



Trademark Tug-of-War

One of the hallmarks of a great brand is to become famous enough to be a household name. However, this can be a double-edged sword. Once your mark becomes famous enough, there is a real risk that the brand just becomes a generic term for any similar type of product. And this could soon be happening with the trademark TACO TUESDAY.

Taco Bell, through its intellectual property (IP) holding entity, has petitioned for the cancellation of the trademark TACO TUESDAY for restaurant services. The mark is concurrently owned by Taco John's and Gregory Hotel, Inc., and has been used by Taco John's since 1979. While Taco Bell's complaint is playfully worded and a little over-the-top ("To deprive anyone of saying 'Taco Tuesday' – be it Taco Bell or anyone else who provides tacos to the world- is like depriving the world of sunshine itself"), the consequences for Taco John's could be quite serious.

In order to function as source identifiers in the marketplace, trademarks must be capable of differentiating your product from your competitors' products. However, once a mark has become generic in the minds of consumers, it ceases to uniquely identify your brand, and there is a real danger that you may lose your trademark rights altogether.

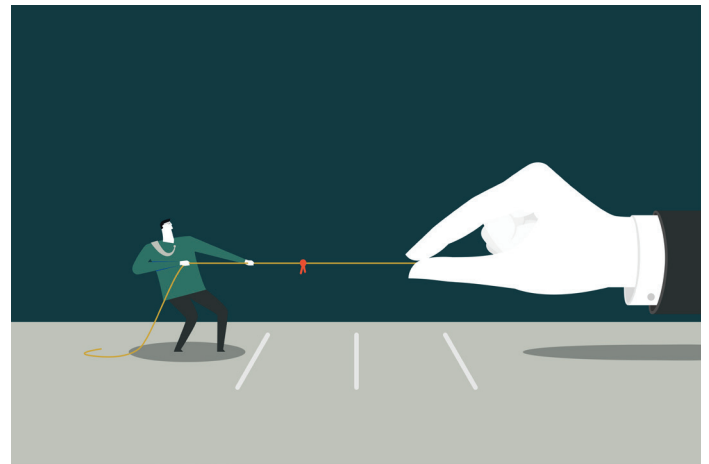
Once famous brands such as aspirin, cellophane, dry ice, hovercraft, kerosene, linoleum, and teleprompter have all suffered the fate of genericization. Others, such as Xerox, have come close to the edge of losing their marks and have had to resort to creative solutions such as advertising campaigns to prevent the brand from becoming genericized.

While that kind of action can be helpful once your mark is already becoming genericized, there are proactive actions a brand owner can take to

prevent genericization of their trademark.

Always use the trademark as a trademark

Resist the urge to use your trademark as a noun or verb in place of other generic descriptors. For example, the phrase "Velcro® it together!" uses the trademark to describe adhering something together with a hook-and-loop fastener. This may lead the public to refer to any attaching things with any hook-and-loop products as "Velcro-ing," regardless of which specific product is being referred to. A better phrase would be "Stick it together with Velcro®!"



Use the appropriate trademark symbols

You should always use the appropriate trademark symbol (® for federally registered marks or TM or SM for unregistered or state-level trademarks and service marks) at least once wherever the mark appears. Typically, the symbol should be used at least with the mark's first or most prominent use in a document or display. However, it should be noted that using the ® symbol with marks that are not federally registered is illegal – in those cases, TM or SM should be used.

Set your mark apart

Consider using different fonts, colorization, capitalization, stylization, or sizing to make the mark appear different from the surrounding text. This will help the public to recognize that your mark is not just an ordinary word.

Develop brand use guidelines

Whether for use by the media or licensees, develop a set of guidelines describing how your trademark is to be properly used and displayed. The document may detail specific fonts or colors the mark must be depicted in or specific phrases incorporating the mark that should be used or avoided. Be proactive and keep the public informed when you are rebranding.

Enforce your rights against infringers

While this does not mean filing a full-blown trademark infringement lawsuit against everybody who misuses your mark, you should at least inform infringing third parties of your trademark rights and demand that they cease their unauthorized use. The vast majority of trademark disputes are resolved by contacting infringers, either informally or in a cease-and-desist letter, to avoid litigation. However, it's critical to understand your business and how it may require different actions. It is possible that overly aggressive claims could lead the accused infringer to file a declaratory lawsuit against you, dragging you into unwanted litigation that could threaten your trademark rights. It is best to contact your trademark lawyer before threatening any legal action against potential infringers.