

Cite as: 5 Tech. L. Rev., Apr. 2008, at 183.

The Theories and Practices of Trademark Genericism

Cheng-Chiou Teng

Abstract

A basic function of trademarks is to identify the source of a product. In order to carry out this function, it is necessary to design a trademark with distinctiveness. A trademark without distinctiveness can not be registered with the Patent and Trademark Office or serve as a basis for claiming trademark rights because it lacks the function of source identification.

Trademark genericism, also known as genericide, genericness and generalization, is the rule which governs the loss of trademark protection of a registered trademark that was once distinctive and often well known, but fell into the public domain and became a generic name owing to the change in the perception of the consuming public.

Genericism in U.S. court practices is not a new concept but is just beginning to appear in Taiwanese Trademark Law when the latest amendment went in effect on 28/11/2003. Considering the fact that this topic is rarely addressed among Taiwan academics or practitioners, this article examines the American legal system and courts practices and attempts to interpret the current Taiwan Trademark Law in order to find the meaning of genericism, causes of genericism, criteria for judging

genericism and the legal effect of post-genericism. In addition, this paper strives to provide solutions to new problems caused by trademark genericism.

Keywords: genericism, distinctiveness, the minds of the consuming public, primary significance test, cancellation of the trademark