

## IP Frontiers: Supreme Court opens trademark protection for potential 'generic.com' website names



By **THOMAS SICA**

On June 30, the Supreme Court issued an opinion in the case of *USPTO v. Booking.com B.V.* The Court held that trademarks that combine a generic word or phrase with “.com” are not automatically considered to be generic. This decision will open the doors for many website owners to register their website name as trademarks in the United States despite its including of “generic” wording.

What does it mean for a trademark to be generic, and why is that important? In order for a trademark to register and be protectable, that trademark must be “distinctive.” The United States Patent and Trademark Office (“USPTO”) uses a sliding scale of designations in determining whether a given trademark is “distinctive.” The most distinctive trademarks are those that are “fanciful,” meaning that the trademark owner created the word or phrase for its business (for example, “Kodak” for cameras). Next are “arbitrary” trademarks which use words that have a given meaning but have no relation to the goods or services offered under that trademark (for example, “Apple” for computers). Lower on the scale are “suggestive” trademarks, which only hint at the quality or nature of the goods or services offered under the trademark (for example, “Netflix” for a streaming service). Further down on the sliding scale are “descriptive” trademarks which use words or phrases that describe a quality or feature of the goods or services (for example, “Juicy” for apples). Finally, at the lowest end of the sliding scale are “generic” trademarks. “Generic” trademarks are the common words or phrases used as the name of goods or services (for example, “Law Firm” for legal services).

“Fanciful,” “arbitrary” and “suggestive” trademarks are always considered “distinctive” and thus can be protected via trademark registration. “Descriptive” trademarks are only “distinctive” if they have a “secondary meaning.” In other words, if the general public associates a “descriptive” word or phrase solely with a particular source, then that mark may be “distinctive.” “Generic” trademarks are never “distinctive,” even if they have a secondary meaning. This is done because the Trademark Office does not want to prevent competitors from using the generic name of a product. For example, a baker cannot register the mark CAKE, because doing so would prevent competitors from calling their cakes by their actual names.

Courts have long dealt with the question of what happens when a generic term is combined with other terms. Courts must determine whether the combination of generic terms conveys a new distinctive meaning. For example, in 1888, the Supreme Court decided the case of *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), which held that adding the word “Company” to a generic word or phrase does not relieve the trademark of its generic status. In the *Goodyear* case, the Court found that “Goodyear Rubber Company” was generic because “goodyear rubber” was the common generic name for vulcanized rubber and adding the word “company” to the trademark added no protectable meaning. This *Goodyear* precedent remained valid even after the Lanham Act was passed in 1946.

It has been almost a century and a half since *Goodyear* was decided and the ways that companies display their trademarks have changed. Notably in today’s world, many businesses have websites to direct customers and potential customers to their goods or services. In reliance upon the precedent set by *Goodyear*, the USPTO had a policy deny-

ing trademark applications that combined a generic word with generic top-level domains (“TLDs”) such as “.com.” The USPTO’s policy was also enforced by the courts. For instance, the Federal Circuit, in *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359 (Fed. Cir. 2009), held that MATTRESS.COM was not registrable as a trademark because it was generic. The Federal Circuit held this way despite evidence that consumers associated the mark with this particular source.

In 2020, this question made its way up to the Supreme Court in *USPTO v. Booking.com B.V.* *Booking.com B.V.* applied to register the mark “BOOKING.COM” at the USPTO for online hotel-reservation services. The USPTO rejected this application reasoning that it was generic. In an 8-1 decision, the Supreme Court struck down the USPTO’s sweeping policy of rejecting trademarks styled as “generic.com.” The decision, authored by Justice Ginsburg, held that a “generic.com” trademark is “a generic name for a class of goods or services only if the term has that meaning to consumers.” In other words, the USPTO must evaluate each “generic.com” trademark application on a case-by-case basis to determine its significance to consumers. If the general public identifies a “generic.com” trademark in association with one source, then the trademark should not be considered generic. This does not mean that all “generic.com” trademarks are non-generic. The owner of a “generic.com” trademark must now provide evidence of the general public’s perception of its trademark in order to avoid a generic designation. While not stated outright in the opinion, the Supreme Court appears to have elevated some “generic.com” trademarks to “descriptive” status. The Court’s analysis focusing on the “meaning to consumers” is very similar, if not identical, to the “secondary meaning” analysis used for descriptive trademarks.

The lone dissent in the *Booking.com* case

was written by Justice Breyer. Breyer argued that “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.” Thus, the addition of .com to a generic word should have no effect on the generic status of that word.

So, what does this case mean moving forward? The USPTO can no longer refuse reg-

istration of every “generic.com” trademark without first considering the perception of that mark by the general public. The Supreme Court has opened the doors for website owners to apply for trademarks in their web addresses even where the address contains a generic term. Now, there is more flexibility in what website names the USPTO will allow as trademarks. It remains to be seen how effec-

tive the USPTO will be in evaluating the distinctiveness of “generic.com” trademarks.

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