

INTELLECTUAL PROPERTY

SPECIAL SECTION | MARCH 2021



2

IP Litigation in the District of Delaware During COVID-19 and Beyond

3

Protection, By Design: An Often Under-Utilized Tool

4

Do Green Certification Marks Lead to Greener Consumption?

5

IP Third-Party Litigation Funding: Bane or Bonanza

6

Is Genericide Still a Thing? Maybe We Worry Too Much About 'Proper Use of Trademarks'

7

Blockchain's Promising Future in Battling Counterfeit Luxury Goods

Is Genericide Still a Thing? Maybe We Worry Too Much About ‘Proper Use of Trademarks’

BY LAURA J. WINSTON
Special to the Legal

Earlier this year, comedian Seth Meyers was making a joke about a politician on his talk show “Late Night with Seth Meyers.” In doing so, he referred to a well-known brand of popular plastic building bricks as “Legos.” Meyers was immediately flooded with online comments telling him that the plural of Lego is Lego. He took to the air waves again on the topic, thanking the commenters but adding “It’s too late for me ... I’m not going to walk home and tell my kids ‘Clean up your Lego.’” Not long after, the owner of the world-famous Lego trademark got into the act via a tweet, saying “Hey @SethMeyers, let us blow your mind ... the plural is not ‘Legos.’ It’s not even ‘Lego.’ It’s actually ‘LEGO BRICKS!’” @LEGO_Group, Twitter (Feb. 11, 2021), https://twitter.com/lego_group/status/1359856214591627269.

In setting Meyers straight, the Lego Group was following the conventional wisdom that to preserve trademark rights and prevent genericide, a trademark needs to be used as an adjective, followed by the generic descriptor—just as we have Band-Aid bandages, Rollerblade in-line skates, and Velcro hook-and-loop fasteners. This last one met with some fanfare in 2017 when Velcro Companies’ in-house and outside counsel got together to make “Don’t Say Velcro,” a lighthearted music video to educate the public, complete with a banner showing their name, logo and the statement “We’re the World.”

But in the current era of social media and targeted advertising, might these efforts even be necessary anymore? Brands have the power to market and connect with consumers in a way that they did not back in the time when the likes of Aspirin, Escalator and Cellophane lost their trademark significance and became the generic terms.

Consider the case of Google. The term coined in 1997 by the company of the same name became a category killer in internet searching and of course has expanded into many facets of our lives, but is commonly used as a verb for searching. In fact, its use as a verb is so common that in 2012 two individuals brought a lawsuit in federal court in Arizona petitioning for cancellation of the Google trademark, eventually



LAURA J. WINSTON, a principal at Offit Kurman, is part of the firm’s intellectual property group. She focuses her practice primarily in the areas of trademarks, copyrights and the internet, representing a broad range of both domestic and international clients from individual business owners and small startup ventures to established Fortune 500 and publicly traded companies.

appealing all the way up to the U.S. Supreme Court in *Elliott v. Google*, 860 F.3d 1151 (9th Cir. 2017), cert. denied 138 S.Ct. 362 (2017). The plaintiffs claimed that “google” is primarily understood as a “generic term used to describe the act of internet searching.” The plaintiff’s evidence even included a quotation from Google’s founder Larry Page, who in 1998 said, “Have fun and keep googling.”

The 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. In the appellate decision, the court 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.”

The idea that one can use a trademark as a verb and it will not lose its significance as a trademark flies in the face of the conventional advice that trademark attorneys give to their clients: “You have to use your trademark as an adjective, modifying the noun that is the generic term. Don’t say “we sell DROMBLES,” say “we sell DROMBLE™ brand sandwich cookies.” Don’t say “we DROMBLE every day during snack time.” And whatever you do, don’t encourage fans of your product to say “I’m the biggest DROMBLER that ever lived.” But year after year, brands that consist of words that are used as nouns, verbs and are

“ 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.”

even modified into other words continue to keep their trademark significance. Band-Aid is an example of a trademark that is virtually always used by consumers as the generic term; Johnson & Johnson seeks to educate the public in every ad by referring to “Band-Aid Brand” when mentioning the product. Yet everyone—everyone—uses “Band-Aid” to refer to adhesive bandages. Despite this common use of Band-Aid as a noun, often pluralized, by media, shoppers, parents taking care of their children’s scrapes, and others, Johnson & Johnson owns 21 U.S. trademark registrations that consist of or contain “Band-Aid,” the oldest was registered in 1925, and the most recent was registered in 2020. It does not look like Band-Aid will suffer the Escalator fate any time soon.

Why did Aspirin, Trampoline and Cellophane lose their trademark significance, and Google and Lego are able to keep theirs? The answer may be the exposure consumers have to these brands today that did not exist decades ago. Back then, 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 in our current era. Brands can reach people through social media accounts, sponsored or targeted ads, and present themselves at times that consumers may have a need. They can easily engage in a dialogue with

consumers, present offers, and fix problems. Planning to buy facial tissues? Kimberly-Clark may just pop up on your Facebook page advertising Kleenex brand tissues and reminding you that it is a brand, not a generic term. Searching e-commerce sites for Windex? SC Johnson may be happy to plant an ad that will easily remind you that Windex is a brand, not the generic term. These heightened connections between brand owner and consumer may be why the genericness challenge to Google was destined to fail.

Thomas McCarthy cites two examples, and says these are only two examples, of brands that became generic and rehabilitated themselves back to trademark status—Singer sewing machines and Goodyear tires. See “McCarthy on Trademarks” Sections 12:30-32 (5th ed.). Each of those brands became generic terms in a simpler time—in the Singer case, for example the U.S. Supreme Court declared Singer to be generic in 1896. See *Singer Manufacturing v. June Manufacturing*, 163 U.S. 169 (1896). Through the company’s continuous advertising over subsequent decades, the public again associated Singer with a single source, and later court decisions held it to be a strong trademark. See e.g. *Singer Manufacturing v. Axelrud*, 28 F.Supp. 450 (D.N.Y. 1939). In 1953, the U.S. Court of Appeals for the Fifth Circuit said that the Singer trademark had been “recaptured.” Back then, through massive educational advertising, Singer accomplished what appears to be happening in a much more universal manner now—brands are making connections with consumers so that there is brand awareness, regardless of the form of the mark or the part of speech consumers use.

What can we as practitioners take away from this? 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. So instead of “Don’t say DROMBLES,” it might be “Make sure your customers see that DROMBLE sandwich cookies are consistently coming from you, through social connection and brand awareness.” ●