

Generic Terms Are Not — and Can Never Be — Trademarks

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Suppose you (or your client) is in the cupcake business and decides to purchase and brand the domain name “cupcakes.com.” Can this be done?

I don't mean, could you buy the URL? (The answer is “no”: it's apparently owned by NA Media and used as a portal for dessert, food, baking and related sites.) My question is: could you or your client claim “cupcakes.com” as a service mark and thereby prevent others from using anything confusingly similar in connection with their own cupcake businesses?

The answer begins with the principle that, in general, the law does not allow a company to claim as its proprietary mark a generic term, that is, a word that identifies the type of product or service involved, such as “Software” used to identify a software product or “Apple” used for fruit (as opposed to as “Apple” used as a trademark for computer technology: such arbitrary uses of words are highly protectable). Since everyone deserves the right to accurately identify the type of goods or services it sells, to allow a single company to claim trademark rights to a generic term would impoverish the language and unfairly hamper competition.

This applies not only to words that begin life as generic terms, but also to words that begin life as brand names but are appropriated by consumers as another word for the types of goods/services they were coined to brand. This is what happened to the terms “escalator,” “cellophane,” and “aspirin,” which were originally created to serve as marks, but which became so widely used to refer simply to that type of good (any elevated moving stairway, any plastic wrap, any acetylsalicylic acid painkiller) that they lost their ability to brand.

So, could you or your client appropriate “cupcakes.com,” not just as a commercial web domain, but also as a protectable service mark?

Probably not, say two recent cases.

Last July the Federal Circuit Court of Appeals turned back Hotels.com's attempt to register as its service mark the term “hotels.com.” The company had argued that even if the term “hotel” is generic for hotel information and bookings, the addition of a dot-com suffix removed that onus and should permit trademarking.

Not so, said the Court. The mere addition of a top level domain (dot-com, dot-org, dot-net, etc.) doesn't remove the taint of genericness from the term.

A similar issue was resolved this winter. Dial-A-Mattress had attempted to register the “Mattress.com” domain name as its service mark. The company had argued that only “online mattress stores” was truly generic for its particular services, and therefore that its “Mattress.com” DN was not generic.

Wrong, repeated the Federal Circuit. “Any term that the relevant public understands to refer to the genus of ‘online retail store services in the field of mattresses, beds and bedding’ is generic.” Nor was the Court persuaded that it was wrong for the Trademark Office to refuse registration. In short, Mattress.com joined hotels.com (and law.com, and several others) in the ash heap of generic non-marks.

In short, if you use a word or phrase generically in identifiers for your products or services, not only can’t you claim that word itself as a proprietary brand name, but you do no better by adding an indistinct suffix like dot-com. So for anyone hoping to appropriate a generic term as its trademark or service mark by adding dot-com (or other relatively indistinct supplementary words), it’s back to the drawing board to find a mark distinctive enough to identify a viable business.

For more information on trademark issues, please contact the author [Howard G. Zaharoff](#).