U.S. Supreme Court Holds that Generic Names May be Registered Trademarks Where Addition of ".com" Changes Term's Meaning to Consumers

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On Tuesday, the U.S. Supreme Court ruled in Patent and Trademark Office v. Booking.com, with an 8-1 vote, that "Booking.com" could be registered as a service mark over the U.S. Patent and Trademark Office ("PTO")'s contention that the name was a generic mark which was not a registrable trademark.

Ordinarily, a generic name, such as a mere name of a class of products or services (like "booking"), cannot be registered as a federal trademark or service mark. This is because "the name of the good itself ... is incapable of distinguishing one producer's goods from the goods of others." In order to be afforded federal trademark protection, a mark must be more distinctive than a mere name for a class of products.

Booking.com, a well-known digital travel company which provides services through its website of the same name including hotel booking services, filed applications to register marks containing the term "Booking.com." The PTO concluded that the word "Booking" was a generic term for making travel reservations and that ".com" was a generic signifier of a commercial website (also known as a "gTLD", standing for generic top-level domain). The combination of the two as "Booking.com", according to the PTO, was simply a generic term referring to an online reservation service for travel.

On appeal, the Supreme Court ultimately held that, because "Booking.com" as a term taken as a whole, in the mind of consumers, constitutes a name that distinguishes its services from those of others, the name is not generic and was eligible for federal registration. The Court reasoned that, while "generic.com" *could* simply convey that the generic good or service is offered online, and nothing more, the unique nature of domain names *could also* convey to a consumer that the name refers to a *specific* service provider, distinguished from others. The Court summarized this ruling with the statement that "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."

This ruling by the Supreme Court potentially widens the door for federal registration of marks which otherwise may have been refused registration as generic. While a combination of a generic name with a generic top-level domain name does not automatically result in a sufficiently distinctive mark, this ruling makes clear that such a result is possible, depending on consumer's perception of the name.

Even in light of this potentially broader range of formerly generic names capable of federal trademark registration, businesses should be cautious of overreach, and aware of the limitations of potentially "weak" marks. Booking.com conceded that its own marks would not prevent from competitors from using the work "booking" to describe their own services, and that close variations on the name "Booking.com" or close variations of its website address would be unlikely to infringe on its marks. Thus, while a "generic.com" website

may potentially be eligible for federal registration as a mark, the limits of protection afforded by such a mark are uncertain.

You should speak to an experienced attorney for questions about whether a potential business name or website name is eligible for federal trademark registration, and about the protections afforded by registration as a trademark. For questions about the Court's decision in Patent and Trademark Office v. Booking.com, and for questions about trademarks, service marks, and other intellectual property issues, please contact Blake Hurt at bhurt@tuggleduggins.com or (336)-271-5252.

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