

No. 15-15809

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

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DAVID ELLIOTT, an Individual, and CHRIS GILLESPIE, an Individual,

*Plaintiffs-Appellants,*

versus

GOOGLE INC., A DELAWARE CORPORATION,

*Defendant-Appellee.*

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On Appeal from the United States District Court for the District of Arizona,  
District Court Case No. 2:12-CV-01072-SMM  
The Honorable Stephen M. McNamee

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**GOOGLE INC'S ANSWERING BRIEF**

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**CORPORATE DISCLOSURE STATEMENT**

Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure, Defendant-Appellee Google Inc. certifies, through its undersigned counsel, that: (a) Google Inc. is a wholly owned subsidiary of Alphabet Inc., a publicly held corporation; and (b) Alphabet Inc. has no parent corporation and no publicly-held corporation owns 10 percent or more of its stock.

Respectfully submitted,

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## **INTRODUCTION**

The federally registered GOOGLE trademark is one of the strongest and most widely recognized brands in the world. Undisputed survey evidence shows that nearly 94 percent of the Internet-consuming public recognizes GOOGLE as a trademark. Dictionaries consistently define GOOGLE with specific reference to the company or the Google search engine. Even Plaintiffs' linguistics experts agree that the GOOGLE mark functions as a trademark and serves to designate Google as the unique source of its renowned search engine. In short, the evidence of record in this case overwhelmingly establishes that GOOGLE is not generic, but a valid, protectable trademark. The District Court properly granted summary judgment to Google on Plaintiffs' suit to cancel the GOOGLE registrations.

On appeal, Plaintiffs point to evidence that some use "Google" as a verb and argue that its primary significance must therefore be that of a verb meaning to search the internet using any search engine. Plaintiffs contend that this evidence raises a genuine issue as to whether the GOOGLE mark is generic and that the District Court erred in granting summary judgment for Google. Plaintiffs' arguments defy logic, are not supported by the record in this case, and ignore or misconstrue the law of this Circuit.

It should come as no surprise that the immense popularity of Google's search engine has spawned verb forms of the famous GOOGLE trademark. Saying "I Googled Barack Obama" is easier than saying "I searched for information about Barack Obama on the Internet using the Google search engine," and it conveys the same message. The same is true of "I Fedexed a package" for "I sent a package using the FedEx delivery service," and "Did you TiVo it?" rather than "Did you record that program using a TiVo video recording device?" Use of these terms as verbs does not establish that the speaker is unaware that they are trademarks. To the contrary, as McCarthy and others point out, this type of usage often signifies brand strength.

Notably, Plaintiffs can cite no authority for the proposition that verb usage of a mark—even pervasive verb usage—renders it generic *per se*. The Ninth Circuit considers numerous factors when analyzing a genericness claim, none of which is whether the mark is used as a verb.

As the District Court recognized, Plaintiffs' theory that GOOGLE has become generic is fundamentally flawed, as it ignores the dispositive issue of whether GOOGLE is perceived by consumers as the generic term for a search engine. Plaintiffs mistakenly argue that "[t]he point of this case is **not** whether google is a generic word for [a] search engine; it is whether google is

a generic word for the act of searching on the internet.” (Op. Br. at 30.) Yet, the Lanham Act permits cancellation for genericness only when a “registered mark becomes the generic name *for the goods or services, or a portion thereof, for which it is registered.*” 15 U.S.C. § 1064 (emphasis added). The goods and services covered by the challenged GOOGLE registrations comprise a search engine, not “the act of searching on the internet.” And Plaintiffs have failed to proffer any evidence that consumers consider GOOGLE to be a generic term for any search engine, regardless of its source.

Plaintiffs also misconstrue the Ninth Circuit’s “primary significance” test. The pertinent inquiry is whether a majority of those who use the Internet regard the GOOGLE mark as an indication of source. Where, as here, the vast majority of Internet users (nearly 94 percent) understand that GOOGLE is a trademark denoting a specific search engine, its “primary significance” is that of a trademark, not a generic term. Plaintiffs have not challenged that evidence, nor offered any evidence to rebut it. Indeed, their own linguistics expert agrees that “Google functions as a trademark in identifying its search engine.” (GER88 ¶70; ER2798 (102:2–103:5).)<sup>1</sup> And Plaintiffs’ own deeply flawed “survey evidence” only sought to test how people *use* the word

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<sup>1</sup> Citations herein to “ER\_\_” and “GER\_\_” are to Plaintiffs’ Excerpts of Record and Google’s Excerpts of Record, respectively.

“google” in casual speech and failed to assess whether they understand the term’s brand significance, which is all that is at issue in this case. Thus, Plaintiffs failed to adduce admissible evidence germane to their claim of genericness under the Lanham Act.

Finally, even if relevant to the genericness inquiry, none of Plaintiffs’ anecdotal “evidence” suggests that use of the GOOGLE mark as a verb renders it incapable of serving as an identifier of source. In most, if not all, of the articles, cartoons, movies, and other materials they cite, it is immediately apparent that the speaker understands that GOOGLE is a trademark and is referring to Google or its search engine by name. Plaintiffs simply cannot overcome the strong presumption that the GOOGLE registrations are valid and protectable. The order and judgment of the District Court granting summary judgment to Google should be affirmed.

#### **ISSUE PRESENTED**

Whether the District Court properly granted summary judgment to Google on the ground that the GOOGLE trademark is protectable and not generic where the undisputed evidence demonstrates that the vast majority of Internet users understand GOOGLE to be the proprietary brand name of the world’s most famous search engine?

### **STATEMENT OF THE CASE**

Plaintiff Elliot instituted this action by filing a complaint on May 21, 2012, which was amended to include Chris Gillespie as a Plaintiff on July 27, 2012 (the “Complaint”). (ER3014–27.) On August 31, 2012, Google filed its answer, along with counterclaims against Plaintiffs for trademark dilution, violation of the Anti-Cybersquatting Consumer Protection Act, unjust enrichment, unfair competition, and false advertising. (ER2986–3013.)

On September 23, 2013, the parties filed cross-motions for summary judgment with respect to Plaintiffs’ claims against Google. (GER104–07.) On September 11, 2014, after full briefing and consideration of the voluminous evidence submitted by both sides, the District Court (Honorable Stephen M. MacNamee presiding) denied Plaintiffs’ motion and granted summary judgment for Google. (ER2–27.)

On April 15, 2015, the parties filed a joint stipulation dismissing Google’s counterclaims without prejudice. (GER1–5.) On April 16, 2015, the District Court entered judgment for Google, ordering that Plaintiffs take nothing by their Complaint and that the action be dismissed. (ER1.) This appeal followed.

## STATEMENT OF RELEVANT FACTS

### **I. GOOGLE AND THE FAMOUS GOOGLE TRADEMARK**

Google is a Delaware corporation headquartered in Mountain View, California. (GER55 ¶1; ER3016 ¶14.) Google’s search engine, accessible at [www.google.com](http://www.google.com), is one of the most recognized and widely used Internet search engines in the world. (GER55–56 ¶¶2–8; ER2560, 2566–626.) The GOOGLE mark identifies Google’s proprietary and unique search engine technology and is famous around the world. (*Id.*) In 2013, brand consultancy firm Interbrand’s “Best Global Brands 2013” report ranked Google as the second most valuable brand in the world (up from No. 4 in 2012). (GER51–52, ¶27; ER1403–04; *see also* GER55 ¶6; ER2614–26.)

The GOOGLE name was created in 1997 by Google founders Larry Page and Sergey Brin. (GER56 ¶9; ER2564, 2568.) GOOGLE is a coined, fanciful mark derived from the word “googol,” the mathematical term for a 1 followed by 100 zeros. (GER56 ¶10; ER2564, 2568.) The founders believed that the term “Google” reflected “their mission to organize a seemingly infinite amount of information on the web.” (GER56 ¶11; ER2568.)

In the relatively short time since Google was founded, it has quickly become the preeminent provider of Internet search services in the United

States and the world. (GER56 ¶12; ER2560, 2566–626.) The company processes billions of search requests every month and, in December 2012, was listed as the most visited website in the world. (GER56 ¶13; ER2560.) Google competes with a number of other search engine providers, all with their own distinct trademarks, including Yahoo!, Bing, Ask.com, and AOL.com in the United States. (GER56 ¶14; ER2560, 2628–33, 2638:2-24.)

The success of Google’s search engine has also spawned many other successful products. (GER56 ¶15; ER2566–97, 2647–49.) Gmail, Google Maps, Google Chrome and Google Wallet are just a few of the goods and services offered by Google and utilized by consumers throughout the United States and the world. (*Id.*; *see also* GER56–57 ¶16; ER2678:1-17.)

Google owns numerous United States and foreign registrations for the GOOGLE trademark, including the two GOOGLE registrations challenged in this action: U.S. Registration Nos. 2,884,502 and 2,806,075 (hereinafter, the “GOOGLE Registrations”). (GER57 ¶17; ER2651–52, 3018 ¶¶25–26.) In relevant part, the ’502 Registration covers “computer hardware; computer software for creating indexes of information; indexes of web sites and indexes of other information resources” in International Class 9. (*Id.*) The ’075 Registration covers, among other things, “computer services, namely,

providing software interfaces available over a network in order to create a personalized on-line information service; extraction and retrieval of information and data mining by means of global computer networks; creating indexes of information; indexes of web sites and . . . other information sources in connection with global computer networks” in International Class 42. (*Id.*) In short, the GOOGLE Registrations cover Google’s proprietary search engine and related services. (ER3:12-13.) Both GOOGLE Registrations are valid and incontestable. (GER57 ¶¶20; ER2651–52.)

## **II. PLAINTIFFS’ IMPROPER REGISTRATION OF DOMAIN NAMES INCORPORATING THE GOOGLE TRADEMARK**

Over two weeks between February 29, 2012, and March 10, 2012, Plaintiff Gillespie registered with GoDaddy.com 763 domain names containing the GOOGLE mark (the “Domain Names”). (GER57–58 ¶¶21–22; ER3015–16 ¶¶10, 3029–34, 2660–73.) Each of the Domain Names includes the GOOGLE mark in its entirety, followed by the name of another famous brand (googledisney.com, googlecartier.com, googlestatefarm.com) or person (googlebarackobama.net) or a generic term (*e.g.*, googlenewtvs.com). (*Id.*) The registration of the Domain Names was a classic case of cybersquatting, with Mr. Gillespie seeking to trade off brand

owners' goodwill by including famous brands such as GOOGLE and DISNEY—which he clearly does not own—in his Domain Names. (*Id.*)

Plaintiffs caused some, if not all, of the Domain Names to resolve to their own website. (GER58 ¶23; ER2640:13–2643:8.) Upon entering “googlebarackobama.net” (or any of the other Domain Names) into an Internet search engine or browser, a user would be directed to Plaintiffs’ “The GLBT Network” website, located at TGN.xxx, rather than a Google search results page for Barack Obama or a website pertaining to Barack Obama, as the user presumably expected. (*Id.*) As Plaintiffs admit, none of the accessible content had any association with Google or the other brands, individuals, or products referenced in the Domain Names: “Q: [A]s a result of setting up the domain name www.googlebarack obama.com to resolve to your TGN.xxx website . . . users who were looking for information about Barack Obama were directed to a website owned by you that has nothing to do with Barack Obama, correct? A: I assume so.” (GER58 ¶24; ER2644:23–2645:5; *see also* ER2681:24–2682:8, 2683.)

### **III. GOOGLE’S SUCCESSFUL UDRP PROCEEDING, AND PLAINTIFF’S PETITION TO CANCEL THE GOOGLE REGISTRATIONS**

In March 2012, Google filed a complaint against Plaintiff Gillespie with the National Arbitration Forum (“NAF”) pursuant to the Uniform

Domain Name Dispute Resolution Policy (“UDRP”) incorporated in the GoDaddy Terms of Use agreement. (GER58 ¶25; ER3016 ¶12, 2685–707.) Among other things, the UDRP complaint asserted that: (1) the Domain Names are confusingly similar to Google’s registered GOOGLE trademarks; (2) Mr. Gillespie has no legitimate interest in the Domain Names; and (3) his use of the Domain Names to generate traffic to his own website supports a finding of bad faith registration and use. (GER58 ¶26; ER2701–05.) Google requested transfer of the Domain Names to Google so that it may safely warehouse them and prevent their future use. (GER58 ¶27; ER2705.)

On April 16, 2012, Mr. Gillespie filed a petition with the U.S. Trademark Trial and Appeal Board (“TTAB”) to cancel the GOOGLE Registrations. (GER58 ¶28; ER3017 ¶18, 2709–25.) The petition asserts that he registered the Domain Names in furtherance of business plans to develop affinity-based social networks, the GOOGLE mark has become generic, and transfer of the Domain Names to Google would harm him and “place in jeopardy his right to domain names comprising the term GOOGLE.” (GER59 ¶29; ER2712–14 ¶¶3–9.) The TTAB proceeding was suspended pending the outcome of this litigation. (ER3 n.2.)

On May 10, 2012, the NAF panel rejected Mr. Gillespie's claim that the GOOGLE mark is generic and ordered the Domain Names transferred to Google. (GER59 ¶34; ER3017 ¶19, 2756.) The panel concluded that: (1) the Domain Names are confusingly similar to the GOOGLE mark; (2) Mr. Gillespie has no rights or legitimate interest in them; and (3) he registered and was using them in bad faith. (GER59 ¶35; ER2761, 2765, 2739–74.)

#### **IV. PLAINTIFFS' ALLEGATIONS IN THIS ACTION**

Plaintiffs acknowledge in their Complaint that Google owns the GOOGLE Registrations but assert that “the term ‘GOOGLE’ is, or has become, a generic term universally used to describe the action of internet searching with any search engine.” (GER60 ¶37; ER3018 ¶¶25–26, 3015 ¶4.) Plaintiffs further assert that allowing Google to retain its registrations will cause Plaintiffs to “lose their rights to the Domain Names now in dispute” and jeopardize their rights “to acquire domain names in the furtherance of their business plans comprising the generic term GOOGLE.” (GER84 ¶38; ER3022 ¶45.) Accordingly, Plaintiffs seek an order cancelling the GOOGLE Registrations and declaring their rights to the Domain Names. (GER84 ¶39; ER3023–24 ¶¶54–61.)

**V. THE GOOGLE MARK IS STRONG AND PROTECTABLE**

**A. Survey evidence overwhelmingly establishes that the GOOGLE mark is not generic**

Google's expert witness, Dr. Gerald Ford, conducted a *Teflon* model survey to determine the primary significance of the term GOOGLE to relevant consumers. (GER84 ¶40; ER2777 ¶2, 2785.) A "Teflon" survey, named for the survey endorsed in the seminal *Teflon* case, *E. I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975), is one of two preferred models for determining genericness. 2 J. Thomas McCarthy on Trademarks and Unfair Competition (4th ed. 1996) ("McCarthy") § 12:14. It is "essentially a mini-course in the generic versus trademark distinction, followed by a test" of other marks and generic (or common) names that are tailored to the facts of a particular case. *Id.* § 12:16.

In Dr. Ford's survey, 420 randomly selected participants were contacted by telephone and asked a series of preliminary questions designed to test whether they understood the difference between a brand name and a common name. (ER2776–88.) Respondents were also asked whether they perform searches on the Internet. (*Id.*) Excluding the 19 respondents who indicated they do not search the Internet, the overwhelming majority (93.77%) of respondents expressed their belief that GOOGLE is a brand

name. (GER84 ¶41; ER2777 ¶4, 2782 n.4.) A mere 5.24 percent of respondents indicated that GOOGLE was a generic term. (GER84 ¶42; ER2786–87.) Dr. Ford’s *Teflon* survey established that the primary significance of GOOGLE is as a trademark, and that GOOGLE has not become generic. (GER84 ¶43; ER2777–78 ¶5, 2788 ¶23.)

Notably, neither Plaintiffs nor their own purported survey expert, James T. Berger, challenged Dr. Ford’s qualifications or the design, execution or results of his survey in opposing Google’s motion for summary judgment. (GER84 ¶44; ER2802:17–2803:4.) To the contrary, Mr. Berger readily agreed at his deposition that a *Teflon* survey is a “well known protocol” to test for genericness. (*Id.*) And nothing in Plaintiffs’ own surveys and supporting expert testimony remotely contradicts Dr. Ford’s conclusion that the GOOGLE mark is not generic.<sup>2</sup>

Mr. Berger conceded that he took a results-driven approach by designing his survey to “prove” that the GOOGLE mark is generic, rather

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<sup>2</sup> Google does not concede the reliability or admissibility of any of Plaintiffs’ purported survey or other expert evidence under *Daubert v. Merrell Dow Pharms.*, 509 U.S. 579 (1993). In fact, that evidence is fundamentally flawed in a number of ways, including improper survey methodology, results-driven protocol, and questionable expert qualifications. However, as discussed more fully below, consideration of those survey results does not give rise to a genuine issue for trial as they do not constitute evidence of genericness of the GOOGLE mark under applicable law.

than to test that theory. (GER84 ¶45; ER2804:7-10.) Not surprisingly, Mr. Berger was not aware of a single court case, treatise, or article that has accepted or endorsed the single-question survey protocol he designed and utilized. (GER85 ¶46; ER2806:20–2807:3, 2809:1-5.) Mr. Berger also conceded that his survey: (1) did not test whether consumers understand that the term “Google” applies to a particular company; (2) did not test the primary significance of the term “Google” to consumers; and (3) did not test whether the term “Google” was generic with respect to Internet search engine services, hardware or software (*i.e.*, the goods and services covered by the GOOGLE Registrations). (GER85 ¶47; ER2805:15-17, 2809:13–2811:10, 2811:4-10.) Rather, Mr. Berger’s survey consisted of a single question: “[I]f you were going to ask a friend to search for something on the Internet, what word or phrase would you use to tell him or her what you wanted him or her to do?” (GER85 ¶48; ER2808:2-5.) According to Mr. Berger, roughly 51 percent of respondents said that they would ask a friend to “Google it.” (GER85 ¶49; ER2808:11-13.) Survey respondents were not asked what they understand the term “Google it” to mean, and it is very plausible—if not highly likely—that the vast majority of survey respondents who said they would tell a friend to “Google it” specifically meant “use the Google search

engine.” (GER85 ¶50; ER2808:14-17.) In other words, there is nothing inconsistent between the results of Dr. Ford’s survey—which show that nearly 94 percent of Internet users primarily understand Google to be a brand name—and Mr. Berger’s survey results (however questionable) showing that 51 percent of respondents refer to Google by name when asking friends to search the Internet.

Plaintiffs’ attorney, Richard Wirtz, also apparently conducted several informal surveys using the Google consumer survey service based on questions and pre-selected answers he devised himself.<sup>3</sup> (Op. Br. at 23; GER85 ¶51; ER2812:21–2816:7.) No expert has validated the protocol, execution or results of those surveys (GER85 ¶52; ER2812:21–2816:7), and Google’s experts have thoroughly discredited them.<sup>4</sup> As the District Court correctly found, those surveys are also inadmissible for reasons discussed

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<sup>3</sup> Incredibly, Plaintiffs contend that Google, and not Mr. Wirtz, conducted these surveys because Mr. Wirtz used Google’s survey tool to communicate his questions and possible answers and collect responses. (Op. Br. at 23–24.) Following this logic, when someone uses the telephone to pose survey questions, Verizon or AT&T is actually conducting the survey.

<sup>4</sup> For instance, Google’s linguistics expert, Dr. Geoffrey Nunberg, characterized Plaintiffs’ surveys as “worthless.” Among other critical flaws, the surveys asked respondents the incredibly vague question of what they most often use the word “google” to mean, and then inexplicably failed to provide the option of stating that they use Google to mean search for information using the Google search engine. (GER85 ¶53; ER2823:16–2824:1.)

below. (ER14–16.) However, even if Mr. Wirtz’s survey results merited consideration, Plaintiffs’ own actual survey expert, Mr. Berger, acknowledged that a majority (57.2%) of those who responded to Mr. Wirtz’s surveys indicated that the primary meaning of the term “Google” was either as an Internet search engine or a producer or source of Internet services, not a generic term for searching the Internet, as Plaintiffs contend. (GER85–86 ¶54; ER2814:16–2815:21.)

**B. Dictionaries consistently define GOOGLE non-generically**

Dictionary definitions demonstrate that the word Google—whether used as a noun or a verb—refers primarily and specifically to Google and its proprietary search engine. Indeed, all of the dictionaries relied upon by Plaintiffs (Op. Br. at 5–9) define the word Google by specifically referencing the GOOGLE trademark or the Google search engine.

- The first definition for “Google” in Collins English Dictionary is “*n trademark* **1** a popular search engine on the internet.” (GER86 ¶56; ER3040.)
- Dictionary.com defines Google as: “*noun* **Trademark.** 1. Brand name of a leading Internet search engine, founded in 1998.” (GER86 ¶57; ER3042.)

- Wikipedia defines the verb “Google” to mean “using the Google search engine to obtain information on the Web.” (GER86 ¶58; ER3044.)

- The Oxford English Dictionary (“OED”) <sup>5</sup> describes the etymology of the verb Google as “a proprietary name for an Internet search engine launched in 1998.” (GER86 ¶60; ER2797 (158:4-19).) It then defines both the transitive and intransitive verb forms of Google: “1. intr. To use the Google search engine to find information on the Internet”; “2. trans. To enter (a search term) into the Google search engine to find information on the Internet; to search for information about (a person or thing) in this way.” (GER86 ¶61; ER2797 (159:21–160:8).)<sup>6</sup>

- The unabridged Merriam-Webster Dictionary entry for Google is “identical in tone and essential content” to that of the OED. (GER86 ¶62; ER2796–97 (157:23–158:3).)

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<sup>5</sup> One of Plaintiffs’ linguistics experts, Dr. Patrick Farrell, testified that the OED is “probably the most comprehensive record of the history of words and everything about words that there is.” (GER86 ¶59; ER2794 (82:17-83:1.)

<sup>6</sup> Plaintiffs contend that the OED’s mere inclusion of an entry for the word Google “*suggests* that google is in fact generic” insofar as “the OED, as a general rule, does not have entries for proprietary names that have not undergone significant genericization.” (Op. Br. at 6–7.) This argument makes little sense, as it is undisputed that the OED “includes more than 1000 entries for proprietary terms,” including Coca-Cola, iPod, Kodak, Nintendo and Pac-Man, just to name a few. (ER39–40.)

- The American Heritage Dictionary defines Google simply as “a trademark for an Internet search engine” and explains that “[t]his trademark often occurs in print as a verb, sometimes in lowercase.” (GER86 ¶63; ER2914 n.8, 2799.)
- WordSpy, which Plaintiffs-Appellants describe as an “online dictionary of new words,” defines the verb Google as “To search for information on the Web, particularly by using the Google search engine.” (GER39 ¶4; ER1387.)<sup>7</sup>
- Even the Urban Dictionary, relied upon by Plaintiffs’ linguistics experts, defines “Google It” first and foremost as “meaning to look it up on Google.” (GER87 ¶64; ER2922 ¶27.)<sup>8</sup>

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<sup>7</sup> According to Plaintiffs, entering “define google” into Google’s search box in May 2012 returned a very similar definition, namely: “Use an Internet search engine, particularly google.com.” (GER47 ¶22; ER486, 1396.) Today, anyone can run the search query “define google,” which returns: “to search for information about (someone or something) on the Internet *using the search engine Google*.” (*Id.* (emphasis added).) Both definitions specifically refer to the Google search engine by name.

<sup>8</sup> Plaintiffs point out that the American Dialect Society selected GOOGLE as its “word of the decade” in 2010, defining “google” as a verb. (Op. Br. at 9.) However, the press release announcing the selection makes clear that the vote is not academic: “In conducting the vote, [ADS members] act in fun and do not pretend to be officially inducting words into the English language.” (GER46–47 ¶21; ER478–80, 1379–80.) In fact, according to Dr. Geoffrey Nunberg, Google’s linguistics expert and an ADS member, the Society votes on the word, but does not deliberate or vote on the definition. (*Id.*) Moreover,

Plaintiffs have not identified a single dictionary that defines the word “google” strictly as a generic verb meaning to search the Internet using any search engine. Rather, all of the dictionaries cited by Plaintiffs acknowledge that Google is the source or brand name of a specific search engine.

**C. Google’s competitors respect the GOOGLE mark**

Google’s competitors also uniformly use GOOGLE as a proprietary brand name. Plaintiffs simply cannot point to a single instance in which a competing search engine provider, such as Microsoft or Yahoo, has referred to its own search engine as a “google.” (GER87 ¶65; ER2636:24–2637:3, 2639:19-21, 2676:23–2677:10.) Nor do these competitors advertise that consumers can “google” using their search engines. (GER87 ¶66; ER2832–46.) In fact, Yahoo! and Bing issue press releases and run advertising campaigns in which they explicitly distinguish themselves from Google, using the GOOGLE mark to refer exclusively to Google and its search engine. (GER87–88 ¶¶66–69; ER2832–46.)

For instance, on July 16, 2012, Yahoo! announced that its new CEO, Marissa Mayer (a former Google executive) had “led efforts for many of Google’s most recognizable products, including the development of its

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the same press release notes that GOOGLE is a trademark for “the world’s dominant Internet search engine.” (GER46–47 ¶21; ER 479.)

flagship search product and iconic homepage for over 10 years.” (GER87 ¶68; ER2842–43.) Three months later, Microsoft launched an ad campaign known as the “Bing it on Challenge” in which Bing spokespersons are shown approaching people on the street and asking them to compare search results from Bing and Google. (GER87–88 ¶69; ER2845–46.) Throughout the ads, GOOGLE is used appropriately as a source-identifier and none of the participants appears confused by the request to compare Bing to Google. (*Id.*)

**D. The media use GOOGLE as a trademark**

The media overwhelmingly use the GOOGLE mark to identify Google and its specific search engine services. Even a cursory review of the Internet reveals that countless news and entertainment publications, including the *New York Times*, the *Washington Post*, ABC News, NBC News, CBS News, Fox News, *Slate*, and *Buzz Feed*, to name just a few, respect the GOOGLE mark and use it non-generically. (GER88 ¶73; ER2852–73.)

**E. Google has invested heavily in protecting its GOOGLE mark**

Google has invested substantial resources and effort in establishing strong and exclusive rights in the GOOGLE brand, including through vigilant policing of known instances of infringement and misuse. (GER64–65 ¶¶75–80; ER1414, 2875–78, 2881–88, 2891–92 (29:16–30:11), 2893–95 (41:7–

48:20).) Google frequently challenges infringers in many different ways, including but not limited to sending demand letters, arbitrating UDRP proceedings, and filing and prosecuting federal lawsuits. (GER89 ¶80; ER2891–92 (29:16–30:11), 2893–95 (41:7–48:20).) Plaintiffs know firsthand that Google actively seeks to stamp out infringing use of its trademarks because Google successfully policed Plaintiffs’ infringing use of the GOOGLE mark through the UDRP proceeding. (GER58 ¶¶25–27; ER3016 ¶12, 2685–707.)

**F. Linguistics experts agree that the GOOGLE mark is not generic**

Both of Plaintiffs’ own linguistics experts have admitted that the GOOGLE mark is not generic when used to refer to Google the company or its Internet search engine. Dr. Farrell made clear at his deposition that he was not opining that the term “Google” was generic in a trademark sense and agreed that “Google functions as a trademark in identifying its search engine.” (GER88 ¶70; ER2795 (102:2–103:5).) Plaintiffs’ other linguistics expert, Dr. Allan Metcalf, testified similarly: “I would also say that the word Google when it is used as the name of a company or the name of a search engine is not generic.” (GER88 ¶71; ER2849 (56:23–57:1), 2850 (116:9–10).) These opinions are consistent with the report of Google’s linguistics

expert, Dr. Nunberg, who concluded that “Google has not become generic” and that “all the relevant forms of evidence demonstrate that the use of *Google* as a verb is specific in its application; that is, it literally denotes only the process of using the Google search engine to search the web.” (GER88 ¶72; ER2819:20-25, 2958 (Conclusion).)

## **VI. THE DISTRICT COURT GRANTS SUMMARY JUDGMENT TO GOOGLE**

On September 11, 2014, the District Court denied Plaintiffs-Appellants’ motion for summary judgment and granted summary judgment to Google, finding “no genuine dispute about whether, with respect to searching on the internet, the primary significance of the word google to a majority of the public who utilize internet search engines is a designation of the Google search engine.” (ER26.)

In considering whether to grant summary judgment, the District Court afforded Plaintiffs an inference—based on the survey evidence provided by Mr. Berger—that a majority of the Internet-using public uses the word “google” as a verb to refer to searching on the internet without regard to search engine used. (*Id.*)<sup>9</sup> However, the court rejected as “flawed” the central

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<sup>9</sup> For reasons discussed below, Google disputes that such an inference can plausibly be drawn from Mr. Berger’s survey.

premise of Plaintiffs' argument, namely, that "a trademark ceases to function as such when it is used primarily as a verb." (ER6.) Instead, as the court correctly noted, under the applicable law, the "dispositive inquiry is whether a majority of the consuming public considers the significance of the mark to be an indication of origin rather than an indication of nature and class." (ER9–10.) "If the primary significance of [] a mark to a majority of the consuming public is to differentiate one service from the services of others, then the mark is not generic. This is true regardless of whether the public also uses the mark as an indiscriminate verb." (ER9.)

Applying this framework, the District Court found that Plaintiffs failed to submit "probative evidence that the primary significance of the word google to a majority of the consuming public was a common descriptive term for search engines." (ER25.) As the District Court explained:

Plaintiffs, at their peril, neglected their burden of proof under the primary significance test, instead electing to present evidence about whether a majority of the consuming public [uses] the word google as a verb. Disregarding primary significance resulted in an absolute failure of proof that is fatal to Plaintiffs' claim for genericide. The Court declines Plaintiffs' invitation to judicially legislate federal trademark law out its "dark ages" by sidestepping the statutory test for primary significance and holding that frequency of verb use is in and of itself sufficient to render a mark generic.

(ER25–26.) Finding no genuine dispute about whether the GOOGLE mark serves as “a designation of the Google search engine,” the District Court granted summary judgment for Google, finding that it “is entitled to judgment as a matter of law that the [Google Registrations] are not generic.” (ER26.)

### **SUMMARY OF THE ARGUMENT**

All of the relevant favors taken into account by the Ninth Circuit in assessing genericness demonstrate that the GOOGLE mark functions as a trademark by identifying Google as the singular source of its famous search engine. Among other key facts, it is undisputed that:

- Dictionaries consistently define the word Google—even in its verb form—by specifically referencing the Google trademark, the Google search engine, and/or Google Inc. (*See* Section V.B., *supra*, at 16–19.)
- Google’s competitors respect the GOOGLE mark and do not refer to their search engines as “googles.” (*See* Section V.C., *supra*, at 19–20.)
- Plaintiffs fail to point to a single instance in which a major media outlet has referred to the Bing or Yahoo! search engines as “googles” or suggested that one can “google” on other companies’ websites. (*See* Section V.D., *supra*, at 20.)

- Google consistently uses the GOOGLE mark as a valuable brand identity in its ads and communications. (*See* Section V.E., *supra*, at 20-21.)
- Google is consistently ranked among the strongest brands in the United States and throughout the world. (GER51–52, ¶27, 55–56 ¶¶2–8; ER1403–04, 2560, 2566–626.)
- Both of Plaintiffs’ linguistic experts expressly admitted that the GOOGLE mark serves to identify Google as the source of its search engine services. (*See* Section V.F., *supra*, at 21-22.)
- When asked whether GOOGLE was a common name or a brand name in connection with searching the Internet, the overwhelming majority (93.77%) of respondents in Dr. Ford’s survey indicated that they regard GOOGLE to be a brand name. (GER84 ¶42; ER2786–87 ¶20.)

Plaintiffs proffer anecdotal evidence that the word “google” has been used in songs, television shows, movies, and news articles as a verb meaning to search the Internet (in most cases, using the Google search engine), and that survey respondents also use it in that way, but this evidence does not create a genuine issue of fact. As the District Court correctly held, the dispositive issue is not how people use the mark in casual conversation (or the grammatical form in which they use it), but whether GOOGLE serves as a

designation of origin of the goods and services listed in the challenged GOOGLE Registrations. Google's survey and other evidence overwhelmingly shows that it does, both sides' linguistics experts unanimously agree that it does, Plaintiffs' survey expert does not refute this proposition (and acknowledges that he did not even test for it), and none of Plaintiffs' other purported evidence undermines in any way GOOGLE's source-identifying function. The District Court's order granting summary judgment to Google should be affirmed.

## **ARGUMENT**

### **I. STANDARD OF REVIEW**

This Court reviews *de novo* a District Court's grant or denial of summary judgment. *Crowley v. Bannister*, 734 F.3d 967, 976 (9th Cir. 2013). Summary judgment is "designed to secure the just, speedy, and inexpensive determination of every action." *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Summary judgment is appropriate when the "pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *Celotex*, 477 U.S. at 322–23. "Only disputes over facts that might

affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

The moving party bears the initial burden of demonstrating that there is no genuine issue of material fact, and that judgment as a matter of law should be granted in its favor. Fed. R. Civ. P. 56(c). Once the moving party has met its initial burden, the nonmoving party must then go beyond the pleadings and point to “specific facts” constituting “significantly probative” evidence capable of supporting a favorable verdict for the non-moving party. *Anderson*, 477 U.S. at 249–50.

A party moving for summary judgment is entitled to the benefit of any relevant presumptions that support the motion. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982) (citing *U.S. v. Gen. Motors Corp.*, 171 U.S. App. D.C. 27, 518 F.2d 420, 441–42 (D.C. Cir. 1975)). The incontestable GOOGLE Registrations create “a strong presumption of validity” of the GOOGLE mark. *See KP Perm. Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 604 (9th Cir. 2005). The presumption of validity “includes the specific presumption that the trademark is not generic.” *Overland*, 692 F.2d at 1254. By virtue of these presumptions, Google has met

its initial burden of demonstrating the lack of a genuine issue for trial. *See id.*; *see also Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999) (citing 15 U.S.C. § 1057(b) (the “presumption of validity . . . places the burden of proving genericness upon the [party alleging genericness]”).

## **II. LEGAL STANDARD FOR GENERICNESS**

The Ninth Circuit has repeatedly addressed the standard for determining genericness: “To determine whether a term has become generic, we look to whether consumers understand the word to refer only to a particular producer’s goods or whether the consumer understands the word to refer to the goods themselves.” *KP Perm. Make-Up*, 408 F.3d at 604. If buyers understand the term as identifying “a particular producer’s goods or services, it is not generic.” *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1016 (9th Cir. 1979). “But if the word is identified with all such goods or services, regardless of their suppliers, it is generic.” *Id.* (citing *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963)).

The Lanham Act provides that “[t]he primary significance of the registered mark to the relevant public . . . shall be the test for determining

whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” 15 U.S.C. § 1064(3). In determining a mark’s primary significance, the Ninth Circuit applies the “who-are-you/what-are-you” test. *Filipino Yellow Pages*, 198 F.3d at 1147. “[A] valid trademark answers the former question, whereas a generic product name or adjective answers the latter.” *Rudolph Int’l, Inc. v. Realys, Inc.*, 482 F.3d 1195, 1198 (9th Cir. 2007). “If the primary significance of the trademark . . . describe[s] the type of product rather than the producer, [it] is a generic term and [cannot be] a valid trademark.” *Filipino Yellow Pages*, 198 F.3d at 1147 (citations omitted).

As McCarthy explains, if a majority of the relevant public is aware of the trademark significance of the term (*i.e.*, that it designates a particular source of goods or services), then its primary significance is as a trademark and it is entitled to protection as such. McCarthy § 12:6 (citing 15 U.S.C. § 1064(3)). Conversely, if a majority of the relevant public regards the term as generic and is unaware of its trademark significance, then it is generic. *See King-Seeley*, 321 F.2d at 581 (finding THERMOS generic as “the great majority of [people] who use the word ‘thermos’ are not aware of any

trademark significance”). McCarthy demonstrates the rule with the following example:

The result of the primary significance rule [is] that majority usage controls. For example, if a survey showed that 75 percent of the public regard the word as generic, then that is its majority usage and its “principal significance.” Even if the seller educates a few customers to use the generic term as a mark, it is still principally generic. . . . If, on the other hand, 75 percent of the public regards the term as an indication of a single commercial source for certain goods or services, then that term should be protected as a trademark or service mark. Consumer survey evidence is admissible to show how prospective purchasers regard the term at issue.

McCarthy § 12:6. Plaintiffs come nowhere close to raising a genuine issue as to whether the GOOGLE mark is generic under the primary significance test.

### **III. THE COURT SHOULD AFFIRM SUMMARY JUDGMENT FOR GOOGLE**

#### **A. The GOOGLE Mark Is Presumed Valid and Not Generic**

It is undisputed that the GOOGLE mark is registered and that the registrations Plaintiffs seek to cancel are incontestable. (GER57 ¶¶18–20; ER3018 ¶¶25–26, 2651–52.) Accordingly, the GOOGLE mark is presumed valid and non-generic, and GOOGLE met its initial burden of demonstrating entitlement to summary judgment. *See Overland*, 692 F.2d at 1254 (rejecting allegation that “Coke” is generic for soda beverages and affirming summary judgment for Coca Cola on infringement claims against a restaurant that

regularly served Pepsi in response to orders for Coke without notifying customers of the switch); *KP Perm. Make-Up*, 408 F.3d at 606 (reversing district court's grant of summary judgment to plaintiff, who had sought a declaration that defendant's registered "Micro Colors" trademark was generic for micropigmentation products, and ordering that summary judgment be entered for the defendant mark owner); *Caesars World Inc. v. Milanian*, 247 F. Supp. 2d 1171, 1194–95 (D. Nev. 2003) (rejecting claim that plaintiff's unregistered COLLOSEUM mark was generic and granting summary judgment for plaintiff on its infringement claim).

Notably, marks that are obviously and substantially weaker than the world-famous GOOGLE mark are consistently found to be non-generic. *See, e.g., Cal. Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1456 (9th Cir. 1985) (rejecting defendant's assertion of genericness and granting preliminary injunction against defendant's use, citing, among other things, a survey showing that 75 percent of relevant consumers understood "California Cooler" to be a brand of wine cooler, not a generic term); *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 532–35 (1987) (finding the mark "Olympic" to be protectable); *Comm. for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814, 821 (9th Cir. 1996) ("Committee for Idaho's

High Desert” not generic); *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 718 F.2d 327 (9th Cir. 1983) (“Park ‘N Fly” not generic), *rev’d on other grounds*, 469 U.S. 189, 192 (1985); *U.S. Jaycees v. San Francisco Jr. Chamber of Com.*, 513 F.2d 1226 (9th Cir. 1975) (*per curiam*) (“Junior Chamber of Commerce” not generic); *Kelley Blue Book v. Car-Smarts, Inc.*, 802 F. Supp. 278, 291 (C.D. Cal. 1992) (“blue book” not generic).

**B. The Undisputed Evidence Overwhelmingly Establishes that GOOGLE Is a Protectable Trademark, Not a Generic Term**

Under the primary significance test, “a mark is not generic merely because it has some significance to the public as an indication of the nature or class of an article.” *Caesar’s World*, 247 F. Supp. 2d at 1194 (citing *King-Seeley*, 321 F.2d at 580). Rather, to be deemed generic, the generic indication of its nature or class must be the term’s *principal* significance. *Id.* As a result, “occasional generic usage does not destroy a trademark.” *Caesar’s World*, 247 F. Supp. 2d at 1194. For instance, the consumer ordering “a cheeseburger and a Coke” is demonstrative of brand loyalty and strength, not genericness. McCarthy § 12.8. Similarly, a request to “Lysol” the counters, “TiVo” a television program, or “FedEx” a package does not remotely suggest that the primary significance of those terms is anything other than as trademarks. (See ER8 (quoting Laura A. Heymann, *The Grammar of*

*Trademarks*, 14 Lewis & Clark L. Rev. 1313, 1348 (2010) (“top-of-mind use of a trademark in its verb form, far from indicating the mark’s generic status, may well indicate the enduring fame of the brand”)).)

As the District Court noted, the “undisputed evidence is that the consuming public overwhelmingly understands the word google to identify a particular search engine, not search engines in general.” (ER26.) That is, even when used as a verb, the GOOGLE mark maintains its source-identifying function and is not, as Plaintiffs contend, a “generic word for . . . searching the Internet.” (Op. Br. at 43.) Every factor the Ninth Circuit considers in determining whether a mark is generic weighs heavily in Google’s favor and demonstrates the protectability of the GOOGLE mark.

#### **1. Dictionaries define GOOGLE non-generically**

The Ninth Circuit has explained that dictionary definitions “are relevant and often persuasive in determining how a term is understood by the consuming public, the ultimate test of whether a trademark is generic.” *Surgicenters of Am.*, 601 F.2d at 1015 n.11. In determining whether a mark is generic, the Court may place “significant” weight on dictionary definitions. *Filipino Yellow Pages*, 198 F.3d at 1148.

“As to dictionary usage, Plaintiffs are unable to cite to a single dictionary whose definition of the word “google” neglects to mention the trademark significance of the term.” (ER20.) Dictionaries consistently define the word Google—whether in its noun or verb form—as specifically identifying Google and its proprietary search engine. (*See* Section V.B., *supra.*, at 16–19.) Of particular note, both the OED and Webster’s Unabridged, relied on by Plaintiffs’ linguistics experts, define the verb Google as meaning “to use the Google search engine to find information on the Internet.” (GER86 ¶¶61–62; ER2797 (159:21–160:8), ER2796–97 (157:23–158:3).) Other dictionaries, like the American Heritage Dictionary, define Google—even in its verb form—simply as “a trademark for an Internet search engine.” (GER86 ¶63; ER2914 n.8.) These non-generic and source-identifying definitions are strong evidence that the general public also understands and uses GOOGLE in a non-generic manner.

## **2. Competitors use GOOGLE non-generically**

A mark’s use by competitors is evidence of how the public perceives the term. *CG Roxane LLC v. Fiji Water Co.*, 569 F. Supp. 2d 1019, 1027 (N.D. Cal. 2008). “If competitors can accurately describe their products or services without using the mark in question, it suggests the mark is not

generic.” (ER22 (citing *Salton Inc. v. Cornwall Corp.*, 477 F. Supp. 975, 986 (D.N.J. 1979).) Applying the “who are you/what are you” test, the Ninth Circuit looks to see whether industry competitors answer the “[w]hat are you?” question using the mark at issue. *Filipino Yellow Pages*, 198 F.3d at 1151–52; *see also Closed Loop Mktg., Inc. v. Closed Loop Mktg., LLC*, 589 F. Supp. 2d 1211, 1219 (E.D. Cal. 2008). That is not the case here.

Plaintiffs present no evidence suggesting that competing search engine providers, such as Microsoft and Yahoo!, answer the critical question of “what are you?” with “a google.” Nor do these competitors advertise that consumers can “Google” using their search engines. In fact, Bing and Yahoo! issue press releases and conduct advertising campaigns in which they explicitly distinguish themselves from Google, using the GOOGLE mark to refer exclusively to Google and its search engine. (GER87–88 ¶¶66–69; ER2832–46.) Those competitors—like the firms that monitor and rank competing search engine providers—all understand that GOOGLE is an extremely valuable trademark and do not use it generically. (GER55 ¶¶2–7, 63–64 ¶¶65–69; ER3018–19 ¶¶25–26, 29–31; ER3021 ¶41; ER2560; ER2566–626; ER2636:20–2637:3; ER2639:18-23; ER2676:23–2677:10; ER2832–46.) “Thus, there is no evidence of competitors’ usage capable of

supporting the inference that the word google has become the common descriptive term for the category of services to which the Google search engine belongs: internet search engines.” (ER22.)

### **3. The media uses GOOGLE non-generically**

In applying the primary significance test, Ninth Circuit courts often accept the media’s usage of a mark as strong evidence of how the public perceives the term. *See, e.g., CG Roxane*, 569 F. Supp. 2d at 1028–29. Additionally, the Ninth Circuit places significant weight on media evidence if it comes from a prominent and widely-circulated publication. *Surgicenters of Am.*, 601 F.2d at 1013, 1017 n.17 (affirming district court properly examined generic use of term by prominent publications such as *Newsweek* magazine and medical publications in granting summary judgment).

Plaintiffs cannot point to a single instance in which a major media outlet has referred to the Bing or Yahoo! search engines as “googles” or suggested that one can “Google” on those sites. To the contrary, the prominent media publications clearly demonstrate that the GOOGLE mark is famous and well-respected. (GER88 ¶73; ER2852–73.) Not one of these publications use the GOOGLE mark generically. (*Id.*; ER23.)

#### **4. Google uses its GOOGLE mark non-generically**

Courts often look at how the party asserting trademark rights uses the term at issue to determine whether that term is functioning as a trademark or a generic term. *See, e.g. Intel Corp. v. Advanced Micro Devices, Inc.*, 756 F. Supp. 1292, 1297-98 (N.D. Cal. 1991) (analyzing Intel’s use of “386” to determine whether the mark was generic); *Filipino Yellow Pages*, 198 F.3d at 1150-51 (considering the defendant competitor’s evidence that the plaintiff publisher himself used the “Filipino Yellow Pages” mark generically).

As seen on Google’s website and throughout its extensive national advertising campaigns, Google uses the GOOGLE mark to identify the source of its proprietary search engine services—not to identify a genus of services. (GER64–65 ¶¶75–76; ER2566–97, 2875–78, 2881–88, 1414.) These advertisements further solidify the primary significance of GOOGLE as a famous trademark that is widely-associated with Google’s brand and valuable goodwill.

#### **5. Google polices infringing uses of the GOOGLE mark**

When analyzing genericness, courts often consider a trademark holder’s vigilance in enforcing its trademark rights and policing known instances of trademark infringement. *See, e.g. Filipino Yellow Pages*, 198

F.3d at 1151 (affirming lower court's reliance on plaintiff's lack of trademark policing as evidence that the mark had become generic).

Google vigorously defends its mark against infringement. (*See* Section V.E., *supra*, at 20-21.) As an initial matter, Google's website enumerates rules and guidelines for anyone contemplating use of the GOOGLE mark, and makes it abundantly clear that GOOGLE is a protected trademark and must be treated as such. (GER89 ¶78; ER2881-88, ER21.) When Google becomes aware of infringing activities, it actively pursues infringers by, among other things, sending demand letters, arbitrating UDRP proceedings, and filing and prosecuting federal lawsuits. (GER89 ¶80; ER2891-92 (29:16-30:11), 2893-95 (41:7-48:21), 2896 (53:17-23).) Historically, Google has spent substantial sums policing and protecting the GOOGLE marks at issue in this case. (GER65 ¶79; ER2897 (73:3-6).) This case serves as just one example of the efforts Google has consistently made to protect its mark from infringement, dilution and cybersquatting.

**6. Plaintiffs' own linguistics experts agree that GOOGLE is not generic**

Both of Plaintiffs' linguistics experts conceded at their depositions that the GOOGLE mark is not generic when used to refer to Google or its search engine. Dr. Farrell testified that "Google functions as a trademark in

identifying its search engine.” (GER88 ¶70; ER2795 (102:2-103:5).) Dr. Allan Metcalf testified similarly: “I would also say that the word Google when it is used as the name of a company or the name of a search engine is not generic.” (GER88 ¶71; ER2849 (56:23–57:1), 2850 (116:9-10).) These opinions fatally undermine Plaintiffs’ claims, as the Registrations Plaintiffs seek to cancel are for GOOGLE in connection with software and services that comprise Google’s search engine.

**7. Survey evidence shows that the vast majority of consumers understand GOOGLE to be a trademark**

Because a term is not generic if it is commonly understood by the public to be a brand, consumer surveys are given significant weight in genericness cases. *See* McCarthy § 12:14. The standard in determining whether a term is a generic name or is instead a brand “is not whether the term has some significance to the public as a generic name of an article, but whether its generic meaning is its primary significance.” McCarthy § 12:6. “The result of the primary significance rule [is] that majority usage controls.” *Id.*; *see also* *Windsurfing Int’l, Inc. v. Fred Ostermann GMBH*, 613 F. Supp. 933, 959 (S.D.N.Y. 1985), *aff’d in part, rev’d in part*, 782 F.2d 995 (Fed. Cir. 1986) (finding “windsurfer” generic after 61.4% of survey respondents recognized term as the name of a type of product rather than a brand); *Intel*,

756 F. Supp. at 1297 (finding “386” generic for microprocessors after 72% of survey respondents expressed belief that it was generic); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1218 (10th Cir. 2004) (“beerman” generic when recognized as common name by 75.9% of survey respondents).

Here, when asked in a *Teflon* survey whether GOOGLE was a common or brand name in connection with searching the Internet, the vast majority (93.77%) of respondents identified GOOGLE as a brand, not a common name. (GER84 ¶41; ER2777 ¶4.) Not surprisingly, and as the District Court found, these results overwhelmingly establish that GOOGLE is not generic.

Desperate to avoid these conclusive survey results, Plaintiffs cite *Anti-Monopoly, Inc. v. General Mills Fun Grp., Inc.*, 684 F.2d 1316 (9th Cir. 1982), for the proposition that the *Teflon* methodology employed by Google’s survey expert cannot accurately measure the primary significance of the GOOGLE mark. (Op. Br. at 30.) Although the District Court specifically noted that *Anti-Monopoly* is not good law, Plaintiffs have apparently decided to ignore that Congress passed the Trademark Clarification Act of 1984 for the very purpose of “overturn[ing] the reasoning in” and “rectif[y]ing the confusion generated by *Anti-Monopoly*.” (ER13 (quoting S. Rep. No. 98-627, at 8, *reprinted in* 1984 U.S.C.C.A.N. 5718, 5725).)

Even before it was overturned, the *Anti-Monopoly* decision was considered an anomaly in trademark law because it created a new test for genericness never seen before or since, *i.e.*, that genericness depends on whether a majority of customers were motivated to buy a product because they knew the trade name of the manufacturer. 684 F.2d at 1324–26. As McCarthy notes, “[t]his bizarre and aberrational view was outside the mainstream of trademark law, which only requires that a trademark identify a single, albeit *anonymous* source.” McCarthy § 12:7 (citations omitted). Due to the unwarranted burden that the “consumer motivation” test placed on trademark owners, and in response to the *Anti-Monopoly* decision, Congress amended the Lanham Act in 1984 to codify the primary significance test as the one and only test of genericness. Trademark Clarification Act of 1984, Pub. L. No. 98-620, 98 Stat. 3335; *see also Gen. Conf. Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Kinship, Int’l, Inc.*, No. CV 87-8113 MRP, 1991 U.S. Dist. LEXIS 21915, at \*13–14 n.2 (C.D. Cal. Oct. 3, 1991) (noting that the 1984 Clarification Act “specifically rejects the Ninth Circuit’s purchaser motivation test adopted in *Anti-Monopoly*”). Plaintiffs’ reliance on *Anti-Monopoly* is both improper and unavailing.

Plaintiffs also argue that a *Teflon* survey is incapable of measuring the primary significance of a mark that is used in connection with services (as well as goods) and claimed to be used as a verb. Plaintiffs cite absolutely no authority for this argument, and it is obvious why. Plaintiffs' criticisms of Dr. Ford's *Teflon* survey boil down to the fact that it does not measure whether consumers primarily use GOOGLE as a verb. But of course the survey did not measure verb usage—why would it? Verb usage is not a factor considered by courts in determining whether a trademark is generic, and it is certainly not a singularly dispositive factor, as Plaintiffs contend.

Dr. Ford's survey is a well-constructed and routinely-accepted application of the *Teflon* methodology that has accurately measured the primary significance of the GOOGLE trademark among the consuming public. Tellingly, Plaintiffs' own survey expert, Mr. James Berger, conceded that a *Teflon* survey is a "well known protocol" to test for genericness. (GER84 ¶44; ER2802:7–2803:4.) Nothing in Plaintiffs' Opening Brief remotely calls into question the soundness (and conclusiveness) of Dr. Ford's survey on the issue of GOOGLE's primary significance as a trademark.

**C. Plaintiffs Failed To Meet Their Burden To Raise a Genuine Issue as to the Protectability of the GOOGLE Mark**

Unable to refute the foregoing evidence that GOOGLE is a strong and protectible trademark, Plaintiffs instead invent a novel genericness theory. They argue: (1) GOOGLE is primarily *used* as a verb; (2) its “primary significance” is therefore as a verb; (3) verbs cannot function as trademarks; so (4) the GOOGLE mark must be generic. (*See Op. Br.* at 13–14.) Even if Plaintiffs had admissible evidence demonstrating that GOOGLE is more often used as a verb than as an adjective or attributive noun (they do not), the notion that such a fact supports a genericness determination is legally baseless and logically unsound.

**1. Plaintiffs’ evidence does not establish that the GOOGLE mark is primarily used as a verb, much less a verb meaning to search the Internet using any search engine**

The factual predicate underlying Plaintiffs’ genericness theory is that the GOOGLE mark is most often used as a verb. However, Plaintiffs fail to proffer admissible evidence to prove this assertion. Anecdotal evidence that the media, cartoonists, TV and film writers, and others sometimes use Google as a verb is plainly insufficient as it does not permit the Court to quantify and compare how often GOOGLE is used as an adjective or noun (or any other

part of speech). Nor have Plaintiffs or their experts gathered evidence of non-verb usage or performed such a comparison themselves. Instead, the only evidence Plaintiffs point to in support of their argument that GOOGLE is primarily used as a verb are the results of Mr. Berger's single-question survey and the results of two deeply flawed surveys conducted by Plaintiffs' counsel, Richard Wirtz. (Op. Br. at 22–27.) Neither establishes that the word “google” is primarily used as a verb, much less that it is primarily used as an indiscriminate verb meaning to search the Internet using any search engine.

**a. The Berger Survey**

As an initial matter, Mr. Berger's survey is inadmissible. For survey results to be admissible, the proponent must show, among other foundational evidence of trustworthiness, that “sound interview procedures were followed by competent interviewers who had no knowledge of the litigation or the purpose for which the survey was conducted.” *Apex Eyewear, Inc. v. Revolution Eyewear, Inc.*, No. CV 99-1623, 2001 U.S. Dist. LEXIS 25831, at \*22 n.3 (C.D. Cal. Jun. 4, 2001); *see also Simon Prop. Grp. L.P. v. MySimon, Inc.*, 104 F. Supp. 2d 1033, 1037–38 (S.D. Ind. 2000) (“To be admissible, the survey must be conducted by qualified experts and impartial interviewers.”);

*Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 814 (9th Cir. 1997) (requiring that surveys be both “relevant” and “conducted according to accepted principles”).

Mr. Berger conceded at his deposition that he was not impartial; he took a results-oriented approach designed to “prove” that the GOOGLE mark is generic, rather than to test that theory. (GER84 ¶45; ER2804:7-10.) He further conceded that he did not use an accepted survey method: his single-question survey protocol has never been endorsed or accepted in any court case, treatise, or article. (GER85 ¶46; ER2806:20–2807:3, 2809:1-5.) And he conceded that his survey lacks relevance to the issues in this case insofar as it admittedly: (1) did not test whether consumers understand that the term “Google” applies to a particular company; (2) did not test the primary significance of the term “Google” to consumers; and (3) did not test whether the term “Google” was generic with respect to Google’s search engine and related services (*i.e.*, the subject of the challenged GOOGLE Registrations). (GER85 ¶47; ER2805:15-17, 2809:13–2811:10, 2811:4-10.) As such, the Berger survey does not merely “push[] the boundaries of reliability” and relevance, as the District Court found (ER18); it crosses over them.<sup>10</sup>

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<sup>10</sup> The District Court found that Mr. Berger’s survey results were only partially admissible. Because he did not conduct the Wirtz surveys and was therefore unqualified to opine on them, the District Court concluded that his

Even if admissible, Mr. Berger's survey is fundamentally incapable of establishing Plaintiffs' core premise that the word "google" is used more often than not as a verb. The survey consisted of a single question: "[I]f you were going to ask a friend to search for something on the Internet, what word or phrase would you use to tell him or her what you wanted him or her to do?" (GER85 ¶48; ER2808:2-5.) According to Mr. Berger, roughly 51% of respondents said that they would ask a friend to "Google it." (GER85 ¶49; ER2808:11-13.)

Such evidence is probative of nothing. For one thing, the single survey question asked respondents to respond by describing an action, *i.e.*, it was designed to elicit a verb. Moreover, Mr. Berger did not ask any follow up questions to determine if the response provided was the way in which the respondents most often used the word "Google." And he made no effort to ascertain what any respondent actually meant when they responded "Google it." It is quite plausible (if not highly likely) that respondents used "Google it" as shorthand for "conduct a search on the Google search engine." In short,

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opinions regarding those surveys were inadmissible. However, the District Court found that his own survey provided data "to opine about whether and how the word google is used as a verb" and, accordingly, that his "opinion that a majority of the public uses the word google as a verb to mean search on the internet, *and only that opinion*, is admissible." (ER18 (emphasis added).)

Mr. Berger's survey results do not give rise to a plausible inference that the word "google" is most often used as a verb, much less a verb meaning to search the Internet on any search engine.

**b. Mr. Wirtz's Surveys**

Plaintiffs concede that Mr. Wirtz single-handedly wrote "the questions and the available answers" for the surveys he conducted using Google's survey tool. (Op. Br. at 23.) This concession, by itself, is fatal to the surveys' admissibility.

As stated above, for survey results to be admissible, they must be conducted by "qualified experts and impartial interviewers." *Simon*, 104 F. Supp. 2d at 1037–38. Because a party's counsel are by no means impartial, McCarthy makes plain that, "[t]he only relevant limitation [on an attorney's participation in a survey] is that the *attorneys do not conduct the survey.*" 6 McCarthy on Trademarks and Unfair Competition § 32.166 (4th ed. 2013) (citing *Hodgdon Powder Co. v. Alliant Techsystems, Inc.*, 512 F. Supp. 2d 1178 (D. Kan. 2007) (survey that was designed and run by plaintiff's attorney without input from a survey professional was "untrustworthy and inadmissible"). Even if Mr. Wirtz claimed to have any experience conducting

consumer surveys (he does not), the fact that he represents Plaintiffs renders his surveys inadmissible.

Notably, the surveys also suffer from a number of other obvious flaws that entirely undermine their reliability. First, it is impossible to tell from the studies who the respondents were, or to assess any potential for bias resulting from the respondents' demographics. Nor is it possible to discern whether each respondent was unique (*i.e.*, whether participants submitted multiple responses). (GER47–49 ¶23; ER1399 ¶17.) Second, “Google” is not capitalized in the survey questions, as one might expect when being asked about Google as a company or a brand. (GER47–49 ¶23; ER1385 (71:14–72:17).) Third, and most problematic, the surveys vaguely asked participants what they “most often use the word ‘google’ to mean,” but then gave them three predetermined responses which inexplicably omitted the most obvious and relevant response, namely: “to search for information using the Google search engine.” (GER47–49 ¶23; ER1400 ¶19.)<sup>11</sup> As the District Court found, “neither the Wirtz surveys themselves nor the opinions Mr. Wirtz draws therefrom meet the threshold standard of reliability required by the

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<sup>11</sup> Indeed, given that Mr. Wirtz's surveys were conducted using the survey tool on Google's website, the only rational conclusion is that most, if not all, of the survey participants are users of the Google search engine and very much aware that GOOGLE is a brand. Plaintiffs do not argue otherwise.

Federal Rules of Evidence . . . .” (ER16.) Accordingly, the District Court properly found these surveys unreliable and inadmissible. (ER14–16.)

## 2. Plaintiffs’ genericness theory fails as a matter of law

Plaintiffs’ genericness argument would fail even if they could show that the relevant consuming public primarily uses “Google” as a verb.

Plaintiffs cite no authority, and Google is aware of none, for the proposition that a trademark ceases to function as a trademark merely because it is used as a verb. In fact, to Google’s knowledge, no court in the United States has held that verb usage is evidence that the mark has become generic, much less that such use warrants invalidation of a registered trademark.<sup>12</sup>

Acknowledging as much, Plaintiffs nevertheless assert that summary judgment should not have been granted for Google because the Trademark Trial and Appeal Board (“TTAB”) has “recognized” a so-called “dichotomy

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<sup>12</sup> Plaintiffs’ reliance on the unpublished district court decision in *FreecycleSunnyvale v. Freecycle Network, Inc.*, No. C 06-00324, 2006 U.S. Dist. LEXIS 74767 (N.D. Cal. Oct. 3, 2006), for the proposition that “verb usage of a trademark . . . can lead to a mark becoming generic” is both misleading and unavailing. (Op. Br. at 52.) There, the defendant filed a counterclaim for contributory infringement alleging, among other things, that the plaintiff had encouraged third parties to use defendants’ mark as “verbs, adjectives, gerunds, and participles.” *FreecycleSunnyvale*, 2006 U.S. Dist. LEXIS 74767, at \*8. The court held merely that defendants’ pleading was sufficient to survive a motion to dismiss; it neither held that verb usage is generic usage nor made any prediction as to whether defendants’ counterclaim would ultimately prevail. *Id.* at \*8–10.

between verb usage and trademark usage.” (Op. Br. at 51 (citing *In Re Treeradar, Inc.*, 77579817, 2011 WL 3212252 (TTAB July 15, 2011), and *In Re Grindmaster Corp.*, 77834762, 2011 WL 5600317 (TTAB Oct. 28, 2011)).) These decisions provide no aid to Plaintiffs, as neither stands for the proposition that a famous trademark loses its protection merely because it is frequently or even predominantly used as a verb.<sup>13</sup>

Not only do Plaintiffs fail to cite any authority for their “verb usage equals genericness” argument, they also badly misconstrue the primary significance test. Plaintiffs argue (without competent evidence) that the word “Google” is primarily used as a verb, so a jury could find that its “primary significance” is that of a generic verb, not of a trademark. In other words, Plaintiffs argue that the purpose of the primary significance test is to

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<sup>13</sup> In *Treeradar*, the TTAB denied registration on the ground that TREE and RADAR were generic words that described the applicant’s tree imaging goods and services, rather than indicating a particular source. 2011 WL 3212252, at \*8. The TTAB also pointed to evidence of the applicant’s own generic use of the mark, generic dictionary definitions, and generic use of the mark by competitors and third party publications. *Id.* at \*6–7. Similarly, in *Grindmaster*, the TTAB concluded that the mark “GRIND’N BREW” was generic based on dictionary definitions, third-party ads, online customer reviews, and media publications. 2011 WL 5600317, at \*3–10. That both marks had been used as verbs was mentioned as part of the TTAB’s overall consideration of the trademark applications, but it was hardly dispositive, as Plaintiffs erroneously suggest. Plaintiffs concede that neither decision is precedential. (Op. Br. at 51.) Indeed, both decisions have been designated as non-precedential, even for the TTAB.

determine how consumers *use* the term in question. Plaintiffs are simply wrong.

Although Plaintiffs' entire case depends on this erroneous interpretation of the primary significance test, they have failed (not surprisingly) to cite any legal support for their position. In fact, the cases cited by Plaintiffs make clear that the primary significance test evaluates how consumers understand or regard a term, not how they use it in conversation. (*See* Op. Br. at 19 (citing *King-Seely*, 321 F.2d at 581 (assessing whether a majority of consumers are “aware of any trademark significance”); McCarthy § 12:6 (explaining that a term’s primary significance is determined by examining whether a majority of the relevant public “regard” the term as a trademark or as generic)); *see also Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (a mark is not generic when the “primary significance of the term *in the minds of the consuming public* is not the product but the producer”) (emphasis added); *E. I. Du Pont de Nemours*, 393 F. Supp. at 525 (generic use of a mark does not constitute sufficient evidence that the mark has become generic in the minds of consumers).

As McCarthy explains, “[b]uyers or users of a product may sometimes *use* a trademark in a generic sense in casual conversation even though when

questioned, those persons are fully *aware* of the trademark significance of the term.” McCarthy § 12:8 (emphasis added).

For example, persons may use XEROX or KLEENEX in a generic sense when asking someone to “Make me a Xerox of this” or asking a friend for “a Kleenex,” even though when going to purchase a photocopy machine or a box of tissues, they know that XEROX and KLEENEX identify the commercial source of those products. *Such casual, non-purchasing uses of terms are not evidence of generic usage.*

*Id.* (emphasis added; citations omitted).

Here, Plaintiffs’ alleged evidence of verb usage sheds absolutely no light on the key question before the Court, *i.e.*, whether consumers understand GOOGLE to be a trademark. One can use the word “google” as a verb (*e.g.*, “I googled myself today”) while at the same time knowing full well that Google (like Bing and Yahoo! and Ask.com) is a particular provider of search engine services. To the extent Plaintiffs argue otherwise, they do so without legal or factual basis.<sup>14</sup> As the District Court held, “Plaintiffs cannot supplant the primary-significance test with a frequency-of-verb-use test to cancel the GOOGLE mark, which they admit refers to ‘one of the largest, most

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<sup>14</sup> In fact, just as the words “hamburger” and “cola” are implied in the statement “I’ll have a BIG MAC and a COKE” (*see* McCarthy § 12:8)), so too are the words “on the Google search engine” implied when one says “I just Googled the phrase ‘faulty logic.’”

recognized, and widely used Internet search services in the world.” (ER26 (citing GER79 ¶2; GER23 ¶2).)

Google, in sharp contrast, has proffered evidence—through the accepted protocol of Dr. Ford’s *Teflon* survey—that the primary significance of Google is as a trademark insofar as nearly 94% of the relevant public recognizes that GOOGLE is a brand name that identifies a particular source of search engine services. (GER84 ¶¶40–41; ER2777 ¶¶2, 4.) This means that for the vast majority of consumers of search engine services, “Google” answers the question “who are you?” whereas “search engine” answers the question “what are you?” Such results—which should come as no surprise to anyone familiar with Google’s products and services—provide strong, uncontroverted evidence that GOOGLE’s primary significance is that of a trademark, not a generic term.

**3. None of Plaintiffs’ other purported evidence raises a genuine issue for trial**

The operative question in assessing Plaintiffs’ genericness claim is whether GOOGLE serves “as an indication of a single commercial source for certain goods or services.” McCarthy § 12:6. Plaintiffs offer an amalgam of irrelevancies, omissions and half-truths, none of which support Plaintiffs’

claim that the GOOGLE mark has lost its source-identifying function and thereby become generic.

For instance, Plaintiffs cite to Google co-founder Larry Page's invitation to "Have fun and keep googling!" as "strong evidence" that Google uses the GOOGLE mark generically. (Op. Br. at 38.) Yet even a cursory review of the newsletter validates what any rational person would presume: Mr. Page was referring specifically to the Google search engine he co-created. Indeed, the first paragraph of the newsletter states: "This [] is an announcement list for the Google search engine which is available at <http://google.stanford.edu/>." (GER38 ¶2; ER2122.) *See, e.g., KP Perm. Make-Up*, 408 F.3d at 605-06 (examining context of founder's statements and rejecting assertion that her use of "micro colors" was generic).

Plaintiffs also argue that a jury could discount the dictionary evidence showing that Google is widely understood as a trademark because Google allegedly "has engaged in a pattern of threatening and intimidating dictionary publishers." (Op. Br. at 36.) This argument is particularly inexplicable, considering that the Ninth Circuit considers vigilance in enforcing trademark rights to weigh against a finding of genericness. *See, e.g. Filipino Yellow Pages*, 198 F.3d at 1151 (affirming lower court's reliance on plaintiff's lack

of trademark policing as evidence mark had become generic). In any event, as the District Court found, “Plaintiffs’ assertions that dictionaries have been ‘intimidated into submission’ and temper their definitions ‘out of [their] fear of [Google]’” are scurrilous attacks unsupported by admissible evidence.” (ER20 n.9.)<sup>15</sup>

Plaintiffs next point to examples of cartoons, television shows, song lyrics, and books in which the word “Google” is used as a verb. (Op. Br. at 39–41.) Not one of these examples remotely suggests that the speaker fails to grasp that GOOGLE is a proprietary name for a particular search engine.

Plaintiffs also argue that “the lack of an adequate substitute generic word is evidence of the genericness of a former trademark adopted by the public.” (Op. Br. at 43–44 (citing cases considering whether a substitute generic term existed for aspirin (generic), cellophane (generic), Q-Tips (not generic, since one could say “medical swab,” “applicator,” or “cotton-tipped applicator”), and Dictaphone (not generic, since “dictating machine” and “dictation equipment” are available common names).) However, in making

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<sup>15</sup> Plaintiffs make a similar argument with respect to the lack of evidence that competitors use the GOOGLE mark generically (Op. Br. at 44–45), and it fails for the same reasons. Moreover, contrary to Plaintiffs’ unsupported assertion, there is no evidence in the record that Google has attempted to police (or ever needed to police) infringing use of the GOOGLE mark by competitors.

this argument, Plaintiffs acknowledge that “search the internet” is an available substitute for the verb “Google,” disproving their own point. (*Id.* at 44.)

Plaintiffs selectively quote a fraction of a single sentence from Dr. Nunberg’s report, in which he states that “a verb cannot serve as a trademark,” as support for their genericness claim. (Op. Br. at 53.) In fact, Dr. Nunberg’s report explicitly rejects the notion that Google is “nonspecific” when used as a verb. (ER1378.) He goes on to opine “that all the relevant forms of evidence demonstrate that the use of *Google* as a verb is specific in its application; that is, it literally denotes only the process of using the Google search engine to search the web.” (ER2958.) And Dr. Nunberg expressly concludes that “[t]he use of *Google as a verb does not in any way compromise its status as a trademark.*” (ER1376 (emphasis added).) As he explained at his deposition, if a mark continues to serve as a source identifier, the fact that it is also used as a verb is irrelevant to the genericness inquiry:

[T]here are any number of marks that have been used as verbs for a long time for which consumer identification of the mark as a trademark is or is presumed to be quite high. And one would assume that that, and not its use as a verb or its use metaphorically in some other sense, is what determines its status as a trademark[. I]f it continues to distinctively identify the source of the product[, o]ne would assume it hasn’t lost its trademark status.

(ER1384 (61:10-18); *see also* ER2819:20-25 ( “Google has not become

generic”).) Accordingly, Plaintiffs’ citation to Dr. Nunberg’s report in an attempt to support their genericness argument is simply baffling.<sup>16</sup>

In a last, desperate effort to raise a genuine issue for trial, Plaintiffs cite to alleged “examples of media usage of GOOGLE to refer to the act of searching on something other than Google Inc.’s search engine.” (Op. Br. at 41–42.) This evidence is inadmissible and, in any event, does not support the proposition for which it is cited.

As a threshold matter, Plaintiffs have neglected to mention that the District Court held these materials inadmissible because they were never produced to Google in discovery. (ER22–23 n.7 (citing Fed. R. Civ. P 37(c)(1) (“If a party fails to provide information . . . as required by Rule 26(a) . . . , the party is not allowed to use that information . . . to supply evidence on

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<sup>16</sup> Plaintiffs assert that Dr. Nunberg is conflicted and that his report lacks credibility because Plaintiffs tried to retain him early on in this case. (Op. Br. at 31–33.) However, it is undisputed that Plaintiffs and their counsel never retained him, provided him with confidential information, asked him to keep anything they told him confidential, or compensated him. (GER18 ¶106; ER45 (95:5-25).) Moreover, none of the evidence submitted by Plaintiffs remotely suggests that Dr. Nunberg had formed an opinion at the time they sought to retain him, much less that he “reversed his opinion” when retained by Google. (Op. Br. at 32.) To the contrary, Dr. Nunberg testified that he never formed a contrary opinion and that he declined to serve as Plaintiffs’ experts because he “didn’t think [they had] a great case.” (GER18 ¶106; ER43 (85:9-20), 44 (87:5-14).) The District Court properly rejected Plaintiffs’ attacks on Dr. Nunberg’s report as “unsubstantiated.” (ER12.)

a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless.”); *see also* GER9–11 ¶¶91–93.) Plaintiffs’ Opening Brief contains no challenge to this aspect of the District Court’s Order, so any argument that these materials are, in fact, admissible is waived. *Bray v. Comm’r of Soc. Sec. Admin.*, 554 F.3d 1219, 1235 n.7 (9th Cir. 2009) (argument not made in opening brief waived) (citation omitted).

Moreover, the “evidence” is nothing more than unauthenticated and irrelevant hearsay. For example, Plaintiffs cite the “Deadly Towers” episode of a TV series entitled “The Angry Video Game Nerd” wherein a character allegedly says that “I googled it to check what it meant, and according to urban dictionary . . . .” (Op. Br. at 42.) Putting aside the lack of authentication of this evidence, it does not remotely suggest that the GOOGLE mark is being used generically. To the contrary, the only logical interpretation of the statement is that the character ran a search for “it” (whatever “it” might be) on the GOOGLE search engine and one of the search results was an entry in the Urban Dictionary.<sup>17</sup> As such, this “evidence” is

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<sup>17</sup> The Google search engine uses proprietary algorithms to crawl through the vast number of third party websites accessible through the Internet and return links to third party webpages that appear relevant to a search query.

merely representative of a typical search conducted using the GOOGLE search engine and not evidence of genericide. (GER9–10 ¶¶91.)

Similarly, Plaintiffs refer to an episode of a German language show entitled “Neues aus der Anstalt” in which a character purportedly says “I googled at wikipedia, and you said ‘some Horst Kohler[.]’” (Op. Br. at 42.) Again, lacking authentication, the alleged statement by a character on an obscure foreign television show, without any context, sheds no light on how the speaker regards or understands the GOOGLE mark. (GER10 ¶¶92.) Ignoring the obvious language barrier and translation problems, this purported evidence about how the GOOGLE mark is used in Germany is wholly irrelevant to this case, which challenges United States trademark registrations. *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 642 (8th Cir. 1984) (“[I]t is irrelevant how a term is used outside the United States” for determining genericness inside the United States); *Carcione v. Greengrocer, Inc.*, 205 U.S.P.Q. (BNA) 1075, 1077 (E.D. Cal. 1979) (“Since we deal here with American trademark law, and thus American consumers, neither British

usage nor the dictionary definition indicating such usage are determinative.”)<sup>18</sup>

Plaintiffs also rely on unauthenticated evidence of alleged search results that purport to show that users “googled” on a number of other Internet sites such as IMDB, Pinterest, Facebook, Wikipedia and eBay. (Op. Br. at 42.) Yet there is no indication of who ran these searches or when; they are not supported by an authenticating declaration; and it is impossible to tell from the brief snippets Plaintiffs cite what any particular search result actually says or means in context. (GER10–11 ¶93.) “Googled on eBay,” for instance, could mean that someone searched for eBay listings by entering search terms into Google’s search engine.

Finally, Plaintiffs’ genericness argument finds no support in the purported “Proposal Request Forms” wherein the response “I googled it” was allegedly provided in answer to the question “[h]ow did you hear about us?” posed by an Internet website. (Op. Br. at 10–11 (citing ER83–84, 832–41);

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<sup>18</sup> For the same reason, the fact that the Swedish Language Council considered adding a word to the Swedish language—*ogooglebar*, meaning something “that you can’t find on the web with the use of a search engine” (Op. Br. 8–9, 37)—is irrelevant, since what people understand the word Google to mean in Sweden has no bearing on the protectability of Google’s U.S. Registrations or how the word is understood in the United States.

*see also* GER11 ¶94.) Like the other evidence cited above, these forms contain, at best, double hearsay. Moreover, although Plaintiffs claim that the website’s traffic “tracker” shows that some respondents actually navigated to the website through other search engine services, this fact (even if true) does not demonstrate that respondents were using the word Google as a verb meaning to search using a search engine other than Google. First, there is no way to tell whether these individuals in fact first learned about the website in question through Google’s search engine, and then later migrated to the site from another search engine. Second, these forms and the accompanying Declaration of Peter Vanrydam do not indicate whether or not the respondents understand Google to be the name of a particular search engine, which clearly falls short of satisfying the primary significance test.

In sum, the only thing Plaintiffs’ evidence demonstrates is that the GOOGLE mark is sometimes used as a verb, which fails to satisfy Plaintiffs’ burden of demonstrating that the GOOGLE mark is generic. As Google’s survey expert noted, “[T]here can be little debate that the primary significance of ‘Google’ is as a brand name of a particular search engine. Accordingly, from a consumer psychology perspective, it is impossible that the primary significance of Google to consumers will be anything other than as a brand

name whether or not some of them casually use the word as a verb to refer to an Internet search.” (GER47–49 ¶¶23; ER1401 ¶¶30.)

#### **4. Plaintiffs’ policy arguments are unavailing**

Plaintiffs conclude their Opening Brief by arguing that public policy favors a finding of genericness in this case. Plaintiffs argue that extending protection to generic marks harms competitors and the public, stifles competition and prevents those in parallel markets from advertising and promoting their goods and services. (Op. Br. at 61–64.) While those ills may justify cancellation of a registered mark which “becomes the generic name for the goods or services, or a portion thereof, for which it is registered” (15 U.S.C. § 1064), such is clearly not the case with the GOOGLE mark. Plaintiffs have not adduced a single shred of evidence to show that the GOOGLE mark has lost its ability to designate Google as the source of its world-famous search engine.

Instead, it is clear from the undisputed facts that what Plaintiffs are attempting to do through this lawsuit is misappropriate Google’s valuable brand recognition and goodwill for their own business purposes through their use of the 763 infringing domain names they registered in 2012, as well as any others they can get their hands on. (See Section II, *supra*, at 8–9.)

Plaintiffs cannot come up with any policy argument that sanctions the piracy they have attempted to perpetrate on Google. To the contrary, the purposes underlying the Lanham Act weigh in favor of affirming summary judgment for Google and preventing Plaintiffs (and others) from taking that which Google has worked so hard to promote and protect—its good name:

The twofold justification for the Lanham Act . . . was: (1) “to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get”; and (2) “where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.”

(ER8 (quoting S. Rep. 1333 at 1 (1946), reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1274); *see also id.* (quoting S. Rep. No. 98-627, at 2, reprinted in 1984 U.S.C.C.A.N. 5718, 5719) (“Because of their importance to our nation’s commerce, trademarks long have been protected from appropriation and misuse by others . . . .”)).)

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**CONCLUSION**

For all of the foregoing reasons, the Court should affirm the District Court's Order and Judgment granting summary judgment to Google.

Dated: October 28, 2015

Respectfully submitted,

GOOGLE INC.

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**CERTIFICATE OF COMPLIANCE  
PURSUANT TO FED. R. APP. P. 32(a)(7)(C)**

I, Angela L. Dunning, hereby certify that, pursuant to Federal Rule of Appellate Procedure 32(a)(7)(C), the foregoing GOOGLE INC.'S ANSWERING BRIEF is proportionately spaced, has a typeface of 14 points or more using Microsoft Word Times New Roman font, and contains approximately 13,817 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

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**CERTIFICATE OF SERVICE**

I, Angela L. Dunning, hereby certify pursuant to Federal Rule of Appellate Procedure 25(d) that I electronically filed the foregoing GOOGLE INC.'S ANSWERING BRIEF with the Clerk of the Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system on October 28, 2015. The participants in this case identified below were served electronically by the appellate CM/ECF system:

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