
TRADEMARK GENERICIDE: WHEN BRANDS FALL PREY TO THEIR OWN FAME

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ABSTRACT

The significance of trademarks truly reflect through its reach and recognition amongst the general public. It is not necessary that any and every trademark is well known. However, when trademarks do become famous to the point of eclipsing over a process/method of preparation or becomes synonymous to a category of goods and services, they lose their distinctiveness. Thus, they fall prey to their own fame. Competitive and aggressive Marketing may bring immense profits and even potentially increase circulation of the goods and services but it would also mean that at the end of this success lies a possibility of genericide. It is interesting to note that when companies successfully embed their brand names in the public mind, their brand names suffer from synonymity and succumb to genericide. This issue is more relevant than ever as it has plagued trademarks under every jurisdiction which shall be explored in this article. This article will attempt to explore the concept of Trademark Genericide and the reasons behind it along with some glaring examples.

INTRODUCTION

Trademark is considered to be an important asset for any business. Its most important function is to indicate the source of goods or services. However, with dictionaries adding newer terms every year and trademarks becoming generic overtime, trademark genericide is a serious issue for various well known businesses today. Some terms have become so generic that its recognition as a specific trademark has eroded with time. In short, when a trademark becomes *publici juris*, it means that it has fallen prey to trademark genericide. Surprisingly terms like Jacuzzi, Breathalyzer, bubble wrap, aspirin, Velcro, Band-Aids etc. were actually trademarked. For example, Breathalyzer was created in Indiana University Foundation in 1931 by one of its Professors. This device was actually patented and the name trademarked. Interestingly, now it is a common term, used to the point that it has lost its trademark to genericide. This article attempts to introduce and analyse trademark genericide and its impact on businesses. It would further expand on the various judicial standpoints taken overtime which has given recognition to this issue recently.

TRADITIONAL DIVISION OF TRADEMARK TYPES

There are roughly 4 categories.

1. **Arbitrary or Coined** terms which are meant to be fanciful. These terms usually have little to no relation to the product they are representing. Example- “APPLE” has no actual reference to computers or software for that matter. A “**fanciful**” or coined term would include examples of KODAK (cameras), these terms are totally made up.¹
2. The next category is that of “**suggestive**” terms, which convey a hint of information but not a complete related description of the product. Example- “Playboy” (magazine) or the famous “TIDE” detergent.²
3. There exists the **descriptive category** which conveys a very imperative or inherent aspect of the product they identify on behalf of. Example- “PARK ‘N FLY” for long-term parking services.³
4. Lastly, **Generic terms** are those which have fallen flat in the public domain and are not entitled to protection. This category shall be further explored below. Example- “shredded

¹ John D. Ingram, *The Genericide of Trademarks*, 2 Buff. INTELL. PROP. L.J. 154, 155 (2004).

² *Playboy Enter Inc. v. Chuckleberry Publ'g, Inc.*, 687 F.2d 563, 566 (2d Cir. 1982).³
Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985)

wheat” to refer to pillow shaped biscuits.³

GENERICIDE AND TRADEMARKS

It is imperative to explore the meaning of “Generic Trademarks” before getting into the concept of trademark genericide. Generic terms cannot afford the benefits of trademark protection in India. It shall be noted that legal protection of any word adopted as a trademark has limitations. It cannot be a word that is primarily understood as a ‘product category’ itself by the public. For example, “Computer” is one of those generic terms, it covers laptop or desktop or any computer related equipment. Thus, when a manufacturer sells “COMPUTER” branded computers then they cannot acquire the exclusive rights that come with trademark registration. Similarly “SHOES” cannot be used as a trademark as it refers to a general category.

The Trade Mark Act, 1999 only protects “distinctive” terms. *Section 9* and *Section 11* of the Act lay down the grounds for refusal of trademark registration. *Section 9 (1) (a)* specifically provides that trademarks *devoid of any distinctive character* would not be registered. Furthermore, “*Section 2 (1) (e)*” of the Act defines “**certification trade mark**” as a “*mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark*”. On a close perusal of the definition, it is clear that a generic trademark cannot provide distinction to the product or service being offered and thus, is not entitled to the protection under the Act. *Section 32* of the Trademarks Act states that when a mark is registered in accordance with Section (9) (1) of the Trademark Act, it is protected under the law when the mark has acquired a distinctive character in regard to the products and services with which it is dealing.

Another important provision is Section 36 of the Trademarks Act, 1999. It expressly indicates that a trademark is subject to cancellation if it is frequently utilized by merchants and other commodity dealers as the name of a commodity (or service) rather than as a source identification.

In “*Mr.A.D.Padmasingh Isaac and Anr. v. Aachi Cargo Channels Pvt. Ltd*”, while dismissing an infringement claim, the Madras High Court noted that the name "Aachi" – which means "grandmother" in Tamil – "is of broad usage" and thus could not be completely dominated by Aachi Masala Foods exclusively.⁴ In 2011, the Delhi HC settled a similar case, in “*Bhole Baba*

³ Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938).

⁴ Mr.A.D.Padmasingh Isaac and Anr. v. Aachi Cargo Channels Pvt. Ltd, AIR 2014 Mad 2

Milk Food Industries Ltd v. Parul Food Specialities (P) Ltd ", The Supreme Court of India noted that the name "Krishna" was a common one. The sitting judge noted that it is as prevalent as "the name John in the West" to clarify this statement. This term doesn't give any secondary distinctiveness, even though the trademark was registered.⁵

In "*Parakh Vanijya Pvt. Ltd.v. Baroma Agro Product & Ors*", the order of the lower courts was appealed to the Supreme Court. The Appellant had applied for 'MALABAR' under Class 30. The Apex Court held no exclusive right can be granted the word 'MALABAR' to the appellant as formative marks with the same name under the same class existed. Furthermore, the apex court of Supreme Court of India clearly said that when the two label markings were compared, they were significantly different. The Respondents' amended label, which included the words "BAROMA," "MALABAR," and "GOLD," looked different than the Appellant's. Because of the foregoing comments and documents on record, the Supreme Court sustained the Calcutta High Court's ruling and found no major flaws warranting intervention with the challenged judgment.⁶

In "*Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. and Ors*", The Apex judiciary body in India, the Supreme Court found it extremely difficult to accept Cadila's assertion that the name "Sugar Free" had become so unique that consumers connected it only with Cadilla's product.⁷

In "*Reebok India Company v. Gomzi Active*", the The Karnataka High Court ruled in favor of Reebok India, holding that the tagline "I am what I am" is among the various others lawfully protected trademarks registered by Reebok. When it comes to uniqueness, the threshold of protection afforded to taglines/slogans/catchphrases under trademark law is the same as that afforded to product names. The phrase met all of the conditions and so qualifies for trademark protection.⁸

GENERIC TERMS THAT WERE DECLARED AS DISTINCT BY INDIAN COURTS

On the contrary, in "*Ishi Khosla v. Anil Aggarwal*", the Delhi High Court held that distinctiveness is not necessarily acquired over time, it can be acquired in 1 day as well.⁹ In

⁵ Bhole Baba Milk Food Industries Ltd v. Parul Food Specialities (P) Ltd, 2011 SCC OnLine Del 288

⁶ Parakh Vanijya Pvt. Ltd.v. Baroma Agro Product & Ors, Civil Appeal No. 6642 OF 2018

⁷ Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. and Ors, 2009 (41) PTC 336 (Del)

⁸ Reebok India Company v. Gomzi Active, ILR 2006 KAR 3961

⁹ Ishi Khosla v. Anil Aggarwal, (2007) ILR 1 Delhi 615

“*H&M Hennes & Mauritz AB & Anr. v. HM Megabrands Pvt. Ltd. & Ors.*”, the Delhi High Court held that “H&M” or “HM”, were neither conventional or "publici juris" to the plaintiffs' and defendants' trades or businesses. The asserted trademark was foreign to both parties' trades, which were linked to fashion clothes, and was allegedly adopted by the plaintiffs far before the defendants.¹⁰ In “*Info Edge (India) Pvt. Ltd. v. Shailesh Gupta*”, the term NAUKRI.COM was awarded distinctiveness. The Court explained that since a Hindi word has been written in the English script, distinctiveness can be attributed to it as no secondary meaning can be given to it.¹¹

ISSUE TODAY- TRADEMARK GENERICIDE

Taking the above discussion further and defining Trademark Genericide, it is the loss of the exclusive rights of a trademark when a term enters the public domain and falls prey to common usage and consumers often denote that particular product as the trademark itself rather than its foundation. Whenever a mark becomes a product's "common descriptive name," the trademark owner loses his or her exclusive right to use it.¹²

In short, trademark genericide extinguishes the trademark itself as the general public relates the term to the product and not its source. For example- “escalator” was originally trademarked by the Otis Elevator company. It can be said that it fell prey to its own fame. Similarly, Dalda, Dettol, Kleenex, Q-tips etc. have been victims of trademark genericide. This issue has plagued trademarks all around the world. In the United States, Justice O'Connor remarked in 1985, in deciding whether the phrase “Park’N Fly”, when used for long-term airport parking services, was a generic word, that "a trademark or service mark that becomes generic is no longer entitled to protection."¹³

REASONS BEHIND LOSS OF TRADEMARK

1. The reason behind genericide is the overuse by the public that dilutes the meaning and completely ceases its actual reference to the source rather than the product.¹⁴
2. One explanation might be the lack of an appropriate replacement phrase for the commodity and service. E.g. Frisbee, Xerox, Aspirin, Cellophane, Zipper, Thermos, Popsicle,

¹⁰ *H&M Hennes & Mauritz AB & Anr. v. HM Megabrands Pvt. Ltd. & Ors.*, CS (Comm) No. 707 of 2016

¹¹ *Info Edge (India) Pvt. Ltd. v. Shailesh Gupta*, (2002) ILR 1 Delhi 220

¹² Shrabani Rout, “*India: Trademark Genericide: Victims Of Their Own Success?*” INTELLECTUAL PROPERTY AND TECH. LAW UPDATES, 13, 14 (May 2017)

¹³ *Supra* Note 3

¹⁴ Harshavardhan Ganesan, *The Other Mass killing: TM genericide* (2016)

Taser, pingpong etc. all were registered trademarks but have fallen prey to trademark genericide. In *Coca-Cola Co v. Overland Inc.*, the Court stated that “An originally non-generic and valid trademark transforms into a generic and invalid one when the principal significance of the word to the public becomes the indication of the nature or class of an article, rather than the indication of the article’s origin”.¹⁵

3. In their attempt to create everlasting impressions on the minds of consumers, trademark owners tend to indulge in aggressive advertising and marketing of their product line. This is understandable, but when use is coupled with ‘tag lines’ such as, ‘Do You Yahoo’ vis-a-vis the Yahoo search engines, brand building begins to run parallel with brand destruction.¹⁶

4. ‘Naked licensing’ poses another serious threat. When trademark owners allow licensees to use their marks without including and/or implementing quality control measures in the license agreement, the mark will be diluted over time. and severs the mark from its ‘source identifying function’.¹⁷ Interestingly, this issue can be seen from a reversed perspective as well. Sometimes generic terms achieve distinction owing to their wide use overtime.

INTERNATIONAL PERSPECTIVE

In 2009, the Federal Circuit heard two instances involving registration refusals based on genericness. In the case of *In re 1800 Mattress.com*, the Circuit upheld the Board's decision to refuse the mark MATTRESS.COM for "online retail shop services in the field of mattresses, beds, and bedding" on the Supplemental Register.¹⁸

The Federal Circuit confirmed the Board's conclusion that HOTELS.COM is generic for travelrelated services as laid in the case of *In re Hotels.com (Hotels.com III)*.¹⁹ "The generic term 'hotels' did not lose its general character by insertion in the domain name HOTELS.COM," the judge determined with the Board. The Circuit further determined that the Board properly weighed the huge number of identical "hotel" domain name usages, as well as common meaning and dictionary indications that "hotels" and ".com" are generic words, and that the Board's determinations were supported by significant evidence.²⁰

¹⁵ *Coca-Cola Co v. Overland Inc.*, 692 F.2d 1250

¹⁶ Samta Mehra and Radha Khera, *The price of fame* (May 2013)

¹⁷ *Id.*

¹⁸ *In re 1800Mattress.com*, 586 F.3d 1359, 92 U.S.P.Q.2d (BNA) 1682 (Fed. Cir. 2009)

¹⁹ *In re Hotels.com (Hotels.com III)*, 573 F.3d 1300, 91 U.S.P.Q.2d (BNA) 1532 (Fed. Cir. 2009).

²⁰ Rebecca Gan, *2009 Trademark Law Decisions of the Federal Circuit*, 59 AMERICAN UNIVERSITY LAW REVIEW 1115, 1127 (2010)

In 2017, in “*Elliott v. Google Inc.*”, it was held that a trade mark does not become generic until the courts declare it to be generic.²¹ David Elliot had attempted to register 763 domain names which included the search engine “Google”. Elliot had filed a suit in the district court stating that Google is primarily understood as a substitute for “internet searching” instead of a specific search engine. Google won the UDRP proceeding on various grounds including the evidence of that fact that the domains were being registered in bad faith. The Jury was not sufficiently convinced that there was any genericide. Further the Court went on to say that “*Even if we assume that the public uses the verb ‘google’ in a generic and indiscriminate sense, this tells us nothing about how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines.*”

MECHANISMS TO AVOID GENERICIDE

In the Indian context “Xerox ” is a glaring example of trademark genericide battle. It is important to discuss the backdrop of the efforts put by the owners of the trademark to prevent its genericide since 2003. Xerox is literally used as a synonym to photocopying. In a recent case of “*B.V Elango v. Rank Xerox Ltd* ”, the IPAB rejected various rectification petitions which were seeking the removal of Xerox as a trademark as it has become generic. The Boards stated that the owners had acted on time as they aggressively campaigned in order to spread the word that Xerox is not a generic word and that it shall not be used frivolously.²² Thus, Xerox retained its status as a trademark. However, personally I feel the reality is far from what was settled judicially as we still see the loose use of this trademark everywhere.

‘**Trademark policing**’ is another efficient, rather required, measure to combat genericism. It requires vigilance in the marketplace and willingness to take quick action against misuse. It is also imperative to ensure proper use of a mark by educating users, the media and the public in general about the correct usage of a mark. If a mark is beginning to appear in dictionaries or being used incorrectly in an article, remedial steps must be taken immediately.

The importance of trademark policing was highlighted in a recent tussle between Google and the Swedish Language Council. The Swedish Language Council designated the term 'ogooglebar,' which translates to 'ungoogleable,' as one of several new words in 2012. Google approached the council and asked that the use of the term be postponed since it contained Google's trademark. It also asked that all search engines not be referred to as ‘Google’. The

²¹ Elliott v. Google Inc., No. 15 -15809 (9th Cir. 2017)

²² B.V Elango v. Rank Xerox Ltd, MANU/IC/0110/2012

altercation finally led to the Language Council getting rid of the word 'ooglebar' altogether. This was a well-deserved triumph for 'Google' for its vigilance.

It has been widely advised that the trademark shall be promoted as an adjective rather than a verb or a noun. Another internal marketing mechanism that can be incorporated is to advertise a trademark in its full sense. For example- *Duracell* battery should be used as *Duracell battery*, and not just Duracell. This enables consumers to know Duracell is a kind of battery. A continued use and timely trademark renewal can keep the trademark alive. When a trademark is infringed, "*Cease and Desist*" notices shall be sent to the infringers. Filing opposition if an existing trademark is applied for registration by another. This would be an effective administrative mechanism that can check the loose use of trademarks.

CONCLUSION

It is abundantly clear that trademark genericide is fairly an intense issue in the global context as its impact is felt all over the world. Considering even Google got involved in such matters. On the bare perusal of the cases above, the important question that arises is that, is the impact of TM genericide making way to penalize companies for being too famous? Interestingly, the statute gives endless protection to trademark but Trademark genericide makes the protection temporal in nature. There is no real solution to this problem, funnily enough when trademarks are at the peak of its fame, it falls victim to it and the "Xerox" is discussed w.r.t. point.

In order to obtain and ensure the protection of trademark, the consumer's understanding of the product and its distinct source shall be tested. Through trademark policing and responsible advertising of trademarks can help in preserving the mark. Trade mark once a figment of creativity by the proprietor is lost due to over popularity. The proprietor must try to check any unauthorized use of its registered trademark: device, heading, brand, ticket, label, signature, name, letter, word, numeral or any combination thereof, necessary actions should be taken. Lastly, in order to avoid trademark genericide, "*prevention is better than cure*" shall be the approach. There is a long way to go before companies can predict trademark genericide and act accordingly. Preventive vigilance is the only way that seems to work as of now.

Your trademark is what sets you apart from your competitors. Losing that place in consumers' minds is like losing your product's public identity. Because of this, preventing genericide is paramount. Ultimately, avoiding genericide is about walking that fine line between becoming a household name and slipping into every-day speech. Adhere to trademark usage guidelines, and be sure to take action when people misuse your trademark. If you actively protect and

uphold your trademark, genericide will become less of a threat. Every brand wants its product to be well known. However, no brand wants its trademark to be a victim of genericide. Hence, it is always advisable to take precautionary measures as and when necessary to protect your trademark.