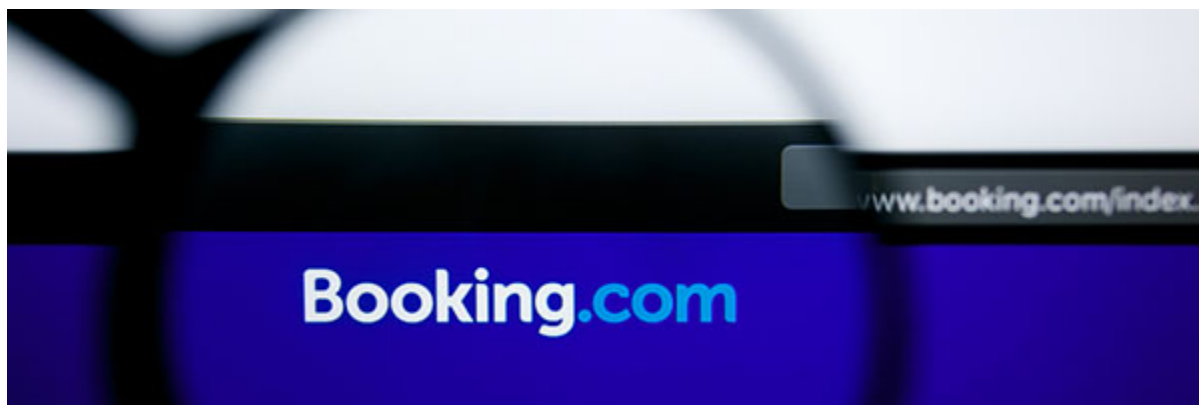


## Supreme Court Finds BOOKING.COM Non-Generic And Capable Of Federal Trademark Registration



Can a generic word combined with “.com” ever be eligible for trademark protection in the United States? Yes, under the Supreme Court’s 8-1 decision in *United States Patent And Trademark Office v. Booking.com B.V.*, issued today.

Trademark law is clear that a generic word – meaning any word that is also the name of a class of products or services – is ineligible for federal trademark registration because a generic term is not and cannot be source identifying. In this case, the travel reservation company Booking.com B.V. (“BBV”) sought to register the mark BOOKING.COM, which also served as its primary website location, for a variety of travel related services. BBV conceded that the word “booking” is generic for travel reservation services, but argued that the addition of “.com” rendered the mark in its entirety sufficiently distinctive to consumers that it identified a singular source of those services. The USPTO countered that the combination of a generic word and “.com” is still generic and urged the Supreme Court to adopt a bright-line rule that no “generic.com” mark is capable of federal trademark registration.

The Court’s ruling hinges on consumer perception – do consumers identify a “generic.com” mark as identifying a class of goods or services, or do consumers recognize that mark as distinguishing a single source among members of the same class? One factor that the Court weighed in favor of registration is that only one entity can occupy a particular domain name at a time, so consumers should know that BOOKING.COM refers to some specific entity simply by virtue of the fact that no other entity can share that identical domain name space. This contention was also supported by evidence of consumer perception and secondary meaning submitted by BBV in its appeal to the federal district court, which the Court declined to reweigh because the USPTO did not contest the lower courts’ assessment of consumer perception in this case.

Although the Court held that a “generic.com” mark, such as BOOKING.COM, is capable of trademark registration, its ruling explicitly states that not all “generic.com” marks are necessarily capable of trademark registration. The question will always hinge on consumer perception and whether the consuming public recognizes a “generic.com” mark as a specific source identifier.

Justice Breyer was the lone dissenter in this case. In his view, the mark BOOKING.COM informs the consumer of the basic nature of its business and nothing more, rendering the mark generic by definition. Even when the consuming public perceives a “generic.com” mark to identify a single source, as the survey evidence submitted by BBV suggested, Justice Breyer would still conclude that such consumer perception cannot transform a generic mark into something non-generic. Such evidence may show that consumers associate a generic term with a particular source, but the term itself remains linguistically generic. The Court’s decision opens the door for more companies to adopt, use and seek federal registration and trademark protection for “generic.com” marks. However, companies and entrepreneurs should take some caution from the Court’s decision. Even if a “generic.com” mark is capable of federal registration, the Court’s decision is peppered with *dicta* suggesting the scope of protection for such a mark may be narrow due to the weakness of such a descriptive mark. This may make it more difficult to protect a “generic.com” mark from imitators and infringers.

The attorneys at Lewis Roca Rothgerber Christie are prepared to offer advice and guidance on how to obtain trademark protection for “generic.com” marks and other marks that may fall under the purview of the Supreme Court’s most recent trademark decision. Please contact David Jackson at [DJackson@lrrc.com](mailto:DJackson@lrrc.com) or your Lewis Roca Rothgerber Christie attorney for assistance at any time.

## Author



**David Jackson**  
Associate

David Jackson is an associate in Lewis Roca Rothgerber Christie’s Intellectual Property group. His practice focuses on trademark clearance, prosecution, and enforcement.

[Read More](#) >

602.262.0807 | [DJackson@lrrc.com](mailto:DJackson@lrrc.com)

## Editor



**Jennifer Van Kirk**  
Partner

Jennifer Van Kirk counsels clients on a wide variety of IP matters, including all aspects of trademark and brand protection: trademark clearance, prosecution, licensing, portfolio management, and litigation guidance. Her experience includes traditional marks as well as 3-dimensional marks, motion marks, service trade dress, and packaging trade dress.

[Read More](#) >

602.262.0203 | [JVanKirk@lrrc.com](mailto:JVanKirk@lrrc.com)

## About The Firm

Lewis Roca Rothgerber Christie is a premier U.S.-based law firm, serving clients from around the world in complex litigation, intellectual property, business transactions, labor and employment, regulatory counseling, and government relations. More than 225 lawyers strong, we are large enough to handle virtually any matter, no matter how sophisticated, but small enough to preserve our culture of legal excellence and exceptional client service.

[Read More](#) >

[Contact Us](#)

| [Subscribe](#)

| [Visit Our Website](#)

| [Forward](#)



**Lewis Roca**  
ROTHGERBER CHRISTIE

Copyright © 2020 Lewis Roca Rothgerber Christie LLP, All rights reserved.

These materials have been prepared by Lewis Roca Rothgerber Christie LLP for general informational purposes only. These materials do not, and are not intended to, constitute legal advice. The information provided in this email is not privileged and does not create an attorney-client relationship with Lewis Roca Rothgerber Christie or any of the firm’s lawyers. This email is not an offer to represent you. You should not act, or refrain from acting, based upon any information in this email. The hiring of a lawyer is an important decision that should not be based solely on written information about qualifications or experiences. Anyone considering a lawyer should independently investigate the lawyer’s credentials and ability, and not rely upon advertisements or self-proclaimed expertise.

**Our mailing address is:**  
201 E. Washington Street, Suite 1200, Phoenix, AZ 85004

ADVERTISING MATERIAL

To opt-out from future communications, please follow [follow this link](#).