United States District Court, W.D. Washington,

at Seattle.

MICROSOFT CORPORATION, Plaintiff,

v.

LINDOWS.COM, INC., Defendant.

No. C01-2115C.

May 13, 2002.

Bruce Braun, Dan K. Webb, Winston & Strawn, Chicago, IL, Karl Justin Quackenbush, Marc C. Levy, Preston Gates & Ellis, Timothy Leroy Boller, William O. Ferron, Jr., Seed Intellectual Property Law Group PLLC, Seattle, WA, for Plaintiff. Daniel R. Harris, Clifford Chance Rogers & Wells, Q. Huy D. Do, Clifford Chance US, Palo Alto, CA, Johanna Calabria, Clifford Chance US, San Francisco, CA, Karin Bornstein Swope, Scott T. Wilsdon, Yarmuth Wilsdon Calfo PLLC, Seattle, WA, for Defendant.

ORDER

JOHN C. COUGHENOUR, Chief Judge.

On March 15, 2002, the Court issued an Order denying Plaintiff's motion for a preliminary injunction on the grounds that Microsoft had only raised "serious questions" about the merits of its case and the balance of hardships did not tip sharply in its favor (Dkt. No. 64). The Court's preliminary ruling analyzed the validity of Microsoft's "Windows" trademark and concluded that the "roughly equal bodies of evidentiary support" prevented it from granting the preliminary injunction. In the Motion for Reconsideration presently before the Court (Dkt. No. 67), Microsoft contends that the Court applied the wrong test for genericness and further argues that it misapplied the evidence submitted by Lindows.com.

Under the Local Rules of the Western District of Washington, "[m]otions for reconsideration are disfavored" and will ordinarily be denied unless the moving party shows "manifest error in the prior ruling or ... new facts or legal authority which could not have been brought to [the Court's] attention earlier with reasonable diligence." Local Rule CR 7(h)(1). Microsoft's motion is brought under the rule's "manifest error" standard, as it claims that a "fundamental misapprehension of the test for 'genericness' led the Court" to an incorrect conclusion. Pla.'s Mot., at 1.

I. TEST FOR GENERICNESS

The Court cited to and applied the Ninth Circuit's test for genericness: "A generic term is one that refers to the genus of which the particular product is a species." Order, at 14 (quoting *Comm. for Idaho's High Desert, Inc. v. Yost,* 92 F.3d 814. 821 (9th Cir.1996)). The Order also relied upon several cases from the Seventh Circuit which applied an indistinguishable standard: "in order to be generic ... the word in question must serve to denominate a type, a kind, a genus or a subcategory of goods." Order, at 25 (quoting *Henri's Food Prods.Co. v. Tasty Snacks, Inc.,* 817 F.2d 1303, 1305-06 (7th Cir.1987)).

Microsoft argues that Lindows.com presented no evidence showing that the consuming public understood "windows" to refer to the class of goods commonly described as operating systems. It also contends that the Court's use of Seventh Circuit case law "conflicts directly with the Ninth Circuit test which requires that the alleged generic term ... be considered as a whole and that genericness turns on consumers' perception of the whole term." Pla.'s Mot, at 2-3. The plaintiff's argument, however, misconstrues the Court's synthesis of the case law from the two circuits.

As demonstrated by the quoted sections above, the Ninth and Seventh Circuits apply a test for genericness that is for all intents and purposes identical. The Seventh Circuit has gone further to explain why an "adjective can be a generic term when that word is part of a common descriptive name of a kind of goods." *Henri's Food Prods.,* 817 F.2d at 1305. Thus, the Seventh Circuit held that "light," and its phonetic equivalent "lite," were generic words when used in reference to beer because "light beer" was a generic name for a type of beer. *See Miller Brewing Co. v. G. Heileman Brewing Co.,* 561 F.2d 75, 80-81 (7th Cir.1977). The Seventh Circuit used this analysis again in *Henri's Food Prods.* when it concluded that "tasty" was not a generic term because " 'tasty salad dressing' is not a kind, sort, genus or subcategory of salad dressing." 817 F.2d at 1306. By example, the court contrasted "French dressing," showing that "French," unlike "tasty," did "serve[ ] to classify the noun to which it is attached." *Id.; see also Mil-Mar Shoe Co. v. Shonac Corp.,* 75 F.3d 1153, 1160 (7th Cir.1996) (finding "warehouse shoes" to be generic).

Microsoft also contends that the Court should reject the *Miller Brewing* line of cases from the Seventh Circuit because they conflict directly with the Ninth Circuit's approach of determining genericness of composite terms by examining the term as a whole rather than its constituent parts individually. *See Filipino Yellow Pages,* 198 F.3d 1143, 1148-1150 (9th Cir.1999) (rejecting arguments that a combination of generic words yields a generic term and discussing cases where the court analyzed the terms "Committee for Idaho's High Desert," "California Cooler," "Self-Realization Fellowship Church" and "Filipino Yellow Pages" as a whole to determine whether they were generic). The Seventh Circuit adheres to the same approach, as it unequivocally stated in *Mil-Mar Shoe,* 75 F.3d at 1161 ("We have recognized in the past that the genericness of a composite term must be evaluated by looking at the term as a whole."). All of the Seventh Circuit cases cited by the Court first analyzed the composite terms-"tasty salad dressing," "French dressing," "warehouse shoes" and "light beer"-as a whole before concluding that the adjectives classifying the nouns to which they were attached were also generic terms. In sum, no direct conflict exists between the two circuits' tests for genericness of composite terms. Further, the Ninth Circuit has never commented on, let alone rejected, the Seventh Circuit's genericness evaluation of adjectives that classify nouns,

and the Court believes that it would accept *Miller Brewing*'s reasoning if it were ever presented with the question.

The Court's conclusion regarding the distinctiveness of the "Windows" trademark follows directly from the synthesis of this case law. Pointing to "light beer" and "matchbox toys" as examples consistent with Ninth Circuit law where consumers viewed composite terms as genus names, *see* Pla.'s Mot., at 2 n. 2, Microsoft maintains that "Windows" cannot be generic because it is not the name for a class of products. Microsoft's reasoning is flawed because it ignores the Seventh Circuit's case law holding that when a composite term is generic and is made up of an adjective (or other descriptive word) that classifies a noun, the adjective itself can also be a generic term. Microsoft's argument also ignores its own analysis of the Defendant's evidence, which shows repeated references to the composite terms "window manager," "windowing environment," "windows programs" and several others. Microsoft's outline of the evidence in the Declaration of Timothy L. Boiler even characterizes each of these composite terms as the genus for a type of product. *See* Boiler Decl. ¶ 16, Exs. 1-14 (highlighting trademark references to "Windows" in blue, descriptive references in yellow and genus references in pink/purple).

Through its own use of the evidence, Microsoft essentially admits that these terms refer to the genus of computer software products that have windowing capability. Just as with "light beer" and "matchbox toys," *see* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 12:10 (4th ed.2001) (citing cases), it logically follows that the use of "windows," "window" and "windowing" is also generic when used to refer to the same class of products.

II. EVIDENCE OF GENERICNESS

Having clarified the legal analysis relied upon by the Court in its ruling on the motion for a preliminary injunction, it is worth revisiting briefly some of the evidence with a sharper focus.

Several news articles that pre-date the introduction of Microsoft Windows as well as the first attempt to register the trademark include references to "window managers" and specifically point to Microsoft Windows as a product within this genus. In an article describing Microsoft's entry into the "window wars," the author frequently used the term "window managers" to describe Microsoft's first "Windows" product. *See* John Markoff, *Microsoft Does Windows*, InfoWorld, Nov. 21, 1983, at 32 ("Microsoft announced Windows, a window manager and graphical-device interface ....") (Boiler Decl. Ex. 2); *see also A Fierce Battle Brews Over the Simplest Software Yet,* Business Week, Nov. 21, 1983, at 114 ("windowing programs are expected to be standard on every personal computer"); Andrew Pollack, *Integrating the Software,* N.Y. Times, Dec. 1, 1983, at D2 ("Window packages have been dubbed environments."); *Microsoft Philosophy Presages Entry in Window Wars,* InfoWorld, Nov. 14, 1983, at 56 ("Given the ammunition, can a Microsoft window manager be far away?").

Advertisements, a key indication of how any industry communicates with its customers, also commonly referred to products by identifying them as a "window manager," "windowing environment" or describing them as compatible with other window managers, such as Microsoft Windows. *See, e.g.,* Boiler Decl. Ex. 8, at MS 000770 ("DESQview. The Multitasking, Windowing Environment"); MS 000769 ("Unlike many other screen managers, C-scape is a true windowing environment."); MS 000756 ("Runs under most window managers, e.g.... Dec Windows"); MS 000776 ("Only HDS' X

terminals come with a built-in Open Look window manager.").

Similarly, many dictionaries used these terms to describe a class of computer software products. For example, Alan Freedman's The Computer Glossary defines "Windows," "windows environment" and "windows program" as follows: *"Windows* is a windows program from Microsoft Corporation.... A *windows environment* is a computer that is running under an operating system that provides multiple windows on screen. [e.g.] Microsoft Windows.... A *windows program* is software that adds a windows capability to an existing operating system." Alan Freedman, The Computer Glossary 751-52 (4th ed. 1989) (Boiler Decl. Ex. 4, at MS 000607-08). In another dictionary, "windows environment" is defined as "[a] computing environment characterized by an operating system that allows multiple windows on the display screen. Examples of such environments include DESQview, Microsoft Windows, Presentation Manager, and X Window for the IBM, and Finder or MultiFinder for the Macintosh." Allen L. Wyatt, Computer Professional's Dictionary 344 (1990) (Boller Decl. Ex. 4, at MS 000629).

Even Microsoft's own computer dictionary includes expansive definitions of "windowing environment" and "windowing software":

windowing environment An operating system or shell that presents the user with specially delineated areas of the screen called windows. Each window can act independently, as if it were a virtual display device. Windowing environments typically allow windows to be resized and moved around on the display. The Apple Macintosh Finder, Microsoft Windows, and the OS/2 Presentation Manager are all examples of windowing environments.

windowing software Programs, such as Microsoft Windows, that enable users to work with multiple on-screen windows. Windowing software acts as an intermediary between an operating system, such as MS-DOS, and application programs designed to work within a windowing environment. *See also* graphical user interface.

Microsoft Computer Dictionary 368 (1991) (Boller Decl. Ex. 4, at MS 000663); *see also* Microsoft Computer Dictionary 482 (4th ed. 1999) (Boller Decl. Ex. 5).

In addition to consistently coupling the company's name with its various Windows versions, Microsoft also showed that it understood "windows" to denote a class of products by referring to its first Windows product as a "window manager." In a 1983 article discussing the company's introduction of Windows 1.0, the group manager for Microsoft Windows was quoted as saying, "[t]he window manager is actually a small part of this announcement." *Microsoft Does Windows, supra*. Steve Ballmer, who was then the vice president for marketing, also described Windows using the same terms: "He [Steve Bulmer (sic)] said that after an extended internal debate about the philosophy of designing window managers, Microsoft had settled on ....."). *Id*.

Finally, there is some evidence that Microsoft's competitors also used the term "window manager" to refer to their system software or graphical user interface. *See, e.g., Apple Computer, Inc. v. Microsoft Corp*., 799 F.Supp. 1006, 1024 (N.D.Cal.1992) (listing the "X Consortium Tab Window Manager" in the scenes a faire table); Microsoft Computer Dictionary 482 (4th ed. 1999) ("Macintosh Window Manager"); Kurt W.G. Mathies & Thorn Hogan, *Managing Multiple Windows*, MacUser, June 1990, at 273 ("Macintosh Window Manager").

III. CONCLUSION

Applying the proper Ninth Circuit test for genericness and the Seventh Circuit's gloss regarding adjectives and other descriptive words that classify the noun to which they are attached in composite terms, the evidence shows that the consuming public used the terms "windows," "window" and "windowing" to refer to a type of graphical user interface or other software program, including operating systems, in which overlapping windows are the predominant visual feature. As a result, the Court did not err in either its legal or factual analysis when it denied Microsoft's motion for a preliminary injunction. The Motion for Reconsideration is DENIED.

SO ORDERED.