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Sorry, Subway: 'Footlong' is a generic term

In a recent review in the New Republic titled "The Incoherence of Antonin Scalia," U.S. District Judge Richard A. Posner writes a scathing critique of Scalia's new book, "Reading Law: The Interpretation of Legal Texts."

Justice Scalia's book (co-authored with Bryan Garner, editor-in-chief of Black's Law Dictionary) advocates what Posner calls "textual originalism" in judicial decision-making.

Scalia's book argues that judges, when interpreting a governing text such as a statute or contract, should "ascribe to that text the meaning it has borne from its inception" rather than speculate about the drafters' "extra-textually derived purposes." Posner complains that this methodology results in undue reliance on dictionaries, which can lead judges to myopic results.

He illustrates the point by attacking a case discussed by Scalia that looks to the dictionary to find out how to interpret the word "sandwich" in a lease (the landlord promised a sandwich shop that no leases in the shopping mall would be given to other shops that sell sandwiches).

We all think we know what a sandwich is, but maybe we shouldn't be so sure about that. Is a hot dog a sandwich? Posner says it is, but the Merriam-Webster Dictionary definition suggests otherwise. It defines a sandwich as "two thin pieces of bread, usually buttered, with a thin layer (as of meat, cheese or savory mixture) spread between them."

To emphasize the imprudence of relying too heavily on dictionaries, Posner picks apart the definition: "A sandwich does not have to have two slices of bread; it can have more than two (a club sandwich) and it can have just one (an open-faced sandwich). The slices of bread do not have to be thin ... The slices do not have to be slices of bread: a hamburger is regarded as a sandwich and also a hot dog ... "

My brain hurt for weeks trying to decide whether a hot dog (or a burrito) is a sandwich. Just as I was getting over it and willing to embrace my uncertainty, I had the cruel fate of coming upon an important new trademark case titled *Sheetz v. Doctor's Associates Inc.* (Sept. 5, 2013), decided by the Trademark Trial and Appeal Board.

In the *Sheetz* case, the board was called upon to answer the very question that had haunted me: Is a hot dog a sandwich?

The philological inquiry arose out of the attempt by sandwich purveyor Subway (owned by Doctor's Associates) to obtain a trademark registration for the term "footlong." This was no trifling matter for the board. Subway sold more than 4 billion "footlong" sandwiches in the last decade.

Most sentient beings are aware of Subway's annoying jingle hawking its $5 footlongs. Apparently not satisfied with having drummed the jingle into our heads and hearts, Subway felt that it could also claim trademark rights in the term "footlong." Subway's competitors who sold 12-inch sandwiches and hot dogs did not agree.

Sheetz Inc., a chain of gas stations and convenience stores, for one, opposed Subway's effort to obtain a federal registration, asserting that "footlong" is a generic term for any 12-inch sandwich.

Foot-long hot dogs were pervasive in American culture long before Subway first appeared in 1965. The long-standing use of "footlong" as a common name for a 12-inch hot dog would be a serious impediment to Subway's effort to register the word as a trademark. Sensing that it had bitten off more than it could chew, Subway narrowed its request by amending the application to cover only "sandwiches, excluding hot dogs."

INSIDE IP LAW

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The issue before the board then was whether "footlong" is a generic term for 12-inch sandwiches — that is, does the consuming public understand "footlong" to refer to the class of products that includes sandwiches other than hot dogs?

The board first addressed the misconception that to be generic, a term must be a noun rather than an adjective. Subway argued that "footlong" is not the name of a food product, but rather is an adjective referring to the length of the sandwich. The board rejected the adjective/noun dichotomy.

The fact that a term is an adjective does not preclude it from being generic (think of "light" for beer). "Genericness cannot be determined simply by applying prescriptivist rules based on parts of speech," according to the board.

The record in the case was replete with evidence showing that "footlong" has been widely used for many years in the food industry to refer to 12-inch sandwiches. The board was unwilling to give Subway a trademark monopoly over a term used by so many others to refer to the length of their sandwiches.

It held that the term was generic for any 12-inch sandwich, hot dog or not. The term does not merely describe a sandwich, but rather identifies a category of sandwiches.

Though it had already reached its conclusion without getting embroiled in hot dog semantics, the board weighed in on the hot dog conundrum for good measure. Subway had argued that hot dogs are not "sandwiches" and thus the board should not consider evidence that the term "footlong" is commonly used to identify a type of hot dog.

The board did not hesitate to take sides in the debate, boldly proclaiming "we find that a hot dog is a sandwich." That should settle the matter. All the foot-long hot dog evidence before the board was relevant. Judge Posner will no doubt be pleased with this commonsensical conclusion.

At the same time, Justice Scalia might be pleased to know that the basis for the board's confident proclamation was a dictionary. The board cited the Random House Dictionary, which tells us that a "hot dog" is "a sandwich consisting of a frankfurter in a split roll, usually eaten with mustard, sauerkraut or relish."

As any Chicagoan will tell you, and as Random House confirms, if there is ketchup on it, it's not a hot dog.