashion industry in Taiwan were outraged by the court's audacity in rejecting an application for registration of the mark, which has been successfully registered in the United States and many EU countries. Some people even wondered why marks such as "Fei-tai-tai (Mrs. Fei)" or "Dr. Wu" were approved for registration but other similar marks were rejected. And if someone as renowned as Jason Wu could not get his trademark registered, then who is entitled to register a trademark? People began to doubt the entire process of registering a trademark.

Disputes concerning trademark protection involve linguistic issues. Is the mark sought for trademark registration distinctive? Is the mark similar to other registered trademarks for similar products or product categories? Do they look similar? Do they sound similar? Do they have similar meanings?² These questions can also be raised during trademark enforcement.

Since numerous issues concerning trademarks have a highly linguistic nature, we will employ a mixture of linguistic approaches, including semiotics, to examine the mark from its shape, sound and meaning to determine whether the mark "MISS WU" is sufficiently distinctive. To clarify the distinctiveness of the mark, the principles of trademark law and linguistic approaches analyzing the phenomena of trademarks will be introduced to investigate the factors considered by the TIPO and IP Court when deciding the case. Moreover, we will also examine the reasoning and

¹ See ROGER W. SHUY, *FIGHTING OVER WORDS: LANGUAGE AND CIVIL LAW CASES* 168 (Oxford University Press 2008).

² See *id.*

ruling held by the IP Court to see whether they are tenable.

II. The History of Trademark

The marking of goods to distinguish them from similar goods offered by other traders, can be traced back to the dawn of history. From the earliest recorded history, humans have used marks to claim ownership, either as the owner or as the manufacturer. Since the origin of trademarks can be researched back to the beginning of the circulation of goods, it is plausible that primitive humans used marks to indicate the ownership of livestock. Eventually, marks were employed to proclaim the maker of goods and their guarantee of the quality of their product. The history of marks is nearly as old as humanity.³

People began to consider marks, which had become representative of a trader's goods, as a type of property in themselves, during the 19th century. The right to take legal action against the infringement of a trade mark, even when the infringer had made an honest error, developed in the middle of the 19th century. However, the effectiveness of the lawsuit was hampered by the obligation for a trader to demonstrate that the mark under dispute did indicate his goods, and that he had previously claimed ownership of the mark.⁴

Despite of the early introduction of marks or trademarks, the official laws regulating trademark usage did not come into being until the late 19th century or early 20th century in most countries. Promulgated and enacted in 1930, the Trademark Law of Taiwan has undergone more than ten separate amendments during the past few years. With the emergence of the trademark law, the rules regulating trademarks gradually started to take shape and to evolve with the times. Trademark law can be viewed as an attempt to enforce its own policy concerning language. According to the legal community, the battle over ownership of words or expressions is authorized by trademark laws.⁵

III. The Distinctiveness of Trademark

The term “distinctiveness,” defined in Paragraph 2 of Article 18 in the Trademark Act of Taiwan, refers to the character of a sign capable of being recognized by relevant consumers as an indication of the source of goods or services, thus distinguishing goods or services of one undertaking from those of other undertakings. The critical factor in trademark protection is

³ See Intellectual Property Office of the UK, *History of Trade Marks*, <http://www.ipo.gov.uk/types/tm/t-about/t-what-is/t-history.htm> (last visited Apr. 18, 2013).

⁴ See *id.*; see also ALISON FIRTH, GARY LEA & PETER CORNFORD, *TRADE MARKS: LAW AND PRACTICE* (Kristin, Lingren 2012).

⁵ See ROGER W. SHUY, *LINGUISTIC BATTLES IN TRADEMARK DISPUTES 2* (Houndmills, Palgrave Macmillan 2002) [*hereafter* SHUY, *TRADEMARK DISPUTES*].

distinctiveness, and differentiation is the essential ingredient of distinctiveness, which is impossible to exist if the difference is not clearly visible. The utmost prerequisite of a mark to be granted trademark registration by the IP office is that it is distinctive. “The whole purpose in registering a mark is to assert that the mark represents a unique good or service. Uniqueness is essential when distinctiveness becomes real and materialized. The mark signals to consumers that the product represented by it is different than another product with a different mark.”⁶

To the layperson, trademarks are names, slogans or logos attached to products, but in the field of trademark law they represent much more than mere slogans. Serving as a “language of commodities,”⁷ trademarks are employed by legal professionals when dealing with trademarks to interpret that language and comprehend the significance of those commodities.⁸

The degree of the distinctiveness of a trademark varies with the nature of the mark. There are four general categories of trademarks: 1) arbitrary or fanciful; 2) suggestive; 3) descriptive; and 4) generic. Commonly known as the Abercrombie classification, the taxonomy was established by Judge Friendly in the 1976 case of *Abercrombie & Fitch v. Hunting World*.⁹ From the viewpoint of semiotics, the Abercrombie classification ranks marks according to the degree to which their signifiers are, “motivated” by their referents; the more motivated the signifier, the less intrinsically distinctive of source it is.¹⁰ The following section gives a brief introduction of each category in descending order of their strength level of distinctiveness.

A. Fanciful or Arbitrary Marks

Fanciful marks, also referred to as coined marks, are invented or designed for the purpose of functioning as trademarks.¹¹ Fanciful words are ones that are either entirely invented in the language or are fully removed from current common usage.¹² Examples will be KODAK for photographic equipment, EXXON for gasoline and oil, and XEROX for photocopying equipment. Fanciful marks are considered the strongest of all marks because they possess sufficient novelty to leave a strong impact on the mind of the

⁶ Elizabeth Karnezos, *Trademarks: A Social Perspective*, in THE SEMIOTICS OF LAW IN LEGAL EDUCATION 205, 206 (Jan M. Broekman & Francis J. Mootz III eds., 2011).

⁷ Winfried Nöth, *The Language of Commodities Groundwork for a Semiotics of Consumer Goods*, 4 INT’L J. OF RESEARCH IN MARKETING 173 (1988).

⁸ See Karnezos, *supra* note 6, at 206.

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

¹⁰ See Barton Beebe, *A Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

¹¹ See Legal Strength of Trademarks, <http://marklaw.com/trademark-FAQ/strength.htm#Eg> (last visited Aug. 8, 2013).

¹² See Roger W. Shuy, *Using Linguistics in Trademark Cases*, in THE OXFORD HANDBOOK OF LANGUAGE AND LAW 449, 453 (Peter Tiersma & Lawrence Solan eds., 2012).

buyers.¹³ Therefore, fanciful marks are accorded the highest level of protection because they lack any individual meaning outside of the trademark. On the other hand, arbitrary marks employ existing words to convey meanings that are very different from their usual senses. Examples include SHELL for gasoline oil, CAMEL for cigarettes and APPLE for computer.

B. Suggestive Marks

Suggestive marks are marks that connote a meaning other than the denotation of the words used as their marks. Usually it requires an imaginative action, a “mental leap,” to connect the mark with the underlying good or service. For example, GREYHOUND (bus transportation services) recalls the attributes of a dog bred to compete in races, thus suggesting “sleekness and speed.”¹⁴ More examples of suggestive marks include 7-ELEVEN for convenience stores, CITIBANK for an urban-based bank and MICROSOFT for software for microcomputers. Fanciful, arbitrary and suggestive marks are deemed as inherently distinctive and require no proof of secondary meaning for legal protection and registration.¹⁵

C. Descriptive Marks

Descriptive marks describe the qualities, ingredients or characteristics of a product or service, such as BEEF & BREW for a restaurant and HOLIDAY INN for hotels. Such marks are not inherently distinctive and cannot be registered as trademarks unless they achieve secondary meaning. Secondary meaning is defined as “a special sense that a trademark or trade name for a business, goods, or services has acquired even though the trademark or trade name was not originally protectable.”¹⁶ Although the mark appears to be descriptive of the goods or services, consumers recognize the mark as having a source, which indicates its function. Secondary meaning can be achieved through long-term use, or large amounts of advertising and publicity.¹⁷ Even if they qualify for trademark protection, descriptive marks are the weakest marks possible, and do not receive as broad a range of legal protection as suggestive, arbitrary and fanciful marks.¹⁸

Sometimes it is difficult to distinguish descriptive marks from suggestive marks. As mentioned previously, suggestive marks require imagination, thought, or perception to reach a conclusion as to the nature of the goods,

¹³ *See id.*

¹⁴ SHUY, TRADEMARK DISPUTES, *supra* note 5, at 37.

¹⁵ THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.1[1] (4th ed. 2002).

¹⁶ BLACK’S LAW DICTIONARY (9th ed. 2009).

¹⁷ *See* Strength of Trademarks, <http://www.bitlaw.com/trademark/degrees.html> (last visited Aug. 8, 2013).

¹⁸ *See* TOM BLACKETT, TRADEMARKS 32 (Houndmills, Macmillan 1998).

whereas descriptive marks allow one to associate directly with that conclusion.¹⁹ Some examples are FOOD FAIR for a supermarket, SHARP for televisions, DIGITAL for computers and WINDOWS for windowing software.

D Generic Marks

“Generic” is a category name borrowed from the fields of biological sciences in which the term is used to depict a major class or kind of things.²⁰ For example, COLA is generic but COCA COLA is not. It is impossible for generic marks to serve as a trademark, even if a company launches a huge advertising campaign that successfully implants the secondary meaning in the mind of consumers.²¹ Generic terms, such as “sugar,” “bicycle,” or “corn flakes” are everyday words, and therefore should be “available for anyone to use freely without fear of being challenged in court.”²² The specific thinking behind the establishment of the category of generic marks is a desire to prevent any manufacturer or service provider from acquiring the exclusive right to employ words that generically identify a product. And the exclusive right may affect fair competition or be used to initiate a suit to interfere with another person’s use of the same term. The words and phrases such as MODEM, WWW or E-MAIL can be considered generic, therefore they are incapable of functioning as a trademark.²³ Further examples are ALL NEWS CHANNEL for broadcasting services, CALL FORWARDING for a telephone call forwarding service YELLOW PAGES for a business telephone directory. These trademarks can still be used by the companies but they are not entitled to equal legal protection by the Trademark Law as other types of trademarks.

IV. Semiotics in Trademark Law

In this article, a variety of linguistic approaches, including semiotics, are employed to analyze the phenomena of trademarks. Since semiotics, a sub-field of structural linguistics, involves a more complicated conceptualization of signs, we will give a brief introduction in this section.

Semiotics is the scholarly discipline that studies systems of signs in all of their manifestations, and the most elaborate system of signs is definitely the human language.²⁴ Numerous researchers, such as Beebe, Garrett, Karnezos, Lang, employ semiotics as essential framework when analyzing trademark

¹⁹ See Strength of Trademarks, *supra* note 17.

²⁰ See Shuy, *supra* note 12, at 451.

²¹ See Strength of Trademarks, *supra* note 17.

²² See Shuy, *supra* note 12, at 451.

²³ See Strength of Trademarks, *supra* note 17.

²⁴ See RENÉ DIRVEN & MARJOLIJN VERSPOOR, COGNITIVE EXPLORATION OF LANGUAGE AND LINGUISTICS 3 (Amsterdam, John Benjamins Publishing Company 1998).

law.²⁵

The two dominant models of what constitutes a sign were established by the linguist Ferdinand de Saussure and the philosopher Charles Sanders Peirce.²⁶

Saussure, the founding father of modern linguistics, constructed a “dyadic” or two-part model of the sign, where the two parts are: a “signifier”—the form which the sign takes; and the “signified”—the concept it represents. The sign is the product of the combination of the signifier with the signified.²⁷ The relationship between the signifier and the signified is referred to as “signification,” which is indicated in the Saussurean diagram by arrows. The horizontal line marking the two elements of the sign is referred to as “the bar.”²⁸ The entire concept is illustrated in Figure 1.²⁹



Figure 1. The Saussurean sign (the dyadic model).

Since the relationship between the sign’s signifier and its signified is “arbitrary,” there is no natural link between the concept of a tree and the sound or appearance of the word “tree,” shown as Figure 2.³⁰

²⁵ See, e.g., Beebe, *supra* note 10; Meghann L. Garrett, *Trademarks as a System of Signs: A Semiotic Look at Trademark Law*, 23(1) INT’L J. FOR THE SEMIOTICS OF LAW 61 (2010); Karnezos, *supra* note 6; Angus Lang, *A Case for Applying the Theoretical Semiotics in the Practice of Trade Mark Law*, 21(1) INT’L J. FOR THE SEMIOTICS OF LAW 1 (2008).

²⁶ See Daniel Chandler, *Semiotics for Beginners*, <http://users.aber.ac.uk/dgc/Documents/S4B/sem02.html> (last visited Apr. 18, 2013).

²⁷ See FERDINAND DE SAUSSURE, *COURSE IN GENERAL LINGUISTICS* 67 (Charles Bally & Albert Sechehaye eds., Wade Baskin trans. 1959). [*hereinafter* SAUSSURE (Baskin)].

²⁸ See DANIEL CHANDLER, *SEMIOTICS: THE BASICS* 8-16 (London, Routledge 2007).

²⁹ See Beebe, *supra* note 10, at 634.

³⁰ See Chandler, *supra* note 26.

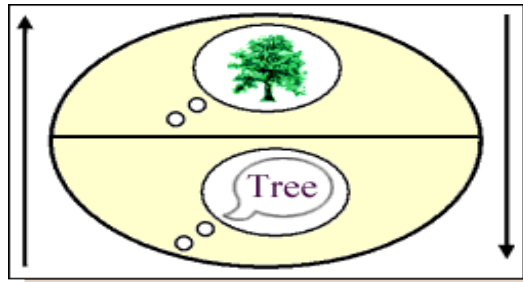


Figure 2. An example of the Saussurean sign (the dyadic model).

In the trademark field, the mark is the signifier and its service or product is the signified; an example is shown as Figure 3.

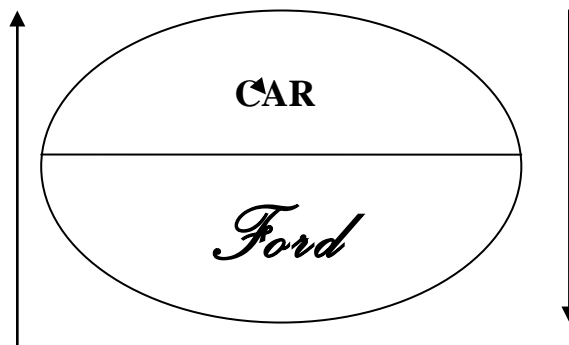


Figure 3. An example of trademark with the dyadic model.

Since semiotics focus on the definition of signs and symbols, it is an ideal instrument for the study of trademarks, which are signs or symbols that are employed by a company to distinguish its unique brand of goods. Filtered through the logic of semiotics, a trademark is no longer a mere sign, but an expression of linguistic communication that has been accepted by society.³¹

A key requirement of a trademark is that the mark itself must have any intrinsic functionality since the registration of a trademark will limit people's ability to use the mark, whether it is a sign, a symbol or a color. Given such a situation, the best trademarks are arbitrary or fanciful words or designs, which have no direct link to the products that they represent except in the minds of the public.³²

When studying trademarks through semiotics it is vital to remember that

³¹ See JASON R. FISHER, VIEWING TRADEMARK LAW THROUGH THE LENS OF SEMIOTICS 3 (May 2009) (Kevelson Seminar Manuscript).

³² See Jason R. Fisher, *Student Positions and Opinions*, 23(1) INT'L J. FOR THE SEMIOTICS OF LAW 3, 18-19 (2010).

like most words, trademarks involve more than just the symbols that they represent.³³ For this phenomenon, Peirce perceived a sign as containing three distinct parts, known as the triadic sign model, shown as Figure 4.³⁴ The model is also commonly termed as a semiotic triangle.

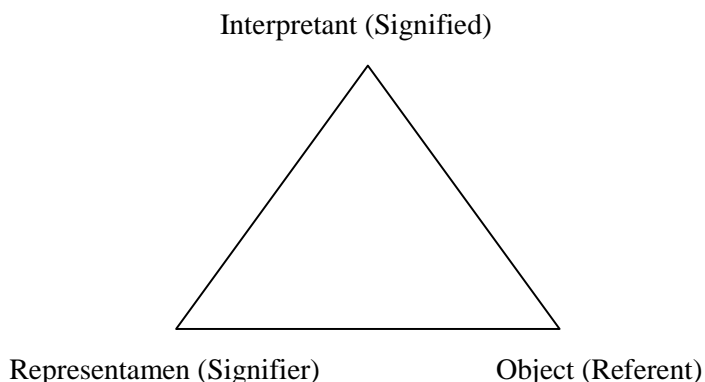


Figure 4. Peirce's triadic sign model.

The first element is the representamen, the visible object that has another meaning outside of itself. According to trademark law, the representamen is the physical mark itself, which serves as a sign or symbol. The second element is the referent, a physical or mental entity, that is linked to the sign through the representamen. The referent is the company or product that is being represented by the trademark. The third and final element is called the interpretant, which Peirce defined as "creating something in the mind of the interpreter." The representamen and the referent are joined by the interpretant; it is the cognitive process by which a person recognizes and interprets a trademark. Since every person's cognitive process is slightly different, the interpretant are never exactly the same. When two people look at the same trademark, both will connect the symbol to its physical counterpart even though their thinking processes will do so in different ways.³⁵

Trademarks have a more complex meaning than the specific products and the companies they represent. The signs and words that we encounter on a daily basis are also an expression of trust, and the smooth operation of the market depends on that trust. A trademark on an item informs the consumer that a company has manufactured the item that they put their trust in and that they are guaranteed a certain level of performance by that product. This is

³³ See *id.*

³⁴ See Beebe, *supra* note 10, at 621; see also Garrett, *supra* note 25, at 64.

³⁵ See Fisher, *supra* note 32, at 19.

why trademark dilution is a serious issue.³⁶

The whole field of trademark law can be considered a “system of signs designated to facilitate the commodification of social distinctions.”³⁷ Jean Baudrillard, among others, advocated that consumption (i.e. the purchase of commodities) should be analyzed “as a system of communication and exchange, as a code of signs continually being sent, received and reinvented—as language.”³⁸

V. The Case of “MISS WU”

Having completed the introduction in previous sections, it is time to examine the case of “MISS WU” from the perspective of linguistics. The IP court rejected Jason Wu’s application on the grounds that the mark is too generic since “WU” is a common surname in Taiwan and cannot be exclusively associated with the designer Jason Wu. In short, the mark lacks distinctive characteristics.

The plaintiff contended that MISS is a metaphor of feminine tenderness and WU is an onomatopoeia, which refers to the sound of an owl, rather than the common Chinese surname “吳” (Wu). The combined term, the trademark, was intended to associate female leather accessories with the logo of an owl, another trademark that was successfully registered by the plaintiff. If this explanation is accepted by the court, then “MISS WU” will be regarded as a suggestive mark. In the Examination Guidelines on Distinctiveness of Trademarks the regulations concerning a suggestive mark are listed in Article 2.1.3:

A “suggestive trademark” refers, by use of metaphor or simile, to the quality, function, or anything related to the ingredients or nature, of the goods. Such sign is easy to remember, but is not necessarily or commonly used by competitors to describe goods or services. A suggestive description differs from direct description of goods or services. When the former is used, consumers must exercise certain level of imagination, thought, feeling or inference in order to understand the connection between the sign and the goods or services. This type of sign is not necessarily or naturally chosen by competitors to describe the features of the goods or services because there are other more directly descriptive words or devices available. Therefore, **the grant of exclusive right to this type of sign will not affect fair competition and such sign is registrable.**

Therefore, it is clear that suggestive trademarks are registrable as long as

³⁶ See *id.* at 19-20.

³⁷ Beebe, *supra* note 10, at 624.

³⁸ *Id.* at 623; see also JEAN BAUDRILLARD, THE CONSUMER SOCIETY: MYTHS AND STRUCTURES 93 (Sage 1998).

certain requirements are met. To decide whether the mark “MISS WU” is sufficiently distinctive, we will employ linguistic approaches, such as corpus linguistics, phonetic rules, semantics and semiotics to examine the look, sound and meaning of the mark.

A. Look

The pattern of the mark “MISS WU” filed by Jason Wu was not specially designed. Even though it is the brand of a distinguished designer, it looks surprisingly ordinary. To give the mark “MISS WU” a connotation closer to the plaintiff’s intended meaning, the shape of the expression has been changed to look more feminine with a linear silhouette design shown as figure 5. The re-designed mark on the right looks considerably more female-like.



Figure 5. “MISS WU” in different fonts.

Although the plaintiff did not perform any particular design work with the mark, we are attempting to demonstrate that more elaboration would make the mark more distinctive.

B. Sound and Meaning

Based on the phonetic pattern of onomatopoeic words, such as “coo” and “oops,” the sound of an owl, is more likely to be spelled as “WOO” rather than “WU”, but unfortunately the word “woo” is already used as a verb for other meanings. The word “woo” refers to 1) sue for the affection of and usually marriage with or 2) solicit or entreat especially with importunity.³⁹ Anyway, “WU” simply does not look or feel like an onomatopoeia as claimed by the plaintiff, even though it is pronounced exactly the same as “woo.” According to Derek Abbott’s Animal Noise Page,⁴⁰ the sounds of an owl hooting can be spelled as:

twit twoo
hoo hoo
whit woo
terwit terwoo

³⁹ See Webster, *Merriam Webster Dictionary*, <http://www.merriam-webster.com/dictionary/woo> (last visited Apr. 2, 2013).

⁴⁰ See Derek Abbott, *Animal Noise Page*, <http://www.eleceng.adelaide.edu.au/Personal/dabbott/animal.html> (last visited Apr. 5, 2013).

Despite the fact that the English language is notorious for its inconsistency between orthography and pronunciation, we can clearly see that the phoneme [u] is usually spelled as “oo” instead of “u”⁴¹ for onomatopoeias. Therefore, it is reasonable for the court to say that “WU” is a surname, even though the plaintiff countered that the IP office committed a dereliction of duty by interpreting “WU” as the surname “吳” (Wu).

The guidelines of surnames used as trademarks are regulated as the Examination Guidelines on Distinctiveness of Trademarks, 4.6.1⁴²:

A surname used on goods or services is usually the principal's surname rather than a sign identifying the source. When other competitors use the same surname, relevant consumers will be unable to identify the source by such surname. From the perspective of competition, different competitors in the same trade having the same surname should be free to use their own surname, regardless of when they enter the market. In principle, use of a surname as a trademark is not distinctive. **Such trademark can be registered only if there is evidence that it has acquired distinctiveness.**

Guideline 4.6.1 indicates that surnames can be registered as trademarks only if there is evidence that it has acquired distinctiveness, which is precisely what “MISS WU” lacks. The appellant challenged the standard of the IP office, citing earlier registered trademarks, such as “Dr. Chi,” “Dr. Ku,” “Miss V,” and “Miss S.” as examples. These marks possess an acquired distinctiveness through a lengthy period of use in commerce. Moreover, neither “V” nor “S” is a surname in English or Chinese.

According to Trademark Law, after a surname has been recognized as acquiring a secondary meaning, the mark is protectable as a trademark, thus preventing anyone else from using the same mark for a comparable product or service, even if they have the same surname. For example, Fred Hilton is forbidden to call his hotel “Hilton Hotel” and John Newman can not call his salad dressing “Newman's Salad Dressing” because the trademarks Hilton and Newman's Own have already achieved secondary meaning.⁴³ You can imagine how much trouble the registration of the mark “MISS WU” will cause to the huge number of people surnamed Wu in Taiwan.

Next, we will apply corpus analysis to the distribution of “MISS WU.” Designed for the study of language, corpus linguistics is a method of linguistic analysis which relies on a collection of natural or “real word” texts

⁴¹ See PETER LADEFOGED, A COURSE IN PHONETICS (Harcourt, 4th ed. 2001).

⁴² Examination Guidelines on Distinctiveness of Trademarks, <http://www.tipo.gov.tw/ct.asp?xItem=285308&ctNode=7048&mp=1> (last visited Apr. 18, 2013).

⁴³ See Strength of Trademarks, *supra* note 17.

known as corpus. The essential characteristics of corpus-based analysis are: 1) it is empirical, analyzing the actual patterns of use in natural texts; 2) it utilizes a large and principled collection of natural texts, known as a “corpus,” as the basis for analysis; 3) it makes extensive use of computers for analysis, using both automatic and interactive techniques and 4) it depends on both quantitative and qualitative analytical techniques.⁴⁴ Since corpus linguistics depends on a massive corpora made up of millions, even a billion words, the statistics it uses are considered reliable, due to the belief that language is a reflection of reality.⁴⁵

Since the mark “MISS WU” is intended to be used in English rather than Chinese, the common language used in Taiwan, it would be inappropriate to use a Chinese corpus for analysis. Therefore, we cannot but do with an English corpus. The corpus used for analysis is the Corpus of Contemporary American English (COCA),⁴⁶ which is the largest corpus available for American English. From the data shown in Table 1 collected from COCA, we have found that the majority of the collocation of “Miss” with a surname occupies 87.3%, while the remaining 12.7% is linked with the name of a place, a country or other words, such as Miss America or Miss California. It is worth pointing out that the very expression “Miss Wu” appeared only once in the corpus. In a corpus as large as 450 million words, that is extremely rare and can be totally ignored. Perhaps this explains why the trademark “MISS WU” was successfully registered with the IP office in the United States.

Table 1. The distribution of the collocation of “Miss”

Expressions	Miss + surname	Miss + other words
Percentage	87.3%	12.7%

The distribution of “Wu” and other common English surnames is presented in Table 2. By the standard of corpus analysis, if the frequency of a recurrent expression per million words is as low as 4.56, it is not worth

⁴⁴ See DOUGLAS BIBER, SUSAN CONRAD, & RANDI REPPEN, *CORPUS LINGUISTICS. INVESTIGATING LANGUAGE STRUCTURE AND USE 5* (Cambridge University Press 1998) [hereafter BIBER, *CORPUS LINGUISTICS*].

⁴⁵ See *id.*; see also *Corpus Linguistics*, <http://www.cl2011.org.uk/> (last visited Apr. 5, 2013).

⁴⁶ The Corpus of Contemporary American English* (not to be confused with the American National Corpus) is the first large, balanced corpus of contemporary American English. It is freely available online, and it is related to other large corpora that they have created. The corpus contains more than 450 million words of text, including 20 million words each year from 1990-2012, and it is equally divided among spoken, fiction, popular magazines, newspapers, and academic texts. The corpus is also updated at least twice each year, and will therefore serve as a unique record of linguistic changes in American English; available at <http://www.americancorpus.org/> (last visited Apr. 2, 2013).

counting, and is likely to be regarded as insignificant.⁴⁷ Compared with common surnames, such as “Smith,” “Brown,” “Johnson,” “Jones,” the frequency of “Wu” seems significantly low, therefore “Wu” is a rare surname in Western culture.

Table 2. The distribution of “WU” and other common surnames

Surname	WU	SMITH	BROWN	JOHNSON	JONES
token	2053	47172	39392	39168	31681
frequency in per million words	4.56	104.83	87.54	87.04	70.40

In contrast, the distribution of the surname “吳” (Wu) in Taiwan is extremely different. Compared with the rarity in Western culture, the surname 吳 “Wu” is very common and abundant in Chinese society. In fact, Wu is one of the top 10 common surnames in Taiwan according to the statistics of the Ministry of the Interior.⁴⁸ In 2012, Wu was the No. 7 most common surname, with 4.04% of the whole population—23 million people—of Taiwan. Therefore, there are approximately one million people surnamed Wu in Taiwan. If half of these people are females, then there are nearly half a million *Miss Wu*’s in Taiwan. That’s definitely a huge number for a category. As mentioned previously, a term used to depict a major category or kind of things or people is generic. Apparently, the differentiation of the surname distribution is a result of cultural differences.

Based on the above-mentioned analyses, it is fair to conclude that “MISS WU” is a generic mark, and the guidelines of generic marks are regulated as the Examination Guidelines on Distinctiveness of Trademarks, 2.2.2⁴⁹:

A generic mark is a sign that is commonly used by businesses in respect of specific goods or services, while a generic name is a name that is commonly used by businesses to denote the goods or services. A generic name also includes the shortened forms, acronyms and common nicknames. For relevant consumers, a generic mark or name is used by general businesses to denote or indicate the goods or services themselves and does not serve to identify the source. For example, “revolving neon light in red, blue and white” is a generic mark for hair salons; “開心果” (“Kai Xin Guo”) is a common nickname for pistachios; “阿拉比卡 Arabica” is

⁴⁷ See BIBER, CORPUS LINGUISTICS, *supra* note 44.

⁴⁸ See Ministry of the Interior website, <http://www.moi.gov.tw/outline/en/en-03.html> (May 2, 2013).

⁴⁹ Examination Guidelines on Distinctiveness of Trademarks, *supra* note 42.

a variety of coffee tree. **These marks or names** cannot serve as the basis for identifying the source and **are not registrable; otherwise, the exclusive right may affect fair competition or be used to initiate a suit to interfere with another's use of the same term.**

The guideline clearly indicates that generic marks are not registrable since “the exclusive right may affect fair competition or be used to initiate a suit to interfere with another person’s use of the same term.”

C. English or Chinese?

When foreign words are used as trademarks, numerous problems may arise. Should a mark’s descriptiveness or suggestiveness be considered from the perspective of speakers of the country where the protection is sought or from those who speak the foreign language itself?⁵⁰

As McCarthy indicated, problems may arise when the foreign language word would or would not have a descriptive connotation to local consumers. McCarthy was troubled by the doctrine of foreign equivalents because it depends greatly on the knowledge and acquaintance of consumers with specific foreign languages or foreign words.⁵¹ In Taiwan, the usage of foreign words as trademarks is regulated in the Examination Guidelines on Distinctiveness of Trademarks 4.1.3⁵²:

If a foreign word is a generic name or relevant description of the designated goods or services, the word is not distinctive. When a trademark to be registered consists of or contains foreign word(s), the applicant should specify the language and the meaning in Chinese in the column of trademark specimen in the application form. If the language is familiar to local people, such as English, it is easier to determine whether the word concerned is a generic name or relevant description of the goods or services. For a word in a language that is less familiar to local people, **even if registration is granted** because it is not found to be a generic name or be descriptive of goods or services, **it may still be subject to cancellation** by opposition or invalidation proceedings **when such word is later found to be unregistrable.**

Again, the guideline clearly points out that if a foreign word is a generic name, the word is not distinctive and therefore not registrable.

D. Interpret the Mark “MISS WU” in the Semiotic Theory

In the case of “MISS WU,” many people have questioned the reasoning

⁵⁰ See SHUY, TRADEMARK DISPUTES, *supra* note 5, at 144.

⁵¹ See *id.*; see also MCCARTHY, *supra* note 15, at § 3.1[1].

⁵² Examination Guidelines on Distinctiveness of Trademarks, *supra* note 42.

of the court and criticized the standard of the court. People in the fashion industry in Taiwan were even outraged by the court's audacity in refusing to grant registration of the mark, which has been successfully registered in the United States and many EU countries. Among the criticisms of the case, the major problem is that the common public, or laypersons from the perspective of legal professionals, confuses the trademark with the designer Jason Wu. In semiotic terms, they have confused the referent with the representamen. It is essential to remember that the mark, not the plaintiff, i.e. the designer, is being examined. Most of the negative reaction focused on how ignorant and ill-informed the IP officials and judges must be if they do not know that Jason Wu is the designer of the gowns of Michelle Obama and Mei-ching Zhou, the first lady of Taiwan. Actually, this very fact is expressly indicated in the defense of the plaintiff. Yes, the court "does" know that Jason Wu is a distinguished international designer. What is problematic is the mark "MISS WU," which is too generic, and thus cannot be registered as a trademark according to the trademark law.

Garrett indicated that marks can be viewed in light of the Peirce's semiotic triangle while analyzing the case of *eBay, Inc. v. Perfumebay.com*⁵³. Following his demonstration, we will illustrate this case with the triangle as well. In this case, the mark "MISS WU" is the signifier, the referent is the trademark. The signifier-referent relation signifies "Jason Wu" rather than the concept of a trademark, which caused the confusion, as the signifier does not signify the correct signified. In the mind of the common public, "MISS WU" means "Jason Wu" but to the IP court it means a phrase which it is not qualified to become a registered trademark. The confusion can be illustrated through the following semiotic triangle shown as Figures 6 and 7.

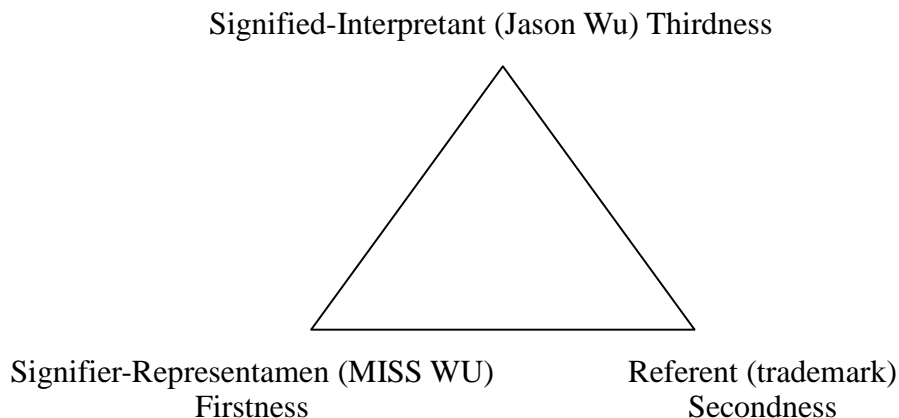


Figure 6. Peirce's triadic sign model applied for "MISS WU."

⁵³ See Garrett, *supra* note 25, at 67.

As mentioned earlier, Peirce defined the interpretant as “creating something in the mind of the interpreter.” The interpretant is what connects the representamen and the referent. According to semiotic theory, the signified changes with person and context.⁵⁴ In this case, the interpretant, i.e. the IP court and the public, understand and interpret the mark “MISS WU” in greatly different ways and their cognitive processes deviate from each other to a noticeable extent as Figure 7 shows.

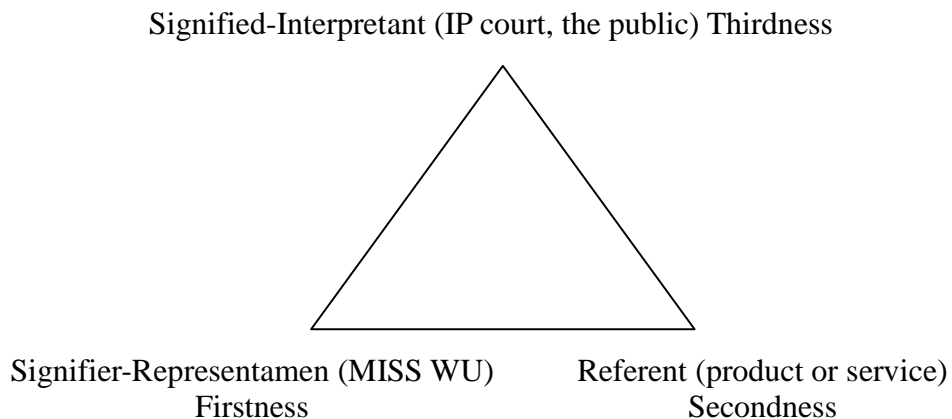


Figure 7. Peirce’s triadic sign model applied for “MISS WU.”

The coincidence of the announcement of the ruling of Jason Wu’s trademark case and First Lady Michelle Obama’s selection of a second Jason Wu-designed gown for Obama’s inauguration ball may have given the mark “MISS WU” a second meaning. People learned that “MISS WU” is one of Jason Wu’s brands. Prior to this surge of media coverage, probably few people had heard of the name. Under the pressure of public opinion, the IP office has conceded that Jason Wu can file a trademark registration again with more supplements, such as the sales figures and the names of celebrities who have worn the products of “MISS WU,” it is likely that they would grant the registration. Nobody would like to see the law twisted merely to satisfy the demands of famous people. However, if we look at the case from the bright side, an ideal world in which the law stands neutral to everybody is still worth our efforts.

Based on the analysis presented above, it is fair to say the IP court acted properly when ruling on the case of Jason Wu. Facing a world-renowned designer such as Jason Wu, it performed its role of gatekeeper. It is understandable that both the IP office and the court have to be cautious in deciding the case since once they grant the registration of “MISS WU,” the applicant will enjoy an exclusive right of use accompanied with the

⁵⁴ See SAUSSURE (Baskin), *supra* note 27, at 80.

protection of the trademark law. The situation would deprive others of the right to use common expressions, such as “A Miss Wu called and left a message,” in everyday life. As a matter of fact, the notion that “bits of linguistic or semiotic material” can actually be owned by individuals and companies has been challenged by researchers.⁵⁵ How to strike the balance between protection of trademarks and freedom of expression is their main concern.

E. Companies’ Strategies for Generic Terms from the Perspective of “MISS WU” Case

The global trend is that successful companies and their lawyers are endeavoring to ensure that their marks do not become generic, termed as genericide.⁵⁶ Genericide is a legal term for generification, which stands for the historical process whereby a brand name or trademark is transformed through popular usage into a common noun.⁵⁷ In fact, a great proportion of the legal efforts of large corporations is spent waging a constant battle against its mark being used as a generic term.⁵⁸ It is beyond imagination and extremely unwise for a company to employ a generic term in the first place when the proprietors of *Kleenex*, *Baggies*, *Xerox*, and *Google* are struggling with the problem of genericide. Take the trademark of *Google* for example. These days, *Google* become more cautious and aggressive, with occasional flurries of letters requesting publications to say “using the Google search engine” instead of “googling.”⁵⁹ But that doesn’t seem to be able to stop people from using the term in everyday speech. We can well imagine how much their attorneys would like to nip the problem in the bud before it gets serious since they fully understand that if a trademark becomes generic through common use, the court can rule it invalid and revoke its registration.

Normally, trademarks attorneys would propose trademark strategies for their clients in order to easily protect their trademark use in the future.⁶⁰ And it is not the case that the term “MISS WU” has been used in commerce for a long time and received recognition from the consumers, and therefore acquired a second meaning. As a matter of fact, Jason Wu started to use that

⁵⁵ See Ronald Butters, *Trademark Linguistics – Trademarks: Language that one owns*, in THE ROUTLEDGE HANDBOOK OF FORENSIC LINGUISTICS 351-64 (Malcolm Coulthard & Alison Johnson eds., 2010).

⁵⁶ See Rhodri Marsden, “Genericide”: When Brands Get Too Big, <http://www.independent.co.uk/news/business/analysis-and-features/genericide-when-brands-get-too-big-2295428.html> (last visited Apr. 8, 2013).

⁵⁷ See Richard Nordquist, *About Grammar*, <http://grammar.about.com/od/fh/g/genericideterm.htm> (last visited Apr. 8, 2013).

⁵⁸ See Marsden, *supra* note 56.

⁵⁹ See *id.*

⁶⁰ See MICHAELA FALLS, RECENT TRENDS IN TRADEMARK PROTECTION 40-45 (Aspatore 2011).

term as recently as the year of 2012. Not a single item of the series of “Jason Wu” or “MISS WU” has been officially purchased in the marketplace of Taiwan. In other words, people have never given recognition to the brand of “MISS WU” as consumers. The reason why people supported Jason Wu in his lawsuit is not that the mark is distinctive enough but that they are proud that he is a world-famous Taiwanese.

VI. Conclusion

A. Findings

This research shows that the law and linguistic disciplines, semiotics in particular, can collaborate effectively to resolve trademark disputes. In fact, the field of trademarks is tailor-made for the application of linguistics. Semiotics can contribute a great deal more to the analysis of trademarks than just a theoretical academic research methodology since the “law is a system of signs”⁶¹ and semiotics is the study of signs. Using semiotics allows people to obtain a more in-depth look at legal realities. If the IP office had employed plain language instead of annoying legalese when it explained why it was inappropriate to register “MISS WU” as a trademark with those linguistic approaches, the public would have identified with the office, rather than blindly supported the plaintiff. This study demonstrated that established linguistic methodologies can assist legal professionals in analyzing the appropriateness of disputed trademarks.

B. Suggestions

Since it is common for trademark applicants to use trademarks that have already been registered as evidence that the intended mark is sufficiently distinctive to qualify as a trademark, we suggest that the IP office evaluate all of the trademarks that have been granted registration through the acquired distinctiveness, i.e. secondary meaning. In the majority of cases, these marks are either generic or descriptive. Generally speaking, the owners of these marks have used the mark for a long period of time, and their products or service are well-received by consumers, which is how their marks acquire distinctiveness—secondary meaning. Perhaps the IP office could supply a brief introduction to those trademarks in the database. Presented with clear explanations of the reasoning behind each existing trademark, other applicants would understand that their intended marks do not meet the requirements of the trademark law because there are no comparable background stories of secondary meaning behind their marks. The provision of such introductions could prevent a considerable amount of ill-feeling and resentment and spare a lot of unnecessary trouble.

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⁶¹ ROBERTA KEVELSON, *THE LAW AS A SYSTEM OF SIGNS* 25 (Plenum Press 1988).

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