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For the most current news and analysis related to the coronavirus, visit the free COVID-19 resource center at TR.com. The website provides the latest on court closings, federal and state legislative responses to the virus, legal analysis of the most important issues, and other topics.

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## TRADEMARK

### Booking.com high court win marks 'victory' for trademark, domain owners

By Patrick H.J. Hughes

Booking.com BV can federally register its name as a trademark after the U.S. Supreme Court concluded that consumers understand the travel reservation company's name is not merely a generic phrase referring to hotel "booking" companies in general.

**United States Patent and Trademark Office et al. v. Booking.com BV, No. 19-46, 2020 WL 3518365 (U.S. June 30, 2020).**

In an 8-1 decision, the justices on June 30 rejected the U.S. Patent and Trademark Office's "nearly per se rule" that a generic word combined with a generic top-level domain, or gTLD, results in a generic term.

The PTO had appealed a 4th U.S. Circuit Court of Appeals decision to set aside a trademark examining attorney's refusal to register



REUTERS/Fabrizio Bensch

a "Booking.com" trademark pursuant to Section 2(e)(1) of the Lanham Act, 15 U.S.C.A.

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Jordan L. Fischer of XPAN Law Group explores the regional tensions in privacy and data governance in light of the coronavirus pandemic.

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## EXPERT ANALYSIS

### The EDPB gives its view on connected car technology – but will it reach the chequered flag?

Dentons attorneys Simon Elliott, Esther Rusling, Nick Graham, Antonis Patrikios and Martin Fanning discuss the European Data Protection Board's draft guidelines for connected vehicles.

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§ 1052(e)(1). *Booking.com BV v. U.S. Pat. & Trademark Off.*, 915 F.3d 171 (4th Cir. 2019).

"We decline a rule ... that would largely disallow registration of 'generic.com' terms and open the door to cancellation of scores of currently registered marks," Justice Ruth Bader Ginsburg wrote for the majority.



Booking.com attorney David Bernstein said the decision was "a victory for countless brand owners that have invested significant resources in building their brands."

Justice Sonia Sotomayor wrote a concurring opinion that said, given some of the facts presented, Booking.com could be generic for the services described, but those facts were not before the court; the effect of adding a ".com" was.

Justice Stephen Breyer, the sole dissenter, said that in his view, "A top-level domain such as '.com' has no capacity to identify and distinguish the source of goods or services. It is merely a necessary component of any web address."

#### ATTORNEYS REFLECT ON DOMAIN NAME HOLDERS' 'VICTORY'

Debevoise & Plimpton LLP attorney David Bernstein, who acted as co-counsel on Booking.com's behalf, said the decision was "a victory for countless brand owners that have invested significant resources in building their brands — such as Weather.com, Law.com, Wine.com and Hotels.com."

Attorneys not involved in the dispute also described the decision as a win for some trademark and domain name holders.



Brett Heavner of Finnegan, Henderson, Farabow, Garrett & Dunner LLP said the decision will provide "significant advantages" to holders of previously unregistrable domain names.

Brett Heavner of Finnegan, Henderson, Farabow, Garrett & Dunner LLP said the decision will provide "significant advantages" to holders of previously unregistrable domain names seeking protection from internet pirates and counterfeiters.



Dorsey & Whitney LLP attorney Fara Sunderji said the court "got it right."

"As owners of registered marks, these domain name owners will be able to take advantage of the in rem jurisdiction elements of the U.S. anti-cyberpiracy law," he said. "Cyberpirates targeting such marks will no longer be

beyond the reach of U.S. courts once these marks are registered."

Dorsey & Whitney LLP attorney Fara Sunderji said the court "got it right" when it said registration eligibility turns on a mark's capacity to distinguish goods.

"While I do think we will see an uptick in applications being filed for generic.com trademarks, I do not think we will see an avalanche of litigation or enforcement actions following a new crop of generic.com registrations," she said.



Dykema attorney Eric T. Fingerhut said the Supreme Court made "a sound decision."

"In my opinion, companies lucky enough to own generic.com domains who have built up enough goodwill in their marks are often sophisticated enough to understand that rights in descriptive marks are somewhat limited."

Dykema attorney Eric T. Fingerhut said the Supreme Court made "a sound decision." He also said it was "a good day for owners of generic.com brands and domainers sitting on stockpiles of generic domain names."

"My hope following this decision, though certainly not an expectation, is the PTO will realize it is in the business of registering marks rather than denying them," he said. "Trademark lawyers need to be able to advise their clients, but the current and often inconsistent practice of the PTO on all sorts of important issues such as distinctiveness and likelihood of confusion makes doing so very difficult."

Mandelbaum Salsburg PC attorney Joel G. MacMull disagreed, saying the high court "got this one wrong."

"There's no question that Booking.com is not generic based on the evidence presented

below, but these were highly specific facts that should not have upended the rational policy that undergirded the PTO's determination," he said.



Mandelbaum Salsburg PC attorney Joel G. MacMull said the high court "got this one wrong."

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Baker Donelson attorney Susan A. Russell said the decision was a "surprise" given the tough questions the justices asked during oral argument that seemed to indicate sympathy for the PTO.

"Mark owners would be wise to take note of Justice Sotomayor's concurrence focusing on the importance of the facts of each case for the genericness analysis, and accordingly not expect that the door to registrability is now wide open for all manner of otherwise generic marks reaching registration," she warned.

### THERE CAN BE ONLY 1 '.COM'

News reports at the time of the oral argument said the points each party made were eclipsed by the debate's unusual status as the Supreme Court's first virtual proceeding, mandated by the COVID-19 pandemic.

Among its many arguments, the PTO said that adding ".com" was the equivalent of adding the word "company" to a generic term, a combination that remains generic according to Supreme Court precedent established more than a century ago in *Goodyear's India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888).

Justice Ginsburg distinguished the examples, noting that there can be only one registrant of a particular ".com" per domain globally. In contrast, many firms around the world can adopt a name with the word "company" attached, she wrote.

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Baker Donelson attorney Susan A. Russell said the decision was a "surprise" given the tough questions the justices asked during oral argument.

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She also downplayed arguments that registering the Booking.com mark would give the company a monopoly on the word "booking."

Only the whole name of the firm would be protected and it would be "weak" protection,

she said. As a result, "because its mark is one of many 'similarly worded marks,' Booking.com accepts that close variations are unlikely to infringe."

### NEW GTLDS?

Justice Breyer said "the *Goodyear* principle is sound as a matter of law and logic" and he failed to recognize the distinction between ".com" and "company."

The addition of a corporate designation does not "magically transform" a generic name to give someone a right to exclude others, he said.

He added that this logic might not apply to marks using the new gTLDs, such as ".guru," ".club" or ".vip." The Internet Corporation for Assigned Names and Numbers, the nonprofit that maintains addresses on the internet, has introduced these relatively new extensions for domains over the past eight years.

In contrast to generic words that might be combined with those terms to create distinctive trademarks, "Booking.com" conveys only a website associated with booking, he said. [WJ](#)

### Attorneys:

*Petitioners:* Sarah T. Harris, Thomas W. Krause, Christina J. Hieber and Molly R. Silfen, U.S. Patent and Trademark Office, Alexandria, VA; Noel J. Francisco, Joseph H. Hunt, Malcolm L. Stewart, Erica L. Ross, Mark R. Freeman, Daniel Tenny and Weili J. Shaw, U.S. Department of Justice, Washington, DC

*Respondent:* David H. Bernstein and Jared I. Kagan, Debevoise & Plimpton LLP, New York, NY; Jonathan E. Moskin, Foley & Lardner LLP, New York, NY; Lisa S. Blatt, Sarah M. Harris, Eden Schiffmann and John B. Swanson, Williams & Connolly LLP, Washington, DC

### Related Filings:

Supreme Court opinion: 2020 WL 3518365  
Oral argument transcript: 2020 WL 2113365  
4th Circuit opinion: 915 F.3d 171

**See Document Section A (P. 21) for the Supreme Court opinion.**