

If It Isn't Perceived as Generic, Then It Isn't Generic: Takeaways from USPTO v. Booking.com

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The United States Supreme Court ruled in *United States Patent and Trademark Office v. Booking.com B. V.* that domain names comprised of generic terminology and a top-level domain (such as .com) can be eligible for trademark protection.¹ Below, we explore what this means for brand owners.

As brief background, this represents the latest chapter in Booking.com's eight years of efforts to federally register Booking.com as a trademark. Consumers visit Booking.com to book travel arrangements and accommodations. The United States Patent and Trademark Office (USPTO) Examining Attorney denied registration based on genericness. The Trademark Trial and Appeal Board (TTAB) affirmed.

Booking.com appealed to the U.S. District Court for the Eastern District of Virginia. The court reversed the TTAB decision and held that Booking.com is entitled to be registered as a trademark. The Fourth Circuit Court of Appeals affirmed the District Court.

The Supreme Court also affirmed the reversal of the TTAB and agreed that Booking.com is entitled to be registered as a trademark, rejecting a *per se* rule proposed by the USPTO which would have rendered any generic term combined with a TLD (a Generic.TLD) as intrinsically generic and unregistrable. The USPTO heavily relied on the Supreme Court's 1888 *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* decision.² The *Goodyear* Court held that adding a generic term such as "Company" to another generic term did not render the compound term protectable, as "Company" denotes a type of organization, rather than a source of services.

Here, the Court declined to extend the *Goodyear* reasoning for company names to domain names. For one thing, whereas "Company" cannot signify source to a consumer, the Court concluded that a website address can as only one entity can operate at a web address at a time. Secondly, *Goodyear* was decided a half-century before the codification of the Lanham Act. The Act created the Supplemental Register, allowing registration of marks that are not fully protectable, but which can become so through consumer recognition.³

In *Booking.com*, the Court stated that the deciding factor on whether a Generic.TLD is generic turns on whether consumers understand that the mark, as a whole, serves as a source of products or services, not as a category of offerings. More plainly, as the Court confirmed: "Because 'Booking.com' is not a generic name to consumers, it is not generic." The Court explained that if a frequent traveler were to understand, e.g., Travelocity, to be a booking.com, then Booking.com should be deemed generic.

The Court clarified that its decision should not be interpreted to mean that any Generic.TLD automatically overcomes the genericness bar. Instead, the genericness determination must be a case-by-case analysis of each mark's consumer perception. Each applicant of a Generic.TLD must first show consumer recognition that consumers associate the mark as a source identifier, after

which the Generic.TLD may be deemed at least descriptive. This consumer recognition could be shown in the form of consumer surveys or other evidence.

Takeaways

How high of a bar will be set by the USPTO and courts for showing consumer recognition? That **remains to be seen**, but likely much higher than has typically been required to show acquired distinctiveness. A specific standard (e.g., “exceptionally high bar” or “preponderance of the evidence”) was not set by the Court. Considering, however, the USPTO’s reticence to register Booking.com as a trademark, it is reasonable to expect that the USPTO will set a rather high bar. Be on the lookout for the USPTO to issue guidance within the next few months.

Should businesses operating at a Generic.TLD apply for federal trademark registration? That **depends** on the goals of each business. Examining Attorneys are probably not going to issue as many genericness refusals on such marks post *Booking.com*. Although it might be more feasible to register one’s domain name, the path to registration is not necessarily free of all obstacles. The cost might also be prohibitively high where a rejection is issued by an Examining Attorney and a consumer survey is needed to show that consumers do not consider it generic. Keep in mind, too, that the business must use its domain name as a trademark and not merely as a domain name. Examples could include use across types of media as the business name, or a display in prominent font or logo form in the content of the applicant’s website. Use merely as a domain name appearing in the address bar will not suffice. Further, any resultant registration likely would be difficult to broadly enforce.

Will this ruling spark more litigation involving owners of Generic.TLDs? **Probably not.** As the Court noted in its decision, and as counsel for Booking.com conceded in oral arguments, rights in any Generic.TLD will be weak and very narrow – and these rights probably will not even be enforceable against many users of highly similar domain names. Obtaining a federal registration certainly could improve a company’s ability to police others’ use of a Generic.TLD in textual ways that could dilute it or lead to genericide. For instance, Booking.com could now more readily force a news outlet or competitor to not state, “Expedia is another booking.com.”

Will this have widespread impact on trademark law? Again, **probably not.** Bright-line rules as to distinctiveness categorization in trademark law, as proposed by the USPTO, are rare. They are contrary to the fundamental definition of trademarks in the Lanham Act, which states that any word, device, symbol, etc. can serve as a trademark if it identifies a source of offerings. Had the Supreme Court adopted the USPTO’s proposed *per se* rule, future disputes might have arisen over whether marks structured in some other format could all be categorically deemed generic – or distinctive – rendering examination of each such mark on distinctiveness grounds as moot. That said, the *Booking.com* decision may have raised the bar, or at least the cost, for proving a potential trademark is not generic.

¹ *United States Patent and Trademark Office v. Booking.com B. V.*, No. 19-46, 2020 U.S. LEXIS 3517 (June 30, 2020).

² *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888) (explaining that inclusion of “Company” in “Wine Company” did not change the fact that the phrase identified a product category, not a distinguishable source within that category).

³ The *Booking.com* Court questioned in oral arguments whether the *Goodyear* Court considered

the [generic word] + [company] combination to be descriptive (i.e., potentially fully protectable) or generic (i.e., never protectable). The Court's decision, however, did not address this issue.