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## Supreme Court Rules that Adding “.com” to a Generic Term Can Result in a Protectable Mark

In [Booking.com v. United States Patent and Trademark Office](#), 591 U.S. \_\_\_\_ (2020), the Supreme Court rejected the United States Patent and Trademark Office’s (PTO) proposed rule that all marks that combine a generic term with an Internet domain name suffix such as “.com” are *per se* generic and therefore unprotectable. According to the Court, such a “sweeping” rule is inconsistent with the principles of trademark law, and “generic.com” marks can be protectable if consumers recognize the mark as an identifier of the source of certain goods and/or services.

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### Background

In 2011 and 2012, Booking.com B.V. (Booking.com), which maintains a travel reservation website at the domain name <booking.com>, filed U.S. applications to register its service mark BOOKING.COM (word mark and stylized versions) for online hotel reservations and related services. The PTO rejected the applications, finding that “booking” was generic for those services, and the addition of the “.com” top-level domain (TLD), which itself is generic, did not make the mark protectable.

On appeal, the U.S. District Court for the Eastern District of Virginia [disagreed](#), holding that “when combined with an SLD [second-level domain], a TLD generally has source identifying significance and the combination of a generic SLD and a TLD is generally a descriptive mark that is protectable upon a showing of acquired distinctiveness.” The District Court found that Booking.com had satisfied that showing. The Fourth Circuit [affirmed](#) the result, though it refused to adopt the district court’s rule that a generic SLD combined with a TLD usually is descriptive.

### Supreme Court Decision

In an opinion authored by Justice Ginsburg and joined by seven other justices, the Court affirmed the Fourth Circuit’s ruling and rejected the PTO’s proposed *per se* rule that a mark consisting of a generic SLD and a TLD is always generic as a matter of law. The Court focused on the Lanham Act’s emphasis that the primary significance of a mark is determined by consumer perception of that mark, and held that a mark of the form of “generic.com” is generic only “if the term has that meaning to consumers.” Relatedly, the Court agreed with the Fourth Circuit that while a “generic.com” term is not automatically protectable, it can become so if consumers recognize and perceive that term, considered in its entirety, as a source identifier.

Applying these principles, the Court reasoned that if Booking.com were generic, “we might expect consumers to understand Travelocity . . . to be a ‘Booking.com’” or “... expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite ‘Booking.com’ provider.” The Court concluded that because the lower courts already determined that consumers do not perceive “Booking.com” in that way and the PTO no longer even disputed that determination, “Booking.com” is not generic.

In proposing its *per se* rule, the PTO relied on *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888). In *Goodyear*, which predated the Lanham Act, the Court held that adding the word “Company” to an otherwise generic mark does not make it protectable. In its briefs and during oral argument, the PTO argued that adding “.com” to an otherwise generic term is no different than adding “company,” and therefore existing law prohibited registration of any “generic.com.” The Court rejected this argument, concluding that a “generic.com” term can convey a “source-identifying characteristic” due to its “association with a particular website.” That association, the Court reasoned, distinguishes the addition of “.com” from “company.” Notably, and apart from the issue at hand, the Court also held that *Goodyear* does not stand for the proposition, as the PTO argued, that terms consisting of a generic word or phrase combined with a corporate designation (for example, “Hat Corp.”) are unprotectable *as a matter of law*. The Court

repeated that “whether a term is generic depends on its meaning to consumers” and emphasized that the “Lanham Act is incompatible with an unyielding legal rule that entirely disregards consumer perception.”

In a concurring opinion, Justice Sotomayor agreed that there is no *per se* rule against trademark protection for a “generic.com” term, but cautioned that consumer survey evidence may be an unreliable indicator of genericness, and noted that, while “the PTO may well have properly concluded, based on . . . dictionary and usage evidence, that Booking.com is in fact generic for the class of services at issue,” “that question is not before the Court.”

In dissent, Justice Breyer contended that, just as *Goodyear* held that “where a compound term consists simply of a generic term plus a corporate designation, the whole is necessarily no greater than the sum of its parts,” “appending ‘.com’ to a generic term ordinarily yields no meaning beyond that of its constituent parts,” particularly since “[l]ike the corporate designations at issue in *Goodyear*, 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. . . . When combined with the generic name of a class of goods or services, ‘.com’ conveys only that the owner operates a website related to such items.” He also noted that the majority’s decision could “lead to a proliferation of ‘generic.com’ marks, granting their owners a monopoly over a zone of useful, easy-to-remember domains.”

### Implications

The Court’s holding in *Booking.com* provides further support by the country’s highest court for the proposition that consumer perception is always key to determining whether a mark is protectable. Nonetheless, the implications of the Court’s decision are likely to be fairly limited.

While the PTO may see an increased number of applications for “generic.com” marks, this does not mean that those applications will result in registrations, or that such marks will be entitled to common-law protection. The Court’s ruling makes clear that protection will require proof that relevant consumers recognize a “generic.com” term as an indicator of source. This threshold is likely to be difficult for many if not most applicants to meet.