

SJ Quinney College of Law, University of Utah Utah Law Digital Commons

Utah Law Faculty Scholarship

Utah Law Scholarship

6-2019

Sui-Genericide

Jorge L. Contreras

S.J. Quinney College of Law, University of Utah, jorge.contreras@law.utah.edu

Follow this and additional works at: <https://dc.law.utah.edu/scholarship>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Contreras, Jorge L., "Sui-Genericide" (2019). *Utah Law Faculty Scholarship*. 161.
<https://dc.law.utah.edu/scholarship/161>

This Article is brought to you for free and open access by the Utah Law Scholarship at Utah Law Digital Commons. It has been accepted for inclusion in Utah Law Faculty Scholarship by an authorized administrator of Utah Law Digital Commons. For more information, please contact valeri.craigle@law.utah.edu.

SUI-GENERICIDE

Jorge L. Contreras¹

Working Draft May 21, 2019

ABSTRACT

Generic terms – those that describe a general class of goods or services -- are not eligible for trademark protection. Firms have historically gone to great lengths to prevent their trademarks from becoming generic – a fate often referred to as genericide. But in a few rare cases, firms have voluntarily declared certain terms that they have created to be generic, a phenomenon that I refer to as “sui-genericide”. This article explores the little-discussed phenomenon of sui-genericide, both its origins in government-sponsored programs of the mid-twentieth century and its most recent incarnation in the area of technical interoperability standards. Though the voluntary relinquishment of the exclusive rights conferred by patents and copyrights has been studied extensively in the literature, there has been comparatively little scholarly attention to such mechanisms under trademark law. This article examines the potential effects of sui-genericide on producer incentives, follow-on innovation and consumer welfare and considers some of the ramifications of incorporating a sui-genericide doctrine into the law. It concludes by recommending potential measures to enhance the legal recognition of declarations of sui-genericide. These include official consideration during trademark prosecution of “consensus” lists of common terms that are developed by broadly-representative industry groups and the creation of a presumption of genericness for terms that appear on such lists, together with international harmonization of this recognition.

¹ J.D. (Harvard Law School), B.S.E.E., B.A. (Rice University). Professor of Law, University of Utah S.J. Quinney College of Law. This research was made possible in part through generous support from the Albert and Elaine Borchard Fund for Faculty Excellence. The author thanks Filipe Acosta, Brad Biddle, Bob Brauneis, Maggie Chon, Christine Farley, Katrina Hull, Yvette Liebesman, Jake Linford, Glynn Lunney, Guido Martinelli, Lisa Ramsey and Jeffrey Van Hoosear for their valuable feedback and comments on this paper. This paper has benefitted from feedback and discussion at the 2019 INTA Trademark Scholarship Symposium in Boston, Massachusetts, and the 7th Annual Trademark Works in Progress Colloquium at American University Washington College of Law (Sept. 2018). Research assistance by Brian Flach and Luke Hanks is greatly appreciated.

CONTENTS

Introduction

- I. Genericism and Genericide Today
 - A. Genericism Defined
 - B. Challenging Marks as Generic
 - C. Genericide Counter-Measures
 - D. The Economics of Genericide
- II. The History of Sui-Genericide
 - A. The Department of Commerce Generic Word Program – A Genericide Wish List
 - B. Generic Drug Names
 - C. Pesticide Common Names
 - D. Synthetic Textile Fibers
 - E. Recent Governmental Engagement with Sui-Genericide
 - F. Technical Standards
 - 1. Trademarks and Technical Standards
 - 2. Standards and Certification
 - 3. Acts of Sui-Genericide: USB and W3C
- III. Understanding Sui-Genericide
 - A. Market Rationales for Sui-Genericide
 - B. Doctrinal Effects of Sui-Genericide
 - C. Certification versus Genericide
 - D. Sui-Genericide versus Nominative Fair Use
- IV. Legal Frameworks for Sui-Genericide
 - A. Legal Effect of Unilateral Declarations
 - B. Non-recognition of Sui-Genericide in Trademark Proceedings
 - C. Reliance and Estoppel
 - D. Cancellation Proceedings
 - E. Toward Greater Legal Recognition of Sui-Genericide
 - 1. Consensus Lists in Trademark Examination
 - 2. A Presumption of Genericism
 - 3. Due Process in the Development of Consensus Lists
 - 4. Implementation: Legislation versus Regulation
 - 5. International Harmonization

Conclusion

INTRODUCTION

Intellectual property rights confer on their owners exclusive rights to exploit inventions, works of authorship and marks for specified periods of time. These rights, particularly when held by business entities, are often viewed as valuable assets, and significant resources are devoted to obtaining, securing and enforcing them against others. Yet prominent examples exist in which holders of valuable intellectual property voluntarily relinquish some or all of their exclusive rights to the public.² Such contributions may take the form of either outright gifts of the relevant IP rights to the public domain or of contractual or pseudo-contractual licenses or “pledges” by rights holders.

For centuries, the author of a copyrighted work has been permitted to make of his composition a “gift to the public”.³ Today, more formal mechanisms exist for dedicating copyrighted works to the public, including a standardized online tool offered by the non-profit Creative Commons.⁴ When a copyrighted work – a novel, a song, a photograph -- enters the public domain, it becomes free for all to use and modify without restriction.⁵

In the case of patents, there are various mechanisms by which inventors may intentionally abandon or dedicate their inventions to the public. Firms may release information via publication in order to prevent it from becoming the subject of patents.⁶ And an applicant

² The focus of this article is on the intentional relinquishment of IP rights. It is also the case that IP rights may be forfeited through involuntary mechanisms, either through the neglect or inattention of the owner, or in response to challenges by third parties. The effect of extinguishing such rights is similar, whether caused by voluntary or involuntary means.

³ *Miller v. Taylor*, [1769] 4 Burr 2303, 2345-46 (98 E.R. 201). *But see* Phillip Johnson, *Dedicating Copyright to the Public Domain*, 71 MODERN L. REV. 587, 595 (2008) (questioning precedential authority of this case).

⁴ Creative Commons, CC0 1.0 Universal (CC0 1.0) Public Domain Dedication (last visited Mar. 2, 2019), <https://creativecommons.org/publicdomain/zero/1.0/> [hereinafter CC0 Dedication].

⁵ *See Golan v. Holder*, 132 S.Ct. 873, 892 (“When a copyrighted work – a novel, a song, a photograph -- is dedicated to the public domain by its owner, it becomes free for all to use and modify without restriction.”)

⁶ *See, e.g.,* Jorge L. Contreras, *Bermuda’s Legacy: Patents, Policy and the Design of the Genome Commons*, 12 MINN. J.L., SCI. & TECH. 61 (2011) (placement of genetic data into public domain by pharmaceutical industry to avoid patenting by others); Oren Bar-Gill & Gideon Parchomovsky, *The Value of Giving Away Secrets*, 89 VA. L. REV. 1857, 1857 (2003) (“In growing numbers,

may deliberately abandon a patent application before it is fully prosecuted,⁷ after which the invention claimed in the application will become part of the public domain. Once abandoned, it cannot be patented by somebody else and will act as prior art defeating subsequent attempts to patent the disclosed invention and even new inventions that are obvious in view of that invention.⁸ The same is true when a patent expires, either at the end of its term or due to its owner's failure to pay maintenance fees.⁹ The inventions claimed by an expired patent can never again be claimed by another: they are forever part of the public domain.

Likewise, the phenomenon of pledging IP rights to the public has been observed and analyzed extensively in the literature.¹⁰ Notable examples include, under copyright law, open source software licensing,¹¹ the distribution of free content by online platforms,¹² and the dissemination of large amounts of user-developed content under Creative Commons licenses,¹³ and, under patent law, the pledging of patents to promote new technology

firms elect to forego patent protection, and choose instead to publish potentially patentable research findings”).

⁷ 37 C.F.R. § 1.138(a) (“An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office.”) Though under some circumstances, an inventor may revive a patent application after it has been abandoned. 35 U.S.C. 27.

⁸ See, e.g., *Vass v. Multi Med Indus.*, 204 USPQ 1071, 1073 (E.D. N.Y. 1979) (“Reference in [patent] 575 to the abandoned application 106 disclosed the claims to the public and became part of the body of prior art.”).

⁹ *Figueroa v. United States*, 466 F.3d 1023, 1027 (Fed. Cir. 2006), *cert. denied*, 550 U.S. 933 (2007) (“failure to pay required maintenance fees results in expiration of the patent, 35 U.S.C. § 41(b)”). See also 4 Chisum on Patents § 11.02.

¹⁰ See, e.g., Colleen V. Chien, *Opening the Patent System: Diffusionary Levers in Patent Law*, 89 S. CAL. L. REV. 793 (2016); Jorge L. Contreras, *Patent Pledges*, 47 ARIZ. ST. UNIV. L.J. 543 (2015); Abraham Bell & Gideon Parchomovsky, *The Evolution of Private and Open Access Property*, 10 THEORETICAL INQUIRIES IN L. 77 (2008); Robert P. Merges, *A New Dynamism in the Public Domain*, 17 U. CHI. L. REV. 183 (2004).

¹¹ See YOCHAI BENKLER, *THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM* (2006) (discussing open source code); Merges, *supra* note 10, at 186 (discussing IBM's Linux strategy).

¹² See Jonathan Barnett, *The Costs of Free: Commodification, Bundling and Concentration*, USC Gould Center for Law and Social Science Research Papers Series No CLASS17-9 (2017) (describing rise of free content on online platforms).

¹³ See, e.g., Lawrence Lessig, *The Creative Commons*, 55 FLORIDA L. REV. 763 (2003).

platforms,¹⁴ interoperability standards,¹⁵ and social causes,¹⁶ and to preempt the appropriation of rights by others.¹⁷ When such pledges are legally enforceable and irrevocable, they act as partial relinquishments of rights to the public.¹⁸

Trademarks, like other forms of intellectual property, can have substantial value. As noted by Professor Barton Beebe, marks like APPLE, GOOGLE, SAMSUNG, TOYOTA, MCDONALDS, STARBUCKS, NIKE, COKE, and PEPSI are “instantly recognizable by a very large proportion of humanity, [and] are among the most valuable and influential signs in the world, rivalling in significance many religious and national symbols.”¹⁹

Yet, with a few exceptions, little scholarly attention has been paid to expanding the public domain under trademark law. These exceptions include a strain of literature addressing the development of naming systems *outside* the boundaries of conventional trademark protection (e.g., the fanciful pseudonyms used by roller derby participants),²⁰ and recent work by Professors Daniel Hemel and Lisa Ouellette that considers both doctrinal and technological measures that have the potential to expand the stockpile of words and symbols available for use in identifying goods and services – the “semantic commons”.²¹ And, of course, a host of scholars over the years have critiqued the breadth of various protective doctrines

¹⁴ See Chien, *Levers*, *supra* note 10; Contreras, *Patent Pledges*, *supra* note 10.

¹⁵ See Contreras, *Patent Pledges*, *supra* note 10.

¹⁶ See Jorge L. Contreras, Bronwyn H. Hall & Christian Helmers, *Pledging Patents for the Public Good* (assessment of prominent green technology pledge); Contreras, *Patent Pledges*, *supra* note 10 (identification of pledges made for philanthropic reasons).

¹⁷ Contreras, *Bermuda’s Legacy*, *supra* note 6, at x (placement of genetic data into public domain by pharmaceutical industry to avoid appropriation by biotechnology firms); Merges, *supra* note 10, at 186 (IBM’s Linux strategy as a response to Microsoft).

¹⁸ See Jorge L. Contreras, *A Market Reliance Theory for FRAND Commitments and Other Patent Pledges*, 2015 UTAH L. REV. 479, x (2015).

¹⁹ BARTON BEEBE, *TRADEMARK LAW: AN OPEN SOURCE CASEBOOK*, Intro. at 2 (4th ed. 2017).

²⁰ See David Fagundes, *Labor and/as Love: Roller Derby as Constructed Cultural Commons*, in GOVERNING KNOWLEDGE COMMONS, Ch. 13 (Brett Frischmann, Michael Madison, Katherine Strandburg, eds., 2014).

²¹ Daniel J. Hemel & Lisa Larrimore Ouellette, *Governing the Semantic Commons* (working draft May 26, 2018, on file with author) (defining “semantic commons” as “the supply of words, sounds, and symbols that can be readily used to describe tangible and intangible items—and, in particular, to describe products, services, and their sources”). This effort responds in part to empirical work showing that the available store of common English words is running out. Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945 (2018).

under trademark law, arguing that they should be narrowed in one way or another.²² However, none of this work tackles head-on the question whether and how trademarks might be contributed by their owners to build a common pool of resources, nor whether such a commons is even desirable.

One of the impediments to this line of reasoning may be inherent limitations imposed by trademark law itself. Unlike patent and copyright law, which offer mechanisms by which inventions and works of authorship may be dedicated to the public domain, trademark law offers no explicit mechanism by which mark owners may place a particular word, term or device into the public domain.

Though a trademark application may expressly be abandoned by the applicant, the effect of abandonment is not the same as it is for a patent application. When a trademark application seeking protection for a mark is abandoned, the mark may become the subject of a new application by anyone else who wishes to use the mark. The same principle applies when a registered trademark is not renewed,²³ a trademark is abandoned due to non-use²⁴ or a registration is otherwise canceled.²⁵ The expiration and cancelation of a mark do not prevent a subsequent claimant from appropriating the mark for itself. In fact, even while arguing for an explicit statutory regime to facilitate the dedication of patents and copyrights to the public domain, One scholar considers trademarks to be so different in kind from these other forms of IP that they are expressly excluded from his proposed statutory scheme to expand the public domain.²⁶

And trademarks may, indeed, be very different than patents and copyrights inasmuch as they bear even less resemblance to traditional forms of property than these other forms of intellectual property. Professor Adam Mossoff, in arguing that trademarks *should* be treated as use-based (usufructury) property rights, acknowledges the prevailing view that a trademark is considered “a

²² See, e.g., Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2005) (arguing for limitation of trademark rights to foster free speech); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 391-410 (1999) (criticizing trademark protection for trade dress); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1688 (1999) (critiquing as over-broad doctrines such as trademark dilution, trade dress protection, and anti-cybersquatting).

²³ cite

²⁴ See Lanham Act, § 45, 15 U.S.C. § 1127 (“A mark shall be deemed to be ‘abandoned’ (a) when its use has been discontinued with intent not to resume...”)

²⁵ cite

²⁶ Clark D. Asay, *A Case for the Public Domain*, 74 OHIO ST. L.J. 753, 799 (2013) (“Waiving trademark rights is inadvisable since doing so may result in significant consumer confusion.”)

regulatory entitlement whose function is to increase social welfare by reducing consumer search costs”.²⁷ If so, then it is easy to see why such an entitlement, when renounced by its “owner”, would not thereafter be made available to the general public any more than the social security check renounced by an individual recipient would be given to someone else requesting it.

Professor William Landes and Judge Richard Posner describe the potential effects of the differential treatment of abandonment observed between patents and copyrights, on one hand, and trademarks, on the other: “When property is abandoned, the law’s choice is between “depropertying” it, so that anyone can use it but no one can establish an exclusive right to its use, and allowing it to be reappropriated, which may make for more efficient use but may also incite rent seeking by competing would-be reappropriators.”²⁸ As discussed above, the abandonment of patents and copyrights falls into the former category, while the abandonment of trademarks falls into the later. Thus, there is no affirmative procedural mechanism that enables a trademark owner to contribute his or her mark to the public or to make it available for public use.

This being said, marks can and do lose their protected status under one particular set of circumstances: when they are found to be generic. Generic terms – those which lack distinctiveness and describe a generic class of goods or services – cannot be enforced as trademarks or registered by others.²⁹ A finding of genericness, however, cannot be initiated by a mark owner. It results either from the action of the trademark examiner during the prosecution process or the challenge of a third party either in an opposition or cancellation proceeding or litigation.³⁰

This article, for the first time, identifies and describes the practice of “sui-genericide”,³¹ whereby a private actor declares that

²⁷ Adam Mossoff, *Trademark as a Property Right*, 107 KY. L.J. __, 3 (2018). For critiques of Mossoff’s thesis, see, e.g., Bryan L. Frye, *Metaphors on Trademark: A Response to Adam Mossoff*, “Trademark as a Property Right”, 107 KY. L. J. ONLINE (2018); Camilla Alexandra Hrdy, *Adam Mossoff: Trademarks As Property*, WRITTEN DESCRIPTION Blog (Sept. 5, 2017, 9:52 PM), <https://writtendescripton.blogspot.com/2017/09/adam-mossoff-trademarks-as-property.html>.

²⁸ WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 28-29 (2003).

²⁹ See Part I, *infra*.

³⁰ See Part x, *infra*.

³¹ The term “sui-genericide” is derived from “genericide”, a challenge to a trademark on the basis that it is generic (see note 55, *infra*), and “sui”, a prefix derived from the Latin term meaning “of oneself”. See Online Etymology Dictionary, *suicide*, <https://www.etymonline.com/word/suicide> (visited Apr. 27,

a particular word or term is generic and thereby seeks to commit it to the public domain. Far from the fringe of commercial activity, this practice has existed for decades in areas such as pharmaceutical and pesticide common names, and more recently has emerged with respect to the names of pervasive interoperability standards such as HTML, XML and USB that are embodied in billions of products around the world.

The remainder of this article proceeds as follows: Part I reviews current U.S. law relating to trademark genericism, including its doctrinal and economic roots.³² Part II explores the phenomenon of sui-genericide – the intentional declaration that one’s own mark is generic – both in several historical contexts and more recently in the area of technical standards. Part III explores the rationales and explanations for sui-genericide, and Part IV poses the question how, and whether, sui-genericide, can be facilitated through existing and new legal mechanisms such as registries, presumptions and certifications.

I. GENERICISM AND GENERICIDE TODAY

A. *Genericism Defined*

The degree of distinctiveness exhibited by a trademark affects both its eligibility for registration and its enforceability. Distinctiveness is generally classified into four categories enumerated by the Second Circuit in *Abercrombie and Fitch Co. v.*

2019). The term also alludes to the Latin term *sui generis*, used frequently discussions of intellectual property to denote a new form of protection beyond existing statutory or common law forms (e.g., whether software should be protected by copyright, patent or a *sui generis* form of protection). *See Sui Generis*, The Law Dictionary, <https://thelawdictionary.org/sui-generis/> (“of its own kind or class”).

³² The focus of this article is on U.S. law. However, the trademark-limiting effect of genericism has been recognized in other jurisdictions including the European Union, as well as under the Paris Convention. *See* ECJ C-191/01, *EUIPO v Wm Wrigley Jr Co*; [2003] E.C.R. I-12447, para. 25 and 31 (exclusion of generic terms from trademark protection “serves the public interest of leaving terms free to be used by all traders and thereby prevents such terms from being reserved to one undertaking only”); Paris Convention for the Protection of Industrial Property, Art. 6.B (trademarks may not be denied registration or invalidated except when they are “devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed”).

*Hunting World, Inc.*³³ Under the *Abercrombie* framework, marks that are either *fanciful* (invented terms such as EXXON, TYLENOL and PRIUS) or *arbitrary* (common words applied in an unfamiliar manner, such as PUMA used for sporting gear) are the strongest and are viewed as inherently distinctive.³⁴ Marks that are *suggestive* (words that require “imagination, thought and perception to reach a conclusion as to the nature of goods”, such as “Microsoft” for computer software),³⁵ are also distinctive. However, words that are merely *descriptive* of the goods or services that they name, such as “App Store” for an online platform for distributing software applications, may not be registered without an additional showing of secondary meaning (i.e., that the mark has come to identify the source of the goods or services in the public eye).³⁶ And, finally, terms that are *generic*, connoting a general category to which a particular product belongs (e.g., car, savings bank, lawnmower) but which give no specific indication of the product’s source, are viewed as not being distinctive and receive no trademark protection whatsoever.³⁷ Though these rules may, at first glance, appear straightforward, the determination whether a particular term is generic or descriptive can be a difficult one.³⁸

As the Federal Circuit has explained,

A generic mark, being the ultimate in descriptiveness, cannot acquire distinctiveness. This is so because generic terms are by definition incapable of indicating source, and therefore are the antithesis of trademarks, and can never attain trademark status.³⁹

A common test applied by the courts to determine whether a mark is generic is whether the “primary significance of the registered mark to the relevant public is as the name for a particular type of good or service irrespective of its source.”⁴⁰ As further

³³ 537 F.2d 4 (2nd Cir. 1976). Other circuits have largely followed the *Abercrombie* framework. [cite McCarthy?]

³⁴ *Id.* at ¶12.

³⁵ *Id.* at ¶18.

³⁶ *See id.* at ¶6 and 15 U.S.C. § 1052(f).

³⁷ *Abercrombie*, 537 F.2d at ¶12. *See also* 15 U.S.C. 1064(c) (a federal registration is subject to cancellation if at any time it “becomes the common descriptive name of an article or substance.”)

³⁸ *See A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986) (“Courts and commentators have recognized the difficulties of distinguishing between suggestive, descriptive, and generic marks.”)

³⁹ *Royal Crown Co., Inc. v. The Coca-Cola Co.* *10 (Fed. Cir., Jun. 20, 2018).

⁴⁰ *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531 (7th Cir. 2003).

explained by the Third Circuit in *E.T. Browne Drug Co. v. Cococare Products, Inc.*,

[T]he primary significance test ... inquires whether the primary significance of a term in the minds of the consuming public is the product or the producer. We ask whether consumers think the term represents the generic name of the product [or service] or a mark indicating merely one source of that product [or service]. If the term refers to the product (i.e., the genus), the term is generic. If, on the other hand, it refers to one source or producer of that product, the term is not generic (i.e., it is descriptive, suggestive, or arbitrary or fanciful). To give an example, “Cola” is generic because it refers to a product, whereas “Pepsi Cola” is not generic because it refers to the producer.⁴¹

Or, put more simply by the Ninth Circuit in *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*,⁴² a distinctive mark answers the questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’⁴³

In addition, for a mark to be deemed generic, it must relate to the *particular* type of good or service for which the mark is registered. That is, even if a term has a generic meaning in some contexts, it may not be generic as to the particular good or service for which it acts as a mark. As noted by the Ninth Circuit in *Google*, this requirement is necessary “to maintain the viability of arbitrary marks as a protectable trademark category”.⁴⁴ That is, “[i]f there were no requirement that a claim of genericide relate to a particular type of good, then a mark like IVORY, which is arbitrary as applied to soap, could be cancelled outright because it is generic when used to describe a product made from the tusks of elephants.”⁴⁵

As a result, much depends on how an adjudicatory body interprets the relevant product or service genus to which the term is

⁴¹ 538 F.3d 185 (3d Cir. 2008) (internal citations omitted). *See also Abercrombie*, 537 F.2d at 9 (genericness “refers, or has come to be understood as referring, to the genus of which the particular product is a species.”)

⁴² 198 F.3d 1143, 1147 (9th Cir. 1999).

⁴³ *Id.* (citing *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1323, 1324 (9th Cir.1993)).

⁴⁴ *Google*, 860 F.3d at *9.

⁴⁵ *Id.* (citing *Abercrombie*, 537 F.2d at 4, 9 n.6 (internal quotation marks omitted)).

applied. In *Google*, the Ninth Circuit upheld the lower court’s ruling that the term GOOGLE was not generic. It reasoned that even if a majority of the public uses the verb “google” indiscriminately to refer to Internet *searching*, this does not mean that GOOGLE has become a generic term for Internet *search engines*.⁴⁶

In *In re Cordua Rests., Inc.*,⁴⁷ the Federal Circuit further complicated the analysis by holding that “a term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a *key aspect* of that genus.”⁴⁸ For example, “the term ‘pizzeria’ would be generic for restaurant services, even though the public does not understand the term to refer to the broad class of restaurants as a whole; the public need only understand that the term refers to ‘a particular sub-group or type of restaurant rather than to all restaurants.’”⁴⁹

Thus, in *Royal Crown v. The Coca Cola Co.*, the Trademark Trial and Appeal Board (TTAB) upheld The Coca Cola Company’s registration of the mark ZERO to describe its line of no-calorie soft drinks. Royal Crown brought an opposition challenging the mark, arguing, among other things, that the term ZERO was generic. In analyzing RC’s genericism challenge, the TTAB defined the relevant genus as “soft drinks, sports drinks, and energy drinks.”⁵⁰ The Federal Circuit reversed and remanded, holding that “The [TTAB] failed to consider whether the relevant consuming public would consider the term ZERO to be generic for a subcategory of the claimed genus of beverages—i.e., the subcategory of the claimed beverages encompassing the specialty beverage categories of drinks with few or no calories or few or no carbohydrates.”⁵¹

But even if certain terms are found to be generic, they may still form part of otherwise distinctive marks. For example, the mark DYNAMITE for a take-out TexMex restaurant chain is likely arbitrary under the *Abercrombie* framework (given the lack of any actual connection between explosives and TexMex food). Yet the term BURRITO for a TexMex restaurant is almost certainly generic. Thus, to avoid any implication that the owner of the DYNAMITE BURRITO

⁴⁶ *Id.* at *20 (noting that the challenger failed to prove that “there is no way to describe ‘internet search engines’ without calling them “googles” and further observing that “not a single competitor calls its search engine “a google,” and . . . members of the consuming public recognize and refer to different “internet search engines”).

⁴⁷ 823 F.3d 594 (Fed. Cir. 2016).

⁴⁸ *Id.* at 603.

⁴⁹ *Royal Crown*, at *12-13 (quoting *In re. Cordua*, 823 F.3d at 605).

⁵⁰ *Id.* at *11.

⁵¹ *Id.* at *13.

restaurant chain could claim rights in the word burrito itself, the PTO generally requires that generic terms included within registered marks be disclaimed as to standalone uses.⁵² Thus, the owner of DYNAMITE BURRITO would likely have an infringement claim against its competitor Dynamite Tacos, but not against Chihuahua Burrito.

B. Challenging Marks as Generic

A mark may be found to be generic in one of two principal ways: at the outset, when it is refused registration by the Patent and Trademark Office (PTO),⁵³ or after registration, when a once-distinctive mark is shown no longer to identify a source of goods and on that basis is canceled.⁵⁴ This latter circumstance is sometimes referred to as “genericide”.⁵⁵ There is a long list of U.S. trademarks that have been canceled due to genericide: ASPIRIN, BRASSIERE, E-TICKET, ESCALATOR, LINOLEUM, THERMOS, TRAMPOLINE and ZIPPER, to name just a few.⁵⁶

⁵² See U.S. PATENT & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.03(c) (Oct. 2018) [hereinafter TMEP] (“If a mark is comprised in part of matter that, as applied to the goods or services, is generic or does not function as a mark, the matter must be disclaimed to permit registration...”); Royal Crown Co., Inc. v. The Coca-Cola Co., slip op. at 3-4 (Fed. Cir., Jun. 20, 2018) (discussing disclaimer of term “ZERO” in beverage companies’ diet soda marks).

⁵³ See, e.g., BARTON BEEBE, TRADEMARK LAW: AN OPEN SOURCE CASEBOOK, Part I, p. 45 (4th ed. 2017) (listing numerous examples and cases); LYDIA PALLAS LOREN & JOSEPH SCOTT MILLER, INTELLECTUAL PROPERTY LAW: CASES AND MATERIALS 515 (5th ed., 2017)).

⁵⁴ Lanham Act, Sec. x.

⁵⁵ The term “genericide” was reportedly coined by the U.S. Trademark Association as a pejorative moniker designed to alert its members to the “danger” of genericism. See Walter P. Margulies, *How the F.T.C. Threatens Trademarks*, N.Y. TIMES, May 20, 1979. See also GLYNN LUNNEY, CASES AND MATERIALS ON TRADEMARK LAW 180 (2nd ed. 2015) (“Because of their antagonism towards the doctrine, trademark plaintiffs’ attorneys ... coined the term “genericide” to capture their sense that finding a trademark generic unfairly punishes successful trademark owners. By relabeling a court’s decision that a term is or has become generic as genericide, the trademark bar attempted to link findings that a claimed trademark is generic with homicide or genocide, and other “-cides” that are inherently wrong.”) Despite its partisan origins, the term “genericide” has now entered the trademark lexicon and is used generally to mean the loss of trademark rights through a finding of genericism. See, e.g., J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1 (4th ed. 1998); Beebe, *supra* note 53, at 45; LOREN & MILLER, *supra* note 53, at 515; JEROME GILSON & ANNE GILSON LALONDE, 1 GILSON ON TRADEMARKS § 2.02 (2017); Jacqueline Stern, *Genericide: Cancellation of a Registered Trademark*, 51 FORDHAM L. REV. 666 (1983); Sung In, *Death of a Trademark: Genericide in the Digital Age*, 21 REV. LITIG. 159 (2002); John Dwight Ingram, *The Genericide of Trademarks*, 2 BUFF. INTELL. PROP. L.J. 154 (2004).

⁵⁶ See, e.g., McCarthy, *supra* note 55, at x (listing numerous marks that have become generic); Ralph A. Folsom & Larry L. Teply, *Trademarked Generic*

The risk of genericide is highest for products that introduce a new technology to the marketplace, as consumers may quickly come to associate the product's brand with its functionality and begin to use the brand to describe the general class of products to which it belongs.⁵⁷ This risk is particularly pronounced for products that are patented, such that there is only one product/brand on the market during the period of patent exclusivity.⁵⁸ This is the “trap” into which Bayer fell with respect to its patented painkiller “aspirin”. As explained by Professor John Ingram, “during the life of the patent Bayer made no attempt to establish in the minds of the public some generic name for the product other than “aspirin.” In fact, they welcomed the public acceptance and use of “aspirin” as the name of the drug. By the time the patent expired, it was too late. “Aspirin” was generic.”⁵⁹

A registered mark may be challenged as generic via one of four procedural routes:

(1) The mark, once allowed by the PTO, will be published in the Official Gazette, following which any person “who believes that he or she would be damaged by the registration of [the] mark” may, within thirty days after publication, initiate an *inter partes* opposition proceeding at the Trademark Trial and Appeals Board (TTAB).⁶⁰ At the opposition proceeding, any ground for rejection of the mark may be raised including that the mark lacks distinctiveness due to genericism.

(2) Under Section 14(3) of the Lanham Act, any person who believes that he or she would be

Words, 89 YALE L.J. 1323, 1324 (1980); Beebe, *supra* note 53, at 45; Loren & Miller, *supra* note 53, at 515. Though genericism is typically discussed in terms of trademarks for products and services, certification marks may also be subject to genericide. *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497 (2d Cir. 1962) (“if an indication of regional origin, registered as a certification mark, becomes a generic term for a certain type of goods coming from any region, then the mark is subject to cancellation”).

⁵⁷ See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 295 (1987) (“a difficult problem of determining whether a trademark has become a generic name arises in cases ... in which the trademark owner initially has a product monopoly”).

⁵⁸ See Ingram, *supra* note 55, at 158-59.

⁵⁹ *Id.*

⁶⁰ 15 U.S.C. § 1063(a); 37 C.F.R. 2.101-107. See also GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY* (4th ed. 2014) (outlining opposition procedure).

damaged by the registration of a mark may petition to cancel a registration at any time “if the registered mark becomes the generic name for the goods or services”.⁶¹

(3) In private litigation, one party, usually as a defense to an allegation of infringement, may counterclaim that an asserted mark is invalid as generic.⁶²

(4) A public agency such as the U.S. Federal Trade Commission (FTC) may petition the PTO to cancel a trademark as generic.⁶³

⁶¹ 15 U.S.C. § 1064(3).

⁶² McCarthy

⁶³ 15 U.S.C. § 1064 (specifically authorizing FTC cancellation proceedings based on genericism). The history of the FTC’s exercise of its power under Section 14 of the Lanham Act is somewhat checkered. *See, generally*, John M. Fietkiewicz, *Section 14 of the Lanham Act--FTC Authority to Challenge Generic Trademarks*, 49 FORDHAM L. REV. 437 (1980). Its first two petitions for cancellation of marks were rejected for lack of standing. *FTC v. Elder Mfg. Co.*, 84 U.S.P.Q. (BNA) 429 (Comm’r Pat. 1950); *FTC v. Royal Mfg. Co.*, 84 U.S.P.Q. (BNA) 429 (Comm’r Pat. 1950). In 1958, 1960 and 1961, the FTC succeeded in canceling three registrations on the basis of abandonment and fraud. *FTC v. Service Seed Co.*, Cancellation No. 7478 (T.T.A.B., filed May 2, 1960); *FTC v. Danne*, Cancellation No. 7152 (Comm’r Pat., filed Aug. 5, 1958), *Bart Schwartz Int’l Textiles, Ltd. v. FTC*, 289 F.2d 665 (C.C.P.A. 1961). But it was not until 1978 that the FTC brought an action under Section 14 to cancel a mark on the basis of genericism. The mark in that case was FORMICA, owned by a subsidiary of American Cyanamid Corporation, and the FTC asserted that the mark had become the common descriptive name for “laminated sheets of wood, fabric or paper impregnated with synthetic resin and consolidated under heat and pressure for use on table tops, furniture and wall panelling.” *FTC v. Formica Corp.*, Cancellation No. 11955 (T.T.A.B., filed May 31, 1978); *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 647 (CCPA 1979); *Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 191 (TTAB 1978). According to the FTC, American Cyanamid had used the mark “to charge higher prices and to stifle competition in the plastic laminates market costing consumers an estimated \$10 million a year.” *FTC v. Formica*, Cancellation No. 11955, Petition for Cancellation at 1. The FTC’s action against Formica triggered strong responses. The President of Formica Corp. is reported to have warned that the FTC’s aggressive policing of generic trademarks “would have all American industries selling their products in plain brown wrappers.” Margulies, *supra* note 55 (quoting Martin B. Friedman). Spirited editorials condemned the FTC’s intervention, one accusing it of “engendering an ‘identity crisis’ in American business.” Margulies, *supra* note 55. One academic commentator characterized the relationship between the FTC and trademark owners as a “religious war.” McCarthy, *supra* note 55, at 152. This public outcry led to Congressional hearings (Hearings on H.R. 3685 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice, 96th Cong., 1st Sess. (1979)) and, eventually, the enactment of the FTC Improvements Act of 1980, Pub. L. No. 96-252, 94 Stat. 391 (1980), which, among other things, prohibited the FTC from using any appropriated funds to

While each of these mechanisms for challenging a mark as generic requires different procedural steps, the substantive requirements for a finding of genericism do not vary greatly from one such mechanism to another. In each case, whether a challenged mark is generic or descriptive is a question of fact.⁶⁴

A party bringing a cancellation action on the basis of genericism bears the burden of proving genericide by a preponderance of the evidence.⁶⁵ The challenger's task is made more difficult because the holder of a registered trademark, after meeting its initial burden in registration, benefits from a presumption of validity.⁶⁶

Despite the number of well-known marks that have fallen to genericide, not all genericism challenges are successful. In some cases, the evidence presented does not meet the required standard for showing that a challenged mark has taken on generic meaning in the public eye. For example, a San Diego jury found in 2017 that Comic-Con International's mark COMIC-CON was not generic after a challenge by Salt Lake City Comic Con, a group accused of infringing the mark.⁶⁷ In reaching its verdict, the jury seemingly relied on evidence including a survey showing that 70% of respondents considered COMIC-CON to be a particular brand rather than a generic description of an event.

In other cases, the owner of a challenged mark may show that the mark, even if it has taken on a generic meaning, is not being used in a generic manner. The most notable example of this approach arose in the highly-publicized genericism challenge to the mark GOOGLE.⁶⁸ In that case, the challenger petitioned the USPTO for cancellation of the GOOGLE mark on the ground that "the word 'google' is primarily understood as 'a generic term universally used to describe the act[] of internet searching'"⁶⁹ and that "verb use

petition to cancel the registration of any trademark on the basis of genericness for the next three fiscal years. *Id.* at § 18. Yet even after this statutory prohibition expired in 1982, it does not appear that the FTC ever again exercised its authority under Section 14 of the Lanham Act to challenge a trademark as generic.

⁶⁴ *In re Hotels.com, LP*, 573 F.3d 1300, 1301 (Fed. Cir. 2009)); *In re Bayer AG*, 488 F.3d 960, 964 (Fed. Cir. 2007).

⁶⁵ *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 684 F.2d 1316, 1319 (9th Cir. 1982).

⁶⁶ *Coca-Cola Co.*, 692 F.2d at 1254.

⁶⁷ *See Rob Salkowitz, Jury Decides For San Diego Comic-Con In Trademark Suit*, *Forbes*, Dec. 17, 2017 (discussing survey and other evidence relied upon by jury in finding that COMIC-CON was not generic).

⁶⁸ *Elliott v. Google, Inc.*, 860 F.3d 1151, 1155 (9th Cir. 2017).

⁶⁹ *Id.* at *4.

constitutes generic use as a matter of law”.⁷⁰ But, as noted above, this challenge was unsuccessful.⁷¹

Unlike other cancellation proceedings – resulting, for example, from a mark owner’s failure to use a mark in commerce – a finding of genericism will prevent others from registering the generic term as a mark.⁷² Thus, like an abandonment of rights under patent or copyright law, a finding of genericism generally has an estoppel effect on third parties, re-committing the generic term to the public.⁷³

C. *Genericide Counter-Measures*

It is often the case that the holders of intellectual property rights will lose those rights based on their own conduct: failing to pay renewal or maintenance fees, failing to disclose prior art to the Patent and Trademark Office, misusing or abusing those rights in commercial transactions, and so on. However, the loss of rights due to genericism arises from the use of a mark not only by the mark owner (though this is certainly possible), but also by competitors, consumers, the media, and others.⁷⁴ Given the large investments that many firms make in building goodwill in their brand identities, trademark owners often go to great lengths to control, or at least influence, third party use of their marks so as to avoid claims of genericism.⁷⁵

There are generally three proactive approaches that mark owners have taken to decrease the likelihood that their marks will become generic. First, the mark owner can impose direct contractual obligations on licensed users of the mark. Thus, in trademark license agreements, it is common for mark owners to prohibit their licensees from using the licensed marks in a manner that might lead to their genericism. These prohibitions often include prohibitions on use of the mark as a verb (e.g., don’t say “I am going to Xerox these papers”) or as a noun (e.g., don’t say “Where is the Xerox of my expense report?”).⁷⁶ And while such restrictions would not be

⁷⁰ *Id.* at *5.

⁷¹ See notes 45-46, *supra*, and accompanying discussion.

⁷² See Fietkiewicz, *supra* note 63, at 455-56.

⁷³ See *id.* Note, however, that under certain rare circumstances, a term that has been adjudged generic may be revived if it is shown to have achieved distinctiveness. See *id.* at n. 144; McCarthy at x.

⁷⁴ See Ingram, *supra* note 55, at 161.

⁷⁵ See, e.g., Johnson, *Why Companies Don’t Want You to Take Their Brand Names in Vain*, *ECONOMIST*, Sep. 9, 2017.

⁷⁶ See Ingram, *supra* note 55, at 160 (“Trademark owners should never use the trademark as a verb or noun, which implies that the word is generic”). *But see*

unexpected in sophisticated commercial arrangements between mark owners and, for example, product manufacturers and distributors, these types of anti-genericide provisions also appear in mass market agreements that are intended for a much broader audience.⁷⁷

Second, mark owners can take their anti-genericide campaigns directly to the public – to users of consumers and products beyond contractual licensees. This sort of direct intervention can come in the form of product advertising, in which the mark owner reminds consumers that its mark designates a particular brand of product rather than the product itself. For example, Landes and Posner describe how General Foods diligently advertised the first widely-distributed decaffeinated coffee as “Sanka-brand decaffeinated coffee” rather than simply “Sanka”.⁷⁸ General Foods succeeded in preventing Sanka from becoming a generic term, and in promoting the alternative generic term “decaf”.⁷⁹

Xerox Corporation is perhaps the best known proponent of the direct-to-consumer counter-measure ad, producing a large quantity of advertising designed not to promote its products, but to protect its trademark.⁸⁰ In the following clever advertisement, for example, Xerox evokes the genericism of the earlier mark zipper, pleading with readers not to use the term XEROX as a synonym for “photocopy”:

id. (“Of course, using a trademark only as an adjective and not as a verb is no guarantee that the mark will not be held to be generic. For example, “Light Beer” and “Lite Beer” were held “to be generic names for a type of beer light in body or taste and low in alcoholic and caloric content.” The same thing happened with “matchbox” toys and “safari” clothing.” (citations omitted)).

⁷⁷ See, e.g., Oracle Corp., Java Licensing Logo Guidelines, <http://www.oracle.com/us/technologies/java/java-licensing-logo-guidelines-1908204.pdf> (2016); Bluetooth SIG, Bluetooth Trademark License Agreement (E-Sign Version 1.3 – Last Revised Dec. 14, 2016).

⁷⁸ Landes & Posner, *supra* note 57, at 294.

⁷⁹ *Id.* Other successful genericide counter-measure campaigns include Chrysler’s “They invented “SUV” because they can’t call them Jeep®”; Johnson & Johnson’s “I am stuck on Band-Aids brand cause Band-Aid’s stuck on me”; and Kimberly-Clark’s “ ‘Kleenex’ is a brand name...and should always be followed by an ® and the word ‘Tissue.’ Help us keep our identity, ours.” Gary H. Fechter & Elina Slavin, *Practical Tips on Avoiding Genericide*, 66 INTA BULLETIN, Nov. 15, 2011.

⁸⁰ See, e.g. Ingram, *supra* note 55, at 161.

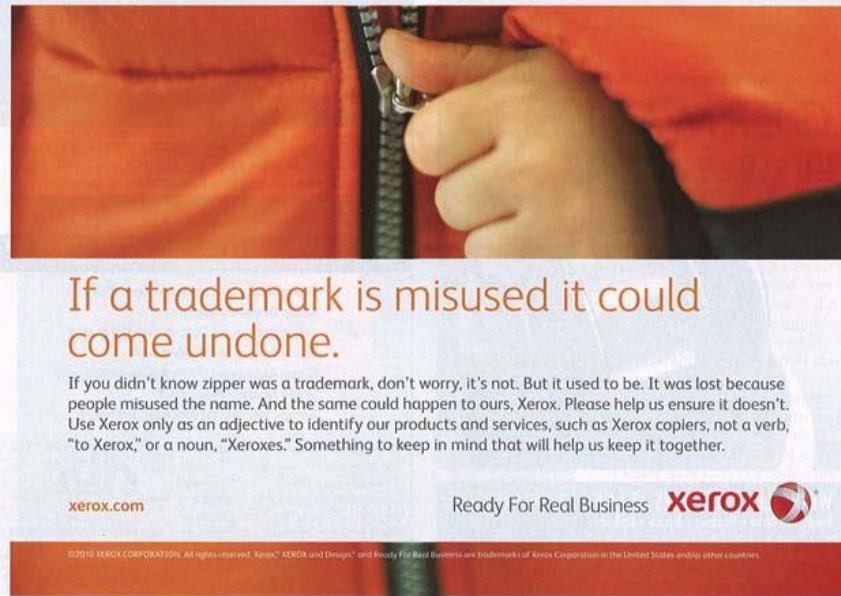


Figure 1
Xerox Genericide Counter-Measure Ad⁸¹

In ads like the one shown in Figure 1, the mark owner identifies a generic term that can be used instead of the trademark to describe the function of the product – its genus (e.g., “copy” or “photocopy”) – while reserving the trademark to identify the source of the product (e.g., a *Xerox* copier). Other attempts to append generic terms to product brand names include Scotch transparent tape, Kleenex facial tissue, Vaseline petroleum jelly, and Rollerblade in-line skates.⁸² As noted by Professors Lydia Loren and Joe Miller, “If the Otis Elevator Company, inventor of the escalator, had promoted the product as a “moving stairway,” escalator might still be a trademark.”⁸³

⁸¹ Xerox Corp., Advertisement, ABA Journal (2010) (reproduced in Liz Johnstone, *Dallas-Connected Xerox Corporation Probably Still Needs Your Help*, FrontBurner, Nov. 13, 2012, <https://www.dmagazine.com/frontburner/2012/11/dallas-connected-xerox-corporation-probably-still-needs-your-help/>). Additional Xerox ads in this vein may be found in ABA Journal, Feb. 2008 (reproduced in Loren & Miller, *supra* note 53, at 515) (again referencing zipper), Ingram, *supra* note 55, at 161 n.58 (referencing ‘aspirin’) and Fechter & Slavin, *supra* note 79 (“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”). Note that Xerox’s requests may be overly prescriptive. As noted by the Ninth Circuit in *Google*, “verb use does not automatically constitute generic use”. *Google*, 860 F.3d at *17.

⁸² See Loren & Miller, *supra* note 53, at 515; Ingram, *supra* note 55, at 159-60, 162.

⁸³ Loren & Miller, *supra* note 53, at 515.

The third general approach taken by mark owners to protect their marks from becoming generic has been to police improper uses of the mark in the marketplace and then request that users cease and desist those uses, sometimes threatening litigation if they fail to comply.⁸⁴ Professor John Ingram describes this approach as employed by The Coca-Cola Company, the owner of one of the most valuable marks in the world:

Coca-Cola employs people to visit retail establishments which do not serve Coca-Cola products and specifically order Coca-Cola or a Coke. If the establishment serves a cola-type beverage without comment, the Coca-Cola employees send a sample of the beverage to Coca-Cola's laboratory for chemical analysis. If the beverage is determined to not be a Coca-Cola product, the company will ask that retail establishment to stop the deceptive practice. If the practice continues, Coca-Cola will bring suit for trademark infringement.⁸⁵

Of course, these prophylactic measures do not guaranty that a mark will not be challenged as generic, and many cancelation proceedings have been brought and won even after mark owners have taken such precautions.

D. *The Economics of Genericide*

More than thirty years ago, Professor William Landes and Judge Richard Posner developed an influential microeconomic model of trademark law that retains its currency today.⁸⁶ In the Landes and

⁸⁴ Ingram, *supra* note 55, at 161. By the same token, a lack of policing by the mark owner can constitute evidence that a mark has become generic. *See, e.g., Filipino Yellow Pages*, 198 F.3d at 1151; *King-Seeley*, 321 F.2d at 579.

⁸⁵ Ingram, *supra* note 55, at 161-62. *See also* Margulies, *supra* note 55 (“Coca-Cola engages in several hundred actions year to prevent establishments from arbitrarily pouring any other cola when the customer asks for a Coke. The folks at Coke don't want the first half of their name to go the route of the last”). Evidence was presented in *Elliott v. Google* that Google also aggressively threatened dictionaries and others that failed to acknowledge its registration of the term GOOGLE. *Google*, 860 F.3d at *19 n.9.

⁸⁶ Landes & Posner, *supra* note 57. To be sure, some economic analysis of trademark law existed prior to Landes and Posner's work (*see, e.g., Folsom & Tepley, supra* note 56, at 1334-46; Lunney, *Monopolies, supra* note 22, at 367-69 (noting earlier work)), but the work of Landes and Posner is viewed by many as the landmark work in the field. *See, e.g.,* P. Sean Morris, *Trademarks and the Economic Dimensions of Trademark Law in Europe and Beyond*, *ENCYCLOPEDIA OF LAW AND ECONOMICS* (May 30, 2016), DOI: https://doi.org/10.1007/978-1-4614-7883-6_566-1 (referring to Landes and Posner's contribution as a “seminal

Posner model, the “essential economic function” of trademarks is the reduction of consumer search costs.⁸⁷ For a given product, consumer search costs associated with a product are inversely related to the strength of its trademark (the stronger the mark, the less consumers will have to search) and the number of other words that producers can use to describe the product (the more words that are available to describe the product (e.g., computer, electrical, heavy), the more accurately and economically the producer can advertise it).⁸⁸ Because a strong trademark will reduce search costs, it will enable the producer to raise its price for the product, assuming that consumers will tolerate the same total cost for a product of a given quality level (i.e., its monetary price plus the consumer’s search cost).⁸⁹

Without protectable trademarks, firms producing lower quality products could advertise their products using exactly the same words as firms producing higher quality products, thus misleading consumers into thinking that the products’ quality levels were equivalent.⁹⁰ It follows that the availability of trademarks, which distinguish one firm’s products from another, encourage firms to improve their own product quality.⁹¹

If, however, a producer is permitted to appropriate *generic* terms that describe a product, then the stock of other words available to competitors will be reduced, increasing search costs for the competitors’ products. For example, if Apple could trademark the generic word “computer”, then other computer makers such as Dell, Lenovo and HP would be required to find other, less apt, words to describe their products (e.g., “computation platform” or “artificial intelligence machine”), thereby adding to consumer uncertainty and, consequently, increasing the total cost of their products.⁹² The result will be a deadweight loss, decreasing overall consumer surplus. Moreover, the appropriating firm will be able to extract economic rents, thus disadvantaging its competitors.⁹³ For these reasons, the appropriation of generic terms as trademarks is viewed as

article which nowadays stands as the cornerstone on the economic analysis of trademark law”).

⁸⁷ Landes & Posner, *supra* note 57, at 275.

⁸⁸ *Id.* at 288. This description is necessarily simplified. The Landes-Posner model takes a number of other variables into account, but these are less relevant to the current discussion.

⁸⁹ *Id.* at 280.

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.* at 291-92 and Fig. 4 (this effect can be represented by a shift to the left of the supply curve for the affected competitors).

⁹³ *Id.*

economically inefficient and welfare reducing, both as to consumers and competitors.

II. THE HISTORY OF SUI-GENERICIDE

As discussed in Part I.A above, terms that identify a general category of goods, rather than the particular source of those goods (e.g., car, café and computer versus Prius, Starbucks and MacBook), are generic and cannot be registered or enforced as trademarks. A finding of genericism is typically made by the PTO during the examination of an application for trademark registration, or by a court or the TTAB following a challenge to a mark. Given the large investments that many firms make in building brand identity and goodwill, as discussed in Part I.C, trademark owners such as Xerox often go to great lengths to prevent their marks from becoming generic. But, surprisingly, some trademark owners have taken a different approach. These firms have affirmatively stated that certain terms that might otherwise be protected as trademarks *are* generic. As such, they intentionally, and prior to any legal challenge, seek to relinquish rights in potentially valuable marks, a practice that I have termed sui-genericide.

Despite the lack of scholarly attention to the phenomenon of sui-genericide, it is not a new phenomenon. This Part discusses the largely forgotten history of the sui-genericide programs that arose during the mid-twentieth century, some of which remain quietly active today, then addresses an emerging trend in the area of technical interoperability standards.

A. *The Department of Commerce Generic Word Program – A Genericide Wish List*

Beginning in the early 1940s, American businesses started to become aware that foreign trademark applications were being filed on terms that were generic in the English language.⁹⁴ Many of these terms described pharmaceutical products and ingredients, including ANTACID, VITAMIN, ANTI-HISTAMIN, NIACIN, B-COMPLEX, FOLIC ACID, PENICILLIN and STREPTOMYCIN.⁹⁵ In 1942, the Proprietary Association, a trade association for non-prescription drug

⁹⁴ See James F. Hoge, *Protection of Generic and Descriptive Names from Trade-Mark Registration Abroad*, 42 TRADEMARK REP. 514, 514 (1952).

⁹⁵ *Id.* at 514-15.

manufacturers,⁹⁶ began to review and oppose these foreign applications.⁹⁷ In 1951, the Proprietary Association joined forces with the American Drug Manufacturers Association and the American Pharmaceutical Manufacturers Association in this activity.⁹⁸ By 1952 this coalition had reviewed 253 such foreign applications in twenty countries and filed 112 oppositions, resulting in forty-three cancelations and fifteen withdrawals.⁹⁹

Beginning sometime in the late 1940s, shortly after the passage of the Lanham Act, the U.S. Department of Commerce's Bureau of Foreign Commerce (later the Bureau of International Commerce) initiated its own program to oppose foreign trademark applications seeking to register generic English terms.¹⁰⁰ Though the Bureau's "Generic Word Program" initially focused on pharmaceutical terms, it soon expanded to cover all product categories of interest to American industry.¹⁰¹ Under the Program, the Bureau invited interested U.S. parties to notify it of attempts abroad to register generic English words as trademarks. The theory underlying the Program was that if generic English language terms became trademarks in foreign jurisdictions, U.S. firms would be unable to use those terms in their foreign advertising, and also that American-made products bearing those generic terms could be excluded from the relevant foreign markets.¹⁰² Thus, it was in the interest of U.S. firms to self-identify terms that they wished to keep generic, both abroad and, presumably, at home.

The majority of the notices under the Generic Word Program, which amounted to over 100 per year by 1965, were submitted to the Bureau by the U.S. Trademark Association (a trade organization

⁹⁶ The Proprietary Association was formed in 1881; in 1989 it changed its name to the Consumer Healthcare Products Association. *See* Consumer Healthcare Prods. Assn., About CHPA, <https://www.chpa.org/about.aspx> (visited Mar. 27, 2019).

⁹⁷ Hoge, *supra* note 94, at 515.

⁹⁸ *Id.* at 514.

⁹⁹ *Id.* at 515.

¹⁰⁰ Walter J. Derenberg, *The Third Year of Administration of the Lanham Trade-Mark Act of 1946*, 40 TRADEMARK REP. 914, 946 (1950).

¹⁰¹ For an insider's description of the Generic Word Program, *see, generally*, Vincent D. Travaglini, *Industrial Property Rights and Foreign Trade*, 51 TRADEMARK REP. 545, 552-54 (1961); Joseph M. Lightman, *Protection of Generic Words against Trademark Registration Abroad*, 54 TRADEMARK REP. 80, 80-83 (1964); Vincent D. Travaglini & Joseph M. Lightman, *Department of Commerce Assistance Available to United States Firms in Protection Abroad against Unfair Trade Practices*, 55 TRADEMARK REP. 740, 741-43 (1965).

¹⁰² Lightman, *supra* note 101, at 80.

now known as the International Trademark Association (INTA)).¹⁰³ According to one Bureau official, the program worked as follows:

When the Bureau of International Commerce learns of a foreign generic word application, it prepares instructions containing appropriate details concerning the application, for transmittal to the American Embassy in the country of application. The Embassy, in effect, is asked to lodge a protest with the foreign Government in efforts to have the application denied. The Embassy is also instructed to emphasize to Governmental authorities the detrimental effects which the registration could have on significant segments of trade between the U. S. and their country. These Embassy approaches are not intended to replace the entering of formal oppositions to objectionable registrations. They serve as informal representations against the potentially adverse trade effects of such attempted registrations. In some countries, the authorities will deny an application as a result of the Embassy's approach; in others they have made it clear that a private formal opposition must be filed before a denial can be considered.¹⁰⁴

According to two Bureau officials writing in 1965, the Generic Word Program resulted in the denial of hundreds of foreign trademark applications “which, if granted, would have prevented American exporters of the goods concerned from making shipments to the countries where the applications were filed.”¹⁰⁵ Generic terms as to which the Bureau successfully objected to foreign registration include WASH-AND-WEAR, T-SHIRT, ELASTIC, COTTON, SILK, AUTO PAINT, PRIMER PAINT, AUTO ENAMEL, LACQUER, SATIN, TRACTOR, DIESEL, AUTO PARTS, OVERDRIVE, CHARCOAL, INTERCOM, RADAR, SONAR, VIDEO, BEARINGS, CHOCOLATE, SNACK, CRISP, CORN FLAKES, EGG BACON, OLD FASHIONED, ICE, JELLY-BEANS, MINESTRONE, BISCUIT, CHEESECAKE, MOZZARELLA and BANANAS.¹⁰⁶

¹⁰³ Travaglini & Lightman, *supra* note 101, at 742.

¹⁰⁴ Lightman, *supra* note 101, at 81.

¹⁰⁵ Travaglini & Lightman, *supra* note 101, at 742. The authors further explain that “[w]hile many such applications may be routinely denied by the local authorities, experience has shown that some will be accepted unless there is active intervention to prevent registration.” *Id.* at 741.

¹⁰⁶ Travaglini, *supra* note 101, at 553-54; Lightman, *supra* note 101, at 83; Travaglini & Lightman, *supra* note 101, at 742-43; *In re Le Sorbet, Inc.*, 228 U.S.P.Q. 27, *4 n.15 (Trademark Tr. & App. Bd. 1985).

The Generic Word Program, which appears to have ended sometime in the late 1980s,¹⁰⁷ represents an important first step toward sui-genericide. Though the U.S. firms who submitted terms to the Bureau through USTA did not themselves make any express representation or commitment regarding the generic nature of those terms, it is likely that their submission of terms to the Generic Word Program had the practical effect of an admission of genericness or, in the alternative, a commitment not to seek registration of the submitted terms.¹⁰⁸

B. Generic Drug Names

Every drug on the market today generally has three different names: a chemical name, a generic or nonproprietary name and a proprietary or brand name. While drug manufacturers seek to differentiate themselves and enhance their brands via advertising, packaging and other means,¹⁰⁹ it is important for public health and safety purposes to have a consistent set of nonproprietary names that all manufacturers can use to refer to drugs having the same active ingredients. For example, Advil[®] and Motrin[®] are well-known brands of the same pain medication – ibuprofen -- which bears the chemical name (RS)-2-(4-(2-methylpropyl)phenyl)propanoic acid.¹¹⁰ The chemical name clearly being too complex for routine usage, most physicians, pharmacists and consumers will refer to the drug either by its brand name or, when referring to a class of drugs, by its generic name.

¹⁰⁷ The actual termination date of the Generic Word Program is not clear, but no references to it have been located after 1985. *See Le Sorbet*, 228 U.S.P.Q. 27 at *4 n.15; Robert Brauneis & Anke Moerland, *Monopolizing Matratzen in Malaga: The Mistreatment of Distinctiveness of Foreign Terms in EU and US Trademark Law* at MS pp. 7-8 (working draft 2018, copy on file with author) (estimating end date of program to be in 1980s).

¹⁰⁸ *See* Part IV.D, *infra* (discussing legal enforceability of submitting firms' position re. genericism of submitted terms).

¹⁰⁹ Proprietary drug names are often created de novo as fanciful terms (e.g., Viagra, Lipitor, Tylenol, etc.) and are thus among the strongest trademarks. For a description of the lengthy and complex process used to select proprietary names for pharmaceutical products, *see, e.g.*, *Pharmacia Corp. v. Alcon Labs., Inc.*, 201 F. Supp. 2d 335, 340-47 (D.N.J. 2002).

¹¹⁰ *See* WebMD, Ibuprofen Oral, <https://www.webmd.com/drugs/2/drug-5166-9368/ibuprofen-oral/ibuprofen-oral/details> (visited Mar. 30, 2019). Chemical names, which are generally of limited commercial value due to their complexity and unfamiliarity, are assigned by the International Union of Pure and Applied Chemistry (IUPAC), an international scientific and standardization body founded in 1919. *See* Int'l Union of Pure & Applied Chemistry, Who We Are, <https://iupac.org/who-we-are/> (visited Mar. 30, 2019). In addition to chemical nomenclature, the IUPAC assigns names to newly discovered elements and develops standardized units of measure, among other things. *Id.*

As noted in Part II.A, above, the registration of generic terms by foreign trademark applicants was first perceived as a threat by the U.S. pharmaceutical industry in the early 1940s. While the Proprietary Association's opposition to the registration of generic terms such as ANTACID and PENICILLIN helped to limit these foreign registrations, it soon became clear that individual opposition proceedings were costly and not always successful.¹¹¹ Likewise, diplomatic efforts by the Bureau through the Generic Words Program could not be relied upon to protect the increasing number of pharmaceutical compound names employed by the industry. A more comprehensive solution was required.

The World Health Organization (WHO) was formed in 1946 as specialized agency of the United Nations. Under the WHO charter, one of the agency's goals is "to develop, establish and promote international standards with respect to food, biological, pharmaceutical and similar products."¹¹² In 1948, the initial World Health Assembly (the decision-making body of WHO¹¹³) resolved to develop a harmonized international pharmacopeia.¹¹⁴ Pursuant to that resolution, the World Health Assembly created a formal program for selecting international nonproprietary names (INN) for pharmaceutical compounds.¹¹⁵ Through the INN program, which was launched in 1953 and continues today,¹¹⁶ the WHO publishes a list of pharmaceutical substance names that are intended to be used generically by the industry. As of 2017, approximately 9,300 terms have been designated as INNs, with approximately 160 more added each year.¹¹⁷

Figure 2 below is an example of the entry for a recommended INN as published by the WHO in its cumulative list of INNs.¹¹⁸

¹¹¹ Hoge, *supra* note 94, at 515 (of 112 oppositions filed between 1942 and 1952, only 43 resulted in cancelation of the targeted application or mark, with another 15 withdrawals).

¹¹² World Health Org. Constitution Art. 2(u) (1946).

¹¹³ See World Health Org., World Health Assembly, <https://www.who.int/mediacentre/events/governance/wha/en/>

¹¹⁴ World Health Org., WHA1.21 (Jul. 1948).

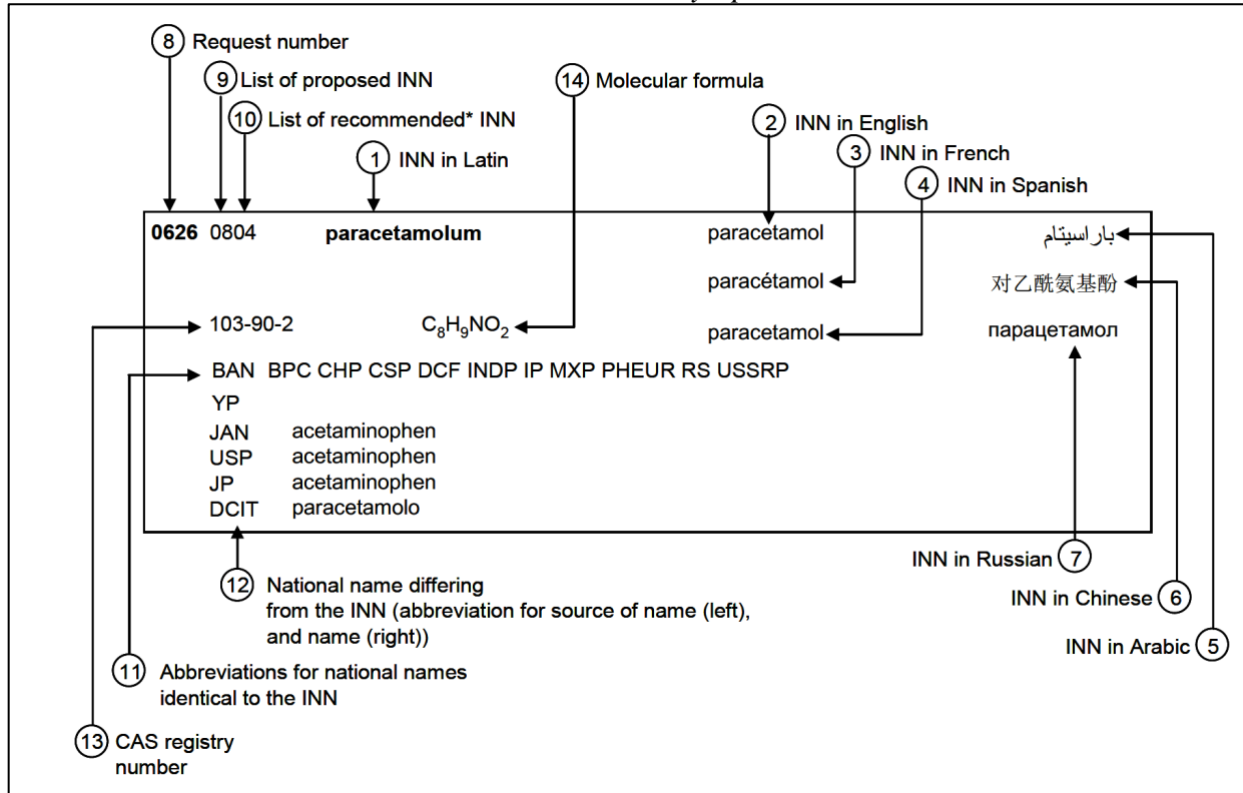
¹¹⁵ World Health Org., WHA3.11 (1950).

¹¹⁶ WORLD HEALTH ORG., GUIDANCE ON THE USE OF INTERNATIONAL NONPROPRIETARY NAMES (INNs) FOR PHARMACEUTICAL SUBSTANCES 19 (2017) [hereinafter WHO INN Guidelines].

¹¹⁷ WHO INN Guidelines, *supra* note 116, at 5.

¹¹⁸ WORLD HEALTH ORG., INTERNATIONAL NONPROPRIETARY NAMES (INN) FOR PHARMACEUTICAL SUBSTANCES CD-ROM (2017).

Figure 2
Published INN Entry - paracetamol



Source: WHO INN Guidelines, p. 10

WHO has established detailed rules for the designation of INNs, including appropriate word stems (e.g., “-aldrate” for antacids and “-imex” for immunostimulants), number of syllables, use of hyphens, and the like.¹¹⁹ Any organization may propose a new INN to WHO using a standardized application form¹²⁰ in which the applicant represents that “insofar as is known, none of the suggested names is either registered or pending registration” as a trademark¹²¹ and discloses any trademark issued for the relevant drug.¹²² Proposed INNs are reviewed by a WHO expert advisory panel for compliance with these rules.¹²³ If the proposed INN is deemed allowable, it is published by WHO for public comment.¹²⁴ During the four-month public comment period, a formal objection may be

¹¹⁹ WHO INN Guidelines, *supra* note 116, at 11-12 and Annexes 2-4.

¹²⁰ World Health Org., Request for an International Nonproprietary Name (reproduced in WHO INN Guidelines, *supra* note 116, at Annex 7) [hereinafter INN Request Form]. See also WHO INN Guidelines, *supra* note 116, at 14-18 (describing application process).

¹²¹ INN Request Form, *supra* note 120.

¹²² WHO INN Guidelines, *supra* note 116, at 16.

¹²³ *Id.* at 6, 49 (Expert Advisory Panel on the International Pharmacopoeia and Pharmaceutical Preparations).

¹²⁴ *Id.* at 49.

filed by any person (e.g., another manufacturer, a trade association such as INTA or a government) who believes that the proposed INN “is in conflict with an existing trademark”.¹²⁵ Upon receipt of such an objection, WHO “will actively pursue an arrangement to obtain a withdrawal of such an objection or will reconsider the proposed name.”¹²⁶ Following the public comment period, once all outstanding objections have been withdrawn, WHO will publish the INN in its next semi-annual list of recommended INNs.¹²⁷

While WHO claims that INNs “are formally placed by WHO in the public domain,”¹²⁸ and that “trademarks cannot be derived from INNs”¹²⁹ these claims are somewhat overstated. As a U.N. agency, with no formal treaty or international agreement in place relating to INNs, WHO has no formal authority to dictate how national trademark offices or private parties treat INNs. Thus, in 1993, the World Health Assembly adopted a resolution *requesting* WHO member states “to develop policy guidelines on the use and protection of international nonproprietary names, and to discourage the use of names derived from INNs, and particularly names including established INN stems as trade-marks.”¹³⁰ To facilitate the adoption of this recommendation, the WHO produced an *Information Leaflet for Trademark Departments*, offering advice regarding INNs to national trademark offices.¹³¹ Thus, while decisions concerning the registration of INNs remain solely with national trademark offices and courts,¹³² the WHO INN program serves a valuable function by coordinating industry usage and promoting norms of genericism with respect to recognized INNs.

The WHO INN process also plays an important role in the approval of generic drug names in particular countries, including the

¹²⁵ *Id.* at 6. *See also* Lightman, *supra* note 101, at 84-85 (discussing U.S. government interaction with INN program).

¹²⁶ *Id.* at 6.

¹²⁷ World Health Org., Lists of Recommended and Proposed INNs, <https://www.who.int/medicines/publications/druginformation/innlists/en/> (visited Mar. 30, 2019).

¹²⁸ WHO INN Guidelines, *supra* note 116, at 6.

¹²⁹ *Id.* at 7.

¹³⁰ World Health Org., WHA46.19 (May 1993).

¹³¹ World Health Org., Information Leaflet for Trademark Departments (n.d.), <https://www.who.int/medicines/services/inn/flyerINN.pdf?ua=1>

¹³² It is telling that neither the TMEP, *supra* note 52, nor the FDA’s Best Practices in Developing Proprietary Names for Drugs (2014) contain any references to the WHO INN program or terms that are designated as INNs in describing what terms may and may not be registered as proprietary names for drugs. *See* Part IV.B, *infra*. But while the U.S. may fail to give official recognition to INNs, other countries have adopted laws and rules prohibiting the registration of INNs as trademarks. *See* Part IV.E, *infra*.

United States. In the United States, generic drug names are assigned by the United States Adopted Name Council (USAN Council), a joint undertaking of the American Medical Association (AMA), the United States Pharmacopeia (USP), and the American Pharmacists Association (APhA), cooperating with the Food and Drug Administration (FDA).¹³³ While many generic drug names were originally condensed versions of the relevant chemical names, that is no longer the case.¹³⁴ The USAN Council has adopted a detailed set of guidelines regarding appropriate nomenclature for generic drug names, including rules for assigning the prefix, infix and stem (suffix) components of a particular name.¹³⁵ These guidelines specify that “[a] name should not conflict, mislead or be confused with other nonproprietary names and with established trademarks.”¹³⁶ In addition, a generic name prefix should not imply that a drug is better, newer or more effective than other compounds, nor should it evoke the name of a manufacturer, medical condition or part of the human anatomy.¹³⁷

The process for creating a new generic drug name is initiated by a manufacturer who submits an application for the name to the

¹³³ The USAN Council grew out of the AMA-USP Nomenclature Committee, which has been adopting common drug names since 1961. Joseph B. Jerome, *Review: United States Adopted Names (USAN). Cumulative List No. 1, 1961-1962*, 186 J. AM. MED. ASSN. 1104 (1963). In 1964, the APhA joined this group to form the USAN Council. 21 C.F.R. 299.4(c) (2014).

¹³⁴ Am. Med. Assn., United States Adopted Names Naming Guidelines, <https://www.ama-assn.org/about/united-states-adopted-names/united-states-adopted-names-naming-guidelines> (visited Mar. 30, 2019) [hereinafter USAN Naming Guidelines].

¹³⁵ See USAN Naming Guidelines, *supra* note 134:

Drugs with the same ending (stem) belong to the same pharmacologic family. Infixes, appearing in the middle of the word, are sometimes used to further classify the drug. Prefixes mean nothing. The sole purpose of a prefix is to differentiate a drug from other members of the class. As an example, consider sildenafil (Viagra™), vardenafil (Levitra™), and tadalafil (Cialis™). The -afil stem is formally defined as for PDE5 (phosphodiesterase 5) inhibitors. The -den- infix indicates that sildenafil and vardenafil have similar chemical structures. The prefixes are sil-, var- and tadal-.

See also Carmen Drahl, *Where Drug Names Come From*, 90 CHEMICAL & ENGINEERING NEWS, Iss. 3, 36 (2012) (explaining idiosyncratic origin of prefixes for several drugs including dasatinib (named for researcher Jagabandhu Das), asunaprevir (named for chemist Li-Qiang Sun) and carfilzomib (named for molecular biologist Philip Whitcome and his wife, Carla, who both succumbed to cancer)).

¹³⁶ USAN Naming Guidelines, *supra* note 134.

¹³⁷ *Id.*

USAN Council.¹³⁸ The applicant is required to include with its application a verification that the proposed generic name does not conflict with “existing chemical names, insecticides, other nonproprietary names or trademarks.”¹³⁹ The application is first reviewed by USAN staff for potential conflicts with existing trademarks and other generic names.¹⁴⁰ If no such conflicts are found, then the USAN Council will review and vote on the approval of the name. If approved, then USAN will submit the name to WHO for INN review and a name will not be approved until INN approval is obtained from WHO.¹⁴¹

Though neither the WHO nor the USAN Council formally prohibit a party from seeking or obtaining trademark protection for a term that is designated as an INN or a USAN, or prevent national trademark offices from issuing such trademarks, the longstanding and widespread use of these two systems, as well as the FDA’s endorsement of the USAN in the United States, seem to create a strong disincentive to the registration of such terms as trademarks. Moreover, were a rogue party to file a trademark application covering a USAN or INN, it is likely that, given active monitoring by trade groups such as INTA and the AMA, the application would quickly be opposed both by competing manufacturers as well as trade associations interested in preserving the integrity of the generic drug naming system. As a result, generic drug names are, for all practical purposes, generic for trademark purposes as well.

C. *Pesticide Common Names*

Like pharmaceutical products, pesticides each have a chemical name, a common or generic name and, in some cases, a brand or proprietary name. In the United States, the regulation and oversight of pest control products and programs was historically shared by a number of federal agencies including the Public Health Service, the Department of Agriculture, and the Departments of War and the

¹³⁸ Am. Med. Assn., USAN Application Forms, <https://www.ama-assn.org/about/united-states-adopted-names/usan-application-forms> (visited Mar. 30, 2019).

¹³⁹ See, e.g., Am. Med. Assn., Form A - USAN Application for Single Entity Drug and Salt Form,

¹⁴⁰ Am. Med. Assn., USAN Negotiation Process, <https://www.ama-assn.org/sites/ama-assn.org/files/corp/media-browser/public/usan/usan-process.pdf> (visited Mar. 30, 2019).

¹⁴¹ Am. Med. Assn., USAN/INN Negotiation Process, <https://www.ama-assn.org/sites/ama-assn.org/files/corp/media-browser/usan-inn-negotiation-process.pdf> (visited Mar. 30, 2019).

Navy.¹⁴² Given this diversity of activity, a federal Interdepartmental Committee on Pest Control was formed in 1946 to help these agencies to coordinate their activities, research and public communication.¹⁴³ Among the Committee's first activities was "the adoption of coined names for insecticides" to be used in lieu of the complex and lengthy chemical names in product labeling and other communications.¹⁴⁴

In 1954, the task of developing these common names for pesticides was handed off to the American Standards Association (ASA),¹⁴⁵ a private sector body that led U.S. efforts on standardization in a variety of industrial sectors.¹⁴⁶ A committee (ASA Committee K-62) was formed that year comprising representatives of governmental agencies and medical and scientific societies, under the sponsorship of the U.S. Department of Agriculture.¹⁴⁷ Significantly, both the U.S. Patent Office and the USTA were included as members of Committee K-62.¹⁴⁸ The Committee charter included the development and approval of common names for herbicides, insecticides, fungicides, rodenticides and other chemicals.¹⁴⁹ Committee K-62 also coordinated with the International Standardization Organization (ISO) Technical Committee 81 (ISO/TC 81), which established international standards for common names for pesticides and other agrochemicals.¹⁵⁰

In 1956, Committee K-62 approved a procedure for the proposal and approval of common names for pest control chemicals, which it published as American Standard K62.1-1956.¹⁵¹ This procedure was

¹⁴² See *Establishment of an Interdepartmental Committee on Pest Control*, 39 J. ECONOMIC ENTOMOLOGY 823, 823 (1946). The large-scale eradication and control of disease-bearing insects was pioneered by the Army Corps of Engineers and Public Health Service in the early twentieth century to support U.S. military activity in tropical locations such as Cuba and Panama. See, e.g., DAVID MCCULLOCH, *THE PATH BETWEEN THE SEAS* x (1977).

¹⁴³ See *Establishment of an Interdepartmental Committee on Pest Control*, 39 J. ECON. ENTOMOLOGY 823, 823 (1946).

¹⁴⁴ See *The Interdepartmental Committee on Pest Control*, 44 J. ECON. ENTOMOLOGY 1029, 1029 (1951).

¹⁴⁵ George W. Fiero, *Report on Program of Common Names for Pesticides*, 53 TRADEMARK REP. 553, 553 (1963).

¹⁴⁶ See ANDREW L. RUSSELL, *OPEN STANDARDS AND THE DIGITAL AGE: HISTORY, IDEOLOGY, AND NETWORKS* 63 (2014).

¹⁴⁷ Fiero, *supra* note 145, at 553-54.

¹⁴⁸ *Id.* at 553-54.

¹⁴⁹ *Id.* at 554.

¹⁵⁰ *Id.* at 553.

¹⁵¹ Am. Standards Assn., *American Standard K62.1-1956 - American Standard Procedure for the Acceptance of an American Standard Common Name for a Pest Control Chemical* (Feb. 28, 1956) (reproduced in R. Behrens et al.,

intended “to make possible the adoption of common names readily acceptable and usable by all interested groups, while guarding against confusion with existing common or proprietary names and against improper use in the future.”¹⁵² Under this procedure, new common names for pesticides would be proposed to ASA by a sponsor – either the product manufacturer or another organization having an interest in the product.¹⁵³ Proposed names had to comply with a number of technical criteria,¹⁵⁴ but also had to be free of potential trademark claims. In particular, the sponsor of a proposed name was required to certify to ASA that

a search has been conducted and findings are submitted to verify the absence of conflicts with existing domestic trademarks or names for other chemicals or products. Should the proposed Common Name itself be trade-marked or be in apparent conflict with any domestic trade-mark or trade name, the Sponsor shall submit to the Committee a written statement from the trade-mark owner releasing the proposed Common Name for unrestricted use.¹⁵⁵

The sponsor was thus required to represent not only that it would not claim trademark rights in an approved common name, but also that it had searched and determined either that the proposed name was not subject to competing trademark rights, or that it had obtained the commitment of the holder of trademark rights permitting the use of the mark as a common pesticide name. This procedure indicates a strong interest in trademarks by the industrial members of Committee K-62, and a strong desire to keep pesticide common names free from trademark encumbrances.

In 1969 ASA became the American National Standards Institute (ANSI), which continued the work of Committee K-62 through

Terminology Committee Report: Weed Society of America, 4 WEEDS 278, 284-87 (1956) [hereinafter ASA K62.1-1956].

¹⁵² ASA K.62.1-1956, *supra* note 151, at § 1.1.

¹⁵³ *Id.* at § 2.6.

¹⁵⁴ *Id.* at §§ 3.3-3.4.

¹⁵⁵ *Id.* at § 3.5. The form of written statement was included in Section 4.2.11: “The undersigned agrees to release and permit the use of the name ‘_____’ (the proposed common name) for use with respect to any product, whether or not manufactured or formulated by the undersigned, which contains a pest control chemical conforming to the description of the pest control chemical specified by ASA in an American Standard adopted and made public pursuant to this Statement.” *See also* Fiero, *supra* note 145, at 557-59 (sample application with trademark disclosures).

approximately 1997.¹⁵⁶ In 1997, the Environmental Protection Agency (EPA), whose regulations require that the “accepted common name” of a pesticide be displayed on the product label,¹⁵⁷ expressly deferred to ANSI’s Committee K-56 for purposes of determining pesticide common names.¹⁵⁸

After 1997, however, possibly due to declining funding and interest by the committee’s sponsor, the U.S. Department of Agriculture, ANSI discontinued both Committee K-62 and its participation in ISO/TC 81. The last version of ANSI’s K.62.1 naming procedure was published in 1985 and withdrawn by ANSI as inactive in 2001.¹⁵⁹

Today, pesticide common names are developed and maintained largely by ISO/TC 81, which has nine participating members and 32 observing members (none of which are from the U.S.).¹⁶⁰ ISO standard 257:2018 (originally published in 1976) lays out guidelines for the development of common names for pesticides and other agrochemicals, with the goal of creating “short, distinctive, easily pronounced names, which will be common to all languages.”¹⁶¹ As in the defunct ANSI procedure, common pesticide names are generally proposed by private companies with an interest in the field and then reviewed by ISO TC/81.

D. *Synthetic Textile Fibers*

In the mid-twentieth century, mass-produced synthetic fibers such as nylon and polyester began to replace natural fibers such as wool and cotton in clothing, linens and a variety of other consumer

¹⁵⁶ A search of the web store of the commercial standards vendor SAI Global (infostore.saiglobal.com) for the term ANSI K.62.1 yields 102 standards, each of which was last updated in 1997 (search conducted Apr. 1, 2019).

¹⁵⁷ 40 CFR 156.10(g).

¹⁵⁸ U.S. Environmental Protection Agency, PRN 97-5: Use of Common Names for Active Ingredients on Pesticide Labeling, § IV.C <https://www.epa.gov/pesticide-registration/prn-97-5-use-common-names-active-ingredients-pesticide-labeling> (“EPA prefers that common names for chemicals be established through standards-setting organizations such as ANSI.”)

¹⁵⁹ Information provided to author by ANSI Web Store supervisor via telephone (212-642-4980) on Apr. 1, 2019.

¹⁶⁰ Int’l Standardization Org., ISO/TC 81, <https://www.iso.org/committee/50160.html> (visited Apr. 1, 2019). Interestingly, the EPA still refers to ANSI’s development of pesticide common names in materials as recent as 2012. *See, e.g.*, Env’t Prot. Agency, Label Review Manual at p. 5-3 (2012) (“EPA will permit the use of common names approved by the American National Standards Institute (ANSI) in the labeling ingredients statement without the accompanying scientific chemical names”).

¹⁶¹ Int’l Standardization Org., ISO 257:2018, Introduction.

products.¹⁶² Under the 1958 Textile Fiber Products Identification Act,¹⁶³ manufacturers are required to affix to every textile fiber product a stamp, tag or label that discloses the fiber content, by weight, of each textile product with reference to that fiber's generic name.¹⁶⁴ Civil and criminal penalties may be imposed with respect to the sale or advertising of textile fiber products that are "misbranded or falsely or deceptively advertised".¹⁶⁵

Authority for assigning appropriate generic names to different synthetic fibers under the Act resides with the FTC.¹⁶⁶ When developing its initial list of sixteen generic names for common synthetic fibers, including acrylic, acetate, polyester and nylon, the FTC held extensive consultations with representatives of private industry regarding the parameters for developing such generic terms.¹⁶⁷ It was decided that such generic terms would be defined based on a fiber's chemical composition. For example, "acetate" is defined as "a manufactured fiber in which the fiber-forming substance is cellulose acetate..."¹⁶⁸ whereas other definitions are significantly more complex and include detailed chemical diagrams and formulae.¹⁶⁹

Since 1977, the FTC has stopped developing its own fiber names and has instead adopted the names designated by the International Organization for Standardization (ISO) in ISO standard 2076.¹⁷⁰ This standard is maintained and reviewed every five years by ISO

¹⁶² See A.F. Richards, *Nylon Fibres* in SYNTHETIC FIBRES: NYLON, POLYESTER, ACRYLIC, POLYOLEFIN 20, 20-21 (J.E. McIntyre, ed., 2005). Synthetic fibers are generally understood to be "manufactured from polymers built up from chemical elements or compounds" and to exclude fibers made from naturally-occurring fiber-forming polymers such as rayon, which is made from regenerated cellulose, which was introduced to the market much earlier. *Id.* at 1.

¹⁶³ P.L. 85-897, 72 Stat. 1712 (Sept. 2, 1958, codified at 15 USC § 70 et seq.). The Textile Fiber Products Identification Act followed the pattern of earlier chapters of the FTC's authorizing legislation relating, for example, to the sale and advertising of natural fiber products such as wool (15 USC § 68 et seq.) and fur (15 USC § 69 et seq.). See also 16 CFR Part 303 (Rules and Regulations Under The Textile Fiber Products Identification Act).

¹⁶⁴ 15 USC § 70b(b).

¹⁶⁵ 15 USC § 70a(a)-(c) (establishing liability), § 70f (injunction proceedings), § 70g (exclusion of imports), § 70i (criminal misdemeanor penalties).

¹⁶⁶ 15 USC § 70e(c).

¹⁶⁷ See Lightman, *supra* note 101, at 83.

¹⁶⁸ 16 CFR Part 303.7(e).

¹⁶⁹ See, e.g., 16 CFR Part 303.7(c) (polyester).

¹⁷⁰ See 16 CFR Part 303.7 (incorporating ISO standard ISO 2076:2010(E) by reference).

Technical Committee 38 (ISO/TC 38 – Textiles).¹⁷¹ ISO/TC 38 currently has twenty-nine participating members including the United States, represented by ANSI, and forty-six observing members.¹⁷²

In a manner similar to the Generic Word Program, the FTC has coordinated with the Department of State and U.S. embassies abroad to request (with some measure of success) that foreign governments prohibit the registration of these synthetic fiber names as trademarks.¹⁷³ Thus, the FTC, in its capacity as the overseer of fair advertising in the U.S., has taken an active role in ensuring the recognition of these fiber names as generic terms. Yet even here, the generic terms for synthetic fibers originate with industry players who then participate in a process overseen by the FTC.

E. Government Engagement With Sui-Genericide Today

By the late 1970s, U.S. federal agencies became increasingly hesitant to involve themselves directly in industrial standardization activities, culminating in the adoption, in 1980, of OMB Circular A-119, which expressly instructs federal agencies to defer to private standardization efforts absent a compelling need for governmentally-developed standards.¹⁷⁴ As a result, efforts such as the Generic Word Program and other direct federal participation in the development of common names for U.S.-manufactured products wound down by the mid-1980s.

This being said, the U.S. government is still actively involved in some aspects of common names. Thus, while the naming of generic drugs has largely been assumed in the U.S. by the private USAN Council in coordination with WHO, the FDA has taken an active

¹⁷¹Int'l Org. Standardization, ISO 2076:2013 (Textiles -- Man-made fibres -- Generic names), <https://www.iso.org/standard/56206.html> (visited Mar. 31, 2019). It appears that through the most recent revision in 2013, the 1977 list has been retained. *Id.*

¹⁷² Int'l Org. Standardization, Participation – ISO/TC 38 – Textiles, <https://www.iso.org/committee/48148.html?view=participation> (visited Mar. 31, 2019).

¹⁷³ See Lightman, *supra* note 101, at 83. Interestingly, one Department of Commerce official reports that at the beginning of the program, “some of these words had been registered abroad by American companies prior to their ... designation by the Federal Trade Commission. In these cases, the Commission worked out appropriate arrangements with the U. S. companies not to exercise any restrictive rights on sales abroad of goods bearing these terms.” Lightman, *supra* note 101, at 84.

¹⁷⁴ Off. Mgt. Budget, Circular A-119: [cite]. See, generally, Emily Bremer [2019 chapter].

role in seeking to develop guidelines for the development of common names for new biological products.¹⁷⁵

In addition, though the Department of Commerce Bureau of Foreign Commerce (and successor Bureau of International Commerce) no longer exist to discourage foreign trademark offices from registering generic English terms through the Generic Word Program, the USPTO advocates to “improve IP policies, laws, and regulations abroad for the benefit of U.S. businesses and stakeholders” through its IP Attaché Program.¹⁷⁶ Likewise, the U.S. Trade Representative (USTR) identifies foreign IP practices that are of concern to U.S. industry and seeks to “use all possible sources of leverage to encourage other countries to ... provide adequate and effective protection and enforcement of U.S. intellectual property (IP) rights.”¹⁷⁷

With respect to generic terms, the USTR has actively opposed the protection of geographic indications (GIs) by the European Union when those GIs are viewed as common names for foodstuffs exported by U.S. manufacturers.¹⁷⁸ For example, the USTR opposed the EU’s designation of “danbo” as a geographic indication for a type of cheese made in Denmark (pursuant to which only producers located in the Danbo region could use that term to describe their cheese products), as manufacturers in the U.S. and elsewhere use “danbo” as the common name for this variety of cheese.¹⁷⁹ Similar concerns have been expressed with respect to other cheese varieties such as fontina, gongonzola, asiago and feta, as well as non-agricultural products including including apparel, ceramics, glass, handicrafts, manufactured goods, minerals, salts, stones, and textiles.¹⁸⁰ And far from being only a bilateral U.S.-EU issue,

¹⁷⁵ See U.S. DEPT. HEALTH AND HUMAN SVCS. – FOOD & DRUG ADMIN., NONPROPRIETARY NAMING OF BIOLOGICAL PRODUCTS: UPDATE GUIDANCE FOR INDUSTRY – DRAFT GUIDANCE (Mar. 2019).

¹⁷⁶ U.S. Patent & Trademark Off., IP Attaché Program, <https://www.uspto.gov/learning-and-resources/ip-policy/intellectual-property-rights-ipr-attach-program/intellectual?MURL=ipattache> (visited Apr. 29, 2019).

¹⁷⁷ OFF. OF THE U.S. TRADE REP., 2019 SPECIAL 301 REPORT 5 (Apr. 2019) [hereinafter Special 301 Report].

¹⁷⁸ *Id.* at 20. Common names for food products are designated by the Codex Alimentarius Commission, a collaboration of the WHO and the UN Food and Agriculture Organization (FAO). See FOOD & AGRICULTURE ORG. OF THE U.N. AND WORLD HEALTH ORG., UNDERSTANDING THE CODEX ALIMENTARIUS 17 (2016).

¹⁷⁹ Special 301 Report, *supra* note 177, at 20. See also Consortium for Common Food Names, *EU Turns its Back on Codex Cheese Standards by Approving GI for Generic Name*, Dec. 1, 2017, <http://www.commonfoodnames.com/eu-turns-its-back-on-codex-cheese-standards-by-approving-gi-for-generic-name/> (visited Apr. 29, 2019).

¹⁸⁰ Special 301 Report, *supra* note 177, at 20.

international disputes regarding the treatment of generic and common names have arisen with numerous countries.¹⁸¹

F. Technical Standards

A somewhat different recent example of sui-genericide has arisen in the context of technical interoperability standards – protocols like Wi-Fi, Bluetooth and 4G/5G that enable different manufacturers’ products to communicate with each other. In most cases, these standards are developed within trade associations known as standards-development organizations (SDOs), which include ISO (mentioned above), the European Telecommunications Standards Institute (ETSI) and the Institute of Electrical and Electronics Engineers Standards Association (IEEE-SA).¹⁸² Private firms make technical contributions to standards within these SDOs and, once draft standards are advanced to a level suitable for implementation in products, vote to approve and publish standards through the SDO.¹⁸³

1. Trademarks and Technical Standards¹⁸⁴

Though standards largely play a technical role and are implemented in products that are manufactured and sold not by the SDO, but by firms that may or may not be SDO members, the names of standards (referred to here as standard-names) can play an important role in the market for technology products of all kinds.

¹⁸¹ See, e.g., Special 301 Report, *supra* note 177, at 30 and 81 (Costa Rica) and 48 (China).

¹⁸² See, generally, Brad Biddle, *No Standard for Standards: Understanding the ICT Standards-Development Ecosystem*, in CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: COMPETITION, ANTITRUST, AND PATENTS, Ch. 2 (Jorge L. Contreras, ed., 2018) (describing the broad range of SDOs active in technology markets).

¹⁸³ *Id.*

¹⁸⁴ Trademarks relating to technical standards have received relatively scant attention in the literature compared to patents and copyrights. For an overview of the use of trademarks with technical standards, see Jorge L. Contreras, *Trademarks, Certification Marks and Technical Standards* in CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: FURTHER INTERSECTIONS OF PUBLIC AND PRIVATE LAW, Chapter X (Jorge L. Contreras, ed., 2019). In contrast, there is an extensive literature relating to copyrights and patents covering technical standards, including requirements to license those patents on terms that are “fair, reasonable and nondiscriminatory” (FRAND), see Jorge L. Contreras, *Technical Standards, Standards-Setting Organizations and Intellectual Property: A Survey of the Literature (With an Emphasis on Empirical Approaches)*, in RESEARCH HANDBOOK ON THE ECONOMICS OF INTELLECTUAL PROPERTY LAW, VOL. II – ANALYTICAL METHODS (Peter S. Menell & David Schwartz, eds., 2019, forthcoming) (review of literature).

When a consumer shops for a new smartphone, she will likely check whether different models implement a range of common standards such as Wi-Fi, Bluetooth, and 4G (soon 5G). Likewise, the typical consumer knows that when she switches from a phone that is charged using a microUSB connector to one that uses Apple’s “Lightning” connector or the more recent USB-C connector, she will need to replace her charging cables as well. Most consumers have only the vaguest notion of how the standards behind these technologies work. Nevertheless, consumers are familiar with the functionality associated with these simple trade names. The names of technical standards thus fulfill a critical informational role for consumers.¹⁸⁵

SDOs have taken a variety of approaches to protecting standard-names. Most prohibit or discourage the use of existing trademarks in standard-names unless they are used in a descriptive sense (e.g., Protocol for Gizmo Compatibility with Microsoft Windows®).¹⁸⁶ But aside from this general principle, SDOs vary significantly in the ways that they treat their standard-names. Many standard names are simply descriptive terms (e.g., ISO’s well-known ISO 9001:2015 standard titled “Quality Management Systems – Requirements”) or acronyms for descriptive terms (e.g., HDMI, an acronym for High Definition Multimedia Interface).¹⁸⁷ These acronyms are generally not registered or protected as trademarks. Some SDOs (e.g., the Internet Engineering Task Force) have registered trademarks in their organization names (e.g., IETF®), but do not protect the names of their standards at all.¹⁸⁸ Other SDOs (e.g., the European Telecommunications Standards Institute (ETSI)) have registered and maintained trademarks for their standard-names and license these marks for use by manufacturers of standards-compliant products, typically on a broad, royalty-free basis.¹⁸⁹

2. *Standards and Certification*

Some SDOs, rather than protecting their standard-names as trademarks, have instead registered them as certification marks.¹⁹⁰ Bluetooth, for example, is a popular short-range wireless

¹⁸⁵ Contreras, *Trademarks*, *supra* note 184, at x.

¹⁸⁶ *See id.* at *21-22.

¹⁸⁷ [cite web sites].

¹⁸⁸ *See* Contreras, *Trademarks*, *supra* note 184, at x.

¹⁸⁹ *See id.* at *24-25.

¹⁹⁰ *See id.* at *21, Table 2.

connectivity standard published by the Bluetooth Special Interest Group and is registered as a certification mark.¹⁹¹ Likewise, WI-FI (designating the 802.11 series of wireless networking standards published by IEEE) is a certification mark held by the Wi-Fi Alliance.¹⁹² Unlike trademarks, certification marks are intended to identify not the source of a product, but particular characteristics of a product.¹⁹³

Many different characteristics are represented by certifications, including conformity to specified safety requirements, reliability measures, manufacturing processes, sourcing practices and purity/ingredient specifications. In many cases, these certifications provide consumers with information that would not easily be discernable from an outward inspection of the product. For example, consumers looking for “organic” bananas or a kosher delicatessen are likely to rely upon certifications that particular bananas or delis meet these criteria, it being difficult, if not impossible, to verify these facts independently.¹⁹⁴ So long as the certification is issued by a trusted intermediary, then consumers have good cause to believe that the certification signifies genuine compliance with the relevant standard. Certification also provides consumers (and retailers) with assurances regarding the safety of certain types of products (whether electrical equipment or raw vegetables). Seeing a UL certification on an electrical appliance or a USDA seal of approval on a package of fresh produce generally signifies that the product will conform to accepted minimum safety requirements.¹⁹⁵ Such certifications are today a market necessity for many product categories, and are used by several SDOs to signify compliance with their standards.¹⁹⁶

3. *Acts of Sui-Genericide: USB and W3C*

The USB Implementers Forum, Inc. (USB-IF) is a non-profit corporation formed in 1995 by the companies that developed the

¹⁹¹ Mark no.

¹⁹² Mark no.

¹⁹³ See, generally, JEFFREY BELSON, *CERTIFICATION AND COLLECTIVE MARKS* (2017); Margaret Chon *Certification and Collective Marks in the United States* in CAMBRIDGE HANDBOOK ON INTERNATIONAL AND COMPARATIVE TRADEMARK LAW (Jane Ginsburg & Irene Calboli, eds., 2019).

¹⁹⁴ See Margaret Chon, *Marks of Rectitude*, 77 FORDHAM L. REV. 101, xx (2009); Jeanne Fromer, *The Unregulated Certification Mark(et)*, 69 STAN. L. REV. 121, xx (2017).

¹⁹⁵ See, generally, Fromer, *supra* note 194, at x.

¹⁹⁶ See *Board-Tech Electronic Co. v. Eaton Corporation, Cooper Wiring Devices, Inc.*, 2018 WL 2901336, No. 17-3829-cv at *1 (2d Cir. Jun. 11, 2018) (“to be commercially viable, light switches in the United States must undergo certification by Underwriters Laboratories”).

Uniform Serial Bus (USB) standard.¹⁹⁷ USB-IF, which today has over one thousand member companies, supports the advancement and adoption of USB technology.¹⁹⁸ USB-IF owns several trademarks and certification marks relating to the Uniform Serial Bus (USB) standard for interconnecting and charging electronic devices (e.g., CERTIFIED USB¹⁹⁹). Yet USB-IF does not hold a registration for the term USB itself. While USB, as an acronym for a relatively well-known descriptive term (Uniform Serial Bus), would likely be deemed descriptive under the *Abercrombie* framework,²⁰⁰ it is possible that the mark USB, which has been in use for more than twenty years, has developed secondary meaning and has thus acquired distinctiveness. As such, it is not a term without potential value.

Nevertheless, USB-IF has publicly declared that the term USB is generic. For example, in a 2008 opposition proceeding before the TTAB, USB-IF opposed a third party's attempted registration of the mark USB-HOUSE (which lacked any disclaimer as to the term USB) on the ground that the term USB is generic.²⁰¹ In the proceeding, the President and Chairman of USB-IF submitted a declaration stating that the term USB "is the common generic term used to describe a computer port that can be used to connect keyboards, mice, game controllers, printers, scanners, digital cameras, and removable media drives."²⁰² USB-IF also noted that there were more than eighty records in the USPTO's trademark database containing the term USB (e.g., USB NOW, USB REALTIME, FLEXIUSB, etc.), all of which contained a disclaimer of the term USB standing alone. USB-IF succeeded in having the registration for USB-HOUSE denied.

Even more notable is the practice of the Worldwide Web Consortium (W3C). W3C is the primary standardization body for the Worldwide Web and is responsible for fundamental Internet application layer protocols including Worldwide Web (www), Hypertext Markup Language (HTML), and Extensible Markup

¹⁹⁷ USB Implementers Forum, Inc., About USB-IF, <https://www.usb.org/about> (visited Apr. 28, 2019).

¹⁹⁸ USB Implementers Forum, Inc., Members, <https://www.usb.org/members> (visited Apr. 28, 2019).

¹⁹⁹ U.S. Trademark No. 2,592,682 (Jul. 9, 2002).

²⁰⁰ Acronyms for descriptive terms are generally deemed to be descriptive themselves. See Trademark Manual of Examining Procedure § 1209.03(h) ("As a general rule, an acronym or initialism cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym or initialism is readily understood by relevant purchasers to be 'substantially synonymous' with the merely descriptive wording it represents").

²⁰¹ In re. USB-HOUSE (2008).

²⁰² *Id.* at Ex. C.

Language (XML).²⁰³ W3C is an unincorporated coalition of four educational institutions: the Massachusetts Institute of Technology (MIT), the European Research Consortium for Informatics and Mathematics (ECRIM), Keio University and Beihang University.²⁰⁴ Its membership consists of approximately 450 institutions, private firms and other organizations having an interest in standards for the Worldwide Web.²⁰⁵

The acronym W3C is a registered trademark in a number of jurisdictions.²⁰⁶ W3C also holds registered and unregistered trademarks in a number of project names including P3P (the Platform for Privacy Preferences Project) and the Amaya web browser/editor.²⁰⁷ Yet on its web site, W3C expressly identifies twenty additional terms (including the widely-deployed HTML, XML and HTTP standards)²⁰⁸ that it expressly designates as generic.²⁰⁹ W3C states that “Terms which claimed as generic are not governed by any W3C license and are used as common descriptors by the W3C.”²¹⁰

What do USB and W3C hope to achieve through these public statements that, if anything, appear to diminish their ability to control the use of their own marks? The next Part examines the potential rationales and effects of such declarations of sui-genericide.

²⁰³ [cite W3C web site info].

²⁰⁴ W3C, Facts About W3C, <https://www.w3.org/Consortium/facts#org> (visited Apr. 28, 2019).

²⁰⁵ W3C, Current Members, <https://www.w3.org/Consortium/Member/List> (visited Apr. 28, 2019) (listing 448 members).

²⁰⁶ Because W3C is not an incorporated entity, its intellectual property, including trademarks, is held by the Massachusetts Institute of Technology, its host institution. See Jorge L. Contreras, *A Tale of Two Layers: Patents, Standardization and the Internet*, 93 DENVER L. REV. 85, xx (2016) (describing W3C legal structure).

²⁰⁷ Worldwide Web Consortium (W3C), W3C Trademarks and Generic Terms, <https://www.w3.org/Consortium/Legal/2002/trademarks-20021231> (2019) (visited Apr. 28, 2019) [hereinafter W3C Trademark Page].

²⁰⁸ *Id.* HTML is an acronym for “hypertext markup language”, XML is an acronym for “extensible markup language” and HTTP is an acronym for “hypertext transmission protocol”.

²⁰⁹ W3C Trademark Page, *supra* note 207 (designating the following terms as generic: ACSS, CSS, DOM, DSig, HTML, HTTP, JEP, MathML, Metadata, PICS, PICSRules, RDF, SMIL, SVG, WebFonts, XENC, XHTML, XML, XMLDSIG and XSL).

²¹⁰ W3C Trademark Page, *supra* note 207.

III. UNDERSTANDING SUI-GENERICIDE

As described in Part II, sui-genericide – the voluntary declaration of potentially valuable terms as generic – has been observed in a range of contexts from common names for pesticides and synthetic fibers to broadly adopted technical standards. This Part explores the rationales leading private firms to relinquish rights to these potentially valuable terms, and how sui-genericide compares to other mechanisms that allow the broad usage of common terms.

A. Market Rationales for Sui-Genericide

After World War II, the growth of American manufacturing industries led to the emergence of markets for novel products. Thus, unlike wool and cotton which had existed for centuries, new synthetic fibers like nylon and polyester were being invented and sold to the public. At the same time, governmental regulators like the FTC began to impose disclosure and labeling requirements to safeguard public health and safety and to inform consumers about the content of products they were buying.

Thus, manufacturers, regulators and consumers were united in their desire to find new generic terms to refer to the basic categories of new products entering the market. The broad recognition of these generic terms would accomplish three interrelated purposes for manufacturers: (1) giving them a common lexicon with which to describe the complex characteristics of their products (e.g., chemical composition and functional effect), (2) enabling them to build brand recognition and loyalty through proprietary names that would thus be less likely to fall to genericide challenges, and (3) preventing others from capturing generic terms used to describe their product categories. By the same token, allowing a particular manufacturer to capture the generic term for a product would not only harm competitors, but make it more difficult for regulators to convey important safety information to the public, and for consumers to understand the features of the products they were purchasing.²¹¹

For example, suppose that the name NYLON were registered as a trademark by a particular manufacturer. Other manufacturers wishing to describe the fiber content of their products could not use the term NYLON unless they wished to refer to fiber produced by the owner of the mark. As a result, they would be forced to describe their nylon-containing products using the much more cumbersome

²¹¹ See Landes-Posner model, discussed in Part x, *supra*.

chemical names for the fiber, such as polyhexamethylene adipamide, polycaproamide or polyundecanamide.²¹² The use of these complex chemical names would not only disadvantage competing nylon manufacturers, but would also be less informative to consumers, who would be less likely to remember the characteristics of the fiber when identified by such a complex name.

Accordingly, the government took an active hand in organizing early naming efforts in fields such as prescription drugs, pesticides and synthetic fibers. The centralized organizational frameworks and rule structures used to develop these names were familiar to scientists and technicians from a range of disciplines, as they resembled much older organizational structures that had been in place since at least the eighteenth century to assign widely-accepted common names to newly discovered astronomical bodies,²¹³ chemical elements,²¹⁴ and plant and animal species.²¹⁵ The difference, of course, between these older naming systems and product generic names is that a new heavenly body or species of bacteria will seldom have significant commercial value, whereas a new prescription medication or clothing fiber could have substantial value. Private industry thus took a leading role in developing and approving common names for new product categories and, as described in Part II, eventually took over this role entirely from the government.

Outwardly, the designation by SDOs of certain standard-names as generic resembles the coordinated sui-genericide activities by participants in industries like pharmaceuticals and pesticides. SDOs are, after all, trade associations comprising industry participants interested in particular technologies who coordinate to develop technical standards for use by all product manufacturers. If the principal developers of USB technology agree to treat the term USB as generic, free from trademark appropriation, then the term could be used freely by all manufacturers of computer peripherals and devices implementing the USB standard. The manufacturers could then differentiate their own product offerings using proprietary brand marks (e.g., the *Rosewill® USB 7-port Hub* or the *SanDisk Cruzer USB 2.0 Flash Drive*).

²¹² See ISO 2076-1977 (E) at 4 (definition of nylon).

²¹³ Astronomical bodies are named by the International Astronomical Union. See Intl. Astronomical Un., *Naming of Astronomical Objects*, <https://www.iau.org/public/themes/naming/>.

²¹⁴ See International Union of Pure and Applied Chemistry, Periodic Table of Elements, <https://iupac.org/what-we-do/periodic-table-of-elements/#a4> (visited Apr. 29, 2019).

²¹⁵ See, e.g., MICHAEL OHL, *THE ART OF NAMING* (English trans. Elisabeth Lauffer, 2018).

In fact, the case for sui-genericide of technical standard-names may be even more clear than it is in other markets. While SDOs create and publish standards that are embodied in a wide range of products – smartphones, cars, telecommunications satellites – SDOs neither manufacture these products nor any components included in them. Instead, they publish documents laying out the protocols necessary to make these products interoperate with one another. Thus, ETSI has published numerous versions of the fourth generation (4G) long term evolution (LTE) standard for wideband wireless communication, and holds trademark registrations for LTE in various countries. However, ETSI itself does not manufacture or sell LTE-compliant products. Smartphones that can connect to the LTE network are manufactured by firms like Apple, Samsung, and many others, each of which is licensed by ETSI to utilize the LTE mark on its LTE-compliant products. And the microchips that enable LTE functionality in these smartphones are sold by vendors like Qualcomm. So if a trademark is intended to indicate source, what source is being indicated by Samsung's use of the LTE mark to indicate that its smartphones contain Qualcomm chips that contain LTE technology? Certainly, use of the LTE mark says nothing about the source or quality of the smartphone, except that it presumably conforms to ETSI's LTE standard.²¹⁶ Thus, the value of trademarks on standard-names is questionable.

B. *Doctrinal Effects of Genericide*

If a term is generic, it describes a product characteristic without indicating its source. A zipper, an escalator, a cellophane wrapper – all of these products and product features may be described by anyone making a product with the relevant characteristics. So, just as an apparel maker may claim that “This travel vest has five zippered pockets”, a product manufacturer may claim “This laptop offers four USB ports”. To make this claim, the statement should be true, but the manufacturer need not obtain the permission of the owner of a particular mark or pass any particular certification test.

²¹⁶ Ultimately, the reason that SDOs register standard-names as trademarks may trace its roots to the standards documents themselves. In many respects, SDOs act like publishers: they sell (or sometimes make freely available) copies of their standards. And, like publishers of books, music and other copyrighted content, piracy of standards documents is a real concern for many SDOs (see Contreras, *Trademarks*, *supra* note x, at *16-17, 21 (discussing piracy and protection of copyrighted standards). Thus, SDOs that anticipate the need to assert rights against unauthorized publishers of their standards may find the registration of trademarks to be helpful in enforcing such rights.

The manufacturer may simply assert, on a factual basis, that the relevant feature is offered.²¹⁷

The genericness of a term also precludes others from registering it as a mark, and poses obstacles to registering it as part of a mark without disclaiming the generic term. Thus, as discussed above,²¹⁸ USB-IF successfully challenged an applicant's application for the mark USB-HOUSE when the term USB itself was not disclaimed. But this result required both that USB-IF monitor and become aware of the threatened registration, and that it then intervene at the TTAB, neither of which is cost-free. Yet even this option does not prevent the use of the generic term in marks, it only prevents the registrant from claiming rights in the generic term used independently. Thus, as USB-IF noted in the USB-HOUSE dispute, there are more than 80 registered marks that incorporate the generic term USB.²¹⁹

These results suggest that generic terms can be incorporated more freely than trademarks into combination marks, either with or without disclaimers. The diversity of names and terms that emerge can be viewed as a positive effect: an opening, as it were, in an otherwise narrowing trademark universe; a growth of the trademark commons. This proliferation of marks might not be possible save for the genericness of the underlying mark. And the desire for private actors such as W3C and USB-IF to open the market to broader uses of these otherwise protectable terms can be analogized to similar gestures toward the public domain made by firms with respect to patentable technologies and copyrighted works.²²⁰

These principles are consistent with the economic model developed by Landes and Posner. In order to maximize consumer surplus, generic terms must remain available to all competitors to describe general categories of goods and services, which can then be differentiated on the basis of individual firm branding. But the classification of terms as generic, and thus beyond the scope of trademark protection, cannot be unbounded. As Landes and Posner show, trademarks themselves provide value to consumers in terms of reduced search costs. Thus, maximizing consumer surplus involves both the recognition of non-generic terms as trademarks, and the availability of generic terms to describe general categories of goods and services.

²¹⁷ The same result obtains under a nominative fair use analysis, but the use of a generic term avoids the necessity to contend with the still-unclear standards for nominative fair use in the U.S.

²¹⁸ See notes x, *supra*, and accompanying text.

²¹⁹ List examples

²²⁰ See notes x, *supra*, and accompanying text.

Thus, to the party that wishes to expand the universe of terms that may be used in commerce, a determination that a mark is generic offers advantages over simply declining to register a mark in the first place. Non-registration leaves the potentially generic term open to registration and enforcement by others, a risky proposition. The finding that a mark is generic, on the other hand, has *erga omnes* effect – one that impacts all possible registrants and users of the mark. As such, like defensive publication in the patent realm,²²¹ genericide does more than eliminate the first user’s ability to exploit a term. It returns the term to the public.

C. Certification versus Genericide

But what about certification marks? As discussed in **Part x** above, the owner of a certification mark may specify relevant quality or functionality features of a product (e.g., organic, kosher), so that the manufacturer of any compliant product may designate its product using the mark. Use of a certification mark thus informs consumers that the marked product conforms with the relevant certification standards, and also allows different manufacturers to compete on the basis of price, size and other product features (e.g., Chiquita versus Dole organic bananas). An additional benefit to consumers is that the owner of the certification mark must make some effort to police the use of its certification mark, thus establishing at least some baseline for reliance on the mark.

But are the same guarantees regarding product characteristics and safety required for the types of products that have been subject to sui-genericide declarations? As discussed in Part II, the manufacture and marketing of pharmaceuticals, pesticides and synthetic fibers are all regulated by governmental agencies. This regulation, coupled with a range of private remedies for false advertising, misrepresentation and consumer fraud, may give consumers the assurances that they need regarding the accuracy of product labeling, and thus reducing the need for separate certification through trademark law. For example, suppose that a firm marketed a product labeled as containing ibuprofen, but its active ingredient did not conform to the WHO’s INN definition of ibuprofen. This act – whether arising from negligence or deception -- would subject the firm to a barrage of liability claims, from FDA enforcement actions to consumer and competitor lawsuits for false advertising to tort claims for any resulting injuries or health effects.

²²¹ See note x, *supra*.

It is unlikely that a certification mark for IBUPROFEN, whether held by a trade association or another private firm, would appreciably increase the incentives to label a product accurately as containing ibuprofen.

The need for certification appears equally uncertain in the area of technical standards. Certainly, compliance with key interoperability standards is an important feature of many products. When a computer is advertised as including Bluetooth capability, a consumer is justified in relying on that representation in making a purchasing decision. In this sense, one might argue that having an independent certification that a laptop incorporates Bluetooth technology is useful to consumers. Yet a laptop computer embodies hundreds of standards²²² and thousands of features and functionalities in addition to interoperability standards. If these features do not work as promised, it is not difficult to construct a theory under which the consumer should be entitled to recover (e.g., breach of implied warranty, false advertising, etc.). Moreover, every consumer need not test a product's features for himself or herself. Once a product is found not to conform to its advertised features, online reviews, retailer pressure, consumer protection regulators and consumer litigation may all combine to push manufacturers to label product features accurately. In these cases, independent certification also adds little to manufacturer incentives to advertise product features accurately.

Thus, certification and certification marks may not be all that necessary in product categories that are either heavily regulated or in which the presence or absence of a product's advertised features is discernable by consumers or consumer protection groups. Whether the product is ibuprofen or nylon or a USB device, the user of the term has a duty to represent its product fairly and accurately. If it does not, then a range of regulatory and tort remedies are available.

And another implicit function of certification marks – precluding a third party from obtaining trademark protection on the same mark – can more easily and cost-effectively be achieved through sui-genericide. That is, a declaration of sui-genericide does not require the operation of a certification program or even the registration and maintenance of certification marks. Sui-genericide may thus function like a poor man's certification. It enables the

²²² See Brad Biddle, Andrew White & Sean Woods, *How Many Standards in a Laptop? (And Other Empirical Questions)*, 2010 INT'L TELECOMM. UNION SEC. TELECOMM. STANDARDIZATION, KALEIDOSCOPE ACAD. CONF. PROC. at 3 (finding 251 standards embodied in an out-of-the-box laptop computer).

name of a common product feature or characteristic to be used broadly within the marketplace, without the cost or legal overhead of certification.

D. Sui-Genericide versus Nominative Fair Use

Under the nominative fair use doctrine, as it has developed in the U.S. and elsewhere, a third party may use and display another's trademark in a manner that is non-deceptive and that does not imply endorsement by the mark owner when referring to the products or services of the mark owner.²²³ Thus, an automotive repair shop may use the trademarked word VOLKSWAGEN to advertise that it repairs Volkswagen automobiles, so long as it does not imply that it has been endorsed by Volkswagen and uses only so much of the mark as is necessary to convey the relevant information.²²⁴

One could thus argue that sui-genericide is not necessary, as the broad use of terms like ibuprofen and USB on products with relevant features, even if these terms were owned as trademarks, could be permitted as nominative fair use. But one must then pose the converse question: why expend the resources required to register and maintain a trademark when its primary purpose will be to be used on products manufactured by others under the nominative fair use doctrine. Sui-genericide offers an inexpensive and effective means to achieve a result similar to that achieved through trademark protection coupled with nominative fair use.

IV. LEGAL FRAMEWORKS FOR SUI-GENERICIDE

If benefits can flow from recognition of marks as generic, then it is worth considering whether and how the practice of sui-genericide could be formalized and made available to parties that would like to avail themselves of it. This Part first assesses the legal effect of sui-genericide statements, and then assesses potential legal frameworks that could enhance the enforceability of these commitments.

²²³ See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:11 (4th ed. 2008); William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008).

²²⁴ See *Volkswagen v. Church* (9th Cir. 1969) (“[In] advertising the repair of Volkswagens, it would be difficult, if not impossible, to avoid altogether the use of the word Volkswagen or its abbreviation ‘VW’, which are the normal terms which, to the public at large, signify [the mark owner’s] cars.”)

A. *Legal Effect of Unilateral Declarations*

As discussed in Part I, a mark will be deemed generic if it has come to describe a general class of goods or services: an escalator, a trampoline, a zipper. In each of the many genericide cases on the books, either the PTO or a challenger presented evidence to demonstrate that the challenged mark was, indeed, generic. But in each of these cases the applicant or registrant sought to rebut this evidence, and in some cases did so successfully, thereby fending off the charge of genericism.²²⁵ A question that does not appear to have arisen yet is the legal effect of a party's own admission of genericism. In each of the sui-genericide examples described in this article, the declarant's conclusory statement is not accompanied by consumer surveys, bibliometric analyses or dictionary definitions. It is, rather, a unilateral statement of a legal conclusion by a party (or a group) that is, at a minimum, interested in the outcome. To what degree can, or should, we trust an entity that unilaterally claims that a term is generic?

Absent a formal abandonment mechanism, such as exists under copyright and patent law, unilateral declarations are given little weight by the law. Certainly, few would give credence to PepsiCo's unsubstantiated and self-serving declaration that COKE is a generic term for a cola beverage. Why should we give greater weight to such a statement if it is made by The Coca Cola Company? That is, can a firm simply declare, without producing relevant evidence, that its own mark has become generic, without the question being adjudicated by a competent finder of fact or law?

Pulling this thread further, could such a declaration be used against others who later sought to register a mark similar to, or incorporating, the self-declared generic term? That is, even if a firm's unilateral declaration regarding the generic nature of a term could impact that firm's ability to register or enforce such a term as a mark, could such a declaration have preclusive effect against others? The answer to most of these questions today, it seems, is no.

B. *Non-Recognition of Sui-Genericide in Trademark Proceedings*

Likewise, the USPTO has never recognized the legal effect of a proposed trademark's inclusion on a list of generic names, whether published by WHO, USAN, ISO or even the FTC. As noted in Part x, above, the USPTO *Manual of Trademark Examining Procedure*

²²⁵ See, e.g., Google, Comic.com

(TMEP) makes no mention of USAN or the WHO INN program, nor does it instruct trademark examiners to consider whether the inclusion of a proposed trademark on such a list of common names should give rise to any presumption of genericness.

In the single Trademark Trials and Appeal Board (TTAB) case mentioning USAN International Drug Names,²²⁶ Smithkline Beecham opposed a Danish firm's U.S. application to register the mark TOPOTECT for a human and veterinary cancer treatment.²²⁷ It argued that the term TOPOTECT was only "a slight misspelling, abbreviation, or variation of the generic term 'topotecan'," which is listed by USAN (in the form *topotecan hydrochloride*) as a generic term for a topoisomerase inhibitor chemotherapy drug.²²⁸ Smithkline Beecham emphasized that "both the World Health Organization and USAN strongly discourage the use of USAN and INN generic terms as trademarks."²²⁹ While the TTAB acknowledged that topotecan is a generic term for a pharmaceutical chemotherapy agent, it did not find that the proposed mark TOPOTECT would be perceived by the public as a misspelling or abbreviation of topotecan.²³⁰ Thus, while the challenged mark was not found to be generic in this case, it at least offers some indication that the USPTO may take cognizance of the designation of a term as a generic or common name on a recognized registry or list, even if only as one piece of evidence supporting a claim for genericide.

What's more, the fact that the TOPOTECT case, a nonprecedential TTAB decision, is the only U.S. trademark case in which an applicant sought to register a USAN common drug name or a variant thereof suggests that industry norms surrounding the registration of common drug names is quite strong. In other words, if industry participants did not view USAN common names as off-limits for trademark protection, then one might expect a greater number of attempts to register these names as trademarks and a concomitant number of TTAB and judicial challenges to those registrations. The

²²⁶ Searches for "World Health Organization" and "USAN" on LEXIS "All Trademark Law Cases" and "All Trademark Law Administrative Materials" conducted on Apr. 28, 2019 resulted in only one case that mentioned a USAN common name in connection with a genericism challenge to a trademark. The WHO INN program was not mentioned at all.

²²⁷ Smithkline Beecham PLC v. TopoTarget ApS Corp., 2004 TTAB LEXIS 504 (Sept. 2, 2004) (nonprecedential).

²²⁸ *Id.* at *10-*12. As noted by the TTAB, a "misspelling or variation in a few letters is far too little to turn a generic term into a protectable trademark". *Id.* at *12 (citing, *inter alia*, In re Organik Technologies Inc., 41 USPQ2d 1690 (TTAB 1997) (ORGANIK phonetic equivalent to misdescriptive term "organic")).

²²⁹ *Id.* at *14.

²³⁰ *Id.* at *23-24.

relative quiet in this small corner of an otherwise litigious industry suggests that declarations of sui-genericide, at least in the pharmaceutical industry, are respected by the players in that industry.

C. *Reliance and Estoppel*

In several of the examples of sui-genericide discussed in this article, the initial proposal for a generic or common name must be submitted in writing, often on a standardized application form. For example, as discussed in Part II.C, the application form for common pesticide names required the applicant to commit not to claim trademark rights in the proposed common name and to obtain a commitment from any relevant trademark holders that the name would be made available “for unrestricted use.”²³¹

While such a unilateral statement would probably not be considered a binding contractual commitment, it could have legal effect under the doctrine of promissory estoppel if others reasonably relied on it.²³² Thus, if other members of the relevant naming committee relied on the applicant’s representation that a proposed common name was not, and would not be, subject to a trademark application when they approved the term as a common name, then the applicant might later be estopped from asserting that trademark against others or from arguing that the name was not generic.²³³

For example, although the U.S. firms that submitted terms to the Bureau of Foreign Commerce Generic Word Program did not themselves make any express representation or commitment regarding the generic nature of those terms, the Bureau required some degree of evidence that the terms were “regarded as generic by the United States industry for the particular types of products on which they are used.”²³⁴ Because it is plausible to assume that this evidence could also have been used to oppose a U.S. registration of

²³¹ See note 155, *supra*, and accompanying text.

²³² See RESTATEMENT (SECOND) OF CONTRACTS § 90(1) (1981) (“[a] promise which the promisor should reasonably expect to induce action or forbearance on the part of the promisee or a third person and which does induce such action or forbearance is binding if injustice can be avoided only by enforcement of the promise.”)

²³³ A similar theory has been proposed in connection with the enforcement of unilateral commitments to license patents that are essential to technical standards on terms that are fair, reasonable and non-discriminatory (FRAND). See Contreras, *Market Reliance*, *supra* note x, at 541-46 (arguing that the makers of such commitments should be legally bound by them under a novel “market reliance” theory, notwithstanding the difficulty of proving actual reliance by market participants).

²³⁴ Travaglini & Lightman, *supra* note 101, at 743.

the submitted terms, one can also assume that the firms seeking to prevent the foreign registration of the term effectively conceded the genericness of the term in the United States. That is, the American auto manufacturers who submitted the term DIESEL to the Bureau could not realistically have expected to obtain a registration of the term DIESEL. Thus their submission of terms to the Generic Word Program had the practical effect of an admission of genericness or, in the alternative, a commitment not to seek registration of the submitted terms.

While such arguments might prevail against the applicant for a particular common or generic name, it is less clear that a promissory estoppel theory would prevent non-applicants from using a common name as a trademark. In considering this question, it is worth analyzing separately other members of the relevant naming committee and uninvolved third parties.

Each of the examples of sui-genericide discussed in this article involves the collective action, or at least acquiescence, of a group of interested parties. Thus, with regard to the Generic Word Program, suggestions for generic words were made to the Bureau by the USTA, which received these suggestions from its member companies. Proposals for generic or common names for pharmaceuticals, pesticides and synthetic fibers, are made by individual firms, but are then evaluated and published by committees consisting of members from multiple industry participants, government and academia (WHO and the USAN Council for pharmaceuticals, ISO/TC 81 for pesticides and ISO/TC 38 for synthetic fibers). Likewise, statements of sui-genericide for technical standards have been made by SDOs (USB-IF and W3C), which are, in effect, trade associations consisting of hundreds of industry participants.

It is possible that by participating in such a group (whether a group dedicated to developing common names such as ISO/TC 81 or an SDO responsible for all aspects of a standard such as USB or HTML), members of the group could be argued to have committed themselves not to register any name designated as generic by the group. While this commitment may be weaker than that of the original applicant for a particular generic name, such an agreement could be implied from group membership through a promissory estoppel theory.²³⁵

²³⁵ Such an argument has also been made in the context of FRAND patent licensing commitments made within SDOs that do not have formal contractual arrangements among their members. See Contreras, *Market Reliance*, *supra* note x, at 496-97 (discussing “voluntary SDO declarations” at SDOs such as IETF).

Even more difficult, however, is the case of non-participants in the naming group. These parties have no explicit or implicit commitment to avoid the registration of a common name as a trademark.²³⁶ Thus, in the TTAB matter involving the mark TOPOTECT, the applicant, a Danish company, did not participate in the USAN naming process. Smithkline Beecham, however, which marketed a *topotecan hydrochloride* product under the brand name Hycamtin, clearly avoided use of the *topotecan* generic name in its brand name.

For all of these reasons, the treatment of common names as generic on an *erga omnes* basis would result in a significantly more robust exclusion of such names as trademarks. One way to achieve this effect is through cancelation of the relevant mark.

D. Cancelation Proceedings

As discussed in Part I.B, above, a registered mark may be challenged on the basis of genericism in a cancelation proceeding by “a person who believes that he is or will be damaged” by such registration.²³⁷ In order to establish standing to bring a cancelation proceeding, such a person must allege a “direct and personal stake” in the outcome of the proceeding,²³⁸ and while actual damage need not be proved to establish standing, the person’s belief that he or she has been damaged must be more than subjective.²³⁹ In addition, a registered mark that its owner seeks to enforce may be challenged as generic by an alleged infringer as an affirmative defense to the claim of infringement.²⁴⁰ But none of these administrative or litigation genericism challenges to registered marks can be initiated by a mark owner or other interested party. Such cancelations currently require action by a third party – either through direct

Membership in a group that collectively commits to treat designated names as generic could also be analogized to a “coordinated pledge” made with respect to patents. See Contreras, *Patent Pledges*, *supra* note 10, at 564-69.

²³⁶ In the case of SDO FRAND commitments, such non-participating parties have been referred to as “outsiders” – market actors that do not participate in SDOs and are thus not bound by the FRAND and other commitments made by SDO participants. See Jorge L. Contreras, *When a Stranger Calls: Standards Outsiders and Unencumbered Patents*, 12 J. COMPETITION L. & ECON. 507, xx (2016).

²³⁷ 15 U.S.C. § 1064.

²³⁸ *Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

²³⁹ *Ritchie*, 50 USPQ2d at 1027. See also TTABMP §§ 303.03-04 (June 2018).

²⁴⁰ See notes x, *supra*.

opposition to the mark or an infringement in which it counterclaims by challenging the mark as generic. Moreover, even under these circumstances, litigation is costly and requires active and determined parties, which might not always be available.

This is the reason that groups like the Proprietary Association began more than a half century ago to oppose foreign trademarks and applications for what they perceived to be generic terms important to U.S. business.²⁴¹ The need for intervention also gave rise to the Bureau of Foreign Commerce Generic Word Program.²⁴² Though the Bureau did not itself initiate proceedings to oppose or cancel foreign trademarks or applications, it did provide an expert, central clearinghouse for petitioning foreign governments to deny trademark protection for words believed by U.S. companies to be generic. And while both of these efforts focused on foreign trademark filings, the FTC's cancellation action against the U.S. trademark FORMICA arose from similar considerations.²⁴³ In all of these cases, actions to cancel registrations for generic marks were made at the request or suggestion of private sector actors operating in the relevant industry.

For a variety of reasons, most likely involving cost and changing government priorities,²⁴⁴ each of these governmentally-sponsored genericide programs had been discontinued by the 1980s. Thus, unless governmental priorities and resources are re-aligned to support a broad program of genericide challenges to U.S. marks, direct cancellation proceedings are unlikely to re-emerge as a significant avenue for eliminating generic marks. The focus thus returns to mechanisms for strengthening the legal enforceability of sui-genericide declarations.

E. Toward Greater Legal Recognition of Sui-Genericide

As noted above, there is currently no reliable way under U.S. law to ensure that commonly-agreed generic terms are not registered as trademarks. This Part offers some modest proposals intended to enhance the legal effect of declarations of sui-genericide.

²⁴¹ See Part II.A, *supra*.

²⁴² See *id.*

²⁴³ See note 63, *supra*.

²⁴⁴ See Part II.E, *supra*, discussing U.S. government disengagement from private standardization efforts.

1. Consensus Lists in Trademark Examination

Though the lists of common names developed by the WHO's INN program, the USAN Council, and ISO committees addressing pesticides and synthetic fibers do not themselves have legal effect, they demonstrate that industry-led coalitions can develop consensus lists of common names for new products that are of concern to them. One way to lend greater legal effect force to these lists (which I term "Consensus Lists") would be to enact federal legislation or regulation officially recognizing Consensus Lists for purposes of trademark examination and challenge. That is, trademark examiners could be directed, to inspect Consensus Lists during the examination process to ascertain whether trademark applications contain terms that have been determined by relevant industry groups to be generic. This relatively modest step in the trademark examination procedure would shift much of the burden of identifying applications for generic terms from competitors and other interested observers (e.g., the private firms who petitioned the USTA to approach the Department of Commerce during the Generic Word Program) to the examination process, where it could arguably be accomplished more efficiently and comprehensively. The examiner's consultation of Consensus Lists during examination could also screen out trademarks on commonly accepted generic terms prior to registration, thus avoiding the need for more costly opposition and cancellation proceedings after trademarks have been issued.

In order to elicit the greatest amount of relevant evidence during examination, it would also be useful for the examiner to notify the relevant naming body when he or she identifies a potential mark that is identical or confusingly similar to a common name included in a Consensus List. This notice would make the naming body aware of the potential trademark and enable it to produce evidence regarding the duration and extent of generic use of the name in the industry.

2. A Presumption of Genericism

A requirement that the generic names included in Consensus Lists be considered during the trademark examination process would ensure that these generic names are not overlooked by the trademark examiner. However, the work of consensus-based naming groups could be given even greater legal weight if a legal presumption were created, either through federal statute or judicial action, that the names included in such Consensus Lists be accorded a rebuttable presumption of genericism for all purposes, including in litigation. That is, if a common name is included in a Consensus List it would be presumed to be generic, and an application that

sought to register that common name (or a term confusingly similar to a common name) would be deemed ineligible for registration unless the applicant presented convincing evidence that the requested mark was distinctive.²⁴⁵ This requirement would serve to flush out, at an early stage, any evidence held by the applicant that its proposed mark is not generic.

Such a presumption of genericness need not be limited to the trademark examination stage. It could also provide benefits in trademark oppositions and cancellation proceedings. That is, just as in an examination, a common name appearing in a Consensus List would be presumptively generic for purposes of challenging a trademark that was identical or confusingly similar to the common name. As a result, such trademarks would be susceptible to cancellation unless the registrant could produce convincing evidence that the term is distinctive as to source and not generic.

An alternative approach might defer the presumption until some time period (e.g., five years) has elapsed during which the common term has remained on the list without challenge (e.g., by the owner of a mark issued before the designation of the mark as a common term). This waiting period would be similar to the period that descriptive marks must wait to acquire distinctiveness before becoming registrable on the Principal Register.²⁴⁶ The value of such a waiting period would be to ensure the stability of the entries on the Consensus List that are accorded a presumption of genericness, particularly if there is a public comment or challenge period after entries first appear on the list.

The creation of a presumption of genericness would give substantial weight to the sui-genericide declarations made via Consensus Lists. In many ways, this weighing of the scales seems fair, given both the overall efficiencies to be achieved by preventing the capture of generic terms as trademarks, and the persuasive weight of an industry consensus regarding the terminology of the relevant field.

3. *Due Process in the Development of Consensus Lists*

Naturally, if Consensus Lists are to be accorded significant legal deference, as proposed in the preceding discussion, then it is

²⁴⁵ See, e.g., *Smithkline Beecham PLC v. TopoTarget ApS Corp.*, 2004 TTAB LEXIS 504 (Sept. 2, 2004) (nonprecedential) (considering whether the proposed mark TOPOTECT was only “a slight misspelling, abbreviation, or variation of the generic term ‘topotecan’”).

²⁴⁶ Lanham Act §§ 23-28, 15 U.S.C. §§ 1091-1096.

particularly important to ensure that the development of such Consensus Lists is conducted in a manner that will be deemed to be representative of the relevant industry and not organized to advantage particular competitors or commercial interests.²⁴⁷ Thus, even if significant deference is given to the determinations of consensus-based naming bodies, this deference must be tempered with due regard to potential anticompetitive conduct by such groups.

In order to assure a suitable level of representativeness among the developers of Consensus Lists, it would not be unreasonable to require that consensus-developing groups, and their procedures, comply with certain minimum “due process” procedures and requirements in order to be recognized. Such due process requirements are already imposed on SDOs in many contexts, and include requirements that such organizations operate on an open, balanced and transparent basis, that standards are developed based on consensus-based processes, and that mechanisms exist for participants to appeal or contest particular decisions.²⁴⁸ Likewise, such due process mechanisms are required of any SDO that wishes to be accredited by the American National Standards Institute (ANSI) as a developer of American National Standards.²⁴⁹ The review of such groups and procedures could be conducted by a governmental agency such as the USPTO or the National Institute for Standards and Technology (NIST), or an impartial non-governmental agency such as ANSI.

At the outset, official recognition of Consensus Lists could be conferred selectively on lists of names developed by well-established naming groups such as those discussed in this article (e.g., USAN Council (pharmaceuticals), ISO/TC 81 (pesticides) and

²⁴⁷ Unfortunately, industry groups have been known throughout history to engage in coercive and collusive practices designed not to further the best interests of the industry, but to advantage particular competitors or groups of competitors. See, e.g., George S. Cary & Daniel P. Culley, *Concerted Action in Standard-Setting* in CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: COMPETITION, ANTITRUST, AND PATENTS, 78 (Jorge L. Contreras, ed., 2018) (describing cases of anticompetitive collusion in standard-setting).

²⁴⁸ These “due process” characteristics are generally required in order for SDOs and their standards to be recognized by certain governmental bodies and are viewed as prudent, if not mandatory, to operate in compliance with applicable antitrust and competition laws. See Justus Baron et al., *Making the Rules: The Governance of Standard Development Organizations and their Policies on Intellectual Property Rights*, JRC Science for Policy Report EUR 29655 at x (Mar. 2019).

²⁴⁹ AM. NAT’L STANDARDS INST., ANSI ESSENTIAL REQUIREMENTS: DUE PROCESS REQUIREMENTS FOR AMERICAN NATIONAL STANDARDS § 3.1.1, 10–11 (2019) [hereinafter ANSI Essential Requirements] (an SDO must conform to the ANSI Essential Requirements in order to be recognized as a developer of American National Standards).

ISO/TC 38 (textiles)) as well as recognized SDOs such as USB-IF and W3C. Later, a procedure could be established whereby additional groups could apply for such recognition after demonstrating their representation of a significant industry sector and their compliance with the due process requirements described above.

Another question relevant to this proposal is whether declarations of sui-genericide should be accepted not only from representative industry bodies, but also from individual firms or persons. For example, could Adobe unilaterally declare, with the same legal effect as an international naming body, that its mark PDF is generic? Many of the same justifications for allowing collective declarations exist with respect to such unilateral declarations. However, one could argue that the law should give less weight to unilateral declarations than to declarations that represent a consensus view of a particular industry. That is, while a unilateral declaration may represent the view of one particular company, other companies in the industry may disagree (perhaps vehemently) with the declaring company's assessment of a term as generic (consider the Pepsi-Coke hypothetical posed in Part IV.A above). With a Consensus List, so long as the naming body is sufficiently representative of the relevant industry, there is a greater likelihood that the terms selected as generic would have more general acceptance and less opposition from competitors.

4. *Implementation: Legislation versus Regulation*

The proposals outlined in this article with respect to the consideration and recognition of Consensus Lists could be implemented in several ways. First, and most directly, Congress could amend the Lanham Act to impose such requirements on the USPTO and to create a legal presumption of genericness associated with names included on Consensus Lists. However, Congressional action – always difficult and complex to achieve -- is not necessarily required to effectuate many of the components of this proposal.

With regard to the consideration of generic names included in Consensus Lists during trademark examination, the USPTO could implement such a requirement through amendments to the Rules of Practice in Trademark Cases,²⁵⁰ codified in the Code of Federal Regulations (CFR) and modified frequently through agency notice and comment rulemaking.²⁵¹ It is also possible that at least a

²⁵⁰ 37 C.F.R. Part 2- Rules of Practice in Trademark Cases.

²⁵¹ See U.S. Pat. & Trademark Off., Rule Making: Trademark Federal Register Notices and Comments, <https://www.uspto.gov/trademark/laws->

requirement that trademark examiners consult Consensus Lists during trademark examination could be effected through a simple amendment to the *Trademark Manual of Examining Procedure*,²⁵² a comprehensive guidance document for trademark examiners, applicants and attorneys that is updated frequently.²⁵³ While an amendment to the TMEP could not create a general presumption of genericness arising from declarations of sui-genericide, it would be a relatively painless first step that could, at a minimum, serve to direct examiner attention to such declarations – a significant improvement over current practice.

5. *International Harmonization*

As indicated by continuing efforts of the USTR in the area of foreign registration of generic and common names,²⁵⁴ there is little international harmonization of the treatment of generic and common names.²⁵⁵ Yet the development of common names in an increasing array of product categories is international in nature.²⁵⁶ It would thus be worthwhile for the USTR and USPTO to urge their foreign counterparts, through existing international cooperative channels, to consider the adoption of the examination and presumption proposals discussed in Subparts 1 and 2 above with respect to Consensus Lists of common names.

The recognition of consensus-based common names as ineligible for trademark registration is not unknown internationally, and in fact many foreign trademark offices give greater deference to such common names than the USPTO. For example, The EU Intellectual Property Office treats as non-registrable “trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union

regulations/rule-making-trademark-federal-register-notices-and-comments (accessed May 19, 2019).

²⁵² TMEP, *supra* note 52.

²⁵³ See U.S. Pat. & Trademark Off., Trademark Manual of Examining Procedure – Files and Archives, <https://www.uspto.gov/trademark/guides-and-manuals/tmep-archives> (accessed May 19, 2019) (TMEP updated 17 times since 2010).

²⁵⁴ See Part II.E, *supra*.

²⁵⁵ For a discussion of the need for greater international harmonization in the recognition of foreign language generic terms, see Brauneis & Moerland, *supra* note 107.

²⁵⁶ E.g., the WHO INN program for pharmaceutical common names (see Part II.B, *supra*), ISO/TC 38 for textile fibers (see Part II.D, *supra*), ISO/TC 81 for pesticides (see Part II.C, *supra*), the Codex Alimentarius Commission for foodstuffs (see note 178, *supra*), and a range of technology-focused SDOs including W3C, ETSI, IEEE-SA and others.

legislation or national law, or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.”²⁵⁷ Likewise, law and regulation in numerous countries prohibit the registration of WHO-recognized INN and other common names as trademarks.²⁵⁸ Accordingly, international harmonization of the proposed measures may be easier to achieve than initial adoption in the U.S.

CONCLUSION

Unlike patent and copyright law, which offer mechanisms by which inventions and works of authorship may be dedicated to the public domain, trademark law offers no explicit mechanism by which parties may place a particular word, term or device into the public domain. Yet for more than half a century, private parties have voluntarily been designating words and terms as generic – the practice of sui-genericide. This practice yields several potential benefits to the market, including the creation of common terms by which all participants in a market can refer to their products while using proprietary brands to differentiate themselves and compete with one another. The designation of these common terms as generic may also have the benefit of preventing others from registering such terms as trademarks, but current legal theories, including promissory estoppel, do not unequivocally render such terms generic for all purposes. Accordingly, this article proposes several measures that could be implemented either through federal legislation or judicial action to enhance the legal recognition of declarations of sui-genericide. These include official recognition and consideration during trademark prosecution of “consensus” lists of common terms that are developed by broadly-representative industry groups and the creation of a presumption of genericness for terms that appear on such lists. Coupled with international harmonization of the treatment of sui-genericide, such measures could reduce consumer search costs, enhance competition among producers of standardized

²⁵⁷ Eur. Union Trademark Reg., 2017/1001, Art. 7(1)(m) (Absolute Grounds for Refusal). *See also* Eur. Union Intell. Prop. Off., Guidelines For Examination Of European Union Trade Marks, Part B – Examination, Section 4 - Absolute Grounds For Refusal, Chapter 13 - Trade Marks In Conflict With Earlier Plant Variety Denominations (Jan. 10, 2017).

²⁵⁸ *See, e.g.*, Indian Trademark Act of 1999, Sec. 13; Andean Community, Decision 486/2000 (Establishing the Common Intellectual Property Regime), Article 135(f) (“Those signs may not be registered as marks that: ... (f) consist solely of a sign or statement which is the generic or technical name of the product or service concerned”).

products, and bring increased efficiency to markets that depend on the unencumbered availability of common names.