

LET ME GOOGLE THAT FOR YOU: *ELLIOTT V. GOOGLE* AND ITS CONFLICTS WITH THE GENERICIDE DOCTRINE IN A DIGITAL AGE

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On September 25, 2017, the legal team at Velcro Companies (“Velcro”) attempted to educate their customer base about trademark law through a unique brand play.¹ Velcro created a YouTube video entitled “Don’t Say Velcro.”² In the video, the Velcro legal team discusses how people mistakenly call their product “velcro,” while they refer to their invention as hook and loop.³ The legal team passionately sings that if everyone calls every version of the product “velcro,” then the company will “lose [its] Circled R.”⁴ To the team’s nearly 500,000 viewers, this video may have seemed comical. However, couched in the Velcro legal department’s playful video is a real legal fear.

The Velcro lawyers are referring to a doctrine called genericide, which applies when a protected trademark is appropriated by the relevant public as the name of a product.⁵ Once a mark is declared to be a generic name, the designation enters the “linguistic commons” and is free for all to use.⁶ Velcro, like many large companies with household names, is constantly thinking about protecting its intellectual property, including its trademark. Losing its

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1. Velcro Companies (VELCRO® Brand), *Don’t Say Velcro*, YOUTUBE (Sept. 25, 2017), <https://www.youtube.com/watch?v=rRi8LptvFZY> [<https://perma.cc/V55V-4XS2>].

2. *Id.*

3. *Id.* at 00:38–48.

4. *Id.* at 00:44. “Circle R” refers to the enclosed R used to mark trademarks that are registered with the United States Patent and Trademark Office. *See* 15 U.S.C. § 1111 (2012).

5. J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1 (5th ed. 2018).

6. *America Online, Inc. v. AT&T Corp.*, 243 F.3d 812 (4th Cir. 2001) (“The task of distinguishing words or phrases functioning as trademarks from words or phrases in the ‘linguistic commons’ begins with the development of an understanding of the common meaning of words and their common usage and then proceeds to a determination of whether the would-be trademark falls within this heartland of meaning and usage.”); *see also* *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 339–40 (4th Cir. 2009) (the law protects the “linguistic commons” by denying protection for “words that do not identify goodwill attached to products or product sources but rather are used for their common meaning or meanings not indicative of products and product sources”).

trademark would alter Velcro's business model and create unwanted situations for the company to navigate, similar to Band-Aid, Clorox, and Rollerblade.⁷

Velcro's video highlights how trademark protection is a vital tool for all companies, big and small, who attempt to brand themselves. But as companies have evolved, so have brands. With the market becoming so saturated with products, and with technology often making products obsolete, the brand has become the focal point of what companies are selling.⁸ Subsequently, consumers fall in love with the brand, while the product is more of a catalyst to promote a profitable brand.⁹ Although this shift has changed the way businesses strategize, the same transformation has not occurred in courts and legal policy.

This conceptual struggle is highlighted in the Ninth Circuit's recent *Elliott v. Google* decision.¹⁰ That case, decided in June of 2017, upheld a summary judgment ruling that found Google's trademark not generic.¹¹ While the court in *Elliott* attempted to follow precedent, they failed to discuss the contextual differences between a brand like Google and other companies that are focused on a product rather than a brand.¹²

There is no denying that the vast majority of the market uses the Google search engine when searching the Internet. Oxford Dictionary has added the verb "google" as a way to describe someone who is searching the web on Google.¹³ Google has successfully integrated their brand with the common vernacular of the average person, yet the court held, as a matter of law, that "google" was not a generic term. Further, while the *Elliott* court attempted to define what does and does not constitute a generic mark, they unintentionally complicated the genericide analysis with a needless policy argument surrounding whether or not verb usage of a trademark constituted genericness.

This Note focuses on the Ninth Circuit's decision on verb usage in relation to the genericness of a mark. Velcro's video highlights the delicate balance of attempting to promote a brand while not stepping on the Lanham Act's toes, to avoid triggering a genericness claim. This Note argues that *Elliott's* faulty logic on verb use of a trademark risks tipping that balance and promotes uncertainty within the genericide doctrine.

7. See Velcro Companies, *supra* note 1, at 01:32–49 (ironically censoring these generic names).

8. See DAVID A. AAKER & ALEXANDER L. BIEL, BRAND EQUITY & ADVERTISING: ADVERTISING'S ROLE IN BUILDING STRONG BRANDS 67 (1993) ("Brands have become so ubiquitous in 20th-century America that we could say we are living in a rich 'brandscape.'").

9. THE EXPRESSIVE ORGANIZATION: LINKING IDENTITY, REPUTATION, AND THE CORPORATE BRAND 52 (Majken Shultz et al. eds., 2000).

10. *Elliott v. Google, Inc.*, 860 F.3d 1151 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017).

11. See *id.* at 1163.

12. See *id.*

13. *Google*, OXFORD DICTIONARY OF ENGLISH.

Part I of this Note gives a brief history of trademark law and the Lanham Act and highlights how courts typically deal with genericide claims through the use of surveys. Part II discusses how branding has rapidly evolved over the past few decades through the use of a brand name as a verb, and how social media has helped that expansion. Part III brings in *Elliott v. Google* and explains the Ninth Circuit's decision surrounding the viability of verb usage for a registered mark. Part IV examines the problems post-*Elliott* with respect to the purposes of trademark law and its intersection with company branding techniques. Part V concludes.

I. TRADEMARK LAW AND THE LANHAM ACT

Before 1946, courts largely relied on the common law to guide trademark decisions.¹⁴ In 1946, Congress created the Lanham Act, which aimed “to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and goodwill by preventing their diversion from those who have created them to those who have not.”¹⁵ The Lanham Act has two primary purposes: to protect consumers against confusion about the origin of a particular good or service, and to encourage companies to stand behind their goods and services by creating goodwill through a reliable and recognizable mark.¹⁶ For a trademark to be protected, the relevant public must recognize the mark as a source indicator for a particular type of good or service.¹⁷ However, if a mark becomes too recognizable, a court may cancel the trademark's registration under the doctrine of genericide.¹⁸

A. INTRODUCTION TO GENERICIDE

The Lanham Act provides that if a registered mark becomes the generic name for the goods or services for which it is registered, a challenger can file a petition in court to have that registration canceled.¹⁹ Courts have held that even when a term itself is a generic term or phrase, it is likely still protectable if it has a secondary meaning that ties the terms to a product and causes

14. Irina D. Manta, *Branded*, 69 S.M.U. L. REV. 713, 725 (2016).

15. S. REP. NO. 79-1333, at 4 (1946).

16. See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 818 (1927); see also *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 514 U.S. 159, 163–64 (1995) (“The true functions of the trademark are . . . to identify a product as satisfactory and thereby to stimulate further purchases by the consuming public.”).

17. See 15 U.S.C. §§ 1051(a)(1), 1127 (2012).

18. See 15 U.S.C. § 1064 (2012).

19. *Id.* § 1064(3).

purchasers to buy the product because of its source.²⁰ Rather, the test for determining the generic nature of a mark assesses the primary meaning of the registered mark to the relevant public.²¹

Congress highlighted the importance of the perspective of the relevant public in determining genericness in a 1984 Amendment to 15 U.S.C. § 1064(3), the provision codifying the genericide doctrine.²² A set of 1984 amendments were introduced after a controversial Ninth Circuit decision, *Anti-Monopoly, Inc. v. General Mills Fun Group*.²³ In *Anti-Monopoly*, the court held that if consumers do not buy a product primarily out of loyalty to the company which makes it, the trademark for the product is public property.²⁴ In making the 1984 amendments, Congress directly sought to overturn *Anti-Monopoly*, highlighting the importance of the consumers' interpretation of the mark, rather than their loyalty.²⁵

The 1984 amendments discussed above codified a test developed by Judge Learned Hand.²⁶ In the landmark case *Bayer Co. v. United Drug Co.*, Judge Learned Hand held the term "aspirin" to be generic after asking this key question: "What do buyers understand by the word for whose use the parties are contending?"²⁷ Thus, the central issue in a genericness case is whether a term, as applied to a product, is primarily understood to be a trademark or a generic name for the product to which it is tied.²⁸

However, sometimes overly simplistic solutions to complex issues result in unsatisfactory and problematic decisions that are less likely to stand the test of time.²⁹ If Judge Learned Hand presented the most applicable method to tackle genericide inquiries, how can courts analyze what is a generic mark in the first place? How do courts enter the mind of the relevant consumer?

20. *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 8 (2d Cir. 1976) (explaining that although "safari" was a generic word, a genuine issue of fact existed as to whether the plaintiff had created a secondary meaning in its use of the word "identifying the source" and showed that "purchasers [were] moved to buy it because of its source").

21. *See id.* at 9.

22. Vincent N. Palladino, *Genericness and the Trademark Clarification Act of 1984: Five Years Later*, 79 TRADEMARK REP. 657 (1989).

23. *See* 611 F.2d 296 (9th Cir. 1979).

24. *See id.* at 300.

25. *See* Palladino, *supra* note 22, at 658.

26. *See* *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640 (Fed. Cir. 1991); *Comm. for Idaho's High Desert v. Yost*, 92 F.3d 814 (9th Cir. 1996).

27. 272 F. 505, 509 (S.D.N.Y. 1921). *See also* *DuPont Cellophane Co. v. Waxed Prod. Co.*, 85 F.2d 75 (2d Cir. 1936), *cert. denied*, 299 U.S. 601 (1936); *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903 (3d Cir. 1952); *Dresser Indus., Inc. v. Heraeus Engelhard Vacuum, Inc.*, 395 F.2d 457 (3d Cir. 1968), *cert. denied*, 393 U.S. 934 (1968).

28. *See* Palladino, *supra* note 22, at 678.

29. *See id.*

B. SURVEY EVIDENCE

One of the main methods used for determining genericide in the modern age relies on survey evidence, usually gathered by the lawyers on either side of the claim. Judges are now accustomed to, and often expect, survey evidence in genericness disputes.³⁰ As intellectual property scholar, J. Thomas McCarthy, explains, survey evidence is only not required if there is overwhelming evidence outside the surveys to prove genericness.³¹ Further, surveys need to show only that a bare majority of respondents do not view a trademark as generic to save a trademark from genericide.³² For example, judges have found that trademarks where sixty percent of survey respondents identify with a specific product are not generic.³³

There are various types of survey evidence that are used to assess genericness, but courts have approved two main models. Those models are the Thermos Survey and the Teflon Survey.³⁴

1. *The Thermos Survey*

The Thermos survey is the less used of the two main surveys and is named for the survey used to prove the term “Thermos” was a generic term.³⁵ A Thermos survey asks respondents how they would ask for the product at issue.³⁶ In the example of the thermos, if the respondents were to refer to the product by the brand name, Thermos, rather than what the good was intended to be called, a vacuum bottle, then the survey points towards the mark being generic. The term would be generic because the consumers would be using it

30. *See* *Heroes, Inc. v. Boomer Esiason Hero’s Foundation, Inc.*, 43 U.S.P.Q.2d 1193 (D.C. Cir. 1997) (rejecting a challenge that HEROES was generic name of charitable services assisting surviving family of police and firefighters killed in line of duty because, in part, “defendant has introduced no consumer surveys”); *Magic Wand*, 940 F.2d at 642 (rejecting a challenge that TOUCHLESS is a generic name for a type of auto wash services, in part because the challenger introduced no survey evidence); *Heroes, Inc. v. Boomer Esiason Hero’s Found., Inc.*, 43 U.S.P.Q.2d 1193 (D.C. Cir. 1997); *Hermes Intern. v. Lederer De Paris Fifth Avenue, Inc.*, 50 F. Supp. 2d 212 (S.D.N.Y. 1999), *rev’d on other grounds*, 219 F.3d 104 (2d Cir. 2000) (challenger failed to conduct genericness survey in opposition to the survey of the mark owner: summary judgment of genericness was denied).

31. MCCARTHY, *supra* note 5, at § 12:14.

32. *See* *TY, Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 530 (7th Cir. 2003).

33. *See id.* at 530–31. While the court in *Ty* referred to the plaintiff’s survey evidence as probative, the defendant also failed to present its own survey evidence of genericness. *See id.* at 531.

34. *See* MCCARTHY, *supra* note 5, at § 12:14.

35. *Am. Thermos Prod. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d*, 321 F.2d 577 (2d Cir. 1963).

36. *See, e.g., E.T. Browne Drug Co. v. Cococare Prod., Inc.*, 538 F.3d 185, 194–95 (3d Cir. 2008).

to refer to the product category rather than a producer who makes products within that product category.³⁷

The Thermos survey model has been used in multiple cases to help judges determine whether a mark is generic.³⁸ However, its design has been criticized because it does not account for the possibility that respondents who are very brand loyal may refer to the product type by the brand name while recognizing that the term is a brand and not a common name.³⁹ Therefore, while it is essential to know how a Thermos survey is structured to understand how courts attempt to hear the relevant consumer, it is also important to note that this type of straight-forward questioning may not be the best indicator of genericness.⁴⁰ In contrast, the Teflon survey is both more probative and more popular.

2. *The Teflon Survey*

The Teflon survey model is the most widely used survey format to resolve genericness challenges. The name of the survey comes from a 1973 telephone survey conducted to show that the mark Teflon was a valid trademark rather than a generic name for a non-stick coating.⁴¹ The Teflon survey asks the consumers to associate a given word with either a registered mark that they know or with a name of a generic product. For example, in *TY, Inc. v. Softbelly's, Inc.*, a survey conducted by the plaintiffs' expert aimed at determining how consumers classified the term "beanies."⁴² The survey revealed that sixty percent of respondents identified "beanies" as a brand name for soft plush

37. *See id.* Other sample questions used in the Thermos brand survey included: Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold? Do you know the names of any manufacturers who make these containers that keep liquids hot or cold? Can you name any trademarks or brand names that are used on these containers?

MCCARTHY, *supra* note 5, at § 12:15.

38. *See, e.g., E.T. Browne*, 538 F.3d 185; *Am. Thermos*, 207 F. Supp. at 9; *Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc.*, 2007 WL 4563873 (N.D. Ga. 2007).

39. MCCARTHY, *supra* note 5, at § 12:15.

40. *See Anti-Monopoly, Inc. v. General Mills Fun Group*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 459 U.S. 1227 (1983), where the court enthusiastically embraced the results of a Thermos survey without considering the possibility of brand loyalty coloring responses.

41. *E. I. DuPont de Nemours & Co. v. Yoshida Intern., Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975); *see Greenbaum, Ginsburg & Weinberg, A Proposal for Evaluating Genericism After "Anti-Monopoly"*, 73 TRADEMARK REP. 101, 118 (1983); *Jacob Zimmerman v. National Assoc. of Realtors*, 70 U.S.P.Q.2d 1425 (T.T.A.B. 2004) (defects in the structure and administration of a Teflon-type survey—such as failing to provide a "don't know" response—resulted in the survey being accorded "very little weight").

42. 353 F.3d 528 (7th Cir. 2003).

toys filled with beads.⁴³ While that could also indicate that as many as forty percent of respondents saw the term as a generic identifier, the court concluded that the sixty percent response rate was evidence that the primary significance of the mark was to designate the source of the plaintiffs' goods.⁴⁴

There are three main steps to crafting a Teflon survey. First, a survey maker explains the basic definitions of terms like "common generic name" and "brand name."⁴⁵ This aims at eliminating the possible survey bias within the survey by making the participants aware of the difference between the two concepts.⁴⁶ Consumers who are loyal to a brand, say Teflon, and based on that loyalty only buy Teflon non-stick spray, may still associate the term "Teflon" with a common term for non-stick spray despite being aware of the Teflon brand.⁴⁷

Second, a survey maker conducts a mini test with the goal of revealing whether the survey participants truly understand the differences between the terms just described.⁴⁸ This involves asking the participants to describe some obvious test terms as either a brand name or common term. Anyone who fails to correctly distinguish between the terms is eliminated from the main genericness survey.⁴⁹

Finally, the survey maker constructs the most relevant part of the survey. This involves displaying the mark in question, as well as similar marks and terms, and asking the survey participants to classify them.⁵⁰ The results from this third step help a court determine whether the relevant consumer interprets a mark as generic.

43. *Id.* at 530–31.

44. *See id.* (While the court in *Ty* referred to the plaintiff's survey evidence as probative, the defendant also failed to present its own survey evidence of genericness.).

45. Justin Anderson, *Three Essential Elements of a Genericness Survey*, MMR STRATEGY GROUP (Nov. 19, 2014), <http://mmrstrategy.com/three-essential-elements-of-a-genericness-survey-2/> [<https://perma.cc/SFB5-4G36>].

46. *See id.*

47. *See id.*

48. *See id.*

49. *See id.*

50. *See id.* In designing a Teflon type survey, both the initial "mini-test" and the other marks and generic names in the list must be carefully constructed and tailored to the facts of a particular case. See discussion of how to properly construct a Teflon-type survey in E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel, in Trademark and Deceptive Advertising Surveys*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS 112–24 (ABA, Eds. Diamond & Swann 2012).

The Teflon survey is the most judicially accepted survey for testing for genericness.⁵¹ In the original Teflon case, the court praised the effectiveness of the Teflon survey, concluding that:

[T]he responses of the [Teflon survey] reveal that the public is quite good at sorting out brand names from common names, and, for TEFLON, answers the critical question left unanswered by the ambiguities inherent in [the Thermos-type] surveys—that of the principal significance of the TEFLON mark to the public.⁵²

Despite the wide acceptance of the Teflon survey, there is still little consistency in how differently courts rule on genericide claims. This inconsistency may be explained by modern branding techniques and how they conflict with a basic reading of the genericide doctrine.

II. THE BRAND AS THE PRODUCT

In 1989, Daymond John trawled the streets of Queens to sell his first batch of handmade wool beanies.⁵³ He made \$800 on his first day—a solid day’s work, but not enough for rapid growth without a little corporate magic.⁵⁴ John ran with his idea, however, and began staking out music video sets, attempting to coax rappers to wear his apparel, which he had branded as being “For Us, By Us.”⁵⁵ Fast forward to 1998—the company now branded as FUBU peaked at \$350 million in annual sales.⁵⁶ Celebrities in various industries were wearing the FUBU brand, and millions of customers were champing at the bit to wear a plain v-neck t-shirt printed with the letters “FUBU.”⁵⁷

John’s story highlights the power of the brand. In the past, a brand played a relatively limited role in marketing, serving mainly to indicate a specific

51. See Jay, *supra* note 50, at 110 (“Teflon surveys have provided the preferred format for genericness surveys as reflected in U.S. court opinions and U.S. Trademark Trial and Appeal Board decisions in which they have been approved.”).

52. E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc., 393 F. Supp. 502, 527 (E.D.N.Y. 1975). Judge Neaher further held that the only survey which really gets down to the critical element is the Teflon Survey. He observed that the challenger’s Thermos survey was ambiguous because responses to “What is the name . . . ?” could be taken as either a generic or a trademark response. MCCARTHY, *supra* note 5, at § 12:16.

53. Alec Banks, *The Rise and Fall of FUBU: A Lesson in Business and Branding*, HUNDREDS (June 30, 2015), <https://thehundreds.com/blogs/content/the-rise-and-fall-of-fubu> [<https://perma.cc/VF9X-9X97>].

54. See *id.*

55. See *id.*

56. See *id.*

57. See *id.*

product.⁵⁸ However, today companies brand the trademark, and the cultural identities associated with the mark, as the product itself.⁵⁹ Companies no longer focus on the product, but the brand.⁶⁰

At the simplest level, a brand is defined as “a name that refers to the product of a particular manufacturer in a particular product category.”⁶¹ Brands today can arguably be more valuable than the book value given to a particular product.⁶² This concept of brand value has many tangible and protectable elements, such as the design and physical appearance of a product, as well as the logos and structure of the packaging.⁶³ However, brands carry intangible value as well.⁶⁴ These include consumer attitudes toward the manufacturing company and beliefs about the brand in relation to oneself and others.⁶⁵ With these intangible elements, a brand can encapsulate much more than a trademark or a logo; it encompasses the essence of a corporation—its products, its employees, and increasingly, its consumers.⁶⁶

Branding has evolved drastically over time and will continue to evolve with the ever-expanding nature of capitalist growth. This Part looks at two different aspects of branding: “verbifying” a brand, and the increasing use of social media.

A. VERBIFYING A BRAND

One of the more effective ways to incorporate a brand into the minds and language of the everyday consumer is to make it a verb.⁶⁷ Companies that can make their brand the descriptor verb for the product or service that the brand is associated with can dominate the market.⁶⁸ The brand simply becomes the only way to refer to a certain type of product. Whether intentional or not, “verbifying” a brand increases the chances of creating a mega brand. This

58. Sonia Katyal, *Stealth Marketing and Antibranding: The Love that Dare Not Speak Its Name*, 58 BUFF. L. REV. 795, 801 (2010).

59. *See id.*

60. *See* KEITH DINNIE, *THE EXPRESSIVE ORGANIZATION: LINKING IDENTITY, REPUTATION, AND THE CORPORATE BRAND* 51 (2003).

61. AAKER, *supra* note 8, at 33; *see also* Deborah R. Gerhardt, *Consumer Investment in Trademark*, 88 N.C. L. REV. 427, 459–67 (2010); Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, 946–55 (2006).

62. *See* WILLIAM LEISS ET AL., *SOCIAL COMMUNICATION IN ADVERTISING: PERSONS, PRODUCTS AND IMAGES OF WELL-BEING* 105–07 (1990).

63. *See* Katyal, *supra* note 58, at 804

64. *See* AAKER, *supra* note 8, at 33.

65. *See id.*

66. *See* Katyal, *supra* note 58, at 804.

67. *See* Colleen Ryan, *When A Brand Becomes A Verb*, IDEALOG (Sept. 27, 2016), <https://idealog.co.nz/etc/2016/09/when-brand-becomes-verb> [https://perma.cc/TD6H-YG5G].

68. *See id.*

process is not always led by the brand company, however, but may be guided by the interpretation of the reasonable consumer.

“Verbifying” a brand is not a new concept. Brands have been trying to get their names into people’s mouths for many years, with varying degrees of success. Verbification of a trademark is more likely to arise during periods of technological breakthrough. In instances where the brand name is the only term the consumer associates with the good or service, the consumer can take hold of how the brand is used in language. One of the most prominent stories of this is that of Xerox.

Xerox was founded in 1906 and originally manufactured photographic paper and equipment.⁶⁹ It was first branded as The Haloid Photographic Company.⁷⁰ The company changed its name to Xerox later to reflect the innovative new technology that the company used to produce its product.⁷¹ Looking for a term to differentiate its new system, Haloid coined the term Xerography from two Greek roots meaning “dry writing.”⁷² Haloid subsequently changed its name to Haloid Xerox in 1958, and then Xerox Corporation in 1961.⁷³

In 1959, the company came to prominence with the invention of the Xerox 914, the first plain paper photocopier. Revenue went up by almost ten times within the next five years.⁷⁴ The Xerox 914 and the iterations that followed became the industry standard for photocopying and remained as such until the invention of digital printing in the late 20th century.⁷⁵

With the rise in Xerox sales came the rise of the Xerox brand. Interestingly, because there was nothing like it on the market and there was no dominant term to describe the act of photocopying an image on a Xerox machine, people began to use the term “xerox” to describe the act of photocopying.⁷⁶ Fast-

69. *Xerox: History Timeline—1950’s* [HEREINAFTER Xerox History Timeline], XEROX, <https://www.xerox.com/about-xerox/history-timeline/1950-decade/enus.html> [<https://perma.cc/7TBB-48WU>] (last visited Dec. 21, 2018).

70. *See id.*

71. *See id.*

72. Kristya Tima, *Xerox: Brand That Became a Common Name*, <https://bookonlime.ru/system/files/node/lecture/20-timofeeva.pdf> [<https://perma.cc/S5XL-33M6>].

73. *See* Xerox History Timeline, *supra* note 69.

74. *See id.*

75. *See id.*

76. *See* Laura A. Heymann, *The Grammar of Trademarks*, LEWIS & CLARK L. REV. 1313, 1320 (2010); *see also* Stuart Elliott, *The Verb Treatment for an Investment House*, N.Y. TIMES (Mar. 15, 2010), <https://www.nytimes.com/2010/03/15/business/media/15adco.html> [<https://perma.cc/Y7MG-R2UA>] (reporting advertising campaign for the Vanguard Group that introduced the verb “Vanguarding”); Geoffrey K. Pullum, *Trademark Grammar*, LANGUAGE LOG (May 22, 2004), <http://itre.cis.upenn.edu/myl/languagelog/archives/>

forward a couple of decades, and the term “xerox” was defined in many major dictionaries, including The Oxford English Dictionary, as a verb with a similar definition to photocopy.⁷⁷ “Xerox” had effectively grown from a brand name for the Xerox Corporation into a new word.

Xerox was aware of this use of their mark, and the danger it posed in light of the genericide doctrine. Xerox released many statements over the years encouraging its customers not to use the term generically. It declared that “you cannot ‘xerox’ a document, but you can copy it on a Xerox Brand copying machine.”⁷⁸ Despite its efforts, the term “xerox” remains in most major dictionaries.⁷⁹ However, Xerox continues to protect its trademark, and the mark has never been officially deemed generic. In fact, in India, one of Xerox’s largest markets, the Intellectual Property Appellate Board (IPAB) declared in 2012 that “Xerox” was a non-generic term after “almost 50 years of continued existence on the register without challenge, and with proof of almost 44 years of use evident.”⁸⁰ That decision was made despite the fact that, as of 2015, most Indians were still using “xerox” as a synonym for photocopying.⁸¹

Some have criticized Xerox for spending unnecessary resources on dissuading its customers from using the term “xerox” generically.⁸² As legal scholar Rebecca Tushnet puts it, “the risk of becoming generic is so low, and the benefits of being on the top of someone’s mind are so high.”⁸³ However, with the unintentional verbification of trademarks came a greater awareness within companies like Xerox about what it meant for a brand to become generic.

Introduction of new technologies, like the Xerox photocopier, which perform functions for which no word previously existed, has led to verbification of trademarks. Introduction of another new technological

000943.html [https://perma.cc/XPQ5-SVKF] (suggesting that modern advertising encourages consumers to use trademarks as language).

77. *Xerox*, OXFORD LIVING DICTIONARIES.

78. R. RADHAKRISHNAN & S. BALASUBRAMANIAN, INTELLECTUAL PROPERTY RIGHTS: TEXT AND CASES 129 (2008).

79. *See id.*

80. R. Sivaraman, *Appellate Board Upholds Trademark Status of Xerox*, HINDU (Sept. 22, 2012), <http://www.thehindu.com/news/national/tamil-nadu/appellate-board-upholds-trademark-status-of-xerox/article3927133.ece> [https://perma.cc/M7ZG-SKNV].

81. Express News Service, *Maggi Returns*, INDIAN EXPRESS (Nov. 11, 2015), <http://indianexpress.com/article/opinion/editorials/maggi-returns/> [https://perma.cc/787S-P2FF].

82. *See* Noam Cohen, *The Power of the Brand as Verb*, N.Y. TIMES (July 18, 2009), <https://www.nytimes.com/2009/07/19/weekinreview/19cohen.html> [https://perma.cc/5LKJ-G5HF].

83. *Id.*

product, social media, has also changed the way consumers interact with brands.

B. THE BRANDING OF SOCIAL MEDIA

Social media has had a huge impact on our daily lives. Since the release of AOL Instant Messenger in 1997,⁸⁴ the exponential advancement in digital communication has contributed to every aspect of society.⁸⁵ Today, whether you are on Facebook, Twitter, YouTube, or any other digital sharing platform, you will see a wide variety of advertisements. Advertising for products or service-based companies is nothing new and is an essential part of any business model where the customer pays a premium to use the good. However, the rise of the Internet and social media created a new challenge in the advertising and branding space: how should a company brand and market itself when the service it provides is free?

To look deeper into this question, it is important to understand some of the history of branding the free. Facebook serves as the prime example of this model. Created in February 2004, Facebook served initially as a social media experiment on a closed network of college students.⁸⁶ Since its early stages, Facebook has held ads for other companies.⁸⁷ In August of 2006, Facebook announced a partnership with J.P. Morgan Chase to promote the Chase credit card.⁸⁸ In the one-year marketing agreement, Facebook hosted Chase banner ads inviting users to join a special Chase network.⁸⁹ Members of this group then earned reward points for their actions, like paying their bills on time.⁹⁰

In September of 2006, Facebook announced “Election 2006,” which allowed anyone to search for and interact with candidates for the Senate, House, and state governorships.⁹¹ With this feature, Facebook signified its

84. Steve Baxter, *Netscape, AOL Team Up on Instant Messenger*, CNN (Oct. 14, 1997), <http://www.cnn.com/TECH/9710/14/internet.messaging/> [https://perma.cc/T7RG-SL7Y].

85. See Vineet Kaul, *The Changing World of Media & Communication*, J. MASS COMM. & JOURNALISM (Apr. 22, 2012), <https://www.omicsonline.org/open-access/the-changing-world-of-media-and-communication-2165-7912.1000116.php?aid=6473> [https://perma.cc/9D9U-TLJ9].

86. See Sarah Phillips, *A Brief History of Facebook*, GUARDIAN (Jul. 25, 2007), <https://www.theguardian.com/technology/2007/jul/25/media.newmedia> [https://perma.cc/F7R6-48P2].

87. See Chris Redshaw, *The History of Advertising on Facebook [Infographic]*, REEF (Dec. 20, 2011), <http://www.reefdigital.com.au/blog/the-history-of-advertising-on-facebook-infographic/> [https://perma.cc/RL4S-HKLM].

88. *See id.*

89. *See id.*

90. *See id.*

91. *See id.*

intent to become a platform for users to read news, discuss topical issues, and integrate themselves with a larger community. In November of 2006, Facebook created the share function, which allowed users to share news or ideas with anyone they were connected with on Facebook.⁹² Facebook quickly turned into the most popular place for people to talk with friends, have a voice, and feel included. At this point, Facebook surely realized that it was sitting on a social goldmine. It could integrate itself into the lives of every single person worldwide. So, Facebook made that its mission. Within a matter of years, Facebook became an essential part of billions of lives, attracting people of all ages, races, and beliefs.⁹³

Facebook was not the only company offering a free service that managed to reach this level of success. Other companies began to corner their niche social markets and made their way towards becoming household names. Twitter became an even more specialized sharing site for people to discuss politics, trends, and celebrity news.⁹⁴ Fitting a complete thought into a 140 character “tweet” became an art that everyone wanted to master.⁹⁵ Yelp became the platform for people to leave reviews on restaurants and other businesses.⁹⁶ And, of course, there is Google.

Google, along with many other less-remembered names like Yahoo, Bing, and AskJeeves, became an easily accessible way to answer any question.⁹⁷ Just type a question into the search bar, and the algorithm spits out the most relevant matches. But how did Google make money and surpass its competitors to be the one-stop shop for all of your questions? Google had to brand itself as the premium product in the search engine space.

How did Google accomplish this feat? It was not offering extensions or add-ons, or anything that would cost the consumer money. Google’s appeal during its early growth days was that it was free. Thus, Google took another route; it aimed to use the intimacy of social media to integrate itself into the

92. *See id.*

93. *See Number of Monthly Active Facebook Users Worldwide as of 4th Quarter 2017 (in millions)*, STATISTA (Mar. 18, 2018), <https://www.statista.com/statistics/264810/number-of-monthly-active-facebook-users-worldwide/> [<https://perma.cc/8A57-7MWD>].

94. *See* Elisa Shearer & Jeffrey Gottfried, *News Across Social Media Platforms in 2017*, PEW RES. CTR. (Sept. 7, 2017), <http://www.journalism.org/2017/09/07/news-use-across-social-media-platforms-2017/> [permalink needed].

95. *See* Courtney Seiter, *A Scientific Guide to Writing Great Tweets: How to Get More Clicks, Retweets and Reach*, HUFFINGTON POST (May 19, 2014), https://www.huffingtonpost.com/courtney-seiter/a-scientific-guide-to-wri_b_5331506.html [<https://perma.cc/XDN3-ZP8Z>].

96. *See* *Yelp*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Yelp> [<https://perma.cc/VE7J-UAQ4>] (last visited Dec. 21, 2018).

97. *See id.*

consumer's everyday lives and common vernacular. To do that, Google focused on language and verb use.

Through Google's social media branding, "I googled it" grew into a common phrase.⁹⁸ Over the course of the last decade, the term "google" has been added to every major dictionary.⁹⁹

Google's dominance has huge implications. Google is everywhere, partnering with companies and expanding their product line to include a variety of different kinds of products and services.¹⁰⁰ Google is a beast of a company in the modern age. Notably, Google, like Facebook, Twitter, and other technology companies, has become an essential part of our lives. The Google brand has spread to all aspects of the lives of the average consumer. It has entered the common vernacular of the world. But then how does society reconcile that with the doctrine of genericide? One needs to look at how people attempt to use the doctrine of genericide to stop Google's continued branding dominance, and how courts respond to those arguments.

With the rise of various technology companies, verbifying a mark has taken on a whole new meaning. Remember, the aim of the genericide doctrine in conjunction with trademark protection is to prevent businesses from monopolizing a name that defines a whole category of products.¹⁰¹ As a result, a company is discouraged from popularizing its name such that it defines all similar products on the market. However, the speed at which companies are made and destroyed in the age of technology has changed how companies think about the danger of verbifying a brand name—dominate the market now, worry about it later.¹⁰²

Brand verbification combined with advanced digital communication creates complexities for the genericide doctrine. When faced with those complexities, the Ninth Circuit attempted to make a strong statement in their decision in *Elliott v. Google*.¹⁰³

98. See Suzanne Choney, *No Googling, Says Google — Unless You Really Mean It*, NBC (Mar. 26, 2013), <https://www.nbcnews.com/technolog/no-googling-says-google-unless-you-really-mean-it-1C9078566> [<https://perma.cc/CJG5-HFFY>].

99. See *Google*, MERRIAM-WEBSTER DICTIONARY, *Google*, OXFORD LIVING DICTIONARIES.

100. See *List of Google Products*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_Google_products [<https://perma.cc/5ARM-XQZX>] (last visited Dec. 21, 2018).

101. See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 818 (1927).

102. See Cohen, *supra* note 82.

103. 860 F.3d 1151 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017).

III. *ELLIOTT V. GOOGLE*

The *Elliott v. Google, Inc.* case arose in 2014 when Chris Gillespie purchased 763 domain names that included the term “google.”¹⁰⁴ Google filed a complaint with the National Arbitration Forum.¹⁰⁵ Subsequently, plaintiff David Elliott claimed, and plaintiff Gillespie joined later, that Google’s mark qualified for genericide as the term “google” had become universally tied to the act of searching the Internet.¹⁰⁶ Plaintiffs claimed that Google violated the Lanham Act, specifically § 1064(3), and petitioned for cancellation of Google’s trademarks.¹⁰⁷

Plaintiffs’ main arguments were that (1) a majority of the relevant public uses the word “google” as a verb—for example, “I googled it,” and (2) verb use constitutes generic use as a matter of law.¹⁰⁸ Google claimed that verb use did not automatically trigger genericide and that plaintiffs had failed to bring any triable issue of fact.¹⁰⁹ The district court agreed, and granted summary judgment in favor of Google.¹¹⁰ Notably, the district court also relied on a Teflon-type survey that showed 94% of participants identified “google” as a brand name, not a “common name.”¹¹¹

On appeal, plaintiffs raised two main issues.¹¹² First, they claimed that the district court failed to note the importance of verb use when determining the generic nature of a mark.¹¹³ Second, they argued that the district court impermissibly weighed the evidence when it granted summary judgment for Google.¹¹⁴

The Ninth Circuit affirmed the district court’s decision.¹¹⁵ On the first issue of verb use, the court countered plaintiffs’ claim in two ways.¹¹⁶ First, the court emphasized that according to its reading of the Lanham Act, a claim of genericide had to be linked to a particular good or service.¹¹⁷ Second, and more

104. *See id.* at 1154.

105. *See id.*

106. *See id.*

107. *See id.* at 1155, 15 U.S.C. § 1064(3) (2012).

108. *Elliott*, 860 F.3d at 1155.

109. *See id.*

110. *See id.*

111. *Elliott v. Google Inc.*, 45 F. Supp. 3d 1156, 1167 (D. Ariz. 2014).

112. *See Elliott*, 860 F.3d at 1155.

113. *See id.*

114. *See id.*

115. *See id.*

116. *See id.*

117. *See id.* at 1156.

importantly for this Note's purposes, the court found that verb use does not automatically constitute genericness.¹¹⁸

The Ninth Circuit's decision relied heavily on the holding in *Coca-Cola Co. v. Overland, Inc.*¹¹⁹ The court in *Overland* noted that Overland could not accurately testify as to "what . . . customers [were] thinking" when they used the term "coke" to order a soda, or whether they had a particular source in mind.¹²⁰ Simultaneously, customers still knew that Coca-Cola itself was a brand.¹²¹ The court subsequently upheld the protection of the Coca-Cola trademarks.¹²² Similarly, the *Elliott* court noted that someone using the term "google" as a verb for searching the Internet did not reveal which search engine they were planning on using to perform that search.¹²³ This argument, the court noted, implicitly rejected plaintiffs' argument that verb use automatically constituted a generic mark.¹²⁴

Plaintiffs' second grounds for appeal concerned the district court's alleged error in overlooking the "sheer quantity" of evidence they presented that highlighted the generic nature of the term "google."¹²⁵ Plaintiffs relied on expert testimony, dictionary entries, and a Teflon-style survey, all of which, they claimed, showed how the public refers to searching the Internet by using the term "google."¹²⁶ When analyzing this evidence, however, both the district court and the Ninth Circuit weighed the consumer surveys provided by Google on the interpretation of their brand as stronger evidence highlighting non-genericide.¹²⁷

In a concurring opinion, Judge Watford wrote that while he agreed with the holding of summary judgment, he could not say that a reasonable jury should be foreclosed from analyzing the way the relevant public uses the mark in determining that mark's genericness.¹²⁸ Judge Watford declined to join the majority opinion to the extent that it could possibly be read as foreclosing the consideration of such evidence as a matter of law.¹²⁹ The Supreme Court denied the petition for a writ of certiorari.¹³⁰

118. *See id.* at 1157.

119. *See id.*

120. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1255 (9th Cir. 1982).

121. *See id.*

122. *See id.* at 1252.

123. *Elliott*, 860 F.3d 1158.

124. *See id.*

125. *Id.* at 1159.

126. *See id.*

127. *See id.* at 1160; *Elliott v. Google Inc.*, 45 F. Supp. 3d 1156, 1167 (D. Ariz. 2014).

128. *See Elliott*, 860 F.3d at 1164 (Watford, J., concurring).

129. *See id.*

130. *See Elliott v. Google Inc.*, 138 S. Ct. 362 (2017).

With the Court ruling at the summary judgement stage, the *Elliott* decision essentially turns on the holding that verb use does not automatically constitute genericness.¹³¹ Verb usage of the term “google,” according to the Ninth Circuit, did not even bring up a question of material fact.¹³² This aggressive holding raises potential problems that courts of the future will likely have to deal with.

IV. PROBLEMS AFTER *ELLIOTT*

The *Elliott* decision raises a unique concern for the future of genericide. The doctrine, as interpreted in *Elliott*, grants trademark owners considerable leeway in developing branding strategies. In the past, as discussed, brands have encouraged the public to use their marks only in identifying their specific products for fear of losing their mark protection to genericide.¹³³ *Elliott* opens the door for companies to intentionally *create* common parlance surrounding their mark. While this new goal technically aligns with the statutory language in the Lanham Act, the consideration of why trademark protection exists reveals that this new incentive is inconsistent with the Act’s purpose.

A. TRADEMARK SOLELY AS A PROPERTY RIGHT

If mark protection is viewed solely as a means to protect consumers from confusion, as described in the Lanham Act,¹³⁴ there may be little justification for the *Elliott* court’s protection of benefits derived from integrating a mark into the everyday vernacular. However, viewing trademark protection as a simple property right or protection of the investment made in a brand may weigh more heavily in favor of protecting against genericide.

This property right justification has been used in previous genericness cases. The premier example is *Quality Inns Int’l, Inc. v. McDonald’s Corp.*¹³⁵ In 1987, Quality Inns started a new chain of hotels under the name “McSleep Inn.”¹³⁶ McDonald’s responded immediately with a cease and desist letter, which Quality Inn followed with a declaratory judgment suit.¹³⁷ One of Quality Inn’s main arguments was that the term “Mc” as a prefix had become generic and had entered the English language with a recognized meaning of its own.¹³⁸

131. *See Elliott*, 860 F.3d at 1155.

132. *See id.*

133. *See* Velcro Companies, *supra* note 1; RADHAKRISHNAN, *supra* note 78, at 129.

134. *See* 15 U.S.C. § 1064(3) (2012).

135. 695 F. Supp. 198 (D. Md. 1988).

136. *Id.* at 201.

137. *See id.*

138. *See id.* at 202.

Both sides brought in various expert witnesses to either corroborate or dispute this claim of genericness through research and surveys.¹³⁹

On the genericness of “Mc,” the court held that McDonald’s had the right to use the prefix “Mc” in conjunction with a generic word.¹⁴⁰ Evidence showed that each word with “Mc” as a prefix was associated with McDonald’s, whether positively or negatively.¹⁴¹ The court thus supported the McDonald’s branding strategy of using the term “Mc” to increase brand recognition. The court felt that it would be unfair to penalize the work McDonald’s had done and rejected any contention that McDonald’s had lost its right to enforce its marks.¹⁴²

The *Quality Inns* decision’s reasoning can explain *Elliott*. The plaintiffs in *Elliott* presented expert testimony and survey evidence that a majority of the relevant consumers viewed “google” as a generic term for searching the Internet.¹⁴³ The plaintiffs asserted that the fact that “google” can and is used as an indiscriminate verb for searching the Internet indicated that the term was generic under the Lanham Act. However, the court in *Elliott*, like the court in *Quality Inns*, gave weight to Google’s masterful branding.¹⁴⁴ These cases point toward trademark protection as a means to incentivize companies to protect their brand, rather than to protect customers from confusion.¹⁴⁵ Customer confusion, which the court hints at by acknowledging the Google survey evidence, is no longer a major concern when addressing superbrands with dedicated customer bases.¹⁴⁶

However, the court’s holding on indiscriminate verb usage in relation to genericide raises interesting questions for companies. Trademark owners, especially big conglomerates like Google, spend large sums of money to protect their brand.¹⁴⁷ As discussed, Xerox has waged an advertising campaign to urge their consumers not to use the term “xerox” generically.¹⁴⁸ Velcro’s recent video ad campaign shows similar behavior.¹⁴⁹ It is fair to assume that

139. *See id.* at 203–16.

140. *See id.* at 216.

141. *See id.*

142. *See id.*

143. *Elliott v. Google, Inc.*, 860 F.3d 1151, 1163 (9th Cir. 2017).

144. *See id.* at 1155; 695 F. Supp. at 216.

145. *See Elliott*, 860 F.3d at 1155; *Quality Inns*, 695 F. Supp. at 216.

146. *See Elliott*, 860 F.3d at 1155.

147. *See* Press Release, Hogan Lovells, U.S. and European Companies Spend Twice as Much of Their Trademark Budget on Enforcement Than Those in Asia (May 12, 2015), <https://www.hoganlovells.com/news/us-and-european-companies-spend-twice-as-much-of-their-trademark-budget-on-enforcement-than-those-in-asia> [https://perma.cc/5Y]X-W9F2].

148. *See* RADHAKRISHNAN, *supra* note 78, at 129.

149. *See* Velcro Companies, *supra* note 1.

these actions arise out of a fear that the mark may be used as either a noun or a verb, and thus trigger a genericide claim.

The court in *Elliott* lessened this fear by finding that indiscriminate use of a mark alone does not support genericide.¹⁵⁰ However, in his concurring opinion, Judge Watford warned against reading the majority opinion to foreclose indiscriminate verb usage as evidence.¹⁵¹

The *Elliott* approach leaves companies like Google with a choice. Do they continue to follow the long-standing practices of protecting their mark through policing and consumer education? Or, if the rules of genericide are now relaxed, do they abandon their efforts to police verb usage? Only time will reveal how companies will react, and what the answer to this new dilemma is.

V. CONCLUSION

Typically, survey evidence has been one of the few consistent methods used by courts to help reveal what consumers think about different products, trademarks, and companies. But can these common survey questionnaires adapt and conform to the *Elliott* holding regarding indiscriminate verb use? By making a broad ruling, the Ninth Circuit has unnecessarily introduced new questions into the genericide doctrine.

The Court's decision on verb usage in *Elliott* was unnecessary. In holding for Google at summary judgment, the Court did not need to answer policy questions on verb usage regarding genericness.

With little statutory guidance, genericide is a doctrine that requires courts to make subjective judgments. Various forms of evidence have been found relevant to the genericness inquiry. This evidence all revolves around the question of how the relevant consumer interprets and understands the mark or brand. This type of abstract question is difficult to translate into a legal standard. The question is further complicated by the shifts in modern corporate branding. In a world where the brand is now the product, consumers have developed such loyalty to companies and brands that they are more tied to the image and lifestyle of the mark rather than the product with which it is associated. Courts need to have some contextual framework to deal with these changing methods and how they intersect with genericide. If no solid framework is created, the doctrine of genericide will eventually become obsolete. Unfortunately, the *Elliott* decision has substantially hindered the doctrine's advancement by answering a question that simply did not need to be answered. By unnecessarily ruling that verb use is not evidence of genericide, the Ninth Circuit sped along the demise of the genericide doctrine.

150. See *Elliott*, 860 F.3d at 1163.

151. See *id.* at 1163–64.

Although Velcro may have been acting conservatively when it released its anti-genericide video, it is very unlikely to do the same post-*Elliott*. *Elliott* made clear that the verbification of a brand is acceptable within the framework of the genericide doctrine. Courts now must question whether they can consider any evidence of a mark being used as a verb, or possibly a noun, in genericness cases. Companies will be incentivized to ignore the checks put into place by the genericide doctrine and push forward their brand in any way they can. With the Ninth Circuit's decision to foreclose verb usage as evidence, the doctrine will now need to overcome an additional roadblock to stay relevant in the age of the superbrands.