

Death by popular demand

With popularity comes the spectre of genericide, but brands can resuscitate marks by taking some simple steps, as **Melanie J Howard** explains

It is strange to think that aspirin, escalator, zipper, cellophane, thermos and pilates were once trademarks. Over the years, the public adopted these terms to refer to a category of product, rather than to the specific manufacturers, and the brand owners lost their exclusive right to each of these terms.

Kleenex, Xerox and Velcro have faced similar challenges, and have launched now-famous marketing campaigns to educate fans and consumers about the importance of using Kleenex tissues, photocopying on a Xerox copier, and fastening a Velcro hook and loop strap. Most recently, Google fought to preserve its trademark rights in the famous brand in a battle that went all the way to the Supreme Court of the US.

The case originated in a domain name dispute. In 2012, Chris Gillespie registered 763 domain names that included the word 'google'. Google objected and filed a complaint with the National Arbitration Forum. Relying upon its federal trademark registrations for the Google mark, Google argued that Gillespie's domain name registrations violated the Uniform Domain Name Dispute Resolution Policy, which is incorporated in the domain name registrar's terms of use. Noting that "Google is the fourth most well-known brand of the world," the NAF found that Google had established the requisite distinctiveness of, and its legitimate rights in, the Google mark; that Gillespie lacked any rights in the disputed domain names; and that Gillespie's actions constituted a pattern of bad faith domain name registration. The NAF ordered the registrar to transfer the domain names to Google.

During the NAF proceeding, Gillespie filed petitions with the Trademark Trial and Appeal Board to cancel two of Google's federal trademark registrations on the grounds that the Google mark had become the generic name for the goods or services on which it was used. David Elliott, later joined by Gillespie, petitioned an Arizona district court to cancel the Google federal trademark registrations under Section 14 of the Lanham Act, which permits cancellation if the trademark is primarily understood as a "generic name for the goods or services, or a portion thereof, for which it is registered." Elliott moved for summary judgment, arguing that the word 'google' is primarily understood as a generic term universally used to describe the act of "internet searching". He maintained that most people use 'google' as a verb (eg,

"I googled it"). In fact, the term 'google' was added to the Oxford English Dictionary in June of 2006 as a verb, specifically referencing the Google search engine: "To use the Google search engine to find information on the internet" and "To search for information about (a person or thing) using the Google search engine."

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The district court in *Elliott v Google Inc* rejected Elliott's arguments. On appeal to the Ninth Circuit, Elliott argued that the district court had misapplied the primary significance test and failed to recognise the importance of verb use. The Ninth Circuit disagreed, affirming the lower court's ruling. The Ninth Circuit noted that Elliott failed to recognise that a genericide claim must always relate to a particular type of good or service, and that he erroneously argued that using a word as a verb automatically constituted generic use. Rather, genericide happens when the primary significance of the registered trademark to the public is "as the name for a particular type of good or service irrespective of its source." Elliott appealed yet again, but, in October last year, the Supreme Court of the US declined to review the Ninth Circuit's ruling.

Google's hard-won victory highlights that loss of trademark protection is a very real risk for highly successful brands. Under US trademark law, genericide is a form of abandonment. A mark can be abandoned "[w]hen any course of conduct of the owner... causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark."

To determine whether a mark has lost its significance in identifying a source or manufacturer, courts will consider dictionary definitions,

generic use of the term by the media, unchallenged generic use by competitors, the brandowner's own generic use and consumer surveys.

Brands can guard against genericide with a few straightforward steps:

Remind the public of the appropriate generic term for the product or service

When launching a marketing campaign for a new product, reference both the distinctive mark and the generic term for the product. The risk of genericide is particularly high for the first entrant into a new market with no competing products or services (such as new technologies) and therefore no commonly accepted generic name. Unless the brand takes initiative to publicise the generic name alongside the trademarked name, the public could adopt the trademark as the generic name. The term "pilates" is a case in point.

Joseph Humbertus Pilates developed an innovative method for conditioning and strengthening the body, obtaining patents for several pieces of equipment he invented. Mr Pilates encouraged others to teach his methods and never took actions to prevent third parties from using his name to describe the exercises they were teaching. When a successor-in-interest sought to enjoin use of the term 'pilates' by a third party, the US District Court for the Southern District of New York found that the mark 'pilates' had become generic. The court in *Pilates, Inc v Current Concepts, Inc* relied in part on evidence that "plaintiff and its predecessors, starting with Mr Pilates himself, have used the word Pilates in a generic sense to describe a method of exercise."

Always use the mark as an adjective, not as a noun

'Escalator' was the brand of the first moving staircase. In *Haughton Elevator Co v Seeberger*, the Otis Elevator Co lost the trademark when the US Patent Office ruled that it had used the term "escalator" as a generic descriptor in its own patents. Xerox, seeking to reclaim its brand from possible genericide, ran a series of ads in the 1990s educating the public on proper use of its trademark, "You can't Xerox a Xerox on a Xerox ... But we don't mind at all if you copy a copy on a Xerox copier."

Never use the mark as a verb

As the Ninth Circuit noted in the *Gillespie* case, using a trademark as a verb (to zipper, for example) does not automatically constitute use sufficient to cause genericide. The relevant analysis is the 'who-are-you/what-are-you' test, "If the relevant public primarily understands a trademark as describing 'who' a particular good or service is, or where it comes from, then the mark is still valid. But if the relevant public primarily understands a mark as describing 'what' the particular good or service is, then the mark has become generic." Only when the public associates the mark with a product, rather than the manufacturer, does the mark run the risk of being considered generic.

Do not use the mark in the possessive or plural form

The manufacturer of 'Singer' sewing machines advertised and referred to its product as 'Singers', without consistently adding 'sewing machines'. In an infringement case brought by the Singer Manufacturing Company against its main competitor, the US Supreme Court in 1896 found that 'Singer' had become the generic term defining a particular type of sewing machine rather than to the manufacturer. (In the 1950s, Singer was able to reclaim its trademark, in a case that remains an outlier).

Ensure the mark is used consistently and distinctively

Use the same spelling, format and spacing every time the mark is used in writing. (ZIPLOC; not ziploc or ZipLoc). Use italics, capitalisation or other stylisation to distinguish the mark in text.

Use the appropriate ®, ™ and ℠ notifications and ownership statements

Proper trademark notification differs across international territories. In some jurisdictions it is required; in others it is optional. When used in US advertising materials, the ® symbol may only be used if the trademark is federally registered in the US for the specific goods and/or services in connection with which it is being used. The ™ or ℠ may be used to denote that a certain term, logo or tagline is a trademark, and it helps to distinguish the mark. Seeking to underscore the distinctiveness of its registered trademark, the owner of the FRIDGIDAIRE brand ran a public relations campaign in the 1960s, "The Word Fridgidaire Always Ends With A Capital 'R'." Brand websites, press releases and – where feasible considering space constraints – advertising and marketing materials should include a statement of trademark ownership – eg "GOOGLE® is a registered trademark of Google, Inc."

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Expand the product offering under the mark

The Band-Aid trademark originated in connection with adhesive bandages. You may recall the jingle "I am stuck on Band-Aid, and Band-Aid's stuck on me!" In fact, the 1970s commercial included two renditions of the phrase: at the beginning of the song, the word 'brand' was included after Band-Aid mark; however, in subsequent phrases, the word 'brand' was omitted. Due to the ubiquitous popular usage of 'band-aids' to refer generally to adhesive bandages, Johnson & Johnson sought to reclaim the distinctiveness of its trademark by expanding into other product categories, including antibiotic and pain relief preparations and foot care products.

It is a paradox of popularity: the more successful a brand is, the more pervasive its market penetration, the greater the risk that its trademarks could be susceptible to death by genericide. To avoid this peril, brands should adopt consistent practices for correct use of their marks (see Google's rules here: <https://www.google.com/permissions/trademark/rules.html>), and educate fans and the general public so that third-party uses of the marks are proper and reinforce the distinctiveness and source-identifying function of the marks (see Velcro Brand's humorous example here: <http://www.velcro.com/about-us/dontsayvelcro/>).

Brands may not be able to police every use of their trademarked names by the general public, but appealing directly to consumers and the media is worth the effort.

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