Funeral for a Brand:
How Trademarks Become Generic
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.
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

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.
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® beer
Identify the Trademark as Such

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

“Budweiser® 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 (5th Cir. 1953)*
What Went Wrong?

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