Trademark Law Update: Supreme Court Decides Fate of Booking.com's Trademark Applications

By: Josh Leggett

That was quicker than expected. The Supreme Court issued its slip opinion in the matter of *United States Patent and Trademark Office v. Booking.com* on June 30, 2020.[i] Justice Ginsburg wrote the opinion for the Court, and Roberts, Alito, Sotomayor, Kagan, Gorsuch, and Kavanaugh joined. Justice Sotomayor wrote a concurring opinion, and Justice Breyer filed a dissenting opinion.

To begin with the conclusion, the Court held that Booking.com was entitled to trademark protection. In making its decision, the Court focused on whether Booking.com as a whole, signifies to consumers the class of online hotel-reservation services. If so, then it is a generic term not entitled to protection.[ii] Part of the Court opinion relates back to Chief Justice Roberts concern at oral argument wherein he inquired as to whether similar sites, such as were considered to be a [iii] According to the Court, because consumers do not view it this way, as was determined by the lower courts, the case should be resolved.[iv]

However, the Court does not conclude its opinion so quickly and addresses the United States Patent and Trademark Office (argument that combining a generic term such as with a generic top level domain like results in a generic pairing, with some exceptions. Importantly, the Court points out that the USPTO own practice does not follow such a rule, and, in fact, existing registered trademarks would be subject to cancellation if such a rule were enforced.[v] The Court declines to adopt such a rule, but it does not go so far as to hold that adding or something similar [classifies] such terms as nongeneric.[vi] Indeed, the Court holds that any given term 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."[vii]

The Court also addresses the USPTO argument that providing trademark protection for would hinder competitors. In response, the opinion cites to certain doctrines that allay this concern. One such doctrine is fair use which from liability anyone who uses a descriptive term, and in good faith and t a mark," merely to describe her own goods."[viii] In short, there are mechanisms in place that guard against this issue.

With this opinion, it will be interesting to see if there is an influx of trademark applications from companies with a single distinguishing factor such as the addition of ".com". I suspect there will be.

[i] *United States Patent and Trademark Office, et al. v. Booking.com B.V.*, No. 19-46, slip op. (June 30, 2020), https://www.supremecourt.gov/opinions/19pdf/19-46_8n59.pdf

[ii] *Id.* at p. 7.

[iii] *Id.*

[iv] *Id.*

[v] *Id.* at p. 8.

[vi] *Id.* at p. 11.

[vii] *Id.*

[viii] *Id.* at p. 12.