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LINGUISTIC EVIDENCE IN TRADEMARK DISPUTES: A FORENSIC ANALYSIS OF LEXICAL, SEMANTIC, AND SYNTACTIC MARKERS

Abstract. Trademark disputes imply a linguistic battle over a term or a sequence of terms. Linguistic methods focusing on lexical, semantic and syntactic analysis can play an important role in assessing similarities, differences or the possibility of consumer confusion. The paper presents three real trademark cases from two distinguished linguists, who were called upon as expert witnesses to identify how lexical choices, semantic content and syntactic patterns can affect legal interpretation. Linguistic evidence withdrawn from corpus analysis can be very valuable in a trademark case. The work of the linguist consists in investigating how often the contested term appears in large corpora and in determining whether only the plaintiff has the right to use that certain word or not.

Keywords: linguistic tools, lexical analysis, semantic analysis, syntactical analysis, corpus analysis

1. Introduction

Trademark cases involve a battle over the use of specific words or expressions. For example, as the paper presents in section 2, it happens very often that certain companies claim they are the only ones who have the right to use a word or even a morpheme, such as McDonald's who claims that the use of the bound morpheme "mc-" by other companies may confuse customers and may be a way to take advantage of the firm's reputation. Therefore, trademark cases involve disputes over words, expressions or even morphemes,

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the smallest units of language that contain meaning. Unfortunately, there is also the problem of authority over words and who can decide why certain words or expressions can only be used by a restricted number of people.

These types of cases usually involve a collaboration between attorneys and linguists, where linguistic analyses are recognised as valuable insights, "especially since trademark disputes are largely about language" (Shuy, 2002, p. 1). Over the past years, attorneys have reached out to linguists and asked for their expertise. We will review in the next section of this paper a few cases where linguists were called upon as expert witnesses.

As Gibbons and Turell (2008) state at the beginning of their book, "Dimensions of Forensic Linguistics", Forensic Linguistics can be used as a tool in different areas of study, such as language used in legislation, legal discourse (courtroom proceedings, police interrogations), legal translation and interpreting, various problems that are caused by misunderstandings of laws and legal terminology, trademark cases, the use of legal evidence (for authorship attribution cases, linguistic profiling) and many more. Their book represents a collection of papers from distinguished linguists and they are categorised into three chapters: "Part I: The language of the law", "Part II: The Language of the court" and "Part III: Forensic linguistic evidence" (Gibbons & Turell, 2008, p. 1). Part III also includes papers from Ronald R. Butters and Jennifer Westerhaus (2004), who show the linguistic criteria that can be found in trademark cases and gives examples from his own experience as an expert witness. He states that linguists can sometimes have a role as legal consultants and their professional expertise can add significant value to the case.

Forensic texts include many types of spoken or written forms of language exchanges such as interviews with the police, testimonies, personal diaries and letters, phone calls or transcripts from various contexts the suspects found themselves in. Certain types of legal texts such as wills, contracts or laws can also be considered forensic texts and be subjected to a linguistic analysis. This happens when legal terminology leaves room for interpretation, or when it simply cannot be understood by its recipients. For example, there was often the case that juries were confused by the legal instructions they had received because of the ambiguity of the legal terms used. Or laws had to be rewritten, because of their confusing phrasing which led to sentences not corresponding to the act committed.

An important question is how can linguists help? In recent years, linguists have been asked to help in different types of cases: disputes over specific morphemes in trademark cases, the interpretation of words in certain legal cases and contexts, issues related to authorship, plagiarism or allegations that certain texts are fabricated (such as wills, contracts, or suicide notes like Virginia Woolf's). The analysis, as any linguistic analysis of a text, implies different analytical tools and various methods, depending on what aspects need to be proved. More notably here would be the way linguists present their information and research to the juries and judges. Linguists should make use of quantitative illustration as much as possible. Charts and graphs, data in the form of numbers and percentages, can help render the information much more clearly because "(...) juries, can be impressed by what they hear, but will better remember what they can see" (Shuy 2002, p. 170).

Another admirable role that a linguist has is that of teaching their audience. In one of his cases, Shuy was given the task to explain to the jury the four categories of trademark. Further in his cases, he helped attorneys, judges and juries understand "the qualities and claims of lexicographical practice, and to convey technical linguistic information about the sounds, grammar, meaning, and discourse of the English language in ways that could be grasped by laypersons. If anything characterizes applied linguistics, it is this" (Shuy 2002, p. 169).

Shuy (2002) goes on and states that "trademark law is about the right to monopolize the use of language" (Shuy, 2002, p. 2). He explores how language is used in battles which lead to companies trying to create their own "language planning and policy" (Shuy, 2002, p. 2). Language planning is an area of study in which experts, usually sociopolitical ones, analyse situations where more languages are used and try to figure out ways to optimise the use of certain words or expressions. These aspects of trademark cases will be reflected in the following case studies that are presented in the next chapter of this paper.

The next section of this paper presents trademark cases where linguistics played an important part.

2. Case studies

The following section explores three real trademark cases from two distinguished linguists, who were called upon as expert witnesses to identify how lexical choices, semantic content and syntactic patterns can affect legal interpretation.

2.1. *Woodroast v. Restaurants Unlimited case*

Woodroad Systems, Inc. in Minnesota filed a complaint against Restaurants Unlimited, Inc. also in Minnesota. Woodroast, also known as “Shelly’s Woodroast” contested the use of “Wood Roasted” on Restaurants Unlimited’s menu and in its advertising. They claimed they had deliberately violated their mark, as this will create confusion and deception among customers. The initial complaint was made for a few meals listed on their menu: “Wood Roasted Vegetables”, “Wood Roasted Seafood”, “Wood Roasted Oven Prawns”. They believed that their name, which was made of only one word “Woodroast”, would be confused to the dishes offered by Restaurants Unlimited, even though here there were two words “Wood Roasted”. Restaurants Unlimited responded and argued that this was a generic term and also a descriptive one, which pointed to a method of cooking the meat. They also mentioned that many other restaurant chains had similar meals names with “wood roasted” included in their menus. Woodroast answered by claiming this method of cooking was unique to them and they had patented it, a method of cooking the meat in wood-burning ovens. They also claimed they had no knowledge of other restaurants with similar names.

Shuy (2002) was asked to provide his expertise by the Restaurants Unlimited’s attorney, Bruce Little. Shuy explains how a good method in many cases is casting a broader net, that is, searching a larger database to check how the respective item is used in real-life contexts and base their conclusions having all these instances in mind. In this particular case, he managed to build a large data base revolving around variations of the term “woodroast” and conducted a corpus analysis. He looked for contexts where the following terms appeared: “wood roasted”, “wood roasting” and “woodroast”. Firstly, he checked whether there were other

restaurants with similar names to the plaintiff. He found five more restaurant names which included the phrase “wood roasted” (“Cluckers Wood Roasted Chicken, Henpecker’s Wood Roasted Chicken, Rollo Pollo Wood Roasted Chicken, Kenny Rogers’ Roasters Wood Roasted Chicken, and Red Hot Hen’s Wood Roasted Chicken.”). He found only one restaurant with “woodroast” in its title, which was the plaintiff. Secondly, he checked menus to see if there were any other meals with “woodroast” or other variations in their names. He found 38 items containing “woodroasted”, “wood roasted”, “WOOD ROASTED,” “WOOD ROASTED,” “Wood-roasted,” and “Wood-Roasted.” Related phrases included “wood-fired roasted,” “wood rotisserie,” “OVEN ROASTED,” “SPIT ROASTED,” “SPIT-ROASTED,” and “wood flamed.” As opposed to the plaintiff, the other 38 restaurants used the term in its past participle form, ending in “-ed”. They also used it as a descriptive element, an adjective, with various items in their menus.

Then, he collected data from the media to decide how unique exactly could this term be. He found 44 articles from newspapers and magazines which contained various form of “wood roast”. He collected data from affidavit and deposition testimonies.

After that, Shuy looked for “woodroasted” in lexicographic sources as well. It appeared nowhere as a “proper noun, common noun, adjective, or verb”. He found “-roasted” in compound words (such as “dry-roasted”). The search for “-roasting” did not have any relevant terms. He searched for “wood” as the first element of a compound word and found two relevant terms: “wood-walled” (1595) and “wood-fired” (1956).

The next step was to look at the other menus from the data base accumulated so far and the obvious difference was that in all these menus the term “wood” is actually combined, using a hyphen, or is separated with “roasted”. The syntax of the menu reflected some problems as well. He also used tagmemics here, because he had previously been asked to be “less academic”. He surveyed hundreds of menus from different restaurants and discovered the following: “(1) self-congratulations, (2) method of cooking, (3) style of food, (4) the food item, and (5) serving modifications” (Shuy, 2002, p. 98). Slots 1, 2, 3 and 5 were optional. Slot 4 was obligatory. For Woodroast slot 4 was the dish, slot 3 was the style of food and was filled with “Woodroast”. This demonstrated successfully, using semantics as linguistic tool, that “Woodroast” represents a style of food and not the dish itself, as Shelly's Woodroast stated.

In other words, the linguistic tools used here were the following:

- Morphology: Shelly's Woodroast used the term "Woodroast" as a proper noun, only one word; other restaurants used "wood roasted", some of them with a hyphen between the morphemes; media articles also used variations of "wood roasted";
- Lexicography: there were no entries for "wood roasted"; none of the searches for "wood roasting" or "wood roasted" was capitalized, like a proper noun;
- Semantics: from the plaintiff's menu one can understand that "Woodroast cooking" was a style of food;
- Syntax: tagmemics, after a survey of hundreds of other restaurants, helped understand the five slots in the menu, "(1) self-congratulations, (2) method of cooking, (3) style of food, (4) the food item, and (5) serving modifications".

As shown in this section, Shuy's analysis consisted of a corpus-based structure which looked for all the occurrences of variations of the term "woodroast".

2.2. Steak n Shake Co. v. Burger King Corp – a linguistic battle over "Steakburger"

Butters (2010) was asked to provide his expertise in "Steak n Shake Co. v. Burger King Corp., 323 F. Supp 2d 983, 985 [E.D. Mo. 2004]" (Butters, 2010, p. 359). Steak n Shake Co., a chain of fast-food restaurants, claimed they had marketed one of their sandwiches a long time ago, a sandwich called "Steakburger". When Burger King Corp. presented a new sandwich with the same name, the linguistic dispute began. Burger King's defence team managed to win a first battle by stating that "steakburger" is a generic term and refers to a sandwich which contains steak. Steak n Shake argued that the term became a descriptive mark and had an important meaning for their brand.

Butters used dictionaries and lexicographical methods to conduct a thorough linguistic analysis regarding the term "steakburger":

The earliest dictionary record of the word *steakburger* that I found was that of the 1961 publication of the second edition of Webster's New Twentieth Century Dictionary of the English Language, Unabridged, 2^d edn (Publisher's Guild, Inc./World): *burger* [from *hamburger*] a combining form meaning sandwich of ground meat (and), as in *steakburger*, *cheeseburger*, etc. [Slang.]

A similar definition is found in the Shorter Oxford Dictionary on Historical Principles, 5th edn, 2002: *steak* ... Comb. & phrases: *steakburger* a *beefburger* made of minced *steak*. (Butter, 2010, p. 360)

Butters (2010) withdrew three key aspects from the analysis conducted up to this point: both definitions describe Steak n Shake's product; the period of forty years between the definitions shows that the use and meaning of the term has not changed and that it has become generic; the definition from 1961 has an exemplary role of an entire category of sandwiches with ground meat, with the suffix "-burger". To strengthen his analysis, he also looked for third-party uses, other competitors who use the term in a generic way as well. His corpus extended to newspapers and magazines from 1930 until the present day and resulted in a multitude of examples where "*steakburger*" was used generically, and not to refer to a specific product or meal.

In the end, the judge decided that "*steakburger*" has indeed a generic meaning due to the linguistic history of the term and Burger King won the case.

The linguistic tools used in this analysis are the following:

- Lexicographical Analysis: Butters consulted dictionaries, newspapers and magazines to determine how the term "*steakburger*" had been defined over time; due to the continuity of these definitions, he also proved that the term had been used in generic contexts;
- Morphology: he analysed constructions that included the morpheme "-burger"; and also checked the historical usage of the term.

Therefore, the analysis conducted by Butters in this case employed a corpus-based methodology which looked for all uses of the term "*steakburger*" and the lexical shifts it went through over the past years.

2.3. "McLanguage"

McDonald's, the giant fast-food marketer, sued Quality Inns, a hotel chain, because they intended in opening a new chain hotel named "McSleep Inns". The new hotel chain would not serve food and did not intend to steal from McDonald's reputation as they claimed. The hotels were planned to be built near restaurants.

McDonald's accused Quality Inns of trademark infringement and demanded that the name "McSleep Inns" be changed. They claimed that the hotel chain took advantage of the fast-food chain's reputation and it would cause confusion among customers. The hotel chain answered and claimed they did not infringe any trademark, did not presuppose false description of the origin of the name and that no other laws were violated. It was not the first time when McDonald's sued for similar reasons and actually won.

During the trial, McDonald's described one of their advertising campaigns in which Ronald McDonald, their advertising icon, had travelled to different states in America and taught children the so-called "McLanguage". This meant simply adding the "Mc-" prefix to various words, such as "McFries". Needless to say, this was concerning to many linguists and social scientists.

"Mc-" is a bound morpheme, which cannot occur in isolation. Having this said, this does not mean it can only occur in "McLanguage". Shuy was called as an expert witness and managed to prove, through a corpus analysis, that "Mc-" had many roles, besides those associated with the fast-food chain. It was clear to him that this bound morpheme, which was originally a Scottish and Irish patronym, had been subjected to a lexical shift and generalization. Initially, it had a meaning associated with family ancestry, but now it was also associated with speed, convenience and a basic nature. He also searched magazines, local and major newspapers and technical publications. Therefore, no one who read any of the publications he had selected would make any association between "Mc-" and McDonald's. Below are seven categories he identified afterwards. In categorizing these and other third-party citations by their meaning types, I separated them into seven divisions (see Lentine & Shuy, 1990).

1. Proper names: McGruff (the crime dog), MacThrift (a budget office supply store with a Scottish motif).
2. Alliterative patterns based on a proper name: Jim McMyth (football player Jim McMahan) and McVeto McKernan (a name given by protesting union workers to Maine governor John McKernan).
3. Acronyms: McDap (Mason County Drug Abuse Program) and McRIDES (Morris County Rides, a ride-sharing program).
4. McDonald's product names, which were not analyzed here for obvious reasons. I never disputed the fact that the "Mc-" morpheme has a strong association with McDonald's. Instead, I tracked its use into other quite different domains. Of the 150 articles gathered, I excluded 56 of them that were directly about McDonald's restaurants and/or about specific McDonald's products.
5. Macintosh Computer Products or related businesses, such as McTek (a computer discount store specializing in Macintosh products) and McToy (computer accessory for accelerating computer processing time). McDonald's and Macintosh had worked out their differences over these names in earlier agreements, making references to them useless in this context.
6. Parodies of a fast-food product or service: McChow Mein (a hypothetical name for a Chinese fast-food restaurant) and McMania (a hypothetical drive-through therapy clinic).
7. Other words that carried the meaning of basic, convenient, inexpensive, and standardized. This turned out to be a very long list that included such terms as McArt, McBook, McCinema, McEconomics, McJobs, McLube, McMail, McMedicine, McNewspaper, McPrisons, McTelevangelism, McPaper, and McYear (Shuy, 2002, p. 99).

The most important category was number 7: "basic, convenient, inexpensive, and standardized". Shuy went on explaining that:

If anything identifies McDonald's process of making, selling, and advertising its hamburgers, it is these four characteristics. Fast food is basic (not gourmet). You can find McDonald's stores virtually anywhere in the world (convenient). The product is relatively inexpensive (at least in most places at the time of the litigation). If you've had one McDonald's hamburger, you know that the next one will be just like it (standardized) (Shuy, 2002, p. 99).

Shuy was aware that his testimony had to stand strong against the linguist McDonald's had hired. He went on with his research and demonstrated that context was important as well and that "Mc-" did not always mean or refer to McDonald's. During the trial, he used the word "green" as an example:

I used the word *green* as an example in the sentence, *Give me the green!* If this sentence is spoken by a speaker holding a bank teller at gun point, it means something quite different from what it would mean when an artist purchases oil paint at an art supply store. In the sentence *The new mechanic was still a little green* we understand that *green* refers to inexperience, primarily from clues given by two other words in that sentence, *new* and *still*. I also pointed out that the context of the sentence alone does not always disambiguate the meaning of *green*. In the sentence *The young sailor was green* we cannot know for sure whether he was seasick or inexperienced. In such cases we have to look for larger context clues found in the surrounding text (Shuy, 2002, pp. 101-102).

Consumers were also an important part of the trial, as with any trademark case. The majority of the consumers asked to participate in a survey related to McDonald's in general, gave answers very close to Shuy's analysis. They mostly believe that the products are basic, uninteresting and convenient.

McDonald's linguist, however, did not go conduct any type of analysis and he stated that he was a theoretical linguist and he had no competency of determining the meaning of the prefix "Mc-". He also mentioned that any opinion he might share would be from the point of view of a native speaker of English. He talked about how most English words have three or four meanings, but no more, as opposed to the 27 meanings that Shuy had found and narrowed down to four: "basic, convenient, inexpensive and standardized". Why did this happen? Shuy had made available his early findings, before they were in a final state, ready to be presented. He explains how this served as a lesson for him never to reveal his work until he had set the pencil down.

Unfortunately, the judge agreed with both linguists, more or less, but emphasized how McDonald's had spent millions of dollars for advertising and for making a name for themselves. Shuy concludes by noting how "one can still wonder why it is that the expenditure of money can determine who can have ownership of a word, much less a prefix" (Shuy, 2002, p. 109).

The linguistic tools used here are the following:

- Lexical analysis: study of the use of the prefix “Mc-”;
- Semantic change analysis: study of the meaning of “Mc-” evolution over time; from the use in family names such as “MacDonald” to the meaning of “basic”
- Sociolinguistic analysis: study of the contexts the prefix appears in and how they change its meaning and interpretation.

As shown in this section, the analysis that Shuy conducted in this case implied a corpus-based approach which included all uses of the bound morpheme “mc-”.

3. Conclusions

As we have presented in the description of the cases above, linguists can have the opportunity to fulfil a very important role in a trademark case. The cases presented above implied the use of linguistic tools related to morphology, sociolinguistic analysis, semantic, syntactical and lexicographical analyses.

The first case we presented, *Woodroast v. Restaurants Unlimited* case, involved the following linguistic tools: morphology (Shelly’s Woodroast used the term “Woodroast” as a proper noun, only one word; other restaurants used “wood roasted”, some of them with a hyphen between the morphemes; media articles also used variations of “wood roasted”); lexicography (there were no entries for “wood roasted”; none of the searches for “wood roasting” or “wood roasted” was capitalised, like a proper noun); semantics (from the plaintiff’s menu one can understand that “Woodroast cooking” was a style of food); syntax (tagmemics, after a survey of hundreds of other restaurants, helped understand the five slots in the menu, “(1) self-congratulations, (2) method of cooking, (3) style of food, (4) the food item, and (5) serving modifications”) (Shuy, 2002, p. 98).

In the second case we presented, the term “steakburger” shows how a thorough analysis can protect the statute of a term. The linguistic tools used here were the following: lexicographical analysis (Butters consulted dictionaries, newspapers and magazines to determine how the term “steakburger” had been defined over time; due to the continuity of

these definitions, he also proved that the term had been used in generic contexts); morphology (he analysed constructions that included the morpheme “-burger”; and also checked the historical usage of the term).

The third and final case, McDonald’s v. Quality Inns, proved that even a bound morpheme, such as “Mc-”, can start a linguistic battle. The linguistic tools used here were the following: -lexical analysis (study of the use of the prefix “Mc-”); semantic change analysis (study of the meaning of “Mc-” evolution over time; from the use in family names such as “MacDonald” to the meaning of “basic”); sociolinguistic analysis (study of the contexts the prefix appears in and how they change its meaning and interpretation).

This paper showed the intersection between linguistic analysis and trademark cases, focusing on lexicographical, semantic tools, and syntactical analysis. Corpus-based data can establish whether a term functions as a proprietary name or has a generic character. Further research may compare linguistic strategies in trademark cases across different countries.

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