U.S. Supreme Court Hears First Ever Teleconference Oral Arguments in USPTO v. Booking.com B.V. Trademark Case

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PRACTICES Intellectual Property, Trademark and Advertising

On Monday, for the first time in history, the U.S. Supreme Court heard oral arguments via teleconference and live-streamed the conference call to the public. And, if that was not exciting enough, to kick off a planned two-week session of tele-arguments, the Court chose a case whose subject is relatable to the general public – domain names. Although the live-streamed teleconference was broadcast practically glitch-free, the attorneys did not get off quite so easily, with each of the Justices taking turns in order of seniority to scrutinize the counselors. Here, we discuss some of the noteworthy arguments from Monday's hearing in *United States Patent and Trademark Office v. Booking.com B.V.*

The case presents the question of whether a domain name that is solely a generic term, which would not generally be protectable as a trademark, can be transformed into a protectable mark through the addition of a generic top-level domain (a gTLD) like .com or .org, in particular, "booking.com." The Trademark Office's current rule TMEP § 1209.03(m) explicitly instructs Trademark Office Examining Attorneys to reject such trademark applications. An Examining Attorney followed that rule in rejecting several trademark applications for the mark BOOKING.COM. This case questions whether the gTLD ".com" can in fact transform the generic term "booking" into a protectable trademark, and if so, under what conditions?

As procedural background, Booking.com operates a website at the domain name *booking.com* on which consumers can secure travel arrangements and accommodations. In 2011 and 2012, Booking.com filed four U.S. trademark applications for the mark BOOKING.COM for, *inter alia*, reservation services. The USPTO (first the Examining Attorney, then the Trademark Trial and Appeal Board) ultimately refused the applications on the basis that BOOKING.COM is a generic term ineligible for protection. On appeal to the United States District Court for the Eastern District of Virginia and then to the United States Court of Appeals for the Fourth Circuit, Booking.com secured reversals of the Trademark Office decision, in significant part by relying on a survey by an expert witness showing that consumers had come to recognize BOOKING.COM as a brand and not as a category of reservation services. The USPTO then petitioned the Supreme Court for review.

Read the full article here.