
NO MORE RESERVATIONS FOR
Booking.com

COURTS CONFIRM IT'S A TRADEMARK

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OVERVIEW

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THE MARKS

- Serial No. 79/122,366



Booking.com

- Serial No. 79/975,457

BOOKING.COM

- Serial No. 79/122,365



Booking.com

THE SUPREME COURT DECISION - HOLDING

- While we reject the rule proffered by the PTO that “generic.com” terms are generic names, we do not embrace a rule automatically classifying such terms as nongeneric. Whether any given “generic.com” term is generic, we hold, depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.
United States Patent and Trademark Office v. Booking.com B.V., 140 S. Ct. 2298, 2301 (2020)

THE SUPREME COURT DECISION - ANALYSIS

- The PTO's principal concern is that trademark protection for a term like "Booking.com" would hinder competitors. But the PTO does not assert that others seeking to offer online hotel-reservation services need to call their services "Booking.com." Rather, the PTO fears that trademark protection for "Booking.com" could exclude or inhibit competitors from using the term "booking" or adopting domain names like "ebooking.com" or "hotel-booking.com." 140 S.Ct. at 2307.

THE SUPREME COURT DECISION – ANALYSIS

(LIKELIHOOD OF CONFUSION)

- That concern attends any descriptive mark. Responsive to it, trademark law hems in the scope of such marks short of denying trademark protection altogether. Notably, a competitor's use does not infringe a mark unless it is likely to confuse consumers. 140 S.Ct. at 2307.

THE SUPREME COURT DECISION – ANALYSIS

(FAIR USE)

- And even where some consumer confusion exists, the doctrine known as classic fair use, ... protects from liability anyone who uses a descriptive term, “fairly and in good faith” and “otherwise than as a mark,” merely to describe her own goods.
140 S.Ct. at 2308.

THE SUPREME COURT DECISION – THE TEST OF GENERICNESS

- First, a “generic” term names a “class” of goods or services, rather than any particular feature or exemplification of the class. ...
Second, for a compound term, the distinctiveness inquiry trains on the term’s meaning as a whole, not its parts in isolation. ... See *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U. S. 538, 545–546 (1920). Third, the relevant meaning of a term is its meaning to consumers. ... Evidencing the Lanham Act’s focus on consumer perception, the section governing cancellation of registration provides that “[t]he primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services.” §1064(3). 140 S.Ct. at 2304.

PROCEDURAL HISTORY - 15 U.S.C. § 1071(b)

- 1. Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, ..., have remedy by a civil action
- 3. [U]nless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not.

WHAT WAS IN ISSUE – PRACTICAL TERMS

- PTO's proposed per se rule would have permitted casting into the public domain such familiar trademarks as COCA-COLA or AMERICAN AIRLINES, not to mention many other .com marks that have been registered and have achieved substantial commercial success, such as STAPLES.COM, WEATHER.COM or ANCESTRY.COM.

PTO'S STATED RATIONALE

- *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598 (1888), had held that an unprotectable corporate designation added to an unprotectable [generic?] term does not confer trademark eligibility.
- As of 1888, descriptive and generic terms were equally unprotectable under the common law. *Canal Company v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871).
- *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 171 (1995), distinguished decisions from before the enactment of the Lanham Act, which “significantly changed and liberalized the common law to ‘dispense with mere technical prohibitions,’ most notably, by permitting trademark registration of descriptive words . . . where they had acquired ‘secondary meaning.’”

FOURTH CIRCUIT DECISION – The Exception That Proves The Rule:

- While these courts [*Hotels.com, etc.*] have generally found the resulting composite of adding “.com” to certain SLDs to be generic, they have nonetheless acknowledged that on rare occasions such marks may be non-generic. Here, the district court did not err in determining that this case presents one such rare occasion where the record evidence supported a finding that the USPTO failed to meet its burden of proving that the public primarily understood BOOKING.COM to refer to the genus of online hotel reservation services, rather than the company or brand itself. *Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171, 186 (4th Cir. 2019).

NON-EXISTENT CIRCUIT SPLIT

- *In re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009).
- *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359 (Fed. Cir. 2009).
- *In re Reed Elsevier Props.*, 482 F.3d 1376 (Fed. Cir. 2007) (Lawyers.com).
- *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 981-82 (9th Cir. 2010)

CONTROLLING FEDERAL CIRCUIT LAW – BACK TO THE FUTURE

- *In re Oppedahl & Larson*, 373 F.3d 1171, 1176 (Fed. Cir. 2004). PATENTS.COM descriptive (not generic): “TLD marks may obtain registration upon a showing of distinctiveness . . . [and] [t]he Board properly left that door open for this patents.com mark” 373 F.3d at 1176. The Federal Circuit further clarified that it would be “legal error” to preclude registration of the “.com” trademark where secondary meaning is proven, *id.* at 1175-76, *as well as* if the .com mark had some inherent distinctiveness (e.g. the hypothetical “Tennis.net.” *Id.* at 1175. The court further ruled that the element .com is descriptive, not generic. *Id.* at 1176.

GRAMMAR AND LOGIC – LUDWIG WITTGENSTEIN

- TTAB admissions: “[I]t is impossible to use BOOKING.COM in a grammatically coherent way to refer generically to anything.”
- “[I]t is not at all logical to refer to a type of product or service as a ‘booking.com.’”
- Sara Jane Leslie: meaning can only be inferred from use, not presumed *a priori* from supposed consumer “understanding.”

SURVEY EVIDENCE

- For the same reason, while the dissent questions the evidence on which the lower courts relied, *post*, at ———, we have no occasion to reweigh that evidence. Cf. *post*, at ——— (SOTOMAYOR, J., concurring). 140 S.Ct. at 2316 n. 6.

LANHAM ACT PUBLIC POLICY

- Enacting the Lanham Act in 1946, Congress recognized two reasons to protect trademarks: (1) "to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get"; and (2) "where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats." S. Rep. 1333, at 1 (1946), reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1274.

LANHAM ACT PUBLIC POLICY (continued)

- The Supreme Court has embraced this logic:

[B]y preventing others from copying a source-identifying mark, [trademark law] reduce[s] the customer's costs of shopping and making purchasing decisions, for it quickly and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.

Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 163-164 (1995) (brackets in original; citation and internal quotation marks omitted).

ATTORNEYS' FEES

- *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015).
- *Peter v. NantKwest, Inc.*, 589 U. S. ____ (2019).

ATTORNEYS' FEES – FIRST AMENDMENT:

- Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, *and to petition the government for a redress of grievances.*

LESSONS

- *Other .com Marks*
- *Other implications for proving genericness*
- *Overcoming PTO refusals in general*

