

advisory

U.S. SUPREME COURT OPENS THE DOOR TO “GENERIC.COM” TRADEMARKS

Booking.com, an on-line travel agency that books hotel reservations and provides other services to customers, filed an application with the U.S. Patent and Trademark Office (the “USPTO”) to register the trademark “Booking.com.” The application was rejected based on the well-established principle that generic terms are not subject to trade mark protection. The decision was appealed to the Trademark Trial and Appeal Board, which upheld the USPTO decision. Both found that “booking” was a generic term on its face and adding “.com” did not add any indication of the source of the services.

On appeal, the Federal District Court reversed the earlier decisions based upon all of the evidence presented, which included consumer surveys. The U.S. Court of Appeals agreed based on a finding that the public would associate the trademark “Booking.com” with the company that had filed the original application and not with online reservation services generally.

The government appealed this decision to the U.S. Supreme Court.

Supreme Court Ruling

Among other issues, the USPTO argued that generic terms are never subject to trademark protection and the lower courts had placed too much weight on the perceptions of the public in determining whether Booking.com would indicate the source of the services being offered. However, in an 8 to 1 decision, the Supreme Court recently agreed with Booking.com. The Court acknowledged that all trademarks must distinguish the goods or services of one company from similar goods or services offered by other competing companies; and that in many cases combining one generic term with another would not satisfy that requirement.



However, in this case adding the “.com” suffix did provide that additional meaning, since only one company can use a particular domain name at any given time and a significant portion of the public would know that a domain name was exclusive to a specific company.

Some Practical Advice

This decision opens the door for companies that have generic names but also own a corresponding website domain name to obtain federal trademark protection that would not have been possible in the past. If you have questions about this issue or other business matters, please contact PLDO Partner William F. Miller at 508-420-7159 or email wmler@pldolaw.com.



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