

## NOTE

### EFFECTIVE POLICING:

### GIVING TRADEMARK HOLDERS A PRE-EMPTIVE STRIKE AGAINST “GENERICIDE”

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“*The real difficulty, of course has been in getting agreement to do something about it. I think we have that now and, therefore, can go ahead.*’ . . . [The company] sent no more than a dozen of such protest letters to dictionaries and publications having general public circulation. Of these about a half dozen agreed to comply with the plaintiff’s request; the others either ignored the protest or expressly refused to comply.”<sup>2</sup>

Calling an insulated container a “thermos,” a pain pill an “aspirin,” or any moving staircase an “escalator” is so commonplace that few speakers realize they are using words that companies invented to peddle novel products. These and numerous other words are not regular nouns, but were all, at one point, trademarks.<sup>3</sup> A trademark is a word or symbol that identifies the source of a good or service.<sup>4</sup>

When companies invented the above-named objects, there were few comparable competing products in the marketplace. Consequently, as insulated containers, pain pills, and moving staircases became increasingly popular, consumers ceased to use “thermos,” “aspirin,” and “escalators” to describe the companies or brands that created and sold these products. Consumers and non-consumers—publishers, writers, and competitors—co-opted these words to describe *the things themselves*.<sup>5</sup> Hence, many consumers call a paper facial tissue, no matter the manufacturer, a “Kleenex” rather than a “Kleenex-brand” facial tissue.<sup>6</sup>

When a trademark comes to signify the type of product rather than the

<sup>2</sup> *American Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 18, n. 4 (D. Conn. 1962).

<sup>3</sup> See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 578 (2d Cir. 1963); *Bayer Co. v. United Drug Co.*, 272 F. 505, 507 (S.D.N.Y. 1921); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 n. 7 (2d Cir. 1976).

<sup>4</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed. 2012).

<sup>5</sup> See, e.g., *Bayer*, 272 F. at 512.

<sup>6</sup> See Merrill Perlman, *On Your Mark*, COLUM. JOURNALISM REV. (June 14, 2010, 12:50 PM), [http://www.cjr.org/language\\_corner/on\\_your\\_mark.php](http://www.cjr.org/language_corner/on_your_mark.php).

product's origin in this manner, the mark is or has become "generic."<sup>7</sup> In statutory and common trademark law, a generic or genericized term or symbol lacks protection – or loses protection it once had – as a trademark because the term or symbol does not identify the source of the product.<sup>8</sup> When a trademark loses protection, a trademark holder can no longer bring legal action to stop competitors or other parties from using the trademark.<sup>9</sup>

Such linguistic evolution happens relatively frequently.<sup>10</sup> "Genericide" happens because consumers or publishers often find it awkward to describe a product by terms that state the product's qualities; with new products, such terms are usually the only linguistic tool at the inventor's disposal.<sup>11</sup> Calling a thermos a "vacuum-insulated container," while precise, is linguistically cumbersome. Consequently, appropriating a more succinct synonym is natural—among consumers and in certain media:<sup>12</sup>

You blow your nose with a "tissue," [not a Kleenex] patch your boo-boo with a "bandage," [not a Band-Aid] make a "copy," [rather than a Xerox] and "overnight" it [as opposed to Fedex-ing it]. But avoiding a trademark can also tie you up in knots. (See "ECD," above ["ECD" stands for electronic control device, the generic name for a Taser-brand device]) If you're not sure they're Rollerblades, you have to call them "inline skates" or "in-line roller skates." A Jet Ski that's not a Kawasaki is a "personal watercraft," a jargony term if ever there was one. (Sorry: "WaveRunner" is Yamaha's trademark.)<sup>13</sup>

Such descriptive shorthand is not the only circumstance where potentially damaging generic use occurs. On occasion, publishers use a trademark as a literary device, a stand-in for the cultural connotations a trademark carries. Such colorful use is frequently an effective device for memorable writing, but can be perilous for trademark holders.

Take, for example, Monty Python's Flying Circus.<sup>14</sup> In a particularly

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<sup>7</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1 (4th ed. 2012).

<sup>8</sup> *Id.* §12:1.

<sup>9</sup> *See, e.g., Abercrombie*, 537 F.2d at 8, 13.

<sup>10</sup> *See* Perlman, *supra* note 5.

<sup>11</sup> *See, e.g., Bayer*, 272 F. at 510-11.

<sup>12</sup> *See* Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 417 (1990) (noting that "words are most readily adopted into language when they fill conceptual voids; indeed, most trademarks that have passed into the language have done so precisely because there was no other word to describe the product they signified.") (footnotes omitted).

<sup>13</sup> Perlman, *supra* note 5.

<sup>14</sup> *Monty Python's Flying Circus: Spam* (BBC television broadcast Dec. 15, 1970); *see* *Gordon v. Virtumundo, Inc.*, 575 F.3d 1040, 1044 & n.1 (9th Cir. 2009).

memorable skit from the program, an elderly couple attempts to order a meal at a greasy spoon but encounters an unusual complication—everything on the menu has SPAM in it.<sup>15</sup> When the elderly woman attempts to order one of the dishes *without* the SPAM, the short-order cook balks.<sup>16</sup> An assortment of Vikings seated nearby begins to chant “SPAM!” at an ever-increasing volume, drowning out the ability of everyone else in the diner to speak.<sup>17</sup>

Years later, based upon memories of this television skit, writers began referring to the sending of unsolicited commercial email (UCE) as “spamming” and the UCE itself as “spam.”<sup>18</sup> As an analogy, the comparison evokes a sense of helplessness at being deluged with unwanted communication. The continued public use of this term is indicative of its evocative power.<sup>19</sup>

Such literary co-opting, while both convenient and evocative, contributes to the genericization of a brand and is quite costly for trademark holders.<sup>20</sup> Trademark holders frequently invest substantial financial resources in creating, promoting, and maintaining trademarks, primarily through cultivation of positive association between consumers and the brand, or “goodwill.”<sup>21</sup> Companies not only spend resources conceptualizing and developing a mark for use, but also, after introducing the mark to the public, developing corporate goodwill in association with it.<sup>22</sup> All of these resources are for naught when protection of the mark in question dissolves because the mark has become generic.<sup>23</sup>

Despite the substantial financial resources involved in creating and disseminating a trademark, trademark holders do not have effective tools at their disposal to combat the slide of a mark into “genericism” and the concomitant loss of trademark protection.<sup>24</sup> This is largely due to judicial and legislative deference to First Amendment protections of expression: courts view the use of a term or symbol to identify a source of a good or service as a

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<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> *Gordon v. Virtumundo, Inc.*, 575 F.3d 1040, 1044 & n.1 (9th Cir. 2009).

<sup>19</sup> *See id.*

<sup>20</sup> *See* 2 MCCARTHY, *supra* note 6, §12:13.

<sup>21</sup> *Id.* §§ 2:19, 2:21, 2:30; Rudolphe Rayle, *The Trend Towards Enhancing Trademark Owners' Rights: A Comparative Study of U.S. And German Trademark Law*, 7 J. INTELL. PROP. L. 227, 232 (2000).

<sup>22</sup> *See* 2 MCCARTHY, *supra* note 6, §§ 2:19, 2:21, 2:30.

<sup>23</sup> Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1790 (2007).

<sup>24</sup> *See* 2 MCCARTHY, *supra* note 6, §§ 12:1, 12.13. *See also* Gary C. Robb, *Trademark Misuse in Dictionaries: Inadequacy of Existing Legal Action and a Suggested Cure*, 65 MARQ. L. REV. (No.2) 179, 182 (1981).

subsidiary concern to the importance of preserving free expression.<sup>25</sup> Here, in the persistent tension between free speech and property rights, courts seem to view disposition of trademark conflicts as an opportunity to liberate trademarks from their creators' clutches.<sup>26</sup> Furthermore, even though many trademarks are invented words, a reader of legal opinions could get the impression that courts perceive their decisions as ones that *return* purloined terms to the public in the name of free expression.<sup>27</sup>

Professional guidelines for journalists and publications reflect this view: there are no promulgated ethical guidelines for proper use of trademarks in publishing, and the leading style handbook for writers, while providing examples of proper and improper use of a trademark, is not a binding professional standard.<sup>28</sup> Publishers of all varieties are legally and ethically free to use trademarks in whatever matter they so desire.<sup>29</sup> This is especially troubling for a trademark holder because a publication's use of a trademark as a general term can be admitted into evidence at trial as proof of a mark's genericity.<sup>30</sup>

The law has traditionally protected trademarks purely because of trademarks' source identifying function,<sup>31</sup> but the trademark landscape has changed. A number of scholars have written extensively about the expanding significance of trademarks as cultural iconography and linguistic necessities.<sup>32</sup> Many scholars argue that there should be fewer legal restraints upon colloquial use of trademarks by third party users to preserve channels of free expression.<sup>33</sup> Yet, a consequence of trademarks' spreading cultural relevance is a vast expansion of opportunities to genericize trademarks.<sup>34</sup> Because of the growing cultural significance of trademark—rather than in spite of it—trademark holders require more sophisticated and effective tools to police how publishers and other non-competing third parties use their marks.

This Article intends neither to marginalize the importance of free speech nor pose suggestions to curb expression. Rather, this Article proposes the

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<sup>25</sup> William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1206 (2008).

<sup>26</sup> See *The Freecycle Network, Inc. v. Oey*, 505 F. 3d 898, 905-06 (9th Cir. 2007). See also *Ty v. Perryman*, 306 F. 3d 509, 514 (7th Cir. 2002) (suggesting that trademark holders should "disclaim" the right to sue dictionaries for generic definitions).

<sup>27</sup> See McGeeveran, *supra* note 24, at 1206.

<sup>28</sup> ASSOCIATED PRESS, *THE ASSOCIATED PRESS STYLEBOOK AND BRIEFING ON MEDIA LAW* (Darrell Christian et al. eds., 2011).

<sup>29</sup> Desai, *supra* note 22 at 183.

<sup>30</sup> See, e.g., *King-Seeley Thermos*, 321 F.2d at 579.

<sup>31</sup> See 1 MCCARTHY, *supra* note 3, § 3:1.

<sup>32</sup> See e.g., Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV., 1313 (2010); Dreyfuss, *supra* note 11.

<sup>33</sup> See e.g., Dreyfuss, *supra* note 11.

<sup>34</sup> See Heymann, *supra* note 30, at 1320-22, 1341-49.

possibility that trademark holders need an additional tool to *effectively* police the use of their marks by noncompeting third parties, such as magazines or blogs, when such use could result in “genericism” and the accompanying loss of protection in a trademark—a substantial material and manpower investment. To remedy the problem, other scholars have proposed reining in courts’ in their consideration of decisions finding trademarks as non-source identifying entities.<sup>35</sup> However, given the difficulty of encouraging a change in common law policy, this Article argues that such an approach will not be as effective as modifying a statute.

To fully appreciate the difficulties of modifying existing practice and law while balancing important speech concerns, this Article will lay out the background of trademark law; flesh out the tensions among trademark holder requirements, free speech interests, and the financial stake trademark holders have in their marks; and, finally propose and vet possible tools for trademark holders to effectively police how non-competing third parties use marks.

Part I explains what trademarks are and how courts determine whether or not a word or symbol receives trademark protection. Part II details ways that a mark can become generic and lose protection. Part III outlines the ways in which trademark holders are expected to monitor use of their marks, including providing guidelines for proper use of a trademark, writing cease-and-desist letters, and monitoring dictionary and other publications’ use of a trademark. Part IV explains that using the methods outlined in Part III as well as the self-policing efforts of the publishing community are insufficient to protect trademarks from genericity. Part V lays out the free speech policy reasons for the current trademark-policing regime. Finally, Part VI outlines the strengths and weaknesses of several potential remedies.

#### I. WHO MADE IT?: THE TRADITIONAL SOURCE-INDICATING ROLE OF A TRADEMARK

Trademarks (words, symbols, trade dress, and, in some cases, product design) identify the source of a good or service.<sup>36</sup> One fundamental goal of trademark law is to prevent consumer confusion as to the source of a good or a service.<sup>37</sup> When a producer uses Trademark B to identify the source of his product, and Trademark B is identical or similar to Trademark A, a consumer might become confused and think that product B comes from source A. Such confusion is actionable as trademark infringement.<sup>38</sup>

As indicators of origin, trademarks facilitate a consumer’s purchasing decision: if a consumer recognizes the trademark (Trademark A) of a product for his present purchase as a trademark for a product he has purchased and used before with satisfaction, the consumer can efficiently make a decision to

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<sup>35</sup> See e.g., Desai & Rierson, *supra* note 22, at 1790-93.

<sup>36</sup> 1 MCCARTHY, *supra* note 3 §§ 3:1-3.

<sup>37</sup> *Id.* §§ 2:1-2.

<sup>38</sup> *Id.* § 2.8.

purchase Trademark A's product without vetting its quality.<sup>39</sup> Protecting Trademark A as intellectual property of the producer creates an incentive for the producer to ensure the consistent high quality of his product, cultivating a goodwill association with the trademark.<sup>40</sup> Goodwill is not instantaneous but grows over time in the presence of a relationship between the consumer and producer.<sup>41</sup>

Both common law and the Lanham Act, which is federal law, enable a producer to defend his mark against potential infringers.<sup>42</sup> If a producer registers a mark under the Lanham Act, a court will presume the mark is valid—it is the defendant's burden to prove the allegedly infringing trademark is invalid at trial.<sup>43</sup> If a mark is not registered under the Lanham Act, there is no such presumption of validity: at trial the trademark owner must demonstrate that the mark is valid.<sup>44</sup> While differences exist in the protections that common law and the Lanham Act afford a trademark holder (and even, in some cases, what marks receive protection),<sup>45</sup> this Article shall treat both the Lanham Act and common law as protecting the same categories of trademarks.

Trademarks fall into one of four categories: generic, descriptive, suggestive, and "arbitrary or fanciful."<sup>46</sup> *Abercrombie & Fitch v. Hunting World* ("Abercrombie") clarified these classifications.<sup>47</sup> In this case, Abercrombie brought suit against a competitor for labeling garments as "Safari" clothing.<sup>48</sup> Abercrombie claimed the term "Safari" was a brand for their own outer garments, shoes, sporting goods, and hats; indeed, Abercrombie had registered the term "Safari" for these items, and it had been using the term for just over forty years.<sup>49</sup>

The category into which a mark belongs depends upon the mark itself, the good or service the mark is meant to represent, and the work the pertinent

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<sup>39</sup> *Id.* § 3:10.

<sup>40</sup> *Id.* § 2:15; Rayle, *supra* note 20, at 232.

<sup>41</sup> 1 MCCARTHY, *supra* note 3, § 2:2 & n. 2 ("The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.") (quoting S. REP. NO. 79-1333, at 3 (1946)).

<sup>42</sup> 1 MCCARTHY, *supra* note 3, §2:2.

<sup>43</sup> *See* 15 U.S.C. § 1057(b) (2012).

<sup>44</sup> *See* 4A LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMP., TR. & MONO. § 26:101 (4th ed. 2012).

<sup>45</sup> *See id.* at §§ 26:3-10 (4th ed.); 4A LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMP., TR. & MONO. § 26:104 (4th ed. 2012).

<sup>46</sup> *Abercrombie*, 537 F.2d at 9.

<sup>47</sup> *See id.*

<sup>48</sup> *Id.* at 7.

<sup>49</sup> *Id.* at 7, 11-14.

customer must do, in his or her own mind, to associate the mark with the good or service.<sup>50</sup> Fanciful, arbitrary, and suggestive marks are marks that are considered inherently distinctive.<sup>51</sup> Inherently distinctive marks receive trademark protection without a showing of secondary meaning, which is the association a consumer develops between a trademark and a product through use over time.<sup>52</sup> A descriptive mark is not inherently distinctive.<sup>53</sup> As the moniker suggests, a “descriptive” mark uses a word that is necessary to *describe* the good or service the mark represents.<sup>54</sup> A descriptive mark can receive trademark protection only upon a showing of secondary meaning.<sup>55</sup> A generic mark is one that denotes the product’s class or identity and not the product’s source.<sup>56</sup> Generic marks never receive trademark protection.<sup>57</sup>

Fanciful and arbitrary marks receive the most protection because they require the greatest leap of imagination on the part of the consumer to associate the mark with the good or service in question.<sup>58</sup> The logic in affording protection to these marks is that the more a consumer must use his or her mind to create a link between a good or service and a mark, “the less likely the words used will be needed by competitors to describe their products or services.”<sup>59</sup> The likelihood that a word is necessary to discuss a good or service is a common way courts weigh whether or not a mark is merely descriptive without secondary meaning.<sup>60</sup>

A generic term is one that describes what a product is rather than where it originated.<sup>61</sup> For a generic term, the association of the mark with the good or service is obvious or already in wide use by the public and requires no imagination on the part of the consumer.<sup>62</sup> Generic terms, whether secondary meaning exists or not, are never protectable as trademarks.<sup>63</sup>

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<sup>50</sup> *See id.* at 9-11.

<sup>51</sup> *Id.* at 10-11.

<sup>52</sup> *Id.* at 8.

<sup>53</sup> *See Id.* at 9-10

<sup>54</sup> *See Id.* at 11.

<sup>55</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766-69 (1992).

<sup>56</sup> *Abercrombie*, 537 F.2d at 9.

<sup>57</sup> *Id.*

<sup>58</sup> *See id.*

<sup>59</sup> *Zobmondo Entm’t, LLC v. Falls Media*, 602 F.3d 1108, 1117 (9th Cir. 2010) (citing *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987)).

<sup>60</sup> *See id.* Preserving access to language is important because it meets several needs: competitive need (competitors need a term to describe what a product is), need of consumers, and need of critics and publishers.

<sup>61</sup> *Abercrombie*, 537 F.2d at 9.

<sup>62</sup> *Id.* *See Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.* 198 F.3d 1143,1147 (9th Cir. 1999).

<sup>63</sup> *Abercrombie*, 537 F.2d at 9.

An example of a generic mark is “screenwipe.”<sup>64</sup> In *In re Gould Paper Corp.*, the Court upheld the Patent and Trademark Office’s refusal to register “screenwipe” as a trademark because the term did not identify the source of the product.<sup>65</sup> Moreover, the term “screenwipe” is a common, arguably necessary way to describe any screen-cleaning device.<sup>66</sup>

A reliable indicator that a mark is generic is that an applicant needs components of the trademark to define what the product is or does.<sup>67</sup> Here, for example, the applicant described “screenwipe” as “a... wipe... for... screens,” and “[n]othing [was] left for speculation or conjecture in the alleged trademark.”<sup>68</sup>

## II. HOW A WHO BECOMES A WHAT: HOW THE PUBLIC, COMPETITORS, AND OTHER THIRD PARTY SPEAKERS GENERICIZE A MARK

As a mark’s classification is not hard and fast:<sup>69</sup> “a term that is in one category for a particular product may be in quite a different one for another.”<sup>70</sup> Just as marks can fall into different categories in different circumstances, circumstances can drive marks into different categories.<sup>71</sup> A term can start off as generic or become generic through use by various parties.<sup>72</sup> Whether a mark is arbitrary, fanciful, suggestive, or descriptive with secondary meaning, a mark can lose protection if competitors, noncompetitive third party users, or the public use the mark regularly in a non-source identifying way.<sup>73</sup>

The Second Circuit, for example, concluded that the use of the word “safari” to describe certain kinds of *clothing* had become generic because the term was “widely used by the general public and people in the trade.”<sup>74</sup> The fact that Abercrombie & Fitch had successfully registered the term “Safari” suggests the term did not begin its life as a generic word.<sup>75</sup> (A generic mark, after all, would not have been registrable in the first place.) The fate of the trademark “safari” is common.<sup>76</sup> Many marks now thought to be generic started life as protected marks or as marks coined for the particular purpose of trademark, but

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<sup>64</sup> *In re Gould Paper Corp.*, 834 F.2d 1017, 1019 (Fed. Cir. 1987).

<sup>65</sup> *Id.* at 1018.

<sup>66</sup> *Id.*

<sup>67</sup> *See id.*

<sup>68</sup> *See id.* at 1019.

<sup>69</sup> *See Standard Brands Inc. v. Smidler*, 151 F.2d 34 (2d Cir. 1945) (V-8 is generic when applied to engines, but arbitrary when applied to vegetable juice).

<sup>70</sup> *Abercrombie*, 537 F.2d at 9.

<sup>71</sup> *See 2 MCCARTHY*, *supra* note 6, §12:13.

<sup>72</sup> *See id.*

<sup>73</sup> *See Abercrombie*, 537 F.2d at 4-13.

<sup>74</sup> *Id.* at 12.

<sup>75</sup> *See id.*

<sup>76</sup> *See id. See, e.g., King-Seeley Thermos*, 321 F.2d 577

over time became generic.<sup>77</sup> There is always the danger that “buyers will take the mark and use it as the generic name of the new product itself,” genericizing the mark.<sup>78</sup> A mark can become generic in a number of ways: through the trademark holder’s actions or inactions, through actions by competitors, or through actions of noncompeting third parties, namely the public and the media.<sup>79</sup>

#### A. Trademark Holder Activity

There are a number of examples where “genericide” occurs due to the trademark holder’s habit of using his own mark in a non-source identifying way.<sup>80</sup> This occurred in *King-Seeley Thermos, Co. v. Aladdin Industries, Inc.*—the “Thermos” case.<sup>81</sup> There, King-Seeley’s own promotional materials and catalogues frequently used the term “Thermos” as a synonym for vacuum-insulated containers, rather than as a source identifier for the particular vacuum-insulated containers it produced.<sup>82</sup> The Second Circuit cited this as an important factor in determining that “Thermos,” an invented word, had become a generic term.<sup>83</sup>

#### B. Unchecked Use By Competitors

A non-generic term can also become generic due to unchecked use by competitors of the term.<sup>84</sup> Un-censured use of a mark enables the mark to drift into the public vernacular in a non-source identifying way.<sup>85</sup> Again, the “Thermos” case is instructive. There, the company allowed competitors to use the fanciful term both descriptively *and* as a synonym for their own products, which naturally diminished the power of the word as a source identifier.<sup>86</sup> Over a period of unchecked use, the public adopted the term as a way to describe the thing itself, rather than the thing’s origin.<sup>87</sup>

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<sup>77</sup> See 2 MCCARTHY, *supra* note 6, §12:18.

<sup>78</sup> *Id.* § 11:9. The seminal case of genericide is *Bayer Co. v. United Drug Co.*, where Bayer lost trademark rights in a word it constructed to describe acetylsalicylic acid: “aspirin.” 272 F. 505 (S.D.N.Y. 1921). Bayer had held a patent for the drug and had called its product “Aspirin.” The patent precluded marketplace competition and, accordingly, there was no trademark competing with “Aspirin” to identify acetylsalicylic acid. Consequently, the word “Aspirin” became consumer and competitor shorthand for the more linguistically cumbersome chemical name of the drug. *Id.* at 505-08, 510-12, 514.

<sup>79</sup> See generally 2 MCCARTHY, *supra* note 6, §12:13.

<sup>80</sup> *Id.*

<sup>81</sup> *King-Seeley Thermos*, 321 F.2d at 577.

<sup>82</sup> *Id.* at 578; *American Thermos*, 207 F. Supp. at 12.

<sup>83</sup> *King-Seeley Thermos*, 321 F.2d at 578; *American Thermos*, 207 F. Supp. at 12.

<sup>84</sup> See *American Thermos*, 207 F. Supp. at 12-13.

<sup>85</sup> See *id.*

<sup>86</sup> *Id.* at 14.

<sup>87</sup> *Id.*

C. *Popularity Or Market-Domination of Trademarked Product*

A trademarked product's very popularity can be the instrument of its descent into genericity.<sup>88</sup> In *Murphy Door Bed Co., Inc. v. Interior Sleep Systems, Inc.*, the Murphy Door Bed Company was the first entity to use the term "Murphy Bed" to describe a bed that folded into the wall on a pivot.<sup>89</sup> The company held a patent on the device, enabling temporary market monopoly on the product type and a practical monopoly on "Murphy bed."<sup>90</sup> During that time, the product became so popular that customers began, seemingly organically, to appropriate the trademark "Murphy bed" as a moniker for the type of pivot bed the company—and eventually others—sold, rather than the particular pivot bed that the Murphy Door Bed Company sold.<sup>91</sup> Here, the public itself was the instrument of the trademark's demise.<sup>92</sup>

D. *Publications, Dictionaries, and Other Media*

Finally, public and media use of a trademark in a non-source identifying way can contribute to a mark's slide into genericism.<sup>93</sup> In *King Seeley*, for example, the courts mentioned the use of "Thermos" in trade and non-trade publications as well as the dictionary as factors in finding "Thermos" generic.<sup>94</sup>

It is difficult to say whether dictionary or media publication merely reflects the public's pre-existing generic use of a term, or whether such publication drives public use towards genericide. Perhaps a dictionary definition reflects the way the public understands a term, but perhaps also a dictionary definition catalyzes further public generic use.<sup>95</sup> The appearance in a dictionary of a generic term legitimizes existing generic use and begets further generic use of a trademark.<sup>96</sup> The same can be said for trade and non-trade magazines and

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<sup>88</sup> See generally *King-Seeley Thermos*, 321 F.2d.

<sup>89</sup> *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 98 (2d Cir. 1989).

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 101.

<sup>92</sup> See *id.*

<sup>93</sup> Desai & Rierison, *supra* note 22, at 1831.

<sup>94</sup> *King-Seeley Thermos*, 321 F.2d at 579; *American Thermos*, 207 F. Supp. at 13.

<sup>95</sup> See Desai & Rierison, *supra* note 22, at 1833; Robb, *supra* note 23, at 181.

<sup>96</sup> See Robb, *supra* note 23, at p. 181-82. In *Boston Duck Tours, LP v. Super Duck Tours, LLC*, dictionary definitions admitted into evidence did not define "duck" as an amphibious vehicle, the good in question. Nevertheless, based on other evidence of genericity the court found "duck" to be generic in such a context, writing that dictionary definitions were "not conclusive indicators of overall public perception." 531 F. 3d 1, 23 (1st Cir. 2008); While continuing to rely on dictionaries for evidence of genericity, some courts have noted that dictionary entries are not perfect snapshots of public perceptions of a trademark's genericity: "[d]ictionary entries also reflect lexicographical judgment and editing which may distort a word's meaning or importance." *Berner Int'l Corp. v. Mars*

newspapers.<sup>97</sup> The use of a trademark in a generic way in a publication can both reflect the way a term is popularly used (indicating that “genericide” has perhaps already occurred) or contribute to generic use of the term by the readers—or both.<sup>98</sup>

Similarly, a writer’s use of a trademark to make an analogy or construct a clever turn of phrase might both indicate a mark’s descent into generic use and drive popular use of the mark in a descriptive manner. If the use of a trademark as a literary device is successful, such use could catalyze improper public deployment of the mark. “AstroTurf” is a good example of such literary use.

AstroTurf is a trademark (“a brand of carpetlike covering made of vinyl and nylon to resemble turf. . .”).<sup>99</sup> Colloquially, political commentators sometimes use “astroturf” to describe a type of movement, made to appear to be “grassroots,” when in fact highly organized corporations or political groups have systematized the movement.<sup>100</sup> Despite this generic usage, “AstroTurf” remains a registered trademark.<sup>101</sup> Another evocative illustration is “Band-Aid.”<sup>102</sup> “Band-Aid” is a trademark, but also has figurative uses: “This trademark sometimes occurs in print in figurative uses: ‘True welfare reform is being bypassed for Band Aid solutions. (Los Angeles Times).’”<sup>103</sup>

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Sales Co., 987 F. 2d 975, 983 (3d Cir. 1953); .

<sup>97</sup> See Robb, *supra* note 23, at 181 & n. 25.

<sup>98</sup> Robb, *supra* note 23, at 183–84. See Merrill Perlman, *Word*, COLUMBIA JOURNALISM REVIEW (Jan. 4, 2010 11:49 AM), available at [http://www.cjr.org/language\\_corner/word.php](http://www.cjr.org/language_corner/word.php) (Discussing Google: Some terms are “‘repurposed’ words, the way the trademark noun ‘Google’ became a verb. (Though Google officially bans using its trademark as a verb, its lawyers are less quick to admonish than those of, say, Xerox.)”).

<sup>99</sup> *Astroturf Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/astroturf?s=t> (last visited Sept. 21, 2014). The dictionary also defines the product the brand represents: “a type of grasslike artificial surface used for playing fields and lawns.” *Id.*

<sup>100</sup> See generally SOURCE WATCH, <http://www.sourcewatch.org/index.php?title=Astroturf> (last visited Jan. 6, 2012); The use of “astroturf” in this context is attributed to a senator’s speech, but it has since appeared in some popular media, including *Campaigns & Elections Magazine* where “AstroTurf” was used (albeit in quotation marks) to describe the Tea Party Movement. Noah Rothman, *The Tea Party in Review*, CAMPAIGNS & ELECTIONS (Nov. 4, 2010), <http://www.campaignsandelections.com/campaign-insider/171752/the-tea-party-in-review.shtml>.

<sup>101</sup> See ASTROTURF, <http://astroturfusa.com> (last visited March 6, 2012).

<sup>102</sup> Ronald R. Butters, *A Linguistic Look at Trademark Dilution*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 507, 512 (2007-08).

<sup>103</sup> *Id.*

### III. CONTESTING GENERICITY: EXPECTATIONS FOR TRADEMARK HOLDERS TO POLICE USE OF MARKS

A discussion about a term's genericity occurs in three general circumstances: (1) when a producer applies to register the mark; (2) when the mark's registration is contested; and (3) as a defense in a lawsuit for infringement, cancellation, or dilution.<sup>104</sup> In the first instance, the Patent and Trademark Office refuses registration if it determines the mark is generic.<sup>105</sup> In the last instance, a defendant can point to the genericity of the plaintiff's trademark to undermine the mark's legitimacy and, consequently, negate both infringement and dilution claims.<sup>106</sup> After all, a producer cannot infringe or dilute an invalid trademark.<sup>107</sup>

If genericity is in question in either of these types of actions, courts investigate whether the plaintiff, in fact, did diligently monitor and attempt to control use of the mark, often asking whether the plaintiff did what a normal trademark holder would do under the circumstances.<sup>108</sup> A trademark holder has the obligation to monitor and police how other parties—both competitors and non-competitors—use his mark to prevent it from becoming generic.<sup>109</sup>

#### A. *Leading by Example: Using a Mark Properly in In-House Publications and Advertisements*

There are a number of ways that mark holders police the use of their marks.<sup>110</sup> Foremost, courts expect mark holders to use the trademark as a source-identifier rather than as a synonym for the product itself in their own advertisements and promotional materials.<sup>111</sup> The careless use of "Thermos" as a synonym in the owner's promotional materials, for example, contributed to public, publisher, and dictionary non-source identifying, generic use of the term.<sup>112</sup> In another example, when denying registration of the word "escalator" as a trademark, the Patent Commissioner noted that the company applying to register the term as a trademark had used the term "escalator" descriptively and generically in materials it produced, namely patent applications and advertisements.<sup>113</sup> The Commissioner also noted that the company failed to

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<sup>104</sup> See generally James Lockhart, *When Does Product Become Generic Term So As To Warrant Cancellation of Registration of Mark, Pursuant to § 14 Lanham Act (15 U.S.C.A. § 1064)*, 156 A.L.R. Fed. 131 (1999).

<sup>105</sup> 15 U.S.C. § 1052(e) (2012).

<sup>106</sup> *Id.*

<sup>107</sup> Infringement and dilution are the two legal actions a trademark holder has to defend his trademark. The nuances of both actions will be described in Section IV(F).

<sup>108</sup> *Id.*

<sup>109</sup> Desai & Rierson, *supra* note 22, at 1791.

<sup>110</sup> *Id.* at 1833-34.

<sup>111</sup> *King-Seeley Thermos*, 321 F.2d at 578-79.

<sup>112</sup> *American Thermos*, 207 F. Supp. at 12.

<sup>113</sup> *Haughton Elevator Company v. Seeberger (Otis Elevator Company Substituted)*, 85

object to generic and descriptive uses of the term in safety regulations and other widely disseminated materials.<sup>114</sup>

*B. Posting and Disseminating Suggestions for Proper Use*

Another tactic trademark holders employ to promote the correct, source-identifying use of a mark is to post or distribute guidelines for use.<sup>115</sup> These guidelines serve the dual purposes of demonstrating to consumers and publishers the “proper” manner for trademark use and providing evidence to courts that a trademark holder remains vigilant about his mark.<sup>116</sup>

Trademark holders disseminate guidelines for trademark use in a variety of platforms. Some trademark holders place advertisements in publications targeting media professionals to demonstrate and request proper use of a trademark.<sup>117</sup> Xerox famously promulgated an advertising campaign, almost begging consumers to use the word “Xerox” in a way that acknowledged “Xerox” was a *brand* of photocopier, not a generic word to be used indiscriminately to describe a photocopier and not a verb for photocopying.<sup>118</sup> One such advertisement stated: “You can’t Xerox a Xerox on a Xerox. But we don’t mind at all if you copy a copy on a Xerox copier.”<sup>119</sup>

Many trademark holders post proper use guidelines on their websites.<sup>120</sup> Microsoft’s website, for instance, lists examples of correct and incorrect uses of its Windows trademark.<sup>121</sup> Microsoft’s website states that the correct way to use its trademark is to say, “[d]ownload a Windows Media File to listen to music,” but incorrect to say, “[l]isten to Windows media songs.”<sup>122</sup> Other websites, such as Apple Inc.’s, go one step further by offering generic alternatives for the brand names that embrace the product.<sup>123</sup> While certainly not colorful or evocative, the generic substitutes are clinically precise.<sup>124</sup>

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U.S.P.Q. (BNA) 80, 81 1950, WL 4178, at \*2 (Comm’r Pat. & Trademarks 1950); 156 A.L.R. Fed. 131 (1999).

<sup>114</sup> *Id.*

<sup>115</sup> Desai & Rierson, *supra* note 22, at 1836.

<sup>116</sup> *See id.*

<sup>117</sup> *Id.*

<sup>118</sup> ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 894 (5th ed. 2010).

<sup>119</sup> *Id.*

<sup>120</sup> *See infra* § IV(C).

<sup>121</sup> MICROSOFT,

<http://www.microsoft.com/about/legal/en/us/intellectualproperty/trademarks/usage/windowsmedia.aspx> (last visited Jan. 4, 2012).

<sup>122</sup> *Id.*

<sup>123</sup> APPLE, <http://www.apple.com/legal/trademark/appletm.html> (last visited Jan. 3 2012). An acceptable substitute for “iPhone,” “iPad,” and “iPod,” is “mobile digital device.”

<sup>124</sup> Interestingly, the fact that “mobile digital device” is meant to cover such a variety of objects reinforces the idea that common language does not always

Hormel Foods, LLC's website for SPAM takes a slightly different approach and addresses specifically the metaphorical use of "spam" by explaining its origin and asserting its own position about the use.<sup>125</sup> Hormel Foods assumes consumers have

probably seen, heard or even used the term "spamming" to refer to the act of sending unsolicited commercial email (UCE), or "spam" to refer to the UCE itself. False Use of the term "spam" was adopted as a result of the Monty Python skit in which our SPAM® canned meat product was featured. In this skit, a group of Vikings sang a chorus of "spam, spam, spam. . ." in an increasing crescendo, drowning out other conversation. Hence, the analogy applied because UCE was drowning out normal discourse on the Internet.<sup>126</sup>

The company goes on to assert it does not object to the "slang" use of "spam" to refer to "UCE," but proposes proper ways to distinguish between the trademark and the "slang."<sup>127</sup> Hormel Foods asks that, if the term is used to describe unsolicited commercial email, "it should be used in all lowercase letters to distinguish it from our trademark SPAM, which should be used with all uppercase letters."<sup>128</sup>

### C. Tracking Publications and Sending Cease-And-Desist Letters

Apart from posting suggested standards for proper use, courts expect mark holders to monitor publications and dictionaries for improper use of a mark.<sup>129</sup> In cases of improper use, courts expect mark holders to write cease-and-desist letters or request clarification and proper use.<sup>130</sup> In *King-Seeley*, the Second Circuit noted with approval that the company had sent letters to the dictionary to amend the definition of "Thermos" to avoid promoting generic use.<sup>131</sup> For a span of thirty years, however, the company had not investigated or searched for descriptive or generic uses of "Thermos."<sup>132</sup> The court noted there were "hundreds" of instances when third parties used "Thermos" descriptively.<sup>133</sup> Yet, during that time, *King-Seeley* only pursued the improper use that came to

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furnish the most natural or clear way to describe new concepts or entities that consumers encounter. A number of items with vastly different uses could fall under the umbrella of "mobile digital device."

<sup>125</sup> Lester Haines, 'Spam King' Richter Get Legal Roasting, REGISTER (June 17, 2004), [http://www.theregister.co.uk/2004/06/17/spam\\_king\\_roasting/](http://www.theregister.co.uk/2004/06/17/spam_king_roasting/).

<sup>126</sup> *Id.*

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> See generally *King-Seeley Thermos*, 321 F.2d 577.

<sup>130</sup> See *id.*

<sup>131</sup> *American Thermos*, 207 F. Supp. at 17 & n.3.

<sup>132</sup> *Id.* at 13.

<sup>133</sup> *Id.*

its attention, only sending cease-and-desist letters in earnest after generic use of the mark had taken hold.<sup>134</sup> Ultimately, the Court held that King-Seeley's vigilance came too little too late.<sup>135</sup> The court perceived the failure of the company to send cease-and-desist letters the moment it had evidence of improper use of its mark as a fatal error.<sup>136</sup>

Cease-and-desist letters are now commonplace in trademark policing practice. Journalists often receive cease-and-desist letters citing failure to properly use a trademarked term.<sup>137</sup> "Many reporters have received at least one letter warning about trademark infringement. Among the most persistent complainers are Wham-O ('Frisbee' is a brand of 'plastic flying disc') and Xerox. And what reporter hasn't had a complaint from a realtor remonstrating that not every real estate salesperson is a Realtor?"<sup>138</sup>

#### IV. POLICING A MARK IS NO GUARANTEE: DIFFICULTIES MARK HOLDERS FACE IN CONTROLLING USE

As demonstrated, non-competing third parties (the public and the media) have the power to kill a trademark.<sup>139</sup> Yet, non-competing third parties must abide by few, if any, restrictions on how they use trademarks.<sup>140</sup>

##### A. *The Impossibility of Neutralizing the Threat Publications Pose*

Company-promulgated suggestions for proper trademark use, such as the guidelines on Microsoft's and Apple's respective web pages, are by no means legally binding.<sup>141</sup> Trademark holders are free to lobby dictionaries for definitions of the trademark term that do not reflect a generic understanding, but dictionaries are equally free to ignore trademark holders' requests.<sup>142</sup> Indeed, no publisher must comply with a targeted ad, suggestions for use, or a cease-and-desist letter.<sup>143</sup>

##### B. *Cease-and-Desist Letters: Anemic Tools*

As discussed *supra*, trademark holders wield cease-and-desist letters frequently, but these letters are of dubious value. Cease-and-desist letters from trademark holders to non-competing third parties are primarily effective when

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<sup>134</sup> *King-Seeley Thermos*, 321 F.2d at 579.

<sup>135</sup> *Id.* at 581.

<sup>136</sup> *Id.* at 579.

<sup>137</sup> See Merrill Perlman, *On Your Mark*, COLUM. JOURNALISM REV. (June 14, 2010 12:50 PM), [http://www.cjr.org/language\\_corner/on\\_your\\_mark.php](http://www.cjr.org/language_corner/on_your_mark.php).

<sup>138</sup> *Id.*

<sup>139</sup> See, e.g., *id.*

<sup>140</sup> See Desai & Rierson, *supra* note 22, at 1834.

<sup>141</sup> *Id.* at 1835.

<sup>142</sup> *Id.* See also *American Thermos*, 207 F. Supp. at 17 & n. 3.

<sup>143</sup> See Desai & Rierson, *supra* note 22, at 1835.

a party is uninitiated to the ins and outs of trademark law.<sup>144</sup> Such parties are often individual small-scale bloggers or website operators.<sup>145</sup> A savvy blogger or website operator will know that mark holders do not have much muscle to stifle improper use of a trademark. Moreover, as the number of websites that write about brands, goods, or services has grown, so have networks of websites that inform each other of their rights to resist cease-and-desist letters.<sup>146</sup>

C. *Self-Regulation by the Publishing Community: Guidelines and Standards*

Publishers have little incentive to respect mark holders' requests as to trademark usage. There are no industry-wide standards for trademark use amongst journalists, only broad ethical canons about integrity in reporting.<sup>147</sup> The Society for Professional Journalist's ethical guidelines makes no mention of respect for intellectual property of any type.<sup>148</sup> The Associated Press's Statement of News Values, which is primarily a statement about journalistic ethics, also makes no mention of trademark use.<sup>149</sup>

Gentle suggestions that writers and reporters use trademarks properly appear in reporting reference books like The Associated Press Stylebook, which is a reference gospel for reporters and publishers, providing instructions as to (among other things) capitalization, punctuation, verb use, and proper noun use, including the use of trademarks.<sup>150</sup> Some definitions of trademarks or former trademarks in the Style Guide include clarification as to proper and improper use; others do not.<sup>151</sup> The Stylebook does not explain the legal consequences to a trademark holder of improper use of a mark.<sup>152</sup> In light of this lack of explanation, guidelines for using a trademark in writing appear

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<sup>144</sup> A gripe site is a website set up for the purposes of encouraging public complaints about a brand, good, or service. For example, "chasebanksucks.com" is a gripe site established to criticize the business practices of Chase Manhattan Bank. Rachael Braswell, *Consumer Gripe Sites, Intellectual Property Law, and the Use of Cease-and-Desist Letters to Chill Protected Speech on the Internet*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1241, 1245 (2007).

<sup>145</sup> *See id.*

<sup>146</sup> *Id.* at 1284-85.

<sup>147</sup> *See* SOCIETY FOR PROFESSIONAL JOURNALISTS, <http://www.spj.org/ethicscode.asp> (last visited Jan. 6 2012); ASSOCIATED PRESS, <http://www.ap.org/newsvalues/> (last visited Jan. 4 2012).

<sup>148</sup> SOCIETY FOR PROFESSIONAL JOURNALISTS, <http://www.spj.org/ethicscode.asp> (last visited Jan. 6 2012).

<sup>149</sup> *See* ASSOCIATED PRESS, <http://www.ap.org/company/news-values> (last visited Jan. 4 2012).

<sup>150</sup> *See* ASSOCIATED PRESS, ASSOCIATED PRESS STYLEBOOK AND BRIEFING ON MEDIA LAW (2011).

<sup>151</sup> *See id.* at 280.

<sup>152</sup> *Id.*

fussy or overly cautious.<sup>153</sup>

Any self-policing the publishing community conducts is organization, or publication, centric. Use of trademarks improperly with impunity by freedom writers and publishers, can be costly for trademark holders, who stand to lose an often substantial investment if a trademark becomes generic and loses protection. Yet, there are important policy benefits that current freedom publishers enjoy.

#### D. *The Special Problems of Dictionaries*

Courts use dictionaries and publications to determine whether a mark is *actually* generic.<sup>154</sup> In dictionaries, courts look for genericized definitions of a trademark alongside, or in place of, recognition that the term is, in fact, a trademark.<sup>155</sup> Such evidence may not be dispositive, but courts weigh it seriously.<sup>156</sup> In *Murphy Door Bed*, the court wrote “the term Murphy bed is included in many dictionaries as a standard description of a wall-bed.”<sup>157</sup> The court added that, while dictionary definitions were not “conclusive proof” of genericity, “they are influential because they reflect the general public’s perception of a mark’s meaning and implication.”<sup>158</sup>

Dictionaries not only *reflect* public use and perception of a term; they also indicate the way other publications use trademarks.<sup>159</sup> “When dictionary markers find, *in the objective data of everyday speech and published writing*, widespread use of well-known brand names in a fashion that has technical earmarks of genericness, they may incorporate their findings in their dictionary entries.”<sup>160</sup> Such “technical earmarks of genericness” include lowercase letters, figurative usage, or use of a trademark as a verb or stand-alone noun or

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<sup>153</sup> The Society for Professional Journalists’ magazine, “Quill” publishes a strongly worded trademark use policy with each issue, but such a statement is an aberration among periodicals. At bottom of the first page of text, the following appears: “Throughout this issue, trademark names are used. Rather than place a trademark symbol at every occurrence of a trademarked name, we state that we are using the names only in an editorial fashion with no intention of infringement of the trademark.” *Title Page*, 100:6 QUILL, 2 (2012), available at <http://digitaleditions.walsworthprintgroup.com/publication/?i=137036&p=4>.

<sup>154</sup> 2 MCCARTHY, *supra* note 6, §12:13.

<sup>155</sup> *See id.*; S.S. Kresge Co. v. United Factory Outlet, Inc., 598 F.2d 694 (1st Cir. 1979) (court used dictionary definition to determine that term was generic.); *Murphy Door Bed*, 874 F.2d at 101 (dictionaries reflect general public perception of a mark’s meaning and implication and are “influential”).

<sup>156</sup> *Id.*

<sup>157</sup> *Murphy Door Bed*, 874 F.2d at 101 (internal citations omitted).

<sup>158</sup> *Id.*

<sup>159</sup> Butters, *supra* note 100, at 511-12; Robb, *supra* note 23, at 181-82.

<sup>160</sup> Butters, *supra* note 100, at 511-12 (emphasis added).

as an adjective.<sup>161</sup> This description of the process of constructing a dictionary definition suggests that, even if evidence of improper trademark use in publications like newspapers, magazines, or online media is not directly before the court, the court indirectly factors improper trademark use in publications via a dictionary definition.<sup>162</sup> Furthermore, as discussed briefly *supra*, the appearance of a generic use of a trademark in a dictionary legitimizes and even popularizes generic use of the trademark, which could contribute to its genericide.

The manner in which other publications use a trademark is compelling evidence at trial, as parties seeking to demonstrate a mark's genericity often introduce evidence of a usage of a mark in publications.<sup>163</sup> Evidence of generic use of a mark in a publication is especially damaging when the trademark holder cannot show that he has attempted to curb this usage by means discussed in Section III.<sup>164</sup>

In *DuPont Cellophane Co., v. Waxed Products Co.*, clippings from newspapers, magazines, trade publications, and the dictionary convinced the court that the term "Cellophane" was generic.<sup>165</sup> In the *King-Seeley "Thermos"* case, the court noted that the company employed a "clipping bureau" for a time in order to monitor how the term was used in trade publications.<sup>166</sup> Indeed, with the exception of consumer perception surveys, dictionary definitions and publications are the most common pieces of evidence produced to help determine whether or not a mark is, or has become, generic.<sup>167</sup> Thus, it is not an exaggeration to say both that publications can pose a huge threat to the integrity of a trademark—it behooves trademark holders to take every step possible to control how marks are used in publications and defined in dictionaries.<sup>168</sup>

#### E. Trademark Holders' Policing Efforts Are Necessary But Not Sufficient

While courts expect trademark holders to actively police their marks, such vigilance does not guarantee a mark's continued validity.<sup>169</sup> There are a host of examples where courts recognize that a mark holder has policed his mark, but still find the mark generic.

In *Murphy Door Bed*, the court noted approvingly that the company had sent

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<sup>161</sup> *Id.* at 515.

<sup>162</sup> See generally Robb, *supra* note 23.

<sup>163</sup> 2 MCCARTHY, *supra* note 6, §12:13.

<sup>164</sup> See, e.g., *King-Seeley Thermos*, 321 F.2d 577.

<sup>165</sup> *DuPont Cellophane Co., Inc. v. Waxed Prods. Co., Inc.*, 85 F.2d 75, 79-80 (2d Cir. 1936).

<sup>166</sup> *American Thermos*, 207 F. Supp. at 13.

<sup>167</sup> See 2 MCCARTHY, *supra* note 6, § 12:13.

<sup>168</sup> See *id.*

<sup>169</sup> See *American Thermos*, 207 F. Supp. at 13; *Cellophane*, 85 F.2d at 79. See also *Murphy Door Bed*, 874 F.2d at 101.

letters to competitors asking them to cease the improper use of “Murphy bed” to describe pivot beds.<sup>170</sup> In fact, the court seemed to suggest that the Murphy Bed Company had done everything possible to rein in improper use of the mark.<sup>171</sup> The company’s efforts, however, were not enough to retrieve the term “Murphy Bed” from its firmly ensconced foothold in the public domain.<sup>172</sup>

In *Abercrombie*, the “Safari” mark for a style of clothes lost distinctiveness “despite [plaintiff’s] attempts to police its mark.”<sup>173</sup> Abercrombie had monitored the use of the word “Safari” to describe clothing, taken steps to stave off use of the word by competitors, and *still* lost trademark protection in the word with respect to certain articles of clothing.<sup>174</sup>

In *King-Seeley*, the Second Circuit faulted the company’s lax policing of its mark, but suggested in the opinion that, even if the corporation had more diligently policed its mark, the mark would have lost protection:

We are not convinced that the trademark’s loss of distinctiveness was the result of some failure on plaintiff’s part. *Substantial efforts* to preserve the trademark significance of the word *were made by plaintiff*, especially with respect to members of the trade. However, *there was little they could do* to prevent the public from using ‘thermos’ in a generic rather than a trademark sense. And whether the appropriation by the public was due to highly successful educational and advertising campaigns or to lack of diligence in policing or not is of no consequence; the fact is that the word “thermos” had entered the public domain beyond recall.<sup>175</sup>

These opinions, in essence, are verbal hand-wringing. While recognizing the inequity of such situations, these courts acknowledge they will on occasion be unable to uphold protection of a mark, despite a mark holder’s best efforts.<sup>176</sup> Policing and monitoring use of a trademark is necessary, but it is not sufficient.

#### F. *Lawsuits Do Not Effectively Control Non-Competing Third Party Use*

The only truly consequential action a mark holder can take is bringing a lawsuit, but a lawsuit is of little help to a trademark holder in preserving the

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<sup>170</sup> *Murphy Door Bed*, 874 F.2d at 99.

<sup>171</sup> *See id.* at 101.

<sup>172</sup> *Id.*

<sup>173</sup> *Abercrombie*, 537 F.2d at 12.

<sup>174</sup> *Id.* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 327 F. Supp. 657, 659 (S.D.N.Y. 1971), *rev’d* 461 F.2d 1040 (2d Cir. 1972) (lower court decision suggests that Abercrombie & Fitch wrote letters or otherwise alerted competitors to the improper use of a trademark in almost 60 instances).

<sup>175</sup> *King-Seeley Thermos*, 321 F.2d at 579 (emphasis added).

<sup>176</sup> *See e.g., id.*

integrity of his mark. A plaintiff can bring an infringement lawsuit when a competitor improperly uses an identical or substantially similar mark in a way that causes consumer confusion, such as thinking a particular product comes from Source A, when the product actually comes from Source B.<sup>177</sup> Trademark holders can also bring a dilution action: dilution by blurring or dilution by tarnishing.<sup>178</sup> In dilution by blurring, a mark holder can bring an action by showing the association of the trademark with another product “blurs” or waters down the association consumers had with the original product and the trademark in question.<sup>179</sup> A plaintiff can bring a tarnishment suit when the defendant has used the trademark in a way that hurt the trademark’s good name.<sup>180</sup>

Non-competing third party use both fails to meet the legal threshold for an infringement suit and, in most cases, falls within statutory exceptions a dilution action.<sup>181</sup> When an infringement or dilution action accrues, the action will often be against a party who uses the trademark as a commercial tool, not the party who has contributed to or caused its genericity.<sup>182</sup> By that point, however, the damage to the mark might very well be irrevocable. If the non-competing third party’s use of the trademark in a generic manner has contributed to widespread generic use of the mark or influenced, for example, a dictionary definition of the trademark that comes into a trial as evidence, a court might find that the mark is generic.<sup>183</sup> Finding the mark is generic will eliminate any legal protection the mark holder had in the trademark.<sup>184</sup>

#### V. WHY AND HOW FREE SPEECH CONCERNS LIMIT A TRADEMARK HOLDER’S ABILITY TO CONTROL USE OF A MARK

Significant policy considerations hamper a trademark holder’s ability to control how non-competing third parties use his mark. The need to protect speech and ensure access to language drives many trademark policy limitations.<sup>185</sup> Indeed, free speech concerns are the reason that generic terms

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<sup>177</sup> 3 THOMAS J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:20.50 (4th ed. 2012).

<sup>178</sup> *Id.*

<sup>179</sup> *Id.*

<sup>180</sup> *Id.*

<sup>181</sup> See 15 U.S.C. § 1125 (2012).

<sup>182</sup> Infringement and dilution-by-blurring actions are only possible under the Lanham Act against parties who have used a trademark “in commerce.” Courts have cabined the phrase “use in commerce” to mean used as a trademark in commerce, meaning used as an indicator of a product’s source. Dilution-by-tarnishment is a more nebulous, nascent doctrine of trademark law.

<sup>183</sup> See *King-Seeley Thermos*, 321 F.2d at 579.

<sup>184</sup> *Id.*

<sup>185</sup> McGevean, *supra* note 24.

receive no trademark protection in the first place.<sup>186</sup> Should generic terms receive trademark protection, competitors would be unable to use a necessary word to describe what a product is.<sup>187</sup> This, in turn, would limit competition and give the generic term wielding party a monopoly on a word and on a market.<sup>188</sup>

Imagine the difficulty, for instance, of marketing a product to compete with a “screenwipe,” had the court overturned the PTO’s refusal to register “screenwipe” as a trademark.<sup>189</sup> Describing a computer screen-cleaning device in a consumer-friendly manner without using “screen” or “wipe” would be difficult, if not impossible.<sup>190</sup>

A. *Affirmative Defenses and Speech Rights: Descriptive Use and Nominative Use*

Affirmative defenses encapsulate many of these speech concerns.<sup>191</sup> A defendant can make a “fair use” defense against a charge of infringement or dilution by showing he used the plaintiff’s mark in a descriptive way—to inform consumers about what his product is rather than his product’s origin.<sup>192</sup> This defense applies to both competitors and non-competing third parties—as long as the trademark is not being used to identify a source.<sup>193</sup>

The dilution statute goes even further. Unlike the infringement statute, the dilution statute specifically provides exceptions to dilution action, including noncommercial use and news commentary and reporting.<sup>194</sup> Courts and commentators often conflate the “fair use” defense at large with this particular statutory provision, as it is “fair” to discuss a trademark and the products the trademarks represented in “news reporting and commentary.”<sup>195</sup>

Folded under the concept of “fair use” is nominative use of a trademark.<sup>196</sup> Nominative use is the use of a mark to talk about the brand itself or the product the brand represents.<sup>197</sup> The most prominent nominative use case is *The New Kids on the Block v. News America Publishing*.<sup>198</sup> In this case, The New Kids on the Block, a popular musical group, sued USA Today for using the band’s

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<sup>186</sup> *Id.* at 1205-06.

<sup>187</sup> *See id.*

<sup>188</sup> *See id.*

<sup>189</sup> *See generally In re Gould Paper Corp.*, 834 F.2d 1017 (Fed. Cir. 1987).

<sup>190</sup> *See id.*

<sup>191</sup> McGeveran, *supra* note 24, at 1215.

<sup>192</sup> *Id.*

<sup>193</sup> *Id.*

<sup>194</sup> 15 U.S.C. § 1125(c)(3) (2012).

<sup>195</sup> *See Id.*

<sup>196</sup> *The New Kids on the Block v. News America Publ’g.*, 971 F.2d 302 (9th Cir. 1992).

<sup>197</sup> *Id.* at 308.

<sup>198</sup> *See id.* at 302.

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trademarked name to market a 900 number the paper used to conduct a reader poll about the band.<sup>199</sup> The Ninth Circuit ultimately held that use of a trademark outside of the context of capitalizing on consumer confusion and “where the only word reasonably available to describe a particular thing is pressed into service” was “outside the strictures of trademark law.”<sup>200</sup>

Most reporting use of a trademark will be nominative—using a trademark to actually discuss the brand or the product. Accordingly, many of the Associated Press Stylebook references concern nominative uses: “Blackberry. A popular device that combines mobile email and a cellphone. Manufactured by *Research in Motion LtdFalse*”<sup>201</sup> Nominative use of a trademark is crucial to the free exchange of ideas. Indeed, “much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.”<sup>202</sup>

For this reason, courts are understandably wary of siding against website operators because of free speech concerns, partly because the criticism of a brand or a brand’s products serves a useful social function.<sup>203</sup> In most cases, critical websites, or consumer “gripe sites” arise in response to an unsatisfactory experience with a company after a consumer has tried, without success, to convince the company to remedy the problem.<sup>204</sup> Gripe sites allow consumers to air grievances and also inform other consumers of problems with a product to enable them to make informed purchasing decisions.<sup>205</sup> These sites thereby facilitate robust competition in the marketplace.<sup>206</sup> Furthermore, curbing commentary about a good’s quality hampers one of the primary goals of trademark law—to encourage a trademark holder to invest in the quality of a product.<sup>207</sup> Consequently, when a trademark holder sends a cease-and-desist letter to a gripe site, often the trademark holder comes across as a bully.<sup>208</sup>

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<sup>199</sup> *See id.* at 304.

<sup>200</sup> *Id.* at 308.

<sup>201</sup> *See ASSOCIATED PRESS, supra* note 199, at 33.

<sup>202</sup> *New Kids on the Block*, 971 F.2d at 307.

<sup>203</sup> Braswell, *supra* note 142, at 1243.

<sup>204</sup> *Id.*

<sup>205</sup> *Id.*

<sup>206</sup> *See id.*

<sup>207</sup> *Id.*

<sup>208</sup> *Id.* at 1287. A number of trademark holders exacerbate this perception by the tone they taken in cease-and-desist letters to gripe sites; a number of trademark holders send vitriolic and frightening missives. *See* WEBGRIPESITES.COM, www.webgripesites.com, last visited on March 1, 2012 (chronicling web ‘gripe sites’ and other sites confronted with legal action). *See also*, Braswell, *supra* note 163, at 1284-87 (discussing effects of cease-and-desist orders on gripe sites generally).

*B. Beyond a Discussion of the Brand Itself: Trademarks As Expressive Tools*

Apart from nominative use to criticize or comment upon a brand: trademarks are critical components for expressive language.<sup>209</sup> Trademarks are the “emerging lingua franca,” having “worked themselves into the English language.”<sup>210</sup> Writers and consumers incorporate trademarks into common language because marks fill “conceptual voids.”<sup>211</sup> In fact, “most trademarks that have passed into the language have done so precisely because there was no other word to describe the product they signified.”<sup>212</sup> As language adapts to incorporate new tangible realities, use of trademarks as nouns, verbs, and literary devices has expanded accordingly.<sup>213</sup>

The evocative nature of a trademark for linguistic purpose is not insignificant.<sup>214</sup> That expressive use of a trademark fills a “conceptual void” suggests that, should speakers be precluded from expressive use of a trademark, an element of linguistic precision would be lost.<sup>215</sup> Returning to the SPAM example, using “spam” or “spamming” is more evocative than using a bland-but-precise descriptor, such as “unwanted mass mailing.” Free speech interests in preserving these evocative linguistic tools appear often in genericity court opinions.<sup>216</sup>

*C. Implications of Expressive Value on Financial Value of a Trademark*

The nature of a trademark’s place in our social and commercial environments is considerably more complicated than their historical service as source-identifiers.<sup>217</sup> A free-speech anchored analysis of a trademark’s genericity necessarily balances the preservation of public access to the expressive value of trademarks with the trademark owner’s interests in source identification.<sup>218</sup>

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<sup>209</sup> See Dreyfuss, *supra* note 11, at 397-98.

<sup>210</sup> *Id.* at 397.

<sup>211</sup> *Id.* at 417.

<sup>212</sup> *Id.*

<sup>213</sup> See generally *id.* (describing the incorporation of trademarks into vernacular English to serve as descriptors for the class of product to which the trademarked product belongs).

<sup>214</sup> See generally *id.* (describing the use of trademarks, instead of classical literature, to form rhetorical and literary allusions, and evocative metaphors).

<sup>215</sup> See *id.* at 417.

<sup>216</sup> See Margareth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 1002-12 (2007); Patrick D. Curran, *Diluting the Commercial Speech Doctrine: “Noncommercial Use” And the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077 (2004). See generally McGeeveran, *supra* note 24, at 1205-07; Dreyfuss, *supra* note 11, at 411.

<sup>217</sup> See 1 MCCARTHY, *supra* note 3, § 3:1; Dreyfuss, *supra* note 11, at 417.

This expressive value, however, does not only implicate the public's need for access.<sup>219</sup> The cultural significance of a trademark makes it an extremely financially valuable piece of property to the trademark holder.<sup>220</sup> Indeed, "a company's brand may be its *most* valuable asset."<sup>221</sup> As the social and economic character of trademarks has changed and the value of a trademark has steadily increased, trademark holders now more than ever require a tool to effectively protect their marks from genericide.

## VI. THE SHAPE OF A PROPOSED REMEDY

The fact that non-competing third parties have no obligation to comply with trademark policing reflects neither the financial value of a trademark nor evidentiary weight that policing efforts and publications' use of a trademark carry.<sup>222</sup> To encourage the creation and maintenance of trademarks, lawmakers should construct a tool that enables trademark holders to more successfully affect the way dictionary publishers use trademarks.<sup>223</sup> The creation of such a tool acknowledges trademarks' new economic and cultural position.

A number of solutions seem practical at first glance, but falter upon closer examination. The problems inherent in the first three potential solutions detailed below—the creation of a separate court system for trademark misuse proceedings; mediation; and contractual relationships—demonstrate that legislative action is the only tenable remedy. By outlining the flaws in these three solutions, lawmakers can amend current legislation to create a tool that addresses these weaknesses.

### A. *A Separate Court*

One difficulty with depending upon a tool or legal device to police trademark use is that, absent emergency injunctions, such a tool might not resolve the issue before damage to the trademark becomes permanent. Platforms for expedient and cost effective resolution exist elsewhere in intellectual property law, and such platforms could serve as a model.

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<sup>218</sup> See McGeeveran, *supra* note 24, at 1207.

<sup>219</sup> See Dreyfuss, *supra* note 11, at 405.

<sup>220</sup> Desai & Rierson, *supra* note 22, at 1796.

<sup>221</sup> *Id.* Trademarks are often worth a substantial amount of money: "Goodwill [sic] and other intangibles on the books of companies in the S&P 500 are valued at \$2.6 trillion or 10% of their total assets . . ." 1 MCCARTHY, *supra* note 3, § 2:19 (quoting *Corporate Write-downs: The goodwill, the bad, and the ugly*, THE ECONOMIST (Jan. 24, 2009), available at <http://www.economist.com/node/12992559>). Moreover, the goodwill of a business, often manifested as the value of its trademark, can be indicated on a business's balance sheet. See *Id.* at § 2:21.

<sup>222</sup> Desai & Rierson, *supra* note 22 at 1835.

<sup>223</sup> See Robb, *supra* note 23, at 183-84.

One possibility is the creation of a separate court that contends only with complaints about non-competing third party use of trademarks. The United States Court of Appeals for the Federal Circuit (“Federal Circuit”), for example, is a federal court that is the exclusive home of patent appeals, overruled only by the Supreme Court.<sup>224</sup> The Federal Circuit hears cases on appeal from the Board of Patent Appeals.<sup>225</sup> The benefits of such a scheme are apparent, namely consolidated judicial expertise about subject matter and institutional knowledge about the likelihood that certain use of a trademark would make the trademark generic.<sup>226</sup> Both of these benefits would preclude the necessity for an endless parade of linguistic experts to testify to a host of issues: the likelihood of genericide, the need to protect free expression, linguistics, or the financial value of a trademark. Judicial decisions in such a setting would come quickly and have immediate effects for both the trademark holder and the non-competing third party.<sup>227</sup>

#### B. Mediation Channels

Another possibility to streamline the process is to funnel disputes about trademark use by non-competing third parties through a mediation channel. A template for this tool, too, exists elsewhere in trademark law. The Anti-Cybersquatting Consumer Protection Act was passed in 1999 to prevent parties who did not own a trademark from registering a domain name including that trademark in order to coerce the actual trademark holder to pay for the domain name.<sup>228</sup> In cases of cybersquatting, the Uniform Domain Dispute Resolution Policy, or UDRP, exists to mediate disputes between trademark holders and domain name registrants.<sup>229</sup> To have a URL, or web address, a party must register with a domain name registrar licensed by ICANN, the Internet Corporation for Assigned Names and Numbers.<sup>230</sup> ICANN requires “all domain name registrants submit to a mandatory UDRP arbitration proceeding” if a dispute arises about the URL and certain circumstances exist; however, the eventual UDRP decision is “not binding and may be appealed” in federal

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<sup>224</sup> The Federal Circuit also has subject matter jurisdiction over certain non-patent issues, but, with the exception of patent counterclaims (which can be heard in other District Courts), is the only federal court that hears appeals about patent issues. THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: COURT JURISDICTION, <http://www.cafc.uscourts.gov/the-court/court-jurisdiction.html> (last visited Apr. 20, 2014).

<sup>225</sup> *See id.*

<sup>226</sup> *See id.*

<sup>227</sup> *See id.*

<sup>228</sup> *See Braswell, supra* note 142, at 1257..

<sup>229</sup> *See id.* at 1279.

<sup>230</sup> *See id.* at 1257, n. 115.

court.<sup>231</sup>

The problem with imposing an arbitration-type solution in the genericide-prevention context is that, unlike in cybersquatting actions, publishers or other non-competing third parties are never in a situation where they must agree to terms in order to be able to publish, write, speak, or otherwise disseminate information. Simply by existing and publishing, an entity does not agree—and should not be held to—binding arbitration.

A workable solution to this snag would be to provide the *option* of out-of-court arbitration solutions between non-competitive third parties and trademark holders. There would be no legal action involved, just a forum for non-competitive third parties and trademark holders to arrive at a compromise. The problem with this suggestion is that there is nothing that compels either party to participate. A trademark holder certainly has more (financial) incentive than a non-competitive third party, but it is difficult to see what such a third party would be able to gain out of such an arrangement. Third parties, after all, never have to conform to a trademark holder's wishes—that is why an imbalance exists in the first place. The lack of matched incentives makes this solution conceptually optimistic but practically far-fetched.

### C. *Contractual Relationships*

Another possible solution requires entrepreneurial efforts by the trademark holder. Trademark holders could seek contractual relationship with publishers. In this scheme, a trademark holder agrees to pay a fee of some kind to ensure the third party only uses his trademark properly. Should the third party fail to abide by the terms of the agreement, the trademark holder would then have a breach of contract action.

The largest problem with this approach is that there are a number of potential non-competing third parties, many of which the trademark holder may not be aware. Yet, for significant and known non-competing third parties, a contractual pre-emptive strike makes economic sense for publishers and trademark holders. A contract creates direct and specific awareness of proper trademark use and incentivizes publisher compliance while enabling trademark holders to protect marks using a device with actual legal consequences for misuse. Encouraging such contracts also underscores the voluntary participation of both parties, upholding the freedom of the press.

### CONCLUSION

In order to respect the crucial free speech interests at stake, a tool for trademark holders to police their marks must be narrowly drawn but effective. Court-developed policy to address this problem would be piecemeal, vary by jurisdiction, and evolve slowly. Thus, a remedy requires Congressional action.

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<sup>231</sup> *Id.* at 1279-80. (describing also the elements a trademark holder must allege to trigger arbitration).

Each of the solutions outlined *infra* would provide trademark holders with a separate tool to protect a mark from genericism, while simultaneously recognizing the importance of preserving the public's access to speech.

This Article has discussed at length the value of trademarks—culturally, linguistically, and financially. Because of the quasi-property rights trademark holders enjoy, the law rightly demands vigilance of trademark holders in trademark maintenance. If lawmakers and the public expect trademark holders to continue to meet these high standards and wish to continue to incentivize trademark maintenance for the public good that results, it is only equitable that lawmakers provide trademark holders the necessary mechanisms to protect their trademarks.