

# THE NIGERIAN JURIDICAL REVIEW

Vol. 13

(2015)

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## **NIGERIAN JURIDICAL REVIEW**

**VOLUME 13 (2015)**

To be cited as: **(2015) 13 Nig. J. R.**

**ISSN: 0189 - 4315**

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### CONTRIBUTIONS

The Journal welcomes articles in any area or related subjects for publishing considerations. Articles and correspondence should be forwarded to:

The General Editor,  
Nigerian Juridical Review, Faculty of Law,  
University of Nigeria, Enugu Campus, Enugu, Nigeria.  
[nigeriajuridical@unn.edu.ng](mailto:nigeriajuridical@unn.edu.ng), [nigeriajuridical@yahoo.com](mailto:nigeriajuridical@yahoo.com)

### PUBLISHED BY

Faculty of Law, University of Nigeria,  
Enugu Campus

### PRINTED BY:

Sylva Prints, Enugu & Abuja  
+234-08063978826; +234-08181610325  
[onyekasyivanus@yahoo.com](mailto:onyekasyivanus@yahoo.com); [sylvanusonyekachi@gmail.com](mailto:sylvanusonyekachi@gmail.com)

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**WHEN A TRADEMARK BECOMES A VICTIM OF ITS OWN SUCCESS:  
THE IRONY OF THE CONCEPT OF GENERICIDE\*****Abstract**

*A proprietor who launches his new product into the market takes on any market strategy to make such product popular and sought after. He gets a brand name for the product so as to distinguish his brand from other brands of the same class of products and advertises it so well that the brand name becomes a household name and the choice of majority of the consumers as against other competing brands of the same class of products. This is a sign of progress in business for such proprietor. However, where such brand name becomes so popular that consumers mistake the brand name for the generic name of products of that class, the brand name becomes "genericised" and therefore loses its distinctiveness and exclusivity to the proprietor. Thus, any competing company is free to use such brand name on its own product. This is a situation where the success of a product brand has led to its extinction. This paper posits that the concept of genericide operates more as a punishment on a successful proprietor than protecting the interest of competitors and consumers.*

**Keywords:** Trademark, Genericide, Intellectual Property, Generic names, Distinctiveness, Trademarks Act.

**1. Introduction**

A trademark is registered by a proprietor so as to distinguish the proprietor's product from those of other competitors. Thus, the proprietor thereafter markets his product under that trademark with a view to making it a popular brand and the major choice of the purchasing consumers. Through good and overwhelming marketing strategy, the trademark may become a household name, so popular that the trademark name or symbol may thus be used to associate or identify products of that particular class. Where the purchasing public identify products of that class with a particular trademark, whether the product is that of the trademark proprietor or not, it is

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\* **Nkem Itanyi, LL.M. (Lond), LL.B. (Ife) B.L.**, Lecturer in the Department of Commercial and Property Law, Faculty of Law, University of Nigeria. E-mail: [nkem.itanyi@unn.edu.ng](mailto:nkem.itanyi@unn.edu.ng).

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said that the trademark has become “genericised” – some form of trademark “suicide,” where a trademark by being so successful, “murders” itself and thus made a general or generic name. The argument is this: the *primus inter pares* of the *raison d’ etre* for registering a trademark and using same in relation to a particular product/goods is so as to distinguish that product from those of the competitors. Thus, where the trademark is no longer capable of distinguishing the product from those of the competitors, it is declared to have committed genericide and thus, have become generic and capable to be used by anyone including the competitors of the original trademark proprietor. Most often than not, it is recognised that it is always the competitors to the trademark owner that goes to court seeking a declaration that the proprietors trademark has become generic. Hence they want to benefit from the popularity of their competitor. It is against this backdrop that we argue in this paper that the concept of genericide is a punishment to the trademark proprietor; as he is punished for being successful with his trademark and brand product. Also, it is our view that the concept of genericide is antithetical to trade competition. It is our recommendation herein that the concept of genericide be abolished or in the alternative, competitors who use the trademark after it has become generic should pay adequate compensation to the trademark proprietor before such use. In discussing this topic, our jurisdictional focus is primarily on Nigerian legislation and case law with secondary references to international laws and case law.

**2. Nature of Trademarks.**

Trademarks are regulated in Nigeria by the Trademarks Act.<sup>1</sup> According to the Act a trademark means:

Except, in relation to a certification mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification

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<sup>1</sup> Cap. T13 Laws of the Federation of Nigeria, 2010.

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trade mark, a mark registered or deemed to have been registered under section 43 of this Act.<sup>2</sup>

The Act went further to define a mark as including “a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.”

In a simplistic form, the Black’s Law Dictionary defines Trademark as “a word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others. The main purpose of a trademark is to designate the source of goods or services. In effect, the trademark is the commercial substitute for one’s signature.”<sup>3</sup>

Similarly, Ogunwumiju JCA adopting the Supreme Court’s definition in *Ferodo Ltd. v. Ibeto Industries Ltd.*<sup>4</sup> stated as follows:

A trademark is a distinctive picture which would indicate to a purchaser of an article bearing it, the means of getting the same article in future by getting an article with the same mark on it. It is a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right either as a proprietor or a registered user to use the mark.<sup>5</sup>

To compartmentalize the above definitions, trademarks could be said to be any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors.

A trademark is registrable under the Trademarks Act (TMA) and the essence of a trademark is that it indicates a connection in the course of trade between the goods and some person having the right to use the name. The registration of trade mark grants a monopoly right and once registered it can be protected both under the statute and under the common law of passing off.<sup>6</sup>

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<sup>2</sup> Section 67 Trade Marks Act, *ibid.*

<sup>3</sup> Bryan Garner (ed.), *Black’s Law Dictionary 9<sup>th</sup> edn.*, (St. Paul Minn USA: Thomson Reuters, 2009) p. 1630.

<sup>4</sup> [2004] 5 NWLR (Pt. 866) 317.

<sup>5</sup> *The Procter and Gamble Company v. Global Soap and Detergent Ind. Ltd. & Anor.* [2013] 2 NWLR (Pt. 1336) p. 461.

<sup>6</sup> See *Patkun Ind. Ltd. v. Niger Shoes Manufacturing Co. Ltd.* [1988] 5 NWLR (Pt. 93) 138.



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Some reasons can be adduced as to why trademarks are protected. First, the essence of trademarks is to distinguish one proprietor's goods from those of his competitors' belonging to the same class. Thus registration of trademarks which are identical or closely resembling each other in respect of same class of goods are prohibited, this is to avoid likelihood of deceit or confusion in the minds of the consumers. The protection of trademarks also encourages the manufacture of quality goods. A long usage of trademark may associate the goods upon which it is used with either high quality or low quality. Thus, a proprietor known by a particular trademark which has been associated with high quality will be encouraged to maintain the high quality standard and maintain his goodwill. Competitors will also be forced to produce high standard goods to match the goodwill of their counterpart. Trademark protection is also granted to avoid imitation. Unscrupulous business men who being aware that a particular trademark has been associated with high quality may want to imitate the trademark and use same on their product without a corresponding high quality product like that of the trademark proprietor. This will in effect bring down the goodwill of the trademark proprietor, hence the trademark protection. Trademark can be used as a secret weapon in domain name disputes. It is a valuable adjunct to a particular business technology.

The man who thinks up a distinctive and original name, device or get-up to market his goods in order to make the goods easily recognisable or even more attractive to the average purchaser, and had over a period of time procured through the quality of his goods substantial goodwill for the name, device or get up, deserves some protection for such name, device or get-up, and he is indeed protected by the law of trademarks.

Like some other intellectual property rights, the registration of trademark confers protection on the proprietor for a limited period of time subject to renewal from time to time.

By section 2(1) of the TMA, there shall continue to be kept the record called the Register of Trademarks, in which shall be entered all registered trademarks with the names and addresses of their proprietors, the date on which applications were made for their

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registration, notifications of assignments and transmissions, the names and addresses of all registered users and such other matters relating to registered trademarks. Section 2(3) provides that the register shall continue to be divided into two parts, Part A and Part B respectively.

Generally, the effect of registration is the grant of monopoly right to use to mark and exclude others from using the mark; and in the event that another person uses the mark, the registered proprietor has the right to sue for infringement of his trademark. However, a proprietor of an unregistered trademark has a right of action in passing off against infringers. Most specifically, the part of the register wherein a trademark is registered determines the extent of the rights and protection granted to the proprietor of the registered trademark. Registration under Part A of the Register confers on the proprietor more rights and protection than those registered under Part B. For example, a registration in Part A is valid in all respects after seven years and can no longer be removed from the register unless where the registration was obtained *ab initio* by fraud or where the mark is scandalous or deceptive.

A trademark is registered in respect of particular goods or classes of goods. Requirements of registration under the two parts of the Register are distinct. By virtue of section 9 of the TMA, for a trademark to be registrable in Part A of the register it must contain the following distinctive particulars:

- (a) The name of the company, individual, or firm represented in a special or particular manner.
- (b) The signature of the applicant for registration or some predecessor in his business.
- (c) An invented word or invented words.
- (d) A word or words having no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or a surname.
- (e) Any other distinctive mark.

The key requirement for registration under Part A of the TMA is that the proposed mark must be distinctive. The Act further defines "Distinctive" as "adapted in relation to the goods in respect of which

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a trademark is registered, to distinguish goods within which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists.”<sup>7</sup> Regrettably, the meaning of ‘distinctive’ does not appear to have been analysed in depth in any decide Nigerian case. In *International Tobacco (Nig.) Ltd. & 2 Ors. v. British American Tobacco (Nig.) Ltd. & Anor.*<sup>8</sup> The Court made an attempt at defining the term ‘distinctiveness.’ The court said:

Distinctiveness as it relates to the law of trademarks means an essential element of a device claimed to be a trademark that identifies the goods of a particular merchant and distinguishes them from the goods of others. A word, symbol, shape or colour serving this purpose is said to be distinctive. Certain marks are inherently distinctive while others only acquire distinctiveness over time. A distinctive mark may lose its distinctiveness over time and become generic. To satisfy the test of distinctiveness when one sees the mark, one’s mind should immediately go to the person or company who sells or manufactures the article and to no others.

For registration in Part B of the Register, the requirement is the mark sought to be registered must be capable of distinguishing goods with which the proprietor of the trademark is connected in the course of trade. Thus, at the point of registration the mark is not required to be distinctive but that it must be capable of distinguishing the goods and may become distinctive through usage after a long time. As soon as it becomes distinctive the owner of the mark could make a fresh application to register it in Part A.

In *Ustikon, Davies v. Sussex Rubber Co.*<sup>9</sup> the court held that the expression “capable of distinguishing” seem to have a somewhat wider import than the expression “adapted to distinguish” in that the former embraces marks which have not, at the date of the application, but which, if used long enough, may acquire the characteristic of distinctiveness of the goods of the proprietor of the trademark.

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<sup>7</sup> Section 9(2) Trade Marks Act.

<sup>8</sup> [2009] 6 NWLR (Pt. 1138) 577.

<sup>9</sup> (1927) 44 RPC 412

There are certain marks which are not allowed to be registered as trademarks. Some of these includes, deceptive or scandalous marks,<sup>10</sup> identical and resembling trademarks likely to deceive or cause confusion;<sup>11</sup> names of chemical substances.<sup>12</sup>

On infringement of trademarks, Section 5(2) provides that without prejudice to the generality of the right to the use of a trade mark given by such registration as aforesaid, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof, using it by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being used as a trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

For the purposes of the infringement of a trade mark, it is not all the features that are contained in the mark that are important. Not all the components are to be considered as forming part of the trademark. The resemblance giving rise to infringement must lie in the basic idea of the mark.<sup>13</sup> In an action for infringement of a trademark, the plaintiff must establish his title either as proprietor or as a registered user entitled to sue. He must then prove that the defendant has acted or threatens to act in a way as to infringe the right conferred upon him by the registration of the trade mark under the Act.<sup>14</sup>

In other to found infringement of a trademark, the intention of the defendant needs not be fraudulent or deliberate. Thus, the phrase “likely to deceive” as used in TMA does not necessarily imply fraud or

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<sup>10</sup> Section 11 TMA

<sup>11</sup> Section 13 TMA

<sup>12</sup> Section 12 TMA

<sup>13</sup> *Procter & Gamble Co. v. Global Soap & Detergent Ind. Ltd.*, above note 5.

<sup>14</sup> *Ayman Enterprises Ltd. v. Akuma Ind. Ltd.* [2003] 13 NWLR (pt. 836) 22

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anything of like nature on the part of the defendant. The relevant consideration is the likely effect of the trademark on members of the consuming public. Therefore, where the mark is likely to confuse the public, the likelihood of deceit is deemed to be present. The foregoing factor is of paramount importance particularly in Nigeria where a considerable number of people are illiterates, more so, when what will not deceive an educated, diligent and careful purchaser may well deceive the illiterate.<sup>15</sup>

### **3. Generic Terms and Genericide**

A valid trade mark can only become generic if the consuming public misuses the mark or name sufficiently for the mark to become the generic name of the product. According to the Black's Law Dictionary, 'generic' was defined thus, "common or descriptive, and thus not eligible for trademark protection; nonproprietary; not having a trademark or brand name."<sup>16</sup> From the foregoing, it is vivid that generic terms are terms or name that are common in relation to a course of trade and therefore any person doing producing products in that class of products is free to use the term/name. Such names are not registrable as trademarks in relation to the course of trade that is common. A manufacturer who produces a video compact disk cannot name it 'electronics' because electronics is a generic name in relation to those gadgets. Therefore, a 'generic name' is "a term that describes something generally without designating the thing's source or creator, such as the word 'car' or 'furniture'. A generic name cannot be protected as a trademark for the thing it denotes; e.g. *Apple* can be a trademark for computers but not for apples."<sup>17</sup> At the risk of repetition, generic names are not registrable *ab initio*.

Conversely, 'genericide' refers to a trademark which has been validly registered as a trademark but due to its constant usage and

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<sup>15</sup> *International Tobacco (Nig.) Ltd. v. British American Tobacco*, above note 8; *United Kingdom Tobacco Co. Ltd. v. Carreras* (1931) 16 NLR 1.

<sup>16</sup> Courts have defined "generic" as "the genus of which the particular product or service is a species." *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979). In other words, a generic term is "the name of the product or service itself - what [the product] is, and as such . . . the very antithesis of a mark." 2 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 12:1[1] (4th ed. 1997).

<sup>17</sup> Black's Law Dictionary, above note 3, p. 754.

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popularity, consumers have come to associate the class of products by that trademark name, by so doing the trademark will lose its distinctiveness or distinguishing nature and become a generic name. When this occurs, the trademark will be struck off the register and everyone is free to use the trademark in relation to that class of goods.

Black's Law Dictionary defines genericide as "the loss or cancellation of a trademark that no longer distinguishes the owner's product from other's products. Genericide occurs when a trademark becomes such a household name that the consuming public begins to think of the mark not as a brand name but as a synonym for the product itself"<sup>18</sup>

A writer described the process of genericide with this scenario. "In one of my frequent daydreams in which I imagine a parallel world where I'm unfeasibly rich and powerful, I've invented a bath overflow warning system called the Liquobeeep. It hangs over the side of the bath and emits a noise when the water reaches the correct level; it's hailed as the most brilliantly simple home gadget of the decade, and is immediately repurposed for sinks, pools, drains, rivers and reservoirs. I experience a warm glow whenever I hear people say "I need to do a Liquobeeep" or "You should have Liquobeeeped it", and enormous pride when Liquobeeep eventually comes to mean any act you perform to ward off potential danger or peril. At which point my trademark slips into the public domain, my business empire crashes, and I snap out of the daydream, covered in sweat, while the beeping of a reversing lorry sounds faintly in the distance."<sup>19</sup>

Things like this do happen. It's called genericide, and successful companies and their lawyers are waging a constant battle against it.

To determine whether a trademark has become generic, the test question put forward by Judge Learned Hand in *Bayer Co. v. United*

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<sup>18</sup> *Ibid.*

<sup>19</sup> Author Unnamed, "Genericide: When Brands get too Big", *The Independent of Friday* 10<sup>th</sup> June, 2011, Available at <http://www.independent.co.uk/news/business/analysis-and-features/genericide-when-brands-get-too-big-2295428.html>. Accessed on 28th October, 2014.

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*Drug Co*<sup>20</sup>. is apt. The question is “what do the buyers understand by the word for whose use the parties are contending?” To provide an answer, if the buyer understands the word to mean the products of that class then it is said that the trademark is generic, but if the buyer understands the word to mean a brand of the class of product or as pointing to a particular proprietor, then the trademark is still distinctive.

The courts today apply more specific standards for determining genericness. For example, in the US, the Federal Circuit and the Trademark Trial and Appeal Board conduct a two-part inquiry: “First, what is the genus of the goods or services at issue? Second, is the term sought to be registered...understood by the relevant public primarily to refer to that genus of goods or services?”<sup>21</sup>

#### **4. Causes of Genericide**

There are so many identifiable causes of genericide – why a trademark may become generic. Some of these causes will be briefly discussed hereunder.

One way genericide may occur is where the owner or the registered user fails to use the trademark correctly on its goods, and in advertising. This may occur where the trademark owner uses the trademark as a noun or verb in describing the product without mentioning the generic name of the class of product. E.g. when advertising you keep emphasizing “buy Indomie” or “google it” such statements may make the trademark of Indomie lose its distinctiveness. To avoid this, statement like “buy Indomie Noodles” is encouraged. This will remind the buyer that Indomie is a brand of Noodles. Another cause of genericide is where the trademark owner fails to prevent infringement and generic use of his trademark by others.

Sometimes trademark owners, especially those who also have a patented product, often encourage the public to use their trademarks

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<sup>20</sup> 272 Fed. 505 (2d Cir. 1921)

<sup>21</sup> *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001), quoting *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 2002 T.T.A.B.

as generic “household words”. However, their success in doing so can backfire when consumers, over time, use these terms to identify the product rather than its source.<sup>22</sup>

Many trademarks have fallen victim of genericide and are today generic names and thus in the public domain. Let’s take a cursory look at some of these trademarks. In *Bayer Co. v. United Drug Co.*<sup>23</sup> the court held that “Aspirin” was generic for acetylsalicylic acid. In *King-Seeley Thermos Co. v. Aladdin Ind. Inc.*<sup>24</sup> the court held that “thermos” was generic for a vacuum-insulated bottle. Other trademarks declared generic are: “yo-yo” held generic for return top;<sup>25</sup> “diet chocolate fudge soda” held to be a generic phrase;<sup>26</sup> “cellophane” was held to be generic term for cellulose – based plastic film;<sup>27</sup> “safari” held to be a generic for a type of clothing;<sup>28</sup> “Escalator” was held generic for a moving stairway;<sup>29</sup> and many more.

### 5. Why Punish A Successful Manufacturer?

In most cases, cancellation of a trademark's federal registration results from private litigation between the trademark owner and a competitor. A declaratory action may be brought by a competitor against the trademark owner, seeking cancellation of the trademark.<sup>30</sup> Genericness may also be used as a defence by a competitor in an infringement action bought by the trademark owner.<sup>31</sup>

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<sup>22</sup> John D. Ingram, “The Genericide of Trademarks” Available at <http://wings.buffalo.edu/law/biplj/biplj223.pdf>

<sup>23</sup> Above note 20.

<sup>24</sup> 321 F. 2d 577 (2d. Cir. 1963).

<sup>25</sup> *Donald Duncan Inc. v. Royal Tops Mfg. Co.*, 343 F. 2d 655 (7<sup>th</sup> Cir. 1965).

<sup>26</sup> *A.J Canfield Co. v. Honickman*, 808 F. 2d 291 (3d Cir. 1986).

<sup>27</sup> *DuPont Cellophane Co. v. Waxed Products Co.* 85 F. 2d 75 (2d Cir. 1936).

<sup>28</sup> *Abercrombie & Fitch co. v. Hunting World Inc.* 537 F. 2d 4, 4 – 15 (2d cir 1976).

<sup>29</sup> *Houghton Elevator Co. v. Seeberger* 85 U.S P.Q. 80 (Comm’r. pat. 1950).

<sup>30</sup> See, e.g., *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9<sup>th</sup> Cir. 1982).

<sup>31</sup> *Linoleum Mfg. Co. v. Nairn*, 7 Ch. D. 834 (1878). See John D. Ingram, “The Genericide of Trademarks” Available at <http://wings.buffalo.edu/law/biplj/biplj223.pdf>



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The court noted in the case of *King-Seeley Thermos Co. v. Aladdin Ind. Inc.*,<sup>32</sup> that this genericide process “can be a harsh one for it places a penalty on the manufacturer who has made skillful use of advertising and has popularized his product”. This dictum reinforces our argument herein. The concept of genericide is a punishment to manufacturer. Every new entrant into the manufacturing industry will always want his products to become popular and become the choice of all consumers/purchasers. To this end, manufacturers engage in all forms of advertisement, on television, radio, newspapers, road shows, promos, etc. where these are successful, the brand becomes so popular that the consuming public now regard the brand name as the name of the product. This is good news to the manufacturer who has achieved huge success; however, the success now in a volte-face becomes a bane on him. Competitors who were lazing around, that didn’t advertise their own products to match the popularity of the trademark owner will now go to court for the trademark to be declared generic so that he can enjoy the popularity of the brand name another man suffered to make popular.

The concept of genericide is antithetical to trade competition. Had it been the concept was not in existence, all those successful competitors that have succeeded in obtaining a declaration from the court making another’s brand name a generic term, would have engaged in massive promotion and advertising so as to popularize their own brand name. No matter what the public think, no matter how they associate a product with a particular brand name, with aggressive advertisement, they will come to know the difference between a brand name and a generic name. thus the onus that a competitor has to prove that trademark name of another has become generic with the preponderance of evidence pointing to the fact that people now refer to the brand name as the product itself will have to be shifted from the court to the advertising field. Thus, instead of going to court seeking a declaration that a trademark has become generic, the competitor should be made to engage in aggressive advertisement to tell people that his own product is also a good brand of that class of product, and he should thus emphasize the generic name of that class of product. Thus, it is our argument that

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<sup>32</sup> 321 F. 2d 577, 581 (2d. Cir 1963).

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the competitor should not get relief from the court by declaring another's trademark generic, but should take upon him the onus of educating the public to differentiate between the earlier brand name they have hitherto known from the generic name of that class of product, so that his own brand name can be recognized as a brand of the same class of product.

In the alternative to the foregoing, we argue that if indeed the concept of genericide would thrive, adequate compensation should be paid to the trademark owner for declaring his trademark generic. Thus, where a trademark has been declared generic, every competitor that wants to use the generic trademark name on his own product should pay some form of compensation or royalty to the former trademark owner. This is predicated on the fact that the trademark has spent his resources in popularizing the product and thus should recoup his expenses. When a manufacturer is popularizing his product, he has in mind to reap the benefits therefrom later, so where such benefits have been taken away from him, he has to be paid compensation therefor.

It is noteworthy to state the fact that this concept of genericide is not expressly stated in Nigeria Trademarks Act. This explains the dearth of cases on this issue in Nigeria. Most of the cases discussed on genericide were determined under the Lanham Act of 1946. Under U.S. law, genericide is a form of abandonment. A mark will be deemed to be "abandoned" if: (1) its use has been discontinued for three years with intent not to resume such use; or (2) when the mark becomes the generic name for the goods or services on or in connection with which it is used. Section 31 of the Nigerian Trademarks Act provides for removal of a trade mark from the register on the ground of non-use.

Notwithstanding the foregoing, a person concerned can still bring an action to declare a registered trademark generic. This is because for a trademark to be generic, it no longer satisfies the requirement of 'distinctiveness' or it is no longer 'capable of distinguishing' the product of the proprietor from the class of products. An attempt was made in the case of *Procter & Gamble Co. v. Global Soap and Detergent*

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*Ind. Ltd. & Anor.*<sup>33</sup> where the Federal High Court Lagos *coram* Mustapha J. declared 'Ariel' a generic name in relation to soap and detergents. This was however quashed on appeal by the Court of Appeal Lagos. The trial judge (with due respect) misdirected himself when he held:

... A trade mark which remains in the register for a period of 38 years without being used in relation to the goods that it was registered has become generic and has fallen into public domain and so can be used by anybody and can be expunged from the register. I hold therefore that the plaintiff is no longer entitled to the exclusive use of the registered trade mark word ARIEL in Nigeria.

The trial judge misplaced non-use, which is a ground for removal of a trademark from the Register under section 31 of TMA, as generic. The Court of Appeal overruled this decision, and in our view rightly so, when it held, per Ogunwumiju J.C.A.:

Now, a lot of energy was expended by both parties on the issue of whether the learned trial Judge's finding that Ariel had become generic and as such it had become part of the public domain was right or not. Suffice it to say that the finding itself is self-contradictory. In one breath, if it expunged for non-use i.e. lack of use due to abandonment it cannot in another breath, have become so popular due to over-use by the proprietor and the general public that it has assumed a generic name applicable to all products of its genre or cadre. A valid trademark can only become generic if the consuming public misuses the mark or name sufficiently for the mark to become the generic name for the product. The consequence of non-use cannot *ipso facto* be that the product has become generic. I find it impossible to agree with the learned trial judge, with the greatest respect to him, on this point.

The case of *Smithkline Beecham PLC v. Farmex Limited*<sup>34</sup> is instructive here. In this case, the Nigerian court considered the issue of a registered mark becoming generic overtime. Put succinctly, the facts were that the appellant was the pharmaceutical assignee of the registered Trademark, "Milk of Magnesia," a medical product in class3. The inscription on the bottle read "Phillips Milk of Magnesia." The respondent also marketed similar products. The inscription on

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<sup>33</sup> Above note 5.

<sup>34</sup> (2010) 1 NWLR (Pt. 1175) p. 285.

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the bottle read “Dr. Meyer Milk of Magnesia.” It was the case of the appellant that the respondent’s product is so similar to their trademark “Milk of Magnesia” to be calculated to deceive and cause confusion in the course of trade in relation to pharmaceutical products and amounts to an infringement of the appellant’s trademark. It was contended on behalf of the respondent that “Milk of Magnesia” is a generic name available for use by all persons who manufactured the product. Bode Rhodes-Vivour, JCA (as he then was) in affirming the judgment of Egbo-Ebo J. of the Lagos Judicial Division of the Federal High Court and thereby dismissing the appeal echoed, *inter alia*:

A generic name is a name shared by many/any manufacturer, a scientific, chemical or common name. It relates to a characteristic of a whole group or class. It is general as opposed to specific. A generic term is one which is commonly used as a name or description of a kind of good and it is general as opposed to specific. A generic term is one which is commonly used as a name or description of a kind of good and it is generally accepted that a generic term is incapable of achieving trade name protection. I am of the firm view that “Milk of Magnesia” is a generic name also known as Magnesium Hydroxide. That explains why the appellant named its product, “Dr. Phillips Milk of Magnesia” and another product “Millex Milk of Magnesia.” All manufacturers of MILK OF MAGNESIA in Nigeria add a brand name to differentiate their product from others in the market. It was concluded that the appellant’s product is “Phillips Milk of Magnesia” and he is the proprietor of the trademark MILK OF MAGNESIA. The respondent’s product, “Dr. Meyer Milk of Magnesia.” doesn’t infringe either Milk of Magnesia or Phillips Milk of Magnesia.

It is pertinent to note that whether or not a trademark has become generic is a question of fact to be determined by the court putting into consideration all surrounding circumstances and the perspective of the public/consumers.

## **6. Conclusion and Recommendations**

In this paper we noted that the main reasons for registering a trademark to include; identifying a particular proprietor’s products and distinguish them from those of others, indicate the source of the

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products and signify its quality level as well as aids in advertising and selling of those products. Once a trademark becomes the common descriptive name of a certain product, the trademark owner will no longer have exclusive right to its use. There are so many names that were once trademarks but are now generic names of products. This is due to some actions or inactions of the trademark proprietors, assignees or the public. Thus, to curb this process of genericide catching up with a trademark, the following recommendations should be adopted.

When a trademark is becoming too popular, the trademark owners must be constantly vigilant to prevent generic use of their trademark by competitors, media, consumers, dictionaries etc. they should also educate the public as to the difference between their trademark name and the generic name of the product. Where a product is new in the market, say the proprietor invented it and had patent for it, while the patent lasts, the proprietor should in addition to the trademark name also get a generic name for that product so that when the patent lapses and the information goes into the public domain, other manufacturers who want to produce more varieties of that product will use the generic name in relation to the product and not the trademark name of the proprietor.

The trademark owner should be proactive in policing improper usage of their mark by promptly any publications or competitor who incorrectly use the mark in a generic sense and requesting that such wrong usage stop forthwith. Washington Post columnist Gene Weingarten unexpectedly found himself involved in one such battle after light-heartedly suggesting to his readers that they might feel more American if they "put on a Stetson". Lawyers for the John B Stetson Company were quick to contact Weingarten and insist that he refrain from using the word "Stetson" as a synonym for "hat", and to always write it as "Stetson®". Weingarten reacted grumpily on his blog ("Stetson® hats suck"), but follow-up correspondence he received from trademark lawyers explained that one of the main strategies to fight the generic usage of such words is to be seen to be

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pro-active; the company has to be able to demonstrate that it cares about its trademark.<sup>35</sup>

Trademark should never be used as a noun or verb; this implies that the word is generic. It should always be used in the adjectival form. The trademark should be capitalized to differentiate it from other words used on the label. Trademark owners should also always attached the registration symbol ® or ™ if unregistered superscript on their products wherever the trademark name appears. This is simply an information to the public that this name herein affixed with this symbol ® is a registered trademark of a particular, hence desist from misusing the mark or name.

“Genericide is the cruelest irony. A firm might come up with a brilliant marketing strategy that successfully pushes a product to the forefront of its sector, but if its trademark becomes so colloquial that it starts to mean the entire product category, it can kill it – and kill profits as other businesses wade in. You might think, well, it's only a name – but it's far more than that. Companies invest huge sums in new product development and building their brands, for example, If Guinness is spending £10m on a single advert, the last thing they want is for people to be using the word Guinness to mean any kind of stout.”<sup>36</sup>

We strongly submit that the concept of genericide should not be used as a punishment to the trademark owner for his efforts at popularizing his product. The concept should either be abolished or in the alternative, if it must remain, the trademark owner must be adequately compensated before any competitor-company could use the trademark as a generic name. There are still many products that have become so popular these days that people are now misusing the trademarks. And these trademarks if not properly checked may lose its distinctiveness and become generic. Trademarks like ‘Google’ for browse, ‘Xerox’ for photocopy, ‘Maggi’ for seasoning, ‘Indomie’ for noodles, ‘Vaseline’ for petroleum jelly, “Formica” for decorative

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<sup>35</sup> Author Unnamed, “Genericide: When Brands get too Big” The Independent of Friday 10<sup>th</sup> June 2011 <http://www.independent.co.uk/news/business/analysis-and-features/genericide-when-brands-get-too-big-2295428.html>.

<sup>36</sup> *Ibid.*

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plastic laminates,<sup>37</sup> 'Kleenex' tissues, and so on are under threat of becoming generic names for their various classes of products.

Your brand name is your most important asset (especially where it has acquired goodwill in the market). It not only defines who you are as company today, it can determine what your company will be tomorrow, too. So it must be protected at all cost.

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<sup>37</sup> *FTC v. Formica Corp.*, Cancellation No. 11955 (T.T.A.B., filed May 31, 1978).