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# Time to break some trademark rules in 2014?

The increasing practice of brand owners ‘verbing up’ their own marks and in some cases deliberately disrupting their own logos demonstrates that strong brands can be flexible, fluid and living

Under the traditional rule of proper trademark use (also known as the ACID test), brands must be used:

- as adjectives;
- in a consistent manner;
- with an identification or symbol indicating whether the mark is registered; and
- in a distinctive or attention-grabbing manner.

While this standard works for many brands, the first two elements – using brands as adjectives only and in a consistent manner – are too restrictive when it comes to strong brands.

## Beyond adjectives

Recent trademark usage trends suggest that there are ways that strong or well-known brands can use their marks as a noun or verb without substantial risk of genericide. A number of companies have used their key trademarks as verbs in advertising campaigns without suffering any apparent genericide damage – this is despite having publicly displayed policies on how to properly use and refer to their trademarks (ie, use as an adjective as opposed to verb/noun). For example, investment company Vanguard used the term ‘vanguarding’ to convey the long-term outlook of its investment products to investors; while Microsoft’s chief executive officer Steve Ballmer told the New York Times in 2009 that the Bing search engine brand had the potential to verb up and that he hoped people will ‘bing’ a new restaurant to find its address. Recently Google launched its advertising campaign “Play your heart out” to entice consumers to visit its PLAY store.

Traditionally, companies would not use or encourage use of their brand names as verbs, or as anything else beyond use as an adjective. Most feared that if a branded product or service became a verb, the brand would lose its distinctiveness and become a name for a generic category or function. A brand is lost to genericide when use of the term becomes so prevalent or generic that it is no longer associated with the brand-owning company.

History is replete with successful brands that were lost to genericide and are now viewed as generic terms for certain products: aspirin, escalator and zipper were all distinctive trademarks at one time. Companies even launched advertising campaigns to

encourage the public to use their trademarks properly. Consider the example of Xerox, which urged consumers to ‘photocopy’ instead of ‘xeroxing’ documents, in an attempt to ensure that the phrase ‘to xerox something’ did not become another way of saying ‘to photocopy something’.

If this happened, then the term Xerox would not be associated with the company’s distinctive brand of copiers, but instead with the function of photocopying. This was significant because genericide of the Xerox brand would have resulted in the loss of ability to distinguish its products or services from those of competitors.

Yet in stark contrast to these historical examples, the increase in competition in nearly every product category – along with greater consumer sophistication today – has reduced the risk posed by a brand name becoming a verb. Moreover, ever-shortening product lifecycles and the fleeting attention spans of most internet users mean that brands must focus on gaining a market share and voice in a short period of time.

As a practical matter in today’s market, when a brand becomes popular and its use widespread, there is low risk of genericide if the brand is verbed up. The public’s use of the Google brand is one of the best examples of this. People often say that they will ‘google’ something on the Internet to mean that they looked up some information online using the Google search engine, rather than just any search engine.

Given the pace of change evident in today’s internet-fuelled markets, there is clear business value associated with the verbed-up use of brands. To mitigate any risk of trademark genericide, we suggest that rights holders:

- make clear to consumers that the action suggested by the verbed-up brand use cannot be accomplished without using the branded product or service – the verbed-up brand can be built into taglines, slogans and/or logos that reinforce this point above (eg, “Vanguarding can’t happen without Vanguard” and “Google Play, play your heart out”);
- create and publish verbed-up brand use guidelines (and/or update trademark guidelines) that reinforce the first point above;
- register the verbed-up brand or the tagline, slogan or logo containing the verbed-up brand;
- send friendly letters to publishers and media outlets that do not appear to appreciate the necessary connection between the brand and the verb in their references;
- work with dictionaries to ensure that any verb listings are consistent with new verbed-up brand policies; and
- conduct regular monitoring of the public’s use and view of the verbed-up brand – ultimately, it is the consuming public that

Figure 1. Google Doodle examples



determines, through its use, whether a verbed-up brand has lost distinctiveness through genericide.

### Fluid and living brands

Traditional thinking says that a mark should be represented in a consistent manner (ie, the same way each time). Brand owners fear the loss of rights that can occur when they cannot tack rights from an updated version of a mark onto rights from the original mark. Tacking requires that two marks make the same continuing commercial impression, which can prove a high bar. However, can a rights holder act strategically to get the best of both worlds: a mark that is protected, yet flexible?

Google did something disruptive and innovative when it started morphing its GOOGLE logo on a regular basis. The so-called 'Doodles' are, as the search giant notes, "fun, surprising, and sometimes spontaneous" (see examples above). Initially, the Doodles startled consumers. Now demand is so great that Google has a team of dedicated illustrators and has created over 1,000 variations of its brand. The innovation worked: the Doodles have helped Google to attract consumers, keep them interested and build brand loyalty.

Some call brands such as this fluid trademarks. However, this may be a misnomer. It might be more accurate to call these brands living trademarks. Like a time-lapse video of a person ageing, these brands transform in appearance over time, but retain their essence; but unlike such a video, these marks are not really fluid – the word calls to mind motion marks, which have a stream of movement that is missing here.

Why do living trademarks work for Google? The brand is strong enough to avoid getting lost in the Doodles. The underlying famous brand, in effect, shines through. Over time, the Doodles have arguably enhanced goodwill in the Google brand by making it come to life in the eyes of consumers. And Google has conditioned consumers – for the benefit of all brand owners – to believe that strong brands can change, yet remain consistent source indicators.

Google notably continues to use its classic GOOGLE logo (see below) and maintains registrations for both that logo and the word GOOGLE in standard characters. Moreover, Google has played it safe on the PR side by not attacking Doodle parodies and becoming a trademark bully.

Tinkering with a major brand was once unthinkable. Google's experiment has changed consumer expectations of what it means for a strong brand to be consistent. It should therefore change how

brand owners, their counsel and trademark offices view strong brands: they have the ability to morph and at the same time to build goodwill. In the non-profit context, the concept of a living trademark provides a particularly intriguing option. Non-profits with strong brands could – if their culture, tradition and policies allow – be more forgiving when it comes to allowing chapters, for example, to make changes to the licensed brand to attract attention and build brand loyalty with their local audience.

Trademark offices should find a way to register living trademarks and give them special status. Offices could require brand owners to submit evidence of a mark's strength and examples of the mark in varied form. In exchange, registrations could provide rights in the part of the mark that is consistent and confer two special legal presumptions. First, the logo may change in more than a material way without loss of rights in the underlying design or stylisation. Second, the underlying design or stylisation is entitled to broader protection than a typical design or stylisation, in the same way that the root word of a family of marks is entitled to broader protection by virtue of the family. (Trademark offices could note that this does not mean the mark is a phantom mark, such as LIVING XXXX FLAVOURS, where XXXX is a variable signalling that the applicant seeks to register multiple marks through one application.)

So, when breaking the traditional (ACID test) rule of using marks in a consistent manner, rights holders and counsel should:

- make sure the subject design or stylisation is strong, with substantial goodwill;
- gauge how much to play with the design or stylisation based on the relative strength of the mark (eg, famous marks can be changed the most);
- change only the design or stylisation, not the corresponding word mark (except when it comes to breaking the ACID test rule of using word marks as adjectives, above);
- make sure that the essence of the logo is retained (eg, the stylisation of the word mark GOOGLE is regularly discernible);
- continue regular trademark use of the original design or stylisation;
- maintain trademark registrations for the original design or stylisation and underlying word mark standing alone;
- not be a trademark bully when others do parodies;
- refer to fluid trademarks as living trademarks; and
- advocate for trademark offices to register living trademarks as such, and give them special status.

Trademark law and practice must evolve to keep pace with changing consumer sophistication and expectations. As it does, do not be afraid to break the old rule of proper trademark use when it comes to strong brands, especially famous ones. [WTR](#)

Andrew Price and Justin Pierce are partners at Venable LLP  
[jpierce@Venable.com](mailto:jpierce@Venable.com)  
[adprice@Venable.com](mailto:adprice@Venable.com)

Figure 2. The classic Google logo

