

The Proper Care and Feeding of Your Trademarks

By Sandra Wunderlich

Trademarks are an incredibly valuable asset for companies. They persuade consumers to purchase products or services, and are what a company uses to communicate quality and value to the consumer. Yet, too many people take this value for granted by forgetting that trademarks need care to remain strong, and feeding to continue to grow in value.

Most companies are well aware that they must police their mark to prevent unauthorized use, or the potential for confusingly similar marks to dilute the power of their mark. But, sometimes threats to the strength and validity of a trademark come from the improper use of the mark by the public or the media.

On May 16, 2017, Google, Inc., won another round in its battle to keep its brand from becoming generic. The Ninth Circuit Court of Appeals held that Google Inc.'s incredibly valuable trademark Google® has not become a generic term for search engines even though many people have come to use the mark as a verb (as in, "I Googled it to find more information.") While this use of the trademark acknowledges the power of the brand as a search engine, it also puts the name at risk of being lost as a trademark. Google, Inc., recognized this risk by taking steps to inform the public and the media consistently of the proper use of its name. The Ninth Circuit specifically noted that evidence Google, Inc., policed its mark weighed against a finding that Google® had become generic.

Some more famous trademarks that lost this battle include aspirin and cellophane. These terms became synonymous with the product rather than as a *source* of the product so they were no longer protectable as a trademark. To avoid this fate, Xerox

Corporation launched an expensive ad campaign to

encourage its customers to stop using its name as a verb and instead "photocopy" documents ("You cannot xerox a document, but you can copy it on a Xerox® brand copying machine.") Similarly, Kimberly-Clark Worldwide, Inc., used advertising to save its brand by requesting its customers stop referring to all tissues as Kleenex® tissues. ("You don't need a Social Security number to get your identity stolen. When you spend nearly a century building a name that people know and trust, the last thing you want is people calling any old tissue a Kleenex® Tissue.")


With the avalanche of social media, the public's use of new words spreads quicker than before and routinely adds words to the English lexicon. What used to take years to develop now takes a much shorter period of time. This could put your brand at risk of becoming generic, and therefore not subject to protection if you fail to act when the mark is used improperly. Although ad campaigns have been effective to discourage the generic use of brand names, they are expensive and there is no guarantee that a court will agree with your argument. Preventing the improper use of the mark by the media and the public is not only a good practice, but it might just prevent the loss of trademark protection.

The Ninth Circuit's recent decision is a good reminder of the necessity for the proper care and feeding of your trademark.

1. Use the proper symbol for the marks on all packaging, printed materials and advertising. The symbol ® should be used for marks that are registered with the United States Patent and Trademark Office. Use ™ for trademarks and ℠ for service marks that are not registered.
2. Remind consumers and the media not to use your mark as a noun or a verb. Instead the mark should be used as a proper adjective of the generic name for the product or service. Although the Ninth Circuit recognized that using



Google® as a verb does not automatically make it a generic term, it is wise to police your mark to prevent challenges if possible.

3. Use your trademark consistently and remind others to do the same. A trademark should not be used in different forms such as making a plural mark singular, or a singular mark plural. If you are referring to more than one of the products or services, you should use the proper mark without adding or subtracting an "s." For example, "Hand me two Kleenex® tissues" rather than "Hand me two Kleenexes" or "Hand me a BAGGIE for my sandwich," when the brand is plural: "I placed my sandwich in a BAGGIES® plastic bag." The last thing a company needs when defending its mark is to have examples presented to the court where company employees did not use the mark consistently.
 4. Similarly, you should not use the mark or allow others to use the mark in a possessive form if that is not the actual mark. Example: McDonalds® hamburger rather than McDonald's hamburger.
 5. Develop a process to identify improper uses of your mark, and take appropriate steps to educate those who do not use it properly. This includes your customers, employees, distributors, etc.
- Be vigilant to use your trademark properly, and remind others to do the same. Consistent and proper use, along with careful policing of your mark, ensures that the message communicated by your brand is not diluted, and creates the right conditions for your trademark to flourish. 



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