
In the Supreme Court of the United States

UNITED STATES PATENT AND TRADEMARK OFFICE,
ET AL., PETITIONERS

v.

BOOKING.COM B.V.

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

BRIEF FOR THE PETITIONERS

SARAH T. HARRIS
General Counsel
THOMAS W. KRAUSE
Solicitor
CHRISTINA J. HIEBER
Senior Counsel
MOLLY R. SILFEN
Associate Solicitor
United States Patent and
Trademark Office
Alexandria, Va. 22314

NOEL J. FRANCISCO
Solicitor General
Counsel of Record
JOSEPH H. HUNT
Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
ERICA L. ROSS
Assistant to the Solicitor
General
MARK R. FREEMAN
DANIEL TENNY
WEILI J. SHAW
Attorneys
Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

QUESTION PRESENTED

Under the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), generic terms may not be registered as trademarks. The question presented is as follows:

Whether the addition by an online business of a generic top-level domain (".com") to an otherwise generic term can create a protectable trademark.

TABLE OF CONTENTS

	Page
Opinions below	1
Jurisdiction	1
Statutory provisions involved	2
Statement	2
A. Legal framework	3
B. The present controversy	7
Summary of argument	14
Argument:	
Appending a top-level domain like “.com” to a generic term does not create a protectable mark	17
A. Like the addition of an entity designation, the addition of a top-level domain to a generic term does not create a registrable trademark	18
B. Sound trademark policy supports the conclusion that adding a top-level domain to a generic term does not create a protectable mark	26
1. This case directly implicates the concerns that animated the Court’s decision in <i>Goodyear</i>	26
2. The nature of the Internet further confirms that adding a top-level domain to a generic term generally will not create a protectable mark	31
3. Respondent has ample protection against unfair competition even without federal trademark registration of BOOKING.COM	34
C. Respondent’s Teflon survey does not provide a sound basis for treating BOOKING.COM as a registrable trademark	36
1. Respondent’s survey evidence is irrelevant under <i>Goodyear</i>	36
2. Reliance on respondent’s survey evidence conflates generic and descriptive terms	40
Conclusion	45
Appendix — Statutory provisions	1a

IV

TABLE OF AUTHORITIES

Cases:	Page
<i>A.J. Canfield Co. v. Honickman</i> , 808 F.2d 291 (3d Cir. 1986)	26, 38, 41
<i>Abercrombie & Fitch Co. v. Hunting World, Inc.</i> , 537 F.2d 4 (2d Cir. 1976)	<i>passim</i>
<i>Advertise.com, Inc. v. AOL Adver., Inc.</i> , 616 F.3d 974 (9th Cir. 2010).....	21, 24, 25, 27
<i>America Online, Inc. v. AT & T Corp.</i> , 243 F.3d 812 (4th Cir.), cert. dismissed, 534 U.S. 946 (2001).....	32
<i>Analog Devices, In re</i> , 10 U.S.P.Q.2d (BNA) 1879 (Fed. Cir. 1989)	42
<i>B & B Hardware, Inc. v. Hargis Indus., Inc.</i> , 135 S. Ct. 1293 (2015)	7
<i>Bayer Co. v. United Drug Co.</i> , 272 F. 505 (S.D.N.Y. 1921)	4
<i>Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.</i> , 174 F.3d 1036 (9th Cir. 1999).....	8
<i>CES Publ'g Corp. v. St. Regis Publ'ns, Inc.</i> , 531 F.2d 11 (2d Cir. 1975)	4, 5, 34, 41
<i>E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.</i> , 393 F. Supp. 502 (E.D.N.Y. 1975).....	10, 43
<i>Elliott v. Google, Inc.</i> , 860 F.3d 1151 (9th Cir.), cert. denied, 138 S. Ct. 362 (2017)	43
<i>Estate of P. D. Beckwith, Inc., v. Commissioner of Patents</i> , 252 U.S. 538 (1920).....	28
<i>Genesee Brewing Co. v. Stroh Brewing Co.</i> , 124 F.3d 137 (2d Cir. 1997)	35, 38
<i>Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.</i> , 128 U.S. 598 (1888)	<i>passim</i>
<i>Harley Davidson, Inc. v. Grottanelli</i> , 164 F.3d 806 (2d Cir. 1999)	41

V

Cases—Continued:	Page
<i>Haughton Elevator Co. v. Seeberger</i> , 85 U.S.P.Q. (BNA) 80 (T.T.A.B. 1950).....	4
<i>Hotels.com, L.P., In re</i> , 573 F.3d 1300 (Fed. Cir. 2009)	9, 20, 21, 24, 33
<i>Howe Scale Co. v. Wyckoff, Seamans & Benedict</i> , 198 U.S. 118 (1905).....	19
<i>Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.</i> , 240 F.3d 251 (4th Cir. 2001).....	4, 43
<i>Inwood Labs., Inc. v. Ives Labs., Inc.</i> , 456 U.S. 844 (1982).....	21
<i>KP Permanent Make-Up, Inc. v. Lasting Impres- sion I, Inc.</i> , 543 U.S. 111 (2004).....	34
<i>Kellogg Co. v. National Biscuit Co.</i> , 305 U.S. 111 (1938).....	36, 37
<i>King-Seeley Thermos Co. v. Aladdin Indus., Inc.</i> , 321 F.2d 577 (2d Cir. 1963).....	4
<i>Lawrence Mfg. Co. v. Tennessee Mfg. Co.</i> , 138 U.S. 537 (1891).....	28
<i>March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc.</i> , 310 F. Supp. 2d 786 (N.D. Tex. 2003), aff’d, 120 Fed. Appx. 540 (5th Cir. 2005).....	42
<i>Martin Container Inc., In re</i> , 65 U.S.P.Q.2d (BNA) 1058 (T.T.A.B. 2002)	22
<i>Mil-Mar Shoe Co. v. Shonac Corp.</i> , 75 F.3d 1153 (7th Cir. 1996).....	4
<i>Miller Brewing Co. v. Falstaff Brewing Corp.</i> , 655 F.2d 5 (1st Cir. 1981)	41
<i>Miller Brewing Co. v. Jos. Schlitz Brewing Co.</i> , 605 F.2d 990 (7th Cir. 1979), cert. denied, 444 U.S. 1102 (1980).....	41, 42
<i>Northland Aluminum Prods., Inc., In re</i> , 777 F.2d 1556 (Fed. Cir. 1985).....	41, 42

VI

Cases—Continued:	Page
<i>1800Mattress.com IP, LLC, In re</i> , 586 F.3d 1359 (Fed. Cir. 2009)	21, 24
<i>Oppedahl & Larson LLP, In re</i> , 373 F.3d 1171 (Fed. Cir. 2004)	23, 24, 25
<i>Pacer Tech., In re</i> , 338 F.3d 1348 (Fed. Cir. 2003).....	7
<i>Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.</i> , 469 U.S. 189 (1985).....	3, 5, 6
<i>Pennington Seed, Inc., In re</i> , 466 F.3d 1053 (Fed. Cir. 2006)	4
<i>Peter v. NantKwest, Inc.</i> :	
cert. granted, No. 18-801 (Mar. 4, 2019)	14
No. 18-801 (Dec. 11, 2019)	14
<i>Qualitex Co. v. Jacobson Prods. Co.</i> , 514 U.S. 159 (1995).....	28
<i>Reed Elsevier Props. Inc., In re</i> , 482 F.3d 1376 (Fed. Cir. 2007)	9, 24
<i>Retail Servs. Inc. v. Freebies Publ'g</i> , 364 F.3d 535 (4th Cir. 2004).....	5, 27
<i>Royal Crown Co. v. The Coca-Cola Co.</i> , 892 F.3d 1358 (Fed. Cir. 2018).....	41
<i>Sara Lee Corp. v. Kayser-Roth Corp.</i> , 81 F.3d 455 (4th Cir.), cert. denied, 519 U.S. 976 (1996)	3, 4, 5, 6
<i>Schwan's IP, LLC v. Kraft Pizza Co.</i> , 460 F.3d 971 (8th Cir. 2006).....	42
<i>Soweco, Inc. v. Shell Oil Co.</i> , 617 F.2d 1178 (5th Cir. 1980), cert. denied, 450 U.S. 981 (1981).....	3, 4
<i>Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.</i> , 202 F.3d 489 (2d Cir.), cert. denied, 530 U.S. 1262 (2000).....	8
<i>Steelbuilding.com, In re</i> , 415 F.3d 1293 (Fed. Cir. 2005)	25
<i>Technical Publ'g Co. v. Lebhar-Friedman, Inc.</i> , 729 F.2d 1136 (7th Cir. 1984).....	25, 41

VII

Cases—Continued:	Page
<i>The Murphy Door Bed Co. v. Interior Sleep Sys., Inc.</i> , 874 F.2d 95 (2d Cir. 1989).....	35
<i>TraFFix Devices, Inc. v. Marketing Displays, Inc.</i> , 532 U.S. 23 (2001)	32
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	3, 4, 6, 26
<i>Wal-Mart Stores, Inc. v. Samara Bros., Inc.</i> , 529 U.S. 205 (2000).....	30
<i>Weiss Noodle Co. v. Golden Cracknel & Specialty Co.</i> , 290 F.2d 845 (C.C.P.A. 1961).....	42
<i>Welding Servs., Inc. v. Forman</i> , 509 F.3d 1351 (11th Cir. 2007).....	3, 4, 21
<i>Wm. B. Coleman Co., In re</i> , 93 U.S.P.Q.2d (BNA) 2019 (T.T.A.B. 2010)	21
 Statutes and regulations:	
Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 <i>et seq.</i>).....	3
15 U.S.C. 1051(a)(1).....	3, 1a
15 U.S.C. 1052.....	4, 6a
15 U.S.C. 1052(a)-(e)	3, 7a
15 U.S.C. 1052(e)	32, 8a
15 U.S.C. 1052(f) (1982)	6
15 U.S.C. 1052(f).....	16, 9a
15 U.S.C. 1057(b).....	3
15 U.S.C. 1062(a)	6, 10
15 U.S.C. 1063(a)	6
15 U.S.C. 1064.....	37, 38, 10a
15 U.S.C. 1064(c) (1982)	5
15 U.S.C. 1064(3) (1988).....	5
15 U.S.C. 1064(3)	11, 37
15 U.S.C. 1067.....	6

VIII

Statutes and regulations—Continued:	Page
15 U.S.C. 1070.....	6
15 U.S.C. 1071(a)	7, 23, 12a
15 U.S.C. 1071(a)(4).....	7, 13a
15 U.S.C. 1071(b).....	9, 14a
15 U.S.C. 1071(b)(1)	7, 14a
15 U.S.C. 1071(b)(3)	7, 14, 15a
15 U.S.C. 1091(a) (§ 23, 60 Stat. 435).....	22, 16a
15 U.S.C. 1115(a)	3
15 U.S.C. 1127.....	3, 17a
Patent Act of 1952, 35 U.S.C. 145	14
Trademark Law Revision Act of 1988, Pub. L. No. 100-667, Tit. I, 102 Stat. 3935	5
§ 115, 102 Stat. 3940-3941	5
§ 136, 102 Stat. 3948	5
28 U.S.C. 1291	7
37 C.F.R.:	
Section 2.145(a).....	7, 23
Section 2.145(c).....	7
 Miscellaneous:	
Am. Intell. Prop. Law Ass’n, <i>Report of the Economic Survey 2019</i> (Sept. 2019).....	30
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> :	
Vol. 1 (3d ed. 1996)	6
Vol. 1 (5th ed. 2019)	21
Vol. 2 (5th ed. 2019)	4, 5, 10, 21, 35
Aron Meystedt, <i>What is My URL Worth? – Placing A Value on Premium Domain Names</i> , 19 <i>Valua- tion Strategies</i> 10 (Nov./Dec. 2015)	32
S. Rep. No. 1333, 79th Cong., 2d Sess. (1946).....	26

IX

Miscellaneous—Continued:	Page
USPTO:	
<i>Trademark Manual of Examining Procedure:</i>	
(3d ed. Jan. 2002)	23
(Oct. 2018).....	23
<i>Trademark Trial and Appeal Board Manual of</i>	
<i>Procedure</i> (rev. June 2018).....	6

In the Supreme Court of the United States

No. 19-46

UNITED STATES PATENT AND TRADEMARK OFFICE,
ET AL., PETITIONERS

v.

BOOKING.COM B.V.

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

BRIEF FOR THE PETITIONERS

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-45a) is reported at 915 F.3d 171. The opinion of the district court on summary judgment (Pet. App. 46a-107a) is reported at 278 F. Supp. 3d 891. The opinion of the district court on petitioners' motion to amend the judgment and motion for expenses (Pet. App. 108a-135a) is not published in the Federal Supplement but is available at 2017 WL 4853755. The opinions of the Trademark Trial and Appeal Board (Pet. App. 136a-181a, 182a-224a, J.A. 309-355) are not published in the United States Patents Quarterly but are available at 2016 WL 1045671, 2016 WL 1045672, and 2016 WL 1045674.

JURISDICTION

The judgment of the court of appeals was entered on February 4, 2019. A petition for rehearing was denied on April 5, 2019 (Pet. App. 225a-226a). The petition for

a writ of certiorari was filed on July 5, 2019 (the day following a holiday). The petition for a writ of certiorari was granted on November 8, 2019. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 1127 of Title 15 of the United States Code defines a “trademark” in relevant part as “any word, name, symbol, or device, or any combination thereof” that is “used by a person * * * 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.” 15 U.S.C. 1127. Other pertinent statutory provisions are reproduced in an appendix to this brief. App., *infra*, 1a-23a.

STATEMENT

Respondent sought to register trademarks containing the term BOOKING.COM for online hotel reservation services. The United States Patent and Trademark Office (USPTO) denied registration. The agency concluded that the term “booking” is generic for the reservation services as to which respondent sought registration; that the top-level domain “.com” is generic for online services; and that the combination did not create a protectable mark. Pet. App. 136a-181a, 182a-224a; see J.A. 309-355. Respondent sought review of that decision in the United States District Court for the Eastern District of Virginia, which held that the term BOOKING.COM is not generic and is potentially protectable as a trademark. Pet. App. 46a-107a. The Fourth Circuit affirmed. *Id.* at 1a-45a.

A. Legal Framework

1. A trademark is a “word, name, symbol, or device” used by a person “to identify and distinguish his or her goods” in commerce. 15 U.S.C. 1127. The Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), defines the term “trademark” and authorizes federal registration of trademarks if certain requirements are met. 15 U.S.C. 1051(a)(1), 1052(a)-(e), 1127. Federal registration provides prima facie evidence of the validity of the registered mark and of the owner’s exclusive right to use the mark in connection with certain goods or services in commerce. See 15 U.S.C. 1057(b); 15 U.S.C. 1115(a).

For purposes of determining whether particular words or phrases can serve as trademarks, this Court has identified five categories of terms, listed in increasing order of distinctiveness and protectability: “(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; [and] (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.)). “A generic term is one that refers to the genus of which the particular product is a species.” *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). It is “the common name of a product or service itself,” and “identifies the general nature of an article.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 & n.10 (4th Cir.) (citation omitted), cert. denied, 519 U.S. 976 (1996). “Genericness lies not in the term itself, but in the use of the term: ‘A word may be generic of some things and not of others.’” *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1358 (11th Cir. 2007) (quoting *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980), cert. denied, 450 U.S. 981 (1981)). For

example, “ivory’ is generic of elephant tusks,” but is not generic “as applied to soap.” *Ibid.* (quoting *Soweco*, 617 F.2d at 1183); see *Abercrombie & Fitch Co.*, 537 F.2d at 9 n.6.

A term can be generic for a class of goods or services in either of two ways. First, a term can be generic from the time of its initial use. For example, terms like “Consumer Electronics Monthly,” “Crab House,” and “Warehouse Shoes” began as (and remained) generic for consumer-electronics magazines, seafood restaurants, and retail stores, respectively. See *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001); *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1161 (7th Cir. 1996); *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 12-15 (2d Cir. 1975) (Friendly, J.). Alternatively, a term that is first used as a “[c]oined” term—one that is “created for the sole purpose of serving as a trademark”—can become generic over time. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:5, at 11-17 (5th ed. 2019); see *id.* § 11:9, at 11-20 to 11-21. Courts have held that terms like “thermos,” “[a]spirin,” and “[e]scalator,” which began as “coined terms” for insulated bottles, medication, and moving staircases, respectively, had become generic through common usage. *Abercrombie & Fitch Co.*, 537 F.2d at 9 n.7 (citing *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BNA) 80 (T.T.A.B. 1950)); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963); *Bayer Co. v. United Drug Co.*, 272 F. 505, 510-514 (S.D.N.Y. 1921) (L. Hand, J.).

A term that either begins as generic or becomes generic over time “can *never* be [a] trademark[.]” *Sara Lee Corp.*, 81 F.3d at 464; see *Two Pesos, Inc.*, 505 U.S. at 768; 15 U.S.C. 1052; see also, *e.g.*, *In re Pennington*

Seed, Inc., 466 F.3d 1053, 1058 (Fed. Cir. 2006) (generic terms “are the antithesis of trademarks, and can never attain trademark status”) (citation omitted). By declining to recognize generic names as trademarks, trademark law “protect[s] the linguistic commons by preventing exclusive use of terms that represent their common meaning.” Pet. App. 2a; see, e.g., *CES Publ’g Corp.*, 531 F.2d at 13 (“To allow trademark protection for generic terms * * * would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”). Thus, “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, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9.¹

In contrast to a generic term, a descriptive term “describes the qualities or characteristics of a good or service,” *Park ’N Fly, Inc.*, 469 U.S. at 194, such as its “function, use, characteristic, size, or intended purpose,” *Retail Servs. Inc. v. Freebies Publ’g*, 364 F.3d 535, 539 (4th Cir. 2004) (citation omitted). Examples of descriptive terms include “After Tan post-tanning lotion, 5 Minute glue, King Size men’s clothing, and the Yellow Pages telephone directory.” *Sara Lee Corp.*,

¹ The Lanham Act originally referred to generic terms as those that constitute “the common descriptive name of an article or substance.” *Park ’N Fly, Inc.*, 469 U.S. at 193-194 (quoting 15 U.S.C. 1064(c) (1982)). In the Trademark Law Revision Act of 1988, Pub. L. No. 100-667, Tit. I, 102 Stat. 3935 (effective Nov. 16, 1989, see § 136, 102 Stat. 3948), Congress amended the statute to replace the term “common descriptive name” with the term “generic name,” e.g., § 115, 102 Stat. 3940-3941 (15 U.S.C. 1064(3) (1988)). See generally 2 *McCarthy* § 12:21, at 12-106 to 12-107 (5th ed. 2019).

81 F.3d at 464 (citing 1 *McCarthy* § 11.08, at 11-31 to 11-40 (3d ed. 1996)). Unlike generic terms, descriptive terms may be protected as trademarks, but only if “the registrant shows that [the term] has acquired secondary meaning, *i.e.*, it ‘has become distinctive of the applicant’s goods in commerce.’” *Park ’N Fly, Inc.*, 469 U.S. at 194 (quoting 15 U.S.C. 1052(f) (1982)).

Suggestive, arbitrary, and fanciful marks “are deemed inherently distinctive and are entitled to protection.” *Two Pesos, Inc.*, 505 U.S. at 768. “Suggestive marks connote, without describing, some quality, ingredient, or characteristic of the product.” *Sara Lee Corp.*, 81 F.3d at 464 (giving examples of Coppertone® and Orange Crush®). “Arbitrary marks are comprised of words in common usage, but, because they do not suggest or describe any quality, ingredient, or characteristic of the goods they serve, are said to have been arbitrarily assigned.” *Ibid.* (giving examples of Camel® cigarettes and Apple® computers). “Fanciful marks are, in essence, made-up words.” *Ibid.* (giving examples of Clorox® and Kodak®).

2. When an applicant seeks to register a trademark, a USPTO examining attorney determines whether “the applicant is entitled to registration.” 15 U.S.C. 1062(a). An applicant who is dissatisfied with the examining attorney’s decision may appeal to the Trademark Trial and Appeal Board (TTAB), which renders a final decision on behalf of the USPTO. See 15 U.S.C. 1067, 1070; see also 15 U.S.C. 1063(a) (permitting third parties to file opposition to registration addressed to the TTAB). Both the examining attorney and the TTAB apply Federal Circuit precedents in deciding whether particular marks qualify for registration because USPTO registration decisions are directly reviewable by the Federal Circuit. See USPTO, *Trademark Trial and Appeal*

Board Manual of Procedure (TBMP) § 101.03 (rev. June 2018).

Any party who is dissatisfied with the TTAB's decision may file a direct appeal in the Federal Circuit. 15 U.S.C. 1071(a); see 37 C.F.R. 2.145(a). That court reviews "the decision from which the appeal is taken on the record before the [USPTO]," 15 U.S.C. 1071(a)(4), and reviews the USPTO's factual findings for "substantial evidence," *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed. Cir. 2003). Alternatively, a party who is dissatisfied with the TTAB's decision may file a civil action in federal district court. 15 U.S.C. 1071(b)(1); see 37 C.F.R. 2.145(c). Unlike in a direct appeal, the applicant and the USPTO may conduct discovery, and the applicant may introduce evidence that the agency had no prior opportunity to consider. If new evidence is introduced on an issue in a Section 1071(b)(1) suit, the judge resolves that issue *de novo*. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1301 (2015); see 15 U.S.C. 1071(b)(3). Any appeal from the district court's decision in such a proceeding is heard by the appropriate regional court of appeals. 28 U.S.C. 1291.

B. The Present Controversy

1. Respondent operates a website on which customers can book hotel accommodations. Pet. App. 4a. In 2011 and 2012, respondent filed four federal trademark-registration applications for marks that included or consisted of the term "BOOKING.COM." *Ibid.* As relevant here, the applications sought registration for use of the marks in connection with "online hotel reservation services." *Ibid.*; see *id.* at 4a n.2.

The USPTO examining attorney denied registration on the ground that BOOKING.COM is generic as applied to the relevant services. See Pet. App. 5a. The

TTAB affirmed in three substantially similar opinions. *Ibid.*; see *id.* at 136a-181a, 182a-224a; J.A. 309-355. The TTAB concluded that “relevant customers would understand the term BOOKING.COM to refer to an online reservation service for transportation and lodgings.” Pet. App. 218a; see *id.* at 176a.

In reaching that conclusion, the TTAB relied on dictionary definitions of the terms “booking,” and “.com”; the use of the term “booking” by “numerous websites” and by respondent to refer to the relevant class of services; and “third-party domain names and trade names that include the designation ‘booking.com,’” such as “hotelbooking.com” and “ebooking.com.” Pet. App. 141a-169a, 187a-211a.² The TTAB found that, in context, “booking” means “a reservation or arrangement to buy a travel ticket or stay in a hotel room; or the act of reserving such travel or accommodation,” and that the term “has been widely used to describe the service of arranging reservations for hotel rooms or air travel.” *Id.* at 160a, 202a. The TTAB further found that “.com” means “commercial organization (in Internet addresses).” *Id.* at 164a, 206a. The TTAB concluded that “BOOKING.COM would be obviously and immediately understood as having the meaning of booking travel,

² A domain name is a string of text that is used to look up a particular site or resource on the Internet. A top-level domain is the right-most portion of a domain name, such as “.com,” “.net,” “.org,” or “.gov.” Domain names also include second-level domains (*e.g.*, “uscourts.gov”) and may include third-level domains (*e.g.*, “ca4.uscourts.gov”). See, *e.g.*, *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 492-493 (2d Cir.), cert. denied, 530 U.S. 1262 (2000); *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999). In the case of “booking.com,” “.com” is the top-level domain and “booking” is the second-level domain.

tours, and lodgings through an internet service.” *Id.* at 176a; see *id.* at 218a (similar).

The TTAB observed that its conclusion comported with prior decisions of the Federal Circuit. Pet. App. 163a, 170a-171a, 205a-206a, 212a-213a. The TTAB explained that the Federal Circuit had “held to be generic marks that were similar” to BOOKING.COM—such as “HOTELS.COM” and “LAWYERS.COM”—“on the basis of” “highly similar” evidence. *Ibid.* (citing *In re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009) and *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376 (Fed. Cir. 2007)).

2. Respondent sought review in the United States District Court for the Eastern District of Virginia, see 15 U.S.C. 1071(b), which reversed in relevant part, Pet. App. 46a-107a. The court agreed with the TTAB that “the word ‘booking’ is generic for the classes of hotel and travel reservation services recited in [respondent’s] applications” because “the word ‘booking,’ standing alone, is the common descriptive”—*i.e.*, generic, see p. 5 n.1, *supra*—“name for both the act of making a reservation and the reservation itself.” Pet. App. 67a. The court also observed that the Federal and Ninth Circuits had found the combination of similar generic terms and top-level domains like “.com” to be generic. *Id.* at 69a-72a, 77a-78a.

The district court nonetheless concluded that “a mark composed of a generic [second-level domain] and a [top-level domain] is a descriptive mark eligible for protection upon a showing of acquired distinctiveness.” Pet. App. 84a-85a. In applying that general rule to this case, and in concluding that BOOKING.COM is descriptive, the court relied in part on “the absence of evidence indicating that the consuming public uses the term BOOKING.COM to refer to a class of services,” *i.e.*, to

Internet booking sites generally. *Id.* at 86a. The court also gave weight to respondent’s “Teflon survey,” which respondent had introduced for the first time in the district court. *Id.* at 84a, 88a.

Teflon surveys are so named because they were first used to determine whether the term “teflon”—coined by DuPont to designate a non-stick coating—had become a generic name for a class of such goods. See *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 523 (E.D.N.Y. 1975) (capitalization altered). When such surveys are performed, the individuals who are surveyed are first given a primer on the difference between a “common” name and a “brand” name, and are then asked whether each of several names, including the term at issue, is “a brand name or a common name.” *Id.* at 526; see 2 *McCarthy* § 12:16, at 12-63 to 12-69 (5th ed. 2019). In this case, respondent’s Teflon survey showed that “74.8 percent” of surveyed consumers “identified BOOKING.COM as a brand name.” Pet. App. 88a.

Having concluded that BOOKING.COM is descriptive, the district court held that, as applied to hotel reservation services, the mark had acquired secondary meaning. Pet. App. 97a-104a. The court ordered the USPTO to register the marks as to two applications, and it remanded the other two applications for further agency fact-finding regarding design and color elements of the proposed marks. *Id.* at 106a-107a & n.23. The court subsequently amended its judgment to direct that the marks it had found distinctive be published for opposition in the USPTO’s Official Gazette, a necessary precondition for registration. *Id.* at 110a-116a; see 15 U.S.C. 1062(a).

3. The court of appeals affirmed. Pet. App. 1a-27a.

a. The court of appeals framed the question before it as “whether the primary significance of the mark [BOOKING.COM] to the relevant public is as an indication of the nature of the class of the product or services to which the mark relates, which suggests that it is generic, or an indication of the source or brand, which suggests that it is not generic.” Pet. App. 9a-10a. The court observed that “[t]he Lanham Act codifies the primary significance test as the test for determining whether a registered trademark has become generic in *cancellation* of registration proceedings.” *Id.* at 10a n.6 (citing 15 U.S.C. 1064(3)). The court noted as well that the Fourth and Federal Circuits “have also applied the primary significance test to determine genericness in registration proceedings.” *Ibid.*

The court of appeals upheld the district court’s determination that BOOKING.COM is not generic because the relevant public would primarily understand the term to indicate respondent’s brand. Pet. App. 12a-13a. In reaching that conclusion, the court relied in significant part on respondent’s Teflon survey. *Id.* at 16a-18a. The court acknowledged that, “[i]f a term is deemed generic, subsequent consumer recognition of the term as brand-specific cannot change that determination.” *Id.* at 11a. The court held, however, that this rule applies only where a term was “already deemed generic” by “a prior court” or was “previously commonly used” by the public. *Id.* at 21a & n.11; see *id.* at 17a. The court of appeals also approved the district court’s reliance on evidence that “the public does not *use* ‘booking.com’ to refer to the relevant services.” *Id.* at 15a. The court of appeals further found that the district court had properly declined to rely on the USPTO’s evidence that respondent’s competitors have included the

term BOOKING.COM in domain names like “hotelbooking.com” and “ebooking.com.” *Id.* at 14a.

In arguing that BOOKING.COM is generic, the government relied in part on this Court’s holding in *Goodyear’s India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), that the addition of an entity designation like “Company” to a generic term cannot create a protectable trademark. Pet. App. 18a. The government contended that the *Goodyear* Court’s rationales for that conclusion apply equally to a mark formed by adding the top-level domain “.com” to a generic term. *Id.* at 18a-19a. The court of appeals rejected that argument, stating that “*Goodyear* was decided almost sixty years before the Lanham Act and, crucially, did not apply the primary significance test” that the court applied in this case. *Id.* at 19a.

The court of appeals stated that it was “not unsympathetic to the USPTO’s concerns that granting trademark protection over BOOKING.COM may prevent other companies from using the mark.” Pet. App. 24a. But the court found “these concerns * * * assuaged by two considerations.” *Ibid.* The court first posited that, because trademark protection applies only to particular services—here, hotel reservation services—other businesses likely could continue to use domain names like “carbooking.com” or “flightbooking.com.” *Ibid.* The court also observed that, if respondent ever files suit alleging infringement of its BOOKING.COM mark, it will be required to show a likelihood of consumer confusion, which might be “more difficult” in the context of “unique” domain names. *Id.* at 24a-25a.

b. Judge Wynn dissented in relevant part. Pet. App. 28a-45a (Wynn, J., concurring in part and dissenting in part). He explained that, because “trademark law does

not protect generic terms,” a business that values trademark protection must choose a non-generic domain name like Amazon.com and can then exclude competitors from using close variants of that name. *Id.* at 28a. Alternatively, an Internet business can choose a generic domain name that identifies the goods or services it provides, thereby easily attracting customers but forgoing the benefits of trademark protection. *Ibid.* Judge Wynn would have held that BOOKING.COM falls into the latter category. *Id.* at 28a-29a.

Judge Wynn would have reversed the district court’s judgment on the ground that the court’s factual findings were premised on “legal error”—the court’s conclusion that the combination of “.com” and a generic term “is usually a descriptive mark eligible for protection upon a showing of secondary meaning.” Pet. App. 30a n.2 (Wynn, J., concurring in part and dissenting in part) (citation omitted); see *id.* at 30a-32a. Judge Wynn stated that the majority’s “ultimate determination—that the proposed mark BOOKING.COM is descriptive—conflicts with the determination that *every other court* has reached” in similar cases. *Id.* at 32a; see generally *id.* at 32a-37a.

Judge Wynn also invoked the established rule that, no matter how much success the user of a generic term “has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” Pet. App. 38a-39a (Wynn, J., concurring in part and dissenting in part) (quoting *Abercrombie & Fitch Co.*, 537 F.2d at 9) (emphasis omitted). Finally, Judge Wynn stated that the court’s decision “unjustifiably empowers [respondent] to monopolize language” and “freeze out potential competitors,” who cannot “use the term ‘booking’ in their own website domain names” without “fac[ing] the risk

of a costly, protracted, and uncertain infringement lawsuit.” *Id.* at 41a-42a; see *id.* at 42a-45a.³

c. The court of appeals denied the government’s petition for rehearing en banc. Pet. App. 225a-226a.

SUMMARY OF ARGUMENT

A. More than 130 years ago, this Court held that the addition of an entity designation like “Company” or “Inc.” to a generic term like “wine,” “cotton,” or “grain” does not create a protectable mark. *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-603 (1888). The Court explained that “the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods,” and that by adopting a name like “Grain Company,” or “Grain Inc.,” one entity cannot foreclose others from “deal[ing] in such articles, and * * * publish[ing] the fact to the world.” *Ibid.*

³ The court of appeals unanimously affirmed the district court’s determination that, under 15 U.S.C. 1071(b)(3), the USPTO was entitled to “all the expenses of the proceeding,” including the salary expenses of the USPTO personnel who had defended the action. Pet. App. 25a-27a (majority opinion) (citation and emphasis omitted); *id.* at 30a n.2 (Wynn, J., concurring in part and dissenting in part). The court of appeals subsequently deconsolidated respondent’s cross-appeal on expenses from the USPTO’s appeal, and it granted respondent’s motion to stay the mandate in the cross-appeal pending this Court’s decision in *Peter v. NantKwest, Inc.*, cert. granted, No. 18-801 (Mar. 4, 2019). On December 11, 2019, the Court issued its decision in *NantKwest*, holding that the USPTO may not recoup the same types of personnel expenses under the parallel provision of the Patent Act of 1952, 35 U.S.C. 145. *Peter v. NantKwest, Inc.*, No. 18-801, slip op. 10. Respondent has filed a petition for a writ of certiorari on the expenses question, which remains pending. *Booking.com B.V. v. United States Patent & Trademark Office*, No. 18-1309 (filed Apr. 10, 2019).

The same principle applies to proposed marks, like the one at issue here, that are formed by adding the top-level domain “.com” to a generic term that denotes the goods or services provided. The district court recognized, and the court of appeals did not dispute, that “booking” is generic for the class of hotel reservation services described in respondent’s trademark applications. Pet. App. 12a-25a, 67a. The addition of “.com” does not create a protectable mark, because it conveys only that respondent operates a commercial website via the Internet. Thus, just as no company could federally register “Booking Company” or “Booking Inc.” as a trademark, respondent should not be permitted to federally register “BOOKING.COM.”

B. Sound trademark policy supports the conclusion that adding a top-level domain to a generic term does not create a protectable mark. The *Goodyear* Court relied in part on the fact that granting trademark protection to “Grain Company” or “Grain Inc.” would have given the first user of that name an effective monopoly on language, to the detriment of competition and consumers. Granting federal trademark protection for “generic.com” terms would have a similar anticompetitive effect.

Indeed, the online context makes trademark registration of “generic.com” terms particularly problematic. Under the domain-name system, only one entity can have contractual rights to use a particular domain name at a given time. That functional feature of the Internet *already* gives significant competitive advantages to entities that obtain “generic.com” domain names. The court of appeals’ rule—which would render all “generic.com” terms potentially registrable as trademarks—would compound those advantages and permit the

monopolization of language that trademark law is meant to discourage.

Trademark protection is not necessary to protect respondent's investment in the name BOOKING.COM. Other legal rules protect respondent from third parties' attempts to trade on its reputation or mislead consumers. Respondent also remains free to register as trademarks stylized elements of its brand identity that distinguish it from its competitors. Respondent can assert those prerogatives without registering the term BOOKING.COM and thereby foreclosing competitors from using similar terms to describe their own online hotel booking services.

C. The courts below relied heavily on respondent's Teflon survey, which purported to show that a significant percentage of consumers identified BOOKING.COM as a brand name, rather than as a general reference to websites offering hotel reservation services. The courts' reliance on that survey was misplaced. Although the parties in *Goodyear* did not conduct consumer surveys, each of them presented evidence that the public associated the term "Goodyear Rubber Company," or some variant thereof, with its own business. The Court found that evidence irrelevant and held, as a matter of law, that appending the word "Company" to an otherwise-unprotectable term did not create a protectable mark. *Goodyear*, 128 U.S. at 602. There is no reason to suppose that modern-day consumer-survey evidence would have produced a different result.

In relying on respondent's survey evidence, the courts below disregarded a fundamental distinction between generic and descriptive terms. Whereas generic terms are not registrable as trademarks, even upon a showing of secondary meaning, descriptive terms may be registered based upon such evidence. See 15 U.S.C.

1052(f). That distinction ensures that generic terms cannot be monopolized even by entities that devote substantial resources to creating a public association between a generic term and a particular brand. In keeping with this principle, other courts of appeals have declined to rely on survey evidence purporting to show that consumers associate generic terms with a specific producer. The court of appeals should have taken that approach here. Just as a survey showing that many consumers associate “Booking Company” or “Booking Inc.” with a particular entity would not render those terms federally registrable as trademarks, respondent’s survey evidence provided no basis for allowing federal registration of BOOKING.COM.

ARGUMENT

APPENDING A TOP-LEVEL DOMAIN LIKE “.COM” TO A GENERIC TERM DOES NOT CREATE A PROTECTABLE MARK

This Court has long recognized that appending a corporate designation like “Company” or “Inc.” to a generic term does not render the combination non-generic, because “[t]he addition” of an entity designation “only indicates that parties have formed an association or partnership to deal in” particular goods or services. *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888). The same rationale applies to top-level domains like “.com,” which indicate only that an entity has an online presence. Because the term “booking” is generic for the class of hotel reservation services at issue here, the term BOOKING.COM may not be registered as a trademark.

The court of appeals’ contrary decision threatens significant anticompetitive consequences. It permits in-

dividuals or entities to monopolize language by obtaining the contractual rights to “generic.com” domain names, and then leveraging those domain names into protected trademarks. Such protection threatens to preclude competitors from calling their products and services by their common names, thereby diminishing competition and harming consumers. The decision below also disregards the long-recognized trademark principle that no entity can obtain a trademark on a generic term, no matter how much money it expends to create an association between the term and the entity’s business. Under established trademark law and policy, the addition of “.com” to a generic term does not create a protectable mark.

A. Like The Addition Of An Entity Designation, The Addition Of A Top-Level Domain To A Generic Term Does Not Create A Registrable Trademark

1. In *Goodyear*, this Court decided the nineteenth-century version of the question presented here. The Goodyear Rubber Company sought to restrain Goodyear’s India Rubber Glove Manufacturing Company from using the name “Goodyear’s Rubber Manufacturing Company” or any equivalent. 128 U.S. at 599. The Court rejected that claim, holding that the term “Goodyear Rubber Company” was not “capable of exclusive appropriation.” *Id.* at 602.

The Court explained that “Goodyear Rubber” was what was then known as the common descriptive name—the generic name in today’s terminology, see p. 5 n.1, *supra*—for “well-known classes of goods produced by the process known as Goodyear’s invention.” *Goodyear*, 128 U.S. at 602. The Court thus likened “Goodyear Rubber” to generic terms like “wine,” “cotton,” and

“grain,” which “cannot be exclusively appropriated by any one.” *Ibid.*

The Court held that “[t]he addition of the word ‘Company’” to a generic term could not render the combination non-generic. *Goodyear*, 128 U.S. at 602. The Court explained that the addition “only indicate[d] that parties ha[d] formed an association or partnership to deal in [the relevant class of] goods, either to produce or to sell them.” *Ibid.* Thus, “parties united to produce or sell wine, or to raise cotton or grain,” could not, by adopting names like “Wine Company, Cotton Company, or Grain Company,” obtain a trademark in the combination; “nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.” *Id.* at 602-603. “The designation Goodyear Rubber Company” therefore was “not * * * subject to exclusive appropriation, [and] any use of terms of similar import, or any abbreviation of them, must be alike free to all persons.” *Id.* at 604.

The *Goodyear* Court grounded its decision in fundamental policies of trademark law. The Court stated that affording trademark protection to a term like “Grain Company” would “impair the equal right of others engaged in similar business to use similar designations,” in violation of the “obvious” principle that “all persons have a right to deal in such articles, and to publish the fact to the world.” *Goodyear*, 128 U.S. at 602-603. The Court explained that such an approach would “injure[,] rather than protect[,]” the public, and would “destroy[]” competition. *Id.* at 603. The Court reaffirmed that ruling nearly two decades later, citing *Goodyear* with approval and reiterating that “one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right.” *Howe*

Scale Co. v. Wyckoff, Seamans & Benedict, 198 U.S. 118, 137 (1905).

2. The principle this Court announced in *Goodyear* applies equally here. As the district court recognized and the court of appeals did not dispute, the term “booking” is generic for the class of hotel reservation services described in respondent’s trademark applications. See Pet. App. 12a-25a, 67a. The noun “‘booking’” can be defined as a “reservation” or “arrangement to * * * stay in a hotel room, etc. at a later date,” as in this sentence: “Increasingly, travelers are using the Internet for both information and bookings.” *Id.* at 141a-142a (citations and emphasis omitted); see *id.* at 67a. Thus, under *Goodyear*, respondent could not federally register “Booking Inc.” or “Booking Company” as a trademark for the relevant class of services.

By the same logic, respondent should not be permitted to federally register BOOKING.COM. Just as “addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in” the relevant class of goods or services, *Goodyear*, 128 U.S. at 602, addition of the top-level domain “.com” “communicates no more than the common meaning[] * * * that the applicant operates a commercial website via the internet,” *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009); see Pet. App. 164a, 206a (TTAB explained that “dictionary definitions * * * indicat[e] * * * that ‘.com’ is an abbreviation meaning ‘commercial organization (in Internet addresses).’”). Like the term “Company” or “Inc.,” “a top level domain designation has no ability to distinguish one source from another and thus, has no trademark significance. Such a top level domain indicator has no source indicating significance and cannot serve any trademark purpose.”

1 *McCarthy* § 7:17.50, at 7-38 to 7-39 (5th ed. 2019) (footnote omitted). Thus, the adoption of a “generic.com” domain name, “without other specification,” cannot “create any exclusive right to the use of the name” as a trademark. *Goodyear*, 128 U.S. at 603; see *Hotels.com*, 573 F.3d at 1304 (recognizing that “registrability does not depend on the .com combination”); *Advertise.com, Inc. v. AOL Adver., Inc.*, 616 F.3d 974, 979-980 & n.4 (9th Cir. 2010) (similar); *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009) (similar).

3. The court of appeals suggested (Pet. App. 19a), and respondent previously has argued (Br. in Opp. 11), that *Goodyear* is inapplicable here because it predated the Lanham Act’s enactment. But “the purpose of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection,” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring in the result), not to abrogate this Court’s longstanding precedents. This Court has neither overruled *Goodyear* nor suggested that it has been superseded by later statutory enactments. In recent years, courts, commentators, and the USPTO all have applied *Goodyear* to hold that adding a corporate (or other entity) designation to generic terms does not create a protectable mark. See, e.g., *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1359 n.4 (11th Cir. 2007) (“The mere inclusion of ‘Inc.’ at the end of the name does not make generic words protectable.”); *In re Wm. B. Coleman Co.*, 93 U.S.P.Q.2d (BNA) 2019, 2025 (T.T.A.B. 2010) (“[T]he term ‘company’ is simply a designation for a type of entity without source-identifying capability.”); 2 *McCarthy* § 12:39, at 12-159 (5th ed. 2019) (“Tacking a company organizational designation such as ‘Company,’ or ‘Inc.’ or ‘Partners’ cannot transform a generic name into a protectable trademark.

Such company designations or their abbreviations are themselves generic and have no trademark significance.”). And respondent has never suggested that the core holding of *Goodyear* no longer applies, such that “Booking Company” or “Booking Inc.” would be eligible for trademark registration.

4. Given the similarity between “Generic Inc.” and “generic.com” terms, the TTAB and most courts of appeals to consider the issue have determined that, under *Goodyear*, a “generic.com” domain name generally is not eligible for federal registration as a trademark.

In *In re Martin Container Inc.*, 65 U.S.P.Q.2d (BNA) 1058 (T.T.A.B. 2002), the TTAB affirmed the denial of registration on the Supplemental Register⁴ to “CONTAINER.COM.” *Id.* at 1060. The TTAB explained that “‘CONTAINER’” was “generic in connection” with the applicant’s services; that “the top level domain indicator” “.com” likewise “has no source-identifying significance”; and that “combining the two does not create a term which has somehow acquired the capability of identifying and distinguishing applicant’s services.” *Ibid.* (citation omitted). The TTAB found the case to be “analogous” to those involving terms like “‘PAINT PRODUCTS CO’” and “‘OFFICE MOVERS, INC.,’” which “were held to be no more registrable than the generic terms would be by themselves.” *Ibid.* The TTAB observed that, “to the average customer seeking to buy or rent containers, ‘CONTAINER.COM’ would immediately indicate a commercial web site on the Internet which provides containers.” *Ibid.* It concluded

⁴ Section 23 of the Lanham Act authorizes registration on the Supplemental Register of certain marks “capable of distinguishing applicant’s goods or services and not registrable on the [P]rincipal [R]egister.” 15 U.S.C. 1091(a).

that registration of the term as a trademark was inappropriate because “[c]ontainer suppliers who compete with applicant may in fact be using or have a competitive need to use the matter sought to be registered as part of their own domain names and trademarks.” *Id.* at 1061.

The USPTO’s *Trademark Manual of Examining Procedure (TMEP)* similarly recognizes that “generic.com” combinations generally are not eligible for federal trademark registration. See *TMEP* § 1215.05 (3d ed. Jan. 2002) (“If a mark is composed of a generic term(s) for the applicant’s goods or services and a [top-level domain], the examining attorney must refuse registration on the ground that the mark is generic and the [top-level domain] has no trademark significance.”); see also *TMEP* § 1215.05 (Oct. 2018) (“Generally, a mark comprised of generic term(s) combined with a non-source-identifying [generic top-level domain] is generic and without trademark or service mark significance.”).

The Federal and Ninth Circuits have reached the same conclusion. As discussed above, see p. 7, *supra*, any party dissatisfied with a USPTO trademark-registration decision may appeal directly to the Federal Circuit. See 15 U.S.C. 1071(a); 37 C.F.R. 2145(a). Since 2004, the Federal Circuit has recognized that “the comparison of [top-level domains] (i.e., ‘.com,’ [‘.org,’ etc.] to entity designations such as ‘Corp.’ and ‘Inc.’ has merit,” because “[t]he commercial impression created by ‘.com’ is similar to the impression created by” those terms. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (2004). The court has determined that, while *Goodyear* does not provide “a perfect analogy,” “[t]he addition of a [top-level domain] such as ‘.com’ or ‘.org’ to an otherwise unregistrable mark will typically not add any source-identifying significance, similar to the analysis of ‘Corp.’

and ‘Inc.’ in *Goodyear*[.]” *Id.* at 1175, 1177. The Federal Circuit thus has affirmed TTAB decisions declining to register terms like “PATENTS.COM,” “MATTRESS.COM,” “LAWYERS.COM,” and “HOTELS.COM.” *Id.* at 1177; *1800Mattress.com IP, LLC*, 586 F.3d at 1363-1364; *Hotels.com*, 573 F.3d at 1304-1306; *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379-1380 (2007).⁵

The Ninth Circuit similarly has recognized *Goodyear*’s relevance to proposed marks comprised of a generic term and a top-level domain. In *Advertise.com*, AOL, which owned trademark registrations including for ADVERTISING.COM, alleged that the use of ADVERTISE.COM infringed its mark. 616 F.3d at 976. The court reversed the grant of a preliminary injunction to AOL, explaining that ADVERTISING.COM was generic because it merely “convey[s] the genus of the services offered under the mark: *internet* advertising.” *Id.* at 982; accord *1800Mattress.com IP*, 586 F.3d at 1364 (finding MATTRESS.COM generic because it refers “to the genus of ‘online retail store services in the field of mattresses, beds, and bedding’”). Citing *Goodyear*,

⁵ Respondent previously has pointed out (Br. in Opp. 7-8, 12) that the Federal Circuit in *Oppedahl & Larson LLP* referred to the term “.com” as descriptive. But because the parties there did not dispute that “patents.com” was *at least* descriptive for the relevant class of computer software, 373 F.3d at 1173-1174 (emphasis omitted), the court had no need to determine whether ‘.com’ is generic. And as discussed above, the court confirmed that adding “.com” “to an otherwise unregistrable mark will typically not add any source-identifying significance.” *Id.* at 1177; see *id.* at 1175. Subsequent Federal Circuit decisions have likewise made clear that, because “.com” generally conveys only that a business has an online presence, “registrability does not depend on the .com combination.” *Hotels.com*, 573 F.3d at 1304; see *1800Mattress.com IP*, 586 F.3d at 1364.

the court explained that “.com,’ when added to a generic term, ‘indicates a commercial entity’ [and] does not suffice to establish that the composite is distinctive, much as AOL would not have created a protectable mark by adopting the designation ‘Advertising Company.’” *Advertise.com*, 616 F.3d at 982.⁶ By the same logic, because respondent could not federally register the term “Booking Company” or “Booking Inc.” as a trademark, it should not be permitted to register the term “BOOKING.COM.”⁷

⁶ The Federal and Ninth Circuits have suggested that adding “.com” or a similar top-level domain to a generic term may create a protectable mark in the “rare” case where the combined term carries additional meaning. See, e.g., *Advertise.com*, 616 F.3d at 981 (concluding that “ADVERTISING.COM” did not present the “rare case”); *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (stating that the addition of a top-level domain may create a registrable mark in the “unusual case” in which it “expand[s] the meaning of the mark”); *Oppedahl & Larson*, 373 F.3d at 1175 (identifying, as a possible exceptional case, an application “to register the mark tennis.net for a store that sells tennis nets”). This case does not present any issue concerning the propriety or scope of such an exception. See Pet. App. 35a-37a (Wynn, J., concurring in part and dissenting in part) (explaining that this case is “readily distinguishable” from examples of the “rare circumstance” envisioned by the Federal and Ninth Circuits).

⁷ Courts have applied similar logic to the names of trade journals, holding that “titles consisting of the trade name and an indication of the type of publication are generic.” *Technical Publ’g Co. v. Lebharr-Friedman, Inc.*, 729 F.2d 1136, 1140 (7th Cir. 1984); see *ibid.* (providing examples including “Video Buyer’s Guide,” and “Safariland Newsletter”) (citations omitted). Thus, the court in *Technical Publishing Company* held that “the addition of ‘News’ to ‘Software’” in the title “‘Software News’” did not make “a stronger case” for trademark protection, because “[t]he word ‘news,’ when coupled with ‘software,’ indicates current information about software.” *Id.* at 1140-1141.

B. Sound Trademark Policy Supports The Conclusion That Adding A Top-Level Domain To A Generic Term Does Not Create A Protectable Mark

The *Goodyear* Court grounded its decision in the longstanding trademark policy that one entity should not be permitted to preclude its competitors from calling their own goods or services by their common name. See 128 U.S. at 602-603. “By protecting trademarks” in the Lanham Act, “Congress [likewise] hoped * * * ‘to foster fair competition.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring in the judgment) (quoting S. Rep. No. 1333, 79th Cong., 2d Sess. 4 (1946)). Permitting federal trademark registration of “generic.com” terms would undermine that goal.

1. This case directly implicates the concerns that animated the Court’s decision in *Goodyear*

The *Goodyear* Court explained that recognition of a trademark in the name “Grain Company” or “Grain Inc.” would have interfered with competitors’ rights “to deal in such articles, and to publish the fact to the world.” 128 U.S. at 602-603. That result would “injure[,] rather than protect[]” the public, “for competition would be destroyed.” *Id.* at 603; accord, *e.g.*, *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 304 (3d Cir. 1986) (“Courts refuse to protect a generic term because competitors need it more to describe their goods than the claimed markholder needs it to distinguish its goods from others.”).

Like permitting federal trademark protection of “Generic Inc.” terms, allowing registration of “generic.com” terms would hinder competitors’ ability to deal in the relevant goods or services and to market themselves to the public. “[G]ranting trademark rights

over a domain name composed of a generic term and a [top-level domain] grants the trademark holder rights over far more intellectual property than the domain name itself.” *Advertise.com*, 616 F.3d at 980. “In addition to potentially covering all combinations of the generic term with any [top-level domain] (e.g., ‘.com’; ‘.biz’; ‘.org’), such trademark protection would potentially reach almost any use of the generic term in a domain name,” inhibiting use of “a vast array of simple, easy to remember domain names and designations that describe the services provided.” *Id.* at 980-981.

The scope of this potential preemption is significant. For example, in a 2004 case addressing whether the term “freebie” is generic, the Fourth Circuit noted that there were at that time “1,600-plus websites (or more) that incorporate the word ‘freebie’ or ‘freebies’ into their domain names.” *Retail Servs. Inc. v. Freebies Publ’g*, 364 F.3d 535, 546 (2004). The court observed that “[t]hese websites are now so common that the term ‘freebie site’ is often used by these sites to refer to other sites that, like defendants, offer information about free products or services.” *Ibid.* Allowing the domain name “freebie.com” to be registered as a trademark, even though the term “freebie” is generic, *id.* at 546-547, would significantly impair these competitors’ ability to operate and market their services.

Treating BOOKING.COM as a protectable trademark would allow a single entity to monopolize the term “booking” with respect to the relevant online services and impede respondent’s competitors from using it in their own domain names. Respondent’s competitors already use a host of domain names that include the terms “booking.com” or “bookings.com,” such as “ebooking.com,” “instantworldbooking.com,” “hotelbooking.com,” “blinkbooking.com,” “eurobookings.com,”

“francehotelbooking.com,” “homesstaybooking.com,” and “dubai-travelbooking.com.” Pet. App. 151a-153a; see *id.* at 155a (listing other similar domain names). Federal registration of BOOKING.COM would “impair the equal right” of these competitors “to use similar designations” that accurately represent the services they offer. *Goodyear*, 128 U.S. at 603; see, e.g., *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U.S. 537, 547 (1891) (stating that a business “has no right to appropriate a sign or a symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose”) (citation omitted); *Estate of P. D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 543-544 (1920) (“Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public.”); see generally *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (observing that trademark law seeks to promote, not inhibit, competition). Indeed, respondent has informed the USPTO that it “considers the use * * * of EBOOKING.COM [by one of its competitors] to be a potential infringement.” J.A. 192.⁸

The court of appeals was “not unsympathetic to the USPTO’s concerns that granting trademark protection over BOOKING.COM may prevent other companies from using the mark.” Pet. App. 24a. The court stated,

⁸ Respondent has obtained the contractual rights to thousands of other similar domain names. See J.A. 200-254. If that were not the case, federal registration of BOOKING.COM as a trademark would threaten to impede competitors’ potential use of those other domain names as well.

however, that “these concerns were assuaged by two considerations.” *Ibid.* First, the court surmised that, because “trademarks only protect the relevant service,” registration of BOOKING.COM “would not necessarily preclude another company” that does not provide hotel reservation services “from using, for example, carbooking.com or flightbooking.com.” *Ibid.*

That reasoning offers no relief to respondent’s direct competitors, including the websites cited above that *do* offer hotel bookings. “[T]here is no reason why monopolization of language should be allowed in the internet domain name context for *any* class of services when trademark law has consistently maintained that generic terms such as ‘booking’ should be available in the public linguistic commons for all competitors to use.” Pet. App. 44a (Wynn, J., concurring in part and dissenting in part). And the possibility that registration of BOOKING.COM will affect a relatively narrow set of businesses provides no justification for a general rule that “generic.com” domain names are potentially registrable as trademarks.

Second, the court of appeals suggested that “the purported overbreadth of the mark can be addressed in proceedings regarding the scope of the trademark’s protection,” such as suits for infringement. Pet. App. 24a. The court pointed out that, in order to hold another entity liable for infringing its mark, respondent must demonstrate a “likelihood of confusion.” *Ibid.* (citation omitted). The court further observed that the nature of the Internet—*i.e.*, the fact “that domain names are unique by nature and that the public may understand a domain name as indicating a single site”—may make it more difficult for respondent to make that showing if a competitor uses a domain name that is similar but not identical to BOOKING.COM. *Id.* at 24a-25a.

As explained below, those features of the Internet make registration of “generic.com” terms less, rather than more, appropriate. See pp. 31-34, *infra*. In any event, even if respondent does not ultimately prevail in a particular infringement suit, the risk and expense of such suits is likely to “chill[]” competitors “from using the term” “‘booking’” in their own domain names. Pet. App. 44a (Wynn, J., concurring in part and dissenting in part); see, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred * * * not merely by successful suit but by the plausible threat of successful suit.”); see also Am. Intell. Prop. Law Ass’n, *Report of the Economic Survey 2019*, at 53, 63 (Sept. 2019) (noting that the average estimated cost of a trademark infringement suit with more than \$25 million at risk has grown to more than \$3.5 million). Registration of “generic.com” terms thus would have at least the same anticompetitive effects as registration of “Generic Inc.” and “Generic Co.” terms.

It is also unclear what practical advantage respondent would derive from federal registration of BOOKING.COM *other than* the increased ability to exclude rivals from using similar but not identical .com names. Due to the way the domain-name system functions, respondent’s competitors already cannot use the exact domain name “BOOKING.COM.” See pp. 31-34, *infra*. And they have a substantial incentive not to use that precise term in their own promotional materials, lest potential customers who seek the competitors’ services find themselves on respondent’s website instead. See Pet. App. 83a. Registration of BOOKING.COM as a trademark thus is likely to confer meaningful practical benefits on respondent only if it impedes rivals from using similar terms (like EBOOKING.COM).

2. *The nature of the Internet further confirms that adding a top-level domain to a generic term generally will not create a protectable mark*

In determining that “a mark composed of a generic [second-level domain] and a [top-level domain] is a descriptive mark eligible for protection upon a showing of acquired distinctiveness,” the district court relied in significant part on the fact that “domain names are inherently unique.” Pet. App. 84a-85a. The court of appeals stated that it did “not address” the district court’s reliance “on BOOKING.COM’s functional role as a web address,” *id.* at 21a n.10, but it likewise gave significant weight to the fact that “domain names are unique by nature.” *Id.* at 24a; see *id.* at 16a (relying on respondent’s Teflon survey, which reflects, at least in part, the fact that only one entity can hold the contractual rights to a particular domain name at a given time). Respondent, too, has taken the position that because a domain name constitutes a “*unique* identifier,” it is “unlikely” that any domain name could “become generic.” Resp. C.A. Br. 25.

It is true that, under the domain-name system, only one entity may hold the contractual rights to a particular domain name at a given time. But that fact neither distinguishes this case from *Goodyear* nor supports a determination that BOOKING.COM is protectable as a trademark. Although no technological barrier precludes multiple firms from calling themselves “The Grain Company” or “Grain Inc.,” other sources of law could restrict competitors’ use of the sorts of names that the *Goodyear* Court discussed. This Court did not suggest, however, that a term like “Grain Inc.” could be registered as a trademark if (for example) applicable state law allowed only one firm to incorporate in the

State under that name. To the contrary, the decision in *Goodyear* was premised on this Court's recognition that "[n]ames which are thus descriptive of a class of goods cannot be exclusively appropriated by any one." 128 U.S. at 602. And distinguishing *Goodyear* based on a functional characteristic of the Internet and the domain-name system would contravene the rule that "[f]unctional features * * * cannot be the basis for trademark protection." Pet. App. 41a (Wynn, J., concurring in part and dissenting in part) (citing *America Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 822-823 (4th Cir.), cert. dismissed, 534 U.S. 946 (2001)); see, e.g., *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33-35 (2001); see also 15 U.S.C. 1052(e).

Rather than supporting the decision below, the fact that only one entity can hold the contractual rights to a domain name at a given time reinforces the conclusion that adding ".com" to a generic term generally does not create a protectable mark. That characteristic of the Internet and the domain-name system already gives respondent a substantial competitive advantage. Consumers who are looking for online hotel reservation booking services, but who are not familiar with any specific purveyor of such services, may search for the word "booking" in a search engine and be directed to respondent's site, or may proceed directly to "booking.com" in the expectation that such services will be offered at that address. See Aron Meystedt, *What is My URL Worth? – Placing A Value on Premium Domain Names*, 19 Valuation Strategies 10, 12 (Nov./Dec. 2015) (noting advantages of "category-defining" domain names, including "[t]he ability to rank higher on search engines with proper development," and "[t]he ability to use existing type-in traffic to generate additional sales"); accord

Pet. App. 28a (Wynn, J., concurring in part and dissenting in part).

There is no sound reason to treat the advantages conferred by the domain-name registration system as a justification for granting *additional* benefits under federal trademark law. Rather, as a matter of trademark law and policy, an “online business” should be given “two options in choosing its domain name.” Pet. App. 28a (Wynn, J., concurring in part and dissenting in part). It can “choose to operate under a generic domain that describes the nature of the services it offers, and thereby” obtain the benefits just discussed. *Ibid.* (footnote omitted). But if it elects those benefits, the business “accepts a tradeoff”: it must give up “the ability to exclude competitors from using close variants of its domain name.” *Ibid.*

Alternatively, a business may obtain the benefits of federal trademark registration by “choos[ing] to operate under a non-generic domain name” like Amazon.com. Pet. App. 28a (Wynn, J., concurring in part and dissenting in part). But by using a domain name that has no inherent or intuitive connection to the goods or services the company provides, the registrant will “potentially limit, at least before it has built customer awareness of its branding, the universe of potential customers who will find its business.” *Ibid.* Allowing a business to obtain *both* the easier customer access that a generic.com domain provides, *and* the exclusionary rights that federal trademark registration entails, would permit the “monopolization of language” that established trademark principles are meant to discourage. *Id.* at 38a; see, e.g., *Hotels.com*, 573 F.3d at 1304, 1306 (denial of registration of “HOTELS.COM” respects the “competitive need for others to use as part of their own domain

names and trademarks, the term that applicant is attempting to register”) (citation omitted); *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975) (Friendly, J.) (permitting generic terms to be registered as trademarks “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are”); cf. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (noting the “undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first”).

3. Respondent has ample protection against unfair competition even without federal trademark registration of BOOKING.COM

Respondent previously has argued that trademark protection is necessary to protect its investment in the name BOOKING.COM and the accompanying domain name. See Br. in Opp. 36-40. As discussed below, see pp. 40-44, *infra*, however, a generic term is not entitled to trademark protection “no matter how much money and effort the user of a generic term has poured into promoting” it. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.). And any claim of unfair surprise would be especially unavailing here because respondent first used the specific domain name BOOKING.COM in January 2005, D. Ct. Doc. No. 61-1, at PTO-00022 (Dec. 9, 2016), after both the USPTO and the Federal Circuit had determined that the addition of a top-level domain like “.com” to a generic term generally will not create a protectable mark. See pp. 22-24, *supra*.

Contrary to respondent’s argument, moreover, other rules of law protect respondent from third parties’ at-

tempts “to trade on” its reputation or “mislead consumers.” Br. in Opp. 38. Independent of federal trademark registration, unfair-competition law prohibits third parties from passing off their goods or services as respondent’s. “While a mark ‘may be generic and not entitled to trademark protection, [a] claim of unfair competition is not foreclosed.’” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 149 (2d Cir. 1997) (quoting *The Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 102 (2d Cir. 1989)) (brackets in original). Liability still may lie if a third party “engage[s] in false advertising or passing off concerning a generic term.” 2 *McCarthy* § 12:2, at 12-18 (5th ed. 2019); see, e.g., *The Murphy Door Bed Co.*, 874 F.2d at 101 (holding that, although the term “Murphy bed” had become generic, and thus not protectable as a trademark, the defendant “did engage in unfair competition * * * by passing off products of his own manufacture as Murphy Co. products”); *Genesee Brewing Co.*, 124 F.3d at 150 (discussing elements of an unfair-competition claim premised on misleading use of a generic term).

Respondent also remains free to register as trademarks stylized elements of its brand identity that distinguish it from its competitors. Indeed, “the examiner and the TTAB both found that the stylized elements of [respondent’s] mark”—“a stylized depiction of the earth behind a briefcase”—“were registrable if [respondent] disclaimed the word mark” BOOKING.COM. Pet. App. 107a n.22 (citation omitted). Respondent thus can invoke substantial protections against unfair competition, even if trademark registration is unavailable for a “generic.com” term.

C. Respondent’s Teflon Survey Does Not Provide A Sound Basis For Treating BOOKING.COM As A Registrable Trademark

Despite the similarities between “Generic Inc.” and “generic.com” terms, and the trademark-policy considerations that weigh against federal registration of either type of mark, the court of appeals viewed respondent’s Teflon survey as substantially supporting federal registration of BOOKING.COM. See Pet. App. 13a-18a. That survey purported to “demonstrate[] that 74.8% of respondents identified BOOKING.COM as a brand name, rather than as a general reference to hotel reservation websites.” *Id.* at 16a. The court of appeals also noted with approval the district court’s related finding that consumers do not use the term “booking.com” to refer to online booking services as a class. See *id.* at 15a.

The court of appeals’ reliance on such evidence contravenes *Goodyear*. It also runs afoul of the longstanding principle that “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, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9. Respondent’s survey evidence thus does not support treating BOOKING.COM as eligible for federal trademark registration.

1. Respondent’s survey evidence is irrelevant under Goodyear

The court of appeals observed (Pet. App. 19a) that this Court’s decision in *Goodyear* did not reference the “primary significance” test, which the Court articulated 50 years later in *Kellogg Co. v. National Biscuit Co.*,

305 U.S. 111 (1938). There, the National Biscuit Company held a patent on “Shredded Wheat.” After the patent expired, the National Biscuit Company alleged that the Kellogg Company had engaged in unfair competition by selling a similar product under the same name. *Id.* at 113-115, 117-118. This Court acknowledged that, “due to the long period in which the plaintiff or its predecessor was the only manufacturer of [‘Shredded Wheat’], many people ha[d] come to associate the product, and as a consequence the name by which the product [wa]s generally known, with the plaintiff’s factory.” *Id.* at 118. But the Court found that “subordinate meaning” insufficient to establish that the plaintiff had a protectable “trade name in the term ‘shredded wheat.’” *Ibid.* Rather, the plaintiff was required to “show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Ibid.* In the Lanham Act, Congress subsequently directed that, for purposes of deciding whether an existing trademark registration should be cancelled, “[t]he primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether [a] 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).

Within the Lanham Act, the “primary significance” test appears in a section entitled “Cancellation of registration,” which addresses the circumstances under which an existing trademark registration may be cancelled. 15 U.S.C. 1064 (emphasis omitted); see Pet. App. 10a n.6. In directing that the inquiry should focus on “[t]he primary significance of the registered mark to the relevant public *rather than* purchaser motivation,” 15 U.S.C. 1064(3) (emphasis added), Section 1064(3)

specifies the precise empirical judgment that should be made in circumstances where continued registrability turns on consumer understandings. Section 1064 does not displace the *Goodyear* Court's holding that "Generic Company" or "Generic Inc." terms are ineligible for trademark protection *as a matter of law*, regardless of the extent to which consumers have come to associate a particular term with a specific producer, because conferral of such protection would trench unduly upon competitors' ability to market their own goods or services. See 128 U.S. at 602-603. Lower courts have recognized that the "primary significance" test "is of limited usefulness when the operative question is whether a * * * product name, even if it does tend to indicate the producer or source of the product, *must nonetheless* be considered" generic because treating the term as eligible for trademark protection would "substantially disadvantage competitors by preventing them from describing the nature of their goods." *Genesee Brewing Co.*, 124 F.3d at 144 (quoting *A.J. Canfield Co.*, 808 F.2d at 305).

The *Goodyear* Court's failure to reference the "primary significance" test therefore does not diminish the import of that decision. To the contrary, *Goodyear* makes clear that, as a matter of law, simply appending a designation like "Co." or "Inc." to an undisputedly generic term cannot make the combination non-generic, "for the obvious reason that all persons have a right to deal in" the generic item "and to publish the fact to the world." 128 U.S. at 603. Any uncertainty as to whether consumers would understand the combination to refer to a specific business was simply irrelevant to the Court's reasoning.

Indeed, both the plaintiff and the defendants in *Goodyear* presented evidence that the public associated

the term “Goodyear Rubber Company,” or some variant thereof, with their particular business. The plaintiff alleged that, through continual use on “signs at its various places of business and factories; on its bill and letter heads; on its various articles of manufacture; and on its corporate seal in contracts and other business transactions[,]” the name had acquired an “inseparable connection with the business and good-will of [its] company” and therefore “ha[d] become of great value.” *Goodyear*, 128 U.S. at 599. The defendants similarly alleged that their business “ha[d] been for upwards of twenty years the most prominent corporation or association in the city of New York engaged in the manufacture of those goods, and ha[d] become known to the trade” by similar names. *Id.* at 601; see Appellants Br. at 15-25, *Goodyear*, *supra* (No. 49) (cataloging use of the term “by the public and the trade” to refer to the defendants’ business).

This Court determined that the evidence “show[ed] very clearly that [one of the defendants] had, as alleged in its answer, been for many years in the use of abbreviations in the designation of its company, using sometimes a name similar to the corporate name of the plaintiff.” *Goodyear*, 128 U.S. at 602. Thus, “if any exclusive right to the abbreviated name were to follow from its protracted use, that right would seem to belong to that company.” *Ibid.* The Court held, however, that the evidence of consumer recognition was irrelevant because, as a matter of law, the name “‘Goodyear Rubber Company’ is not one capable of exclusive appropriation.” *Ibid.* The Court explained that “[n]ames of * * * articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article

of commerce, without other specification, create any exclusive right to the use of the name.” *Goodyear*, 128 U.S. at 603. Although the *Goodyear* Court had no consumer survey before it, such a survey would have served the same purpose as the evidence the Court found irrelevant.

The functional attributes of the domain-name system—and, in particular, the fact that only one entity may hold the contractual rights to a particular domain name at any given time—further reduce the probative value of respondent’s survey evidence. A consumer who is familiar with that aspect of the domain-name system can infer that BOOKING.COM refers to *some* specific entity, even if he has no prior awareness of the particular company involved. See Pet. App. 84a (district court noting that “consumers are primed to perceive a domain name as a brand”). Respondent’s survey evidence necessarily reflects, at least in part, that general consumer awareness of the way in which the Internet operates. But “BOOKING.COM’s functional role as a web address,” *id.* at 21a n.10, cannot support a determination that BOOKING.COM is protectable as a trademark. See pp. 31-32, *supra*. Just as survey evidence could not transform “Grain Inc.” into a protectable trademark, it cannot render a “generic.com” term eligible for federal trademark registration.

2. *Reliance on respondent’s survey evidence conflates generic and descriptive terms*

The *Goodyear* Court’s rejection of evidence of consumer understanding is consistent with the bedrock distinction between generic terms, which are not eligible for trademark protection even upon a showing of secondary meaning, and descriptive terms, which are po-

tentially registrable if secondary meaning is established. See 15 U.S.C. 1052(f); see, *e.g.*, *Abercrombie & Fitch Co.*, 537 F.2d at 9. That distinction ensures that trademark law does not enable the monopolization of terms that should be free for all to use. See, *e.g.*, *CES Publ'g Corp.*, 531 F.2d at 13 (“To allow trademark protection for generic terms * * * even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”).

Thus, even complete “success * * * in securing public identification” between a generic term and a specific producer “cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9. That is because “[g]eneric terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.” *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1558 (Fed. Cir. 1985) (brackets in original); see also, *e.g.*, *Royal Crown Co. v. The Coca-Cola Co.*, 892 F.3d 1358, 1370 (Fed. Cir. 2018); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999); *A.J. Canfield Co.*, 808 F.2d at 297; *Technical Publ'g Co. v. Lebhan-Friedman, Inc.*, 729 F.2d 1136, 1139 (7th Cir. 1984); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 7-8 & n.2 (1st Cir. 1981) (collecting authority); *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979), cert. denied, 444 U.S. 1102 (1980). “[E]vidence that a generic term is identified with one producer, indicative of a secondary meaning for a descriptive term, proves only what courts call ‘de facto’ secondary meaning” with respect to a generic term, which cannot render the term “protectable.” *A.J. Canfield Co.*, 808 F.2d at 297.

In keeping with that principle, the courts of appeals have declined to rely on survey evidence purporting to show that consumers associate a particular generic term with a specific producer. See, e.g., *Miller Brewing Co.*, 605 F.2d at 995 (rejecting survey showing that consumers associated the term “light” beer with Miller Brewing Company, because such evidence “would not advance Miller’s trademark claim”); *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 976 (8th Cir. 2006) (“Survey evidence, then, could show only that consumers had come to associate the term [Brick Oven] with the plaintiffs['] product and could not show that a generic term had become protectible.”); *Northland Aluminum Prods., Inc.*, 777 F.2d at 1560 (holding that, because BUNDT “is a common descriptive name” for a particular type of cake, survey showing that 75-84% of relevant consumers associated the term with the applicant’s brand “can not change the result”); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847-848 (C.C.P.A. 1961) (examiner erred in accepting secondary-meaning evidence for a generic term because, “no matter what the market situation may have been as to indication of origin or secondary meaning, the common descriptive name of the product cannot become a trademark owned exclusively by one vendor”); see also *In re Analog Devices*, 10 U.S.P.Q.2d (BNA) 1879, 1879 (Fed. Cir. 1989) (Evidence of “associat[ion]” between business and “generic” term “does not, indeed cannot, rebut genericness.”) (citation and emphasis omitted).

A Teflon survey may be used to establish that a descriptive term has acquired secondary meaning, thereby warranting trademark registration. See, e.g., *March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 803 (N.D. Tex. 2003), *aff’d*, 120 Fed.

Appx. 540 (5th Cir. 2005) (finding, based in part on Teflon survey, that “March madness has acquired secondary meaning in the mind of the public”) (citation omitted). A Teflon survey also can establish whether a “coined” term—like Teflon or Google—has become generic through widespread use. See *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 523 (E.D.N.Y. 1975); *Elliott v. Google, Inc.*, 860 F.3d 1151, 1160 (9th Cir.), cert. denied, 138 S. Ct. 362 (2017); cf. *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 255 (4th Cir. 2001) (rejecting survey evidence regarding consumers’ understanding of the term “crab house” because the case did not “involv[e] a coined word for a commercial product * * * that is alleged to have become generic through common usage”). But while survey evidence may be useful in a variety of contexts, it cannot turn a “generic.com” domain name into a protectable trademark—just as it could not render “Grain Inc.” eligible for trademark registration.

In concluding that BOOKING.COM is descriptive, the courts below also relied in part on “the absence of evidence indicating that the consuming public uses the term BOOKING.COM to refer to a class of services.” Pet. App. 86a (district court); see *id.* at 15a (referring with approval to district court’s finding that consumers do not use the term “booking.com” to refer to online booking services as a class). It is true that, in the usual case where a purported trademark is alleged to be generic, the determination whether the mark is protectable depends on whether consumers understand it as the common name of a class of products or services. The government has not contended that BOOKING.COM is generic in the sense that consumers use that term to refer to Internet booking sites generally. Instead, the government has argued that BOOKING.COM is generic

because consumers would understand the term to convey solely that respondent provides online booking services, and the term conveys no additional meaning that would distinguish respondent's services from those of other providers. Under *Goodyear*, the term "Grain Inc." is not protectable as a trademark, even though consumers do not use the term "Grain Incs." to refer to incorporated grain merchants as a class, and even though consumers could understand it to refer to a specific company. *Goodyear* also makes clear that the term "Grain Company" is generic and therefore unprotectable even if consumers in a given market have come to associate it with a particular source.

Respondent and the court of appeals therefore are wrong in suggesting (Pet. App. 21a & n.11; Br. in Opp. 33-34) that respondent's survey was instructive because the term BOOKING.COM had not *already* been held generic and was not "previously commonly used." In fact, the term "booking.com" had previously been used within other businesses' longer domain names. See pp. 27-28, *supra*. And even if no such prior usages existed, neither *Goodyear* nor general trademark-law principles permit a business to obtain a monopoly on a generic term simply by being its first adopter. Accordingly, just as consumer survey evidence showing that the public associated "Grain Inc." with the first entity to use that name in a particular market could not make the term a registrable trademark, respondent's survey evidence regarding BOOKING.COM cannot establish that the term is eligible for federal trademark registration.

CONCLUSION

The judgment of the court of appeals should be reversed.
Respectfully submitted.

SARAH T. HARRIS
General Counsel
THOMAS W. KRAUSE
Solicitor
CHRISTINA J. HIEBER
Senior Counsel
MOLLY R. SILFEN
Associate Solicitor
United States Patent and
Trademark Office

NOEL J. FRANCISCO
Solicitor General
Counsel of Record
JOSEPH H. HUNT
Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
ERICA L. ROSS
Assistant to the Solicitor
General
MARK R. FREEMAN
DANIEL TENNY
WEILI J. SHAW
Attorneys

JANUARY 2020

APPENDIX

1. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark

(1a)

in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall¹ specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and

¹ So in original. The word “shall” probably should not appear.

Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The

Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be pub-

lished in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) **Designation of resident for service of process and notices**

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

2. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be

refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines

that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except

as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

3. 15 U.S.C. 1064 provides:

Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered,

a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. 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.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant

from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

4. 15 U.S.C. 1071 provides:

Appeal to courts

(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 of this title or section 1141k of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant

shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an *ex parte* case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under

section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

5. 15 U.S.C. 1091 provides:

Supplemental register

(a) Marks registerable

In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled “An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes”, to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

6. 15 U.S.C. 1127 provides:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word “commerce” means all commerce which may lawfully be regulated by Congress.

The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

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.

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other

distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term “collective mark” means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made

merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission,

causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

The term “Act of March 3, 1881”, “Act of February 20, 1905”, or “Act of March 19, 1920”, means the respective Act as amended.

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

The term “domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

The term “Internet” has the meaning given that term in section 230(f)(1) of title 47.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the

deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.