PROVING A MARK GENERIC UNDER THE LANHAM ACT: HOW DO YOU DO IT AND WHAT ARE THE CONSEQUENCES?

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1. INTRODUCTION.

Trademarks are "classified along a conceptual spectrum of increasing inherent distinctiveness." Go-To.com, Inc. v. The Walt Disney Co., 202 F.3d 1199, 1207 (9th Cir. 2000). From weakest to strongest, courts categorize marks as generic, descriptive, suggestive, and arbitrary or fanciful. Id. This article focuses on the weakest – the generic mark. Virtually all lawyers are familiar with the term generic as applied to trademarks , but few understand precisely how courts determine what is and is not generic and what it means if a mark is found to be generic.

This article will discuss the Ninth Circuit's test for genericness and show how it is applied to specific marks. The article will then examine the consequences of a finding that a mark is generic, and show how a holder of a generic mark may still assert a claim under the Lanham Act.

2. THE TEST FOR GENERICNESS: DOES THE PUBLIC PERCEIVE THE MARK AS DESCRIBING THE PRODUCT ITSELF OR THE TYPE OF PRODUCT.

The test for genericness is fairly straightforward: "A 'generic' term is one that refers, or has come to be understood as referring, to the genus of which the particular product or service is a species." Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc., 198

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F.3d 1143, 1147 (9th Cir. 1999). Whether a trademark is generic "depends on the primary significance of the mark to the relevant public." Films of Distinction, Inc. v. Allegro Film Productions, Inc., 12 F. Supp. 2d 1068, 1075 (C.D. Cal. 1998)(emphasis added). The issue of genericness is a question of fact. Committee for Idaho's High Desert, Inc. v. Yost, 92 F.3d 814 (9th Cir. 1996).

Another way of phrasing the test is whether it is "difficult to imagine another term of reasonable conciseness and clarity by which the public [could] refer[]" to these goods and services and their producer." See Committee For Idaho's High Desert, 92 F.3d at 822, quoting, Blinded Veterans Ass'n v. Blinded American Veterans Foundation, 872 F.2d 1035, 1041 (D.C. Cir. 1989). If the Court can imagine another way to describe the goods and services in a reasonably concise way, then the marks are not generic.

In making the determination of whether a mark is generic, many courts follow the test set forth by Judge Learned Hand:

> "What do the buyers understand by the word for whose use the parties are contending?" If buyers take the word to refer only to a particular producer's goods or services, it is not generic. But if the word is identified with all such goods and services, regardless of their suppliers, it is generic and so not a valid mark.

Surgicenters of America, Inc. v. Medical Dental Surgeries Co., 601 F.2d 1011, 1016 (9th Cir. 1979), citing, Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

In determining whether a mark is generic, the Court must look at the mark "as a whole, rather than looking at its constituent parts individually." Committee for Idaho's High

Desert, 92 F.3d at 821. Thus, in Committee for Idaho's High Desert, the Ninth Circuit held that it made no difference whether "Committee" or "Idaho's High Desert" are generic. What matters is whether the complete term "Committee for Idaho's High Desert" is generic.

Furthermore, the Ninth Circuit has held that dictionary definitions are "not determinative." Filipino Yellow Pages, 198 F.3d at 1148, citing, Surgicenters of America, 601 F.2d at 1015 n.11. Nevertheless, dictionary definitions are "relevant and often persuasive in determining how a term is understood by the consuming public." Id.

3. THE GENERICNESS TEST AS APPLIED.

Perhaps the best way to understand the genericness test is to see how courts apply it. In the following cases, courts found that the marks at issue were generic:

- Surgicenters of America, 601 F.2d at 1017: "Surgicenter" is held generic because evidence (including use of term by third-parties such as Department of Health, Education & Welfare, Library of Congress, medical schools, medical publications, and many others) established that "the consuming public connected the term 'Surgicenter' with the service rather than the server."
- Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902 (9th Cir. 1995): "Self-realization" is held generic in the context of the name of a spiritual organization. However, the Court reversed the grant of summary judgment on the issue of whether "Self-Realization Fellowship" and "Self-Realization Church" – combinations of individually generic terms – were

generic, noting that the validity of those combinations was not based on the validity of the individual parts.

4 Filipino Yellow Pages, 198 F.3d at 1151: The Ninth Circuit affirmed a finding that "Filipino Yellow Pages" is generic because "[i]f faced with the question 'What are you?', [distributors of yellow pages for the Filipino community] could all respond in the same way: 'A Filipino yellow pages.'"

In the following cases, courts found that marks were not generic:

4 Committee for Idaho's High Desert, 92 F.3d at 821-22: "Committee for Idaho's High Desert" is not generic, because the name for the genus to which these particular services belong would probably be "environmental education and advocacy" and the name for a supplier of these goods and services might be "environmental advocacy organization."

4 Chronicle Publishing Co. v. Chronicle Publications, Inc., 733 F. Supp. 1371, 1375 (N.D. Cal. 1989): "Chronicle" is not "a synonym for a book and the general consuming public does not perceive 'Chronicle,' 'Chronicle Books,' or 'Chronicle Publishing,' to exclusively describe a book or a type of book or a type of book published by plaintiff."

4 Deborah Heart & Lung Center v. Children of the World Foundation, Ltd., 99 F. Supp.2d 481 (D. N.J. 2000): "Children of the World" is not generic to describe a charity that provides hospital services to foreign children because there are other terms that can be used to describe the targeted group, such as "Humanity's Children" or "The World's Children."

4. WHAT IS THE EFFECT OF A MARK BEING GENERIC.

A generic mark cannot become, and cannot be protected as, a trademark. Surgicenters, 601 F.2d at 1014; Chronicle Publishing Co., 733 F. Supp. at 1375.

While a generic mark cannot be protected "as a trademark," that does not necessarily mean that a misleading use of a generic mark cannot form the basis of a false designation of origin claim under Section 43(a) of the Lanham Act.

Various courts have found that the misleading use of a generic mark can still support a claim for relief under the Lanham Act. The Second Circuit has held that a finding that a mark is generic does not foreclose relief under Section 43 (a) if:

(1) goods or services are involved,

(2) interstate commerce is affected,

(3) "an association of origin by the consumer" between the generic term and the first user exists (i.e., secondary meaning), and

(4) there is a likelihood of consumer confusion as to the goods' or services' source when the generic term is applied to the second user's goods or services.

Manning Int'l. Inc. v. Home Shopping Network, Inc., 152 F. Supp.2d 432, 436 (S.D.N.Y. 2001). See also Blinded Veterans Ass'n, 872 F.2d 1035 (while a subsequent competitor cannot be prevented from using a generic term to denote itself or its product, "it may be enjoined from passing itself or its product off as the first organization or its product"). The Ninth Circuit has not yet opined on the validity of this test.

5. CONCLUSION.

Defendants in a trademark action (especially where the trademark is not registered) should always consider raising genericness as an issue: the consequences of a finding of genericness are devastating to the plaintiff's claim. On the other hand, a trademark plaintiff should draft its complaint with the risk of genericness in mind and define the genus of the product or service in such a way that it is not the same as the name of the product itself.