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# Trademark Guidance Supports U.S. Supreme Court's Booking.com Ruling For Domain Name Trademark Registration

Intellectual Property

Litigation

The US Patent and Trademark Office issued Examination Guide 3-20 on Oct. 28 to clarify procedures that trademark examiners should follow in view of the U.S. Supreme Court's June 2020 ruling. [As we discussed in a previous article](#), the ruling stated that Booking.com was not a generic term and is entitled to protection under trademark laws. In its guidance, the USPTO stated, "the examining attorney must not initially refuse registration of a generic.com term on the Principal Register as generic, even if there is strong evidence of genericness." Further, the guidance acknowledged that survey evidence may be analyzed to determine that consumers recognize the generic.com term as a source identifier.

The question at issue in [Patent and Trademark Office v. Booking.com B.V.](#) was whether or not adding .com to a generic word like Booking can render the resulting combination of terms registerable as a trademark. In finding Booking.com non-generic, the court avoided an iron clad ruling that whenever .com is added to a generic term it becomes trademarkable. The court, ruled however, that due to the specific evidence in the Booking.com case, the trademark owner had proven a non-generic mark.

The new guidance issued by the USPTO, has enhanced the value of top level domain names (TLD). The guidance affirmed that a generic.com term that has some consumer recognition as being the identifier of the source of a particular good or service will be worthy of a trademark. As a result of the U.S. Supreme Court ruling and the guidance, it will be important to view genericness in light of how consumers perceive the generic.com term. A generic.com term might convey to consumers a source-identifying characteristic (e.g. an association with a particular website). Because only one entity can occupy a particular Internet domain name at a time, a consumer who is familiar with that aspect of the domain-name system can infer that such a generic.com term refer to *some* specific entity.

As a result, owners of generic.com, generic.net, generic.org, generic.biz, generic.edu or generic.info domain names should apply for federal trademark registrations for the entire TLD. The Booking.com ruling and USPTO guidance has opened the door for registration of such domain names.

If you do submit a generic.com registration, you may wish to have survey evidence in hand to prove non-genericness of your mark. The court held that the relevant meaning of a term is its meaning to consumers. "Evidence informing that (non-generic) inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning. Surveys can be helpful evidence of consumer perception but require care in their design and interpretation."

The guidance also provided examples of the types of evidence that could be used to show that consumers would perceive a generic.com term as a source identifier including:

1. A combination of dictionary excerpts defining the component elements of the generic.com term;
2. Significant evidence of usage of those elements or the combined term by consumers or competitors in the relevant marketplace;
3. Evidence of the "generic.com" term used by third parties as part of their domain names; or
4. Evidence of the applicant's own use of the generic.com term.

Each of items 2-4, above can be shown via survey evidence, declarations and advertising expenditures, yet the guidance warned that, "information regarding how the survey was conducted, the questionnaire itself, the universe of consumers surveyed, the number of participants surveyed, and the geographic scope of the survey should be submitted within or along with such a report."

The Booking.com ruling and the guidance demonstrate how the internet and new technology are indelibly affecting business and the law.