

THE DAILY RECORD

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IP FRONTIERS

Police trademarks, prevent generic use

Aspirin...
Escalator...
Laundromat...
Pilates...
Thermos...
Yo-Yo...

At first glance, those words appear to have nothing in common, but upon closer examination it is clear each are genericized trademarks.

In other words, they are former brand names that once were legally protected as trademarks. They've since come to signify a generic product regardless of its source or manufacturer.

"Thermos" originally was a trademarked name for a vacuum flask owned by King-Seeley Thermos Co., but was declared generic in the United States in 1963. See *King-Seeley Thermos Co. v. Aladdin Industries Inc.*, 321 F.2d 577 (Second Cir. 1963).

The examples I've mentioned provide an important reminder of the need to police trademarks and prevent generic use to ensure those marks remain strong and enforceable throughout the lifetime of a business.

Generic terms are common words, often found in the dictionary, that identify products and services and are not specific to any particular manufacturer or source. Once a mark is determined to be generic, rarely, if ever, can it be protected legally as a valid mark. Even after obtaining a federal trademark registration or common law trademark rights, trademark owners must remain vigilant and take affirmative steps to protect their marks.

Preventing generic use

Trademark owners can take several steps to prevent generic use. As a preliminary matter, the trademark should be used as an adjective, not as a noun or a verb. Correct use of the Kleenex® trademark is: "Could you hand me a KLEENEX tissue?" An example of incorrect usage is: "Could you hand me a KLEENEX?"

Trademark owners should be sure to use a product's generic name with the trademark (e.g., APPLE computers, EXXON gasoline). The advertising campaign conducted by Xerox Corp.

is one example of affirmative action by a trademark owner to prevent generic use of a mark by encouraging users to "photocopy" documents, not "Xerox" documents.

More recently, Google Inc. has launched an aggressive campaign to prevent genericide of its famous Google™ trademark. It has cracked down on generic usages of the term "google," and is reinforcing use of the mark preceding a generic term, i.e., "GOOGLE search," "GOOGLE search engine," etc.

A trademark owner should use trademark notice, an important tool that provides the public notice of trademark rights for registered and unregistered marks alike. The use of ® with a federally registered trademark, and TM or SM to indicate the significance of a trademark or service mark, respectively, are effective precautions.

Companies also may find it useful to create internal and/or external guidelines for how a trademark may be used in advertising material, on a Web site, by sales persons, etc. Guidelines may include where and how often trademark notices — ®, TM, SM — appear and provide for consistent font type, size or style to help a mark stand out from surrounding text. Those steps should help consumers more easily distinguish between trademark terms and generic product names or descriptive text in product literature or advertising. Similarly, it is not wise to allow spelling changes, abbreviations, plurals or apostrophes with a trademark.

Trademark owners also should be sure to take such steps in company-produced product literature and advertising materials and enforce correct usage by third parties. It often may be the case that a third-party distributor, reseller or competitor who uses a trademark fairly to describe a company's product actually is using the trademark in a generic sense. In such cases, it may be helpful or necessary to contact the third party directly to advise them of the proper trademark use, e.g., that the trademark must be used as an adjective, followed by the generic name of the product, such as with Band-Aid® Brand adhesive bandages.



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Policing unauthorized use

Trademark owners are responsible for policing their own trademarks. Although the U.S. Patent and Trademark Office exists to help procure trademark rights, there are no official public agencies that police and protect trademarks. Owners must regularly monitor the market for any suspicious, generic or infringing trademark use.

To assist trademark owners in such efforts, there are several private trademark watch services that monitor the marketplace

for similar marks and alert trademark owners to potentially confusing, generic or infringing usages.

Imposing company guidelines to ensure the correct use of trademarks, and vigilant monitoring of the marketplace, whether by the trademark owner or a third-party service can mean the difference between an unenforceable trademark and a strong, enforceable mark with infinite potential to bring value to a business.

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