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# The Battle of the Verbs: The Ninth Circuit's Reconciliation of "Verbing" with Trademark Law and Practices

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**THE BATTLE OF THE VERBS: THE NINTH CIRCUIT’S  
RECONCILIATION OF “VERBING” WITH TRADEMARK LAW AND  
PRACTICES**

*Taylor Carrere\**

*In its recent decision in Elliot v. Google, the Ninth Circuit reinforced Google’s trademark significance against claims that the mark “google” should be canceled under the Lanham Act due to the public’s verb usage of the trademark. The public’s “verbing” of popular marks has become a particularly onerous problem for internet and technology trademark owners like Google, who want to encourage their products’ integration into pop culture while still maintaining control of their mark. The court’s holding that evidence of verb usage, without more, is not sufficient to prove that the trademark has succumbed to genericide is a step in the right direction in reconciling older trademark practices with modern language use and the evolving realities of internet marketing.*

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### I. INTRODUCTION

Even though the verb “google” has only recently been introduced into the English language,<sup>1</sup> most people would probably understand a person stating they “googled something” to mean that they used an internet’s search engine to learn more about a subject. It would not be unusual to overhear one friend saying to another, “I googled the long-term effects of eating those carbs. It’s not good.” The listening friend will likely understand that when her friend says she has “googled” carbs, she means that she has researched on the internet how bad carbs are for her. Although using the word “google” in this way has become second nature to the public, Google<sup>2</sup> has spent years<sup>3</sup> reminding people that “google” is not just

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<sup>1</sup> Google, Inc. was founded in 1998, and the term “google” was not filed for trademark protection until 1999, making the word about technology services less than twenty years old. See *Our Story: From the Garage to the Googleplex*, GOOGLE, <https://www.google.com/intl/en/about/our-story/> (last visited Sept. 28, 2017); see also United States Patent and Trademark Office, reg. nos. 2884502 and 2806075, <http://tmsearch.uspto.gov/bin/showfield?f=toc&state=4803%3At08erp.2.151> (last visited Nov. 1, 2017).

<sup>2</sup> Google is now a subsidiary of a larger company called Alphabet, but this paper continues to refer to Google as the company which owns the trademark to be consistent with the Ninth Circuit’s usage in *Elliot v. Google, Inc.* 860 F.3d 1151 (9th Cir. 2017), which began before the company became part of the larger corporation in October of 2015. Further, the Google search engine is still under the Google umbrella of the company. See Avery Hartman, *Here Are All the Companies and Divisions within Alphabet, Google’s Parent Company*, BUS. INSIDER: TECH INSIDER (Oct. 26, 2016 12:37 PM), <http://www.businessinsider.com/alphabet-google-company-list-2016-10/#google-officially-became-alphabet-in-october-2015-with-the-aim-to-allow-its-different-businesses-to-operate-independently-and-move-faster-each-division-has-its-own-ceo-with-google-cofounder-larry-page-taking-the-helm-of-alphabet-1>.

<sup>3</sup> Suzanne Choney, *No Googling, Says Google—Unless You Really Mean It*, NBC NEWS (Mar. 26, 2013, 3:43 PM), <https://www.nbcnews.com/technology/no-googling-says-google-unless-you-really-mean-it-1C9078566> (detailing some of the lengths Google has gone to since 2006 to ensure that those using its brand as a verb do so in specific reference to the Google search engine).

something you do on the internet. First and foremost, it is a trademark—and an extremely valuable one at that.<sup>4</sup>

Ironically, a trademark’s transition from noun to verb signifies not only that the trademark has been successfully integrated into the minds of consumers, but also that it may be on its way to the generic graveyard.<sup>5</sup> Genericide occurs when a valid trademark evolves from being used for identifying a single product under a brand name to representing an entire category of products not connected to the brand.<sup>6</sup> Once a mark loses its ability to signify the source of the good or product being sold, it no longer qualifies for trademark protection.<sup>7</sup> Other brands have already fallen victim to genericide, and few people, if any, remember that terms such as “trampoline,” “escalator,” and “aspirin” were initially trademark-protected brands.<sup>8</sup> Over time, these terms became generic because they came to signify the product, rather than the producer, in the public’s mind.<sup>9</sup>

For the past five years, Google has been engaged in extensive litigation to protect its trademark against allegations brought by Chris Gillespie and David Elliot, who wanted to use the mark in their own trademark registrations as part of an academic experiment.<sup>10</sup> Gillespie and Elliot argued that the term “google” was

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<sup>4</sup> Rami S. Yanni, *Genericization of a Giant: Has the World’s Most Valuable Brand Become Generic?*, CORP. COUNS. (Apr. 27, 2017), <http://www.corpcounsel.com/id=1202784727374/Genericization-of-a-Giant-Has-the-Worlds-Most-Valuable-Brand-Become-Generic?slreturn=20170816132911>.

<sup>5</sup> Scott Brown, “*I Tweeted on Facebook Today: Re-Evaluating Trademark Genericide of Internet-based Trademarks*,” 7 J.L. & POL’Y INFO. SOC’Y 457, 482 (2012).

<sup>6</sup> *Id.* at 460.

<sup>7</sup> *Id.*

<sup>8</sup> Mary Beth Quirk, *15 Product Trademarks That Have Become Victims of Genericization*, CONSUMERIST (May 16, 2017, 3:36 PM), <https://consumerist.com/2017/05/16/google-avoids-genericide-will-remain-a-protected-trademark/>;

<sup>9</sup> *Id.*

<sup>10</sup> Mary Beth Quirk, *Google Avoids Genericide, Will Remain a Protected Trademark*, CONSUMERIST (May 16, 2017, 3:58 PM), <https://consumerist.com/2017/05/16/google-avoids-genericide-will-remain-a-protected-trademark/>; see also Yanni, *supra* note 4 (explaining that Gillespie, who originally registered the 763 domain names, claimed he was doing so as part of

generic because the majority of the public understood the term, when used as a verb, to mean to search for information on the internet.<sup>11</sup> Because generic trademarks cannot be given trademark protection,<sup>12</sup> Gillespie and Elliot argued that they should be allowed to incorporate the term into their business plans.<sup>13</sup> After this argument was rejected by the National Arbitration Forum (“NAF”) and the United States District Court for the District of Arizona, Gillespie and Elliot appealed the decision to the Ninth Circuit, which decided the case in May of 2017.<sup>14</sup>

This Recent Development argues the Ninth Circuit’s decision in *Elliot v. Google, Inc.*—that verb usage of a trademark does not necessitate its death by genericide—is an accurate and important step in reconciling trademark law with modern language practices and internet marketing. It progresses in four parts. Part II explains the legal backdrop of the genericide problem by detailing the Lanham Act and the genericide doctrine.<sup>15</sup> It also explains the linguistic concept of “verbing” and the effects it has on trademark law and practices. Part III presents the background for the Ninth Circuit’s recent decision in *Elliot v. Google, Inc.* which upheld Google’s trademark against a Lanham Act petition that sought to cancel the trademark.<sup>16</sup> Part IV discusses how the Ninth Circuit’s decision accurately reflects the goals of trademark law and acknowledges the evolution of language and internet marketing realities and discusses possible revisions to trademark law to better reflect these new realities.

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an academic expert to test a computer program he designed to prevent cyber piracy).

<sup>11</sup> Yanni, *supra* note 4.

<sup>12</sup> Brown, *supra* note 5, at 460.

<sup>13</sup> Yanni, *supra* note 4.

<sup>14</sup> *Elliott v. Google, Inc.*, 860 F.3d 1151 (9th Cir. 2017).

<sup>15</sup> Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1790 (2007).

<sup>16</sup> *Elliot*, 860 F.3d at 1163.

## II. THE LEGAL BACKDROP

### A. *Lanham Act and the Genericide Doctrine*

A trademark term falls into one of five basic classifications.<sup>17</sup> These classifications act as a sliding scale, which courts use to determine the amount of protection a trademark is given.<sup>18</sup> At one end of this scale, fanciful or arbitrary marks are considered to be the strongest type of trademarks and, thus, receive the most protection under both the common law and the Lanham Act.<sup>19</sup> Fanciful marks, such as “Google” and “Xerox,” are usually words invented solely for the purpose of being used as trademarks; therefore, they have no connection to common words used prior to their invention.<sup>20</sup>

At the other end of the scale, generic words garner no protection because “they do not (or no longer) have the capacity for source identification.”<sup>21</sup> Without being able to distinguish the goods or services for which the trademark represents, generic trademarks do not serve one of the basic goals of trademark law: to protect consumers from deceptive and confusing trade names by enabling them to purchase a product they trust.<sup>22</sup>

The Lanham Act, first passed in 1946, provides trademark owners with significantly more rights than were guaranteed under either the common law or the previous Trademark Act of 1905.<sup>23</sup>

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<sup>17</sup> Desai & Rierson, *supra* note 15, at 1805 (listing the five categories of trademark status as arbitrary, fanciful, suggestive, descriptive, and generic). The Ninth Circuit combines arbitrary and fanciful terms into one category to recognize four categories of trademark protections. *Elliot*, 860 F.3d at 1155. Because both arbitrary and fanciful marks earn the same degree of trademark protection, this distinction holds no real significance for the purposes of this article.

<sup>18</sup> Desai & Rierson, *supra* note 15, at 1805.

<sup>19</sup> *Id.* at 1805, 1809.

<sup>20</sup> *Id.* at 1807.

<sup>21</sup> *Id.* at 1809. For example, “Apple” cannot be a trademark for a produce company that grows apples because it is a generic name for the good that the company supplies. However, it can be used as a trademark for a computer company. Thus, the ability to register and protect a trademark is fact-specific. Brown, *supra* note 5, at 460.

<sup>22</sup> Brown, *supra* note 5, at 477–78.

<sup>23</sup> Desai & Rierson, *supra* note 15, at 1815 (explaining that under the common law, the first user of a trademark could only obtain priority in the geographic locations in which his or her mark had gained “goodwill”).

The Act expanded the types of marks that qualify for federal trademark protection and eliminated geographical restrictions on these protections.<sup>24</sup> The Lanham Act also provides for a cause of action to cancel trademarks that have fallen to generic use.<sup>25</sup> Specifically, the Act allows a petition to cancel a trademark to be made at “any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered.”<sup>26</sup> The Act further states:

If the registered mark becomes the generic name for less than all the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.<sup>27</sup>

Thus, the current version of the Lanham Act extends no protection to generic words or terms and considers them to be abandoned and invalid.<sup>28</sup>

Genericide refers to “the process by which a mark that was once highly valuable and unquestionably protectable loses all trademark status and value.”<sup>29</sup> To determine whether a trademark is susceptible to genericide, courts use the primary significance test codified in the Act and articulated by the Supreme Court in *Kellogg Co. v. Nat’l*

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<sup>24</sup> *Id.* at 1815–16.

<sup>25</sup> 15 U.S.C. § 1064(3) (2012).

<sup>26</sup> *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> Sandra L. Rierson, *Toward a More Coherent Doctrine of Trademark Genericism and Functionality: Focusing on Fair Competition*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 691, 701 (2017) (“The current version of the Lanham Act extends no protection to words or terms considered generic, even if the word or term was, at one point, a registered inherently distinctive trademark. The Act codifies the doctrine of genericide by stating that, if a mark *becomes* ‘the generic name for the goods or services on or in connection with which it is used,’ for any reason, it is considered abandoned and is no longer a valid trademark.”).

<sup>29</sup> Desai & Rierson, *supra* note 15, at 1790.

*Biscuit Co.*<sup>30</sup> In *Kellogg Co.*, the Supreme Court held that a company could not claim trademark protection for the term “shredded wheat” merely because it had a secondary meaning that was associated with its particular product.<sup>31</sup> Rather, the company had to show that “the primary significance of the term in the minds of the consuming public [was] not the product but the producer.”<sup>32</sup>

Some circuits, including the Ninth Circuit, have attempted to refine the primary significance test by relying upon the “who-are-you/what-are-you” test.<sup>33</sup> A trademark protected term will answer the question, “who are you?,” while a generic term will answer the question, “what are you?”<sup>34</sup> For example, if asked to give the significance of the term “trampoline,” one would likely explain that it is a recreational device that one jumps on. The term “trampoline,” therefore, answers the question “what is it?” rather than “who is it?” because the answer involves explaining what the product does rather than who produces it. On the other hand, if asked to give the significance of the term “Samsung,” one would likely explain that it is a brand of electronics and appliances. Because the answer identifies the term with the producer rather than the product, the term “Samsung” answers the question “who is it?” and would be considered a valid trademark under the primary significance test.

In an attempt to answer these questions, courts examine evidence of the trademark’s use in a variety of situations.<sup>35</sup> The burden is on the examining attorney to prove by clear evidence that the mark is generic; this evidence can be taken from any competent source that demonstrates the public’s primary understanding of the term.<sup>36</sup> This often includes evidence of the mark’s use in commercial settings—such as competitors’ use of the mark, the trademark

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<sup>30</sup> Rierson, *supra* note 28, at 702–03; *see also* *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

<sup>31</sup> *Kellogg Co.*, 305 U.S. at 118.

<sup>32</sup> *Id.*

<sup>33</sup> Desai, *supra* note 15, at 1825.

<sup>34</sup> Brown, *supra* note 5, at 461.

<sup>35</sup> *Id.* at 462.

<sup>36</sup> U.S. PATENT AND TRADEMARK OFFICE, TMEP § 1209.01(c)(i) (9th ed. 2017), <https://tmepl.uspto.gov/RDMS/TMEP/Oct2017#/Oct2017/TMEP-1200d1e6993.html>.



holder's use of the mark, testimony of members of the trade, and—finally—surveys.<sup>37</sup>

Surveys are one of the most common forms of evidence offered to prove a mark's generic nature and are commonly used by courts making genericide determinations.<sup>38</sup> Modern genericide surveys trace their origins to two seminal cases that employed significantly different surveys in order to determine whether the trademarks in question were indeed generic.<sup>39</sup> The first, which will be discussed later in this section, came from *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*<sup>40</sup> This “Thermos Survey,” as it has become commonly known, consists of a series of open-ended questions aimed at discerning how the consumer would ask for or describe a product in order to determine if the trademark has become a generic name for that product.<sup>41</sup>

The second, commonly known as a “Teflon Survey,” employs mostly close-ended questions in order to determine whether a mark is a brand name or a common name.<sup>42</sup> This survey technique originates from the case *E. I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*,<sup>43</sup> in which the plaintiff, Du Pont, conducted a survey hoping to contradict evidence that its trademark, TEFLON, had become a generic term for the non-stick coating on pots and pans.<sup>44</sup> Du Pont started the survey by explaining the difference between “brand names” and “common names.”<sup>45</sup> Once assured that the respondents understood this distinction, Du Pont then read a list of eight words, including the disputed trademark, to the respondents and had them answer whether they thought the word was a brand name or a common name.<sup>46</sup> Teflon Surveys have now become the

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<sup>37</sup> Brown, *supra* note 5, at 463.

<sup>38</sup> E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of a Species*, 99 TRADEMARK REP. 1118, 1119 (2009).

<sup>39</sup> *Id.* at 1122.

<sup>40</sup> 321 F.2d 577 (2d Cir. 1963).

<sup>41</sup> Jay, *supra* note 38, at 1122, 1124.

<sup>42</sup> *Id.* at 1122.

<sup>43</sup> 393 F. Supp. 502 (E.D.N.Y. 1975).

<sup>44</sup> Jay, *supra* note 38, at 1125.

<sup>45</sup> *Id.* at 1126.

<sup>46</sup> *Id.*

preferred survey method by courts attempting to establish the trademark's significance.<sup>47</sup>

In addition to considering evidence of commercial uses of the trademark, courts also look at evidence of the public's non-commercial uses, such as dictionary and media use of the trademark, to determine whether the mark is generic<sup>48</sup> despite the fact that trademark holders have no legal right to control non-commercial uses of their marks.<sup>49</sup> Courts take non-commercial uses into consideration based on the idea that they have the potential to show the primary significance of the mark to the public.<sup>50</sup> As the Second Circuit noted, "[t]hough not conclusive, dictionary definitions of a word to denote a category of products are significant evidence of genericness because they usually reflect the public's perception of a word's meaning and its contemporary usage."<sup>51</sup> The same rationale applies to courts' considerations of media and non-trade magazines' uses of the trademark.<sup>52</sup> Because of the circumstantial nature of this kind of evidence, courts usually require additional evidence to corroborate the idea that the trademark has become generic.<sup>53</sup>

#### B. *Verbing and Its Effect on Trademark Law*

Modern English speakers are certainly familiar with nominalizations of verbs, as the English language is full of words

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<sup>47</sup> *Id.* at 1131.

<sup>48</sup> Brown, *supra* note 5, at 464.

<sup>49</sup> Desai & Rierson, *supra* note 15, at 1835.

<sup>50</sup> Vanessa Bowman Pierce, *If It Walks and Quacks Like a Duck, Shouldn't It be a Duck?: How a "Functional" Approach Ameliorates the Discontinuity Between the "Primary Significance" Tests for Genericness and Secondary Meaning*, 37 N.M. L. REV. 147, 160–61 (2007).

<sup>51</sup> *Harley-Davidson, Inc. v. Grotanelli*, 164 F.3d 806, 810 (2d. Cir. 1999).

<sup>52</sup> Jessica E. Lanier, *Effective Policing: Giving Trademark Holders a Pre-Emptive Against "Genericide"*, 20 B.U. J. SCI. & TECH. L. 247, 257–58 (2014).

<sup>53</sup> Brown, *supra* note 5, at 464. As Pierce notes, however, dictionary entries and other non-trade publications do not necessarily demonstrate that a trademark is used generically by the public at the time of their publication, but, rather, cause a trademark to be seen as generic by their readers. In short, they may not reflect a term's generic nature so much as cause it to become generic. Pierce, *supra* note 50, at 160–61.

that were once verbs and have become nouns.<sup>54</sup> Traditional nominalizations, such as the words “acceleration” and “intimidation,” have obvious roots in their verb counterparts, but English speakers have recently become even more transparent in their use of nominalizations by foregoing the alteration of the verbs and, instead, using their verb form as nouns.<sup>55</sup> “Hey, I like your build,” is an example of the latter.<sup>56</sup>

Although the opposite of nominalization, verbing, may seem like a more recent phenomenon, it has actually been around for centuries, with some of the best known historical examples coming from William Shakespeare’s plays.<sup>57</sup> In Shakespeare’s historical play, *Richard II*, the Duke of York tells young Henry Bolingbroke (soon to be Henry IV of England) who has returned from exile without the king’s permission, “Grace me no grace, nor uncle me no uncle/ I am no traitor’s uncle”<sup>58</sup> With this turn of phrase, the Duke of York has turned the honorary titles “your grace” and “uncle” into verbs in order to express his disgust at his nephew’s disregard of his and the king’s authority. The verbing that is so well employed here by Shakespeare has now become a ubiquitous part of our everyday conversations, so much so that even the Oxford Dictionary has recognized some of these verbified nouns.<sup>59</sup>

Although versatility is undoubtedly a strength of the English language, it also poses problems for trademark owners who are taught never to allow their brand to be used as nouns or verbs. What may be even more problematic for trademark owners than the American public’s tendency toward nominalization is the public’s growing fascination with “verbing.”<sup>60</sup> “Defined, verbing is the

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<sup>54</sup> Henry Hitchens, *Those Irritating Verbs-as-Nouns*, N.Y. TIMES Mar. 30, 2013, at SR9.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> Anthony Gardner, *You’ve Been Verbed*, THE ECONOMIST 1843 (2010), <https://www.1843magazine.com/content/ideas/anthony-gardner/youve-been-verbed>.

<sup>58</sup> WILLIAM SHAKESPEARE, RICHARD II act 2, sc. 3 ll. 86–87 (Anthony B. Dawson & Paul Yachin eds., Oxford Univ. Press 2011) (1597).

<sup>59</sup> Gardner, *supra* note 57 (highlighting the dictionary’s inclusion of “access” and “reference” as verbs).

<sup>60</sup> Brown, *supra* note 5, at 482.

turning of a noun or other type of speech into a verb.”<sup>61</sup> One reason “verbing” is so popular is that it acts as a “vivid linguistic shortcut,” allowing people to quickly convey their meaning through vivid rhetorical images that are associated with the nouns.<sup>62</sup> Instead of saying, “I shoved my way through the crowd by making use of my elbow,” one can simply say, “I elbowed through the crowd.”<sup>63</sup> “Verbing,” therefore, is a quick and innovative linguistic shortcut.

Linguists have also noted that another reason for the popularity of “verbing,” especially in the trademark arena, is its usefulness in filling the “conversational vacuum” that occurs when innovative or new products come to the market.<sup>64</sup> Furthermore, “when a business is the first to find widespread success and adoption of their service or product, they embed themselves in popular culture”<sup>65</sup> and have a higher risk of being verbed. The internet and many of the technological advancements that accompany it are only a few decades old.<sup>66</sup> Keeping this in mind, along with the understanding of how these technologies have become embedded into our daily lives, one can appreciate the struggle that internet trademark owners, like Google, face in trying to prevent verbing of their marks.<sup>67</sup>

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<sup>61</sup> *Id.*

<sup>62</sup> Chi Luu, *Do You Even Language Bro? Understanding Why Nouns Become Verbs*, JSTOR DAILY (Mar. 9, 2016), <https://daily.jstor.org/in-which-we-science-why-nouns-become-verbs-because-language/>.

<sup>63</sup> *Id.*

<sup>64</sup> Laura Heymann, *Who Is the Reasonable Person? The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1347 (2010).

<sup>65</sup> Michael Pignataro, *Powerful Brands: The Significance of Branding-Verbing*, COREPHP, (Aug. 21, 2015), <https://www.corephp.com/blog/powerful-brands-the-significance-of-brand-verbing/>.

<sup>66</sup> *History of the Web*, WORLD WIDE WEB FOUND., <https://webfoundation.org/about/vision/history-of-the-web/> (last visited Sept. 16, 2017).

<sup>67</sup> Luu, *supra* note 62 (noting that invented creative verbs from proper nouns have become prolific especially among the internet). Although, as discussed in the next section, Twitter allows verb usage of its mark, many of the often-verbed brands strictly prohibit such usage. See *Skype Trademark and Brand Guidelines*, SKYPE, at 5, [https://secure.skypeassets.com/content/dam/scom/pdf/skype\\_brand\\_guidelines.pdf](https://secure.skypeassets.com/content/dam/scom/pdf/skype_brand_guidelines.pdf) (last visited Nov. 1, 2017) (emphasizing that “Skype” can only be used an adjective or a proper noun); *TiVo Brand Guidelines*, TiVO, at 4.1,

### C. *Examples of Lost Trademarks*

Traditionally, trademarks have been threatened when the public uses a brand name meant to be an adjective as a noun to identify the product for which the trademark is known. “Some famous marks that have lost their protection through genericide include aspirin, shredded wheat, and escalator. All of these terms started as source identifiers, but for various reasons became identified in the public’s mind with the type of products to which they were attached.”<sup>68</sup> Significantly, some of the classical examples of trademark genericide involved innovative technology or products that had not seen significant commercial use before being trademarked; thus, these product names helped fill the linguistic vacuum that their existence created, but at the expense of their trademark protections.<sup>69</sup>

For example, in *Haughton Elevator Co. v. Seeberger*,<sup>70</sup> the United States Patent and Trademark Office (USPTO) held that the word “escalator,” though originally trademark protected, was no longer a valid trademark because in the public’s mind it had come to represent the product rather than the producer.<sup>71</sup> In making this determination, the USPTO noted that the parties did not dispute that the word “escalator” was only recognized by the public as a moving stairway rather than the Otis Company’s trademark.<sup>72</sup> It further pointed out that the company itself used the term generically in patent applications and advertisements, leading the USPTO to determine that such usage supported the conclusion that the company had abandoned its trademark.<sup>73</sup>

In *King-Seeley Thermos Co.*, the Second Circuit affirmed a district court’s determination that the trademark “THERMOS” had

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[http://assets.tivo.com/assets/resources/TiVo\\_Brand\\_Guidelines\\_v3.3a.pdf](http://assets.tivo.com/assets/resources/TiVo_Brand_Guidelines_v3.3a.pdf) (last visited Nov. 1, 2017) (emphasizing that “it is never permissible to use any of [its] trademarks as verbs”).

<sup>68</sup> Brown, *supra* note 5, at 460.

<sup>69</sup> See generally *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (1950) (escalator); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (thermos).

<sup>70</sup> 85 U.S.P.Q. 80 (1950).

<sup>71</sup> *Id.*

<sup>72</sup> *Id.* at 80.

<sup>73</sup> *Id.*

become a generic word for “vacuum-insulated” bottle because of the widespread use of the trademark as a stand-in for the product itself.<sup>74</sup> Although King-Seeley Thermos Co. had attempted after an initial period of advertising to market “THERMOS” as a descriptive trademark, the Court found there was ample support for the district court’s finding that the substantial majority of the public knew the term “thermos” as a vacuumed-sealed bottle without its trademark significance.<sup>75</sup> The Court emphasized, however, that a mark having a dual meaning was not dispositive to the issue of genericness:

[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. In order to become generic[,] the principal significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.<sup>76</sup>

While these cases pertain to trademarks falling to genericide because of the public’s use of them as nouns, modern technology trademark owners possibly have a greater problem in the public’s use of their trademarks as verbs. Xerox is a classic example of a modern technology trademark owner’s fight against verbing.<sup>77</sup> The company’s 914-model was the first copier widely known to the American public.<sup>78</sup> Consequently, the public began to use “xerox” as a general verb for photocopying.<sup>79</sup> Out of fear of losing its trademark to genericide, Xerox launched an aggressive advertising campaign<sup>80</sup> to educate the public about its brand and policed the use

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<sup>74</sup> *King-Seeley Thermos Co.*, 321 F.2d at 578.

<sup>75</sup> *Id.* at 579–80 (“The results of the survey (conducted at the behest of the defendant) were that about 75% [o]f adults in the United States who were familiar with containers that keep the contents hot or cold, call such a container a ‘thermos’; about 12% [o]f the adult American public know that ‘thermos’ has a trade-mark significance, and about 11% [u]se the term ‘vacuum bottle.’”).

<sup>76</sup> *Id.* at 580 (citation omitted).

<sup>77</sup> *When a Brand Name Becomes a Verb*, BRANDMATTERS, <https://brandmatters.com.au/blog/when-a-brand-name-becomes-a-verb> (Feb. 4, 2011) [hereinafter BRANDMATTERS].

<sup>78</sup> Brown, *supra* note 5, at 469.

<sup>79</sup> *Id.*

<sup>80</sup> This campaign sought to educate the public about the difference between Xerox’s brand name and the common name for the goods and services the company offered. Gary H. Fletcher & Elina Slavin, *Practical Tips on Avoiding Genericide*, INT’L TRADEMARK ASS’N (Nov. 15, 2011),

of its name by sending letters to those who “verbed” the brand even in noncommercial contexts.<sup>81</sup> Although the un-capitalized “xerox” is now listed as a verb by the Merriam-Webster Dictionary, the corporation has refused to acknowledge the word’s dual meaning and has not given up its campaign to prevent verb-use of its trademark.<sup>82</sup> Because of its efforts to educate the public and its aggressive policing of its mark, Xerox has not lost its trademark protections.<sup>83</sup>

Xerox is not alone, however, in this battle-of-the-verbs; other modern technology trademark owners are now facing the problem of how to balance the public’s verbing of their brand with their desire to make their product ubiquitous in consumers’ daily lives. In a world where people regularly discuss their plans to “Netflix” and “Skype” all day, trademark owners straddle a fine line. Although Twitter, unlike Xerox, has accepted the verb-usage of its trademark, the company emphasizes that it must be used with a capital letter and reserves the right to enforce its guidelines through litigation.<sup>84</sup> Thus, even the more accepting trademark owners have expressed some wariness of the verb usage of their marks.

Further, Twitter has shown its willingness to join the trademark battle by its drawn-out struggle to gain the rights to trademark the

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<http://www.inta.org/INTABulletin/Pages/PracticalTipsonAvoidingGenericide.aspx>. An example of one of the ads used during the campaign is the following: “You can’t Xerox a Xerox on a Xerox. But we don’t mind at all if you copy a copy on a Xerox copier.” *Id.* For further examples of trademark advertising meant to educate the public, see Megan Garber, “*Kleenex Is a Registered Trademark*” (*and Other Desperate Appeals*), ATLANTIC (Sept. 25, 2014), <https://www.theatlantic.com/business/archive/2014/09/kleenex-is-a-registered-trademark-and-other-appeals-to-journalists/380733/>.

<sup>81</sup> Becky Peterson, *This 1979 Letter to The New York Times Shows Just How Much Xerox Hates People Using Its Name as a Verb*, BUS. INSIDER (July 27, 2017, 5:05 PM), <http://www.businessinsider.com/old-letter-to-new-york-times-xerox-takes-trademark-very-seriously-2017-7>.

<sup>82</sup> *Id.*

<sup>83</sup> Brown, *supra* note 5, at 466–67.

<sup>84</sup> *Brand Guidelines*, TWITTER, at 12–13, [https://about.twitter.com/content/dam/about-twitter/company/brand-resources/en\\_us/Twitter\\_Brand\\_Guidelines\\_V2.0.pdf](https://about.twitter.com/content/dam/about-twitter/company/brand-resources/en_us/Twitter_Brand_Guidelines_V2.0.pdf) (last visited Sept. 19, 2017).

term “Tweet.”<sup>85</sup> Beginning in 2009, Twitter filed two applications to trademark the term but ran into complications because another company owned the trademark.<sup>86</sup> After initiating a lawsuit against the company in 2011, Twitter negotiated with the company to acquire the mark.<sup>87</sup> After the transfer, however, Twitter worried that its “Tweet” mark would be treated similarly to Xerox’s mark because of its verbing potential and eventually accepted verb use of the trademark in an attempt to control it.<sup>88</sup> The aggressive negotiations Twitter used to gain the mark not only emphasize some of the problems innovative trademark owners face in establishing their brands, but also highlight the lengths they are willing to go to control their marks.<sup>89</sup> Twitter is not alone, of course, in its struggle to control the verbing of its mark, and Google’s recent legal battle in the Ninth Circuit merely adds another chapter to this drawn-out story.

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<sup>85</sup> Amir Efrati, *Twitter Will Get “Tweet” Trademark, Settles Lawsuit*, WALL STREET JOURNAL BLOG, (Oct. 10, 2011, 8:17 PM), <https://blogs.wsj.com/digits/2011/10/10/twitter-settles-lawsuit-over-“tweet”-trademark/?mod=e2tw>.

<sup>86</sup> *Twitter Gets Shut Out Once More, U.S. Trademark Office Won’t Grant Jack Dorsey Trademark for ‘Tweet’*, NY DAILY NEWS (Mar. 20, 2011 4:00 AM), <http://www.nydailynews.com/entertainment/gossip/twitter-shut-u-s-trademark-office-won-grant-jack-dorsey-trademark-tweet-article-1.121949>. Twittad, the company who beat out Twitter for the registration of the word “tweet,” provides “a service that matches Twitter users with advertisers to sell spaces on their profiles based on the number of followers they have.” *Id.*

<sup>87</sup> Efrati, *supra* note 85.

<sup>88</sup> Scott Martin, *Is Twitter’s ‘Tweet’ Trademark at Risk?*, USA TODAY (last updated Oct. 5, 2013, 11:51 PM), <https://www.usatoday.com/story/tech/2013/10/04/is-twitters-tweet-trademark-at-risk/2923269/> (noting that “tweet” is defined as a noun by the Mariam-Wester dictionary: “a post made on the Twitter online message service”); *see also Brand Guidelines*, *supra* note 84, at 12–13 (permitting use of “Twitter” and “Tweet” in noun and verb format but requiring that both terms be capitalized to emphasize their trademark significance and that they be used only in connection with Twitter’s “Tweet and “Retweet products”).

<sup>89</sup> For a criticism of Twitter’s attempts to gain trademark protection for “Tweet” see Henry Blodget, *Hey, Twitter, Enough of This Crap About “Here’s How You Can Use the Word Tweet,”* BUS. INSIDER: TECH INSIDER (Oct. 30, 2010 9:36 AM), <http://www.businessinsider.com/twitter-trademarks-tweet>.



### III. *ELLIOT V. GOOGLE, INC.*: THE NINTH CIRCUIT UPHOLDS GOOGLE'S TRADEMARK

In early 2012, Chris Gillespie, a man who is now famous for challenging Google's mark, registered 763 domain names that included the word "google" with another specific brand, person, or product to create domain names such as "googlebarackobama.net" and "googledisney.com."<sup>90</sup> Although Gillespie claimed that he registered the domain names as part of an academic experiment to test a computer program he was developing to prevent cyber piracy, Google filed a complaint under the Uniform Domain Name Dispute Resolution Policy.<sup>91</sup> The company argued that Gillespie's use of its trademark amounted to cybersquatting,<sup>92</sup> which is the act of "registering, selling or using a domain name with the intent of profiting from the goodwill of someone else's trademark."<sup>93</sup> Gillespie claimed he chose the term "google" as a common denominator in all of the domain names because "google" was "both a generic term and a very highly searched term."<sup>94</sup> Google argued, and NAF agreed, that the domain names were confusingly similar to Google's trademark and that Gillespie had registered them in bad faith.<sup>95</sup>

Soon thereafter, David Elliot, a third-party beneficiary of Gillespie,<sup>96</sup> filed a petition in an Arizona district court, seeking to cancel Google's trademark under the Lanham Act,<sup>97</sup> which Gillespie later joined.<sup>98</sup> The petition argued that "google" had become synonymous with the act of searching on the internet and, thus,

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<sup>90</sup> *Elliot v. Google, Inc.*, 860 F.3d 1151, 1154 (9th Cir. 2017).

<sup>91</sup> Yanni, *supra* note 4.

<sup>92</sup> *Id.*

<sup>93</sup> *Cybersquatting: What Is It and What Can Be Done About It?*, nolo.com, <http://www.nolo.com/legal-encyclopedia/cybersquatting-what-what-can-be-29778.html> (last visited Sept. 16, 2017).

<sup>94</sup> Yanni, *supra* note 4.

<sup>95</sup> *Elliot*, 860 F.3d at 1154.

<sup>96</sup> Sarah Mitroff, *A Disgruntled Gentleman Honestly Thinks He Can Strip Google of Its Trademark*, VENTUREBEAT, (May 25, 2012, 4:52 PM), <https://venturebeat.com/2012/05/25/google-sued-over-trademark/>.

<sup>97</sup> 15 U.S.C. § 1051 (2012).

<sup>98</sup> *Elliot*, 860 F.3d at 1154–55.

qualified for cancellation under the Act because it was generic.<sup>99</sup> When both parties filed summary judgment motions on the issue of genericness, the Court sided with Google.<sup>100</sup> It ruled that the relevant inquiry was not, as Elliot argued, whether “google” was most commonly used as a verb to denote the act of searching for something on the internet, but, instead, whether the public primarily understood the term “google” to be a generic word for search engines, and that Elliot failed to produce sufficient evidence to support this claim.<sup>101</sup>

At trial, Elliot attempted to introduce two surveys to prove that Google’s mark was generic.<sup>102</sup> The District Court refused to admit the first survey because it was conducted by Elliot’s counsel, Wirtz,<sup>103</sup> and there was no evidence regarding its reliability or that it was made in accordance to generally accepted principles of survey making.<sup>104</sup> The second survey Elliot offered at trial was a modified version of the Thermos Survey conducted by a survey expert who asked respondents, “If you were going to ask a friend to search for something on the Internet, what word or phrase would you use to tell him/her what you want him/her to do?”<sup>105</sup> Just over half of the

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<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* As will be discussed more in-depth later in this section, Elliot argued that trademarks can serve their purpose only if they are nouns and that “verb use automatically constitutes generic use.” *Id.* at 1158.

<sup>102</sup> *Elliot v. Google, Inc.*, 45 F. Supp. 3d 1156, 1167–71 (D. Ariz. 2014).

<sup>103</sup> The Court noted that Wirtz did not have any expertise in survey interpretation as claimed at trial and was particularly concerned with the conflict of interest that would occur because Wirtz could not testify about the reliability of the survey and continue to be Elliot’s counsel. *Id.* Wirtz’s surveys prompted respondents to select among one of three answers to the prompt: “I most often use the word google to mean.” *Id.* at 1167. The answer that respondents could choose from were “to search something on the internet”; “the name of a specific search engine”; and “the internet (in general)”. *Id.* Of the 1,033 respondents for the first survey, 52.2% answered that they most often used “google” to mean to search for something on the internet. *Id.*

<sup>104</sup> *Id.* at 1168; *see* FED. R. EVID. 702(c)-(d) (establishing that expert opinions must be based on reliable methods and principles to be admissible).

<sup>105</sup> *Elliot*, 45 F. Supp. 3d at 1168–69. This question was the only question in the survey. *Id.* at 1169. As the district court pointed out, Thermos Surveys typically ask several questions, and this survey did not test the primary significance of the term to consumers or whether it was generic with respect to search engines. *Id.*

251 respondents answered using the word “google.”<sup>106</sup> Although it admitted the second survey, the district court found this evidence unpersuasive because it did not address the dispositive issue of whether the primary significance of the term to the consuming public was a generic word used to indicate search engines in general.<sup>107</sup>

The Court also noted that Elliot produced no evidence that any dictionary had defined the term “google” without referencing its trademark significance and that none of Google’s competitors used the term generically to refer to their products.<sup>108</sup> Instead, all that Elliot offered as additional support for his claim was that the media sometimes used the term generically and that the co-founder of Google once used the word generically.<sup>109</sup> In ruling that Elliot had not met his burden, the Court specifically addressed the semantic issue of whether verb usage alone could be a dispositive factor in determining whether a term was indeed generic.<sup>110</sup> It stated, “[t]he Court declines Plaintiffs’ invitation to judicially legislate federal trademark law out [of] 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.”<sup>111</sup>

In his appeal to the Ninth Circuit, Elliot argued that the district court misapplied the standard of the primary significance test by framing the inquiry as whether the public primarily thought of the

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<sup>106</sup> *Id.* at 1169. Specifically, 129 of the respondents used the word “google” in some way to answer the question. *Id.*

<sup>107</sup> *Id.* at 1170. Google also offered survey evidence in the form of a Teflon Survey, which asked 420 respondents identify six names as either brands or as common names. *Id.* at 1166. Although not told that “both” was an acceptable answer, some respondents said that some of the names listed were both. *Id.* “Excluding 19 respondents who answered they do not conduct searches on the internet, 93.77% of the respondents identified “Google” as a brand name, and only 5.25% identified Google as a common name.” *Id.*

<sup>108</sup> *Id.* at 1171–73. What the court means when referring to Google’s competitor’s use is that Microsoft and Yahoo do not call their search engines a “google.” Instead, they have their own brand names for their search engines—Bing and Yahoo! Search, respectively.

<sup>109</sup> *Id.* For a more in-depth discussion of Larry Page’s statement for google users to “keep googling,” see *infra* Part IV.

<sup>110</sup> *Id.* at 1174.

<sup>111</sup> *Id.*

term “google” as a generic term for search engines.<sup>112</sup> Instead, he argued, the Court should have framed the inquiry as whether the public primarily used the word “google” as a noun identifying Google’s trademark or as a verb for the action of searching on the internet.<sup>113</sup> The Ninth Circuit disagreed with this argument for two reasons: (1) the argument “fail[ed] to recognize that a claim of genericide must always relate to a particular type of good or service,” and (2) it made the assumption that verb usage constitutes generic use.<sup>114</sup>

First, the Court held that Elliot’s criticisms of the district court’s framing of the inquiry were unfounded because “the district court properly recognized the necessary and inherent link between a claim of genericide and a particular type of good or service.”<sup>115</sup> To support this conclusion, the Court pointed to the language of the Lanham Act that allows a party to request cancellation of a trademark “when it becomes the generic name for the *goods or services . . .* for which it is registered.”<sup>116</sup> The Court did not address its reasons for believing why “google” must generically refer to search engines rather than the act of conducting searches through a search engine as Elliot suggested. Its reasoning, however, appeared to be grounded in the district court’s determination that the contested Google trademarks<sup>117</sup> dealt specifically with Google’s search engine rather than the act of searching things on the internet.<sup>118</sup>

The Court further noted the Lanham Act designated the standard for cancellation of a trademark to be the primary significance of the trademark protected term and focused on whether the trademark had

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<sup>112</sup> Elliot v. Google, Inc., 860 F.3d 1151, 1156 (9th Cir. 2017).

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*

<sup>115</sup> *Id.* at 1157.

<sup>116</sup> *Id.* (quoting 15 U.S.C. § 1064(3) (2012)) (emphasis and alteration in original).

<sup>117</sup> Elliot contested two of Google’s trademarks. Elliot v. Google, Inc., 45 F. Supp. 3d 1156, 1159 (D. Ariz. 2014). The marks numbered 2884502 and 2806075 cover “computer software for creating indexes of information” and services that provided this software to create personalized information respectively. *Id.* (citation omitted). In short, the trademarks cover the search engine itself rather than the consumer’s act accomplished through the search engine. *Id.*

<sup>118</sup> *Elliot*, 860 F.3d at 1157 (referencing *Elliot*, 45 F. Supp. 3d at 1159).

become the generic name for certain goods or services that it offered.<sup>119</sup> Such a requirement, the Court held, “recognize[d] that a term may be unprotectable with regard to one type of good, and protectable with regard to another type of good.”<sup>120</sup>

Second, the Court chose not to focus on the traditional advice regarding the grammatical use of trademarks when determining whether Google’s mark was generic.<sup>121</sup> Instead, it held that Elliot’s argument that trademarks can only be valid when used as an adjective to be a “semantic argument [that] contradict[ed] fundamental principles underlying the protectability of trademarks.”<sup>122</sup> In doing so, the Court pointed to the legislative intent behind the Lanham Act, in which Congress specifically acknowledged that a person could use a trademark as a product, i.e. as a noun, while still keeping the source of that product in mind.<sup>123</sup>

The Court also pointed to its prior decision in *Coca-Cola v. Overland, Inc.*<sup>124</sup> to support its conclusion, where the Ninth Circuit

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<sup>119</sup> *Id.* For an example of a trademark deemed generic because its primary significance to the public was the product rather than the producer, see *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921). In *Bayer*, the Southern District of New York determined that the trademark Aspirin had become generic and passed into the public domain because people buying the product associated the term “aspirin” as a name for the medicine rather than the company producing the medicine. *Id.* at 510–512; see also Bill Donahue, *Before Google, These 5 Brands Fought Against ‘Genericide’*, LAW360 (May 24, 2017 9:32 PM), <https://www.law360.com/articles/927986> (providing more examples of products that fought genericide).

<sup>120</sup> *Elliot*, 860 F.3d at 1157.

<sup>121</sup> See generally Danica Mathes, *Lessons from Google Surviving the Genericide Attack*, Law360 (July 7, 2017, 11:48 AM), <https://www.law360.com/articles/938665/lessons-from-google-surviving-the-genericide-attack> (listing traditional “dos” and “don’ts” to establish trademark boundaries, including not using the trademark as a verb or a noun and using it as an adjective to qualify the product’s generic name); see also 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12.26 (5th ed. 2017) (noting the importance of designating a generic term with a trademark, i.e. using the trademark as adjective, in preventing generic use of the trademark).

<sup>122</sup> *Elliot*, 860 F.3d at 1157.

<sup>123</sup> *Id.* at 1157–58.

<sup>124</sup> *Coca-Cola v. Overland, Inc.*, 692 F.2d 1250, 1255 (9th Cir. 1982).

held that “Coke” was not a generic term.<sup>125</sup> In *Overland*, the Ninth Circuit held that the use of “Coke” as a general term for soda did not prove the trademark’s genericness because it failed to prove that the customers did not think of Coca-Cola as the source of the soda.<sup>126</sup> The Court held that in the same way a purchaser might use the noun “Coke” in an indiscriminate way to refer to soda in general, without subjecting Coca-Cola’s trademark to genericide, so too could an internet user use the term “google” as an indiscriminate verb without Google losing its trademark for such use.<sup>127</sup>

The Court noted that focusing on whether the mark had come to represent the product itself, in this case search engines, was a requirement “necessary to maintain the viability of arbitrary marks as a protectable trademark category.”<sup>128</sup> It also emphasized that if Elliot’s theory that verb use alone could cause genericide was correct, there would be no need to inquire into the consumer’s inner thought process.<sup>129</sup> Not doing so would contradict the purpose of applying the primary significance test.<sup>130</sup> In making this distinction, the Court upheld a trademark that obviously retains its trademark significance and gave popular trademark owners a reason to breathe a little easier while still managing to uphold the goals of trademark law.

#### **IV. *ELLIOT V. GOOGLE, INC.*: A STEP IN THE RIGHT DIRECTION**

The Ninth Circuit’s decision in *Elliot v. Google, Inc.*, although grounded in basic trademark principles, accounts for the evolving nature of language and accurately reflects the main goals of trademark law. More court decisions consistent with this opinion could help alleviate the tension and needless litigation that comes from such usage when it is obvious the brand still holds its significance.

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<sup>125</sup> *Elliot*, 860 F.3d at 1158 (citing *Coca-Cola*, 692 F.2d at 1255).

<sup>126</sup> *Coca-Cola*, 692 F.2d at 1255.

<sup>127</sup> *Elliot*, 860 F.3d at 1158.

<sup>128</sup> *Id.* at 1157.

<sup>129</sup> *Id.* at 1158.

<sup>130</sup> *Id.* at 1157–58. Because the primary significance test is focused on how the consumer perceives the product, it is essential to discover what the consumer thinks about the product. *Id.*

A. *The Decision Accounts for the Evolution of Language*

When rejecting Elliott's argument that trademarks must be adjectives in order to be valid, the Ninth Circuit stated: "[i]f Elliott were correct that a trademark can only perform its source-identifying function when it is used as an adjective, then we would not have cited a need for evidence regarding the customers' inner thought processes."<sup>131</sup> By applying the primary significance test to Google's trademark, the Court rejected the semantic dogma that has plagued popular trademark owners for years, namely that the public's use rather than their perception of the trademark was the most important factor in determining whether a mark is generic.<sup>132</sup>

The Court held the popularity of "googling" does not make Google's mark generic, acknowledging that language is not static and applicable to only one situation; thus, it can be considered a step toward easing some of the tension between traditional trademark practices and modern language use. As one author points out, current trademark laws encourage trademark owners to think of the enforcement of their trademarks as "akin to thwarting adverse possession: [t]he trademark's inviolability must be defended against any and all encroachments, lest the right to own the mark be relinquished to those who are using it for some personal benefit."<sup>133</sup>

These aggressive tactics are understandable when one considers what is at stake. Under the "once generic, always generic" theory, trademarks killed by genericide cannot be revived even by another evolution in the English language.<sup>134</sup> Thus, "[g]enericide poses the ultimate threat, as it can reduce the value of the billion-dollar mark to zero."<sup>135</sup> Had the Ninth Circuit ruled otherwise, it could have

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<sup>131</sup> *Id.* at 1158 (referring to the Court's decision in *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250 (9th Cir. 1982)).

<sup>132</sup> *Id.* ("We have already acknowledged that a customer might use the noun "coke" in an indiscriminate sense, with no particular cola beverage in mind; or in a discriminate sense, with a Coca-Cola beverage in mind. In the same way, we now recognize that an internet user might use the verb "google" in an indiscriminate sense, with no particular search engine in mind; or in a discriminate sense, with the Google search engine in mind.").

<sup>133</sup> Heymann, *supra* note 64, at 1318.

<sup>134</sup> Desai & Rierson, *supra* note 15, at 1849.

<sup>135</sup> *Id.* at 1797.

turned Google's mark, worth billions,<sup>136</sup> into a very expensive trademark disaster.

Further, although there is undoubtedly some benefit in having trademark owners actively managing their brands, applying strict rules to trademark language can lead to undesirable consequences—such as one of the most valuable and recognized brands in the world arguing against genericide over mere semantics.<sup>137</sup> “If trademark law does indeed purport to reflect how the reasonable consumer acts in the marketplace, that reflection should incorporate the fact that language variation is an inherent characteristic of the English language.”<sup>138</sup> Thus, “verbing” should be recognized for the common linguistic practice that it is, and other federal circuits should follow the Ninth Circuit in acknowledging that its use does not necessitate the conclusion that a trademark is generic. By explicitly refusing to decide the case on verb usage alone, the Ninth Circuit's decision implicitly creates room for language to evolve naturally without necessarily having deadly consequences for the trademarks that inevitably rest on this language.

#### B. *The Decision Reflects the Goals of Trademark Law*

In addition to acknowledging the fluidity of language, the Ninth Circuit's decision reflects the twin goals of trademark law: (1) encouraging the production of quality products and (2) reducing customers' cost of shopping and making purchase decisions.<sup>139</sup> “[T]rademarks reduce the buyer's cost of collecting information about goods and services by narrowing the scope of information into brand segments rather than have the buyer start a new search process with each purchase.”<sup>140</sup> By doing so, trademarks ensure that, with

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<sup>136</sup> *The World's Most Valuable Brands*, FORBES, <https://www.forbes.com/powerful-brands/list/#tab:rank> (last viewed Sept. 19, 2017) (listing Google as the second most valuable brand in the world with a reported worth of \$101.8 billion).

<sup>137</sup> *Id.*

<sup>138</sup> Heymann, *supra* note 64, at 1329; *see also* 2 MCCARTHY, *supra* note 121, § 12:8 (“Buyers 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.”)

<sup>139</sup> 1 MCCARTHY, *supra* note 121, § 2.5.

<sup>140</sup> *Id.*



minimal effort, the consumer can get the quality of the product to which they have grown accustomed.<sup>141</sup>

If the Ninth Circuit had held verb usage of a brand alone constitutes genericide, as Elliot argued it should, the Court would have eroded these principal protections. Elliot offered no real evidence that the use of the term “google” as a verb in any way eroded Google’s significance as a trademark to the public.<sup>142</sup> As the Arizona District Court pointed out, the evidence Elliot offered, if taken for its full weight, only supported the conclusion that the majority of the public used “google” as a verb to mean conducting internet searches.<sup>143</sup> It did not support any inference that the primary significance of Google to the consuming public was to represent search engines in general.<sup>144</sup> In fact, no company’s trademark has ever been canceled under the Lanham Act solely because of the verb usage of its trademark.<sup>145</sup> Because terms, including trademarks, can have dual significance in the English language, canceling a trademark solely because it has become ubiquitous enough to be verbed would likely run contrary to the goals of trademark law by confusing consumers who, although they use the trademark indiscriminately as a verb, have come to expect the term to have brand-significance in certain contexts.

The Teflon Survey used by Google as evidence that its brand was not generic demonstrates this point. Even though respondents were not told that they could identify the queried terms as both common names and brand names, some of the respondents still listed the terms as both.<sup>146</sup> These respondents’ refusals to list the proffered brands merely as one category or another demonstrates that consumers can separate a brand name from its generic form

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<sup>141</sup> *Id.*

<sup>142</sup> *Elliot v. Google, Inc.*, 860 F.3d 1151, 1162 (9th Cir. 2017) (“Elliot cannot survive summary judgment based on ‘sheer quantity’ of irrelevant evidence. We agree with the district court that, at best, Elliot has presented admissible evidence to support the inference that a majority of the relevant public uses the verb “google” in a generic sense. Because this alone cannot support a claim of genericide, the district court properly granted summary judgment for Google.”).

<sup>143</sup> *Elliot v. Google, Inc.* 45 F. Supp. 3d 1156, 1170 (D. Ariz. 2014).

<sup>144</sup> *Id.*

<sup>145</sup> *Brown*, *supra* note 5, at 483–84.

<sup>146</sup> *Elliot*, 45 F. Supp. 3d at 1166.

depending on the context. By refusing to acknowledge this dichotomy and taking this usage out of context, courts would likely create greater confusion among consumers who have come to rely on these trademarks to ensure that they get the quality of product to which they are accustomed.

Everyone loves knock-offs at discounted prices, but no one wants to pay for a knock-off if he or she is trying to purchase the original. Similarly, if Google were to lose its trademark protections, different companies offering similar “google” products could crop up, creating mass confusion and potential disappointment for consumers trying to buy legitimate Google services. This could create confusion and disappointment among consumers if they unknowingly attribute an inferior product to Google.

Further, such a holding would be a slap in the face to trademark owners whose marketing techniques have made their brands household names. Although the genericide doctrine has been used to prevent companies from monopolizing brands that no longer have trademark significance, trademark law also serves to protect trademark owners who have worked hard to ensure their brands have legitimate significance.<sup>147</sup> For Google, this could mean that the company’s successful marketing strategies over the last couple of decades would reduce its brands value to rubble,<sup>148</sup> and the many consumers who have come to rely on Google as a source of their technological services would be faced with trying to discern their beloved brand from the many companies piggy-backing on Google’s success while offering an inferior product.

This could also spell disaster for those who advertise on Google and use the brand’s popularity to endorse their own products.<sup>149</sup>

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<sup>147</sup> Brown, *supra* note 5, at 477–78.

<sup>148</sup> See Desai & Rierson, *supra* note 15, at 1796–97 (noting that a company’s brand “may be its most valuable asset,” and that “[g]enericide poses the ultimate threat, as it can reduce the value of a billion-dollar mark to zero.”).

<sup>149</sup> Currently, if a person is shopping around for shoes, ads will pop up in later browsing sessions from companies like Zappos, Belk, and other shoe retailers, offering similar style shoes to what that person was looking for originally. This is a feature of Google’s Adword, and it can apply to any search done through Google. For more information on Google’s Adword, see Chuck Topinka, *How Does Exactly Google’s Adword Work?*, FORBES (Aug. 15, 2014, 12:04 PM),

Currently, Google offers a wide range of advertising options for business owners and other organizations who wish to advertise with the company on various platforms<sup>150</sup> and on varying budgets.<sup>151</sup> In 2016, Google made a reported \$19.1 billion from ad revenues.<sup>152</sup> If the company's brand was to be ruled generic merely because it is popular enough to be verbed, not only would Google stand to lose serious money,<sup>153</sup> the small businesses, startups, and other companies who use Google as a way to promote their ideas and products would lose valuable time and money in the process.

Such a holding would also fail to acknowledge the changes that the internet has brought to the way trademark owners must market their brands in order to make them successful. Far from sticking with the traditional trademark precepts regarding marketing, modern trademark owners, especially those with technology-related trademarks, are encouraged by some advisors to "verb" their marks.<sup>154</sup> For example, one advisor advocated that trademark owners

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<https://www.forbes.com/sites/quora/2014/08/15/how-exactly-does-google-adwords-work/#714d5af47bd3>.

<sup>150</sup> Featured Resources, GOOGLE ADWORDS, <https://adwords.google.com/home/resources/> (last visited Oct. 24, 2017) (providing resources for posting ads on Gmail, Google Maps, and through mobile devices).

<sup>151</sup> Pricing, GOOGLE ADWORDS, <https://adwords.google.com/home/pricing/> (last visited Oct. 24, 2017).

<sup>152</sup> Robert Hof, *Google's Ad Machine Is Even More Profitable Than Anyone Knew*, FORBES (Feb. 1, 2016, 5:49 PM), <https://www.forbes.com/sites/roberthof/2016/02/01/googles-ad-machine-is-even-more-profitable-than-anyone-knew/#ad05ae5104ae>.

<sup>153</sup> Although an adverse decision from the Ninth Circuit would not have affected Google's trademark protection in its other numerous trademarks and logos, many of these trademarks are in combination with its base "google" trademark to create, for example, "Google Chrome." Further, even though Google would lose none of its trademark protections for its logos, this would probably be of little consolation to Google as its search engine brings in all the advertising money, and its logos alone may not be enough to distinguish its products from others. See Topinka, *supra* note 149 (explaining that at the base of its advertising scheme, Google uses the searches conducted through its search engine to generate and sell personalized ads).

<sup>154</sup> Laura Senecal, *The "Verbing" of Brands*, ADWEEK (Dec. 15, 2008), <http://www.adweek.com/brand-marketing/verbing-brands-97771/>.

use “verbing” as a way to integrate their products with the public’s daily lives:

The first question a marketer should ask when looking at a brand assignment is: What can the brand do to translate its attributes into actions? What behaviors can the brand take to reach its marketing goals? What can the brand do to make itself more relevant, integral, helpful or entertaining to its audience? A simple acid test: Show me, don’t snow me.

It’s not surprising that, in a world of increasing transparency, actions speak louder than words. Brands need to act thoughtfully, tangibly and honestly to live the promises they make . . . not just talk about them. They need to verb.<sup>155</sup>

Although her advice varies greatly from the traditional advice of presenting one’s trademark in adjective form only, it has a common-sense ring to it when it comes to marketing: make something so ubiquitous to people’s everyday lives that it literally becomes a part of their vocabulary, and you have hit marketing gold. In fact, from a marketing perspective, the brand’s popularity has reached an ultimate high if a trademark becomes so ubiquitous that it is verbed, despite the risk of genericide.<sup>156</sup>

Further, because the internet has changed the pace at which brands become popular,<sup>157</sup> some trademark owners are less concerned with their brands being considered generic as they are with them falling obsolete.<sup>158</sup> If the company is the first to find widespread success and adoption of its products, that company and its products are often embedded into pop culture.<sup>159</sup> Thus, advice like that above, although risky, is hard for technology companies to ignore. For example, in the late 2000s, Microsoft’s chief executive Steve Ballmer said that he liked the name “Bing” for the company’s

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<sup>155</sup> *Id.*

<sup>156</sup> Brown, *supra* note 5, at 482; *see also* Noham Cohen, *The Power of the Brand as Verb*, N.Y. TIMES, (July 18, 2009), <http://www.nytimes.com/2009/07/19/weekinreview/19cohen.html> (quoting Rebecca Tushnet, an expert on trademark law at Georgetown University, as saying, “[w]hat people know from marketing experience now and what people now understand as a practical matter is that it is very good when people use your name as verb.”).

<sup>157</sup> BRANDMATTERS, *supra* note 77.

<sup>158</sup> *See* Cohen, *supra* note 156.

<sup>159</sup> Pignataro, *supra* note 65.

search engine because it “worked globally” and had the potential “to verb up.”<sup>160</sup> Despite the trademark implications, Ballmer hoped that people would “bing it” rather than “google it”—a desire which has probably changed given Google’s recent legal battles.

Even Google at one point embraced the verbing of its brand. Part of Elliot’s argument before the Ninth Circuit regarding the trademark’s genericness was that the company itself had used the brand generically as a verb.<sup>161</sup> Specifically, he cited to a “Google Friends Newsletter” in which Google’s co-founder Larry Page told people to “have fun and keep googling!”<sup>162</sup> The Ninth Circuit pointed out, however, that this evidence fell short of showing any generic use on Google’s part because it did not demonstrate whether Larry Page had Google’s search engine in mind when making the statement.<sup>163</sup> The Ninth Circuit’s decision, although not explicit in acknowledging internet marketing realities, does help alleviate the tension created by these conflicting interests and gives internet trademark owners more leeway in promoting their brands.

### C. Possible Changes to Trademark Law

To reconcile trademark laws with evolving language principles and internet marketing realities, more federal circuits must follow the Ninth Circuit’s finding that “verbing” alone does not destroy a trademark’s primary significance to public consumers. Although no United States courts have ruled that a trademark is generic within the meaning of the Lanham Act based solely on the public’s use of it as a verb,<sup>164</sup> the threat of one doing so still lingers. As long as courts continue to focus on the semantic use of the trademark as evidence of its generic nature, trademark owners will continue to be aggressive in their protection tactics.

In his concurrence in *Elliot*, Judge Watford emphasized that courts should not completely disregard verb usage, arguing that

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<sup>160</sup> Cohen, *supra* note 156.

<sup>161</sup> *Elliot v. Google Inc.*, 860 F.3d 1151, 1162 (9th Cir. 2017).

<sup>162</sup> *Id.*

<sup>163</sup> *Id.* (“Elliot has not shown, nor is it likely that he could show, that the cofounder of Google had no particular search engine in mind when he told recipients of the “Google Friends Newsletter” to “keep googling.”).

<sup>164</sup> Brown, *supra* note 5, at 483–84.

indiscriminate verb use of a trademark could potentially be relevant in determining if a trademark is generic.<sup>165</sup> He argued that verb usage would be relevant to the inquiry if the evidence showed that the public used the “verbed” trademark to represent the product as a species rather than the act accomplished by using the product.<sup>166</sup> While this is possibly true, it is hard to see how the “verbed” trademark would come to represent the product species itself unless language further evolves to make such use practical. One generally turns nouns into verbs to quickly get a point across. It is hard to imagine one using a verb to represent a noun, which is what must occur if verbing is to represent the product species as a whole.

Perhaps a better way to understand Judge Watford’s point is to consider, for example, a person who uses Google’s Hangout to “Skype” someone long distance.<sup>167</sup> Because the products have many similarities,<sup>168</sup> unsophisticated users (and even those more familiar with the latest technology) may not realize the distinction between the two and use the latter when referring to the former. If evidence were to show that the majority of the public considered “Skype” to be any system used to make a video call regardless of the company

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<sup>165</sup> *Elliot*, 860 F.3d at 1164 (Watford, J. concurring). For a clearer understanding of his point, think of the present case. If the evidence showed that the term “google” had become a generic term for a search engine rather than the act of searching on the internet, it would have been relevant evidence to the inquiry of whether the term “google” was generic.

<sup>166</sup> *Id.* Both the majority opinion and Watford’s concurrence agree that one of the failures of Elliot’s argument was that he did not offer evidence that those who were using “google” in an indiscriminate sense were doing so when referring to search engines in general. *Id.* at 1157, 1164. Instead, he offered evidence that “google” had become a generic term for searching things on the internet. *Id.* at 1157. The Court held that cancellation under the Lanham Act required that the evidence of genericide relate to a particular product or service—in Google’s case, the Google search engine. Thus, Elliot’s evidence of verb usage did not matter where it counted. *Id.*

<sup>167</sup> *Switching to Classic Hangouts from Skype for Business*, G SUITE LEARNING CENTER, at 1, <https://gsuite.google.com/learning-center/products/hangouts/switch-from-skype/switch-from-skype.pdf> (last visited Sept. 24, 2017).

<sup>168</sup> *Id.* Although this document is used by Google to allege superiority over Skype’s product, one can see that both products’ goal is to provide video and phone chats to numerous people through a wireless connection.

that produced it, Skype could lose its trademark because the primary significance of the trademark would be the generic product rather than Skype as the producer.<sup>169</sup> Thus, people who say that they “Skyped” someone, but, in reality, used Google Hangout without realizing that there was a difference in the two systems, would put Skype’s trademark at risk.

Although the concurring opinion makes a good case for not systematically ruling out verb usage in genericide determinations, courts can still alleviate the negative effects aggressive trademark policies have by shifting the focus of verb usage to the proper context, namely the commercial arena. As some scholars argue, courts consider too broad a scope of evidence when determining whether a trademark has fallen victim to genericide.<sup>170</sup> They argue that non-competitive uses, such as dictionary entries and media use, are not truly indicative of what constitutes a term’s “primary significance” to the consumer in the commercial context and that courts should focus instead on its use in its relevant marketplace.<sup>171</sup> As they put it:

[U]se of a trademark as a common noun or verb, in a noncommercial context, does not have the same direct impact on a mark’s source-identifying capacity as does an infringing use by the trademark holder’s competitor. Such noncommercial uses typically indicate that mark is functioning in a hybrid fashion (a fate that is practically inevitable for the most famous trademarks).<sup>172</sup>

Because courts continue, however, to consider noncommercial uses of trademarks as evidence of genericide, trademark owners continue to feel the need to police even the fair use of their marks through threats of litigation and a constant stream of cease and desist letters.<sup>173</sup>

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<sup>169</sup> Both the majority and the concurrence would have found Elliot’s evidence relevant if it had shown that the public was using “google” as a generic term to represent search engines, rather than the act of searching on the internet. See *Elliot*, 860 F.3d at 1159, 1164. The same logic would undoubtedly extend to the Skype scenario.

<sup>170</sup> Desai & Rierson, *supra* note 15, at 1833.

<sup>171</sup> *Id.* at 1833, 1844.

<sup>172</sup> *Id.* at 1835–36.

<sup>173</sup> *Id.* at 1839–40.

One can argue, however, that eliminating all noncommercial uses of trademarks may be tipping the scale too much in favor of trademark owners who already have a significant advantage over their competitors. While the evidence should appropriately focus on the consumer's perception in a commercial setting, dictionary and media use does demonstrate, on some level, an understanding of the general public and, thus, should not be discounted completely.

A Teflon survey, like the one offered by Google, is a good way to determine if a brand is actually generic because it seeks to discern whether the public recognizes a trademark as a brand or common name.<sup>174</sup> If properly conducted surveys reveal that the majority of the public does not recognize the trademark significance of the brand, then the mark is not fulfilling its identifying duty and should properly be deemed generic.<sup>175</sup> If these surveys do reveal a majority of brand recognition, the trademarks are fulfilling their identification purpose and should not be considered generic just because of the public's fair use of them.<sup>176</sup>

Further, judicial balancing of the different uses—putting more weight on competitor's use and consumer's perception—would be a more nuanced way to determine whether a trademark has fallen to genericide and would allow trademark owners more room in advertising their mark. Such judicial balancing would recognize that a company like Twitter, who permits verb usage of its mark, is still taking lengths to acquire and protect its marks despite its flexibility in grammar. This balancing, although surely not eliminating the preventive measures of wary trademark owners, would allow trademark owners to better balance the competing interests of marketing and protecting their brands while also acknowledging that language is not concrete property to be only used one way.

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<sup>174</sup> Jay, *supra* note 38, at 1126–27.

<sup>175</sup> *See id.* at 1127 (“When a majority of relevant consumers identify a challenged mark as a “brand name,” the survey will be proffered to show non-genericness; conversely, parties challenging a mark as being generic will tender a Teflon Survey if more than half of relevant consumers classifies the mark as a ‘common name’.”).

<sup>176</sup> *Id.*



## V. CONCLUSION

The Ninth Circuit's decision in *Elliot v. Google, Inc.* to uphold Google's trademark under the primary significance test may have come as no shock to anyone given the massive popularity the company has earned throughout the world. The Court's decision, however, to hold that verb usage of a trademark alone does not necessitate a trademark's death by genericide is important in many respects.

First, the decision acknowledges that language cannot be fixed in time and that, in order to allow its natural progression, words must be viewed in context to discern their meaning. The term "google" may be used by the public as a verb for the act of searching for information on the internet; however, as the Ninth Circuit's opinion acknowledges, that does not mean that the public does not recognize Google's significance as a trademark in a commercial context. To hold otherwise would place artificial barriers on the public's use of language and would undoubtedly make already aggressive trademark enforcement policies even more so.

Second, the decision accurately reflects the goals of trademark law and the realities of internet and technology marketing strategies. Because words have dual meanings, and consumers may still recognize a term's trademark significance despite using it as a verb, a court's ruling that verb usage alone makes a trademark generic would do little to reflect the goals of trademark law. In fact, doing so would likely make it more difficult for consumers to discern the product they have learned to trust from inferior ones marketed by companies attempting to capitalize on the trademark's success.

Further, the internet has accelerated the pace at which brands gain a reputation and a following. Internet trademark owners are currently forced to walk the thin line of integrating their brands into popular culture while still retaining their trademark rights. The Ninth Circuit's decision, however, makes this decision easier by refusing to place special significance on the syntax of the trademark but instead focus solely on the primary significance of the term to the public.

While courts should not eliminate verb usage in their analysis of whether a trademark has become generic, they should place a greater

emphasis on its use in commercial contexts rather than on the public's fair use. Although doing so will probably not be enough to encourage all trademark owners to cease their aggressive trademark policies, the overall effect would hopefully be to discourage the obvious cybersquatting that occurred in this case and to reduce the amount of pointless litigation and cease and desist letters that stem from the public's fair use of the trademark. Thus, the Ninth Circuit's decision is a victory for the consumer and the trademark owner alike, in that the former can continue to "google" or "xerox" to their hearts' content while the latter is less galvanized to prevent such use.