Google defeated a claim that its GOOGLE trademark was generic, in *Elliot v. Google Inc.*, a recent case from the United States District Court for the District of Arizona.

In 2012, Google filed a Uniform Domain Name Dispute Resolution Policy (UDRP) Complaint against the owner of several hundred domain names that included the word “google.” The UDRP’s Administrative Panel ruled in favor of Google and ordered that the domain names be transferred to Google.

The domain name owner responded by suing Google in the Arizona district court, seeking cancellation of two of Google’s US Trademark Registrations covering search engines.

The domain name owner argued that “google” has become a generic term and is therefore not a protectable trademark. Google filed a motion for summary judgment to dismiss the domain name owner’s claims.

A generic term is one that identifies a general category of goods or services, while a trademark identifies the specific source of those goods or services. A trademark may become generic if the public ceases to associate the mark with a particular source of a good or service, but instead believes the term to refer to a general category of goods or services. Examples of trademarks that have become generic terms include
“aspirin,” “escalator” and “videotape.”

In *Elliot v. Google*, the domain name owner tried to establish that the GOOGLE trademark had become a generic term for search engines. However, the domain name owner did not argue that the majority of the public understands the term “google” to refer to search engines in general. Instead, it based its genericness argument on the public’s use of the term “google” as a verb, contending that “verbs, as a matter of law, are incapable of distinguishing one service from another, and can only refer to a category of services.” The domain name owner offered media and survey evidence to support its genericness claim, but focused mostly on the public’s use of the term “google” as a verb. As a result, the court found that the evidence failed to create a genuine dispute about whether “the primary significance of the word ‘google’ to a majority of the public who utilize Internet search engines is a designation of the Google search engine.”

The court rejected the domain name owner’s genericness argument, holding that the use of a trademark as a verb does not, alone, prevent it from identifying a product or its source.

The court found the domain name owner’s reliance on verb usage as a basis for genericness “misplaced”; even if a majority of the public uses “google” as a verb to refer to the act of searching on the Internet, such usage does not make the term generic because the public still uses “GOOGLE” as a trademark to refer to Google’s search engine. Accordingly, the court granted Google’s motion for summary judgment and ruled that the GOOGLE mark is not generic. In reaching its decision, the court also noted specific steps taken by Google to prevent its GOOGLE mark from becoming generic, including using the mark to identify the Google search engine in national advertising campaigns, establishing standards for third-party use of the mark, and engaging in a pattern of enforcement measures.

The court’s decision highlights the risk that a trademark may become generic and reminds brand owners of steps they can take to prevent generic use of their marks. Brand owners can monitor both authorized and unauthorized uses of their trademarks to ensure their marks continue to function as source identifiers.

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