SUPREME COURT PERMITS TRADEMARK REGISTRATION FOR BOOKING.COM

June 29, 2020

By: Heidi Howard Tandy

In a case that has been widely watched for years by businesses and trademark practitioners, the Supreme Court ruled today, June 30th, 2020, that *Booking.com* is eligible to register that brand name with the US Patent and Trademark Office ("USPTO"). The ruling rejected the USPTO's claim that booking.com was an "unprotectable generic term". The Court's decision will have a significant impact on businesses, nonprofits and others who spend time, effort, money and promotional capital to build a brand out of generic words or a phrase that refers to the entity's goods or services.

It has long been a principle of trademark adoption and trademark law, that a descriptive term may be registered on the Principal Register of the US Trademark Office only if it develops significance "in the minds of the public" — a quality called "acquired distinctiveness" or "secondary meaning." *Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U. S. 205, 210–211 (2000)*. However, until this ruling today, trademarks comprised solely of generic terms could not be registered; now, they can be in certain circumstances.

As shown by earlier litigation over the *Booking.com* trademark, there is a very thin line between marks that are generic, and marks that are descriptive. In 2017, a lower court stated that the "consuming public … primarily understands that *Booking.com* does not refer to a genus, rather it is descriptive of services involving 'booking' available at that domain name." *Booking.com B.V. v. Matal, 278 F. Supp. 3d 891, 918 (2017).*

In this Supreme Court ruling today, the Court clearly stated that a "'generic.com' term" could be seen by the public as identifying a source of goods or services, because of its association with a specific website and the services or products available. Consequently, the Court ruled that "consumers could understand a given 'generic.com' term to describe the corresponding website or to identify the website's proprietor." *United States Patent and Trademark Office et al. v. Booking.com B.V., 19 - 46 (2020)*

The Court also stated clearly that a paramount aspect of trademark law practice is that "a competitor's use" of a term or phrase "does not infringe a mark unless it is likely to confuse consumers." In other words, third party use of a generic or descriptive term in the nominative or descriptive way is not barred because someone holds registration for a mark that includes that term. Trademark rights, like copyright, are not a monopoly ownership of a word, or a phrase, or an image in all contexts or for all products or services. Both types of ownership already have a wide range of carve-outs that allow others to use a registered word, or phrase, or image, or other work, in a non-infringing manner.

This ruling will give businesses broader opportunities to obtain protection for their marks that feature generic terms, and possibly even their descriptive marks. It will also make it even more critical for businesses whose branding includes generic or descriptive words to work with an experienced – and ideally board-certified –attorney. If you have any questions, feel free to reach out to our firm's Intellectual Property practice, to understand when cease and desist letters to infringers are appropriate, where the use of a business's trademark by a third party might not be infringing, and how to move forward with obtaining protection across

the United States for your business’s brands, slogans and logos.

Related Practices

Intellectual Property

Private Equity & Venture Capital

Related Practice Teams

Dispute Resolution

Related Team Member(s)

Heidi Howard Tandy

Topics

Intellectual Property

Registered Trademarks