

## How Not to Prove a Mark is Generic. Use of GOOGLE as a Verb Does Not Constitute Genericide

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The Ninth Circuit Court of Appeals explained recently in *Elliot v. Google* that use of the **GOOGLE** trademark as a verb, “e.g. **google** it,” does not alone cause the mark to become generic. The question presented was whether the public’s use of “google” as a verb referred to the **Google** search engine, or whether it was directed more generally to the covered goods or services, i.e. search engines. In affirming a grant of summary judgment in Google’s favor, the Court emphasized the necessary and inherent link between genericide and a particular type of good or service and that trademarks can be used in forms other than adjectives without being rendered generic.

Plaintiffs relied on their argument that verb use constitutes generic use as a matter of law and therefore the lower court’s ruling in Google’s favor was inappropriate. The Court, however, disagreed with this proposition, focusing on two points that Plaintiffs failed to recognize: first, that a claim for genericide “must always” relate to a particular type of good or service; and second, that verb use does not automatically constitute generic use.

A trademark can be cancelled under Section 14(3) of the Lanham Act (15 U.S.C. § 1064(3)) if, *inter alia*, the trademark becomes a generic name for the type of goods or services rather than an indicator of the source of such goods or services. To determine whether a mark is generic, the Act sets forth the “primary significance test”: whether the primary significance of the registered mark to the relevant public has become the generic name for the goods or services. The Court emphasized that the recitation of “goods or services” throughout the Lanham Act required that the primary significance test be interpreted as requiring that the use supporting a claim of genericide relate to the particular type of good or service for which the mark was registered.

Thus, the Court emphasized the distinction between the use of “google” to generally identify search engines, on one hand, and the use of “google” to generally describe the act of searching the internet, on the other, in holding that even if Plaintiffs could prove that the majority of the relevant public did use “google” as a verb in a generic sense, this fact alone is insufficient to support a jury finding of genericism.

As to the second point regarding verb use of a mark, the Court reasoned that in enacting the primary significance test “Congress has instructed us that a speaker might use a trademark as a noun and still use the term in a source-identifying trademark sense.” The Court also emphasized that it would not interpret what customers were thinking or the meaning they had when they used a mark as something other than an adjective, i.e. whether they used the mark to generically reference a type of good or service or whether they had a specific source in mind. The burden of proving that mindset remains with the plaintiff. The Court made the point that it was not holding that verb use is “categorically irrelevant” to a genericness determination, only that the evidence presented by the plaintiffs did not meet their burden.

In forming its decision, the Ninth Circuit appears to embrace a new classification system for verb use into two types: “discriminate verbs” that are used with a particular brand in mind; or “indiscriminate verbs” that are used generically without a brand in mind. The Court noted that these novel terms, coined by the district court, “properly frame the inquiry as to whether the speaker had a particular source in mind.”

The Court dismissed plaintiffs arguments relating to the district court’s weighing of evidence. The Court held that the evidence presented by Plaintiff in the form of surveys, experts, and media as well as consumer use (the Court highlighted rapper T-Pain’s use of the phrase “google [his] name” in a song) merely bolstered the claim that “google” was used as a verb. As noted, this alone is not enough to support a finding of genericism by a jury. Similar arguments were dismissed by the Court as unresponsive of the ultimate question.

**Takeaways:**

- Use of a mark as a verb does not automatically render a mark generic, although it is possible that it may be used as evidence of genericism.
- The Ninth Circuit may have a new classification system when analyzing whether verb use is relevant to a genericness inquiry, namely whether the use is discriminate or indiscriminate.
- Not all uses of a mark as something other than as an adjective – such as a noun or verb – relate to a genericness inquiry; what matters is what the relevant public is thinking when using a mark in such fashion.

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