

GOOGLE®: Not your Generic Search Engine

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GOOGLE®: Not your Generic Search Engine

“Google it.” Everyone says it. But what is meant by the phrase? When asking someone where to find facts or information online, you will likely be told to “google it.” The term “Google” has entered the vocabulary as a verb, not just a brand name.¹ The internet search engine has become shorthand for conducting an online search for information.² At the same time, the trademark, GOOGLE®, is one of the most valuable and recognizable brands in the world and is strongly associated with the goods and services offered under the mark.³ Can a famous brand remain protectable as a trademark if it is often used as a verb for the very service provided under the trademark? That was the question asked by Chris Gillespie and David Elliott, individuals who sought to register over 750 domain names that included the term, “Google.”⁴

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1. See, e.g., *Google*, MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/google> (defining the transitive verb as follows: “to use the Google search engine to obtain information about (someone or something) on the World Wide Web.”) (last visited Feb. 13, 2018).

2. *Id.*

3. *Google v. Gillespie*, Nat’l Arb. F., Claim No. FA1203001434643 (May 10, 2012), <http://www.adrforum.com/domaindecisions/1434643.htm>; see also BRAND FINANCE, GLOBAL 500 2017: THE ANNUAL REPORT ON THE WORLD’S MOST VALUABLE BRANDS (2017) (listing Google as the most valuable brand of 2017), http://brandfinance.com/images/upload/global_500_2017_locked_website.pdf (last visited Feb. 13, 2018).

4. *Google v. Gillespie*, Nat’l Arb. F., Claim No. FA1203001434643 (May 10, 2012), <http://www.adrforum.com/domaindecisions/1434643.htm>.

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I. DISTINCTIVE TRADEMARKS AND GENERICIDE

In order for a trademark to be protectable, and thus enforceable as a trademark against infringers, the mark must be distinctive.⁵ A trademark is distinctive if it serves as a source identifier for a good or service.⁶ In trademark law, there is a spectrum of terms from least distinctive to most distinctive, categorized as (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.⁷ At one end of the spectrum, generic terms are common names which identify the type of good or service.⁸ Generic terms are not capable of serving as source identifiers and are not registerable or enforceable as trademarks. Arbitrary and fanciful marks are strong trademarks and are inherently distinctive.⁹ They are automatically entitled to protection and serve to identify the source of a product or service.¹⁰ An example of an arbitrary mark is APPLE[®] for computers. The term APPLE[®] is not being used with fruit or a fruit-based business, but is instead, being used with unrelated goods.¹¹ Fanciful trademarks are made-up terms such as EXXON[®] and KODAK[®].¹² The trademarks at issue, GOOGLE[®] for computer hardware, computer software, and computer services,¹³ are fanciful marks and are afforded strong protections.¹⁴

Even though strong distinctive marks are afforded the greatest protection in trademark law, they are also susceptible to falling victim to genericide.¹⁵ Genericide occurs when the public appropriates a trademark and uses it as a generic name for a particular type of good or service irrespective of its source.¹⁶ Examples include

5. Lanham Act, 15 U.S.C. § 1052 (2012).

6. *Id.* at § 1127.

7. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *see generally* 15 U.S.C. §§ 1052, 1127.

8. *Hunting World*, 537 F.2d at 9.

9. *Two Pesos, Inc.*, 505 U.S. at 768 (citing *Hunting World*, 537 F.2d at 9).

10. *Id.*

11. MARK A. GLICK ET AL., *INTELLECTUAL PROPERTY DAMAGES: GUIDELINES AND ANALYSIS* 257 (2002).

12. Expert Report of Robert T. Scherer at 32, *J.T. Colby & Co., Inc. v. Apple Inc.*, No. 1:11-cv-04060-DLC (S.D.N.Y. Sep. 17, 2012).

13. GOOGLE, Registration No. 2,884,502 (discussing “computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources”); GOOGLE, Registration No. 2,806,075 (discussing “computer services, namely, providing software interfaces available over a network in order to create a personalized on-line information service; extraction and retrieval of information and data mining by means of global computer networks; creating indexes of information, indexes of web sites and indexes of other information sources in connection with global computer networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, by means of global computer information networks”).

14. Expert Report of Robert T. Scherer at 36, *J.T. Colby & Co., Inc. v. Apple Inc.*, No. 1:11-cv-04060-DLC (S.D.N.Y. Sep. 17, 2012) (“Fanciful marks consist of those marks which are made up or invented words, such as EXXON, KODAK and GOOGLE . . .”).

15. *Elliott v. Google*, 860 F.3d 1151, 1155–56 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

16. *Id.* at 1156.

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ASPIRIN, CELLOPHANE, and ESCALATOR, three terms that were once protectable as arbitrary or fanciful trademarks, but now are primarily understood by the public to be generic names for those same goods.¹⁷ A registered U.S. trademark is subject to cancellation if it becomes the generic name for the goods or services, or a portion thereof, for which it is registered.¹⁸

When Google, Inc. (“Google”) challenged the registration of Gillespie and Elliott’s domain names containing GOOGLE[®], Gillespie and Elliott countered that GOOGLE[®] no longer served as a source identifier and had fallen victim to genericide.¹⁹ Relying on evidence that “google” is overwhelmingly being used as verb for internet searching, Elliott and Gillespie fought for the cancellation of the GOOGLE[®] trademarks before the National Arbitration Forum and in the federal courts.²⁰ Their battle ended at the U.S. Supreme Court when their Petition for Writ of Certiorari was denied and the U.S. Court of Appeals for the Ninth Circuit decision that GOOGLE[®] is not generic was upheld.²¹

II. GOOGLE SUCCESSFULLY CHALLENGED THE REGISTRATION OF DOMAIN NAMES CONTAINING “GOOGLE”

Google discovered that Chris Gillespie registered 763 domain names between February and March 2012 that contained the GOOGLE[®] trademark followed by another famous brand or the name of a well-known individual.²² Examples of the domain names registered include googledisney.com, googlebarackobama.net, and googlemexicocity.com.²³ The company immediately filed a Uniform Domain Name Dispute Resolution Policy complaint requesting a decision by a three-member panel appointed by the National Arbitration Forum that the domain names be transferred to Google.²⁴

Google argued (i) that it rightfully owned the GOOGLE[®] trademarks, (ii) that the domain names registered by Gillespie contained the GOOGLE[®] trademark in its entirety, (iii) Gillespie was seeking to sell the domain names or otherwise gain revenue through pay-per-click advertising and third party advertising links, and (iv) Gillespie filed for a large number of domain name registrations in a short amount of

17. *Id.*

18. *Elliot v. Google*, 45 F. Supp. 3d 1156, 1161 (D. Ariz. 2014) (quoting 15 U.S.C. § 1064(3) (2012)).

19. *Elliot*, 45 F. Supp. 3d at 1161.

20. *Id.*

21. *Elliot v. Google*, 860 F.3d 1151, 1163 (9th Cir. 2017), *cert. denied*, 138 S.Ct. 362 (2017) (mem.).

22. *Google v. Gillespie*, Nat’l Arb. F., Claim No. FA1203001434643 (May 10, 2012), <http://www.adrforum.com/domaindecisions/1434643.htm>.

23. *Elliot v. Google*, 45 F. Supp. 3d 1156, 1159 (D. Ariz. 2014).

24. *Google v. Gillespie*, Nat’l Arb. F., Claim No. FA1203001434643 (May 10, 2012), <http://www.adrforum.com/domaindecisions/1434643.htm>.

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time.²⁵ This evidence supported a finding that Gillespie acted in bad faith registering and using the domain names, Google concluded.²⁶ Therefore, Google argued, the domain names should be transferred to it.²⁷

In response, Gillespie explained that he legitimately obtained the domain names with the intent of developing a business model of affinity-based social networks providing content, products, and services distinct from Google.²⁸ He also stated that he did not register the domain names in the hope of attracting internet users who are seeking to avail themselves of Google's search engine services and that users will discover his websites when they use the term, "google" as a generic verb to search for a topic, brand, or person.²⁹

The UDRP panel ruled in favor of Google and ordered the domain names be transferred to Google because they are confusingly similar to the GOOGLE® mark, Gillespie had no right or legitimate interests in the domain names, and the domain names were registered and used in bad faith.³⁰

A. District Court Held GOOGLE® Not Generic

In response to the loss before the UDRP panel, Gillespie, along with Chris Elliott, filed a complaint seeking cancellation of the GOOGLE® trademarks and a declaration that the marks are generic with the U.S. District Court for the District of Arizona.³¹ After discovery, the parties filed cross-motions for summary judgment on the issue of whether the GOOGLE® trademarks at issue are generic.³²

Senior District Judge, Stephen M. McNamee, wrote the opinion holding that GOOGLE® is not a generic term and therefore, the GOOGLE® trademarks at issue are not subject to cancellation.³³ The Court stated that the test for determining whether a registered trademark has become the generic name of goods or services on or in connection with which it has been used, is the "primary significance test."³⁴ "A mark is not generic when the primary significance of the term in the minds of the

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

29. *Id.*

30. Google v. Gillespie, Nat'l Arb. F., Claim No. FA1203001434643 (May 10, 2012), <http://www.adrforum.com/domaindecisions/1434643.htm>.

31. Elliot v. Google Inc., 45 F. Supp. 3d 1156, 1160 (D. Ariz. 2014). The Defendants filed counterclaims for trademark dilution, cybersquatting, and unjust enrichment under the Lanham Act, and unfair competition and false advertising under California state law. *Id.*

32. *Elliot*, 45 F. Supp. 3d at 1160.

33. *Id.* at 1175.

34. *Id.* at 1161.

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consuming public is not the product but the producer.”³⁵ In contrast, “if the primary significance of the trademark is to describe the type of product rather than the producer, the trademark is a generic term and cannot be a valid trademark.”³⁶ The Court, therefore, determined that “the relevant issue is whether the primary significance of the GOOGLE[®] marks to a majority of the public who performs searches on the internet understands that the mark refers to the Google search engine as opposed to a descriptive term for search engines in general.”³⁷

Before the Court evaluated the evidence to determine the primary significance of GOOGLE[®], the Court discussed Plaintiffs’ main argument, that “a trademark ceases to function when it is used primarily as a verb.”³⁸ The Court stated that this premise is flawed, and that a term functions as a trademark if it distinguishes a product or service from those of others and indicate the product’s or service’s source.³⁹ Verb usage of a trademark can still identify a producer or denote source, the Court noted.⁴⁰ The Court discussed discriminate verb use and indiscriminate verb use and distinguished the two through an example.⁴¹ Discriminate verb use of, “I will PHOTOSHOP the image” means the act of manipulating an image by using the trademarked PHOTOSHOP[®] graphics software sold by Adobe Systems.⁴² Indiscriminate verb use of, “I will PHOTOSHOP the image” could also mean image manipulation by using graphics editing software in general, referring to the category of activity.⁴³ The Court clarified that indiscriminate verb usage of a mark does not perform exclusively as a trademark; rather it describes both the species of activity (Adobe’s PHOTOSHOP[®] brand software) and the genus of the activity (using image manipulation software in general.)⁴⁴

The Court went on to say that a mark is not rendered generic merely because the mark serves this “dual function” of identifying the species of service at the same time indicating the genus of services in which the species belongs.⁴⁵ Nor, the Court said, is a mark generic “merely because it has some significance to the public as an indication of the genus of the activity.”⁴⁶ In order for a mark to become generic, the

35. *Id.*

36. *Id.*

37. *Id.* at 1164.

38. *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1161 (D. Ariz. 2014).

39. *Id.* at 1161–62.

40. *Id.* at 1162.

41. *Id.*

42. *Id.*

43. *Id.*

44. *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1162 (D. Ariz. 2014).

45. *Id.*

46. *Id.*

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Court stated, “the *principal significance* of the word must be of the nature or class of an article, rather than an indication of its origin.”⁴⁷

In determining the primary significance of the GOOGLE® marks to the consuming public, the Court first recognized the strong presumption of validity afforded to the GOOGLE® trademarks, since they are registered with the U.S. Trademark Office.⁴⁸ This presumption includes the specific presumption that the marks are not generic.⁴⁹

Next, the Court turned to the evidence provided including dictionary usage, mark-holder usage, competitor usage, media usage, expert opinions, and consumer surveys.⁵⁰ Regarding the dictionary definitions of “google,” all of the definitions submitted to the Court included use of “google” as a verb *and* the trademark significance of the term.⁵¹ This evidence, the Court held, established that “google” carries meaning as an indiscriminate verb.⁵²

Evidence that Google’s co-founder, Larry Page once stated, “have fun and keep googling” was offered by Plaintiffs to support that Google uses the term as a verb, and they made several arguments that Google does not enforce its trademark rights in the GOOGLE® mark.⁵³ The Court disregarded these arguments as unreasonable.⁵⁴ The Court further looked at how competitors describe their products or services.⁵⁵ If short, simple descriptive terms exist for the genus of the trademarked species, this supports that the mark at issue is not generic.⁵⁶ The term “internet search engine” was determined to be short and simple supporting Google’s position.⁵⁷ There was no evidence that Google’s competitors use the GOOGLE® mark in a non-trademark way.⁵⁸ Evidence, did, however, support that the media sometimes uses GOOGLE® as a verb to mean searching the internet.⁵⁹

The Court then turned to the offered survey evidence which established that 51% of people understand that “google” is used as a verb as the indiscriminate act of

47. *Id.* (emphasis added).

48. *Id.* at 1170.

49. *Id.*

50. *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1170 (D. Ariz. 2014).

51. *Id.* at 1171.

52. *Id.*

53. *Id.*

54. *Id.*

55. *Id.* at 1172.

56. *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1172 (D. Ariz. 2014).

57. *Id.*

58. *Id.*

59. *Id.* at 1173.

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searching on the internet and over 90% of the consuming public understand GOOGLE' to be a particular brand.⁶⁰

The Court opined that for the cancellation claim to survive summary judgment, Plaintiffs needed to submit probative evidence that the primary significance of the term, "google" to the majority of the consuming public was a common descriptive term for search engines.⁶¹ But, Plaintiffs failed to do so, instead, presenting evidence about whether the majority of the consuming public understood the term, "google" to be a verb, killing their claim for genericide.⁶² Rather, the Court held that the evidence supported that the consuming public "overwhelmingly understands the word, 'google' to identify a particular search engine, not to describe search engines in general."⁶³ The Court, therefore, determined that Google was entitled to judgment as a matter of law, and that the GOOGLE' trademarks were not generic.⁶⁴

B. Ninth Circuit Upheld District Court Decision

Dissatisfied with the District Court's decision, Elliott and Gillespie appealed the ruling to the United States Court of Appeals for the Ninth Circuit.⁶⁵ Plaintiffs raised two arguments on appeal: (1) that the district court misapplied the primary significance test and failed to recognize the importance of verb use, and (2) that the district court impermissibly weighed the evidence when it granted summary judgment for Google.⁶⁶ Judge Richard Tallman wrote for the majority affirming summary judgment for Google.⁶⁷

The opinion began with the Court reiterating the "primary significance test" or, as the Ninth Circuit calls it, "the who-are-you/what-are-you" test.⁶⁸

If the relevant public primarily understands a mark as describing the "who" a particular good or service is, or where it comes from, then the mark is still valid. But if the relevant public primarily understands a mark as describing the "what" the particular good or service is, then the mark has become generic.⁶⁹

60. *Id.* at 1173–74.

61. *Id.* at 1174.

62. *Elliott v. Google Inc.*, 45 F. Supp. 3d 1156, 1174 (D. Ariz. 2014).

63. *Id.* at 1175.

64. *Id.* at 1175.

65. *Elliott v. Google*, 860 F.3d 1151 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

66. *Id.* at 1155.

67. *Id.*

68. *Id.* at 1156.

69. *Id.* at 1156.

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Preliminarily, Plaintiffs argued that the question presented by the district court should have been whether the relevant public primarily uses the word, “google” as a verb.⁷⁰ The Court concluded that this inquiry was flawed because the claim of genericide must always relate to a particular type of good or service and second, the question assumes that verb use automatically constitutes generic use, which it does not.⁷¹ Plaintiffs claim that “google” has become generic for the “act” of searching the internet and posits that the district court erred when it looked at internet search engines.⁷² After looking at the language of the Lanham Act and the protectability of arbitrary marks, the Court concluded that a claim of genericide must relate to a particular type of good or service, not an act.⁷³

Next, the Court considered Plaintiffs’ claim that a word can only be used in a trademark sense when it is used as an adjective.⁷⁴ Looking to *Coca-Cola Company v. Overland, Incorporated*,⁷⁵ the Court emphasized that they already rejected the theory that only adjective use constitutes trademark use.⁷⁶ In *Coca-Cola Company*, the Court noted that the mere fact that customers ordered “a coke,” using the mark as a noun, failed to show what consumers were thinking, or whether they had a specific source in mind.⁷⁷ Using the terms coined by the district court, the Court acknowledged that a customer might use the noun “coke” in an “indiscriminate sense,” with no particular soda in mind; or in a “discriminate sense,” with COCA-COLA® the brand in mind.⁷⁸ As such, the Court recognized that in the same way, an internet user might use the verb, “google” in an indiscriminate sense with no particular search engine in mind; or in a discriminate sense with GOOGLE® the brand in mind.⁷⁹ The Court concluded by stating that because a claim of genericide must relate to particular good or service and because verb use does not necessarily constitute generic use, the district court properly framed its inquiry “as whether the primary significance of the word, ‘google’ to the relevant public is as a generic name for internet search engines or as a mark identifying the Google search engine” specifically.⁸⁰

The Court then turned to the Plaintiffs’ argument that the district court impermissibly weighed the evidence considering the “sheer quantity” of evidence

70. *Id.* at 1155.

71. *Elliott v. Google*, 860 F.3d 1151, 1156 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

72. *Id.* at 1157.

73. *Id.*

74. *Id.*

75. 692 F.2d 1250 (9th Cir. 1982).

76. *Elliott v. Google*, 860 F.3d 1151, 1158 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

77. *Id.*

78. *Id.*

79. *Id.*

80. *Id.* at 1159.

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produced to support their claim for genericide.⁸¹ The Court looked at the evidence provided and determined that it failed to support the primary significance test because it did not relate to a particular type of good or service, as required.⁸² Plaintiffs needed to submit evidence that supported a jury finding that the primary significance of the word, “google” to the relevant public is a name for internet search engines generally and not as a mark identifying the GOOGLE[®] search engine in particular.⁸³ Instead, their evidence only supported the inference that the majority of the public uses the verb “google” in a generic sense.⁸⁴ Alone, this evidence is insufficient to support a finding of genericide.⁸⁵ The Court reviewed the survey evidence, use of “google” as a verb by rap artist T-Pain and other consumers and media, the dictionary definitions discussed above, use by Larry Page, the founder of Google, as discussed above, and use of alternative words for GOOGLE[®] as previously mentioned.⁸⁶ The Court concluded that this evidence was mostly irrelevant and agreed with the district court that at best, Plaintiffs presented admissible evidence to support the inference that a majority of the relevant public uses the verb ‘google in a generic sense.⁸⁷ But, since that fact alone does not support a claim for genericide, summary judgment was properly granted for Google.⁸⁸

C. Writ of Certiorari Denied; Ninth Circuit Decision that GOOGLE[®] Not Generic Stands

In the face of defeat, Gillespie and Elliott continued the fight. On August 14, 2017, they petitioned the Supreme Court for a Writ of Certiorari.⁸⁹ The Petition focused on three questions. First, does verb use of a trademark, such as “google,” constitute generic use as a matter of law?⁹⁰ Second, is the test for primary significance one of majority usage or majority understanding, as the Ninth Circuit found?⁹¹ And, third, is the district court allowed or required to weigh evidence on a motion for summary

81. *Id.*

82. *Elliott v. Google*, 860 F.3d 1151, 1159 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

83. *Id.*

84. *Id.*

85. *Id.* at 1159–60.

86. *Id.* at 1161–62.

87. *Id.* at 1162.

88. *Elliott v. Google*, 860 F.3d 1151, 1162–64 (9th Cir. 2017) (Watford, J., concurring) (agreeing with the holding of the majority but declining to foreclose the possibility that evidence of indiscriminate verb use could be relevant in deciding whether a trademark has become generic).

89. Petition for Writ of Certiorari, *Elliott v. Google*, 138 S.Ct. 362 (2017) (No. 17-258).

90. *Id.* at 8.

91. *Id.* at 12.

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judgment and did it err when it weighed and discounted all of the evidence of genericness presented?⁹²

Starting with a policy argument, Petitioners argued that the Court should opine on verb usage of trademarks because, without discussion, “it leaves trademark owners, competitors, and the public in the dark as to the ramifications.”⁹³ Petitioners went on to argue that the district court’s use and the Ninth Circuit’s adoption of verb usage as “discriminate” or “indiscriminate” was illogical and contradicted trademark law.⁹⁴ Petitioners quoted the International Trademark Association (“INTA”) advising that “trademarks are proper adjectives used to identify the source of the goods or services noun that they describe” and that “trademarks should not be used as verbs.”⁹⁵ Plaintiffs went onto say that the Ninth Circuit holding “open[s] the door for the registration of verbs as trademarks.”⁹⁶ But, even more problematic, they stated, is the Ninth Circuit’s holding that “verb usage, even indiscriminate verb usage, of a trademark is completely irrelevant to whether a trademark is generic.”⁹⁷ Petitioners feared that this holding is dangerous and told the Court so.⁹⁸ Trademark owners, they stated, follow advice of experts and INTA, and expend large sums of money to police verb usage of their marks.⁹⁹ If verb usage is completely irrelevant to genericness, they claimed, then trademark owners can stop policing verb usage of their marks.¹⁰⁰ Trademark owners, therefore, are left with uncertainty and the Court should resolve this, Petitioners urged.¹⁰¹

Next, Petitioners argued that the Ninth Circuit set forth a new test under the “primary significance test.”¹⁰² Petitioners cited *McCarthy on Trademarks and Unfair Competition* interpreting the primary significance test as the rule of “majority usage.”¹⁰³ The district court assumed that a majority of the public uses the verb, “google” in a generic and indiscriminate sense.¹⁰⁴ It went on to conclude that this fact

92. *Id.* at 14.

93. *Id.* at 8.

94. *Id.* at 8–9.

95. Petition for Writ of Certiorari at 9, *Elliott v. Google*, 138 S.Ct. 362 (2017) (No. 17-258) (quoting *Proper Trademark Use Presentation*, INT’L TRADEMARK ASS’N 17 (2015), <http://www.inta.org/TrademarkBasics/Documents/INTAProperUsePresentation.pptx>).

96. *Id.* at 10.

97. *Id.* at 10.

98. *Id.* at 11.

99. *Id.* at 11.

100. *Id.* at 11.

101. Petition for Writ of Certiorari at 11, *Elliott v. Google*, 138 S.Ct. 362 (2017) (No. 17-258).

102. *Id.* at 12 (“Until the Ninth Circuit’s decision in this case, the primary significance test from § 1064(3) had been interpreted as the rule of ‘majority usage.’” (citing 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:6 (4th ed. 1996))).

103. *Id.* at 12.

104. *Id.* at 13.

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on its own cannot support a jury finding of genericide under the primary significance test.¹⁰⁵ The Ninth Circuit agreed and in doing so, Petitioners suggested, rejected the majority usage test in favor of a new test: “how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines.”¹⁰⁶ Given the difficulty in understanding what is in the minds of the public, this test makes it hard to prove genericness and expands the monopoly awarded to trademark owners, Petitioners argued.¹⁰⁷

Lastly, Petitioners asked the Court to clarify whether weighing evidence is necessary on a motion for summary judgment and specifically, whether the district court erred when it weighed and discounted the evidence of genericness presented by Petitioners.¹⁰⁸

Google elected not to respond to the Petition and on September 14, 2017, filed a Waiver of Right to Respond.¹⁰⁹ On October 16, 2017, the U.S. Supreme Court denied the Petition.¹¹⁰ By refusing to hear the appeal, the decision of the Ninth Circuit Court of Appeals is the final say and the challenged GOOGLE[®] trademarks remain enforceable.¹¹¹

III. THE FUTURE OF TRADEMARK PROTECTION FOR GOOGLE[®] AND OTHER WELL-KNOWN BRANDS

With the Supreme Court denying the Petition for a Writ of Certiorari, the decision by the Ninth Circuit stands.¹¹² So long as the primary significance in minds of the consuming public is that GOOGLE[®] is a brand, GOOGLE[®] is not generic, no matter how many times we instruct others to “google it.” But, the determination of whether a trademark has become generic can be revisited. It is highly likely that Google will face future challenges to its mark, especially if GOOGLE[®] continues to be more and more ubiquitous as the go-to internet search engine.

To avoid being a victim of its own success, Google will need to continue its efforts to avoid genericism. In the future, we could see a catchy video like the one produced by Velcro Companies, the markers of VELCRO[®], encouraging consumers

105. *Id.* at 13.

106. *Id.* at 13.

107. Petition for Writ of Certiorari at 13, *Elliott v. Google*, 138 S.Ct. 362 (2017) (No. 17-258).

108. *Id.* at 15–16.

109. Waiver of Right of Respondent Google, Inc. to Respond, *Elliott v. Google*, 138 S. Ct. 362 (2017) (No. 17-258).

110. *Elliott v. Google*, 860 F.3d 1151 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (mem.).

111. *See id.*

112. *See id.* (deciding that “Google” was not victim of genericide because it is primarily understood to refer to the corporation rather than search engines themselves, the decision leaves open the possibility for future challenges if the primary understanding of “Google” did change in that way).

GOOGLE®: NOT YOUR GENERIC SEARCH ENGINE

to call non-VELCRO® fasteners a “hook-and-loop,”¹¹³ made by Google, convincing us to “internet search it.”

Indeed, early on, Google recognized the need to take steps to protect its mark from genericism.¹¹⁴ Efforts included discouraging publications from using the term “googling” in reference to internet searching, and sending cease and desist letters to offenders.¹¹⁵ These efforts along with Google’s own trademark use guidelines,¹¹⁶ ultimately resulted in the Oxford English Dictionary and the Merriam-Webster Collegiate Dictionary differentiating the noun and company name, “Google,” and the verb, “to google,” through use of lowercase letters for the act of searching for information on the internet, and the use of a capital “G” for the noun and the company, Google, in their definitions.¹¹⁷ In fact, Google specifically asked Wordspy.com to modify its definition of “google” to read, “[t]o search for information on the Web, particularly by using the Google search engine.”¹¹⁸ The publisher of Merriam-Webster even stated that they crafted a definition that tried to be respectful of Google’s trademark.¹¹⁹ The importance of these dictionary definitions cannot be overstated. Both were cited in the District Court opinion and the Ninth Circuit opinion, swaying the judges in Google’s favor that the marks are not generic.¹²⁰

113. Velcro Brand, *Don't Say Velcro*, YOUTUBE (Sept. 25, 2017), <https://www.youtube.com/watch?v=rRi8LptvFZY> (“Our Velcro Brand Companies legal team decided to clear a few things up about using the VELCRO® trademark correctly – because they’re lawyers and that’s what they do. When you use ‘velcro’ as a noun or a verb (e.g., velcro shoes), you diminish the importance of our brand and our lawyers lose their *insert fastening sound.* So please, do not say ‘velcro shoes’ (or ‘velcro wallet’ or ‘velcro gloves’) - we repeat ‘velcro’ is not a noun or a verb. VELCRO® is our brand. #dontsayvelcro.”).

114. See, e.g., *Do You “Google?”*, GOOGLE OFFICIAL BLOG (Oct. 25, 2006), <https://googleblog.blogspot.com/2006/10/do-you-google.html> (“While we’re pleased that so many people think of us when they think of searching the web, let’s face it, we do have a brand to protect, so we’d like to make clear that you should please only use “Google” when you’re actually referring to Google Inc. and our services.”).

115. See Jeffrey Kobulnick & Joseph Rothberg, *Court Finds ‘Google’ is Not Generic*, IPWATCHDOG (May 20, 2017), <http://www.ipwatchdog.com/2017/05/20/court-finds-google-not-generic/id=83476/>.

116. GOOGLE - RULES FOR PROPER USAGE, <https://www.google.com/permissions/trademark/rules.html> (last visited Feb. 13, 2018).

117. Jeffrey Kobulnick & Joseph Rothberg, *Court Finds ‘Google’ is Not Generic*, IPWATCHDOG (May 20, 2017), <http://www.ipwatchdog.com/2017/05/20/court-finds-google-not-generic/id=83476/>.

118. *Elliott v. Google Inc.*, 45 F. Supp. 3d 1156, 1171 (D. Az. 2014).

119. *Id.*

120. *Id.*; *Elliott v. Google*, 860 F.3d 1151, 1163–64 (9th Cir. 2017) (“At most, with respect to evidence that the public employs the verb ‘google’ without regard to the search engine used, the plaintiffs have mustered secondary definitions from a few dictionaries and expert testimony from their linguists. Whatever this evidence might suggest about the use of ‘google’ as a verb, no rational jury could rely on it to find, on this record, that the word has become the generic name for Internet search engines. As already mentioned, these dictionaries’ primary definitions of the word uniformly refer to Google’s own search engine. And the expert linguists conceded in their depositions that, despite their opinion that ‘google’ is used in verb form without regard to a specific search engine, the term has not become a generic name for search engines.”).

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The need for continued policing of the public's use of famous trademarks is imperative for a brand to maintain its distinctiveness and enforceability as a trademark. The *Elliott v. Google* decision is instructive for other famous brand owners who experience widespread use of marks by the public, including the need to be proactive in monitoring domain name registrations, use by consumers and the media, and dictionary definitions and the importance of providing detailed trademark usage guides.¹²¹ Further, the decision serves as supportive precedent for successful brands whose marks are facing genericism challenges.¹²²

In a quote provided to *The Recorder* by Richard Wirtz, lawyer for Petitioners, Wirtz stated that he believes Congress needs to address the issue of "trademark verbing."¹²³ "While the Ninth Circuit landmark decision is now the single authority addressing the verbing of trademarks in the U.S.," Wirtz said, "we don't believe it is the end of the 'verbing of trademark' legal issue . . . we don't see how any owner of a trademark can intelligently police verb usages, which will most likely result in further challenges to verb-ed trademarks."¹²⁴ We shall see. Or, we can always "google it."

121. See Petition for Writ of Certiorari at 11, *Elliott v. Google*, 138 S. Ct. 362 (2017) (No. 17-258), 2017 WL 3601395 ("This holding is dangerous. Trademark owners, following the conventional wisdom and advice of experts like INTA, have expended large sums of money to police the verb usage of their marks. For example, Xerox has waged an advertising campaign to ask the public not to use XEROX as a verb because it could lead to genericide. However, if verb usage is completely irrelevant to genericness, then trademark owners can cease policing verb usage of their marks."); see also *Elliott v. Google Inc.*, 860 F.3d 1151, 1156 (9th Cir. 2017) ("Genericide occurs when the public appropriates a trademark and uses it as a generic name for particular types of goods or services irrespective of its source. For example, ASPIRIN, CELLOPHANE, and ESCALATOR were once protectable as arbitrary or fanciful marks because they were primarily understood as identifying the source of certain goods. But the public appropriated those marks and now primarily understands aspirin, cellophane, and escalator as generic names for those same goods.").

122. See Petition for Writ of Certiorari at 11, *Elliott v. Google*, 138 S. Ct. 362 (2017) (No. 17-258), 2017 WL 3601395 (suggesting that brands can cease policing verb usage of their trademarks to the extent that people understand the word, in its common usage, to reference the brand rather than the category of product produced, even if the word shares some usage as a verb).

123. Ross Todd, *US Supreme Court Rejects Case Challenging Google's Trademark as Generic*, RECORDER (Oct. 16, 2017), <https://www.law.com/therecorder/sites/therecorder/2017/10/16/us-supreme-court-rejects-case-challenging-googles-trademark-as-generic/>.

124. *Id.*