

No. _____

In the Supreme Court of the United States

DAVID ELLIOTT, an Individual;
CHRIS GILLESPIE, an Individual,
Petitioners,

v.

GOOGLE, INC., a Delaware corporation,
Respondent.

*On Petition for Writ of Certiorari to the
United States Court of Appeals for the Ninth Circuit*

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Trademarks, unlike copyrights or patents, enjoy a monopoly without a statutory time limit. However, the lack of a time limit on a trademark registration is subject to the statutory grounds on which a registration may be cancelled. Registration of a federal trademark may be cancelled “[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered. . . .The primary significance of the registered mark to the relevant public rather than purchaser motivation 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.” 15 U.S.C. § 1064(3). However, neither § 1064, nor any case authority interpreting it, tells what effect, if any, verb usage of a registered mark by the relevant public has on the status of that mark as generic or non-generic. In light of this lack of guidance on a novel, modern issue of trademark law, the following questions are presented to this Court:

- I. Does verb use of a trademark, such as “google,” constitute generic use as a matter of law?
- II. Is the test for “primary significance” one of “majority usage” (as the Second Circuit and leading trademark scholars have interpreted it) or “majority understanding” (as the Ninth Circuit in this case found)?
- III. Is the district court allowed or required, pursuant to *Anderson v. Liberty Lobby* (1986) 477 U.S. 242, to weigh the evidence on a motion for summary judgment and did the district court

err when it weighed and discounted all of the evidence of genericness presented by the non-movant on this motion for summary judgment?

PARTIES TO PROCEEDING

Petitioners, David Elliott and Chris Gillespie, were the plaintiffs and counter-defendants in the district court, and the plaintiff-appellants in the court of appeals.

Respondent, Google, Inc., a Delaware corporation, was the defendant and counter-claimant in the district court, and the defendant-appellee in the court of appeals.

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OPINIONS BELOW

The published amended memorandum opinion of the United States Court of Appeals for the Ninth Circuit is reported at 860 F.3d 1151 and is included herein as Appendix A. The opinion of the district court is reported at 45 F.Supp.3d 1156 and included herein as Appendix B.

BASIS FOR JURISDICTION

This Court has jurisdiction of this petition to review the judgment of United States Court of Appeals for the Ninth Circuit pursuant to 28 U.S.C. § 1254(1). The Ninth Circuit's memorandum opinion was filed on May 16, 2017, and subsequently an amended memorandum opinion was issued on June 14, 2017, to correct a case reference on page 9.

The district court had subject matter jurisdiction pursuant to 15 U.S.C. § 1119 (Section 37 of the Lanham Act) because the dispute involved two registered marks for GOOGLE, and 15 U.S.C. § 1121 which provides that the district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction, of all actions arising under the Lanham Act.

STATUTES INVOLVED

15 U.S.C. § 1064: "A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by

blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

...

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation 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.

...

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required. . . .

INTRODUCTION

The English language is dynamic. Like a living being, it is constantly evolving to meet the needs of its speakers to express concepts that did not exist before. One increasingly common trend is the “verbing” of trademarks, i.e., the appropriation by the public of trademarks to express an action associated with the class of goods or services to which the product originally associated with the trademark belongs. We now refer to magazine cover photos as “photoshopped”; we “windex” our windows to remove streaks; we “xerox” exhibits; we “rollerblade” down the street on our inline skates; we “wite-out” the mistakes in a term paper; and we read a news article about the police “taser” a resistant suspect. This appropriation by the public is not something to be prevented; rather, it is something to be encouraged. It fills holes in the language created by the rapid progress of our species, allowing for more efficient and effective communication. The appropriation by the public in this case is an ideal example: there is no single word other than google that conveys the action of searching the internet using any search engine.

Verbing creates questions that have never been addressed by the drafters of the Lanham Act or the courts. What effect, if any, does the verbing of a trademark have on that trademark's status as non-generic versus generic? Can a verb ever perform a source identifying function? Even if it can perform a source identifying function, what effect does use of the verbed trademark in a manner which does *not* indicate source have on that trademark's status as being non-generic versus generic?

Scholars, such as trademark experts and linguists, have consistently advised that verbs cannot perform a source identifying function. These scholars consistently warn trademark owners that trademarks should never be permitted to be used as verbs and that allowing such verb usage will result in genericide.

The Ninth Circuit's opinion contradicts the advice given by scholars, leaving trademark owners and the appropriating public standing on uncertain ground. The Ninth Circuit found that trademarks used as verbs *can* be used either discriminately (in a manner which indicates source) or indiscriminately. These terms were coined by the Ninth Circuit in its opinion in this case and are not derived from any existing trademark law or precedent. However, the Ninth Circuit found neither discriminate nor indiscriminate verb usage affects the mark's status as generic or non-generic. The Ninth Circuit found that only usage of the mark as the name (noun) for the class of goods or services on or in connection with which the trademark was used is relevant to the genericness of a mark.

First, taking this decision to its logical end results in untenable and conflicting consequences. A mark

may be used ubiquitously as an indiscriminate verb to the point where no one remembers the term's origin as a trademark and yet, pursuant to the Ninth Circuit's opinion, the mark's status would remain unchanged, existing in perpetuity.

Second, the Ninth Circuit's decision only begs more questions. If a verb can be discriminate, does that mean it can be registered as a trademark itself? On the other hand, if verb usage is not trademark usage, then can competitors fairly use verbs which originated with trademarks indiscriminately to describe the action of using their own products?

This Court must act now and undo the chaos created by the Ninth Circuit's misguided decision.

STATEMENT OF THE CASE

A. Facts Giving Rise to this Case

The word "google" has been used ubiquitously as a verb meaning to search for something on the internet for at least the last decade. The parties dispute whether it is primarily used to refer to searching for something on the internet in general, regardless of what search engine is used, or to refer to searching the internet using only Google Inc.'s search engine.

The word "google" is defined as a verb in leading dictionaries, some with reference to Google Inc.'s search engine, and *some without*. In 2010, the verb "google" was chosen by the American Dialect Society as its "word of the decade" and defined by these leading experts as: "Verb meaning 'to search the internet.' Generic form of the trademarked 'Google,' the world's dominant Internet search engine." Petitioners

presented to the district court hundreds of examples of the public using the verb google to refer to performing online searches on databases such as Ebay, Facebook, IMDB, Pinterest, and Wikipedia. Use of google as a verb to refer to searching for something on the internet in general, regardless of what search engine is used, can be found in movies, television programs, songs, news and media articles, advertising (unrelated to google.com), books, cartoons, and hundreds of purchased and available domains containing the word google. The district court weighed and discounted all of this evidence of genericness.

B. The District Court Proceedings

This case began with one member of the public's use of google as a verb in an indiscriminate manner. In light of the now prevalent use of google as a verb meaning to search on the internet (regardless of what search engine is used), Petitioners registered domains which combine the generic verb google with another term. When Google Inc. successfully utilized UDRP proceedings to have the domains transferred to Google Inc., Petitioners filed their first amended complaint on July 27, 2012, for Cancellation of Respondent Google Inc.'s ("Google Inc.") federal trademark registrations Nos. 2806075 and 2884502 for the mark GOOGLE, and for a declaration that the GOOGLE mark has become generic and/or that Petitioners' use of the verb google in their domain names constituted fair (non-trademark) use. (14 ER 3014) Google Inc. filed its answer and counterclaims on August 31, 2012, alleging trademark dilution, cybersquatting, unjust enrichment, unfair competition, and false advertising.

Petitioners and Google Inc. each filed cross motions for summary judgment on the issue of genericness on September 23, 2013. This appeal arises from Respondent/Defendant Google Inc.'s motion for summary judgment on genericness, which was granted by the district court on September 11, 2014.

C. The Appellate Court Proceedings

The parties then stipulated to dismiss the remaining claims, and judgment was entered accordingly on April 16, 2015. On April 27, 2015, Petitioners filed a notice of appeal from the district court's September 11, 2014 Order. After briefing and oral arguments, the Ninth Circuit issued a published opinion on May 16, 2017, affirming the Order of the district court wherein it granted summary judgment in favor of Google Inc. on the issue of genericness. On June 14, 2017, the Ninth Circuit issued an Amended (again, published) Opinion affirming the Order of the district court, in order to correct a citation. Pet. App. 1. This petition for certiorari was then timely filed.

**REASONS WHY CERTIORARI
SHOULD BE GRANTED**

I. Review Is Warranted Because the Ninth Circuit Has Decided Important Questions of Federal Trademark Law That Have Not Been, but Should Be, Settled by this Court: Does Verb Use of a Trademark, Such as “Google”, Constitute Generic Use as a Matter of Law and Where Does Verb Usage of a Mark Fit in the Analysis of the Genericness of a Mark?

It may be surprising, given the prevalence of verbed trademarks, but these important questions of federal trademark law have not been settled by this Court, which leaves trademark owners, competitors, and the public in the dark as to the ramifications of verb usage of trademarks. As such, resolution of these unsettled questions is critically important not just to Petitioners and to Google Inc. but also to the owners of the ROLLERBLADE, XEROX, PHOTOSHOP, TiVO, FEDEX, and FACETIME trademarks, among others which have been verbed.

A. Is Verb Usage of a Trademark Generic Usage as a Matter of Law?

The Ninth Circuit in this case first rejected the premise that all verb usage of a trademark is necessarily generic usage, and instead found that verb usage of a trademark may be discriminate or indiscriminate. These terms do not exist anywhere else in established trademark law, precedent or even commentary, but rather were invented by the district court. Furthermore, this finding is illogical as it

contradicts both a basic tenant of trademark law and the opinions of linguists (experts on the English language), and is unnecessary in light of the Ninth Circuit's second holding.

The Ninth Circuit's first holding is illogical because verbs cannot indicate the source of a good or a service. A verb describes an action. It does not identify the item which must be used to perform that action, let alone that item's producer.

The Ninth Circuit's first holding contradicts a basic tenant of trademark law – that trademarks are adjectives (or, as sometimes called, “attributive nouns”) used to convey a specific piece of information (the source and/or producer) regarding a noun (the good or service on or in connection with which the trademark is used).

The Ninth Circuit's first holding contradicts the opinions of multiple trademark experts and linguists. For example, the International Trademark Association (“INTA”), a well-respected international trade association of trademark owners and professionals that is dedicated to supporting trademarks, states that “[a]ll trademarks are proper adjectives used to identify the source of the goods or services noun that they describe.” INTA warns that “Trademarks Should Not Be Used as Verbs” because “[u]sing a trademark as a verb implies that the trademark is an action word. Trademarks are source identifiers and have no relation to the actions they may describe. . . .” *Proper Trademark Use Presentation*, International Trademark Association (April 2015), available at <https://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkUseFactSheet.aspx>.

The Ninth Circuit's holding (i.e., that verbs can be discriminate) appears to open the door for the registration of verbs as trademarks.

Even more problematic, however, is the fact that the Ninth Circuit's first holding is completely unnecessary in light of its second holding: that verb usage, *even indiscriminate verb usage*, of a trademark is completely irrelevant to whether that trademark is generic or non-generic.

B. Is Verb Usage of a Trademark Relevant to Whether That Trademark Has Become Generic?

The Ninth Circuit in this case then went on to hold that verb usage is not relevant at all in determining whether a mark has become generic. The Ninth Circuit held that even majority usage of a trademark as an indiscriminate verb is not relevant to genericness:

At summary judgment, the district court assumed that a majority of the public uses the verb "google" to refer to the act of "searching on the internet without regard to [the] search engine used." In other words, it assumed that a majority of the public uses the verb "google" in a generic and indiscriminate sense. The district court then concluded that this fact, on its own, cannot support a jury finding of genericide under the primary significance test. We agree.

Pet. App. 14-15. In so holding, the Ninth Circuit concluded that the district court in this case was justified in ignoring a massive quantity of evidence presented by Petitioners including dictionary definitions of google as an indiscriminate verb,

examples of actual references by members of the relevant public to googling on other search engines such as Yahoo or Bing, surveys that show that a majority of the relevant public primarily use the word google as an indiscriminate verb, and thousands of instances of indiscriminate verb usage of google in movies, television programs, songs, news and media articles, advertising (unrelated to google.com), books, cartoons, and domain names.

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. Trademark owners are thus left on uncertain ground: do they follow the longstanding practice, advised by trademark experts, of policing verb usage, or do they follow the holding of the Ninth Circuit in this case and abandon their efforts to police verb usage?

The inescapable fact is that any indiscriminate use of a trademark affects the public's understanding of the mark. Unchecked indiscriminate verb usage of trademarks could, and will, lead to a reality where the public can no longer recall that the verb derives from a trademark, while simultaneously allowing the trademark to exist on the Principal Register in perpetuity. This is something the drafters of the Lanham Act never intended.

The better holding is one which views the various uses of a trademark holistically: considering all uses of the mark which bear any connection to the class of goods or services in question, what is the primary significance of the mark to the relevant public? Is it as a generic verb or as a trademark? This Court should grant this petition, reverse the holdings of the Ninth Circuit on the new, important questions of federal trademark law discussed herein, and embrace Petitioners' logical and holistic approach to the issue of verbing.

II. Review Is Warranted Because the Opinion by the Ninth Circuit Conflicts with an Opinion of the Second Circuit and Well-Respected Secondary Authority by Changing the Test for Genericness from “Majority Usage” to “Majority Understanding.”

“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.” 15 U.S.C. § 1064(3)

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.” *See* 2 McCarthy on Trademarks and Unfair Competition § 12:6 (4th ed.) (Principal generic significance—Majority use controls); *see also* Restatement (Third) of Unfair Competition § 13 (1995) (“The [primary significance] standard is often interpreted as a rule of majority usage.”); *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 581, 138 U.S.P.Q. 349

(2d Cir. 1963) (“Since the great majority of those members of the public who use the word ‘thermos’ are not aware of any trademark significance, there is not enough dual use to support King-Seeley’s claims to monopoly of the word as a trademark.”); *see also* Vincent N. Palladino, “*Surveying Secondary Meaning*”, 84 Trademark Rptr 155, 178 (1994).

The district court “assumed that a majority of the public uses the verb ‘google’ in a generic and indiscriminate sense. The district court then concluded that this fact, on its own, cannot support a jury finding of genericide under the primary significance test.” Pet. App. 15. The Ninth Circuit agreed with this logic and conclusion. In doing so, the Ninth Circuit rejected the long-standing “majority usage” test in favor of the following test: “how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines.” Pet. App. 14-15.

The new test set forth by the Ninth Circuit is exceedingly difficult in application. It asks district courts, in making a determination of whether a mark has become generic, to reach into the mind of the public and attempt to discern how it “understands” a word, rather than looking at objective evidence of how the word is used. It requires parties asserting genericness to find ways to prove how the public “understands” a word. This makes it very difficult for challengers to prove genericness, which, in turn, expands the monopoly granted to trademark owners and contracts the public’s power to appropriate a former trademark for the public’s own use as a generic term.

III. Review Is Warranted Because the Opinion by the Ninth Circuit Either Misinterprets this Court's Prior Decision in *Anderson v. Liberty Lobby, Inc.* as Allowing or Requiring a Weighing of the Evidence by the District Court Or, If Properly Interpreted, Follows a Ruling of this Court Which Has Been Criticized Repeatedly in Dissent and by State Supreme Courts as Contradictory and Unworkable and Thus Should Be Overruled.

Even if the district court and the Ninth Circuit were correct in holding that the fact that a majority of the public uses the verb “google” in a generic sense does not tend in any way to prove that the primary significance of “google” is generic, the district court still erred in granting Defendant Google’s motion for summary judgment.

The district court, relying upon *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986), weighed the evidence presented by both sides on summary judgment, placed the burden entirely on Plaintiff, and found that Plaintiff’s evidence, though voluminous, was not “significantly probative” enough to be capable of supporting a favorable jury verdict. The Ninth Circuit’s opinion sanctioned this weighing of the evidence, stating that “Elliott was required to identify *sufficient* evidence to support a jury finding...” (emphasis added).

Plaintiff presented to the district court multiple surveys, two linguists’ expert opinions, evidence of media and public verb usage and, in particular, of indiscriminate verb usage, dictionary definitions,

trademark owner usage, consumer usage, and the lack of a generic substitute for the term google. All of these categories of evidence are relevant to genericness, as the district court admitted. Yet the district court found that all of this evidence was not enough. It did so by impermissibly weighing the evidence in reliance on *Anderson*.

The case of *Anderson v. Liberty Lobby, Inc.* was controversial even when first announced in 1986. In his dissenting opinion, Justice Brennan challenged the proposition that the test for determining whether a factual dispute is genuine for summary judgment purposes is whether a reasonable jury could find for the non-moving party. Such a determination would force the trial judge, Justice Brennan found, to weigh the evidence. He concluded that the ultimate burden of proof at trial is irrelevant and that the only question is whether the opposing affidavit raised a genuine issue of fact:

I am more troubled by the fact that the Court's opinion sends conflicting signals to trial courts and reviewing courts which must deal with summary judgment motions on a day-to-day basis... The Court's opinion is replete with boilerplate language to the effect that trial courts are not to weigh evidence when deciding summary judgment motions... But the Court's opinion is also full of language which could surely be understood as an invitation-if not an instruction-to trial courts to assess and weigh evidence much as a juror would... I simply cannot square the direction that the judge 'is not himself to weigh the evidence' with the direction

that the judge also bear in mind the ‘quantum’ of proof required and consider whether the evidence is of sufficient ‘caliber or quantity’ to meet that ‘quantum.’ I would have thought that a determination of the ‘caliber and quantity,’ i.e., the importance and value, of the evidence in light of the ‘quantum,’ i.e., amount ‘required,’ could only be performed by weighing the evidence.

Anderson v. Liberty Lobby, Inc. (1986) 477 U.S. 242, 265-66 (Brennan, J., dissenting)

The Supreme Courts of several states have declined to follow *Anderson* for this very reason. See *Dairy Stores, Inc. v. Sentinel Pub. Co.*, 104 N.J. 125, 156-57, 516 A.2d 220, 235-36 (N.J. Sup. Ct. 1986) (“We are persuaded, however, that the clear-and-convincing test inevitably implicates a weighing of the evidence, an exercise that intrudes into the province of the jury.”); *Moffatt v. Brown*, 751 P.2d 939, 944 (Alaska 1988) (“In retaining the ‘genuine issue of material fact’ test for summary judgment determinations, the New Jersey court explained ‘that the clear-and-convincing test inevitably implicates a weighing of the evidence, an exercise that intrudes into the province of the jury.’ We agree....”); *Parker v. Haller*, 751 P.2d 372, 377 (Wyo. 1988) (“We decline the invitation to weigh evidence submitted in support of and in opposition to a motion for summary judgment and continue to follow our standard of review that summary judgment is improper if there is a dispute as to a material fact.”); *Huckabee v. Time Warner Entm’t Co. L.P.*, 19 S.W.3d 413, 420-22 (Tex. 2000) (“Requiring the trial court to determine at the summary judgment stage whether a reasonable

juror could find the evidence to be clear and convincing suggests that the trial court must weigh the evidence.”).

Thus, this Court is called upon to either clarify that *Anderson* does not, as so many courts have found, require the weighing of the evidence, or overrule *Anderson* and its contradictions and clearly hold that district courts are not to weigh the value of the evidence presented by a non-movant and instead look to whether there exists an issue of material fact to be decided by the jury. In this case, the district court, purporting to follow *Anderson*, erred either way by weighing the value of the evidence before it. The issue of primary significance is a question of fact. *See Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 929 (9th Cir. 2005) (“Whether a mark is generic is a question of fact.”) Plaintiff presented admissible evidence on that issue. Summary judgment should not have been granted.

CONCLUSION

For the above and foregoing reasons, Petitioners request the issuance of a writ of certiorari to the United States Court of Appeals for the Ninth Circuit.

Respectfully submitted,

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App. 1

APPENDIX A

FOR PUBLICATION

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

No. 15-15809

D.C. No. 2:12-cv-01072-SMM

[Filed June 14, 2017]

DAVID ELLIOTT, an Individual;)
CHRIS GILLESPIE, an Individual,)
<i>Plaintiffs-Appellants,</i>)
)
v.)
)
GOOGLE, INC., a Delaware)
corporation,)
<i>Defendant-Appellee.</i>)

AMENDED OPINION

Appeal from the United States District Court
for the District of Arizona
Stephen M. McNamee, District Judge, Presiding

Argued and Submitted March 17, 2017
San Francisco, California

Filed May 16, 2017
Amended June 14, 2017

App. 2

Before: Richard C. Tallman and Paul J. Watford,
Circuit Judges, and Louis Guirola, Jr.,
Chief District Judge.

Opinion by Judge Tallman;
Concurrence by Judge Watford

SUMMARY**

Trademark Law

The panel affirmed the district court's summary judgment in favor of Google, Inc., in an action under the Lanham Act, seeking cancellation of the GOOGLE trademark on the ground that it is generic.

The panel held that a claim of genericness or "genericide," where the public appropriates a trademark and uses it as a generic name for particular types of goods or services irrespective of its source, must be made with regard to a particular type of good or service. The district court thus correctly focused on internet search engines rather than the "act" of searching the internet. The panel also held that verb use of the word "google" to mean "search the internet," as opposed to adjective use, did not automatically constitute generic use. The panel affirmed the district court's conclusion that the plaintiffs' evidence was

* The Honorable Louis Guirola, Jr., Chief United States District Judge for the Southern District of Mississippi, sitting by designation.

** This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

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insufficient to establish that the primary significance of the word “google” to the relevant public was as a generic name for internet search engines, rather than as a mark identifying the Google search engine in particular.

Concurring, Judge Watford wrote that he joined the court’s opinion with the caveat that the panel need not decide whether evidence of a trademark’s “indiscriminate” verb use could ever tell a jury anything about whether the public primarily thinks of the mark as the generic name for a type of good or service.

COUNSEL

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OPINION

TALLMAN, Circuit Judge:

I.

Between February 29, 2012, and March 10, 2012, Chris Gillespie used a domain name registrar to acquire 763 domain names that included the word “google.” Each of these domain names paired the word “google” with some other term identifying a specific

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brand, person, or product—for example, “googledisney.com,” “googlebarackobama.net,” and “googlenewtvs.com.”

Google, Inc. (“Google”) objected to these registrations and promptly filed a complaint with the National Arbitration Forum (“NAF”), which has authority to decide certain domain name disputes under the registrar’s terms of use. Google argued that the registrations violate the Uniform Domain Name Dispute Resolution Policy, which is included in the registrar’s terms of use, and amount to domain name infringement, colloquially known as “cybersquatting.” Specifically, Google argued that the domain names are confusingly similar to the GOOGLE trademark¹ and were registered in bad faith. The NAF agreed, and transferred the domain names to Google on May 10, 2012.

Shortly thereafter, David Elliott filed, and Gillespie later joined,² an action in the Arizona District Court. Elliott petitioned for cancellation of the GOOGLE trademark under the Lanham Act, which allows cancellation of a registered trademark if it is primarily understood as a “generic name for the goods or services, or a portion thereof, for which it is registered.” 15 U.S.C. § 1064(3). Elliott petitioned for cancellation on

¹ Both the NAF case and the case at issue actually involve two separate trademark registrations—numbers 2884502 and 2806075. But because the parties agree that these two marks collectively refer to the Google search engine and related services, we refer to these marks collectively as the GOOGLE trademark.

² For the remainder of this opinion, we collectively refer to Appellants as “Elliott.”

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the ground that the word “google” is primarily understood as “a generic term universally used to describe the act[] of internet searching.”

On September 23, 2013, the parties filed cross-motions for summary judgment on the issue of genericness. Elliott requested summary judgment because (1) it is an indisputable fact that a majority of the relevant public uses the word “google” as a verb—i.e., by saying “I googled it,” and (2) verb use constitutes generic use as a matter of law. Google maintained that verb use does not automatically constitute generic use, and that Elliott failed to create even a triable issue of fact as to whether the GOOGLE trademark is generic. Specifically, Google argued 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 district court agreed with Google and its framing of the relevant inquiry, and granted summary judgment in its favor.

Elliott raises two arguments on appeal. First, he argues that the district court misapplied the primary significance test and failed to recognize the importance of verb use. Second, he argues that the district court impermissibly weighed the evidence when it granted summary judgment for Google. We review the district court’s grant of summary judgment *de novo* and ask, viewing the evidence in the light most favorable to Elliott, “whether there are any genuine issues of material fact and whether the district court correctly applied the relevant substantive law.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005) (citing *Clicks Billiards, Inc. v.*

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Sixshooters, Inc., 251 F.3d 1252, 1257 (9th Cir. 2001)). For the reasons described below, we reject both of Elliott’s arguments and affirm summary judgment for Google.

II.

We recognize four categories of terms with regard to potential trademark protection: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful terms. *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999) (quoting *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979)). This case involves the first and fourth categories, which lie at opposite ends of the spectrum with regard to protectability. At one extreme, generic terms are “common descriptive” names which identify only the type of good “of which the particular product or service is a species.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 718 F.2d 327, 329 (9th Cir. 1983), *rev’d on other grounds*, 469 U.S. 189 (1985). Generic terms are not protectable because they do not identify the source of a product. *Id.* At the other extreme, arbitrary or fanciful marks “employ words and phrases with no commonly understood connection to the product.” *JL Beverage Co. v. Jim Beam Brands Co.*, 828 F.3d 1098, 1107 (9th Cir. 2016). Arbitrary or fanciful marks are “automatically entitled to protection because they naturally serve to identify a particular source of a product.” *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)).

Over time, the holder of a valid trademark may become a “victim of ‘genericide.’” *Freecycle Network*,

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Inc. v. Oey, 505 F.3d 898, 905 (9th Cir. 2007) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:1 (4th ed. 1998) [hereinafter McCarthy]). 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. *See Bayer Co. v. United Drug Co.*, 272 F. 505, 510 (S.D.N.Y. 1921); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936); *Freecycle Network, Inc.*, 505 F.3d at 905. The original holders of the ASPIRIN, CELLOPHANE, and ESCALATOR marks are thus victims of genericide.

The question in any case alleging genericide is whether a trademark has taken the “fateful step” along the path to genericness. *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531 (7th Cir. 2003). The mere fact that the public sometimes uses a trademark as the name for a unique product does not immediately render the mark generic. *See* 15 U.S.C. § 1064(3). Instead, a trademark only becomes generic when the “primary significance of the registered mark to the relevant public” is as the name for a particular type of good or service irrespective of its source. *Id.*

We have often described this as a “who-are-you/what-are-you” test. *See Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d

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925, 929 (9th Cir. 2005) (quoting *Filipino Yellow Pages, Inc.*, 198 F.3d at 1147). If the relevant public primarily understands a mark as describing “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 “what” the particular good or service is, then the mark has become generic. In sum, we ask whether “the primary significance of the term in the minds of the consuming public is [now] the product [and not] the producer.” *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

A.

On appeal, Elliott claims that he has presented sufficient evidence to create a triable issue of fact as to whether the GOOGLE trademark is generic, and that the district court erred when it granted summary judgment for Google. First, he argues that the district court erred because it misapplied the primary significance test and failed to recognize the importance of verb use. Specifically, he argues that the district court erroneously framed the 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 in particular. Instead, Elliott argues that the court should have framed the inquiry as whether the relevant public primarily uses the word “google” as a verb.

We conclude that Elliott’s proposed inquiry is fundamentally flawed for two reasons. First, Elliott fails to recognize that a claim of genericide must always relate to a particular type of good or service.

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Second, he erroneously assumes that verb use automatically constitutes generic use. For similar reasons, we conclude that the district court did not err in its formulation of the relevant inquiry under the primary significance test.

First, we take this opportunity to clarify that a claim of genericide or genericness must be made with regard to a particular type of good or service. We have not yet had occasion to articulate this requirement because parties usually present their claims in this manner *sua sponte*. *See, e.g., KP Permanent Make-Up, Inc.*, 408 F.3d at 605 (claiming that “micro colors” is generic for micropigmentation services); *Filipino Yellow Pages, Inc.*, 198 F.3d at 1146 (claiming that “Filipino Yellow Pages” is generic for “telephone directories targeted at the Filipino-American community”); *Park ‘N Fly, Inc.*, 718 F.2d at 330 (claiming that “Park ‘N Fly” is generic for airport parking lots). But here, Elliott claims that the word “google” has become a generic name for “the act” of searching the internet, and argues that the district court erred when it focused on internet search engines. We reject Elliott’s criticism and conclude that the district court properly recognized the necessary and inherent link between a claim of genericide and a particular type of good or service.

This requirement is clear from the text of the Lanham Act, which allows a party to apply for cancellation of a trademark when it “becomes the generic name for the *goods or services . . .* for which it is registered.” 15 U.S.C. § 1064(3) (emphasis added). The Lanham Act further provides that “[i]f the registered mark becomes the generic name for less

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than all of the *goods or services* for which it is registered, a petition to cancel the registration for only those *goods or services* may be filed.” *Id.* (emphasis added). Finally, the Lanham Act specifies that the relevant question under the primary significance test is “whether the registered mark has become the generic name of [certain] *goods or services*.” *Id.* (emphasis added). In this way, the Lanham Act plainly requires that a claim of genericide relate to a particular type of good or service.

We also note that such a requirement is necessary to maintain the viability of arbitrary marks as a protectable trademark category. By definition, an arbitrary mark is an existing word that is used to identify the source of a good with which the word otherwise has no logical connection. *See JL Beverage Co.*, 828 F.3d at 1107. If there were no requirement that a claim of genericide relate to a particular type of good, then 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.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 n.6 (2d Cir. 1976). This is not how trademark law operates: Trademark law recognizes that a term may be unprotectable with regard to one type of good, and protectable with regard to another type of good. In this way, the very existence of arbitrary marks as a valid trademark category supports our conclusion that a claim of genericide must relate to a particular type of good or service.

Second, Elliott’s alternative inquiry fails because verb use does not automatically constitute generic use. Elliott claims that a word can only be used in a

trademark sense when it is used as an adjective. He supports this claim by comparing the definitions of adjectives and trademarks, noting that both adjectives and trademarks serve descriptive functions.

Once again, Elliott’s semantic argument contradicts fundamental principles underlying the protectability of trademarks. When Congress amended the Lanham Act to specify that the primary significance test applies to claims of genericide, it specifically acknowledged that a speaker might use a trademark as the name for a product, i.e., as a noun, and yet use the mark with a particular source in mind, i.e., as a trademark. It further explained that:

A trademark can serve a dual function—that of [naming] a product while at the same time indicating its source. Admittedly, if a product is unique, it is more likely that the trademark adopted and used to identify that product will be used as if it were the identifying name of that product. But this is not conclusive of whether the mark is generic.

S. Rep. No. 98-627, at 5 (1984). In this way, Congress has instructed us that a speaker might use a trademark as a noun and still use the term in a source-identifying trademark sense.

Moreover, we have already implicitly rejected Elliott’s theory that only adjective use constitutes trademark use. In *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250 (9th Cir. 1982), the Coca-Cola Company sued a local restaurant for trademark infringement because its servers regularly and surreptitiously replaced customer orders for “a coke” with a non-Coca-Cola

beverage. *Id.* at 1252. The restaurant defended on the basis of genericide, arguing that the COKE trademark had become a generic name for all cola beverages. *Id.* at 1254. To support its claim, the restaurant presented employee affidavits stating that the employees believed that customers who ordered “a coke” were using the term in a generic sense. *Id.* We rejected these affidavits because they were not based on personal knowledge. More significant to the issue at hand, we also noted that the mere fact that customers ordered “a coke,” i.e., used the mark as a noun, failed to show “what . . . customers [were] thinking,” or whether they had a particular source in mind. *Id.* at 1255.

If Elliott were correct that a trademark can only perform its source-identifying function when it is used as an adjective, then we would not have cited a need for evidence regarding the customers’ inner thought processes. Instead, the fact that the customers used the trademark as a noun and asked for “a coke” would prove that they had no particular source in mind. In this way, we have implicitly rejected Elliott’s theory that a trademark can only serve a source-identifying function when it is used as an adjective.

For these reasons, the district court correctly rejected Elliott’s theory that verb use automatically constitutes generic use.³ Moreover, the district court

³ We acknowledge that if a trademark is used as an adjective, it will typically be easier to prove that the trademark is performing a source-identifying function. If a speaker asks for “a Kleenex tissue,” it is quite clear that the speaker has a particular brand in mind. But we will not assume that a speaker has no brand in mind simply because he or she uses the trademark as a noun and asks for “a Kleenex.” Instead, the party bearing the burden of proof

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aptly coined the terms “discriminate verb” and “indiscriminate verb” in order to evaluate Elliott’s proffered examples of verb use and determine whether they were also examples of generic use. Although novel, these terms properly frame the relevant inquiry as whether a speaker has a particular source in mind. We have already acknowledged that a customer might use the noun “coke” in an indiscriminate sense, with no particular cola beverage in mind; or in a discriminate sense, with a Coca-Cola beverage in mind. In the same way, 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.

Because a claim of genericide must relate to a particular type of good or service and because verb use does not necessarily constitute generic use, the district court did not err when it refused to frame its inquiry as whether the relevant public primarily uses the word “google” as a verb. Moreover, the district court correctly 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 in particular. We therefore evaluate Elliott’s claim of genericide and the sufficiency of his proffered evidence under the proper inquiry.

must offer evidence to support a finding of generic use. *See* McCarthy § 12:8 (“The fact that buyers or users often call for or order a product by a [trademark] term does not necessarily prove that that term is being used as a ‘generic name.’”).

B.

Elliott next argues that the district court must have impermissibly weighed the evidence when it granted summary judgment for Google in light of the “sheer quantity” of evidence that Elliott produced to support his claim of genericide. *See Jesinger v. Nev. Fed. Credit Union*, 24 F.3d 1127, 1131 (9th Cir. 1994) (noting that a court “must not weigh the evidence” at summary judgment). We disagree. Instead, we conclude that Elliott’s admissible evidence is largely inapposite to the relevant inquiry under the primary significance test because Elliott ignores the fact that a claim of genericide must relate to a particular type of good or service.

A party applying for cancellation of a registered trademark bears the burden of proving genericide by a preponderance of the evidence. *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 684 F.2d 1316, 1319 (9th Cir. 1982). Moreover, the holder of a registered trademark benefits from a presumption of validity and has “met its [initial] burden of demonstrating” the lack of “a genuine issue of material fact” regarding genericide. *Coca-Cola Co.*, 692 F.2d at 1254. Therefore, in light of the relevant inquiry under the primary significance test, Elliott was required to identify sufficient evidence to support a jury finding 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.

At summary judgment, the district court assumed that a majority of the public uses the verb “google” to refer to the act of “searching on the internet without

regard to [the] search engine used.”⁴ In other words, it assumed that a majority of the public uses the verb “google” in a generic and indiscriminate sense. The district court then concluded that this fact, on its own, cannot support a jury finding of genericide under the primary significance test. We agree.

As explained above, a claim of genericide must relate to a particular type of good. Even if we assume that the public uses the verb “google” in a generic and indiscriminate sense, this tells us nothing about how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines. As explained below, we also agree that Elliott’s admissible evidence only supports the favorable but insufficient inference already drawn by the district court—that a majority of the public uses the verb “google” in a generic sense. Standing in isolation,⁵ this fact is insufficient to support a jury finding of genericide. The district court therefore properly granted summary judgment for Google.

We begin with Elliott’s three consumer surveys. Consumer surveys may be used to support a claim of

⁴ In making this assumption, the district court drew a favorable (and generous) inference for Elliott. As discussed above, verb use does not necessarily constitute generic use, yet most of Elliott’s proffered evidence relies on that theory.

⁵ Contrary to our colleague’s suggestion, we do not hold that generic verb use is “categorically irrelevant.” However, evidence that a mark is used in a generic sense in one particular setting cannot support a finding of genericide when it is unaccompanied by evidence regarding the primary significance of the mark as a whole.

genericide “so long as they are conducted according to accepted principles.” *Stuhlbarg Int’l Sales Co. v. John D. Brush & Co.*, 240 F.3d 832, 840 (9th Cir. 2001). Here, the district court properly excluded two of Elliott’s consumer surveys because they were not conducted according to accepted principles. Specifically, these surveys were designed and conducted by Elliott’s counsel, who is not qualified to design or interpret surveys. *See* Federal Judicial Center, Reference Manual on Scientific Evidence 364 (3d ed. 2011) (explaining that valid survey design typically requires graduate training or professional experience in survey research).⁶

The district court properly considered only Elliott’s third survey, which was conducted by James Berger—a qualified survey expert. Elliott’s third survey is a “Thermos” survey, which generally “puts the respondent in an imaginary situation . . . and asks how the respondent would ask” for the type of good for which the trademark is alleged to be generic. McCarthy § 12:15 (citing *Am. Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9, 21–22 (D. Conn. 1962), *aff’d*, 321 F.2d 577 (2d Cir. 1963)). Here, Berger asked 251 respondents: “If you were going to ask a friend to search for something on the Internet, what word or phrase would you use to tell him/her what you want him/her to do?” Over half of the 251 respondents

⁶ The district court also correctly noted that, if the surveys were admitted, Elliott’s counsel would need to withdraw in order to offer testimony on the survey results. *See* Ariz. R. Sup. Ct. 42, E.R. 3.7 (“A lawyer shall not act as advocate at a trial in which the lawyer is likely to be a necessary witness . . .”).

answered this question by using the word “google” as a verb.

Although verb use does not automatically constitute generic use, the district court allowed Berger to rely on the third survey to offer his expert “opinion that a majority of the public uses the word google as a [generic and indiscriminate] verb to mean search on the internet.” In this way, Elliott’s admissible consumer survey evidence goes no further than supporting the favorable inference already drawn by the district court.⁷

We next consider Elliott’s examples of alleged generic use by the media and by consumers. Documented examples of generic use might support a claim of genericide if they reveal a prevailing public consensus regarding the primary significance of a registered trademark. *See* McCarthy § 12:13

⁷ The district court also considered a fourth survey. Although Google already benefits from a presumption against genericide, *see Coca-Cola Co.*, 692 F.2d at 1254, Google offered a “Teflon” survey to prove that the GOOGLE mark is not generic. A Teflon survey begins with a brief lesson explaining the difference between brand names and common names. It then asks respondents to classify a series of words, including the trademark at issue, as either brand names or common names. *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 526–27 (E.D.N.Y. 1975). In response to Google’s Teflon survey, a little over 93% of respondents classified “Google” as a brand name. Most respondents also classified “Coke,” “Jello,” “Amazon,” and “Yahoo!” as brand names, and classified “Refrigerator,” “Margarine,” “Browser,” and “Website” as common names. Unlike Elliott’s Thermos survey, Google’s Teflon survey offers comparative evidence as to how consumers primarily understand the word “google” irrespective of its grammatical function.

(explaining that generic use by the media is a “strong indication of the general public’s perception”) (quoting *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989)). However, if the parties offer competing examples of both generic and trademark use, this source of evidence is typically insufficient to prove genericide. *See id.*

Initially, we note that Elliott’s admissible examples are only examples of verb use. To repeat, verb use does not automatically constitute generic use. For instance, Elliott purports to offer an example of generic use by T-Pain, a popular rap music artist. But we will not assume that T-Pain is using the word “google” in a generic sense simply because he tells listeners to “google [his] name.” T-Pain, *Bottlez*, on rEVOLVER (RCA Records 2011). Without further evidence regarding T-Pain’s inner thought process, we cannot tell whether he is using “google” in a discriminate or indiscriminate sense. In this way, many of Elliott’s admissible examples do not even support the favorable inference that a majority of the relevant public uses the verb “google” in a generic sense.

Elliott also attempted to offer clear examples of indiscriminate verb use by the media and by consumers. For example, in response to Google’s motion for summary judgment, he produced a transcript from an episode of a German television show in which a character claims to have “googled at Wikipedia.” Elliott also produced examples in which the media uses phrases like “googled on ebay,” “googled on facebook,” and “googled on pinterest.” Finally, Elliott produced evidence suggesting that certain consumers claimed that they accessed a website by “googling” it, even

though those consumers actually accessed the website through a non-Google search engine.

The district court properly excluded these examples of indiscriminate verb use because they were not disclosed during discovery and because Elliott failed to show that his delay was “substantially justified or . . . harmless.” Fed. R. Civ. P. 37(c)(1); *see also Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 2001) (“[W]e give particularly wide latitude to the district court’s discretion to issue [discovery] sanctions”). Moreover, even if these examples had been timely disclosed, they are largely irrelevant because they only support the favorable inference already drawn by the district court.

We next consider Elliott’s proffered expert testimony. Each of Elliott’s experts, including Dr. Berger, Dr. Patrick Farrell, and Dr. Allan Metcalf, opine that the word “google” is used in a generic sense when it is used as a verb.⁸ On its face, this testimony simply supports the favorable inference already drawn by the district court.

Next, we consider Elliott’s proffered dictionary evidence. *See* McCarthy § 12:13 (noting that dictionary definitions are “sometimes persuasive in determining public usage”). Elliott does not present any examples

⁸ Elliott does not argue that these reports have any relevance beyond showing generic verb use. Instead, Elliott attacks the credibility of Google’s expert, Dr. Nunberg, and claims that the jury should be allowed to evaluate his credibility. Elliott cannot carry his burden of proof by attacking the credibility of Google’s experts. Moreover, the district court properly rejected Elliott’s attacks on Dr. Nunberg as unsubstantiated.

where “google” is defined as a generic name for internet search engines. Instead, Elliott presents secondary definitions where google is defined as a verb. *See, e.g., Google, Collins English Dictionary.com*, <https://www.collinsdictionary.com/dictionary/english/google> (last visited Apr. 15, 2017) (defining google primarily as a “trademark” but secondarily as a verb meaning “to search for (something on the internet) using a search engine”); *Google, Dictionary.com*, <http://dictionary.reference.com/browse/google> (last visited Apr. 15, 2017) (defining google primarily as the “brand name of a leading Internet search engine” but secondarily as a verb meaning “to search the Internet for information about [something]”). Once again, Elliott’s proffered dictionary evidence only supports the favorable inference already drawn by the district court.⁹

Next, we consider Elliott’s claim that Google has used its own trademark in a generic sense. Generic use of a mark by the holder of that mark can support a finding of genericide. *See* McCarthy § 12:13. However, Elliott has not presented an example of generic use by Google. Instead, Elliott has presented an email from Google cofounder Larry Page, which encourages recipients to “[h]ave fun and keep googling!” Once

⁹ Elliott argues that these dictionaries only refer to the GOOGLE trademark because Google threatened to take legal action if the companies refused to acknowledge its registration. Contrary to Elliott’s assumption, Google’s policing activities weigh against finding genericide. *See, e.g., Filipino Yellow Pages, Inc.*, 198 F.3d at 1151 (affirming lower court’s reliance on plaintiff’s lack of trademark policing as evidence that mark had become generic); *King-Seeley Thermos Co. v. Alladin Indus.*, 321 F.2d 577, 579 (2d Cir. 1963) (same).

again, Elliott relies on an example of verb use. Elliott has not shown, nor is it likely that he could show, that the cofounder of Google had no particular search engine in mind when he told recipients of the “Google Friends Newsletter” to “keep googling.”¹⁰

Finally, we consider 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. Once again, a claim of genericide must relate to a particular type of good or service. In order to show that there is no efficient alternative for the word “google” as a generic term, Elliott must show that there is no way to describe “internet search engines” without calling them “googles.” Because not a single competitor calls its search engine “a google,” and because members of the consuming public recognize and refer to different “internet search engines,” Elliott has not shown that there is no available substitute for the word “google” as a generic term. *Compare, e.g., Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J. 1952) (concluding that “medical swab” and “cotton-tipped applicator” are efficient alternatives for Q-Tips); *with Bayer Co.*, 272 F. at 505 (concluding that there is no efficient substitute for the generic term “aspirin” because consumers do not know the term “acetyl salicylic acid”); *see also Softbelly’s Inc.*, 353 F.3d at 531 (explaining that genericide does not typically occur “until the trademark has gone so far toward

¹⁰ Elliott also argues that the email shows generic use because “googling” is not capitalized. As we explained with regard to verb use and noun use, we cannot rely on grammatical formalism to determine what a speaker has in mind when using a registered trademark. *See Coca-Cola Co.*, 692 F.2d at 1255.

becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name”).

Elliott cannot survive summary judgment based on “sheer quantity” of irrelevant evidence. We agree with the district court that, at best, Elliott has presented admissible evidence to support the inference that a majority of the relevant public uses the verb “google” in a generic sense. Because this fact alone cannot support a claim of genericide, the district court properly granted summary judgment for Google.

III.

The district court did not misapply the primary significance test, nor did it weigh the evidence when it granted summary judgment for Google. We agree that Elliott has 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 and not as a mark identifying the Google search engine in particular. We therefore affirm the district court’s grant of summary judgment.

Costs shall be taxed against Elliott. *See* Fed. R. App. P. 39(a)(2).

AFFIRMED.

WATFORD, Circuit Judge, concurring:

I join the court’s well-reasoned opinion with one caveat. To resolve this appeal, we need not decide whether evidence of a trademark’s “indiscriminate” verb use could ever tell us something about whether

the public primarily thinks of the mark as the generic name for a type of good or service. *Maj. op.* at 13–14. To the extent the court’s opinion can be read as taking a position on that question, I decline to join that aspect of its reasoning.

We don’t need to resolve whether evidence of indiscriminate verb use is categorically irrelevant in an action alleging that a trademark has become generic because, on this record, no rational jury could find in the plaintiffs’ favor even taking into account the flimsy evidence of indiscriminate verb use they produced. In support of its motion for summary judgment, Google produced overwhelming evidence that the public primarily understands the word “Google” as a trademark for its own search engine, not the name for search engines generally. In Google’s consumer survey, 93% of respondents identified “Google” as a brand name, rather than a common name for search engines. In every dictionary in the record, the first entry for “Google” or “google” refers to Google’s search engine. Google extracted concessions from the plaintiffs’ expert linguists that Google functions as a trademark for Google’s search engine. Google also submitted evidence showing that it uses its trademark to refer only to its own search engine, that it polices infringement by others, and that its competitors refrain from using the trademark to refer to their own search engines. Finally, Google offered evidence showing that major media outlets use “Google” to refer exclusively to Google’s search engine.

In response, the plaintiffs produced thousands of pages of largely irrelevant evidence showing merely that “google” is sometimes used as a verb. The sliver of

potentially relevant evidence purporting to show that the public uses the verb “google” to refer to searching the Internet with any search engine (as opposed to Google’s search engine in particular) is too insubstantial to save the plaintiffs’ case. For example, the plaintiffs point to their Thermos survey, in which respondents were asked what word or phrase they would use to ask a friend to search for something on the Internet. Most respondents answered either “google,” “google it,” “google something,” “google this,” “google search,” or “bring up google.” However, those answers share the same problem that the court identifies with almost all of the plaintiffs’ evidence, such as the rapper T-Pain’s lyric telling his listeners to “google my name.” That is, without more context, we simply can’t tell whether the survey respondents were referring to searching the Internet with Google’s search engine or with any search engine generally.

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.

There may never be a case that turns on evidence that a trademark is commonly used as a verb to refer to use of a type of good or service, as opposed to use of the particular product for which the trademark is registered. But if such a case were to arise, it's not obvious to me that a jury should be foreclosed from relying on the way the public uses the word as a verb to decide whether the public also thinks of the mark as the generic name for the type of good or service. The way we use words as verbs is often related to how we use those words as adjectives or nouns, such that evidence of indiscriminate verb use could potentially be relevant in deciding whether a trademark has become the generic name for a type of good or service. To the extent the court's opinion can be read to foreclose the consideration of such evidence as a matter of law, I decline to join it.

APPENDIX B

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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA**

No. CV-12-1072-PHX-SMM

[Filed September 11, 2014]

David Elliot and Chris Gillespie,)
)
 Plaintiffs,)
)
 v.)
)
 Google Incorporated,)
)
 Defendant.)
)
 Google Incorporated,)
)
 Counter-Claimant,)
)
 v.)
)
 David Elliot and Chris Gillespie,)
)
 Counter-Defendants,)
)

**AMENDED MEMORANDUM OF DECISION
AND ORDER**

Before the Court are Plaintiffs David Elliot's ("Elliot") and Chris Gillespie's ("Gillespie") (collectively "Plaintiffs") and Defendant Google Incorporated's ("Defendant") fully briefed cross-motions for summary judgment. (Docs. 67; 73; 83; 86; 111; 112.) For the reasons that follow, Plaintiffs' motion is denied and Defendant's motion is granted.¹

BACKGROUND

The following facts are undisputed unless otherwise noted. This case concerns two United States registrations of the GOOGLE mark: Number 2884502 (the " '502 Mark") and Number 2806075 (the " '075 Mark"). The '502 Mark covers "computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources." (Docs. 68 ¶ 18; 87 ¶ 18.) The '075 Mark covers, *inter alia*:

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

¹ The parties' requests for oral argument are denied because there was adequate opportunity to present written argument and oral argument will not aid the Court's decision. Fed. R. Civ. P. 78(b); LRCiv. 7.2(f); Partridge v. Reich, 141 F.3d 920, 926 (9th Cir. 1998).

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.

(Docs. 68 ¶ 19; 87 ¶ 19.) It is undisputed that the ‘502 and ‘075 GOOGLE marks refer to the eponymous search engine service provided by Defendant (the “Google search engine”).

During a two-week period ending on March 10, 2012, Plaintiffs used a domain name registrar to acquire 763 domain names that combined the word “google” with another brand, *e.g.*, googledisney.com, a person, *e.g.*, googlebarackobama.net, a place, *e.g.*, googlemexicocity.com, or with some generic term, *e.g.*, googlenewtvs.com (the “Domain Names”). (Docs. 68 ¶ 22; 70-6 at 2-8; 87 ¶ 22.) Defendant promptly filed a complaint requesting transfer of the Domain Names pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) incorporated into the domain name registrar’s Terms of Use. (Docs. 68 ¶¶ 25-27; 70-3 at 2.) Responding to Defendant’s arbitration complaint, Gillespie asserted, *inter alia*, that the GOOGLE mark has become generic and that he should be permitted to use the Domain Names incorporating the GOOGLE mark in furtherance of his business plans.²

² Gillespie also filed a petition with the U.S. Trademark Trial and Appeal Board (“TTAB”) requesting cancellation of the ‘502 Mark and the ‘075 Mark contending that the GOOGLE mark has become generic. (Docs. 68 ¶¶ 28-29; 87 ¶¶ 28-29.) The TTAB proceedings have been stayed pending resolution of this case.

(Docs. 68 ¶ 33; 87 ¶ 33.) The UDRP panel ordered the Domain Names be transferred to Defendant because: the Domain Names are confusingly similar to the GOOGLE mark; Gillespie has no rights or legitimate interests in the Domain Names; and the Domain Names were registered and used in bad faith.³ (Docs. 68 ¶¶ 34-35; 87 ¶¶ 34-35.)

Elliot then instituted the present action by filing a complaint (Doc. 1), which was amended to include Gillespie as a Plaintiff (Doc. 25), seeking cancellation of both the ‘502 and ‘075 marks and a declaration of the same. Defendant’s answer alleged counterclaims for trademark dilution, cybersquatting, and unjust enrichment under the Lanham Act, as well as counterclaims for unfair competition and false advertising under California state law. (Doc. 28.) After completing discovery, the parties filed cross-motions for summary judgment on the issue of whether the ‘502 and ‘075 Marks are invalid because they are generic.

STANDARD OF REVIEW

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a).

³ Although Plaintiffs object to facts concerning the UDRP proceeding on the basis of relevance, “[e]vidence which is essentially background in nature can scarcely be said to involve disputed matter, yet it is universally offered and admitted as an aid to understanding.” Fed. R. Evid. 401 advisory committee notes (1972). Plaintiffs’ hearsay objection fails because the evidence could be presented in admissible form at trial. See Fed. R. Civ. P. 56(c).

“[T]he substantive law will identify which facts are material[;] [o]nly disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.” Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). “One of the principal purposes of the summary judgment rule is to isolate and dispose of factually unsupported claims or defenses.” Celotex Corp. v. Catrett, 477 U.S. 317, 323-24 (1986) (further quotation omitted).

The movant bears the initial burden of proving the absence of a genuine issue of material fact. Id. at 323. For issues on which the movant would bear the burden of proof at trial, the initial summary judgment burden is met by marshaling the evidence to foreclose the possibility that a reasonable jury could find for the non-movant. Adickes v. S. H. Kress & Co., 398 U.S. 144, 157-58 (1970). Where the non-movant would bear the burden of proof at trial, the movant may carry its initial burden by proving the absence of evidence to support the non-movant’s case. Celotex, 477 U.S. at 325. If the movant carries its initial burden, the non-movant must designate “significantly probative” evidence capable of supporting a favorable verdict. Anderson, 477 U.S. at 249-50.

In determining whether either or both of these burdens have been carried, “[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in [that party’s] favor.” Id. at 255; see Narayan v. EGL, Inc., 616 F.3d 895, 899 (9th Cir. 2010) (explaining an inference is justifiable if it is rational or reasonable). “Credibility determinations, the weighing of the evidence, and the drawing of legitimate

inferences from the facts are jury functions, not those of a judge . . . ruling on a motion for summary judgment.” Anderson, 477 U.S. at 255.

ANALYSIS

Plaintiffs contend the GOOGLE mark has become generic because a majority of the public understands the word google, when used as a verb, to mean the indiscriminate act of searching on the internet without regard to the search engine used. Underlying Plaintiffs’ argument is the proposition that verbs, as a matter of law, are incapable of distinguishing one service from another, and can only refer to a category of services. Defendant contends there is no admissible evidence capable of supporting a finding that a significant portion, let alone a majority, of the consuming public does not principally understand the GOOGLE mark to identify a distinct product, regardless of how the mark is employed grammatically.

In ruling on Plaintiffs’ motion, the Court accepts as true Defendant’s admissible evidence and draws all reasonable inferences in Defendant’s favor; in ruling on Defendant’s motion, the Court accepts as true Plaintiffs’ admissible evidence and draws all reasonable inferences in Plaintiffs’ favor. The Court first resolves the chief legal disagreement between the parties (whether verb use of a mark necessarily renders the mark generic) and the admissibility of expert evidence before proceeding to the ultimate issue of whether either party is entitled to summary judgment on whether the GOOGLE mark has become generic.

I. Grammatical Function and Genericness

A mark is subject to cancellation if it “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” 15 U.S.C. § 1064(3); accord Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985). “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.” 15 U.S.C. § 1064(3). Under the primary-significance test, a mark is not generic when “the primary significance of the term in the minds of the consuming public is not the product but the producer.” Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 118 (1938); see Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921) (“What do the buyers understand by the word for whose use the parties are contending?”). “[I]f 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.” Rudolph Int’l, Inc. v. Realys, Inc., 482 F.3d 1195, 1198 (9th Cir. 2007) (quoting Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc., 198 F.3d 1143, 1147 (9th Cir. 1999)).

The crux of Plaintiffs’ argument is the premise “a trademark ceases to function as such when it is used primarily as a verb.” (Doc. 111 at 2) (emphasis omitted). This premise is flawed: a trademark performs its statutory function so long as it distinguishes a product or service from those of others and indicates the product’s or service’s source. See 15 U.S.C. § 1127. Verb use of a trademark is not fundamentally

incapable of identifying a producer or denoting source. A mark can be used as a verb in a discriminate sense so as to refer to an activity with a particular product or service, *e.g.*, “I will PHOTOSHOP the image” could mean the act of manipulating an image by using the trademarked Photoshop graphics editing software developed and sold by Adobe Systems. This discriminate mark-as-verb usage clearly performs the statutory source-denoting function of a trademark.

However, a mark can also be used as a verb in an indiscriminate sense so as to refer to a category of activity in general, *e.g.*, “I will PHOTOSHOP the image” could be understood to mean image manipulation by using graphics editing software other than Adobe Photoshop. This use commandeers PHOTOSHOP to refer to something besides Adobe’s trademarked product. Such indiscriminate mark-as-verb usage does not perform the statutory trademark function; instead, it functions as a synecdoche describing both a particular species of activity (*e.g.* using Adobe’s PHOTOSHOP brand software) and the genus of services to which the species belongs (*e.g.* using image manipulation software in general).

It cannot be understated that a mark is not rendered generic merely because the mark serves a synecdochian “dual function” of identifying a particular species of service while at the same time indicating the genus of services to which the species belongs. S. Rep. No. 98-627,⁴ at 5 (1984), reprinted in 1984

⁴ Report of the Senate Committee on the Judiciary regarding the Trademark Clarification Act of 1984, Pub. L. No. 98-620, §§ 102-03,

U.S.C.C.A.N. 5718, 5722 (explaining “dual function” use “is not conclusive of whether the mark is generic”); accord 15 U.S.C. § 1064(3) (“A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service.”). Nor is a mark “generic merely because it has *some significance* to the public as an indication of the nature or class of an article. . . . In order to become generic the *principal significance* of the word must be its indication of the nature or class of an article, rather than an indication of its origin.” Feathercombs, Inc. v. Solo Prods. Corp., 306 F.2d 251, 256 (2d Cir. 1962) (emphasis added). Moreover, “casual, non-purchasing uses of [marks] are not evidence of generic usage” because primary significance is determined by “the use and understanding of the [mark] in the context of purchasing decisions.’ ” 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 12:8 (4th ed. 2014) (quoting Restatement (Third) of Unfair Competition § 15 cmt. c (1995)) [hereinafter “McCarthy”].

“The salient question is the primary significance of the term to the consumer. If the term indicates a product of a single producer to the consumer, it is a valid trademark.” S. Rep. No. 98-627, at 5, reprinted in 1984 U.S.C.C.A.N. 5718, 5722. Thus, even if a mark *qua* verb is used exclusively in the indiscriminate sense, the mark is **not** generic if a majority of the consuming public nevertheless uses the mark *qua*

98 Stat. 3335, which adopted the primary-significance test by amending Sections 14(c) and 45 of the Lanham Act.

mark to differentiate one particular product or service from those offered by competitors.

A genericism inquiry guided by grammatical formalism is incompatible with the intent of the Lanham Act and its subsequent amendment by the Trademark Clarification Act. The twofold justification for the Lanham Act as stated by the Senate Committee on Patents was: (1) “to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get”; and (2) “where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.” S. Rep. 1333, at 1 (1946), reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1274.

The benefits derived from protecting trademarks include fostering market competition by enabling a consumer to distinguish competing articles from each other; and encouraging quality by “securing to the producer the benefit of the good reputation which excellence creates.” Id. at 2, reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1273. The same was true nearly 40 years later: “Because of their importance to our nation’s commerce, trademarks long have been protected from appropriation and misuse by others, both to protect the consumer from deception and confusion and to insure that producers are rewarded for their investment in the manufacture and marketing of their product.” S. Rep. No. 98-627, at 2, reprinted in 1984 U.S.C.C.A.N. 5718, 5719.

It is thus contrary to both the letter and spirit of trademark law to strip a mark of legal protection solely because the mark—cultivated by diligent marketing, enforcement, and quality control—has become so strong and widespread that the public adopts the mark to describe that act of using the class of products or services to which the mark belongs. As one scholar has stated, “top-of-mind use of a trademark in its verb form, far from indicating the mark’s generic status, may well indicate the enduring fame of the brand.” Laura A. Heymann, The Grammar of Trademarks, 14 Lewis & Clark L. Rev. 1313, 1348 (2010). This is especially true where the mark in question is arbitrary or fanciful because such terms had a different or no independent meaning before they were adopted as marks. See Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc., 618 F.3d 1025, 1032-33 (9th Cir. 2010) (explaining the strongest end of the trademark spectrum as arbitrary marks, which are “actual words with no connection to the product,” and fanciful marks, which are “made-up words with no discernable meaning”).

Plaintiffs’ argument that courts have already recognized a “dichotomy between verb usage and trademark usage” and that “[v]erb usage is therefore generic usage,” is unsupported. (Doc. 73 at 6, 8.) Plaintiffs cite two non-precedential TTAB cases denying initial registration of marks that sought to combine two common words (“tree” and “radar” for treeradar and “grind” and “brew” for “grind ‘n brew”) because the marks were conceptually weak

(generic/descriptive).⁵ See In re Grindmaster Corp., No. 77834762, 2011 WL 5600317, at *4 (TTAB Oct. 28, 2011) (noting the putative mark was merely equivalent to the concatenation of two verbs); In re TreeRadar, Inc., No. 77579817, 2011 WL 3212252, at *7 (TTAB July 15, 2011) (noting claimed trademark use and recognition was ambiguous partly because applicant used the putative mark as a generic verb “in one instance”). Plaintiffs also cite Freecycle sunnyvale v. Freecycle Network, Inc., No. C 06–00324 CW, 2006 WL 2827916, at *3 (N.D. Cal. Oct. 3, 2006), which held allegations of intentionally encouraging others to use an unregistered mark generically as part of an effort to render the mark generic and unregistrable were sufficient to state a cognizable claim for contributory infringement. Inasmuch as these cases are apposite and support the proposition that mark-as-verb use renders a previously distinctive mark generic, the Court finds them unpersuasive. If the primary significance of such a mark to a majority of the consuming public is to differentiate one service from the services of others, then the mark is not generic. This is true regardless of whether the public also uses the mark as an indiscriminate verb.

Plaintiffs’ reliance on a procrustean grammatical standard is misplaced. The dispositive inquiry is whether a majority of the consuming public considers the primary significance of the mark to be an indication of origin rather than an indication of nature and class. See Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1254 n.10 (9th Cir. 1982); King-Seeley Thermos Co. v.

⁵ See Fortune Dynamic, 618 F.3d at 1032-33.

Aladdin Indus., Inc., 321 F.2d 577, 580-81 (2d Cir. 1963). “The primary significance test does not, in and of itself, tell us how to differentiate a mere product brand from a product genus. . . . Once that question is decided, the resulting question often decides itself.” A.J. Canfield Co. v. Honickman, 808 F.2d 291, 301 (3d Cir. 1986).⁶ In this case, the relevant issue is whether the primary significance of the GOOGLE mark to a majority of the public who performs searches on the internet understands the mark to refer to the Google search engine as opposed to a descriptive term for search engines in general.

II. Expert Opinion Evidence

In the Ninth Circuit, “expert opinion is admissible and may defeat summary judgment if it appears the affiant is competent to give an expert opinion and the factual basis for the opinion is stated in the affidavit.” Walton v. United States Marshals Serv., 492 F.3d 998, 1008 (9th Cir. 2007) (alteration omitted) (quoting Bulthuis v. Rexall Corp., 789 F.2d 1315, 1318 (9th Cir.

⁶ “If some people regard the contested designation as a generic name, while others regard it as a mark, the term must be placed either in the ‘generic’ pigeonhole or in the ‘trademark’ category.” 2 McCarthy § 12:6. Some scholars have criticized this as a false dichotomy because trademarks “can perform a variety of informational functions—ranging from the provision of pure commercial or source-related information to the provision of pure generic or product-category information—at the same time.” Ralph H. Folsom & Larry L. Teply, Trademarked Generic Words, 89 Yale L.J. 1323, 1339 (1980). “A better approach to this problem would be to recognize that a finding of one primary significance may not be possible: in other words, that the hybrid character of many trademarked words may create pluralities or coextensive majorities.” Id. at 1351.

1985) (per curiam)). To be admissible, an expert's testimony must be relevant and have "a reliable basis in the knowledge and experience of [the relevant] discipline." Kumho Tire Co., Ltd. v. Carmichael, 526 U.S. 137, 149 (1999). "Expert opinion testimony is relevant if the knowledge underlying it has a valid connection to the pertinent inquiry. And it is reliable if the knowledge underlying it has a reliable basis in the knowledge and experience of the relevant discipline." Primiano v. Cook, 598 F.3d 558, 565 (9th Cir. 2010) (citations and internal quotation marks omitted).

"In a case involving scientific evidence, evidentiary reliability [is] based upon scientific validity." Daubert v. Merrell Dow Pharms., Inc., 509 U.S. 579, 590 n.9 (1993) (emphasis omitted). Scientific validity concerns the soundness of methodology rather than the correctness of conclusions. Estate of Barabin v. AstenJohnson, Inc., 740 F.3d 457, 463 (9th Cir. 2014) (en banc). "The reliability inquiry is 'a flexible one,' " id. (quoting Kumho Tire, 526 U.S. at 150), that considers whether the expert's testimony "is based on sufficient facts or data" and "is the product of reliable principles and methods," and whether the expert "reliably applied the principles and methods to the facts of the case," Fed. R. Evid. 702.

Both parties object to each others' expert reports regarding the primary significance of the GOOGLE mark in the minds of the consuming public.

A. Defendant's Expert Linguist

Defendant's expert linguist, Dr. Geoffrey Nunberg, opined about a linguistic phenomenon observed in some "highly distinctive and famous marks" where "the

name of a particular product is used to convey the genus without actually denoting it.” (Doc. 72-1 at 5.) Dr. Nunberg’s expert report explains:

Trademarks are sometimes used in extended or figurative ways to denote something independent of their proprietary meaning (cf Astroturf for political movements, Band-Aid for social remedies). In a special case of this process, trademarks may be used as verbs to denote the characteristic action associated with the product or service they represent. Examples include TiVo, Fed-Ex, Skype, and Google. Such verbs may be specific in their application . . . [b]ut such verbs may [also] be used in a representative way to connote a more general action. Thus when somebody says, “I need the book tomorrow—can you Fed Ex it to me?” we ordinarily assume that a shipment by UPS will be acceptable as well, without assuming that the verb to Fed-Ex simply means to ship by priority courier.

(Id. at 5-6.) Accordingly, Dr. Nunberg asserts that the use of the word google as a nonspecific verb does not compromise the status of the GOOGLE mark because it literally denotes the use of Google’s search engine. (Id. at 5-7.) Consistent with his report, Dr. Nunberg opined that the GOOGLE mark has not become generic and that the phrase “go google it” is not necessarily shorthand for “look it up on the internet.” (Doc. 70-9 at 3-4.)

Plaintiffs attack Dr. Nunberg as a “hired gun who will say anything he is paid to say” because he allegedly “reversed his opinion.” (Doc. 86 at 12.) While inconsistencies may be an indicator of reliability, see

Daubert, 509 U.S. at 590 n.9, Plaintiffs do not substantiate their allegation that Dr. Nunberg reversed his opinion. The fact that Dr. Nunberg first expressed interest in being retained by Plaintiffs before being subsequently retained by Defendant does not necessarily mean Dr. Nunberg gave inconsistent professional opinions. To the contrary, the only evidence in the record is Dr. Nunberg's testimony that Plaintiffs never retained, paid, or shared any confidential or work product information with him, that he never shared any of Plaintiffs' information with Defendant, and that while he may have shared ideas with Plaintiffs, the only expert opinion he rendered was the one contained in his report. (Doc. 113-3 at 3-5.)

Plaintiffs' unsubstantiated allegation of inconsistent opinions can be addressed on cross-examination. Plaintiffs' other objection, that Dr. Nunberg's "opinions are conclusions on the ultimate issues" (Doc 86 at 12), is misplaced. See Fed. R. Evid. 704(a) ("An opinion is not objectionable just because it embraces an ultimate issue."). As there is no serious contention that Dr. Nunberg lacked sufficient data, utilized unsound methods, or applied those methods unreliably, Dr. Nunberg's opinion is admissible.

B. Defendant's Consumer Survey Expert

Defendant's survey expert, Dr. Gerald Ford, conducted a consumer survey modeled after the one used in E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502 (E.D.N.Y. 1975), to prove that the primary significance of the TEFLON mark in the minds of consumers was DuPont's non-stick coating, rather than non-stick coatings in general. In Dr. Ford's "Teflon" survey, 420 randomly selected participants

were contacted via telephone and were asked whether “Hewlett Packard” and “computer” were brands names or common names. (Doc. 70-7 at 8-9.) All 420 respondents successfully identified “Hewlett Packard” as a brand name and “computer” as a common name. (Id.)

The respondents were then asked to identify six names (STP; Coke; Jello; refrigerator; margarine; aspirin) as either brand names or common names and were told that “don’t know” or “no opinion” was an acceptable answer. (Id. at 8-9.) They were not told that “both” was an acceptable answer, but answers of “both” were nevertheless recorded. (Id. at 9.) The respondents were subsequently asked to apply the brand name/common name distinction to another five names (browser; website; Amazon; Yahoo; Google) specifically with respect to searching on the internet. (Id.) Last, the respondents were asked whether they conducted searches on the internet—respondents who did not were excluded from the results. (Id.)

Excluding 19 respondents who answered they do not perform searches on the internet, 93.77% identified GOOGLE as a brand name and 5.25% identified GOOGLE as a common name. (Id. at 12.) For purposes of comparison, 93.52% of consumers identified the YAHOO! mark as a brand name while 5.99% identified YAHOO! as a common name. (Id.) Both GOOGLE and YAHOO! beat out COKE: 89.53% of consumers identified the COKE mark as a brand name while 6.73% identified COKE as a common name. (Id. at 11.) The only mark with higher brand name recognition or lower common name misrecognition than GOOGLE was the AMAZON mark at 96.51% and 2.99%, respectively. (Id. at 12.)

Even accounting for the 19 respondents who claimed they did not perform searches on the internet, the results “are projectable to all members of the defined universe at a 95% level of confidence with an estimated error of +/- 2.37%.” (Id. n.8.)

Plaintiffs’ sole objection is that the study is irrelevant because it does not account for verb usage, which is generic usage. (Doc. 86 at 9.) In support, Plaintiffs cite the Ninth Circuit’s criticism and rejection of Teflon style surveys in Anti-Monopoly, Inc. v. General Mills Fun Group, 684 F.2d 1316, 1323-24 (9th Cir. 1982). However, Congress passed the Trademark Clarification Act of 1984, Pub. L. No. 98-620, 98 Stat. 3335, for the express purpose of “overturn[ing] the reasoning in” and “rectif[ying] the confusion generated by Anti-Monopoly.” S. Rep. No. 98-627, at 8, reprinted in 1984 U.S.C.C.A.N. 5718, 5725. In particular, Congress sought to “clarify that a mark may have a ‘dual purpose’ of identifying goods and services and indicating the source of the goods and services.” Id.

Plaintiffs object that Dr. Ford’s survey is irrelevant because it “does not even address the verb issue” and “tests only whether the word ‘google’ when used as a noun, is a proprietary name or common name.” (Doc. 73 at 21) (emphasis omitted). Expert evidence is “relevant if the knowledge underlying it has a valid connection to the pertinent inquiry.” Primiano, 598 F.3d 558, 565 (quoting United States v. Sandoval-Mendoza, 472 F.3d 645, 654 (9th Cir. 2006)). The pertinent inquiry here is whether the primary significance of the GOOGLE mark to a majority of the consuming public (those who utilize internet search engines) is to indicate the Google

search engine in particular or to indicate the common descriptive term for search engines in general. Dr. Ford's survey is evidence that the significance of the GOOGLE mark "with respect to searching the internet" to an overwhelming majority of the consuming public (93.77%) is a particular brand name rather than a common name like "website" (identified as such by 97.76% of respondents). (Doc. 70-7 at 11-12.) Therefore, Dr. Ford's survey is relevant.

C. Plaintiffs' Counsel's Surveys

Plaintiffs' counsel, Richard Wirtz, designed and executed surveys using "Google Consumer Surveys" that asked respondents to select one of three answers to the prompt: "I most often use the word google to mean." (Docs. 75-16; 75-17.) The 1,033 responses for the first survey were: "to search something on the internet" (52.2%); "the name of a specific search engine" (28.7%); and "the internet (in general) (19.1%)." (Doc. 75-16.) The 1,007 responses for the second survey were "to search something on the internet" (72%); "the name of a company" (11.5%); and "the internet (in general)" (16.6%). (Doc. 75-17.) Plaintiffs cite these surveys as evidence that a majority of the consuming public predominantly uses the word "google" as an indiscriminate verb meaning to search on the internet. (Doc. 84 ¶ 23.)

Defendant's objection is that these surveys, and others designed and executed by Mr. Wirtz,⁷ are

⁷ The additional surveys asked similar questions (e.g. "What does Google primarily mean to you"; "what is a synonym for search engine"; and "what does 'google it' mean"), and were not submitted as separate exhibits. Rather, they were included only as part of

inadmissible because they are irrelevant, unreliable, and that Mr. Wirtz is not qualified to render an opinion about the meaning of such surveys. (Docs. 78 at 6 n.3; 83 at 8.) Defendant argues that the Wirtz's surveys are fundamentally flawed because they did not permit respondents to answer that the word google meant "to search for information using the Google search engine." (Doc. 83 at 9.) Defendant further argues that the fact that Mr. Wirtz represents Plaintiffs renders the Wirtz surveys inadmissible. (Id.)

To be admissible, a survey must be "conducted in accordance with generally accepted survey principles." Federal Judicial Center, Reference Manual on Scientific Evidence 364 (3d ed. 2011) [hereinafter "FJC, Scientific Evidence"]; see Fed. R. Evid. 703. "An assessment of the precision of sample estimates and an evaluation of the sources and magnitude of likely bias are required to distinguish methods that are acceptable from methods that are not." FJC, Scientific Evidence at 364 n.16. Thus, the survey expert "must demonstrate an understanding of foundational, current, and best practices in survey methodology, including sampling, instrument design . . . , and statistical analysis." Id. at 375.

Generally, valid survey design requires "graduate training in psychology (especially social, cognitive, or consumer psychology), sociology, political science, marketing, communication sciences, statistics, or a related discipline," but "professional experience in teaching or conducting and publishing survey research

Plaintiffs' consumer survey expert's report. (See Doc. 99-1 at 9-10, 54-69.)

may provide the requisite background.” Id. While counsel may be “involved in designing the questions to be asked, . . . it may be improper for an attorney to single handedly design a survey without professional assistance.” 6 McCarthy § 32:166. An expert who seeks to opine about the results of a survey that he or she did not personally conduct still must possess the requisite scientific background and familiarity with survey methodology. FJC, Scientific Evidence at 375-76.

There is no evidence the Wirtz surveys were conducted according to generally accepted principles. While Plaintiffs submitted demographic data for two Wirtz surveys (Doc. 111-2), there is no explanation of the methods of statistical analysis. Even if the statistical methods were included, there is no evidence regarding their reliability. Moreover, Mr. Wirtz does not have, nor does he claim to have, adequate training to design a survey or to interpret survey results. Neither Plaintiffs’ nor Defendant’s survey experts opined about the methodological validity of the Wirtz surveys. In fact, as explained below, Plaintiffs’ survey expert expressly disclaimed any knowledge about the design or execution of the Wirtz surveys. Dr. Nunberg, who is qualified to opine about designing survey questions about the meanings of words, testified that he thought the two main Wirtz surveys were “worthless” because asking “what does X mean to you” is “the vaguest possible question you can ask” and because the possible responses did not allow respondents to answer that the word “google” meant “to use the Google search engine.” (Doc. 85-2 at 3.)

Contrary to Plaintiffs’ argument that the Wirtz surveys are “court complaint” because Mr. Wirtz “did

no more than any other attorney working with a human surveyor to design an appropriate survey question,” Plaintiffs are seeking to qualify “Google Consumer Surveys” as an expert in survey design and Mr. Wirtz as an expert in survey interpretation. (Doc. 111 at 1, 6.) It is not clear whether the purported expert statistical analysis comes from “Google Consumer Surveys,” Mr. Wirtz, or both. If an actual expert had been provided with the methodological information necessary to opine about survey results, the expert could have opined that the Wirtz surveys “test[ed] whether majority usage of ‘google’ is as a verb or as a source indicator.” (*Id.*) However, such information is absent from the record and no expert so opined. Because neither the Wirtz surveys themselves nor the opinions Mr. Wirtz draws therefrom meet the threshold standard of reliability required by Federal Rules of Evidence, they are inadmissible. *E.g., Hodgdon Powder Co., Inc. v. Alliant Techsystems, Inc.*, 512 F. Supp. 2d 1178 (D. Kan. 2007) (excluding survey partly because “[n]othing in the record suggests that plaintiff’s counsel has any experience with designing or conducting market surveys”). Even if the surveys were admissible, their introduction at trial would require the testimony of Mr. Wirtz, which would preclude him from acting as an advocate. *See Ariz. R. Sup. Ct. 42, ER 3.7; LRCiv 83.2(e).*

D. Plaintiffs’ Consumer Survey Expert

Plaintiffs’ consumer survey expert, James Berger, conducted a substantially modified version of the survey used in *Am. Thermos Prods. Co. v. Aladdin Industries, Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d*, 321 F.2d 577 (2d Cir. 1963), to prove that the word

thermos had become the common descriptive name for vacuum bottles. The purpose of Mr. Berger's "Thermos" survey was to test "if people who access the internet at least once a week regard GOOGLE in its verb form to be generic rather than a brand name." (Doc. 99-1 at 6.) Mr. Berger opined that while the Teflon protocol is more commonly used, the "Thermos" protocol was selected because it allowed testing of the verb form of a mark. (Id. at 7.)

In Mr. Berger's Thermos survey, 251 respondents were asked a series of screening questions before they were asked: "If you were going to ask a friend to search for something on the Internet, what word or phrase would you use to tell him/her what you want him/her to do?" (Id. at 8.) Slightly over half of the validated respondents' answers (129 of them) contained the word google. (Id. at 9-10.) Mr. Berger opined that the survey results "proved beyond any doubt that the primary significance [*sic*] 'google' to the relevant public when used as a verb is generic and commonly used to mean search on the internet." (Id. at 9, 11.)

Defendant objects to the objectivity, reliability, and relevance of Mr. Berger's survey. Mr. Berger testified in his deposition that the survey was designed to prove something that Plaintiffs wanted to prove. (Doc. 70-8 at 5.) Further, Mr. Berger testified that his survey did nothing to test whether consumers understand that the GOOGLE mark *qua* mark refers to one company (id. at 6), and that it was not important to ask respondents about their understanding of the word google (id. at 9). In fact, Mr. Berger stated that his survey tested neither the primary significance of the term Google to consumers nor whether the term was generic with

respect to search engine hardware and software that are the subject of the '502 and '075 Marks. (Id. at 10-12.) While Mr. Berger was aware that Thermos style surveys ordinarily ask several questions, his survey asked only one substantive question. (Id. at 7.) Mr. Berger conceded that he was not aware of any other Thermos style survey in which only one substantive question was posed, nor was he aware of a court ever accepting such a survey. (Id. at 7-8.) Moreover, Mr. Berger testified that he was not aware of any treatises or articles that endorse the use of a single substantive question Thermos style survey. (Id. at 10.)

Mr. Berger noted the results of his survey were similar to the results of the Wirtz surveys. (Id. at 8, 13-15.) Defendant objects to the reliability of the Wirtz surveys referenced in Mr. Berger's report. An expert who seeks to opine about the results of a survey that he or she did not personally conduct should demonstrate familiarity with the survey methodology including target population, sampling design, and survey design, as well as rates and patterns of missing data and statistical analyses used to interpret results. FJC, Scientific Evidence at 375-76. As explained above, information about the methodology and statistical analyses of the Wirtz surveys is absent from the record—Mr. Berger did not claim to know such information nor was it included in his report.

It is undisputed that the Wirtz surveys were conducted before Mr. Berger was retained as an expert and that he was not involved in any way and had no knowledge about the developing or execution of those surveys. (Doc. 70-8 at 13-15.) Mr. Berger further testified that he “reviewed the questions that were

included in the surveys . . . only in the context of putting them in his report.” (*Id.* at 15.) Mr. Berger did not testify that such surveys are the type of evidence that consumer survey experts ordinarily rely upon.

The Court finds that Mr. Berger’s expert opinion partially admissible. Mr. Berger lacked sufficient methodological familiarity with the Wirtz surveys to reliably opine about their meaning and did not claim that the Wirtz surveys were methodologically reliable. To the extent that Mr. Berger opines about the results of the Wirtz surveys, his opinion is inadmissible. However, Mr. Berger designed, conducted, and interpreted a survey that provides him with data to opine about whether and how the word google is used as a verb. That there is no authority endorsing or accepting his one-substantive-question Thermos style survey pushes the boundaries of reliability, but not past the threshold of inadmissible “junk science.” Thus, Mr. Berger’s opinion that a majority of the public uses the word google as a verb to mean search on the internet, and only that opinion, is admissible. It bears repeating, however, that this is not the dispositive issue. The dispositive issue is whether the *primary* significance of the GOOGLE mark to a majority of the consuming public is an indication of search engines in general—a matter that Mr. Berger is not qualified to opine upon.

III. Primary Significance of the Google Mark to the Consuming Public

“A party moving for summary judgment is entitled to the benefit of any relevant presumptions that support the motion.” *Coca-Cola Co.*, 692 F.2d at 1254. “Federal registration of a trademark endows it with a

strong presumption of validity. The general presumption of validity resulting from federal registration includes the specific presumption that the trademark is not generic.” KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 408 F.3d 596, 604 (9th Cir. 2005) (quoting Overland, Inc., 692 F.2d at 1254). It is undisputed that both the ‘502 and ‘075 marks are registered and incontestable pursuant to 15 U.S.C. §§ 1058, 1065.

While Plaintiffs’ dispute the validity of these registrations on the basis they are generic, the fact that the marks are indeed registered means that Plaintiffs bear the burden of proving at trial that the marks are generic. See Filipino Yellow Pages, 198 F.3d at 1146. A second consequence of the registrations is that Defendant “has met its [initial] burden of demonstrating that the genericness of the trademark [GOOGLE] does not raise a genuine issue of material fact.” Overland, Inc., 692 F.2d at 1254. Thus, to survive Defendant’s motion, Plaintiffs must designate specific facts from which a jury could find that the GOOGLE mark is generic. See id. If Plaintiffs cannot come forward with such evidence even when given the benefit of the doubt, then Plaintiffs necessarily cannot satisfy the more demanding standard of showing that the evidence, when viewed most favorably to Defendant, cannot support a finding that the Google mark is not generic.

There are various forms of evidence that courts have found relevant to the primary significance inquiry, including: dictionary usage; mark-holder usage; competitor usage; media usage; and consumer

surveys.⁸ See 2 McCarthy § 12:13 to :14. Contrary to Plaintiffs' inflexible insistence on framing the matter as grammatical logomachy, whether the GOOGLE mark is generic depends on whether its primary significance to a majority of the public is a designation of search engines in general. Thus, Plaintiffs' many relevancy objections are misplaced: evidence is relevant if it has any tendency to make a fact of consequence in determining the public's understanding of the GOOGLE mark more or less probable. See Fed. R. Evid. 401.

As to dictionary usage, Plaintiffs are unable to cite to a single dictionary whose definition of the word "google" neglects to mention the trademark significance of the term. Plaintiffs accuse Defendant of "intimidat[ing] [dictionaries] into submission" (Doc. 86 at 1), because Defendant enforces its mark. For example, Defendant asked the website wordspy.com to modify its definition of google as a discriminate verb ("To search for information on the Web, particularly by using the Google search engine") to "take into account

⁸ "The central inadequacy of the primary-significance test is that it is essentially binary in nature: it is premised on the assumption that a word must function discontinuously either as a trademark or as a product-category word." Folsom & Teply, supra note 6, at 1339. "If each consumer has a trade name awareness that lies somewhere on the continuum between total product class significance and total source distinguishing significance, then genericide evaluation should attempt to determine the degree to the side of the midpoint on which each consumer lies." Lee B. Burgunder, An Economic Approach to Trademark Genericism, 23 Am. Bus. L.J. 391, 406 (1985). No doubt, surveys could be constructed that would be more probative than are the Teflon and Thermos protocols regarding the *primary* significance of a word to a majority of the consuming public. See supra note 6.

the trademark status of Google.” (Doc. 87 ¶ 96.) Likewise, Plaintiffs contend that the Merriam-Webster dictionary “tempered its definition of google as a result of its fear of Defendant” because the publisher stated “we were trying to be as respectful as we possibly could be about Google’s trademark.” (Doc. 87 ¶ 105.) Plaintiffs also cite the opinions of both of their expert linguists in support of the proposition that the inclusion of a word in dictionaries means that the word carries generic usage. (*Id.* ¶¶ 100-01.) It is undisputed that both of Plaintiffs’ linguistic experts testified the GOOGLE mark serves to identify Google as the provider of its search engine services. (Docs. 68 ¶¶ 70-71; 87 ¶¶ 70-71.) Viewing the evidence⁹ in the light most favorable to Plaintiffs, it establishes the word google carries meaning as an indiscriminate verb.

Shifting to mark-holder usage, Plaintiffs emphasize that Google co-founder Larry Page stated on July 8, 1998, “Have fun and keep googling.” (Doc. 84 ¶ 2.) Plaintiffs also cite to the fact that entering the search query “define: google” into the Google search engine resulted in a verb definition of: “Use an internet search engine, particularly google.com.” (Doc. 70-5.) Plaintiffs argue that non-enforcement of a mark suggests it is generic (Doc. 86 at 11) and point to the fact that the GOOGLE mark is used in other domain names that Plaintiffs did not purchase (Doc. 73 at 19). However, it is undisputed that: Defendant uses the GOOGLE mark to identify the Google search engine in national

⁹ Plaintiffs’ assertions that dictionaries have been “intimidated into submission” and temper their definitions “out of [their] fear of Defendant” are scurrilous attacks unsupported by admissible evidence.

advertising campaigns; has policies in place that set strict standards for third party use of the mark; publishes rules and guidelines for use of the mark; and spends sizeable sums policing and enforcing its rights in the mark. (Docs. 68 ¶¶ 75-80; 87 ¶¶ 75-80.) While it is true that non-enforcement of a mark may be evidence the mark is generic, the undisputed facts make it unreasonable to infer that Defendant does not enforce its rights in the mark.

Plaintiffs' alternative argument is that Defendant's enforcement expenditures are "so proportionately low" to the estimated valuation of the GOOGLE mark (over \$113 billion) that "it constitutes abandonment of the mark." (*Id.*) Plaintiffs cite no authority in support of this proposition and the Court is aware of none. Plaintiffs' theory would diminish the economic value of a mark to the mark-holder by inflating enforcement costs according to some arbitrary fraction of mark valuation. See William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, 30 J.L. & Econ. 265, 295 (1987). Such a result is inconsistent with federal trademark law's goals of facilitating commerce by permitting consumers to make purchasing decisions based on mark-recognition and securing to mark-holders the benefits appurtenant to marks associated with quality products and services. The Court declines to countenance Plaintiffs' theory that failure to spend some fraction of estimated mark valuation in enforcement of the mark means the mark is generic. Thus, as with dictionary usage, mark-holder usage establishes at most that google-as-verb is sometimes used in the indiscriminate sense.

Moving next to how competitors use the mark, Plaintiffs provide no evidence that competitors use the GOOGLE mark in a non-trademark fashion. Plaintiffs assert that lack of competitors' use of the mark is irrelevant and that "[t]here is no doubt that they refrain from doing so for fear of the wrath of Defendant." (Doc. 86 at 16.) In support, Plaintiffs cite a footnote from the Second Circuit's decision in Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc., 874 F.2d 95, 101 n.2 (2d Cir. 1989), which noted competitors' non-use is not independently sufficient to prove non-genericness because enforcement of the mark might deter use. However, Murphy Door Bed Co. also acknowledged that competitors' non-use of a mark is nonetheless evidence the mark is not generic. Id. The Court agrees that non-use of a mark by competitors is indeed probative of genericism, albeit peripherally.

If competitors can accurately describe their products or services without using the mark in question, it suggests the mark is not generic. E.g., Salton Inc. v. Cornwall Corp., 477 F. Supp. 975, 986 (D. N.J. 1979) (considering whether being unable to use a mark to describe products substantially disadvantaged competitors). A corollary of this point is that the existence of a short and simple descriptive term for the genus to which the trademarked species belongs also evidences the mark in question as not generic. E.g., Q-Tips, Inc. v. Johnson & Johnson, 108 F. Supp. 845, 863 (1952) (distinguishing the trademarked product "Q-Tips" from the descriptive term for the type of goods "double tipped applicator"). In this case, "internet search engines" is the short and simple descriptive term for the genus to which the Google search engine belongs. It is undisputed that competing search engine

providers Yahoo! and Microsoft Bing routinely distinguish their search engine services from Google's search engine service in press releases and advertising campaigns. (Docs. 68 ¶¶ 66-69; 87 ¶¶ 66-69.) Thus, there is no evidence of competitors' usage capable of supporting the inference that the word google has become the common descriptive term for the category of services to which the Google search engine belongs: internet search engines.

As to media use, Plaintiffs contend that the media often uses the word google as an indiscriminate verb. Some of Plaintiffs' purported evidence of indiscriminate verb use is inadmissible because it was not timely disclosed.¹⁰ As Defendant points out, some of Plaintiffs' media evidence recognizes the trademark significance

¹⁰ Pursuant to Federal Rule of Civil Procedure 26(a)(3)(A)(iii), a party is required to provide the opposing party "an identification of each document or other exhibit" that the proponent "may present at trial." "If a party fails to provide information . . . as required by Rule 26(a) . . . , the party is not allowed to use that information . . . to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1). This sanction is "self-executing" and "automatic" so as to "provide[] a strong inducement for disclosure of material that the disclosing party would expect to use as evidence, whether at a trial, at a hearing, or on a motion, such as one under Rule 56." *Id.* advisory committee notes (1993).

Defendant objected that some of Plaintiffs' media evidence was not disclosed. (Doc. 112 at 8.) "The burden is on the proponent to show that the material is admissible as presented or to explain the admissible form that is anticipated" at trial. Fed. R. Civ. P. 56(c)(2) advisory committee notes (2010). Plaintiffs did not respond to Defendant's objection and it is not self-evident that the evidence is harmless or that its non-disclosure was substantially justified. The Court will not consider the untimely evidence. (Doc. 87 ¶¶ 91-94).

of the GOOGLE mark and that Plaintiffs have not designated a single instance in which a major media outlet has referred to a competing search engine as a “google.” Plaintiffs’ media evidence consists mostly of verb usage, some of which is followed by recognition of trademark significance. (Doc. 84 ¶¶ 11-17.) Like Plaintiffs’ other evidence, the media’s use of the word google establishes that it is sometimes used as verb to mean search on the internet.

Last, Plaintiffs’ consumer survey evidence, consistent with all the other relevant evidence, is that the word google is indeed used as a verb. Mr. Berger’s survey quantifies the proportion of society that understands google as a verb as 51%. While Mr. Berger’s survey did not test whether this majority understood google-as-verb in a discriminate or indiscriminate sense, Mr. Berger’s opinion allows the inference that a majority of the consuming public understands the word google—when used as a verb—to refer to the indiscriminate act of searching on the internet. However, the fact that a majority of the public understands a trademark as an indiscriminate verb is not dispositive on whether the mark is generic. The dispositive question is whether “the *primary significance* of the trademark is to describe the *type of product* rather than the *producer*.” Rudolph Int’l, 482 F.3d at 1198 (first emphasis added) (quoting Filipino Yellow Pages, 198 F.3d at 1147). It is undisputed that Mr. Berger’s survey did not test the primary significance of the word google and the Court has found Mr. Berger is not qualified to opine about matter. Therefore, Plaintiffs present no evidence that the primary significance of the word google to a majority of

the consuming public is a common descriptive term for search engines.

Summary

The Court is mindful that “summary judgment is generally disfavored in the trademark arena” due to “the intensely factual nature of trademark disputes.” Rudolph Int’l., 482 F.3d at 1199 n.3 (quoting KP Permanent Make-Up, Inc., 408 F.3d at 602). However, summary judgment is nevertheless appropriate when there is no genuine issue of material fact. Id. at 1199. Such is the case here.

The existence of a primary significance implies the existence of, at least, a secondary significance; depending on the trademarked term, there may also be tertiary and quaternary meanings. Congress has spoken with particular clarity and force on the issue of whether a registered trademark is subject to cancellation as generic because it has more than one significance: “A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service.” 15 U.S.C. § 1064(3). Therefore, as a matter of law, a mark is not generic only because it simultaneously signifies more than just the trademarked product.

The word google has four possible meanings in this case: (1) a trademark designating the Google search engine; (2) a verb referring to the act of searching on the internet using the Google search engine; (3) a verb referring to the act of searching on the internet using *any* search engine; and (4) a common descriptive term for search engines in general. The ‘502 and ‘075 marks

are subject to cancellation *only* if the fourth meaning is the *primary* significance of the word google to a majority of the consuming public.

Accepting Plaintiffs' evidence as true, 51% of those who utilize internet search engines use the word google as a verb to mean search on the internet. This establishes that the second and third meanings exist. Drawing all reasonable inferences in Plaintiffs' favor, a majority of the consuming public uses google-as-verb in its indiscriminate sense to mean search on the internet without regard to the search engine used. This means that the third meaning is more significant than the second meaning. Plaintiffs then make the leap, without any competent evidence, that the third meaning is the most *frequently* used meaning and seek cancellation of the '502 and '075 Marks because of the frequency with which the word google is used as a verb. This argument is factually and legally flawed. Factually, Plaintiffs offer no competent evidence in support of their assertion that verb use is more frequent than non-verb use. Legally, the test for whether a mark has become generic is not whether its most frequent use is as an indiscriminate verb, but whether its primary significance to a majority of the consuming public is as a common descriptive term. Even if the most frequent use of the word google is its third meaning, Plaintiffs' argument nevertheless fails because there is no evidence to suggest that the primary significance of the word google is the fourth meaning *because* the third meaning is most frequently used.

Plaintiffs' claim for trademark cancellation disappears when the admissible evidence in the record

is examined according to the laws enacted by Congress. It is undisputed that well over 90% of the consuming public understands the word google with respect to searching on the internet as designating not a common name, but a particular brand. (Doc. 68 ¶ 41.) This fact establishes that the first meaning (a trademark designating the Google search engine) is more significant than is the fourth meaning (a common descriptive term for search engines in general) to a vast majority of the consuming public. Therefore, the '502 and '075 marks are **not** subject to cancellation. This is true even though the Court accepts as true that the 51% of the public also understands the third meaning (a verb referring to the act of searching on the internet using *any* search engine)—it is undisputed that the first and third meanings are not mutually exclusive and, in fact, coexist. (Id. ¶¶ 70-71.)

For the cancellation claim to survive summary judgment, Plaintiffs needed to submit significantly probative evidence that the primary significance of the word google to a majority of the consuming public was a common descriptive term for search engines. Plaintiffs, at their peril, neglected their burden of proof under the primary significance test, instead electing to present evidence about whether a majority of the consuming public understood the word google as a verb. Disregarding primary significance resulted in an absolute failure of proof that is fatal to Plaintiffs' claim for genericide. The Court declines Plaintiffs' invitation to judicially legislate federal trademark law out its "dark ages" by side-stepping the statutory test for primary significance and holding that frequency of verb use is in and of itself sufficient to render a mark generic. (Doc. 111 at 1.)

Likewise, the Court declines to depart from settled Ninth Circuit jurisprudence holding that “[t]he question of genericness is often answered by reference to the ‘who-are-you/what-are-you’ test: a valid trademark answers the former question, whereas a generic product name or adjective answers the latter.” Rudolph Int’l, 482 F.3d at 1198. The undisputed evidence is that the consuming public overwhelmingly understands the word google to identify a particular search engine, not to describe search engines in general.

“[T]he record taken as a whole could not lead a rational trier of fact to find” that the primary significance of the word Google is not an indicator of the Google search engine but is an indicator of internet search engines in general. Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986). The fact that a bare majority of the consuming public also uses the word google as a generic verb to mean search on the internet does nothing “more than simply show that there is some metaphysical doubt as to the material facts.” Id. Plaintiffs cannot supplant the primary-significance test with a frequency-of-verb-use test to cancel the GOOGLE mark, which they admit refers to “one of the largest, most recognized, and widely used Internet search services in the world.” (Docs. 68 ¶ 2; 87 ¶ 2.)

CONCLUSION

Accepting Plaintiffs’ evidence as true and drawing all justifiable inferences therefrom in Plaintiffs’ favor, a majority of the public uses the word google as a verb to refer to searching on the internet without regard to search engine used. Giving Plaintiffs every reasonable

benefit, a majority of the public uses google-as-verb to refer to the act of searching on the internet and uses GOOGLE-as-mark to refer to Defendant's search engine. However, there is no genuine dispute about whether, with respect to searching on the internet, the primary significance of the word google to a majority of the public who utilize internet search engines is a designation of the Google search engine. Therefore, Defendant is entitled to judgment as a matter of law that the '075 and '502 Marks are not generic.

Accordingly,

IT IS HEREBY ORDERED denying Plaintiffs' motion for summary judgment. (Doc. 73.)

IT IS FURTHER ORDERED granting Defendant's motion for summary judgment. (Docs. 67; 78.)

IT IS FURTHER ORDERED that the Court will subsequently issue the Order Setting Final Pretrial Conference.

DATED this 10th day of September, 2014.

/s/Stephen M. McNamee
Stephen M. McNamee
Senior United States District Judge

APPENDIX C

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA**

NO. CV-12-01072-PHX-SMM

[Filed April 16, 2015]

David Elliott, et al.,)
)
Plaintiffs,)
)
v.)
)
Google Incorporated, et al.,)
)
Defendants.)

ORDER

Before the Court is the parties' Joint Stipulation Dismissing Counterclaims Without Prejudice. (Doc. 126.) Having met and conferred to narrow the issues in dispute, the parties have stipulated to a dismissal of Google's counterclaims. (Id.) Accordingly, good cause appearing,

IT IS HEREBY ORDERED granting the Joint Stipulation Dismissing Counterclaims Without Prejudice. (Doc. 126.) All of Google's counterclaims are dismissed without prejudice. This Order shall have no effect on the Plaintiff's anticipated appeal of this Court's Amended Memorandum of Decision and Order

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regarding the parties' respective Summary Judgment Motions.

IT IS FURTHER ORDERED that the Clerk of the Court shall enter judgment in favor of Defendants and terminate the action.

DATED this 16th of April, 2015.

s/_____
Honorable Stephen M. McNamee
Senior United States District Judge

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA**

NO. CV-12-01072-PHX-SMM

[Filed April 16, 2015]

David Elliott, et al.,)
)
Plaintiffs,)
)
v.)
)
Google Incorporated, et al.,)
)
Defendants.)
)

JUDGMENT IN A CIVIL CASE

Decision by Court. This action came for consideration before the Court. The issues have been considered and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that pursuant to the Court's Order filed April 16, 2015, judgment is entered in favor of defendant and against plaintiffs. Plaintiffs to take nothing, and the amended complaint and action are dismissed.

Brian D. Karth
District Court Executive/
Clerk of Court

April 16, 2015

By s/ Kathy Gerchar
Deputy Clerk