

## **“Genericization of well-known Trademarks - Dilution of Brand Names from proper nouns to common nouns”**

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### **PATTERNS OF TRADEMARK GENERICIZATION**

A trademark is an identifier (word, symbol) that is graphically representable and used to distinguish the origin of products and services. It serves four main functions: (1) distinguishing the products from those of other actors, (2) indicate the origin of goods, (3) guaranteeing a certain level of quality, and (4) appearing in advertising (Ingram, 2004).<sup>1</sup> Occasionally a trademark becomes the generic term of certain goods or services (e.g., all vacuum insulated bottles are called Thermos bottles). This can have intended and unintended effects. In both cases, the public no longer uses the trademarked name to distinguish the goods from one company to another. To consumers, the primary meaning and connotation of a trademark must be related to the producer, not the product itself (*Kellogg Co v. National Biscuit Co 1938*).<sup>2</sup> If this is not the case, and the Trademark is being used by the public as the generic name for the whole product category, the Trademark can then be subject to cancellation. This results in the loss of the enforceable trademark rights for the trademark holder, a process called trademark genericization.

### **Legal Side of Trademark Genericization**

Trademark genericization has both a legal and practical side. A trademark usually can only become legally generic after court ruling. In this case, someone needs to build a case and provide sufficient proof that a certain trademark has become known to the general public as the identifier of a certain category of products, rather than the indicator of the origin of the products. The practical side of genericization is how people are using the Trademark in their communication and usually occurs before legal genericization. Even though a trademark has not been genericized from a legal perspective, the public might still use the Trademark as the generic term for the category of goods. The main difference between practical and legal genericization is that other companies are not allowed to commercially exploit the protected Trademark if it is not legally genericized. Trademarks are valuable assets to businesses; they fulfil important functions towards the communication with the market (e.g., indicating the origin or the goods, exclusivity, lifestyle).

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<sup>1</sup> J.D. Ingram, (2004). The Genericide of Trademarks. Buffalo Intellectual Property Law Journal, 2(2), 154-163.

<sup>2</sup> Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938)

A recent example of a company that faced their Trademark becoming the generic term for searching something on the internet is Google, in the *Elliott v. Google Inc.* case. David Elliott is an individual who has commercial benefit from domain names registered under a third party's GoDaddy.com account. GoDaddy.com is a domain name register company. The domain names Elliott registered contained the Trademark Google in them. Upon Elliott's registrations, Google filed a complaint. Elliott tried to argue that Google is a generic term, leading to the Elliott v. Google Inc case.

### **Examples of Trademark**

Examples of trademarks that have been genericized are *escalator* (Otis Elevator Company), *aspirin* (Bayer), and *trampoline* (Griswold-Nissen Trampoline & Tumbling Company). These products or brands were once the respective names for moving staircases, acetyl salicylic acid, and rebound tumblers (Mansfield, 2015).<sup>3</sup> Although trademark genericization might seem to be a negative phenomenon, it can have positive effects for businesses as well. This dissertation will both identify the good and bad practices in trademark genericization.

The basis of trademark law originated in protecting the consumers from the possibility of confusion regarding the origin of a physical product. This was later extended to include the protection of the goodwill value of a company (Cohen, 1991), with enforceable rights to prosecute an infringer. Goodwill is the value of intangible assets, which may include the value of the Trademark. This means, for example, that you are not allowed to copy the trademarks of another company to benefit from their image, to sell more products of your own.

To avoid losing the exclusive right to a trademark, it must keep its distinctive character. Generic terms are used to identify a product category (e.g., cars, computers, vacuum-insulated bottles) and will face many difficulties in obtaining trademark protection. The trademark name can be measured on the spectrum of distinctiveness: (1) arbitrary, (2) fanciful, (3) suggestive, (4) descriptive, and (5) generic, as established in the *Abercrombie & Fitch Co. v. Hunting World* case.<sup>4</sup> Usually, the more arbitrary and fanciful a trademark is, the easier it is to obtain trademark protection. The more descriptive and generic a trademark is, the less likely it is to obtain protection. Arbitrary trademarks are common words used in an unrelated context to the subject they are identifying (e.g., Apple for electronic devices). Fanciful trademarks are inherently distinctive words that are used to identify the products (e.g., Kodak for cameras). Airbus is an example of a suggestive trademark for airplanes, indicating the nature, quality, or a characteristic of the goods. Marks that are descriptive usually describe the ingredients or attributes of a product, and therefore should not be able to function as a trademark (e.g., cold, and creamy for

<sup>3</sup> Mansfield, W. (2015). Genericization: Friend or Foe? from <<http://www.globaltrademag.com/global-trade-daily/commentary/genericization-friend-or-foe>> accessed 20 May 2020.

<sup>4</sup> *Abercrombie & Fitch Co. v. Hunting World* 537 F.2d 4 (2nd Cir. 1976)

ice-cream). Generic trademarks are used to identify a whole product category, which makes them incapable of functioning as a trademark (e.g., watch for timepieces). However, in the Abercrombie & Fitch case they argued that descriptive words can obtain trademark protection provided that a well-defined secondary meaning has been developed that is tied to a particular company and that is not related to its generic usage. An example of this is the Trademark SHARP for televisions (Trademark Strength, 2014).<sup>5</sup>

Companies can appeal a negative decision from the trademark office and provide their reasoning on why their mark should obtain trademark protection. Trademark applications often get refused on absolute grounds, by being too descriptive for example, and are therefore not be able to obtain trademark protection. Trademarks can also become descriptive over time when the public starts using the term as the descriptor for the product category (e.g., using Kleenex® for the product category tissue). At this point, the Trademark is subject to cancellation. This is also true for words that have a meaning in a foreign language. Though largely meaningless to the public, a descriptive word in a foreign language cannot normally obtain protection since the word or device holds a real meaning (Re Hercules Powder Co., 46 App. D.C. 52). On these grounds, some trademarks have been denied registration. The New York Supreme Court held *Conserva Di Tomate* descriptive, since it is Italian for preserved tomatoes (*Roncoroni v. Gross*, 92 App. Div. 221, 86 N.Y.S. 1112).

## DOCTRINE OF DILUTION AND TRADEMARK LAW IN INDIA

In India well-known trademarks have been accorded extraordinary proprietary rights against registration of identical or deceptively similar marks as well as against their misuse. This special protection accorded to well-known trademarks is a consequence of precedents and pronouncements that have been judiciously evolved by the Courts in India. Here it would be relevant to mention that statutory protection was accorded to well-known marks in India only in the year 1999. Prior to that well-known marks were protected under the common law principles of passing off. The Indian Trademark Registry's website provides a comprehensive list of well-known trademarks in India like Google, Kit Kat, AMUL etc. At present the list has 81 trademarks declared as well-known by judicial and quasi-judicial authorities in India. The list can be accessed here.

Trademarks are an important tool and protect both the consumer and the producer in a market-based competition economy. They provide consumers a way of ascertaining the producer, reduces search costs and of ensuring an expected quality. The producer or manufacturer is

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<sup>5</sup> 'Trademark Strength' (Inta.org, 2020)

<<http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkStrengthFactSheet.aspx>> accessed 2 June 2020.

assured of the fact that others cannot use his reputation and earned respect by passing off their products under his name.

### **The Trademarks Act, 1999**

The Trademarks Act, 1999 is a very important statute relating to trademark law in India. A lot of the judicial precedents in the country are based on an interpretation of its provisions. If scrutinized, we find that the statute gives us plenty of clues, but no clear stance, on the issue of the genericization of trademarks.

Section 94 of the Act lays down the various grounds for the refusal of registration of a trademark. Sub-clause (b) and (c) of sub-section 1 are particularly important, laying down that trademarks,

*(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;*

*(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered.*

### **Judicial Precedent and Principles**

#### **(i) *Heinz Italia and Anr. v. Dabur India Ltd.*<sup>6</sup>**

#### **Facts & Contentions**

In this case, the plaintiffs (Heinz Italia) claimed infringement of their Trademark on Glucon-D by the defendants (Dabur). The defendants had come up with a product called Glucose-D, with deceptively similar packaging.

The contentions that are relevant to us here are firstly, the defendant's claim that the Trademark could not be protected, being generic in nature. The second contention was, simply put, of passing off and trademark infringement.

#### **Principles and Judgment**

With regard to the question of genericness, the court noted that the term glucose was undoubtedly a word of common parlance and would fall under the definition of a generic word.

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<sup>6</sup> Heinz Italia and Anr. v. Dabur India Ltd. (2007) 6 SCC 1.

But the test as to having a trademark over it nevertheless would depend upon its having derived a secondary meaning, by which it has come to denote more than just the species of product, but the source, or manufacturer of the same. The judge cited the *Godfrey Philips India case*<sup>7</sup> to show that even a generic word could be the basis for an injunction, in special circumstances.

So, the court essentially disregarded the question as to the genericness of the product to look at the principle behind the law, and decided that intentional misrepresentation made to injure the business or goodwill of a person, and calculated to deceive, is all that matters. So, in a passing-off action if the plaintiff has established his reputation and the defendant's product is like be capable of confusing the purchasing public, an injunction would follow.<sup>8</sup>

### **(ii) *Shell Brands International v. Pradeep Jain***<sup>9</sup>

#### **Facts**

The plaintiffs, Shell India, were involved in the production and distribution of oil and oil related products, having established themselves in India in 1946. They use a trademarked shell, as their logo. The defendants in the instant case are involved in the exporting of bedsheets, quilts and pillow covers in various specifications; apparently being a proprietary concern. They do not, however, deal with oil products of any kind.

#### **Principles and Judgment**

There was essentially a question of importance in this case: -

#### **Whether the word Shell was a generic word and if so to what effect?**

The court observed that the purpose of trademarks was to identify the source of the product. Marks, they said, are of four varieties: -

- i) Descriptive
- ii) Geographical
- iii) Generic
- iv) Arbitrary

A mark is arbitrary, if it has no relation with the goods and services it represents, almost fanciful, so to say. Geographical marks are named after geographical markers, and descriptive marks are used to describe the product (but such description should not amount to the common name used

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<sup>7</sup> Godfrey Philips India Ltd. v. Girnar Food & Beverages (P) Ltd. 69 (1997) DLT 8.

<sup>8</sup> Id.

<sup>9</sup> Shell Brands International v. Pradeep Jain. CS (OS) 639/2008, decided on 01.02.2010.

for the class of products). A generic word needs no explanation; it is a term used in common parlance.

Now, the plaintiffs, of course, contended that the trademark Shell was arbitrary, having no relation whatsoever to the products of the plaintiff. They contended that, in relation to petroleum products, it can be safely said that the mark has acquired a secondary significance, as to identify itself with the plaintiffs. Upholding the same, the court observed that *shell* is a common word, signifying many things. They said that though shell was not a descriptive word in relation to the goods and services offered by the plaintiff, it is a common word. They held that *there is no genericness of shell, in relation to petroleum products. However, it is also undoubtedly a common dictionary word.*<sup>10</sup>

### **PROTECTION OF WELL-KNOWN TRADEMARKS PRIOR TO THE ACT OF 1999**

As mentioned above, the Indian Legislature extended extraordinary protection to well-known marks only in the year 1999 and prior to that such marks were protected under the common law principles of passing off.

One of the remarkable cases, in which well-known mark was protected under the common law principles of passing off, is the case of *Daimler Benz Aktiengesellschaft & Anr v. Hybo Hindustan*<sup>11</sup>. In the case, the Plaintiff, manufacturer of Mercedes Benz cars, alleged Defendant of using its mark BENZ for selling its undergarments. The Court restrained the Defendant from using the impugned mark and stated that there's no valid reason as to why any trader in India should adopt the name Benz, which is associated with one of the finest engineered cars in the world, and use the same name with respect to ordinary goods, in this case undergarments, particularly underwear.

Spill-over reputation of the mark- The Court in the case recognized worldwide reputation of the mark BENZ and further opined that Benz as name of Car would be known to every family that has ever used a quality car. The name Benz as applied to a car, has a unique place in the world. There is hardly one who is conscious of existence of the cars/automobiles, who would not recognize the name Benz used in connection with cars. Nobody can plead in India, where Mercedes Benz cars are seen on roads, where Mercedes have collaborated with TATAs, where there are Mercedes Benz Tata trucks have been on roads in very large number, who can plead that he is unaware of the word Benz as used with reference to car or trucks.

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<sup>10</sup> Id.

<sup>11</sup> Daimler Benz Aktiengesellschaft & Anr v. Hybo Hindustan. AIR 1994 Del 239

Similarly, in the landmark case of *Whirlpool Co. & Anr. v. N.R. Dongre*<sup>12</sup>, the Court based on transborder reputation enjoined the Defendants from using the mark Whirlpool for their products (washing machines). At the time of the suit, the plaintiff had a worldwide reputation and used to sell their machines in the US embassy in India and advertised in a number of international magazines having circulation in India.

### **TRANSBORDER REPUTATION OF A TRADEMARK**

The Act under Section 11(9) recognizes the concept of transborder or spill over reputation of a trademark. It provides that for determining whether a mark is well-known or not, it is not necessary that the Trademark must have been used in India<sup>13</sup> and that the mark is well-known to the public at large in India.<sup>14</sup>

However, as mentioned earlier, even prior to incorporation of Section 11(9) in the Act of 1999, the Supreme Court in *N.R. Dongre v. Whirlpool Corporation*<sup>15</sup> recognized the concept of cross-border reputation when it upheld the decision of the Division Bench Delhi High Court which granted a temporary injunction in favour of a plaintiff based abroad. At the time of the suit, the plaintiff had a worldwide reputation and used to sell their machines only in the US embassy in India and advertised in a number of international magazines having circulation in India.

Similarly, in the case of *Apple Computer Inc. v. Apple Leasing & Industries*<sup>16</sup>, the Division Bench of Delhi High Court held that it was not necessary to insist that a particular plaintiff must carry on business in a jurisdiction before improper use of its name or mark can be restrained by the Court.

### **PROTECTION OF WELL-KNOWN MARK ACROSS ALL CLASSES**

Section 11(2) of the Trademark Act extends protection to well-known marks across all classes. It implies that if AMUL is a well-known mark in respect of dairy-based products, the said mark cannot be used or registered even in respect of electronic items. Relevant extract of Section 11(2) is reproduced below:

“A trademark which-

(a) is identical with or similar to an earlier trademark; and

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<sup>12</sup> *Whirlpool Co. & Anr. v. N.R. Dongre* (1996) PTC 415 (Del)

<sup>13</sup> Section 11(9)(i)

<sup>14</sup> Section 11(9)(v)

<sup>15</sup> *N.R. Dongre v. Whirlpool Corporation* 1996 PTC (16)

<sup>16</sup> *Apple Computer Inc. v. Apple Leasing & Industries* 1992 (1) ALR 93

(b) is to be registered for goods or services which are not similar to those for which the earlier trademark is registered in the name of a different proprietor, shall not be registered if or to the extent, the earlier trademark is a well-known mark in India and use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trademark.”

Extending Protection to well-known marks across all classes- The legal proposition of extending protection to well-known marks across all classes has also been recognized by the Judiciary in plethora of judgments. For instance, in the case of *Kirloskar Diesel Recon Pvt. Ltd. vs Kirloskar Proprietary Ltd.*<sup>17</sup>, the Court while extending protection to the mark Kirloskar stated that in case of trading name which has become almost a household word and under which trading name a variety of activities are undertaken, a passing off can successfully lie if the defendant has adopted identical or similar trading name and even when the defendant does not carry on similar activity. Even if the defendant’s activities in such circumstances, are remote, the same are likely to be presumed a possible extension of plaintiff’s business or activities. In the instant case, the Respondents have established that word Kirloskar has become a household word and their businesses cover variety of activities and that there is even a common connection with some activities of the Respondents and activities of the Appellants.

### **FILING OF TRADEMARK AS A WELL-KNOWN TRADEMARK**

On 6<sup>th</sup> March 2017, DIPP (Department of Industrial Policy and Promotion) notified the circular issuing newly formulated Trademark Rules, 2017. The Rules incorporated several newly added provisions inter alia including the Rule that a trademark now can be filed as a well-known trademark i.e. the applicant at the time of making application request for determination of a mark as a well-known mark accompanied by a statement of case along with evidence and documents and prescribed fee of Rs. 1,00,000.<sup>18</sup>

Guidelines for filing a mark as well-known– “Pursuant to the aforesaid, the Indian Trademark Registry also published guidelines to be followed while filing an application for a well-known mark in India. The guidelines mention that such an application shall be filed only through comprehensive e-filing system of trademarks. As per the guidelines, the applicant shall file a statement of case and evidence claiming that the mark is a well-known trademark. While filing a well-known trademark an applicant shall provide as under:

- Statement of case and evidence stating that the Trademark is well-known mark;
- Details of successful enforcement of rights (if any);

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<sup>17</sup> Kirloskar Diesel Recon Pvt. Ltd. vs Kirloskar Proprietary Ltd. AIR 1996 Bom 149

<sup>18</sup> Rule 124 of Trademark Rules, 2017



- Copy of any judgment of any Court in India, where the Trademark has been held to be well-known.
- The guidelines can be accessed here.”<sup>19</sup>

## **WELL-KNOWN TRADEMARKS AND DOCTRINE OF DILUTION**

The Act does not specifically describe the definition of Trademark dilution; but, its meaning can be found in Section 29(4)(c) of the Trademarks Act, 1999 which “provides that a registered trademark is infringed by a person who not being a registered proprietor or person using by way of permitted use, uses in the course of trade, a registered mark which has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark.”<sup>20</sup>

The Doctrine of Dilution was analyzed by the Delhi High Court in the case of *Tata Sons Ltd. vs Manoj Dodia & Ors.*<sup>21</sup>. In the case the Court stated that the Doctrine of Dilution which has recently gained momentous, particularly in respect of well-known trademarks emphasizes that use of a well-known mark even in respect of goods or services, which are not similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well-known Trademark enjoys by reducing or diluting the Trademark’s power to indicate the source of goods or services.

### **When does Trademark Dilution Occur?**

Dilution of a well-known mark occurs when a well-known trademark loses its ability to be uniquely and distinctively identified and consequent change in perception which reduces the market value or selling power of the product bearing the well-known mark.

Dilution may also occur when the well-known Trademark is used in respect of goods or services of inferior quality. If a brand which is well known for the quality of the products sold or services rendered under that name or a mark similar to that mark is used in respect of the products which are not of the quality which the consumer expects in respect of the products sold or services provided using that mark, that may evoke uncharitable thoughts in the mind of the consumer about the trademark owner’s product and he can no more be confident that the product being sold

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<sup>19</sup> Guidelines for filing a mark as well-known at <[http://www.ipindia.nic.in/writereaddata/Portal/News/333\\_1\\_Well-known\\_public-Notice.pdf](http://www.ipindia.nic.in/writereaddata/Portal/News/333_1_Well-known_public-Notice.pdf)> accessed 18 May 2020.

<sup>20</sup> Section 29(4)(c) of the Trademarks Act, 1999, <<https://indiankanoon.org/doc/774878/>> accessed 12 May 2020.

<sup>21</sup> *Tata Sons Ltd. vs Manoj Dodia & Ors.* CS(OS) No. 264/2008

or the service being rendered under that well-known brand will prove to be of expected standard or quality.<sup>22</sup>

In the case of *Kamal Trading Co. vs. Gillette UK Limited*<sup>23</sup>, injunction was sought against the Defendants who were using the mark 7'O Clock on their toothbrushes. The Bombay High Court held that the plaintiff had acquired an extensive reputation in all over the world including India by using the mark 7'O Clock on razors, shaving creams and the use of an identical mark by the defendant would lead to the customer being deceived.

### **PUNITIVE DAMAGES ON INFRINGEMENT OF WELL-KNOWN MARKS**

The Judiciary has in several cases has propounded that awarding punitive damages to the owner of well-known mark would deter trademark infringers from causing dilution of well-known trademarks. For instance, in the Tata case, the Court awarded punitive damages of Rs.2 lacs to the Plaintiff and observed that most of the products sold by these companies are branded products, the marks on them having transborder reputation and enjoying tremendous brand equity. It is, therefore, becoming increasingly necessary to curb such trademark piracies lest they drive away the huge foreign investment our country is attracting. The Court should not give premium to dishonesty and unfair practices by those who have no compunctions in blatantly using the Trademark of others for making unearned profits. Our country is now almost in the league of advanced countries. More and more foreign companies are entering our markets, with latest products. They would be discouraged to enter our country to introduce newer products and make substantial investments here, if the Courts do not grant adequate protection to their intellectual property rights such as patents, trademarks and copyright.

Similarly, in the case of *Kabushiki Kaisha Toshiba Trading v. Mr. S.K. Sil & Anr.*<sup>24</sup>, the Delhi High Court while awarding punitive damages of Rs. 5 lacs to the Plaintiff stated that that the intention behind awarding punitive damages is to deter those who may be waiting in the wings and may be tempted to imitate the trade mark of others, in case those who are sued before the Courts are not made to pay such damages as would really pinch them. Awarding token damages may, therefore, not serve the desired purpose.

Other cases wherein the Courts have adequately compensated the Plaintiff for infringement of their well-known marks are *Time Incorporated vs. Lokesh Srivastava & Anr.*<sup>25</sup>, wherein the Court awarded the Plaintiff punitive damages of Rs. 5 lakhs in addition to compensatory damages also of Rs. 5 lakhs and stated that Courts in cases of IP infringement shall grant

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<sup>22</sup> Tata Sons case (*ibid*)

<sup>23</sup> Kamal Trading Co. vs. Gillette UK Limited 1998 IPLR 135

<sup>24</sup> Kabushiki Kaisha Toshiba Trading v. Mr. S.K. Sil & Anr. CS(OS) No.1298/2010

<sup>25</sup> Time Incorporated vs. Lokesh Srivastava & Anr. 2005 (30) PTC 3 (Del.)

compensatory as well as punitive damages. Similarly, in the case of *Microsoft Corporation & Anr. vs Kurapati Venkata Jagdeesh Babu*<sup>26</sup>, the Delhi High Court awarded the Plaintiff compensatory as well as exemplary damages.

## **VULNERABILITY OF WELL-KNOWN TRADEMARK IN CYBER AGE**

The susceptibility of a well-known mark to be infringed has augmented in the internet world leading to diminishing of boundaries and universal access to trademarks and brands. In the Kabushiki Kaisha Toshiba case, the Court took account of the rapidly expanding cyberspace and stated that on account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising, publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy transborder reputation. It is, therefore, being increasingly felt that such Trademark needs to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well-known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well.

In the Rolex case, the Court opined that over the years and very quickly in recent times, the international boundaries are disappearing. With the advent of the internet in the last over ten years it cannot now be said that a trademark which is very well known elsewhere would not be well known here. The test of a well-known trademark in Section 2(zg) is qua the segment of the public which uses such goods.

## **THE LEGAL BACKDROP**

### **Lanham Act and the Genericide Doctrine**

A trademark term falls into one of five basic classifications. These classifications act as a sliding scale, which courts use to determine the amount of protection a trademark is given. At one end of this scale, fanciful or arbitrary marks are the strongest type of trademarks and, thus, receive the most protection under both the common law and the Lanham Act.<sup>27</sup> Fanciful marks, such as *Google and Xerox*, are usually words invented solely for the purpose of being used as

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<sup>26</sup> Microsoft Corporation & Anr. vs Kurapati Venkata Jagdeesh Babu CS(OS) 2163/2010 & I.A. No.14225/2010

<sup>27</sup> 'Lanham (Trademark) Act' ([www.nolo.com](http://www.nolo.com), 2020) <[https://www.nolo.com/legal-encyclopedia/content/lanham-act.html#:~:text=The%20Lanham%20Act%20\(also%20known,effect%20on%20July%205%2C%201947.>](https://www.nolo.com/legal-encyclopedia/content/lanham-act.html#:~:text=The%20Lanham%20Act%20(also%20known,effect%20on%20July%205%2C%201947.>) accessed 19 May 2020).

trademarks; therefore, they have no connection to common words used prior to their invention.<sup>28</sup>

Genericide refers to *the process by which a mark that was once highly valuable and unquestionably protectable loses all trademark status and value*. To determine whether a trademark is susceptible to genericide, courts use the primary significance test codified in the Act and articulated by the Supreme Court in *Kellogg Co. v. Nat'l Biscuit Co.*<sup>29</sup> In *Kellogg Co.*, the Supreme Court held that a company could not claim trademark protection for the term *shredded wheat* merely because it had a secondary meaning that was associated with its particular product. Rather, the company had to show that *the primary significance of the term in the minds of the consuming public [was] not the product but the producer.*<sup>30</sup>

### Verbing and its Effect on Trademark Law

Modern English speakers are certainly familiar with nominalizations of verbs, as the English language is full of words that were once verbs and have become nouns.<sup>31</sup> Traditional nominalizations, such as the words *acceleration* and *intimidation*, have obvious roots in their verb counterparts, but English speakers have recently become even more transparent in their use of nominalizations by foregoing the alteration of the verbs and, instead, using their verb form as nouns. *Hey, I like your build*, is an example of the latter.<sup>32</sup>

### ELLIOT V. GOOGLE, INC.: THE NINTH CIRCUIT UPHOLDS GOOGLE'S TRADEMARK

In early 2012, Chris Gillespie, a man who is now famous for challenging Google's mark, registered 763 domain names that included the word *google* with another specific brand, person, or product to create domain names such as *googlebarackobama.net* and *googledisney.com*. Although Gillespie claimed that he registered the domain names as part of an academic experiment to test a computer program he was developing to prevent cyber piracy, Google filed a complaint under the Uniform Domain Name Dispute Resolution Policy. The company argued that Gillespie's use of its Trademark amounted to cybersquatting, which is the act of *registering, selling, or using a domain name with the intent of profiting from the goodwill of someone else's trademark.*<sup>33</sup>

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<sup>28</sup> Id. at 1807

<sup>29</sup> Rierson, *supra* note 28, at 702–03; see also *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938).

<sup>30</sup> *Kellogg Co.*, 305 U.S. at 118

<sup>31</sup> Henry Hitchings, 'Those Irritating Verbs-As-Nouns' (*Opinionator*, 2020)

<<https://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/>> accessed 21 May 2020.

<sup>32</sup> Id.

<sup>33</sup> 'Cybersquatting: What It Is and What Can Be Done About It' (*www.nolo.com*, 2020)

<<https://www.nolo.com/legal-encyclopedia/cybersquatting-what-what-can-be-29778.html>> accessed 26 May 2020.

Gillespie claimed he chose the term *google* as a common denominator in all the domain names because *google* was ***both a generic term and a very highly searched term***. Google argued, and NAF agreed, that the domain names were confusingly like Google's Trademark and that Gillespie had registered them in bad faith.<sup>34</sup>

Soon thereafter, David Elliot, a third-party beneficiary of Gillespie, filed a petition in an Arizona district court, seeking to cancel Google's Trademark under the Lanham Act, which Gillespie later joined.<sup>35</sup> The petition argued that *google* had become synonymous with the act of searching on the internet and, thus, qualified for cancellation under the Act because it was generic.<sup>36</sup>

First, the Court held that Elliot's criticisms of the district court's framing of the inquiry were unfounded because ***the district court properly recognized the necessary and inherent link between a claim of genericide and a particular type of good or service***. To support this conclusion, the Court pointed to the language of the Lanham Act that allows a party to request cancellation of a trademark ***when it becomes the generic name for the goods or services . . . for which it is registered***. The Court did not address its reasons for believing why *google* must generically refer to search engines rather than the act of conducting searches through a search engine as Elliot suggested. Its reasoning, however, appeared to be grounded in the district court's determination that the contested Google trademarks dealt specifically with Google's search engine rather than the act of searching things on the internet.<sup>37</sup>

Second, the Court chose not to focus on the traditional advice regarding the grammatical use of trademarks when determining whether Google's mark was generic. Instead, it held that Elliot's argument that trademarks can only be valid when used as an adjective to be a ***semantic argument [that] contradict[ed] fundamental principles underlying the protectability of trademarks***. In doing so, the Court pointed to the legislative intent behind the Lanham Act, in which Congress specifically acknowledged that a person could use a trademark as a product, i.e. as a noun, while still keeping the source of that product in mind.<sup>38</sup>

The Court also pointed to its prior decision in ***Coca-Cola v. Overland, Inc.***<sup>39</sup> to support its conclusion, where the Ninth Circuit held that ***Coke*** was not a generic term. In *Overland*, the Ninth Circuit held that the use of *Coke* as a general term for soda did not prove the Trademark's genericness because it failed to prove that the customers did not think of Coca-Cola as the source of the soda.

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<sup>34</sup> Elliot, 860 F.3d at 1154.

<sup>35</sup> 15 U.S.C. § 1051 (2012)

<sup>36</sup> Elliot, 860 F.3d at 1154–55.

<sup>37</sup> Elliot, 860 F.3d at 1157 (referencing Elliot, 45 F. Supp. 3d at 1159).

<sup>38</sup> Id at 1157. 123 I

<sup>39</sup> *Coca-Cola v. Overland, Inc.*, 692 F.2d 1250, 1255 (9th Cir. 1982).

The Court held that in the same way a purchaser might use the noun *Coke* in an indiscriminate way to refer to soda in general, without subjecting Coca-Cola's Trademark to genericide, so too could an internet user use the term *google* as an indiscriminate verb without Google losing its Trademark for such use.<sup>40</sup>

The Court noted that focusing on whether the mark had come to represent the product itself, in this case search engines, was a requirement ***necessary to maintain the viability of arbitrary marks as a protectable trademark category***. It also emphasized that if Elliot's theory that verb use alone could cause genericide was correct, there would be no need to inquire into the consumer's inner thought process.<sup>41</sup> Not doing so would contradict the purpose of applying the primary significance test. In making this distinction, the Court upheld a trademark that obviously retains its trademark significance and gave popular trademark owners a reason to breathe a little easier while still managing to uphold the goals of trademark law.

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<sup>40</sup> Coca-Cola, 692 F.2d at 1255 United States Court of Appeals

<sup>41</sup> Id. at 1158