

TRADEMARK & UNFAIR COMPETITION

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Class 4: Generic Marks

CLASS OUTLINE

- Generic Terms
- Genericide
- Genus determinations
- Surveys for genericism:
 - Teflon
 - Thermos

TYPES OF GENERIC MARKS

1. Initial finding of genericness (e.g., “Multistate Bar Examination” for legal testing); or
2. Genericide; i.e., through loss of distinctiveness (e.g., aspirin)

Standard Use Trademark Registration Procedure

- (1) File application (“use” or “1(a)”) with PTO
- (2) Application assigned to examiner to determine whether proper; examiner to communicate any problems to registrant (who has 6 months to cure)
- (3) Examiner makes final determination (denials appealable to Trademark Trials and Appeals Board (TTAB); and next to Federal Circuit)
- (4) Approvals are published in the Gazette, and objectors have 30 days to file. If no objection, registration issues (good for 10 years, renewable indefinitely so long as in use)

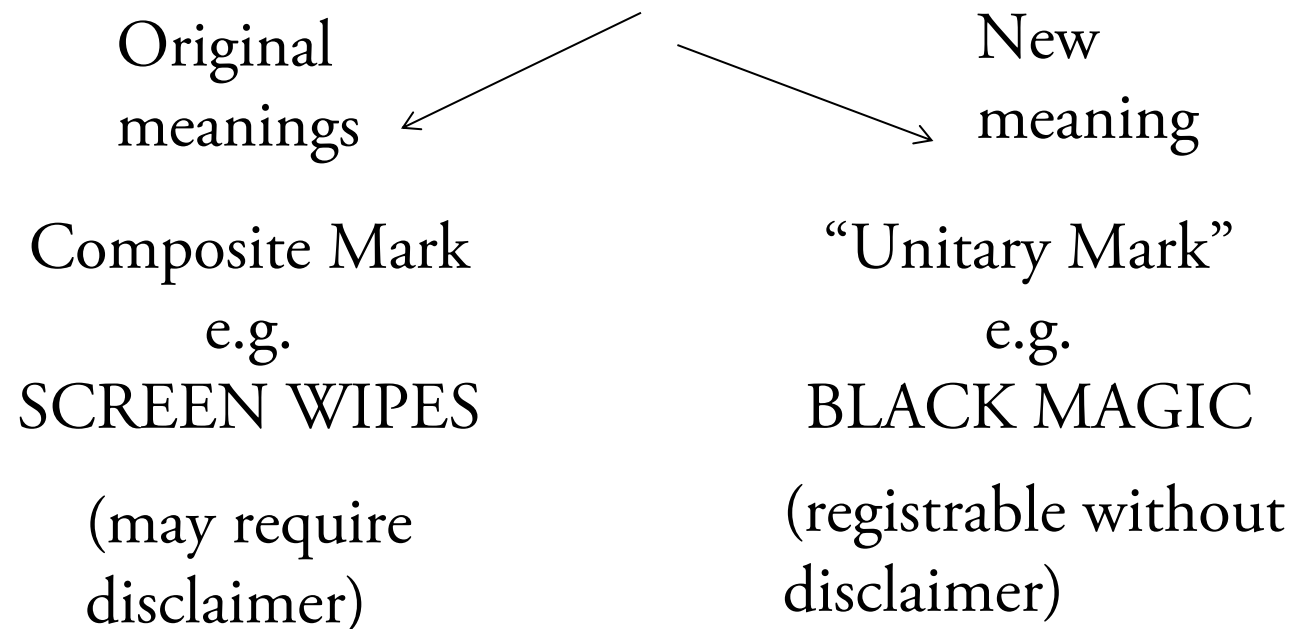
“Intent to Use” (ITU) Trademark Registration Procedure

- (1) File “Intent to Use” application
- (2) Application reviewed by examiner and, if found eligible, published for opposition (30-day period allowed for opposition filings)
- (3) If no opposition, PTO issues “notice of allowance”
- (4) Applicant has 6 months from issuance of “notice of allowance” to commence use and file a “Statement of Use” (one extension allowed, for cause, up to a total of 36 months)
- (5) Upon examination and approval of that “Statement of Use,” registration issues
- (6) **Once issued, priority of use back dates to date of initial “Intent to Use” application

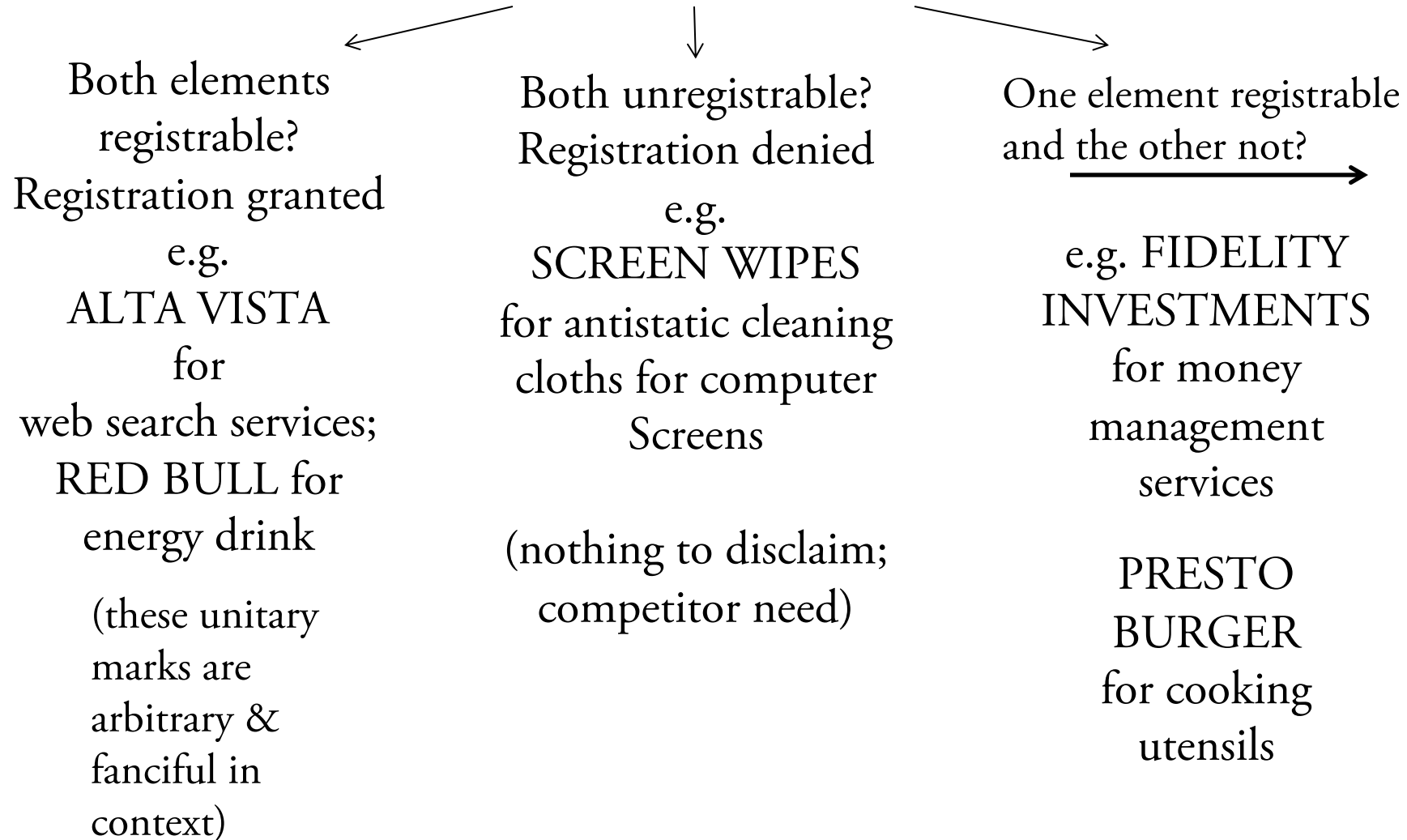
Composite Marks

Marks Involving Two or More Elements
(e.g., two words, or a word and a graphic design)

Do the elements retain their original meanings, or do they create a new meaning when joined together?



Composite Marks



Composite Marks

Composite Marks
where one element
registrable and the other
is not

Separate words:
Disclaimer of non-
registrable word
required

FIDELITY
INVESTMENTS
for money management
services

PRESTO
BURGER
for cooking utensils

Words joined or
creatively connected:
potentially no
disclaimer required

MEANMACHINE
for lawn mowing machine

RAIN-X
for waterproofing chemical

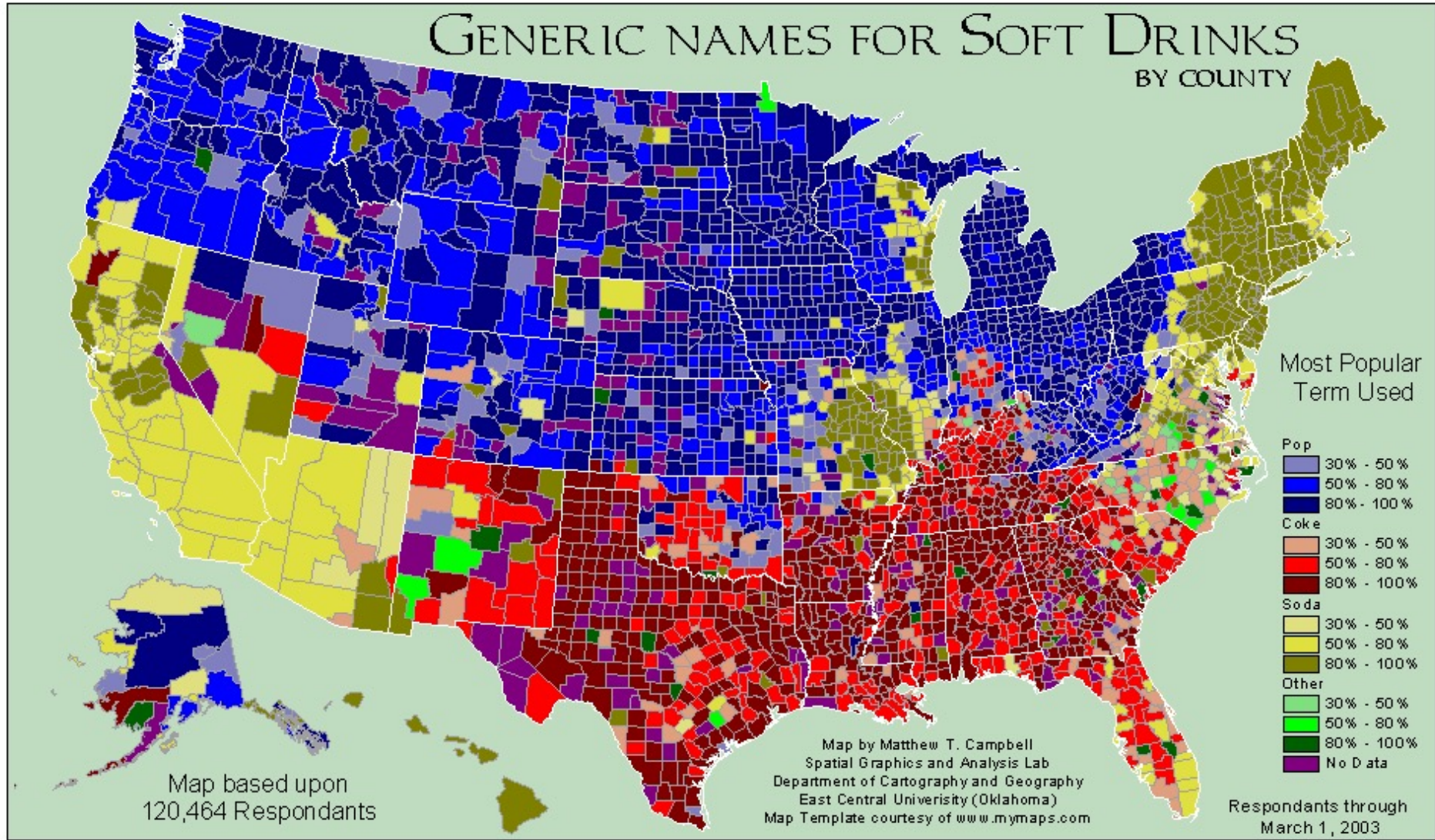
The “primary significance” test for genericness:

→ Is the “primary significance” of the mark intended to identify the product, or the producer?

1. What is the genus of the goods at issue?
2. Does the relevant public understand the designation primarily to refer to that genus of goods?

May be more complicated if there is more than one common name (e.g., soda, pop, coke, soft drink)

GENERIC NAMES FOR SOFT DRINKS BY COUNTY



More Genericide Victims

- Zipper
- Escalator
- Cellophane
- Thermos
- Aspirin
- Trampoline
- Kerosene
- Granola
- Brassiere
- Heroin (*a “suggestive” mark said to make the user feel “hero-ish,” according to its creators at Bayer)

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Avoiding Genericide

1. Use a compound name (i.e. a generic term *following the brand name):

e.g. Instead of “Zipper,” use “Zipper slide fastener” or

Instead of “Viagra,” use “Viagra sildenafil citrate” on all marketing materials

2. Use the word “brand”:

e.g. “Zipper brand slide fasteners”

Companies sometimes use the “TM” mark to make the same point, e.g. “ZipperTM”

3. Use the mark on multiple products (a “family” of products):

e.g. JELL-O brand gelatin & JELL-O brand pudding pops

4. Police the market:

e.g. send threatening letters; run ads



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.

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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.

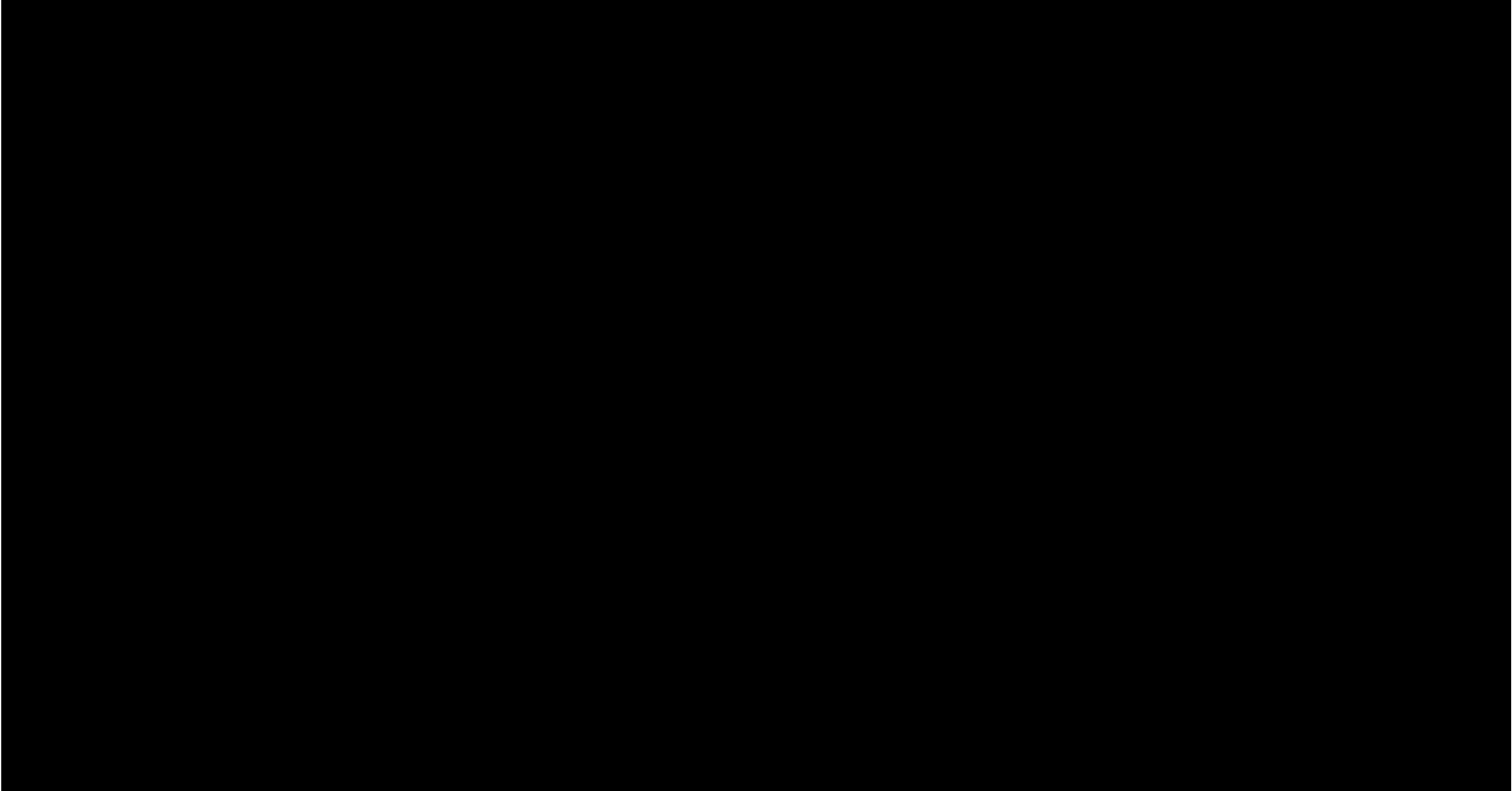
As soon as the mighty little Jeep vehicle came back from World War II, people discovered how much fun a utility vehicle could be. What made it perfect for the army made it perfect for having a picnic in the hills. Or a hunting trip. Or a snowy drive up to the cabin. And ever since, our vehicles have 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



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- Don't register Google trademarks as second or third level domain names.
- Don't use Google trademarks in a way that suggests a common, descriptive, or generic meaning.
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The “genus” test

Canfield v. Honickman:

“When a producer introduces a product that differs from an established product class in a significant, functional characteristic, and uses the common descriptive term of that characteristic as its name, that new product becomes its own genus, and the term denoting the genus becomes generic if there is no commonly used alternative that effectively communicates the same functional information.”

Applying the “genus” test:

- Established product class: razor blades
- New product that differs in a particular characteristic: razor blades that dispense lotion as you use them
- New name: self-lubricating razor
- Therefore “self-lubricating razors” are a new genus
- Whether “self-lubricating razor” is generic for that new genus depends on competitors’ need – is there any other way for them to convey the function or characteristic in this case, lotion dispensation?

Surveys for Genericism

1. Teflon (generally reserved for genericide cases)
2. Thermos