

FINNEGAN



Losing Grip on the FRISBEE

March 29, 2010

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Do you know that the terms "aspirin," "escalator," "thermos," and "zipper" were once protectable trademarks? And do you know that FRISBEE is yet another mark that may soon join the list of trademarks that have become generic? What causes protectable marks to fall into public domain? To a large degree, FRISBEE and other similarly-situated marks are victims of their own success. In each case, these products have been so novel and so successful that consumers have come to identify the thing itself by the brand name (is escalator a brand of moving stairs, or moving stairs themselves!). In some cases the trademark owner has failed to provide the public with an easy generic name for the product itself -- a factor that all but ensures misuse of the brand. And a lack of adequate enforcement on the part of trademark owners can accelerate the process and make genericness irreversible.

The Spectrum of Distinctiveness

It is often said that not all trademarks are created equal. Trademark law in the United States recognizes that some marks are stronger than others and are, therefore, worthy of greater protection. The degree of strength is measured based on where a particular mark falls along the spectrum of distinctiveness. On the one end of the spectrum are fanciful and arbitrary marks that enjoy the highest degree of protection because they are immediately perceived by consumers as source-identifiers. Fanciful marks are neologisms created to

identify particular goods or services, the most famous examples being EXXON and KODAK. Arbitrary marks are terms that have common meaning in the language but are used in an arbitrary manner on the goods or services—for example, the mark APPLE for computers, or CAMEL for cigarettes. Suggestive marks, as one court noted, "shed some light on the characteristics of the goods, but so applied they involve an element of incongruity" and require imagination on the part of consumers to connect the name with particular features of the goods or services. Examples of suggestive marks include IVORY for soap or SPARKLE for fine jewelry. Fanciful, arbitrary, and suggestive marks are all immediately protectable. Further along the spectrum are descriptive marks, which do just that—they describe certain characteristics of the goods or services. Examples of descriptive marks are XPRESSO for a coffee shop or E-COUTURE for an online designer clothing store. Descriptive marks are only protectable upon a showing of acquired secondary meaning—namely, that consumers have come to associate the mark with the source of the product rather than with the product itself or a particular feature of the product. At the end of the spectrum are generic terms, which serve as common terms identifying the goods or services in connection with which they are used (such as the word "tea" for a beverage made of tea leaves) and are unprotectable under any circumstances -- even if they have acquired secondary meaning.

Interestingly, even the strongest fanciful mark can eventually become generic if the rights in the mark are not properly enforced. An example that comes to mind is the mark XEROX that, at one point, was actively used by the public to identify photocopies and the process of making photocopies. It took titanic efforts on the part of attorneys and marketing professionals to re-educate U.S. consumers about the trademark significance of the term XEROX and to resurrect the mark's distinctiveness. BAND-AID has suffered similarly. Other marks have not been so lucky and have inevitably fallen into public domain . . . Will the mark FRISBEE be another victim of genericness?

FRISBEE: Not a Toy War

Toy maker Wham-O, Inc. ("Wham-O") currently owns a federal registration for the mark FRISBEE for "toy flying saucers for toss games" that dates back to 1959. Since the 1960s, Wham-O has also been the owner of the registrations for the

marks SLIP'N SLIDE for water slides and HULA HOOP for plastic hoops. A competing toy manufacturer, Manley Toys, Ltd. ("Manley"), with whom Wham-O has been engaged in bitter legal battles for a number of years, recently filed a petition to cancel the mark FRISBEE on the ground that the mark has become a generic term for identifying flying disks.¹ On the same day, Manley Toys also filed petitions to cancel the marks SLIP'N SLIDE² and HULA HOOP³ also on genericness grounds.

In November 2008, Wham-O brought a declaratory judgment action in the United States District Court for the Northern District of California seeking a court ruling that its federally registered marks FRISBEE, SLIP'N SLIDE, and HULA HOOP have not become generic.⁴ The complaint alleges that Wham-O has exclusively used the marks for over forty years and that "[t]oys sold under the marks are among the most popular ever sold, with sales in the hundreds of millions of units."⁵ Wham-O accuses Manley of engaging in "a wide-range scheme to destroy Wham-O's business and the enormous goodwill associated with many of its famous brands."⁶ The complaint also provides the history of Wham-O and Manley Toys' rocky relationship, including an award of \$6 million in actual and exemplary damages for the intentional infringement and dilution of Wham-O's SLIP'N SLIDE design marks and a permanent injunction against the use of Wham-O's federally-registered FRISBEE and SUPERBALL marks by Manley.⁷

On August 13, 2009, the court threw out Wham-O's declaratory judgment action on the grounds of lack of federal subject matter jurisdiction and failure to present a justiciable case or controversy.⁸ Specifically, the court noted that it lacked original jurisdiction over the case because "the courts do not have 'jurisdiction under the Declaratory Judgment Act to determine the validity of [a] trademark where there is no issue of infringement."⁹ The court went on to state that there was no justiciable case or controversy before it because "[t]here is no evidence of a threat of litigation or liability hanging over Wham-O as a result of any activity on Defendants' part."¹⁰ Dismissing the case, the court held, will "preserve the status quo" because Wham-O is allowed to continue to use the marks and Manley is refrained from doing so until the TTAB renders a decision in a cancellation proceeding before it.¹¹

Wham-O has appealed the decision of the district court to the United States Court of Appeals for the Ninth Circuit. And unless the appellate court disagrees with the decision of the district court, the TTAB will get to determine whether the marks FRISBEE, SLIP'N SLIDE, and HULA HOOP are free for competitors and the public to use as generic identifiers for flying disks, water slides, and plastic hoop toys.

At least with respect to the FRISBEE mark, Wham-O is facing an uphill battle to seeking to keep its trademark alive. Flying disks sold under the FRISBEE mark have enjoyed immense success. The products have been so successful that competitors and, most importantly, the public have started using the mark FRISBEE as a common name for flying disks. The opening sentence in a Wikipedia article about "Flying Disks" states: "Flying disks (commonly called Frisbees) are disk-shaped objects . . ." This sentence alone exemplifies that the FRISBEE mark is in a lot of trouble. The word "commonly" and the term "Frisbees"—a trademark used in a plural form with no ® sign next to it or even a single mention of Wham-O—sound like a public verdict of genericness.

So what went wrong for the FRISBEE mark? Numerous legal actions against Manley show that Wham-O did enforce its rights at least against most egregious infringers. Sometimes, however, the inevitable path to genericness starts on a much smaller scale: with college students on campuses across the country using the word FRISBEE as a common term to identify flying disks that they like to toss around or with online articles or blog posts using the mark FRISBEE as a generic identifier for certain types of toys. And, as the law of nature dictates, eventually the quantity of improper use transforms into quality. Every-day use of a registered mark as a generic term by the public can become so widespread and devastating to the trademark's distinctiveness that any enforcement activities start looking like an attempt to fight a fire with a squirt gun.

Keep a Tight Grip on Your Mark

The *Wham-O* case suggests that even though a trademark owner is not under an obligation to prosecute every *de minimis* infringement or police every instance of misuse of its mark, sometimes going only after the most notorious infringers is not enough. Educating the public on how to properly use your registered

trademark is equally important. The controversy around the FRISBEE mark is a good reminder for all trademark owners that correctly using the mark in advertising and promotional materials as well as educating the public on what use is improper can help avoid problems in the future.

Among the basic rules for proper usage of trademarks promulgated by the International Trademark Association ("INTA") are the following:

- Make sure that the mark stands out from the rest of the text by capitalizing the first letter (e.g., Exxon) or using all uppercase letters (e.g., "COCA-COLA");
- Remember that trademarks are adjectives and should always be followed by a generic term (e.g., "APPLE computers");
- Never pluralize the mark or use it in a possessive form (e.g., "two Frisbees" or "Frisbee's color" are incorrect usages of the mark);
- Never use the mark as a noun (e.g., "use a Kleenex" instead of "use a KLEENEX tissue");
- Never use the mark as a verb (e.g. "Xerox the book" instead of "make photocopies of the book").
- If a mark is improperly used in third party materials (such as media articles), promptly ask the author to correct the improper use.¹²

This might seem like a lot of rules to keep in mind and consistently follow, but, as a matter of practice (and finances), it is far easier to prevent a mark from becoming generic than to try to resurrect a mark that has already fallen victim to genericness.

Will the FRISBEE mark rise from the ashes like a phoenix or will toy manufacturers across the country gain the right to use the word freely as applied to their own Frisbees?

To be continued.

Endnotes ¹ *Manley Toys, Ltd. v. Wham-O, Inc.*, Cancellation No. 92049734 (petition for cancellation filed on July 30, 2008).

² *Manley Toys, Ltd. v. Wham-O, Inc.*, Cancellation No. 92049646 (petition for cancellation filed on July 30, 2008).

³ *Manley Toys, Ltd. v. Wham-O, Inc.*, Cancellation No. 92049760 (petition for cancellation filed on July 30, 2008).

⁴ *Wham-O, Inc. v. Manley Toys, Ltd.*, CV 08-07830 (C.D. Cal. Nov. 25, 2008).

⁵ *Id.* at *1.

⁶ *Id.*

⁷ *Id.*

⁸ *Wham-O, Inc. v. Manley Toys, Ltd.*, No. CV 08-07830 CBM (SSx), Order granting defendants' motion to dismiss, denying defendant's motions to strike, and denying defendants' requests for judicial notice (C.D. Cal. August 13, 2009).

⁹ *Id.* at *6 (citing *Homemakers, Inc. v. Chicago Home for the Friendless*, 169 USPQ 262, 263 (7th Cir. 1971) (per curiam)).

¹⁰ *Id.* at *7.

¹¹ *Id.* at *8.

¹² http://www.inta.org/index.php?option=com_content&task=view&id=108&Itemid=129&getcontent=1

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