

# THE CUSTOMER IS ALWAYS RIGHT: TRADEMARK LAW AND GENERIC WEBSITE NAMES IN *U.S. PATENT AND TRADEMARK OFFICE v. BOOKING.COM B.V.*

**Abstract:** In 2020, in *U.S. Patent and Trademark Office v. Booking.com B.V.*, the Supreme Court clarified that the owner of a website with a descriptive domain name could trademark the name, even if it were styled “generic.com,” as long as it had acquired secondary meaning to consumers. Justice Breyer, in his dissent, vigorously argued that this ruling would limit competition. He claimed that allowing Booking.com to trademark its brand name, which contains terms that competitors use to describe similar business activities, would essentially be giving it a monopoly. This Comment supports the majority’s decision, as it conforms with the Lanham Act. Further, this Comment maintains that existing protections mitigate Justice Breyer’s monopolization concerns and argues that the Patent and Trademark Office should instill a strict evidentiary requirement for consumer perception.

## INTRODUCTION

Businesses spend millions annually on marketing to increase product recognition and their brand’s reputation, or goodwill.<sup>1</sup> Customers use a company’s brand to differentiate it from its competitors.<sup>2</sup> There is a consensus,

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<sup>1</sup> See Ivan De Luce, *10 Companies That Spent More Than \$1 Billion in Ads So You’d Buy Their Products*, BUS. INSIDER (Oct. 4, 2019), <https://www.businessinsider.com/10-biggest-advertising-spenders-in-the-us-2015-7> [<https://perma.cc/5KXK-UWM6>] (listing the companies that have spent the most in advertising in 2018, a record year for advertising expenditures); Christine Moorman, *Marketing Budgets Vary by Industry*, CMO INSIGHTS & ANALYSIS FROM DELOITTE (Jan. 24, 2017), <https://deloitte.wsj.com/cmo/2017/01/24/who-has-the-biggest-marketing-budgets/> [<https://perma.cc/P46U-RJ5X>] (exploring marketing expenditure as a percentage of overall budget and finding that when marketing increases profits, companies spend much more of their budget to entice customers to buy their products). A company’s goodwill is its reputation with consumers and its brand is the company’s physical mark that consumers look for to distinguish it from competitors, a marker of its goodwill. See *Goodwill*, BLACK’S LAW DICTIONARY (11th ed. 2019) (describing goodwill as a measure of a company’s reputation); U.S. PAT. & TRADEMARK OFF., TRADEMARK BASICS, <https://www.uspto.gov/trademarks-getting-started/trademark-basics> [<https://perma.cc/4KKX-P3AT>] (Jan. 17, 2021) (defining a trademark as synonymous with brand). For example, old and new customers buying Apple’s smart phones because of the company’s strong reputation would demonstrate Apple’s goodwill, and the apple logo that it puts on its devices would be its brand. See *Goodwill*, BLACK’S LAW DICTIONARY, *supra* (defining goodwill as a company’s reputation). A company’s goodwill is included in its valuation as an asset and includes its reputation and the extent to which customers choose its products or services over others. *Id.* Additionally, because a company’s trademark is a signal of its goodwill, infringement of that trademark is theft. *Id.*

<sup>2</sup> U.S. PAT. & TRADEMARK OFF., *supra* note 1. The U.S. Patent and Trademark Office (PTO) considers a company’s trademark as synonymous with its brand name and defines it as any combina-

rooted in common law, that businesses deserve to benefit from the good reputation of their brand and that competitors should not overstep by taking advantage of another's goodwill.<sup>3</sup> It is less clear, however, when protecting a brand's reputation would stifle legitimate competition.<sup>4</sup> This issue does not arise when entities trademark terms or symbols for their products that are entirely unique but, rather, with marks that are generic or descriptive of a type of good or service.<sup>5</sup> In such circumstances, trademark status would grant the owner of a non-distinctive mark a monopoly over the use of a term that its direct competitors employ to describe their shared business.<sup>6</sup> In 2020, in *U.S.*

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tion of words or symbols that indicate that the company made the trademarked product. *Id.* For example, Apple and Samsung, competing smartphone makers, rely on brand appeal to distinguish themselves from each other. *See id.*; Geoffrey Cain, *Samsung Vs. Apple: Inside the Brutal War for Smartphone Dominance*, FORBES (Mar. 13, 2020), <https://www.forbes.com/sites/forbesdigitalcovers/2020/03/13/samsung-vs-apple-inside-the-brutal-war-for-smartphone-dominance/#43a8a9ed4142> [<https://perma.cc/R7YT-X39X>] (detailing how Samsung launched an innovative campaign in the United States to compete with Apple for brand domination).

<sup>3</sup> *See* H.R. REP. NO. 79-219, at 2 (1945) (explaining the policy basis for the Lanham Act, the statute that controls trademark registration). Businesses have long marked their products. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:1 (5th ed. 2020). Indeed, merchants from more than 4,000 years ago used to mark their goods so that buyers could identify the product's origin. David D. Mouery, Comment, *Trademark Law and the Bottom Line—Coke Is It!*, 2 BARRY L. REV. 107, 111 (2001). The earliest recorded common law trademark case is *Sykes v. Sykes*, decided in 1824. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1853 (2007). In *Sykes*, the English court held that the defendants had infringed upon the plaintiff's rights by using its mark to disguise the defendants' products as the plaintiff's. *Id.* *See generally* *Sykes v. Sykes* (1824) 3 B&C 541, 107 Eng. Rep. 834 (LJKBOS) (holding that defendant's use of "Sykes Patent" on products that imitated plaintiff's caused consumer confusion, decreased plaintiff's sales, and was thus a violation of plaintiff's rights).

<sup>4</sup> *See* U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2310 (2020) (Breyer, J., dissenting) (arguing that allowing the registration of a generic term would give the business a monopoly over other similar services). This issue may arise in two cases; first, where a company tries to trademark the name of a generic class of goods, thus gaining control over the use of that mark to describe an entire class of product. *See id.* at 2315 (providing "Wine" as an example of an unacceptable trademark because it is synonymous with the product itself and thus not distinguishing for customers, and it could prevent competitors from using "Wine" to describe their own products). Second, the issue arises when a company tries to infringe on another's trademark and take advantage of its reputation to gain consumers. *See* Gap, Inc. v. G.A.P. Adventures, Inc., No. 07 Civ. 9614, 2011 WL 2946384, at \*18 (S.D.N.Y. 2011) (holding that Gap, the retailer, was entitled to relief against G.A.P. Adventures, a tour operator, because of the risk of consumer confusion).

<sup>5</sup> *See* *Booking.com B.V.*, 140 S. Ct. at 2303 (explaining that unique marks allow consumers to readily identify the brand because they are distinctive, whereas generic or descriptive marks just indicate the type of good or service and do nothing to distinguish the business).

<sup>6</sup> *See* 15 U.S.C. § 1127 (describing how a mark must be distinct and used to distinguish the product from competitors). In *U.S. Patent & Trademark Office v. Booking.com B.V.*, Justice Breyer's concern in his dissent was that allowing Booking.com to trademark its company name would allow them to bring infringement lawsuits against companies with "booking" in their name, thereby monopolizing the booking industry and preventing competitors from entering the field. *Booking.com B.V.*, 140 S. Ct. at 2315 (Breyer, J., dissenting) (raising the concern of giving Booking.com too much control over the booking industry due to the generic term's expansiveness); *see also* H.R. REP. NO. 79-219, at 2 (asserting that trademark registration is not intended to give the trademark-owner a monopoly).

*Patent and Trademark Office v. Booking.com B.V.*, a majority of the Supreme Court held that the primary factor in determining trademark eligibility for a descriptive mark is whether the brand has acquired secondary meaning to consumers.<sup>7</sup> In his dissent, Justice Breyer derided the majority for stifling competition by allowing the registration of essentially generic marks.<sup>8</sup> He believed that doing so would edge out competitors who wanted to allude to their shared type of business in their brand name.<sup>9</sup>

This Comment argues that the Court's decision in *Booking.com* was in line with federal trademark policy and will not lead to monopolies because of various safeguards already in place.<sup>10</sup> Part I discusses federal trademark law in the United States, including its purpose and mechanics, as well as the procedural history of *Booking.com*.<sup>11</sup> Part II surveys the Supreme Court's decision in *Booking.com*.<sup>12</sup> Finally, Part III supports the majority's rationale and argues that although the decision is in accordance with federal trademark policy, the United States Patent and Trademark Office (PTO) should require companies to present satisfactory evidence to demonstrate that a descriptive mark has acquired sufficient secondary meaning among consumers.<sup>13</sup>

## I. FEDERAL TRADEMARK LAW

Federal law protects a company's brand through the Lanham Act.<sup>14</sup> The Lanham Act provides both a means to register a trademark and also avenues for relief from trademark infringement.<sup>15</sup> A trademark is a term or image that

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<sup>7</sup> See *Booking.com B.V.*, 140 S. Ct. at 2307 (majority opinion) (stating that consumer perception determined whether a court would consider a mark styled "generic.com" generic or descriptive). A seemingly-descriptive trademark, one that is not necessarily distinctive in and of itself, may obtain secondary meaning to consumers when consumers recognize that the trademark indicates a specific product or brand. *Id.* at 2302.

<sup>8</sup> *Id.* at 2315 (Breyer, J., dissenting). For example, a generic mark may be something indicative of a general category of goods or services, like "wine," but a more unique mark may have no correlation to the good or service, like "Kodak." See *id.* at 2309–10 (providing "wine" as an example of a generic mark that could not be trademarked and "Kodak" as a unique mark that facilitates customers' identification of the product because of its distinctiveness).

<sup>9</sup> *Id.* at 2315.

<sup>10</sup> See *infra* notes 96–121 and accompanying text.

<sup>11</sup> See *infra* notes 14–72 and accompanying text.

<sup>12</sup> See *infra* notes 73–95 and accompanying text.

<sup>13</sup> See *infra* notes 96–121 and accompanying text.

<sup>14</sup> See 15 U.S.C. § 1051 (describing how brands can apply to register their trademark through the PTO); *Booking.com B.V.*, 140 S. Ct. at 2302 (stating that the Lanham Act is the principal protection for trademarks in the United States).

<sup>15</sup> *Booking.com B.V.*, 140 S. Ct. at 2302; see 15 U.S.C. § 1051 (discussing the application process for registering a trade or service mark); *id.* § 1125 (describing the rights of a mark-owner from another's misuse of their mark). The application should include information about the applicant and their past usage of the mark, as well as contain a statement that the applicant is the mark's owner, the owner uses the mark in commerce, and the mark does not infringe upon another mark. *Id.* § 1051. Once the PTO registers the trademark, the mark-owner may initiate a lawsuit for injunctive relief and dam-

differentiates a brand from its competitors.<sup>16</sup> For example, “Diet Coke” is a registered trademark of The Coca-Cola Company.<sup>17</sup> When consumers buy a “Diet Coke” they know that they are buying a Coca-Cola product, not an imitation.<sup>18</sup> Section A of this Part explores the policy behind trademark protection.<sup>19</sup> Section B discusses current federal trademark law.<sup>20</sup> Section C delves into the background of *U.S. Patent and Trademark Office v. Booking.com B.V.*<sup>21</sup>

### A. The Purpose of Trademark Protection

Congress passed the Lanham Act in 1946 to consolidate and clarify previous federal trademark laws.<sup>22</sup> Trademark laws have two goals: (1) to protect consumers from purchasing deceptively marketed goods and services, and (2) to protect an entity’s ownership of a trademark and its associated value.<sup>23</sup> In essence, trademark registration acknowledges and protects the worth of the brand’s goodwill.<sup>24</sup> Trademark registration guards against unfair competition by ensuring that consumers are not misled into purchasing unintended products.<sup>25</sup> The House Report on the Lanham Act addressed concerns over monopolies, including arguing that the concerns were irrelevant because trademarks assist fair competition by allowing consumers to purchase the product that they deem is best, without concern of fraud, by encouraging companies to compete for market share.<sup>26</sup> The Act also ensures that trademark-owners profit as a result of their

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ages against another who uses their mark in a false or misleading way, causing consumer confusion. *Id.* § 1025.

<sup>16</sup> U.S. PAT. & TRADEMARK OFF., *supra* note 1 (providing information to those wishing to register a mark, including information on what is eligible to be trademarked).

<sup>17</sup> DIET COKE, Registration No. 3,820,750.

<sup>18</sup> See H.R. REP. NO. 79-219, at 2 (1945) (explaining that federal law protects trademarks to ensure that customers get the product they want); John Dwight Ingram, *The Genericide of Trademarks*, 2 BUFF. INTELL. PROP. L.J. 154, 161 (2004) (remarking that Coca-Cola is known for aggressively protecting its trademark against infringement).

<sup>19</sup> See *infra* notes 22–29 and accompanying text.

<sup>20</sup> See *infra* notes 30–54 and accompanying text.

<sup>21</sup> See *infra* notes 55–72 and accompanying text.

<sup>22</sup> See H.R. REP. NO. 79-219, at 3 (explaining that prior to the Lanham Act, the prevailing federal trademark law had been frequently amended and supplemented by other legislation, including through provisions in tariff statutes, making it difficult to find and interpret). Additionally, Congress noted that previously it had considered trademark law to be a state issue but that, due to the cross-border nature of trade, federal trademark regulation was necessary. See *id.* at 4 (stating that trade is no longer local, but national, and interstate commerce is the proper domain of federal law).

<sup>23</sup> See *id.* at 4 (describing the “twofold” nature of the Lanham Act: to protect consumers from companies deceiving them into buying an unintended product and to safeguard a company’s goodwill or reputation in their mark).

<sup>24</sup> See *id.* (explaining that when a business has spent resources to promote itself, it should be able to benefit from those expenditures and not be at risk of theft or fraud).

<sup>25</sup> *Id.*

<sup>26</sup> See *id.* at 3 (describing how trademarks give consumers confidence in their choices and encourage producers to invest in good quality products). The premise is that when consumers can distin-

brand's reputation.<sup>27</sup> In this way, trademarks encourage competition and better quality products, and they discourage monopolies and efforts to mislead consumers.<sup>28</sup> Although Congress has removed or modified certain aspects of the Lanham Act, recent Supreme Court decisions have upheld the Act's stated purpose.<sup>29</sup>

### B. An Overview of Federal Trademark Law

The Lanham Act governs the process for registering a trademark and provides relief in the case of trademark infringement.<sup>30</sup> To get trademark protec-

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guish among brands they will choose a product that balances quality and cost and that companies will accordingly compete to make these products, creating an efficient marketplace. *See id.* (arguing that trademarks are "the essence of competition" in that they allow consumers to choose among competing products and thus encourage companies to compete with each other, while protecting the company's brand and reputation from fraud).

<sup>27</sup> *See id.* (discussing the policy for preventing expropriation of a business's goodwill). In 1942, in *Mishawaka Rubber & Woolen Manufacturing Co. v. S.S. Kresge Co.*, a Supreme Court case that the Lanham Act Committee Report cited, Justice Frankfurter upheld Mishawaka's trademark infringement action. 316 U.S. 203, 208 (1942). In *Mishawaka*, the defendant had sold lesser-quality shoes that incorporated a design element that looked like Mishawaka's trademark. *Id.* at 203–04. Mishawaka had spent considerable effort and funds to promote its product to the public. *Id.* The Supreme Court found that although there was no evidence that consumers were misled, there was a possibility that some may have unintentionally bought the competitor's product, thinking it was Mishawaka's. *Id.* at 204. The Court held that this would be damaging to Mishawaka's brand and thus constituted actionable trademark infringement. *Id.* at 208. Dissenting, Justice Black highlighted that there was no indication to support the contention that the defendant purposely misled consumers or that the Mishawaka brand was at all affected. *Id.* at 208–09 (Black, J., dissenting). Without that evidence, Justice Black saw no basis for trademark infringement or relief and, indeed, speculated that this would result in Mishawaka receiving an undeserved boon by eliminating its competition. *Id.* at 209.

<sup>28</sup> *See* H.R. REP. NO. 79-219, at 3 (arguing that trademarks facilitate superior products by allowing customers to distinguish between brands and choose what they prefer).

<sup>29</sup> *See, e.g.,* *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017) (explaining that trademarks bolster the economy by encouraging competition and ensuring that the trademark-owner gets the fruits of his goodwill for his higher quality products); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 781–82 (1992) (reiterating the Lanham Act's goal to safeguard valid business efforts and consumer expectations); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 190 (1985) (reiterating that Congress intended the Lanham Act to "secure" the entity's goodwill, which is developed from the entity's business and reputation). Recent Supreme Court decisions, for example, have modified the Lanham Act and held that its prohibitions against "immoral" trademarks and marks that denigrate any individual are invalid under the First Amendment. *See Iancu v. Brunett*, 139 S. Ct. 2294, 2297 (2019) (affirming that the immoral trademark clause in the Lanham Act is invalid under the First Amendment); *Matal*, 137 S. Ct. at 1765 (holding that the disparagement clause infringes upon the Constitution's free speech clause); *see also* 15 U.S.C. § 1052 (a)–(b) (declaring ineligible a trademark that included "immoral or scandalous" subject-matter, implied a false association between the product and an individual or place, denigrated an individual, or featured the insignia of any country).

<sup>30</sup> 15 U.S.C. §§ 1051, 1125; U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298, 2302 (2020). There are other means of intellectual property protection, namely patents and copyrights. U.S. PAT. & TRADEMARK OFF., TRADEMARK PROCESS, <https://www.uspto.gov/trademarks-getting-started/trademark-process#step1> [<https://perma.cc/WF47-AP52>] (Feb. 2, 2021). Patents secure inventions, copyrights safeguard artistic works, and trademarks protect brand names and symbols associated with goods and services. *Id.* For example, if someone invented a new form of blender, they could patent

tion, an entity must register its mark with the PTO.<sup>31</sup> Although the process of getting a trademark is straightforward, what can be trademarked is more complicated.<sup>32</sup> The Act allows an entity to register its trademark if it meets two requirements: (1) it is actively used in commerce, and (2) it is distinctive and identifies the brand.<sup>33</sup>

Prior to applying, the PTO encourages applicants to consider the strength of their mark to ensure it will pass the distinctiveness requirement.<sup>34</sup> In classifying strength, the PTO categorizes marks with respect to the associated prod-

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the invention, trademark the blender logo, and copyright the radio jingle for the blender. *See id.* (providing a similar example for a fictitious invented vacuum cleaner).

<sup>31</sup> U.S. PAT & TRADEMARK OFF., *supra* note 30. First, an entity must submit an application to the PTO that describes the mark completely, identifies the relevant goods and services associated with it, and ensures that there are no comparable trademarks in use for related goods or services. *Id.* The purpose of this phase is to ward against potential infringement on another trademark. *See id.* (discussing the search requirement and providing information for applicants on how to run a successful search on their mark). Next, a PTO examining attorney will review the application. *Id.* The PTO will then either reject the application with an explanation and allow a six month window to re-apply, or it will approve the application. *Id.* If the PTO approves the application, it will publish the mark in an “Official Gazette,” which gives other parties thirty days to oppose the registration. *Id.* If there is no conflict within the time period, the PTO will grant the trademark, and the trademark-owner simply has to maintain the mark by submitting periodic documents. *Id.*

<sup>32</sup> *See* 15 U.S.C. §§ 1051–1052 (outlining requirements for trademark applicants, including that the owner use the mark in commerce, the mark does not infringe upon another mark, and it is not just descriptive of the product but is distinctive); Jon J. Lee, *Double Standards: An Empirical Study of Patent and Trademark Discipline*, 61 B.C. L. REV. 1613, 1627–28 (2020) (stating two common reasons for trademark denial: likelihood of consumer confusion and a lack of distinctiveness). Recognizing that this standard may be vague, the PTO publishes accessible guidance for applicants to use while considering whether their mark meets the criteria for trademark status. U.S. Pat. & Trademark Off., *Basic Facts: Selecting a Mark*, YOUTUBE (Sept. 30, 2016), [https://www.youtube.com/watch?v=z4jmtzR4\\_NU&feature=emb\\_title](https://www.youtube.com/watch?v=z4jmtzR4_NU&feature=emb_title) [<https://perma.cc/E2AY-Z596>] (teaching applicants how to consider the strength of their mark).

<sup>33</sup> 15 U.S.C. §§ 1051–1052. Applicants can satisfy the first requirement if they simply have a bona fide, or genuine, future intent to use the mark in commerce. *See id.* § 1051 (a)–(b) (discussing the application process for a trademark). The PTO stresses the second requirement, that the mark be distinctive and indicative of the product’s source, in proceedings so as to avoid consumer confusion. *See id.* § 1052 (d)–(e) (stating that a mark cannot infringe upon an existing mark or solely be descriptive of a product); U.S. Pat. & Trademark Off., *supra* note 32 (describing the requirements to potential applicants so applicants can determine whether their mark is eligible for trademark registration). Additionally, the Lanham Act forbids registration for trademarks that use “immoral, deceptive, or scandalous matter,” denigrate any individual, alive or dead, suggest a false origin for the product, or use any insignia of the United States or a United States President. 15 U.S.C. § 1052(a)–(b). The prohibitions on immoral or scandalous marks and on marks that denigrate individuals, however, have been struck down by the Supreme Court as violating the First Amendment. *See Iancu*, 139 S. Ct. at 2297 (holding that the immoral or scandalous trademark bar infringed on the First Amendment); *Matal*, 137 S. Ct. at 1765 (stating that the disparagement ban violates the free speech protections of the Constitution).

<sup>34</sup> U.S. Pat. & Trademark Off., *supra* note 32. The PTO produces material on its website that applicants may look at to gauge whether their mark meets the eligibility requirements for trademark registration. *See id.* (outlining the criteria a mark must meet in order to be eligible for trademark registration).



uct as follows: generic, descriptive, suggestive, and fanciful or arbitrary.<sup>35</sup> A generic mark includes a term that indicates the type of good or service an entity sells.<sup>36</sup> An entity cannot trademark these terms because doing so would grant them a monopoly over a term that describes an entire class of goods.<sup>37</sup> Descriptive marks describe the goods or services that the owner offers.<sup>38</sup> Descriptive marks are generally invalid because they present information, rather than indicate a specific business.<sup>39</sup> They may be accepted, however, if the entity can present evidence, commonly through surveys, showing that the term has acquired sufficient standing with consumers, or secondary meaning, that it is now associated with the business specifically.<sup>40</sup> Suggestive, fanciful, and arbitrary marks are stronger than descriptive marks, and it is more likely that the PTO will accept them for trademark registration.<sup>41</sup> Suggestive marks indicate aspects of the product, fanciful marks consist of invented terms, and arbitrary marks contain terms with an accepted definition that has no connection to the

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<sup>35</sup> *Id.*; see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (describing the four categories of trademark distinctiveness). In *U.S. Patent and Trademark Office v. Booking.com B.V.*, Justice Ginsburg offered the following examples: “wine” as a generic term, “Park ‘N Fly” as a descriptive mark, “Tide” as a suggestive mark, “Camel” as an arbitrary mark, and “Kodak” as a fanciful mark. 140 S. Ct. at 2302–03.

<sup>36</sup> U.S. Pat. & Trademark Off., *supra* note 32; see 15 U.S.C. § 1052 (e)–(f) (prohibiting trademark status for a mark that is merely descriptive of the goods or services offered without being distinctive). A candle brand called “Candle” would be an example of a generic mark. See Ingram, *supra* note 18, at 156 (explaining that “ivory” is an example of an ineligible descriptive trademark for products made from tusks but is acceptable for soap products).

<sup>37</sup> See H.R. REP. NO. 79-219, at 3 (1945) (stating that the Lanham Act intends to stimulate competition and thus discourage monopolies). Furthermore, generic trademarks could cause consumer confusion because they do not clearly identify the product’s producer. See *id.* at 2 (clarifying that Congress intended the Act to safeguard the public’s expectation that they are getting the specific product they want from the producer they intend, as its trademark evidences); U.S. Pat. & Trademark Off., *supra* note 32 (emphasizing the distinctiveness of a mark to applicants to satisfy trademark requirements).

<sup>38</sup> See 15 U.S.C. § 1052(e) (explaining federal trademark law regarding descriptive marks); U.S. Pat. & Trademark Off., *supra* note 32. “Tastykake” is an example of a descriptive mark for a pastry. See Ingram, *supra* note 18, at 155 (defining descriptive marks and providing “Tide” laundry detergent as an example).

<sup>39</sup> U.S. Pat. & Trademark Off., *supra* note 32.

<sup>40</sup> 15 U.S.C. § 1052(f); U.S. Pat. & Trademark Off., *supra* note 32; see MCCARTHY, *supra* note 3, § 12:16 (detailing how the *Teflon* survey has become the standard test for consumer perception); *infra* notes 67–68 and accompanying text (outlining the *Teflon* survey method and why the PTO disfavors it). The secondary meaning standard allows descriptive marks to gain federal trademark protection if they have become distinctive of the products. 15 U.S.C. § 1052(f). The Supreme Court clarified the secondary meaning standard in 2000 in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, where a clothing manufacturer sued Walmart for selling alleged reproductions. 529 U.S. 205, 205, 216 (2000). The Court found that a product’s design is not inherently distinctive but that the mark-owner may receive trademark protection if it shows that the mark has acquired secondary meaning among consumers and that consumers recognize the mark as distinctive of the brand. *Id.* at 205–06.

<sup>41</sup> U.S. Pat. & Trademark Off., *supra* note 32.

product.<sup>42</sup> These marks are the strongest because they are unusual and unrelated to the product at issue, which makes the brand distinctive.<sup>43</sup> Yet, even the strongest terms may become generic over time and, thus, the brand may lose its trademark registration.<sup>44</sup>

Case law has also guided PTO decisions.<sup>45</sup> In *Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co.*, decided in 1888, the Supreme Court held that simply adding "Company" to an already descriptive term did not make it trademarkable because "Company" merely indicates an organization.<sup>46</sup> Another important Supreme Court case was in 1938, in *Kellogg Co. v. National Biscuit Co.*, where the Court ruled that Kellogg could continue to produce shredded wheat cereal in the same shape that National Biscuit had patented.<sup>47</sup> The

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<sup>42</sup> *Id.*; see *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9, 10 (2d Cir. 1976) (discussing the origin of the "suggestive" category as a middle ground between fanciful and generic and highlighting that marks may shift between categories depending on usage and differing meaning). "Playboy" Magazine is an example of a suggestive mark. See Ingram, *supra* note 18, at 155 (defining the suggestive term category and providing "Playboy" and "Tide" as examples of marks suggestive of particular products, an erotic magazine and laundry detergent). "Penguin" Publishers is an example of an arbitrary mark, and "Google" is an example of a fanciful mark. See *id.* (describing the categories and providing examples such as "Kodak" film for a fanciful mark and "Camel" cigarettes for an arbitrary mark).

<sup>43</sup> U.S. Pat. & Trademark Off., *supra* note 32.

<sup>44</sup> See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963) (affirming the district court's holding that "Thermos," previously trademarked, had become generic through extensive, long-term use and therefore no longer had trademark protection); U.S. Pat. & Trademark Off., *supra* note 32; see Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1843 (2007) (citing *Allocs for Dummies Inspires IDG Ire*, LUMEN DATABASE (Mar. 15, 2000), <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=149> [https://perma.cc/9VDA-U52Q]) (discussing trademark dilution and "genericide" of brands with fanciful trademark names, such as Kleenex and Xerox, brand names that became synonymous with the product itself).

<sup>45</sup> See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 174 (1995) (stating that a color could be trademarked if it had acquired secondary meaning to consumers); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 111, 122–23 (1938) (holding that Kellogg did not infringe upon National Biscuit's trademark even though it shared in the company's acquired goodwill, because the cereal's name was merely descriptive and its shape was functional); *Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 603 (1888) (forbidding the trademarking of a descriptive term followed by a "Company" designation because the designation added no distinguishing meaning).

<sup>46</sup> *Goodyear*, 128 U.S. at 603. At the time, "Goodyear Rubber" was a well-known term used to describe a type of rubber that Charles Goodyear patented in 1849. *Id.* at 600, 602. In this case, Goodyear Rubber Company sued Goodyear Rubber Manufacturing to prevent them from using "Goodyear" in their name, arguing that the defendant was doing so to steal the plaintiff's business and goodwill. *Id.* at 600–01. The defendant stated that it had been using the name for years following its licensing of Goodyear patents in 1849. *Id.* at 600. The Supreme Court affirmed that if anyone could trademark "Goodyear," the defendants would have a right to the mark due to their lengthy use, but stated that the term being descriptive of a means of production made it ineligible for trademark registration. *Id.* at 602.

<sup>47</sup> *Kellogg*, 305 U.S. at 123. National Biscuit sued to prevent Kellogg from making cereal, alleging unfair competition because Kellogg was also calling its cereal "shredded wheat" and was using the same pillow shape for its cereal as National Biscuit. *Id.* at 111. Specifically, National Biscuit was not claiming a right to the cereal itself but, rather, to its name and shape. *Id.* at 116. In turn, Kellogg argued that it was engaging in honest competition. *Id.*



Court ruled that this was not trademark infringement because the patent had expired, the name “Shredded Wheat” was descriptive, and the shape of the cereal was necessary for the product.<sup>48</sup> Finally, in *Qualitex Co. v. Jacobson Products Co.*, decided in 1995, the Supreme Court allowed Qualitex to trademark the color of its dry-cleaning pads.<sup>49</sup> Even though the Court found that a color was not inherently distinctive, it held that in this case it had acquired a special significance to Qualitex consumers, who would seek out the color as a symbol of the brand.<sup>50</sup>

In cases of alleged trademark infringement, the mark-owner may sue for injunctive relief.<sup>51</sup> The mark-owner may also sue to recover the competitor’s profits at the owner’s expense, damages, and litigation costs.<sup>52</sup> The competitor may invoke the fair use defense, which exculpates it if it has acted fairly and in good faith.<sup>53</sup> Importantly, the mark-owner has the burden to overcome the defense and may do so by showing likelihood of confusion.<sup>54</sup>

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<sup>48</sup> *Id.* at 113, 116–17, 122. Additionally, the Court held that although Kellogg likely benefited from National Biscuit’s goodwill by using the pillow shape, Kellogg had its own company logo on the product in a manner sufficient to avoid consumer confusion and prevent unfair competition. *Id.* at 122.

<sup>49</sup> *Qualitex*, 514 U.S. at 174. Qualitex manufactures dry cleaning press pads, a product that dry cleaners use at the end of the process to press clothes and give them a finished look. See *Sun Glow Press Pads*, QUALITEX CO., <http://www.qualitexco.com/http/pads.html> [<https://perma.cc/9UQW-XBSH>] (advertising that award-winning dry cleaning shops use the Sun Glow Press Pads and stating that the green-gold color is a registered trademark).

<sup>50</sup> *Qualitex Co.*, 514 U.S. at 171, 174. In *Qualitex*, both companies sold dry-cleaning pads but the Court found that Qualitex alone had cultivated its reputation and goodwill through the product’s association with its color. *Id.* at 159. The Court held that whether an owner could trademark a product’s color as a descriptive mark was not a function merely of the color’s distinctiveness, but whether the color had acquired secondary meaning through use. *Id.* at 163; see *supra* note 40 and accompanying text (describing the secondary meaning standard); see also *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 206, 216 (2000) (holding that a court may find that a product design is distinctive by showing that the secondary meaning of its design caused consumers to seek out the product).

<sup>51</sup> 15 U.S.C. § 1114 (specifying the right to protection from mark infringement); *id.* § 1116 (detailing the means by which a mark-owner may receive an injunction). A court-ordered injunction would prevent the competitor from continuing to infringe by banning their use of the particular mark. See *id.* § 1116 (explaining that equity should guide courts in granting an injunction against a competitor). The Lanham Act distinguishes innocent and culpable infringement by specifying that the mark-owner may only recover damages when the infringement was knowingly intended to cause consumer confusion. *Id.* § 1114(1).

<sup>52</sup> *Id.* § 1117(a)–(d) (outlining recovery for mark infringement, including that a mark-owner may recover damages for lost profits and attorney fees, treble damages for intentional misuse of the mark, and statutory damages for violations of the Lanham Act).

<sup>53</sup> *Id.* § 1115(b)(4) (explaining the fair use defense—that the alleged infringer used the mark at issue in good faith and fairly to represent their goods and services or their origin). Under 15 U.S.C. § 1114, a mark-owner has the right to prevent infringement but must provide proof that the use of the mark was likely to cause consumer confusion. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004). In turn, the alleged infringer may assert the fair use defense to rebut any allegation under 15 U.S.C. § 1115. *Id.* at 118.

<sup>54</sup> *KP Permanent*, 543 U.S. at 118, 124 (finding that the defendant need not prove fair use after asserting it as a defense and that the burden shifts to the plaintiff to show consumer confusion). In *KP Permanent*, Lasting Impression, a beauty company, sued KP Permanent Make-Up over the use of the

*C. Factual and Procedural Background of U.S. Patent  
and Trademark Office v. Booking.com B.V.*

Booking.com was founded in 1996 and has become one of the world's largest online travel companies.<sup>55</sup> The name "Booking.com" is both the company's name and domain name.<sup>56</sup> Booking.com applied for trademark registration in 2011 but the PTO's examining attorney rejected the application.<sup>57</sup> Booking.com appealed to the Trademark Trial and Appeal Board (TTAB), the PTO's appeal board, in 2016, but TTAB also rejected the company's trademark application.<sup>58</sup> TTAB determined that "Booking.com" was ineligible because it was generic, and, even if it were descriptive, evidence did not indicate that it had secondary meaning to consumers.<sup>59</sup> TTAB classified "Booking.com" as generic because it referred to a type of service, making bookings, but disclaimed that it could classify the term as descriptive because it described the company's product, a booking service.<sup>60</sup> If it were descriptive, TTAB found that evidence indicated that the average consumer understood "Booking.com" to refer to a class of services, not a specific brand, and thus it was still ineligible.<sup>61</sup> Booking.com argued that it was within the policy of the Lanham Act to

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term "micro color," which KP had used since 1990 and Lasting had trademarked in 1992. *Id.* at 111. Although Lasting argued that KP had infringed upon its mark, KP asserted the fair use defense—that it had been acting fairly and in good faith in using the term "micro color" to describe its products and that it had been using the term from before Lasting received a trademark. *Id.* In *KP Permanent*, the Supreme Court remanded the case after holding that Lasting had the burden to show consumer confusion, but it also noted that some degree of consumer confusion will be tolerated for a descriptive trademark because otherwise the company may gain a monopoly over a term that competitors use to describe a shared good or service. *Id.* at 122, 124. Likelihood of confusion was shown in 1942, in *Mishawaka Rubber & Woolen Manufacturing v. S.S. Kresge Co.*, when the defendant's shoe contained a similar red plug in its heel and the Supreme Court agreed that there was a "reasonable likelihood" that it deceived some consumers, even though the plaintiffs offered no proof. 316 U.S. 203, 204 (1942).

<sup>55</sup> *About Booking.com*, BOOKING.COM, <https://www.booking.com/content/about.html> [<https://perma.cc/9NYY-HY7N>]. Booking.com connects businesses with travelers and functions as a one-stop-shop for customers to book flights, hotels, rental cars, and even activities. *Id.*

<sup>56</sup> *See id.* (describing the business of Booking.com at the domain name, booking.com).

<sup>57</sup> *In re Booking.com B.V.*, 2016 WL 1045674, at \*1, \*19 n.1 (T.T.A.B. 2016), *rev'd and remanded sub nom.* *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891 (E.D. Va. 2017), *aff'd sub nom.* *Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171, 181 (4th Cir. 2019), *vacated*, 140 S. Ct. 2298 (2020).

<sup>58</sup> *Id.* at \*1, \*15–16. Claiming that its name had become distinct and recognizable to consumers due to its advertising and strong reputation, Booking.com applied to register four trademarks, each with the same term, styled differently. *Id.* at \*2.

<sup>59</sup> *In re Booking.com B.V.*, 2016 WL 1045674, at \*1, 15–16.

<sup>60</sup> *See id.* (explaining that a consumer may understand "Booking.com" to mean a generic type of services offered by many providers including Booking.com, Expedia.com, and Kayak.com, but that it is also descriptive because the name describes the services the company offers).

<sup>61</sup> *See id.* at \*11 (holding that the J.D. Power survey data showed brand success, not consumers understanding the company to be a specific brand). In its appeal before the Trademark Trial and Appeal Board (TTAB), Booking.com presented survey data from J.D. Power & Associates. *Id.* at \*7. The

allow a trademark in a case where a company has put a great deal of effort into cultivating reputation and goodwill.<sup>62</sup> TTAB disagreed, finding that trademarking a generic term creates a monopoly against the express purpose of the Act.<sup>63</sup>

After TTAB rejected Booking.com in favor of the PTO's position, the company appealed to the United States District Court for the Eastern District of Virginia in 2017.<sup>64</sup> The PTO expanded its argument, claiming that a ".com" designation was akin to the "Company" designation in *Goodyear*.<sup>65</sup> It argued that the addition of the ".com" marker was in itself generic and, thus, did not modify the generic nature of "booking."<sup>66</sup> Ultimately, the district court reversed TTAB's decision due to new survey evidence that Booking.com submitted, which demonstrated that the site had acquired secondary meaning to consumers.<sup>67</sup> The

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survey asked about "pricing; information provided; booking options; the online 'store'; ease of booking; sales and promotions; and customer service." *Id.* at \*11. TTAB held that this survey was not as demonstrative as a *Teflon* survey, the standard test for consumer perception, and indeed showed success and satisfaction, not perception. *Id.*

<sup>62</sup> *Id.* at \*14.

<sup>63</sup> *Id.* To the PTO, this would halt competition, as any other company that used the term "Booking.com" may be infringing upon the mark. *See id.* (rationalizing that allowing a trademark for a generic term, one that describes a category of goods, would provide a monopoly because a competitor would not be able to describe their goods without infringing upon another's mark). During oral arguments before the Supreme Court, the Government argued that the trademark would give Booking.com a monopoly and gave the examples of "ebooking.com" and "hotelbooking.com" as brand names that Booking.com would be able to suppress. Oral Argument at 15:07, *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298 (2020) (No. 19-46), <https://www.oyez.org/cases/2019/19-46> [<https://perma.cc/6YR9-F6RQ>].

<sup>64</sup> *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 895 (E.D. Va. 2017), *aff'd sub nom. Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171, 181 (4th Cir. 2019), *vacated*, 140 S. Ct. 2298 (2020).

<sup>65</sup> *Id.* at 910.

<sup>66</sup> *Id.*; Oral Argument, *supra* note 63, at 01:28.

<sup>67</sup> *Booking.com B.V.*, 278 F. Supp. 3d at 923. As opposed to its TTAB appeal where it presented a commissioned survey that the TTAB did not find persuasive, before the district court Booking.com presented *Teflon* survey evidence—the recognized standard for determining whether a mark is generic. *Id.* at 898; MCCARTHY, *supra* note 3, § 12:16. The *Teflon* Survey is a survey format broadly accepted by courts to measure a mark's secondary meaning to consumers. MCCARTHY, *supra* note 3, § 12:16. The *Teflon* Survey was first used in 1975 in *E.I. DuPont de Nemours & Co. v. Yoshida Int'l Inc.*, where the court held that a survey asking respondents to classify a series of terms as brand names or common names, after receiving an explanation of the difference, was valid evidence that consumers believed "Teflon" to be a brand name. 393 F. Supp. 502, 526–27 (E.D.N.Y. 1975). In that case, the court relied on a survey to determine consumers' perception of a trademark. *Id.* at 527. A *Teflon* survey is a survey format that involves asking whether the respondent thinks a series of terms are common names or brand names. MCCARTHY, *supra* note 3, at § 12:16. Since 1975, companies have frequently used the *Teflon* survey format to demonstrate that their trademark has acquired secondary meaning to consumers such that consumers use the mark to distinguish their goods from competitors. *See, e.g.,* *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1166–67, 1176 (D. Ariz. 2014) (relying on a *Teflon* survey to find that that "Google" had not become generic for search engines); *Hershey Co. v. Promotion in Motion, Inc.*, No. 07-1601, 2011 WL 5508481, at \*9 (D.N.J. Nov. 7, 2011) (finding that Hershey's numerous *Teflon* surveys offered reasonable evidence that "KISSES" are recognized by consumers as a distinct brand); *March Madness Athletic Ass'n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 803 (N.D. Tex. 2003) (using *Teflon* survey evidence showing that consumers identi-

district court agreed that “booking” was generic, but found that “Booking.com,” when considered as a whole, was descriptive and that the public used it not to identify a type of website or service, but rather a specific website.<sup>68</sup> In addition, the court found that the name had developed significance to consumers who associated it with a specific brand that offered a superior product.<sup>69</sup> The PTO appealed this decision to the United States Court of Appeals for the Fourth Circuit in 2019, and the Fourth Circuit affirmed the district court.<sup>70</sup> The Fourth Circuit agreed with the district court that Booking.com had acquired secondary meaning and found it noteworthy that the PTO had no evidence showing “booking.com” was a generic term that customers used to indicate a class of services.<sup>71</sup> Subsequently, the PTO petitioned the Supreme Court for a writ of certiorari to review the Fourth Circuit’s decision, which the Court granted.<sup>72</sup>

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fied “March Madness” as a trademark and not generic to find that the mark had obtained secondary meaning). Although courts tend to rely on *Teflon* surveys to indicate secondary meaning, the PTO disfavors the format as a test of a mark’s genericness due to the potentially ambiguous and subjective nature of its questions. *See, e.g., Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC.*, 124 U.S.P.Q.2d 1184, 2017 WL 3948367 at \*15 (T.T.A.B. 2017) (rejecting a *Teflon* survey that did not adequately explain the difference between a trademark and a generic term and used an ambiguous example that may have confused participants); *Zimmerman v. Nat’l Ass’n of Realtors*, 70 U.S.P.Q.2d 1425, 2004 WL 763936 at \*12–13 (T.T.A.B. 2004) (outlining failures of a *Teflon* survey that was improperly structured by having only 96 participants, giving respondents misleading examples, and lacking a “don’t know” answer option).

<sup>68</sup> *Booking.com B.V.*, 278 F. Supp. 3d at 914, 922 (making its decision on the basis of new evidence such as the *Teflon* survey and the social media following for Booking.com). In *Goodyear*, the Supreme Court held that that adding “Company,” a word that indicates a business association, to “Goodyear Rubber,” a term that describes a means of production, did not make the mark eligible for trademark status because both terms were generic and when combined did not distinguish the product. *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602–03 (1888). In considering “Booking.com” as a trademark, the district court held that the “company” designation in Goodyear was solely an indicator of corporate status, and that it was substantially different from “.com,” which is a domain component and holds meaning to consumers as indicating a unique address. *Booking.com B.V.*, 278 F. Supp. 3d at 910. *Compare Goodyear*, 128 U.S. at 602–03 (noting that “Company” indicates a business type and holding that no entity could trademark the term combined with a generic word because the combination imparts no distinguishing meaning to consumers), *with Booking.com B.V.*, 278 F. Supp. 3d at 910 (differentiating an entity designation with a domain name and stating that the latter specifically indicates a unique web address and thus is distinguishing to consumers).

<sup>69</sup> *Booking.com B.V.*, 278 F. Supp. 3d at 918–19.

<sup>70</sup> *Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171, 181 (4th Cir. 2019), *vacated*, 140 S. Ct. 2298 (2020). The Fourth Circuit reiterated trademark policy to safeguard brand goodwill and prevent customer confusion, and it affirmed that companies would never be able to trademark generic marks such as “Lite Beer,” which may provide the company a monopoly over all light beer marketing. *Id.* at 176–77. Additionally, the Fourth Circuit clarified that the PTO has the burden of proving that a mark is generic because the consequences of such a decision have serious implications for trademark registration. *Id.* at 179.

<sup>71</sup> *Id.* at 181–82. Instead of demonstrating that customers use “booking.com” generically to indicate a class of booking services, the PTO simply referenced similar domain names, like “hotelbooking.com” and “ebooking.com” to support its argument that Booking.com had not acquired secondary meaning. *Id.* at 182.

<sup>72</sup> *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2304 (2020).

## II. THE SUPREME COURT'S DECISION IN *U.S. PATENT AND TRADEMARK OFFICE V. BOOKING.COM B.V.*

In the Supreme Court's 2020 case, *U.S. Patent and Trademark Office v. Booking.com B.V.*, the Justices considered whether granting trademark protection to a mark styled "generic.com" would limit competition and whether a blanket prohibition against the mark would be reasonable.<sup>73</sup> On June 30, 2020 the Supreme Court affirmed the district court's decision in favor of Booking.com due to the company's acquired significance to consumers.<sup>74</sup> Section A of this Part examines Justice Ginsburg's majority opinion.<sup>75</sup> Section B focuses on Justice Breyer's dissent.<sup>76</sup>

### *A. Justice Ginsburg's 8–1 Majority Opinion*

The Court ruled in favor of Booking.com due to the website's acquired meaning to customers.<sup>77</sup> Justice Ginsburg, in her majority opinion, held that although "booking" and ".com" may alone be generic, together they were descriptive.<sup>78</sup> Additionally, although a generic term can never be trademarked, a descriptive term can be if evidence shows it has acquired secondary meaning.<sup>79</sup>

<sup>73</sup> Oral Argument, *supra* note 63, at 9:03 (responding to a question from Justice Thomas about whether allowing the trademark would give Booking.com an unfair advantage over other online booking providers and thus a *per se* rule would be appropriate); *id.* at 37:04 (suggesting the PTO was attempting to create a *per se* rule, contrary to its prior decisions).

<sup>74</sup> *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020).

<sup>75</sup> See *infra* notes 77–85 and accompanying text.

<sup>76</sup> See *infra* notes 86–95 and accompanying text.

<sup>77</sup> *Booking.com B.V.*, 140 S. Ct. at 2305. Justice Ginsburg rooted her analysis in the primary significance test, a test that the PTO uses to determine whether a mark has lost its distinctive meaning to consumers by becoming generic and thus should lose its registration. *Id.* at 2304; see 15 U.S.C. § 1064(3) (stating that the PTO would cancel a previously registered mark if it became used generically for the goods or services for which it was initially trademarked). The majority used the primary significance test to highlight the importance of consumer perception and declined to hold whether the test was applicable outside of mark cancellation. *Booking.com B.V.*, 140 S. Ct. at 2304 n.3.

<sup>78</sup> *Booking.com B.V.*, 140 S. Ct. at 2306 (holding that a "generic.com" mark may be descriptive if it communicates details to a consumer about the mark's source, that is, the website's owner). The PTO has interpreted *Goodyear* as creating a rule that a mark styled "Generic Company" could not be trademarked at all, regardless of secondary meaning. *Id.* The majority corrected this understanding and stated that *Goodyear*'s holding meant that multiple generic terms would remain generic if their combination imparted nothing to differentiate the brand to consumers. *Id.* In its analysis, the majority first considered the mark as a whole. *Id.* at 2304. For example, people do not refer to "booking.coms" as types of booking suppliers; rather the term indicates a particular provider of that service. See *id.* at 2304–05 (declaring that "Booking.com" was not generic and had a distinguished meaning to consumers). Next, the majority considered whether "Booking.com" had developed consumer meaning. *Id.* at 2304. After noting that lower courts had made uncontested determinations that it had, the Supreme Court held that the brand could be trademarked. *Id.* at 2305.

<sup>79</sup> *Id.* at 2303. The majority stated that the PTO can accept evidence of secondary meaning from surveys, dictionaries, common usage, or anything that demonstrates that customers see the mark as distinguishing the business from its competitors. *Id.* at 2307 n.6. Justice Sotomayor's concurring opinion highlighted that although survey evidence may be faulty, the Supreme Court had not mandated

Acquired secondary meaning indicates that consumers recognize that the mark indicates a specific brand.<sup>80</sup> The Court highlighted that a single business can hold a domain which already gives it a particular meaning to consumers.<sup>81</sup> Because Booking.com presented survey evidence demonstrating that it had acquired secondary meaning to consumers, its mark was eligible for trademark status as a descriptive mark.<sup>82</sup> The Court refused to adopt the PTO's proposed *per se* rule, which would declare any "generic.com" mark to be generic and ineligible for trademark protection regardless of consumer perception.<sup>83</sup> Further, the majority rejected the PTO's concerns of monopolization.<sup>84</sup> The Court held that these risks accompanied any descriptive mark and were mitigated by the fact that, for a descriptive mark, infringement occurs only when use of a similar mark confuses customers.<sup>85</sup>

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any evidentiary requirement and instead indicated that the PTO should rely on a myriad of data, including consumer use and perception and even dictionary evidence. *Id.* at 2309 (Sotomayor, J., concurring).

<sup>80</sup> *Id.* at 2303 (majority opinion).

<sup>81</sup> *See id.* at 2306 (clarifying that because a domain name represents a unique website that only one entity can occupy, a consumer will understand the domain name to indicate a specific website or the website's owner).

<sup>82</sup> *See id.* at 2305 (holding that "Booking.com" was a mark that had developed special meaning to customers and thus was not generic). Trademark eligibility depends on consumer perception of the mark as distinguishing the brand from competitors. *Id.* at 2307.

<sup>83</sup> *Id.* at 2305. A "*per se*" rule is one that applies without considering the facts or context of the particular case. *Per Se*, BLACK'S LAW DICTIONARY, *supra* note 1. In this case, a *per se* rule would mean that the any mark styled "generic.com" would not be able to receive federal trademark registration regardless of whether or not its owner could prove that consumers recognized the mark as belonging to a particular good or service. *See Booking.com B.V.*, 140 S. Ct. at 2305–06 (finding that the PTO's premise for its *per se* rule was faulty because "generic.com" is not comparable to "Generic Company" in that ".com" signifies a unique website, rather than being a general indication of corporate status).

<sup>84</sup> *Booking.com B.V.*, 140 S. Ct. at 2307; *see* Brief for the Petitioners at 44, *Booking.com B.V.*, 140 S. Ct. 2298 (No. 19-46), 2020 WL 114444, at \*44 (arguing that neither precedent nor the Lanham Act allowed for granting Booking.com exclusive control of a generic term).

<sup>85</sup> *Booking.com B.V.*, 140 S. Ct. at 2307; *see* 15 U.S.C. § 1125(a)(1)(A) (detailing that a mark-owner may take civil action for misuse of his mark when the misuse is likely to cause consumer confusion). Additionally, the Court pointed to other safeguards against mark monopoly, such as the fair use defense, which would prevent Booking.com from edging out competitors. *Booking.com B.V.*, 140 S. Ct. at 2307–08. For example, Booking.com would only be able to bring suit against "internetbooking.com" if it could demonstrate that the use of its mark was not in good faith or fair, meaning that the competitor was intentionally trying to mislead Booking.com consumers and there was a likelihood of confusion. *See* 15 U.S.C. § 1115(b)(4) (recognizing that the fair use doctrine would apply, preventing Booking.com from getting a monopoly over their mark, and suggesting the doctrine as an available defense for the infringing user of a registered trademark); *Booking.com B.V.*, 140 S. Ct. at 2307 (stating that anti-competition concerns accompany every descriptive mark). Additionally, the Court found that consumer confusion is less likely to occur when the mark incorporates descriptive elements because consumers realize these are commonly used to describe a type of goods and services and do not distinguish brands from each other. *See id.* (explaining that consumers are less likely to think a competitor's use of a mark with a generic or descriptive term comes from the mark's owner, and less likely to be misled).



### B. Justice Breyer's Dissent

Justice Breyer was the sole dissenting vote.<sup>86</sup> Essentially, he viewed “Booking.com” as generic, not descriptive, and thus ineligible for a trademark regardless of consumer perception.<sup>87</sup> He also posited that even if the mark were descriptive and registration were a question of consumer perception, it would be extremely difficult to establish because surveys offer inadequate evidence.<sup>88</sup> He brushed off the suggestion that Booking.com could present anything that would demonstrate consumer perception.<sup>89</sup> Modern people know that a domain name leads to a particular website, and any evidence may just be reflecting that understanding, rather than recognition of the particular brand.<sup>90</sup>

Justice Breyer noted that, even if a generic mark were to gain significance to consumers, allowing registration would be against Lanham Act policy.<sup>91</sup> A generic term describes a class of goods and services, like “haircut” or “grocery store,” and permitting an entity to trademark such a term could lead to monopolization.<sup>92</sup> An entity using the same generic term to describe its business would risk expensive litigation.<sup>93</sup> Nevertheless, Justice Breyer offered reassur-

<sup>86</sup> *Booking.com B.V.*, 140 S. Ct. at 2309 (Breyer, J., dissenting).

<sup>87</sup> *Id.* at 2310–11 (arguing that, because trademark law does not protect generic marks and the term “Booking.com” provided no additional information to the consumer, it was ineligible for federal trademark protection).

<sup>88</sup> *Id.* at 2313. The *Teflon* survey found that about three quarters of participants recognized “Booking.com” and a third incorrectly thought “washingmachines.com” was a distinct brand. *Id.* at 2313–14; Brief for the Respondent at 12, *Booking.com B.V.*, 140 S. Ct. 2298 (No. 19-46), 2020 WL 833244, at \*12. Justice Breyer argued that because these two were equally generic, the survey in fact likely indicated the effectiveness of Booking.com’s advertising campaign, not that its generic brand name had acquired distinctiveness. *Booking.com B.V.*, 140 S. Ct. at 2314 (Breyer, J., dissenting).

<sup>89</sup> *Booking.com B.V.*, 140 S. Ct. at 2313. Justice Breyer stated that the majority was looking for common usage that would show the generic nature of the term, but that this was faulty because no one would refer to travel websites broadly as “booking.coms.” See *id.* (stating that the survey evidence the majority relied on simply asked whether consumers link the term with one source, a process that presupposes that “generic.com” marks are descriptive because people understand that a “.com” leads to a particular website).

<sup>90</sup> *Id.* at 2312.

<sup>91</sup> *Id.* at 2310 (citing *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975)) (describing the long-standing anti-monopoly policy for disallowing generic trademarks, regardless of consumer perception). The Lanham Act supports competition, as it is intended to protect the consumer from fraudulent or faulty products and the company from encroachment upon its cultivated goodwill. *Id.* at 2310 (citing *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985)) (presenting the Supreme Court’s recognition of the purpose and importance of the Lanham Act); see H.R. REP. NO. 79-219, at 2 (1945) (noting the legislative purposes of the Lanham Act, including to support competition).

<sup>92</sup> See *Booking.com B.V.*, 140 S. Ct. at 2310 (Breyer, J., dissenting) (giving “wine” as an example of a generic term).

<sup>93</sup> *Id.* at 2315. For example, in theory, if Booking.com had received its trademark, it could sue “ebooking.com” or “Booker.com” for trademark infringement. *Id.* The threat of this action may squash competitors, giving Booking.com a monopoly over other booking services. See *id.* (describing the implications of Booking.com receiving trademark registration).

ances to those with ineligible marks.<sup>94</sup> According to the Justice, trademark status is unnecessary for “Booking.com” to protect itself, in addition to being expressly against the policies and practice of the Lanham Act.<sup>95</sup>

### III. STRINGENT EVIDENTIARY REQUIREMENTS SHOULD BE ENACTED TO TEST SECONDARY MEANING AND PREVENT BUSINESSES FROM MONOPOLIZING GENERIC TERMS

In 2020, in *U.S. Patent and Trademark Office v. Booking.com B.V.*, the Supreme Court affirmed the primacy of consumer perception and goodwill in federal trademark law.<sup>96</sup> In *Booking.com*, the Supreme Court recognized that a brand’s goodwill may grant a mark its protection, even when the mark is descriptive.<sup>97</sup> Since the Supreme Court’s 1888 case, *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, the Court has been increasingly friendly to companies wanting to claim ownership over their brand’s goodwill.<sup>98</sup> *Booking.com* will lead

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<sup>94</sup> *Id.* (discussing other protections available to businesses with marks that are ineligible for trademark protection). Justice Breyer stated that Booking.com was already given exclusive use of its brand by virtue of owning the domain name, and that, in lieu of trademark registration, the company could rely on unfair competition laws and false advertising laws. *Id.* He also questioned the motivation for a business that sought to trademark a generic term, arguing that, given other protections, it would only be beneficial to businesses seeking to squelch competition. *Id.*

<sup>95</sup> *Id.* at 2315–16. Nevertheless, in its brief and in oral arguments, Booking.com repeatedly offered assurances that it sought trademark protection not to defeat competitors but, rather, to protect its goodwill from Internet scams and cybersquatting. See Brief for the Respondent, *supra* note 88, at 25–26 (discussing the vulnerability of websites to fraud from scammers posing as their website in order to dupe unsuspecting customers); Oral Argument, *supra* note 63, at 48:35 (arguing that Booking.com wants trademark status to protect against fraud, not to vanquish competitors).

<sup>96</sup> *U.S. Pat. & Trademark Off. v. Booking.com*, 140 S. Ct. 2298, 2307 (2020) (holding that the ultimate test for determining if a mark styled “generic.com” is deserving of trademark protection is whether the mark has secondary meaning—if consumers perceive the mark as distinguishing the brand from its competitors).

<sup>97</sup> See *id.* (holding that Booking.com is eligible for trademark protection because of the established consumer recognition of the brand as a travel booking provider); *id.* at 2308 (recognizing that because “Booking.com” is a descriptive mark and therefore weak, it would be difficult to show consumer confusion in an infringement claim and difficult to prevent others from using the term).

<sup>98</sup> Compare *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 603 (1888) (holding that simply adding “Company” to a generic term did not entitle the term to trademark protection), and *Amoskeag Mfg. Co. v. D. Trainer & Sons*, 101 U.S. 51, 52–53, 55–56 (1879) (holding ineligible for trademark registration a specially-styled mark indicating producer and quality, despite customers identifying it with the brand), with *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 174 (1995) (allowing a color to be trademarked because it had acquired a secondary significance to consumers as indicative of the business’s product), and *Mishawaka Rubber & Woolen Mfg. v. S.S. Kresge Co.*, 316 U.S. 204, 207–08 (1942) (holding that a company deserved protection against an infringing competitor for its distinctive shoe style), and *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122–23 (1938) (representing a more restrictive approach to trademark protection). In 1938, eight years before Congress passed the Lanham Act, the Supreme Court decided *Kellogg Co. v. National Biscuit Co.* 305 U.S. at 123. In *Kellogg*, the Court dismissed National Biscuit’s infringement suit against Kellogg for using the shape of its cereal. *Id.* The Court held that National Biscuit had no right to the goodwill it had garnered in its shape because the shape was functional, not trademarked, and Kellogg had

to more trademark applications from brands with descriptive marks and those styled “generic.com.”<sup>99</sup> But even if these brands receive federal trademark protection, there are measures in place to prevent them from monopolizing the field.<sup>100</sup> Section A of this Part affirms that *Booking.com* was within the scope of the Lanham Act.<sup>101</sup> Section B recommends that the PTO adopt a strict evidentiary standard to determine the secondary meaning of descriptive marks.<sup>102</sup>

### A. Booking.com and the Lanham Act

The decision in *Booking.com* was in line with the Lanham Act’s purpose.<sup>103</sup> The Lanham Act provides federal trademark status to businesses so that consumers feel confident that they are getting the product they want and so that businesses can ward against the fraudulent exploitation of their brand.<sup>104</sup> Justice Breyer argued that the *Booking.com* decision would lead to an

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attempted to differentiate its brand. *Id.* at 122. In *Kellogg*, the Court subordinated the business that possessed the goodwill in the interest of allowing product competition. *See id.* (stating that Kellogg was “sharing” in the goodwill and reputation that National Biscuit had cultivated by producing its invented cereal shape, but that this was not unfair when the shape of the cereal was not trademarked or patented). More recently, in 1992’s business-friendly judgment *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court held that a business did not have to show that its registered mark had secondary meaning to sue for infringement when the mark was distinctive. 505 U.S. 763, 776 (1995). The PTO has read *Goodyear’s* restriction on trademarks expansively, resulting in a regime which dramatically limits companies’ ability to trademark generic terms. *See* Brief for the Petitioners, *supra* note 84, at 17 (arguing that “.com” was parallel with “Company” as a generic company designation which, in line with *Goodyear*, does not sufficiently differentiate a mark). *Booking.com* limits *Goodyear* and allows for the trademarking of a combination of generic terms if that combination results in a descriptive secondary meaning. *See supra* notes 78–83 and accompanying text (describing the majority’s rationale for redefining *Goodyear*).

<sup>99</sup> *See* A. John P. Mancini et al., *Insight: Trademark Rights Still Intact After High Court Booking.com Decision*, BLOOMBERG L. (July 22, 2020), <https://news.bloomberglaw.com/ip-law/insight-trademark-rights-still-intact-after-high-court-booking-com-decision-7> [<https://perma.cc/M988-CK6N>] (discussing the implications of *Booking.com* and providing “generic.com” examples of real trademark applications filed immediately following the decision).

<sup>100</sup> *See infra* notes 109–115 and accompanying text (including the PTO trademarking process and the evidentiary requirement to demonstrate that the mark has gained secondary meaning).

<sup>101</sup> *See infra* notes 103–108 and accompanying text.

<sup>102</sup> *See infra* notes 109–121 and accompanying text.

<sup>103</sup> *See infra* notes 104–108 and accompanying text (describing the implications and rationale of the *Booking.com* decision as in line with the policy of the Lanham Act).

<sup>104</sup> *See Lee, supra* note 32, at 1626–27 (listing benefits of federal trademark status); *supra* notes 22–29 and accompanying text (stating the policy of the Lanham Act and federal trademark registration status as protecting company goodwill and consumer expectations). There are three reasons why a business may want federal trademark registration: (1) it is prima facie evidence that may be used in court indicating that the mark is legitimate and owned by the business; (2) it provides protection across the United States; and (3) it gives notice to others that the business owns the mark and any use of it is trademark infringement. *Lee, supra* note 32, at 1626–27. These reasons benefit the business by validating its ownership of the mark and, in turn, protect the consumer by safeguarding against infringing marks that may cause consumer confusion. *See id.* (describing why a business would choose federal trademark registration over state registration or no registration).

escalation of generic marks that would monopolize their fields and push out competitors.<sup>105</sup> But the outcome in *Booking.com* meets the Lanham Act's purpose because it recognizes, on the basis of evidence, that consumers distinguish the mark "Booking.com" as differentiating the business from its competitors.<sup>106</sup> Allowing a mark to receive federal protection on the basis of consumer perception acknowledges that that perception is grounded in the goodwill of the business and in its efforts to cultivate the brand.<sup>107</sup> *Booking.com* upholds the purposes of trademark law, to ensure that consumers receive the product they want and are not duped by products taking advantage of another's mark.<sup>108</sup>

### B. Rigorous Evidentiary Standard for Descriptive Marks

The *Booking.com* ruling does not mean automatic registration for descriptive marks.<sup>109</sup> Truly generic marks—those that describe a category of goods and services—will still not be entitled to trademark registration.<sup>110</sup> To gain trademark registration for a descriptive mark, companies will still have to present the PTO with evidence that their mark has acquired secondary meaning to consumers, such that consumers distinguish their brand from competitors from the mark alone.<sup>111</sup> Although a majority of the Supreme Court found *Booking.com*'s survey compelling, its holding did not clarify what evidence will be sufficient for other marks.<sup>112</sup> The PTO must establish and administer a stringent evidentiary standard for secondary meaning.<sup>113</sup> If the PTO will accept

<sup>105</sup> U.S. Pat. & Trademark Off. v. *Booking.com*, 140 S. Ct. 2298, 2315–16 (2020) (Breyer, J., dissenting).

<sup>106</sup> *Id.* at 2305 (majority opinion).

<sup>107</sup> See H.R. REP. NO. 79-219, at 2 (1945) (discussing the policy for protecting brands through trademarks). See generally *Mishawaka Rubber & Woolen Mfg. v. S.S. Kresge Co.*, 316 U.S. 204 (1942) (holding that a company deserves protection if it has successfully developed its brand).

<sup>108</sup> See *Booking.com B.V.*, 140 S. Ct. at 2305 (stating that the Lanham Act protects a descriptive mark if it has secondary meaning and if consumers use that mark to distinguish the product from competitors, and that "Booking.com" meets that criteria); H.R. REP. NO. 79-219, at 2 (describing the purpose of the Lanham Act, to bestow federal trademark status to protect a company's cultivated goodwill and a consumer's expectation).

<sup>109</sup> See *Booking.com B.V.*, 140 S. Ct. at 2307 n. 6 (discussing that, for a company to trademark a "generic.com" term, it must still present evidence to demonstrate meaningful consumer perception, as well as go through the PTO trademarking process).

<sup>110</sup> *Id.* at 2303 (holding that marks generic to their associated goods or services will never be eligible for trademark registration because they are inherently unable to distinguish their producers).

<sup>111</sup> See *id.* at 2302 (stating that the PTO may grant federal trademark status to a descriptive mark if it has a demonstrated secondary meaning and consumers use the mark to distinguish the brand from competitors).

<sup>112</sup> See *Booking.com B.V.*, 140 S. Ct. at 2307 & n.6 (holding that "Booking.com" was eligible for trademark status because it was not generic and that this analysis depends on consumer perception).

<sup>113</sup> See *id.* (holding that evidence of customer perception may be anything that shows how consumers distinguish the brand). Traditionally, the PTO has disfavored the *Teflon* survey as ambiguous due to the subjective nature of its questions. See MCCARTHY, *supra* note 3, § 12:16 (describing flaws with *Teflon* surveys, including one instance in which the examples used in the survey were unclear

survey evidence, the survey must meet requirements for diversity of respondents, as well as incorporate questions that are non-leading and allow for consumers to express uncertainty.<sup>114</sup> The PTO must also consider evidence of anything that indicates how consumers understand a brand, like dictionaries, common usage, and survey data.<sup>115</sup>

Importantly, if a brand were to successfully demonstrate secondary meaning and register its descriptive mark styled “generic.com” with the PTO, it would be difficult for the brand to block competitors and attempt to monopolize use.<sup>116</sup> A competitor’s use will only infringe upon a descriptive mark when that use is likely to confuse consumers.<sup>117</sup> In essence, courts in infringement suits consider descriptive marks weaker, so the standard for establishing trademark infringement is higher.<sup>118</sup> Additionally, a competitor may refute an infringement complaint through the affirmative fair use defense.<sup>119</sup> These safeguards mean that a trademark-owner is unlikely to waste expenses litigating against a competitor who is fairly using the owner’s mark.<sup>120</sup> Ultimately, the purpose of trademarking a descriptive mark may be less to discourage compe-

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and the respondents had a limited array of choices). A strict standard for consumer perception, including guidance on conducting surveys, would yield more transparent evidence of secondary meaning. *See Booking.com B.V.*, 140 S. Ct. at 2309 (Sotomayor, J., concurring) (reinforcing the majority holding and emphasizing that the PTO can deem what evidence is appropriate to demonstrate what the brand signifies to consumers).

<sup>114</sup> *See MCCARTHY*, *supra* note 3, § 12:16 (explaining the *Teflon* survey format, how it has become the standard for courts, and identifying some PTO criticism of the survey style, including that it does not allow for uncertainty).

<sup>115</sup> *Booking.com B.V.*, 140 S. Ct. at 2309 (Sotomayor, J., concurring).

<sup>116</sup> *See infra* notes 117–121 and accompanying text (explaining why it would be difficult for a “generic.com” mark-owner to monopolize use of its mark).

<sup>117</sup> 15 U.S.C. § 1114(1) (detailing the circumstances of trademark infringement). Section 1125 of the Lanham Act also details when a mark-owner may pursue civil action for trademark infringement, namely in cases where the misuse is likely to confuse customers or when the use “misrepresents” the brand. 15 U.S.C. § 1125(a)(1). In *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, a trademark infringement case in 2004, the Supreme Court held that the burden was on the party bringing the action to establish likelihood of confusion. 543 U.S. 111, 124 (2004).

<sup>118</sup> *See Booking.com B.V.*, 140 S. Ct. at 2307 (explaining that weaker marks are less likely to be able to succeed in a trademark infringement suit).

<sup>119</sup> *See supra* notes 53–54 and accompanying text (describing the fair use defense: that if the competitor argues that their use was fair and in good faith, the burden shifts to the mark-owner to show consumer confusion). It is noteworthy that the Supreme Court has stated that some consumer confusion is acceptable for a descriptive mark because otherwise the mark-owner would receive a monopoly over a descriptive term that competitors use to describe a good or service generally. *KP Permanent*, 543 U.S. at 122.

<sup>120</sup> *See Booking.com B.V.*, 140 S. Ct. at 2307–08 (outlining a safeguard against a mark owner gaining a monopoly over a descriptive mark, including that the mark owner must demonstrate consumer confusion as a result of the infringing use and refute the fair use defense). A trademark-owner faces a high bar in making this argument, considering that some consumer confusion is acceptable for a descriptive mark. *Id.*

tion and more to access certain avenues for relief against counterfeit products or scams.<sup>121</sup>

### CONCLUSION

In 2020, in *U.S. Patent and Trademark Office v. Booking.com B.V.*, the Supreme Court acknowledged that a combination of generic terms can yield a descriptive mark that is deserving of trademark status. Paramount in this holding is the Supreme Court's recognition that the consumer's perception of the brand's mark is the ultimate test of trademark eligibility. To prevent the proliferation of "generic.com" marks, the PTO must enact a strict evidentiary standard for testing consumer perception. With that standard, the risk of a company monopolizing a generic term is low because safeguards, like the evidentiary requirement, the PTO registration process, and the fair use defense, in addition to the inherent difficulties of suing on behalf of a weak descriptive mark, make the possibilities of a successful infringement suit unlikely.

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<sup>121</sup> See Brief for the Respondent, *supra* note 88, at 25–26 (detailing that Booking.com wanted the protection against scams and fraud, not competitors).



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