

Patents Expire, But Trademarks Can Last Forever

Jason Balich ■ Wolf Greenfield

Kerosene is a generic term for a light fuel oil today. But in 1854, “Kerosene” was a registered trademark owned by Abraham Gesner, and only the North American Gas Light Co. and the Downer Co. were allowed to call their lamp oil kerosene (Figure 1). Gesner also obtained a patent in 1850 for his method of distilling kerosene from bitumen, which, being free of sulfur and nitrogen, was more suitable for illumination in lamps. Back then, patents had a 21-year term.

Although kerosene eventually became generic (and thus no longer protectable as a trademark), the story of kerosene did not have to end that way. When properly maintained and protected, trademarks can last forever.

While patents look to promote innovation by encouraging inventors to disclose their innovations for a limited monopoly, a primary purpose of trademarks is to protect consumers. Trademarks encourage manufacturers to consistently make quality products, communicate a company’s brand promise, and reduce a customer’s time and effort in making purchasing decisions. A trademark can be a word, a name, a symbol, a slogan, a distinctive sound, a color, a product shape, and even a scent, so long as the trademark identifies and distinguishes the goods and services of one company from those of another.

Some marks are fanciful — completely made-up words — like Google or Verizon. Others are arbitrary, like using “Apple” to identify a computer. Suggestive marks provide a subliminal hint as to what the product does (think Coppertone suntan lotion). Descriptive marks describe products — “Boston Beer” is literally beer from Boston, but also identifies its manufacturer.

To use a trademark to protect your good or service, start by ensuring that your contemplated mark is available to use in the specific jurisdiction and is connected to the specific goods or services you want to protect. The basic test is whether the mark is “likely to cause confusion or to cause mistake or to deceive.” If your contemplated mark is taken or confusingly similar to another’s for a similar good or service, consider an alternative.

Once chosen, consider registering your trademark either with your

state (typically through the secretary of state) or with the U.S. Patent and Trademark Office (USPTO). Registration with the USPTO provides benefits such as nationwide rights, rights to have U.S. Customs seize infringing goods, and priority for foreign trademark filings. Registration begins with filing an application that will be examined (similar in concept to patent examination). Once any rejections are overcome, the mark is published in the Official Gazette. If the mark is not opposed within 30 days, it is “allowed” and ultimately registered.

Maintaining registration requires continued use of the mark on or in connection with the goods and/or services identified in the registration and periodically filing documentation with the USPTO. A valid trademark can be lost if it is abandoned — one must use it or lose it.

A mark can also be lost if it becomes transformed into a generic descriptive term — one must “police” its mark to prevent this. Generic terms are not protectable as trademarks because they no longer identify the goods and services of one specific company from those of another. Kerosene, aspirin, escalator, and even heroin are all examples of words that were coined as trademarks but became genericized.

Companies can prevent genericide through their own careful use of their marks as an identifier of goods, as opposed to things in their own right. For example, “using LEGO blocks” properly uses the mark; “playing with LEGOs” does not. Indeed, a company’s misuse of its own trademark can lead to genericide. The Otis Elevator Co., for example, initially secured a trademark for their “escalator” moving staircase, but the trademark was canceled when the USPTO ruled that even Otis had used the word escalator as a generic descriptive term for all moving staircases in its patents.

Companies can (and should) enforce their marks against others using them improperly. They can launch marketing campaigns to educate consumers about the importance of, for example, blowing their nose in Kleenex tissues, photocopying on a Xerox copier, and securing items with Velcro hook and loop fasteners. Xerox famously said: “When you use ‘Xerox’ the way you use ‘aspirin,’ we get a headache.”

So, the next time you are looking to protect a good or service, don’t just limit yourself to contemplating patent protection. These days, utility patents have a 20-year term from the filing date of the application and design patents have a 15-year term from the date of grant. In contrast, trademarks can last forever.

CEP



◀ **Figure 1.** Kerosene is an example of a trademark that became genericized. Image courtesy of Historic New England.

Jason Balich is a trial and appellate lawyer at the law firm Wolf Greenfield, based in Boston, MA. He has a BSE in chemical engineering from Princeton Univ., an MBA from Bentley Univ., and a JD from Quinnipiac Univ. School of Law.