

Genericism: What a Headache!

By: Jim Astrachan

"The single question, as I view it, in all of these cases is merely one of fact: What do buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold them, I take it, it makes no difference whatsoever what efforts the plaintiff has made to get them to understand more. He has failed and he cannot say that when the defendant uses the word, he is taking away customers who wanted to deal with him, however closely disguised he may be allowed to keep his identity." With this long sentence and wordy, Judge Learned Hand, in 1921, described the test for determining whether what had once been a strong trademark had become generic and ceased to function as such.

The mark squarely in Judge Hand's sights was, of course, ASPIRIN, until then the trademark of Bayer Co. He concluded, "so here the question is whether the buyers merely understood that the word "aspirin" meant this kind of drug, or whether it meant that and more than that; i.e. that it came from a single, though, if one please, anonymous source from which they had got it before."

Once the aspirin trademark no longer signified its owner as the source of the product, it became generic; it became a class of mark no longer protectible under federal or state law because to do so would be to grant someone a monopoly in a word that merely identifies the goods, e.g. "spoon".

The folks at Bayer brought on their own migraine when they used their valuable mark the wrong way. Their improper, denominative, use was exemplified by the package labeling which read, "Bayer-Tablets of Aspirin." Clearly, the only trademark that the marketers employed was BAYER; the description of the product was "tablets of aspirin." Bayer's own usage showed that the tablets being offered were Bayer's make of a drug called aspirin.

Dupont's marketing of its cellophane tape is a similar example of bad usage which resulted in loss of its mark in 1936. And as so often the case, each of these decisions were the result of an infringement action brought by the mark's owner against a competitor who successfully defended on the grounds of genericism.

The trademark owner's improper use of a mark is not the only way for a trademark to lose significance. An owner's failure to adequately police others' improper usage of the mark can also lead to genericism. That is why mark owners often engage in extensive advertising campaigns designed to educate the public about the use of valuable marks instead of extolling the virtues of their products.

Xerox, for example, ran a print ad reminding the public that TRAMPOLINE, DRY ICE, MIMEOGRAPH, SHREDDED WHEAT, LANOLIN, KEROSENE, HIGH OCTANE, CUBE STEAK and

ESCALATOR all were once trademarks. The ad reads, "Now they're just names. They failed to take precautions..." laments the copy. Xerox demands, albeit, politely, "whenever you use our name, please use it as a proper adjective in conjunction with our products and services, e.g. Xerox copiers...". WEIGHT WATCHERS, KODAK, KLEENEX, BACARDI, TOBACCO, REALTOR, PLEXIGLAS, ROLLS-ROYCE and LEVIS have all engaged in educational ad campaigns fearing that their failure to police the public's improper usage of their marks will lead to genericism and cancellation. Each of these folks should be concerned. "Pass me a kleenex, I spilled a bacardi and coke on my levis".

Once in a while court will bend over a bit to help preserve what's left of a mark gone generic, while at the same time allowing others a hybrid generic usage, but only if the brand tried to prevent the mark from going generic. THERMOS is an example. Based on a survey, the court found that 75% of all adults in the United States who were familiar with a container that kept contents hot or cold, called the container a "thermos"; only 12% of American adults knew that "thermos" had trademark significance; only 11% of those surveyed used the generic term "vacuum bottle" to describe the container.

Despite the strong public association with thermos as a hot/cold container, the court found there had been a losing effort, but to the court the attempt was critical. Yet by then the word "thermos" had become part of the public domain and a competitor's use was not to be entirely restricted. On the basis of 12% recognition as a trademark, the court ruled that the competitor could use "thermos" to describe its hot or cold container. But if it did so in its advertising, in order not to deceive the public "thermos" must be preceded by the ALADDIN brand and *ALADDIN* was required to confine its use of "thermos" to the lower-case.

It's tough out there for the owner of a leading mark. After spending gobs of money to establish its mark as the household name for the product, the trip over the top of the hill to oblivion is but a short shove -- a shove a competitor is always happy to provide. Proper usage and policing of the public's usage are essential to a program designed to preserve rights. Remember this: There is no such thing as a Xerox. In *How to use a Trademark Properly* Sidney Diamond wrote that in advertising and packaging the product's generic name should follow the mark, e.g. LEVIS jeans. Never, he said, use the mark to stand in place of the generic name. It's good to remember his advice.

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