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CHRIS GILLESPIE and DAVID ELLIOTT

10 UNITED STATES DISTRICT COURT

11 DISTRICT OF ARIZONA

12
13 DAVID ELLIOTT, an Individual,
CHRIS GILLESPIE, an Individual,
14 Plaintiffs,
15 v.
16 GOOGLE, INC., a Delaware corporation,
17 Defendant.

Case Number: CV 12-1072-PHX-SRB

MEMORANDUM OF POINTS AND
AUTHORITIES IN OPPOSITION TO
DEFENDANT GOOGLE'S MOTION
FOR SUMMARY JUDGMENT ON
PLAINTIFF'S CLAIM FOR
DECLARATORY RELIEF

ORAL ARGUMENT REQUESTED

Judge: Hon. Steven McNamee

18
19
20 AND RELATED COUNTERCLAIMS
21

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1 I. INTRODUCTION

2 Defendant moves for summary judgment on the issue of the genericness of the
3 word "google." Defendant seeks to confuse the issue by providing evidence of non-
4 material facts and ignoring the relevant facts. The issue is the primary significance of
5 "google" to the public not the popularity of Defendant or its product. Defendant
6 introduces only evidence of its market share, a flawed survey, the opinion of a
7 lexicologist who admits that google when used as a verb bears no trademark significance,
8 and incomplete dictionary evidence from sources it has intimidated into submission.
9 Defendant does not introduce any evidence of how the public actually uses the word
10 google. For example, Defendant does not introduce evidence of trademark use of
11 "google" in books, magazines, or television shows.

12 Defendant ignores the context of this case. (1) Trademarks are protected by law
13 because they serve to identify and distinguish a seller's good or services and signify that
14 all bearing the mark are controlled by a single source and of equal quality. When the
15 service can only be utilized through a website, the URL serves this function. (2) This case
16 involves a new product in a developing industry. This is often the context of genericide
17 as the public turns to former trademarks to express a new idea. (3) This case involves a
18 use of a trademark as a verb¹. Considering this unique context, the overwhelming
19 evidence submitted by Plaintiff of genericness and Defendant's failure to introduce
20 evidence of non-genericness summary judgment is only appropriate—in Plaintiff's favor.

21 II. STATEMENT OF FACTS

22 The verb google is as old as the trademark and has ben included in print and
23 online dictionaries since 2003. (Separate Statement ¶ "SS" 81,82) The verb is frequently
24 used in television shows, movie, news, magazines, novels, and cartoons; google has
25 become a word root, and the root carries the verb meaning. SS 83 Thousands of domain
26

27 ¹Plaintiffs' Motion for Summary Judgment, which Plaintiff incorporates by
28 reference, discusses this issue of first impression in greater depth: can a verb ever
function as a trademark? Because the answer to this question is no, any verb usage of
a trademark is non-trademark usage.

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1 names offered for sale on GoDaddy's auction site incorporate the verb. SS 85 When
 2 chosen as word of the decade by the American Dialect Society, google was a verb. SS
 3 86 Defendant's own search engine, when asked to "define google" returns a definition
 4 of "google" (lower case) only as a verb. SS 87 When 1,033 members of the relevant
 5 public were asked "I most often use the word 'google' to mean:" 52.2% chose "to search
 6 something on the internet" (i.e. verb usage), while only 28.7% chose "the name of a
 7 specific search engine" (arguably trademark usage). SS 88 The remaining 19.1% chose
 8 "the Internet (in general)." SS 88 When another 1,007 respondent were asked to
 9 complete the same sentence and given slightly different answer choices, 72% chose "to
 10 search something on the internet," 16.6% chose "the Internet (in general)," and just
 11 11.5% chose "the name of a company." SS 89

12 Even assuming for the sake of argument that verb usage could still carry trademark
 13 significance (though that defies law and logic), the word google is generic. When asked:
 14 "If you were going to ask a friend to search for something on the Internet, what word or
 15 phrase would you use to tell him/her what you want him/her to do?" 129 of 252
 16 respondents used the word "google" in their response. Of those 129, 125 used the word
 17 generically (google/google it/google something/google this), while only 4 or 1.6% used
 18 the word in a manner clearly intended to refer to Defendant (Google search/Bring up
 19 google/go to google.com). SS 90

20 The public and the media use the word google in a non-specific way. In the
 21 episode "Deadly Towers" of the Television series "The Angry Video Game Nerd" a
 22 character says "...I googled it to check what it meant, and according to urban
 23 dictionary..." SS 91 In episode 3.5 of the German language show "Neues aus der Anstalt"
 24 a character says "I googled at wikipedia, and you said 'some Horst Kohler[.]'" SS 92

25 A quick google on Defendant's website shows that the phrase "googled on imdb"
 26 gets 5 results, "googled on pinterest" got 27 results, "googled on facebook" gets 41
 27 results, "googled on wikipedia" gets 136 results, and "googled on ebay" gets 407 results.
 28 SS 93 Exhibit 28 is fourteen different Proposal Request Forms submitted by actual people.

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1 SS 94 In these request forms, each respondent is asked "How did you hear about us?"
 2 and each of their responses use the word google. Ex 28 However, the program which
 3 generates these forms tracks the site from which the respondent was referred and each
 4 of these fourteen people came from search engines other than Defendant's. Ex 28

5 III. STANDARD

6 This Court may grant summary judgment if it finds that there is "no genuine
 7 dispute as to any material fact and that the movant is entitled to judgment as a matter of
 8 law." FRCP 56(a). Defendant must present the Court undisputed, *material, facts*
 9 (supported by admissible evidence) which establish each element of its claim or defense.
 10 If a statement of fact contains a legal conclusion or otherwise unsupported statement,
 11 including a fact which relies upon inadmissible hearsay, such a fact is disregarded.
 12 *Eisenstadt v. Centel Corp.*, 113 F.3d 738, 742 (7th Cir.1997). The moving party bears the
 13 burden of production and persuasion on its own claims. *Southern California Gas Co v.*
 14 *City of Santa Ana* (9th Cir. 2003) 336 F.3d 885. The court views the evidence in a light
 15 most favorable to the nonmoving party, drawing all reasonable inferences in the
 16 nonmoving party's favor. *Anderson v. Liberty Lobby Inc.* (1986) 477 U.S. 242, 255.

17 IV. THE UNDISPUTED MATERIAL FACTS PROVE THAT GOOGLE IS GENERIC

18 A. Defendant Has Submitted No Relevant, Admissible Evidence That the 19 Primary Significance of the Word Google to the Public Is as a Trademark

20 "The primary significance of the registered mark to the relevant public rather than
 21 purchaser motivation shall be the test for determining whether the registered mark has
 22 become the generic name of goods or services on or in connection with which it has
 23 been used." 15 U.S.C. § 1064(3). Under the primary significance test, majority usage
 24 controls. *King-Seeley Thermos Co. v. Aladdin Industries, Inc.* (2d Cir. 1963) 321 F.2d
 25 577, 581 ("Since the great majority of those members of the public who use the word
 26 'thermos' are not aware of any trademark significance, there is not enough dual use to
 27 support King-Seeley's claims to monopoly of the word as a trademark."); See also
 28 Restatement (Third) of Unfair Competition § 13 (1995)("The [primary significance]
 standard is often interpreted as a rule of majority usage.")

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1 The point seems to be that where some customers regard the term as
2 generic, while others regard it as a mark, the term must be placed either in
3 the "generic" pigeonhole or in the "trademark" category. For example, if a
4 survey showed that 75 percent of the public regarded the word as generic,
5 then that is its "principal significance."
6 2 McCarthy on Trademarks and Unfair Competition § 12:6 (4th ed.)(citations omitted).
7 Majority usage means the usage chosen by over one half of respondents when given two
8 mutually exclusive choices. Vincent N. Palladino, "Surveying Secondary Meaning", 84
9 Trademark Rptr 155, 178 (1994).

10 Furthermore, the question is not whether the majority simply associates the word
11 with a particular producer, but whether the *primary* significance of the word is to identify
12 that single producer. "Even if only one producer Parker Brothers has ever made the
13 MONOPOLY game, so that the public necessarily associates the product with that
14 particular producer, the trademark is invalid unless source identification is its primary
15 significance." *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.* (9th 1979) 611 F.2d 296, 302.

16 **1. Neither the Popularity of Defendant as a Company nor its
17 Product/Services are Relevant to the Primary Significance of its
18 Trademark to the Public.**

19 Defendant points out that it dominates the search engine market and the resulting
20 fame of its company as proof of non-genericness. However, this evidence results simply
21 from Defendant's lack of true competitors for so many years. Defendant's search engine
22 may not have been the first search engine in history, but it is the most popular.

23 If anything, Defendant's dominance of the search engine market hinders
24 Defendant's arguments of non-genericness. Defendant has such a large market share that
25 it is essentially a "single source" of search engine services. Courts have repeatedly held
26 that where a trademark holder is or was the single source of a product or service
27 (whether due to a patent or market conditions), then the link in a minority of people's
28 minds between the product and its name with the single source company will be
dismissed as mere de facto secondary meaning. *A.J. Canfield Co. v. Honickman*, 808
F.2d 291, 297, 1 U.S.P.Q.2d 1364 (3d Cir. 1986) ("Therefore, evidence that a generic
term is identified with one producer, indicative of a secondary meaning for a descriptive
term, proves only what courts call "de facto" secondary meaning. Such evidence

1 indicates only that the producer has dominated the market for a product (often because
2 it has had a patent).")

3 Admittedly, it may be difficult in the single source case to determine the primary
4 significance of a word. *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F.
5 Supp. 448, 212 U.S.P.Q. 748 (N.D. Cal. 1981), rev'd, remanded on other grounds,
6 *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316, 216 U.S.P.Q. 588
7 (9th Cir. 1982) ("In the case of the single producer of a unique item, it is a difficult and
8 delicate task to separate product from source characteristics as they appear in the
9 consumer's mind"). This case is an example of that difficulty. However, it is not
10 impossible. As Professor McCarthy writes:

11 The prime question is: What does the public call this "thing"? If, to the
12 public, the "thing" is named by the term that the seller intends as a
13 trademark, then it is not a mark at all—it is a generic name. But if the public
14 calls the "thing" by some name other than the mark, then the mark
15 probably does function as a mark even though there is, temporarily, no one
16 else on the market with the "thing."

17 2 McCarthy on Trademarks and Unfair Competition § 12:49 (4th ed.)

18 For example, in *DuPont Cellophane Co. v. Waxed Products Co.* (2d Cir. 1936)
19 85 F.2d 75, at 80, DuPont had invented a new transparent wrapping material, calling
20 their product "Cellophane." Initially, DuPont held a patent for the product but once the
21 patent expired, other sellers sought to use the word cellophane to name the product.
22 While, despite the patent, others had manufactured and sold similar transparent wrapping
23 material in "considerable quantities" even before the patent expired, this case is still cited
24 as a "single source" case. See 2 McCarthy on Trademarks and Unfair Competition §
25 12:49 (4th ed.) The court therefore sought to determine what the public called the
26 "thing" and found that 'cellophane' was used to designate the product far more
27 commonly than any other term. Defendant's current market share is just that – market
28 share – and is more relevant to discount any lingering association between the word
google and Defendant's company, than to prove non-genericness.

2. Defendant's Legal Conclusions, and Hearsay "Evidence" Are Irrelevant.

Defendant states as "fact" that "The GOOGLE mark identifies Google's proprietary

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1 and unique search engine technology and services and is famous throughout the United
 2 States and around the world." Defendant's Separate Statement ¶ "DSS" 8 In support of
 3 this "fact" Defendant cites the declaration of its own attorney and its exhibits 1 (a hearsay
 4 article stating that in August 2013 Defendant's sites led the search market with a 66.9%
 5 of search queries conducted), 4 (another hearsay article stating that Defendant's sites
 6 ranked the number one internet properties in December 2012), 5 (another hearsay article
 7 ranking Defendant's "brand" as the second most valuable brand in the world), 6 (another
 8 hearsay article ranking Defendant's "brand" as the fourth "best" brand in the world), and
 9 7 (another hearsay article claiming that Defendant's company has the fourth best
 10 reputation among the most visible companies, whatever that means). Aside from the fact
 11 that none of this "evidence" is admissible to prove any of the matter asserted, none of this
 12 "evidence" touches on the relevant inquiry in this case, which is primary significance,
 13 i.e., primary use.

14 **3. Defendant's Enforcement Budget Is Evidence of its Abandonment of**
 15 **the Mark to the Public – not of the Mark's Non-genericness.**

16 Defendant also points to its enforcement budget as evidence of the non-
 17 genericness of the word google. Initially, it is clear that while lack of enforcement is
 18 evidence of genericness, the converse is not so. Once a term has "entered the public
 19 domain" by becoming a generic term through public usage, enforcement of asserted
 20 trademark rights is too late and is of no avail. By that time, "policing is of no
 21 consequence to a resolution of whether a mark is generic." *Murphy Door Bed Co. v.*
 22 *Interior Sleep Systems, Inc.* (2d Cir. 1989) 874 F.2d 95; accord *King-Seeley Thermos Co.,*
 23 321 F.2d 577.

24 In addition, Defendant's enforcement budget is completely disproportionate to the
 25 "evidence" its has presented which purports that Defendant's trademark is worth
 26 \$113,669,000,000. (Def.'s Exhibit 5.) If that is the value of the mark, then Defendant's
 27 budget for enforcement is so low proportionately it constitutes abandonment of its mark.

28 **4. Defendant's Survey Is Useless in That it Ignores the Most Prevalent**
Use of the Word Google—as a Verb.

Defendant submits what is known as a Teflon survey, based upon a survey

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1 approved by a district court in *E. I. Du Pont de Nemours & Co. v. Yoshida International,*
 2 *Inc.* (E.D.N.Y., 1975) 393 F.Supp. 502, in support of its argument that the word google
 3 is not generic. A “teflon” survey explains the difference between a brand name and a
 4 common name and asks respondents to classify a list of words (including the word at
 5 issue) as brand or common. In the original “teflon” survey, after confirming the survey
 6 respondents’ understanding of the difference between a brand name and a common
 7 name, interviewers read a list of eight words, including the word at issue, or the “test”
 8 word (TEFLON), and seven other words that served as “controls” (STP, COKE, JELLO,
 9 THERMOS, MARGARINE, REFRIGERATOR, and ASPIRIN). Survey respondents were
 10 asked to classify the word as a brand name or a common name. 68% of Du Pont’s survey
 11 respondents identified TEFLON as a brand name, whereas only 31% identified it as a
 12 common name. Survey respondents also correctly identified STP (90%), COKE (76%),
 13 and JELLO (75%) as brand names, and REFRIGERATOR (94%), MARGARINE (91%), and
 14 ASPIRIN (86%) as common names. The district court reasoned that, given the mark and
 15 usage at issue, this survey answered the “critical question,” that is, that of the principle
 16 significance of the TEFLON mark to the public.

17 When the *E.I. duPont* court in 1975 approved of the use of the “teflon” survey,
 18 it did so in the context of a trademark used to designate the producer of a product (as
 19 opposed to a service) which was alleged to have become a noun (as opposed to a verb)
 20 used to identify the product itself. The context of this case however is drastically
 21 different. This case involves the use of a trademark which originally designated the
 22 provider of a service and which is alleged to be primarily used now as a verb. In fact, a
 23 “teflon” survey is both irrelevant and improper in this case. First, a “teflon” survey is
 24 misleading. It asks respondents to classify words as either brand names or common
 25 names. It does not address alternate usage of a word, such as usage as a verb, which is
 26 the key issue in this case. Second, it ignores the complexity of the genericness analysis.

27 The critical question is: what is the principle significance of the word to the
 28 public? In other words, how do people most often use and understand the word? The

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1 “teflon” survey does not come close to answering that question in this case. Instead, it
2 presupposes usage as a noun (generic) or an adjective (brand) and asks respondents to
3 sort words into those two categories. It does not ask how they most often use the word
4 in question (as a noun, adjective, or verb) and it does not ask whether that primary usage
5 is meant to communicate a particular producer of a product or service.

6 To understand exactly how off-target a “teflon” survey is in this case, one need
7 only look to Defendant’s “teflon” survey, conducted by expert witness Dr. Gerald L.
8 Ford. SS 95 Defendant’s survey essentially duplicated the original “teflon” survey, with
9 minor substitutions. Respondents were first told:

10 The research we are conducting today is on brand or proprietary names and
11 common names.

12 By a brand or proprietary name, I mean a name like ‘Chrysler’ which is
13 used by one company or organization; by a common name, I mean a name
like ‘automobile’ which is used by a number of different companies or
organizations.

14 Respondents were then asked:

15 Now, if I were to ask you "Do you understand the name ‘Hewlett Packard’
16 to be a brand or proprietary name or a common name?" what would you
say?

17 Now, if I were to ask you "Do you understand the name ‘computer’ to be
18 a brand or proprietary name or a common name?" what would you say?

19 Respondents who answered these two questions “correctly” were told:

20 Now, I am going to read you some names and ask you to tell me whether
21 you understand each name to be a brand or proprietary name used by one
company or organization or a common name used by a number of different
companies or organizations.

22 For any of the names, if you don’t have an opinion or don’t know, that is
an acceptable answer.

23 The names then provided to respondents were: STP, COKE, JELLO, REFRIGERATOR,
24 MARGARINE, ASPIRIN. Respondents then were asked to again classify a list of “names”,
25 this time “with respect to search the internet”: BROWSER, WEBSITE, AMAZON,
26 YAHOO, AND GOOGLE. Not surprisingly, 93.77% of the 401 respondents, when given
27 the choice between brand “name” and common “name,” chose brand for GOOGLE. The
28 point of this case is not whether google is a generic word for browser; it is an issue of

1 verb usage.

2 The *Anti-Monopoly* case is instructive:

3 General Mills conducted a survey based upon a survey approved by a
 4 district court in the "Teflon" case, *E. I. Du Pont de Nemours & Co. v.*
 5 *Yoshida International, Inc.*, E.D.N.Y., 1975, 393 F.Supp. 502. In the survey
 6 conducted by General Mills, people were asked whether "Monopoly" is a
 7 "brand-name," and were told: "By brand name, I mean a name like
 8 Chevrolet, which is made by one company; by common name, I mean
 9 'automobile,' which is made by a number of different companies."
 10 (Emphasis in the original.) The results of this survey had no relevance to the
 11 question in this case. Under the survey definition, "Monopoly" would have
 12 to be a "brand name" because it is made by only one company. This tells
 13 us nothing at all about the primary meaning of "Monopoly" in the minds of
 14 consumers.

15 It is true that the witness through whom the survey was introduced testified
 16 on direct examination that as a result of it his opinion was that "Monopoly"
 17 primarily denotes source or producer. However, on cross-examination and
 18 redirect examination it became clear that this witness had done no more
 19 than reduplicate the "Teflon" survey (with appropriate substitutions and
 20 slight additions) and had no opinion on the relevance of this survey to any
 21 issue in the present case. The brand-name survey is not even some
 22 evidence to support finding ; it is no evidence to support it.

23 684 F.2d 1316, 1323-24 (9th Cir. 1982). Similarly, in this case the results of Defendant's
 24 Teflon survey have no relevance to the question in this case. Defendant's survey ignore
 25 verb usage of the word google and merely duplicate the original Teflon survey with
 26 substitutions. It tells us nothing about the primary meaning of google in the minds of
 27 consumers.

28 **5. Defendant Misrepresents its Dictionary Evidence by Intentionally
 Leaving out Complete And/or Previous Definitions and Is Skewed
 by Defendant's Influence and Intimidation.**

Defendant next provides dictionary definitions which refer to Defendant, thereby
 supposedly constituting evidence of the understanding of google as a trademark. As Dr.
 Metcalf opined, "[t]he makers of dictionaries are cautious when it comes to mentioning
 trademarks."² SS 99 The very inclusion of a trademark in the dictionary is a statement
 by the dictionary editors that the trademark has become common or a generic word. SS
 100 Indeed, Dr. Farrell remarks regarding the Oxford English Dictionary entry for

²See Metcalf's Report, pg. 7: "When a lexicographer chooses to include a
 trademark in a dictionary, it's because the lexicographer, reviewing files of citations, has
 observed a common and generic word derived from a trademarked name." See also
 Farrell's report, p.5, "the OED [Oxford English Dictionary], as a general rule, does not
 have entries for proprietary names that have not undergone significant genericization."

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1 "Google" that:

2 The entry seems to be carefully crafted so as to no more than merely suggest that
 3 the word has been decoupled from its origin as a trademark, i.e., that it has been
 4 GENERICIZED. Controversy is avoided by having Google rather than google, as
 5 the main form of the entry, with only a note that the latter is a variant form, and
 6 by including reference to the Google search engine in the definitions.

7 Even the dictionary definitions Defendant cites are misleading. Collins English

8 Dictionary defines google the noun as a trademark, but defines google the verb as

9 "(without a cap) 2 to search for (something on the internet) using a search engine 3 to

10 check (the credentials of someone) by searching for websites containing his or her

11 name." SS 102 Clearly, this verb definition is generic. And the order of the different

12 definitions is not significant, as most dictionaries put definitions in order of oldest to

13 newest, or noun to verb. Dictionary.com does the same, defining the noun as a

14 trademark and the ver "(used with object)...2. (Often lowercase) to search the Internet for

15 information about (a person, topic, eetc.): We googled the new applicant to check her

16 background. Verb (used without an object)...3. (Often lowercase) to use a search engine

17 such as Google to find information, a Web site address, etc., on the Internet." SS 57

18 Again the verb is defined generically. Wikipedia defines the verb generically as well:

19 "However, it can also be used as a general term for searching the internet using any

20 search engine, not just Google." SS 58 Oxford English Dictionary's suggests that google

21 is generic by:

22 (i) the etymological note, which states that this is a *derivation from* the
 23 proprietary name [rather than stating that it *is* a proprietary name]; (ii) the
 24 particular choices for illustrative examples [which includes lower case and
 25 non-specific examples]; and (iii) the fact that the OED, as a general rule,
 26 does not have entries for proprietary names that have not undergone
 27 significant genericization, as evidenced by the lack of any entry for the
 28 noun from which the verb Google was derived and the absence of entries
 for Yahoo, Bing, Toyota, Chevrolet, Starbucks, Facebook, Windows, and
 the like. Farrell report. SS 101, 104

Merriam-Webster flat-out admits that it has tempered its definition of google as a

result of its fear of Defendant: "We were trying to be as respectful as we possibly could

be about Google's trademark," said John Morse, publisher of the Merriam-Webster

dictionary, in an interview. SS 105 Dictionary makers are more likely to define the word

in a proprietary way in order to save themselves the headache of a dispute with the

1 trademark owner. SS 101 Dictionaries and the media can be, and are, bullied by well-
 2 funded trademark owners into affording more trademark significance to a word than the
 3 relevant public does.³

4 **6. Lack of Competitor's Use of the Mark to Refer to Their Own
 5 Products Is Irrelevant under *Murphy Door Bed Co.***

6 The fact that companies like Bing and Yahoo do not refer to their search engines
 7 as "googles" is not evidence of non-genericness. There is no doubt that they refrain from
 8 doing so for fear of the wrath of Defendant: "Indeed, the only evidence that even
 9 arguably supports the view that the mark was not generic is the circumstance that other
 10 manufacturers did not use the term Murphy bed to describe their beds. However, that
 11 fact is not sufficient to support a conclusion that the mark is not generic, especially since
 12 Murphy's action in policing the mark might well have deterred other manufacturers from
 13 using the term Murphy bed in describing their products." *Murphy Door Bed Co., Inc.*

14 ³In 2003, WordSpy (an online dictionary of new words) included an entry for the
 15 verb google, "To search for information on the Web, particularly by using the Google
 16 search engine." SS 96 Defendant's trademark attorneys wrote Word Spy "asking" Word
 17 Spy to "help us to protect our brand by deleting the definition of "google" found at
 18 wordspy.com or revising it to take into account the trademark status of Google." Word
 19 Spy chose the latter option, but not before forwarding Defendant's "request" to its entire
 20 list serve, asking:

21 I understand what's involved in trademark protection, but "google" is an
 22 important new verb, so I certainly don't want to delete it from the site. I
 23 also don't want any legal hassles. Is there a response I can send to this
 24 lawyer that will allow me to keep this entry? What if I just acknowledge
 25 that Google(tm) is a trademark of Google Technologies Inc.? Would that be
 26 good enough?

27 When is a word deemed to have become generic? Search Lexis-Nexis for
 28 "googled or googling or (google w/7 verb)" and you'll get nearly 400
 citations. Surely this cat's out of the trademark bag...

P.S. I expect the ADS [American Dialect Society] will soon receive a similar
 letter for selecting the verb "google" as "Most useful" and runner-up for
 WOTY [Word of the Year], and for having the temerity to post this on the
 ADS Web site. SS 97

Defendant sent a similar "request" to the Swedish Language Council after the Council
 announced that among its annual list of new Swedish words for 2012 was ogooglebar
 (ungoogleable), meaning something "that you can't find on the web with the use of a
 search engine." SS 98 However, instead of altering their definition of the word, the
 Language Council decided to remove the word altogether, stating "Instead, we're
 removing the word today and stating our displeasure with Google's attempt to control
 the language."

1 *v. Interior Sleep Sys., Inc.* (2d Cir. 1989) 874 F.2d 95, 101 fn. 2.

2 **7. Defendant’s Linguist Is Conflicted, His Confusions Are of Law and**
3 **Without Factual Support, and He Admits That Use of Google as a**
4 **Verb Cannot Have Trademark Significance.**

5 Defendant’s expert linguist, Geoffrey Nunberg, was first contacted regarding his
6 services by Plaintiff’s counsel in December of 2012. SS 106 Plaintiffs counsel sent
7 Nunberg the complaint asking if he would be an expert in the case. SS 106 In addition,
8 Plaintiffs’ counsel left Nunberg a voicemail explaining Plaintiffs’ theories in the case. SS
9 106 In response, Nunberg emailed that he thought the case was “interesting” and that he
10 would be “happy” to discuss being Plaintiff’s expert. SS 107 On December 5, 2012,
11 Nunberg and Plaintiff’s counsel had a telephone conversation about the case and
12 Plaintiffs’ theories and strategies thereof. SS 108 Following the conversation, Plaintiff felt
13 that Nunberg was “on board” with being Plaintiffs’ expert witness. SS 108 The next day,
14 Nunberg sent Plaintiffs’ counsel several expert witness reports he had prepared in prior
15 cases to ensure that he had not previously expressed any conflicting opinions that could
16 be used to impeach the opinion he would give in this case (at that time contemplating
17 an opinion in favor of Plaintiffs). SS 109 After reviewing these reports, on January 30,
18 2013, Plaintiffs’ counsel told Nunberg that Plaintiffs were interested in retaining Nunberg
19 as an expert witness. SS 110 On March 4, 2013, however, Nunberg told Plaintiffs’
20 counsel “I was looking forward to working on [your case], but some health issues make
21 it difficult for me to make commitments over the intermediate term, so I’ll have to pass.”

22 SS 111

23 Despite all this, Nunberg has now reversed his opinion and provided an opinion
24 for Defendant. He is clearly a hired gun who will say anything he is paid to say. Several
25 of Nunberg’s opinions are conclusions on the ultimate issues of this case: such as
26 whether widespread use of a trademark as a verb affects the validity of the mark. Clearly
27 Nunberg’s opinions on this are improper. In addition, some of Nunberg’s opinions
28 contradict existing law. Nunberg opines that a trademark can be “representative” of a
genus without being generic. However the very definition of a generic word is one which
represents the genus, rather than the product of one specific producer. Nunberg’s

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1 contrary opinion must be disregarded. Finally, Nunberg opines that a verb can never
 2 function as a trademark. As will be discussed in the following section (and in Plaintiffs'
 3 motion for summary judgment), the logical conclusion to be drawn from this opinion is
 4 that verb usage is necessary non-trademark (or generic) usage. Thus, if the majority usage
 5 of a word is as a verb, then the word is generic.

6 **B. It Cannot Be Disputed That the Word Google Is Most Often Used by the**
 7 **Public as a Verb, Which Is Necessarily Generic Usage, and Thus the Word**
 8 **Itself Is Generic⁴**

9 **1. Verb Usage of a Word is Necessarily Non-Trademark (i.e. Generic)**
 10 **Usage**

11 Defendant's own expert witness, Geoffrey Nunberg, both in his expert report and
 12 during his deposition, stated unequivocally that "a verb cannot serve as a trademark."
 13 SS 112 A trademark performs a function: it identifies and distinguishes the goods of one
 14 producer from those of others and thereby indicates source. 15 U.S.C. §1127 (definition
 15 of "trademark") *Qualitex Co. v. Jacobson Prods. Co.* (1995) 514 U.S. 159, 163. Certain
 16 words are not trademarks because they do not perform this function. *Anti-Monopoly, Inc.*
 17 *v. Gen. Mills Fun Grp., Inc.* (9th Cir. 1982) 684 F.2d 1316, 1319 ("It is the
 18 source-denoting function which trademark laws protect, and nothing more.") A word can
 19 only perform this source-identifying function when it is used as an adjective, modifying
 20 the generic name of the thing in such a manner as to indicate its source⁵. The generic
 21 noun tells what the product is, the adjective (or attributive noun) adds information by
 22 specifying from whom the product comes (i.e., NIKE shoes). Verbs are entirely outside
 23 of this structure. A verb is action. It tells what you are doing. It cannot distinguish one
 24

25 ⁴Plaintiffs incorporate by reference their motion for summary judgment. (Dkt. #73.)

26 ⁵Some scholars prefer to classify trademarks as "attributive nouns" (i.e. nouns that
 27 modify other nouns) rather than adjectives. See Geoffrey K. Pullum, "Punctuation and
 28 Human Freedom", in the Great Eskimo Vocabulary Hoax and Other Irreverent Essays on
 the Study of Language 67, 73, note 25 (1991) (contending that trademarks are used as
 "attributive modifiers," not as adjectives). Defendant's expert witness, Geoffrey Nunberg,
 is of this view. (Exhibit 2 (Deposition of Nunberg) 64:10-20.)

1 product from another. This circuit's who are you (from)/what are you dichotomy⁶ can be
2 slightly modified to: who are you (from)/what are you (doing)? A trademark answers the
3 former, a verb answers the latter.

4 Because a verb cannot serve as a trademark, verb usage is necessarily non-
5 trademark (i.e. generic) usage. The trademark trial and appeal board has recognized the
6 dichotomy between verb usage and trademark usage. *In Re Treeradar, Inc.*, 77579817,
7 2011 WL 3212252 (Trademark Tr. & App. Bd. July 15, 2011)("In one instance the term
8 is used in the manner of a verb ('TreeRadar for tree decay') which indicates generic use
9 rather than trademark use.") *In Re Grindmaster Corp.*, 77834762, 2011 WL 5600317
10 (Trademark Tr. & App. Bd. Oct. 28, 2011)("By using the term "grind'n brew" in the
11 manner of a verb, equating it to the verbs "grind" and "brew" standing alone, the above
12 indicates generic use rather than trademark use.") These decisions are highly persuasive.
13 *High Voltage Beverages, LLC v. Coca-Cola Co.*, 3:08CV367, 2010 WL 5924318
14 (W.D.N.C. Dec. 16, 2010) report and recommendation adopted in part, rejected in part
15 sub nom. *High Volatage Beverages, LLC v. Coca-Cola Co.*, 3:08CV367, 2011 WL
16 831523 (W.D.N.C. Mar. 3, 2011) ("While TTAB decisions are not precedential, they
17 have persuasive value with reviewing courts as they represent the considered opinions
18 of highly specialized adjudicators.")

19 The International Trademark Association's "Guide to Proper Trademark Use" states
20 "[t]rademarks and service marks are proper adjectives. Not nouns. Not verbs. A mark
21 should always be used as an adjective qualifying a generic noun that defines the product
22 or service." SS 113 INTA is not alone in recognizing that verbs cannot function as
23 trademarks. For example:(1) Gilson on trademarks provides practice tips to reduce risk
24 of genericism, including using word marks as "a proper adjective that modifies a noun"
25 and not using a trademark in the possessive, in the plural, or as a verb. Gilson on
26 Trademarks § 2.02[6] (Karin Green ed., 2010); (2) Sidney A. Diamond, attorney,

27
28 ⁶ 2 McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed.);
Surgicenters of America, Inc. v. Medical Dental Surgeries, Co. (9th Cir. 1979) 601 F.2d
1011

1 trademark scholar, and Federal Commissioner of Patents, Trademarks and Copyrights,
 2 in his "How to Use a Trademark Properly", 61 Trademark Rep. 431, 432, 438–39 (1971),
 3 recognizes the rules for proper trademark use, including ensuring use as a "proper
 4 adjective" and avoiding "incorrect grammatical form[s]," plurals, and possessives; (3)
 5 John Dwight Ingram, in his article "The Genericide of Trademarks', warns that
 6 "Trademark owners should never use the trademark as a verb or noun, which implies that
 7 the word is generic." Buffalo Intellectual Property Law Journal, Vol. 2:154, pg 160.

8 At least one District Court has recognized that verb usage of a trademark is misuse
 9 that can lead to a mark becoming generic. *FreecycleSunnyvale v. Freecycle Network,*
 10 *Inc.*, No. 2006) WL 2827916 (N.D. Cal. Oct. 3, 2006) (holding that counterclaim that
 11 plaintiff had "willfully and intentionally induced third parties to infringe the Marks by
 12 encouraging others to misuse the Marks in the form of verbs, adjectives, gerunds, and
 13 participles . . . so that this misuse will result in the Marks being rendered generic" stated
 14 a cause of action for contributory infringement)

15 2. The Primary Significance of google to the public is as a verb

16 The verb google is as old as the trademark. It is included in print and online
 17 dictionaries, and has been since 2003. SS 81-2 The verb is frequently used in television
 18 shows, movie, news, magazines, novels, and cartoons. SS 83 google has become a word
 19 root, and the root carries the verb meaning. SS 84 Thousands of domain names offered
 20 for sale on GoDaddy's auction site incorporate the verb. SS 85 When chosen as word of
 21 the decade by the American Dialect Society, google was defined as a verb. SS 86
 22 Defendant's own search engine, when asked to "define google" returns a definition of
 23 "google" (lower case) only as a verb. SS 87 When 1,033 members of the relevant public
 24 were asked "I most often use the word 'google' to mean:" 52.2% chose "to search
 25 something on the internet" (i.e. verb usage), while only 28.7% chose "the name of a
 26 specific search engine" (arguably trademark usage). SS 88 The remaining 19.1% chose
 27 "the Internet (in general." When another 1,007 respondent were asked to complete the
 28 same sentence and given slightly different answer choices, 72% chose "to search

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1 something on the internet," 16.6% chose "the Internet (in general)," and just 11.5%
2 chose "the name of a company." SS 89

3 **C. Even If Verb Usage Could Possibly Retain Trademark Significance Plaintiff**
4 **Has Submitted So Much Evidence That the Word Google Is Generic That**
5 **No Jury Could Possibly Decide in Defendant's Favor.**

6 **1. Plaintiff's surveys show that the public does not primarily associate**
7 **the word google with Defendant exclusively**

8 When asked "I most often use the word 'google' to mean:"(1) to search something
9 on the internet, (2) the name of a specific search engine, or (3) the internet (in general).
10 *Only 28.7%* of the public chose "a specific search engine." SS 88

11 When asked: "If you were going to ask a friend to search for something on the
12 Internet, what word or phrase would you use to tell him/her what you want him/her to
13 do?" 129 of 252 respondent used the word "google" in their response. Of those 129, 125
14 used the word generically (google/google it/google something/google this), while only
15 4 or 1.6% used the word in a manner clearly intended to refer to Defendant (Google
16 search/Bring up google/go to google.com). SS 90

17 **2. Use of the word google in television, film, cartoons, music, etc does not**
18 **exclusively identify and distinguish Defendant's services**

19 Plaintiffs have submitted an overwhelming quantity of evidence of the public and
20 the media's non-specific use of the word google. Ex. 22-34

21 **3. Plaintiff has submitted direct evidence of use of the word google to mean**
22 **searching on a website other than Defendant's.**

23 The strongest evidence of the genericness of the word google, as Defendant's own
24 expert has opined, are instances in which are person uses the word google and clearly
25 refers to a website other than Defendant's. Plaintiffs have submitted several examples of
26 this kind of evidence. For example, in the episode "Deadly Towers" of the Television
27 series "The Angry Video Game Nerd" a character says "...I googled it to check what it
28 meant, and according to urban dictionary..." SS 91 In addition, in episode 3.5 of the
German language show "Neues aus der Anstalt" a character says "I googled at wikipedia,
and you said 'some Horst Kohler[.]'" SS 92

In addition, a quick google on Defendant's website shows that the phrase "googled

1 on imdb” gets 5 results, “googled on pinterest” got 27 results, “googled on facebook”
2 gets 41 results, “googled on wikipedia” gets 136 results, and “googled on ebay” gets 407
3 results. SS 93

4 Perhaps most tellingly, Exhibit 28 is fourteen different Proposal Request Forms
5 submitted by actual people. SS 94 In these request forms, each respondent is asked “How
6 did you hear about us?” and each of their responses use the word google. However, the
7 program which generates these forms tracks the site from which the respondent was
8 referred and each of these fourteen people came from search engines other than
9 Defendant’s.

10 **VII. CONCLUSION**

11 For the foregoing reasons, Plaintiffs request this Court deny Defendant’s motion
12 for summary judgment.

13 Respectfully Submitted,

14 DATED: November 1, 2013

15 **WIRTZ LAW APC**

16 By: /s/ Richard M. Wirtz
17 Richard M. Wirtz (*pro hac vice*)
18 Attorney for Plaintiffs

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CERTIFICATE OF SERVICE

I hereby certify that on November 1, 2013, I electronically transmitted the attached document to the Clerk's Office using the CM/ECF System for filing.

/s/ Erin K. Barns

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