

No. 19-46

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IN THE  
**Supreme Court of the United States**

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UNITED STATES PATENT &  
TRADEMARK OFFICE *et al.*,

*Petitioners,*

*v.*

BOOKING.COM B.V.,

*Respondent.*

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ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE FOURTH CIRCUIT

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**BRIEF FOR *AMICUS CURIAE*  
INTELLECTUAL PROPERTY  
OWNERS ASSOCIATION IN SUPPORT  
OF RESPONDENT**

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**INTEREST OF THE *AMICUS CURIAE***

*Amicus curiae* Intellectual Property Owners Association (IPO) is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights.<sup>1</sup> IPO's membership includes more than 175 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventors, authors, executives, law firms, or attorney members. The corporate members of IPO own tens of thousands of trademarks and rely on the federal trademark system to protect these valuable assets. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO regularly represents the interests of its members before government entities and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The IPO Board of Directors approved the filing of this brief.<sup>2</sup>

This case presents a question of substantial practical importance to IPO's members: namely, whether the addition of a generic top-level domain (".com") to an otherwise generic term can create a protectable trademark. IPO respectfully requests that this Court find

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1. Pursuant to Supreme Court Rule 37.6, *amicus* affirms that no counsel for a party authored this brief in whole or in part, nor has any counsel, party, or third person other than *amicus* or its counsel made any monetary contribution intended to fund the preparation or submission of this brief. The parties have consented to the filing of the brief.

2. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

that generic terms added to generic top-level domains (TLDs) are not *per se* generic, and thus are eligible for trademark protection under certain circumstances. Instead, these terms should be analyzed to determine whether they have achieved secondary meaning due to use in commerce and can, therefore, be protected as trademarks.<sup>3</sup>

### SUMMARY OF THE ARGUMENT

This case presents a narrow issue before this Court. IPO believes that a generic term added to a generic TLD should be eligible for trademark protection under certain circumstances, including upon a showing of secondary meaning or inherent distinctiveness. This approach is consistent with how courts of appeals and the U.S. Patent and Trademark Office analyze such terms, and is not inconsistent with prior precedent of this Court. Furthermore, domain names can serve as unique source-identifiers to the relevant public. This unique ability for domain names to identify a location on the internet, however, does not make a domain name term *per se* functional. Finally, permitting trademark protection for certain “generic.com” terms will not necessarily result in overly broad marks because (1) each generic component of the term will be free for others to use and (2) enforcement of the mark will still require a showing of likelihood of confusion. For these reasons, IPO respectfully requests that this Court find that a generic term added to a generic top-level domain (TLD) is not *per se* generic, and thus,

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3. IPO takes no position on the other aspects of the Fourth Circuit’s decision in *Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171 (4th Cir. 2019).

can be eligible for trademark protection under certain circumstances.

## ARGUMENT

### I. A GENERIC TERM ADDED TO A GENERIC TOP-LEVEL DOMAIN (TLD) SHOULD NOT BE CONSIDERED GENERIC *PER SE*

A generic term refers to a genus of which a particular good or service is a species. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). A finding of genericness has drastic consequences. A generic term cannot be registered as a trademark. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Further, once a term is deemed generic, it can never be eligible for trademark protection. Even if the term develops source-identifying meaning in the eyes of the relevant public, it cannot be protected because it could create a monopoly over a commonly used term. *Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171, 186 (4th Cir. 2019); *see also Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

Descriptive terms, on the other hand, describe the characteristics of a good or service. Such a term can be protected and registered as a trademark upon a showing of acquired secondary meaning (i.e., the mark has become distinctive of the applicant's good or product in commerce). *Park 'N Fly, Inc.*, 469 U.S. at 194; *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 394 (4th Cir. 2009).

Although a domain name may contain generic component parts, IPO believes that this kind of name



should be eligible for trademark protection under certain circumstances, including upon a showing of secondary meaning or inherent distinctiveness. Courts of appeals and this Court have never created a bright-line rule against registering such marks, and doing so now would be unprecedented. Furthermore, domain names are different from the names of traditional brick-and-mortar companies and can serve as unique source-identifiers to the relevant public. Accordingly, IPO believes that a generic term added to a generic TLD should not be deemed generic *per se*.

**A. A Generic Term Added to a Generic TLD  
Should Be Analyzed for Secondary Meaning  
or Inherent Distinctiveness**

As courts of appeals and the U.S. Patent and Trademark Office have noted, a generic TLD added to a generic term may render the composite term sufficiently distinctive to be protected as a trademark. *Booking.com B.V.*, 915 F.3d at 186; *see also In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005) (“Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark.”); Trademark Manual of Examining Procedure § 1209.03(m) (same).

Although protection is limited to “rare circumstances,” these terms should nevertheless be analyzed similarly to other terms that may be descriptive or allegedly generic. Upon a showing that the “primary significance” of a mark to the relevant public is as a source and not the product, a generic second-level domain name combined with a “.com” can result in a protectable (non-generic) mark. *Booking.com B.V.*, 915 F.3d at 187.

As with other terms, information related to a domain-name term should be reviewed as to whether it has secondary meaning or can be protected as a trademark due to use in commerce. For example, consumer surveys are routinely used in disputes over a term's genericness. Such surveys can be "strong evidence" that the relevant public associates a mark with a brand as opposed to a generic meaning. *See id.* at 183 (noting that survey evidence indicated that "74.8% of respondents identified BOOKING.COM as a brand name, rather than as a general reference to hotel reservation websites.").

Furthermore, a showing of inherent distinctiveness could also render a TLD added to a generic term protectable as a trademark. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004) (providing a hypothetical example of where a TLD could enhance the distinctiveness of a mark, such as TENNIS.NET, for a company that sells tennis nets but does not operate on the internet).

**B. Courts of Appeals Have Not Applied a *Per Se* Rule to Marks Having a Generic Term Added to a Generic TLD**

Besides the Fourth Circuit, the Federal Circuit and Ninth Circuit are the only other courts of appeals to have addressed whether adding a ".com" to a generic second-level domain can be protectable as a trademark. None of these circuits, however, has adopted a categorical rule that a mark containing a generic term with a generic TLD is generic *per se*.

Indeed, the Federal Circuit and the Ninth Circuit have explicitly stated that adding a “.com” to a generic second-level domain is not *per se* unprotectable as a trademark. *See Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 982 (9th Cir. 2010) (“We have already stated that we create no *per se* rule against the use of domain names, even ones formed by combining generic terms with TLDs, as trademarks.”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177 (Fed. Cir. 2004) (“The addition of a TLD such as ‘.com’ or ‘.org’ to an otherwise unregistrable mark will typically not add any source-identifying significance.... This, however, is not a bright-line, *per se* rule.”).

The Ninth Circuit and Federal Circuit both looked at evidence of distinctiveness, even though each found “generic.com” names generic. *Booking.com B.V.*, 915 F.3d at 186. For example, in finding ADVERTISING.COM generic, the Ninth Circuit left open the possibility that “consumer surveys or other evidence might ultimately demonstrate that [the] mark is valid and protectable.” *Advertise.com, Inc.*, 616 F.3d at 982. Similarly, in finding HOTELS.COM generic, the Federal Circuit considered a consumer survey regarding the public’s understanding of HOTELS.COM. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1305 (Fed. Cir. 2009).

As such, the Fourth Circuit’s holding in *Booking.com B.V. v. United States Patent & Trademark Office* is not necessarily inconsistent with decisions in the other circuits that have declined to create a bright line rule against registering generic terms combined with generic TLDs. *See* 915 F.3d 171, 186 (4th Cir. 2019) (“We therefore decline to adopt a *per se* rule and conclude that when ‘.com’ is combined with an SLD, even a generic SLD, the

resulting composite may be non-generic where evidence demonstrates that the mark's primary significance to the public as a whole is the source, not the product."). Therefore, this case does not create a need for this Court to resolve a conflict among the courts of appeals.

**C. *Goodyear's Did Not Create a Per Se Rule Against Trademarking a Generic Term Added to a Generic TLD***

In an 1888 decision, this Court reviewed whether a generic term (i.e., "an article of commerce" such as a particular type of rubber) combined with the term "Company" could form a protectable trademark. *Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 603 (1888). In holding that it could not, this Court confirmed that no one party should have the exclusive right to identify itself according to the product it sold, and that naming a company "in the name of an article of commerce, without other specification," cannot create such exclusive rights:

The addition of the word "Company" only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them. Thus parties united to produce or sell wine, or to raise cotton or grain, might style themselves "Wine Company," "Cotton Company," or "Grain Company," but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles, and to publish the

fact to the world. Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.

*Id.* at 602-03.

In reaching its decision, the *Goodyear's* Court looked to *Canal Co. v. Clark*, in which this Court held that no one party can claim exclusive use of “geographical names, designating districts of country.” *Goodyear's Rubber Mfg. Co.*, 128 U.S. at 603 (citing *Canal Co. v. Clark*, 80 U.S. 311, 324 (1871)). In doing so, this Court reasoned that such geographical designations “pointed only to the place of production, and not to the producer” and did not serve to identify the source of the goods. *Id.* A “trade-mark must, either by itself or by association, point distinctively to the origin or ownership of the article to which it is applied.” *Id.*

Use of a “.com,” however, is neither equivalent nor analogous to use of the designation “Company.” The combination of a TLD with a generic term can form a unique Internet address from which goods or services supplied or rendered from a single source can emanate. In other words, such a domain name provides “other specification” as required by *Goodyear's*; it does not point “only to the place of production,” but also “to the producer,” as set forth in *Canal*.

Circuit courts have, therefore, properly interpreted *Goodyear's* as not creating a *per se* rule for top-level

domain indicators. While *Goodyear's* is still considered a precedential trademark decision, it was decided long before the Lanham Act created a path for trademarking descriptive terms and also long before internet companies (and domain names) came into existence. It decided a much different issue from the one facing the Court today.

Therefore, declining to adopt a rule that “generic.com” terms are *per se* generic will not be inconsistent with Supreme Court precedent.

#### **D. Domain Names Can Represent Source Identifying Locations on the Internet**

IPO believes that the addition of a “.com” or other generic TLD to denote a specific, source identifying location on the internet can result in a protectable mark. Unlike general terms for traditional brick-and-mortar companies such as “crab house,” *see Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 254-55 (4th Cir. 2001), looking to the component parts of a domain name may not unambiguously represent the primary significance of the term as a whole. *See In re Hotels.com*, 573 F.3d at 1305 (acknowledging that “consumers may automatically equate a domain name with a brand name”) (citation omitted). Thus, even where the domain-name-as-mark technically describes the service provided, it does not necessarily follow that the public commonly understands the mark to refer to the service broadly speaking.

**E. A TLD Indicator Added to a Generic Term Does Not Make the Composite Term *Per Se* Functional**

Although functional features of a product cannot form the basis for trademark protection of a mark, marks function to identify a source. As this Court has stated in *TrafFix* and *Qualitex*, “in general terms a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001) (quoting *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 165 (1995)).

Even if such a doctrine can be applicable to word marks, a TLD indicator added to a generic term does not make the composite term *per se* functional under the doctrine. A domain name, such as Wine.com (to use the “Wine” example from the *Goodyear’s* case), is not essential to the use or purpose of wine or the service of selling wine. It should also not affect the cost or quality of wine or the service of selling wine.

**II. GRANTING TRADEMARK PROTECTION TO A GENERIC TERM ADDED TO A GENERIC TLD WILL NOT NECESSARILY RESULT IN OVERLY BROAD MARKS**

Finally, IPO believes that granting trademark protection to a mark containing a generic term combined with a generic TLD upon a showing of primary significance to the relevant public will not necessarily lead to overly broad domain name marks. Because each generic term

and generic TLD, taken individually, would remain generic and free for all competitors and others to use, the resulting scope of protection will necessarily be narrow. Furthermore, to enforce such a mark, an owner would still need to show a likelihood of confusion. *Booking.com B.V.*, 915 F.3d at 187.

As discussed above, online companies are different from brick-and-mortar companies. “Given that domain names are unique by nature and that the public may understand a domain name as indicating a single site, it may be more difficult for domain name plaintiffs to demonstrate a likelihood of confusion.” *Id.*

Furthermore, the USPTO has already registered marks having arguably generic terms added to a generic top-level domain name. *See, e.g.*, STAPLES.COM (Reg. No. 2,397,238), WEATHER.COM (Reg. No. 2,699,088), ANCESTRY.COM (Reg. No. 3,852,700). To find that these marks are now *per se* generic would cause a number of marks that the USPTO has vetted and deemed eligible for registration to become invalid.

IPO is also concerned that creating a *per se* rule that a generic term added to a generic TLD causes the composite mark to be generic will be an overly restrictive application of trademark law. Once a mark is deemed generic, it is no longer eligible for trademark protection. Requiring that each composite term containing an allegedly generic term and a generic TLD be evaluated for its primary significance will help ensure that marks that the relevant public views as source identifiers remain protectable.



**CONCLUSION**

For the reasons stated above, IPO respectfully requests that the Court find that a generic term added to a generic top-level domain is not *per se* generic, and thus, can be eligible for trademark protection under the appropriate circumstances.

Respectfully submitted,

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February 19, 2020

## **APPENDIX**

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1. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

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