

# Prosecution of Generic.com Trademarks in a Post-Booking.com World

By Joelle A. Milov

## I. Introduction

In *United States Patent & Trademark Office v. Booking.com B.V.*, the Supreme Court considered whether so-called generic.com marks, which combine a generic term with a top-level domain name, are registrable on the Principal Register.<sup>1</sup> The United States Patent & Trademark Office (USPTO) sought a *per se* rule that generic.com marks cannot be federally registered, but the Court declined to impose such a rule, opening the door for applicants to seek registrations for such marks. However, the Court did not address how the USPTO should assess future generic.com applications. This article seeks to provide guidance as to prosecuting generic.com federal trademark applications.

Part II of this article reviews the law regarding generic and descriptive marks and the lower court rulings in *Booking.com*. Part III discusses the Supreme Court's ruling in *Booking.com*. Part IV offers direction for attorneys in applying to register generic.com marks, reviewing both recently issued USPTO guidance for examiners and the recent prosecution of three generic.com applications.

## II. Background

In *Booking.com* the Supreme Court considered whether the mark BOOKING.COM, comprised of a generic term—"booking"—and a top level domain—.com—was generic *per se* and thus unregistrable.<sup>2</sup> The USPTO argued that any "generic.com" term is unregistrable,<sup>3</sup> but the Court rejected such a *per se* rule and affirmed the decision of the Fourth Circuit upholding registration.<sup>4</sup> Before analyzing the Court's decision, it is necessary by way of background to review the law relating to generic and descriptive trademarks as well as the lower court rulings in *Booking.com*.

### A. Descriptive and Generic Marks

Trademark law seeks to protect both trademark owners and consumers.<sup>5</sup> The primary purpose of trademarks is to distinguish between sources of various goods and services.<sup>6</sup> "Guarding a trademark against use by others . . . 'secure[s] to the owner of the mark the goodwill' of her business and 'protect[s] the ability of consumers to distinguish among competing producers.'"<sup>7</sup>

Trademarks fall on a spectrum of distinctiveness and protectability.<sup>8</sup> At the most-protectable end of the spectrum are arbitrary or fanciful marks, followed by suggestive marks, descriptive marks, and generic terms (which are not protectable).<sup>9</sup> Arbitrary/fanciful marks (such as CAMEL OR KODAK) and suggestive marks

(such as TIDE) are inherently distinctive and capable of registration on the Principal Register.<sup>10</sup> Descriptive marks (such as 5 MINUTE GLUE)<sup>11</sup> are registrable on the Principal Register only upon a showing that the mark has acquired distinctiveness.<sup>12</sup> Finally, a generic term (such as WINE) "is one that refers to the genus of which the particular product is a species."<sup>13</sup> Such marks are not registrable, even upon proof of secondary meaning, "no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification."<sup>14</sup>

Classifying a mark as descriptive and capable of registration or generic and incapable of registration is not merely a semantic exercise, as registration on the Principal Register provides a trademark owner with significant benefits. For example, a federal trademark registration provides its owner with a presumption of the mark's validity nationwide.<sup>15</sup> Further, once a trademark registration becomes incontestable under 15 U.S.C. § 1065 after being in continuous use in commerce for five years registration, it cannot be attacked as merely descriptive.<sup>16</sup> "The rub . . . is in trying to distinguish generic marks from [protectable marks]."<sup>17</sup>

### B. Prior Proceedings in *Booking.com*

Booking.com, a travel reservation website, sought federal registration of BOOKING.COM in standard character and stylized forms for various travel agency and hotel reservation services, but the USPTO denied registration.<sup>18</sup> The examining attorney initially rejected all four applications on the ground that BOOKING.COM was descriptive.<sup>19</sup> After Booking.com objected that the mark had acquired distinctiveness, the examiner again refused the applications on the ground that the mark was generic for the applied-for services or, in the alternative, that it was descriptive and lacked acquired distinctiveness.<sup>20</sup> Booking.com sought reconsideration, but it was denied, and Booking.com also appealed the refusal of registration to the USPTO Trademark Trial and Appeal Board (TTAB), but the TTAB affirmed the refusal.<sup>21</sup>

Booking.com appealed the denial of registration to the United States District Court for the Eastern District of Virginia.<sup>22</sup> The evidence before the district court included the record before the TTAB, but the court also relied on Booking.com's Teflon survey, a widely used trademark

---

JOELLE A. MILOV is an associate with Cowan, Liebowitz & Latman, P.C.

survey, which showed that 74.8% of respondents found BOOKING.COM to be a brand name.<sup>23</sup> The court found that the mark was descriptive, not generic,<sup>24</sup> and that Booking.com had established secondary meaning for the mark in International Class 43 for hotel reservation services for two of its applications and ordered that the marks be registered for those applications.<sup>25</sup> The court remanded the remaining two applications in Class 43 to the USPTO for further factfinding.<sup>26</sup>

The USPTO appealed the court's determination regarding the registrability of BOOKING.COM. The USPTO only challenged the trial court's finding that the mark was not generic; it did not challenge the court's secondary meaning determination.<sup>27</sup> The Fourth Circuit affirmed, finding that the district court did not err in holding that the USPTO failed to meet its burden to establish that the relevant public would understand BOOKING.COM "to refer to general online hotel reservation services rather than Booking.com the company."<sup>28</sup> The Fourth Circuit also rejected the USPTO's argument that the addition of the top-level domain ".com" to a generic term like booking would necessarily be generic.<sup>29</sup> Instead, the court held that "when '.com' is combined with a [second level domain], even a generic [second level domain], 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."<sup>30</sup>

The USPTO petitioned for a writ of certiorari on the following question: "Whether the addition by an online business of a generic top-level domain ('.com') to an otherwise generic term can create a protectable trademark."<sup>31</sup> On November 8, 2019, the Supreme Court granted the petition.<sup>32</sup>

### III. The Supreme Court Decision

In the Supreme Court, the USPTO advanced two arguments in favor of a *per se* rule that marks composed of a generic term (such as "booking") and a top-level domain (such as ".com") are necessarily generic and unregistrable without regard to how consumers perceive the mark: (1) the rule was a necessary extension of the Court's precedent, and (2) it was necessary to ensure competition.<sup>33</sup> The Court, in an opinion by Justice Ruth Bader Ginsburg, joined by seven other Justices, rejected both arguments and declined to adopt the USPTO's proposed rule.<sup>34</sup>

The USPTO analogized a generic.com mark to a "generic company" trademark that the Court held was incapable of serving as a trademark in a pre-Lanham Act case, *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*<sup>35</sup> In *Goodyear*, the Court found that "Goodyear Rubber Company" was not capable of serving as a trademark because "Goodyear Rubber" was descriptive of goods produced by a particular process, and "[n]ames which are thus descriptive of a class of goods cannot be exclusively appropriated by any one."<sup>36</sup> The addition of

the term "Company," the Court found, only established that parties have formed an entity to deal in the relevant goods, and this addition could not prevent others from using a similar name for a similar business "for the obvious reason that all persons have a right to deal in such articles, and to publish the fact to the world."<sup>37</sup>

"In *Goodyear*, the Court found that 'Goodyear Rubber Company' was not capable of serving as a trademark because 'Goodyear Rubber' was descriptive of goods produced by a particular process."

With respect to generic.com marks, the Court in *Booking.com* concluded that *Goodyear* did not support the proposed *per se* rule for two reasons. First, the Court found that a generic.com mark could provide source-identifying information because it would be linked to a specific website, i.e., www.generic.com.<sup>38</sup> Because of this, a consumer would know that a generic.com mark would refer to the website or the website's owner and not merely to a class of goods or services such that it is incapable of signifying source.<sup>39</sup> Second, the Court found the USPTO's reliance on *Goodyear* to be contrary to fundamental trademark law principles because the *per se* rule advocated by the USPTO would apply regardless of how consumers perceive the mark.<sup>40</sup> Genericism, however, depends on how consumers perceive a given term.<sup>41</sup> A *per se* rule that disregarded consumer perception was therefore inappropriate.<sup>42</sup>

The Court also found that not adopting a *per se* rule would not inhibit competition.<sup>43</sup> While the USPTO argued that registering BOOKING.COM might prevent others from using a BOOKING mark or a domain name that included the term "booking," the Court noted that trademark law does not prevent the use of similar marks writ large; instead, infringing marks are those that are likely to cause consumer confusion.<sup>44</sup> In analyzing whether a mark is likely to confuse consumers, a court will consider whether the mark is distinctive, and "[w]hen a mark incorporates generic or highly descriptive components, consumers are less likely to think that other uses of the common element emanate from the mark's owner."<sup>45</sup> Further, classic fair use allows an individual to use a term not as a mark but to describe his or her wares.<sup>46</sup>

While the USPTO argued that the owner of a generic.com mark had other advantages and remedies available without registration, the Court found that such recourse did not negate registrability.<sup>47</sup> The USPTO also argued that owners of generic.com domains were already well

poised competitively because consumers could find their sites easily.<sup>48</sup> It argued further that unfair competition law could prevent any attempts at passing off.<sup>49</sup> The Court found that none of these contentions precluded registration.<sup>50</sup>

Although the Court declined to adopt a *per se* rule regarding generic.com terms, it also did not hold that all generic.com terms necessarily would qualify for trademark protection. Instead, it held that whether a generic.com mark is generic “depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.”<sup>51</sup>

### III. Prosecution Guidance for Generic.com Terms

In *Booking.com*, the Court opened the door to generic.com registrations, but it did not indicate how the USPTO should assess generic.com applications. Practitioners, however, may find direction in prosecuting their clients’ generic.com marks from a recently issued USPTO guide. In addition, a review of the recent prosecution history of three generic.com applications suggests options for attorneys to present to clients attempting to register generic.com marks.

#### A. USPTO Guide 3-20

In October 2020, a few months after the Court decided *Booking.com*, the USPTO issued Examination Guide 3-20, entitled “Generic.com Terms after *USPTO v. Booking.com*” (“Guide 3-20”).<sup>52</sup> Guide 3-20 reviews an examining attorney’s process of reviewing generic.com marks as well as the refusals he or she will issue in response to applications to register purportedly generic terms. The Guide also covers how examining attorneys will assess claims of acquired distinctiveness in relation to generic.com marks.

In assessing whether a mark is generic, an examining attorney will apply the following two-part test: “(1) What is the genus of goods or services at issue? (2) Does the relevant public understand the designation primarily to refer to that genus of goods or services?”<sup>53</sup> In making this assessment, examining attorneys must review all evidence of consumer perception, including evidence submitted by applicant, “to determine whether the relevant consumers perceive the term as generic for the identified class of goods and/or services or, instead, as capable of serving as a mark.”<sup>54</sup> Evidence that the applied-for generic.com term is generic may include the following:

- a combination of dictionary excerpts defining the component elements of the generic.com term;
- significant evidence of generic usage of those elements or the combined term by consumers or competitors in the relevant marketplace;

- evidence of the “generic.com” term used by third parties as part of their domain names (e.g., “[adjective]generic.com”) in connection with the same or similar goods and/or services; or
- evidence of the applicant’s own use of the generic.com term.<sup>55</sup>

An examining attorney must establish that an applied-for term is generic by clear evidence.<sup>56</sup> If the evidence indicates that the mark is generic, the examining attorney will initially issue a refusal on the ground that the mark is merely descriptive under 15 U.S.C. § 1052(e)(1).<sup>57</sup> If the examining attorney issues a refusal on genericness grounds, the attorney also should explain how the cited evidence establishes that the component parts of the generic.com term are generic and that the composite does not provide new or further significance to consumers that could indicate the source of goods or services.<sup>58</sup> If the cited evidence “strongly suggests” that the applied-for generic.com term cannot indicate the source of goods or services, the examining attorney should include an advisory statement that the attorney does not recommend an acquired distinctiveness claim or an amendment to the application to seek registration on the Supplemental Register.<sup>59</sup> Conversely, if the evidence shows that the applied-for generic.com mark is capable of identifying a source, the examining attorney may alert the applicant that it can amend its application to seek registration on the Supplemental Register.<sup>60</sup>

If an applicant seeks registration for a generic.com mark under a claim that the applied-for mark has acquired distinctiveness under section 1052(f), in full or in part, the examining attorney will review the applicant’s evidence of acquired distinctiveness, as well as other evidence, to assess if consumers consider the generic.com mark a source indicator for the applied-for goods or services.<sup>61</sup> The Guide notes that “[t]ypically, the applicant will need to provide a significant amount of actual evidence that the generic.com term has acquired distinctiveness in the minds of consumers.”<sup>62</sup> Importantly, a generic.com applicant usually will not be able to support its acquired distinctiveness claim with either the fact that it has been using the generic.com mark for five years or that it has a prior registration for the same term.<sup>63</sup> Instead, in showing that the applied-for mark has achieved secondary meaning, an applicant may submit

consumer surveys; consumer declarations; declarations or other relevant and probative evidence showing the duration, extent, and nature of the applicant’s use of the proposed mark, including the degree of exclusivity of use; related advertising expenditures; letters or statements from the trade or public; and any other appropriate evidence tending to show

that the proposed mark distinguishes the goods or services to consumers.<sup>64</sup>

Guide 3-20 reaffirms the usefulness of consumer surveys in assessing acquired distinctiveness of generic.com trademarks and notes what will be required from applicants who submit survey evidence. Any provided survey “must be properly designed and interpreted to ensure that [it is] an accurate and reliable representation of consumer perception of a proposed mark.”<sup>65</sup> To establish the survey’s accuracy and reliability, an applicant must provide a report, usually from a survey expert, showing “the procedural aspects of the survey and the statistical accuracy of the results.”<sup>66</sup> The applicant also must provide—either as an additional submission or as a portion of the report—the universe of surveyed consumers, how many participants were surveyed, and the geographic scope of the relied-upon survey.<sup>67</sup> If an applicant does not provide this information, the examining attorney may request it from the applicant.<sup>68</sup>

If, after reviewing an applicant’s acquired distinctiveness evidence, the examining attorney finds that the generic.com term is generic, he or she will refuse registration on genericness grounds and state that the submitted acquired distinctiveness evidence does not negate the genericness refusal.<sup>69</sup> In addition to refusing registration on genericness grounds, the examining attorney will issue or continue a refusal on merely descriptiveness grounds, and he or she should disclose why the acquired distinctiveness evidence does not overcome the refusal on descriptiveness grounds if the mark is ultimately found not to be generic.<sup>70</sup> If the evidence shows that the applied-for mark is capable of serving as a source indicator, but the examining attorney finds that the submitted evidence is insufficient to show secondary meaning, he or she may allow registration on the Supplemental Register.<sup>71</sup>

## B. Prosecution History of Certain Generic.Com Terms

It is too early to determine the full impact that *Booking.com* or Guide 3-20 will have on practitioners’ attempts to register other generic.com marks. If an applicant received an initial refusal *before* the issuance of *Booking.com* and responded to the initial office action *after* *Booking.com*, the USPTO may not yet have acted upon that response to office action. If an examining attorney issued an office action after *Booking.com* and/or the publication of Guide 3-20, an applicant may not have responded to the office action yet, as applicants have six months to respond to such refusals.<sup>72</sup> Nonetheless, a brief look at some recent USPTO filings may provide practitioners with insight into the options they could present to their clients who may be seeking to register generic.com marks. Three such options are: (1) apply for the generic.com mark in stylized form with a disclaimer; (2) apply for the generic.com mark under a section 2(f) claim of acquired distinctiveness and supply significant evidence; or (3) apply for the generic.com mark and, if applicable, argue that the examining attorney has not adduced sufficient genericness evidence

post-*Booking.com* and preserve additional fallback arguments. Each of these options has its own benefits and burdens.

## 1. The stylized mark and disclaimer approach

The first potential approach to seeking registration of generic.com marks is to chart a path of lesser resistance by seeking to register a stylized mark with an added disclaimer.<sup>73</sup> For example, on May 19, 2020, Beef Jerky, LLC sought to register BEEFJERKY.COM, UNIVERSALLY FAMOUS ESTABLISHED 1995 B in the stylized form seen here for “beef jerky, beef sticks and dried meat” in International Class 29.<sup>74</sup> On August 27, 2020, after the decision in *Booking.com* but before the publication of Guide 3-20, the examining attorney issued a non-final office action that sought, *inter alia*, a disclaimer of “BEEF JERKY” and “.COM” because “the wording ‘BEEFJERKY’ is merely descriptive of and generic for applicant’s goods because applicant identifies its goods in the record as ‘beef jerky’” and “the non-source-identifying generic top-level domain . . . ‘.COM’ merely indicates an Internet address for use by commercial for-profit organizations.”<sup>75</sup> After the examining attorney continued and made final the disclaimer requirement, the applicant added the disclaimer “No claim is made to the exclusive right to use ‘BEEF JERKY.COM ESTABLISHED 1995’ apart from the mark as shown.”<sup>76</sup> On December 1, 2020, the applicant’s mark was published in the *Trademark Official Gazette*.<sup>77</sup>



It should be noted that, in this case, the applicant’s addition of a disclaimer cabins the applicant’s rights in the disclaimed terms to those words in the applied-for stylization.<sup>78</sup> Accordingly, while the applicant’s rights in the applied-for mark described above are more circumscribed than they would be in a standard character mark with no disclaimer, the applicant was able to register at least one version of its generic.com mark on the Principal Register within a relatively short period of time.

## 2. The § 2(f) claim and additional evidence approach

The second potential approach to generic.com trademark prosecution is seeking registration on the basis that a generic.com mark has acquired distinctiveness under § 2(f) and adducing substantial evidence in support of such a claim. For example, on May 2, 2019, EntertainmentCareers.Net, Inc. applied for the eponymous term ENTERTAINMENTCAREERS.NET for “Providing on-line employment information in the field of employment opportunities and career placement, recruitment, careers, and job listings; Providing an on-line searchable database featuring classified ad listings and employment opportunities; Employment hiring, recruiting, placement, staffing and career networking services” in International Class 35.<sup>79</sup> The examining attorney issued an office ac-

tion to the applicant, asserting that the mark was merely descriptive of the applicant's services and appeared to be generic.<sup>80</sup> In support of this assertion, the examining attorney attached internet evidence "show[ing] the wording ENTERTAINMENT CAREERS routinely refers to jobs and job opportunities in the entertainment field."<sup>81</sup> In response to the office action, the applicant argued that the mark had acquired distinctiveness and, in support of this claim, it introduced a declaration and pointed to the fact that it previously had two registrations, supported by § 2(f) claims, for the same mark for largely the same service, which marks had "lapsed inadvertently."<sup>82</sup> The declaration attested to the fact that the mark had been in use

"... it was not until the issuance of Guide 3-20 a few months later that practitioners gained some insight into how generic.com applications will be analyzed by the USPTO moving forward. "

for almost two decades and that the applicant's website has featured more than 300,000 jobs posts and attracted more than 25 million unique visitors.<sup>83</sup> The applicant also highlighted its unsolicited media coverage in no fewer than 40 publications.<sup>84</sup> On February 19, 2020, the application's status was listed as "Approved for Publication,"<sup>85</sup> but it was not until after the *Booking.com* decision that the applicant received notice that the mark would be published in the *Trademark Official Gazette*.<sup>86</sup> The application for ENTERTAINMENTCAREERS.NET recently matured into a registration on October 20, 2020.<sup>87</sup> While the applicant ultimately was successful in its registration efforts, the accumulation of evidence to support its section 2(f) claim took time and effort.

### 3. The arguing insufficient genericness evidence with fallback approach

The third potential approach is to argue insufficient genericness evidence in light of *Booking.com*. Indeed, at least one applicant appears to have been emboldened by *Booking.com* and continues to seek registration of its generic.com mark on the Principal Register. On April 11, 2019, One Click Internet Ventures LLC filed an application to register the standard character mark READERS.COM for "eyewear; eyeglasses; reading glasses; reading sunglasses, computer glasses, eyewear accessories, namely, pouches and cases" in International Class 9.<sup>88</sup> The examining attorney issued an office action to the applicant that addressed, *inter alia*, the fact that the applied-for mark was generic for the applied-for goods.<sup>89</sup> In support of this assertion, the examining attorney "attached evidence from various online retailers [that] shows that the wording 'READERS' in the applied-for mark means 'reading glasses' and thus the relevant public would understand this designation to refer primarily to that genus of goods because it equates the term 'readers' to 'reading

glasses'."<sup>90</sup> In the alternative, the examining attorney issued a refusal on the basis that the applied-for mark was merely descriptive of the applicant's applied-for goods.<sup>91</sup> On December 23, 2019, the applicant responded to the office action and argued that the examining attorney's evidence was insufficient to show that the applied-for mark as a whole was generic and cited *Booking.com*, in which the Court had recently granted certiorari.<sup>92</sup> The applicant also disputed that the applied-for mark was merely descriptive and highlighted its statement of substantially exclusive and continuous use of the mark for five preceding years as well as its active prior registration for the mark.<sup>93</sup>

After receiving the response to office action, the USPTO approved READERS.COM for publication but later withdrew the approval and issued another office action in May 2020, just weeks before *Booking.com* was handed down.<sup>94</sup> In the office action, the examining attorney refused registration, finding that the mark was generic and, in the alternative, that the mark was merely descriptive and that the acquired distinctiveness evidence of five years' use was insufficient "because it is such a short period of time of use and no evidence regarding the advertising or sales expenditures, customer surveys or verified statements of long term use has been provided."<sup>95</sup> In its response to the office action, written after the issuance of *Booking.com* and Guide 3-20, the applicant again argued that the examining attorney did not sufficiently establish that the applied-for mark was generic and asserted that the argument regarding genericness—that the applied-for mark was generic because READERS is generic—was inconsistent with *Booking.com*.<sup>96</sup> In the alternative, the applicant argued that the applied-for mark had acquired distinctiveness and, as a final fallback, that if that argument could not overcome the descriptiveness refusal, then it would amend its application to seek registration on the Supplemental Register.<sup>97</sup> As of this writing, the examining attorney has not acted upon the applicant's response.

### IV. Conclusion

The Supreme Court in *Booking.com* provided brand owners with the possibility that generic.com terms may be registrable. But it was not until the issuance of Guide 3-20 a few months later that practitioners gained some insight into how generic.com applications will be analyzed by the USPTO moving forward. While it is still too early to determine the types of arguments and evidence that will be most well received by the USPTO in support of registration, the above examples of recent generic.com applications provide some possible guidance for practitioners who may choose to prosecute such applications. In addition to available facts supporting registrability, the client's appetite for risk, budgetary considerations, and desire for speedy resolution will also inform the prosecution strategy for a given generic.com mark.

## Endnotes

1. *United States PTO v. Booking.com B.V.*, 140 S. Ct. 2298 (2020) (“Booking.com III”).
2. *Id.* at 2301. This article uses BOOKING.COM (in all caps) to refer to the applied-for mark and Booking.com to refer to the entity seeking registration of such mark.
3. *Id.* at 2303, 2305.

The USPTO recognized one exception to its request for a *per se* rule: “Sometimes adding a generic term to a generic top-level domain results in wordplay (for example, “tennis.net”).” *Id.* at 2305 n.4. As the Court recognized, such an exception was not at issue in Booking.com III, *see id.*, and for purposes of this article, I will not consider it as part of the USPTO’s argument.
4. *Id.* at 2308–09.
5. *See Booking.com B.V. v. United States Patent and Trademark Office*, 915 F.3d 171, 176 (4th Cir. 2019) (“Booking.com II”) (“Trademark law protects the goodwill represented by particular marks and serves the twin objectives of preventing consumer confusion between products and the sources of those products, on the one hand, and protecting the linguistic commons by preventing exclusive use of terms that represent their common meaning, on the other.”).
6. 15 U.S.C. § 1127 (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”); *see B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 142 (2015) (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”).
7. Booking.com III, 140 S. Ct. at 2302 (quoting *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)).
8. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (1976); Booking.com III, 140 S. Ct. at 2302.
9. *Abercrombie*, 537 F.2d at 9.
10. *See, e.g., Wal-mart Stores v. Samara Bros.*, 529 U.S. 205, 210–11 (2000); *id.* at 210 (describing CAMEL as an arbitrary mark for cigarettes, KODAK as a fanciful mark for film, and TIDE as a suggestive mark for laundry detergent).
11. *See Booking.com v. Matal*, 278 F. Supp. 3d 891, 901 (E.D. Va. 2017) (“Booking.com I”) (categorizing 5 MINUTE GLUE as descriptive).
12. *See Samara Bros.*, 529 U.S. at 211–12; Booking.com III, 140 S. Ct. at 2302–03. “This acquired distinctiveness is generally called ‘secondary meaning.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

Descriptive marks that have not achieved secondary meaning, but are “capable of distinguishing applicant’s goods or services,” are registrable on the Supplemental Register. 15 U.S.C. § 1091.
13. *Park ‘n Fly*, 469 U.S. at 194; *see Abercrombie*, 537 F.2d at 9; Booking.com III, 140 S. Ct. at 2303 (describing WINE as a generic term for wine).
14. *Abercrombie*, 537 F.2d at 9.
15. 15 U.S.C. § 1057(b); *see, e.g., Samara Bros.*, 529 U.S. 205, 209 (2000).
16. 15 U.S.C. § 1065; *Park ‘n Fly*, 469 U.S. at 205.
17. *Booking.com I*, 278 F. Supp. 3d at 902 (quoting *Ashley Furniture Indus. Inc. v. Sangiacomo N.A.*, 187 F.3d 363, 369 (4th Cir. 1999)).
18. *Id.* at 895–97.
19. *Id.* at 897.
20. *Id.*
21. *Id.* at 895–97.
22. *Id.* at 891.
23. Pursuant to Booking.com’s appeal to the district court under 15 U.S.C. § 1071(b), it was permitted to submit evidence to the trial court that was not before the TTAB. *See Booking.com III*, 140 S. Ct. at 2303; *Booking.com I*, 278 F. Supp. 3d at 915.

Teflon surveys, which are the “most widely used survey format to resolve a genericness challenge,” provide survey respondents with a primer on the distinction between the generic or common names and trademark or brand names, and then present respondents with a series of names, which they are asked to identify as common or brand names.”

*Booking.com I*, 278 F. Supp. 3d at 915 (internal citation omitted).
24. *Id.* at 918.
25. *Id.* at 923–24.
26. *Id.* The court found that Booking.com did not establish secondary meaning for the mark for the Class 39 services. *Id.* at 923. Booking.com did not appeal the determination regarding its Class 39 services. *Booking.com II*, 915 F.3d at 177 n.2.
27. *Booking.com II*, 915 F.3d at 179.
28. *Id.* at 181.
29. *Id.* at 184.
30. *Id.* at 186.
31. Petition for Writ of Certiorari at 1, *Booking.com III*, 140 S. Ct. 2298 (2020).
32. *United States PTO v. Booking.com B.V.*, 589 U.S. \_\_\_\_ (2019).
33. *Booking.com III*, 140 S. Ct. at 2305–08.
34. *Id.* at 2305.
35. *Id.*
36. *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888); *see also Booking.com III*, 140 S. Ct. at 2305.
37. *Goodyear*, 128 U.S. at 602–03; *see also Booking.com III*, 140 S. Ct. at 2305.
38. *Booking.com III*, 140 S. Ct. at 2306.
39. *Id.*
40. *Id.*
41. *See infra* part II.A for the applicable genericness test.
42. “The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” 15 U.S.C. § 1064(3).
43. *Booking.com III*, 140 S. Ct. at 2307–08.
44. *Id.* at 2307.
45. *Id.*
46. *Id.* at 2307–08.
47. *Id.* at 2308.
48. *Id.*
49. *Id.*
50. *Id.*
51. *Id.* at 2307.
52. United States Patent & Trademark Office, Examination Guide 3-20: Generic.com Terms after *USPTO v. Booking.com* (“Guide 3-20”) (Oct. 2020), available at <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-3-20.pdf>.
53. United States Patent & Trademark Office, Trademark Manual of Examining Procedure (TMEP) § 1209.01(c)(i) (Oct. 2018) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986)), available at <https://tmep.uspto.gov/RDMS/TMEP/current>; *see* Guide 3-20 at 2.
54. Guide 3-20 at 2; TMEP § 1215.05 (“Thus, to establish that a mark comprising a generic term with a non-source-identifying gTLD is



- generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.”).
55. Guide 3-20 at 3 (footnote omitted).
  56. TMEP § 1209.01(c)(i).
  57. Guide 3-20 at 3.
  58. *Id.*
  59. *Id.*
  60. *Id.*
  61. *Id.*
  62. *Id.* at 4; see generally Bill Donahue, *USPTO Weighs In On High Court’s Booking.com TM Ruling*, Law360 (Oct. 28, 2020 5:59 PM), [https://www.law360.com/ip/articles/1323718/uspto-weighs-in-on-high-court-s-booking-com-tm-ruling?nl\\_pk=c8cfc137-ec9a-45b6-ade1-d6f439902158%E2%80%A6](https://www.law360.com/ip/articles/1323718/uspto-weighs-in-on-high-court-s-booking-com-tm-ruling?nl_pk=c8cfc137-ec9a-45b6-ade1-d6f439902158%E2%80%A6).
  63. Guide 3-20 at 3.
  64. *Id.* at 4.
  65. *Id.*; see generally *Booking.com III*, 140 S. Ct. at 2307 n.6 (“Surveys can be helpful evidence of consumer perception but require care in their design and interpretation.”).
  66. Guide 3-20 at 4.
  67. *Id.*
  68. *Id.*
  69. *Id.*
  70. *Id.*
  71. See *id.*
  72. 15 U.S.C. § 1062(b); TMEP § 711.
  73. Such an approach likely would have been available even before *Booking.com*. For example, in a first office action issued to *Booking.com*, the examining attorney sought the addition of a disclaimer of *BOOKING.COM* in the stylized mark. Office Action at 3–4, U.S. Trademark App. No. 85485097 (Mar. 23, 2012), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn85485097&docId=OOA20120323135119#docIndex=23&page=1>.
  74. U.S. Trademark App. Ser. No. 88922990 (filed May 19, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88922990&docId=APP20200522093437#docIndex=17&page=1>. For the sake of simplicity, the depiction of the mark and the identification of goods are presented above in the form that the USPTO approved for publication. It should be noted, however, that neither the drawing nor the identification of goods listed above is in the form that applicant initially sought to register.
  75. Non-Final Office Action at 2, U.S. Trademark App. Ser. No. 88922990 (Aug. 27, 2020), Ser. No. 88922990, available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88922990&docId=OOA20200827152155#docIndex=12&page=1>.
  76. Final Office Action at 2, U.S. Trademark App. Ser. No. 88922990 (Oct. 21, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88922990&docId=OOA20201021105452#docIndex=7&page=1>; Request for Reconsideration after Final Action at 1, U.S. Trademark App. Ser. No. 88922990 (Oct. 27, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88922990&docId=RFR20201028204015#docIndex=4&page=1>. Notably, the mark contains additional words that were not required to be disclaimed.
  77. Trademark Official Gazette Publication Confirmation, U.S. Trademark App. Ser. No. 88922990 (Dec.1, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88922990&docId=PB320201201075000#docIndex=0&page=1>.
  78. See TMEP § 1213; Guide 3-20 at 4; see generally TMEP § 1209.03(w).
  79. U.S. Trademark App. Ser. No. 88413492 (filed May 2, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=ROA20190506082211#docIndex=11&page=1>. For the sake of simplicity, the identification of services is presented above in the form that the USPTO approved for publication and not in the form that applicant sought to initially register.
  80. Nonfinal Office Action at 2–3, U.S. Trademark App. Ser. No. 88413492 (July 20, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=OOA20190720110429#docIndex=9&page=1>; see generally Guide 3-20 at 2 (noting that Guide 3-20 applies to various generic top-level domains, such as .com and .net).
  81. Office Action at 2, 9–21, U.S. Trademark App. Ser. No. 88413492 (July 20, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=OOA20190720110429#docIndex=9&page=1>.
  82. Response to Office Action at 2–3, U.S. Trademark App. Ser. No. 88413492 (Jan. 17, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=ROA20200120180747#docIndex=8&page=1>.
  83. *Id.*, Declaration of Brad Hall at 1-2; see *id.* Response to Office Action at 2–4.
  84. *Id.*, Response to Office Action at 4; *id.*, see Declaration of Brad Hall at 2–3 & Ex. 4.
  85. Trademark Snap Shot Publication Stylesheet, U.S. Trademark App. Ser. No. 88413492 (Feb. 19, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=EXA20200218151302#docIndex=4&page=1>.
  86. Official USPTO Notice of Publication Under 12(a), U.S. Trademark App. Ser. No. 88413492 (July 15, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=NOP20200715060628#docIndex=3&page=1>.
  87. Registration Certificate for ENTERTAINMENTCAREERS.NET, Reg. No. 6177638, (October 20, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88413492&docId=ORC20201005092030#docIndex=0&page=1>.
  88. U.S. Trademark App. Ser. No. 88381046 (filed Apr. 11, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88381046&docId=ROA20190415075159#docIndex=8&page=1>. For the sake of simplicity, the owner of the application and identification of goods are listed as they currently are listed on the USPTO’s Trademark Status & Document Retrieval System, and not as they appear in the initial application.
  89. Office Action at 2, U.S. Trademark App. Ser. No. 88381046 (June 24, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88381046&docId=OOA20190624113611#docIndex=7&page=1>.
  90. *Id.* at 3.
  91. *Id.*
  92. Response to Office Action at 2–7, U.S. Trademark App. Ser. No. 88381046 (Dec. 23, 2019), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88381046&docId=ROA20191223182507#docIndex=5&page=1>.
  93. *Id.* at 7–8.
  94. Nonfinal Office Action at 1, U.S. Trademark App. Ser. No. 88381046 (May 11, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88381046&docId=OOA20200511134807#docIndex=2&page=1>.
  95. See *id.* at 2. The examining attorney also noted that the applicant’s cited prior registration, which was on the Supplemental Register, showed the term’s “inherent descriptiveness.” *Id.*
  96. Response to Office Action at 1, U.S. Trademark App. Ser. No. 88381046 (Nov. 10, 2020), available at <https://tsdr.uspto.gov/documentviewer?caseId=sn88381046&docId=ROA20201111184951#docIndex=1&page=1>.
  97. *Id.*

Reprinted with permission from: *Bright Ideas*, 2021, Vol. 30, No. 1, published by the New York State Bar Association, One Elk Street, Albany, NY 12207.

Originally published in Vol. 30, No. 1 of *Bright Ideas* (Winter 2021), a publication of the Intellectual Property Law Section of the New York State Bar Association.