



ALERTS

U.S. Supreme Court Concludes That In Trademark Registration, The Customer Is King (Or Queen)

July 1, 2020

Highlights

U.S. Supreme Court rules that “Booking.com” is not a generic term if “it is not a generic name to consumers”

The Court noted there are no greater concerns associated with the registration of “BOOKING.COM” than with the registration of other descriptive marks

Even if a descriptive mark is weak, that does not disqualify it from federal registration

On June 30, the U.S. Supreme Court ruled in [United States Patent & Trademark Office v. Booking.com B.V.](#) that the online travel reservation domain “BOOKING.COM” is eligible for federal trademark registration.

On behalf of the 8-1 majority, Justice Ruth Bader Ginsburg rejected the U.S. Patent and Trademark Office’s (USPTO) *per se* rule that the combination of a generic word and “.com” is or must be a generic combination. Justice Ginsburg said, “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.” (Emphasis added.)

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Only distinctive marks qualify for the principal trademark register. As such, Booking.com had been denied four separate registrations associated with the term BOOKING.COM. In rejecting registration, the USPTO reasoned that the term BOOKING.COM is generic.

Even if it is considered descriptive, the USPTO reasoned that the term would not be registrable because it lacks the requisite acquired distinctiveness, or “secondary meaning.” In response, Booking.com sought review in the U.S. District Court for the Eastern District of Virginia and supplied evidence of such a secondary meaning. Both the District Court and the U.S. Court of Appeals for the Fourth Circuit ruled in Booking.com’s favor.

The Supreme Court’s analysis is rooted in the language of the [Lanham Act](#) and its examination of a mark vis-à-vis “the relevant public” as “the test for determining whether the registered mark has become the generic name of goods and services.” Discounting the USPTO’s concern that permitting registration would hinder others in their right to use the term “booking” and unduly control their use of similar language, the Supreme Court concluded that such a “concern attends any descriptive mark.” A descriptive mark may be weak; but its competitive disadvantage does not “inevitably disqualify” it from federal registration.

To obtain more information, please contact the Barnes & Thornburg attorney with whom you work or Deborah Pollack-Milgate at 317-231-7339 or dpollackmilgate@btlaw.com.

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