

## Despite Podcast's Popularity, "SERIAL" Trademark Registration Denied as Generic

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Most everybody knows about "Serial," the award-winning investigative journalism podcast that tells a story in ... serial form. Despite the podcast's popularity and recognition in the media, the US Patent and Trademark Office's appeal board ruled on March 26, 2018, that "serial" is generic for a multi-installment audio program and can't be registered as a trademark.

Unlike arbitrary or fanciful terms, like AMAZON for an online marketplace or VERIZON for cell phone services, descriptive terms, such as CARTOON NETWORK for a cartoon TV channel, WINDOWS for an operating system using windows, and SPORTS ILLUSTRATED for a sports magazine with pictures, can be protected upon proof they have developed "secondary meaning" as brand names. A trademark owner can show secondary meaning by lengthy use in commerce, large-scale advertising expenses, lots of media references, or surveys of consumer recognition, among other things.

Generic terms, on the other hand, can never be protected as trademarks, because to do so would thwart competition, by making it impossible for competitors to describe their products. A PTO trademark examiner refused registration of SERIAL as generic, and the company behind the podcast appealed, arguing that the term instead was a descriptive mark, eligible for registration because it had achieved secondary meaning.

The company pointed to thousands of media stories about it as proof of secondary meaning. It also cited articles calling successful programs as "Serial-like" or "Serial-esque" as evidence that when the media and consumers saw the word SERIAL, they thought of that particular podcast.

But the Trademark Trial and Appeal Board agreed that the examiner correctly denied registration, saying that these references amounted at most to "de facto secondary meaning" – that is, although many people associate it with a particular producer, that doesn't eliminate its ordinary meaning as a class of goods or services.

This is a problem that producers of new, innovative, and popular products may face when they use common terms to identify them. The generic word may be synonymous with their product at the start, giving them de facto secondary meaning, but once competitors start to produce the same thing, the word remains available for all to use.

On the other hand, the appeal board held that the company's logo format, which framed the six letters of SERIAL each in rounded rectangles, were recognized by the public as identifying the source of the podcast, and thus could be registered as trademarks. Evidence that programs like "Saturday Night Live" and "Sesame Street" mimicked the logos in their parodies of the podcast was "highly significant" proof of their distinctiveness. And this is not surprising – parodies only work if a large audience is familiar with the thing being parodied and gets the joke.

### Key takeaway

Just because everyone knows your popular product's name doesn't mean you can protect it as your exclusive trademark. If it's a descriptive term, you can protect it if it develops "secondary meaning" as a brand. But if it's the generic name for the product, no amount of notoriety or consumer recognition will give it trademark protection. The case is [In re Serial Podcast, LLC](#), No.

86454420 (T.T.A.B., Mar. 26, 2018).

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