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PERSPECTIVE

Brand owners rejoice at Google trademark ruling

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In trademark law, as in life, there can be too much success. Becoming a household name may get your product into more homes, but gaining such notoriety carries with it some risk. Namely, if a court deems a mark “generic,” trademark law may no longer protect that brand name. A once-valuable asset, lost to legal nuance.

This risk may be less of a concern after the 9th U.S. Circuit Court of Appeals’ recent decision in *Elliott v. Google*, 2017 DJDAR 5648 (June 14, 2017), given the court’s holding that “verb use [of a trademark] does not necessarily constitute generic use.”

Before this decision, limits on “genericide” were well established. For example, occasional generic use is not enough. For a trademark to become generic, the “primary significance of the registered mark to the relevant public” must be as the name for a particular type of good or service, irrespective of its source. In other words, if the public primarily understands a trademark as describing “what” a good is (instead of “who” the good comes from), the mark would be generic and ineligible for protection. Think thermos or aspirin, both once-valuable brand names lost to genericide.

For many, the word “google” (lowercase) has become synonymous with the act of using an online search engine. According to the plaintiffs in *Elliott v. Google*, this meant that the “Google” (uppercase) trademark was being used generically and, thus, was invalid. In support of this claim, the plaintiffs produced reams of evidence showing consumers’ use of “google” as a verb.

The district court did not agree, granting summary judgment for Google. Framing the legal analysis in terms of consumers’ thought

processes, the trial judge adopted a dichotomy between “discriminate” and “indiscriminate” uses of a trademark. That is, a consumer uses the mark “discriminately” when they have the particular brand in mind, but “indiscriminately” when they have no particular brand in mind. But the district court reasoned that, even if consumers used a verb form of “google” in an indiscriminate sense, this did not make the trademark generic.

The 9th Circuit agreed. In an oddly discursive opinion, the court held that verb use of “google” could not show genericness alone, because consumers could still identify “Google” as a search engine owned by Google, even if they used “google” as a verb to refer to the act of using an online search engine.

The panel first explained at length that Elliott’s verb-means-generic theory “fails to recognize that a claim of genericide must always relate to a particular type of good or service.” But it is not clear that Elliott was contending otherwise. He was contending that the widespread use of “google” to mean the act of using an online search engine made the mark generic. But that is not necessarily the same as divorcing the mark from any good or service, given that the service with which Google is used as a trademark is an online search engine. The majority opinion could be read to foreclose such arguments in the future or, alternatively, to require a heightened burden on the plaintiff to link verb use with a particular product.

That ambiguity comes to the fore in the more interesting portion of the opinion holding that verb use does not automatically constitute generic use. That is, the fact that lots of people now regularly refer to “googling” a subject online is distinct from — and does not negate — the fact that, in general, people still think of “Google” as a particular online search engine offered by Google.



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So, the 9th Circuit held, siding with the district court, much of the plaintiffs’ evidence was “largely irrelevant” because it only supported the conclusion that use of “google” as a *verb* was indiscriminate. To succeed in establishing genericness, the plaintiffs needed to show conclusive proof that the relevant public primarily understands the word “google” as a generic name (that is, a noun) for Internet search engines. Because Google introduced evidence showing that many consumers still identified “Google” as a brand name, the court ruled in the company’s favor.

The panel suggested that evidence of use of a mark as a verb would rarely, if ever, constitute evidence of genericide. Plaintiffs must do more and show that consumers view the mark as describing the good or service itself, rather than that the mark is also used as a verb in connection with the good or service.

The court explained in its ruling that “verb use does not necessarily constitute generic use.” (Emphasis added.) This might leave open the possibility that, in certain circumstances, verb use could support a conclusion of genericide. Judge Watford wrote a separate concurrence on this point, emphasizing his belief that evidence of indis-

criminate verb use should not be foreclosed as a matter of law. It is not immediately clear what kind of circumstances would make such evidence relevant; we will have to see what facts come up in future cases.

For now, the 9th Circuit’s ruling keeps the bar for establishing genericide very high where a mark is being used as a verb. And, the court’s decision keeps Google’s mark intact as applied to its popular search engine.

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