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Once Generic, Always Generic? Not Necessarily

By Jessica A. Ekhoff



ACCORDING TO BULLSHINE, "ONCE GENERIC, ALWAYS GENERIC." SAZERAC DISAGREED

A fundamental, immutable rule of trademark law is that generic terms cannot be protected or registered as trademarks. A generic term is the common name of the type of product itself. More specifically, "a generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is the species."[1] A term that starts out as a trademark can also become a victim of "genericide," becoming understood as a generic term and losing trademark protectability. Classic cases include "aspirin, cellophane, linoleum, milk of magnesia, escalator, and shredded wheat."[2]

Brand owners often take well-advised prophylactic measures to prevent genericide. Recall the JEEP advertisement from 2007 imploring the public to remember that "Jeep is a registered trademark. Good thing. No telling what kind of jacked-up station wagons they'd be trying to pass off as Jeep vehicles otherwise."

The courts have recognized that a term that has "gone generic" can be recaptured into trademark status, but only in rare cases. In 1876, the Supreme Court held SINGER to be generic for sewing machines[3], but in 1953, a federal Court of Appeals held that Singer had "recaptured" the SINGER trademark from the public domain, and it had become a valid trademark.[4]

So timing counts. It counts in determining genericness, determining possible recapture, and applying the rules to a specific case. Thus arose the recent case of *Bullshine Distillery LLC v. Sazerac Brands, LLC*, 130 F.4th 1025 (Fed. Cir. 2025), an appeal from a trademark opposition proceeding.

1. *Abercrombie & Fitch Co. v. Hunting World. Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).
2. J. Marvel and D. Hilliard, *Trademarks and Unfair Competition Deskbook*, (12th ed. 2025).
3. *Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 203 (1896).*
4. *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 521 n.3 (5th Cir. 1953).

In 2015, Bullshine Distillery LLC applied to register BULLSHINE FIREBULL as a trademark for "alcoholic beverages except beers." Sazerac opposed the application, alleging likelihood of confusion with its FIREBALL mark for whiskey and liqueurs. Bullshine counter-claimed to cancel Sazerac's FIREBALL registrations on the ground that "fireball" was a generic term for spicy cinnamon alcoholic beverages. Ten years later, considering an issue of first impression regarding the timing of genericness assessments in trademark opposition cases, the U.S. Court of Appeals for the Federal Circuit sided with Sazerac (at least with respect to the genericness question) and upheld the Trademark Trial and Appeal ("TTAB") ruling that FIREBALL was not generic at the time Sazerac registered it.

Genericnes at the Time of Registration Controls

Bullshine argued that if Sazerac's FIREBALL mark had been generic at any point in time – even years before Sazerac obtained its registrations – then it was ineligible for trademark registration.[5] According to Bullshine, "once generic, always generic." Sazerac disagreed, arguing that genericness mattered at the time of registration.

The Federal Circuit (the main reviewing court of the TTAB) first noted that Section 2(e) of the Lanham Act states that a mark cannot be registered which "when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." *Bullshine Distillery*, 130 F.4th at 1029. The court then noted that generic terms are included in the "merely descriptive" prohibition, which "prevents registration of a generic term because it would deceive consumers as to the origin of a good. This inquiry necessarily looks to what consumers would think **at the time of registration**." *Id.* (emphasis added).

> THE GENERICNESS BATTLE WAS WON BUT THE TRADEMARK OPPOSITION WAS LOST

The court next considered the statutory scheme of the Lanham Act and the fact that long-standing trademark registrations – even incontestable ones – can be canceled if the mark has become generic over time. According to the court, "This demonstrates Congress' understanding that whether a term is generic is an inquiry that changes over time, and therefore Bullshine's argument that once generic always generic, no matter how far removed from the time-period of genericness, is inconsistent with the statute." *Id.* The court further noted that the Lanham Act's purpose is to protect consumers from confusion, and "[t]he public is not protected by looking to what consumers thought of a term ten, fifty, or one-hundred years ago. It is the impression of consumers **at the time of the mark's registration**—whether they would be confused or misled by a mark—that the Act aims to protect." *Id.*, at 1029-30 (emphasis added).

Having determined the Board used the correct legal standard when it assessed whether FIREBALL was generic at the time Sazerac obtained its trademark registrations, the Federal Circuit then upheld the TTAB's finding that it was not generic at that time. Substantial evidence supporting the Board's ruling included recipes for "fireball" drinks that did not include whiskey or other liquor and testimony showing that "FIREBALL was known by the relevant consumers more as a trademark, either for ATOMIC FIREBALL candy or DR. MCGILLICUDDY'S FIREBALL cinnamon whisky, than as a nondistinctive term for a specific flavor." *Id.*, at 1031.

5. The TTAB previously ruled that FIREBALL was not generic at the time of trial and Bullshine did not appeal this portion of the Board's decision. *Sazerac Brands, LLC v. Bullshine Distillery LLC*, No. 91227653, 2023 WL 2423356, at *22 (TTAB March 6, 2023).

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BULLSHINE FIREBULL
Not Confusingly Similar to FIREBALL

That said, the genericness battle was won but the trademark opposition was lost. Still, getting a ruling that FIREBALL was not generic was probably more important to Sazerac than the particular opposition outcome.

In its cross-appeal, Sazerac argued the TTAB erred by (1) finding the FIREBALL trademark is not famous, (2) deeming the FIREBALL trademark conceptually weak, and (3) not considering the number and nature of similar marks in use on similar goods. *Id.* The Federal Circuit found that substantial evidence supported the TTAB's findings on all three likelihood of confusion factors.

First, the court agreed with Bullshine and the TTAB that FIREBALL is not a famous trademark. The TTAB found Sazerac had failed to introduce evidence that would have provided context for its sales and advertising figures, such as how sales of FIREBALL whiskey compare with those of competing liquor brands. Additionally, most of Sazerac's evidence of purported fame related to shot drinkers specifically, even though the FIREBALL registrations cover whiskey and liqueurs more broadly.

The court also upheld the Board's finding that FIREBALL is conceptually weak because it is highly suggestive of spicy-sweet cinnamon-flavored whiskey. The court noted Sazerac's admissions that its product and ATOMIC FIREBALL candy have the same flavor profile and that the word "fireball" is commonly used in the names of popcorn, ice cream, beef jerky, and other food products featuring a spicy-sweet cinnamon taste.

Finally, the court found that the Board had, in fact, taken into account the lack of similar marks used in connection with similar goods, but when weighing all relevant *DuPont* factors, correctly found no likelihood of confusion.

The most important lessons of the FIREBALL case for brand owners are that genericness is determined in trademark opposition and cancellation proceedings at the time of registration, and redemption from an earlier time of genericness is possible if the evidentiary record supports it. ■

*firm*UPDATE

APPOINTMENTS

- **Seth Appel**

Seth has been appointed to the 2025-26 Editorial Board of *Landslide* Magazine, the magazine of the ABA Section of Intellectual Property Law.

- **Thad Chaloemtiarana**



Thad has been appointed Chair of the Nominating Committee for the ABA Section of Intellectual Property Law, and reappointed as Section Liaison to the Intellectual Property Law Committee of the National Asian Pacific American Bar Association for 2025-26.

- **Robert Sacoff**



Bob has been reappointed as the ABA Section of Intellectual Property Law Liaison to AIPPI for 2025-26.

PRESENTATIONS

- **Seth Appel and Jonathan Jennings**





Seth and Jonathan will speak to the INTA Healthcare and Pharmaceutical Industry Group on September 11, 2025 about the challenges of incorporating elements of generic terms into pharmaceutical branding.

firm NOTEWORTHY

Chambers USA - 2025

Pattishall McAuliffe has again been recognized for its experience in Trademark, Copyright and Trade Secrets. **David Hilliard** and **Thad Chaloemtiarana** were recognized individually as "Notable Practitioners."

Managing IP - IP Stars 2025

Seth Appel, **Phillip Barengolts**, **Ashly Boesche**, **Bradley Cohn**, **Jonathan Jennings** and **Janet Marvel** were recognized nationally and in Illinois as Trade Mark Stars. **Bradley** was also recognized as a Copyright Star.

Public Interest Law Initiative (PILI)

Pattishall McAuliffe was a proud sponsor of PILI's 2025 Annual Pro Bono Reception, held on June 25, 2025 at the Ivy Room at Tree Studios in Chicago, IL.

The Legal 500 United States

Pattishall McAuliffe has again been recognized for its experience in trademark litigation and "non-contentious" trademark work.

For trademark litigation, it was noted that the firm's "wide-ranging practice extends across the sectors of banking, healthcare and media, to name a few. **Bradley Cohn**, who helms the practice, is routinely engaged by clients for assistance with trademark dilution, keyword advertising and environmental marketing claims. **Thad Chaloemtiarana** is well-positioned to advise on dilution, grey market goods and domain name cybersquatting, while **Jonathan Jennings** is sought after for his extensive experience in relation to litigation, licensing and domain name mandates. **Phillip Barengolts** deploys his substantive skills before the Trademark Trial and Appeal Board to advise AI, pharma and consumer companies, while **Ashly Boesche** is highly knowledgeable when it comes to electronically stored information. **Jacquelyn Prom** is also recommended."

For "non-contentious" trademark work, it was noted that the firm is "esteemed for its licensing, social media and protective work in the trademark sphere and also excels on the cutting-edge tech side. **Bradley Cohn** spearheads the team, remaining a force to be reckoned with in the entertainment, fashion and beverage sectors. Other key names to note in the practice include **Thad Chaloemtiarana**, who contributes his vast expertise that spans tech development, branding and distribution agreements, among a host of other transactions, and veteran practitioner **Jonathan Jennings**, who displays substantial skills in relation to prosecution, licensing and domain name matters. **Phillip Barengolts** fields a considerable workload that extends across consumer health, crop science and pharma sectors, **Ashly Boesche** covers the full array of trademark issues, and **Jacquelyn Prom** handles a substantive volume of domain name enforcement matters."