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Q: Can Booking.Com Be Trademarked? A: Booking.Yeah

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Q: Can Booking.com Be Trademarked?

A: Booking.yeah

*Samantha Favela**

I. INTRODUCTION

Internet domains come in all sorts of combinations. From creating a website called Business.com to Dotcom.com, the possibilities are somewhat endless. This customizable feature attracts people and companies to create domains to fit their commercial needs, enabling them to match a company's name, product, or service to the domain. A website domain is comprised of a top-level domain (TLD) such as ".com," as well as a second-level domain (SLD) such as art—where the most customization occurs.¹ As the Internet grew, so did the popularity of the "generic domain name," a domain with a generic SLD like art. By choosing a generic domain to represent a company, that company can hit the Internet jackpot.² But the price for a generic domain name can cost a small fortune.³ Generic domains are easier to find and remember, helping to attract unintended consumers. The right domain name can reduce the cost of advertising because if a consumer is searching for a common product, they will quickly be linked to sites where the domain name is the exact product the consumer is looking for.⁴ Thus, generic domains have turned into the most coveted virtual real estate.⁵ But this popularity creates tension with trademark law. While companies want to be easily found on the Internet, they also want to protect themselves from competitors. The Supreme Court attempted to resolve this conflict in the groundbreaking case of *United States Patent & Trademark Office v. Booking.com B.V.*⁶

Part II of this Casenote discusses the background of trademark law in order to establish the relevant and underlying principles. Part III addresses the history of generic domain cases and how they were treated at all levels of the United States Patent and Trademark Office (USPTO) and judicial system. Part IV dissects the *Booking.com* case, its road to the Supreme Court, and its outcome. Part V explains why the ruling is in accordance with the law and why it is important to further trademark principles. Finally, Part VI addresses

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1. Xuan-Thao N. Nguyen, *Shifting the Paradigm in E-Commerce: Move over Inherently Distinctive Trademarks—the E-Brand, I-Brand and Generic Domain Names Ascending to Power?*, 50 AM. U. L. REV. 937, 956 n.128 (2001).
2. *Id.* at 953–54.
3. *Id.* at 938.
4. *Id.* at 954.
5. *Id.* at 955.
6. USPTO v. Booking.com B.V., 140 S. Ct. 2298, 2302 (2020).

the implications this ruling has for the future and the important questions that arise.

II. BACKGROUND OF TRADEMARK LAW

Trademark law protects words, phrases, symbols, or designs that identify the source of goods or service of one party that distinguishes them from another.⁷ Trademark law is a longstanding concept that is fundamentally grounded in the idea that a mark identifies the maker.⁸ But this concept has evolved into more modern functions such as embodying a company's investment, reducing the costs for consumers to search and decide on products, increasing efficiency, and providing a sense of protection.⁹ Essentially, a trademark functions not only to identify the source of the good or service but also as an advertising vehicle.¹⁰

Trademark law is governed by the Lanham Act, which creates a national system for registering trademarks as well as setting out protections for current trademark owners.¹¹ A trademark is protectable even if it is not federally registered.¹² However, federally registering a mark offers certain advantages, such as establishing the registrant as the owner of the mark, granting exclusive use in commerce, and providing nationwide constructive notice of these rights.¹³ In order to register a mark, the owner of a mark must complete a federal registration application through the USPTO, and the mark is then evaluated by a trademark attorney to determine if it is eligible for trademark protection.¹⁴ If the application is rejected, an applicant can appeal to the Trademark and Trial Appeal Board (TTAB), and if dissatisfied with the TTAB decision, the applicant can appeal through the traditional court system.¹⁵

Trademarks are characterized by their distinctiveness, and this distinctiveness exists on a spectrum.¹⁶ On one end are generic terms which are not

7. Judy E. Zelin, *Trademarks, Etc.*, 70 TEX. JUR. 3D § 7, Westlaw (Apr. 2021 ed.).

8. JAMES E. HAWES, TRADEMARK REGISTRATION PRACTICE § 1:2 (Mar. 2021 ed.).

9. *Id.*

10. *Id.*

11. *Booking.com*, 140 S. Ct. at 2302; *see also* Lanham Act, 15 U.S.C. §§ 1051–1141n (1946).

12. *Booking.com*, 140 S. Ct. at 2302.

13. HAWES, *supra* note 8, § 1:3.

14. GARY D. KRUGMAN, TRADEMARK TRIAL AND APPEAL BOARD: PRACTICE AND PROCEDURE § 2:1 (2020–2021 ed.).

15. 15 U.S.C.A. §§ 1070, 1071 (2011).

16. HAWES, *supra* note 8, § 1:6.

afforded any protection and cannot be trademarked.¹⁷ Generic terms refer to the genus of a particular product or service or, stated differently, are terms that are commonly used as the name or description of a kind of good, such as thermos.¹⁸ The idea of non-registrable trademark stems from the notion that affording protection to generic terms would promote anti-competitive behavior,¹⁹ since the term is incapable of identifying a single source.²⁰ In order for a mark to be established as a valid trademark as compared to a generic mark, the owner of the mark “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”²¹ Additionally, in an important Supreme Court case further defining the parameters of what constitutes a generic trademark, the Court ruled in *Goodyear Co. v. Goodyear Rubber Co.* that the combination of a generic term and “company” cannot be trademarked.²² On the opposite side of the spectrum are arbitrary and fanciful marks.²³ These are the strongest types of trademarks and are entitled to protection because they are considered inherently distinct.²⁴ Here, the words are used in arbitrary or fanciful ways, meaning these marks have no association with the goods or services they designate.²⁵ Examples include “KODAK” for photography-related products or “Apple” for computers.²⁶ In between the two are descriptive marks and suggestive marks.²⁷ Descriptive marks are one step above generic, and these are words that describe the quality, function, characteristic, or ingredient of the good or service.²⁸ The strength and the ability to register a descriptive mark depends on how distinctive it is of the goods or services it is associated with, but generally descriptive marks are considered weak marks.²⁹ An example would be “Yellow Pages” for the telephone directory.³⁰ In order for a descriptive

17. *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 901 (E.D. Va. 2017), *aff’d*, 915 F.3d 171 (4th Cir. 2019), *aff’d*, 140 S. Ct. 2298 (2020), *vacated*, 141 S. Ct. 187 (2020).
18. CHARLES E. MCKENNEY & GEORGE F. LONG III, FEDERAL UNFAIR COMPETITION: LANHAM ACT 43(a) § 3:3 (2020).
19. *Matal*, 278 F. Supp. 3d at 901.
20. KRUGMAN, *supra* note 14, § 2:77.
21. *Kellogg Co. v. Nat’l Biscuit Co.*, 205 U.S. 111, 118 (1938).
22. *Goodyear Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602–03 (1888).
23. *Matal*, 278 F. Supp. 3d at 901.
24. *Id.*
25. HAWES, *supra* note 8, § 1:6.
26. *Matal*, 278 F. Supp. 3d at 901.
27. HAWES, *supra* note 8, § 1:6.
28. *Id.*
29. *Matal*, 278 F. Supp. 3d at 901.
30. *Id.*

mark to be trademarked, it must have acquired a secondary meaning.³¹ Secondary meaning is when the descriptive mark is associated in the minds of consumers with that particular good or service or when it identifies a particular producer.³² Only descriptive marks require secondary meaning in order to be protected.³³ Suggestive marks are one step below arbitrary and fanciful, and these marks are words that convey the impression of goods or services but still require imagination to associate it with the good or service.³⁴ “Coppertone” for sunscreen is an example of a suggestive mark as it implies without describing a certain characteristic of the sunscreen.³⁵

Federal registration of a mark does not create a complete ban on the use of the protectable trademark in commerce.³⁶ Specifically, with descriptive marks, certain doctrines are available to guard against anti-competitiveness and allow for good faith use.³⁷ Because trademark infringement is the unauthorized use of a mark in a way that is likely to cause confusion, deception, or mistake about a good or service,³⁸ a competitor can use someone else’s protectable mark unless it will likely cause confusion.³⁹ Even if it does generate some confusion, it may not be infringement.⁴⁰ Classic fair use allows an entity to use someone else’s trademark to refer to their own product or service.⁴¹ This allows for some confusion in the interest of free competition.⁴²

III. PRIOR TREATMENT OF “.COM” CASES

The USPTO has been inconsistent with how it handles the eligibility of a generic domain trademark, allowing some names to be trademarked and not allowing others.⁴³ For example, Art.com and Dating.com have achieved federal registration.⁴⁴ However, consistently on appeal, generic domain cases

31. Zelin, *supra* note 7, § 7.

32. *Id.*

33. *Matal*, 278 F. Supp. 3d at 901.

34. HAWES, *supra* note 8, § 1:6.

35. *Matal*, 278 F. Supp. 3d at 901.

36. *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020).

37. *Matal*, 278 F. Supp. 3d at 911–12.

38. *About Trademark Infringement*, USPTO, <https://www.uspto.gov/page/about-trademark-infringement> (last visited July 5, 2021).

39. *Booking.com*, 140 S. Ct. at 2307.

40. *Id.* at 2307–08.

41. *Id.*

42. *Id.* at 2308.

43. *See id.* at 2305; *see In re Hotels.com, L.P.*, 573 F.3d. 1300, 1306 (Fed. Cir. 2009).

44. *Booking.com*, 140 S. Ct. at 2305.

have been decided in favor of no eligibility due to its generic nature.⁴⁵ For example, in *In re Hotels.com, L.P.*, “Hotels.com” was generic since the addition of “.com” simply shows Internet commerce and does not convert the generic term into a brand name.⁴⁶ Because there was not enough evidence to show that Hotels.com had become distinct, it was not trademarkable.⁴⁷ The United States Courts of Appeals for the Federal Circuit similarly held in *In re Reed Elsevier Properties Inc.* that “Lawyers.com” could not be trademarked due to the mark being understood to refer to the genus of services it was promoting and not the specific company itself.⁴⁸ The Ninth Circuit determined that “Advertise.com” was a generic term as applied to Internet advertising services.⁴⁹ Consequently, it was not trademarkable because adding “.com” to a generic term simply indicates a commercial entity and is not sufficient to make it distinct.⁵⁰ The commonality of these cases demonstrate that “.com” is a generic term that cannot be afforded protection as a registered mark in combination with another generic SLD. It was not until the district court in *Booking.com* that the view began to shift, eventually creating a circuit split that required the Supreme Court to resolve.⁵¹

IV. BOOKING.COM BREAKING PRECEDENT

Because of its treatment in both the district court and court of appeals, the *Booking.com* case was an outlier. Although the USPTO rejected “Booking.com” as a protectable trademark four times, both the district court for the Eastern District of Virginia and the Fourth Circuit ruled in favor of Booking.com, breaking from other courts’ holdings and creating a split among itself and the Ninth and Federal Circuit.⁵²

Booking.com, a travel booking website, filed four applications through the USPTO to trademark their name, which included a standard character version and three stylized versions of the mark.⁵³ The mark for each application was rejected because it was merely descriptive, had no secondary mean-

45. See *In re Hotels.com, L.P.*, 573 F.3d at 1306.

46. *Id.* at 1304.

47. *Id.* at 1306.

48. *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1378–79 (Fed. Cir. 2007).

49. *Advertise.Com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 981–82 (9th Cir. 2010).

50. *Id.*

51. See *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 923 (E.D. Va. 2017).

52. See *Booking.com B.V. v. USPTO*, 915 F.3d 171, 188 (4th Cir. 2019), *aff’d*, 140 S. Ct. 2298 (2020), *vacated*, 141 S. Ct. 187 (2020); *Matal*, 278 F. Supp. 3d at 923.

53. Paul J. Reilly & Smitha Mathews, *What to do with a Descriptive Mark? Booking.com & the PTO*, ST. B. TEX. 1, 3 (2020).

ing, and was generic as to reservation services.⁵⁴ After reconsiderations were denied, Booking.com appealed to the TTAB, consolidating the four applications.⁵⁵ Booking.com's principal argument at this stage focused on distinctiveness, maintaining that the mark was not generic but rather had acquired the secondary meaning required to be registered.⁵⁶ The company argued that "Booking" and ".com" should not be treated as independent terms but should be treated in its entirety.⁵⁷ Contrarily, the Trademark Office argued a per se rule that adding ".com" to a generic term such as booking always makes the mark generic.⁵⁸ This became the main argument as the case progressed.⁵⁹ The TTAB upheld the refusal to register "Booking.com" as a trademark because it is generic as applied to the company's services and the mark is merely descriptive with no showing of it having acquired distinctiveness.⁶⁰

After exhausting its options at the USPTO, Booking.com took the case to federal district court in the Eastern District of Virginia.⁶¹ The case turned on where "Booking.com" fell on the distinctiveness spectrum.⁶² Because the issue focused on distinctiveness, Booking.com was allowed to present evidence that consumers did not perceive Booking.com as a generic term for a service.⁶³ Specifically, the court highlighted a Teflon survey revealing that nearly 75% of the respondents identified "Booking.com" as a brand name.⁶⁴ The district court used the Fourth Circuit's three-step test for genericness: (1) determine the relevant class of product or service to which the mark is used; (2) determine the relevant purchasing public of the relevant class of product or service; and (3) determine whether the primary significance of the mark to the relevant public is to identify the class of product or service to which the mark relates.⁶⁵ The district court first determined the relevant class broadly as "making hotel reservations for others."⁶⁶ Secondly, the court identified consumers "who use travel, tour, and hotel reservation services" as the relevant purchasing public.⁶⁷ The decision turned on the third step, and while the dis-

54. *Id.*

55. *Id.*

56. *Id.* at 4.

57. *Id.*

58. *Id.*

59. *See* Reilly & Mathews, *supra* note 53, at 4.

60. *Id.* at 5.

61. *Id.* at 6.

62. Booking.com B.V. v. Matal, 278 F. Supp. 3d 891, 900 (E.D. Va. 2017).

63. *Id.* at 915.

64. *Id.*

65. *Id.* at 902.

66. *Id.* at 903.

67. *Id.*

trict court indicated the mark should be considered in its entirety, it was not precluded from considering the meaning of individual words to determine the meaning of the entire mark.⁶⁸ The district court decided to break from Federal Circuit precedent in holding that “.com” when combined with a SLD, such as Booking.com, is generally a descriptive mark that is protectable upon showing it has acquired distinctiveness.⁶⁹

Unhappy with the decision, the USPTO appealed the district court’s determination that “Booking.com” is not generic.⁷⁰ The Fourth Circuit narrowed down the dispute to the third step of the generic test: the public’s understanding of what the term “Booking.com” references.⁷¹ The Fourth Circuit first clarified that the USPTO bore the burden of proving that a mark is generic,⁷² and the mark in question should be considered as a whole when determining its validity.⁷³ Therefore, the Fourth Circuit found agreed with the district court in that the USPTO failed to satisfy its burden of proving that the relevant public understood “Booking.com,” taken *as a whole*, to refer to general online hotel reservation services instead of Booking.com the company.⁷⁴ Because the USPTO lacked any evidence that “Booking.com” was generic and Booking.com introduced survey evidence to support its distinctiveness argument, the district court was correct when it found “the evidence weighed in favor of Booking.com to be non-generic.”⁷⁵ The Fourth Circuit also rejected the USPTO’s per se rule based on the decision in *Goodyear*.⁷⁶ The addition of a TLD like “.com” to a generic SLD like “booking” is not necessarily generic.⁷⁷ However, the court rejected the district court’s reasoning that “.com” has source identifying significance when added to a domain name such as “booking.”⁷⁸ The inquiry instead centered on whether the public understood the term as a whole to refer to the source.⁷⁹ Therefore, the Fourth Circuit held that adding “.com” to a SLD can result in a descriptive mark if it

68. *Matal*, 278 F. Supp. 3d at 904.

69. *See id.* at 923.

70. *See Booking.com B.V. v. USPTO*, 915 F.3d 171, 176 (4th Cir. 2019), *aff’d*, 140 S. Ct. 2298 (2020), *vacated*, 141 S. Ct. 187 (2020).

71. *Id.* at 181.

72. *Id.* at 179–80.

73. *Id.* at 181 (citing *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001)).

74. *Id.*

75. *Id.* at 181–82.

76. *Booking.com*, 915 F.3d at 184.

77. *Id.* at 181.

78. *Id.* at 185.

79. *Id.*

can be shown that the mark's primary significance to the relevant public is the source.⁸⁰

The USPTO appealed once again.⁸¹ The Supreme Court declined to adopt the per se rule that all generic domain marks are generic and are not protectable.⁸² Instead, the Court established that consumer perception is the deciding factor in these situations.⁸³ In order for the mark to be deemed non-generic, it must identify the source and not the class.⁸⁴ Therefore, because "Booking.com" is not generic to consumers, it is not a generic mark.⁸⁵ The Court importantly distinguished *Goodyear*, holding that a TLD is unlike a company designation because a TLD directs consumers to a single, specific website, unlike a company designation.⁸⁶ This comparison was faulty, according to the Court, since domain names themselves can only be occupied by one entity at a time.⁸⁷ Further, the Court made clear that this ruling would not allow for monopolies and "undue control" because other fundamental trademark laws still apply such as likelihood of confusion and classic fair use.⁸⁸

V. BEST POSSIBLE OUTCOME

Although this is a controversial decision by the Supreme Court, it is correct for several reasons. First, the Supreme Court decided against a strict per se rule and therefore allowed for a case-by-case analysis.⁸⁹ This is important because a case-by-case analysis reveals the USPTO's current and required format.⁹⁰ A trademark application is examined individually when determining if it can be registered due to the nuances of the mark itself.⁹¹ It is difficult to look at a mark in a vacuum since certain inquiries are necessary to determine how distinct a mark is, what product or service the mark identifies,

80. *Id.* at 186.

81. *See* USPTO v. Booking.com B.V., 140 S. Ct. 2298, 2304 (2020).

82. *See id.* at 2301.

83. *Id.* at 2307.

84. *See id.*

85. *Id.* at 2305.

86. *See id.* at 2305–06.

87. *Booking.com*, 140 S. Ct. at 2306.

88. *See id.* at 2307–08.

89. *See id.* at 2301.

90. *See* John Strand & Amanda Slade, *Supreme Court's Booking.com Ruling Signals Uptick in Registration of "Generic.com" Marks*, IPWATCHDOG (July 5, 2020), <https://www.ipwatchdog.com/2020/07/05/supreme-courts-booking-com-ruling-signals-uptick-registration-generic-com-marks/id=123072/>.

91. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001).

what industry the product or service is in, and if the mark is used in commerce.⁹² The same inquiries apply to marks concerning domain names.⁹³

Secondly, and similarly, the Supreme Court's holding follows the heart of the Lanham Act.⁹⁴ Trademark law is intended to reflect and protect consumer perceptions,⁹⁵ and this ruling does just that.⁹⁶ Trademark eligibility for generic marks turns on whether consumers associate the mark with a particular product or entity rather than the whole genus.⁹⁷ It follows that the same rules would apply to determining whether a domain name is really generic.⁹⁸ Further, the Lanham Act incentivizes brand investment by assuring that the producer of a good or service, and not an imitating competitor, will gain the financial, reputation-related rewards associated with a desirable product or service.⁹⁹ It goes against the Lanham Act to have a ruling that prevents a company to profit off of their investment to make their brand distinct.¹⁰⁰ Therefore, per se rules do not allow for this consumer perception inquiry and are not compatible with trademark law's goals.¹⁰¹

Thirdly, this ruling is still subject to other trademark limitations such as classic fair use and the likelihood of confusion.¹⁰² A critique of allowing "generic.com" marks to be trademarked is that this will promote anti-competitiveness.¹⁰³ However, these fundamental trademark doctrines combat this fear because they ensure that competitors are free to use the generic marks in a non-trademark manner as long as it does not cause consumer confusion.¹⁰⁴ This ruling does not give generic domain marks a free pass.¹⁰⁵ Just as descriptive trademarks are considered inherently weak, generic domain marks will be viewed the same.¹⁰⁶ Booking.com even admitted that registration of

92. See HAWES, *supra* note 8, § 1:11.

93. See *In re Nett Designs, Inc.*, 236 F.3d at 1342.

94. See Strand & Slade, *supra* note 90; see also Lanham Act, 15 U.S.C. §§ 1051–1141n (1946).

95. See *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 900 (E.D. Va. 2017).

96. See *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2305 (2020).

97. See *Matal*, 278 F. Supp. at 902.

98. See *id.* at 905–06.

99. *Id.* at 900 (quoting *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 163–64 (1995)).

100. See *id.*

101. See Strand & Slade, *supra* note 90.

102. See *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020).

103. *Id.* at 2314 (Breyer, J., dissenting).

104. See *id.* at 2307 (majority opinion).

105. See *id.*

106. See *id.*

its mark would not prevent others from using “booking” to describe their services.¹⁰⁷ Further, the Supreme Court’s reasoning does not entirely break from precedent.¹⁰⁸ In *In re Dial-a-Mattress*, the mark “1-888-M-A-T-R-E-S-S” was found protectable because, even though area codes have no source identifying significance by themselves and the term “mattress” was generic, the combination of an area code and a generic term was deemed source-identifying, making it a descriptive term.¹⁰⁹ The district court in the *Booking.com* case relied on *In re Dial-a-Mattress* in its ruling, and the current Supreme Court reasoning tracks it perfectly.¹¹⁰ A TLD is just like an area code; it does not have any source identifying significance by itself and, when combined with a SLD, indicates a domain name which is unique, just like a telephone number.¹¹¹ The combination of a generic SLD and a TLD signals that services relating to the generic SLD are available by accessing the domain name, thus making it a descriptive term.¹¹²

Finally, the ruling keeps up with the times and changing landscape of technology. As the Court mentioned in the opinion, domain names are a unique source identifier and in themselves can only identify one entity, company, or person.¹¹³ No two entities can occupy a single domain at the same time. If the Court completely ignored this significant factor, it would have ignored the key characteristic of domain names. In doing so, the Court would have limited the availability of a whole sector of companies that use their trademarks to highlight their Internet connection.

If the Court had adopted a per se rule prohibiting the registrability of generic.com trademarks, the outcome would have certainly created stricter precedent with hindering effects. Adopting a per se rule would have provided generic.com marks no protection at all.¹¹⁴ Generic.com marks would not be eligible for federal registration and all the advantages associated with it regardless of whether they are distinctive in the eyes of consumers.¹¹⁵ Although a mark does not need to be registered, certain benefits like prima facie evidence of validity and ownership, enhanced remedies, or the right to bring a federal cause of action would not be afforded to these mark owners.¹¹⁶ Ultimately, this could have a deterring effect on online businesses and competi-

107. *Id.* at 2308.

108. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001).

109. *Id.*

110. *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 909 (E.D. Va. 2017).

111. *Id.*

112. *Booking.com*, 140 S. Ct. at 2306.

113. *Id.*

114. *Id.* at 2305.

115. *Id.*

116. HAWES, *supra* note 8, § 1:10.

tion, something the Lanham Act has specifically tried to avoid.¹¹⁷ Establishing a per se rule does not completely bar an entity from protecting their mark.¹¹⁸ The unfair-competition law can prevent competitors from passing off their services as another trademark owner's, but, as the Court stated, federal trademark registration would offer generic.com mark owners the greater protection.¹¹⁹ Lastly, having a per se rule would have created clearer precedent and made it easier for courts and practitioners to determine trademark eligibility.¹²⁰ However, the clearer precedent may come at a cost.

VI. IMPLICATIONS FOR THE FUTURE

The allowance of generic domain trademarks and the case-by-case analysis creates certain implications for the future, especially for practitioners and for future Internet ideas. Lawyers and business owners will now have to treat generic domain marks just like descriptive trademarks.¹²¹ Generic domain marks will be afforded the same protections, and the same fundamental trademark doctrines apply if in the eyes of consumers the mark identifies the source.¹²² Using a generic domain mark in a unique font or stylization to set a website and name apart will be important in order to establish the mark as a source identifier in the eyes of the public.¹²³ Data concerning consumer perception is still necessary and is arguably even more important. There will be a stronger reliance on surveys for support, examples of consumer and competitor usage, and even dictionaries to prove that the public finds the mark distinctive and not generic.¹²⁴ But survey evidence should not be viewed as conclusive.¹²⁵ As Justice Sotomayor addressed in her concurrence, a flawed survey will have little value in determining whether the public views a mark as generic.¹²⁶ Therefore, extra emphasis is needed to ensure that the design and analysis of the surveys or other evidence is valid. Ultimately, not having a per se rule opens the door for more trademark eligibility, but the reality is that registering a generic domain mark will be costly.¹²⁷ It will be difficult to

117. See *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 901 (E.D. Va. 2017).

118. *Booking.com*, 140 S. Ct. at 2308.

119. *Id.*

120. See Strand & Slade, *supra* note 90.

121. *Booking.com*, 140 S. Ct. at 2307.

122. *Id.*

123. Martha Allard, *Impact of Supreme Court Trademark Decision in Booking.com Case*, JD SUPRA (July 13, 2020), <https://www.jdsupra.com/legalnews/impact-of-supreme-court-trademark-91400/>.

124. *Booking.com*, 140 S. Ct. at 2309 (Sotomayor, J., concurring).

125. *Id.*

126. *Id.*

127. Strand & Slade, *supra* note 90.

overcome the presumption that it is not registrable. This type of inquiry may be fact intensive and require substantial documentation, something that might turn into a cost barrier.¹²⁸

The Supreme Court's ruling can also have potential negative impacts on the future. The dissent warns about the high likelihood that this will create a monopoly over certain domain names and drive anti-competitiveness.¹²⁹ Essentially, this ruling allows the trademark of a generic name, breaking from certain precedent and becoming counter-intuitive of established law.¹³⁰ Further, because of the unique nature of domain names, owners have extra competitive advantages, as was pointed out by Justice Breyer in his dissent.¹³¹ Domain owners have automatic exclusivity that is world-wide, and generic domain names are easier for consumers to find.¹³² Therefore, an owner of a generic domain name enjoys these benefits not because of the value of their goods or services but because they were lucky enough to be the first to obtain the domain.¹³³ Allowing further registration would confer additional competitive benefits that could hinder competition.¹³⁴ Additionally, a concern before courts is the reliability of survey data.¹³⁵ This decision only heightens the reliance on survey data since the determination of genericness turns on consumer perception that can only be measured using surveys and other similar methods.¹³⁶ As Justice Breyer stated, survey evidence "may be an unreliable indicator of genericness" since it is possible that a generic term can achieve an association, but that association does not mean the term becomes non-generic.¹³⁷ Further, the TTAB and other courts "have concluded that survey evidence is generally of little value in separating generic from descriptive terms."¹³⁸ This heightened reliance on survey data makes decision making and outcome predicting more difficult if the issue relies on a rather unreliable and subjective factor. Further, it raises a question as to what constitutes an effective consumer survey, which is something that the Court did not address and will likely lead to more litigation. Lastly, the Court's holding provides

128. *Id.*

129. *Booking.com*, 140 S. Ct. at 2314 (Breyer, J., dissenting).

130. *Id.* (citing *Goodyear Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602–03 (1888)).

131. *Id.*

132. *Id.* at 2315.

133. *Id.*

134. *Id.* at 2314.

135. *Booking.com*, 140 S. Ct. at 2313 (Breyer, J., dissenting).

136. *Id.*

137. *Id.* at 2314.

138. *Id.* at 2313.

no guidance on how to resolve conflicts in the future.¹³⁹ For example, it is unclear whether Booking.com can stop hotel-booking.com from using “booking.com” in their name.

Finally, this decision raises important questions over the protectability of other symbols and terms commonly used on the Internet. For example, USPTO examining attorneys have rejected applications for marks that combine the hashtag symbol and a generic term.¹⁴⁰ In the USPTO’s Trademark Manual of Examining Procedure, these types of marks must be refused as merely descriptive or generic.¹⁴¹ It is unclear if the refusal in this case by the Supreme Court to adopt a per se rule will affect the USPTO’s position concerning hashtags. Further, it is uncertain how this ruling will extend to other TLDs such as “.org” or “.net” and how it will extend to other Internet based symbols such as “@.”

VI. CONCLUSION

Although seemingly controversial, the Supreme Court’s ruling in the *Booking.com* case is the best possible outcome. It tracks the purpose of the Lanham Act while keeping traditional trademark doctrines in mind. While the concerns for its anti-competitive effects are valid and should be monitored, the outcome of this case must be viewed against the necessity for law to keep up with the times, especially when it comes to changing technology. Without this ruling, a whole sector of businesses and people would be ineligible to obtain the benefits of their investment and would be unable to protect their investment in the same way others are able to. However, this decision is not necessarily a free-for-all as evidence and support of a mark’s distinctiveness is required, and realistically this may be a cost burden to some businesses. There are still unanswered questions as to how this ruling applies to other Internet symbols. But one thing is for sure—this ruling has opened the door for businesses to take advantage of federal registration. Since this decision, over 200 applications have been filed with the USPTO to register generic domain marks.¹⁴²

139. *Id.* at 2315.

140. Patricia Cotton & Paul E. Thomas, *Is “Booking.com” Mark Registrable? SCOTUS Says Booking.com-pletely!*, PILLSBURY (July 1, 2020), <https://www.pillsburylaw.com/en/news-and-insights/booking-com-scotus-trademark.html>.

141. *Id.*

142. Michael D. Adams, *Domains as Brands – Implications of U.S. Patent and Trademark Office v. Booking.com B.V.*, MAYER BROWN (July 21, 2020), <https://www.mayerbrown.com/en/perspectives-events/publications/2020/07/domains-as-brands-implications-of-us-patent-and-trademark-office-v-booking-com-bv>.

