Sui-Genericide

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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.

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I. INTRODUCTION

Intellectual property ("IP") 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 IP voluntarily relinquish some or all of their exclusive rights to the public.[1] 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."[2] Today, more formal mechanisms exist for dedicating copyrighted works to the public, including a standardized online tool offered by the nonprofit Creative Commons.[3]

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.[4] And an applicant may deliberately abandon a patent application before it is fully prosecuted,[5] after which the invention claimed in the application will become part of the public domain. Once abandoned, the invention cannot be patented by anyone 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 it.[6] The same is true when a patent

1. 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.

2. *See* Millar v. Taylor (1769) 98 Eng. Rep. 201, 224; 4 Burr. 2303, 2345–46 (KB). *But see* Phillip Johnson, '*Dedicating' Copyright to the Public Domain*, 71 MOD. L. REV. 587, 594–95 (2008) (questioning precedential authority of this case). *See also* Dave Fagundes & Aaron Perzanowski, *Abandoning Copyright*, 62 WM. & MARY L. REV. 487 (2020).

3. *CCo 1.0 Universal (CCo 1.0) Public Domain Dedication*, CREATIVE COMMONS, https://creativecommons.org/publicdomain/zero/1.0 [https://perma.cc/B9MP-YFLT].

4. *See, e.g.*, Jorge L. Contreras, *Bermuda's Legacy: Policy, Patents, and the Design of the Genome Commons*, 12 MINN. J.L. SCI. & TECH. 61, 95–98 (2011) [hereinafter Contreras, *Bermuda's Legacy*] (describing 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, firms elect to forego patent protection, and choose instead to publish potentially patentable research findings.").

5. Express Abandonment, 37 C.F.R. § 1.138(a) (2019) ("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 (2018).

6. *See, e.g.*, Vass v. Multi Med Indus., Inc., No. 78 C 251, 1979 WL 25145, at *2 (E.D.N.Y. June 26, 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."). *See generally* Christopher A. Cotropia & David L. Schwartz, *The Hidden Value of Abandoned Applications to the Patent System*, 61 B.C. L. REV. 2809 (2020) (explaining the connection between prior art, published patent applications and the role of obviousness).

expires, either at the end of its term or due to its owner's failure to pay maintenance fees.[7] 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.[8] Under copyright law, notable examples include open source software licensing,[9] the distribution of free content by online platforms,[10] and the dissemination of large amounts of user-developed content under Creative Commons licenses.[11] Under patent law, notable examples include the pledging of patents to promote new technology platforms,[12] interoperability standards,[13] and social causes,[14] and to preempt the appropriation of rights by others.[15]

Trademarks, like other forms of IP, can have substantial value. As noted by Professor Barton Beebe, marks like APPLE, GOOGLE, SAMSUNG, TOYOTA, MCDONALDS, STARBUCKS, NIKE, COKE, and PEPSI are "[i]nstantly 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."[16]

Yet, with a few exceptions, little scholarly attention has been paid to expanding the public domain under trademark law. These exceptions include literature addressing the development of naming systems *outside* the boundaries of conventional trademark protection (e.g., the fanciful pseudonyms

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7. Figueroa v. United States, 466 F.3d 1023, 1027 (Fed. Cir. 2006) ("[F]ailure to pay required maintenance fees results in expiration of the patent, 35 U.S.C. § 41(b)."); *see also* 4 DONALD S. CHISUM, CHISUM ON PATENTS § 11.02(1)(D)(iv) (2020) (describing how failure to pay maintenance fees can result in patent expiration).

8. *See, e.g.*, Colleen V. Chien, *Opening the Patent System: Diffusionary Levers in Patent Law*, 89 S. CAL. L. REV. 793, 795–801 (2016); Abraham Bell & Gideon Parchomovsky, *The Evolution of Private and Open Access Property*, 10 THEORETICAL INQUIRIES L. 77, 80–86 (2009); Robert P. Merges, *A New Dynamism in the Public Domain*, 71 U. CHI. L. REV. 183, 184 (2004). *See generally* Jorge L. Contreras, *Patent Pledges*, 47 ARIZ. ST. L.J. 543 (2015) [hereinafter Contreras, *Patent Pledges*] (discussing and analyzing pledges of intellectual property to the public domain).

9. *See* YOCHAI BENKLER, THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM 63–67 (2006) (discussing open source code); Merges, *supra* note 8, at 186 (discussing IBM's Linux strategy).

10. *See generally* Jonathan M. Barnett, *The Costs of Free: Commodification, Bundling and Concentration* (USC Gould Sch. of L. Ctr. for L. & Soc. Sci., Paper No. 17-7, 2017), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2916859 (describing rise of free content on online platforms).

11. *See, e.g.*, Lawrence Lessig, *The Creative Commons*, 55 FLA. L. REV. 763, 764 (2003).

12. *See* Chien, *supra* note 8, at 795–98; Contreras, *Patent Pledges*, *supra* note 8, at 544–45.

13. *See* Contreras, *Patent Pledges*, *supra* note 8, at 573–80.

14. *See generally* Jorge L. Contreras, Bronwyn H. Hall & Christian Helmers, *Pledging Patents for the Public Good: Rise and Fall of the Eco-Patent Commons*, 57 HOUS. L. REV. 61 (2019) (assessing the prominent green technology pledge); Contreras, *Patent Pledges*, *supra* note 8, at 590–92 (describing pledges made for philanthropic reasons).

15. Contreras, *Bermuda's Legacy*, *supra* note 4, at 95 (placing genetic data into public domain by pharmaceutical industry to avoid appropriation by biotechnology firms); Merges, *supra* note 8, at 186 (discussing IBM's Linux strategy as a competitive response to Microsoft).

16. BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 2 (4th ed. 2017).

used by roller derby participants),[17] 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."[18] And, of course, a host of scholars over the years have critiqued the breadth of various protective doctrines under trademark law, arguing that they should be narrowed in one way or another.[19] However, none of this work tackles head-on the questions of whether and how trademark rights might be contributed to a common pool of resources, nor whether such a linguistic 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,[20] trademark law offers no explicit mechanism by which a particular word, term, or device may be committed to the public domain.

Though a trademark application may 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.[21] The same principle applies when a registered trademark is not renewed, a trademark is abandoned due to non-use or a registration is otherwise canceled.[22] The expiration and cancellation 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

17. *See* David Fagundes, *Labor and/as Love: Exploring the Commons of Roller Derby*, *in* GOVERNING KNOWLEDGE COMMONS 417–44 (Brett M. Frischmann, Michael J. Madison & Katherine J. Strandburg eds., 2014).

18. Daniel J. Hemel & Lisa Larrimore Ouellette, *Trademark Law Pluralism*, U. CHI. L. REV. (forthcoming 2021) (defining "semantic space" as "the supply of words, sounds, and symbols that can be 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, 948 (2018).

19. *See, e.g.*, Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1099 (2003) (arguing for limitation of trademark rights to foster free speech); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 391–410 (1999) [hereinafter Lunney, *Monopolies*] (criticizing trademark protection for trade dress); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1697–1705 (1999) (critiquing as over-broad doctrines such as trademark dilution, trade dress protection, and anti-cybersquatting).

20. *See supra* notes 8–15 and accompanying text.

21. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:57 (5th ed. 2020) [hereinafter 3 MCCARTHY, TRADEMARKS].

22. *See id.* (clarifying that while others may apply for registration of the mark after it has been cancelled for non-renewal or otherwise, common law rights still protect the trademark if its use has not been abandoned by the expired registrant).

are expressly excluded from his proposed statutory scheme to expand the public domain.[23]

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 IP. Professor Adam Mossoff, in arguing that trademarks *should* be treated as use-based (usufructuary) property rights, acknowledges the prevailing view that a trademark is considered "a regulatory entitlement whose function is to increase social welfare by reducing consumer search costs."[24] 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.

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 "depropertizing" 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 also may incite rent seeking by competing would-be reappropriators.[25]

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 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 that lack distinctiveness and describe a generic class of goods or services—cannot be enforced or registered as trademarks.[26] A finding of genericness, however, cannot be initiated by a mark owner.[27] It results either from the action of the trademark examiner during the prosecution process, the challenge of a third party either in an opposition or cancellation proceeding, or litigation.[28]

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23. *See* 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.").

24. Adam Mossoff, *Trademark as a Property Right*, 107 KY. L.J. 1, 3 (2018). For critiques of Mossoff's thesis, see, for example, Bryan L. Frye, *Metaphors on Trademark: A Response to Adam Mossoff, "Trademark as a Property Right,"* 107 KY. L.J. ONLINE, 2018–2019, at 1; and Lisa Larrimore Ouellette, Michael Risch, & Camilla Hrdy, *Adam Mossoff: Trademarks as Property*, WRITTEN DESCRIPTION (Sept. 5, 2017, 9:52 PM), https://writtendescription.blogspot.com/2017/09/adam-mossoff-trademarks-as-property.html [https://perma.cc/RF4M-K3MK].

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

26. *See infra* Section II.A.

27. *See infra* Section II.B.

28. *See infra* Section II.B.

This Article, for the first time, identifies and describes the practice of "sui-genericide,"[29] whereby a private actor declares that a particular word or term is generic and thereby seeks to commit it to the public domain. This form of behavior exists along a spectrum, where at one end the owner of an existing trademark may declare that the mark is generic and thus unprotectable, and at the other end a market actor may declare that one or more terms that it has not registered, but which could be registered by others, are generic and thus unprotectable. Far from the fringe of commercial activity, practices along this spectrum have existed for decades in areas such as pharmaceutical, pesticide and synthetic fiber common names,[30] and have emerged more recently 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.[31]

The remainder of this Article proceeds as follows: Part II reviews current U.S. law relating to trademark genericism, including its doctrinal and economic roots.[32] Part III 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 IV explores the rationales and explanations for sui-genericide, and Part V poses the questions of how and whether sui-genericide can be facilitated through existing and new legal mechanisms such as registries, presumptions, and certifications. Lastly, Part VI concludes.

29. I derive the term "sui-genericide" from the term "genericide," a challenge to a trademark on the basis that it is generic, *see infra* text accompanying note 57, and "sui," a prefix derived from the Latin term meaning "of oneself," *see Suicide,* ONLINE ETYMOLOGY DICTIONARY, https://www.etymonline.com/word/suicide [https://perma.cc/6XZD-Y6JL]. The term also alludes to the Latin term *sui generis*, used frequently in 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*, LAW DICTIONARY, https://thelawdictionary.org/sui-generis [https://perma.cc/C385-XGCD] ("Of its own kind or class.").

30. *See infra* Sections III.A–.C.

31. *See infra* Section III.D.

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* Case C-191/01, Off. for Harmonisation in the Internal Mkt. v. Wm. Wrigley Jr. Co., 2003 E.C.R. I-12473, ¶¶ 25, 31 (excluding 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(2), Mar. 20, 1883, 21 U.S.T. 1538, 828 U.N.T.S. 305 (revised at Stockholm July 14, 1967) (stating that 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").

II. 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, as enumerated by the Second Circuit in *Abercrombie & Fitch Co. v. 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 that 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 appear straightforward at first glance, the determination whether a particular term is generic or descriptive can be complex.[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]

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33. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976). Other circuits have largely followed the *Abercrombie* framework. *See* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2 (5th ed. 2020) [hereinafter 2 MCCARTHY, TRADEMARKS].

34. *Abercrombie*, 537 F.2d at 11.

35. *Id.* (quoting Stix Prods., Inc. v. United Merchs. & Mfrs., Inc., 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

36. *See* 15 U.S.C. § 1052(f) (2018); *Abercrombie*, 537 F.2d at 8.

37. *Abercrombie*, 537 F.2d at 11; *see also* 15 U.S.C. § 1064(c) (1984) (amended 1988) (noting that 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. v. Coca-Cola Co., 892 F.3d 1358, 1366 (Fed. Cir. 2018) (citation omitted) (first quoting H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989 (Fed. Cir. 1986); and then quoting *In re* Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1569 (Fed. Cir. 1987)).

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 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.*, 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?'"[42]

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 *Elliott v. Google, Inc.*, this "requirement is necessary to maintain the viability of arbitrary marks as a protectable trademark category."[43] 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.'"[44]

As a result, much depends on how an adjudicatory body interprets the relevant product or service genus to which the term is applied. In *Google*, the Ninth Circuit upheld the lower court's ruling that the term GOOGLE was not

40. Elliott v. Google, Inc., 860 F.3d 1151, 1156 (9th Cir. 2017) (quoting 15 U.S.C. § 1064(3) (2018)).

41. E.T. Browne Drug Co. v. Cococare Prods., Inc., 538 F.3d 185, 192 (3d Cir. 2008) (second and third alterations in original) (citations omitted) (first quoting *Canfield*, 808 F.2d at 292–93; and then quoting Dranoff-Perlstein Assocs. v. Sklar, 967 F.2d 852, 859 (3d Cir. 1992)); *see also Abercrombie*, 537 F.2d at 9 (explaining genericness "refers, or has come to be understood as referring, to the genus of which the particular product is a species").

42. Filipino Yellow Pages, Inc. v. Asian J. Publ'ns, Inc., 198 F.3d 1143, 1147 (9th Cir. 1999) (second alteration in original) (quoting Off. Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1391 (9th Cir. 1993)).

43. *Elliott*, 860 F.3d at 1157.

44. *Id.* (quoting *Abercrombie*, 537 F.2d at 9 n.6).

generic.[45] 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]

But in *In re Cordua Restaurants, 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. Coca-Cola Co.*, the Trademark Trial and Appeal Board ("the TTAB") upheld The Coca-Cola Company's registration of the mark ZERO to describe its line of no-calorie soft drinks.[50] Royal Crown ("RC") opposed the mark, arguing, among other things, that the term ZERO was generic.[51] In analyzing RC's genericism challenge, the TTAB defined "the relevant genus . . . [as] 'soft drinks, sports drinks, and energy drinks.'"[52] The Federal Circuit reversed and remanded, holding that

> [t]he [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.[53]

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 restaurant chain could claim rights in the word "burrito" itself, the

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45. *Id.* at 1163.

46. *Id.* at 1162 (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. *In re* Cordua Rests., Inc., 823 F.3d 594 (Fed. Cir. 2016).

48. *Id.* at 603 (emphasis added).

49. Royal Crown Co. v. Coca-Cola Co., 892 F.3d 1358, 1367–68 (Fed Cir. 2018) (quoting *In re Cordua*, 823 F.3d at 605).

50. *Id.* at 1364.

51. *Id.* at 1363.

52. *Id.* at 1367 (quoting Royal Crown Co. v. Coca-Cola Co., 2016 TTAB LEXIS 234, at *20 (T.T.A.B. 2016)).

53. *Id.* at 1368.

Patent and Trademark Office ("the PTO") generally requires that generic terms included within registered marks be disclaimed as to standalone uses.[54] 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 PTO,[55] and after registration, when a once-distinctive mark is shown no longer to identify a source of goods and on that basis is canceled.[56] This latter circumstance is sometimes referred to as "genericide."[57] 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.[58]

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

54. *See* U.S. PAT. & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.03(b) (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 . . . ."). *See generally Royal Crown*, 892 F.3d 1358 (discussing disclaimer of term "ZERO" in beverage companies' diet soda marks).

55. *See, e.g.*, BEEBE, *supra* note 16, at 45 (listing numerous examples and cases); LYDIA PALLAS LOREN & JOSEPH SCOTT MILLER, INTELLECTUAL PROPERTY LAW: CASES & MATERIALS 515 (5th ed. 2017).

56. 15 U.S.C. § 1064(3) (2018).

57. 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, at F16, https://www.nytimes.com/1979/05/20/archives/how-the-ftc-threatens-trademarks.html [https://perma.cc/EU5M-3T74]; *see also* GLYNN LUNNEY, CASES AND MATERIALS ON TRADEMARK LAW 180 (2d ed. 2016) ("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.*, 2 MCCARTHY, TRADEMARKS, *supra* note 33, § 12:1; BEEBE, *supra* note 16, at 45; LOREN & MILLER, *supra* note 55, at 515; 1 JEROME GILSON & ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 2.02 (2020) [hereinafter GILSON]; Jacqueline Stern, *Genericide: Cancellation of a Registered Trademark*, 51 FORDHAM L. REV. 666, 666 (1983); Sung In, Note, *Death of a Trademark: Genericide in the Digital Age*, 21 REV. LITIG. 159, 161 (2002); John Dwight Ingram, *The Genericide of Trademarks*, 2 BUFF. INTELL. PROP. L.J. 154, 161 (2004).

58. *See, e.g.*, 2 MCCARTHY, TRADEMARKS, *supra* note 33, § 12:18 (listing numerous marks that have become generic); Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1324 (1980); BEEBE, *supra* note 16, at 45; LOREN & MILLER, *supra* note 55, at 515. Though genericism is typically discussed in terms of trademarks for products and services, certification marks may also be subject to genericide. Folsom & Teply, *supra*, at 1326 n.26 ("[I]f 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.").

describe the general class of products to which it belongs.[59] 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.[60] This is the "trap" into which Bayer fell with respect to its patented painkiller "aspirin." As explained by Professor John Ingram:

> [D]uring 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.[61]

A registered mark may be challenged as generic via one of four procedural routes outlined in §§ 13 and 14 of the Lanham Act:

> (1) The mark, once allowed by the PTO, will be published in the Official Gazette, following which "[a]ny person who believes that he [or she] would be damaged by the registration of [the] mark" may, within 30 days after publication, initiate an *inter partes* opposition proceeding at the TTAB.[62] 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 § 14(3) of the Lanham Act, any person who believes that he or she would be damaged by the registration of a mark may petition to cancel a registration "[a]t any time if the registered mark becomes the generic name for the goods or services."[63]
>
> (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.[64]
>
> (4) A public agency such as the U.S. Federal Trade Commission may petition the PTO to cancel a trademark as generic.[65]

While each of these mechanisms requires different procedural steps, the substantive requirements for a finding of genericism do not vary greatly from

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59. *See* William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 295 (1987) [hereinafter Landes & Posner, *Economic Perspective*] ("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.").

60. *See* Ingram, *supra* note 57, at 158–59.

61. *Id.*

62. 15 U.S.C. § 1063(a) (2018); 37 C.F.R. §§ 2.101–2.107 (2019).

63. 15 U.S.C. § 1064(3).

64. 3 MCCARTHY, TRADEMARKS, *supra* note 21, § 20:56.

65. 15 U.S.C. § 1064. The FTC has exercised this power only once. *See* Fed. Trade Comm'n v. Formica Corp., 200 U.S.P.Q. (BNA) 182, 185 (T.T.A.B. 1978); Formica Corp. v. Lefkowitz, 590 F.2d 915, 922 (C.C.P.A. 1979). *See generally* Jorge L. Contreras, The *Formica* War and the FTC's Forgotten "Name Robbing Campaign" (Aug. 17, 2020) (unpublished manuscript) (on file with author) (describing the FTC's campaign to declare the FORMICA mark generic in the 1970s).

one mechanism to another. In each case, the determination whether a challenged mark is generic is a question of fact.[66]

A party bringing a cancellation action on the basis of genericism bears the burden of proving genericide by a preponderance of the evidence.[67] 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."[68]

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, in 2017, a San Diego jury found 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.[69] In reaching its verdict, the jury seemingly relied on evidence including a survey showing that 70 percent of respondents considered COMIC-CON to be a particular brand rather than a generic description of an event.[70]

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.[71] In that case, the challenger petitioned the PTO 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,'"[72] and that "verb use constitutes generic use as a matter of law."[73] But this challenge was unsuccessful because the verb "google" was found to relate specifically to internet searches conducted using Google's proprietary search engine.[74]

Unlike other cancellation proceedings—resulting, for example, from a mark owner's failure to use a mark in commerce—a finding of genericism will

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

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

68. Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1254 (9th Cir. 1982).

69. Rob Salkowitz, *Jury Decides for San Diego Comic-Con in Trademark Suit*, FORBES (Dec. 8, 2017, 6:52 PM), https://www.forbes.com/sites/robsalkowitz/2017/12/08/breaking-jury-decides-for-san-diego-comic-con-in-12m-trademark-suit/#30af45b6cc86 [https://perma.cc/LY88-MAG7] (discussing survey and other evidence relied upon by jury in finding that COMIC-CON was not generic).

70. *Id.*

71. *See* Elliott v. Google, Inc., 860 F.3d 1151, 1163 (9th Cir. 2017) ("We agree that Elliott has failed to present sufficient evidence to support a jury finding that the relevant public primarily understands the word 'google' as a generic name for internet search engines and not as a mark identifying the Google search engine in particular.").

72. *Id.* at 1155 (alteration in original).

73. *Id.*

74. *See supra* notes 45–46 and accompanying text.

prevent others from registering the generic term as a mark.[75] Thus, like an abandonment of rights under patent or copyright law, a finding of genericism generally has an estoppel effect on third parties, recommitting the generic term to the public.[76]

C. GENERICIDE COUNTER-MEASURES

It is often the case that the holders of IP rights will lose those rights based on their own conduct: failing to pay renewal or maintenance fees, failing to disclose prior art to the PTO, misusing or abusing those rights in commercial transactions, and so on.[77] 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.[78] 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.[79]

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.[80] 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., do not say "I am going to Xerox these papers") or a noun (e.g., do not say "Where is the Xerox of my expense report?").[81] And while such restrictions would not be unexpected in sophisticated commercial arrangements between mark owners and, for

75. *See* John M. Fietkiewicz, Comment, *Section 14 of the Lanham Act—FTC Authority to Challenge Generic Trademarks*, 48 FORDHAM L. REV. 437, 455–56 (1980).

76. *See id.* Note, however, that a term that has been adjudged generic may be revived if it is shown to have achieved distinctiveness. *See id.* at 455 n.144; GILSON, *supra* note 57, § 2.02(7)(c) (providing SINGER (for sewing machines) and GOODYEAR (for rubber tires) as examples of marks as to which distinctiveness has been "recaptured" after a finding of genericness).

77. *See* CHISUM, *supra* note 7, §§ 11.02(1)(D)(iv), 11.03(1)(a)(i).

78. *See* Ingram, *supra* note 57, at 161.

79. *See, e.g.*, *Why Companies Don't Want You to Take Their Brand Names in Vain*, ECONOMIST (Sept. 9, 2017), https://www.economist.com/books-and-arts/2017/09/09/why-companies-dont-want-you-to-take-their-brand-names-in-vain [https://perma.cc/RFH5-9EED].

80. *See* Jorge L. Contreras, *Trademarks, Certification Marks and Technical Standards*, *in* 2 THE CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: FURTHER INTERSECTIONS OF PUBLIC AND PRIVATE LAW 205, 213–14 (Jorge L. Contreras ed., 2019) [hereinafter Contreras, *Trademarks*].

81. *See* Ingram, *supra* note 57, at 160 ("Trademark owners should never use the trademark as a verb or noun, which implies that the word is generic."). *But see 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." (footnotes omitted) (quoting Miller Brewing Co. v. G. Heileman Brewing Co., 561 F.2d 75, 79–81 (7th Cir. 1977))).

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.[82]

Second, mark owners can take their anti-genericide campaigns directly to the public—to users and consumers of 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."[83] General Foods thus succeeded in preventing Sanka from becoming a generic term, and in promoting the alternative generic term "decaf."[84]

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.[85] 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":

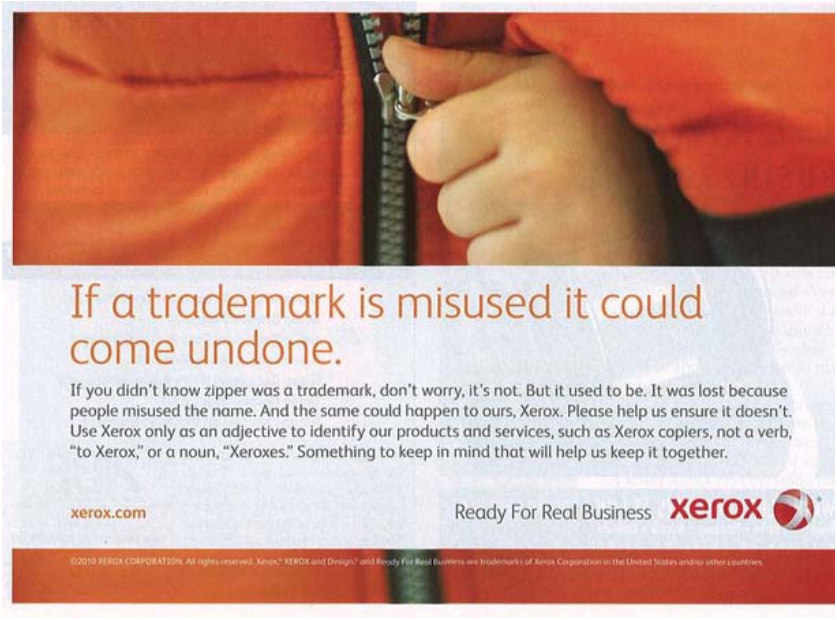
82. *See generally* ORACLE, JAVA LICENSING: LOGO GUIDELINES (2016), http://www.oracle.com/us/technologies/java/java-licensing-logo-guidelines-1908204.pdf [https://perma.cc/YL27-XU8P] (cataloguing official guidelines for using Java's logo); BLUETOOTH SIG, BLUETOOTH TRADEMARK LICENSE AGREEMENT (2019), https://www.bluetooth.com/wp-content/uploads/2019/03/btla.pdf [https://perma.cc/FD2X-JG6Q] (listing terms of Bluetooth's trademark license agreement).

83. Landes & Posner, *Economic Perspective*, *supra* note 59, at 294.

84. *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 BULL., Nov. 15, 2011 (alteration in original).

85. *See, e.g.*, Ingram, *supra* note 57, at 161 (discussing the efforts of trademark owners, like Xerox, to protect their trademark, including the use of newspaper and magazine ads).

Figure 1. Xerox Genericide Counter-Measure Ad[86]



Other attempts to append generic terms to product brand names in order to avoid genericide include Scotch *transparent tape*, Kleenex *facial tissue*, and Vaseline *petroleum jelly*.[87] As noted by Professors Lydia Loren and Joe Miller, "[i]f the Otis Elevator Company, inventor of the escalator, had promoted the product as a 'moving stairway,' *escalator* might still be a trademark."[88]

Most recently, the legal department at Velcro Companies released a series of clever music videos urging consumers to use the term "hook and loop fastener" to refer to the ubiquitous fabric fastening system invented by the company more than 60 years ago:

86. Megan Garber, *'Kleenex is a Registered Trademark' (and Other Desperate Appeals)*, ATLANTIC (Sept. 25, 2014), https://www.theatlantic.com/business/archive/2014/09/kleenex-is-a-registered-trademark-and-other-appeals-to-journalists/380733 [https://perma.cc/42Y7-7H97]. For additional examples of ads used to protect a trademark, see LOREN & MILLER, *supra* note 55, at 515 (displaying a Xerox ad that explains potential trademark repercussions of using the term "Xerox" the same as one would use "zipper"); Ingram, *supra* note 57, at 161 n.58 (referencing a Xerox ad explaining potential repercussions of using the term "Xerox" the same as one would use "aspirin"); and Fechter & Slavin, *supra* note 84 ("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." Elliott v. Google, Inc., 860 F.3d 1151, 1157 (9th Cir. 2017).

87. *See* LOREN & MILLER, *supra* note 55, at 515; Ingram, *supra* note 57, at 159–60, 162.

88. LOREN & MILLER, *supra* note 55, at 515.

You call it "velcro" but we're begging you

This is [bleeping] "hook and loop."

. . .

But if you keep calling these "velcro" shoes,

Our trademark will get killed.[89]

Toward the end of one of the videos, Velcro makes a general appeal on behalf of all trademarks in jeopardy of genericide:

If you need something to clean up your socks,

Do it with bleach and not with [Clorox].

If you have blood from a boo-boo you made,

This is a bandage and not a [Band-Aid].

If you're exercising with someone you're dating,

It's inline skating and not [Rollerblading].

I know that bleeped stuff is more fun to say,

But if you keep doing it our trademarks go away.[90]

In ads like these, 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). While the effectiveness of consumer ad campaigns such as these is not known, the number of (largely derogatory) viewer comments received by Velcro in response to its music video suggests that, at a minimum, consumers are hearing the message.[91]

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 from those uses, sometimes threatening litigation if they fail to comply.[92] 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:

89. VELCRO® Brand, *Don't Say Velcro*, YOUTUBE (Sept. 25, 2017), https://www.youtube.com/watch?v=rRi8LptvFZY&ab_channel=VELCRO%C2%AEBrand [https://perma.cc/CV7S-TXGC].

90. *Id.* (brand names inserted by author over "bleeps" in audio).

91. VELCRO® Brand, *Thank You for Your Feedback—Don't Say Velcro*, YOUTUBE (June 4, 2018), https://www.youtube.com/watch?v=ZLWMQLMiTPk&ab_channel=VELCRO%C2%AEBrand [https://perma.cc/W8RM-AF8B] ("We heard you. Our first Don't Say Velcro video received thousands of comments from over 150 countries. Some people loved it, some gave us new names for hook & loop fasteners, and some had other colorful feedback.").

92. *See* GILSON, *supra* note 57, § 2.02(7)(b)(17)–(19); Ingram, *supra* note 57, at 161 (advising trademark owners to police the use of their mark). 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, Inc. v. Asian J. Publ'ns, Inc., 198 F.3d 1143, 1151 (9th Cir. 1999); King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963) (describing failures to police the use of trademarks).

> 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.[93]

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

D. THE ECONOMICS OF GENERICIDE

More than 30 years ago, Professor William Landes and Judge Richard Posner developed an influential microeconomic model of trademark law that retains its currency today.[94] In the Landes and Posner model, the "essential economic function of trademarks" is the reduction of consumer search costs.[95] 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).[96] Because a strong trademark will reduce search costs, it will enable the producer to raise the price of 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).[97]

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

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93. Ingram, *supra* note 57, at 161–62; *see also* Margulies, *supra* note 57 ("Coca-Cola engages in several hundred actions year [sic] 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. Elliott v. Google, Inc., 860 F.3d 1151, 1162 n.9 (9th Cir. 2017).

94. Landes & Posner, *Economic Perspective*, *supra* note 59, at 268–69. To be sure, some economic analysis of trademark law existed prior to Landes and Posner's work (see, for example, Folsom & Teply, *supra* note 58, at 1334–46; and Lunney, *Monopolies*, *supra* note 19, at 367–69 (noting earlier work)), but the work of Landes and Posner is viewed by many as a landmark in the field. *See, e.g.*, P. SEAN MORRIS, TRADEMARKS AND THE ECONOMIC DIMENSIONS OF TRADEMARK LAW IN EUROPE AND BEYOND 3 (A. Marciano & G.B. Ramello eds., 2016) (referring to Landes and Posner's contribution as a "seminal article which nowadays stands as the cornerstone on the economic analysis of trademark law").

95. Landes & Posner, *Economic Perspective*, *supra* note 59, at 275.

96. *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.

97. *Id.* at 280.

that the products' quality levels are equivalent.[98] It follows that the availability of trademarks, which distinguish one firm's products from another, encourage firms to improve their own product quality.[99]

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.[100] 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.[101] For these reasons, the appropriation of generic terms as trademarks is viewed as economically inefficient and welfare reducing, both as to consumers and competitors.

III. THE HISTORY OF SUI-GENERICIDE

As discussed in Section II.A, 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.[102] 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.[103] Given the large investments that many firms make in building brand identity and goodwill, as discussed in Section II.C, trademark owners such as Xerox and Velcro often go to great lengths to prevent their marks from becoming generic.[104] But, surprisingly, some current and potential trademark owners have taken a different approach. These firms have affirmatively declared 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 sui-genericide, from governmental programs that arose

98. *Id.*

99. *Id.*

100. *Id.* at 291–92 fig.4 (noting that this effect can be represented by a shift to the left of the supply curve for the affected competitors).

101. *Id.*

102. *See supra* Section II.A (describing how to categorize a term as generic).

103. *See supra* text accompanying notes 55–56.

104. *See supra* Section II.C (discussing ways that mark owners protect their mark from becoming generic).

during the mid-twentieth century to examples of voluntary programs driven by industry trade associations and standardization organizations today.

A. THE DEPARTMENT OF COMMERCE GENERIC WORD PROGRAM: A GENERICIDE WISH LIST

Beginning in the early 1940s, American businesses began to notice that foreign firms were filing trademark applications on terms that were generic in the English language.[105] Many of these terms described pharmaceutical products and ingredients, including ANTACID, VITAMIN, NIACIN, B-COMPLEX, FOLIC ACID, PENICILLIN and STREPTOMYCIN.[106] In 1942, the Proprietary Association, a trade association for non-prescription drug manufacturers,[107] began to review and oppose these foreign applications.[108] In 1951, the Proprietary Association joined forces with the American Drug Manufacturers Association and the American Pharmaceutical Manufacturers Association in this activity.[109] By 1952 this coalition had reviewed 253 such foreign applications in 20 countries and filed 112 oppositions, resulting in 43 cancellations and 15 withdrawals.[110]

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 renamed the Bureau of International Commerce) initiated its own program to oppose foreign trademark applications seeking to register generic English terms.[111] 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.[112] Under the Program, the Bureau invited interested U.S. parties to notify it of attempts abroad to register generic English words as trademarks.[113] 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

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

106. *Id.* at 514–15.

107. The Proprietary Association was formed in 1881; in 1999 it changed its name to the Consumer Healthcare Products Association. *See About CHPA*, CONSUMER HEALTHCARE PRODS. ASS'N, https://www.chpa.org/About.aspx [https://perma.cc/BMG4-LZP4].

108. Hoge, *supra* note 105, at 514–15.

109. *Id.* at 514.

110. *Id.* at 515.

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

112. 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); and 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).

113. *See* sources cited *supra* note 112.

generic terms could be excluded from the relevant foreign markets.[114] 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 ("USTA") (a trade organization now known as the International Trademark Association ("INTA")).[115] 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.[116]

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."[117] Generic terms as to which the Bureau successfully objected to foreign registration included 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.[118]

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114. Lightman, *supra* note 112, at 80.

115. *See* Travaglini & Lightman, *supra* note 112, at 742.

116. Lightman, *supra* note 112, at 81.

117. Travaglini & Lightman, *supra* note 112, 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.

118. Travaglini, *supra* note 112, at 553–54; Lightman, *supra* note 112, at 82–83; Travaglini & Lightman, *supra* note 112, at 741–43; *In re* Le Sorbet, Inc., 228 U.S.P.Q. 27, at *4 n.15 (T.T.A.B. 1985).

The Generic Word Program, which appears to have ended sometime in the late 1980s,[119] represents an important first step toward sui-genericide. Though the U.S. firms who submitted terms to the Generic Word Program did not themselves make any express representation or commitment regarding the generic nature of those terms, it is likely that their submissions had the practical effect of an admission of genericness or, in the alternative, a commitment not to seek registration of the submitted terms.[120]

Though the Department of Commerce Bureau of Foreign Commerce (and its successor the Bureau of International Commerce) no longer exists to discourage foreign trademark offices from registering generic English terms through the Generic Word Program, the PTO conducts "advoca[cy] to improve IP policies, laws, and regulations abroad" through its IP Attaché Program.[121] Likewise, the U.S. Trade Representative ("the 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."[122]

With respect to generic terms, the USTR has actively opposed the protection of geographic indications ("GIs") by the European Union ("EU") when those GIs are viewed as common names for foodstuffs exported by U.S. manufacturers.[123] 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 United States and elsewhere use "danbo" as the common name for this variety of cheese.[124] Similar concerns have been expressed with respect to other cheese

119. The actual termination date of the Generic Word Program is not clear, but no references to it have been located after 1985. *See In re Le Sorbet*, 228 U.S.P.Q. 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*, 67 GRUR INT'L 1118, 1121–22 (2018) (estimating the end date of the program to be in the 1980s).

120. *See infra* Section IV.D (discussing legal enforceability of the submitting firms' position regarding genericism of submitted terms).

121. *IP Attaché Program*, U.S. PAT. & TRADEMARK OFF. (Sept. 17, 2020, 2:29 PM), https://www.uspto.gov/learning-and-resources/ip-policy/intellectual-property-rights-ipr-attach-program/intellectual [https://perma.cc/FV77-2NT6].

122. OFF. U.S. TRADE REPRESENTATIVE, 2019 SPECIAL 301 REPORT 5 (2019) [hereinafter SPECIAL 301 REPORT], https://ustr.gov/sites/default/files/2019_Special_301_Report.pdf [https://perma.cc/79YH-4T5G].

123. *Id.* at 20. Common names for food products are designated by the Codex Alimentarius Commission, a collaboration of the World Health Organization and the United Nations Food and Agriculture Organization. *See* FOOD & AGRIC. ORG. OF UNITED NATIONS & WORLD HEALTH ORG., UNDERSTANDING CODEX 17, 19 (2016), http://www.fao.org/3/a-i5667e.pdf [https://perma.cc/TFL4-JUYQ].

124. SPECIAL 301 REPORT, *supra* note 122, at 20; *see also EU Turns Its Back on Codex Cheese Standards by Approving GI for Generic Name*, CONSORTIUM FOR COMMON FOOD NAMES (Dec. 1, 2017), http://www.commonfoodnames.com/eu-turns-its-back-on-codex-cheese-standards-by-approving-gi-for-generic-name [https://perma.cc/8SJC-4HJX] (describing the EU's decision to grant Denmark exclusive use of the name "danbo").

varieties "such as fontina, gorgonzola, asiago, [and] feta," as well as "non-agricultural products, including apparel, ceramics, glass, handicrafts, manufactured goods, minerals, salts, stones, and textiles."[125] And far from being only a bilateral U.S.–EU issue, international disputes regarding the treatment of generic and common names have arisen in numerous countries.[126]

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.[127] While drug manufacturers seek to differentiate themselves and enhance their brands via advertising, packaging and other means,[128] 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.[129] Because the chemical name is clearly too complex for routine usage, most physicians,

125. SPECIAL 301 REPORT, *supra* note 122, at 20.

126. *See, e.g.*, *id.* at 48, 80–81 (discussing China and Costa Rica).

127. The same three-tier naming structure exists with respect to many other chemical products including pesticides. *See* Jorge L. Contreras, *A Historical Note on the Assignment of Pesticide Common Names*, STANDARDS ENG'G 14 (Nov./Dec. 2020). In addition, a number of products are characterized by a two-tier naming structure. For example, many cultivated plant varieties (cultivars), have both a generic designation or denomination (also referred to as an epithet) and a brand name. This structure ensures that the industry can refer consistently to the specific cultivar in question, while individual breeders can differentiate themselves through the use of brand names. Detailed rules for developing denominations for cultivars are set out in the INTERNATIONAL CODE OF NOMENCLATURE FOR CULTIVATED PLANTS ("ICNCP") produced by the International Society for Horticultural Science, a non-governmental scientific association based in Leuven, Belgium. *See generally* INT'L SOC'Y FOR HORTICULTURAL SCI., INTERNATIONAL CODE OF NOMENCLATURE FOR CULTIVATED PLANTS (C.D. Brickell et al. eds., 9th ed. 2016). These rules are followed by the naming authorities for different types of cultivars. One of the most complex and comprehensive catalogs of names is for roses. The American Rose Society serves as the International Cultivar Registration Authority for roses, and as such maintains a catalog of tens of thousands of different rose varieties and oversees the naming of new ones in accordance with the ICNCP. *See Rose Registrations*, AM. ROSE SOC'Y (Apr. 19, 2018), https://www.rose.org/single-post/2018/04/19/Rose-Registrations [https://perma.cc/E47F-M3LB]. Rose denominations are independent of the brand names under which particular breeders may market their plants.

128. 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, for example, Pharmacia Corp. v. Alcon Lab'ys, Inc., 201 F. Supp. 2d 335, 340–47 (D.N.J. 2002).

129. *See Ibuprofen*, WEBMD, https://www.webmd.com/drugs/2/drug-5166-9368/ibuprofen-oral/ibuprofen-oral/details [https://perma.cc/WQ3U-6Z3Z]. 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 Who We Are*, INT'L UNION PURE & APPLIED CHEMISTRY, https://iupac.org/who-we-are [https://perma.cc/7DCX-B4HP]. In addition to chemical nomenclature, the IUPAC assigns names to newly discovered elements and develops standardized units of measure, among other things. *Id.*

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, ibuprofen.

As already noted in Section II.A, 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.[130] 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.

1. The WHO INN Program

The World Health Organization ("WHO") was formed in 1946 as a 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."[131] In 1948, the initial World Health Assembly (WHO's decision-making body[132]) resolved to develop a harmonized international pharmacopeia.[133] Pursuant to that resolution, the World Health Assembly created a formal program for selecting international nonproprietary names ("INN") for pharmaceutical compounds.[134] Through the INN program, which was launched in 1953 and continues today,[135] 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.[136]

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.[137] Any

130. *See* Hoge, *supra* note 105, at 515 (explaining that of 112 oppositions filed between 1942 and 1952, only 43 resulted in cancellation of the targeted application or mark, with another 15 withdrawals).

131. Constitution of the World Health Organization, art. 2, para. u, July 22, 1946, 62 Stat. 2679, 14 U.N.T.S. 185.

132. *See World Health Assembly*, WORLD HEALTH ORG., https://www.who.int/mediacentre/events/governance/wha/en [https://perma.cc/42FH-24EW].

133. 1 WORLD HEALTH ORG., HANDBOOK OF RESOLUTIONS AND DECISIONS OF THE WORLD HEALTH ASSEMBLY AND THE EXECUTIVE BOARD 127, WHA1.27 (12th ed. 1973) [hereinafter WHO, RESOLUTIONS AND DECISIONS].

134. *See id.* at 128, WHA3.11.

135. WORLD HEALTH ORG., GUIDANCE ON THE USE OF INTERNATIONAL NONPROPRIETARY NAMES (INNS) FOR PHARMACEUTICAL SUBSTANCES 5 (2017) [hereinafter WHO INN GUIDELINES], https://www.who.int/medicines/services/inn/FINAL_WHO_PHARM_S_NOM_1570_web.pdf [https://perma.cc/725S-N5DH].

136. *Id.*

137. *Id.* at 11–12, 21–47.

organization may propose a new INN to WHO using a standardized application form[138] in which the applicant represents "that insofar as is known, none of the suggested names is either registered or pending registration" as a trademark[139] and discloses any trademark issued for the relevant drug.[140] Proposed INNs are reviewed by a WHO expert advisory panel for compliance with these rules.[141] If the proposed INN is deemed allowable, it is published by WHO for public comment.[142] During the four-month public comment period, a formal objection may be 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."[143] 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."[144] 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.[145]

While WHO claims that INNs "are formally placed by WHO in the public domain,"[146] and that "trademarks cannot be derived from INNs,"[147] 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."[148] To facilitate the adoption of this recommendation, WHO produced an *Information Leaflet for Trademark Departments*, offering advice regarding INNs to national trademark offices.[149] Thus, while decisions concerning the registration of INNs remain solely with national trademark

138. *Id.* at 51–52; *see also id.* at 14–17 (describing application process).

139. *Id.* at 52.

140. *Id.* at 16.

141. *Id.* at 6, 49 (explaining the process of the Expert Advisory Panel on the International Pharmacopoeia and Pharmaceutical Preparations).

142. *Id.* at 49.

143. *Id.* at 6; *see also* Lightman, *supra* note 112, at 84–85 (discussing U.S. government interaction with INN program).

144. WHO INN GUIDELINES, *supra* note 135, at 6.

145. *See Lists of Recommended and Proposed INNs*, WORLD HEALTH ORG., https://www.who.int/medicines/publications/druginformation/innlists/en [https://perma.cc/7DWU-FTHD].

146. WHO INN GUIDELINES, *supra* note 135, at 5.

147. *Id.* at 7.

148. WORLD HEALTH ORG., FORTY-SIXTH WORLD HEALTH ASSEMBLY: RESOLUTIONS AND DECISIONS ANNEXES 21 (1993).

149. WHO INT'L NONPROPRIETARY NAMES FOR PHARM. SUBSTANCES, INFORMATION LEAFLET FOR TRADEMARK DEPARTMENTS, https://www.who.int/medicines/services/inn/flyerINN.pdf [https://perma.cc/8938-BZ74].

offices and courts,[150] the WHO INN program serves a valuable function by coordinating industry usage and promoting norms of genericism with respect to recognized INNs.

2. The USAN Process

The WHO INN process also plays an important role in the approval of generic drug names in particular countries, including the United States. In the United States, generic drug names are assigned by the U.S. Adopted Name Council ("the USAN Council"), a joint undertaking of the American Medical Association ("AMA"), the U.S. Pharmacopeia, and the American Pharmacists Association ("APhA"), in cooperation with the Food and Drug Administration ("the FDA").[151] While many generic drug names were originally condensed versions of the relevant chemical names, that is no longer the case.[152] The USAN Council, which was formed in 1961, 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.[153] These guidelines specify that "[a] name should not conflict, mislead or be confused with other nonproprietary names and with established trademarks."[154] In addition, a generic name prefix should not imply that a drug is better, newer or more effective than other compounds,

150. It is telling that neither the TMEP, *supra* note 54, nor the FDA's BEST PRACTICES IN DEVELOPING PROPRIETARY NAMES FOR DRUGS 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. FDA, GUIDANCE FOR INDUSTRY: BEST PRACTICES IN DEVELOPING PROPRIETARY NAMES FOR DRUGS (2014), https://www.fda.gov/files/drugs/published/Best-Practices-in-Developing-Proprietary-Names-for-Drugs.pdf [https://perma.cc/A37C-6XYU]; *see infra* Section V.C. But while the United States may fail to give official recognition to INNs, other countries have adopted laws and rules prohibiting the registration of INNs as trademarks. *See infra* Section V.E.

151. The USAN Council grew out of the AMA-USP Nomenclature Committee, which has been adopting common drug names since 1961. Joseph B. Jerome, *United States Adopted Names (USAN). Cumulative List No. 1, 1961–1962*, 186 JAMA 1104, 1104 (1963) (book review). In 1964, the APhA joined this group to form the USAN Council. 21 C.F.R. § 299.4(c) (2019).

152. *United States Adopted Names Naming Guidelines*, AM. MED. ASS'N [hereinafter *USAN Naming Guidelines*], https://www.ama-assn.org/about/united-states-adopted-names/united-states-adopted-names-naming-guidelines [https://perma.cc/UQ6E-EY6N].

153. As explained by the USAN Naming Guidelines,

> 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-.

Id.; *see also* Carmen Drahl, *Where Drug Names Come From*, 90 CHEM. & ENG'G NEWS 36, 36–37 (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)).

154. *USAN Naming Guidelines*, *supra* note 152.

nor should it evoke the name of a manufacturer, medical condition or part of the human anatomy.[155]

The process for creating a new generic drug name is initiated by a manufacturer who submits an application to the USAN Council.[156] 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."[157] The application is first reviewed by USAN staff for potential conflicts with existing trademarks and other generic names.[158] 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; a name will not be approved until INN approval is obtained from WHO.[159]

3. Legal Effect

Under the Federal Food, Drug, and Cosmetic Act,[160] the Commissioner of the FDA is authorized to designate the official name of any drug marketed in the United States. The FDA officially "recognizes the skill and experience of the [USAN] [Council] in deriving names for drugs."[161] Accordingly, the FDA has officially delegated the designation of drug names to the USAN Council, which it advises via a liaison member.[162]

Though neither WHO, the USAN Council, nor the FDA 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 naming convention in the United States, create a strong presumption against the registration of such terms as trademarks. 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

155. *Id.*

156. *See USAN Application Forms*, AM. MED. ASS'N, https://www.ama-assn.org/about/united-states-adopted-names/usan-application-forms [https://perma.cc/VZL8-6A62] (categorizing six different forms for USAN application).

157. AM. MED. ASS'N, FORM A: USAN APPLICATION FOR SINGLE ENTITY DRUG AND SALT FORM 1, https://www.ama-assn.org/system/files/2019-03/form-a-sngl-entity-modified.doc [https://perma.cc/J8DH-WC7S].

158. *See USAN Negotiation Process*, AM. MED. ASS'N, https://www.ama-assn.org/sites/ama-assn.org/files/corp/media-browser/public/usan/usan-process.pdf [https://perma.cc/N5ES-SUR5] (outlining the procedure of processing an USAN application).

159. *See USAN/INN Negotiation Process*, AM. MED. ASS'N, https://www.ama-assn.org/sites/ama-assn.org/files/corp/media-browser/usan-inn-negotiation-process.pdf [https://perma.cc/A534-5PSN] (showing the process by which drug names are selected and approved).

160. Federal Food, Drug, and Cosmetic Act, Pub. L. No. 87-781, § 308, 76 Stat. 780, 796 (1962).

161. 21 C.F.R. § 299.4(c) (2019).

162. *Id.* § 299.4(e).

system and the FDA itself. As a result, generic drug names are, for all practical purposes, generic for trademark purposes as well.

C. 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 products.[163] The appearance of these new fibers, and consumers' unfamiliarity with them, led to governmental efforts to inform consumers about what they were buying. Under the 1958 Textile Fiber Products Identification Act,[164] 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.[165] 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."[166]

Authority for assigning appropriate generic names to different synthetic fibers under the Act resides with the FTC.[167] When developing its initial list of 16 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.[168] The generic names for fibers are often based on their chemical composition. For example, "acetate" is defined as "[a] manufactured fiber in which the fiber-forming substance is cellulose acetate,"[169] whereas other definitions are significantly more complex and include detailed chemical diagrams and formulae.[170]

Since 1977, similarly to the FDA's delegation of drug naming functions to the USAN Council, the FTC has adopted the fiber names designated by the International Organization for Standardization ("ISO") in ISO standard

163. *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. J.E. McIntyre, *Historical Background*, *in* SYNTHETIC FIBRES, *supra*, at 1, 1.

164. Textile Fiber Products Identification Act, Pub. L. No. 85-897, 72 Stat. 1717 (1958) (codified at 15 U.S.C. §§ 70–70k (2018)). 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 (*id.* §§ 68–68j) and fur (*id.* §§ 69–69j). *See also* Rules and Regulations Under the Textile Fiber Products Identification Act, 16 C.F.R. pt. 303 (2020) (following a similar pattern to the aforementioned statutes).

165. 15 U.S.C. § 70b(b).

166. *Id.* § 70a(a)–(c) (establishing liability); *id.* § 70f (establishing injunction proceedings); *id.* § 70g (establishing exclusion of imports); *id.* § 70i (establishing criminal misdemeanor penalties).

167. *Id.* § 70e(c).

168. *See* Lightman, *supra* note 112, at 83.

169. 16 C.F.R. § 303.7(e).

170. *See, e.g.*, *id.* § 303.7(c) (describing polyester).

2076.[171] This standard is maintained and reviewed every five years by the Textiles division of the ISO Technical Committee 38 ("ISO/TC 38").[172] ISO/TC 38 currently has 31 participating members including the United States, represented by the American National Standards Institute ("ANSI"), and 46 observing members.[173]

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.[174] Thus, the FTC, in its capacity as the overseer of fair advertising in the United States, 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.

D. TECHNICAL STANDARDS

A somewhat different example of sui-genericide arises 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, the European Telecommunications Standards Institute ("ETSI") and the Institute of Electrical and Electronics Engineers Standards Association ("IEEE-SA").[175] Private firms make technical contributions to standards within these SDOs and, once draft standards are advanced to a level suitable for implementation in products, the members of the SDO vote to approve and publish the resulting standards.[176]

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171. *See id.* § 303.7 (incorporating ISO standard ISO 2076:2010(E) by reference).

172. *See ISO 2076:2013: Textiles—Man-Made Fibres—Generic Names*, ISO, https://www.iso.org/standard/56206.html [https://perma.cc/W3RM-NRJN]. It appears that through the most recent revision in 2013, the 1977 list has been retained. INT'L ORG. FOR STANDARDIZATION, MAN-MADE FIBRES—GENERIC NAMES 2–5 (2013).

173. *ISO/TC 38: Participation*, ISO, https://www.iso.org/committee/48148.html?view=participation [https://perma.cc/LWQ7-VQ8F].

174. *See* Lightman, *supra* note 112, at 83. Interestingly, one Department of Commerce official reports that at the beginning of the program,

> [S]ome 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.

Id. at 84.

175. *See generally* C. Bradford Biddle, *No Standard for Standards: Understanding the ICT Standards-Development Ecosystem*, *in* THE CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: COMPETITION, ANTITRUST, AND PATENTS 17 (Jorge L. Contreras ed., 2018) (describing the broad range of SDOs active in technology markets).

176. *Id.* at 21–22.

1. Trademarks and Technical Standards[177]

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.

> 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.[178]

SDOs have taken a variety of approaches to protecting 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).[179] 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.[180] Other SDOs (e.g., ETSI) have registered and maintained trademarks for some of their standard-names and license these marks for use by manufacturers of standards-compliant products, typically on a broad, royalty-free basis.[181]

177. 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 Contreras, *Trademarks*, *supra* note 80. 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")." Jorge L. Contreras, *Technical Standards, Standards-Setting Organizations, and Intellectual Property: A Survey of the Literature (With an Emphasis on Empirical Approaches)*, *in* 2 [Analytical Methods] RESEARCH HANDBOOK ON THE ECONOMICS OF INTELLECTUAL PROPERTY LAW 185, 190 (Peter S. Menell & David L. Schwartz eds., 2019).

178. Contreras, *Trademarks*, supra note 80, at 205.

179. *What is ISO 9001:2015—Quality Management Systems?*, AM. SOC'Y FOR QUALITY, https://asq.org/quality-resources/iso-9001 [https://perma.cc/89X3-66VB]; HIGH DEFINITION MULTIMEDIA INTERFACE, https://www.hdmi.org/learningcenter/trademark_logo_pub.aspx [https://perma.cc/MKB5-PQWW].

180. Contreras, *Trademarks*, *supra* note 80, at 225–26.

181. *Id.* at 226.

Some SDOs, rather than protecting their standard-names as trademarks, have instead registered them as certification marks.[182] Unlike trademarks, certification marks do not identify the source of a product, but the product's compliance with certain standards.[183] Bluetooth, for example, is a popular short-range wireless connectivity standard published by the Bluetooth Special Interest Group and is registered as a certification mark.[184] Likewise, Wi-Fi (designating the 802.11 series of wireless networking standards published by IEEE-SA) is a certification mark held by the Wi-Fi Alliance.[185] These certification marks may be applied by anyone manufacturing or selling a product that complies with the relevant standard.[186]

2. Acts of Sui-Genericide: USB and W3C

Some standard-names have become so commonplace over the years that there is a strong argument that they have become generic. For example, the DVD (digital versatile disc) standard developed by Philips, Sony, and others in the early 1990s became ubiquitous and the term "DVD" came to signify any video disc-based storage medium of a particular size and configuration, without indication of source. For this reason, the DVD Format/Logo Licensing Corporation, which owns several DVD-related trademarks, disclaims the base term "DVD" in its trademark registrations.[187] It is likely that the creators of standards such as DVD and CD (compact disc) did not originally intend that these standard-names become generic; rather, this outcome was simply the result of broad public adoption of these standards. Yet a recent trend has emerged in which the owners of trademarks in standard-names have voluntarily declared these names to be generic: sui-genericide.

The USB Implementers Forum, Inc. ("USB-IF") is a non-profit corporation formed in 1995 by the companies that developed the Uniform Serial Bus ("USB") standard for interconnecting and charging electronic devices.[188] USB-IF, which today has over one thousand member companies, supports the advancement and adoption of USB technology[189] and owns several trademarks and certification marks relating to the USB standard (e.g., CERTIFIED USB[190]). Yet USB-IF does not hold a registration for the term USB itself. While USB, as

182. *See id.* at 223 tbl.12.2.

183. *See generally* JEFFREY BELSON, CERTIFICATION AND COLLECTIVE MARKS: LAW AND PRACTICE (2017) (discussing certification marks); Margaret Chon, *Certification and Collective Marks in the United States*, *in* THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW (Irene Calboli & Jane C. Ginsburg eds., 2020) (discussing certification marks).

184. BLUETOOTH, Registration No. 2,909,356.

185. WI-FI, Registration No. 2,525,795.

186. TMEP, *supra* note 54, § 1306.01 ("Certification marks may be used to certify that authorized users' goods or services meet certain standards in relation to quality, materials, or mode of manufacture (e.g., approval by Underwriters Laboratories).").

187. *See, e.g.*, DVD, Registration No. 2,295,726 (disclaiming the word "DVD" as the DVD logo design).

188. *About USB-IF*, USB, https://www.usb.org/about [https://perma.cc/AXG3-T6K4].

189. *Members*, USB, https://www.usb.org/members [https://perma.cc/93AT-9P53].

190. CERTIFIED USB, Registration No. 2,592,682.

an acronym for a relatively well-known descriptive term (Uniform Serial Bus), would likely be deemed descriptive under the *Abercrombie* framework,[191] it is possible that the mark USB, which has been in use for more than 20 years, has developed secondary meaning and 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.[192] 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."[193] USB-IF also noted that there were more than 80 records in the PTO'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.[194] USB-IF succeeded in having the registration for USB-HOUSE denied.[195]

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 Language ("XML").[196] W3C is an unincorporated coalition of four educational institutions: the Massachusetts Institute of Technology, the European Research Consortium for Informatics and Mathematics, Keio University, and Beihang University.[197] Its membership consists of approximately 445 institutions, private firms, and other organizations having an interest in standards for the Worldwide Web.[198]

191. Acronyms for descriptive terms are generally deemed to be descriptive themselves. *See* TMEP, *supra* note 54, § 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.").

192. *In re* USB-HOUSE, at 2 (T.T.A.B. 2008).

193. *Id.* at Exhibit C.

194. *Id.* at 4, Exhibit A.

195. *Id.*

196. *W3C Mission*, W3C, https://www.w3.org/Consortium/mission [https://perma.cc/U3E8-HEJB]; Jorge L. Contreras, *A Tale of Two Layers: Patents, Standardization, and the Internet*, 93 DENV. L. REV. 855, 874–75 (2016) [hereinafter Contreras, *Two Layers*].

197. *Facts About W3C*, W3C, https://www.w3.org/Consortium/facts#org [https://perma.cc/7ELB-NCJW].

198. *Current Members*, W3C (Oct. 19, 2020), https://www.w3.org/Consortium/Member/List [https://perma.cc/Z7KE-7UUV] (listing 445 members).

The acronym W3C is a registered trademark in a number of jurisdictions.[199] 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.[200] Yet on its website, W3C expressly identifies 20 additional terms (including the widely-deployed HTML, XML, and HTTP standards)[201] that it expressly designates as generic.[202] W3C states: "Terms which [are] claimed as generic are not governed by any W3C license and are used as common descriptors by the W3C."[203]

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.

IV. UNDERSTANDING SUI-GENERICIDE

As described in Part III, sui-genericide—the voluntary declaration of potentially valuable terms as generic—has been observed in a range of contexts from common names for pharmaceuticals, synthetic fibers and cultivated plants to broadly adopted technical standards. This Part explores the rationales leading private firms to relinquish rights to these potentially valuable terms, and assesses 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.[204] 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.[205] 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.[206]

Thus, manufacturers, regulators and consumers were united in their desire to find generic terms to refer to the basic categories of new products

199. Because W3C is not an incorporated entity, its intellectual property, including trademarks, is held by the Massachusetts Institute of Technology, which is its host institution. *See* Contreras, *Two Layers*, *supra* note 196, at 876–78 (describing W3C's legal structure).

200. *W3C Trademarks and Generic Terms*, W3C, https://www.w3.org/Consortium/Legal/2002/trademarks-20021231 [https://perma.cc/4SMT-YC6Y].

201. *Id.* HTML is an acronym for "HyperText Markup Language," XML is an acronym for "Extensible Markup Language," and HTTP is an acronym for "Hypertext Transfer Protocol." *Id.*

202. *Id.* (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).

203. *Id.*

204. LIZABETH COHEN, A CONSUMERS' REPUBLIC: THE POLITICS OF MASS CONSUMPTION IN POSTWAR AMERICA 6–8 (2003).

205. *See* Richards, *supra* note 163, at 20.

206. *See supra* notes 164–65 and accompanying text.

entering the market. The broad recognition of these generic terms would achieve three interrelated goals 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, whether in the United States or abroad, 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.[207]

For example, suppose that the term NYLON is 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 the 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 chemical names, such as polyhexamethylene adipamide, polycaproamide, or polyundecanamide.[208] The use of these complex chemical names would not only disadvantage competing nylon manufacturers, but would be less informative to consumers, who would be unlikely to remember the characteristics of the fiber when identified by such complex names.

Accordingly, the government took an active hand in organizing early naming efforts in fields such as prescription drugs 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,[209] chemical elements,[210] and plant and animal species.[211] 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

207. *See supra* Section II.D (discussing the Landes–Posner economic model).

208. *See* INT'L ORG. FOR STANDARDIZATION, *supra* note 172, at 4 (giving the definition of nylon).

209. Astronomical bodies are named by the International Astronomical Union. *See Naming of Astronomical Objects*, INT'L ASTRONOMICAL UNION, https://www.iau.org/public/themes/naming [https://perma.cc/XX7N-Y8RH].

210. *See Periodic Table of Elements*, INT'L UNION PURE & APPLIED CHEMISTRY, https://iupac.org/what-we-do/periodic-table-of-elements/#a4 [https://perma.cc/3A9T-XZWB].

211. *See generally* MICHAEL OHL, THE ART OF NAMING (Elisabeth Lauffer trans., 2018) (describing the process of scientific naming).

approving common names for new product categories and eventually took over this role entirely from the government.[212]

Outwardly, the designation by SDOs of certain standard-names as generic resembles coordinated sui-genericide activities by participants in industries like pharmaceuticals and textiles. 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*).[213]

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.[214] Instead, they publish documents laying out the protocols necessary to make these products interoperate with one another.[215] 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.[216] However, ETSI itself does not manufacture or sell LTE-compliant products.[217] 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.[218] And the microchips that enable LTE functionality in these smartphones are sold by vendors like Qualcomm.[219] 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

212. *See supra* Section III.D.

213. In this respect, a declaration of sui-genericide resembles the collective or group pledges made with respect to patents in industries that are heavily dependent on standards. *See generally* Contreras, *Patent Pledges*, *supra* note 8 (discussing the group patent pledges).

214. *See supra* notes 175–76.

215. *See supra* notes 175–76.

216. *Brand and Trademarks*, ETSI [hereinafter *ETSI Trademark Page*], https://www.etsi.org/media-library/brand-and-trademarks [https://perma.cc/8QN8-9ZQK].

217. *See* Contreras, *Trademarks*, *supra* note 80, at 226; *ETSI Trademark Page*, *supra* note 216.

218. *See ETSI Trademark Page*, *supra* note 216.

219. *See Modem-RF Systems*, QUALCOMM, https://www.qualcomm.com/products/modems [https://perma.cc/P2MC-J7TB].

standard.[220] Thus, the value of trademarks on standard-names is questionable and the case for treating these terms as generic is considerable.

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 "this travel vest has five zippered pockets," a product manufacturer may claim "this laptop offers four USB ports." To make such a 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. The manufacturer may simply assert, with a factual basis, that the relevant feature is offered.[221]

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, USB-IF successfully challenged an application for the mark USB-HOUSE when the term USB itself was not disclaimed.[222] 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.[223] 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.[224]

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

220. 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 80, at 219–20 (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.

221. 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 United States. *See id.* at 214–17.

222. *See supra* notes 192–95 and accompanying text.

223. *See, e.g.*, Brad Walz, *Breakdown of Trademark Infringement Litigation Costs*, BOB (Apr. 24, 2018), https://www.trademarkbob.com/blog/trademark-litigation-costs [https://perma.cc/ZSX3-5MXJ] ("To take a TTAB proceeding all the way to a final decision could cost $300,000 or more.").

224. To name just a few: USBGEAR, USB-CADDY, USB-BUG, and GOODUSB. Others can be found by accessing the PTO's public database. *Trademark Electronic Search System (TESS)*, U.S. PAT. & TRADEMARK OFF., http://tess2.uspto.gov [https://perma.cc/C5VH-YQFP] (click on "Basic Word Mark Search (New User)"; then type "USB" under "Search Term"; then click on "Submit Query").

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.[225]

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.[226] 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.

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,[227] 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 Section III.D.1, the owner of a certification mark may specify relevant quality or functionality features of a product (e.g., organic, kosher), so that that the manufacturer of any compliant product may designate its product using the mark.[228] 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,[229] thus establishing at least some baseline for reliance on the mark.

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225. *See supra* notes 8–15 and accompanying text.

226. *See* Landes & Posner, *Economic Perspective*, *supra* note 59, at 275.

227. *See supra* note 4 and accompanying text.

228. *See supra* Section III.D.1.

229. *See* 15 U.S.C. § 1064(5)(A) (2018) (describing how a certification mark may be cancelled if "the registrant . . . does not control, or is not able legitimately to exercise control over, the use of such 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? The manufacture and marketing of pharmaceuticals and synthetic fibers are regulated by governmental agencies.[230] 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. Thus, 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.

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 standards[231] 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 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 class action 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 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 manufacturer has a duty to represent its product fairly and accurately. If it does not, then a range of regulatory and tort remedies are available.

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230. *See supra* Section III.C.

231. *See generally* 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. (finding 251 standards embodied in an out-of-the-box laptop computer).

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 a certification mark. Sui-genericide may thus function like a poor man's certification: It enables the 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 United States 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.[232] 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.[233]

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.

V. 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.

A. LEGAL EFFECT OF UNILATERAL DECLARATIONS

As discussed in Part II, 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

232. *See* 2 MCCARTHY, TRADEMARKS, *supra* note 33, § 23:11; William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 91 (2008).

233. *See* Volkswagenwerk AG v. Church, 411 F.2d 350, 352 (9th Cir. 1969) ("[I]n . . . 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 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.[234] 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.[235] Why should we give greater weight to such a statement if it is made by The Coca-Cola Company itself? 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

The PTO has never officially 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 Section III.B, above, the PTO *Manual of Trademark Examining Procedure* ("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.[236]

In the single TTAB case mentioning USAN International Drug Names,[237] Smithkline Beecham opposed a Danish firm's U.S. application to register the

234. *See, e.g.*, Elliott v. Google, Inc., 860 F.3d 1151, 1156 (9th Cir. 2017); San Diego Comic Convention v. Dan Farr Prods., 336 F. Supp. 3d 1172, 1183 (S.D. Cal. 2018).

235. To this point, it is interesting to note that although W3C has self-declared the term HTTP to be generic, the HTTP standard was developed, and is maintained, by a different SDO, the Internet Engineering Task Force ("IETF"). *See* Contreras, *Two Layers*, *supra* note 196, at 876–77.

236. *See supra* Section III.B.

237. Searches for "World Health Organization" and "USAN" on LEXIS "All Trademark Law Cases" and "All Trademark Law Administrative Materials" conducted on April 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.

mark TOPOTECT for a human and veterinary cancer treatment.[238] 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.[239] Smithkline Beecham emphasized "that both the World Health Organization and USAN strongly discourage the use of USAN and INN generic terms as trademarks."[240] 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."[241] Thus, while the challenged mark was not found to be generic in this case, it at least offers some indication that the PTO may note whether a term is designated 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 are 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 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.[242] While a statement in such an application 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.[243] Thus, if other members of the relevant naming committee relied on the applicant's representation that a

238. Smithkline Beecham PLC v. TopoTarget ApS Corp., 2004 TTAB LEXIS 504, at *1 (T.T.A.B. 2004).

239. *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 n.8 (citing, *inter alia*, *In re* Organik Techs. Inc., 41 U.S.P.Q.2d (BNA) 1690 (T.T.A.B. 1997) (concluding "ORGANIK" was the phonetic equivalent to misdescriptive term "organic")).

240. *Id.* at *14.

241. *Id.* at *23–24.

242. *See supra* Sections III.B–.C.

243. *See* RESTATEMENT (SECOND) OF CONTS. § 90(1) (AM. L. INST. 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.").

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.[244]

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."[245] Because it is plausible to assume that this evidence could also have been used to oppose a U.S. registration of 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 the legal impact of a sui-genericide declaration on 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 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 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

244. 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 FRAND. *See* Jorge L. Contreras, *A Market Reliance Theory for FRAND Commitments and Other Patent Pledges*, 2015 UTAH L. REV. 479, 541–46 [hereinafter Contreras, *Market Reliance*] (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).

245. Travaglini & Lightman, *supra* note 112, at 743.

responsible for 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.[246]

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.[247] 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.[248]

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 cancellation of the relevant mark.

D. CANCELLATION PROCEEDINGS

As discussed in Section II.B, a registered mark may be challenged on the basis of genericism in a cancellation proceeding "by any person who believes that he is or will be damaged" by such registration.[249] In order to establish standing to bring a cancellation proceeding, such a person must allege "a direct and personal stake in the outcome of the" proceeding,[250] 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.[251] In addition, a registered mark that its owner seeks to enforce may be challenged as generic

246. 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 244, at 496–97 (discussing "voluntary SDO declarations" at SDOs such as IETF). 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 8, at 564–69 (discussing the forms of coordinated pledges).

247. 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, 515–16 (2016) (discussing SDO outsiders and licensing commitments).

248. *See* Smithkline Beecham PLC v. TopoTarget ApS Corp., 2004 TTAB LEXIS 504, at *3 (T.T.A.B. 2004).

249. 15 U.S.C. § 1064 (2018).

250. Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999); *see also* Empresa Cubana Del Tabaco v. Gen. Cigar Co., 753 F.3d 1270, 1275 (Fed. Cir. 2014) (explaining that a plaintiff's substantial interest in a trademark created standing to bring a claim).

251. *Ritchie*, 170 F.3d at 1098; *see also* U.S. PAT. & TRADEMARK OFF., TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE §§ 303.03–303.04 (2020) (defining "damage").

by an alleged infringer as an affirmative defense to the claim of infringement.[252] But none of these administrative or litigation genericism challenges to registered marks can be initiated by a mark owner or other interested party. Such cancellations currently require action by a third party—either through direct opposition to the mark or an infringement action in which it defends by challenging the mark as generic.[253] Moreover, even under these circumstances, litigation is costly and requires active and determined parties, which might not always be available.

What's more, governmental programs directed at challenging generic marks, such as the Bureau of Foreign Commerce Generic Word Program,[254] are unlikely to reemerge 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 consensus-based generic terms are not registered as trademarks.[255] This Section offers some modest proposals intended to enhance the legal effect of declarations of sui-genericide.

1. Consensus Lists in Trademark Examination

Though the lists of common names developed by the WHO INN program, the USAN Council, and SDOs and trade associations naming fibers and plants do not themselves have legal effect, they demonstrate that industry-led coalitions can develop lists of common names for new products. One way to lend greater legal effect to such lists (which I term "Consensus Lists") would be to enact federal legislation or regulation that officially recognizes Consensus Lists for purposes of trademark examination and challenge.

Under such a regime, trademark examiners would 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. Consulting 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.

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252. *See supra* text accompanying note 64.
253. *See supra* text accompanying notes 62–65.
254. *See supra* text accompanying note 120.
255. *See supra* Section V.B.

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 and preserve 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 are subject to a rebuttable presumption that they are generic 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 it) would be deemed ineligible for registration unless the applicant presented convincing evidence that the requested mark was distinctive.[256] 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.[257] 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.

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256. *See, e.g.*, Smithkline Beecham PLC v. TopoTarget ApS Corp., 2004 TTAB LEXIS 504, at *10 (T.T.A.B. 2004) (considering whether the proposed mark TOPOTECT was only "a slight misspelling, abbreviation, or variation of the generic term 'topotecan[]'").

257. Lanham Act, ch. 540, §§ 23–28, 60 Stat. 427, 435–36 (1946) (codified at 15 U.S.C. §§ 1091–1096 (2018)).

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.[258]

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 particularly important to ensure that the development of such Consensus Lists is conducted in a manner that will be deemed to represent an actual consensus among members of the relevant industry and not organized to advantage particular competitors or commercial interests.[259] 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.[260] Likewise, such due process mechanisms are required of any SDO that wishes to be accredited by ANSI as a developer of American National Standards.[261] The review of such groups and procedures

258. However, as pointed out by Professor Jason Rantanen, the creation of lists of presumptively generic terms could lead both trademark examiners and judges to look more skeptically at genericide challenges based on terms that do not appear on such lists. E-mail from Jason Rantanen, Professor of L., Univ. of Iowa Coll. of L., to Jorge L. Contreras, Professor of L., Univ. of Utah S.J. Quinney Coll. of L. (Aug. 9, 2019) (on file with author).

259. 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 generally, e.g.*, George S. Cary & Daniel P. Culley, *Concerted Action in Standard-Setting*, *in* THE CAMBRIDGE HANDBOOK OF TECHNICAL STANDARDIZATION LAW: COMPETITION, ANTITRUST, AND PATENTS, *supra* note 175, at 61 (describing cases of anticompetitive collusion in standard-setting).

260. 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, JORGE CONTRERAS, MARTIN HUSOVEC & PIERRE LAROUCHE, EUR. COMM'N JOINT RSCH. CTR., MAKING THE RULES: THE GOVERNANCE OF STANDARD DEVELOPMENT ORGANIZATIONS AND THEIR POLICIES ON INTELLECTUAL PROPERTY RIGHTS 115–22 (Nikolaus Thumm ed., 2019).

261. AM. NAT'L STANDARDS INST., ANSI ESSENTIAL REQUIREMENTS: DUE PROCESS REQUIREMENTS FOR AMERICAN NATIONAL STANDARDS § 3.0, at 10, § 3.1.1, at 10–11 (2020) (stating that an SDO must conform to the ANSI Essential Requirements in order to be recognized as a developer of American National Standards).

could be conducted by a governmental agency such as the PTO 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), the ICNCP (plants) and 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.[262]

Another question relevant to this proposal is whether declarations of sui-generericide 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).[263] 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: Legislative, Regulatory, Judicial

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 PTO and to create a legal presumption of genericness associated with names included on Consensus Lists.[264] 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 PTO could implement such a requirement through amendments to the Rules of Practice in Trademark Cases,[265] codified in the CFR and modified frequently through

262. *See supra* Section V.E.1.
263. *See supra* Section V.A.
264. *See supra* Section V.E.2.
265. Rules of Practice in Trademark Cases, 37 C.F.R. pt. 2 (2019).

agency notice and comment rulemaking.[266] It is also possible that at least a requirement that trademark examiners consult Consensus Lists during trademark examination could be effected through a simple amendment to the *Trademark Manual of Examining Procedure*,[267] a comprehensive guidance document for trademark examiners, applicants, and attorneys that is updated frequently.[268] 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 an examiner's attention to such declarations—a significant improvement over current practice.

Finally, even without formal legislation or regulation, at least some of the benefits of sui-genericide, whether unilateral or collective, could be recognized by the courts, which routinely evaluate industry norms and practices and establish legal presumptions. Through this mechanism, sui-genericide could be given greater legal weight almost immediately, and judicial decisions recognizing this doctrine could spur the development of legislation and regulation.

5. International Harmonization

As indicated by continuing efforts of the USTR in the area of foreign registration of generic and common names,[269] there is little international harmonization of the treatment of generic and common names.[270] Yet, the development of common names in an increasing array of product categories is international in nature.[271] It would thus be worthwhile for the USTR and the PTO to urge their foreign counterparts, through existing international cooperative channels, to consider the adoption of the examination and presumption proposals discussed in Sections V.E.1–.2 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

266. *See Rule Making: Trademark Federal Register Notices and Comments*, U.S. PAT. & TRADEMARK OFF. (July 16, 2020, 10:43 AM), https://www.uspto.gov/trademark/laws-regulations/rule-making-trademark-federal-register-notices-and-comments [https://perma.cc/62UH-QFK6].

267. TMEP, *supra* note 54.

268. *See Trademark Manual of Examining Procedure—Files and Archives*, U.S. PAT. & TRADEMARK OFF. (Oct. 31, 2018, 9:14 AM), https://www.uspto.gov/trademark/guides-and-manuals/tmep-archives [https://perma.cc/Y8AN-EXA3] (showing the TMEP has been updated 17 times since 2010).

269. *See supra* Section III.A.

270. *See generally* Brauneis & Moerland, *supra* note 119 (discussing the need for greater international harmonization in the recognition of foreign language generic terms).

271. *See, e.g.*, *supra* Section III.B.1 (describing the WHO INN program for pharmaceutical common names); *see supra* Section III.C (describing ISO/TC 38 for textile fibers); *see supra* note 123 and accompanying text (describing the Codex Alimentarius Commission for foodstuffs); *see supra* Section III.D.2 (describing a range of transnational technology-focused SDOs including W3C, ETSI, IEEE-SA and others).

the PTO does. 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 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.[272]

Likewise, law and regulation in numerous countries prohibit the registration of WHO-recognized INNs and other common names as trademarks.[273] Accordingly, international harmonization of the proposed measures may be easier to achieve than initial adoption in the United States.

VI. 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 legislation, regulation, 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

272. Council Regulation 2017/1001, art. 7(1)(m), 2017 O.J. (L 154), 9 (EU). *See generally* EUR. UNION INTELL. PROP. OFF., GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS (2017), https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/26_part_b_examination_section_4_AG_chap_13_article_7(1)(m)_clean_lr2_en.pdf [https://perma.cc/T2VC-U9GW] (discussing how to interpret the regulation).

273. *See, e.g.*, The Trade Marks Act, 1999, § 13 (India); *see also* Subregional Integration Agreement (Cartagena Agreement), Decision 486—Common Provisions on Industrial Property, art. 135(f), Sept. 14, 2000, https://www.wipo.int/edocs/lexdocs/laws/en/can/can012en.pdf [https://perma.cc/L7VH-W836] ("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 . . . .").

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