

Supreme Court Holds that “Booking.com” is Eligible for Federal Trademark Registration

July 2, 2020

The Supreme Court has ruled that “Booking.com” is eligible for federal trademark registration, after the United States Patent and Trademark Office (“USPTO”) had previously refused registration of the mark on the grounds that it was merely a generic name for a class of goods. In *United States Patent and Trademark Office v. Booking.com B.V.*, 591 U.S. ____ (2020), the Court held that “Booking.com” was not merely a generic term for online hotel-reservation services, but rather is perceived by consumers as descriptive of a specific website and thus qualifies for federal trademark registration.

The Court acknowledged that “[p]rime among the conditions for registration, the mark must be one ‘by which the goods of the applicant may be distinguished from the goods of others,’” citing the Lanham Act, which is the federal statute governing trademarks. Whether a mark qualifies for registration depends upon its “distinctiveness”. That is, marks may be (from low to high distinctiveness): (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. The more distinctive a mark, the more likely it qualifies for federal registration.

A “generic” mark does not qualify for federal registration because it is merely a name for a class of goods or services itself and does not distinguish the goods of one manufacturer from the goods of another – i.e. the words “computer” or “refrigerator”. The USPTO had viewed the mark “Booking.com” as such a term, as it is comprised merely of the generic words “booking” (meaning to make travel reservations) and “.com” (a commercial website) and denied Booking.com a federal trademark registration.

However, in seeking review of the USPTO’s decision in the U.S. District Court for the Eastern District of Virginia, Booking.com presented evidence of consumer perception of “Booking.com” demonstrating that the consuming public understood the mark “Booking.com” to refer to a specific website, and not just a general term for online hotel-reservation sites. The District Court held that this evidence established that the mark was “descriptive”, meaning that consumers generally recognize “Booking.com” as a brand name rather than a generic class of goods. The District Court additionally found that the term had acquired secondary meaning as to hotel reservation services and concluded that for those services, the marks meet the distinctiveness requirement for registration. The USPTO appealed to the Fourth Circuit, which affirmed the District Court.

The Supreme Court agreed that because “Booking.com” was viewed by consumers as a specific website, different from other online reservation sites such as Travelocity, that “Booking.com” was not generic and thus eligible for

registration. That is, “Booking.com” was not a term that customers would use to refer to online reservation sites in general, the way an individual might use the term “computer” or “refrigerator” to refer to a computer or refrigerator, respectively, regardless of the producer. The Supreme Court also disagreed with the USPTO’s reliance on the common law principle applied in *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S.598 (1888) that a generic corporate designation added to a generic term does not confer trademark eligibility. The Supreme Court rejected the USPTO’s argument that the combination of two generic marks to form a “.com” mark was the same as simply calling a company “The Wine Company” because a “generic.com” mark refers users to a specific website, associated with a specific company.

The Court also noted that a conclusive rule that a “generic.com” mark was generic and ineligible for registration was inconsistent with current USPTO records, which reflect that “ART.com” and “dating.com” were eligible for registration. However, it is important to note that, even if a mark is registered with the USPTO, the mark may be considered somewhat weak as a descriptive mark– a point that the Supreme Court noted in the decision, acknowledging that “Booking.com accepts that close variations are unlikely to infringe” and a “federal registration of ‘Booking.com’ would not prevent competitors from using the word ‘booking’ to describe their own services.”

The Supreme Court’s decision will have widespread impact on the Internet and may open the door to the federal registration of marks once considered ineligible for such protection.

If you have questions feel free to contact Karen I. Levin at (516) 296-9110 or via email at klevin@cullenllp.com or Ariel E. Ronneburger at (516) 296-9182 or via email at aronneburger@cullenllp.com.

Practices

- Intellectual Property

Attorneys

- Karen I. Levin
- Ariel E. Ronneburger