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CLERK U.S. DISTRICT COURT DISTRICT OF ARIZONA	
BY _____	P DEPUTY

REFERENCE CVLR 2.1(b)(1)  
(Rule Number/Section)

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8 Attorneys for Plaintiff DAVID ELLIOTT

9  
10 UNITED STATES DISTRICT COURT  
11 DISTRICT OF ARIZONA

12 CV-12-1072-PHX-MHB

13 DAVID ELLIOTT, an Individual,  
14 Plaintiff,  
15 v.  
16 GOOGLE, INC., a Delaware corporation and  
DOES 1-10,  
17 Defendants.

Case Number:  
**COMPLAINT FOR CANCELLATION OF  
TRADEMARK AND DECLARATORY RELIEF**  
**DEMAND FOR JURY TRIAL**

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19 Plaintiff David Elliott ("Plaintiff") alleges as follows:

- 20 1. This action seeks cancellation of GOOGLE, INC.'s ("Defendant") federally
- 21 registered trademarks pursuant to 15 U.S.C. sections 1064 and 1119, and a declaration of
- 22 Plaintiff's rights with respect to the Fair Use Doctrine, codified at 15 U.S.C. section 1115 of the
- 23 Lanham Act, among other rights.
- 24 2. Defendant is the record owner of federally registered trademarks issued by the
- 25 United States Patent and Trademark Office ("USPTO"), namely, U.S. Registration No. 2,806,075
- 26 ("'075 Registration") and 2,884,502 ("'502 Registration"). Copies of the registrations are attached
- 27 as **Exhibit 2**. Plaintiff contends that Defendant's registrations should be cancelled because the
- 28 marks are generic.



1 III.

2 FACTS COMMON TO ALL COUNTS

3 Plaintiff's Business Model and Related Actions

4 10. Plaintiff is developing an internet-based business that will promote commerce,  
5 community, relationships, personal health, charity, and more. This business is based upon  
6 ICANN's intention to remodel and restructure the Internet and its use by releasing affinity-and  
7 location-based domain extensions. The initial phase of the business will be targeted toward the  
8 GLBT community worldwide, but the model for the future of the business is unlimited.

9 11. As part of these plans, Plaintiff obtained and registered the Domain Names in  
10 February and March of 2012 using Chris Gillespie's GoDaddy.com account, to be used in  
11 connection with Plaintiff's bona fide offering of goods and services. Plaintiff's Domain Names,  
12 listed in Attachment A, contain the **generic verb** "GOOGLE" (meaning "to search") plus a noun,  
13 including topics, brands or persons, thereby creating a new term with a distinct meaning.

14 12. On March 14, 2012, Defendant filed a complaint against Mr. Gillespie, the named  
15 registrant of the Domain Names, with the National Arbitration Forum ("Forum") pursuant to the  
16 Uniform Domain Name Dispute Resolution Policy adopted by the Internet Corporation for  
17 Assigned Names and Numbers ("ICANN"), arguing a perceived likelihood of confusion and  
18 seeking transfer of the Domain Names to Defendant. The proceeding number for this domain  
19 name dispute is FA1203001434643.

20 13. On April 16, 2012, in agreement with and for the benefit of Plaintiff, a Petition  
21 for Cancellation with the United States Patent and Trademark Office before the Trademark Trial  
22 and Appeal Board ("TTAB") was filed in the name of the registrant of the Domain Names to  
23 cancel Defendant's registration of the same two marks at issue in this complaint.

24 14. On April 17, 2012, in agreement with and for the benefit of Plaintiff, a timely  
25 response was filed to the domain name dispute in the Forum. The Forum issued a decision on  
26 May 10, 2012, granting Defendant's request. Godaddy.com, LLC intends to transfer these  
27 Domain Names on May 24, 2012, in accordance with ICANN's Uniform Domain Name Dispute  
28 Resolution Policy.



1 services, namely, providing software interfaces available over a network in order to create a  
2 personalized on-line information service; extraction and retrieval of information and data mining  
3 by means of global computer networks; creating indexes of information, indexes of web sites  
4 and indexes of other information sources in connection with global computer networks;  
5 providing information from searchable indexes and databases of information, including text,  
6 electronic documents, databases, graphics and audio visual information, by means of global  
7 computer information networks." The '075 Registration was issued on January 20, 2004,  
8 alleging first use and first use in commerce in September of 1997 for the Class 038 and 042  
9 services. The filing date of Defendant's '075 Registration was September 16, 1999.

10 22. Based on the information available from the USPTO, Defendant has yet to file a  
11 Declaration of Incontestability for any of these marks.

#### 12 History of the Term "GOOGLE"

13 23. The origin of term "GOOGLE" is the word "googol," the mathematical term for  
14 a 1 followed by 100 zeros. Defendant itself recognizes the historic origins of the term  
15 "GOOGLE" on its website.

16 24. Since Defendant first adopted the term "GOOGLE," the mark "GOOGLE" has  
17 become a world-wide generic term for internet searching.

18 25. Worldwide, the term "GOOGLE" has been, and is now used as a common  
19 transitive verb meaning "to search the Internet" or to "search the Internet using any search  
20 engine." The Collins English Dictionary, the online dictionary [www.dictionary.com](http://www.dictionary.com), and  
21 Wikipedia all recognize "GOOGLE" as a transitive verb. There is no known synonym for the  
22 verb "GOOGLE." Copies of the definitions of the verb "GOOGLE" from these dictionaries are  
23 respectively attached as **Exhibits 3, 4, and 5** and incorporated by this reference. One researcher,  
24 Adam Kilgarriff, has identified at least 5 English, 17 Dutch, 34 German, 6 Norwegian, 5  
25 Swedish, 8 Italian, 5 Spanish, 21 Romanian, 4 Slav, 11 Russian, 25 Slovak, 7 Slovene, 10 Irish,  
26 10 Welsh, 16 Greek, 10 Chinese, 3 Hindi, 2 Telugu, and 19 Persian forms of the verb  
27 "GOOGLE." A copy of Mr. Kilgarriff's report is attached as **Exhibit 6** and incorporated by this  
28 reference.

1           26.    On January 8, 2010, the American Dialect Society voted the verb "GOOGLE" the  
2 word of the decade, identifying its meaning as "to search the Internet." A copy of the press  
3 release is attached as **Exhibit 7** and incorporated by this reference.

4           27.    On July 8, 1998, co-founder Larry Page himself, used "GOOGLE" as a verb when  
5 he wrote on a mailing list: "Have fun and keep googling!"

6           28.    Defendant is attempting to exercise exclusive rights and control over the now  
7 generic verb "GOOGLE" through its registered mark, under which it seeks to become the de  
8 facto regulator for all uses of the term "GOOGLE," and benefit monetarily as a result.

9           29.    While Defendant's registered marks might also be used as a name of or to identify  
10 a unique product or service, the primary significance of the registered marks to the relevant  
11 public is that of the generic name and interchangeable with the act of an online search.

12           30.    Defendant has been aware for some time that the term "GOOGLE" is being used  
13 generically as a transitive verb meaning "to search the Internet." Defendant's December 31,  
14 2010 Annual Report, page 14, recognized that "the word 'Google' could become so commonly  
15 used that it becomes synonymous with the word 'search.' If this happens, we could lose  
16 protection for this trademark." A copy of this report is attached hereto as **Exhibit 8** and  
17 incorporated by this reference.

18           31.    Thousands of other domain names using the term "GOOGLE" exist. These are not  
19 owned by either Plaintiff or Defendant, but many are running live web sites, including sites  
20 providing pornographic material, questionable dating services, competitive search engine  
21 services, and more. Plaintiff is not aware of any efforts by Defendant to stop these other domain  
22 name owners from using the "GOOGLE" term in their domain names. Screenshots of these  
23 domains are attached as **Exhibit 9** and incorporated by this reference.

24           32.    In addition, when Plaintiff last checked, there were at least 959  
25 "GOOGLE"-related domains for sale in the aftermarket through Go Daddy Auctions, being sold  
26 for tens of thousands of dollars. These "GOOGLE"-related domains have been purchased,  
27 registered, and listed for re-sale at huge profits by owners who are neither Plaintiff nor  
28 Defendant. Defendant has taken no action to stop the sales or control ownership. A list of non-

1 Plaintiff "GOOGLE"-related domain names is attached as **Exhibit 10** and incorporated by this  
2 reference.

3 33. In comparison to other brand-related domain names, the number of "GOOGLE"-  
4 related domain names are widespread and dominate the marketplace. For example, a  
5 comparison of domains for sale on Go Daddy Auctions, (attached and incorporated by this  
6 reference as **Exhibit 11**) shows that there are 160 "GOOGLE"-domains for every one  
7 JPMorganChase-domain; 192 "GOOGLE" domains for every one Macy's domain; 240  
8 "GOOGLE" domains for every Metlife domain; and 120 "GOOGLE" domains for every one  
9 Aflac-domain.

10 34. It was Plaintiff's understanding, based on research that includes Defendant's own  
11 promotions, that the verb "GOOGLE" is commonly and generically being used to describe  
12 Internet searching. That, in conjunction with the available domains on Go Daddy Auctions,  
13 <http://auctions.godaddy.com>, indicated to the Plaintiff that he may legitimately purchase the  
14 available Domain Names in good faith.

#### 15 **Relation Between Defendant's Name and Plaintiff's Domain Names**

16 35. There is no actual or likelihood of confusion between the Defendant's search  
17 engine and the Domain Names at issue. Internet users will not be confused when arriving at the  
18 domain names because Plaintiff has made and will be making the appearance of the websites  
19 distinct from Defendant's [www.google.com](http://www.google.com) website. Users would only come upon Plaintiff's  
20 websites when they use the term "GOOGLE" as a generic verb in conjunction with a topic,  
21 brand, or person to broadly search the Internet.

22 36. Internet users who seek to avail themselves of Defendant's specific search engine  
23 services to obtain information about a certain topic, brand or person almost exclusively go to  
24 the [www.google.com](http://www.google.com) domain name directly and type in the topic, brand, or person into the  
25 Defendant's search engine search box.

26 37. Internet users seeking Defendant's search engine do not arrive at Plaintiff's website  
27 instead, but rather use the search engine services directly on the [www.google.com](http://www.google.com) domain  
28 name. Users who seek Google's search engine would not arrive at Plaintiff's websites by

1 mistake.

2 38. Internet users instead type the generic term "GOOGLE," ubiquitously used as a  
3 verb, to mean "search," combined with another generic topic, directly into their internet  
4 browsers to arrive at Plaintiff's Domain Names. Under no circumstances do users arrive at  
5 Plaintiff's websites by going directly to the www.google.com domain and typing in a topic into  
6 the search box.

### 7 **General Allegations**

8 39. The Domain Names sought to be transferred are or will be inconsistent with the  
9 Plaintiff's equal right to use the designation in connection with the same or a similar business  
10 enterprise. Plaintiff has at least equal rights to use this term in connection with his goods and  
11 services.

12 40. If Defendant is permitted to retain the registrations sought to be canceled, Plaintiff  
13 will lose his rights to the Domain Names now in dispute and will have his rights jeopardized  
14 to acquire domain names in the furtherance of his business plans comprising the generic term  
15 GOOGLE.

16 41. If Defendant is permitted to acquire the domain registrations sought to be  
17 transferred, Plaintiff will lose title in and to the Domain Names and will lose his right to enjoy  
18 the free and exclusive use thereof in connection with the offering of his goods and services  
19 through his Internet-based business, all to the damage of Plaintiff.

20 42. Defendant has not objected to Go Daddy Auction reselling of domain names with  
21 the generic term "GOOGLE," nor has it objected to other purchasers/registrar of domain names  
22 using the generic term "GOOGLE," but rather has singled out Plaintiff and his business model  
23 for attack.

24 43. Plaintiff, and similarly situated sellers, have the right to fairly use the generic term  
25 "GOOGLE" to describe searching on the internet when, in fact, the term is accurately used as  
26 such.

27 44. The fact that Defendant has obtained federally registered marks containing the  
28 generic term "GOOGLE" does not entitle Defendant to monopolize a term that is now common



1 among consumers to describe the act or process of internet searching.

2 45. Defendant's attempt to restrict the fair use of the generic term "GOOGLE" by  
3 Plaintiff and others within the marketplace has given rise to the present controversy,  
4 necessitating the cancellation of the Defendant's registered marks, and a declaration of Plaintiff's  
5 rights with respect to the fair use of the generic term "GOOGLE."

6 46. All conditions precedent to this lawsuit have occurred, been performed, or have  
7 been waived by Defendant.

8 47. As a result of the conduct set forth above, Plaintiff has been forced to retain the  
9 undersigned attorneys to prosecute the instant action and is obligated to pay reasonable  
10 attorney's fees. Those fees should be paid by Defendant, pursuant to controlling law.

11 48. Pursuant to the Lanham Act, the Court has jurisdiction to order the USPTO to  
12 make appropriate entries on the Federal Register with respect to the subject mark, and its  
13 inability to serve as a proper indicator of origin, due to its generic, common, and ordinary  
14 meaning.

15 **FIRST CAUSE OF ACTION**

16 **Cancellation of U.S. Registration No. 2,806,075**

17 **(15 U.S.C. §§ 1064 and 1119)**

18 49. Plaintiff incorporates each of the foregoing paragraphs as though fully set forth at  
19 this point.

20 50. Defendant claims ownership of the '075 Registration for the mark "GOOGLE."  
21 The '075 Registration should be cancelled pursuant to 15 U.S.C. sections 1064 and 1119,  
22 because the term "GOOGLE" is generic, and of common ordinary usage, in connection with  
23 goods, services, products, and derivatives thereof.

24 51. The term "GOOGLE" is commonly understood as a generic term for searching on  
25 the internet with any search engine, and is otherwise descriptive of the act of searching on the  
26 internet.

27 52. Pursuant to the Lanham Act, the Court has jurisdiction to order the USPTO to  
28 make appropriate entries on the Federal Register with respect to the subject mark, and its

1 inability to serve as a proper indicator of origin, due to its genericness, common and ordinary  
2 meaning.

3 **SECOND CAUSE OF ACTION**

4 **Cancellation of U.S. Registration No. 2,884,502**

5 **(15 U.S.C. §§ 1064 and 1119)**

6 53. Plaintiff incorporates each of the foregoing paragraphs as though fully set forth at  
7 this point.

8 54. Defendant claims ownership of the '502 Registration for the term "GOOGLE"  
9 mark. The '502 Registration should be cancelled pursuant to 15 U.S.C. sections 1064 and 1119,  
10 because the term "GOOGLE" is generic, and of common ordinary usage, in connection with  
11 goods, services, products, and derivatives thereof.

12 55. The term "GOOGLE" is commonly understood as a as a generic term for searching  
13 on the internet with any search engine, and otherwise descriptive of the act of searching on the  
14 internet.

15 56. Pursuant to the Lanham Act, the Court has jurisdiction to order the USPTO to  
16 make appropriate entries on the Federal Register with respect to the subject mark, and its  
17 inability to serve as a proper indicator of origin, due to its genericness, common and ordinary  
18 meeting.

19 **THIRD CAUSE OF ACTION**

20 **Declaratory Relief**

21 **(28 U.S.C. § 2201)**

22 57. Plaintiff incorporates each of the foregoing paragraphs as though fully set forth at  
23 this point.

24 58. An actual and present controversy exists between Plaintiff and Defendant with  
25 respect to Plaintiff's ability to use the generic term "GOOGLE" in his Domain Names and to  
26 describe the products and services sold by Plaintiff.

27 59. Plaintiff believes that the term "GOOGLE" is generic and is of ordinary meaning  
28 and usage, and that under any circumstances, Plaintiff has a right to use the term "GOOGLE"

1 to fairly and properly describe the act of searching on the internet for certain terms.

2 60. Defendant filed an action with ICANN, requesting transfer of Plaintiff's Domain  
3 Names and received a decision granting this request. The Domain Names are scheduled to  
4 transfer to Defendant on May 24, 2012. Defendant raised its objection claiming trademark rights  
5 and entitlements pursuant to its registered marks. Accordingly, Plaintiff reasonably believes that  
6 Defendant will commence litigation against Plaintiff if Plaintiff does not cease use of the term  
7 "GOOGLE."

8 61. Even if the Court were to determine that Defendant somehow is entitled to  
9 protection in connection with the generic term "GOOGLE," Plaintiff's use of that term  
10 nonetheless constitutes "fair use" pursuant to 15 U.S.C. section 1115. Plaintiff uses the term  
11 "GOOGLE" in its Domain Names in good faith, in a non-trademark manner that does not  
12 operate as a source or indicator of origin for Plaintiff's products; rather, use of the term fairly  
13 describes internet searching of a certain term.

14 62. In the event that this Court determines that Defendant does have protectable rights  
15 in the generic term "GOOGLE" under the Registrations, those rights must be declared to cease  
16 at the point others in the market, such as Plaintiff, can fairly and in good faith describe their  
17 wares/services as internet searches for a certain topic or item. No current synonym exists to  
18 replace "GOOGLE" as a verb meaning to search on the internet. Moreover, the prior knowledge  
19 and dealings of Defendant supports the declaration that Defendant has waived any right to  
20 object to Plaintiff's fair or descriptive use of the term "GOOGLE," that Defendant is estopped  
21 from asserting any such objection, and is similarly barred from doing so under the doctrines of  
22 laches and acquiescence.

23 63. Plaintiff and Defendant's interests are adverse, and a judicial determination is  
24 necessary and appropriate to resolve the parties respective interests.

25 64. Plaintiff requests that this Court resolve the competing contentions of the parties  
26 and declare that:

27 a. the term "GOOGLE" is a generic term widely used throughout the world over to  
28 describe the action of searching on the internet;

- 1 b. Defendant does not have exclusive rights to the term "GOOGLE" in reference to  
2 searching on the internet, and cannot control the use of that term or force others  
3 to refrain from using it in this context;
- 4 c. Defendant's federal trademarks issued under the '075 Registration and the '502  
5 Registration should be cancelled, and cannot be used by Defendant to prohibit  
6 the use of the term "GOOGLE" in Plaintiff's products or services;
- 7 d. Plaintiff's use of the term "GOOGLE" has at all times been proper and does not  
8 violate any rights that Google may have;
- 9 e. Defendant has waived, is estopped, and is otherwise barred from claiming  
10 Plaintiff infringed the rights, if any, that Google owns in the term "GOOGLE"; and
- 11 f. Plaintiff shall retain full and complete ownership of the Domain Names and no  
12 party shall transfer ownership without the consent of Plaintiff.

13 **PRAYER FOR RELIEF**

14 WHEREFORE, Plaintiff respectfully requests that this Court grant the following relief:

- 15 1. Enter Final Judgment cancelling Defendant's marks, the '075 Registration and the  
16 '502 Registration, and directing the Director of the United States Patent and Trademark Office  
17 to remove such registrations from the Principal Register.
- 18 2. Declare that:
- 19 a. the term "GOOGLE" is a generic term widely used throughout the world over to  
20 describe the action of searching on the internet;
- 21 b. Defendant does not have exclusive rights to the term "GOOGLE" in reference to  
22 searching on the internet, and cannot control the use of that term or force others  
23 to refrain from using it in this context;
- 24 c. Defendant's federal trademarks issued under the '075 Registration and the '502  
25 Registration should be cancelled, and cannot be used by Defendant to prohibit  
26 the use of the term "GOOGLE" in Plaintiff's products or services;
- 27 d. Plaintiff's use of the term "GOOGLE" has at all times been proper and does not  
28 violate any rights that Defendant may have;

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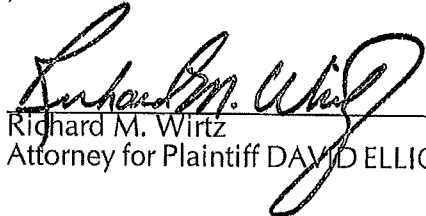
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- e. Defendant has waived, is estopped, and otherwise barred from claiming Plaintiff infringed the rights, if any, that Defendant owns in the term "GOOGLE"; and
  - f. Plaintiff shall retain full and complete ownership of the Domain Names and that no party shall transfer ownership without the consent of Plaintiff.
3. Award Plaintiff's attorney's fees and costs incurred in this action; and
  4. Grant such additional relief as the court deems just and proper.

DATED: May 21, 2012

Respectfully Submitted,

WIRTZ LAW APC

By:   
Richard M. Wirtz  
Attorney for Plaintiff DAVID ELLIOTT