



All That Glitters Isn't Gold: The Permanent Unprotectability of Generic Trademarks

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Since 2011, jewelry designer Solid 21, Inc. has alleged in multiple actions that several leading watchmakers have infringed its registered trademark RED GOLD. On June 12, 2015, Judge Gee of the U.S. District Court for the Central District of California scuttled Solid 21's campaign by holding that the RED GOLD trademark is generic and unenforceable for jewelry. Judge Gee's [decision](#) demonstrates the vital importance of selecting an inherently distinctive trademark.

Generic marks—which identify product classes rather than their source—are unprotectable. Formerly distinctive trademarks may become generic if widely applied to describe a product category; “aspirin” famously devolved from powerful trademark to unprotectable descriptor. However, courts may retroactively conclude that a trademark was generic *prior* to its adoption, even if the mark was registered by the Trademark Office, and is unprotectable regardless of the public's

association.

Here, the Court accepted evidence that the industry had used “red gold” to describe a category of gold red-tinted watches and jewelry long before Solid 21 adopted its mark. The Court disregarded evidence that consumers associate RED GOLD with Solid 21, explaining that “if a term is generic at the time the plaintiff begins using the term as a trademark, the term cannot become [protectable] through evidence that the public associates the term with the plaintiff.”

The decision is a reminder of the importance of selecting a trademark that cannot be construed as applying to an entire category. Marks that lack a descriptive element are likelier to gain registration and to wield greater strength against infringing designations. Finally, imaginative marks are far less likely to be found retroactively generic and to share the fate of Solid 21's trademark—RED GOLD today; fools' gold tomorrow.

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