

GOOGLE Trademark Has Not Become Generic

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In *Elliott v Google, Inc*, 15-15809, 2012 WL 2112311 (May 16 2017) the Ninth Circuit upheld a district court's decision not to cancel the GOOGLE trademark, rejecting a claim that it had become generic.

The plaintiffs were two businessmen who had purchased 763 domain names that included the term 'google' accompanied by a specific search term such as 'googlebarackobama.net'. Google obtained ownership of the domain names through an administrative action, claiming that the domain names were confusingly similar to the GOOGLE mark. In response, the plaintiffs filed a petition in the US District Court for the District of Arizona seeking to cancel the GOOGLE trademark as generic. Thereafter, both parties sought summary judgment on the issue of genericness.

The plaintiffs argued they were entitled to summary judgment because they presented evidence showing that a majority of the public uses the word 'google' primarily as a verb to refer to the act of searching the Internet and use of a mark as a verb, the plaintiffs claimed, constitutes generic use as a matter of law. In opposition, Google argued that the plaintiffs had failed to create even a triable issue of fact and were therefore not entitled to summary judgment because, despite evidence of verb usage, the plaintiffs did not present any evidence showing that the relevant public primarily understands the word 'google' as a generic name for internet search engines. The district court agreed with Google and entered summary judgment in its favour. The plaintiffs appealed.

On appeal, the Ninth Circuit was tasked with addressing the importance of verb use when determining whether a mark has become generic and whether such use of the word 'google' as a verb had caused the GOOGLE mark to lose its trademark protection.

Primary importance test

Under the Lanham Act, a registered trademark may be cancelled and lose trademark protection if it is primarily understood as a "generic name for the good or services, or a portion thereof, for which it is registered" (15 USC § 1064(3)). Generic terms are not protectable because they do not identify the source of a product. Certain valid trademarks may become generic over time through a process referred to as 'genericide'. As the Ninth Circuit explained

"Genericide occurs when the public appropriates a trademark and uses it as a generic name for particular types of good or services irrespective of its source."

However, just because the public sometimes uses a trademark to refer to a product does not automatically render that trademark generic. Instead, as the Ninth Circuit stated, the proper rule is:

“[A] trademark only becomes generic when the primary significance of the registered mark to the relevant public is as the name for a particular type of good or service irrespective of its source.”

Applying these principles of trademark law, the Ninth Circuit rejected the plaintiffs’ arguments.

Ninth Circuit’s decision – two lessons

First, the Ninth Circuit held that, as the language of the Lanham Act makes clear, a claim of genericness or genericide must be made with regard to a particular type of good or service. Thus, the relevant inquiry in this case was not whether the term ‘google’ is commonly used as a verb for searching the Internet. Instead, the court explained, the appropriate question was whether ‘google’ has become a generic term for the relevant category of products or services – in this case, search engines.

Second, the Ninth Circuit took the opportunity to clarify that using a mark as a verb does not automatically constitute generic use. Contrary to the plaintiffs’ argument, the court made clear that it will not assume genericide when the evidence simply shows that a trademark is used as something other than an adjective to identify a product. Specifically, the court explained that just because someone uses a mark as a verb or a noun does not necessarily mean that he or she has no particular brand in mind. For example, a person may use ‘Kleenex’ as a noun to refer to tissues in general, instead of using the word as an adjective to describe the product (eg, ‘Kleenex tissue’), and still associate the product with the particular Kleenex brand. Similarly, in this case, the evidence showed that although consumers used the term ‘google’ as a verb (eg, ‘google this’ or ‘googling’), such consumers still identified the term with the GOOGLE mark.

The court therefore held that in order to prove genericide, a claimant must present evidence that the public has no specific brand in mind when using the trademark term to identify a product. Because the plaintiffs did not present any evidence purporting to show that ‘google’ was primarily used to describe search engines without regard to the specific Google brand, the Ninth Circuit affirmed the district court’s decision to reject the application to cancel the GOOGLE mark.

Comment

In addition to Google, the Ninth Circuit’s decision represents a victory for other owners of well-known trademarks. The ruling arguably makes it more difficult to prove that a mark is generic. Petitioners seeking to cancel marks as generic will have to meet the added burden of proving a negative. That is, in addition to presenting evidence of common usage, petitioners will need to show that, when using the mark, speakers do not associate the term with any particular source. This is a difficult showing to make, since it requires presenting evidence of the relevant public’s inner thought process when using the mark.

The lasting impact of the decision is yet to be determined as the plaintiffs have 90 days from the date of the decision to petition a review by the US Supreme Court, which will need to decide whether to take the case.

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