

Crayola Files Suit to Prevent Genericide and Dilution

I found about this about this case, which involves a product known by virtually every American, by reading this [tweet](#) from fellow New York attorney Mark H. Jaffe, who also provided a link to the [complaint](#).

Plaintiff is Crayola Properties, Inc., which is a subsidiary of Hallmark Cards [the level of cuteness of a Hallmark card written in crayolas is almost unbearable] and Defendant is Alex Toys, LLC. Defendant is allegedly counterfeiting the famous crayons and infringing and diluting the Crayola trade mark. Defendant sells crayons which bear, according to the complaint, the term “crayola” printed on their sides and sometimes on their packaging as well.

The complaint explains the origin of the Crayola mark, which has been used since 1905. The mark was coined by the wife of a co-founder of the company from the French word “*craie*” (chalk) and “ola,” short for “oleaginous” [not for *oh là là*]. So Crayola is an oily chalk, and, as such, has been happily used by toddlers, in age or in spirit, for more than a century, either on paper or on freshly-repainted kitchen walls. Two hundred billion Crayola crayons have been sold and 3 billion are produced each year.



A Famous Mark

Plaintiff owns over 20 registrations for Crayola trade marks and for trade marks containing the term Crayola. The complaint argues that Crayola is a famous trade mark, and it would be difficult to disagree, as they are sold in every U.S. supermarket I have ever visited, toys stores, office supply stores, and they grace the tables of family-style restaurants coast to coast, keeping kiddos busy while they wait for their grilled cheese sandwiches. Also, crayolas have been featured on an U.S. stamp and are on permanent display at the [Smithsonian](#). Plaintiff argues that “[a]n overwhelming majority of consumers think of the CRAYOLA mark without prompting when asked to name a brand of crayons.” If the case goes to trial, this question would certainly be part of a survey presented as evidence by Plaintiff.

Willful Trade Mark Counterfeiting Claim

Plaintiff claims that Defendant’s use of the Crayola trade mark on its products is willful trade mark counterfeiting, in violation of [sections 32\(1\)](#) and [34\(d\)](#) of the Lanham Act, and is asking to be awarded compensatory and treble damages. Indeed, the latter are mandatory under Section 35(b) of the Lanham Act if the use of the counterfeit mark has been willful. Plaintiff argues that infringement is willful as Defendant has hired Plaintiff’s former General Manager of Sales as its Executive Vice President of Sales.



Genericide Is No Laughable Matter

Trade Mark Dilution Claim

Plaintiff also claims that Defendant's unauthorized use of the famous crayola trade mark dilutes it, in violation of [Section 43\(c\) of the Lanham Act](#). Dilution by blurring, as defined by the Lanham Act, occurs when a trade mark similar to a famous mark impairs the distinctiveness of the famous mark. In our case, the trade mark "Crayola" is printed on Defendant's crayons as such: crayons crayons crayolas. It could be argued that consumers may believe that crayolas mean "crayon" in another language, as it follows "crayons" in English and "crayons" in French.

Of course, having a trade mark become a generic term is the nightmare of every trade mark holder, as a mark considered to be generic by a court can no longer play its role of indicator of the goods or services' origin.

Trade Mark Infringement Claim

Plaintiff also argues that Defendant infringed its trade mark by using it on its web site and on its products and that, as Plaintiff has "*no control over the nature and quality of the goods and services of Defendant... [a]ny failure, neglect, or default by Defendant in providing goods or services will reflect adversely on Crayola as the believed source of origin.*" Filing this suit is a way for Crayola to prevent improper use of its trade mark by a third party and thus possibly losing its rights by genericide, should a court determine that indeed crayons and crayolas are merely similar nouns.

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