

A WOLF IN SHEEP'S CLOTHING? A DEEP DIVE INTO THE IMPLICATIONS OF UNITED STATES PATENT & TRADEMARK OFFICE V. BOOKING.COM B.V.

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In October Term 2019, the United States Supreme Court considered whether adding a top-level domain—for example “.com”—to a generic term would automatically prohibit Trademark eligibility.^[i] In *United States Patent & Trademark Office v. Booking.com B.V.*, the Court refused to hold that such was the case. The Court did utilize this opportunity to clarify its prior holding in *Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* that adding a generic designation like “Company” to another generic term—here, Goodyear Rubber—would inhibit Trademark eligibility.^[ii] The Court explained there is not an automatic prohibition on a generic designation combined with another generic term as Trademark eligibility depends on whether the combination provides additional, distinctive meaning to consumers that would distinguish the goods or services associated with the Trademark.

When considered together, the Court’s holdings in *Goodyear* and *Booking.com* set the standard that adding a generic designation (such as “company”) to a generic term (like “goodyear rubber”) merely indicated a company’s association or partnership to deal in such goods or services and did not convey additional, distinguishing meaning to consumers. At the time of the *Goodyear* holding, “goodyear rubber” referred to a well-known class of goods produced by Goodyear’s invention process, not to a specific company.^[iii] In contrast, consumers perceive “Booking.com” to be a specific website for a company instead of a general class of goods or services.^[iv] While the *Booking.com* decision may appear to be a victory for future businesses hoping to capitalize on this holding, the Court’s reasoning turned on the fact that the United States Patent and Trademark Office (USPTO) did not challenge the lower court’s determination that consumers would not perceive every booking site (e.g., Travelocity) as a category of *Booking.com*. This is because the USPTO argued that a consumer-perception determination was unnecessary because a generic term combined with a top-level domain was automatically ineligible for trademark registration.^[v] The Court disagreed with this position and reiterated there was an established process for generic terms seeking Trademark registration.

This process begins with the Lanham Act—the federal law relating to Trademarks. The purpose of providing legal protection to Trademarks is to protect consumers’ ability to distinguish among

competing producers or businesses. Distinctiveness is measured on a sliding scale from generic to fanciful. The more distinctive the mark, the more likely it is to be registered in the Principal Registrar, which allows for greater protections than the alternative Supplemental Registrar. A generic term, by itself, is considered weak and ordinarily ineligible for registration on either Registrar.

In *Booking.com*, the Court determined that a generic term combined with another word could distinguish a mark. However, such combination does not automatically qualify a mark as descriptive in order for the mark to achieve a “secondary meaning,” (acquired distinctiveness that achieves significance in the minds of the public), that is required for registration. If a Trademark applicant can demonstrate that the consumer perception of a mark equates a secondary meaning, then the mark should be considered eligible for registration.

To demonstrate consumer perception equates a secondary meaning in commerce, the Court found that Trademark applicants may rely upon consumer surveys, dictionaries, usage by consumers and competitors, and any other source of evidence that demonstrates how consumers perceive the proposed mark’s meaning.^[vi] Here, the majority did not provide specific guidelines for determining the credibility of consumer surveys to demonstrate a secondary meaning because the USPTO did not address the credibility of consumer surveys that supported the position that Booking.com had achieved a secondary meaning. The Court’s opinions universally cautioned overreliance of consumer surveys because surveys “require care in their design and interpretation” and “may be an unreliable indicator of genericness.”^[vii] Therefore, Trademark applicants are better served by utilizing dictionary meanings, trade usage, and other sources in conjunction with well-designed and objectively interpreted consumer surveys to demonstrate that a mark has achieved secondary meaning.

The *Booking.com* decision provides several knowledge guideposts to help individuals when branding their business and seeking registration of their marks. First, while generic terms combined with top-level domain names will not be automatically deemed ineligible for registration, such marks will be facing an uphill battle to prove the mark is a descriptive mark and has achieved secondary meaning. Second, the use of a well-designed and objectively interpreted survey in conjunction with dictionary meanings, trade usage, and other sources will most likely be required to demonstrate that consumer perception supports a secondary meaning of the proposed mark. Thus, when working with clients that are seeking to register marks that are similar to Booking.com, counsel should advise clients of these criteria points and prepare accordingly in order to increase the likelihood of successful registration of a trademark.

^[i] 140 S. Ct. 2298 (2020).

^[ii] 128 U.S. 598 (1888).

^[iii] *Booking.com*, 140 S. Ct. at 2305.

^[iv] *Id.* at 2306.

^[v] *Id.* at 2305.

^[vi] *Id.* at 2307, n.6.

^[vii] *Id.* (majority); *Id.* at 2309 (Sotomayor, J., concurring); *Id.* at 2314 (Breyer, J., dissenting).

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