

## Brand Protection Alert

July 2020

# Supreme Court: 'Generic.com' Domains Not Necessarily Generic; May Be Federally Registered

The U.S. Supreme Court has decided that "generic.com" marks that constitute (or also function as) domains are not per se generic and may be federally registered and protected upon a showing that they are not generic and have acquired secondary meaning. The Court's 8-1 decision affirmed the Fourth Circuit's determination that travel company and website Booking.com is entitled to register "booking.com" for online hotel reservation services on the federal Principal Register. The Court relied on the statutory "primary significance to the relevant public" test for genericness. However, it assumed that Booking.com had established the primary "trademark significance" of "booking.com" because Booking.com's evidence had been accepted by the district court and the Fourth Circuit, and the U.S. Patent and Trademark Office (USPTO) did not challenge the finding before the Supreme Court.

The Court rejected the USPTO's bid for a hardline rule that adding the generic top-level domain extension ".com" to a generic word results in a generic combination.

### Key Takeaways:

- Most "generic.com" marks that constitute (or also function as) domain names are theoretically candidates for trademark protection and federal registration.
- The question of what evidence will suffice to prove a "generic.com" term is a mark is not settled, and at least two of the justices and various commentators have expressed concerns about the adequacy of traditional consumer survey evidence in this area.



- The decision does not address "generic.com" terms that do not also function as domain names or that fail other protection or registration criteria, such as those that are deceptively "misdescriptive."
- Beyond acknowledging Booking.com's concession that its mark will be weak, the Court leaves to future cases the scope of protection to which any particular "generic.com" mark is entitled.

### ***United States Patent and Trademark Office v. Booking.com B.V., No. 19-46, Supreme Court of the United States, June 30, 2020***

Booking.com B.V., a digital travel company that provides hotel and travel reservation services under the trade name and service mark "Booking.com" and provides these services through its website at "booking.com," filed applications with the USPTO to register "booking.com" on the Principal Register for travel-related services. Both a USPTO examining attorney and the Trademark Trial and Appeal Board (TTAB) concluded that "Booking.com" is generic for the services at issue—making online travel reservations—and therefore unregistrable.

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Booking.com sought review in the U.S. District Court for the Eastern District of Virginia because the forum permitted it to introduce new evidence. The district court relied on that new evidence—survey evidence that the consuming public primarily understands BOOKING.COM as a mark—to conclude that “Booking.com”—unlike “booking”—is descriptive, not generic, and it had acquired secondary meaning. On the USPTO’s appeal, the Fourth Circuit affirmed, finding no error in the district court’s assessment of how consumers perceive “Booking.com” and rejecting the USPTO’s contention that the combination of “.com” with a generic term such as “booking” “is necessarily generic.”

In its appeal to the U.S. Supreme Court, the USPTO continued to advance a blanket rule that combining a generic term with “.com” yields a generic composite. The USPTO relied heavily on the common-law principle from the Court’s 1888 opinion in *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, that a generic corporate designation such as “Company,” “Co.” or “Inc.” added to a generic term does not confer trademark eligibility. The USPTO argued that adding “.com” to a generic term analogously “conveys no additional meaning that would distinguish [one provider’s] services from those of other providers,” rendering “generic.com,” like “Generic Company,” ineligible for trademark protection.

While the dissent endorsed this proposition, the majority rejected application of *Goodyear* because “generic.com” might also convey to consumers a source-identifying characteristic: an association with a particular website. Both the USPTO and the dissent acknowledged that only one entity can occupy a particular internet domain name, so “[a] consumer who is familiar with that aspect of the domain-name system can infer that BOOKING.COM refers to some specific entity.” The majority noted that the USPTO’s proposed blanket rule was also inconsistent with the office’s past practice, citing federal registrations for “ART.COM” (on principal register for “[o]nline retail store services” offering “art prints, original art, [and] art reproductions”) and “DATING.COM” (on supplemental register for “dating services”).

The majority also rejected the USPTO’s policy arguments echoed by the dissent, namely, that allowing trademark protection for “Booking.com” would exclude or inhibit competitors from using the term “booking” or adopting domain names such as “ebooking.com” or “hotel-booking.com.” The Court reasoned that the

same concern is inherent in any descriptive mark but is addressed by the fact that a competitor’s use does not infringe a mark unless it is likely to confuse consumers. The Court observed, and Booking.com conceded, that “Booking.com” would be a “weak” mark, but the Court found that no policy concerns, or even the inherent advantage in ownership of an exclusive domain, warrant denying trademark protection where distinctiveness has been acquired.

Finally, the majority opinion rejected the argument advanced by the USPTO and the dissent that owners of generic domain names would enjoy additional competitive advantages due to the automatic exclusivity inherent in domain names and the fact that generic domains are easier for consumers to find. The Court reasoned that these competitive advantages should not disqualify a mark from federal registration, and are similarly inherent in all descriptive marks.

## Impact of the Court’s Ruling

The Court’s holding represents a public policy decision that “generic.com” marks that constitute or also function as domain names will be treated differently from “Generic Company” and similar names and marks. Rather than categorize essentially all “generic.com” terms based on a linguistic analysis of the terms’ components and structures, each decision will be made on an ad hoc basis and will depend on what meaning the domain name holder can prove. This provides the first user of a “generic.com” domain name with the opportunity to generate a mark through the market impact it makes via use, marketing and sales. Despite the Court’s dismissal of potential competitive impacts, it may be a material advantage to the domain holder.

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