



Genericness

Trademark & Unfair Competition
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ericejohnson.com

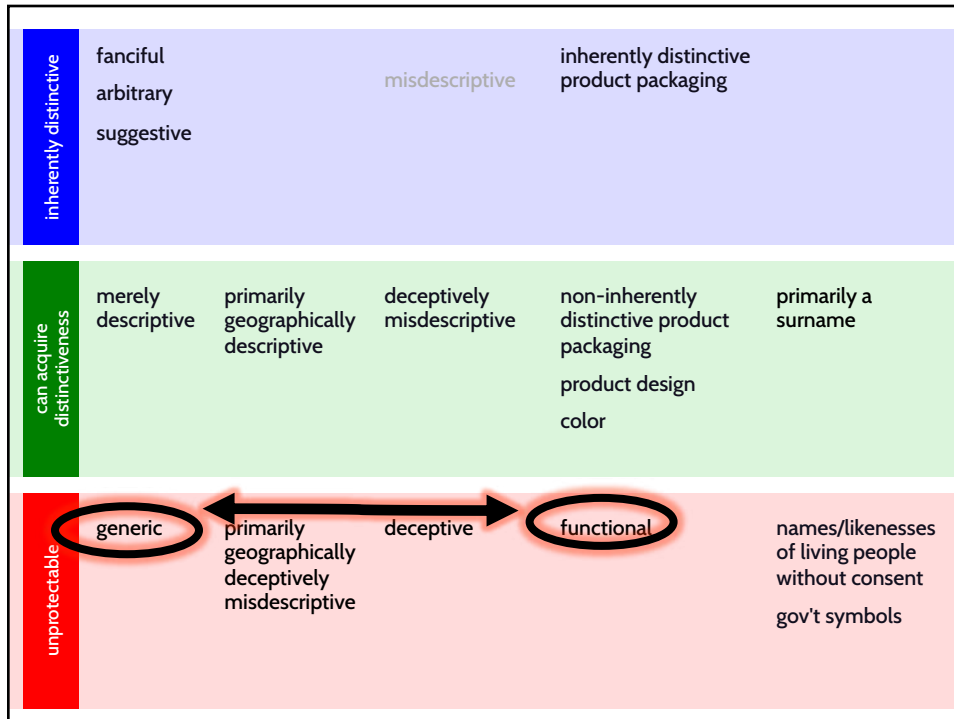


Konemark
Most rights sharable

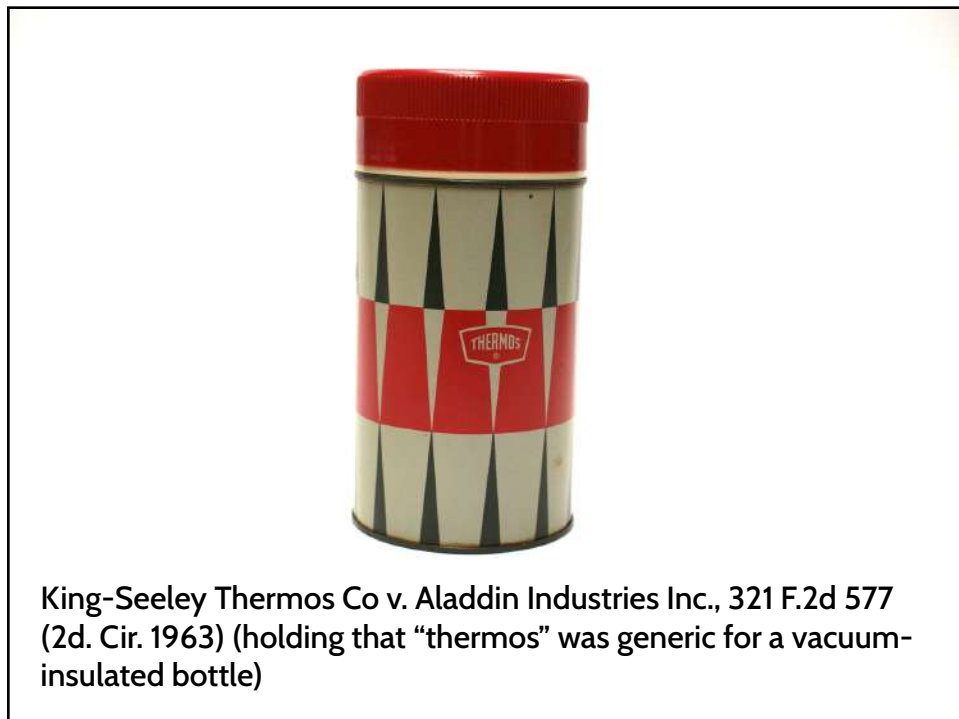
source

distinctiveness

inherently distinctive	fanciful arbitrary suggestive		misdescriptive		inherently distinctive product packaging
can acquire distinctiveness	merely descriptive	primarily geographically descriptive	deceptively misdescriptive	non-inherently distinctive product packaging product design color	primarily a surname
unprotectable	generic	primarily geographically deceptively misdescriptive	deceptive	functional	names/likenesses of living people without consent gov't symbols

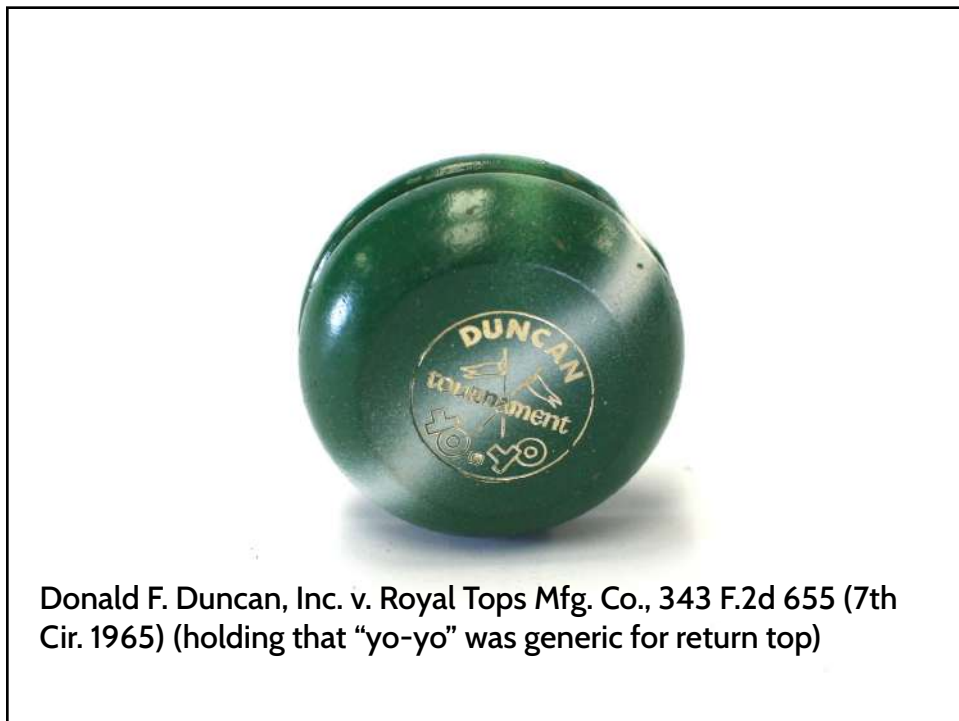


Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938)
 (holding that trademark law would not allow Nabisco to prevent rival Kellogg from making its own shredded wheat cereal; the cereal's shape was functional, and therefore unprotectable as a trademark, and the term "shredded wheat" was generic, and therefore unprotectable as well)





DuPont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2d Cir. 1936) (holding that “cellophane” was generic for cellulose-based plastic film)



Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655 (7th Cir. 1965) (holding that “yo-yo” was generic for return top)

Could these be
generic?
*What do you
think?*




travel
CHANNEL®


Pampers®

inherently distinctive	fanciful arbitrary suggestive
can acquire distinctiveness	merely descriptive
unprotectable	generic



held:
suggestive



A.J. Canfield Co. v. Honickman, 808 F.2d 291 (3d Cir.1986)
 (holding that “diet chocolate fudge soda” was a generic phrase)

Wite-Out[®]

held:
suggestive

Remember that as a threatened party (potential defendant) for trademark infringement, you could mount a defense based on genericness. This can change settlement dynamics!


What if you make a bunch of flying disc toys marked “frisbee” and you get a threatening letter from Wham O?



If a trademark is misused it could come undone.

If you didn't know zipper was a trademark, don't worry, it's not. But it used to be. It was lost because people misused the name. And the same could happen to ours, Xerox. Please help us ensure it doesn't. Use Xerox only as an adjective to identify our products and services, such as Xerox copiers, not a verb, "to Xerox," or a noun, "Xeroxes." Something to keep in mind that will help us keep it together.

xerox.com

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This is an example of prophylactic advertising done for prospective use in litigation to defend against an invalidity attack based on the the XEROX mark having become generic.

Note the exhortation to use xerox “only as an adjective”

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How much probative value does this have?
Probably not much.

What matters legally is not that Xerox is running these ads—what would matter is if they are effective in changing the public's use and understanding of the word.

But regardless, the fact that Xerox has put in this effort is something a judge or jury might latch on to, and that's probably what Xerox is really hoping for.



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