Cancelling a Trademark: What's Peloton's Spin?

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April 26, 2021

Can a company cancel another's trademark? Peloton makes the case that Spin® has become a generic term.

Peloton Interactive, Inc., the maker of the popular Peloton® stationary bicycles, recently filed a **Petition to Cancel** the registration owned by Mad Dogg Athletics, Inc. for the trademark "SPIN" for stationary exercise bicycles and physical fitness instruction. From Peloton's perspective, "spin class" and "spin bike" are part of the fitness lexicon. Even five minutes of simple Google searching reveals that everyone in the world—other than Mad Dogg—understands that "spin" and "spinning" are generic terms to describe a type of exercise bike and associated in-studio class.[1]

How can this be? Can Peloton take away someone else's trademark registration?

There's a real possibility of that in our view.

What constitutes a strong trademark?

A trademark is a word, phrase, symbol, or design, as well as a sound, shape, color, scent, or taste that is used in conjunction with, and to identify the source of, goods or services in the marketplace (e.g., brand names and logos).

Trademark rights do arise automatically under common law through the actual exclusive use of the mark in commerce, without registration. However, registration of the trademark with the Trademark Office (e.g., the United States Trademark Office) provides several advantages that could be taken away if the registration is canceled.

The goal of trademarks is to create a distinctive brand in the market that distinguishes goods or services from the competition. To that end, there are marks that are inherently stronger, and those that are weaker and may not even be registerable, or in this case, be able to maintain their registration.

The strongest trademark is one that is completely made up, coined, or fanciful, because it is inherently distinctive, having never existed before it was created to be a trademark. The next strongest mark is one that is formed of a word or words that have a common meaning, but that are used in an arbitrary way that is otherwise not logically connected with the product or service (think Apple® for computers). A suggestive mark provides some hint or suggestion as to the product or service without actually describing the product or service, such as Airbus® for airplanes or Subway® for sub sandwiches.

Terms that are difficult to trademark

A lot of companies are named after first names or surnames of, for example, the founders. Names, especially surnames, are relatively difficult to register as trademarks because the

Trademark Office is hesitant to give one individual or entity the right to use the surname mark exclusively for certain goods or services. Descriptive marks are too weak to be considered a trademark under common law and are difficult to register. The word or phrase inherently describes a feature or characteristic of the goods or services; specifically, a mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, use, or targeted user of the specified goods or services.

Finally, generic marks are not actually considered a trademark. A generic word or phrase is so inherently descriptive of a product or service with which it is associated that it is ultimately incapable of functioning as a trademark. Generally speaking, generic words can be thought of as the typical or well-known name of the product or service in question. For example, it would not be possible to register "CLOCK" for timepieces, or "LIGHT" for lighting fixtures. The reason for this is one of public policy. If such generic words or phrases were registerable, then the words or phrases would become unavailable for the public to use to describe the items.

The trouble with generic trademarks

If trademarks are improperly used, they may be at risk of becoming generic. A famous example of this is "ESCALATOR", which used to be a trademark owned by Otis Elevator. The mark was used incorrectly and repeatedly as a noun, and Otis ultimately lost the rights to claim it as a trademark. This is the spin that Peloton is trying to put on Mad Dogg's trademark registration by filing the Petition to Cancel.

Is the term "spinning" generic, or does it still have trademark significance? Mad Dogg certainly has a long history with this mark, beginning with trademark registrations for "Johnny G.'s Spinning" and "Johnny G. Spinner," registered in 1993. These marks refer to Johnny Goldberg, a South African endurance racing cyclist who created indoor cycling back in 1982. He called it "spinning," and along with his partner in Mad Dogg Athletics, John Baudhuin, started teaching indoor cycling fitness classes and programs in 1993, using stationary bikes he built himself. At the time, the name was clearly a trademark, being a novel reference to the motion and effect of the exercise. The mark was, and still is, used for the exercise classes and the bikes themselves, Spinner® indoor bicycles, as well as many other related goods such as athletic wear and water bottles.

Can trademark owner keep the term Spin® from being considered generic?

All this being said, the question is, how are the "Spin®" and Spinning®" marks perceived now? Mad Dogg holds 39 registrations for various forms of these marks. The oldest Mad Dogg registrations mentioned above, along with "Spinner" for the indoor bicycles themselves, are all still alive and well, with current specimens of use showing proper trademark use (i.e. "Spinner® stationary bicycle"), and no significant generic use of "Spinner" as a noun for an indoor bicycle. Mad Dogg has also been enforcing and defending their rights against every attack, successfully, thus far. They have also been creative in their quest to avoid genericide, by registering "SPIN" or "Spinning" for a multitude of goods and services, such as exercise clothing, nutritional supplements, body lotions and oils, computer software, fitness instruction, and more, as well as registering myriad variations on the "Spin" mark, such as SPIN BODY, SPIN YOGA, SPIN FITNESS, SPIN TECH, SPIN GYM, etc.

Regardless, one could argue that many people do still use the word, "Spin" or "Spinning" to refer to indoor cycling classes. It is possible, however, that Mad Dogg could keep their trademark rights. Those of us of a particular age may remember the "I am stuck on Bandaid® brand" advertising campaign – meant to dissuade consumers from using "Band Aid" generically for adhesive bandages. Kleenex also seems to have averted genericide of its mark by consistently using "Kleenex® tissues." If Mad Dogg embarks on a similar nationwide campaign to encourage fitness studios and consumers to use the term "indoor cycling" (or "SPIN® indoor cycling" if using

the Mad Dogg SPINNING® programs and equipment), rather than "spinning" by itself, they might also avoid the fate of aspirin, cellophane, dry ice, and laundromat.

Questions about creating or defending a trademark?
Please contact **Sean Detweiler**.

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Footnote:

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1. Petition to Cancel, paragraph 3, Cancellation Proceeding Number 92076483, TTAB