

Supreme Court to Hear Dot-Com Trademark Issue

November 18, 2019

On November 8, 2019, the United States Supreme Court agreed to take up a case that could potentially have a significant impact on domain name owners and those who have invested in promoting their dot-com brand. Can combining an arguably generic term with a generic top-level domain create a mark that is eligible for trademark protection?

Booking.com operates an online travel reservation system. In 2012, Booking.com applied to register stylized versions of "Booking.com" as a trademark. The United States Patent and Trademark Office ("USPTO") rejected the marks as generic. On appeal, the Trademark Trial and Appeal Board ("TTAB") agreed, concluding that the mark was generic as applied to Booking.com's "online hotel reservation services" because "booking" refers to "a reservation or arrangement to buy a travel ticket or stay in a hotel room," and the ".com" suffix did not add any source-indicating significance or otherwise change its meaning.

Booking.com appealed the refusal to the United States District Court for the Eastern District of Virginia. In 2017, the district court reversed. Considering the totality of the evidence in the record, including consumer survey evidence, the court concluded that "consumers are primed to perceive a domain name as a brand which militates for, not against, trademark protection for domain names," and that the addition of ".com" identifies a source and transforms a generic mark into a descriptive mark that may qualify for trademark protection upon a showing of secondary meaning.

The Fourth Circuit affirmed, finding that the public would associate the mark as a whole with the Booking.com brand, rather than online hotel reservation services in general. The Fourth Circuit's decision appeared to be at odds with other cases addressing domain names from the Federal and Ninth Circuits, involving domain names such as HOTELS.COM, LAWYERS.COM, and ADVERTISING.COM, creating a circuit split ripe for a Supreme Court decision.

What to watch

Under trademark law, generic terms cannot be protected, no matter the investment an owner might make to create awareness in that term as a source identifier. Otherwise, a single business could unfairly monopolize terms that competitors need to fairly describe their goods, which could stifle competition.

Yet, the USPTO and courts have repeatedly held that, in examining a trademark, it should not be dissected and considered piecemeal. Instead, the proposed trademark must be considered in its entirety. A trademark is more than the sum of its parts, and the focus is on the overall commercial impression that it conveys.

The Booking.com case juxtaposes these principles, and the Supreme Court's decision in this case may have implications not only for existing internet businesses, but also for new companies developing and protecting their online brands.

The Supreme Court will likely hear the case in the spring, with a decision by mid-2020.

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