

The Art of Trademark Use

Do you know what TRAMPOLINE, ESCALATOR and WALKMAN have in common? Initially all were distinctive trademarks, but over time they lost the power of being distinctive and entered the public domain.

There are several reasons for this phenomenon. It occurs when consumers start to use the trademark as the “name” of the product. It can happen because of the product’s popularity or improper use of the trademarks by the public or even by the trademark owner himself. In some instances, it may be difficult to prevent such evolution as linguistic changes are impossible to stop. MASTER, as an example, was a distinctive trademark in Switzerland at a time when English was not commonly used in advertising language. Today it is a generic term.

Because trademark rights are territorial, courts may take a different approach in considering if a trademark is still distinctive or not. The trademark WALKMAN was declared void of distinctiveness by an Austrian court, while in other countries it continues to be a distinctive trademark. In the US a court declared that GOOGLE remains distinctive despite often being used as a verb, which can be an indicator of generic use. In another country, a court may be ruling differently.

To avoid weakening the distinctive power of a trademark or even risking that a trademark will be lost here are some tips for trademark owners to follow.

Use a trademark properly. Never use a trademark to describe the product. If a new product or service is developed that did not exist before, invent a name for the product or service itself allowing others to freely use this name. Additionally, create a different name to function as a trademark. Never distort that name. To protect your trademark from losing its distinctive power, below are some dos and don’ts to follow:

- Do not pluralize: Incorrect - Two ACERS; Correct – Two ACER computers
- Do not use as a noun: Incorrect: Give me a RICOLA; Correct – Give me a RICOLA drop
- Do not use a possessive form: Incorrect My LABELLO; Correct -My LABELLO lip balm
- Do not use as a verb: Incorrect: Xerox the report; Correct: Make a photocopy on a XEROX copier
- Use in a consistent manner: Incorrect –H AND M; Correct – H&M
- Distinguish from surrounding text by using different typeface, in italics, in color, in capital letters, to name a few.

Watch the use of your trademark. Develop guidelines about how to use a trademark in a distinctive manner and watch for them to be followed by own employees and business partners. If there is a risk of naming the product by the trademark name, use the trademark also for other products. As an example, ROLLERBLADE is used for in-line skates and for a line of skating equipment (helmets, pads etc.). This way it clearly shows that ROLLERBLADE is used to distinguish the products and not as a synonym of the product.

Monitor the use of your trademark. Observe if third parties are using your trademark improperly endangering the strength of your trademark. In particular, on-line dictionaries may be a source of misuse that needs to be corrected. If this happens, alert them of the improper use.

Quick read

- Use it or lose it
- When you use a trademark, use it properly to avoid losing the distinctive power
- Watch and monitor to prevent misuse

Célia Ullmann, Of Counsel at Sedin SA
September 2018