

No. 15-15809  
U.S.D.C Case No. 2:12-CV-01072-SMM  
UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

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**DAVID ELLIOTT**, an Individual and  
**CHRIS GILLESPIE**, an Individual,  
  
Plaintiffs, Counter-Defendants, Appellants,

v.

**GOOGLE INC.**, a Delaware corporation,  
  
Defendant, Counter-Claimant, and Appellee,

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U. S. District Court for the District of Arizona,  
Case No. 2:12-CV-01072-SMM

**APPELLANT'S OPENING BRIEF**

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## **I. JURISDICTIONAL STATEMENT**

Pursuant to Ninth Circuit Rule 28-2.2, Appellant submits the following statement of jurisdiction: The District Court had federal question jurisdiction under 28 U.S.C. §§ 1331 and 1338(a) and therefore this Court has jurisdiction under 28 U.S.C. § 1292(a)(1).

## **II. STATEMENT OF ISSUES PRESENTED FOR REVIEW**

Did the district court err in finding that there was no genuine dispute of material fact with regards to the genericness of the GOOGLE mark despite the introduction of multiple surveys, two linguists' expert opinions, media evidence of 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 supporting a finding of genericness?

Did the district court err in finding that a verb can perform the essential functions of a trademark?

Did the district court err in finding that verb use and, in particular, indiscriminate verb use of a trademark is wholly irrelevant to the genericness inquiry, *even if*, when used as a verb, a mark is primarily used generically?

Did the district court err in finding that a trademark cannot become generic through public appropriation of the mark in spite of binding precedent, the Lanham

Act itself, and the sound policy reasons underlying the genericide doctrine?

### **III. PRIMARY AUTHORITY**

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....”

#### **IV. STATEMENT OF THE CASE**

##### **A. Statement of Facts**

The GOOGLE trademark has been used as a verb since Larry Page, in 1998, first urged the recipients of the Google Friends Newsletter to “Have fun and keep googling!” 2 ER 271. Since 1998 the term has become ubiquitous, in no small part due to the success to Respondent’s search engine. The verb is frequently used in television shows and movies (See 5 ER 843-849), songs (See 5 ER 820-829), news and media articles (See 4 ER 773-818), advertising of products unrelated to the google.com search engine (See 4 ER 769-771), books (See 5 ER 977-7 ER 1370), and cartoons (See 4 ER 739-767). There are hundreds of domains for sale on GoDaddy



which incorporate google. (3 ER 364-476) Sometimes it is clear from the context that the verb is used to refer to the act of searching for something on the internet using Google Inc.'s search engine, *however*, it is also increasingly being used to refer to the act of searching for something on the internet in general, regardless of what search engine is used.

The relevant public – the national adult internet population– most often uses the word google as a verb meaning “to search the internet” and not as a designator of Google Inc. as the source of a product or service. When 747 members of the national adult internet population were surveyed using the Google Consumer Surveys Service and asked to select an answer for the following: "I most often use the word ‘google’ to mean," 52.2% chose "to search something on the internet" (i.e. verb usage), while only 28.7% chose "the name of a specific search engine" (arguably trademark usage). The remaining 19.1% chose "the Internet (in general)." (1 ER 50) When another 707 members of the national adult internet population where asked to select an answer to the same question and provided slightly different options to chose from 72% chose "to search something on the internet," 16.6% chose "the Internet (in general)," and just 11.5% chose "the name of a company." (1 ER 64)

When 251 screened members of the national adult internet population were asked the open-ended question "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?" 129 of the 251 respondents used the word "google" in their response. Of those 129, 125 used the word generically (google/google it/google something/google this), while only 4 or 1.6% used the word in a manner clearly intended to refer to Google Inc. (Google search/Bring up google/go to google.com). 5 ER 903-906.

The verb google is now included in many dictionaries. Again, some definitions make reference to Google Inc.'s search engine and some do not. Of those which do make reference to Google Inc.'s search engine, several admit to having done so to appease Google Inc. and avoid a lawsuit.

Collins English Dictionary defines google the noun as a trademark, but defines google the verb as “(without a cap) **2** to search for (something on the internet) using a search engine **3** to check (the credentials of someone) by searching for websites containing his or her name.” (5 ER 942.)

Dictionary.com does the same, defining the noun as a trademark and the verb “(used with object)...**2**. (Often lowercase) to search the Internet for information about (a person, topic, etc.): We googled the new applicant to check her background. Verb (used without an object)...**3**. (Often lowercase) to use a search engine such as Google to find information, a Web site address, etc., on the Internet.” (5 ER 934.)

Google Inc.'s own search engine, at the time of the briefing before the district court, when asked to "define google" (even when "Google" is capitalized) returned a definition of "google" (lower case) as a verb. (3 ER 486;10 ER 2223.) The definitions returned were:

1. Use an Internet search engine, particularly Google.com: “she spent the afternoon googling aimlessly”
2. Search for the name of (someone) on the Internet to find out information about them.

The first definition defines google as to “[u]se **a** search engine” (emphasis added), “**particularly** [but not exclusively] Google.com[.]”

Wikipedia defines the verb generically as well: “However, it can also be used as a general term for searching the internet using any search engine, not just Google.” (5 ER 936.)

The verb google was added to the Oxford English Dictionary in 2006. While the Oxford English Dictionary defines the verb google specifically, “To use the Google search engine to find information on the Internet” (2 ER 299)(probably as a result of pressure from Google Inc., as discussed in further detail *infra*) OED’s entry for the verb *suggests* that google is in fact generic by:

- (i) the etymological note, which states that this is a *derivation from the*

proprietary name [rather than stating that it *is* a proprietary name]; (ii) the particular choices for illustrative examples [which includes lower case and non-specific examples]; and (iii) the fact that the OED, as a general rule, does not have entries for proprietary names that have not undergone significant genericization, as evidenced by the lack of any entry for the 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, 2 ER 300.)

Merriam-Webster, which also added the verb google in 2006 (See 2 ER 310), flat-out admits that it has tempered its definition of google as a result of its fear of Google Inc.: “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. 2 ER 294.

In 2003, WordSpy (an online dictionary of new words) included an entry for the verb google, “To search for information on the Web, particularly by using the Google search engine.”(9 ER 2125) Google Inc.’s trademark attorneys wrote Word Spy “asking” Word Spy to “help us to protect our brand by deleting the definition of "google" found at wordspy.com or revising it to take into account the trademark status

of Google.” Word Spy chose the latter option, but not before forwarding Google Inc.’s “request” to its entire list serve, asking:

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

When is a word deemed to have become generic? Search Lexis-Nexis for "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.

(9 ER 2125)

Google Inc. 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.” (5 ER 938) 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.”

In 2010, the verb google was chosen by the American Dialect Society as its “word of the decade.” (3 ER 478) “This society includes most of the world’s experts on American English and its vocabulary as well as on issues of language change and genericization and some of them even serve as editors of major dictionaries.” (2 ER 308) When so selected, the verb was defined by these leading experts in the field as follows: “Verb meaning ‘to search the internet.’ Generic form of the trademarked ‘Google,’ the world’s dominant Internet search engine.” (3 ER 479, 2 ER 308) No one at the 2010 meeting during which the word of the decade was selected and defines proposed that the definition of google be limited to the search engine google, even though the society’s 2002 definition of google (when it was then voted the “Most Useful”) was so limited. (2 ER 330)

Google is a word root. It has spawned new words such as googleology, googleologist, and googleable. (2 ER 298; 2 ER 342; 2 ER 349; 2 ER 353) When used as a root, google- refers to the act of searching the internet and applies to all

search engines. (2 ER 293) Googleology is the study of internet searching, not the study of Google Inc.. (2 ER 293)

The verb google has been translated into many other languages. (2 ER 307)

Consumers undoubtedly use the verb google to refer to the act of searching for something on the internet using a search engine *other than google.com*.

A company called 352 Media Group maintains a website on which potential clients can request a proposal by filling out a “Proposal Request Form.” (2 ER 83) One of the things the form asks potential clients is “How did you hear about us?” – an open ended question. (2 ER 84) When the potential client fills out the form, the program then emails it to 352 Media Group. (2 ER 84) When it does so it also records and provides 352 Media Group with the website URL from which the potential client was directed to 352 Media Group’s website. (2 ER 84) In 2010, 352 Media Group noticed that, in response to the question “How did you hear about us?” several clients had indicated some variation of the phrase “I googled it” when in fact, those clients had been directed to 352 Media Group’s page from Bing or Yahoo. (2 ER 84) This observation lead 352 Media Group’s Chief Marketing Officer to write an article on his blog entitled “Can You google Someone on Bing or Yahoo?” (2 ER 84; See the article at 4 ER 830) Included in the record on appeal are fourteen of these Proposal

Request Forms submitted by potential clients. (5 ER 832-841.)

The following number of results are returned when the phrase “googled on...[a site other than google.com] is entered into the google.com search engine:

“googled on ebay”: 407 results (5 ER 851)

“googled on facebook”: 41 results (5 ER 853)

“googled on imdb”: 6 results (5 ER 855)

“googled on pinterest”: 27 results (5 ER 857)

“googled on wikipedia”: 136 results (5 ER 859)

## **B. Procedural History**

Appellants David Elliot and Chris Gillespie (“Appellant”) 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 Appellant’s use of the verb google in their domain names constituted fair 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. (13 ER 2986)

Appellant and Google Inc. each filed cross motions for summary judgment on



the issue of genericness on September 23, 2013. (See 7 ER 1424-13 ER 2974.) On September 11, 2014, the district court denied Appellant's motion for summary judgment and granted Google Inc.'s motion for summary judgment. (1 ER 2-27) The parties then stipulated to dismiss the remaining claims and judgment was entered on April 16, 2015. (1 ER 1)

## **V. SUMMARY OF ARGUMENT**

In ruling on a motion for summary judgment, the district court is not permitted to weigh the evidence. Rather, it may only decide whether or not there is any genuine issue of material fact which requires the matter to proceed to the jury. However, the district court in this case did not follow this rule. Instead, it weighed the evidence, found one party's evidence to be more persuasive, and granted summary judgment in that party's favor. This ruling must be reversed.

Google Inc. filed for summary judgment on the issue of genericness, which is both the basis of Appellant's cancellation claim and one of Appellant's defenses to Google Inc.'s counterclaims. Genericness is an issue of fact, which precluded summary judgment unless Appellant introduced no evidence probative of genericness. This was clearly not the case. Appellant submitted a plethora of evidence on the issue of genericness, more than enough to create a genuine question of fact (so much, in

fact, that Appellant sought summary judgment *in Appellant's favor*). Appellant submitted multiple surveys, the expert opinions of two distinguished expert linguists, examples of generic usage of the word google by the media and by Google Inc. itself, and dictionary evidence of genericness. Appellant submitted direct evidence, which Google Inc.'s own expert admitted was highly probative of genericness, of consumers' and of the media's use of the verb google to meaning searching on the internet on something other than Google Inc.'s search engine. Appellant demonstrated that there is no available efficient substitute generic word describing the action of searching on the internet, which is probative of genericness. Despite all of this evidence, the district court found that there was no genuine issue of fact with regards to genericness. This was clear error.

In order to justify its finding that there was no genuine issue of material fact with regards to genericness in the face of such an abundance of evidence submitted by Appellant, the district court made several erroneous findings of law which it then used to declare Appellant's evidence "irrelevant" to the inquiry. For example, Appellant submitted a large quantity of evidence of use of the word google as a verb. A verb cannot function as source identifier, as a trademark, and therefore *any* use of a former mark as a verb is necessarily generic use. In order to discount this evidence,

the district court held that a verb can somehow function as a source identifier and, in doing so, coined the heretofore unidentified terms “discriminate verb” and “indiscriminate verb.” However, Appellant also introduced evidence that the primary significance of the word google is as an indiscriminate verb. To dismiss *that* body of evidence, the district court reasoned that “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* mark to differentiate one particular product or service from those offered by competitors.” 1 ER 8. In short, the district court found that generic usage is irrelevant to the genericness inquiry so long, as when a mark is used as a mark, it is used as a mark. If this reasoning seems circular and self-fulfilling it is because it is circular and self-fulfilling. It is also erroneous as a matter of law.

To justify its decision to dismiss all evidence of verb usage as irrelevant to the genericness inquiry, the district court reasoned that it would not be fair to trademark owners to “strip a mark of legal protection solely because the mark...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.” 1 ER 8. Yet this conclusion is contrary to precedent, to the Lanham Act itself, and to the policy underlying the provisions of the Lanham Act.

The very definition of genericide is the conversion of a formerly protectable trademark into a generic term by public appropriation thereof. This is a fate suffered by many arbitrary or fanciful marks over the years – including Escalator, Murphy Bed, Cellophane, and Thermos, to name a few.

The Lanham Act itself provides that a mark's registration may be cancelled at any time should the mark become generic, and permits the Federal Trade Commission to institute an action to have a mark cancelled for genericness. Underlying this provision are sound policy reasons. Continued protection of generic marks hurts competitors by driving up the costs of communication with customers and thereby excluding smaller competitors from the market. In doing so, it also hurts consumers by driving up prices. It hurts parallel markets by preventing the providers of related goods and services from describing the nature of their goods and services. And it hurts the public at large by restricting the free development of language.

Whether or not this Court agrees with the district court's conclusions of law one thing is clear – the issue of the genericness of the GOOGLE mark simply cannot be disposed of on summary judgment. Weighing the evidence is the job of a jury, not of the district court. The district court's decision granting summary judgment on the issue of genericness must be reversed and this case remanded to allow a jury to decide,

based on *all* of the evidence, whether the GOOGLE mark has become generic.

## **VI. STANDARD OF REVIEW**

A district court's decision to grant or deny summary judgment or a summary adjudication motion is reviewed de novo. See *Szajer v. City of Los Angeles* (9th Cir. 2011) 632 F.3d 607, 610; *Universal Health Servs., Inc. v. Thompson* (9th Cir. 2004) 363 F.3d 1013, 1019. See also *Freecycle Sunnyvale v. Freecycle Network* (9th Cir. 2010) 626 F.3d 509, 514; *One Indus., LLC v. Jim O'Neal Distrib., Inc.* (9th Cir. 2009) 578 F.3d 1154, 1162 (noting that summary judgment is disfavored in trademark cases).

The appellate court's review is governed by the same standard used by the trial court under Fed. R. Civ. P. 56(c). See *Suzuki Motor Corp. v. Consumers Union, Inc.* (9th Cir. 2003) 330 F.3d 1110, 1131. On review, the appellate court must determine, viewing the evidence in the light most favorable to the nonmoving party, whether there are any genuine issues of material fact and whether the district court correctly applied the relevant substantive law. See *Olsen v. Idaho State Bd. Of Medicine* (9th Cir. 2004) 363 F.3d 916, 922. The court must not weigh the evidence or determine the truth of the matter but only determine whether there is a genuine issue for trial. See *Balint v. Carson City* (9th Cir. 1999) 180 F.3d 1047, 1054.

Summary judgment may be appropriate when a mixed question of fact and law involves undisputed underlying facts. See *EEOC v. United Parcel Serv.* (9th Cir. 2005) 424 F.3d 1060, 1068; *Colacurcio v. City of Kent* (9th Cir. 1998) 163 F.3d 545, 549.

## **VII. ARGUMENT**

### **A. The Court Erred By Weighing the Evidence and Determining a Disputed Issue of Fact – The Primary Significance of the Word "Google" to the Public**

Summary judgment may only be granted if there is “no genuine dispute as to any material fact and that the movant is entitled to judgment as a matter of law.” FRCP 56(a). This standard is construed “with due regard ... for the rights of persons asserting claims and defenses that are adequately based in fact to have those claims and defenses tried to a jury ...” *Celotex Corp. v. Catrett* (1986) 477 US 317, 327. As such, Courts must act with caution in granting summary judgment. *Anderson v. Liberty Lobby, Inc.* (1986) 477 US 242, 255.

#### **1. Genericness is an Issue of Fact and Therefore Summary Judgment May Only Be Granted Where No Reasonably Jury Could Find, Based on the Evidence Presented, That the Mark**

### **in Question is Generic**

The district court granted Google Inc.'s motion for summary judgment on the issue of whether Google Inc.'s trademarks are invalid because they are generic. 1 ER 4. "Whether a mark is generic is a question of fact." *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.* (9th Cir. 2005) 419 F.3d 925, 929. Therefore, the district court was required to find that there was no genuine dispute as to this material fact and that no reasonable jury could conclude from the evidence produced that the mark is generic. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.* (9<sup>th</sup> Cir. 2005) 408 F.3d 596, 606. The court was required to view the evidence in a light most favorable to the nonmoving party (Appellant), drawing all reasonable inferences in the nonmoving party's favor. *Anderson v. Liberty Lobby Inc.* (1986) 477 U.S. 242, 255. Given the evidence presented and the court's duty to draw all inferences in Appellant's favor, the district court clearly erred in finding that there was no genuine dispute as to the genericness of the GOOGLE mark.

### **2. Appellant Presented Ample Evidence Based on Which a Reasonable Jury Could Find that the GOOGLE Mark is Generic.**

The test for genericness is "[t]he primary significance of the registered mark to

the relevant public..." 15 U.S.C. § 1064(3). Under the primary significance test, majority usage controls. *King-Seeley Thermos Co. v. Aladdin Industries, Inc.* (2d Cir. 1963) 321 F.2d 577, 581 ("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 Restatement (Third) of Unfair Competition § 13 (1995)("The [primary significance] standard is often interpreted as a rule of majority usage.")

...where some customers regard the term as generic, while others regard it as a mark, the term must be placed either in the "generic" pigeonhole or in the "trademark" category. For example, if a survey showed that 75 percent of the public regarded the word as generic, then that is its "principal significance."

2 McCarthy on Trademarks and Unfair Competition § 12:6 (4th ed.)(citations omitted). Majority usage means the usage chosen by over one half of respondents when given two mutually exclusive choices. Vincent N. Palladino, "Surveying Secondary Meaning", 84 Trademark Rptr 155, 178 (1994). The question is: how is the word used a majority (i.e. greater than 50%) of the time?

Furthermore, the question is not whether the majority simply associates the



word with a particular producer, but whether the *primary* significance of the word is to identify that single producer. "Even if only one producer Parker Brothers has ever made the MONOPOLY game, so that the public necessarily associates the product with that particular producer, the trademark is invalid unless source identification is its primary significance." *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.* (9th Cir. 1979) 611 F.2d 296, 302. In the context of trademarks versus verbs, the question is whether the word is primarily used to denote the action (i.e. most often used as a verb)—even if the public necessarily associates a producer with a particular verb because, for example, that producer makes the best product through which the action can be accomplished—or the producer (i.e. most often used as a trademark). In this case, the question is whether the public uses the word google primarily as a non-specific verb meaning to search on the internet

Evidence that may prove genericness can include the following: (1) generic use by competitors of the mark that has not been contested by the owner of the mark; (2) generic use of the trademark by the proponent of the trademark; (3) dictionary definitions to determine public usage; (4) generic usage in the media of the trademark, such as in trade journals and newspapers; (5) testimony of persons in the trade; and (6) consumer surveys. McCarthy on Trademarks and Unfair Competition § 12:13;

*Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.* (9th Cir. 1999) 198 F.3d 1143. Direct evidence of consumer’s use of the mark to refer to a product other than that of the trademark holder is strong evidence of genericness. In addition, the lack of an available substitute generic term is also evidence that the mark has become generic. *Bayer Co. v. United Drug Co.* (D.C.N.Y. 1921) 272 F. 505; *DuPont Cellophane Co., Inc. v. Waxed Products Co., Inc.* (2d Cir. 1936) 85 F.2d 75; *Q-Tips, Inc. v. Johnson & Johnson* (D.N.J. 1952) 108 F. Supp. 845, 863; *Dictaphone Corp. v. Dictamatic Corp.* (D. Ore. 1978) 199 U.S.P.Q. 437.

**a. Appellant’s Surveys Demonstrated that The Relevant Public Uses the Mark Generically; Their Weight and Credibility Were Determinations to Be Made By the Jury**

Doubts as to the methodology, the design, the reliability, and the experience and reputation of the expert go to the weight of the survey, a question for the jury:

“Treatment of surveys is a two-step process. First, is the survey admissible? That is, is there a proper foundation for admissibility, and is it relevant and conducted according to accepted principles? See *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 814 (9th Cir.1997); *E. & J. Gallo*

*Winery*, 967 F.2d at 1292–93. This threshold question may be determined by the judge. Once the survey is admitted, however, follow-on issues of methodology, survey design, reliability, the experience and reputation of the expert, critique of conclusions, and the like go to the weight of the survey rather than its admissibility.

*Stuhlbarg*, 240 F.3d at 840. These are issues for a jury...”

*Clicks Billiards, Inc. v. Sixshooters, Inc.* (9th Cir. 2001) 251 F.3d 1252, 1263.

**i. Appellant’s Google Consumer Surveys Were Admissible and Probative**

Courts have come to expect consumer surveys on the issue of genericness. However, in doing so, Courts often overlook a very practical problem with such a requirement: cost. With surveys costing anywhere from ten to a hundred thousand dollars to conduct, should Courts continue to require, in order to prove genericness, traditional *Teflon* or *Thermos* surveys, they will likely eliminate the ability of all but the most wealthy Parties to litigate the issue of genericness. Appellant in this case, faced with this dilemma, resorted to the most economical and simultaneously objection-proof solution it could find: Google Inc.’s own consumer survey service. After all, how could Google Inc. object to the reliability and methodology of its own

survey engine? Despite this, Google Inc. did in fact challenge the surveys conducted by Appellant using Google Inc.'s own survey engine.

Appellant's Google Surveys can be found in the record at 10 ER 2225-2227 and 3 ER 488-490. These surveys poll google.com users who are accessing premium content. They collect demographic information on respondents by age, income, and geographic location in the United States, and results can be sorted according to that information. 2 ER 76 (Decl. Wirtz, ¶17). The demographic information collected with regards to the respondents of Appellant's Google Survey can be found at 3 ER 50-73. The sample was the national adult Internet population. The question posed was close ended, and the order of possible answers was randomized. Google Inc. itself provided a white paper on the accuracy of its surveys, though it has since deleted this white paper. 2 ER 76 (Decl. Wirtz, ¶17).

Appellant's attorney, Richard Wirtz did not conduct these surveys, and it was error for the district court to find that he did. These surveys are automated. Mr. Wirtz's only role therein was in writing the questions and the available answers. He had no interaction with the respondents, did not tally the responses or analyze the data. He had no more involvement in the conduct of the surveys than any other attorney engaging any other survey expert to conduct a genericness survey. His involvement

was limited to the writing of the questions and, per *Clicks Billiards*, challenges to the form, format, and content of the questions and possible answers goes to the weight but not the admissibility of the surveys.

Most importantly, at the bottom of each survey results page it clearly states: "Methodology: Conducted by Google Consumer Surveys..." See 1 ER 50. Google Inc. Could not therefore challenge the methodology of surveys which Google Inc. Itself conducted. The surveys themselves were an admission and thus should have been admitted. Any challenge to these surveys should have been to the questions themselves and the possible answers given which, per *Clicks Billiards* goes to the weight but not the admissibility of the surveys. And the weight of these surveys was a matter for only a jury to decide.

Appellant's first survey (1 ER 50) asked the relevant public to select an answer for the following: "I most often use the word 'google' to mean." The survey returned 747 responses. Of these, 52.2% chose "to search something on the internet" (i.e. verb usage), while only 28.7% chose "the name of a specific search engine" (arguably trademark usage). The remaining 19.1% chose "the Internet (in general)."

Appellant's second survey (1 ER 64) asked the relevant public to select an answer for the following: "I most often use the word 'google' to mean." The survey

returned 707 responses. Of these, 72% chose "to search something on the internet," 16.6% chose "the Internet (in general)," and just 11.5% chose "the name of a company."

In both of these surveys, respondents were presented with answers and allowed to select only one. They were asked to choose the one they *most often* use. These questions were intended to test the *primary* significance of the word "google" to the relevant public: the national adult internet population. In response to both, a much higher percentage of respondents selected a non-specific (i.e. generic) usage than selected a usage which specifically indicated Google Inc. (I.e. "a specific search engine" or "the name of a company"). These results clearly demonstrate that the relevant public more often uses the word google as a verb than it uses the word to indicate Google Inc. or its specific search engine product. In short, verb usage is primary usage.

Based on this data, a reasonable jury could conclude that GOOGLE is generic.

**ii. Appellant's Thermos Survey Was Admissible and Probative**

Faced with Google Inc.'s ironic challenges to Appellant's Google Surveys, Appellant also engaged a survey expert to conduct a more traditional Thermos style

survey. 5 ER 861. A Thermos style survey was selected over a Teflon style survey because a Thermos survey allowed for the testing of verb usage, whereas Teflon did not. “Under this protocol the respondent is a provided a description and asked to identify what is being described.” 5 ER 867 (Berger Survey Report ¶10).

251 respondents were asked a series of screening questions and then 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?" 129 of the 251 respondents used the word "google" in their response. Of those 129, 125 used the word generically (google/google it/google something/google this), while only 4 or 1.6% used the word in a manner clearly intended to refer to Google Inc. (Google search/Bring up google/go to google.com). 5 ER 903-906. Based on these responses, Appellant’s expert opined that the results “proved beyond any doubt that the primary significance ‘google’ to the relevant public when used as a verb is generic and commonly used to mean search on the internet.” 5 ER 871.

The district court admitted Appellant’s Thermos survey. However, it then proceeded to dismiss its results as wholly irrelevant to the issue at hand, which it then incorrectly framed as “whether the *primary* significance of the GOOGLE mark to a majority of the consuming public is an indication of search engines in genreal...” 1ER

18. As discussed in greater detail below, the court used an incorrect interpretation of law to wholly discount Appellant's survey. This was clear error. A jury, based on the results of this survey, could have found the GOOGLE mark to be generic.

**iii. Google Inc.'s Survey Intentionally Ignored the  
Verb Usage of the Word Google**

Google Inc. submitted what is known as a Teflon survey, based upon a survey approved by a district court in *E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc.* (E.D.N.Y., 1975) 393 F.Supp. 502, in support of its argument that the word google is not generic. A "teflon" survey explains the difference between a brand name and a common name and asks respondents to classify a list of words (including the word at issue) as brand or common. In the original "teflon" survey, after confirming the survey respondents' understanding of the difference between a brand name and a common name, interviewers read a list of eight words, including the word at issue, or the "test" word (TEFLON), and seven other words that served as "controls" (STP, COKE, JELLO, THERMOS, MARGARINE, REFRIGERATOR, and ASPIRIN). Survey respondents were asked to classify the word as a brand name or a common name.

When the *E.I. duPoint* court in 1975 approved of the use of the "teflon" survey,



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

The critical question is: what is the principle significance of the word to the public? In other words, how do people most often use and understand the word? The “teflon” survey does not come close to answering that question in this case. Instead, it presupposes usage as a noun (generic) or an adjective (brand) and asks respondents to sort words into those two categories. It does not ask how they most often use the word in question (as a noun, adjective, or verb) and it does not ask whether that primary usage is meant to communicate a particular producer of a product or service.

To understand exactly how off-target a “teflon” survey is in this case, one need only look to Google Inc.’s “teflon” survey, conducted by expert witness Dr. Gerald

L. Ford. Google Inc.'s survey essentially duplicated the original "teflon" survey, with minor substitutions. Respondents were first told:

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

By a brand or proprietary name, I mean a name like 'Chrysler' which is 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.

Respondents were then asked:

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

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

Respondents who answered these two questions "correctly" were told:

Now, I am going to read you some names and ask you to tell me whether 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.

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

The names then provided to respondents were: STP, COKE, JELLO, REFRIGERATOR, MARGARINE, ASPIRIN. Respondents then were asked to again classify a list of "names", this time "with respect to search the internet": BROWSER,

WEBSITE, AMAZON, YAHOO, AND GOOGLE. Not surprisingly, 93.77% of the 401 respondents, when given the choice between brand “name” and common “name,” chose brand for GOOGLE. The point of this case is **not** whether google is a generic word for search engine; it is whether google is a generic word for the act of searching on the internet.

The *Anti-Monopoly* case is instructive:

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

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

684 F.2d 1316, 1323-24 (9th Cir. 1982)(emphasis added). Similarly, in this case the results of Google Inc.'s Teflon survey have no relevance to the question in this case.

Google Inc.'s survey ignored verb usage of the word google altogether and merely duplicate the original Teflon survey with substitutions. It tells us nothing about the primary meaning of google in the minds of consumers.

**b. Appellant's Linguistic Experts Opined that GOOGLE is Generic**

Appellant introduced the opinions of not one, but two expert linguists: Dr. Patrick Farrell (See 2 ER 296 for Dr. Farrell's report), and Dr. Allan Metcalf (See 2 ER 317 for Dr. Metcalf's report). Both of these experts opined that the word google has become generic and means "to search on the internet." Their conclusions, and their analysis supporting those conclusions, could lead a reasonable jury to conclude that the word google is generic.

**i. It Is the Province of the Jury to Weigh Appellant's Linguistic Experts' Opinions Against the Opinion of Google Inc.'s Conflicted Linguistic Expert**

Google, Inc., to counter the expert opinions of Metcalf and Farrell, submitted the expert opinion of Geoffrey Nunberg. However, Google Inc.'s expert linguist, Geoffrey Nunberg, was first contacted regarding his services by Plaintiff's counsel in December of 2012. (2 ER 77) Plaintiffs counsel sent Nunberg the complaint asking

if he would be an expert in the case. (2 ER 77) In addition, Plaintiffs' counsel left Nunberg a voicemail explaining Plaintiffs' theories in the case. (2 ER 77) In response, Nunberg emailed that he thought the case was "interesting" and that he would be "happy" to discuss being Plaintiff's expert. (2 ER 77) On December 5, 2012, Nunberg and Plaintiff's counsel had a telephone conversation about the case and Plaintiffs' theories and strategies thereof. (2 ER 77) Following the conversation, Plaintiff felt that Nunberg was "on board" with being Plaintiffs' expert witness. (2 ER 77) The next day, Nunberg sent Plaintiffs' counsel several expert witness reports he had prepared in prior cases to ensure that he had not previously expressed any conflicting opinions that could be used to impeach the opinion he would give in this case (at that time contemplating an opinion in favor of Plaintiffs). (2 ER 78) After reviewing these reports, on January 30, 2013, Plaintiffs' counsel told Nunberg that Plaintiffs were interested in retaining Nunberg as an expert witness. (2 ER 78) On March 4, 2013, however, Nunberg told Plaintiffs' counsel "I was looking forward to working on [your case], but some health issues make it difficult for me to make commitments over the intermediate term, so I'll have to pass." (2 ER 78) He apparently had gotten a higher offer from Google Inc..

Despite all this, Nunberg then reversed his opinion and provided an opinion for Google Inc. (See 2 ER 89, Report of Geoffrey Nunberg.) He is clearly a hired gun

who will say anything he is paid to say.

In addition, some of Nunberg's opinions contradict existing law. Nunberg opines that a trademark can be "representative" of a genus without being generic – "It sometimes happens that highly distinctive and famous marks...are used in 'representative' ways to stand in for a genus of goods...We do not read such uses as generic..." However the very definition of a generic word is one which represents the genus, rather than the product of one specific producer. *Abercrombie & Fitch Co. v. Hunting World, Inc.* (2d Cir. 1976) 537 F.2d 4, 9 ("A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.")

Finally, Nunberg's opinion makes no logical sense. Nunberg opines that a verb can never function as a trademark ("Verbs can't be trademarked in the first place." 2 ER 141.)(2 ER 264 (Depo of Nunberg at 34:19-21)) The logical conclusion to be drawn from this opinion is that verb usage is necessary non-trademark (or generic) usage. Thus, if the majority usage of a word is as a verb, then the word is generic. However, Nunberg opines that use of the word google as a nonspecific verb denotes use of Google's search engine. This opinion makes no sense. How can a "nonspecific" word connote a *specific* search engine? As a result of this inconsistency, Dr. Nunberg's opinion completely lacked credibility.

These serious flaws in the opinion of Dr. Nunberg could lead a jury to discount Dr. Nunberg's opinions.

**c. Appellant's Dictionary Evidence Shows that the Primary Significance of the Mark Is As a Generic Verb**

Collins English Dictionary defines google the noun as a trademark, but defines google the verb as “(without a cap) **2** to search for (something on the internet) using a search engine **3** to check (the credentials of someone) by searching for websites containing his or her name.” (5 ER 942.) Clearly, this verb definition is generic.

Dictionary.com does the same, defining the noun as a trademark and the verb “(used with object)...**2**. (Often lowercase) to search the Internet for information about (a person, topic, etc.): We googled the new applicant to check her background. Verb (used without an object)...**3**. (Often lowercase) to use a search engine such as Google to find information, a Web site address, etc., on the Internet.” (5 ER 934.) Again the verb is defined generically.

Wikipedia defines the verb generically as well: “However, it can also be used as a general term for searching the internet using any search engine, not just Google.” (5 ER 936.)

And while the Oxford English Dictionary defines the verb google specifically (probably as a result of pressure from Google Inc., as discussed below) OED's entry

for the verb suggests that google is in fact generic by:

(i) the etymological note, which states that this is a *derivation from* the proprietary name [rather than stating that it *is* a proprietary name]; (ii) the particular choices for illustrative examples [which includes lower case and non-specific examples]; and (iii) the fact that the OED, as a general rule, does not have entries for proprietary names that have not undergone significant genericization, as evidenced by the lack of any entry for the 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, 2 ER 300.)

**i. The Very Inclusion of a Trademark in a Dictionary is Evidence That The Mark Has Become Generic**

As Plaintiff's expert Dr. Metcalf opined, "[t]he makers of dictionaries are cautious when it comes to mentioning trademarks." (Metcalf Report, 2 ER 323.) "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." (Metcalf Report, 2 ER 323.) "[T]he OED [Oxford English Dictionary], as a general rule, does not have entries for proprietary names that have not undergone significant genericization." (Farrell Report, 2 ER 300.)

**ii. Evidence of Reference to Google Inc. In Some Dictionary Definitions of GOOGLE May Be**



**Discounted By the Jury Because Google Inc. Has  
Engaged In a Pattern of Threatening and  
Intimidating Dictionary Publishers.**

Dictionaries and the media can be, and are, bullied by well-funded trademark owners into affording more trademark significance to a word than the relevant public does. For example, Merriam-Webster flat-out admits that it has tempered its definition of google as a result of its fear of Google Inc.: “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. 2 ER 294.

In 2003, WordSpy (an online dictionary of new words) included an entry for the verb google, “To search for information on the Web, particularly by using the Google search engine.”(9 ER 2125) Google Inc.’s trademark attorneys wrote Word Spy “asking” Word Spy to “help us to protect our brand by deleting the definition of "google" found at wordspy.com or revising it to take into account the trademark status of Google.” Word Spy chose the latter option, but not before forwarding Google Inc.’s “request” to its entire list serve, asking:

I understand what's involved in trademark protection, but "google" is an important new verb, so I certainly don't want to delete it from the site. I also don't want any legal hassles. Is there a response I can send to this

lawyer that will allow me to keep this entry? What if I just acknowledge that Google(tm) is a trademark of Google Technologies Inc.? Would that be good enough?

When is a word deemed to have become generic? Search Lexis-Nexis for "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.

(9 ER 2125)

Google Inc. 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.” (5 ER 938) 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.”

**d. Appellant’s Evidence Shows that Google Inc. Has Used**

### **the Mark Generically as a Non-Specific Verb**

On July 8, 1998, Google Inc. Cofounder Larry Page urged email recipients to “Have fun and keep googling!” (9 ER 2122.) Thus it was Google Inc. itself which first encouraged the public to use google as a *lower-case* verb. That is exactly what the public did. This is strong evidence that the verb google is generic.

Perhaps most tellingly, Google Inc.'s own search engine, at the time of the briefing before the district court, when asked to "define google" (even when "Google" is capitalized) returned a definition of "google" (lower case) as a verb. (10 ER 2223.)

The definitions returned were:

1. Use an Internet search engine, particularly Google.com: “she spent the afternoon googling aimlessly”
2. Search for the name of (someone) on the Internet to find out information about them.

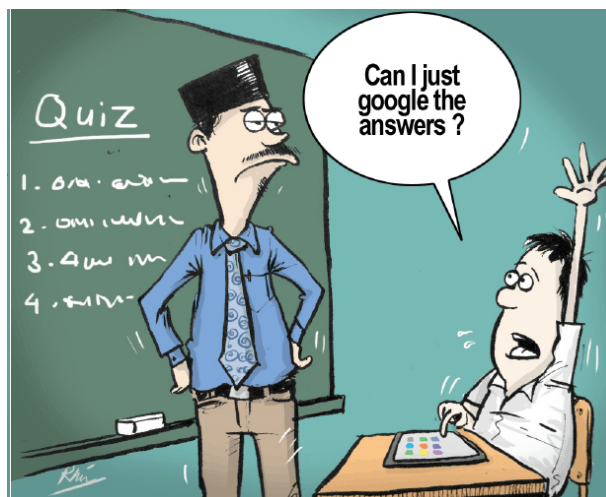
The first definition defines google as to “[u]se **a** search engine” (emphasis added), “**particularly** [but not exclusively] Google.com[.]” This definition then includes an example in which google appears in the lower case and which does not include any specific reference to Google Inc.’s particular search engine. The second definition omits any reference to Google Inc.’s search engine whatsoever. This true is strong evidence of genericness.

**e. Appellant’s Evidence Demonstrates that the Word “Google” Is Frequently and Primarily Used by the Media as a Generic Verb**

**i. Appellant Submitted Numerous Examples of Media Usage of GOOGLE in a Non-Specific Manner**

In support of their motion for summary judgment, and in opposition to Google Inc.’s motion for summary judgment, Plaintiffs introduced a multitude of examples of media usage of the word google as a generic verb. These include examples wherein google is used without reference to Google Inc.’s search engine in particular, and (even more persuasively), examples where the verb google is not capitalized. Use of a trademark in all lowercase, without another generic term attached, is generic usage.

Take the following for example:



(4 ER 739). Plaintiffs submitted numerous media examples like this. In this example, google appears in lower case, clearly used as a verb, and without any reference to Google Inc.'s search engine. The tablet before the student does not display Google Inc.'s search engine. The verb is being used non-specifically.

Plaintiffs submitted a results list (5 ER 843-849) of 80 movies and tv series with quotes that include the word google, which include numerous examples of generic verb usage of the term:

[The Office \(2005 TV Series\)](#)  
Episode: [Launch Party \(2007\)](#)  
Angela is worse than usual lately, and we have a party to throw, so I *googled*, "How to deal with difficult people." And I got all of this.

Plaintiff submitted a list of songs which use google as a generic verb. (5 ER 820-829.) For example:

[T-pain - Bottlez Lyrics](#)

Baby it's okay, you can **Google** my name. Got that, Rozay, Rozay Rozay Rozay, Ro  
Rozay Na na na, gon' pop that thang. Shak it so hard got you spillin your ...  
[www.musicsonglyrics.com/bottlez-lyrics-tpain.html](http://www.musicsonglyrics.com/bottlez-lyrics-tpain.html)

(5 ER 828.)

Plaintiff also submitted the results of searches on Google Inc.'s own search engine for books which use google as a generic verb, including the excerpts from the books wherein the generic verb is used. For example, Plaintiff submitted the following excerpt from *I'm With Fatty: Losing Fifty Pounds in Fifty Miserable Weeks*,

by Edward Ugel:

“‘Not like this. This is something entirely different. This seems ... medical.’

‘Medical?’

‘I googled it.’

‘You googled ‘snoring’?’

‘I googled ‘snoring and weight gain.’“

’What’d it say?’

‘It says we need to talk to a doctor.’” (7 ER 1542)

**ii. Appellant Even Submitted Examples of Media Usage of GOOGLE to Refer to the Act of Searching on Something *Other Than Google Inc.’s Search Engine***

The strongest evidence of the genericness of the word google, as Google Inc.’s own expert opined, are instances in which a person uses the word google and clearly refers to a website other than Google Inc.’s. (See Nunberg Report, 2 ER 92, “Such representative uses can be distinguished from ‘true’ nonspecific or generic uses of marks only when we see the mark used specifically for any product in a genus. To show that Coke had become generic for cola drinks, that is, we would look for statements like ‘Diet Pepsi is a better coke than Coca Cola.’”) Appellant submitted

examples of the media doing just this.

For example, in the episode “Deadly Towers” of the Television series “The Angry Video Game Nerd” a character says “...I googled it to check what it meant, and according to urban dictionary...” (5 ER 848.) 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[.]’” (5 ER 848.)

Plaintiff submitted screenshots of searches for phrases wherein the verb google is used to indicate the act of searching on the internet via a website other than Google Inc.s, which returned the following number of results:

“googled on ebay”: 407 results (5 ER 851)

“googled on facebook”: 41 results (5 ER 853)

“googled on imdb”: 6 results (5 ER 855)

“googled on pinterest”: 27 results (5 ER 857)

“googled on wikipedia”: 136 results (5 ER 859)

This is clear evidence that the public (and the media) is using the verb google to mean to search the internet *using a service other than Google Inc.’s*.

**f. Appellant Submitted Direct Evidence of *Consumer Usage of the Verb “Google” to Mean Searching On the Internet On Something Other Than Google Inc.’s***

## **Search Engine**

Perhaps most tellingly, Appellant submitted fourteen different Proposal Request Forms submitted by actual people. (5 ER 832-841.) In these request forms, each respondent is asked “How did you hear about us?” and each of their responses use the word google. However, the program which generates these forms tracks the site from which the respondent was referred and each of these fourteen people came from search engines other than Google Inc.’s. This is particularly strong evidence of genericness, as admitted by Google Inc.’s own expert.

**g. Appellant Demonstrated That There is No Available Efficient Substitute Generic Word For the Action of Searching the Internet**

It is well settled trademark law that the lack of an adequate substitute generic word is evidence of the genericness of a former trademark adopted by the public. See *Bayer Co. v. United Drug Co.*, 272 F. 505 (D.C.N.Y. 1921) (consumers knew only the word "aspirin," and did not know the term "acetyl salicylic acid"); see also *DuPont Cellophane Co., Inc. v. Waxed Products Co., Inc.*, 85 F.2d 75 (2d Cir. 1936). (similarly, the availability of the phrase "transparent glycerinated cellulose hydrate regenerated from viscose" did not prevent "cellophane" from being held to be generic); see also *Q-Tips, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (D.N.J.



1952) (alternative terms available, e.g., "medical swab," "applicator," or "cotton-tipped applicator," so term "Q-Tips ha[d] not come to mean to the consumer the product double tipped applicator as distinguished from a certain brand of applicator"); see also *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. 437 (D. Ore. 1978) (similarly, the availability of the descriptive "dictating machine" and "dictation equipment" prevented "Dictaphone" from becoming generic).

Here, consumers have no efficient alternative for the verb google. It would be unnatural and inefficient to require people to say "I searched the internet for her" as opposed to "I googled her."

**h. Lack of Competitor Usage Is Not Probative Given Google Inc.'s Pattern of Threats of Litigation and Is Certainly Not Probative Enough to Overwhelm All of Plaintiff's Evidence of Genericness and Thereby Justify Summary Judgment**

The fact that companies like Bing and Yahoo do not refer to their search engines as "googles" is not, in this case, evidence of non-genericness. There is no doubt that they refrain from doing so for fear of the wrath of Google Inc.: "Indeed, the only evidence that even arguably supports the view that the mark was not generic is the circumstance that other manufacturers did not use the term Murphy bed to describe

their beds. However, that fact is not sufficient to support a conclusion that the mark is not generic, especially since Murphy's action in policing the mark might well have deterred other manufacturers from using the term Murphy bed in describing their products." *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.* (2d Cir. 1989) 874 F.2d 95, 101 fn. 2.

Plaintiff submitted several pieces of evidence which demonstrate that Google Inc. actively polices usage of its mark by competitors, dictionaries, and the media.

Further, even *if* lack of competitor usage of "google" constituted evidence of non-genericness, it could not possibly be so significant as to so strongly outweigh all of Appellant's other evidence to justify the granting of summary judgment.

**3. Given The Sheer Quantity of Evidence Presented by Appellant of the GOOGLE Mark's Genericness, the District Court Could Not Possibly Have Properly Found That There Was No Genuine Dispute of Material Fact With Regards to Genericness and That No Jury Could Find the Mark to be Generic.**

In order to grant summary judgment on an issue which is predominately, if not completely, an issue of fact, the court must find that there was no genuine dispute as to that fact. Such has been the case in cases where one side fails to produce any

evidence on the “disputed fact” in question, or produces evidence so lacking in persuasiveness (such as self-serving declarations) that the Court may conclude that no reasonable jury could find other than one way. This is very clearly not the case here.

**B. The District Court Made Several Erroneous Findings of Law Which It Used to Discount or Ignore Appellant's Evidence.**

As mentioned above, the district court discounted Appellant’s evidence of genericness to the point of holding it to be no evidence at all of genericness, by making several erroneous holdings of law.

**1. The District Court Erred in Failing to Find That a Verb Usage of a Mark is Generic Usage**

The district court held: "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."

The district court proceeded on this mistaken assumption that there are discriminate and indiscriminate verbs and that a trademark can be used as a

discriminate verb and still function as a trademark. Thus, where Appellant introduced a wealth of evidence of verb usage, which should have all been considered as generic usage, the district court erroneously deemed that evidence to be irrelevant. This was error.

The term “discriminate verb” exists nowhere in the law. It is a term entirely invented by the district court. In reality, there is no such thing as a discriminate verb. Verb usage, being inherently indiscriminate, is generic usage.

**a. Trademarks are Adjectives Because Their Function Aligns with the Function of Adjectives Generally: Modifying and Describing a Noun**

A part of speech is a category to which a word is assigned in accordance with its syntactic functions. The function of the usage of the word defines its part of speech. The same word can be assigned to more than one part of speech when it is used to perform more than one syntactic function and each part will have a different meaning. A noun is a thing; an adjective is a word that modifies and describes a noun; and a verb is a word that expresses an action.

A trademark is a word that performs a function: "to identify and distinguish" the goods of one producer from those manufactured or sold by others and thereby indicates source. 15 U.S.C. §1127 (definition of "trademark") *Qualitex Co. v.*

*Jacobson Prods. Co.* (1995) 514 U.S. 159, 163. Certain words are not trademarks because they do not perform this function. *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.* (9th Cir. 1982) 684 F.2d 1316, 1319 ("It is the source-denoting function which trademark laws protect, and nothing more.") We call these words, which do not perform a source-identifying function, generic.

A word can only perform a source-identifying function when it is used as an adjective, modifying the generic name of the thing in such a manner as to indicate its source.<sup>1</sup> The generic noun tells what the product is, the adjective (or attributive noun) adds information by specifying from whom the product comes (i.e., NIKE shoes). Verbs are entirely outside of this structure. A verb is action. It tells what you are doing. It cannot distinguish one product from another. Verbs therefore cannot perform the source-identifying function which trademarks, by definition, must perform. Verbs cannot function as trademarks.

**b. In the Context of the Accepted Who Are You/what Are**

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<sup>1</sup>Some scholars prefer to classify trademarks as "attributive nouns" (i.e. nouns that modify other nouns) rather than adjectives. See Geoffrey K. Pullum, "Punctuation and 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). Google Inc.'s expert witness, Geoffrey Nunberg, is of this view. Regardless of the term assigned to trademarks it is clear that their function is to describe and/or modify nouns in order to designate the source of the noun.

**You? Test, Verbs Answer the Question "What Are You (Doing)?" While Trademarks Answer the Questions "Who Are You?" "Where Do You Come From?" "Who Vouches for You?"**

In determining whether a word is generic or non-generic in this circuit, we use the who are you (from)/what are you dichotomy. "A mark answers the buyer's questions "Who are you? Where do you come from?" "Who vouches for you?" But the name of the product answers the question "What are you?" 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 (Quoting test); *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.* (9th Cir. 1999) 198 F.3d 1143 (quoting treatise test with approval); *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.* (9th Cir. 2005) 419 F.3d 925; *Rudolph Intern., Inc. v. Realys, Inc.* (9th Cir. 2007) 482 F.3d 1195.

No prior case has dealt with whether and how this test works in the context of a former trademark being used as a verb. However, with only slight modification, this test can be adapted to fit this new scenario. A trademark still answers the questions: "Who are you? Where do you come from?" "Who vouches for you?" A verb answers the question: "What are you doing?"

- c. A Trademark must Be Specific; it must Designate Just One Source, Even If the Identity of That Source Is Unknown. Verbs Are Not Specific with Regards to Which Object Must Be Used to Accomplish the Action Described, Much Less Which Producer the Object Must Come From.**

Trademarks specifically identify just one source. Though that source can be anonymous, the case law is clear that it must be singular. Use of a trademark is a way of saying "I want a cola that's made by the Coca Cola company, because I have had their cola before and I like it and that is exactly what I want." Instead, all you have to say is "I'll have a diet Coke" When that word—COKE—stops indicating one specific source of the cola, and instead can be understood to mean Coca Cola or any other equivalent cola made by any company, then it stops performing the function of a trademark, as discussed above.

Verbs are not and cannot be specific. They describe an action, not an object. Even verbs which describe an action that necessarily requires an object are not specific with regards to the object. Think, for example, of the verb "sweep." While one's mind might immediately think that you sweep with a broom, you can also "sweep" crumbs off the counter with your hand, or "sweep" someone off their feet.

The verb is not and cannot be specific.

**d. The TTAB and At Least One District Court Have Recognized The Dichotomy Between Verbs and Trademarks**

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



of highly specialized adjudicators.")

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

The district court declined to follow the logic of these cases. However, that was an error which this Court may review de novo. While these cases are not precedential, they follow common sense and the letter and spirit of the Lanham Act by striking the appropriate balance between the interests of trademark owners and the interests of the public.

**e. Other Respected Secondary Sources Recognize That Trademarks Are Not Verbs**

The International Trademark Association's (INTA) "Guide to Proper Trademark Use" states "[t]rademarks and service marks are proper adjectives. Not nouns. Not verbs. A mark should always be used as an adjective qualifying a generic noun that

defines the product or service." (4 ER 732) INTA is not alone in recognizing that verbs cannot function as trademarks. For example: (1) Gilson on Trademarks provides practice tips to reduce risk of genericism, including using word marks as "a proper adjective that modifies a noun" and not using a trademark in the possessive, in the plural, or as a verb. Gilson on Trademarks § 2.02[6] (Karin Green ed., 2010); (2) Sidney A. Diamond, attorney, trademark scholar, and Federal Commissioner of Patents, Trademarks and Copyrights, in his "How to Use a Trademark Properly", 61 Trademark Rep. 431, 432, 438–39 (1971), recognizes the rules for proper trademark use, including ensuring use as a "proper adjective" and avoiding "incorrect grammatical form[s]," plurals, and possessives; (3) John Dwight Ingram, in his article "The Genericide of Trademarks", warns that "Trademark owners should never use the trademark as a verb or noun, which implies that the word is generic." Buffalo Intellectual Property Law Journal, Vol. 2:154, pg 160.

**f. Google's Own Expert Opined That a Verb Cannot Serve as a Trademark**

Google Inc.'s own expert witness, Geoffrey Nunberg, both in his expert report and during his deposition, stated unequivocally that "a verb cannot serve as a trademark." (2 ER 264 (Depo of Nunberg at 34:19-21))

**g. A Simple Verb/Trademark Dichotomy is Appropriate**

### **and Efficient**

As the analysis above demonstrates, a verb can never perform a source-identifying function, and it can therefore never be a trademark. Given this fact, it is appropriate and efficient to hold that when a mark is used as a verb, this is a generic usage. By so doing, language would be encouraged to evolve in a natural way whereby a singular term is adopted to convey a more complex meaning. By simplifying language and cutting down the number of words necessary to convey an idea, communications costs (in terms of time primarily) are reduced. What may seem obtuse can be re-phrased rather simply: why require people to use four words to express an idea (search on the internet) when one word (google) could convey the same meaning?

This holding has two consequences. First, when that generic verb usage becomes the primary significance of the (former) mark to the public, then the mark has become generic. Second, when a mark is used as a verb (i.e. generically), this is fair use. Practically speaking, if this Court were to hold in accordance with these principles, this does not mean that Bing could begin advertising their ‘Bing google.’ It simply means that they could advertise their services by, for example, saying that consumers can google more thoroughly on Bing.

The district court declined to make such a holding (that a verb cannot function

as a trademark and therefore verb usage is necessarily generic usage). This Court should not make the same error. The conclusion is one of logic. A trademark designates source. A generic word does not designate source. Similarly, a verb cannot designate source. Therefore a verb cannot be a trademark and must be a generic word. Verb usage is therefore generic usage.

**2. The District Court Erred In Holding That Generic Verb Usage of a Mark Is Completely Irrelevant to the Genericide Inquiry**

The district court not only failed to find that verb usage is generic usage, it went a step further. The court stated that "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." This framing of the inquiry completely ignores whether the primary significance of the word google to the public is as an indiscriminate verb. The district court seemed to find that, so long as when a mark is used as an adjective it is used in a discriminate sense, that mark cannot be found to be generic, *even if it is primarily used as something other than as an adjective* (such as when it is used as a verb) and, when so used in its primary manner, it is used generically. It therefore found that verb usage is *entirely irrelevant* to the

genericness inquiry and thereby entirely dispensed with Appellant's evidence of genericness. This cannot withstand scrutiny.

**a. Generic Verb Usage Is Evidence That a Mark Has Become Generic**

Even if this Court does not accept Plaintiff's position that a verb can never function as a trademark, and even if this Court instead adopts the district court's finding that a verb can either be used specifically (which would constitute trademark usage) or non-specifically (which would constitute generic usage), it still must acknowledge that *when* a trademark is used as a non-specific verb (i.e. when it is used generically) then this evidence of generic usage is relevant to the genericness inquiry. Evidence of non-specific verb usage must be collected with evidence of specific adjective and verb usage, and this evidence must be weighed in order to find the primary significance of the word to the relevant public. To ignore an entire body of evidence of generic usage contradicts the letter and spirit of the Lanham Act.

**b. When the Primary Significance of a Mark to the Consuming Public Is as a Generic Verb, Then the Mark Is Generic.**

Taking into account *all* evidence of usage of a word, a court must then find what the primary significance of that word is to the relevant public. If the primary

significance is as a trademark, then the word is a trademark. If the primary significance is as something other than a trademark, then the word is generic. In the context of this case, if the primary significance of the word google is as a non-specific verb, then the word is generic. As discussed in more detail *infra*, the primary significance of a word is how that word is most often used by the public. So, if google is most often used by the public as a non-specific verb, then it is generic.

**3. The District Court Ignored Binding Precedent, the Lanham Act Itself, and the Important Policy Reasons Behind the Genericness Doctrine in Holding That a Mark Cannot Become Generic Through Public Appropriation of an Arbitrary or Fanciful and Famous Mark.**

The district court held that: “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.” 1 ER 8. This is contrary to the doctrine of genericide and the Lanham Act.

The very definition of genericide is when a mark is so widespread that the public has expropriated it for a use other than as a trademark. The district court

clearly expressed its discomfort with stripping a trademark owner of its trademark as a result of *too much success*. However, this process of public expropriation is not novel, it has occurred many times before. All coined marks that have been found to be generic – escalator for example – have only become so as a result of widespread use by the public. The public adopts the mark as the word for the “thing” and so makes the mark generic. This is unfortunate for the owner of the mark but good and necessary for the public and for the natural evolution of language.

**a. The Escalator and Murphy Bed Trademarks Became Generic Through Public Appropriation**

The word escalator used to be a trademark belonging to the Otis Elevator Company. Otis manufactured the first moving stairway under the mark ESCALATOR. The mark was registered on May 29, 1900. Because Otis's escalator so dominated the moving stairway market, the public began to recognize "escalator" as the name for a moving stairway, without reference to the maker thereof. Fifty years later, a competitor brought an interference proceeding and cancelled the registration on the grounds that the mark was generic. In affirming the cancellation, the commissioner of patents found relevant (1) the term "escalator" means any moving stairway without reference to the maker thereof, (2) that, in advertisements, "escalator" was written in small letters and in the same manner and same context as other generic words, such

as "elevator," and (3) in a model standard safety code for elevators, dumbwaiters, and escalators, "escalator" was defined as "a moving inclined continuous stairway or runway used for raising or lowering passengers[,]" without indication of origin.

The term murphy bed also used to be a trademark. In the early 1900s, William Lawrence Murphy invented and manufactured the first wall bed. He began to sell these beds under the mark MURPHY BED in 1925. In the early 1980s the Patent and Trademark Office denied Murphy Co.'s application to register the MURPHY BED mark on the grounds that the term "Murphy bed" was "used by a substantial segment of the public as a generic term for a bed which folds into a wall or closet." In the mid 1980s, a competitor (and former distributor) of Murphy Co. began to call their wall beds "Murphy beds." In the lawsuit that followed, the Second Circuit found that the term "Murphy Bed" was generic and therefore that the claim of Murphy Co. For trademark infringement "must fail." "Neither statutory law, namely the Lanham Act, nor common law supports a claim for trademark infringement when the mark in question is generic." *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.* (2d Cir. 1989) 874 F.2d 95, 101. The court recognized that Murphy Co. was the first to coin the word Murphy to describe a wall bed, but that, over time, the public expropriated the term as a synonym for wall bed. The court found relevant the fact that the term 'Murphy bed' was included in many dictionaries as a term for wall bed. "While



dictionary definitions are not conclusive proof of a mark's generic nature, they are influential because they reflect the general public's perception of a mark's meaning and implication." In addition, the court found relevant the numerous examples before it of newspaper and magazine use of the phrase Murphy bed to describe a type of bed as "a strong indication of the general public's perception that Murphy bed connoted something other than a bed manufactured by Murphy Co." *Id.* At 101. Addressing the evidence of Murphy Co's efforts at policing its mark, the court found these efforts "of no consequence" to whether a mark is generic. *Id.*

Thus it is clear that formerly arbitrary or fanciful marks have in many previous instances been found generic, regardless of the "fairness" to the former trademark holder.

**b. The Lanham Act Allows Cancellation of Marks Which Become Generic**

15 U.S.C. §1064 provides that a petition to cancel a registration of a mark may be filed by any person who believes that he is or will be damaged by the registration if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered. This section also permits the Federal Trade Commission to apply for cancellation of a registered mark on the grounds that the mark has become generic. The very inclusion of this section in the Lanham Act

demonstrates not only that a previously registerable mark may become generic, but, by providing a mechanism for cancellation of generic marks, reflects the perceived importance of denying trademark rights to marks which have become generic.

**c. There are Important Policy Reasons Which Justify Denying Trademark Protection to Marks Which Have Become Generic**

The legislature had reason to consider, in connection with a proposed amendment to 15 U.S.C. §1064, the policy reasons which justify denying trademark protection to marks which have become generic. During the hearings before the subcommittee on courts, civil liberties, and the administration of justice of the committee on the judiciary house of representatives on H.R. 3685, Alfred F. Dougherty, Director of the Bureau of Competition of the Federal Trade Commission, testified as to the “important public interest” justifying the cancellation of generic marks. Hearings on H.R. 3685 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 96th Cong., 1st Sess. (1979) [hereinafter cited as *Hearings*] (statement of Alfred Dougherty). Mr. Dougherty’s testimony directly contradicts the holding of the district court in this case: “It may seem at first blush that canceling a trademark that has become generic subsequent to registration imposes an unjustified hardship on its owner, who may

have expended considerable sums in advertising and promoting it. Yet, as generations of judges and the framers of the Lanham Act recognize, this perception is erroneous.”

*Hearings* (Statement of Alfred Dougherty at 37.)

Initially, Mr. Dougherty observed that the possibility of perpetual existence is an essential difference between trademarks and other forms of intellectual property such as patents and copyrights. Therefore, there are certain grounds upon which an injured party may seek cancellation of a registered mark and “cancellation on any of these grounds vindicates public as well as private interests. A trademark which offends any of these provisions harms rather than benefits the public and therefore not entitled to the public’s grant of protection.” *Hearings* (Statement of Alfred Dougherty at 35.) With regards to generic trademarks, Mr. Dougherty explained the following harms resulting from continued protection of generic marks:

**i. Generic Marks Hurt Competitors and Stifle Competition**

If one competitor could get (or maintain) the exclusive right to use of a generic terms in connection with the goods to which it applies, other competitors would be “hard pressed to adequately describe and promote their products to the public.” *Hearings* (Statement of Alfred Dougherty at 36.) “Without calling the new produce by its generic name, the newcomer must convince consumers that the new product is

a functional substitute for the generically-branded product. This requires an extra investment...Furthermore, to induce consumers to experiment with the new product, the entrant might have to set an initial price so low as to preclude entry by all except large, well capitalized firms.” *Hearings* (Statement of Alfred Dougherty at 36.)

**ii. Generic Marks Hurt Consumers**

Without the use of the generic term, consumers would be reluctant to experiment with other products not called by the generic name (fearing that the other products are not the functional substitute for the generically-branded product) and would therefore be likely to pay more to purchase the generically-branded product from the trademark holder.

Further, “use of a product’s generic name is the exercise of a right possessed by all –and in the free exercise of which the consuming public is deeply interested.”*Hearings* (Statement of Alfred Dougherty at 37.)

**iii. Generic Marks Hurt Parallel Markets**

Mr. Dogherty provides the following example:

Consider the situation that would prevail if the now generic word ‘linoleum’ were still a trademark and could only be used commercially in connection with one firm’s products. How does a merchant who sells a cleaner for linoleum-type products effectively advertise and promote

his product, or a contractor who installs that type of produce acquaint the public with his services? *Hearings* (Statement of Alfred Dougherty at 36.)

## VIII. CONCLUSION

For the foregoing reasons, the decision of the district court must be reversed and the case remanded for trial.

DATED: August 27, 2015

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**IX. CERTIFICATE OF COMPLIANCE**

I certify that the attached Opening Brief complies with the type-volume limitation of FRAP 32(a)(7)(B) in that the brief contains 13,766 words excluding the portions exempted by FRAP 32(a)(7)(B)(iii). The brief's type size and type face comply with FRAP 32(a)(5) and (6)

DATED: August 27, 2015

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By: /s/ Richard M. Wirtz  
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**X. STATEMENT OF RELATED CASES**

There are no cases pending in this Court known to Appellant which would be deemed related.

DATED: August 27, 2015

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