

“Taco Tuesday” Serves Up Lessons on Trademark Protection

Article

Amundsen Davis IP Alert

June 20, 2023

If you're celebrating Taco Tuesday, where are you going? If you answered anything other than Taco John's, you're guilty of aiding in trademark genericization. Taco John's (now owned by Spicy Seasonings, LLC) obtained a trademark on “Taco Tuesday” back in 1989. Taco John's is now at risk of losing its trademark due to the widespread use of Taco Tuesday by local food trucks and large chain restaurants alike, despite continual enforcement of its mark.

Taco Bell has now made it a mission to free the phrase Taco Tuesday. The entity filed a Petition for Cancellation of Taco John's trademark “Taco Tuesday” on, aptly, Tuesday, May 16, 2023. In its Petition, Taco Bell alleges Taco John's trademark registration is “not cool.” According to Taco Bell, “[t]he Registration [of Taco Tuesday] potentially subjects Taco Bell and anyone else who wants to share tacos with the world to the possibility of legal action or angry letters if they say “Taco Tuesday” without express permission from Registrant [Spicy Seasonings, LLC] – simply for pursuing happiness on a Tuesday. This violates an American ideal: “the pursuit of happiness.”

While poking some fun, Taco Bell did lay out an argument alleging “Taco Tuesday” no longer functioned as a source of tacos. It was enough of an argument that the Trademark Trial and Appeal Board instituted the proceeding, and Taco John's (well, Spicy Seasonings, LLC) has until June 25, 2023 to respond to Taco Bell's petition.

How can Taco John's maintain its rights in Taco Tuesday? What steps could Taco John's take? How can you, as a brand owner, prevent YOUR trademarks from becoming generic? Identify and use a generic term for your product and use it with your trademark. If there is no generic term yet, create one. Watch third parties and correct any improper usage, preferably with a smile and in a kindhearted way. Sometimes, though, a good trademark will just catch fire, and a clever, upbeat advertising campaign may be the best way to educate the public about your brand. Indeed, Taco John's quickly took to social media to thank Taco Bell for the free advertising and reminding everyone that “Taco Tuesday is best celebrated at Taco John's.”

PROFESSIONALS

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I cannot predict what will happen to Taco Tuesday ®, but whatever happens is likely to have a significant impact as other brands, like Band-Aid ®, Kleenex ® and Hula-Hoop ®, as they continually fight against genericide.

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