

Marketers, Trademark Attorneys & Trademark Use: Is The Tension Justified?

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GENERAL MILLS

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STRATEGIC NAME
development.
A Brand Naming Consultancy

Dean **R.** Karau, Esq.

Fredrikson
& BYRON, P.A.

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ASPIRIN

ESCALATOR

CELLOPHANE

HEROIN

LINOLEUM

MIMEOGRAPH

TRAMPOLINE

SPANDEX

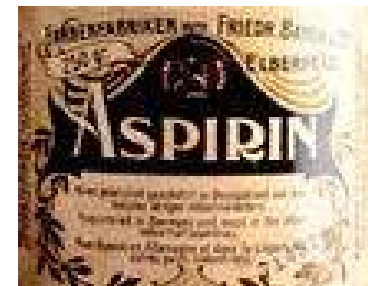
YO-YO

ZIPPER



“Will our mark be next?”

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A slippery slope?

Typical Trademark “Rules” of Use

Do:

1. Do use a trademark in distinct type.
2. Do use a mark as an adjective.
3. Do use a mark with notice of its status.

Don'ts:

1. Don't use a mark as a noun.
2. Don't use a mark as a verb.
3. Don't change a mark's form.
4. Don't use a mark in a possessive form.

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If a trademark is misused it could come undone.

If you didn't know zipper was a trademark, don't worry, it's not. But it used to be. It was lost because people misused the name. And the same could happen to ours, Xerox. Please help us ensure it doesn't. Use Xerox only as an adjective to identify our products and services, such as Xerox copiers, not a verb, "to Xerox," or a noun, "Xeroxes." Something to keep in mind that will help us keep it together.

xerox.com

Ready For Real Business **xerox** 

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PLEASE DON'T FOOL AROUND WITH OUR NAME.

Every now and then, the most confusing conversation in the world takes place. Here it is.

"Let's Federal Express it."

"Okay. Who should we use?"

"Let's just Federal Express it."

"Okay. Who should we use?"

Please. "Federal Express" is not a phrase that refers to anybody and everybody in the overnight package business.

Federal Express is a name. Our name. In fact, our trademark. Which is why when you ask for Federal Express, you should get no one but Federal Express. A single, specific air express company that happens to deliver more packages to more places overnight than any other air express company. And, for the last ten years, has earned its reputation as the most reliable in the business.

So, let's make a deal.

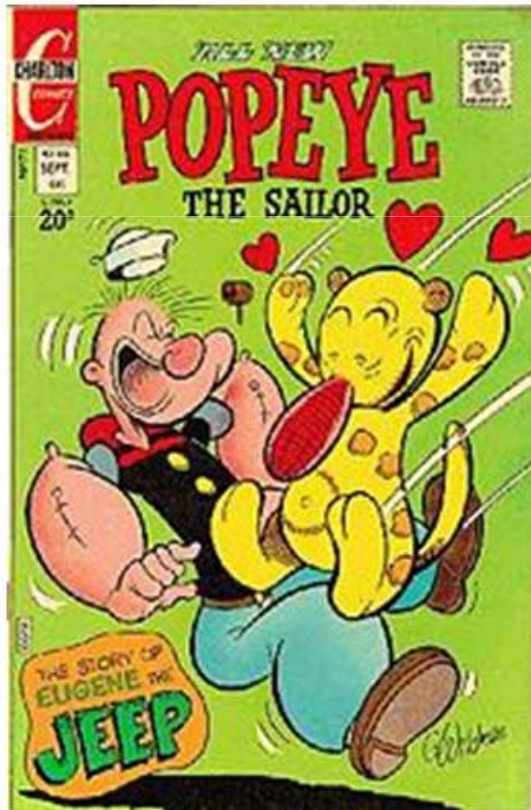
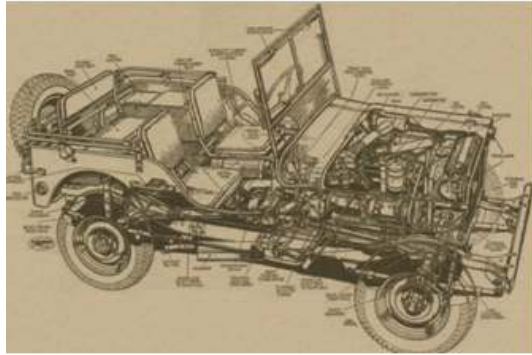
We'll try not to lose your packages.

Please try not to misplace our name.

FEDERAL EXPRESS
WHY FOOL AROUND WITH ANYONE ELSE?

*Federal Express™ is a registered trademark of the Federal Express Corporation. ©2011 Federal Express Corporation.

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They invented "SUV" because they can't call them Jeep.



Jeep is a registered trademark. Good thing. No telling what kind of jacked-up station wagons they'd be trying to pass off as Jeep vehicles otherwise. Because sometime around the mid-80s, a craze took off.

The era of the SUV was born. Fact is, we had them beat by a few decades. As soon as the mighty little Jeep vehicle came back from World War II, people discovered how much fun a utility vehicle could be. What made it perfect for the army made it perfect for having a picnic in the hills. Or a hunting trip.

Or a snowy drive up to the cabin. And ever since, our vehicles have had a heritage of earning their name by getting the tires dirty and doing what comes naturally. Each is rugged enough, dependable enough, unstoppable enough, and agile enough to be a Jeep all-purpose, fun-making machine. When heading straight out into the unknown, it's good to know you're going there in a vehicle that's been heading down that muddy road from the beginning. That's Jeep 4x4. And that's a heritage no



"SUV" can ever stake claim to. Jeep.com

Have fun out there. Jeep

But This Is A Noun



The 1985 Jetta \$7995.  **It's not a car.
It's a Volkswagen.**

This Could Be A Verb



Why BING?


It has potential

"to verb up."

Steve Ballmer
Microsoft CEO

And This Is A Verb

Are you just
investing,
or are you
Vanguarding[™]?

Learn more about Vanguarding 

Access your accounts and timely investment information. Learn about retirement investing, mutual funds, ETFs, IRAs, 401(k) plans, college savings plans, brokerage, advice services, and more.

[Go to the Personal Investors site »](#)



Vanguard[®]

What Will Your Mark Become?

The next

G Or g le



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Test for Genericness

- **Section 14 of the Trademark Act, 15 U.S.C. §1064(3):**
- **"The primary significance of the registered mark to the relevant public ... shall be the test..."**
- **In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009)**

Abandonment of Mark:

- **Section 45 of the Trademark Act, 15 U.S.C. §1127:**
 - "A mark shall be deemed to be 'abandoned' if either of the following occurs:
...
(2) When any course of conduct of the owner, including acts of omission as well as commission, 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.
..."

Evidence of Genericness

Trademark owner's misuse of its own mark is very persuasive evidence

- **CVP Systems, Inc. v. M-Tek Incorporated, 32 USPQ2d 1951 (ND IL 1994):**

“The picture that has emerged from the evidence of record is that respondent, in its efforts to persuade the poultry industry . . . to use its packaging machines, attempted to generate recognition by equating the brand with the product. **These attempts succeeded** and those connected with the poultry industry began to view and use CVP in a generic manner for packaging machines and the packaging process.”

(Emphasis added.)

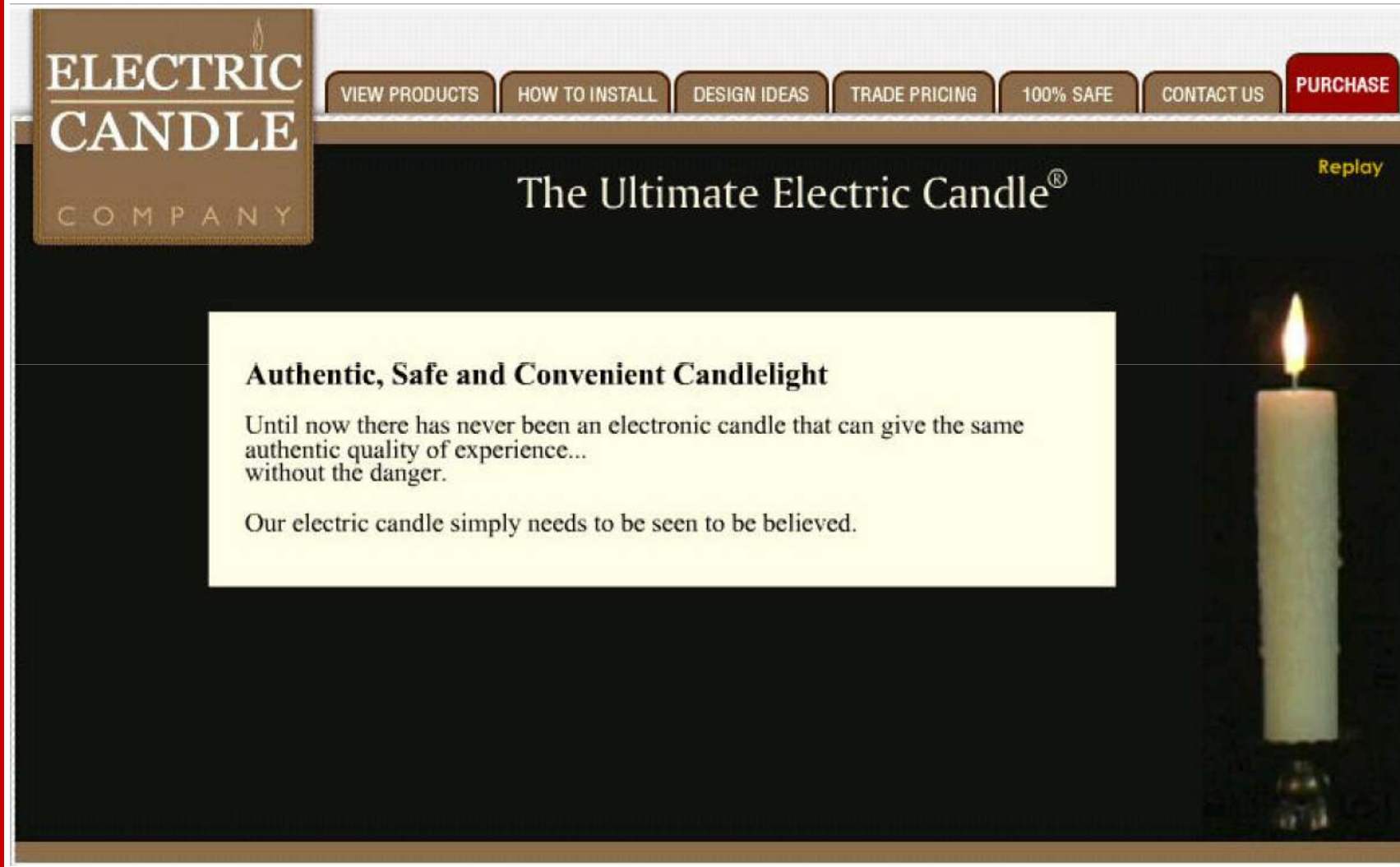
Cont'd: Evidence: owner's misuse

- **In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987)**
 - **SCREENWIPE generic for cloths for cleaning computer and television screens**

Cont'd: Evidence: owner's misuse

- **In re Wm. B. Coleman Co., 93 USPQ2d 2019 (TTAB 2010)**
 - **ELECTRIC CANDLE COMPANY generic for lighting fixtures**

Cont'd: Evidence: owner's misuse



The screenshot shows the website for the Electric Candle Company. At the top left is the logo for "ELECTRIC CANDLE COMPANY". To the right of the logo is a navigation menu with buttons for "VIEW PRODUCTS", "HOW TO INSTALL", "DESIGN IDEAS", "TRADE PRICING", "100% SAFE", "CONTACT US", and "PURCHASE". Below the navigation menu is the main heading "The Ultimate Electric Candle®" with a "Replay" button to its right. In the center of the page is a white text box with the following text:

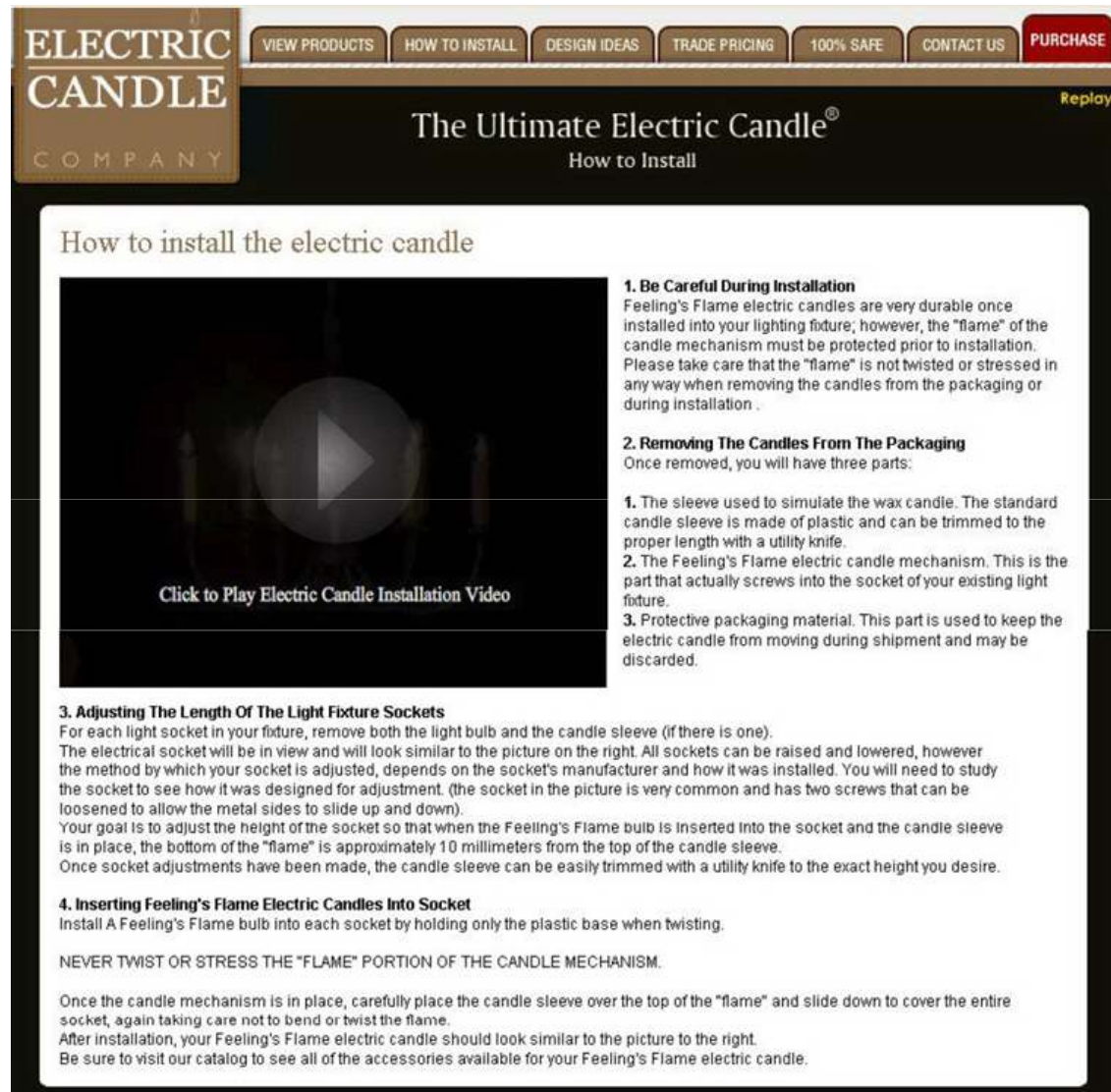
Authentic, Safe and Convenient Candlelight

Until now there has never been an electronic candle that can give the same authentic quality of experience... without the danger.

Our electric candle simply needs to be seen to be believed.

On the right side of the page, there is a photograph of a lit white candle in a glass holder, set against a dark background.

Cont'd: Evidence: owner's misuse




ELECTRIC CANDLE COMPANY

VIEW PRODUCTS HOW TO INSTALL DESIGN IDEAS TRADE PRICING 100% SAFE CONTACT US PURCHASE

The Ultimate Electric Candle®
How to Install

How to install the electric candle



Click to Play Electric Candle Installation Video

1. Be Careful During Installation
Feeling's Flame electric candles are very durable once installed into your lighting fixture; however, the "flame" of the candle mechanism must be protected prior to installation. Please take care that the "flame" is not twisted or stressed in any way when removing the candles from the packaging or during installation.

2. Removing The Candles From The Packaging
Once removed, you will have three parts:

1. The sleeve used to simulate the wax candle. The standard candle sleeve is made of plastic and can be trimmed to the proper length with a utility knife.
2. The Feeling's Flame electric candle mechanism. This is the part that actually screws into the socket of your existing light fixture.
3. Protective packaging material. This part is used to keep the electric candle from moving during shipment and may be discarded.

3. Adjusting The Length Of The Light Fixture Sockets
For each light socket in your fixture, remove both the light bulb and the candle sleeve (if there is one). The electrical socket will be in view and will look similar to the picture on the right. All sockets can be raised and lowered, however the method by which your socket is adjusted, depends on the socket's manufacturer and how it was installed. You will need to study the socket to see how it was designed for adjustment. (the socket in the picture is very common and has two screws that can be loosened to allow the metal sides to slide up and down). Your goal is to adjust the height of the socket so that when the Feeling's Flame bulb is inserted into the socket and the candle sleeve is in place, the bottom of the "flame" is approximately 10 millimeters from the top of the candle sleeve. Once socket adjustments have been made, the candle sleeve can be easily trimmed with a utility knife to the exact height you desire.

4. Inserting Feeling's Flame Electric Candles Into Socket
Install A Feeling's Flame bulb into each socket by holding only the plastic base when twisting.

NEVER TWIST OR STRESS THE "FLAME" PORTION OF THE CANDLE MECHANISM.

Once the candle mechanism is in place, carefully place the candle sleeve over the top of the "flame" and slide down to cover the entire socket, again taking care not to bend or twist the flame.
After installation, your Feeling's Flame electric candle should look similar to the picture to the right.
Be sure to visit our catalog to see all of the accessories available for your Feeling's Flame electric candle.

Evidence of Genericness

Third-party uses of your mark

- competitors using it in a highly descriptive or generic manner,
 - media usage including by writers and journalists in articles,
 - use by anyone on websites,
 - including social media,
 - inclusion in dictionaries as a noun or verb relating to the goods or services
-
- **Surveys are important evidence regarding whether or not a term is generic as the test is "the primary significance of the mark to the relevant public"**

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Marketing Considerations

- Memorability
- Distinctiveness
- Fit to concept
- Emotional bonding
- Latent association
- Trademark availability
- URL/domain
- Brand architecture

Re-writing the Rules

- Semantics or Syntax?
- Nouns speak louder than adjectives
- Noun/verbs speak even louder



Sprint®



GUESS®
U. S. A.



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Verbing Up

The logo for 'oust' features the word in a dark blue, lowercase, sans-serif font. A light blue shadow is cast behind the letters, giving it a three-dimensional appearance.

The logo for 'ally' consists of the word in a lowercase, sans-serif font. The letter 'a' is purple, while the remaining letters 'lly' are black.

The logo for 'gather' is the word in a lowercase, sans-serif font, colored in a bright orange.

The logo for StumbleUpon features a circular icon on the left, split vertically with a green top half and a blue bottom half, containing a white stylized 'SU' monogram. To the right of the icon, the words 'StumbleUpon' are written in a grey, sans-serif font.

The logo for 'Ping' is the word in a grey, sans-serif font. A small blue musical note icon is positioned above the letter 'i'.

The logo for 'XING' is the word in a teal, uppercase, sans-serif font. To the right of the word is a yellow graphic element consisting of two chevron-like shapes pointing towards each other.

The logo for 'bing' is the word in a blue, lowercase, sans-serif font. The letter 'i' has a small yellow dot above it.

In other verbs

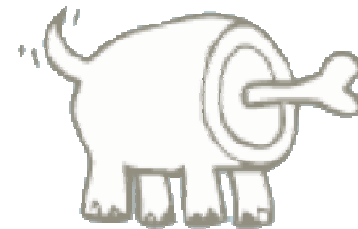
SPURL.NET



folkd.com

Tip'd

FARK.com



PLURK

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Considerations For Whether to Follow “The Rules”:

Is The Mark Really At Risk For Becoming Generic?



The 1985 Jetta \$7995:  It's not a car.
It's a Volkswagen.

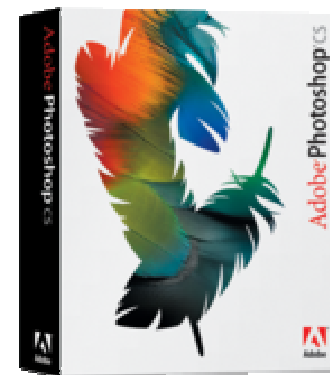
Considerations:

- **New type of product with no established generic name?**

- **Rollerblades®
(in-line skates)**



- **Photoshop®
(image editing software)**



Considerations:

- **Highly descriptive words for unique type of product?**
 - **Electric Candle Company**
(“lighting fixtures”)
 - **Screenwipe**
(cloths for cleaning computer & television screens)



Considerations:

- **Dominant market position?**

- **Xerox®**
(photocopiers)



- **Jell-O®**
(gelatin)



- **Q-Tips®**
(cotton swabs)



Considerations:

- User unfriendly generic (complicated / long / not well-known) combined with leading position?

- Jet Ski®
(personal watercraft)



- Aspirin
(acetylsalicylic acid pain reliever)



- Frisbee®
(flying disc)



Considerations:

- **In your experience, do people use the brand as a generic reference?**
- **Is it likely they ever will?**

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