

Spinning Out of Trademark Protection: Highly Distinctive Marks Versus Generic Terms

What do the words “aspirin,” “escalator,” “cellophane” and “thermos” have in common? Each used to be a distinctive trademark but, over time, became a generic term that lost its protection.

Trademark Protection for Fitness Terms

The most recent example regarding this issue involves the terms “Spin,” “Spinning,” “Spin Pilates” and “Spin Fitness,” all of which are registered trademarks with the U.S. Patent and Trademark Office (USPTO) and owned by Mad Dogg Athletics, Inc.

Peloton Interactive, Inc. petitioned the Trademark Trial and Appeal Board of the USPTO (TTAB) to cancel all of these registrations on the grounds that the marks have become generic terms for a type of exercise bike and associated in-studio classes and thus are no longer entitled to protection.

Trademark Considerations

A trademark’s protectability hinges on its distinctiveness (i.e., its ability to function as a source identifier for an entity), which falls on a spectrum. At the strongest end of the spectrum are fanciful and arbitrary marks, which are highly distinctive and entitled to robust protection. **Fanciful marks** are made-up words created to function as trademarks, such as “Clorox” for cleaning and disinfectant products. **Arbitrary marks** are real words used in connection with unrelated products or services, such as “Apple” for electronics.

In the middle of the spectrum are **suggestive marks**, which conjure up or hint at qualities of a product or service without actually describing them, such as “Netflix” for streaming movie and television services.

On the weakest end of the spectrum are **descriptive marks** and generic terms. A descriptive mark describes the characteristics of the product or service and can only become protectable if it acquires secondary meaning through extensive advertising, high profile usage and/or consistent use over time, such that consumers come to associate the descriptive mark with the brand. One such example is “U.S. Postal Service” for mail delivery services in the United States.

In contrast, a **generic term** identifies the class of which the offered product or service is a member, such as “Smartphone” for a mobile phone with computer functions. A generic name is not, and can never become, protectable, otherwise competitors would be precluded from referring to their own products or services by their commonly known names or terms.

There is tension between a well-known word being a highly distinctive, protectable trademark and becoming generic and thus incapable of protection. Specifically, a trademark can be so ubiquitous and successful that consumers identify it as the commonly known name or term for a product or service, rather than as a particular brand. When that happens, the trademark can be the victim of “genericide” and lose its legal protection, which is what happened to “aspirin” for a pain reliever, “escalator” for a moving staircase, “cellophane” for a thin transparent wrapping material, and “thermos” for an insulated bottle.

Weakest

Strongest



Notably, if properly used and maintained, and in direct statutory contrast to protection for patents and copyrights, trademark protection does not have a time limit.

In fact, there are multiple steps that can be taken to help protect a distinctive trademark indefinitely, such as:

- Always using a trademark as an adjective that is followed by a generic term or noun, and never pluralizing a trademark or using it as a verb.
- Never altering or abbreviating a trademark and always setting it apart from other words, such as by capitalizing it, using a different typography or color, or enclosing it in quotation marks.
- Using proper trademark notice, such that the symbol ® should be used after a federally registered trademark and the symbol TM should be used after an unregistered mark.
- Policing and enforcing against infringements of a trademark.
- Marketing campaigns to educate the public about proper trademark use, such as when Kimberly-Clark Worldwide Inc. took out a newspaper advertisement explaining that KLEENEX is a registered trademark that should always be followed by the ® symbol and the term “Brand Tissue.”

What Businesses Should Know

- Generic terms can never be protectable trademarks. Highly distinctive marks can become generic terms that lose their protection if they become synonymous with the common name or term for a product or service rather than associated with a brand. However, there are steps that can be taken to help maintain trademark protection, even indefinitely.
- While highly distinctive marks may not immediately communicate to consumers the specific products or services being offered, they are afforded the broadest scope of protection.
- Advertisers and their agencies can seek to mitigate risk by carefully selecting a mark and consulting with counsel to evaluate its strength and protectability, as well as how to help maintain its protection.

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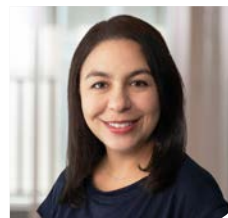


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