

# UIC

## REVIEW OF INTELLECTUAL PROPERTY LAW



### TRADEMARK LAW AFTER *USPTO V. BOOKING.COM*: “GENERIC.COM” TAKEOVER

PAIGE MILLER

#### ABSTRACT

Booking.com is your one-stop shop, and among the most popular websites, for booking travel plans. One can book flights, hotel reservations, car rentals, and even travel attractions all on one website. But should the trademark “Booking.com” be eligible for federal trademark protection? Should any trademark with the form “generic.com” be eligible for federal trademark protection? This was the main issue in the June 2020 Supreme Court decision, *United States Patent and Trademark Office v. Booking.com B.V.*, to which Justice Ginsburg and the majority held that “Booking.com” is eligible for federal registration on the principal register. That decision, as Justice Breyer argues in his dissenting opinion, was incorrectly decided. This article will explore how trademark law disfavors awarding federal protection to “Booking.com,” and more generally, “generic.com” marks. *Booking.com* opens the door to a future anticompetitive economy where one business with a registered “generic.com” trademark will envelop the market for which it targets.

**UIC JOHN MARSHALL  
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*Cite as Paige Miller, Trademark Law After USPTO V. Booking.com: “Generic.com” Takeover, 20 UIC REV. INTELL. PROP. L. 182 (2021).*

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I. INTRODUCTION

Imagine you are a novice entrepreneur hopeful to share your passion of handmade, artisan candles with the world. With today’s increasing online market, instead of opening a brick-and-mortar store, it would be more convenient to simply have a website where customers can look through essential oils and scents to create their own custom candle for you to make and ship to them. You also hire employees for marketing, customer service, finance, product fulfillment, and information technology.

Before launching your business, you meet with a website creator in which they ask you the question you’ve anticipated most: what is the name of your website? You want your website name to be something that explains to the consumer what you are selling without being overly broad. The name of your website is “Candlely.com.”

A few weeks into the launch of “Candlely.com,” you receive an e-mail from Intellectual Property Counsel of “Candles.com” threatening trademark infringement of “Candles.com.” The e-mail says that if you do not cease all business under the name “Candlely.com,” they will proceed with legal action. As a young entrepreneur, you don’t have the funds to hire representation and you think it would be easier to terminate “Candlely.com” fearing that an alternative name including anything similar to “Candles.com” will again threaten litigation.

This hypothetical would not be a potential reality if the majority in *United States Patent and Trademark Office v. Booking.com B.V.* did not decide the case the way it did.<sup>1</sup> Unfortunately, because of this decision, the above situation will happen all too often in the future of trademark law.

In *Booking.com*, the Supreme Court held that “Booking.com” “is not a generic name to consumers”<sup>2</sup> and “whether any given ‘generic.com’ term is generic . . . 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.”<sup>3</sup>

*Booking.com* was improperly decided because the majority did not give considerable weight to the future of trademark law after its decision. This decision is

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\* © Paige Miller, Juris Doctor Candidate, May 2022, UIC John Marshall Law School; B.S. in Psychology, University of Minnesota Twin Cities (2019). Many thanks to UIC John Marshall Law School Review of Intellectual Property Law editors and staff for the countless hours of work and dedication to this journal. I would like to dedicate this article to my parents, sister, friends, and mentors – thank you for the unconditional support and motivation to help me achieve this accomplishment.

<sup>1</sup> 140 S. Ct. 2298 (2020).

<sup>2</sup> *Id.* at 2305.

<sup>3</sup> *Id.* at 2307.

detrimental for trademark law in the future because it will create an anti-competitive market where “generic.com” trademarks will create copious monopolies.

Part II (“Background”) provides background information on trademark law and internet domain names. Part III (“The Case”) provides details of *Booking.com*. This Part will include the relevant facts, procedural history, analysis, and the majority holding, as well as Justice Breyer’s dissenting opinion. Part IV (“Analysis”) expands upon the problems with the majority’s holding regarding the future of trademark law and the internet. Finally, Part V (“Conclusion”) will serve as a wrap-up of previous points and reiterate the importance of the economic consequences that will result from this case.

## II. BACKGROUND

### A. Trademark Purpose & History

The main underlying principle of trademark protection “is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”<sup>4</sup> While trademarks protect sellers by “designat[ing] the goods as the product of a particular trader and protect[ing] his good will against the sale of another’s product as his,”<sup>5</sup> it also “protect[s] the ability of consumers to distinguish among competing producers.”<sup>6</sup> Thus, 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.”<sup>7</sup>

Trademarks have “ancient origins” and existed at common law to which trademark ownership and protection was limited to “the province of the States.”<sup>8</sup> However, in 1946, because Congress concluded that trademarks “desirably promote competition and the maintenance of product quality,” it enacted the Lanham Act<sup>9</sup> “in order to provide national protection for trademarks used in interstate and foreign commerce.”<sup>10</sup> Under the Lanham Act, a trademark owner may obtain federal protection

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<sup>4</sup> *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). See also *In re Sones*, 590 F.3d 1282, 1287 (Fed. Cir. 2009) (“the purpose of a trademark is to distinguish goods and to identify the source of the goods.”) (citing *In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1367 (Fed. Cir. 1999)); *Burris Carpet Plus, Inc. v. Burris*, 785 N.W.2d 164, 173 (N.D. 2010) (A mark must “identify the provider of the goods or services, distinguishing the user’s goods or services from the goods or services of others in the customers’ minds.”).

<sup>5</sup> *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918).

<sup>6</sup> *Park’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

<sup>7</sup> *Qualitex Co. v. Jacobson Prod. Co., Inc.*, 514 U.S. 159, 163–64 (1995) (emphasis in original) (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01[2] (3d ed. 1994)).

<sup>8</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (citing 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:8 (4th ed. 2017)).

<sup>9</sup> See generally *The Lanham Act*, 15 U.S.C. §§ 1051–1141.

<sup>10</sup> *Park’N Fly*, 469 U.S. at 193 (Other reasons for adoption of the Lanham Act included “rights to trademarks were uncertain and subject to variation in different parts of the country” and “Congress

through the Patent and Trademark Office (“PTO”) who “administers a federal registration system for trademarks.”<sup>11</sup>

There are two types of registers: the principal register and the supplemental register, the supplemental register being available for marks that are currently ineligible to be registered under the principal register.<sup>12</sup> Although registering a mark is not mandatory and “the owner of an unregistered mark may still use it in commerce and enforce it against infringers . . . registration [on the principal register] gives trademark owners valuable benefits.”<sup>13</sup> These benefits include “prima facie evidence of the validity of the registered mark”<sup>14</sup> and “constructive notice of the registrant’s claim of ownership” if possible infringement arises.<sup>15</sup>

Trademark owners wishing to register a trademark will file an application with the PTO where an Attorney Examiner will determine the eligibility of the mark.<sup>16</sup> If the Examining Attorney determines there are “statutory bars to registration,”<sup>17</sup> the examiner might “reject the application in whole or in part, [or] request further information” to which “the applicant can then respond to this ‘Office Action’” where the applicant and the PTO will communicate back and forth about the mark’s eligibility.<sup>18</sup> If the mark is finally rejected by the PTO, “[a]n appeal may be taken to the Trademark Trial and Appeal Board (“TTAB”) from any final decision of the examiner in charge of the registration of marks.”<sup>19</sup> If the TTAB upholds the decision of the Examining Attorney, the applicant may appeal to the United States Court of Appeals for the

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determined that ‘a sound public policy requires that trademarks should receive nationally the greatest protection’” because trademarks “promote competition and the maintenance of product quality”).

<sup>11</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019); see 15 U.S.C. §§ 1051, 1052.

<sup>12</sup> *In re Bush Bros. & Co.*, 884 F.2d 569, 570 (Fed. Cir. 1989) (“A mark that does not meet all the requirements for registration on the Principal Register, but that is ‘capable of distinguishing the applicant’s goods or services’ may be registered on the Supplemental Register.”); *In re Bachman Chocolate Mfg. Co.*, 153 U.S.P.Q. 753, 753 (T.T.A.B. 1967). In determining whether applicant’s candy bar shape was registrable on the supplemental register, the court stated:

the shape of applicant’s candy bar is somewhat unique in design and since the examiner has made nothing of record to show that this configuration is either so non-distinctive as to be incapable of distinguishing or has any functional aspects, it must be held that it is, prima facie, capable of distinguishing applicant’s goods and, therefore, registrable on the Supplemental Register.

See 15 U.S.C. § 1091.

<sup>13</sup> *Iancu*, 139 S. Ct. at 2297 (citing *Matal*, 137 S. Ct. at 1752).

<sup>14</sup> 15 U.S.C. § 1115(a).

<sup>15</sup> *Id.* § 1072; See 15 U.S.C. § 1115(b) (“[A mark that] has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable”).

<sup>16</sup> 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:124.50 (5th ed. 2020); see 15 U.S.C. § 1051.

<sup>17</sup> See 15 U.S.C. § 1052(a)-(f) (some of the statutory bars to registration include “deceptive matter”, or “matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols”).

<sup>18</sup> See MCCARTHY, *supra* note 16, § 19:124.50.

<sup>19</sup> 15 U.S.C. § 1070.

Federal Circuit or, as an alternative, choose to “obtain review by a civil action filed in a district court.”<sup>20</sup>

### B. *Spectrum of Distinctiveness*

Under the Lanham Act, “federal trademark protection is available only to ‘distinctive’ marks—marks that serve the purpose of identifying the *source* of . . . goods or services.”<sup>21</sup> A mark is distinctive if it is “inherently distinctive” or if “it can acquire distinctiveness over time.”<sup>22</sup> A mark is “inherently distinctive” when “its intrinsic nature serves to identify its particular source.”<sup>23</sup> A mark has “acquired distinctiveness” when “there is an association formed in the minds of the consumers between the mark and the source or origin of the product.”<sup>24</sup> In other words, a mark with acquired distinctiveness “might initially have been understood to describe a broad class of potential products or services, but over time it has taken on a ‘secondary meaning’ that links it to a particular source.”<sup>25</sup>

Trademarks are grouped into “categories of generally increasing distinctiveness . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”<sup>26</sup> Suggestive, arbitrary, and fanciful marks, “because of their intrinsic nature serve[] to identify a particular source of a product, are deemed inherently distinctive

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<sup>20</sup> MCCARTHY, *supra* note 16, § 21:20; *see* 15 U.S.C § 1071; *see also* CAE, Inc. v. Clean Air Engineering, Inc., 267 F.3d 660, 673 (7th Cir. 2001) (“In an appeal to the Federal Circuit, the case proceeds on the closed administrative record and no new evidence is permitted. In contrast, an appeal to the district court is both an appeal and a new action, which allows the parties to request additional relief and to submit new evidence.”).

<sup>21</sup> Royal Palm Properties, LLC v. Pink Palm Properties, LLC, 950 F.3d 776, 782 (11th Cir. 2020) (quoting Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1357 (11th Cir. 2007)).

<sup>22</sup> *Royal Palm*, 950 F.3d at 782.

<sup>23</sup> Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 381 (2d Cir. 2005); *see also id.* (Coca-Cola is an example of an inherently distinctive mark because it “describes only one brand of soft drink”).

<sup>24</sup> Real Foods Pty. Ltd. v. Frito-Lay N. Am., Inc., 906 F.3d 965, 978 (Fed. Cir. 2018) (quoting Tone Bros., Inc. v. Sysco Corp., 28 F.3d 1192, 1201 (Fed. Cir. 1994)).

<sup>25</sup> *Royal Palm*, 950 F.3d at 783. *See* Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc., 696 F.3d 206, 226 (2d Cir. 2012) (holding that Louboutin’s Red Sole Mark for a painted “high-gloss red lacquer” on the “outsoles” of its footwear has acquired secondary meaning because extensive advertising and sales demonstrate that the symbol is “uniquely associated with the Louboutin brand”); *see also Real Foods*, 906 F.3d at 978 (Real Foods’ proposed descriptive mark “Corn Thins” for “popped corn cakes” have not acquired distinctiveness because Real Foods performed small amounts of advertising, did not have high sales, and consumers had “low brand loyalty”).

<sup>26</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). *See Hickory Farms, Inc. v. Snackmasters, Inc.*, 500 F. Supp. 2d 789, 795 (N.D. Ill. 2007) (holding that “beef stick” and “turkey stick” are generic because they “named . . . beef or turkey prepared and packed in stick form”); *Baig v. Coca-Cola Co.*, 69 F. Supp. 3d 766, 775 (N.D. Ill. 2014) (holding that “Naturally Zero” is descriptive because it “immediately conveys . . . that the spring water sold by Plaintiffs contains no calories or additives”); *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1126 (9th Cir. 2014) (“POM” used in connection with pomegranate juice beverages is suggestive because the word “POM” “requires customers to use some additional imagination and perception to decipher the nature of Pom Wonderful’s goods”); *Omega S.A. v. Omega Eng’g, Inc.*, 228 F. Supp. 2d 112, 123 (D. Conn. 2002) (The mark “Omega” for watches is arbitrary because the word “omega” does not suggest time or watches); *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116, 117 (W.D.N.Y. 1989) (“Kodak trademark is perhaps one of the strongest and most distinctive trademarks in this country, if not in the world.”).

and are entitled to protection.”<sup>27</sup> A descriptive mark, that “describes the product’s features, qualities, or ingredients . . . [is] not inherently distinctive, and a showing that the mark has acquired distinctiveness— ‘secondary meaning’—is required before protection will be extended.”<sup>28</sup>

A generic term, one that refers to “the genus of which the particular product is a species,” is ineligible for trademark protection.<sup>29</sup> At common law, “neither those terms which were generic nor those which were merely descriptive could become valid trademarks.”<sup>30</sup> When the Lanham Act was adopted, it “makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, . . . [but] it offers no such exception for generic marks.”<sup>31</sup> Therefore, “even proof of secondary meaning, by virtue of which some ‘merely descriptive’ marks may be registered, cannot transform a generic term into a subject for trademark.”<sup>32</sup> Due to the ineligibility of generic terms to be registered, if a protected and registered mark becomes generic, it will be cancelled.<sup>33</sup> Consequently, in a situation where the “majority of the relevant public appropriates a trademark term as the name of a product (or service), the mark is a victim of ‘genericide’ and trademark rights generally cease.”<sup>34</sup> Terms that fell victim to genericide include “aspirin,’ ‘cellophane,’ and ‘escalator.’”<sup>35</sup>

Generic names are “irretrievably in the public domain,”<sup>36</sup> and there are multiple policy reasons that favor the ineligibility of trademark protection for generic names.<sup>37</sup> The Supreme Court has stated that, “[s]haring in the goodwill of an article unprotected by . . . trade-mark is the exercise of a right possessed by all-and in the free exercise of which the consuming public is deeply interested.”<sup>38</sup> Furthermore, protection for generic terms would create anti-competitive effects because “[a]llowing a generic term to have trademark protection would overstep the purposes of trademark law and violate fundamental concepts of fair competition . . . [A company] cannot appropriate the English language, and by doing so render a competitor inarticulate.”<sup>39</sup> Trademarks should not be used to “perpetuate product monopolies”; instead “trademark policies are designed to protect consumers from being misled as to the enterprise . . . from which

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<sup>27</sup> *Two Pesos*, 505 U.S. at 768.

<sup>28</sup> *Lane Cap. Mgmt., Inc. v. Lane Cap. Mgmt., Inc.*, 192 F.3d 337, 344 (2d Cir. 1999) (citing *Two Pesos*, 505 U.S. at 768–69).

<sup>29</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); see 15 U.S.C. § 1064(3).

<sup>30</sup> *Abercrombie*, 537 F.2d at 9 (citing *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 323 (1872)).

<sup>31</sup> *Abercrombie*, 537 F.2d at 9.

<sup>32</sup> *Id.*

<sup>33</sup> *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007); see 15 U.S.C. § 1064(3).

<sup>34</sup> *Freecycle*, 505 F.3d at 905.

<sup>35</sup> MCCARTHY, *supra* note 16, § 12:1. See *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936); *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80, 81 (1950).

<sup>36</sup> *Henri’s Food Prods. Co., Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1305 (7th Cir. 1987).

<sup>37</sup> MCCARTHY, *supra* note 16, § 12:1.

<sup>38</sup> *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938).

<sup>39</sup> *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153, 1162 (7th Cir. 1996) (quoting *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609–10 (7th Cir. 1986)). See *CES Pub. Corp. v. St. Regis Publ’n., Inc.*, 531 F.2d 11, 13 (2d Cir. 1975) (“To allow trademark protection for generic terms . . . even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”).



the goods or services emanate . . . and to achieve these ends in a manner consistent with the objectives of free competition.”<sup>40</sup>

### C. Importance of Consumer Perception

Because one of the main purposes of trademark law, and the Lanham Act, is to “protect . . . the consumers of the country,”<sup>41</sup> how consumers perceive a trademark is critical. McCarthy on Trademarks and Unfair Competition states that “the customer’s state of mind is key to all trademark disputes” and “the customer’s state of mind is paramount to determine . . . validity.”<sup>42</sup> Consumer perception is usually assessed through consumer surveys that, “examin[e] the average potential consumer in the context of the existing marketplace and exposed to the information currently available in the marketplace.”<sup>43</sup> Consumer surveys are used throughout trademark disputes, including whether a mark has secondary meaning or whether false advertising is present; however, “consumer survey[s] [are] the most definitive evidence of [a mark’s] genericness.”<sup>44</sup> Consumer surveys are “routinely admitted” by courts in trademark cases and are “far more prevalent in trademark law than in most other areas [of law].”<sup>45</sup> Not all surveys are admitted: “Once the survey is admitted, however, follow-on issues of methodology, survey design, reliability, the experience and reputation of the expert, critique of conclusions, and the like going to the weight of the survey rather than its admissibility.”<sup>46</sup>

Although surveys are prevalent in trademark disputes, there are “ongoing controversies that tend to complicate the question of whether survey evidence should

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<sup>40</sup> *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 611 F.2d 296, 300-01 (9th Cir. 1979) (citing *HMH Publ’g Co. v. Brincat*, 504 F.2d 713, 716 (9th Cir. 1974)).

<sup>41</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 781-82 (1992) (Stevens, J., concurring) (Explaining Congressman Lanham’s statement regarding the purposes underlying the trademark statute. The purposes also included, “foster[ing] fair competition” and “secur[ing] to the business community the advantages of reputation and good will by preventing their diversion”).

<sup>42</sup> MCCARTHY, *supra* note 16, § 2:22. See *Uncommon, LLC v. Spigen, Inc.*, 305 F. Supp. 3d 825, 845 (N.D. Ill. 2018) (“this case turns primarily on consumer perception of the parties’ products and marks”).

<sup>43</sup> *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 995 (7th Cir. 1989).

<sup>44</sup> *Select Comfort Corp. v. Baxter*, 156 F. Supp. 3d 971, 983 (D. Minn. 2016). See *March Madness Athletic Ass’n, LLC v. Netfire, Inc.*, 310 F. Supp. 2d 786, 803-04 (N.D. Tex. 2003) (The mark “March Madness” describing basketball tournaments in March has acquired secondary meaning and is not a generic mark because consumer surveys concluded that “the primary significance of March madness, to members of the public . . . is a trade name relating to basketball.”), *aff’d*, 120 F. App’x 540 (5th Cir. 2005).

<sup>45</sup> *Schering Corp. v. Pfizer Inc.*, 189 F.3d 218, 225 (2d Cir. 1999). See *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 969 (Fed. Cir. 2015) (“Consumer surveys have become almost de rigeur in litigation over genericness.”).

<sup>46</sup> *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1263 (9th Cir. 2001). See *Shire City Herbals, Inc. v. Blue*, 410 F. Supp. 3d 270, 289 (D. Mass. 2019) (surveys that “sampled an overbroad population” have “limited, if any, probative value” for determining the genericness of “Fire Cider” for herbal drinks); *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 304 (S.D.N.Y. 2000) (surveys that had “serious flaws” such as questions that suggest the answers and questions being based on a faulty premise were not helpful in determining whether “Pilates” is generic for a method of exercise).

be admitted.”<sup>47</sup> The relevance of a survey will be undermined when “the term at issue was regularly used before the plaintiff sought trademark protection.”<sup>48</sup> Surveys that “[s]imply assert[] consumer awareness of the term begs the question” whether the term is generic.<sup>49</sup>

#### D. *Trademark Infringement & Likelihood of Confusion Standard*

A trademark infringes on another if it is “likely to cause confusion.”<sup>50</sup> A likelihood of confusion “exists between two marks if ‘the defendant’s actual practice is likely to produce confusion in the minds of consumers about the origin of the goods or services in question.’”<sup>51</sup> To determine whether a likelihood of confusion exists, each circuit performs its own “non-exclusive” factor test, which usually include considering “the strength of the plaintiff’s mark,” “the similarity of the two marks,” and “the similarity of the goods or services that the marks identify.”<sup>52</sup> A “statutory affirmative defense” to a trademark infringement claim is fair use.<sup>53</sup> Fair use demonstrates that “a junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a trademark.”<sup>54</sup>

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<sup>47</sup> *Schering*, 189 F.3d at 227. See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1305 (Fed. Cir. 2009) (consumer surveys given little weight, holding that “Hotels.com” is generic for services of providing temporary lodging).

<sup>48</sup> *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 976 (8th Cir. 2006) (survey evidence was irrelevant to determine whether “Brick Oven” for frozen pizza was generic because the term was already commonly used “before either party began labeling their frozen pizzas”) (citing *Miller Brewing Co. v. Joseph Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979)). See *Hunt Masters, Inc. v. Landry’s Seafood Restaurant, Inc.*, 240 F.3d 251, 255 (4th Cir. 2001) (“Hunt does not claim to have first coined the term ‘crab house.’ Therefore, it is not necessary to determine whether the term has become generic through common use, rendering Hunt’s customer survey irrelevant.”).

<sup>49</sup> *Stuhlbarg Intern. Sales. Co., Inc. v. John D. Brush & Co., Inc.*, 240 F.3d 832, 840 (9th Cir. 2001).

<sup>50</sup> 15 U.S.C. § 1114(1)(a).

<sup>51</sup> *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 158 (4th Cir. 2014) (quoting *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004)).

<sup>52</sup> *Compare Swatch*, 739 F.3d at 158 (factors considered were (1) strength of the mark as actually used in the marketplace; (2) similarity between the two marks to consumers; (3) similarity of the goods; (4) similarity of the facilities used; (5) similarity of the advertising; (6) defendant’s intent; (7) actual confusion; (8) quality of defendant’s product; and (9) sophistication of consuming public), *with In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (factors considered were (1) similarity of the marks; (2) similarity of goods or services; (3) similarity of trade channels; (4) buyers’ care; (5) fame of prior marks; (6) third party use of the mark on similar goods; (7) actual confusion; (8) how long there has been concurrent use and no confusion; (9) variety of goods; (10) market interface; (11) applicant’s right to exclude others from use of its mark; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of the use).

<sup>53</sup> 15 U.S.C. § 1115(b)(4).

<sup>54</sup> *Bell v. Harley Davidson Motor Co.*, 539 F. Supp. 2d 1249, 1257 (S.D. Cal. 2008) (“The precise elements of the classic fair use defense are that the defendant (1) is not using the term as a trademark, (2) uses the term only to describe its goods and services, and (3) uses the term fairly and in good faith.”).

### E. Composite Terms

*Booking.com* concerned a compound, or composite, term, which is when more than one word is used.<sup>55</sup> To determine the validity of a composite term, the Supreme Court has stated that, “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.”<sup>56</sup> Therefore, “[w]ords which could not individually become a trademark may become one when taken together.”<sup>57</sup> When looking at a composite mark as a whole, a once descriptive term may result in a generic combination with the addition of a generic term.<sup>58</sup>

Both the majority opinion and dissenting opinion laboriously discuss *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*<sup>59</sup> when determining trademark eligibility for the mark in question. In *Goodyear*, the Supreme Court held that “Goodyear Rubber Company’ is not one capable of exclusive appropriation” because “Goodyear Rubber’ are terms descriptive of well-known classes of goods produced by the process known as ‘Goodyear’s Invention’” and “[t]he addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them.”<sup>60</sup> The Court further stated that “[n]ames of such articles cannot be adopted as trade-marks . . . nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.”<sup>61</sup>

### F. Domain Names

Finally, *Booking.com* discusses trademark eligibility for a mark ending in “.com”.<sup>62</sup> A domain name is “the Internet address of a Web site” also known as the “uniform resource locator (url).”<sup>63</sup> A domain name consists of (1) a top level domain name (“TLD”) and (2) a second level domain name (“SLD”), appearing to the left of the top level domain name.<sup>64</sup> The most common top level domain names are “.org,” “.net,” “.gov,” and “.com,” with most United States firms preferring to use “.com” as its top

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<sup>55</sup> United States Patent and Trademark Office v. *Booking.com B.V.*, 140 S. Ct. 2298, 2301 (2020). See MCCARTHY, *supra* note 16, § 11:27.

<sup>56</sup> *Ex Rel. P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920).

<sup>57</sup> *Cal. Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985) (quoting *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976)).

<sup>58</sup> See *In re Ampco Foods, Inc.*, 227 U.S.P.Q. (BNA) ¶ 331 (T.T.A.B. 1985) (The mark “Russet Fries” for “dehydrated potato mixtures for french frying” is a generic term and cannot be registered on Principle Register). *But see* *Wash. Speakers Bureau, Inc. v. Leading Authorities, Inc.*, 33 F. Supp. 2d 488, 495-96 (E.D. Va. 1999) (Although “The Speakers Bureau” is generic, the addition of “Washington” to “Speakers Bureau” “converts the generic name to a descriptive mark”).

<sup>59</sup> 128 U.S. 598, 602-03 (1888).

<sup>60</sup> *Id.* at 602.

<sup>61</sup> *Id.* at 603.

<sup>62</sup> *Booking.com*, 140 S. Ct. at 2301.

<sup>63</sup> 6 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 22:38 (4th ed. 2020); 1 NEIL SMITH, INTERNET LAW AND PRACTICE § 13:10 (2020).

<sup>64</sup> 2 VED P. NANDA ET AL., LITIGATION OF INTERNATIONAL DISPUTES IN U.S. COURTS § 8:31 (2020); MCCARTHY, *supra* note 16, § 25A:11.

level domain name.<sup>65</sup> In “Booking.com,” “Booking” is the second level domain name and “.com” is the top level domain name. When registering a domain name, because each domain name is unique, if the requested domain name has already been assigned to someone else, the applicant must choose a different one.<sup>66</sup> At the close of the second quarter in 2020, there were about 370.1 million domain name registrations across all TLDs, an increase of about 3 million domain name registrations compared to the first quarter of 2020.<sup>67</sup> At the end of the second quarter of 2020, the largest TLD reported to be “.com” with about 149 million reported domain names using that TLD.<sup>68</sup>

Domain names are subject to the same restrictions as any other mark to determine its eligibility for registration, therefore generic domain names are ineligible and may not be registered.<sup>69</sup> The Trademark Manual of Examining Procedure states that “when a trademark . . . is composed in whole or in part, of a domain name, neither the beginning of the URL nor the TLD have any source-indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address.”<sup>70</sup> Thus, the PTO usually argues that “.com” and other TLDs do not add distinctiveness to the domain name to act as a trademark.<sup>71</sup> This principle has been routinely used by courts when rejecting the eligibility of domain names if the TLD is being added to an otherwise non-registerable, generic SLD.<sup>72</sup>

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<sup>65</sup> See MCCARTHY, *supra* note 16, §§ 25A:11 & 7:15.50; 1 SMITH, *supra* note 63, § 13:10; 2 NANDA ET AL., *supra* note 64, § 8:31.

<sup>66</sup> Brookfield Comm., Inc. v. West Coast Ent. Corp., 174 F.3d 1036, 1044 (9th Cir. 1999). The organization responsible for checking the availability of a domain name and subsequent registration is The Internet Corporation for Assigned Names and Numbers (“ICANN”). See MCCARTHY, *supra* note 16, § 25A:12.

<sup>67</sup> VERISIGN, [https://www.verisign.com/en\\_US/domain-names/dnib/index.xhtml?section=executive-summary](https://www.verisign.com/en_US/domain-names/dnib/index.xhtml?section=executive-summary) (last visited Sept. 27, 2020).

<sup>68</sup> *Id.*

<sup>69</sup> 1 SMITH, *supra* note 63, § 13:12. See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1362 (Fed. Cir. 2009) (holding that “Mattress.com” is generic); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177 (Fed. Cir. 2004) (“patents.com” is merely descriptive and ineligible for trademark registration).

<sup>70</sup> U.S. PAT. & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1215.02 (22nd ed. Oct. 2018).

<sup>71</sup> *Id.*

<sup>72</sup> See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1306 (Fed. Cir. 2009) (holding that “Hotels.com” is generic because the separate terms “hotel” and “.com” “in combination have a meaning identical to the common meaning of the separate components.”); *Borescopes R U.S. v. 1800Endoscope.com, LLC*, 728 F. Supp. 2d 938, 948-49 (M.D. Tenn. 2010) (holding that [www.borescopesrus.com](http://www.borescopesrus.com) is generic and ineligible for registration); *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007) (“Lawyers.com”, a website providing interactive exchange of legal services and legal news is generic). *But see In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (holding that “Steelbuilding.com” is not generic because “The addition of the TLD indicator expanded the meaning of the mark to include internet services that include ‘building’ or designing steel structures”).

### III. THE CASE

#### A. Facts & Procedural History

Booking.com is a digital company used for travel reservations with the domain name of its website also being “Booking.com”.<sup>73</sup> Booking.com’s 2011 and 2012 trademark applications for “Booking.com” were refused.<sup>74</sup> The PTO and TTAB deduced that “Booking” means “making travel reservations” and “.com” “signifies a commercial website.”<sup>75</sup>

Booking.com sought review in the United States District Court for the Eastern Division of Virginia and introduced consumer surveys as new evidence of consumer perception.<sup>76</sup> Relying heavily on this evidence, the district court determined that “Booking.com,” unlike “booking” is not generic because the “consuming public . . . primarily understands that BOOKING.COM does not refer to a genus, rather it is descriptive of services involving ‘booking’ available at that domain name.”<sup>77</sup> “Booking.com,” according to the district court, is trademark eligible.<sup>78</sup>

The PTO appealed the determination that “Booking.com” is not generic to the United States Court of Appeals for the Fourth Circuit.<sup>79</sup> The PTO argued that the combination of “.com” with a generic term like “booking” is “necessarily generic.”<sup>80</sup> The Fourth Circuit rejected the PTO’s argument and affirmed the decision of the district court.<sup>81</sup> The Supreme Court granted certiorari to review the Fourth Circuit’s decision.<sup>82</sup>

#### B. Supreme Court Decision

The main issue before the Supreme Court was whether “Booking.com,” taken as a whole is generic.<sup>83</sup> In order to resolve this issue, the Court concluded that it must turn on whether “Booking.com” “signifies to consumers the class of online hotel-reservation services.”<sup>84</sup>

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<sup>73</sup> *Booking.com*, 140 S. Ct. at 2303.

<sup>74</sup> *Id.* See *Booking.com B.V. v. United States Patent and Trademark Office*, 915 F.3d 171, 177 (4th Cir. 2019).

<sup>75</sup> *Booking.com*, 140 S. Ct. at 2303. The PTO and TTAB determined that “Booking.com” is “generic for the services at issue” and that “customers would understand the term BOOKING.COM primarily to refer to an online reservation service for travel, tours, and lodgings.”

<sup>76</sup> *Id.* The survey indicated that 74.8% of participants thought that “Booking.com” is a brand name and 23.8% believed it was a generic name. *Id.* at 2313-14.

<sup>77</sup> *Id.* at 2303. See *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 918 (2017).

<sup>78</sup> *Booking.com*, 140 S. Ct. at 2303-04.

<sup>79</sup> *Id.* at 2304.

<sup>80</sup> *Id.* See *Booking.com B.V. v. United States Patent and Trademark Office*, 915 F.3d 171, 184 (4th Cir. 2019).

<sup>81</sup> *Booking.com*, 140 S. Ct. at 2304.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 2304-05 In determining the genericness of “Booking.com”, the majority created an analogy in which it said that “if ‘Booking.com’ were generic, we might expect consumers to understand Travelocity—another such service—to be a ‘Booking.com.’”

The majority recognized through the undisputed consumer surveys that “Booking.com” is not generic because “Booking.com” is not a generic name to consumers.<sup>85</sup> The majority rejected the PTO’s suggested rule that when a generic term is combined with a top-level domain like “.com,” (making “generic.com”) the resulting combination is generic.<sup>86</sup>

In support of its argument, the PTO relied on *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*<sup>87</sup> It argued that “Generic.com” is comparable to “Generic Company,” which was ineligible for trademark protection in *Goodyear*, because adding “.com” to a generic term “conveys no additional meaning that would distinguish [one provider’s] service from those of the other providers.”<sup>88</sup>

In rejecting this argument, the Court noted that “generic.com” terms are not capable of signifying an entire class of online goods or services because only one entity can occupy a particular internet domain name.<sup>89</sup> Thus, consumers could understand a “generic.com” term to refer to the singular website, which is not a class of goods or services.<sup>90</sup> The Court also used the PTO’s past practices to reject its argument, such as accepting “DATING.COM” on the supplemental register.<sup>91</sup>

The PTO argued that trademark protection for terms like “Booking.com” “would hinder competitors” and “Booking.com” would monopolize similar language that should be free to use.<sup>92</sup> The PTO also argued that Booking.com has already “seized a domain name that no other website can use and is easy for consumers to find. Consumers might enter ‘the word “booking” in a search engine’ . . . or ‘proceed directly to “booking.com” in the expectation that [online hotel-booking] services will be offered.’”<sup>93</sup>

The Court explained that the likelihood of confusion doctrine would guard against anticompetitive effects and prevent Booking.com from holding a monopoly on the term “booking.”<sup>94</sup> The Court recognized that Booking.com acknowledged that its mark is weak, making it more difficult to show a likelihood of confusion and that the company understands that close variations to its mark are unlikely to infringe.<sup>95</sup> The Court concluded that the competitive advantages that Booking.com obtains in terms of its

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<sup>85</sup> *Id.* at 2305.

<sup>86</sup> *Booking.com*, 140 S. Ct. at 2305.

<sup>87</sup> 128 U.S. 598, 602-03 (1888).

<sup>88</sup> *Booking.com*, 140 S. Ct. at 2305-06. See *Goodyear’s India Rubber Glove Mfg. Co.*, 128 U.S. at 599-604. The Court held that “Goodyear Rubber Company’ is not one capable of exclusive appropriation” because “Goodyear Rubber” are descriptive terms and “[n]ames which are thus descriptive of a class of goods cannot be exclusively appropriated by anyone.” In addition, including the word “Company” at the end of a mark “only indicates that parties have formed an association or partnership to deal in such goods” and does not “create any exclusive right to use the name of the mark.” Thus, Goodyear Rubber Company did not have an exclusive right to use the purported mark and Defendant, attempting to reach the public “to its own manufactured goods” could not be restrained from use of its mark.

<sup>89</sup> *Booking.com*, 140 S. Ct. at 2305-06

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 2305. See DATING.COM, Registration No. 2,580,467.

<sup>92</sup> *Booking.com*, 140 S. Ct. at 2307.

<sup>93</sup> *Id.* at 2308.

<sup>94</sup> *Id.* at 2307-08.

<sup>95</sup> *Id.* at 2308.

domain name does not automatically make the mark ineligible for trademark protection.<sup>96</sup>

In making its final holding, the Court stated that whether a “generic.com” term is generic, “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.”<sup>97</sup> The Court affirmed the Fourth Circuit that “Booking.com” is eligible for trademark protection.<sup>98</sup>

### C. Breyer’s Dissent

Justice Breyer wrote a powerful dissent discussing his legal and economic concerns with the majority’s decision.<sup>99</sup> Breyer applied the principle in *Goodyear* to internet domain names in support of his argument that “Booking.com” is generic and ineligible for trademark registration.<sup>100</sup> Breyer argued that, “[w]hen a website uses an inherently distinctive second-level domain . . . adding ‘.com’ merely denotes a website associated with that term.”<sup>101</sup> Thus, “Booking.com is no more and no less than a website associated with its generic second-level domain, ‘booking.’”<sup>102</sup>

Breyer also addressed concerns with the consumer surveys that were so heavily relied upon in the lower courts.<sup>103</sup> The majority stated that “only one entity can own the rights to a particular domain name.”<sup>104</sup> However, this is present in every “generic.com” case and in order to prevent “automatic trademark eligibility for every ‘generic.com’ domain,” survey evidence could be relied upon.<sup>105</sup> Breyer blamed advertising as the reason why consumers identified “Booking.com” as a brand name rather than a generic name and argued that, “[i]f someone were to start a company called ‘Washingmachine.com,’ it could likely secure a similar level of consumer identification by . . . advertising.”<sup>106</sup> Breyer strongly doubted the reliability of the consumer surveys because the surveys “tested consumers’ association of “Booking.com” with a particular company, not anything about the term itself . . . such an association does not establish that a term is nongeneric.”<sup>107</sup>

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<sup>96</sup> *Id.*

<sup>97</sup> *Booking.com*, 140 S. Ct. at 2307.

<sup>98</sup> *Id.* at 2308-09.

<sup>99</sup> *Id.* at 2309 (Breyer, J., dissenting).

<sup>100</sup> *Id.* at 2311.

<sup>101</sup> *Id.* at 2312.

<sup>102</sup> *Booking.com*, 140 S. Ct. at 2312.

<sup>103</sup> *Id.* at 2313.

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

<sup>106</sup> *Id.* at 2314. The survey showed that 33% of participants believed that “Washingmachine.com” (a fictitious company) is a brand and 60.8% thought it was generic.

<sup>107</sup> *Booking.com*, 140 S. Ct. at 2314 (Breyer explained that although the viewpoint that consumer surveys are unreliable is the minority view, he believes it is the correct one and it is supported by case law and a well-known trademark treatise); see MCCARTHY, *supra* note 16, § 12:17.25; Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118-19 (1938); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

Finally, Breyer feared that “granting trademark protection to ‘generic.com’ marks threatens serious anticompetitive consequences in the online marketplace.”<sup>108</sup> Breyer professed that, as a main principle in trademark law, “[t]erms that merely convey the nature of the producer’s business should remain free for all to use.”<sup>109</sup> The “advantages of doing business under a generic name . . . irrespective of the trademark laws” are extensive.<sup>110</sup> They include “less effort and expense educating consumers” due to generic names being easy to remember, “immediately convey[ing] the nature of the business,” and automatically creating “the impression that it is the most authoritative and trustworthy source of the particular goods.”<sup>111</sup>

Breyer discussed additional competitive advantages that are unique to the internet.<sup>112</sup> There can only be one “Booking.com” due to automatic, worldwide exclusivity associated with domain name ownership.<sup>113</sup> Generic domain names “are easier for consumers to find” because the domain name is the type of good or service they are looking for.<sup>114</sup> Furthermore, the owner of a generic trademark is allowed to “exclude others from using *similar* domain names [and] to threaten trademark lawsuits against competitors.”<sup>115</sup> Although in this case Booking.com argued that it would not threaten competitors with lawsuits, “other firms may prove less restrained.”<sup>116</sup>

Breyer contended that through the majority’s reasoning, “many businesses could obtain a trademark by adding ‘.com’ to the generic name of their product.”<sup>117</sup> Consequently, Breyer sees a future economy “in an anticompetitive direction” and, at the extreme, “that direction points towards one firm per product, the opposite of the competitive multifirm marketplace that our basic economic laws seek to achieve.”<sup>118</sup> Breyer also concerned himself with the “threat of costly litigation [that] will no doubt chill others from using variants on the registered mark and privilege established firms over new entrants to the market.”<sup>119</sup> Breyer concluded by stating his fear that the majority’s decision “will lead to a proliferation of ‘generic.com’ marks, granting their owners a monopoly over a zone of useful, easy-to-remember domains.”<sup>120</sup>

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<sup>108</sup> *Booking.com*, 140 S. Ct. at 2314.

<sup>109</sup> *Id.* at 2313.

<sup>110</sup> *Id.* at 2314.

<sup>111</sup> *Id.* (citing Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J 1323, 1337-1338 (1980)).

<sup>112</sup> *Booking.com*, 140 S. Ct. at 2314.

<sup>113</sup> *Id.* at 2314-15.

<sup>114</sup> *Id.* at 2315.

<sup>115</sup> *Id.* Examples given by Breyer of domain names that could threaten trademark lawsuits if used by competitors include “Bookings.com,” “eBookings.com,” “Booker.com,” or “Bookit.com.”

<sup>116</sup> *Id.*

<sup>117</sup> *Booking.com*, 140 S. Ct. at 2315.

<sup>118</sup> *Id.* See also *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 603 (1888). The court stating in part that:

No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured, rather than protected, for competition would be destroyed.

<sup>119</sup> *Booking.com*, 140 S. Ct. at 2315

<sup>120</sup> *Id.* at 2315-16.



## IV. ANALYSIS

A. “*Booking.com*” is Generic

As a preliminary matter, the Court was incorrect in holding that “*Booking.com*” is not generic.<sup>121</sup> Holding that a compound term as a whole is generic that includes a generic SLD and the TLD “.com” is not a novel pronouncement. There are various cases in which terms similar in structure to “*Booking.com*” were deemed generic.<sup>122</sup>

In these instances, there was wide skepticism regarding the significance of the TLD “.com” in a term.<sup>123</sup> The skepticism was still present even while acknowledging that “only one entity can hold a particular domain name,”<sup>124</sup> as the *Booking.com* majority relied upon to support its conclusion that “.com” indicates a source identifying characteristic.<sup>125</sup> However, cases deciding the same issue as *Booking.com* determined that “.com” simply “only indicates that the goods are available via the Internet.”<sup>126</sup>

The majority’s reasoning that “generic.com” is not analogous to “Generic Company” in its source identifying characteristics is flawed. Adding “Company,” or any corporate designation, to the end of a term means that, “parties have formed an association or partnership to deal in such goods.”<sup>127</sup> This does not aid in any source

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<sup>121</sup> *Booking.com*, 140 S. Ct. at 2305.

<sup>122</sup> See *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 978 (9th Cir. 2010) (“ADVERTISING.COM is generic. When any online advertising company, including AOL’s competitors, is asked the question ‘what are you?’ it would be entirely appropriate for the company to respond ‘an advertising.com’ or ‘an advertising dot-com.’”); *In re Hotels.com*, 573 F.3d 1300, 1306 (2009) (“The Board’s finding that HOTELS.COM is generic was supported by substantial evidence. The refusal of registration is affirmed.”); *Borescopes R U.S. v. 1800Endoscope.com, LLC*, 728 F. Supp. 2d, 938, 951 (M.D. Tenn. 2010) (“[T]he Court has determined [www.borescopesus.com] to be generic.”); *In re Meridian Rack & Pinion*, 114 U.S.P.Q.2d 1462, 1467 (2015) (“[T]he meaning of the phrase BUYAUTOPARTS.COM as a whole is generic for ‘on-line retail store services featuring auto parts.’”); *In re Cyberfinancial.Net, Inc.*, 65 U.S.P.Q.2d 1789, 1794 (2002) (“Applicant seeks to register the generic term ‘bonds,’ which has no source-identifying significance in connection with applicant’s services, in combination with the top level domain indicator ‘.com,’ which also has no source-identifying significance.”); *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 1378 (2007) (Application for “providing access to an online interactive database featuring information exchange in the field of law, lawyers, legal news, and legal services” was generic); *United Oil Heat, Inc. v. M.J. Meehan Excavating, Inc.*, 95 Mass. App. Ct. 579, 588 (2019) (“[T]he term OrderMyOil.com is a generic name that answers the question, ‘What are you?’ The answer is, ‘A website where I may order my oil.’”).

<sup>123</sup> See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009) (“[c]onsumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses.”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1176 (Fed. Cir. 2004) (“Regardless of the current state of Internet governance, the Board is correct that the overall impression of ‘.com’ conveys to consumers the impression of a company or commercial entity on the Internet.”); *Meridian Rack*, 114 U.S.P.Q.2d at 1467 (“‘.com’ is widely understood and used to refer to a form of electronic commerce that allows consumers to purchase goods or services online.”).

<sup>124</sup> *Advertise.com*, 616 F.3d at 980.

<sup>125</sup> *Booking.com*, 140 S. Ct. at 2306.

<sup>126</sup> *In re Eddie Zs Blinds & Drapery, Inc.*, 74 U.S.P.Q.2d 1037, 1038 (2005).

<sup>127</sup> *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888).

identifying characteristics about the product or service—anyone could add “Company” or “Incorporated” to the end of the proposed mark.

Similarly, adding a TLD simply means that the product or services are on a website, which also does not aid in distinguishing the products or services among other entities. Furthermore, every website requires a TLD and “.com” is the most popular one among websites.<sup>128</sup> A consumer would not know the identifying characteristics that shows what goods are available only through “.com”; all they know is that the goods are associated with a website.

When characterizing the strength of “Booking.com,” the majority relied on the fact that every website is unique without considering that a TLD does not identify the source of the goods.<sup>129</sup> The majority also incorrectly distinguished between the TLD “.com” and “Company” at the end of a mark because both of these do not differentiate the goods from another source. Both of these terms indicate the nature of the business, and Breyer correctly explained that, “terms that merely convey the nature of the producer’s business should remain free for all the use.”<sup>130</sup> Because these terms should remain free for all to use, it further supports the argument that they do not have any trademark significance.

In previous cases, utilizing the dictionary was also an imperative step in determining the genericness of a term with a “.com” TLD.<sup>131</sup> When determining whether “Booking.com” is generic, the majority neglected to consider what the everyday language of “Booking” entails. Instead, the majority relied heavily on consumer surveys to determine whether consumers associated “Booking.com” as a brand or a generic name.

Breyer correctly devalued these surveys in that they “tested consumers’ association of ‘Booking.com’ with a particular company, not anything about the term itself.”<sup>132</sup> “Booking.com” is an enormous company. With over 26,000 employees, as of September 2020, Booking Holdings, the parent company of “Booking.com,” has a total revenue of \$15.1 billion with a market value of \$60.6 billion.<sup>133</sup> Furthermore, it was

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<sup>128</sup> MCCARTHY, *supra* note 16, § 25A:11 (“Most commercial firms in the United States prefer to use the top level domain ‘.com.’”); *see* Borescopes R U.S. v. 1800Endoscope.com, LLC, 728 F. Supp. 2d, 938, 947 (M.D. Tenn. 2010) (“[E]ach website on the internet has a domain name, ‘which is an identifier somewhat analogous to a telephone number or a street address.’”) (quoting Johnny’s Fine Foods, Inc. v. Johnny’s Inc., 286 F. Supp. 2d 876, 889 (M.D. Tenn. 2003)).

<sup>129</sup> *Booking.com*, 140 S. Ct. at 2306.

<sup>130</sup> *Id.* at 2313. *See* Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co., 128 U.S. 598, 604 (1888) (“The designation ‘Goodyear Rubber Company’ not being subject to exclusive appropriation, any use of terms of similar import, or any abbreviation of them, must be alike free to all persons.”).

<sup>131</sup> *See In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009) (“[I]f the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic.”); *In re DNI Holdings Ltd.*, 77 U.S.P.Q.2d 1435, 1440 (2005) (“[D]ictionary definitions show that ‘sports betting’ is the equivalent of ‘sports wagering’ . . . We have no doubt but that joining the separate words ‘sports’ and ‘betting’ creates a term that, in context, would be generic for a service that permits one to wager on sporting events.”); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1303 (Fed. Cir. 2009) (“The TTAB started its analysis with dictionary . . . definitions of ‘hotel,’ ‘temporary lodging,’ and ‘.com.’”).

<sup>132</sup> *Booking.com*, 140 S. Ct. at 2314.

<sup>133</sup> *Booking Holdings*, FORBES, <https://www.forbes.com/companies/booking/#430c02a94c69> (last visited Feb. 6, 2020); Andrea Murphy, Hank Tucker, Marley Coyne & Halah Touryalai, *Global 2000*

ranked number 369 in Forbes’ Global 2000 list, ranking the world’s 2,000 largest public companies.<sup>134</sup> Taking these statistics into consideration, it is clear why the surveys indicated that 74.8% of the participants thought that “Booking.com” is a brand because so many people have heard of “Booking.com” through its immense advertising and prominent presence in the marketplace.<sup>135</sup> That consumers have heard of “Booking.com” should not automatically mean that it is not generic. The strong presence of “Booking.com” in the marketplace skewed the survey results and created an illusory indication that consumers do not associate “Booking.com” as generic. Regardless of what the surveys indicate, the term is still one that “connotes the basic nature of that thing—the hallmark of a generic term.”<sup>136</sup>

The definition of the verb “book” is: “to register (something, such as a name) for some future activity or condition (as to engage in transportation or reserve lodgings),” and “to reserve in advance.”<sup>137</sup> Furthermore, the definition of “Booking” is: “the act of one that books.”<sup>138</sup> The majority did not see the significance that “Booking.com” is an online booking service; however, this is crucial in proving that “Booking.com” is generic. Breyer correctly concluded that, “[t]he company’s name informs the consumer of the basic nature of its business.”<sup>139</sup> The website itself even mentions on its homepage that it is “[t]he World’s #1 Choice for Booking Accommodations.”<sup>140</sup> Relying on skewed consumer surveys and the website admitting that it provides booking services, the majority’s conclusion that “Booking.com” is not generic was incorrect. “Booking.com”

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*The World’s Largest Public Companies*, FORBES (May 13, 2020, 6:00 AM), <https://www.forbes.com/global2000/#4bdefa60335d> [hereinafter *Global 2000*].

<sup>134</sup> *Global 2000*, *supra* note 133.

<sup>135</sup> *Booking.com*, 140 S. Ct. at 2313-14. See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (“The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff.”); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976). The court expresses one reason why, regardless of a generic term’s prominence in the market, a generic term cannot be afforded trademark protection:

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.

<sup>136</sup> *Booking.com*, 140 S. Ct. at 2312.

<sup>137</sup> *Book*, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/book> (last visited Oct. 18, 2020).

<sup>138</sup> *Booking*, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/booking> (last visited Oct. 18, 2020).

<sup>139</sup> *Booking.com*, 140 S. Ct. at 2309.

<sup>140</sup> *BOOKING.COM*, <https://www.booking.com> (last visited Oct. 18, 2020). See also *HOTELS.COM*, <https://www.hotels.com> (last visited Oct. 18, 2020). *HOTELS.COM*, which was denied federal registration because it was considered generic, does not have any type of catch-phrase or promotional advertisement that they are a hotel service. It would seem counterintuitive that *BOOKING.COM*, who openly promotes that they sell booking services was eligible for federal registration, while *HOTELS.COM* that does not include this type of language, was denied eligibility.

is the sum of its constituent parts—an online provider of booking and the relevant public would understand the mark this way.<sup>141</sup>

### B. *Economic Anti-Competitive Effects*

Allowing “Booking.com” to obtain federal trademark registration would be a detriment to an economy that promotes competition and would negate the purpose of trademark law. Breyer argued that if “generic.com” marks are eligible for federal trademark protection, as the internet grows, the online economy would eventually, at the extreme, equate to “one firm per product,”<sup>142</sup> meaning that each “generic.com” mark would be a monopoly over the product or service it provides. Just as the hypothetical from the Introduction illustrates, “Candles.com” would encompass the entire online market for candles just as “Booking.com” would encompass that of online booking. Unfortunately, this hypothetical might become a reality in the near future if the majority’s decision is upheld. This decision might fundamentally reorient our economy by destroying the possibility of competition in some, many, or most sectors.

“Booking.com” is already on its way to a monopoly in the online booking services as is apparent from a simple Google search of the word “Booking.” When searching “Booking,” not only is the first page of results flooded with links to “Booking.com” and information about “Booking.com,”<sup>143</sup> but the “News” section is flooded with articles about “Booking.com,”<sup>144</sup> and the majority of the results in the “Images” section are logos and advertisements for “Booking.com.”<sup>145</sup> Thus, “Booking.com” already receives essentially all of the online bookings business from consumers due to the easy access of its site through a simple internet search.<sup>146</sup>

The current anti-competitive nature of “Booking.com” is heightened due to its federal trademark protection. Now, not only is “Booking.com” the internet leader for online booking services, but they have the right to threaten to exclude possible

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<sup>141</sup> See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009) (“Because websites operate under the term ‘mattress.com’ to provide mattresses, and they provide them online, the Board properly concluded that the relevant public understands the mark MATTRESS.COM to be no more than the sum of its constituent parts, an online provider of mattresses.”).

<sup>142</sup> *Booking.com*, 140 S. Ct. at 2315.

<sup>143</sup> GOOGLE, <https://www.google.com> (last visited Oct. 18, 2020).

<sup>144</sup> *Id.*

<sup>145</sup> *Id.*

<sup>146</sup> See Aron Meystedt, *Domain Names: There’s Value in Those URLs*, INTELLIGENT COLLECTOR, <https://intelligentcollector.com/domain-names-theres-value-in-those-urls/> (last visited Oct. 18, 2020). The author states the following when discussing the advantages a category-defining domain name offers its owners:

[C]ategory-defining domain name offers several advantages for companies operating on the Internet [including]: [t]he ability to rank higher on search engines . . . A moat against the entry of other potential entrants . . . [and] [t]he ability to advertise a single URL and convey exactly what business your company operates.

Matt Southern, *Over 25% of People Click the First Google Search Result*, SEARCH ENGINE JOURNAL (July 14, 2020), <https://www.searchenginejournal.com/google-first-page-clicks/374516/#close> (“It’s well known users rarely venture into the second page of search results.”).

competitors with a similar domain name.<sup>147</sup> The majority asserted that “Booking.com” has said they would not threaten litigation against owners of domain names similar to “Booking.com.”<sup>148</sup> However, the majority did not give considerable weight to how owners of other “generic.com” marks might act if exposed to a potential competitor with a similar name—how “Booking.com” alleges they would act is not informative of how others will act if in the same situation.

The majority argued that the owner of a “generic.com” mark might not prevail in litigation due to a lack of consumer confusion or a showing of fair use by the alleged infringer.<sup>149</sup> However, the majority failed to recognize that awarding “Booking.com” federal trademark eligibility, allowing them rights to litigate, advances its monopoly over the services and continues to promote an anti-competitive economy. Even before litigation ensues, if the owner of a federally registered “Generic.com” mark contacts a possible infringer, it is more likely that the threat of litigation would cause the potential infringer to cease to exist. As a new entity in the online booking service market, the intimidation from “Booking.com,” the “World’s #1 Choice for Booking Accommodations,”<sup>150</sup> might cause the less-developed startup entity to reconsider its business model. As a new entity in the market, “the threat of costly litigation will no doubt chill others from using variants on the registered mark and privilege established firms over new entrants to the market.”<sup>151</sup> Therefore, even if the litigation would have been unsuccessful, the larger firm owners of “Generic.com” would advance its monopoly and lessen the “competitive multifirm marketplace that our basic economic laws seek to achieve.”<sup>152</sup>

Upholding this case will also cause negative effects on the efficiency of applying for a federally recognized trademark. Although the majority mentioned a few instances where the PTO awarded federal registration on trademark applications that looked similar in structure to “Booking.com,”<sup>153</sup> the majority disregarded all of the cases

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<sup>147</sup> See 15 U.S.C. § 1114; see also *Booking.com*, 140 S. Ct. at 2315 (“Federal registration would allow respondent to threaten trademark lawsuits against competitors using domains such as ‘Bookings.com,’ ‘eBooking.com,’ ‘Booker.com,’ or ‘Bookit.com.’”).

<sup>148</sup> *Booking.com*, 140 S. Ct. at 2308.

<sup>149</sup> *Id.*

<sup>150</sup> *BOOKING.COM*, *supra* note 140.

<sup>151</sup> *Booking.com*, 140 S. Ct. at 2315. See Robert G. Bone, *Rights and Remedies in Trademark Law: The Curious Distinction Between Trademark Infringement and Unfair Competition*, 98 TEX. L. REV. 1187, 1187 (2020) (“The high litigation costs and risks of trademark cases can chill socially desirable uses, such as uses of product features to compete, uses of marks for expressive purposes, and innovative uses of marks on the internet.”); Glynn S. Lunney, Jr., *Two-Tiered Trademarks*, 56 HOUS. L. REV. 295, 304, 321-22 (2018) (“outcomes today in the trademark system depend, and sometimes depend almost entirely, on the respective wealth of the parties.”).

<sup>152</sup> *Booking.com*, 140 S. Ct. at 2315.

<sup>153</sup> *Id.* at 2305 (These trademarks include “ART.COM” on the principal register for “online retail store services” offering art and “DATING.COM” on the supplemental register for dating services); see also *In re Steelbuilding.com*, 415 F.3d 1293, 1298 (Fed. Cir. 2005) The court states:

The STEELBUILDING.COM web site thus includes more than a mere shopping guide for metal building structures. As the program-user develops the design, the program re-calculates design elements as necessary to meet codes and other engineering requirements . . . The purchaser can compare prices of different designs, and finally purchase a preferred design. Therefore . . . the Board fails to acknowledge the interactive design feature of the applicant’s goods and services.

where the PTO, and even the courts, denied federal registration. The majority decision created inconsistency among the Court and the PTO regarding how to deal with “Generic.com” marks.<sup>154</sup> The majority decision will overwhelm the TTAB with a flood of appeals from those instances where marks were denied registration that are structurally identical to “Booking.com.” The inconsistencies will create confusion among courts on whether to rely on the *Booking.com* majority or the traditions of the PTO.

## V. CONCLUSION

The consequences of adhering to the holding of *Booking.com* would be catastrophic to the future of trademark law. If the generic mark “Booking.com” is permitted to obtain federal trademark registration, it will create a future trademark world of “generic.com” marks. This future would be detrimental to the core concepts of trademark law, namely, promoting competition to benefit consumers.<sup>155</sup> Because of this decision, there is nothing stopping any generic trademark owner who has been denied federal registration from creating a website and adding “.com” to the mark. Relying on *Booking.com* as support would permit the previously denied mark to obtain registration. As previously denied “generic.com” marks become eligible for federal registration, each generic mark will obtain a monopoly over the product or service it

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<sup>154</sup> See Ann K. Linnehan, *Need Trademark Protection for a Generic Domain Name?*, 38 GONZ. L. REV. 503, 523 (2003). Linnehan, a Trademark Attorney for the PTO re-iterates the PTO’s stance on the significance of domain names regarding trademark protection when she said:

To attain protection as a trademark, the domain name must be more than just a web site locator. It must also act as an identifier of the origin of the goods or services . . . The USPTO states that a mark composed of a generic term and a top-level domain will be refused registration because the mark is generic and the top-level domain has no trademark significance . . . the TTAB appears to have adopted the USPTO’s position on generic domain names.

See MCCARTHY, *supra* note 16, § 7:17.50 (In his Author’s Opinion discussing the *Booking.com* Fourth Circuit Court of appeals case (915 F.3d 171 (2019)), McCarthy says:

Discarding the predictable and clear line rule of the U.S.P.T.O. and the Federal Circuit creates a nebulous and unpredictable zone of generic name and top level domain combinations that somehow become protectable marks when accompanied by favorable survey results . . . The Fourth Circuit decision raises a host of challenging infringement questions, such as whether a federally registered mark BOOKING.COM is infringed by hypothetical marks such as: hotelbooking.com; seasidebooking.com, booking.vacations or booking.hotels.

<sup>155</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, *not* trademark law, to encourage invention by granting inventors a monopoly.”) (emphasis added); MCCARTHY, *supra* note 16, § 2:1 (“there is also the policy of encouraging competition from which the public benefits.”).

sells, just as Justice Breyer feared.<sup>156</sup> It is just a matter of time before Booking.com obtains a monopoly over the term “Booking” and the other generic terms will soon follow on its footsteps. As more generic terms are claimed by one entity, consumers will not be benefited due to the lack of options.<sup>157</sup> The internet as the medium for monopolies to conduct their business further discourages consumers from knowing what other sources are available.<sup>158</sup>

The majority in *Booking.com* made two mistakes in its analysis: it incorrectly concluded that “Booking.com” is not generic and it incorrectly determined that there were no threats to the economy by holding “Booking.com” eligible for federal trademark protection. However, analysis regarding what the future of trademark law will look like if this case is upheld is frightening. The economic threats of trademark law that follows from *Booking.com* strongly suggest that this case needs to be overturned. The majority opinion in *Booking.com* did not carefully consider the effect that granting federal registration eligibility to one mark would have on all the structurally similar marks that were once denied registration nor the effect it will have on the economy on the years to come.

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<sup>156</sup> *Booking.com*, 140 S. Ct. at 2315-16. See MCCARTHY, *supra* note 16, § 2:12 (“A trademark precludes the idea of a monopoly. It is a means of distinguishing one product from another; it follows therefore that there must be others to distinguish from.”) (quoting Edward S. Rogers, *Goodwill, Trademarks and Unfair Trading* 51 (1914)).

<sup>157</sup> See Glynn S. Lunney, Jr., *Trademarks and the Internet: The United States’ Experience*, 97 TRADEMARK REP. 931, 932 (2007) (“Consumers . . . are intensely interested in competition and the lower prices it can bring.”).

<sup>158</sup> See Stacy L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 779 (2004) (“Internet-related trademark cases has seriously eroded these substantive [trademark rules], to the point where trademark law’s anticompetitive tendencies threaten to overwhelm its information-facilitating function in some contexts.”); Michael S. Denniston & Margaret Smith Kubiszyn, *WWW.YOURCLIENT.COM: Choosing Domain Names and Protecting Trademarks on the Internet*, 61 ALA. LAW. 40, 41 (2000) (“A business’s home page on the World Wide Web can provide information about the business and the goods and services it provides to a virtually unlimited audience at a relatively low cost.”).