

TRADEMARK EROSION: AVOIDING GENERICIDE





In 1950, “escalator” officially became just another word.

Prior to that year’s landmark case of [Haughton Elevator Co. v. Seeberger](#), Otis Elevator Company owned exclusive rights to the trademark “ESCALATOR”; it was a brand name used to sell a particular type of moving staircases. But the court decided that the company had relinquished that control when it advertised its product alongside the common noun “elevator” — “the latest in elevator and escalator design” — and in lowercase format to boot, thus reducing the trademark to generic status.

This is a legal situation known as trademark erosion or genericide. It has also happened to former brand names like Aspirin and Thermos, and even heroin, after each one gained such substantial marketshare and mindshare — along with taking a laissez-faire attitude toward brand protection — that their trademarks actually “[became the product itself rather than an indication of source of the product or service.](#)”

Think yo-yo, zipper, trampoline — these now-common nouns all began life as trademarks. But the list doesn’t end there. Not by a long shot.



Sam Parker
@sammy1137

 Follow

Puffs plus lotion are the best Kleenex I've ever used

10:41 PM - 20 May 2016

   1



Laura Di Labio
@lauradilabio

 Follow

Actually, they're just "facial tissues" if they don't come from the Kleenex region of France.

11:53 AM - 27 Oct 2015

  1,033  1,879



2. PATROL AND CONTROL

[Mark D. Penner](#) is a lawyer with Toronto's Fasken Martineau specializing in trademark law. Over the span of his distinguished career, replete with five straight appearances on the [IAM Patent 1000](#) for excellence in patent prosecution, he has counseled clients on how to protect their trademarks from misuse and erosion.

According to Penner, the first thing that companies need in the fight against trademark genericization is vigilance: "What they have to do is patrol, patrol and control the use of the mark in the marketplace to make sure people are using it as a trademark."

Oliver Herzfeld, chief legal officer at global brand extension agency [Beanstalk](#), [agrees](#): "At a minimum, [trademark] owners should establish an appropriate level of proactive monitoring."

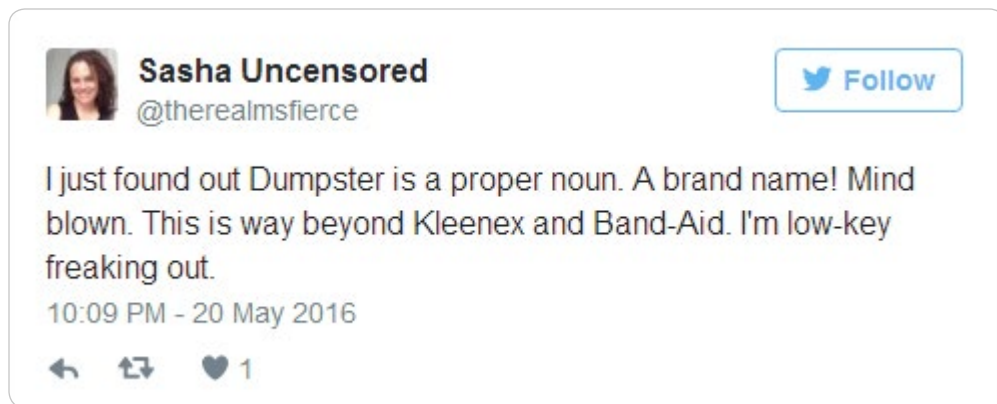
Gaining awareness of how your brand is being used in both traditional and social media is crucial to protecting your trademark; the first because it influences the public, the second because it reflects how your mark is being used by members of the general public.



NOT AN EXACT SCIENCE

But even then, after being armed with the knowledge of who is saying what when and where, measuring and pinpointing trademark erosion — and when a mark may be at risk of genericide — isn't an exact science.

Penner explains that the true test is to determine whether or not the mark has lost its distinctiveness. Problem is that, once that's deemed to have happened, it may be too late. Even more frustrating for brands and marketers is that each case is unique — there is no cut-off number that establishes a lack of distinctiveness.



It's an irony of which Penner says brands must be aware. "The problem is that you invest a lot of time, money and effort to have people associate your brand with a particular product, and have done such a good job that they actually think it's a reference to the product itself, then you've actually seceded too much," he says.



“Because what happens is you’ve now effectively given the world that mark, and you may actually lose it. Somebody might challenge it on the basis that it has become genericized, and it’s no longer distinctive of you.”



“An essential function of a brand is to associate a series of products or services with a specific business source... Therefore, becoming a synonym is not tantamount to commercial success, but rather to the loss of the mark identity, or put in other words, to trademark erosion.”

- Paulina Maturana, Clarke, Modet & Co.

Bottom line is this: if you don't know how consumers and commentators are talking about your trademark, you can't ensure it's being respected.

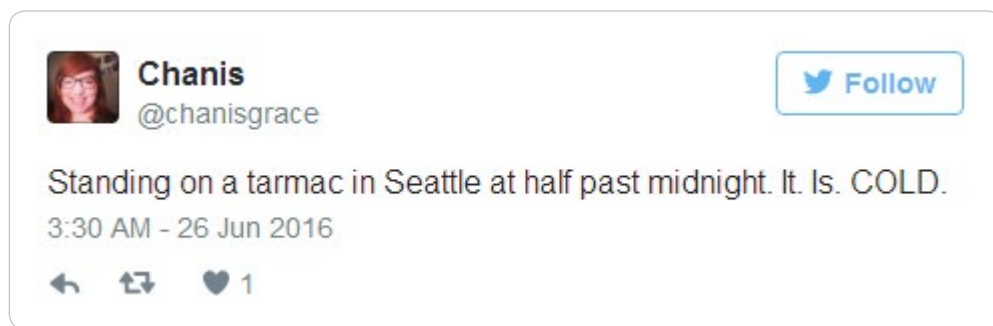
A trademark must, by definition, have distinctiveness. That distinctiveness is lost precisely when the trademark is used as a synonym for the product type in general. And this is what companies must avoid.

Because contrary to what most of us might think, “becoming a synonym is not tantamount to commercial success.” It might seem strange that achieving such heights of popularity would have negative consequences — after all, dominating mind share is every marketer's dream — but the truth is that there is a fine line between having it all and losing it all.

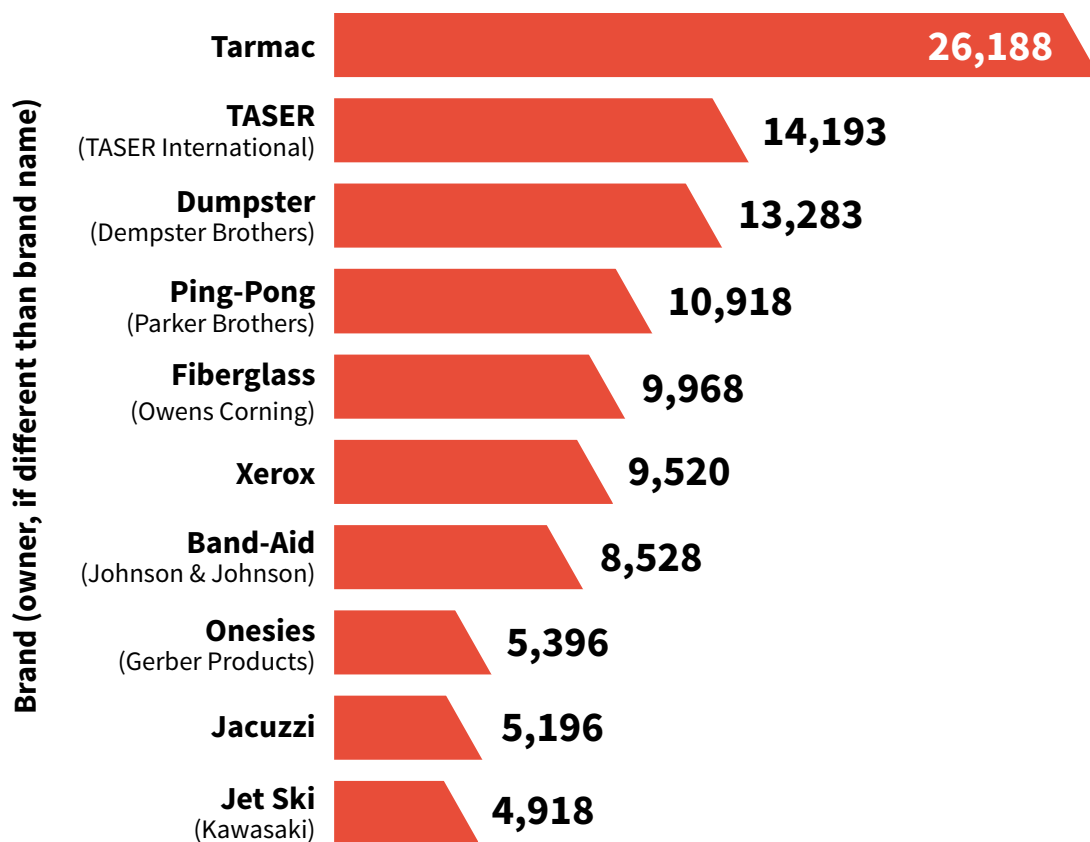
3. WHICH BRANDS NEED TO “WATCH THEIR BACKS”?

Over the span of seven weeks, MediaMiser used its media monitoring and analysis software to track mentions in online news and on Twitter of 24 trademarked brand names identified by [Consumerist](#) as trademarks that need to “watch their backs” in terms of [potential genericization](#). They’re brands we’ve all referred to hundreds of times, probably in many cases to reference similar (but other) products, brands like Frisbee, Kleenex, Bubble Wrap, and Popsicle.

We found the following to be some of the most mentioned brands (along with their owners, if a different name than the brand itself) in online news articles.



ONLINE NEWS - MOST MENTIONED TRADEMARKS (APRIL/MAY 2016)



Honourable mentions: Teflon (DuPont), Velcro (Velcro Co.), Frisbee (Wham-O)

COMPARATIVE MENTIONS: BRANDS VS. GENERIC TERMS

While the above list indicates some of the most mentioned trademarks in online news articles for a limited slice of time, what's even more interesting is the rate of mentions of various trademarked brands compared to the well-established generic terms for the same products.

We monitored for mentions of brand names “Kleenex” and “Frisbee” during the same time period versus their generic counterparts. Kleenex was mentioned nearly 750 per cent more often in online news than “facial tissue”, while Frisbee was mentioned nearly 2,000 per cent more often than the term “flying disc”.



Kleenex	<div></div>	3,217
“Facial Tissue”	<div></div>	381



Frisbee	<div></div>	3,849
“Flying Disc”	<div></div>	187



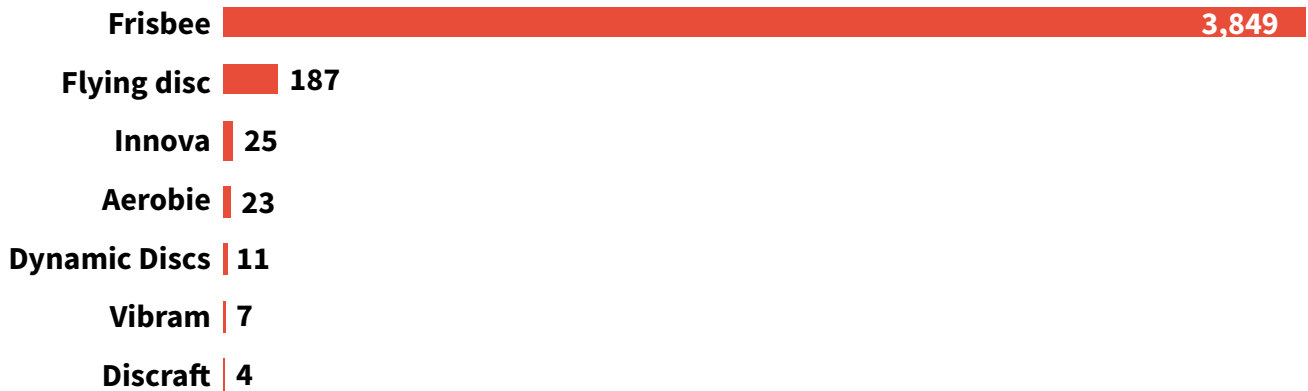
Ping Pong	<div></div>	10,918
“Table tennis”	<div></div>	3,405

According to [Wikipedia](#), a trademark can become genericized when “the products or services with which the trademark is associated have acquired substantial market dominance or mind share, such that the primary meaning of the genericized trademark becomes the product or service itself rather than an indication of source for the product or service.”

Any trademark that achieves such market dominance, like the ones listed above, risks its legal protection and intellectual property rights “unless the owner... works sufficiently to correct and prevent such broad use.”

MARKET DOMINANCE

A look at Frisbee's mentions in the news versus some of its biggest competitors only cements the above:



Brittani Bartok
@BrittaniBartok

 Follow

There's just no cool way to chase down a bouncing ping pong ball...

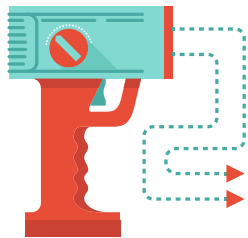
1:23 PM - 17 Apr 2015

  13  41

THE CURIOUS CASE OF TASER

One particular company on our list has done a particularly remarkable job in terms of policing the use of its brand is TASER International, makers of those ubiquitous stun guns called Tasers (they prefer to write their brand name in all uppercase, similar to the approach employed by ESCALATOR years ago).

But unlike the latter, the stun gun maker has been aggressive in pointing out that it's OK to use the term "Taser" if the brand is known. If not, it's simply a stun or electroshock gun. It's a strategy that seems to have had an impact, at least in the news media, where references of "stun gun" or "electroshock gun" outstripped those of "Taser" or "tasered":



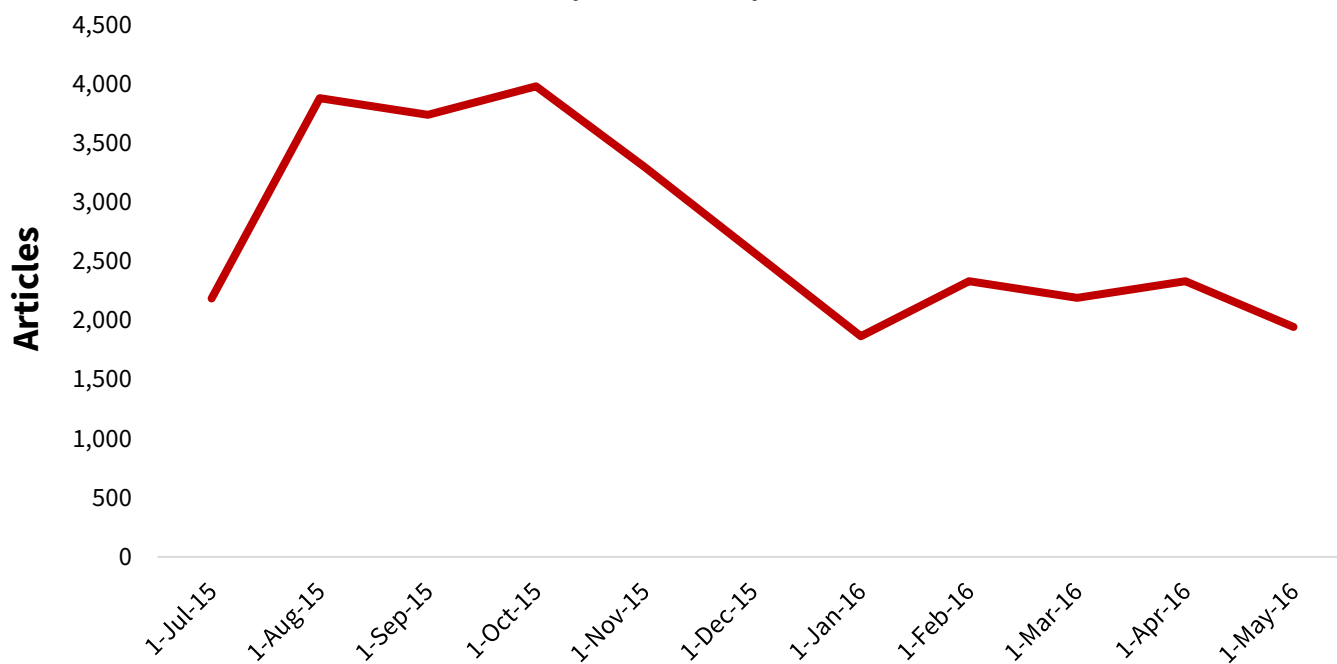
The company has also gone on record to say that ["Taser is not a verb"](#), meaning terms like "Tasered" and "Tased" are not cool, even though some in the media have argued it's too late for that:





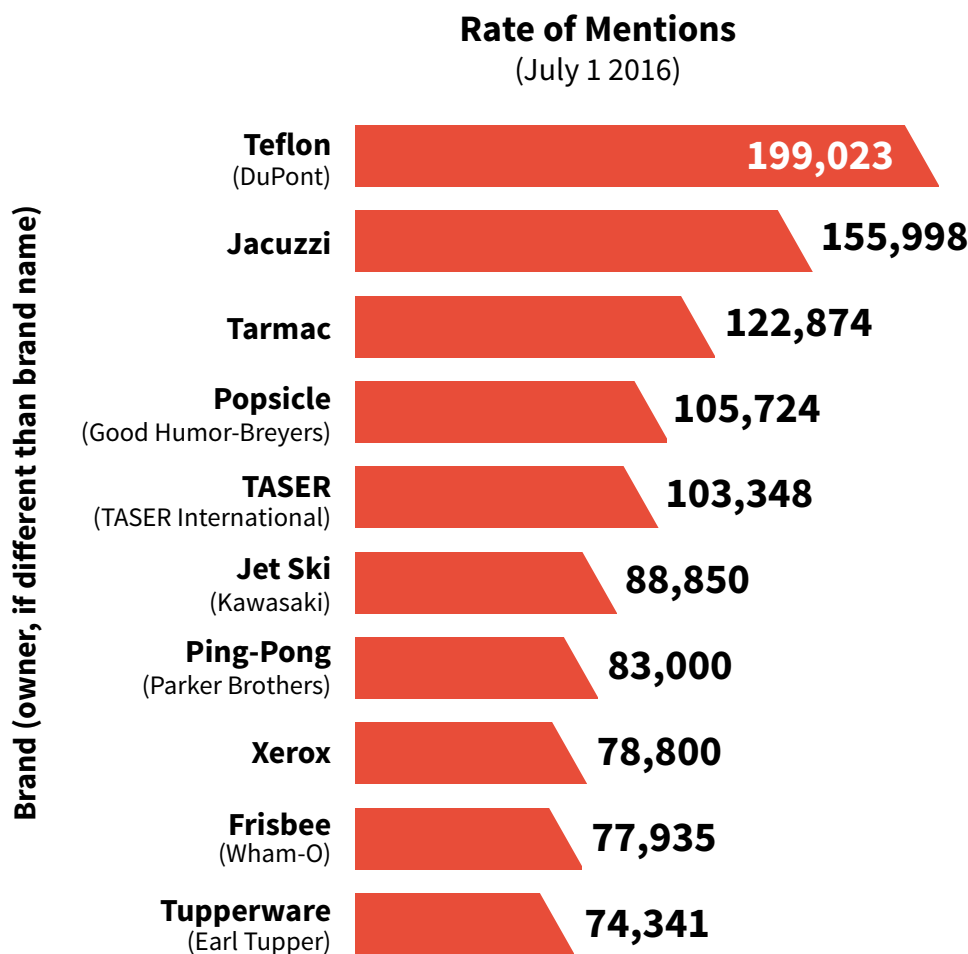
Indeed, the numbers seem to show that Taser's strategy is working. We tracked mentions of "tased" or "tasered" in online news from July 2015 to July of this year, and it would appear as if its usage is trending downward:

Mentions in online news of "tased" or "tasered"
(July 1, 2015 - July 6, 2016)



TWITTER - MOST MENTIONED TRADEMARKS

On Twitter — which is of course much harder to police than the mainstream media — we monitored for the rate of mentions of the same number of brands a little later in the year. And though the results only indicate rankings over a small slice of time, **six out of the top ten and nine of the top thirteen most mentioned brands of all 24 analyzed appeared on both lists.**



Honourable mentions: Dumpster (Dempster Brothers), Chapstick (Wyeth Consumer Healthcare), Styrofoam (Dow Chemical)



WHAT ABOUT XEROX?

Xerox, for its part, is lumped in here mostly because of the ongoing belief that its trademark is at risk. But what we discovered while analyzing the ~100K tweets containing the term — the high number due largely to the fact that it is a massive and wildly successful company — is that most were legitimate mentions of the company itself.

Where the notion of trademark erosion did crop up in regard to Xerox was often in tweets where “to xerox” was *cited as an example* of genericide. But in our analysis, “Xerox” was rarely used organically as a verb. Backing this up are the results of an [online survey](#) conducted by the [World Intellectual Property Review](#), which found that “readers overwhelmingly believe that Xerox should not be a generic term.”

4. POLICING YOUR TRADEMARK

Most in trademark law agree you should actively monitor your brand's usage in the media and on social. But what gets tricky is what to do next. After all, you can't come down like a ton of bricks on someone who tweeted about Googling something on a Saturday afternoon, lest you end up looking like the language police.

Fasken Martineau's Penner says brands could learn a lot from Jack Daniels, which instead of an iron fist took more of a [velvet glove approach](#) when its trademark was misused, and that ended up going viral thanks to its "exceedingly polite" nature. "I think Jack Daniels got a lot of goodwill because of the way they handled (that situation)," he says. "It could have just as easily (gone another way), if they went super aggressive."

SO WHAT CAN BRANDS DO TO PROTECT THEMSELVES?

Ensure you (and others) use your trademarks properly as trademarks, making it clear that your word is a trademark. If you're ever challenged down the road, it's important to be able to show you've done all you can to protect the trademark's integrity:

- 1 Use "TM" or "R" where appropriate to indicate that term is a trademark, and ensure that you distinguish it from other text somehow (by capitalizing the word, or taking a page from Taser's book and using all caps);
- 2 Monitor (patrol) both traditional and social media to ensure your brand is being properly represented, and that it doesn't become a replacement word for a class of products or services. For objectivity's sake, you may wish to consider using third-party organizations for this;
- 3 Finally, along with patrolling, you must also control your brand. The public (and media) must be made aware that there's value to your trademark. Cease-and-desist letters and legal action are not out of the question, but don't be too heavy handed, or it could come back to bite you in the court of public opinion.

WHAT ABOUT YOUR BRAND?

TRACK AWARENESS, SENTIMENT, AND REPUTATION OF YOUR BRAND
OR YOUR COMPETITORS WITH MEDIAMISER.

BOOK A DEMO

APPENDIX

All brands tracked

Tarmac
Taser (Taser Systems)
Dumpster (Dempster Brothers Ltd.)
Ping-Pong (Parker Brothers)
Fiberglass (Owens Corning)
Xerox
Band-Aid (Johnson & Johnson)
Onesies (Gerber Products Ltd.)
Jacuzzi
Jet Ski (Kawasaki)
Teflon (DuPont)
Velcro (Velcro Company)
Frisbee (Wham-O)
Adrenalin (Parke Davis)
Styrofoam (Dow Chemical Co.)
Kleenex (Kimberly-Clark)
Tupperware (Earl Tupper)
Bubble Wrap (Sealed Air)
Super Heroes (DC Comics, Marvel Comics)
Popsicle (Good Humor-Breyers)
AstroTurf (Monsanto)
Crock Pot (Sunbeam Products)
Plexiglass (Altuglas International, Rohm & Hass)
Q-Tip (Unilever)
Chapstick (Wyeth Consumer Healthcare)