

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 REPLY BRIEF**

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## I. INTRODUCTION

Language is constantly evolving and trademark law – the law of commercial language – must evolve with it. When the concept of genericness was first codified, a mark was found to be generic when it became the name for the class of goods to which it was applied (e.g., ESCALATOR for moving staircases). Later, this concept expanded and it is now widely recognized that a mark can also be generic when it describes the class of goods to which it is applied (e.g., MATCHBOX for matchbox-sized toy cars). Now this Court is faced with a new scenario: the use of trademarks to denote *an action* related to the good and services to which the trademark is applied. We now refer to magazine cover photos as "photoshopped"; we "windex" our windows to remove streaks; we "xerox" exhibits; we "rollerblade" down the street on our inline skates; we "wite-out" the mistakes in a term paper; and we read a news article about the police "tasing" a resistant suspect. The impact these verb uses (i.e. "verbing") of trademarks have on the validity and strength of the respective trademarks involved has never been decided by this or any Court.

Google Inc. would have this Court find verb usage of a trademark to be entirely irrelevant to the genericness inquiry and thus entirely exclude all evidence of verb usage in determining the genericness of a mark. This is what the district court found; in so doing, the district court not only weighed the evidence, but then closed its eyes



to thousands of pages of evidence on how the relevant public understands and uses the GOOGLE trademark.

Plaintiffs and Appellants Elliott and Gillespie (collectively "Elliott"), advocate a more holistic approach. Elliott submits the question to be asked is: Taking into account all uses of the mark in question (whether as nouns, adjectives, or verbs), is the majority of the relevant public's uses of the mark (a) indicative of a source of goods or services (non-generic), or (b) indicative of something else, such as the name of the genus of goods or services, a characteristic of the genus of goods or services, *or an action involving the genus of goods or services?*

If this Court affirms the district court's ruling, then it would be finding that there can be no set of facts in which a mark may become generic based on indiscriminate verb usage. As applied to the facts in this case, this Court would be finding that even if it can be proven that every single time someone uses the word "google" as a verb, he/she means and understands the word to mean "to search on the internet using *any* search engine," the mark is still not generic. Such a result cannot be the step in the evolution of the trademark law.

If, on the other hand, this Court determines that evidence of indiscriminate verb usage has any bearing whatsoever on the genericness of a mark, then this case must be remanded for trial where the evidence will be weighed appropriately by a jury and

not the district court.

## **II. RESPONDENT HAS MISCONSTRUED THE FACTS TO POISON THE WELL: APPELLANTS ARE NOT CYBERSQUATTERS**

To distract the Court from the merits of this appeal and poison this Court’s opinion of Elliott, Google in its Respondent’s Brief states that “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.” (Brief, Pg. 19)

First, Google Inc.’s allegations of cybersquatting against Elliott were not at issue before the trial Court on the underlying motion and are not supported by evidence in the record. This is an appeal from the district court’s order granting Google Inc.’s motion for summary judgment on the issue of genericness. Elliot and Gillespie’s actions which precipitated this action are not relevant to the issue of genericness. Notably, in support of its prejudicial statement that “Mr. Gillespie [was] seeking to trade off brand owners’ goodwill...” Google Inc. cites only to the existence of the domain registrations themselves, and not to any actual evidence in the record of Mr. Gillespie’s intent. This is because Mr. Gillespie’s intent was not at issue before the district court.

Second, Google Inc.’s statement that this is “a classic case of cybersquatting”

is completely disingenuous considering the fact that Google Inc. ultimately dismissed its cybersquatting claims against Elliott after its motion for summary judgment on the non-genericness issue was granted. (GER 1-5) Cybersquatting is not the issue here: genericness is.

Third, Google Inc.'s statement that this is "a classic case of cybersquatting" is demonstrably not true. As stated above, Mr. Gillespie's intent is not at issue here; however, because Google Inc. has brought it up, Gillespie has no choice but to refute the unsubstantiated accusation. "Under the classic definition, a 'cybersquatter' is a person who knowingly obtains from a registrar a domain name consisting of the mark or name of a company for the purpose of ransoming the right to that domain name back to the legitimate owner for a price." 5 McCarthy on Trademarks and Unfair Competition § 25A:48 (4th ed.); see also House Judiciary Committee Report on H.R. 3028, H.R. Rep. No. 106-412 pp. 5-6 (October 25, 1999) ("These cyberpirates have no intention of using the domain name in commerce and instead often attempt to exact money from a company in exchange for domain names that relate to that company's trademarks."). Mr. Gillespie registered a number of domains which contained the *indiscriminate and generic* verb "google" plus a noun. He has not offered these domain names for sale to Google Inc. or to anyone else. He has not attempted to ransom the domains back to Google Inc.; he seeks *no* damages in his complaint. To

the contrary, he has complied with all requests from third-party trademark owners to transfer domain names that include those third parties' marks to them, *free of charge*. This is far from the "classic case of cybersquatting."

In contrast, third parties (not Elliott or Gillespie and not Google Inc.) own thousands of other domains which incorporate the word "google" and are, on those domains, running live web sites, including sites providing pornographic material, questionable dating services, competitive search engine services, and more. Screenshots of these sites can be found in the record at 15 ER 3169 - 3236. There is no evidence in the record of Google Inc. pursuing any of these other domain holders who are actually attempting to turn a profit using google-plus domains.

In addition, at the time of the filing of the complaint in this action, there were at least 949 google-plus domains for sale in the aftermarket through Go Daddy Auctions, being sold and offered for sale for tens of thousands of dollars. The owners of these domains are clearly turning a profit on the purchase and sale of google-plus domains and yet, again, there is no evidence in the record of Google Inc. pursuing any of these other domain holders.

In comparison, Mr. Gillespie's registration of the google-plus domains in question was a perfectly permissible academic experiment. Ironically, the source of all of this trouble is Mr. Gillespie's invention which he created to assist in the

prevention of cyberpiracy. Mr. Gillespie's invention (for which he filed a patent application) is a computer program which generates and registers domain names combining a word or series of words desired to be protected with other "trending" or highly searched terms. The purpose of this invention is to allow, for example, a trademark owner, to quickly and efficiently register a large number of domains incorporating his trademark and other highly searched terms and then resolve those domains back to the trademark owner's webpage. This serves the purpose of both preventing cyberpiracy by quickly registering domains containing the to-be-protected term, and increasing traffic to the trademark owner's own page. In order to test his invention, Mr. Gillespie chose to use the word "google" as the base term because it was both a generic term and a very highly searched term (for various reasons). To be clear, Mr. Gillespie did not intend to profit off his registration of the google-plus domains. Instead, he intended to profit off his invention by offering its services to third parties. The registration of the google-plus domains was merely an experiment.

**III. AN ORIGINALLY NON-GENERIC, VALID TRADEMARK BECOMES  
GENERIC AND INVALID WHEN BUYERS UNDERSTAND THE  
TERM AS BEING *IDENTIFIED WITH* (NOT JUST *MEANING*) ALL  
SUCH GOODS OR SERVICE, REGARDLESS OF THEIR SUPPLIERS**

Google Inc. argues that "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.*'” Brief Pg 3, citing 15 U.S.C. § 1064 (emphasis added by Google Inc. in its Brief). Based on this citation, Google Inc. attempts to over-simplify the issue by concluding that because “google” does not *mean* “search engine,” “google” is not generic. The question of whether “google” is generic is not so black and white. A mark may be generic though it does not directly name the goods and services. “Google” may be generic though it does not mean “search engine.”

Specifically, in *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1258 (9th Cir. 1982), to which Google Inc. itself cites, this Court held that an originally non-generic, valid trademark becomes generic and invalid when the principal significance of the word to the public becomes the indication of the nature or class of an article, rather than the indication of the article's origin. There is clearly a difference between a mark directly naming a class of goods or services, and the mark becoming an indication of the nature of a class of goods or services. The former is a more narrow inquiry, the latter a more broad inquiry.

Similarly, other 9<sup>th</sup> Circuit precedent has stated that if buyers understand the term as being *identified with* "a particular producer's goods or services, it is not generic." *Surgicenters of Am., Inc. v. Medical Dental Surgeries Co.* (9th Cir.1979) 601

F.2d 1011, 1016. "But if the word is *identified with all* such goods or services, regardless of their suppliers, it is generic." *Id.* (Emphasis added) Thus, "identified with" all such goods or services is not the same as directly naming such good or services. The former, like the concept of the "indication of the nature" of the goods or services is a broader concept which embraces both adjectives that are commonly used to describe the class of goods and verbs commonly used to describe the action of using the goods. See *Rudolph Int'l, Inc. v. Realys, Inc.* (9th Cir. 2007) 482 F.3d 1195, 1198 ("Adjectives, as well as nouns, can be generic marks.")(citing *Nupla Corp. v. IXL Mfg. Co.* (Fed.Cir.1997) 114 F.3d 191, 196, which held that "cush-n-grip" is a generic adjective for cushion-gripped tools); See also *Riggs Mktg. Inc. v. Mitchell* (D. Nev. 1997) 993 F. Supp. 1301, 1307 ("It is true that adjectives can be generic when they do not directly name the product but rather name some important characteristic of a product." citing McCarthy, Section 12:10.) For example, MATCHBOX was held generic for toy cars sold in matchbox sized packages. *J. Kohnstam, Ltd. v. Louis Marx & Co.* (C.C.P.A.1960) 280 F.2d 437. Similarly, LIGHT BEER was held generic for beer light in flavor and low in calories. *Miller Brewing Co. v. G. Heileman Brewing Co.* (7th Cir. 1977) 561 F.2d 75.

Thus, Google Inc.'s argument that "google" does not mean search engines misses the point entirely. The proper question is whether there exists a genuine triable

issue of fact as to whether google (when used as a noun, and adjective, or a verb) is primarily identified with Respondent's search engine service **exclusively** (trademark use) or with **any** search engine services generally (generic use).

**IV. WITH REGARDS TO THE QUESTION OF WHETHER GOOGLE IS GENERIC, THERE EXIST GENUINE ISSUES OF MATERIAL FACT WHICH REQUIRE THE MATTER TO PROCEED TO A JURY**

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.

**A. All reasonable doubt as to the existence of a genuine issue of fact should be resolved against the moving party.**

Google Inc. seems to argue that there was no genuine issue of material fact with regards to the genericness of the word "google" because Elliott did not conclusively prove that "google" was in fact generic. This, however, is not the standard. To establish the existence of a factual dispute, the opposing party need not establish a



material issue of fact conclusively; only that "the claimed factual dispute be shown to require a jury or judge to resolve the parties' differing versions of the truth at trial." *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Association* (9th Cir.1987) 809 F.2d 626, 630; See also *First National Bank of Arizona v. Cities Service Co.* (1968) 391 U.S. 253, 288-289 ("[i]t is true that the issue of material fact required by Rule 56(c) to be present to entitle a party to proceed to trial is not required to be resolved conclusively in favor of the party asserting its existence; rather, all that is required is that sufficient evidence supporting the claimed factual dispute be shown to require a jury or judge to resolve the parties' differing versions of the truth at trial.")

Any doubt as to the existence of a genuine issue of material fact should be resolved against the moving party, here Google Inc. *Hector v. Wiens* (9th Cir.1976) 533 F.2d 429, 432.

**B. A "Genuine Issue of Material Fact" Exists Where a Reasonably Minded Jury Could Return a Verdict in the Non-movant's Favor, Even When Such a Result Is Unlikely**

If the defendant in a run-of-the-mill civil case moves for summary judgment or for a directed verdict based on the lack of proof of a material fact, *the judge must ask himself not whether he thinks the evidence unmistakably favors one side or the other* but whether a

fair-minded jury could return a verdict for the plaintiff on the evidence presented. The mere existence of a scintilla of evidence in support of the plaintiff's position will be insufficient; there must be evidence on which the jury could reasonably find for the plaintiff.

*Anderson v. Liberty Lobby, Inc.* (1986) 477 U.S. 242, 252 (emphasis added).

Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict. The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.

*Id.* at 255.

In contravention of these standards, the district court in this case weighed the strength of the evidence, chose to discount and ignore Elliott's evidence. This was reversible error.

**C. Summary Judgment Is Disfavored in Trademark Infringement Cases Generally, and Particularly in Cases Where Trademark Validity Is at Issue**

A trademark infringement case where the validity of the mark in question is challenged on the grounds that the mark is generic is, more than other case,

particularly ill-suited to summary judgment. This is because, generally, "Because of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena." *Entrepreneur Media, Inc. v. Smith* (9th Cir.2002) 279 F.3d 1135, 1140 (quotation marks and citations omitted). And more specifically, because trademark validity is "an intensely factual issue," "summary judgment is generally disfavored in the trademark arena [especially where validity is at issue]." *KP Permanent Make-Up* (9<sup>th</sup> Cir. 2005) 408 F.3d 596, 602 (citation and quotation marks omitted). In fact, it has repeatedly been held that "Whether a mark is generic is a question of fact." *Stuhlberg Int'l Sales Co., Inc. v. John D. Brush & Co., Inc.* (9th Cir.2001) 240 F.3d 832, 840. Thus, it would be an egregious case, where absolutely no admissible evidence of genericness is presented, were summary judgment on non-genericness would be appropriate.

**D. Summary Judgment Is So Rare on the Issue of Non-genericness, Elliot Could Find Only One 9th Circuit Opinion Affirming the Grant of Summary Judgment on the Issue of Non-genericness, Where Literally No Admissible Evidence Was Offered by the Party Asserting Genericness**

Summary judgment is so rarely granted on the issue of genericness that Appellant was only able to find a handful of 9th Circuit cases dealing with the grant

of summary judgment on the issue. Of these, only one resulted in the 9th Circuit affirming a grant of summary judgment finding a mark to not be generic. *Coca-Cola Co. v. Overland, Inc.* (9th Cir. 1982) 692 F.2d 1250. Therein, The Coca-Cola Company brought suit against Overland Inc. (the Topaz Lodge and Casino) for substituting in response to orders for "Coca-Cola" or "Coke" other cola beverages. Defendant counterclaimed accusing plaintiff of using its trademark infringement suits as means of attempting to monopolize the soft-drink syrup market, in violation of Sherman Act. Defendant argued that "Coke" had become generic to all cola beverages. The District Court granted summary judgment against defendant on both plaintiff's complaint and defendant's antitrust counterclaim finding, among other things, that "Coke" had not become generic. The 9th Circuit affirmed this holding. However, it did so because Defendant Overland, in order to establish the existence of a genuine issue of material fact, had only submitted affidavits of its own employees stating that the employees believe that customers ordering "Coke" are using the term in a generic sense. *Id.* at 1254.

These affidavits are clearly insufficient to rebut the presumption that the trademark "Coke" is not generic and thus do not establish the existence of a genuine issue of material fact. Before affidavits opposing a motion for summary judgment can be given any weight, Rule 56(e) requires that

they be made on personal knowledge, set forth such facts as would be admissible in evidence, and show affirmatively that the affiant is competent to testify on the matters stated therein. *Id.* Overland's employees are not qualified to testify as to what their customers are thinking when using the term "Coke." See Fed.R.Evid. 701. The affidavit statements of the employees that they believe customers use "Coke" in the generic sense are thus inadmissible and must be disregarded as failing to meet the requirements of Rule 56(e). Moreover, even if the employees' affidavits are considered, they are too speculative and insubstantial to establish the existence of a genuine issue of material fact with respect to the genericness of the trademark "Coke."

*Id.* at 1254-55.

As the United States Supreme Court in *Anderson* stated, more than a scintilla of evidence is required to establish a genuine issue of fact. *Coca-Cola* gives an example of what the Court will find to be a mere scintilla of evidence: a handful of self serving affidavits testifying speculatively as to what other people mean when using a mark. However, in this case Elliott has extensively exceeded the quantity and quality of evidence put forth in the *Coca-Cola* case. Summary judgment was improper.

**E. In this case, the following are genuine issues of material fact which precluded summary judgment:**

**1. Whether Google, When Used as a Verb, Primarily Is Discriminate or Indiscriminate**

Elliott presented evidence that when “google” is used as a verb it is primarily used in an indiscriminate manner. In other words, when used as a verb, “google” is more often used to mean “to search the internet,” without regard to which search engine is used, than it is used to mean “to search the internet using only the Google search engine exclusively.” Google Inc. argues that, when used as a verb, “google” is mostly used to mean “to search the internet using the Google search engine.” Elliott has offered survey evidence on this question of fact, Google Inc. has offered no evidence at all on this point. Both sides have offered media evidence and argued as to the implications to be drawn from the media evidence. Elliott has offered direct evidence of purchasers using “google” to mean searching the internet using search engines other than Google Inc.’s search engine. None of this evidence was excluded outright as inadmissible. This is therefore a material question of fact for the jury to decide.

## 2. The Weight of Google Inc.'s Irrelevant Teflon Survey

Google Inc. offered an irrelevant survey which did not address verb usage at all but merely sought to test whether the word “google” when taken out of any context, is understood to also be a brand name. Elliott argued that the weight of that survey should be zero. See *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.* (9th Cir.1982) 684 F.2d 1316, 1323 (finding that a survey was “no evidence” to support a finding of nongenericness, when the party introducing it had made no showing of its relevance to the case)<sup>1</sup>. Not only did Google Inc.’s survey purposely avoid collecting the public’s understanding of the meaning of the verb google (instead specifically instructing respondents to classify Google as either a generic noun or a trademark), it completely failed to test whether Google is generic for services. All control words given to respondents were names for goods. Yet, Google Inc. has two trademarks at issue here: one for goods, and one for services. Google Inc.’s survey completely ignored the distinction between the two. Google Inc.’s survey is facially

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<sup>1</sup> Google Inc. argues that *Anti-Monopoly* is no longer good law. This is not accurate. Only one holding from *Anti-Monopoly* was overturned by the Trademark Clarification Act of 1984: the purchaser motivation test. The finding that a survey which is irrelevant to the issues at hand is “no evidence” at all of nongenericness is still good law. Elliott is not arguing that all Teflon-style surveys are inappropriate in genericness cases but rather that in this case the Teflon-style survey was no evidence of non-genericness because it failed to address the critical issue: the use of google as a verb.

worthless, but nonetheless should be presented to a jury for deliberation.

### **3. The Weight of Elliott's Thermos Survey**

Similarly, Elliott offered a relevant Thermos survey to show that the consuming public uses "google" primarily as an indiscriminate verb. Google Inc. challenged this survey. This survey was admitted by the district court. Therefor, pursuant to *Clicks Billiards, Inc. V. Sixshooters, Inc.* (9<sup>th</sup> Cir. 2001) 251 F.3d 1252, 1263, its weight should have gone to the jury. ("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... These are issues for a jury...")

### **4. The Weight of Elliott's Google Consumer Surveys**

The district court found that Elliott's Google Consumer Surveys were inadmissible because Elliott's attorney, Mr. Wirtz, "designed and executed" them. 1 ER 14. However, Mr. Wirtz neither designed nor executed these surveys; rather, Google Inc. did both the design and the execution. Google Inc.'s very own consumer surveys allow a user to select from a short menu of available survey formats and input the questions to be asked using a controlled amount of characters and, where applicable, the available responses to choose from. Once these parameters are inputted, Google Inc.'s consumer survey then conducts the survey, collects and



analyzes the data, and presents it as a report back to the user. Thus, while Mr. Wirtz chose the words and inputted the questions and the responses into the closed-question format provided by Google Inc.'s consumer survey, it is Google Inc. itself which designed, executed, compiled data on, and analyzed the surveys. It is exceedingly ironic that Google thereafter challenged the methodology and reliability of its own survey product.<sup>2</sup>

Google Inc. argues that Elliott's argument that Google Inc. itself conducted the Google Consumer Surveys means that "when someone uses the telephone to pose survey questions, Verizon or AT&T is actually conducting the survey." This statement is specious. When someone uses the telephone to pose survey questions, he interacts directly with the participants. He voices the questions, listens to and transcribes the answers, and then collects and tallies the results. In contrast, when Mr. Wirtz used Google Inc.'s consumer survey he simply supplied the text of the questions and available answers and clicked a button. Google supplied the format of the survey, randomized the answers, presented the questions to the participants, collected, tallied,

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<sup>2</sup> Google Inc.'s survey cost only \$100 to get 1000 responses. The survey provides the gender, age, location, and wealth of the respondents and the report can be sorted according to these varying demographics. Google Inc. advertises that its survey reaches validated, representative respondents. Indeed, Google's survey is actually more thorough than the \$25,000-\$50,000 traditional surveys. It is a question of fact for the jury to decide whether Google Inc.'s survey is good enough or if it constitutes an admission.

and analyzed their responses. Mr. Wirtz had no direct contact with the participants. The reason attorneys are permitted to participate in the design of surveys, but not their execution is because of the danger that an attorney interacting directly with survey participants will, through word or gesture, influence their responses. There was no such risk here. The only question, then, is whether these survey questions and the available responses were probative of the matter they are offered to prove: genericness.<sup>3</sup> This is a question as to the weight of the surveys and should have been left to the jury to decide.

It was error for the district court to exclude these surveys altogether. Rather, the jury should have been left to weigh the reliability of these surveys, considering all of these facts.

## **5. How Dictionaries Define "Google"**

Elliott's position is that dictionaries define "google" generically. Google Inc.'s position is that dictionaries define "google" non-generically. Both sides introduced

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<sup>3</sup> Certainly, if Google Inc. had reasons to object to the methodology of the surveys (for example, whether the surveys collected duplicate responses or non-human responses), it (being the creator and operator of the technology involved) could have put forward evidence of the unreliability of its consumer surveys. For what must only be marketing reasons, it did not do so, challenging only Mr. Wirtz's participation in the design of the survey questions. However, flaws in the design of survey questions go to the weight, and not the admissibility of the survey.

competing dictionary evidence, and evidence affecting the weight and credibility of each other's dictionary evidence. How dictionaries define "google," and the weight to be afforded those definitions, are issues of fact which should be determined by the jury.

Furthermore, the dictionary definitions to which Google Inc. points in its answering brief are purposefully incomplete. A dictionary entry consists of multiple definitions for a single word. These definitions are sorted by part of speech. Both Google Inc. and Elliot cite to several of the same dictionaries for their definitions of "google." However, Google Inc.'s citations include only the entry for the noun google, and conveniently leave out the entry for the verb google. For example, Google Inc. cites Collins English Dictionary's entry for Google:

The first definition for "Google" in Collins English Dictionary is "*n trademark* 1 a popular search engine on the internet." (GER86 ¶56;ER3040.)

However, Google Inc. leaves off the remainder of this entry. The complete entry (which can be found in the record at 5 ER 941-945) is as follows:

*"n trademark* **1** a popular search engine on the internet *>vb (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"

The weight of the various definitions of Google are a question of fact for the jury.

## **6. How the Media Uses "Google"**

Both sides introduced evidence of media usage of the term “google,” including usage in television shows, movies, news articles, cartoons, songs, and books. Both debated the import of the media usage examples introduced by the other side. How the media uses “google,” and the weight to be afforded to the examples of media usage introduced, are issues of fact which should be considered by the jury.

## **7. How Respondent Uses "Google"**

Elliott’s position is that Google Inc. has itself, on several occasions, used “google” generically. In support of this position, Elliott introduced Google Inc.’s definition of “google” on the Google search engine as well as Google Inc.’s founder’s statements in a newsletter in the late 1990s. Google Inc. denies that it has ever used “google” generically, and (1) offers an alternative explanation of the meaning behind its founder’s words in the newsletter and (2) offers evidence that, after its Motion for Summary Judgment and Elliott’s opposition thereto were filed, it changed its definition of “google” on the Google search engine. Initially, it should be noted that Google Inc.’s changing of the definition of “google” on the Google search engine after Elliott pointed to that definition as evidence in support of Elliott’s opposition to Google Inc.’s motion is an admission that the definition before was, at minimum, problematic. How Google Inc. has used the term ‘google’ is a question of fact which

should have been put to the jury.

Furthermore, it was and is Google Inc.'s responsibility to provide the public with an alternative generic verb to use. Instead, Google Inc. from the beginning encouraged the public to use the word “google” as a verb. The jury should have been permitted to consider this fact.

#### **8. How Companies Other than Respondent Use "Google" in Their Advertising**

Elliott introduced evidence of companies other than Google Inc. using the verb google in their advertising. Google Inc., while not disputing that the advertising occurred, argued that the usage in those advertisements was specific verb usage. Whether the usage in those advertisements was specific or non-specific was a question of fact to be determined by the jury.

#### **9. How "Google" Is Used as a Word Root**

Elliott introduced evidence to show that the verb “google” is now a word root and, when used as such, carries the generic meaning of the verb “google” and does not indicate a brand name. While Google Inc. did not dispute the fact that “google” “is sometimes incorporated into derivative words” it does dispute the meaning of the “derivative words” and specifically whether they carry any trademark significance. The meaning of google derivative words and their weight in the genericness inquiry

was a question of fact to be determined by the jury.

**10. Whether and How "Google" Is Used in Domain Names Which Do Not Belong to Respondent**

Elliott introduced evidence which shows that “google” is used in thousands of domains, some of which host functioning websites and some of which are for sale (at great profit to their owners) on GoDaddy’s secondary market auction site. While not disputing that the domains exist, Google Inc. (1) disputes whether google, when incorporated into the domains, is used as a verb, and (2) (notwithstanding its non-enforcement of these thousand plus domains) incredulously argues that it is somehow actually enforcing its mark. How the word google is used in these domains, and the weight of their existence to the genericness inquiry, was a matter for the jury to decide.

**11. Whether a Verb Can, in Any Circumstances, Carry Trademark Significance (That Is, Whether Discriminate Verbs Exist)**

Elliott asserted that a verb cannot carry trademark significance. Google Inc. disputes this fact, arguing that a verb (and specifically the verb “google”) can and does carry trademark significance. Both sides point to the expert testimony of Google

Inc.'s expert Geoffrey Nunberg<sup>4</sup> in support of their respective positions. Elliott also offers in support of its position The International Trademark Association's "Guide to Proper Trademark Use," Gilson on Trademarks, Sidney A. Diamond's "How to Use a Trademark Properly," and John Dwight Ingram's "The Genericide of Trademarks," as well as district court and TTAB decisions which imply that verb usage of a mark lacks trademark significance. These questions of fact should be left to the jury.

## **12. Whether and How the Public Uses "Google" to Refer to Search Engines Other than Respondent's Search Engine**

Elliott presented evidence which shows that the consuming public uses "google" to refer to search engines other than Google Inc.'s search engine. First, Elliott presented proposal request forms wherein respondents were asked "How did you hear about us?" and responded using the word google, though the program which processes the request forms reported that the respondents in fact were directed to the site from other search engines. Google Inc. disputes the meaning and weight of these request forms. GER 11. Their meaning and weight was a question of fact for the jury to decide.

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<sup>4</sup> The jury should be allowed to weigh the credibility of Professor Nunberg, in particular, who after consulting with Elliott's counsel and agreeing with Elliott theory in the case, purportedly refused to be retained for health reasons, but then miraculously was healthy enough to be subsequently retained by Google Inc. to espouse an opposite opinion in favor of Google Inc.

Second, Elliott presented search results from searches for phrases following the following form: “googled on [website other than google.com]” These search results showed the number of results for each search, which demonstrates that there exist a number of webpages wherein the authors have referred to googling on websites other than google.com (such as Ebay, Wikipedia, and Facebook). Google Inc. disputes the weight of these search results. GER 11. Their weight is a question of fact for the jury to decide.

## VIII. CONCLUSION

The district court committed reversible error. Perhaps blinded by the prestige of Google Inc., the district court improperly weighed, discounted, and even ignored Elliott’s evidence. The district was mistakenly persuaded by the misguided arguments of the powerhouse that is Google Inc. Google Inc. continues to argue, as it did before the district court, that “google” is not generic because it does not mean “search engine.” *This is not the dispositive issue here. **A trademark becomes generic when buyers understand the term as being identified with** (which is not the same thing and broader than *meaning*) **all such goods or services, regardless of their suppliers.*** The proper question is whether there exists a genuine issue of fact as to whether “google” when used as a noun, adjective, or a verb, is primarily identified with Google Inc.’s search engine service **exclusively** or with search engine services **generally**. Because



“google” is primarily identified with the non-specific act of searching the internet, without regard to the particular search engine used, it has become generic. Or, at the very least, there exists a genuine issue of material fact with regards to this issue.

A genuine issue of material fact exists where a reasonably minded jury *could* return a verdict in the non-movant’s favor, *even when such a result is unlikely*. All reasonable doubt as to the existence of a genuine issue of fact should be resolved against the moving party. It is only the exceedingly unmeritorious case where summary judgment is appropriate. This was not such a case.

Furthermore, summary judgment is particularly disfavored in trademark infringement cases, and even more so where trademark validity is at issue. In fact, summary judgment is so rarely appropriately granted on the issue of non-genericness that Plaintiffs could only find one Ninth Circuit opinion affirming the grant of summary judgment on the issue of non-genericness. In that case, literally no admissible evidence of genericness was offered by the party asserting genericness. That case is clearly distinguishable from this one.

This is not a run-of-the-mill genericness case that involves an important question of federal law that has not been, but should be, settled. The old rules cannot be applied blindly to these novel facts. This Court must decide whether evidence of generic verb usage of a trademark is either (1) so entirely irrelevant to the genericness

inquiry as to amount to no evidence of genericness at all, or (2) at least relevant to genericness. If evidence of generic verb usage of a trademark is relevant in any way, then this case must be reversed and remanded for trial.

DATED: December 11, 2015

**W I R T Z L A W A P C**

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## **IX. CERTIFICATE OF COMPLIANCE**

I certify that the attached Reply Brief complies with the type-volume limitation of FRAP 32(a)(7)(B) in that the brief contains 6160 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: December 11, 2015

**WIRTZ LAW APC**

By: /s/ Richard M. Wirtz  
Richard M. Wirtz  
Attorney for Elliott/Appellant

9th Circuit Case Number(s)

15-15809

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**CERTIFICATE OF SERVICE**

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I certify that the foregoing document is identical to the version submitted electronically on December 11, 2015.

DATED: December 21, 2015

Respectfully Submitted  
**WIRTZ LAW APC**

By: /s/ Richard M. Wirtz  
Richard M. Wirtz  
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