Adding ".com" to Generic Term May Open Route to Trademark Protection According to Supreme Court

Article
September 2020

RELATED SERVICES

Intellectual Property

Generic terms—those words that actually name a product or service—are ineligible for trademark protection under current United States trademark law. The United States Patent and Trademark Office (USPTO) decided that adding ".com" to an otherwise generic term was not sufficient to allow trademark registration of the "generic.com" composition. In the matter at hand, the internet website Booking.com was refused trademark registration of its name based on this decision by the USPTO.

On June 30, 2020, however, the United States Supreme Court reversed this decision, holding that adding ".com" to an otherwise generic—and thus ineligible for registration—term may be registered. The Court said, a generic.com term is only generic if consumers and customers take the term, as a whole, as generic. The Court noted that, in the lower court proceedings, evidence had been presented that consumers do not view Booking.com as a generic website to book hotels and such, but rather associated it with a particular company.

The USPTO raised the concern that allowing such trademarks to be registered would be akin to allowing a business to add the word "Company" to a generic term and noted that this is not permitted. The Court, however, noted that, unlike business names, domain names are single use—only one "generic.com" domain name exists for each possible generic term. In addition, the Court said, the USPTO has other tools in its arsenal, such as insistence of a disclaimer of the generic term, to guard against a particular generic.com trademark holder from exerting undue control over other trademarks that include the generic term. This, the Court said, further shows that there is no basis to deny Booking.com the protection of a federally registered trademark.

This decision opens the door to a new category of potentially protectable trademarks: generic terms with ".com" added to the end. However, it is important to note that whether a generic.com trademark could be registered depends in large part on how that trademark is viewed by consumers. Booking.com is registerable because consumers attribute that trademark to a specific company; however, this may not be true in every case. Much of whether a generic.com

brand name is going to be able to be trademarked is likely to depend on evidence showing how consumers view the name; such evidence could include consumer surveys, evidence of marketing efforts, and evidence of long-term use. Nevertheless, companies who wish to use their most basic and generic description of the goods and services they offer as a part of a trademark now have another avenue by which to seek protection. However, it will be important to consider and prepare for questions that will likely be raised by the USPTO, including why the particular generic.com trademark is not viewed by consumers as generic, in order to raise the likelihood of obtaining trademark protection.

Adding ". com" to Generic Term May Open Route to Trademark Protection According to Supreme Court