

## Notes on s 10(2)(c) TMA -- customary signs and indications

Section 10(2)(c) TMA provides that a mark is ineligible for registration or its registration is liable to be revoked if it 'consists exclusively of a sign or an indication which has become customary in the current language or in the *bona fide* and established practices of the trade'.

Note the somewhat unusual use of the past tense 'has become customary'. The disqualification is intended to apply to signs and indications (usually words) that were not always the customary way to describe goods and services *but that have become so*. A good example is the word 'aspirin'. ASPIRIN, an invented word, was registered as a trade mark by Bayer AG and applied to the analgesic drug acetylsalicylic acid.



The patent on acetylsalicylic acid expired in 1917 and generic substitutes began to be manufactured in large quantities. But the trade mark ASPIRIN had by this time become the customary word in a number of languages for a headache pill. Moreover, as the *Oxford English Dictionary* entry below shows, the word had even come to be used attributively in English to mean a mild palliative of some kind:

*fig. 1930 Time & Tide* 30 Aug. 1085/1 This aspirin remedy could continue only so long as the price of wheat and wool was high. **1957** M. SWAN *Brit. Guiana* i. i. 21 The living standards would eventually improve without the necessity for this aspirin from the Government.

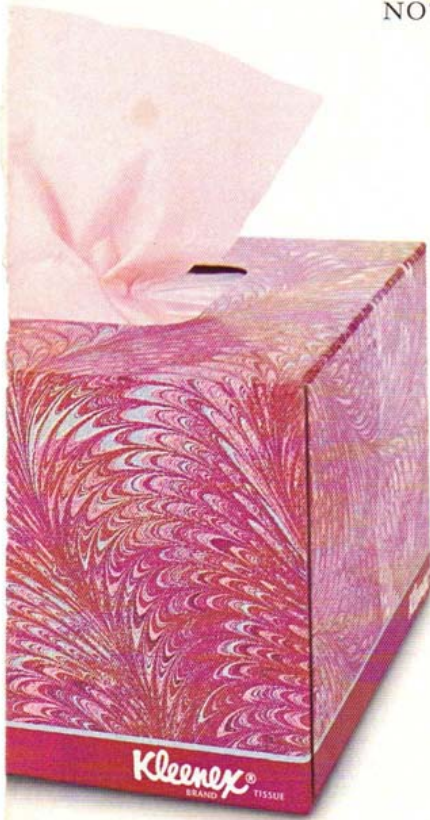
Another example of the process by which a trade mark becomes the generic word for the product to which it is applied is 'escalator' – originally ESCALATOR<sup>®</sup> the registered trademark of the Otis Elevator Corporation – now the generic word for a moving staircase. Here are some other trade marks that have lost their distinctiveness and become part of ordinary language:

- brassiere
- cellophane
- celluloid
- cola
- corn flakes
- dry ice
- gramophone
- granola
- heroin
- jungle gym
- kerosene
- linoleum
- mimeograph
- raisin bran
- saran wrap
- shredded wheat
- tabloid
- thermos
- touch-tone
- trampoline
- TV dinner
- windbreaker
- yo-yo
- zipper

The implication of s 10(2)(c) is that if a trade mark is so successful that it becomes the customary way to describe the goods or services to which it relates, it can no longer function as a trade mark since it no longer distinguishes the goods of the proprietor from the similar goods of its competitors. The term of art for this process is 'genericide' – denoting that a trade mark commits suicide by becoming the generic term for the goods to which it is applied.

How is trade mark genericide avoided? Trade mark proprietors whose trade marks are in danger of becoming customary have to take certain self-help measures to ensure that this does not occur. These measures include, in the proprietor's own use of the mark, always using the <sup>®</sup> symbol, spelling the word in capitals or with a capital first letter, never using the mark as a verb or noun and only as an adjective. Proprietors also try to educate the public to do the same, though this is not an easy task:

NOT ALL TISSUES  
ARE KLEENEX® TISSUES.  
(AND THAT'S  
NOTHING TO SNEEZE AT.)



If it hasn't got the Kleenex® brand on the box, then it's not a Kleenex® tissue. While we're on the subject, just remember that Kleenex® is a brand, so it's an adjective, not a noun. And it's always spelled with a capital "K" followed by the registered trademark symbol and the word "tissue." So, if you can follow these guidelines, we have only one thing to say – bless you.

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Another example is this advertisement intended for retailers and distributors of XEROX® copiers

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**XEROX**

If you use "Xerox" the way you use "zipper," our trademark could be left wide open. **There's a new way to look at it.**

No one likes to have their name open to misuse. Which is what happens when you use our name in a generic manner. Basically you're putting it in a compromising position which could cause it to lose its trademark status. That's what happened to the name "zipper" years ago. So when you use our name, please use it as an adjective to identify our products and services, such as "Xerox copiers." Never as a verb: "to Xerox" in place of "to copy," or as a noun: "Xeroxes" in place of "copies." Now that you're aware of all this, that should just about zip things up. Thanks.

**XEROX**

[xerox.com/learn](http://xerox.com/learn) 1-800-ASK-XEROX **WAL LEARN** Technology | Document Management | Consulting Services

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In the end, not much can be done to prevent genericide as it is caused by the process by which a word becomes the customary term for something in everyday language – this is a social process and not something that can be directed or prevented by proprietors. A likely candidate for genericide is therefore GOOGLE®, the registered trade mark of Google Technology Inc and applied to its search engine and related services. However, the word is increasingly being used in ordinary language as a verb meaning 'look something up on the internet' as the following example shows:

**go places. google things.**

Not just a cell phone. A Treo.

[onTreo.com](http://onTreo.com)

Requires data service from a mobile service provider at an additional cost. Not all areas receive coverage at all times. Coverage not available in all areas. © 2008 Palm, Inc. Palm and Treo are trademarks or registered trademarks owned by Palm, Inc. Google and Gmail are trademarks of Google, Inc.

**do you like this?**

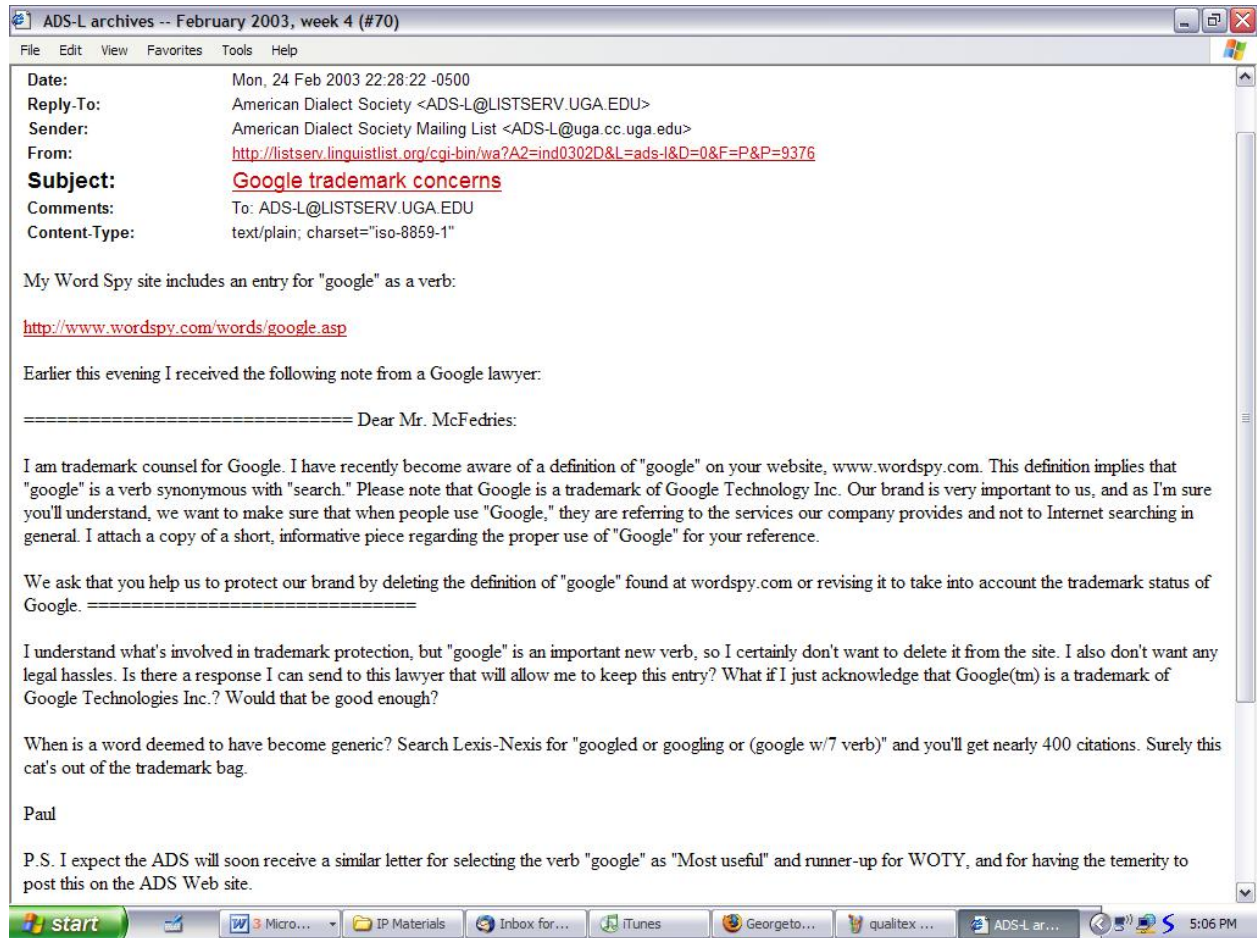
Not just a cell phone. A Treo.

[onTreo.com](http://onTreo.com)

Requires data service from a mobile service provider at an additional cost. Not all areas receive coverage at all times. Coverage not available in all areas. © 2008 Palm, Inc. Palm and Treo are trademarks or registered trademarks owned by Palm, Inc. Yahoo! and Yahoo! Search are trademarks of Yahoo! Inc.

See also this amusing column published in the Mail & Guardian:  
<http://www.mg.co.za/article/2009-02-21-google-me-baby>

Google Inc does its best to hold back this tide, but it may already be too late:



Other resources:

Wikipedia entry on 'Genericized trademark' has some further examples:  
[http://en.wikipedia.org/wiki/Genericized\\_trademark](http://en.wikipedia.org/wiki/Genericized_trademark)

An example with resonance closer to home is the fate of the opportunistic registration of 'Rooibos' as a trade mark in the United States -- <http://www.rooibosdirect.com/press0605.pdf>

For more on Google's impending genericide (and its logical inevitability) just google 'Google genericide' -- [http://www.google.com/search?sourceid=navclient&ie=UTF-8&rlz=1T4GGLD\\_en\\_ZA211&q=google+genericide](http://www.google.com/search?sourceid=navclient&ie=UTF-8&rlz=1T4GGLD_en_ZA211&q=google+genericide)