

Managing The Legal Risk of "Verbing Up" Brands and Trademarks

Article By:

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Trademark lawyers need to face the facts. Despite decades of ardent counseling to the contrary, business executives and marketers are not only testing the waters with the treatment of their most valuable brands as verbs, in some cases, they are diving in head first, committing substantial resources and effort toward the clearly stated goal of "[verbing up](#)" and having their brands used as verbs by consumers in everyday life and conversation. The most recent example is Vanguard's decision to promote "[Vanguarding](#)" over mere investing.

A growing number of brand owners apparently are convinced the stated risk of [genericide](#) is either too remote or distant to fear, or at least that the marketing benefits of encouraging the verbing of their brands far exceeds losing all exclusive rights in the trademarks associated with those brands. So, what is a responsible trademark lawyer to do when those in charge of the brand insist on treating it as a verb? Instead of papering the file with "I told you so" memos, I'd suggest we roll up our sleeves, put on our thinking caps, and get creative.

Last year my DuetsBlog post entitled "[Just Verb It? A Legal Perspective on Using Brands As Verbs: Part I](#)," explored the rapidly growing marketing and business interest in brandverbs and brandverbing, stirred a vibrant dialog between marketing types and trademark types, and concluded:

The challenge for trademark types and trademark owners is that many marketers are not listening to these cautious admonitions. As a consequence, trademark types will need to be increasingly more and more creative in their approach to mitigate the risk of the brand not only going to marketing heaven, but dying a sudden death immediately thereafter.

Then, in "[Just Verb It? Part II: A Legal Perspective on Using Brands as Verbs](#)," I asked what companies like Microsoft, Culver's and Yahoo! "know or at least believe" that others don't know or believe, i.e., those who religiously follow the International Trademark Association's black and white guidelines to "[NEVER use a trademark as a verb](#)."

Part III of my Just Verb It? series suggested that "not all slippery slopes are created equal" and questioned the slipperiness of the genericide slope, at least as it relates to brandverbing, in "[Just Verb It? Part III: Testing the 'Slippery Slope' of Using Brands as Verbs](#)," further recognizing:

Given the apparent marketing and business value associated with having brands embraced as verbs, I submit that creative trademark types and marketers can and should work together to find ways of mitigating the extreme risk of trademark genericide without bowing to the slippery slope argument that forbids any brandverbing whatsoever.

Here are a few opening thoughts and considerations toward mitigating the risk of trademark genericide when the managers of the brand have decided to assume the risk and embraced a brandverbing strategy:

1. Make clear to consumers that the action suggested by the brandverb (e.g., Googling or Vanguarding) cannot be accomplished without using the branded product or service (e.g., Google or Vanguard);
2. Build the verbed brand into taglines, slogans, and/or logos that reinforce point (1) (e.g., "[Get Culverized](#)," "Googling is Impossible Without Google" or "Vanguarding Can't Happen Without Vanguard");
3. Federally register the form of the brand name serving as a brandverb (e.g., [Vanguarding](#)) or the tagline, slogan, or logo containing the brandverb ([I've Been Krogering](#));
4. Create and publish trademark and brandverb use guidelines that reinforce points (1), (2), and (3);
5. Work with dictionaries to make sure that any verb listings are consistent with point (1) (e.g., "[to search for information about a specific person through the Google search engine](#)");
6. Send friendly letters to publishers and media outlets that don't appear to appreciate point (1) from the context of their brandverb references;
7. Respect that the majority of the relevant consuming public will decide the meaning of the brandverb and whether it has lost distinctiveness through genericide, so closely and regularly monitor their views; and
8. Adjust tactics to achieve point (1) when it appears (7) is trending negatively.

What steps would you recommend to mitigate the risk of genericide?

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