



The price of fame

Advertising and education can help even the biggest brands to avoid genericide in India, say **Samta Mehra** and **Radha Khera**

Is it not the ability to distinguish goods and services of contemporaneous traders the essence of a trademark? What happens when instead of indicating source, the mark starts representing the entire product category, or a trademark becomes so demotic, that its significance becomes limited to being synonymous with the product itself? This signifies the commencement of deterioration of the trademark or, 'genericide' as the IP fraternity calls it.

Supported by the epic case histories of 'Escalator', 'Zipper', 'Cellophane', 'Yo Yo', 'Gramophone', 'Aspirin', 'Thermos', it would be proper to conclude that the line between a well-known brand and the brand becoming 'generic' can be thin. That the general populace should instantly recognise a mark is a trait desired by every brand creator, yet when the public begins to associate a familiar mark with products of rival traders as well, the threat of genericism becomes imminent. Current examples of famous marks which might face such a threat include 'Band-aid', 'ChapStick', 'iPod', 'Jacuzzi', 'Jet Ski', 'Kleenex', 'Photoshop' and 'Scotch tape'.

When does a mark become generic?

The first known use of the term 'genericide' may be traced to the 7 March, 1983 issue of *Legal Times*, which included an article titled 'Court Rules that 'Monopoly' Has Suffered Genericide'. The article covered a US trademark case involving the famous board game Monopoly, which had become

so popular that its manufacturer could no longer take legal action against the creation of derivative or imitative games that invoked the name 'Monopoly'. That said, the origins of genericide go much further back to 1869 when linoleum was ruled generic.

There are no set standards to be followed for determining whether a mark has become generic and every case is decided on merits. The UK Patents, Designs and Trademarks Act 1883 provided that if a mark was publicly used by more than three persons for the same or similar description of goods, it should be deemed as 'common to the trade' in respect of such goods. The provision was, however, dropped in subsequent UK statutes (presumably as it was impractical and no hard and fast rule could be laid down).

In the Indian context, Section 36 of the Trademarks Act, 1999 states that if a particular mark is widely used by traders as the name of an article (or service) and not as a source identifier, the trademark in question becomes vulnerable to cancellation. Similar is the case involving the name of a patented article. No matter how distinctive the name, if two years after the lapse of patent, that name is the only practicable name or description of that article, the mark loses its trademark value and may be struck off the register.

Thus, a logical test to decide whether a mark which was originally a trademark has become *publici juris* is to see whether the use of it by third persons is calculated to deceive the public or not. If the mark has come to be in such universal use that nobody can be

induced to believe that he or she is buying goods of a particular trader, the right of the trademark must be gone.

Loss of trademark character

The blame for denudation of rights associated with a trademark can be placed on trademark owners and the public (including the media).

In their attempt to create everlasting impressions on the minds of consumers, trademark owners tend to indulge in aggressive advertisement 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.

'Naked licensing' poses another serious threat. When trademark owners allow licensees to use their marks without incorporating quality control provisions in the licence agreement and/or enforcing such provisions it leads to dilution of the mark in the long run and severs the mark from its 'source identifying function'.

Coming to the role of the public, it is worth mentioning that the constant development of linguistic skills bending towards fashionable adjustments of words, is extremely prevalent nowadays. In the era of social networking and the internet, language development does not care about brand protection. As a result, we often see trademarks being used in a pluralised and verbalised manner: 'Xerox the documents' as opposed to 'photocopy the documents on a Xerox copying machine'; 'do

you twitter' instead of 'do you post messages on the twitter website'; etc. Needless to say, with such obvious verbalisation and association, it is natural for the identity of the mark to become camouflaged with the product itself. The media too sometimes plays a role in genericism with its ever pervasive tendency to take a trademark to heart or treat it as a cultural icon, eg 'he is a Teflon president because no blame ever sticks to him'.

Another factor which may sometimes lead to the demise of a trademark involves patents. Trademarks for goods that are patented are susceptible to becoming generic once patent protection ends. This usually happens in cases where the inventor is the only maker of a product until patent protection lasts and makes the mistake of using the same name as a trademark and as a product identifier. Over time, consumers know of the product only by the name given to it by the inventor. Therefore, if trademark pirates attempt to encash on the success of a patented product once it is off patent, unless educated otherwise, consumers continue to associate it with an incorrect source of origin, ultimately leading to loss of trademark value.

Protective measures

As a preventive measure, it is prudent to promote use of a trademark as an adjective, not as a noun or verb. To figure this one out, a good test is to remove the trademark from the sentence and notice if the sentence still makes sense. If it does, the usage is proper, else it is not. Also, trademarks should not be used in a pluralised manner since they become prone to falling generic. For instance, Johnson & Johnson changed the lyrics of their Band-Aid television commercial jingle from "I am stuck on Band-Aids, cause Band-Aid's stuck on me" to 'I am stuck on Band-Aid brand, cause Band-Aid's stuck on me'. Such attempts go a long way in protecting the rights bestowed on a trademark, hence, Band-Aid as a trademark continues to be used in force.

In terms of genericism associated with patents, threat to a mark is easily obviated by coming up with product descriptors separate from the trademark. Some examples are: 'Escalators are known as moving stairs'; 'Cellophane is transparent wrapping material' and; 'Yo-Yo is a spinning toy'. In any event, under the Indian statute a two-year grace period is allowed after expiry of patent before the trademark becomes liable to be struck off. This period must be utilised to create a trademark separate from the generic name of the article or substance in case such an exercise has not been undertaken during the term of the patent. For instance, Chrysler attempted to promote awareness of its trademark with

advertising campaigns using tag lines with the generic name and its trademark – 'They invented SUV because they can't call "them Jeep"'. Clearly, this was an attempt to protect the trademark 'Jeep', whereas SUV is a generic term for such vehicles.

Additional measures such as distinctive treatment of the trademark in print, by means of capital letters, placing the mark within quotes, using different typeface/fonts, using the word 'Registered' or the symbol ® or ™, assist in the success of preventive measures. Also, if a trademark is used on a variety of products, it is relatively less likely to become generic.

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'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. In 2012, the word 'ogooglebar' translating to 'ungoogleable' was named as one of many new words in Sweden by the Language Council. Google contacted the council and requested it defer use of the said word since it contained Google's trademark. It also asked that all search engines not be referred to as 'Google'. The altercation finally led to the Language Council getting rid of the word 'ogooglebar' altogether. This was a well deserved triumph for 'Google' for its vigilance.

Xerox: An Indian case study

In India, attempts were made to derogate 'Xerox' as a generic word since it had started being used as a synonym for photocopying. However, in a recent case, when the Indian IP Appellate Board (IPAB) was faced with rectification petitions seeking the removal of

Xerox trademarks on the ground that the mark was generic, the board rejected the petition and held that 'the owners of the mark 'Xerox' had acted just in time to save the trademark from losing its life.' To reach this conclusion, much weight was ascribed by the board to aggressive campaigning undertaken by Xerox since at least 2003. Numerous advertisement campaigns ran including, 'If you use Xerox the way you use Zipper, our Trademark could be left wide open' and 'If you use Xerox the way you use Aspirin, we get a headache'. Evidence that owners of the trademark 'Xerox' had taken strong objection to the loose use of the word 'Xerox' by the government and public sector was presented, as were various responses in the form of apologies with assurances to set right the inadvertent error. There was material to indicate that the High Courts, the Port Trust and like institutions and the Government of India had agreed to delete the word Xerox and use the word 'photocopy' instead. Thus, a constant watch and effort to maintain the force of the mark helped 'Xerox' sustain its value as a trademark.

Every brand maker desires its brand to earn renown. But fame always comes at a price and it is left to us to decide how much one is willing to pay. And not just in terms of monetary efforts but also vigilance and timely enforcement of rights. 'Xerox', for instance, spent millions to educate the general public of its brand name. Because the brand owners acted well in time, the brand is intact and continues to enjoy its popularity.

While it may not be easy to maintain continuous protection for trademarks that are at the zenith of their fame, it is definitely not impossible. Preventive and corrective measures, if taken on time, can ensure a long walk for well known marks before they wishfully go to their graves.

Authors



Samta Mehra is a partner at Remfry & Sagar in New Delhi, India. She has 13 years' experience and is well acquainted with all aspects relating to trademarks, with a particular interest in the finer nuances of assignment and licensing. In addition, she is a member of INTA and ECTA and a regular at various international conferences and seminars. Radha Khera is an associate, also at Remfry & Sagar.