

Lessons From Google Surviving The Genericide Attack

The U.S. Court of Appeals for the Ninth Circuit recently affirmed a federal district court's grant of summary judgment in favor of [Google Inc.](#) in connection with an attempt to cancel the "Google" trademark registrations under the theory that the mark has become a generic term used by the public for searching on the internet. The ruling is a victory for brand owners, especially those who risk genericness challenges because of the success of their products or services and the widespread (mis)use of their marks by the public.

Overview of the Google Case

In 2012, Chris Gillespie and David Elliott registered 763 domain names that included the word "google" and an additional term identifying a specific brand, person, product, location or event such as [googledisneyworld.com](#), [googledallascowboys.com](#) and [googledonaldtrump.com](#). Google filed a cybersquatting complaint under the Uniform Domain Name Dispute Resolution Policy,[1] claiming that the domain names were confusingly similar to the "Google" trademark and were registered in bad faith. The complaint was filed with the National Arbitration Forum, and the NAF found in favor of Google and transferred the domain names to Google.[2] Elliott and Gillespie (collectively "Elliott") then filed an action in the Arizona district court petitioning to cancel the "Google" trademark[3] under the Lanham Act,[4] arguing that the word "google" is primarily understood as a generic term universally used to describe the act of internet searching.

The parties filed cross-motions for summary judgment, with Elliott arguing that (1) it is an indisputable fact that a majority of the relevant public uses the word "google" as a verb (e.g., "I googled it"), and (2) verb use constitutes generic use as a matter of law, and Google arguing that verb use does not automatically constitute generic use and that Elliott failed to present sufficient evidence to support a jury finding that the relevant public primarily understands the word "google" as a generic name for internet search engines. The Arizona district court found in favor of Google,[5] and ruled that, even if the term "google" has become known — and is used as a verb — for searching the internet, that doesn't necessarily mean that the primary significance of the term "google" to the relevant public is as a generic name for internet search engines generally instead of as a mark identifying the Google search engine in particular. On May 16, 2017, the U.S. Court of Appeals for the Ninth Circuit affirmed the district court's grant of summary judgment.[6]

Before we discuss the court's decision in more detail, let's review some of the concepts framing the issues raised in the Google case.

The Spectrum of Distinctiveness — Weak vs. Strong Marks

Not all marks are created equal, and some terms can never be marks. The generally recognized categories of types of terms on the "spectrum of distinctiveness" or "distinctiveness/descriptiveness continuum" (which roughly reflects their eligibility to obtain trademark status and the degree of protection accorded from weakest to strongest) are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful terms. Generic terms are terms that the public understands primarily as the common name for the goods or services, such as "Salt" when used in connection with sodium chloride or "The Chocolatier" for a store providing chocolate candy. "Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status." [7] In other words, because generic terms identify the product or service and not the source of the product or service, generic terms are not protectable. On the other end of the spectrum are arbitrary and fanciful terms. Arbitrary marks are common words that are used in a unique way such that the words have no relationship to the product or service, such as "[Apple](#)" for computers. Fanciful marks are terms that have been invented or "coined" for the sole purpose of functioning as a trademark, such as the term "Google" for an internet search engine[8] or "[Xerox](#)" for copiers. Arbitrary or fanciful marks are "automatically entitled to protection because they naturally serve to identify a particular source of a product." [9]

However, even a strong arbitrary or fanciful mark has the potential to lose its trademark significance and become generic.

Genericide — When Good Marks Go Bad

The Lanham Act allows cancellation of a registered trademark if it is primarily understood as a “generic name for the goods and services, or a portion thereof, for which it is registered.”[10] This phenomenon has become known as “genericide” — when the public appropriates a trademark and uses it as a generic name for a particular type of goods or services, irrespective of the source of those goods or services. Once a mark becomes generic, it is no longer subject to trademark protection — and “linoleum,” “thermos” and “videotape” are some well-known victims. As “McCarthy on Trademarks and Unfair Competition” describes, genericide can occur for a variety of reasons:

Sometimes genericide occurs as a result of the trademark owner’s failure to police the mark, resulting in widespread usage by competitors leading to a perception of genericness among the public, who sees many sellers using the same term. Sometimes, a term intended by the seller to be a trademark for a new product is taken by the public as a generic name because customers have no other word to use to name this new thing. Such was the fate under U.S. law of words like “aspirin,” “cellophane,” and “escalator.”[11]

One court explained that genericide does not typically occur “until the trademark has gone so far toward becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name.”[12]

However, there are situations in which some portion of the market may use a given term as a generic name at the same time as other consumers use it in a trademark sense. Under these circumstances, the Lanham Act states that: “The primary significance of the registered mark to the relevant public ... shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”[13] Therefore, genericide hinges on whether “the primary significance of the term in the minds of the consuming public is [now] the product [and not] the producer.”[14] This is typically determined by reviewing evidence such as dictionary usage, mark-holder usage, competitor usage, media usage, and consumer surveys.[15] And this is exactly what the Google court had to evaluate.

Back to the Google Case

As previously mentioned, Elliott argued that the word “google” is primarily understood as a generic term universally used to describe “the act” of searching the internet. However, the court clarified that “a claim of genericide must always relate to a particular type of good or service”[16] as required by the language in the Lanham Act.[17] The Ninth Circuit noted that this requirement was “necessary to maintain the viability of arbitrary marks as a protectable trademark category” or “a mark like IVORY, which is arbitrary as applied to soap, could be cancelled outright because it is generic when used to describe a product made from the tusks of elephants.”[18] Elliott’s claim did not meet this requirement. Elliott did not argue, nor did Elliott’s evidence[19] show, “that the primary significance of the word ‘google’ to the relevant public is as a name for internet search engines generally and not as a mark identifying the Google search engine in particular.”[20]

Elliott also argued that the district court should have framed the inquiry as whether the relevant public primarily uses the word “google” as a verb, claiming that a word can only be used in a trademark sense when it is used as an adjective. However, the Ninth Circuit stated that this inquiry failed “because verb use does not automatically constitute generic use.”[21] To support its conclusion, the court stated that “we now recognize that 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 the Google search engine in mind.”[22] However, the court concluded that the mere fact that customers use “google” as a verb fails to show what those customers were thinking and whether they had a particular source in mind.

How to Avoid Genericide

Traditionally, trademark use guidelines always instruct that marks should only be used as adjectives and strongly advise against using marks as nouns or verbs. However, many marketers view it as a badge of honor when their brand names are “verbed” because they see it as having reached a different echelon of consumer recognition and market dominance. Although trademark verbing (by both the public and brand owners) appears to be on the rise lately, and the Google opinion provides guidance and distinctions that may give brand owners a new level of comfort, that doesn’t mean that brand owners shouldn’t remain vigilant about protecting their marks or that they should completely abandon the tried and true trademark use “rules.” Genericide, after all, is a serious but typically avoidable consequence.

Some well-known brands are actively attempting to avoid falling victim to genericide. Xerox Corp. has run several ads attempting to educate the public how to properly use its “Xerox” mark, including: “You can’t Xerox a Xerox on a Xerox. But we don’t mind at all if you copy a copy on a Xerox copier.” and “When you use ‘Xerox’ the way you use ‘aspirin,’ we get a headache.”

[Kimberly-Clark Corp.](#) has run similar campaigns to help protect its “Kleenex” mark: “‘Kleenex’ is a brand name ... and should always be followed by an ® and the word ‘Tissue.’ [Kleenex Brand Tissue] Help us keep our identity, ours.” and “‘Kleenex’ is a brand name. Not any old tissue is a Kleenex Tissue.”

However, aggressive educational advertising campaigns are typically one of the last steps brands take to protect their marks. Brands should also adhere to established trademark use “Do’s and Don’ts” to prevent genericide, such as:

Dos:

- Do use the mark as an adjective qualifying the generic name of the product. (Q-Tips cotton swabs.) If the product is the first of its kind in the marketplace, come up with a generic term for the product.
- Do use appropriate notice symbols with the marks. The ® symbol may only be used for registered marks. The ™ symbol should be used with unregistered marks.
- Do distinguish the mark from surrounding text by capitalizing the mark or the first letter of the mark, using a distinctive typeface, enlarging or italicizing the mark, or using a logo.
- Do use the mark on a line of products rather than a single product. (“[Reebok](#),” used on clothing, shoes and accessories)
- Do educate employees, distributors, dealers, and customers how to properly use the mark.
- Do police the mark by monitoring third-party use of the mark and objecting to misuse of the mark. Although brand owners are not required to prosecute (or even act immediately against) every potential infringer, brands do have a legal duty to protect against infringement and act reasonably in protecting their trademark rights.

Don'ts:

- Don't use the mark as a verb. (You use a Xerox brand copier to make a copy. You do not "xerox" these documents.)
- Don't use the mark as a noun. (Kleenex.)
- Don't use the mark in the plural or possessive (unless the mark is plural or possessive). (You buy a pair of [Nike](#) shoes, not a pair of Nikes.)
- Don't abbreviate, alter, or hyphenate a mark or create an acronym (unless that is the actual mark). (A&W root beer, not A and W.)

Despite this sage advice, to the dismay of trademark lawyers everywhere, marketers and trendsetters are wont to follow Katharine Hepburn's words of wisdom: "If you obey all of the rules, you miss all of the fun." So, in the event the brand or the public bends the "don't" rules with a mark, the Google case suggests the need for brand owners to take extra care to mitigate the potential risks.

For example, educate the public that the brand-verb ["googling"] can only be accomplished by using the branded product or service (Google), such as in a tagline ("Googling Isn't Possible Without Google") or in other messaging within an advertisement. Brands should consider taking ownership of brand-verbs by filing trademark applications and providing use guidelines for the brand-verbs. In the Google case, Elliott alleged that the only reason every dictionary definition of the word "google" included a reference to the "Google" trademark is because Google threatened to take legal action if the companies refused to acknowledge its registration. The court stated that "Google's policing activities weight against finding genericide."^[23] No doubt Google's early and continued diligence in discouraging publication (sometimes via cease-and-desist letters) from using the term "googling" in reference to internet searches assisted Google greatly in its efforts to preserve its valuable rights in the "Google" mark. Other brands should take note.

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[1] The Uniform Domain Name Dispute Resolution Policy was adopted by the [Internet Corporation for Assigned Names and Numbers](#) ("ICANN") in 1999, available at <https://www.icann.org/resources/pages/policy-2012-02-25-en>.

[2] Google Inc. v. Chris Gillespie, Claim Number: FA1203001434643 (National Arbitration Forum 2012), available at <http://www.adrforum.com/domaindecisions/1434643.htm>.

[3] The two GOOGLE trademark registrations at issue were Reg. No. 2884502 for "computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources" in Class 9, and Reg. No. 2806075 for "Providing electronic mail and workgroup communications services over computer networks; providing multiple user access to proprietary collections of information by means of global computer information networks" in Class 38 and "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" in Class 42.

[4] 15 U.S.C. §§ 1051 et seq., also known as the Trademark Act of 1946.

[5] *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156 (D. Ariz. 2014), available at https://origin-www.bloomberglaw.com/public/desktop/document/Elliott_et_al_v_Google_Incorporated_Docket_No_212_cv01072_D_Ariz_M.

[6] *Elliot v. Google Inc.*, No. 15-15809 (9th Cir. May 16, 2017), available at <http://cdn.ca9.uscourts.gov/datastore/opinions/2017/05/16/15-15809.pdf>.

[7] *In re Merrill Lynch*, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1569 (Fed. Cir. 1987).

[8] History of Google. (n.d.). In Wikipedia. Retrieved June 13, 2017, available at https://en.wikipedia.org/wiki/History_of_Google#cite_note-Hanley-69 (“The name “Google” originated from a misspelling of “googol”, which refers to the number represented by a 1 followed by one-hundred zeros. [Google co-founders Larry] Page and [Sergey] Brin write in their original paper on PageRank: ‘We chose our systems name, Google, because it is a common spelling of googol, or 10100 and fits well with our goal of building very large-scale search engines.’” (internal citations omitted)).

[9] *KP Permanent Make-Up, Inc.*, 408 F.3d at 602 (alterations omitted) (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

[10] 15 U.S.C. § 1064(3).

[11] J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition, § 12:1 (4th ed., Westlaw database updated June 2017) (internal citations omitted).

[12] *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531 (7th Cir. 2003). In the Google case, Elliott’s claim that there is no efficient alternative for the word “google” as a name for “the act” of searching the internet regardless of the search engine used failed because Elliott did not show that there is no way to describe “internet search engines” without calling them “googles.” Elliott, No. 15-15809, at 19-20.

[13] 15 U.S.C. § 1064(3) (emphasis added).

[14] *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

[15] McCarthy, *supra* note 12, § 12:13-12:14.

[16] Elliott, No. 15-15809, at 8 (emphasis added).

[17] 15 U.S.C. § 1064(3) (The Lanham Act allows cancellation of a registered trademark if it becomes the generic name for the goods and services... for which it is registered.” (emphasis added)) .

[18] Elliott, No. 15-15809, at 9 (emphasis added) (internal quotation marks omitted) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 n.6 (2d Cir. 1976)).

[19] The court concluded that much of Elliott’s evidence was inadmissible for various reasons (e.g., two of Elliott’s three surveys were not conducted according to accepted principles, certain evidence was not disclosed during discovery, etc.), and that “Elliott’s admissible evidence is largely inapposite to the relevant inquiry under the primary significance test because Elliot ignores the fact that a claim of genericide must relate to a particular type of good or service.” Elliott, No. 15-15809, 13. Although the court found that Elliott’s admissible evidence supports the inference that a majority of the public uses the verb “google” in a generic [and potentially indiscriminate] sense, the evidence “tells us nothing about how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines.” Id. at 14. “Elliott cannot survive summary judgment based on ‘sheer quantity’ of irrelevant evidence.” Id. at 20.

[20] Elliott, No. 15-15809, at 13.

[21] *Id.* at 10.

[22] *Id.* at 12.

[23] *Id.* at 18-19, n.9.