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13
14 **IN THE UNITED STATES DISTRICT COURT**
15 **IN AND FOR THE DISTRICT OF ARIZONA**

17 DAVID ELLIOTT *et al.*,
18 Plaintiffs,
19 v.
20 GOOGLE INC. *et al.*,
21 Defendants.

22 AND RELATED COUNTERCLAIMS.
23
24
25
26
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Case No. CV 12-1072-PHX-SMM

**DEFENDANT GOOGLE INC.'S
MOTION FOR SUMMARY JUDGMENT;
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT THEREOF**

ORAL ARGUMENT REQUESTED

Judge: Hon. Stephen M. McNamee

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MOTION FOR SUMMARY JUDGMENT (FED. R. CIV. P. 56(a))

1
2 Plaintiffs David Elliot and Chris Gillespie seek to cancel as generic one of the
3 strongest and most widely recognized trademarks in the world: GOOGLE. They also seek
4 a declaration entitling them to use 763 domain names registered by Mr. Gillespie
5 containing the famous GOOGLE mark. Remarkably, although an international arbiter has
6 already determined that Mr. Gillespie effectively misappropriated the GOOGLE mark and
7 ordered that the domain names be transferred to defendant Google Inc. (“Google”),
8 Plaintiffs nevertheless claim that GOOGLE has become a generic term for searching the
9 Internet and that they should be entitled to use it however they wish. Plaintiffs’ claims
10 fail as a matter of law.

11 Use of GOOGLE as a verb does not render it generic, but rather demonstrates its
12 strength and the overwhelming popularity of the Google search engine. Plaintiffs have
13 adduced no evidence even remotely showing that use of GOOGLE as a verb has
14 weakened the mark’s ability to serve as an identifier of source, or that the “primary
15 significance” of GOOGLE in the minds of consumers is the generic meaning ascribed to it
16 by Plaintiffs. Rather, the survey evidence and other key factors considered under the
17 Ninth Circuit’s “who are you/what are you” test establish beyond dispute that the primary
18 significance of GOOGLE is that of a distinctive brand, not a generic term. Even
19 Plaintiffs’ own experts concede that the GOOGLE mark identifies Google as the source of
20 its unique search engine services. As such, no reasonable trier of fact could conclude that
21 the GOOGLE mark is generic. Google respectfully requests that summary judgment be
22 granted in its favor and that all of Plaintiffs’ claims be dismissed with prejudice.¹

MEMORANDUM OF POINTS AND AUTHORITIES

I. STATEMENT OF FACTS

A. Google and the GOOGLE® Trademark

23
24
25
26 Google is a Delaware corporation located in Mountain View, California. (SOF 1.)
27 Google’s search engine, accessible at www.google.com, is one of the largest, most

28 ¹ This motion is not addressed to Google’s counterclaims against Plaintiffs.

1 recognized, and widely used Internet search services in the world. (SOF 2–8.) The
2 GOOGLE mark identifies Google’s proprietary and unique search engine technology and
3 services and is famous around the world. (SOF 3–8.)

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

9 In the short time since Google was founded, it has quickly become the preeminent
10 provider of Internet search services in the United States and the world. (SOF 12.) The
11 company processes billions of search requests every month and, in December 2012, was
12 listed as the most visited website in the world. (SOF 13.) Google competes in a crowded
13 field of other search engine providers, all with their own distinct trademarks, including
14 Yahoo!, Bing, Ask.com, and AOL.com. (SOF 14; *see also* SOF 3, 69.)

15 The success of Google’s search engine has also spawned many other successful
16 products. (SOF 15.) Products such as Gmail, Google Maps, Google Chrome and Google
17 Wallet are just a few of the many goods and services offered by Google and utilized by
18 millions of consumers throughout the United States and the world. (SOF 15, 16.)

19 Google owns numerous United States and foreign registrations for the GOOGLE
20 trademark, including the two GOOGLE registrations challenged in this action: U.S.
21 Registration No. 2884502 and U.S. Registration No. 2806075. (SOF 17.)² The ’502
22 Registration issued on September 14, 2004, with Google’s first use in commerce dating
23 back to January 26, 2000. (SOF 18.) The ’075 Registration issued on January 20, 2004,

24 ² The ’502 Registration covers “computer hardware; computer software for creating
25 indexes of information; indexes of web sites and indexes of other information resources”
26 in Int’l Class 009 (SOF 18.) The ’075 Registration” covers “[p]roviding electronic mail
27 and workgroup communications services over computer networks . . . ,” in International
28 Class 038 and “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 Int’l Class 042 (SOF 19.)

1 with Google’s first use in commerce dating to September 1997. (SOF 19.) Both of these
2 registrations are valid and incontestable. (SOF 20.)

3 **B. Registration of the Domain Names**

4 Between February 29, 2012, and March 10, 2012, Mr. Gillespie registered 763
5 domain names containing the GOOGLE mark with GoDaddy.com (the “Domain
6 Names”). (SOF 21.) Each of the Domain Names includes the GOOGLE mark in its
7 entirety, followed by the name of another famous brand (*e.g.*, googledisney.com,
8 googlecartier.com, googlestatefarm.com) or person (*e.g.*, googlebarackobama.net) or a
9 generic term (*e.g.*, googlenewtvs.com). (SOF 22.) The registration of the Domain Names
10 was a classic case of cybersquatting, with Mr. Gillespie seeking to trade off brand owners’
11 goodwill by including famous brands such as GOOGLE—which Mr. Gillespie clearly
12 does not own—in his Domain Names. (*Id.*)

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

24 **C. Google’s Successful UDRP Proceeding Against Mr. Gillespie, and Mr. 25 Gillespie’s Petition To Cancel the GOOGLE Registrations**

26 In March 2012, Google filed a complaint against Mr. Gillespie with the National
27 Arbitration Forum (“NAF”) pursuant to the Uniform Domain Name Dispute Resolution
28 Policy (“UDRP”) incorporated into the GoDaddy Terms of Use agreement. (SOF 25.)

1 Among other things, the UDRP complaint asserted that: (1) the Domain Names are
2 confusingly similar to Google’s registered GOOGLE trademarks; (2) Mr. Gillespie has no
3 legitimate interest in the Domain Names; and (3) Mr. Gillespie’s use of the Domain
4 Names to generate traffic to his own website supports a finding of bad faith registration
5 and use. (SOF 26.) Google requested transfer of the Domain Names to Google so that it
6 may safely warehouse them and prevent their future use. (SOF 27.)

7 On April 16, 2012, Gillespie filed a petition with the U.S. Trademark Trial and
8 Appeal Board (“TTAB”) to cancel Google’s ’502 and ’075 Registrations. (SOF 28.) The
9 petition asserts that Mr. Gillespie registered the Domain Names in furtherance of his
10 business plans to develop various affinity-based social networks, the GOOGLE mark has
11 become generic, and transfer of the Domain Names to Google would harm Gillespie and
12 “place in jeopardy his right to domain names comprising the term GOOGLE which he
13 may seek to acquire in the furtherance of his business plans.” (SOF 29.) Mr. Gillespie’s
14 TTAB proceeding has been suspended pending the outcome of this litigation.

15 On April 17, 2012, Mr. Gillespie filed a response in the UDRP Proceeding. (SOF
16 30.) In his response, Mr. Gillespie admitted that he registered the Domain Names, that he
17 originally caused them to resolve to TGN.xxx, and that he later set up some of the Domain
18 Names to resolve to websites that generate click-through advertising revenue when
19 visitors click on embedded links. (SOF 31.) Mr. Gillespie asserted that he “is in the
20 process of developing various affinity-based social networks,” including “The GLBT
21 Network,” but offered no explanation whatsoever of how registration and use of Domain
22 Names combining the famous GOOGLE Mark with other famous brands might be
23 necessary or appropriate to further those development plans or any other legitimate
24 business interest. (SOF 32.) Mr. Gillespie’s response reiterated his contention that the
25 GOOGLE mark has become generic and that he should be permitted to use the Domain
26 Names incorporating the GOOGLE mark in furtherance of his business plans. (SOF 33.)

27 On May 10, 2012, the NAF panel refused to consider Mr. Gillespie’s argument that
28 the GOOGLE mark is generic and ordered that the Domain Names be transferred to

1 Google. (SOF 34.) The panel concluded that: (1) the Domain Names are confusingly
2 similar to the GOOGLE mark; (2) Mr. Gillespie has no rights or legitimate interest in
3 them; and (3) he registered and was using them in bad faith. (SOF 35.)

4 Mr. Gillespie initiated this action on May 21, 2012, and filed the FAC to include
5 Mr. Elliott as a co-plaintiff on July 27, 2012. (SOF 36.)

6 **D. Plaintiffs' Allegations**

7 Plaintiffs acknowledge that Google owns the GOOGLE trademark registrations but
8 assert that “the term ‘GOOGLE’ is, or has become, a generic term universally used to
9 describe the action of internet searching with any search engine.” (SOF 37.) Plaintiffs
10 further assert that allowing Google to retain its registrations will cause Plaintiffs to “lose
11 their rights to the Domain Names now in dispute” and jeopardize their rights “to acquire
12 domain names in the furtherance of their business plans comprising the generic term
13 GOOGLE.” (SOF 38.) Accordingly, Plaintiffs seek an order cancelling the GOOGLE
14 registrations and declaring their rights to the Domain Names. (SOF 39.)

15 **E. The GOOGLE Mark Is Strong and Protectable**

16 **1. Survey evidence shows that the GOOGLE mark is not generic**

17 Google’s expert witness, Dr. Gerald Ford, conducted a *Teflon* model survey to
18 determine the primary significance of the term GOOGLE to relevant consumers. (SOF
19 40.) A “*Teflon*” survey model, named for the survey endorsed in the seminal *Teflon* case,
20 *E. I. Du Pont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975),
21 is one of two preferred survey models for determining genericness. 2 J. Thomas
22 McCarthy on Trademarks and Unfair Competition § 12:14 (4th ed. 1996) (“McCarthy”).
23 A *Teflon* survey is “essentially a mini-course in the generic versus trademark distinction,
24 followed by a test” of other marks and generic names in a list constructed and tailored to
25 the facts of a particular case. *Id.* at § 12:16.

26 When asked whether GOOGLE was a common name or a brand name in
27 connection with searching the Internet, the overwhelming majority (93.77%) of
28 respondents in Dr. Ford’s survey expressed their belief that GOOGLE is a brand name.

1 (SOF 41.) A mere 5.24 percent of respondents indicated that GOOGLE was a generic
2 term. (SOF 42.) Dr. Ford’s survey demonstrates that the primary significance of
3 GOOGLE is as a trademark, and that GOOGLE has not become generic. (SOF 43.)

4 Notably, neither Plaintiffs nor their own purported survey expert, James T. Berger,
5 have challenged Dr. Ford’s qualifications or the design, execution or results of Dr. Ford’s
6 survey. (SOF 44.) To the contrary, Mr. Berger readily agreed at his deposition that a
7 *Teflon* survey is a “well known protocol” to test for genericness. (*Id.*) And nothing in
8 Plaintiffs’ own surveys and supporting expert testimony remotely contradicts Dr. Ford’s
9 conclusion that the GOOGLE mark is not generic.³

10 Mr. Berger conceded that he took a results-driven approach by designing his
11 survey to “prove” that the GOOGLE mark is generic, rather than to test that theory. (SOF
12 45.) Not surprisingly, Mr. Berger was not aware of a single court case, treatise, or article
13 that has accepted or endorsed the single-question survey protocol he designed and
14 utilized. (SOF 46.) Mr. Berger also conceded that his survey: (1) did not test whether
15 consumers understand that the term “Google” applies to a particular company; (2) did not
16 test the primary significance of the term “Google” to consumers; and (3) did not test
17 whether the term “Google” was generic with respect to Internet search engine services,
18 hardware or software (*i.e.*, the goods and services covered by the ’502 and ’075
19 Registrations). (SOF 47.) Rather, Mr. Berger’s survey consisted of a single question:
20 “[I]f you were going to ask a friend to search for something on the Internet, what word or
21 phrase would you use to tell him or her what you wanted him or her to do?” (SOF 48).
22 According to Mr. Berger, roughly 51 percent of respondents said that they would ask a
23 friend to “Google it.” (SOF 49.) Survey respondents were not asked what they
24 understand the term “Google it” to mean, and it is very plausible—if not highly likely—

25 ³ Google does not concede the reliability or admissibility of any of Plaintiffs’ purported
26 survey or other expert evidence under *Daubert v. Merrell Dow Pharms.*, 509 U.S. 579
27 (1993). In fact, that evidence is fundamentally flawed in a number of ways, including
28 improper survey methodology, results-driven protocol, and questionable expert
qualifications. However, consideration of those survey results does not give rise to a
genuine issue for trial, as they do not come anywhere close to satisfying Plaintiffs’ burden
to demonstrate genericness of the GOOGLE mark.

1 that the vast majority of survey respondents who said they would tell a friend to “Google
 2 it” specifically meant “use the Google search engine.” (SOF 50.) In other words, there is
 3 nothing remotely inconsistent between the results of Dr. Ford’s survey—which show that
 4 nearly 94 percent of the relevant public primarily understand Google to be a brand
 5 name—and Mr. Berger’s survey results (however questionable) showing that 51 percent
 6 of respondents refer to Google by name when asking friends to search the Internet.

7 Plaintiffs also apparently conducted several informal surveys of their own design
 8 using the Google consumer survey service. (SOF 51.) No expert has validated the
 9 protocol, execution or results of those surveys (SOF 52), and Google’s experts have
 10 thoroughly discredited them.⁴ However, even if Plaintiffs’ informal survey results
 11 merited consideration, Plaintiffs’ own survey expert, Mr. Berger, acknowledged that a
 12 majority (57.2%) of survey respondents indicated that the primary meaning of the term
 13 “Google” was either as an Internet search engine or a producer or source of Internet
 14 services, not a generic term for searching the Internet, as Plaintiffs contend. (SOF 54.)

15 2. Dictionaries consistently define GOOGLE non-generically

16 Dictionary definitions demonstrate that the word Google—whether used as a noun
 17 or a verb—refers primarily and specifically to Google and its proprietary search engine.
 18 The FAC cites three sources as evidence that dictionaries define GOOGLE as a generic
 19 verb: Collins English Dictionary, www.dictionary.com, and Wikipedia. (SOF 55.) The
 20 first definition for “Google” in the Collins English Dictionary is “*n trademark* 1 a popular
 21 search engine on the internet.” (SOF 56.) The dictionary.com site defines Google as:
 22 “*noun Trademark.* 1. Brand name of a leading Internet search engine, founded in 1998.”
 23 (SOF 57.) Finally, Wikipedia defines the verb “Google” to mean “using the Google
 24 search engine to obtain information on the Web.” (SOF 58.)

25
 26
 27 ⁴ For instance, Google’s linguistics expert, Dr. Geoffrey Nunberg, characterized Plaintiffs’
 28 surveys as “worthless.” Among other critical flaws, Plaintiffs’ surveys did not provide
 respondents the option of stating that they use Google as a verb to mean search for
 information on the Google search engine. (SOF 53.)

1 The dictionary definitions cited by the parties' linguistics experts provide similarly
2 non-generic definitions. The Oxford English Dictionary ("OED")⁵ describes the
3 etymology of the verb Google as "a proprietary name for an Internet search engine
4 launched in 1998." (SOF 60.) It then defines both the transitive and intransitive verb
5 forms of Google: "1. intr. To use the Google search engine to find information on the
6 Internet"; "2. trans. To enter (a search term) into the Google search engine to find
7 information on the Internet; to search for information about (a person or thing) in this
8 way." (SOF 61.) The unabridged Merriam-Webster Dictionary entry for Google is
9 "identical in tone and essential content" to the OED's. (SOF 62.) The American Heritage
10 Dictionary defines the word Google simply as "a trademark for an Internet search engine"
11 and explains that "[t]his trademark often occurs in print as a verb, sometimes in
12 lowercase." (SOF 63.) Even the Urban Dictionary, relied upon by Plaintiffs' experts,
13 defines "Google It" first and foremost as "meaning to look it up on Google." (SOF 64.)

14 3. Google's competitors respect the GOOGLE mark

15 Google's competitors also uniformly use GOOGLE as a proprietary brand name.
16 Plaintiffs simply cannot point to a single instance in which a competing search engine
17 provider, such as Microsoft or Yahoo, has referred to its own search engine as a "google."
18 (SOF 65.) Nor do these competitors advertise that consumers can "google" using their
19 search engines. (SOF 66.) In fact, Yahoo! and Bing issue press releases and run
20 advertising campaigns in which they explicitly distinguish themselves from Google, using
21 the GOOGLE mark to refer exclusively to Google and its search engine. (SOF 66–69.)

22 For instance, on July 16, 2012, Yahoo! announced that its new CEO, Marissa
23 Mayer, a former Google executive had "led efforts for many of Google's most
24 recognizable products, including the development of its flagship search product and iconic
25 homepage for over 10 years." (SOF 68 (emphasis added).) Three months later, Microsoft
26 launched a comparative ad campaign known as the "Bing it on Challenge" in which Bing

27 ⁵ One of Plaintiffs' linguistics experts, Dr. Patrick Farrell, testified that the OED is
28 "probably the most comprehensive record of the history of words and everything about
words that there is." (SUF 59.)

1 spokespersons are shown approaching people on the street and asking them to compare
2 search results from Bing and Google. (SOF 69.) Throughout the ads, GOOGLE is used
3 appropriately as a source-identifier and none of the participants appears confused by the
4 request to compare Bing to Google. (*Id.*)

5 **4. The media use GOOGLE as a trademark**

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

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

12 Both of Plaintiffs' own linguistics experts have admitted that the GOOGLE mark is
13 not generic when used to refer to Google the company or its Internet search engine. (SOF
14 70, 71.) Dr. Farrell made clear at his deposition that he was not opining that the term
15 "Google" was generic in a trademark sense and agreed that "Google functions as a
16 trademark in identifying its search engine." (SOF 70.) Plaintiffs' other linguistics expert,
17 Dr. Allan Metcalf, testified similarly: "I would also say that the word Google when it is
18 used as the name of a company or the name of a search engine is not generic." (SOF 71.)
19 These opinions are consistent with the report of Google's linguistics expert, Dr. Nunberg,
20 who concluded that "all the relevant forms of evidence demonstrate that the use of *Google*
21 as a verb is specific in its application; that is, it literally denotes only the process of using
22 the Google search engine to search the web. Moreover, the status of the verb could not in
23 any event bear directly on the status of the Google mark itself." (SOF 72.)

24 **6. Google has invested heavily in protecting its GOOGLE mark**

25 Google has invested substantial resources and effort in establishing strong and
26 exclusive rights in the GOOGLE brand, including through vigilant policing of known
27 instances of infringement and misuse. (SOF 76–80.) Google frequently challenges
28 infringers in many different ways and in many different forums, including but not limited

1 to sending demand letters, arbitrating UDRP proceedings, and filing and prosecuting
2 federal lawsuits. (SOF 80.) Plaintiffs know firsthand that Google actively seeks to stamp
3 out infringing use of its trademarks because Google successfully policed Plaintiffs'
4 infringing use of the GOOGLE mark through the UDRP proceeding. (SOF 25–27, 34.)

5 **II. ARGUMENT**

6 **A. Summary Judgment Standard**

7 Summary judgment is “designed to secure the just, speedy and inexpensive
8 determination of every action.” *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Summary
9 judgment is appropriate when the “pleadings, depositions, answers to interrogatories, and
10 admissions on file, together with the affidavits, if any, show that there is no genuine issue
11 as to any material fact and that the moving party is entitled to a judgment as a matter of
12 law.” Fed. R. Civ. P. 56(c); *Celotex*, 477 U.S. at 322–23. The moving party bears the
13 initial burden of demonstrating that there is no genuine issue of material fact, and that
14 judgment as a matter of law should be granted in its favor. Fed. R. Civ. P. 56(c). Once
15 the moving party has met its initial burden, the nonmoving party must then “go beyond
16 the pleadings” and designate “specific facts showing that there is a genuine [material]
17 issue for trial.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute is
18 genuine only if, on the entirety of the record, a reasonable jury could resolve a factual
19 matter in favor of the non-movant. *Id.*

20 A party moving for summary judgment is entitled to the benefit of any relevant
21 presumptions that support the motion. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250,
22 1254 (9th Cir. 1982) (citing *United States v. Gen. Motors Corp.*, 171 U.S. App. D.C. 27,
23 518 F.2d 420, 441–42 (D.C. Cir. 1975)). GOOGLE’s incontestable federal registrations
24 create “a strong presumption of validity” of the GOOGLE mark. *See KP Perm. Make-Up,*
25 *Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 604 (9th Cir. 2005). The presumption of
26 validity “includes the specific presumption that the trademark is not generic.” *Overland,*
27 692 F.2d at 1254. By virtue of these presumptions, Google has met its initial burden of
28 demonstrating the lack of a genuine issue for trial. *See id.*

1 **B. Legal Standard for Genericness**

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

11 In applying this standard, the Ninth Circuit employs the “primary significance
12 test.” *Caesars World, Inc. v. Milanian*, 247 F. Supp. 2d 1171, 1194–95, (D. Nev. 2003),
13 *aff’d*, 126 Fed. Appx. 775 (9th Cir. 2004). The Lanham Act explains that “[t]he primary
14 significance of the registered mark to the relevant public ... shall be the test for
15 determining whether the registered mark has become the generic name of goods or
16 services on or in connection with which it has been used.” 15 U.S.C. § 1064(3). In
17 determining a mark’s primary significance, the Ninth Circuit applies the “who-are-you/
18 what-are-you” test. *Filipino Yellow Pages, Inc. v. Asian Journal Pubs., Inc.*, 198 F.3d
19 1143, 1147 (9th Cir. 1999). “[A] valid trademark answers the former question, whereas a
20 generic product name or adjective answers the latter.” *Rudolph Int’l, Inc. v. Realys, Inc.*,
21 482 F.3d 1195, 1198 (9th Cir. 2007). “If the primary significance of the trademark . . .
22 describe[s] the *type of product* rather than the *producer*, [it] is a generic term and [cannot
23 be] a valid trademark.” *Filipino Yellow Pages*, 198 F.3d at 1147 (citations omitted).

24 **C. The Court Should Grant Summary Judgment to Google**

25 **1. The GOOGLE mark is presumed valid and non-generic**

26 It is undisputed that the GOOGLE mark is registered and that the registrations
27 Plaintiffs seek to cancel are incontestable. (SOF 18–20.) Accordingly, the GOOGLE
28 mark is presumed valid and non-generic, and GOOGLE has met its initial burden of

1 demonstrating its entitlement to summary judgment. *See Overland*, 692 F.2d at 1254
2 (rejecting allegation that “Coke” is generic for soda beverages and affirming summary
3 judgment for Coca Cola on infringement claims against a restaurant that regularly served
4 Pepsi in response to orders for Coke without orally notifying customers of the switch); *KP*
5 *Perm. Make-Up*, 408 F.3d at 606 (reversing district court’s grant of summary judgment to
6 plaintiff, who had sought a declaration that defendant’s registered “Micro Colors”
7 trademark was generic for micropigmentation products, and ordering that summary
8 judgment be entered for the defendant mark owner); *Caesars World*, 247 F. Supp. 2d at
9 1194–95 (rejecting claim that plaintiff’s unregistered COLLOSEUM mark was generic
10 and granting summary judgment for plaintiff on its infringement claim).

11 Notably, marks that are obviously and substantially weaker than the world-famous
12 GOOGLE mark are consistently found to be non-generic. *See, e.g., California Cooler,*
13 *Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1456 (9th Cir. 1985) (rejecting defendant’s
14 assertion of genericness and granting preliminary injunction against defendant’s use,
15 citing, among other things, a survey showing that 75 percent of relevant consumers
16 understood “California Cooler” to be a brand of wine cooler, not a generic term); *San*
17 *Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 532–35
18 (1987) (finding the mark “Olympic” to be protectable); *Committee for Idaho’s High*
19 *Desert, Inc. v. Yost*, 92 F.3d 814, 821 (9th Cir. 1996) (“Committee for Idaho’s High
20 Desert” not generic); *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 718 F.2d 327 (9th
21 Cir. 1983) (“Park ‘N Fly” not generic), *rev’d on other grounds*, 469 U.S. 189, 192 (1985);
22 *United States Jaycees v. San Francisco Jr. Chamber of Commerce*, 513 F.2d 1226 (9th
23 Cir. 1975) (*per curium*) (“Junior Chamber of Commerce” not generic); *Kelley Blue Book*
24 *v. Car-Smarts, Inc.*, 802 F. Supp. 278 (C.D. Cal. 1992) (“blue book” not generic).

25 2. Plaintiffs cannot meet their burden to prove genericness

26 The “presumption of validity [of the GOOGLE mark] places the burden of proving
27 genericness upon the [party alleging genericness].” *Filipino Yellow Pages*, 198 F.3d at
28 1146 (citing 15 U.S.C. § 1057(b)). Plaintiffs simply cannot satisfy that burden.

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

11 Here, the evidence easily establishes that, even when GOOGLE is used as a verb,
12 the mark maintains its source-identifying function and is not, as Plaintiffs contend, a
13 “generic term for internet searching.” (SOF 54.) Indeed, as shown below, every factor
14 Ninth Circuit courts consider in determining whether a trademark is generic weighs
15 heavily in Google’s favor and demonstrates the protectibility of the GOOGLE trademark.

16 **a. Dictionaries define GOOGLE as a trademark**

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

22 As discussed above, dictionaries consistently define the word Google—whether in
23 its noun or verb form—as specifically identifying defendant Google and its proprietary
24 search engine. (*See* Section II.E.2, *supra.*) Of particular note, both the OED and
25 Webster’s Unabridged, relied on by Plaintiffs’ own linguistics experts, define the verb
26 Google as meaning “to use the Google search engine to find information on the Internet.”
27 (SOF 60–62.) Other dictionaries, like the American Heritage Dictionary, define the word
28 Google—even in its verb form—simply as “a trademark for an Internet search engine.”

1 (SOF 63.) These non-generic and source-identifying definitions provide strong evidence
2 that the general public also understands and uses GOOGLE in a non-generic manner.

3 **b. Competitors use GOOGLE as a trademark**

4 A mark's use by competitors is evidence of how the public perceives the term. *CG*
5 *Roxane LLC v. Fiji Water Co.*, 569 F. Supp. 2d 1019, 1027 (N.D. Cal. 2008). Applying
6 the “who are you/what are you” test, the Ninth Circuit looks to see whether industry
7 competitors answer the “what are you?” question using the term at issue. *Filipino Yellow*
8 *Pages*, 198 F.3d at 1151–52; *see also Closed Loop Mktg. v. Closed Loop Mktg., LLC*, 589
9 F. Supp. 2d 1211, 1219 (E.D. Cal. 2008). That is not the case here.

10 Plaintiffs have not and cannot present any evidence suggesting that competing
11 search engine providers, such as Yahoo! and Microsoft, answer the critical question of
12 “what are you?” with “a google.” Those competitors—like the firms that monitor and
13 rank competing search engine providers—all understand that GOOGLE is an extremely
14 valuable trademark and do not use it generically. (SOF 2–7, 65–69.)

15 **c. The media use GOOGLE as a trademark**

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

23 Plaintiffs cannot point to a single instance in which a major media outlet has
24 referred to the Bing or Yahoo! search engines as “googles” or suggested that one can
25 “Google” on those sites. To the contrary, the prominent media publications cited above
26 demonstrate plainly that the GOOGLE mark is famous and well-respected. (SOF 73.)

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1 **d. Google uses GOOGLE as a trademark**

2 Courts often look at how the party asserting trademark rights uses the term at issue
3 to determine whether that term is functioning as a trademark or a generic term. *See, e.g.*
4 *Intel Corp. v. Advanced Micro Devices, Inc.*, 756 F. Supp. 1292, 1297–98 (N.D. Cal.
5 1991) (analyzing Intel’s use of “386” to determine whether the mark is generic); *Filipino*
6 *Yellow Pages*, 198 F.3d at 1150–51 (considering the defendant competitor’s evidence that
7 the plaintiff publisher himself used the “Filipino Yellow Pages” mark generically).

8 Google consistently uses GOOGLE as a valuable brand identity, and Plaintiffs
9 cannot point to any evidence that Google uses the mark generically. That fact, however,
10 has not stopped Plaintiffs from distorting the words of Google’s co-founder Larry Page
11 into something they allege is a generic use. Plaintiffs refer to Mr. Page’s exhortation to
12 consumers in a 1998 mailing list to “keep googling” as evidence that Google uses the
13 GOOGLE mark generically. (SOF 74.) That is obviously not so. Rather than
14 encouraging generic Internet searching, it is clear, in context, that Mr. Page used the term
15 “googling” to encourage the specific use of the Google search engine and to promote
16 brand awareness and loyalty. There is simply no indication that Mr. Page used or
17 intended to use the mark generically. *See, e.g., KP Perm. Make-Up*, 408 F.3d at 605–06
18 (examining context of founder’s statements in brochure and article and rejecting assertion
19 that her use of “micro colors” therein was generic).

20 As seen on Google’s website and throughout its extensive national advertising
21 campaigns, Google uses the GOOGLE mark to identify the source of its proprietary
22 search engine services—not to identify a genus of services. (SOF 75.) In fact, Google
23 spent over ██████ advertising its brand in the United States in 2010 and 2011 alone.
24 (SOF 76.) These advertisements further solidify the primary significance of GOOGLE as
25 a famous trademark that is widely-associated with Google’s brand and valuable goodwill.

26 **e. Google polices infringing uses of the GOOGLE mark**

27 When analyzing alleged genericness, courts often consider a trademark holder’s
28 vigilance in enforcing its trademark rights and policing known instances of trademark

1 infringement. *See, e.g. Filipino Yellow Pages*, 198 F.3d at 1151 (affirming lower court’s
2 reliance on plaintiff’s lack of trademark policing as evidence that mark had become
3 generic).

4 Google vigorously defends its mark against infringement. (SOF 77–80.) As an
5 initial matter, Google’s website enumerates rules and guidelines for anyone contemplating
6 use of the GOOGLE mark, and makes it abundantly clear that GOOGLE is a protected
7 trademark and must be treated as such. (SOF 78.) When Google becomes aware of
8 infringing activities, it actively pursues infringers by, among other things, sending demand
9 letters, arbitrating UDRP proceedings, and filing and prosecuting federal lawsuits. (SOF
10 80.) Historically, Google has spent upwards of ██████ dollars per year policing and
11 protecting the GOOGLE marks at issue in this case. (SOF 79.) This case serves as just
12 one example of the efforts Google has consistently made to protect its mark from
13 infringement, dilution and cybersquatting.

14 **f. Plaintiffs’ experts concede that GOOGLE is not generic**

15 As discussed above, each of Plaintiffs’ own linguistics experts concedes that the
16 GOOGLE mark is not generic when used to refer to Google or its search engine. Dr.
17 Farrell testified that “Google functions as a trademark in identifying its search engine.”
18 (SOF 70.) Dr. Metcalf also testified that “the word Google when it is used as the name of
19 a company or the name of a search engine is not generic.” (SOF 71.) These opinions
20 fatally undermine Plaintiffs’ claims, as the registrations Plaintiffs seek to cancel are for
21 GOOGLE in connection with software and services that comprise Google’s search engine.

22 **g. Survey evidence shows that the vast majority of consumers**
23 **believe that GOOGLE is a trademark, not a generic term**

24 Because a term is not generic if it is commonly understood by the public to be a
25 brand, consumer surveys are given significant weight in genericness cases. *See* McCarthy
26 § 12:14. The standard in determining whether a term is a generic name or is instead a
27 brand “is not whether the term has some significance to the public as the generic name of
28 an article, but whether its generic meaning is its primary significance.” *Id.* at §12:6. “The

1 result of the primary significance rule [is] that majority usage controls.” *Id.*; *see also*
 2 *Windsurfing Int’l, Inc. v. Fred Ostermann GMBH*, 613 F. Supp. 933, 959 (S.D.N.Y.
 3 1985), *aff’d in part, rev’d in part*, 782 F.2d 995 (Fed. Cir. 1986) (finding “windsurfer”
 4 generic after 61.4% of survey respondents recognized the term as the name of a type of
 5 product rather than a brand); *Intel Corp.*, 756 F. Supp. at 1297 (finding “386” generic for
 6 microprocessors after 72% of survey respondents expressed belief that it was generic);
 7 *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1218 (10th Cir. 2004) (“beerman” generic
 8 after recognized as a common name by 75.9% of survey respondents).

9 Here, when asked in a *Teflon* survey whether GOOGLE was a common or brand
 10 name in connection with searching the Internet, the vast majority (93.77%) of respondents
 11 identified GOOGLE as a brand—not a common name. (SOF 41.) Not surprisingly, these
 12 results overwhelmingly establish that GOOGLE is not generic.

13 III. CONCLUSION

14 For the reasons discussed above, Google respectfully requests that the Court grant
 15 its motion for summary judgment as to all claims asserted by Plaintiffs in the FAC.

16 DATED this 23rd day of September, 2013.

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CERTIFICATE OF SERVICE

I hereby certify that on September 23, 2013, I electronically transmitted the attached document to the Clerk’s Office using the CM/ECF System for filing.

By /s/ Angela L. Dunning

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