



Elliot v. Google, Inc., 860 F.3d 1151 (9th Cir. 2017)

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Recommended Citation

Kayla Jewell, *Elliot v. Google, Inc.*, 860 F.3d 1151 (9th Cir. 2017), 28 DePaul J. Art, Tech. & Intell. Prop. L. 71 (2019)

Available at: <https://via.library.depaul.edu/jatip/vol28/iss1/5>

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***ELLIOTT V. GOOGLE, INC.*, 860 F.3d 1151 (9TH CIR. 2017)**

I. INTRODUCTION

In *Elliott v. Google, Inc.*,¹ the United States Court of Appeals for the Ninth Circuit considered whether the Google trademark has fallen prey to genericide.² Under the Lanham Act, a trademark loses its registration if the mark becomes a generic name for the goods or services for which it is registered.³ David Elliott and Chris Gillespie (“Elliott plaintiffs”) alleged that the Google trademark had become generic based on public use.⁴ Specifically, the Elliott plaintiffs argued that the public was not using the Google trademark to describe internet searches done via the Google search engine but instead to describe the general act of internet searching.⁵ To help support this argument, Elliott pointed to common phrases such as, “I googled it.”⁶

In deciding the case, the District Court focused on internet search engines instead of the act of searching the internet.⁷ By doing so, the District Court found that the Google trademark had not become generic because it was being used as a verb, which does not automatically constitute generic use.⁸ The Ninth Circuit affirmed the District Court’s holding and explained that trademarks become generic when the public starts to use the mark to refer to the good or service, not the act of using the good or service.⁹ The court held that use of a mark as a verb does not render the trademark generic.¹⁰

¹ *Elliott v. Google, Inc.*, 860 F.3d 1151, 1155 (9th Cir. 2017).

² *Id.*; see *infra* note 44.

³ 15 U.S.C. § 1064.

⁴ *Elliott*, 860 F.3d at 1155.

⁵ *Id.*

⁶ *Id.*

⁷ *Elliot v. Google, Inc.*, 45 F. Supp. 3d 1156, 1175 (D. Ariz. 2014).

⁸ *Id.*

⁹ *Elliott*, 860 F.3d at 1157.

¹⁰ *Id.* at 1163.

II. BACKGROUND

In February and March of 2012, Elliott acquired 763 domain names that all included the word “google” from a domain name registrar, Godaddy.com, LLC.¹¹ The domain names paired the word “google” with a variety of other terms.¹² After Google, Inc. (“Google”) discovered Elliott’s domain names, it filed a complaint with the National Arbitration Forum, an organization that arbitrates and mediates disputes for businesses.¹³ Through its complaint, Google claimed that the registered domain names violated the Uniform Domain Name Dispute Resolution Policy¹⁴, which is included in the registrar’s terms of use.¹⁵ Google argued that Elliott’s registration violation is trademark infringement because the domain names are confusingly similar to the trademark GOOGLE.¹⁶ The trademarks in question are No. 2884502¹⁷ and No. 2806075,¹⁸

¹¹ *Id.* at 1154; Google Inc. v. Chris Gillespie, 2012 WL 3679676, 7* (May 10, 2012).

¹² *Elliott*, 860 F.3d at 1154.

¹³ *Id.*

¹⁴ Uniform Domain-Name Dispute-Resolution Policy, *General Information*, ICANN, <https://www.icann.org/resources/pages/help/dndr/udrp-en>.

Under the policy, most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name.

¹⁵ *Elliott*, 860 F.3d at 1154.

¹⁶ *Id.*

¹⁷ *Elliot*, 45 F. Supp. 3d at 1159.

The [2884]502 Mark covers computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources.

¹⁸ *Id.*

The [2806]075 Mark covers, *inter alia*: Computer services, namely, providing software interfaces available over a network in order to create a personalized on-line information service; extraction and retrieval of information and data mining by means of global computer networks; creating indexes of information, indexes of web sites and indexes of other

which collectively refer to the search engine.¹⁹ The National Arbitration Forum ruled in favor of Google and, on May 10, 2012, transferred the domain names at issue to Google.²⁰

In response to the National Arbitration Forum's decision, Elliott filed an action in the Arizona District Court, which Gillespie later joined.²¹ Elliott sought for the cancellation of the Google trademark based on the theory that the trademark has become generic.²² In an attempt to justify his theory, Elliott argued the word "google" is largely used as a "generic term universally used to describe the act of internet searching."²³ On September 23, 2013, both parties filed for summary judgment on whether the Google trademark had become generic.²⁴ In plaintiff's motion for summary judgment, Elliott argued that the majority of the relevant public uses the word "google" as a verb.²⁵ Elliott further argued that verb use constitutes generic use as a matter of law.²⁶ Google argued that verb use does not automatically amount to generic use.²⁷ Further, Google asserted that Elliott failed in creating a triable issue of fact as to the genericity of the Google trademark.²⁸ The District Court granted Google's motion for summary judgment.²⁹

Elliott appealed the Arizona District Court's decision to the Ninth Circuit Court of Appeals.³⁰ On appeal, Elliott argued the

information sources in connection with global computer networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, by means of global computer information networks.

¹⁹ *Id.*

²⁰ *Elliott*, 860 F.3d at 1154.

²¹ *Id.* at 1154-55.

²² *Id.* at 1155.

²³ *Id.*

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Elliott*, 860 F.3d at 1155.

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*

District Court erred in applying the primary significance test and assessing the importance of verb use.³¹ Additionally, he argued that the District Court impermissibly weighed the evidence when it ruled on Google's summary judgment.³² The Ninth Circuit reviewed the District Court's holding *de novo*, rejected Elliott's contentions, and affirmed the summary judgment for Google.³³ In affirming the District Court's decision, the appellate court held that verb use does not automatically constitute genericide, which cancels a valid trademark.³⁴ Elliott filed a petition for a writ of certiorari on August 14, 2017, asking the United States Supreme Court to overturn the Ninth Circuit's decision.³⁵ On October 16, 2017, the Supreme Court denied Elliott's petition for writ of certiorari.³⁶

III. LEGAL ANALYSIS

Elliott raised two issues on appeal. First, that the district court misapplied the primary significance test and failed in recognizing the weight of verb usage. Second, that the district court impermissibly weighed the evidence in granting Google's motion for summary judgment.³⁷ The Ninth Circuit rejected both arguments and affirmed the district court's decision.³⁸

To assess the district court's decision, the court here explained the categories in which a potential trademark can be classified: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful terms.³⁹ Arbitrary marks are terms that have meaning separate from the trademarked good or service.⁴⁰ Fanciful marks are terms are created by the trademark owner specifically for

³¹ *Id.*

³² *Elliott*, 860 F.3d at 1155.

³³ *Id.*

³⁴ *Id.* at 1163.

³⁵ *Elliott et al. v. Google Inc.*, No. 17-258, *petition for cert. filed*, 2017 WL 3601395 (U.S. Aug. 14, 2017).

³⁶ *Elliott, David, et al. v. Google, Inc.* 2017 WL 3581929 (Oct. 16, 2017).

³⁷ *Elliott*, 860 F.3d at 1155.

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ 1-2 GILSON ON TRADEMARKS § 2.04.

the trademarked good or service.⁴¹ Whereas generic marks are not offered trademark protection, arbitrary or fanciful terms are automatically afforded protection.⁴²

Elliott argued that the Google trademark, which is in the arbitrary category of protection, has shifted to the generic category because of public appropriation of the mark.⁴³ This is referred to as genericide.⁴⁴ Genericide occurs when the public uses a trademark in place of the generic name for particular types of goods or services irrespective of its source. The court explained that the question of whether a trademark has crossed the line into genericide is determined by a “who-are-you/what-are-you” test.⁴⁵

In looking to Elliott’s first argument, the court named two reasons for rejection. First, Elliott failed to recognize that genericide claims must relate to a particular type of good or service. Second, Elliott wrongly assumed verb use automatically equates to

⁴¹ *Id.*

⁴² *Elliott*, 860 F.3d at 1155.

⁴³ *Id.*

⁴⁴ *Id.* at 1156.

For example, ASPIRIN, CELLOPHANE, and ESCALATOR were once protectable as arbitrary or fanciful marks because they were primarily understood as identifying the source of certain goods. But the public appropriated those marks and now primarily understands aspirin, cellophane, and escalator as generic names for those same goods.

⁴⁵ *Id.*

If the relevant public primarily understands a mark as describing “who” a particular good or service is, or where it comes from, then the mark is still valid. But if the relevant public primarily understands a mark as describing “what” the particular good or service is, then the mark has become generic. In sum, we ask whether “the primary significance of the term in the minds of the consuming public is [now] the product [and not] the producer.”

(quoting *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118, 59 S. Ct. 109, 83 L. Ed. 73, 1939 Dec. Comm’r Pat. 850 (1938)).

generic use.⁴⁶ The court noted that the plain language of the Lanham Act clearly requires the claim of genericide be in connection with the goods or services for which it is registered.⁴⁷ The court went on to explain the importance of that particular requirement when assessing arbitrary marks.⁴⁸

Arbitrary marks connect an unrelated, existing word to a good or service.⁴⁹ It would be illogical to cancel an arbitrary trademark like “Apple” for computers because it is generic when used in connection to fruit.⁵⁰ The mere fact that arbitrary marks are afforded federal trademark protection is evidence that genericide claims are required to be in connection with the good or service for which the trademark is registered.⁵¹

The court’s second line of reasoning in rejecting Elliott’s argument was that verb use does not automatically constitute generic use.⁵² The basis of Elliott’s argument was that a word can only be used in a trademark sense when used as an adjective because both trademarks and adjectives are descriptive.⁵³ The court referred to the Congressional Record to show how the primary significance test applies to claims of genericide.⁵⁴ Further, the court has previously implicitly rejected the argument that adjective use only

⁴⁶ *Id.* at 1157.

⁴⁷ *Id.*

⁴⁸ *Elliott*, 860 F.3d at 1157.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Elliott*, 860 F.3d at 1157-58.

A trademark can serve a dual function—that of [naming] a product while at the same time indicating its source. Admittedly, if a product is unique, it is more likely that the trademark adopted and used to identify that product will be used as if it were the identifying name of that product. But this is not conclusive of whether the mark is generic.

S. Rep. No. 98-627, at 5 (1984).

represents trademark use.⁵⁵ Additionally, in evaluating Elliott's examples of the public using the Google trademark as a verb, the district court coined the terms "discriminative verb" and "indiscriminative verb."⁵⁶

The Ninth Circuit rejected Elliott's second argument that the District Court impermissibly weighed evidence when it granted Google's summary judgment.⁵⁷ Elliott pointed to the "sheer quantity" of evidence to support this argument.⁵⁸ The court found the evidence to be largely irrelevant to the primary significance test because the genericide claim did not relate to a good or service.⁵⁹ All of the admissible evidence submitted by Elliott are examples only of verb use.⁶⁰ Elliott provided clear examples of indiscriminate verb use by the media and by consumers, but the district court properly excluded them because they were not disclosed during the discovery period.⁶¹ The court noted that even if the above evidence was included, that it was largely irrelevant.⁶² The court repeatedly pointed out that claims of genericide must be in connection to the good or service for which the mark is registered.⁶³

IV. FUTURE IMPLICATIONS

The existence of this case incites the question of why brands fight so hard against becoming generic. Trademarks are the "single

⁵⁵ *Id.* at 1158 (citing *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250 (9th Cir. 1982)).

⁵⁶ *Id.*; *Elliot v. Google, Inc.*, 45 F. Supp. 3d 1156, 1162 (D. Ariz. 2014) ("A mark can be used as a verb in a discriminate sense so as to refer to an activity with a particular product or service. . . . However, a mark can also be used as a verb in an indiscriminate sense so as to refer to a category of activity in general.").

⁵⁷ *Elliot*, 860 F.3d at 1159.

⁵⁸ *Id.*

⁵⁹ *Id.* at 1157.

⁶⁰ *Id.* at 1161.

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Elliot*, 860 F.3d at 1158-59.

largest source of intangible value in a company.”⁶⁴ In 2014, Forbes estimated the Google trademark’s value at \$113,000,000,000.⁶⁵

Google still controls the Google trademark, so it can continue to prevent competitors and third party developers, like Elliott, from tarnishing the mark.⁶⁶ The holding in the present case brings good news to owners of popular trademarks that are being used as verbs more and more often. For example, some popular trademarked social media networks like Snapchat and Instagram are being used as verbs.⁶⁷ The District Court used Photoshop⁶⁸ to help further explain discriminative and indiscriminate verb use.⁶⁹ There is no way to know if a person is using the verb in a discriminative or indiscriminate sense, which would be using the verb to refer to the act of using the registered trademark or to refer to the act of using similar products to that of the registered trademark.⁷⁰ By explaining that verb use does not constitute generic use, the Ninth Circuit has helped these increasingly successful companies hold on to their trademark registrations.

The holding in *Elliott v. Google, Inc.* could create new advertising possibilities for companies. Traditionally, trademark owners discourage the use of their mark as a noun or verb to avoid genericide.⁷¹ However, in light of the holding in the present case,

⁶⁴ Sean Stonefield, *The 10 Most Valuable Trademarks*, FORBES (June 15, 2011, 11:22 AM), <https://www.forbes.com/sites/seanstonefield/2011/06/15/the-10-most-valuable-trademarks/#944031236b81>.

⁶⁵ Eric Goldman, *Google Successfully Defends Its Most Valuable Asset In Court*, FORBES (Sept. 15, 2014, 12:11 PM), <https://www.forbes.com/sites/ericgoldman/2014/09/15/google-successfully-defends-its-most-valuable-asset-in-court/>.

⁶⁶ *Id.*

⁶⁷ Users of these social media platforms will sometimes refer the action of posting on the platform by using the name of the platform as a verb. Examples of this include: “I Snapchatted it” and “Did you Instagram it?”

⁶⁸ *Elliot v. Google, Inc.*, 45 F. Supp. 3d 1156, 1162 (D. Ariz. 2014).

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ Danica Mathes, *Lessons From Google Surviving The Genericide Attack*, LAW360 (July 7, 2017, 11:48 AM),

some companies might try to strengthen their brand by using the trademark as verb is advertising slogans. Prior to this case, a few companies have promoted their brand with verb usage,⁷² such as Yahoo!'s "Do You Yahoo!?" marketing campaign.

In his petition for a writ of certiorari, Elliott asserted the Ninth Circuit's decision has created a Circuit Split.⁷³ Elliott argued that the primary significance test prior to the present case had been interpreted as the rule of "majority usage" instead of "majority understanding."⁷⁴ Elliott further claimed the Ninth Circuit rejected this long-standing test in favor of an assessment of how the public understands a word.⁷⁵ The Second Circuit has interpreted the rule of primary significance to mean "majority usage."⁷⁶ If his assertion is accurate, this could lead other major companies looking to protect their trademark to find security in the Ninth Circuit. This could also potentially offer more protection to trademark owners located within the Ninth Circuit as opposed to other Circuits. Due to the circuits' differing tests, the U.S. Supreme Court should have considered the case to give clarity as to what test should be applied to genericide claims.

V. CONCLUSION

This holding demonstrates effects common vernacular and the evolution of language can have on trademark law and how it is applied. The Ninth Circuit ultimately held that a trademark cannot

<https://www.law360.com/articles/938665/lessons-from-google-surviving-the-genericide-attack>.

⁷² *Id.*

⁷³ Elliott v. Google, Inc., 2017 WL 3601395, *12-*13 (Aug. 14, 2017) (citing King-Seeley Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577, 581, 138 U.S.P.Q. 349 (2d Cir. 1963) ("Since the great majority of those members of the public who use the word 'thermos' are not aware of any trademark significance, there is not enough dual use to support King-Seeley's claims to monopoly of the word as a trademark.")).

⁷⁴ Elliott v. Google, Inc., 2017 WL 3601395, *12 (Aug. 14, 2017).

⁷⁵ *Id.* at *13.

⁷⁶ King-Seeley Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577, 581 (2d Cir. 1963).

become generic from widespread use as a verb.⁷⁷ Therefore, the Arizona District Court did not err in assessing the validity of the Google trademark, meaning Google has successfully protected its most valuable asset.⁷⁸ *Elliott* is good news for successful companies, especially highly successful companies like Google.

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⁷⁷ *Elliott*, 860 F.3d at 1163.

⁷⁸ *Id.*

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