

Public Use of “Googling” Does Not Genericize Trademark

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When faced with a random (but very important) question, how often is our response: “I’ll google it”? Using google as a verb, similar to the above question, was at the center of a recent decision by the

U.S. Court of Appeals for the Ninth Circuit in *David Elliott v. Google, Inc.* The appellate court affirmed the district court’s summary judgment holding that Appellants failed to establish a genericness attack on the google mark because (1) the Appellants did not demonstrate how the public uses the word google with regard to a particular good or service and (2) public use of a trademark as a verb does not automatically constitute generic use.

One of the Appellants had registered 763 domain names including the word “google,” such as googledisney.com and googlebarackobama.com. Google filed a complaint with the National Arbitration Forum and the domain names were transferred to Google. The Appellants then filed an action in federal district court in Arizona, alleging that the google trademark had become generic. Appellants moved for summary judgment motion, arguing that a majority of the relevant public uses the word google as a verb when referring to internet searching, and that public use of the trademark as a verb had genericized the mark. Google cross-moved for summary judgment, arguing that the Appellants failed to provide sufficient evidence to show that the public uses the word google as a generic term to refer to internet search engines (*i.e.*, the services in connection with which the google trademark is registered). The district court granted Google’s motion, and Appellants appealed to the Ninth Circuit.

The 9th Circuit explained that 15 U.S.C. § 1064(3) provides that a trademark can be cancelled when the trademark “becomes the generic name for the *goods or services*... for which it is registered.” (Emphasis added). As such, the Ninth Circuit held that “a claim of genericide must relate to a particular type of good. Even if we assume that the

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public uses the verb 'google' in a generic and indiscriminate sense, this tells us nothing about how the public primarily understands the word itself, irrespective of its grammatical function, with regard to internet search engines.” In other words, (1) cancellation of a registration on the ground of genericness requires a showing that the word is used generically in connection with the specific goods or services identified in the registration; and (2) using a trademark as a verb is not sufficient to establish the genericness of a mark, since verb usage does not demonstrate how the public views the trademark with regards to the goods or services. Consequently, the Appellants failed to establish that the google trademark had become generic.

To provide additional clarity to its decision, the appellate court examined the evidence provided by the Appellants and determined that the evidence (including lyrics from T-Pain’s “Bottlez”) merely demonstrated that google can be considered a verb for *using* search engines. But the 9th Circuit found that none of the evidence demonstrated that the public uses the word google as a generic term for internet search engines. As such, the court affirmed the district court’s decision.

The key takeaways are that public use of a trademark as a verb is not sufficient by itself to meet the burden of proof on a genericness claim and that, to support cancellation of the registration on the ground of genericness, the evidence must show genericness of the mark in connection with the specific goods or services identified in the registration.