

BOOKING.COM – Generic. no. Trademark. yeah.

U.S.P.T.O. v. Booking.com B.V., 591 U.S. (2020)

By: Reid Huefner & Peggy Herrmann | July 6, 2020

Last week, the Supreme Court held that the combination of a generic word and “.com” is not necessarily generic and may be eligible for federal trademark registration. A trademark allows consumers to distinguish the goods or services of one manufacturer from another’s and permits a trademark owner to protect its good will. Generic names are ineligible for federal trademark registration, as they are the names or classes of services or products.

After its application for BOOKING.COM was refused by the USPTO, Booking.com sought judicial review in the Eastern District of Virginia, which ultimately found the term descriptive, the term had acquired secondary meaning and, thus, the term met the distinctiveness requirement for registration. The decision was affirmed by the Fourth Circuit and now the Supreme Court. The lower courts determined that consumers do not perceive BOOKING.COM as a class of online hotel-reservation services and the USPTO did not dispute that finding on appeal.

The Court rejected the USPTO’s proposed adoption of a bright-line rule—the combination of a generic word and “.com” is necessarily generic and, therefore, “ineligible for registration regardless of specific evidence of consumer perception.”¹ The Court relied on consumer perception and held that “[w]hether any given ‘generic.com’ term is generic ... depends on whether consumers in fact perceive that term as a name of a class or, instead, as a term capable of distinguishing among members of the class.”² Consumers understand that BOOKING.COM does not refer to a class but is descriptive of booking services available at that specific website. BOOKING.COM, therefore, is not generic, as it is not a general name to consumers.

In distinguishing this matter from Court precedent,³ the Court reasoned that domain names (which are unique) may also convey to consumers the source of a good or service by an association with a particular website. The Court pointed out that refusing registration flies in the face of the USPTO’s own practice (which previously registered ART.COM on the principal register and DATING.COM on the supplemental register). Rejecting the USPTO’s argument that registration would prevent competitors from using “booking” or a similar domain name, such as ebooking.com, the Court reasoned that when marks include highly descriptive or generic components, “consumers are less likely to think that other uses of the common element emanate from the mark’s owner.”⁴ Additionally, even if some confusion exists, competitors are permitted to use descriptive terms fairly and in good faith.

The Court further refused the USPTO’s argument that a trademark is not needed because other competitive advantages (e.g., search engine results) are available. It reasoned that all descriptive marks would have the same competitive advantages and are also provided protection from passing off and false advertising by unfair competition law but are still eligible for registration.

Nonetheless, after this long-fought win, BOOKING.COM is still a weak mark. Booking.com admitted as much in oral argument, and further conceded that close variations are unlikely to infringe. Interestingly, presumably to ward off such variants, websites booking.net, booking.org, and booking.biz all redirect users to the booking.com website.

¹ *U.S.P.T.O. v. Booking.com, B.V.*, 591 U.S., ____, at *7 (2020).

² *Id.* at *11. The Court also notes that beyond consumer-survey evidence to support consumer perception, “dictionaries, usage by consumers and competitors, and other sources of evidence bearing on how consumers perceive a term’s meaning” are also useful to determine whether a mark is generic or descriptive. *Id.* at 11, n. 6.

³ In *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, the Court held that adding a corporate designation to a generic term (e.g., Wine Company) does not bestow trademark eligibility. 128 U.S. 598, 602–603 (1888).

⁴ *Booking.com.*, at *12.