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GENERICIDE

THE FOE OF BIG BRANDS

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Introduction

In Harry Potter and the Sorcerer's Stone, J.K. Rowling wrote, "to the well-organized mind, death is but the next great adventure." Rowling's sentiments may be valid in the world of fantasies but in the world of big businesses and valuable brands, the death of a trademark may torpedo business into eventual nothingness. This is owed to the fact that marks have come to take on a 'mythical status'.¹ History is replete with the corpses of valuable brand whose successes and common usage was the harbinger of their demise, a process with the appellation "Genericide". As brands succeed and their status transcends being a badge of origin, it fast becomes a way of life, a symbol of status, a diction in our everyday vocabulary, and therein lies the curse of Genericide. Consequently, over every popular brand/trademark lurks the danger of genericide which perilously dangles like the sword of Damocles. Twitter acknowledged the lurking danger of genericide, such that it stated in its Initial Public Offer filing that "there is a risk that the word 'Tweet' could become so commonly used that it becomes synonymous with any short comment posted publicly on the internet, and if this happens, we could lose protection of this trademark."

Many more brands stand this danger, notorious of which is the trademark "Google". According to Brand Finance², Google has surpassed Apple as the most valuable global brand. Google is reported to possess trademark portfolio valued an estimate of of \$44.3 billion, the highest in the world.

What Is Genericide?

According to the Black's Law Dictionary (10th Edition) ("Dictionary"), genericide refers to "the loss or cancellation of a trademark that no longer distinguishes the owner's product from others' products." According to the Dictionary, "genericide occurs when a trademark becomes such a house-hold name that the consuming public begins to think of the mark not as a brand name but as a synonym for the product itself." Once declared to be a generic name, the designation enters the 'linguistic commons' and is free for all to use.

Cellophane, Aspirin, Yo-Yo, Escalator were all exclusive trademarks which have since become generic and reported to have lost its distinctiveness worthy of trademark protection. Parker Brothers, the company which acquired the Monopoly trademark in 1936, initially lost the trademark for the board game currently published by Hasbro. (The decision was overturned in 1984, and Parker Brothers continues to hold the

¹T. Drescher, 'The Transformation and Evolution of Trademarks – From Signals to Symbols to Myth' (1992) 82 TM Rep. 301

²<https://brandfinance.com/press-releases/google-pips-apple-apple-no-longer-the-worlds-most-valuable-brand-global-brand-rankings-reveals/>



the trademark for the board game.)

The issue of genericide came up in the lawsuit³ against Google in which David Elliott sought to invalidate some of Google's registrations for the GOOGLE trademark, arguing that the word had come into common usage as a verb that simply means to search the Internet. In support of these claims, Elliott's complaint cited entries in online dictionaries and other publications.

However, the court ruling in favour of Google, pronounced that the plaintiffs' evidence was insufficient to establish that the primary significance of the word "google" to the relevant public, was as a generic name for internet search engines, rather than as a mark identifying the Google search engine in particular. The Court also held that the use of the word "google" as a verb to mean "search the internet," as opposed to adjective use, did not automatically constitute generic use.

Justification For Genericide

The justification for genericide is mostly considered through the prism of economics and competition. The Courts⁴ have always believed that in genericide, the cost for conducting searches at the relevant trademark registry is reduced or eliminated. Furthermore, if the trademark has lost its element of distinctiveness the economic justification for monopoly rights accruing to the trademark is defeated. "After all, if the public does not understand "aspirin"⁵ to refer to the producer of the product, but rather only a type of product, allowing one producer to monopolize the term "aspirin" would inhibit competition while creating no gains for consumers."⁶

In the 'Shredded Wheat case,'⁷ key to the Court's reasoning is the idea that to foster competition, certain marks must be given over to Genericness and that to benefit the public, one owner should not be entitled to monopolize a word that has now passed into the common vernacular as describing a mere type of good.

The "shredded wheat" decision ushered in what is known as the "primary significance" test, in which a court requires the trademark holder to "show that the primary significance of the term in the minds of the consuming public is not the product but the producer."

⁴Ty, Inc. v. Perryman, 306 F.3d 509, 510 (7th Cir. 2002); Brennan's, Inc. v. Brennan's Rest., L.L.C., 360 F.3d 125, 132 (2d Cir. 2004)

⁵See Bayer Co. v. United Drug Co., 272 F. 505, 511 (S.D.N.Y. 1921)

⁶Ibid

⁷Kellogg Co. v. National Biscuit Co

³ Elliott v. Google, Inc., No. 15-15809 (9th Cir. 2017)

In the case of shredded wheat, the Court determined that “shredded wheat” was merely “the term by which the biscuit in pillow-shaped form is generally known by the public.” Hence, the term was generic. Furthermore, in considering the genericism of a formerly protectable mark that has fallen into the public domain, the court takes cognizance of the trademark’s expressive use. In other words, rather than restricting itself to the use of the trademark from the perspective of the consumer, the courts should also consider expressive contexts in which the trademarks are used, such as dictionary definitions and newspaper usage.⁸

Lastly, on this point, in an early British decided case (*Ford v Foster*, dating from 1872), the Court took the approach that the test must be whether a word that was originally a trade mark which has become *publici juris* (that is, has fallen into the public domain), is calculated to deceive the public as to whether the relevant goods were made by the original owner or not. If the mark has become so public and in such universal use, that nobody can be deceived by the use of it, into thinking that such goods are the goods of the trader, then however hard it may appear to be on the trader, the right to the trade mark has been lost.⁹

That is, if the public cannot be deceived that noodles branded “Indomie” belongs to Dufil, then “Indomie” has become generic, however, if the public can be deceived into thinking such noodles belong to Dufil’s “Indomie”, then the trademark “Indomie” is still capable of distinguishing and not generic.

Preventing Genericide

The death of Trademarks can be avoided with the right strategy. Companies like Twitter and Google resist genericidal claims by contending that their brands are a key element of differentiating them from the competition and that a powerful brand can elicit loyalty from satisfied customers.¹⁰

An important resource for the prevention of Genericide is *International Trademarks Association’s Trademark Usage Guidelines*.



⁸See *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989)

⁹KISCH IP - How and when does a trademark become generic? Accessed at <https://www.lexology.com/library/detail.aspx?g=8cb5409b-fd40-419d-ae5e-8224e2646803> On 9th August 2019 at 4:15pm.

¹⁰Dave Bookbinder, What is the Value of a Brand? On Huffpost.

According to the Guidelines, in order to avoid genericide, trademark owners should adhere to the following guidelines when using their trademarks:

- Use the generic name of the goods with the trademark (Q-Tips cotton swabs) (and, if your product is the first entrant, come up with a generic term for the product);
- Give proper notice of a registered trademark to consumers by using either: “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R enclosed within a circle, ®. 15 U.S.C. § 1111. For an unregistered mark, use TM;
- Distinguish the trademark from surrounding text by capitalizing the trademark, using a distinctive typeface, or at the very least, capitalizing the first letter of the trademark;
- Use the trademark as an adjective (GOOGLE search);
- Do not use the trademark as a noun (GOOGLE);
- Do not use the trademark in the plural (incorrect: buy two DR. PEPPERS; correct: buy two DR. PEPPER soda beverages);
- Do not use the trademark as a verb (incorrect - GOOGLE Arsene Wenger; correct - search Arsene Wenger on GOOGLE search);
- Do not abbreviate the trademark or alter it in any way (use H&M and not H and M);
- Use the trademark on a line of products rather than a single product (NIKE, used on sneakers and clothing);
- Object to others’ misuse of the trademark; and
- Educate the public, including individuals within the trademark owner’s organization, distributors, dealers, and consumers, to ensure proper usage of the trademark. Misuse often occurs due to lack of education, not wrongful intent. See example of public education from Velcro, Chanel etc.

Is Genericide Reversible?

The question has always been whether a mark that has become generic can regain its distinctiveness. It should be noted that whether a mark has fallen into genericide is determined by the courts. Thus, it is always difficult for a mark that has been pronounced generic by the court to regain distinctiveness.

However, where a mark is on its way to becoming generic, it may be salvaged. Marks that were once on their way to becoming generic include XEROX, JEEP, BAND-AID, and KLEENEX. To prevent these trademarks from becoming generic, each trademark owner ran an aggressive ad campaign to educate consumers

to view its trademark as a source identifier as opposed to a common name for its goods and/or services.¹¹

Examples of these ad campaigns are:

Xerox Corp.'s "You can't Xerox a Xerox on a Xerox. But we don't mind at all if you copy a copy on a Xerox® copier."

Chrysler LLC's "They invented "SUV" because they can't call them Jeep®."

Johnson & Johnson Corp.'s "I am stuck on Band-Aids brand cause Band-Aid's stuck on me."

Kimberly-Clark Corp.'s "Kleenex' is a brand name...and should always be followed by an ® and the word 'Tissue.' [Kleenex® Brand Tissue] Help us keep our identity, ours."¹²

In the case of Google, the search-engine giant was able to escape genericide due to its policing activities. The court stated that "Google's policing activities weighed against finding genericide." No doubt Google's early and continued diligence in discouraging publication (sometimes via cease-and-desist letters) from using the term "googling" in reference to internet searches assisted Google greatly in its efforts to preserve its valuable rights in the "Google" mark.

Conclusion

Kalyan C. Kankanala in Fun IP, Fundamentals of Intellectual Property writes that a Trademark is a company's persona and identity in the marketplace. Even though a rose by any other name would still smell as sweet but it would have lost valuable noses who wish to smell it because of the loss of its identity.

Genericide is usually the slow and painful death of a mark which leaves a trail of market decline in its wake.

Armed with the foregoing, I am convinced that you will not "google" me.

¹¹INTA Bulletin November 15, 2011 Vol 66 No. 22

¹²ibid

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