Preventing Trademarks from Becoming “Generic”

Trademarks are words, symbols, phrases and/or logos used on goods or services to enable consumers to identify the source of those goods or services. Laws exist which protect trademarks from being misused in an effort to avoid consumer confusion and unfair competition among businesses. However, only certain marks may function as a trademark and thus receive protection. A mark must be "distinctive" in order to function as a trademark. A trademark owner's mark is "distinctive" when it distinguishes their goods or services from other similar goods or services. A generic mark may never function as a protected trademark.

Categories of Trademarks

Generally, there are five categories of marks. A "fanciful" mark is one that has been invented and has no dictionary meaning, such as "Kodak" film. An "arbitrary" mark is a common term used for an unrelated good or service, such as "Apple" for computers. A "suggestive" mark is a term which suggests, but does not describe the product for which it is used, such as "Microsoft" for computer software. A "descriptive" mark actually describes the good or service such as "Personal Finance" for a for a financial investment magazine. Finally, "generic" marks are terms that actually name the good or service for which it is used, such as "aspirin" for acetylsalicylic acid.

Generic Marks May Never Function as Trademarks

A mark must at a minimum be "distinct" to function as a trademark and thus receive legal protection. The distinctiveness or "strength" of a mark will vary according the category into which it falls. Generally, fanciful, arbitrary and suggestive marks are considered to be inherently distinct. Descriptive marks are not distinct unless the owner can prove that their mark is understood by the public as a "secondary meaning," of the term or phrase. Upon such a showing a descriptive mark may "acquire" distinctiveness and function as a trademark. Generic marks are never able to function as trademarks. Rather, generic marks are in the public domain and anyone has a right to use them.

Genericized Trademarks

Once established, it is possible for a trademark to become generic. Trademarks that are "genericized," can no longer function as trademarks. As a result, the owner of a genericized trademark loses all enforceable trademark rights and protections. Genericization of trademarks can occur when the trademark is misused by the public,
such as when the brand name of a product becomes associated with the actual product itself rather than with its source.

Genericization may also result when a trademark owner fails to maintain active use of their mark or to enforce their rights in the mark, such as through an infringement action. However, trademarks are legally declared "generic" only upon a hearing and court ruling.

**Former trademarks that are now used generically include:**

- Aspirin
- Cellophane
- Bikini
- Cola
- Granola
- Tollhouse cookie (Nestle lost trademark rights in the 1970s)
- Zipper
- Yo-yo
- Escalator

When a federally registered trademark is later deemed generic, the U.S. Patent and Trademark Office will cancel or invalidate the registration. Anyone is then free to use the term without fear of a trademark infringement lawsuit.

**Protecting Trademarks from Becoming Genericized**

Examples of current trademarks that have been considered "at risk" of becoming genericized include Xerox for copiers, Band-Aid for adhesive bandages and Kleenex for tissues. To prevent genericization of their mark, trademark owners must actively campaign to cease any misuse of the mark. For example, trademark owners may request web page authors, dictionary editors and/or the general public to stop using their trademark incorrectly and to begin using it properly. The "proper" use of a trademark is to use the mark as an adjective, not a noun or verb.

One successful example of preventing genericization of a trademark is Xerox. Xerox has expended large sums of money in marketing and advertising to prevent the misuse of its trademark so as to avoid losing it. The owners of the Xerox trademark have launched print ads which advise consumers that they cannot "Xerox" a document, but they can "copy it" on a Xerox brand copy machine.

Another way trademark owners have attempted to prevent the loss of their mark to genericization is by including the word "brand" after their trademark. For example, Johnson & Johnson changed their ad campaign from, "I am stuck on Band-Aids, 'cause Band-Aid's stuck on me," to "I am stuck on Band-Aid brand, 'cause Band-Aid's stuck on me."

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