

## Funeral for a Brand:

How Trademarks Become Generic



ESCALATOR



CELLOPHANE



THERMOS



PILATES



ASPIRIN

# Trademarks 101

A word, name, slogan, symbol, design, or other designation that identifies and distinguishes the source of a product or service.





# Trademarks Must Be Distinctive!

In other words, the relevant consumers must recognize the mark as distinguishing the goods or services of one party from those of others.

# The Sliding Scale of Distinctiveness

- **Fanciful**
  - **Kodak®** for cameras
- **Arbitrary**
  - **Apple®** for computers
- **Suggestive**
  - **Chicken of The Sea®** for tuna fish
- **Descriptive**
  - **Park 'N Fly®** for airport parking services
- **Generic**
  - “apple” for apples

# Generic Terms

- Words that **name** a product are “generic.”
- A trademark or service mark that becomes generic is no longer entitled to protection.  
*(Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 194, 105 S. Ct. 658, 661, 83 L. Ed. 2d 582 (1985).)*
- Generic marks are subject to cancellation at any time.
- A generic mark lacks protection even if it is incontestable.
- Generic terms lack distinctiveness and cannot function as trademarks.

# Generic Terms

**Theory** – Everyone has a right to use the name of a product to identify the product, so the name can never identify and distinguish a unique source of the product.



# What are some trademarks used for these products?





# What are some generic terms for these products?



# Can Trademarks Become Generic?

- **Yes**, if the public comes to understand the trademark to be the name of the product itself as opposed to identifying an exclusive source of the product.
- If this happens, competitors of the trademark owner may have the right to use the term to name the product.

# Examples of Trademarks That Are Now Generic Terms

## Escalator

Held generic for  
moving staircase

*Haughton Elevator Co. v. Seeberger  
(Otis Elevator Co.), 85 U.S.P.Q. 80  
(Comm. Pat. 1950)*





# Examples of Trademarks That Are Now Generic Terms

## Thermos

Held generic (in the United States) for vacuum-insulated bottles



*King-Seely Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963)

# Examples of Trademarks That Are Now Generic Terms

## Cellophane

Held generic for transparent cellulose sheets



*DuPont Cellophane Co. v. Waxed Prods. Co.*,  
85 F.2d 75 (2d. Cir. 1936)

# Examples of Trademarks That Are Now Generic Terms

## Aspirin

Held generic (in the United States) for acetylsalicylic acid pain reliever

*Bayer Co., Inc. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921)



# More Recently

## Pilates

Held generic for a form of exercise

Pilates, Inc. v. Current Concepts, Inc., 120 F. Supp. 2d 286 (S.D.N.Y. 2000)



# Evidence Considered in Determining Genericness

- Dictionary definitions
- Generic use by competitors and others in the trade
- The trademark holder's own generic use
- Generic use in the media
- Consumer surveys
- Alternative generic words

# Preventing a Trademark From Becoming Generic

To prevent the public from coming to understand the trademark to be the name of the product itself, the trademark owner should use the term properly...



# Advertising & Correspondence

Do not use the trademark as the name of the product itself in your own advertising or internal correspondence.

# Plurality

Use the generic term for the product, not the trademark, to show plurality:

- **Correct:** Two Gillette razors
- **Incorrect:** Two Gillettes

## Not a Verb

Do not use a trademark as a verb.

**Correct:** “Please make copies of this report using the Xerox® copier.”

**Incorrect:** “Please Xerox this report.”



# Identify the Trademark as Such

Identify the trademark as a trademark by using **capital letters or quotes** to depict the trademark:

BUDWEISER or “Budweiser”

# Identify the Trademark as Such

Identify the trademark as a trademark by using a **generic term** following the trademark:

BUDWEISER beer

# Identify the Trademark as Such

Identify the trademark as a trademark by using the word “**brand**”:

BUDWEISER brand beer



# Identify the Trademark as Such

Identify the trademark as a trademark by using the appropriate **trademark symbols**:

Budweiser<sup>®</sup> beer

# Identify the Trademark as Such

Identify the trademark as a trademark by using the **statements** indicating that the trademark is a trademark:

“Budweiser<sup>®</sup> is a trademark of Anheuser-Busch, Inc.”

# Create a Generic Term for a Product

If the product is new and there are no existing generic terms for the product, create a generic term at the same time you create the trademark.



# Create a Generic Term for a Product

If the existing generic term is one that would be complicated or difficult for people to understand, find or create a more simple generic term.

Which is easier for people to understand—  
“acetylsalicylic acid” or  
“pain reliever”?

# Create a New Product Category

If your trademark is at risk of being considered a generic term for a particular type of product, use the at-risk mark for a different product and tout the fact that the mark is a brand for a line of products:

ROLLERBLADE for in-line skates  
ROLLERBLADE for a line of  
skating equipment (e.g.,  
pads, sticks, helmets, etc.).

# Friendly Letter

If members of the **media** misuse the trademark as a generic term, consider sending a friendly letter explaining how they misused your mark and asking them to use your trademark correctly.



# Consult Your Trademark Counsel

If a **competitor** misuses the trademark as a generic term, consult your trademark counsel about whether and how to object to the misuse.

# Can You “Recapture” a Trademark That Has Become Generic?

Maybe, but only in those very rare circumstances in which the public no longer understands the term to be the name of the product itself . . .

# Recapture

## SINGER for sewing machines

*Singer Mfg. Co. v. Briley*, 207 F.2d 519 (5<sup>th</sup> Cir. 1953)

# What Went Wrong?

- Escalator
- Thermos (in the United States)
- Cellophane
- Aspirin (in the United States)





# Questions?



