A Search by Any Other Name: Google, Genericism, and Primary Significance

Erica C. Hughes
American University Washington College of Law

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A SEARCH BY ANY OTHER NAME:
GOOGLE, GENERICISM, AND PRIMARY SIGNIFICANCE

ERICA C. HUGHES*

I. Introduction .................................................................................................................. 270
II. The Genericide Doctrine: Losing Your Mark to the Public Domain ................................................................. 272
   A. What Is a Trademark? .................................................................................................... 272
   B. The Lanham Act, the Inherently Distinctive Requirement, and the Development of the Genericide Doctrine .......... 273
   C. The Primary Significance Test: Secondary Meaning, the “Who-Are-You/What-Are-You” Test and the Elliott Decision .................................................................................................................. 275
   D. Headaches of Genericism: Booking.com and the Xerox Corporation ........................................................................... 279
III. The Elliott decision and its application to genericism and claims of genericide......................................................... 282
   A. Application of the Elliott decision: Genericism ............................................................ 282
      i. Dual Function and Verb Usage as It Relates to Genericness ....................................... 283
      ii. Evidence of Public Use Versus Evidence of Public Understanding .......................... 285
   B. Application of the Elliott decision: Genericide ........................................................... 288
      i. The Same Bottle of Aspirin: Xerox and Google ...................................................... 288

* Junior Staffer, American University Business Law Review; J.D. Candidate, American University Washington College of Law, 2019; B.A., Government and Politics, University of Maryland, 2014. To the American University Business Law Review Editorial Board, staff, and my Note and Comment Editor, Conor Arpey: I owe you my gratitude for your insights and feedback throughout the writing and publication process. I would like to thank Professor Christine Haight Farley for introducing me to trademark law and her invaluable guidance on this topic. I also want to thank my incredible family and friends for their unwavering love, support, and encouragement.
I. INTRODUCTION

“When you use ‘xerox’ the way you use ‘aspirin,’ the advertisement reads, ‘we get a headache.’”\(^1\) Much like the Xerox Corporation, Google has sustained quite the headache over the years due to threats of genericide.\(^2\)

Genericide is a phenomenon in which a business can lose trademark protection of its otherwise incontestable mark.\(^3\) A trademark is a symbol used in the marketplace that identifies a distinct source of goods or services.\(^4\) Google is a well-known trademark, but dictionaries often define the word “google” as a verb, meaning to search something online.\(^5\) In addition, the word “google” was frequently used as a verb in both casual conversation and in the media.\(^6\) Moreover, as one of the most valuable brands, Google\(^7\) has

\(^1\) See Timothy J. Lockhart, Did You Know . . . There’s a Trademark Graveyard?, INTABULL. (Dec. 15, 2008), http://www.inta.org/INTABulletin/Pages/DidYouKnowTheresaTrademarkGraveyard.aspx (describing Xerox Corporation’s advertising campaign to combat genericide and alluding to the loss of trademark protection for the mark “aspirin” due to genericide).


\(^3\) See 1 JEROME GILSON & ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 2.02 (2017) (defining genericide as the evolution of a trademark’s meaning from a single source of products to a word of the product itself).

\(^4\) See What Is Trade-Mark, L. DICTIONARY, http://thelawdictionary.org/trademark/ (last visited Jan. 23, 2018) (defining a trademark as “[a] distinctive mark, motto, device, or emblem, which a manufacturer stamps, prints, or otherwise affixes to the goods he produces, so that they may be identified in the market, and their origin be vouched for.”).

\(^5\) See Jacob Gershman, Yes, ‘Google’ Is Used As a Verb, But It’s Still a Trademark, Court Says, WALL ST. J. (May 16, 2017, 7:07 PM), https://www.wsj.com/articles/no-googling-on-bing-search-leader-avoids-genericide-in-trademark-case-1494976044 (listing ways that the trademark “Google” is used as a generic verb “to search for something online”).

\(^6\) Id.

good reason to be concerned. With a brand worth $109.4 billion, it is no wonder that Google needs an aspirin or two.

However, both Google and the Xerox Corporation now have another form of relief. The U.S. Court of Appeals for the Ninth Circuit ruled in Elliott v. Google, Inc., that the Google trademark did not fall prey to genericide because (1) the claim of genericide did not relate to a good or service and (2) Google’s verb usage does not automatically constitute a generic use. The Ninth Circuit’s holding contrasts with the traditional tenet of genericism avoidance: do not use the trademark as a noun or verb. The protection of the Google trademark, despite the mark’s generic verb usage, is significant.

On October 16, 2017, the United States Supreme Court denied the plaintiff’s petition for certiorari, which asked the Court to consider whether the test for primary significance is the Ninth Circuit’s “majority understanding” test or the “majority usage” test utilized by the U.S. Court of Appeals for the Second Circuit.

This Comment will analyze the effect of the Elliott decision on the phenomenon of genericide and generic trademarks. Part II will discuss the Lanham Act, the inherent distinctiveness of trademarks, and the cancellation of trademarks. It will also discuss the Elliott holding and the Ninth Circuit’s variation of the primary significance test. Part III will apply the Ninth Circuit’s reasoning in Elliott to both the Xerox Corporation trademark as it

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9. See Rath, supra note 7 (ranking Google as the most valuable brand in the world).
10. See Elliott v. Google, Inc., 860 F.3d 1151, 1163 (9th Cir. 2017) (exemplifying that Google’s trademark was challenged on the basis of genericide).
11. Id.
12. Id. at 1156.
13. See Gilson & Lalonde, supra note 3, § 2.02(b) (including “do not use the trademark as a noun or a verb” in a checklist for preventing loss of distinctiveness).
15. See Elliott, 860 F.3d 1154, cert. denied, 138 S.Ct. 362 (2017) (presenting the two genericide questions and one evidence question to the U.S. Supreme Court).
II. THE GENERICIDE DOCTRINE: LOSING YOUR MARK TO THE PUBLIC DOMAIN

A. What Is a Trademark?

A trademark is a term, symbol, object, or a sensation that is legally protected if it is connected to a unique source of a good or service and distinguishes that source from other sources.17 Trademark protection is a particularly important property right because it authenticates the quality of a product or service from a particular source and makes it easier for consumers to decide which good or service they want to use.18 Without this protection, the public would be vulnerable to both confusion and deception in the economy.19 The Lanham Act was enacted in 1946 to regulate and protect trademarks for the purpose of promoting competition, clarity, and fostering the goodwill of businesses in the marketplace.20 The Act defines the word “trademark” as any word, symbol, or device that is used or is intended to be used, in commerce, to distinguish goods and indicate the source of the goods.21

As the language in the statute indicates, trademark protection requires a

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17. See GILSON & LALONDE, supra note 3, § 1.02 (noting the Lanham Act definition is consistent with definitions under federal law and at common law before the Lanham Act was adopted).
18. See id. § 1.03 (explaining that trademarks communicate quality of goods, good will or function as an advertising until it has an association with a particular source).
19. See id. (stating that trademarks assure consumers that what they bought from the source before will be the same product or of the same quality when they go back to purchase more).
20. See Park ‘n Fly v. Dollar Park & Fly, 469 U.S. 189, 198 (1984) (explaining Congress’ conclusion that national trademark protection is important); see also GILSON & LALONDE, supra note 3, § 1.02 (stating that the adoption of the Lanham Act brought precise definitions to basic trademark law that decreased uncertainty in interpreting the law).
21. 15 U.S.C. § 1127 (2012); see also GILSON & LALONDE, supra note 3, § 1.02 (noting that the statutory definition of trademark is “virtually limitless,” as suggested by the word “includes” in the direct quotation of the trademark definition in the Lanham Act).
single source be tied to a good by consumers, in order to distinguish the goods.\textsuperscript{22} Therefore, to be eligible for protection under the Lanham Act, a trademark must be distinctive.\textsuperscript{23} A trademark can either be inherently distinctive or it may acquire distinctiveness through secondary meaning.\textsuperscript{24}

\subsection*{B. The Lanham Act, the Inherently Distinctive Requirement, and the Development of the Genericide Doctrine}

There are four categories of distinctiveness: "(1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful."\textsuperscript{25} A generic mark refers to a category where the good belongs.\textsuperscript{26} An example of a generic mark is a "Ping-Pong Paddle" for a brand that sells ping-pong paddles.\textsuperscript{27} Conversely, a descriptive mark can only be protected through evidence of the distinctiveness of the applicant’s goods.\textsuperscript{28} An example of a descriptive mark is "American Ping-Pong Paddle" because the mark describes the particular ping-pong paddle brand as being American.\textsuperscript{29} A suggestive mark is a protectable mark that requires imagination to reach a conclusion about its source.\textsuperscript{30} Arbitrary and fanciful marks are afforded the strongest protection.\textsuperscript{31} Arbitrary marks are common words attached in an unfamiliar

\footnotesize{\textsuperscript{22} See 15 U.S.C. § 1052 (stating that a mark that distinguishes its goods from other sources will be given trademark registration).


\textsuperscript{24} See id. at 459 (citing Steven Wilf, \textit{Who Authors Trademarks?}, 17 CARDOZO ARTS & ENT. L.J. 1, 33 (1999)) (defining secondary meaning (also referred to as acquired distinctiveness) as “the public’s association of a once independent word or symbol with a product that transforms the word of symbol into a distinctive mark”).

\textsuperscript{25} See Abercrombie, 537 F.2d at 9 (describing the four categories of distinctiveness); see also GILSON & LALONDE, supra note 3, § 2.01 (laying out the four categories on the trademark distinctiveness spectrum that were originally articulated by Judge Friendly in Abercrombie & Fitch Co).

\textsuperscript{26} See id. ("[O]ne that refers, or has come to be understood as referring, to the genus of which the particular product is a species.”).

\textsuperscript{27} See Mangis, \textit{supra} note 23, at 458.

\textsuperscript{28} See Abercrombie, 537 F.2d at 10; see also Mangis, \textit{supra} note 23, at 459 (noting that, unlike a generic mark, a descriptive mark can gain distinctiveness through secondary meaning).

\textsuperscript{29} Mangis, \textit{supra} note 23, at 459.

\textsuperscript{30} Abercrombie, 537 F.2d at 11; see also Jake Linford, \textit{The False Dichotomy Between Suggestive and Descriptive Trademarks}, 76 OHIO ST. L.J. 1367, 1371 (2015) (explaining that according to trademark doctrine, a suggestive mark is “inherently distinctive because there is a weak connection between” the source and the good).

\textsuperscript{31} Abercrombie, 537 F.2d at 11.
Fanciful marks are words that were solely invented for their use as trademarks. The Lanham Act allows for a mark’s cancellation if the mark “becomes the generic name for the goods or services . . . for which it is registered.” Even if a secondary meaning is proven for the newly generic mark, it is still not enough to make that mark protectable. When the public primarily understands a former trademark as the name of a good and not the source of a good, genericide occurs.

Historically, genericide cases have primarily turned on whether the mark passed into the public domain. Courts analyzed evidence of (1) alternative generic terms for the mark; (2) what the mark meant to the public; and (3) evidence of generic and descriptive use without any indication of the good’s origin. Even when companies try to reclaim marks from the public domain, courts hold that the mark is generic. When a company in one case used their trademark to describe their product, rather than just indicate its source, the mark fell victim to genericide. In addition, a company’s failure to police its own mark is taken into account.

32. Id. at n.12; see also Linford, supra note 30, at 1376 (using as an example for an arbitrary mark the registered trademark “Apple” for computers).
33. Abercrombie, 537 F.2d at n.12; see also Linford, supra note 30, at 1376 (giving the registered trademark “Xerox” for photocopiers as an example of an arbitrary mark).
35. Abercrombie, 537 F.2d at 9; see also Linford, supra note 30, at 1378 (stating that courts and scholars presume a mark that is used as the name of a product cannot serve as a signifying mark, even public sees the term as a trademark).
36. See, e.g., Elliott v. Google, Inc., 860 F.3d 1151, 1156 (9th Cir. 2017) (citing Bayer Co. v. United Drug Co., 272 F. 505, 512 (S.D.N.Y. 1921); Freecycle Network, Inc. v. Oey, 505 F.3d 898, 905 (9th Cir. 2007); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 81 (2d Cir. 1936).
39. DuPont Cellophane Co., 85 F.2d at 77.
40. Haughton Elevator Co., 85 U.S.P.Q (BNA) at 80.
41. See Bayer Co., 272 F. at 510 (holding that it was too late to reclaim the trademark “aspirin” once the public learned to know the trademark as the name of the drug).
42. See DuPont Cellophane Co., 85 F.2d at 78 (holding that the trademark “cellophane” was now generic because Plaintiff had used the mark as a descriptive term in advertising and was referred to in a generic sense in industry magazines).
43. See King-Seeley Thermos Co., 321 F.2d at 579 (stating that King-Seeley failed to police its trademark because it did not actively seek out generic use of “thermos” by non-trade publications).
C. The Primary Significance Test: Secondary Meaning, the "Who-Are-You/What-Are-You" Test and the Elliott Decision

Under the Lanham Act, the test for determining genericism is finding the primary significance of the mark to the public. The primary significance of a trademark is also used in the test for determining secondary meaning. A descriptive mark, which is not inherently distinctive, can acquire distinctiveness through secondary meaning and, thus, become a protectable trademark. The Supreme Court held "secondary meaning is acquired when in 'the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.'” In Kellogg Co. v. National Biscuit Co., the Supreme Court writes regarding section 43 in the Lanham Act “to establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”

The green-gold color trademark in Qualitex Co. v. Jacobson Products Co. developed secondary meaning because customers identified the green-gold color as the Plaintiff’s mark. Thus, the color identified the product’s source and was protected through acquired distinctiveness. Direct evidence of secondary meaning can include: (1) trial testimony; (2) affidavits; (3) survey and statistical data; and (4) unsolicited consumer response and testimonials. A variety of other factors, considered as indirect evidence, include: (1) extent or amount of advertising; (2) extent of sales of

44. See 15 U.S.C. § 1064(3) (2012) (“The primary significance of the registered mark to the relevant public [is] . . . the test for determining whether the registered mark has become . . . generic.”).


46. See id. (explaining that when a brand’s mark attains secondary meaning, the brand is distinguished a particular brand and indicates a source).

47. Id.; see also David E. Rigney, Annotation, Application of Secondary Meaning Test in Action for Trademark or Tradename Infringement Under § 43(a) of the Lanham Act (15 U.S.C.A. § 1125(a)), 86 A.L.R. Fed. 489 (1988) (“[I]t is not necessary that the public know who or what the source really is.”).

48. 305 U.S. 111, 118 (1938).

49. Id. at 118.

50. 514 U.S. at 166.

51. Id.

52. Id.

53. See Rigney, supra note 47, at 18 (listing types of direct evidence the courts have relied on to determine secondary meaning).
the product or service;\textsuperscript{54} (3) nature and extent of unsolicited media coverage that the product or service has received; (4) extent and nature of copying and third party use of the mark; and (5) length of use of the mark.\textsuperscript{55} The Court’s articulation of the primary significance test for secondary meaning of a trademark is instructive for the issues of genericide and genericness.\textsuperscript{56}

Circuit courts have developed multiple tests for analyzing the primary significance of a term.\textsuperscript{57} The tests can overlap with one another and some circuits use a combination of different tests.\textsuperscript{58} The U.S. Court of Appeals for the Third Circuit’s primary significance test will not initiate the test until it decides on the mark’s genus\textsuperscript{59} at issue.\textsuperscript{60} The U.S. Court of Appeals for the Sixth Circuit determines the genus of the product first and then establishes the primary significance of the term to the public when used for said genus of products.\textsuperscript{61} The U.S. Court of Appeals for the First Circuit states the primary significance to the relevant public is their ability to identify the nature of the good, not its source.\textsuperscript{62} The U.S. Court of Appeals for the Fourth

\textsuperscript{54} See id. (giving success or popularity of a product or service, and the nature of the sales as examples of showing “extent of sales of the product or service).

\textsuperscript{55} See id. at 19 (listing indirect evidence of secondary meaning that courts will consider in their determination of secondary meaning).

\textsuperscript{56} See Qualitex Co., 514 U.S. at 163 (quoting Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 851 (1982)) (“‘Secondary meaning’ is acquired when ‘in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.’”); Elliott v. Google, Inc., 860 F.3d 1151, 1156 (9th Cir. 2017) (stating that a term becomes generic when the primary significance of the mark to the public is the name for a particular good, regardless of its source).


\textsuperscript{58} See Gilson & Lalonde, supra note 3, § 2.02(6)(a) (describing how courts have used more specific language to determine whether a mark is generic).

\textsuperscript{59} See Genus, DICTONARY.COM, http://www.dictionary.com/browse/genus?s=t (last visited Feb. 9, 2018) (defining “genus” as a “class or group of individuals, or of species of individuals”).

\textsuperscript{60} See Gilson & Lalonde, supra note 3 § 2.02(6)(b) (describing different types of primary significance tests and highlighting a test that invokes genus-species language).

\textsuperscript{61} See Nartron Corp. v. STMicroelectronics, Inc., 305 F.3d 397, 404 (6th Cir. 2002) (quoting Blinded Veterans Ass’n v. Blinded Veterans Found., 872 F.2d 1035, 1041 (D.C. Cir. 1989)) (stating that the appropriate test for genericness is whether the relevant public perceives the term primarily as the designation of the article); see also Gilson & Lalonde, supra note 3 § 2.02(6)(e) (describing the Sixth Circuit test for genericness).

\textsuperscript{62} See Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 18 (1st Cir. 2008) (defining the legal standard of the genericism analysis as determining the primary significance of the mark to the relevant public); see also Gilson & Lalonde, supra note 3 § 2.02(6)(e) (describing the First Circuit test for genericness).
A SEARCH BY ANY OTHER NAME

Circuit’s test also stipulates that a generic term’s primary significance must indicate the class of the product or service to the relevant consuming public, not its source. The Second Circuit’s primary significance test involves a showing that the term is an indication of the nature of the article, rather than an indication of its origin. The Ninth Circuit articulated the “Who-Are-You/What-Are-You” test in *Official Airline Guides, Inc. v. Goss.* The court stated the test as follows: “A mark answers the buyer’s questions ‘Who are you? Where do you come from?’ ‘Who vouches for you?’ But the name of a product answers the question ‘What are you?’” If the type of product is described instead of the producer, the trademark is deemed generic.

In *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.,* the Ninth Circuit rejected a broad reading of *Surgicenters of America, Inc. v. Medical Dental Surgeries* and held that the combination of the two generic marks (in this case “Filipino” and “yellow pages”) did not automatically make the resulting combination generic. However, the court still found that the plaintiff’s trademark was generic or, in the most favorable reading of the evidence, was descriptive without secondary meaning. The court reasoned that if faced with the “What are you?” question under the test, the various Filipino directories would answer: “A Filipino yellow pages.”

63. *See* Glover v. Ampak, Inc., 74 F.3d 57, 59 (4th Cir. 1996) (holding that “[w]hen a trademark ceases to identify in the public’s mind the particular source of a product or service but rather identifies a class of product or service, regardless of source, that mark has become generic and is lost as an enforceable trademark”); *see also* GILSON & LALONDE, supra note 3 § 2.02(6)(e) (describing the Fourth Circuit test for genericness).

64. *See* King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 580 (2d Cir. 1963) (stating that to become generic, a mark must indicate the class of a good, not the origin of the good); GILSON & LALONDE, supra note 3 § 2.02(6)(e) (describing the Second Circuit test for genericness).

65. 6 F.3d 1385, 1391 (9th Cir. 1993).

66. *Id.* (quoting I J. MCCARTHY, TRADEMARKS & UNFAIR COMPETITION § 12.01 (3d ed. 1992); *see Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.,* 198 F.3d 1143, 1147 (illustrating a test to distinguish unprotectable generic marks that describe a class of good (answers “What-Are-You?”) and protectable marks that describe the producer of a good (answers “Who-Are-You?”)).

67. *See* Filipino Yellow Pages, 198 F.3d at 1147 (quoting Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., 611 F.2d 296, 304 (9th Cir. 1979)) (“[I]f the primary significance of the trademark is to describe the type of product rather than the producer, the trademark [is] a generic term and [cannot be] a valid trademark.”).

68. *Id.*

69. 601 F.2d 1011, 1020 (9th Cir. 1979) (holding that the mark “Surgicenter” was generic or descriptive without secondary meaning).

70. *Filipino Yellow Pages, 198 F.3d at 1148.*

71. *Id.* at 1151-52.

72. *Id.* at 1151.
In *Yellow Cab Co. v. Yellow Cab of Elk Grove, Inc.*, the Ninth Circuit held that the response to “what are you?” was expected to be “a taxicab company” or “a cab company.” Additionally, it was suggested that by asking to refer to the yellow cab company, a company was likely to point to a business operating under the name “Yellow Cab.” As a result, summary judgment was reversed because the “who-are-you?” question was a genuine issue of material fact.

In the *Elliott* case, the Ninth Circuit held that the lower court correctly applied the primary significance test. The plaintiffs acquired 763 domain names that included the word “google” and sought to cancel Google’s mark because it became a generic term for searching the Internet. The Ninth Circuit reasoned that without making a claim with regard to a particular type of good, arbitrary marks could not be protected. Without the connection to the particular good or service, an arbitrary mark for one product could be deemed generic because it is generic as applied to a completely different product.

The Ninth Circuit also rejected Elliott’s argument that verb usage automatically constituted genericism. The court affirmed the lower court’s articulation of indiscriminate verb usage and discriminate verb usage. Since the claim “must relate to a particular type of good,” the court held that

73. 419 F.3d 925 (9th Cir. 2005).
74. See id. at 929-30 (explaining that the question “Who-are-you?” was a question of fact and that summary judgment was improperly granted).
75. Id. at 929.
76. See id. at 929-30 (noting that the plaintiff provided evidence that there was a genuine issue of material fact as to whether “yellow cab” was generic or, in the alternative, descriptive without secondary meaning).
77. See Elliott v. Google, Inc., 860 F.3d 1151, 1163 (9th Cir. 2017) (“The district court did not misapply the primary significance test . . .”).
78. See id. at 1154-55 (stating the plaintiffs filed an action to cancel the “Google” trademark after the National Arbitration Forum (“NAF”) transferred the plaintiffs’ domain names to Google in 2012, after Google filed their lawsuit).
79. See id. at 1156-57 (holding that the Lanham Act requires a link between a claim of genericide and a particular good or service under the primary significance test).
80. See id. at 1157 (using “IVORY” as an example of a mark that could be cancelled because it is generic for tusks of elephants but arbitrary for soap).
81. See id. at 1157-58 (stating that Congress’s intent when amending the Lanham Act was to specify “that a speaker might use a trademark as the name for a product, i.e., as a noun, and yet use the mark with a particular source in mind, i.e., as a trademark”).
82. See id. at 1158 (defining indiscriminate verb usage as use of a mark with no particular source in mind and defining discriminate verb usage as use of a mark with a source in mind). The court further recognized that a consumer may use the word “google” with no particular search engine in mind (i.e., indiscriminate) or may use the trademark with the Google search engine in mind (i.e., discriminate). *Id.*
the assumption under which the public uses a mark in a generic and indiscriminate sense is irrelevant to determining how the public primarily understands the mark itself. Further, the court found Elliott’s evidence of indiscriminate verb usage by consumers, the media, and Google employees, to be insufficient.

D. Headaches of Genericism: Booking.com and the Xerox Corporation

The Elliott decision’s effect on genericness and genericide will be played out in the future. In Booking.com, the plaintiff company appealed the Trademark Trial and Appeal Board’s (“TTAB”) decision that their mark “Booking.com” is generic. The mark in this case was being used by a travel and accommodations site that offers travel and accommodations services. The plaintiff argued that the mark cannot be used in a grammatically coherent way to refer generically to anything. In other words, one cannot refer to something as a “Booking.com” or use “Booking.com” as a verb. The TTAB in Booking.com argued the mark’s use is irrelevant. On appeal, the court held that the mark “Booking.com” was descriptive with secondary meaning and, thus, was protectable. The court also noted that evidence indicating consumer use, such as referring to services as “booking.coms,” was relevant in its analysis.

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83. See id. at 1157-59 (stating that the Ninth Circuit has already rejected the theory that trademarks can only be used as adjectives).
84. See id. at 1161-62 (holding that the dictionary evidence only showing secondary definitions was insufficient for a finding of genericide and that there was an efficient alternative for the word “google” because the other internet search engine competitors do not call their searches a “google”).
85. See Goldman, supra note 14 (stating that the Elliott decision was a big win for trademark owners because the ruling makes genericide challenges more difficult).
86. See Kat Greene, Booking.com Demands Better Answers from USPTO, LAW360 (Sept. 6, 2016, 5:51 PM), https://www.law360.com/articles/836232 (summarizing Booking.com’s appeal of the TTAB’s decision).
87. Id.
89. See Greene, supra note 86.
92. Id. at *20.
The district court held that alone, the word “booking,” was generic for the classes of hotel and travel reservation services because competitors use the word “booking” to describe making a reservation. However, the mark at issue in this case was “Booking.com,” and not “booking.” As a result, the court analyzed the impact of the top level domain “.com” on the mark and determined that top level domains are source identifying. Additionally, a mark with a generic second level domain (e.g. “booking”) and a top level domain (e.g. “.com”) can be protected if it has acquired distinctiveness.

The court noted the absence of evidence of public use of the term “booking.com” and rejected the plaintiff’s argument, supported by a statement from the U.S. Court of Appeals for the Federal Circuit that use of a mark to determine genericness “is irrelevant.” In determining that “booking.com” is descriptive with secondary meaning, the court primarily relied on evidence that consumers understand the mark to be a brand. After analyzing the plaintiff’s survey, the court concluded that the defendants had not established that “Booking.com” is generic and that the mark is in fact descriptive. In addition, the court held the mark “Booking.com” is descriptive with secondary meaning after analyzing other surveys provided by the plaintiff, advertisements, sales, media coverage, length and exclusivity of use, and social media following.

The Xerox Corporation’s brand stands to be the most affected by the application of the Ninth Circuit’s primary significance test combined with its ruling on verb usage in genericism and genericide cases. The Xerox

93. Id. at *7.
94. Id. at *9.
95. Id. at *11 (stating that the court declines to rely on Federal Circuit precedent that “.com” has no source identifying significance and instead approaching the genericness of “.com” as an issue of first impression).
96. See id. at *16 (relying on the Federal Circuit’s statement in a case involving the denial of registration to “Mattress.com” and a genericness test).
97. Id. at *17-20, *22-23 (stating the survey indicated that 74.8% of consumers of online travel services recognize BOOKING.COM as a brand and dismissing the defendants’ arguments that (1) genericness inquiries are not relevant when the term was commonly used prior to being a mark; (2) “.com” marks should be tested without the “.com”; (3) that there are methodological flaws in the survey pertaining to the survey population, not accounting for the ability to distinguish “.com” common names and “.com” brand names and the order in which the marks were presented in the survey).
98. See id. (reproducing the tables used in the survey results, and discussing the defendants’ expert’s critiques).
99. See id. at *19 (“[T]he Court finds that the relevant consuming public primarily understands that BOOKING.COM does not refer to a genus, rather it is descriptive of services involving “booking” available at that domain name.”).
100. Id. at *20-23.
101. See Goldman, supra note 14 (stating that the Elliott decision is a win for “[b]ig
A SEARCH BY ANY OTHER NAME

trademark was in danger of becoming generic before the corporation ran an aggressive ad campaign to view the mark as a name that indicates the source of their products and services, not a name for the service itself.\textsuperscript{102} Despite the risk of becoming generic, Xerox has so far avoided genericide.\textsuperscript{103} There are several brands of photocopiers on the market: Hewlett Packard, Canon, Epson, Brother, Dell and, of course, Xerox.\textsuperscript{104} There are fifteen search results in a search for “Xerox” using Hewlett Packard’s search engine but all of the results use the mark to describe a product affiliated with the Xerox Corporation.\textsuperscript{105} In Canon’s “About Section” on their website, there is no mention of the mark “Xerox.”\textsuperscript{106} In the Canon’s website’s search engine, there are thirteen results for the term “Xerox” but all of the results refer to the company itself.\textsuperscript{107} Epson’s “About Section” does not use the mark “Xerox” and have no search results for the mark in its search engine.\textsuperscript{108} In Brother’s “About Section” there is no mention of the mark Xerox and no search results for the mark in the website’s search engine.\textsuperscript{109} Finally, Dell’s “About Page” does not mention the mark

\textsuperscript{102} See Gary H. Fechter & Elina Slavin, Practical Tips on Avoiding Genericide, INTABULL. (Nov. 15, 2011), https://www.inta.org/INTABulletin/Pages/PracticalTipsonAvoidingGenericide.aspx (explaining how companies use advertising to prevent the genericide of their trademarks).

\textsuperscript{103} See id.  (suggesting that because Xerox’s mark has not been deemed generic, it seems the ad campaign to combat genericide was successful).


\textsuperscript{106} Search Results for Xerox, CANON GLOB., http://search.global.canon/en_all/search.x?q=xerox&ie=utf8&cat=0&pagemax=10&imgsize=3&pdf=ok&zoom=0&sort=0&actor=0&lfor=0&ref=search.global.canon&pid=ZRsqlrjuo2aBqsSxxGsM5TQ..&qid=Oei31Wq98raDXToh9ls0Xm9EgJ0j2D&page=1 (last visited Feb. 9, 2018) (input “xerox” into website’s search engine).


Xerox and its search results page only referred to Xerox as a brand. The Elliott decision and the “Who-Are-You/What-Are-You” test gives both Booking.com and Xerox a stronger defense against claims of genericness. The application of the Ninth Circuit’s reasoning to the foregoing facts show a better and more efficient way to analyzing genericness than the test articulated by the plaintiffs in Elliott.

III. THE ELLIOTT DECISION AND ITS APPLICATION TO GENERICISM AND CLAIMS OF GENERICIDE.

A. Application of the Elliott decision: Genericism

The Elliott decision is correct in ruling the use of a trademark as a noun or as a verb is not relevant to the primary significance analysis. By focusing on the public’s understanding of the trademark, rather than the public’s use of the mark, the test of genericness becomes more straightforward. The Ninth Circuit’s “Who-Are-You/What-Are-You” test primarily focuses on the public’s understanding of the trademark and is an efficient way of analyzing issues of genericness and genericide. This straightforward approach is supported by the notion that a trademark can serve the dual function of naming a product and simultaneously indicating its source. With the application of the Elliott decision, the question of genericness and genericide has turned in the favor of trademark owners.


110. See Goldman, supra note 14 (suggesting that the Elliott decision was a “[b]ig [w]in” for trademark owners with big brands).

111. See infra notes 148-159, 189-198 and accompanying text.

112. See id. (holding that the lower court did not misapply the primary significance test by not recognizing the alleged importance of verb use).

113. See Yellow Cab Co. v. Yellow Cab of Elk Grove, Inc., 419 F.3d 925, 929 (9th Cir. 2005) (articulating the “Who-Are-You/What-Are-You” analysis); Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc., 198 F.3d 1143, 1147 (9th Cir. 1999).

114. See Elliott, 860 F.3d at 1158 (quoting Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1255 (9th Cir. 1982)) (stating that the court has already noted that “the mere fact that consumers order ‘a coke,’ i.e., used the mark as a noun, failed to show ‘what . . . customers [were] thinking,’ or whether they had a particular source in mind”).

115. See Goldman, supra note 14 (suggesting that the Elliott decision was a “[b]ig [w]in” for trademark owners with big brands).
i. Dual Function and Verb Usage as It Relates to Genericness

In Elliott, the district court quotes an amendment to the Lanham Act stating a trademark can serve the dual function of both naming a product while also indicating its source. The court’s use of this explanation supports its ruling that irrelevance of verb usage can extend to noun usage. Further, the court acknowledged indiscriminate and discriminate verb use of “google” in the same sense that a consumer could use the word “coke.” If the treatment of verb usage and noun usage are the same, the inability to use the mark “Booking.com” to refer to something generically and in a grammatically coherent way has significantly less weight in the analysis of genericism. Consequently, if the primary significance test were one of majority usage rather than majority understanding, the analysis of genericism for this mark would be less efficient because the mark cannot be used in a grammatically coherent way. Subsequently, evidence that a majority of the public uses “google” in a generic way is not only insufficient to support a finding of genericism, but it says very little about the subject matter at all.

The Ninth Circuit holds that even if there were an assumption that the word could be used, and is used, in a generic and indiscriminate sense, it would say nothing about the public understanding, which is an assertion that is mentioned in the Booking.com complaint. While the appeal does not

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118. See Elliott, 860 F.3d at 1158 (quoting S. REP. No. 98-627, at 5 (1984)) (“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.”).

119. See id. (stating that Congress’ acknowledgement of the dual function has instructed the court that a consumer could use a trademark as a noun and still use the trademark to identify the source).

120. Id. at 1159 (citing Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250 (9th Cir. 1982)).

121. See Complaint, supra note 88, ¶ 38 (stating that it is impossible to generically use the mark “Booking.com” in a grammatically coherent way).

122. See id. ¶ 55 (addressing the fact that the Trademark Trial and Appeal Board found the mark Booking.com was impossible to use in a grammatically coherent way to refer generically to anything).

123. See id. (explaining that the Trademark Trial and Appeal Board instead broke the mark “Booking.com” into pieces and speculated about the meanings of the component pieces and how the consumers understood the meanings in order to determine whether the mark would be generic, as opposed to trying to figure out how the mark could be “used” generically).

124. See Elliott, 860 F.3d at 1158 (“If Elliott were correct that a trademark can only perform its source-identifying function when it is used as an adjective, then we would
deal with genericide directly, the Ninth Circuit decision may be applied to
determine whether the mark is generic. Booking.com differs in that the
mark in question involves a gerund and a verb, not a noun like “google.”
In addition, the Booking.com mark includes a generic mark (“Booking”) and
a top level domain (“.com”). But it follows that if the evidence of
grammatical generic use of the word does not indicate how the public
primarily understands the word, the lack of ability to grammatically use the
mark generically does not indicate how the public primarily understands the
word.

The application of the Elliott decision, therefore, changes Booking.com’s argument against genericism because the TTAB does not
need to address the inability to grammatically use the mark in a generic
way. Without the weight of grammatical generiness, a finding of
genericism rests on the literal application of the “Who-Are-You/What-Are-
You” formulation, and not an apparent lack of genericism because the mark
cannot be used grammatically in such a way.

The uniqueness behind trademarks of domain name registrations is
mentioned in the Booking.com complaint. The plaintiff company
established the uniqueness of combining two generic terms “Booking” and
“.com” to create a mark that, by definition cannot be used to signify another
source because it is a URL. One of the major differences between the
circumstances in the Elliott decision and prior genericism cases is that the
claim of genericism came as a result of a domain name registration
dispute. This difference is fundamental in that the Google mark, an internet-based trademark, and its domain name indicates a single source associated with the mark. For example, the mark “VITAMINS.COM,” as a URL, will uniquely distinguish a single website location that no other third party can link to with a different mark. Thus, by definition, the mark is inherently distinctive and perhaps should not be considered generic. However, the policy of making any domain name, even generic ones, a protected trademark can be problematic because it would monopolize necessary generic terms needed to describe products or services. Consumers could also still not tell from a purely generic second level domain, what website it will ultimately lead to. In other words, if the mark cannot be used in a generic way, then the majority usage test is unhelpful for determining genericism and the primary significance test must then be based on majority understanding. If the primary significance test is based on a majority understanding, then the issue of application of genericness for a mark that cannot be used in a logically generic way, would not come up at all.

ii. Evidence of Public Use Versus Evidence of Public Understanding

The evidence of the public using the mark “Booking.com” as a way to refer to a class of services is irrelevant because it cannot be applied to the mark due to its grammatical nature. Furthermore, the District Court for the Eastern District of Virginia could have reached the same holding without considering this evidence. As Elliott explains, Congress indicates in its

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133. Elliott, 860 F.3d at 1151.
134. See Sarah E. Akhtar & Robert C. Cumbow, Why Domain Names Are Not Generic: An Analysis of Why Domain Names Incorporating Generic Terms are Entitled to Trademark Protection, 1 CHI.-KENT J. INTELL. PROP. 226, 227 (1999) (defining domain names as “ordinary words, letters, or numbers that signify the location of a Web site on the Internet, such as drugstore.com. Domain names are easily recognizable and, therefore, powerful”).
135. Id.
136. Id.
137. Id. at 241 (explaining that it “would be against public policy to allow a trademark owner to assert dilution claims against every domain name registrant whose domain name comprised part of a trademark that consisted of a generic [second level domain]”).
138. See id. at 228 (stating that the mark “DRUGSTORE.COM” is arguably generic because no consumer can identify a source looking solely at the second level domain mark “DRUGSTORE”).
139. Elliott, 860 F.3d at 1159; Complaint supra note 88, ¶ 38.
140. Complaint supra note 88, ¶ 38.
141. Id.
142. See Booking.com B.V. v. Matal, No. 1:16-cv-425 (LMB/IDD), 2017 WL
amendment to the Lanham Act that a trademark can serve a dual function in that it can be used grammatically as a noun or verb, and serve a source-identifying function. The TTAB’s argument in Booking.com is similar to the conclusion reached in Elliott. The evidence regarding the use of the mark “Booking.com” was in fact irrelevant. The district court primarily focused on the plaintiff’s evidence that the public understands the trademark in question to be a specific brand. While the court did analyze the public’s use of the mark, the deciding factor in the mark’s protectability was ultimately the evidence of public understanding, not use. The court relied heavily on the plaintiff’s survey, proving that the public understood the mark as a specific brand and not a generic name for online booking services. Despite the court’s statement that evidence of use is highly relevant to the analysis, it relied heavily on the survey evidence that pointed directly to the public’s understanding of the mark rather than how the public used the mark.

In addition, the plaintiffs in Elliott assert that their usage argument is supported by their understanding that verbs cannot indicate the source of a good or service. The plaintiffs in Elliott argue that verbs cannot indicate the source of a good or service because it describes an action. The

3425167, at *19-20 (E.D. Va. Aug. 9, 2017) (stating that the absence of evidence of consumer usage of the mark “Booking.com” to refer to a class of services is “highly relevant”).

143. Elliott, 860 F.3d at 1158.

144. See id. at 1161 (stating that even with a favorable inference that the majority of the public uses the verb “google” to refer to generically searching the internet, it cannot support a finding of genericide).

145. See Booking.com, 2017 WL 3425167, at *19 (declining the invitation to rely on theoretical and indirect sources of consumer understanding over direct and persuasive evidence in a survey that shows how the consuming public understands the mark as a brand).

146. See id.

147. Id.

148. See id. at *17 (quoting 2 McCarthy on Trademarks § 12:16) (describing the Plaintiff’s Teflon survey, a survey from a source that are the “most widely used format to resolve a genericness challenge”).

149. Id. at *20 (emphasis added) (“Because plaintiff’s Teflon survey is the only evidence . . . speak[ing] directly to how consumers understand plaintiff’s mark, it weighs heavily in the secondary meaning analysis and the survey . . . indicates strong brand awareness.”).

150. See Elliott v. Google, Inc., 860 F.3d 1151 (9th Cir. 2017), petition for cert. filed, 2017 WL 3601395, at *9 (U.S. Aug. 14, 2017) (No. 17-258) (“The Ninth Circuit’s first holding is illogical because verbs cannot indicate the source of a good or a service. A verb describes an action. It does not identify the item which must be used to perform that action, let alone that item’s producer.”).

151. Id.
plaintiffs also argue that a verb cannot possibly identify either an item or a source.\textsuperscript{152} If this were the case, then clear and direct evidence that the public understands the trademark in question as source indicating would be disregarded.\textsuperscript{153} Rejecting evidence of actual primary significance to the public in favor of a use based doctrine, runs contrary to the language set forth in the Lanham Act.\textsuperscript{154} There is no preferential treatment for the use of the mark in the Lanham Act as an indicator of true primary significance.\textsuperscript{155} Further, the meaning of the phrase “primary significance” does not suggest use.\textsuperscript{156} Thirdly, Congress states that a trademark can in fact have dual function and be used as grammatically as a noun or verb and be used in a source-identifying sense.\textsuperscript{157} Finally, the Court’s articulation of the primary significance test as it relates to secondary meaning suggests that primary significance is mental process, not mere usage.\textsuperscript{158} The Court states “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”\textsuperscript{159} The phrase “in the minds” is more compatible with the “Who-Are-You/What-Are-You” test because it deals with majority understanding.\textsuperscript{160} Disregarding evidence of actual majority understanding in favor of majority usage conflicts with the primary significance language used by both Congress and the Supreme Court.\textsuperscript{161}

Despite the irrelevance of the lack of grammatically generic uses for the mark “Booking.com” under the \textit{Elliott} decision, the strict application of the “Who-Are-You/What-Are-You” variation of the primary significance test

\begin{enumerate}
\item Id. \textsuperscript{152}
\item See \textit{Booking.com}, 2017 WL 3425167, at *23 (stating that a consumer survey statistician found the survey results indicating that 74.8\% of consumers recognize “Booking.com” as a brand name as strongly establishing that consumers do not perceived the mark as a generic or common name).
\item See 15 U.S.C. § 1064(3) (2012) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).
\item Id. \textsuperscript{155}
\item Id.; see also \textit{Significance}, MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/significance (last visited Feb. 9, 2018) (defining “significance” as either (1) “something that is conveyed as meaning often obscurely or indirectly;” (2) “the quality of conveying or implying;” (3) “the quality of being important” or (4) “the quality of being statistically significant”).
\item \textit{Elliott}, 860 F.3d at 1158 (quoting S. REP. No. 98-627, at 5 (1984)).
\item Id. (emphasis added) (quoting Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 851 n.11 (1982)).
\item See id.; \textit{Elliott}, 860 F.3d at 1158.
\item \textit{Qualitex Co.}, 514 U.S. at 163; 15 U.S.C. § 1064(3).
\end{enumerate}
will determine that the “Booking.com” mark is not generic.  

B. Application of the Elliott decision: Genericide

   i. The Same Bottle of Aspirin: Xerox and Google

   The Xerox Corporation’s trademark “Xerox” is often used as a verb, and the company has attempted to combat this by using advertising campaigns that discourage the use of the word “Xeroxing.” Under the Ninth Circuit ruling, the policing of verb usage is no longer necessary, so long as it passes the “What-Are-You/Who-Are-You” test. In order for the Xerox mark to become generic under the genericide doctrine, the claim must be made in regard to a particular type of good or service. 

   Xerox is similar to Google in that the indiscriminate verb usage of the mark is an act and not an actual good or service. The assumption in Elliott would be similar to that posed in a genericide case for Xerox. If there is an assumption that the public uses the verb “Xerox” in a generic and indiscriminate sense, it says nothing about how the consumers primarily understand the word, irrespective of its grammatical function. Congress’ explanation in its amendment to the Lanham Act downplays the importance of the grammatical use of the mark. If a trademark can be used as a verb or noun and still maintain its source indicating function, then evidence of the verb or noun use cannot be determinative in whether a mark is generic. Even if the product is unique and the trademark is eventually used to describe the product, it is not conclusive regarding the mark’s genericness.

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162. See Elliott, 860 F.3d at 1158.
163. See Lockhart, supra note 1 (describing techniques used to prevent genericide, including anti-genericide advertisements, creating a generic name for the branded good, and consistently using the word “brand” beside the mark).
164. See Elliott, 860 F.3d at 1155 (holding a consumer can use the trademark in either an indiscriminate sense, with no source in mind, or in a discriminate sense, with the brand of the product in name without subjecting the term to a finding of a genericide).
165. See id. (finding the framework for genericide is to determine whether the primary significance of the mark to the public is a generic name for the good or service in question).
166. See id. at 1158 (“[A]n internet user might use the verb ‘google’ in an indiscriminate sense . . . .”); Mike Hoban, Google This: What It Means When a Brand Becomes a Verb, FAST COMPANY (Jan. 18, 2013), https://www.fastcompany.com/3004901/google-what-it-means-when-brand-becomes-verb (describing an advertisement campaign asking consumers to not use the name “Xerox” as a verb).
167. Elliott, 860 F.3d at 1159.
168. Id.
169. Id. at 1158.
170. See id.
171. See id. (quoting S. REP. No. 98-627, at 5 (1984)) (“Admittedly, if a product is
Consequently, although the Xerox Corporation’s founders Joseph C. Wilson and Chester Carlson invented the photocopier and introduced this unique product to public consumers, it is still not conclusive to the mark’s genericness when the consumers began to use the word “Xerox” to refer to photocopiers.172 The Xerox Corporation and Google are similar in the sense that they are both corporations who were known for their new or relatively new technology.173 Both corporations had services dealing with technology that were conceptually new to the public, and the public tended to refer to these services with the affiliated marks “Xerox” and “Google.”174 Applying the explanation in the amended Lanham Act alone, shows that this is not enough to deem a trademark as generic.175

ii. Definition, Verb Usage, and the “Who-Are-You/What-Are-You” Test

In addition, similar to “google” mark, the dictionary defines “Xerox” as a the company’s trademark first: “a brand name for a copying machine for reproducing printed, written, or pictorial matter by xerography.”176 Its noun and verb meaning only serves as secondary definitions: (1) a copy made on a xerographic copying machine; and (2) to print or reproduce by xerography.177 The existence of these secondary definitions, under the Elliott decision, are irrelevant to the finding of genericide.178 These


174. See Elliott, 860 F.3d at 1155 (stating the plaintiffs’ claim that the relevant public use the word “google” to refer to search engines); The Story of Xerography, supra note 172 (describing story of the first xerographic machine); Our Story, supra note 173 (describing the creation of the popular search engine Google); Lockhart, supra note 1 (describing Xerox’s efforts to combat genericide through policing use of its mark as a generic verb).


176. See Xerox, DICTIONARY.COM, http://www.dictionary.com/browse/xerox?s=t (last visited Feb. 9, 2018) (defining Xerox as “a copy made on a xerographic copying machine,” or “to print or reproduce by xerography”).

177. Id.

178. See Elliott v. Google, Inc., 860 F.3d 1151, 1162 (9th Cir. 2017) (concluding that the dictionary evidence, which only has secondary definitions where google is defined as a verb, can only support the favorable inference already drawn by the court and does not support a finding of genericide on its own).
secondary definitions only support a favorable inference already drawn by the court: that the public uses the mark in an indiscriminate sense.\textsuperscript{179} The first definition is a better representation of how the public primarily sees the mark and is another route to the “Who-Are-You/What-Are-You” test.\textsuperscript{180}

The Ninth Circuit Court states that instead of presenting examples where “google” is primarily defined as a generic name for an Internet search engine, Elliott simply gave secondary definitions.\textsuperscript{181} It can be inferred from the court’s phrasing and language when discussing the dictionary evidence that the order of the definitions made a difference.\textsuperscript{182} If the first definition of the word google had in fact just been a grammatical generic use of the mark, it would serve as better evidence that the public primarily views the mark as generic term.\textsuperscript{183}

With the removal of the verb usage as evidence of genericide, the Xerox Corporation has a straightforward path to defeat genericide claims. Therefore, the Xerox brand is more like the company in \textit{Yellow Cab Co.}\textsuperscript{184}

None of the All-in-One printers\textsuperscript{185}, including Xerox, lists “Xerox” or “Xeroxing” in their product description of the machine’s functionality: universally, the word “copy” is used.\textsuperscript{186} In addition, none of the companies who create the printers mention the words “Xerox” or “Xeroxing” on their websites.\textsuperscript{187} In \textit{Filipino Yellow Pages}, when asked the question “What are

\begin{itemize}
  \item Id. (explaining that the lower court had assumed that the majority of the public used the mark google in an indiscriminate sense and, even with this assumption, the lower court found it could not support a finding of genericide).
  \item Id. (suggesting that the fact a trademark is primarily defined as a brand in a dictionary entry defeats the secondary entry that supports generic usage of the word).
  \item Id.
  \item See id. at 1161 (emphasis added) (“Elliott does not present any examples where ‘google’ is defined as a generic name for Internet search engines. Instead, Elliott presents secondary definitions where google is defined as a verb.”).
  \item See id.
  \item \textit{Yellow Cab Co. v. Yellow Cab of Elk Grove, Inc.}, 419 F.3d 925, 929 (9th Cir. 2005) (reversing summary judgment for a finding of genericness because there was an expectation that cab companies’ answers to the “Who-Are-You/What-Are-You” test would not be “Yellow Cab” which indicates the mark is seen as brand); \textit{All-In-One Printers, supra} note 104 (showing that All-in-One manufacturers do not use mention the word “xerox”, supporting the assertion that these companies would not identify as “Xerox companies”).
  \item \textit{All-In-One Printers, supra} note 104 (showing multiple brands of photocopiers on an office supply retailer website).
  \item Id.
\end{itemize}
you?” the three companies involved would answer “A Filipino yellow pages” because they all dealt with contact books, which are normally referred to as Yellow Pages, that listed Filipino businesses or contacts. Since other competitors responded to “what are you?” using “Filipino yellow pages,” the term was found to be generic. As evidenced by the product descriptions of various brand name photocopiers and by the websites of the competitions, it is unlikely that companies that sell photocopiers would answer “a Xerox company” to the question “what are you?” This makes the Xerox Corporation similar to the company in Yellow Cab Co, where the response to the “what are you?” question in that case was expected to be “a taxicab company” or “a cab company.” The case of Xerox, the response to “what are you?” would be expected to be along the lines of a “photocopier producer” or a “printer manufacturer.”

Finally, like in the Elliott case, there is an efficient alternative for the word “Xerox.” The alternative word can be found in the product descriptions of the various machines offered in the marketplace: printer, photocopier, or copier. Without a showing that there is no available substitute for the word Xerox, a finding of genericness cannot be made because, again, the “claim of genericide must relate to a particular type of good or service.” As evidenced by the product descriptions, there is in fact an efficient

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188. See Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc., 198 F.3d 1143, 1151 (9th Cir. 1999).
189. See id. (quoting Surgicenters of Am., Inc. v. Med. Dental Surgeries, 601 F.2d 1011 (9th Cir. 1979)) (“Giving [Filipino Yellow Pages (“FYP”)] exclusive rights to the term “Filipino Yellow Pages” might be inappropriate because it would effectively ‘grant [FYP as] owner of the mark a monopoly, since a competitor could not describe his goods as what they are.””).
190. See Yellow Cab Co. v. Yellow Cab of Elk Grove, Inc., 419 F.3d 925, 929-30 (9th Cir. 2005) (“Posing the question: “Could you refer me to a yellow cab company?” one would expect these same companies to point not to themselves, but to a business operating under the name “Yellow Cab.” “Yellow cab” thus appears to answer the “who are you?” rather than the “what are you?” question, demonstrating its nongenericness.”); All-In-One Printers, supra note 104.
191. See id. (“Posing the question: “Could you refer me to a yellow cab company?” one would expect these same companies to point not to themselves, but to a business operating under the name “Yellow Cab.””).
192. See id. (stating the exception of a taxicab company to not answer “what are you” with “a yellow cab company” appears to show that that “Yellow Cab” answers the “who are you” question, thus showing its non-genericness).
193. See Elliott v. Google, Inc., 860 F.3d 1151, 1162 (9th Cir. 2017) (citing TY Inc. v. Softbelly’s, Inc., 353 F.3d 528, 531 (7th Cir. 2003)) (noting that genericide usually does not occur until there are no efficient alternatives for the mark at issue, and that the word “internet search engine” is an efficient alternative to the mark google).
194. All-In-One Printers, supra note 104.
195. Elliott, 860 F.3d at 1162.
alternative.196 Additionally, like in the Elliott decision, not a single competitor calls its photocopier a “xeroxer.”197 Therefore, like Google, the Xerox Corporation’s mark is not generic.198 The fact that the public uses the word “Xerox” in an indiscriminate sense cannot support a finding that the term has become generic.199 A claim of genericide for the mark “Xerox” must relate to the type of good – a photocopier – and framing the issue as whether the public uses the mark as a noun or a verb is the incorrect analysis to determine genericide.200

IV. THE ELLIOTT DECISION, THE INTERNET ERA, AND GOOGLE’S PATH

The Elliott decision is a step towards significantly stronger rights for trademark owners everywhere.201 There are various implications for establishing stronger trademark rights in the Internet Era.

A. The Internet Era: Domain Name Registration and Genericism

Even if there are a number of policy concerns behind creating stronger trademark rights, the nature of the Internet calls for special adjustments in trademark law. Specifically, genericide in domain name registration disputes should involve a stricter primary significance test.202 As the Booking.com complaint mentions, a domain name trademark using two generic terms (i.e. “Booking” and “.com”) signifies a single source solely by

196. See id. (holding that because there is no evidence that a competitor describes themselves as “a google” and that the public recognizes the alternative word “internet search engine,” there is an efficient alternative to the mark “Google”); All-In-One Printers, supra note 104 (describing photocopying machines using verbs and nouns like “photocopying,” and “photocopiers,” as opposed to “xeroxing” or “Xerox machines,” in product descriptions).
197. See Elliott, 860 F.3d at 1162 (holding that because search engine competitors do not call their searches “googles” there is no showing that there is no available substitute for the word “google” as a generic term).
198. See id. at 1155.
199. See id. at 1158 (holding that neither indiscriminate or discriminate use of a trademark can support a finding of genericide).
200. See id. at 1157 (explaining that, because a majority of the evidence of generic use presented to the court at best support favorable inferences drawn by the court, this evidence is irrelevant in determining the genericide of a trademark).
201. See Goldman, supra note 14 (“The court emphatically endorsed all of its practices (and the significant dollars Google spent preparing this case). . . . Other big brands whose trademarks are often used as verbs or nouns also have a lot of reason to cheer this ruling.”).
the fact that it is a URL. In analyzing the genericism of a fanciful mark in domain name registration disputes, there must be complete erosion of the connection between the mark’s source and the mark itself such that the mark has become the primary way to describe the good or service. Evidence of indiscriminate verb usage should not be used as evidence of genericide in domain name registration disputes like the one in Elliott.

Both Booking.com and Elliott involve domain name trademarks, distinguishing them from prior genericide case law. Despite this notable difference, a monopolization of necessary generic and descriptive terms in domain name registrations will be problematic. The uniqueness of fanciful marks used in domain name registrations, however, still calls for a stricter application of the primary significance test because there is a unique single source space on the web identified with the fanciful mark, regardless of casual and grammatical generic use in the public domain. This difference arguably makes claims of genericism of a fanciful mark weaker since the single source of the mark (e.g. “insertfancifulterm.com”) has likely already been registered while the mark was still inherently distinctive and the link will still be intact. Unlike pre-Internet terms such as “aspirin” and “cellophane,” fanciful marks used in a second level domain in the Internet age are anchored by the link to its website. This stricter test for domain name registration will further the goals of trademark law and protect the consumers surfing the web. An example is The Lego Group’s trademark “Lego,” which is a children’s toy, and operation of a Lego fan site at domain

203. Complaint, supra note 88, ¶¶ 69-70 (asserting that a URL trademark signifies a single source and thus cannot be a generic mark by its nature).

204. See id. ¶ 55 (stating that the TTAB found the mark Booking.com could not be used to refer to generically to anything while being grammatically coherent (e.g. “a Booking.com,” “Booking.com-ing”)).


206. See Akhtar & Cumbow, supra note 134, at 234 (stating that the mark “PETSTORE.COM” is “arguably generic” because no consumer can identify a source looking solely at the second level domain mark “PETSTORE”).

207. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (explaining that arbitrary and fanciful marks are afforded the strongest protection).

208. See Haughton Elevator Co. v. Seeberger, 85 U.S.P.Q (BNA) 80, 80 (Dec. Comm’r Pat. 1950) (citing evidence of generic and descriptive use without any indication of the good’s origins as one of the reasons the mark “Elevator” was now generic).

209. King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 577 (2d Cir. 1963); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 81 (2d Cir. 1936); Haughton Elevator Co., 85 U.S.P.Q (BNA) at 80; Bayer Co. v. United Drug Co., 272 F. 505, 512 (S.D.N.Y. 1921).

210. See GIBSON & LALONDE, supra note 3 (stating that protecting trademarks is important because it help authenticates the source).
names such as “ratemylego.com.”\textsuperscript{211} The fear of the Lego Group is that use of their mark in another domain name will cause consumers to think that they sponsor or own the website in operation.\textsuperscript{212}

By restricting the ability for others to use a trademark in the domain name, consumers are better able to go to the site they intend to visit, rather than a website that has nothing to do with the source at all. There is room for fair use of the mark, however: there are arguably good free speech claims in domain name registrations.\textsuperscript{213}

\textbf{B. Google’s Next Steps}

The increased protections for Google’s mark are not foolproof. Google, like any trademark owner, should continue to watch out for genericism. Under this proposed change, if the Google mark should ever lose its association with either the subsidiary or the parent company Alphabet in the public understanding, then the mark cannot be protected, even in domain name registrations.\textsuperscript{214} Some linguistic experts estimate that the mark Google is heading toward genericization.\textsuperscript{215} Alphabet should continue to diversify the brand Google with different products under the Alphabet holding corporation\textsuperscript{216} and utilizing brand content strategies\textsuperscript{217} in light of the structural changes of Google’s corporate structure and its other upcoming developments.

\begin{footnotesize}
\begin{enumerate}
\item\textsuperscript{211} See Deven R. Desai & Sandra L. Rierson, Confronting the Genericism Conundrum, \textit{28 Cardozo L. Rev.} 1789, 1840-41 (2007) (describing The Lego Group’s letter to a website operator that claims the use of their trademark “Lego” in the domain name registration constitutes trademark infringement).
\item\textsuperscript{212} Id.
\item\textsuperscript{213} See Darryl C. Wilson, Battle Galactica: Recent Advances and Retreats in the Struggle for the Preservation of Trademark Rights on the Internet, \textit{12 J. High Tech. L.} 1, 54 (2011) (describing a case involving a gripe site using the trademark name in the domain name that found in favor of the domain name usage).
\item\textsuperscript{214} See Elliott v. Google, Inc., 860 F.3d 1151, 1157 (9th Cir. 2017) (suggesting that if the primary dictionary definition of “google” was “an Internet search engine,” the dictionary evidence would be sufficient to find for genericide).
\item\textsuperscript{216} See Bernard Cova, Re-branding Brand Genericide, \textit{57 Bus. Horizons} 359, 362 (2014) (describing the strategy of a company producing different categories of products bearing the same brand name in order to combat the risk of genericide of a particular good or service).
\item\textsuperscript{217} See id. at 363 (explaining that a wide range brand content strategies from radio to social media networks can allow companies to act as editors and guide conversations and interactions relating to the brand).
\end{enumerate}
\end{footnotesize}
ventures into new markets. These strategies will likely become more and more important as Alphabet continues to grow other businesses under its Alphabet brand, as opposed to its subsidiary brand, Google.

V. CONCLUSION

The *Elliott* decision is a change of direction arguably facilitated by the Internet Era. The Ninth Circuit decision to devalue the evidence of generic use will change the way claims of genericness are viewed and how the inherent distinctiveness of a mark is defended. It will also significantly strengthen a company’s defense to genericism and will likely decrease the number of challenges pertaining to an arbitrary mark’s distinctiveness. The inherently distinctive requirement calls for claims of genericism to relate to the good or service, and according to the Ninth Circuit articulation, that all but eliminates the usefulness of evidence of indiscriminate use and creates a stricter primary significance test and stronger rights for trademark owners.

218. See Stewart, *supra* note 215 (discussing Google’s threat of genericism in light of the company transitioning to alphabet, specifically stating that “[v]entures like Nest, which makes home thermostats and alarms, and Calico, a life sciences company focused on longevity, are not Google-branded, and will be separate companies free to develop their own brands operating under the Alphabet holding company”).

219. See *id.* (“If the day comes when Google is deemed a generic term, the Alphabet holding company and these companies—and any new trademarks they develop—will be unaffected. In the meantime, ‘Alphabet’ is all but immune from genericization. Google may pervade much of our lives, but one thing it will surely never control is the letters of the English language.”).