

Lanham Act §§ 10, 45 (15 U.S.C. §§ 1060, 1127)
CB 312-356

Genericism

Bayer Co. v. United Drug Co. (SDNY 1921) [312]

typo: missing "that" after but in p. 313, line 6 (in old edition)

Aspirin (coined name) was patented, ran out in 1917. Up to 1915, however, main sales distribution channel was thru chemists - who sold it as "Aspirin" w/out anything indicating who manufactured it.

1915 Bayer starts selling direct to retail in package "bayer-Tables of Aspirin" but LH says by then it's too late - it's generic.

HELD: grant an injunction against direct sales of the drug under the name 'Aspirin' to manufacturing chemists, physicians, and retail druggists. This will, of course, include invoices and correspondence.

In sales to consumers there need, however, be no suffix or qualification whatever. In so far as customers came to identify the plaintiff with 'Aspirin' between October, 1915, and March, 1917, this may do it some injustice, but it is impracticable to give any protection based on that possibility. Among consumers generally the name has gone into the public domain.

Stix [SDNY 1968) (per Weinfeld) [315]

competitor's campaign to genericize a mark ruled out of order

....why? if "purpose of the genericism doctrine is to permit competitors to call their competing goods or services by their commonly -known names"

- a) when you start campaign it's not generic
- b) bad faith,
- c) not 'natural'

PROBLEM p. 328: what's wrong with the ad?

King-Seeley Thermos (2nd 1963) [328]

Issue: use of survey evidence as to generic/source recognition

Q:who should be surveyed?

Q:what should they be asked?

A: all consumers, not just purchasers

- should not be asked "motivation to buy" or
- rather should be asked something like, "what do you call a thingie" and "do you know who makes {brand-name}" i.e. "what do you call a container to keep things hot or cold" and "who makes them?"

Notes 4 & 5 on pp. 330-31 deserve attention.

Note 4.

Amendments to Lanham Act § 14 & §45

underline that

- merely being unique doesn't make you generic and
- being anonymous or unknown source won't necessarily make you generic.

Note 5. Survey design as a black art...

Dupoint v. Yoshida (EDNY 1975) [332]

Evaluation of survey evidence to answer question whether "TEFLON" is generic for "non-stick pan coating"

NB. also where burden of proof lies: on party moving for finding of generic-ness, (if trademark exists) -- key paragraphs are last two on p. 334

Note also the issue of passage of time at [335] -- keeping a term from becoming generic requires a quick response, or at least is much helped by it.

NOTE WELL

[336] You really, really can't get a TM for a generic term (for the thing to which it refers). Even 'defacto 2ndary meaning' - when public learns to associate generic name ('ice' beer or 'lite' beer) with one manufacturer – does NOT allow one to get TM for a generic! And this is true whether you originated the term, or appropriated it.

AOL v. AT&T (4th Cir. 2001) [336]

AOL claims AT&T infringes "Buddy List" "You Have Mail" and "IM"

DCT said, on summary judgment, that they are all generic

CTA says "Buddy List" has issues of fact that need trial; affirms on the other two.

Facts:

AOL registered BUDDY LIST in 1998 (claiming use as a SM since 8/31/95), but not the other marks, although it promotes them a lot.

Recall that PTO's decision is NOT entitled to deference. Rather it is EVIDENCE [339] that this particular registered mark is valid (here, suggestive) and not merely descriptive.

Since it's evidence it

- (1) can be rebutted but
- (2) issue can't be decided on SJ motions since weighing evidence requires trial (SJ is only for uncontested facts!).

In contrast, for

"You have mail" there was (1) no registration and (2) boatloads of prior use.

Plus, the court says reasonably, AOL's uses of the phrase [342] is functional - it's not a signifier of a service offered for sale - ie. you don't see it when you *don't* have mail. "When words are used in a context that suggests only their common meaning, they are generic and may not be appropriated as exclusive property." This is an important point, and easy to get wrong.

eg. "apple" or "blackberry" is generic for fruit but not computers
[NB every generic word IS trademarked!]

AOL's survey evidence that lots of people associate AOL with "you've got mail" is useless since at best it shows "de facto secondary meaning".

Luttig's dissent says, "YOU HAVE MAIL" is generic but AOL uses "YOU'VE GOT MAIL" which is different enough to maybe be TM-able.

Questions p. 346

1. Are acronyms of a generic automatically generic? *Blinded veterans* court thought it was, but AOL court seems to find for IM there may be issues of fact?

2. Why exactly was 'You have mail' generic?

A. It did a function?

B. AOL had used it generically?

C. Others had used it generically?

"Is a phrase 'born generic' if it is coined? [no. but it can be if it's made of common words and functional]

Harely Davidson v. Grottanelli (2d 1999) [346]

H-D sued local garage and motorcycle repair service DBA "Hog Farm"

H-D said HOG was a common law TM for their motorcycles.

Held, on basis of prior use and dictionaries and films, that "HOG" is generic for large motorcycles. [contrast to BUG for a car! - just one brand]

GENERIC TERM IN A FOREIGN LANGUAGE [349]

Otokoyama sake - let one merchant TM then others couldn't call it by its name, albeit a foreign word.

EVEN A GENERIC TERM CAN'T BE USED IN A WAY THAT CAUSES CONFUSION
[349] - just look different and you are OK.

Religion cases

Religions are generic
Denominations/Churches may not be.

Genericness is hard to wield as a sword (to cancel mother church's mark); easier as a shield (to defend against claim you can't call yourself what you like).

But just because it's easier to wield as a shield doesn't mean that it's a self-wielding argument. See Te-Ta-Ma Truth Foundation v. World Church of the Creator (7th Cir. 2002) [Supp @ 39] in which the two bodies fight over "Church of the Creator". The defendants -- bigots -- didn't produce any evidence other than a dictionary to rebut the SJ motion by the plaintiffs. The court held that "Church of the Creator" was not generic, unlike "lite beer" or "sandwich" as it was not a genus (like "church") but rather a species (a denomination).

Microsoft v. Lindows

M\$ claims that Lindows, a linux-based system that runs windows-compatible programs, violates its TM in WINDOWS.

Lindows defended, inter alia, with a claim of genericism.

Supplement @ p. 34. Note the importance of defining

- the relevant public
 - the relevant "Genus or category of products at issue"
- in a genericism claim.

Note also that the timing issue will be critical in some cases. In the case of TEFLON, the defendant obviously wants the time to be later -- after the term is common. And the law allows this.

In the Lindows case, however, the defendant wants the time to be early -- before the creation of what it would term a huge amount of defacto secondary meaning. Is that kosher?

The answer has to be "yes" -- if it weren't then the defacto secondary meaning doctrine would have no practicable effects. [See supp @ 36]

Rehearing denial (http://www.net2.com/Reconsideration_Denied.pdf)

Is the judge getting testy here?

Bonus: Here's an interesting news story.

http://www.infoworld.com/article/04/02/17/HNlindash_1.html

Lindows becomes 'Lin---s' in Europe

A court order bars the full name

By Joris Evers, IDG News Service February 17, 2004

Following court orders barring the Lindows name, Linux vendor Lindows.com Inc. has changed its name in several European countries to Lin---s, pronounced Lindash.

By changing its name, Lindows.com can continue to offer its desktop Linux product to citizens of those countries where Microsoft Corp. won injunctions banning the Lindows name, Lindows.com said in a statement Tuesday.

A new www.lin---s.com Web site has been created especially for people in Belgium, the Netherlands, Luxembourg and Sweden, Lindows.com said.

"This was in direct response to the court order barring us from the Benelux regions," Lindows spokeswoman Cheryl Schwarzman said.

An Amsterdam District Court judge ruled in late January that Lindows.com's use of the terms Lindows, LindowsOS and Lindows.com violated the Benelux Merkenwet, the branding law for Belgium, the Netherlands and Luxembourg (Benelux). Lindows looks too much like Microsoft's Windows, the judge found.

Microsoft earlier won preliminary injunctions barring Lindows.com from using the Lindows name in Sweden and in Finland, it has said. However, according to Schwarzman there currently is no legal barrier preventing Finnish citizens from buying from Lindows.com.

After several legal setbacks in Europe, Lindows.com last week claimed a victory in its U.S. battle with Microsoft. A district court in Washington said that if the case came to trial, it would instruct the jury to consider whether "windows" was a generic term before Microsoft introduced software with that name in 1985.

Microsoft has insisted several times that its pursuit of Lindows is about only the Lindows name, and not about its competing operating system. A Microsoft spokeswoman did not immediately return a call seeking comment on the new Lindash name.

Dial 1-800 [353]

Dial-a-Mattress gets cited frequently.

Stands for propositions that phone numbers which spell stuff can be protected via TM, but can also be generic.

Also stands for proposition that even if something is generic, there may be unfair competition issues if someone is trying to cause confusion.

Note the subtle difference with the 1-800-HOLIDAY case. There the defendant took advantage of people dialing zero instead of "O" -- but didn't advertise. The 6th Circuit held that this constituted taking advantage of existing confusion rather than causing it, and hence was not illegal.

Nice questions on p. 355.