



PROGRAM MATERIALS

Program #31125

June 15, 2021

Is Genericide Still a Thing?

Copyright ©2021 by

- **Laura Winston, Esq. - Offit Kurman - Attorneys at Law**

**All Rights Reserved.
Licensed to Celesq®, Inc.**

Celesq® AttorneysEd Center
www.celesq.com

5255 North Federal Highway, Suite 100, Boca Raton, FL 33487
Phone 561-241-1919

Is Genericide Still a Thing?

Presented by:
Laura J. Winston,
Principal Attorney,
Offit Kurman

OVERVIEW

- THE BASICS: the continuum of distinctiveness
- What is genericness?
- What is genericide?
- Current state of genericide concerns

TRADEMARK DISTINCTIVENESS CONTINUUM

- Most to Least distinctive
 - Arbitrary or Coined:
 - APPLE for computers and phones
 - OREO for cookies
 - Suggestive:
 - TRAVELOCITY for travel booking web site
 - Descriptive:
 - THE PARAMEDIC COURSE for EMS education courses

GENERIC

- Definition from Oxford Languages:
 - characteristic of or relating to a class or group of things; not specific.
 - "chèvre is a generic term for all goat's milk cheese"
- A generic word cannot function as a trademark.

EXAMPLES

- ALE HOUSE (*Ale House Management, Inc. v. Raleigh Ale House*, 205 F.3d 137, 54 USPQ 2d 1040 (4th Cir. 2000))
- CLOUD TV (*In re Activevideo Networks, Inc.*, 111 USPQ 2d 1581 (T.T.A.B. 2014))
- MULTISTATE BAR EXAMINATION (*National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F. 2d 478 (7th Cir. 1982), cert. denied, 464 U.S. 814 (1983))

THE *BOOKING.COM* CASE

- General Principle pre-*Booking.com*:
 - HOTELS.COM:
- “We agree with the TTAB that for the mark here at issue, the generic term “hotels” did not lose its generic character by placement in the domain name HOTELS.COM.” *In re Hotels.com*, L.P., 573 F.3d 1300 (Fed. Cir. 2009).
 - LAWYERS.COM:
- *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376 (Fed. Cir. 2007).
- Then...

SECONDARY MEANING DOT YEAH

- *United States Patent and Trademark Office v. Booking.com, B.V.*, 591 U.S. ____ (2020)
- When is a generic word + “.Com” not generic? When the public doesn’t think so, according to the Supreme Court’s ruling.
- But it takes a great deal of advertising and investment in public recognition to reach the level of recognition as a trademark.
- The dispute over the registrability of “BOOKING.COM” began after Booking.com filed four federal trademark applications. A USPTO Examining Attorney rejected those applications based on the view that “BOOKING.COM” is generic and therefore **incapable of acquiring “secondary meaning”** as a trademark.
- In other words, as in *Hotels.Com*, because BOOKING is generic, and “.COM” is merely an identifier for use on the internet, “BOOKING.COM” is generic and not entitled to registration.

SECONDARY MEANING DOT YEAH

- Booking.com appealed the decision, first to the Trademark Trial and Appeal Board (TTAB), which sided with the USPTO.
- The company appealed again in the Eastern District of Virginia.
- Booking.com presented as evidence a survey showing that a majority (approximately 75%) of consumers recognize the name “BOOKING.COM” as a brand rather than a generic term for a reservation service. The Court was convinced and reversed the TTAB’s decision, determining that Booking.com had adequately differentiated its name from the generic term “booking.” The case was then brought to the Fourth Circuit Court of Appeals, which upheld the lower court’s decision. The USPTO appealed.

SECONDARY MEANING DOT YEAH

- 8-1 opinion written by the late Justice Ruth Bader Ginsburg: Calling the USPTO's rule against registration of generic terms paired with ".COM" "sweeping" and "nearly *per se*", the Court held that although "booking" is a generic term for hotel reservation services, adding the ".com" element rendered it a compound term that needs to be considered as a whole. "If 'Booking.com' were generic," the Court said, "we might expect Travelocity – another such service – to be a 'Booking.com.'"
- Justice Stephen Breyer's dissent: "The survey participants who identified 'Booking.com' as a brand likely did so because they had heard of it, through advertising or otherwise." But doesn't Justice Breyer's argument make the majority's point – that it is public recognition that gives "BOOKING.COM" its acquired distinctiveness and makes it eligible for trademark protection?

(More on this case at <https://www.offitkurman.com/blog/2020/07/02/u-s-supreme-court-booking-com-is-not-generic-and-is-entitled-to-trademark-registration/>.)

GENERICIDE

- Definition from Oxford Languages:
 - “the process by which a brand name loses its distinctive identity as a result of being used to refer to any product or service of its kind.
 - "chances are, your home abounds with registered trademarks that have fallen prey to genericide"

GENERICIDE

- Examples of generic terms that used to be trademarks:
- ASPIRIN (in the US), see *American Druggists' Syndicate v. United States Industrial Alcohol Co.*, 2 F.2d 942 (D.C. Cir. 1942).
- ESCALATOR, see *Haughton Elevator Co. v. Seeberger*, 85 USPQ 80 (Comm'r Pat. 1950).
- TRAMPOLINE, see *Nissen Trampoline Co. v. American Trampoline Co.*, 193 F.Supp. 745 (S.D. Iowa 1961).
- CELLOPHANE, see *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir. 1936), cert. *denied*, 299 U.S. 601 (1936).

GENERICIDE

- Companies go to great lengths to educate the public against genericide.
- Some rules for proper use of trademarks:
 - Use the trademark as an adjective that modifies a noun. Example: BAND-AID® bandages.
 - Don't use the trademark as a noun. This includes not using it in plural form, e.g. "Band-Aids"
 - Don't use the trademark as a verb.
- Long-running Xerox add: "Not even Xerox can Xerox"
- 2017 Velcro video – a humorous and educational PSA letting the public know it's not Velcro but hook-and-loop fasteners



<https://www.youtube.com/watch?v=rRi8LptvFZY>

THE GREAT SETH MEYERS/LEGO DEBATE OF FEBRUARY 2021

- On his show *Late Night with Seth Meyers*, Meyers was insulting the appearance of a politician and in doing so, mentioned “Legos”.
- A couple of days later on his show, he responded to comments he had received over social media



<https://www.youtube.com/watch?v=ntWLYFIEVUI>

THE GREAT SETH MEYERS/LEGO DEBATE OF FEBRUARY 2021

- But then, the brand owner got into the act:



- And Seth Meyers responded



<https://www.youtube.com/watch?v=DXGNqkmrcQI>

DO WE REALLY NEED TO WORRY ABOUT “PROPER USE OF TRADEMARKS”?

- GOOGLE as a verb
 - GOOGLE: a category killer in the search engine space, frequently used as a verb for internet searching
- *Elliott v. Google*, 860 F.3d 1151 (9th Cir. 2017), cert. *denied* 138 S.Ct. 362 (2017)
- Plaintiffs claimed that “google” is primarily understood as a “generic term used to describe the act of internet searching.” The evidence even included a quotation from Google’s founder Larry Page, who in 1998 said, **“Have fun and keep googling.”**

DO WE REALLY NEED TO WORRY ABOUT “PROPER USE OF TRADEMARKS”?

- District court granted summary judgment for Google, holding that the plaintiffs did not present sufficient evidence to show that the public primarily understands “google” to be generic. The plaintiffs appealed and the U.S. Court of Appeals for the Ninth Circuit upheld the lower court’s decision. I
- 9th Circuit opinion said repeatedly that verb use does not automatically render a mark generic. This conclusion was despite the fact that the plaintiffs submitted evidence of media references to “googled on Facebook,” “googled on eBay” and “googled on Pinterest,” and the rapper T-Pain telling listeners to “google my name.”

DO WE REALLY NEED TO WORRY ABOUT “PROPER USE OF TRADEMARKS”?

- Why is GOOGLE apparently safe from genericide? And does anyone not realize that LEGO is a specific brand, even if they refer to them as LEGOS?
- The answer may lie within the social media era. Back in the days when ASPIRIN, ESCALATOR and TRAMPOLINE became generic, a consumer's exposure to a brand was limited and passive. One might have encountered advertising in the newspaper, on the radio or later TV, or on billboards.
- Though advertisers have always had a goal of connecting with consumers in a meaningful way, the opportunities to do so are heightened today.

DO WE REALLY NEED TO WORRY ABOUT “PROPER USE OF TRADEMARKS”?

- Besides GOOGLE, BAND-AID, and LEGO, many other brands used as ordinary items
- UBER, KLEENEX, CLOROX, ROLLERBLADE, SCOTCH, TAPE, POST-IT, WITE-OUT, TASER, COKE, BUBBLE WRAP, CHAPSTICK, FRISBEE, JACUZZI, PHOTOSHOP, POWERPOINT

STEPS FOR BRANDS

- Brands can reach people through:
 - social media accounts
 - sponsored or targeted ads
 - influencer marketing
 - direct dialogue with a consumer
- In short, brands can now present themselves at times that consumers may have a need.
- This level of engagement reminds consumers that they are dealing with brands.

TAKEAWAYS

- We are probably not quite ready to discard the conventional wisdom about proper trademark use completely, but we may be able to approach it in a more relaxed manner, especially for consumer-centered brands that are active on social media and regularly engage with the consuming public.

QUESTIONS?



« **Laura J. Winston**

Principal Attorney, Offit Kurman, P.A.

Email: lwinston@offitkurman.com

Phone: 347.589.8536

Twitter and Clubhouse: @LauraWinston