

Is 'Spinning' Generic? Peloton Is Willing To Pay To Find Out

By **Bill Donahue**

Law360 (February 17, 2021, 8:13 PM EST) -- Peloton wants to liberate the term "spinning" from trademark control after years of "baseless" threats by a rival company, setting the stage for a closely watched case about both genericide and the pitfalls of aggressive enforcement.

In a strongly worded pair of petitions filed Tuesday at the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board, Peloton accused Mad Dogg Athletics of using bogus threats to maintain an unfair monopoly over a word that had become a common term for indoor cycling.

"Enough is enough," Peloton wrote, asking the agency to cancel trademark registrations for the terms. "It is time to put a stop to Mad Dogg's tactic of profiting by threatening competitors, marketplaces and even journalists with enforcement of generic trademarks."

Peloton's case is a rare high-profile showdown over so-called genericide — the idea that a prominent brand name has become such a fixture in the market that consumers start to use it for any company's goods or services.

The company claims Mad Dogg has long tried to "stem the tide" with aggressive legal tactics, but has not succeeded.

"What Peloton is arguing is essentially that Mad Dogg's Spin and Spinning marks are a victim of their own success, that the business was so successful that the mark came to define the category of exercise services," said Monica Riva Talley, the head of the trademark practice group at Sterne Kessler Goldstein & Fox PLLC

Mad Dogg claims to have coined the terms "Spin" and "Spinning" for its indoor stationary bikes and its style of cycling class, and has had the terms registered as trademarks since the 1990s. The company sells bikes under the names and also licenses it to gyms and class instructors.

But the terms have become widely used by third parties in recent years, with "spin class" and "spinning" often used to refer to any type of indoor cycling class. Peloton and others have avoided the term, but many small businesses, media outlets and consumers have not.

Proving that a brand has succumbed to genericide is no easy task. Trademarks like aspirin, elevator and thermos all slipped into the public domain decades ago, but many words that are often used generically

by consumers — like Kleenex, Band-Aid and Xerox — have managed to hang on to their protected status.

In its legal filings, Peloton argued that even a cursory internet search shows that "everyone in the world — other than Mad Dogg — understands that 'spin' and 'spinning' are generic terms." The company cited articles by The Wall Street Journal, The New York Times, The Washington Post and "countless" other outlets that use the term generically.

For some trademark experts, the evidence in favor of Peloton's argument is overwhelmingly strong.

"Unfortunately for Mad Dogg, this is a situation where a mark was unique 20 years ago but has now fallen into the common vernacular," said Dyan Finguerra-DuCharme, who co-chairs the trademark practice at Pryor Cashman LLP.

"Peloton should easily win on summary judgment based on the thousands of references to 'spin' and 'spinning' in news stories, blogs and social media posts," Finguerra-DuCharme said.

In Mad Dogg's defense, the company has successfully had "Spin" and "Spinning" registered as trademarks for more than two decades, entitling it to a certain level of deference. It has also, for better or for worse, used those registrations aggressively to try to prevent its trademark from becoming generic.

"This will be an interesting case to watch as the parties spin the facts and ride their respective strengths," said Mark Sommers, a partner with Finnegan Henderson Farabow Garrett & Dunner LLP.

"The board will be called upon to weigh presumptions of ownership accorded by registrations, public and trade uses of the marks and nomenclature at issue, and the policing efforts of trademark owner," Sommers said.

Those trademark policing efforts form an interesting element of the upcoming legal battle — potentially a key argument in Mad Dogg's defense, but also possibly the reason the company is facing such a challenge in the first place.

Certainly, pushing back on misuse and educating consumers is an important tool for any company seeking to fight back against genericide. The company behind Velcro, for instance, made headlines in 2017 when it released a humorous video urging consumers to avoid using the name generically.

But if not handled carefully, such efforts can also lead to the kind of litigation that results in courts officially declaring a trademark generic, particularly if one picks a fight with a well-funded foe that has an interest in punching back.

According to Peloton, Mad Dogg sent a huge number of "baseless cease-and-desist letters" over its supposed trademark rights, including to journalists and individuals. Eventually, one of those demands targeted Peloton, seeking to force the company to remove a YouTube video that referred to a group of Peloton users as "Mocha Spin Docs."

But unlike the others who had received such demands, Peloton is now fighting back. Whether it's because of the company's deep pockets, or because it's a leading producer of lower-case "S" spin bikes, Peloton has decided that it's willing to pay to find out if "spinning" is really an enforceable trademark.

"Mad Dogg may have had great success with its aggressive enforcement campaign against small players," said Finguerra-DuCharme, the Pryor Cashman attorney, "but it finally sent a letter to a spin master who had the means to challenge its position."

--Editing by Peter Rozovsky.

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