

Supreme Court: “Booking.com” Can Be Registered as Trademark

Article By:

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By an 8-1 vote, the Supreme Court rejected a *per se* rule by the US Patent and Trademark Office (PTO) that a generic word followed by “.com” is necessarily generic and therefore ineligible for trademark protection. *U.S. Patent and Trademark Office et al. v. Booking.com BV*, Case No. 19-46 (Supr. Ct. June 30, 2020) (Ginsberg, Justice) (Sotomayor, Justice, concurring) (Breyer, Justice, dissenting). In so doing, the Supreme Court found that the proper test for whether “booking.com” is eligible for trademark protection for travel booking services is whether the public perceives “booking.com” as identifying a single source.

Trademarks identify and distinguish the goods and services of a single party, and the Lanham Act establishes a system of trademark registration. Among other requirements for registration, a trademark must be distinctive, as judged along a spectrum of trademark distinctiveness. Distinctive trademarks, in order of most to least strength, include fanciful or made-up words (e.g., KODAK); arbitrary marks that are existing words that have no connection to the underlying goods or services (e.g., CAMEL cigarettes); and then suggestive marks, which require some mental thought to connect them to an attribute of the products or services (e.g., TIDE laundry detergent). Descriptive words are not inherently distinctive (e.g., BEST BUY), but can still be protectable and registerable upon proof of acquired distinctiveness (*i.e.*, secondary meaning) arising from extensive use and advertising by the trademark owner. At the low end of the spectrum of distinctiveness are generic terms, which merely refer to a category or class of goods or services (e.g., wine or art) and are therefore never protectable or registerable as trademarks.

The PTO refused registration for “Booking.com,” citing policy developed from a 132-year-old Supreme Court case which held that the addition of “Company” to a generic word does not render the resulting name (*i.e.*, Generic Company) distinctive. See *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, [128 U. S. 598](#) (1888). After the Trademark Trial and Appeal Board (TTAB) affirmed the refusal of registration, Booking.com appealed to the US District Court for the Eastern District of Virginia, which reversed the refusal of registration, finding that “‘Booking.com’—unlike ‘booking’—is not generic. The district court found 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.” The US Court of Appeals for the Fourth Circuit affirmed the judgment of the Virginia federal court (*IP Update*, Vol. 22, No. 3), and the PTO sought *certiorari* from the Supreme Court.

The Supreme Court granted *certiorari* (*IP Update*, Vol. 22, No. 11), and Justice Ruth Bader Ginsberg delivered the opinion of the Court, with which six other justices joined. Justice Sotomayor filed a short concurring opinion, and Justice Breyer dissented. The question under review by the Court was “whether the addition by an online business of a generic top-level domain (.com) to an otherwise generic term can create a protectable trademark.

Both parties in *Booking.com* agreed that “booking” is generic for the kind of travel booking services offered by Booking.com. Nevertheless, the Supreme Court found that the *Goodyear* principle should not automatically be extended to domain names:

A ‘generic.com’ term might also convey to consumers a source-identifying characteristic: an association with a particular website. As the PTO and the dissent elsewhere acknowledge, only one entity can occupy a particular Internet domain name at a time, so ‘[a] consumer who is familiar with that aspect of the domain-name system can infer that BOOKING.COM refers to *some* specific entity.’

Rejecting the PTO’s bright-line rule against registration of “generic.com” domain names, the Supreme Court said that the question of whether Booking.com is generic “turns on whether that term, taken as a whole, signifies to consumers the class of online hotel reservation services.” The Supreme Court found the PTO’s reliance on *Goodyear* to be flawed because it ignored “the bedrock principle of the Lanham Act” that the question of whether a term is generic must be answered by asking how consumers perceive the term.

The record in the case reflected that Booking.com entered extensive evidence of consumer recognition that Booking.com referred to a single source rather than a genus. In particular, a so-called *Teflon* survey, which is a well-recognized measure for genericness, found that approximately 75% of surveyed consumers believed Booking.com identifies a single source rather than a class or genus of services. At oral argument, Chief Justice Roberts mirrored this finding, noting that someone looking to make a hotel reservation would not make a “booking.com,” but rather would simply make a “booking” (perhaps *at* Booking.com).

The Court also emphasized that it may still be quite difficult for a party to prove that its combination of a generic word plus a generic “.com” has achieved enough secondary meaning to qualify for trademark protection:

While we reject the rule proffered by the PTO that ‘generic.com’ terms are generic names, we do not embrace a rule automatically classifying such terms as nongeneric. Whether any given ‘generic.com’ term is generic, we hold, depends on whether consumers, in fact, perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.

Concurring and Dissenting Opinions

Justice Sotomayor concurred in the judgment of the Court that there is no *per se* rule against registration of a generic word followed by “.com,” but expressed some concern about whether the PTO has the resources to conduct its own *Teflon* surveys for genericness and to critique survey evidence submitted by trademark applicants and their experts.

Justice Breyer dissented, expressing concern about the potential anti-competitive effects of permitting a party to monopolize a generic term merely by adding a necessary top-level-domain extension, such as “.com.” Breyer noted that generic domains such as wine.com are easier for consumers to find and remember, and the Court’s decision “will lead to a proliferation of

'generic.com' marks, ... [which] will tend to inhibit, rather than to promote, free competition in online commerce."

Practical Considerations

The Supreme Court recognized that affirmance of the PTO's *per se* rule would have "opened the door to cancellation of scores of currently registered marks." Indeed, Justice Ginsberg noted that the PTO's own past practice of granting trademark registration for "generic.com" domain names such as Art.com and Dating.com appears inconsistent with the *per se* rule that the PTO was advancing in Booking.com.

Addressing the concerns in Justice Breyer's dissent that it would be anti-competitive for Booking.com to enjoy a monopoly on the generic word "booking," the Court noted Booking.com's concession at oral argument that "Booking.com" would be a weak mark, for which it would be harder to show a likelihood of confusion against future users of "booking." The Court also recognized that a party using "booking" in a "non-trademark sense" would have available to it a defense that the use is a fair use that is beyond the reach of trademark laws.

Practice Note:

The question that arises here is, why do trademark owners need to secure trademark registration for domain names if the ensuing scope of the registration would be severely limited? The practical answer is that ownership of a trademark registration is a gateway to remedies offered to trademark owners under the Lanham Act. For example, owners of trademark registrations are in better stead for cost-effective arbitrations against typo squatters like "Bookking.com" under the Uniform Dispute Resolution Policy for confusingly similar domain names, and ownership of a registration would make it easier for a party like Booking.com to stop an airport gift shop from selling merchandise bearing the trademark "Booking-it.com."

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