

## PRACTITIONER'S CHECKLIST

### AVOIDING GENERICIDE

Ayşen Kunt, Kodiak Law & IP (Istanbul, Türkiye)

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All trademark owners hope that their flagship trademarks become well-known. However, such success may put their rights at risk when the trademark becomes the generic name to designate the product type. Most jurisdictions have laws that a trademark may be declared invalid when a trademark is no longer useful as an indicator of origin as it has become the generic name used by consumers to refer to the type of product regardless of its commercial origin.

To avoid such severe consequences, certain measures can be taken to ensure that the public is aware that the sign is a registered trademark and not a generic name for a product type.

- I. **Develop an internal best practices document with guidance on avoiding genericide while a new brand is still in development, especially if the trademark is a new word in the market sector that may be prone to becoming generic.**
  - A. Before launching a coined trademark, prepare a generic term that is a noun to use with the coined mark.
    1. If an existing generic term is complicated or difficult for people to understand, find or create a simpler one.
    2. If the product is new and there is no existing generic term, create one.
  - B. Use the brand as an adjective with the generic term.
    1. Examples: ROLLERBLADE in-line skates, PING PONG table tennis, KLEENEX tissue.
  - C. In a pinch, you can use the word “brand” as the generic term:  
[TRADEMARK] brand.

1. Example: ROLLERBLADE brand, PING PONG brand, KLEENEX brand.

**II. Prepare a standard, written explanation for correct usage of your mark that can easily be distributed to third parties, such as licensees or general consumers, when incorrect usage is found.**

- A. Keep the tone upbeat and positive but be firm and clear about what the correct usage is.
- B. Consider adding similar language in any trademark/branding usage guidelines that are incorporated into agreements with third parties.
- C. Monitor compliance with the guidelines regularly to prevent a spread of improper use.

**III. Monitor how your mark is used in the media, including television, social media, and dictionaries, and correct any misuses.**

- A. If appropriate, use the ® registration symbol (or a TM or SM symbol for unregistered trademarks).
- B. Distinguish the trademark from surrounding text by capitalizing the entire name, using a distinctive typeface, or, at the very least, capitalizing the first letter.
- C. Always use your own mark correctly, even internally. Disgruntled ex-employees might leak embarrassing documents that could be costly during litigation.

**IV. Clever advertising can educate the public about proper usage. However, use good judgment when approving quirky advertising and promotional materials; such uses may inadvertently dilute your own mark by confusing the public about correct usage.**

- A. The classic example is XEROX. The Xerox Corporation conducted a widespread ad campaign to urge consumers to use the verb “photocopy” rather than the now-popularized shorthand “xerox.” They were successful and prevented genericide of their trademark.
- B. Velcro BVBA created and posted a video to educate consumers on the correct use of the VELCRO trademark and the generic names of the tape or fastener (“hook-and-loop”).

**V. Educate individuals within your organization and/or supply chain, such as distributors and dealers.**

- A. Misuse often occurs due to lack of education, not wrongful intent.
  - B. Consider creating a public relations campaign (television, radio, social media, etc.) to demonstrate correct and incorrect uses.
- VI. **Keep detailed marketing records so that you can prove “acquired distinctiveness” if necessary.**
  - A. Consider retaining records showing your advertising costs, revenue figures, and unsolicited press mentions.
- VII. **Consider creating a new product category if your trademark is at risk of being considered a generic term for a particular type of product and tout the fact that the mark is a brand for a line of products.**
- VIII. **Adopt a proper license policy.**
  - A. Ensure that all license agreements include the requirement that licensees adhere strictly to the brand guidelines.
  - B. The licensing requirements need to be reasonable, because if they are too strict or not feasible for licensees to carry out from a business perspective, this can encourage or result in use of the mark as a generic term.
- IX. **Consider the geographical connection between markets.**
  - A. For example, in the European Union, if a mark becomes generic in one of the EU jurisdictions, it could be cancelled for the whole EU.
- X. **Pay special attention to the use of the mark in jurisdictions with different alphabets.**
  - A. Adopt rules for the use of the mark in its original alphabet and in transliteration.
  - B. Put special efforts into locating generic use of the mark in the local language as early as possible, as it can be extremely detrimental.
- XI. **Attach the mark to the goods, if possible.**
  - A. Attaching the mark to the goods (especially if accompanied by the ® sign) would help ensure that the mark is perceived as a mark, and not as a descriptor.

**XII. Genericide can be a consequence of the activity or inactivity of the trademark holder.**

- A. In some jurisdictions the loss of distinctive character of a trademark may support the revocation thereof only when it is a consequence of the proprietor's action or inactivity.
  - 1. Actions that could contribute to the loss of distinctive character include usage of the mark in a generic way by its owner.
  - 2. Inactivity that could lead to the loss of distinctive character includes not informing customers that the sign is a registered trademark or not taking action against generic use or infringement of the mark.
  - 3. In line with EU caselaw, the measures to be considered include conducting advertising campaigns, placing warnings on product labels, formally requesting dictionary editors to indicate within the relevant entries that the term is a registered trademark or sending cease and desist letters to third parties that may be using the mark in a generic manner.
- B. Becoming a common name, i.e., a generic term, is always judged from the point of view of the relevant public. Therefore, the correct definition of the relevant public is extremely important. This would allow directing your efforts to the correct target.