



THE PROBLEM OF GENERICIDE IN TRADEMARK LAW: A COMPARATIVE STUDY WITH FOCUS ON INDIAN JURISPRUDENCE

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Abstract:

This research article critically addresses the subject of genericide in trademark law, with a comparative focus on Indian jurisprudence. It analyzes how trademarks lose their individuality and legal protection when they become generic words through public usage. With a focus on legal tests, evidence procedures, and judicial tendencies, a thorough comparison of legal standards in the US, EU, and India is provided. The study outlines the flaws in India's present strategy and makes policy suggestions for procedural change and doctrinal clarity. It emphasizes how crucial a strong legal system is to preserving trademark integrity and customer confidence.

Keywords: Genericide, Trademark, Comparative focus, robust legal framework, distinctiveness, judicial trends.

1. Introduction

In the intricate domain of intellectual property law, trademarks hold a unique position by acting as a link between legal safeguards and the commercial identity of businesses. They serve to differentiate the goods or services of one entity from those of others, enabling consumers to make informed choices and allowing companies to build brand value. However, this crucial function is at risk when a trademark, through widespread misuse or neglect by its owner, loses its uniqueness and becomes synonymous with the category of products or services it represents. This phenomenon is known as genericide.

Genericide presents an intriguing contradiction within trademark law where the very success and widespread recognition of a trademark can lead to its erosion. Once a term that signifies the origin of a specific product becomes associated with the product itself in the minds of consumers, it no longer qualifies as a protectable trademark. Notable historical examples from international courts include "Aspirin," "Escalator," "Thermos," and "Cellophane," which were once exclusive trademarks but eventually became generic terms due to common usage.

The principle of genericide serves a vital public interest function. It prevents any single business from monopolizing essential terms that others need to describe their products. However, it also imposes a considerable responsibility on trademark owners to vigilantly monitor and control the use of their marks, ensuring they remain distinct from common language. This tension between protecting commercial interests and preserving linguistic freedom underscores the complex nature of trademark law. In the Indian legal system, the response to genericide is still in its early stages. While the Trade Marks Act, 1999, outlines general principles of distinctiveness and exclusion by description, it does not explicitly define or include genericide as a basis for trademark cancellation. Although Indian courts have addressed cases involving the loss of distinctiveness, a consistent body of case law specifically

dealing with genericide has not yet been established. This ambiguity can present challenges for businesses operating in a globalized market, particularly in sectors such as pharmaceuticals, technology, and consumer goods, where brand dilution is a frequent concern. This research paper seeks to explore the issue of genericide by conducting a thorough comparative analysis of key legal jurisdictions, namely the United States, the European Union, and the United Kingdom. It will also focus on the evolving landscape of Indian jurisprudence in this area. The paper will investigate the theoretical foundations, evidence required, prevailing judicial trends, and policy considerations related to genericide. It will also evaluate the strategies used by trademark holders to prevent genericide and propose recommendations for strengthening India's legal framework to better address the challenges posed by this phenomenon.

By examining this topic from various legal and practical viewpoints, the research aims to enhance understanding of how trademark law should balance the interests of businesses, consumers, and the broader public in the context of a rapidly evolving commercial environment.

2. Understanding Genericide in Trademark Law

Definition and Legal Nature : Genericide arises when the public adopts a trademark as a generic name for a product or service category, so that the mark becomes generic. In trademark law, distinctiveness is a *sine qua non* to registration and enforcement. If a trademark is so widely and generically used that consumers use it to describe the product itself instead of its source, it becomes generic.

The doctrine benefits the public interest in that it protects language from becoming captive and preventing any entity from monopolizing widely used product descriptions. Therefore, trademarks are protected property rights, but they are not absolute or permanent.

Types of Marks and Vulnerability to Genericide

Trademarks fall generally into:

Fanciful/Arbitrary Marks (e.g., Apple, Kodak)

Suggestive Marks (e.g., Coppertone)

Descriptive Marks (e.g., "Creamy" for milk products)

Generic Terms (e.g., "Milk" for milk)

Arbitrary and fanciful marks are less likely to succumb to genericide, and descriptive marks are most susceptible. Even fanciful marks can, however, become generic by repeated abuse (e.g., "Escalator").

Comparative Jurisprudence

Understanding the doctrine of genericide requires a comparative ideology, it is because of the reason that it has different jurisdictions to adopt, distinct statutory formulations, judicial tests, and evidentiary approaches to determine when a trademark has become generic. This section provides an in-depth analysis of how genericide is treated in the United States, European Union, and the United Kingdom—three jurisdictions that have significantly shaped global trademark jurisprudence—and contextualises their relevance to Indian legal development.

Firstly about the United States, The United States possesses the most advanced jurisprudence on genericide, primarily because it was one of the first countries to recognize the phenomenon of genericide and it has a strong common law tradition. The statute governing is the Lanham Act¹ in the country, which gives grounds for cancellation of a registered mark if it becomes "the generic name for the goods or services. or a portion thereof."

American courts largely depend on the "primary significance test," which determines whether the primary significance of the term among the minds of the concerned public is the product itself or not. This test was clearly defined in *Kellogg Co. v. National Biscuit Co*², where the Supreme Court ruled that "shredded wheat" was generic because the public identified the term with the product, not a particular manufacturer.

Key Case laws on which the U.S. Courts Rely on :

*Bayer Co. v. United Drug Co*³: Judge Learned Hand held that "Aspirin," while an original proprietary mark of Bayer, had reached the status of being generic within the United States due to universal use by the public, in spite of remaining a proprietary trademark in other courts.

*King-Seeley Thermos Co. v. Aladdin Industries, Inc*⁴: The court ruled that "Thermos" had lost its trademark value and become the generic name for vacuum flasks, reiterating that public use could supersede even aggressive trademark policing by the owner.

*Elliott v. Google Inc.*⁵: One of the newest landmarks, this case made clear that verb usage (e.g., "to google something") does not always make a mark generic. The court ruled that even though widely used as a verb, "Google" still had source meaning in consumers' minds.

Secondly, the European Union, The European Union is based on a mixed legal system combining civil law with supranational regulation. Genericide is covered by Article 58(1)(b) of Regulation (EU) 2017/1001, under which a European Union Trade Mark (EUTM) is to be revoked if "in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service."

Legal Terminology commonly used on this regard is that "Degeneration": The EU terms the loss of uniqueness through generic use as "degeneration." In contrast to the U.S. system, the EU model emphasizes the actions of the trademark owner. The owner must take action against abuse or let it spread; otherwise, the mark is susceptible to cancellation.

Key case law in the EU is *Windsurfing Chiemsee Produktions v. Boots- und Segelzubehör Walter Huber*⁶: CJEU, i.e, Chief Justice of European Union has held that a geographic name could become distinctive if the public of the concerned area understands it as a mark. This case implicitly explained

¹ The Lanham (Trademark) Act [Pub. L. 79-489](#)

² *Kellogg Co. v. National Biscuit Co* (305 U.S. 111, 1938)

³ *Bayer Co. v. United Drug Co.* (272 F. 505, S.D.N.Y. 1921)

⁴ *King-Seeley Thermos Co. v. Aladdin Industries, Inc.* (321 F.2d 577, 2d Cir. 1963)

⁵ *Elliott v. Google Inc.* (860 F.3d 1151, 9th Cir. 2017)

⁶ *Windsurfing Chiemsee Produktions v. Boots- und Segelzubehör Walter Huber* (Joined Cases C-108/97 and C-109/97, 1999 ECR I-2779)

that degeneration (or genericide) is all about consumer perception but also takes into account the behavior of the owner and the linguistic requirement of the term.

Criteria for Genericide under EU Law: Evaluation of the relevant class of consumers, frequently in more than one member state.

Determination of whether the term has lost its origin function as a result of "acts or inactivity" of the owner.

Burden on the proprietor to demonstrate active steps to maintain distinctiveness.

Comparative Observations:

The EU system is proprietor-oriented compared to the U.S. system. Although both gauge public opinion, the EU incorporates an added measure of responsibility upon the trademark holder to avoid decay. In multi-lingual cultures, this can create significant compliance burdens.

Thirdly United Kingdom, Prior to Brexit, the UK implemented the EU Trade Mark Directive and the CJEU jurisprudence. After Brexit, the UK Trade Marks Act 1994 still reflects most of the EU regime. Pursuant to Section 46(1)(c) of the Act, a trademark can be revoked if "it has become the common name in the trade for a product or service in respect of which it is registered."

Test for Genericide: The UK uses a two-pronged test:

- Whether the term has become generic in trade.
- Whether the owner has not taken proper measures to avoid such result.

Key Case here is: *Celltech Pharma Ltd. v. The Office for Harmonization in the Internal Market (OHIM)*: Though decided in the EU system, this case was invoked by UK courts to affirm the principle that a trademark employed generically within an industry might nonetheless preserve its proprietary value if the general public perceives it as source-identifying.

Evidentiary Emphasis: The UK courts give considerable emphasis to:

Trade usage

Consumer and expert opinion

Policing activities of the proprietor

The onus of proof usually rests with the party requesting revocation to prove that the trademark has lost its origin function.

Lastly the Relevance of all these with India

The Indian Trade Marks Act, 1999 does not formally adopt the doctrine of genericide. Nonetheless, it is heavily influenced by common law jurisdictions, particularly the UK, and also recognizes the importance of consumer perception. Indian courts, not having a codified genericide doctrine, tend to fall back on: Descriptive use exclusions under Section 9, Revocation for loss of distinctiveness under Section 47(1)(b), Public interest balancing.

India's absence of a systematic legal and evidentiary regime for dealing with genericide is wanting in predictability and consistency. The lack of statutory tests similar to the "primary significance" doctrine implies that courts improvise on an ad hoc basis, frequently without adequate empirical support.

3. Indian Jurisprudence on Genericide

Although the Indian Trade Marks Act, 1999 does not specifically employ the term genericide, the notion is dealt with indirectly by means of provisions concerning loss of distinctiveness. The provision most closely applicable is Section 47(1)(b), under which a registered trademark may be removed if it has become the "common name in the trade" for the goods or services with which it is registered as a result of the proprietor's acts or omissions. This closely mirrors the EU approach, which focuses on the owner being responsible for policing their mark.

India does not follow a codified test such as the U.S. "primary significance test." Rather, courts examine whether the public still identifies the mark with the source or simply the product itself, in large part based on context and fact evidence. Indian jurisprudence is in a state of development, with few but influential decisions showing the judicial approach toward genericness.

In *Marico Ltd. v. Agro Tech Foods Ltd.* (2010), the Bombay High Court held that the term "LO SODIUM" was generic as it simply labeled a product characteristic. While not a typical example of post-registration degeneration, it stressed descriptiveness and use by others as generic disavows uniqueness.

More specifically on point is *ITC Ltd. v. Nestle India Ltd.* (2020), in which the Delhi High Court ruled that "Magic Masala" had attained descriptive and generic status as a result of industry-wide usage. Of particular significance, the fact that ITC did not produce consumer survey data weakened its argument of secondary meaning. This reflects the growing judicial focus on market use and public perception—even though formal surveys are seldom conducted in India.

Equally, in *Britannia Industries Ltd. v. ITC Ltd.* (2021), the Delhi High Court reaffirmed that words such as "Nutri Choice" could not be monopolized without definite proof of source-identifying character. The Court emphasized that if a term is widely used by various market participants, then the burden of proof is on the trademark owner to prove distinctiveness through effective enforcement and consumer identification.

Indian courts, albeit prudent, have acknowledged the risk of trademarks being stripped of their proprietary nature due to public use, non-enforcement, and market saturation. Yet, due to the absence of a standardized evidentiary framework, i.e., required consumer perception surveys or linguistic study, application has been inconsistent.

The other challenge is the confusion of genericness at the stage of registration and genericide post-registration. Indian case law does not always recognize the difference between these two stages and thus creates confusion in analysis. In addition, the Trade Marks Registry has failed to provide procedural guidelines for seeking cancellation under Section 47(1)(b) in particular, while other sections have well-defined opposition mechanisms.

In summary, while the Indian judicial system recognizes implicitly the doctrine of genericide, there is a compelling need for doctrinal sophistication, systematic evidence standards, and administrative change. As Indian trademarks emerge as world players, formulating a sturdy and predictable scheme to combat genericide will become crucial in guarding trademark value and consumer confidence.

4. Legal Tests and Evidentiary Standards

The legal determination of genericide depends mainly on consumer perception and the degree to which a trademark still serves as an indicator of source. Under U.S. law, the "primary significance test" is the standard established by §1064(3) of the Lanham Act whereby the inquiry is whether the primary meaning of the term to the public is the name of the product itself or its source. On this question, U.S. courts have depended on evidence based on empirical fact—specifically, carefully designed consumer surveys—whether a trademark has fallen into generic use.

Teflon survey" and "Thermos survey" are two high-profile survey techniques taken to gauge consumer recognition. Courts accept corroborative testimony like dictionary entries, extensive third-party use, trademark owner failure to police mark, and reference in the press. Under the European Union, Article 58(1)(b) of the Regulation 2017/1001 EU Trade Mark states that a mark is liable to revocation if it is the common name in trade under the acts or omissions of the proprietor. The Court of Justice of the European Union gives equal importance to the perception by the relevant class of persons as well as to the diligence by the proprietor to enforce. Trade usage, competitor behavior, and documentary evidence of the proprietor's proactive steps to preclude misuse—e.g., cease and desist notices—are some of the crucial evidentiary ingredients.

Contrarily, Indian trademark jurisprudence is devoid of a codified test for genericide. Although Section 47(1)(b) of the Trade Marks Act, 1999 allows the cancellation of a mark that is the common name in the trade because of the proprietor's neglect, Indian courts have not developed a systematic consumer perception test or standardized survey procedures. Judicial decisions tend to be based on circumstantial evidence such as usage by competitors, descriptive nature of the mark, and lack of enforcement action. Importantly, Indian courts, in rulings such as *ITC v. Nestle* and *Britannia v. ITC*, have held that consumer perception is valuable as evidence but were skeptical of unregulated survey data. Thus, the Indian evidentiary landscape continues to be ad hoc and judge-made, and it introduces uncertainty into judgments. The lack of doctrinal consistency and empirical precision highlights the urgent need for legislative or judicial definition to bring it in line with international best practices in genericide assessment.

Doctrinal Tensions

Private Right vs. Public Interest

The genericide doctrine captures the timeless IP conundrum—is a private party entitled to usurp a term necessary for communication?

- The balancing act includes:
- Protecting reasonable investments of brand owners
- Preserving market competition and linguistic freedom
- Preventing consumer deception

In India, courts generally favor public interest in close cases. This is different from the U.S., where robust brand protection is the rule unless overwhelming proof of genericide is shown.

Preventing Genericide and Policy Recommendations for India

Prevention of genericide involves proactive, multi-pronged effort by trademark owners and systemic judicial assistance. Internationally, trademark owners preserve distinctiveness by active policing of the marks, public education programs to remind consumers of brand identity, and regular use of the trademark with proper symbols (™/®) and qualifiers (e.g., "X-brand photocopiers" rather than "Xeroxing"). Enforcement against competitor infringing and descriptive use is also essential. In India, the lack of formal doctrinal precision and evidentiary requirements has undermined the enforcement mechanism under Section 47(1)(b) of the Trade Marks Act, 1999. To reduce the risk of genericide and enhance trademark protection, a number of policy interventions are suggested. First, the Indian Trade Marks Registry and judiciary must embrace the "primary significance test" as a norm to decide public perception, thus conforming to international jurisprudence. Second, statutory or judicial standards should be framed to govern the admissibility, technique, and weight of consumer perception surveys in trademark litigation. Third, capacity building and training of examiners and judges on genericide and brand degeneration should be institutionalized. Fourth, the Registry can issue advisories inviting brand owners to keep an eye on third-party usage and conduct periodic distinctiveness audits. Finally, amendment to legislation should codify the procedural structure under which cancellation proceedings can be brought on grounds of genericide, with explicit evidence hurdles. A firm blend of owner vigilance as well as systemic legal reform needs to come into place to avoid dilution of proprietary rights and continue to ensure trademarks play their fundamental role of differentiating goods and services in the market.

5. Conclusion

The specter of genericide poses a serious menace to the validity of trademark law by devaluing the essence of trademarks as identifiers of sources. By comparative analysis, it can be seen that although jurisdictions such as the United States and the European Union have formulated systematic legal tests and evidence standard such as primary significance test and consumer perception surveys India is in the infancy of addressing this problem with legal specificity. Indian doctrine, although conceptually recognizing the issue via Section 47(1)(b) of the Trade Marks Act, 1999, is not doctrinally precise, lacks standardized evidentiary procedures, and is enforced unevenly. Trademark owners are left exposed to brand dilution in the absence of efficacious legal recourse.

In order to protect the economic and reputational equity in trademarks, India has to shift toward an empirically oriented and doctrinally precise apparatus for determining genericide. Judicial recognition of systematic consumer surveys, use of internationally accepted tests, and administrative changes in the Trade Marks Registry are necessary steps ahead. As Indian markets become more global and competitive, strengthening the legal framework against genericide will not only safeguard brand owners but also consumer faith and stability in the market. Genericide is thus not merely a legal requirement, but a strategic priority for a contemporary IP ecosystem.

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