

## The Likely End of “Netbook” as a Trademark: A Cautionary Tale of Genericide

By Brandon Warner

Have you ever thought about purchasing a netbook as an easy way to browse the web on the go? Is the device that came to mind a particular ultra-portable computer by Psion that was introduced in 1999? If not, then you are certainly not alone. In fact, such a lack of source identification may have netbook joining the illustrious ranks of aspirin, linoleum, escalators, and zippers. All of these terms have lost trademark protection after they became “genericized.”

IP attorneys often caution clients against the dangers of a trademark becoming generic. A generic mark is one that is or has become synonymous with a general class of product or service, rather than with the specific, source-identifying meaning intended by the mark’s owner. Unless an owner puts forth sufficient effort to protect its trademark against such broad usage, the intellectual property rights in the mark may be lost. Attorneys refer to this process as genericide.

In the past, trademarks have fallen prey to genericide fairly infrequently. This is not to say, however, that it never occurs. In fact, given today’s world of seemingly constant and instantaneous information distribution over the Internet, the need to protect trademarks from genericide has arguably become all the more important. While the process of a mark becoming generic at one time may have taken several years, experience tells us that this is no longer the case. For example, virtually no one had heard of a “netbook” in 2007, but now it can be hard to read about technology without hearing the term.

In February, Intel and Dell filed lawsuits against Psion Teklogix, Inc. (owner of the “Netbook” trademark registration), seeking a declaration that the term has become generic. They argued that the word “netbook” has become adopted by the public as a category of small, inexpensive notebook computers specifically designed for connecting to the Internet (a portmanteau of the words Internet and notebook).

Psion originally filed for a U.S. trademark registration on the term “Netbook” for use with “laptop computers” in 1996; the U.S. Patent and Trademark Office granted the registration in 2000. During the course of the next three years, Psion released a Netbook line of products that consisted of computers smaller than laptops, but larger than cell phones or PDAs. These products were met with somewhat limited success.

Several years after Psion’s Netbook line ceased wide-scale distribution, a number of other manufacturers began to produce computers smaller than laptops that were specifically designed for Internet connectivity and applications. These so-called “netbooks” gained prominence in 2008, following Intel’s release of its Atom processor. The wide range of such computers now includes the Asus Eee PC, the Acer Aspire One, the Sylvania GNET, and various Mini models from Dell and HP (just to name a few). Computer manufacturers, distribution chains, media, and the public at large use the term “netbook” to describe these products without regard to brand in order to differentiate the class of products from notebook computers.

At the end of December 2008, Psion began a vigorous effort to enforce its rights in the “Netbook” trademark registration, sending cease-and-desist letters to companies and demanding that they stop using the name. Most experts, however, agree that Psion’s efforts were too little, too late. Although less than a year had passed since “netbook” had gained widespread prominence in the marketplace, the term has become a colloquial description of a category of computer—much like the terms desktop, laptop, and notebook have previously. In other words, because Psion remained idle while “netbook” gained widespread use and adoption by the public, it has likely lost its rights associated with that term as a trademark.

Several lessons can be learned from the likely genericizing of “netbook.”

- **Genericide is not only a concern of big companies with majority market shares.**

Traditionally, the dangers of genericide have been highest when the products or services associated with a particular trademark have achieved substantial market dominance and/or name recognition. Aspirin, for example, became generic because it was the most widely distributed over-the-counter pain medication. But Psion's "Netbook" trademark registration was different. Psion is by no means a manufacturing superpower with a majority market share. With the proliferation of information sources today, all trademark holders must remain keenly aware of potential threats to their marks' protections.

- **Select a trademark with care.**

Part of the problem with Psion's "Netbook" mark was not its market dominance, but rather its lack of creativity. As Intel argues in its complaint against Psion, "netbook" was destined to become a general description of a *notebook* for surfing the *Internet*. The more arbitrary or fanciful a mark is, the less likely it will become a generic descriptor of a general class of goods or services. Companies or individuals seeking trademark protection should work closely with their IP attorneys to develop innovative marks to safeguard the integrity of their marks against genericide.

- **Actively protect the mark against generic usage.**

Not only did Psion choose an arguably descriptive term for its mark, but it also failed to adequately protect that mark against generic use. Psion should have taken action as soon as the public began to adopt "netbook" as a generic term for small, Internet-focused notebooks. Instead, Psion waited almost a year—an eternity in Internet time—before it sent cease-and-desist letters to various users. More importantly, Psion has taken no action to combat the public's generalization of the term. Unfortunately for Psion, a mark cannot be revived once it has become generic.

Trademark owners can learn both from Psion's inaction and from the successful informational campaigns by companies such as Xerox and Google to protect their marks. Recently, Adobe has undertaken a media blitz to encourage proper use of its Photoshop trademark, educating the public that the mark has a specialized meaning and that it is not proper to refer to "photoshopping" anything. Your IP attorney can help you develop a strategy to ensure that your mark is shielded from the threat of genericide.

Please give us call if you have any questions about adequately protecting your valuable trademarks from genericide.

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