



# Trademark management

## Genericide or clever marketing?

**The pace of change on the Internet means that a mark could potentially become generic within a matter of months. But is the use of a mark as a verb, so often the first step to 'genericide' in the past, now really such a bad thing? Is it time to allow marks "to verb up"?**

A marketing person asks (hypothetically): "Can I use the trademark as a verb?"

A trademark practitioner responds (not hypothetically): "No!"

It is ingrained in every practitioner that trademarks must be distinctive and that the mark must not be allowed to become generic through use, whether as a verb or otherwise. To obtain protection a sign must not be used in common parlance otherwise it would have no distinctiveness to allow it to function as a trademark. Once granted protection, a trademark must preserve the ability to point to a single source of a product or service. Therefore, it follows that use of the mark must not be allowed to affect its essential function.

In a surprising statement during the launch of the new Bing search engine, Microsoft's chief executive, Steve Ballmer, told *The New York Times* that the name "works globally" and has the potential "to verb up". That is, some day, Ballmer hopes, people will 'bing' a new restaurant to find its address or 'bing' a job applicant for telling events in his past.

The term 'Bing' seems fanciful enough to be granted trademark protection. However, its owner appears keen for the name to be used in a generic manner. The process through which a distinctive mark becomes generic usually takes time, and terms such as 'aspirin', 'cellophane', 'escalator' and 'linoleum' are some examples of generic terms that started life as fanciful or arbitrary marks. The Internet may be speeding up this process. Fanciful words are easily and quickly circulated, especially when the words are used for online applications.

Traditionally, it is the product's popularity that causes consumers to use the mark as a 'name' for the product itself. Where improper use, such as in advertising and labelling, is made by the proprietor, the trademark can lose its distinctiveness. The

term 'genericide' is sometimes used to describe the process where the mark owner actually participates, often unknowingly, in the destruction of the distinctiveness of the trademark. However, could it be said that owners now deliberately encourage the use of their mark as a verb to promote a new product as though it already has a wide appeal and following – is this reverse psychology in marketing or genericide?

### 'Tweeting' and 'googling'

This generation is one where instant messaging and online chats are commonplace; thus, it is unsurprising that words or marks used on the Internet take on a life of their own. The terms 'tweet', 'googled' and 'googling' are commonly used but is such use harmful to the relevant mark owners?

Over the past three years, since the launch of Twitter, the word 'tweet' has been used in relation to the services Twitter provides and has no doubt achieved a degree of respectability. Unsurprisingly, Twitter is keen to protect the rapidly growing language surrounding its service. In a recent blog, Twitter's co-founder, Biz Stone, told users that: "We have applied to trademark 'tweet' because it is clearly attached to Twitter from a brand perspective but we have no intention of 'going after' the wonderful applications and services that use the word in their name *when associated with Twitter*" (emphasis added).

Google faces a similar challenge when it comes to ensuring its mark remains distinctive. The variants 'googling' and 'googled' are commonly used to denote the act of conducting an internet search using the Google search engine. This may have come about due to the search engine's popularity. Clearly all such use of the variants refers back to Google as the source since it is unlikely that one would use the terms if a different search engine was involved. If the terms are used regardless of the search engine used, so that they become synonymous with the word 'search', then issues will arise. Preserving the distinctiveness in the word 'Google' is crucial if trademark rights are to be maintained.

From the two examples of 'tweet' and Google above, it does appear that, in controlling a brand, rights holders balance the interest between correct use to preserve

distinctiveness and the marketing value in 'not-so-correct' use. This is probably a common-sense approach since brand owners are unlikely to want to crack down on use of a mark, albeit a variant, by loyal users.

### Classic rules and moving forward

It is worth remembering the following classic rules for protecting a trademark:

- Enforce correct grammatical use (eg, 'this vacuum cleaner is a HOOVER').
- Use the product's generic name with the trademark (eg, APPLE computers, GOOGLE search engine).
- Make the trademark stand out from surrounding text, such as in product labels or in advertising.
- Use a trademark notice. Provide public notice of trademark rights – ® for a registered trademark or ™ to indicate the significance of a mark.
- Avoid all variations (where possible).

Considering the speed at which marks can become popular on the Internet, it may be necessary to relax these rules if it meets the greater objective of marketing to a wider audience. Nonetheless, there is no point to marketing if the target consumer is not able to identify the goods/services as originating from one undertaking and not another. Trademark rules can still work alongside new marketing practices.

Is it really that problematic if consumers use the mark as a verb but can still identify the source of the goods or services? When used as a verb, has the trademark automatically lost its distinctiveness? Crucially, has the mark lost its ability to function as a trademark?

The advent of the Internet means that the answers to these questions are no longer clear cut. If a trademark maintains its capacity to distinguish after being promoted widely online and becoming so popular that it quickly starts being used as a verb, arguably this is evidence that the word has acquired distinctiveness and still clearly functions as a trademark.

So should practitioners begin advising their clients to "verb up" as suggested by Microsoft's chief executive? Probably not, but if the mark can still fulfil its essential function then perhaps some bending of the traditional rules will prove beneficial in the long run. [WTR](#)

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