

## Examination Guide 3-20

### Generic.com Terms after *USPTO v. Booking.com*

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#### I. Introduction

On June 30, 2020, the U.S. Supreme Court decided *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729 (2020) (*Booking.com*), rejecting a rule that a proposed mark consisting of the combination of a generic term and a generic top-level domain, like “.com,” is automatically generic. In view of the Court’s decision, this examination guide addresses the procedures for examining applications for these “generic.com terms.” This guidance supersedes any previous United States Patent and Trademark Office (USPTO) guidance on this topic to the extent there are any conflicts.

#### II. Overview of *Booking.com*

*Booking.com* arose from the USPTO’s refusal to register the proposed mark BOOKING.COM on the ground that it is generic as applied to the identified hotel reservation services, or, in the alternative, that it is merely descriptive and has not acquired distinctiveness. The Trademark Trial and Appeal Board affirmed both refusals, but appeals at the district and circuit court levels were resolved in favor of the applicant, who had argued that the evidence of record, including new evidence introduced in the district court proceeding, established that consumers perceive the term as a source indicator, rather than as a class of online reservation services, and that the term had acquired distinctiveness in the minds of consumers.

While the lower-court decisions considered whether the evidence of record established that BOOKING.COM was generic, the Supreme Court’s opinion in *Booking.com* focused on the question of whether the USPTO may employ a *per se* rule that a generic term combined with a generic top-level domain, such as “.com,” results in a combination that is necessarily generic.<sup>1</sup> The Court rejected such a *per se* rule, holding that “[w]hether any given ‘generic.com’ term is generic ... depends on whether consumers in fact perceive that term

as the name of a class or, instead, as a term capable of distinguishing among members of the class.”<sup>2</sup> In reaching its decision, the Court left undisturbed the circuit court’s finding that “.com does not itself have source-identifying significance when added to a [second-level domain] like booking.”<sup>3</sup>

Therefore, under *Booking.com*, a proposed mark composed of a generic term combined with a generic top-level domain, such as “.com,” is not automatically generic, nor is it automatically non-generic.<sup>4</sup> Instead, as in any other genericness analysis, examining attorneys must evaluate all of the available evidence, including the applicant’s evidence of consumer perception, to determine whether the relevant consumers perceive the term as generic for the identified class of goods and/or services or, instead, as capable of serving as a mark.<sup>5</sup>

Accordingly, generic.com terms are potentially capable of serving as a mark and may be eligible for registration on the Supplemental Register, or on the Principal Register upon a sufficient showing of acquired distinctiveness. However, a generic.com term may still be refused as generic when warranted by the evidence in the application record.

### **III. Examination of Generic.com Terms**

*Booking.com* rejected a *per se* rule that generic.com terms are automatically generic but did not otherwise significantly alter the genericness analysis to be applied to generic.com terms or the USPTO’s examination procedures regarding these terms. The following guidance pertains to any applied-for mark consisting of a generic.com term, that is, any combination of a generic term and generic top-level domain designating an entity or information, such as “.com,” “.net,” “.org,” “.biz,” or “.info.”

#### **A. Genericness Analysis and Relevant Evidence**

In *Booking.com*, the Supreme Court also specifically declined to adopt a rule that these terms are automatically non-generic.<sup>6</sup> Thus, examining attorneys must continue to assess on a case-by-case basis whether, based on the evidence of record, consumers would perceive a generic.com term as the name of a class of goods and/or services or, instead, as at least capable of serving as a source indicator.

To establish that a generic.com term is generic and incapable of serving as a source indicator, the examining attorney must show that the relevant consumers would understand the primary significance of the term, as a whole, to be the name of the class or category of the goods and/or services identified in the application.<sup>7</sup> Generally, evidence showing generic use of the generic.com term in its entirety, including evidence of domain names containing the term for third-party websites offering the same types of goods or services, is a competent source of the consumers’ understanding that will support a finding of genericness.<sup>8</sup> However, even in the absence of such evidence, a genericness refusal may be appropriate if the evidence of record otherwise establishes that the combination of the generic elements of the proposed mark “yields no additional meaning to consumers capable of distinguishing the goods or services.”<sup>9</sup>

Evidence of consumer perception may include “dictionaries, usage by consumers and competitors, use in the trade, and any other source of evidence bearing on how consumers perceive a term’s meaning,” including relevant and probative consumer surveys.<sup>10</sup> These are the same types of evidence examining attorneys traditionally consider when assessing genericness.<sup>11</sup>

The following are examples of the types of evidence that may support the conclusion that consumers would perceive the generic.com term, as a whole, as the name of the class of goods and/or services:

- a combination of dictionary excerpts defining the component elements of the generic.com term;
- significant evidence of generic usage of those elements or the combined term by consumers or competitors in the relevant marketplace;
- evidence of the “generic.com” term used by third parties as part of their domain names (e.g., “[adjective]generic.com”) in connection with the same or similar goods and/or services<sup>12</sup>; or
- evidence of the applicant’s own use of the generic.com term.

When issuing a genericness refusal, the examining attorney must explain how the evidence of record supports the conclusion not only that the individual elements of the generic.com term are generic, but also that, when combined, the combination creates no new or additional significance among consumers capable of indicating source.<sup>13</sup>

## **B. Procedures for Refusals**

Consistent with existing examination procedures, 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.<sup>14</sup> Instead, the examining attorney must refuse the proposed mark as merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and provide relevant supporting evidence.<sup>15</sup> If the evidence strongly suggests that the generic.com term is not capable of serving as a source indicator, the refusal must include an advisory that a claim of acquired distinctiveness or an amendment to the Supplemental Register is not recommended.<sup>16</sup> If, on the other hand, the examining attorney determines that the generic.com term is at least capable of serving as a source indicator based on the available evidence, then the examining attorney may advise that the applicant may amend the application to the Supplemental Register.<sup>17</sup> If the record creates doubt as to whether the applied-for generic.com term is capable of functioning as a mark, the examining attorney must refrain from giving any advisory statement.<sup>18</sup>

If the initial application seeks registration on the Supplemental Register or on the Principal Register under a claim of acquired distinctiveness, and there is strong evidence of genericness, then a refusal on the basis that the generic.com term is generic will be appropriate.

### **1. Claim of Acquired Distinctiveness**

If the application itself or a subsequent submission includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), the examining attorney must carefully review the applicant’s evidence in support of the claim, along with all other available evidence, to determine whether the relevant consumers have, in fact, come to view the proposed generic.com term as an indicator of source for the identified goods and/or services.<sup>19</sup>

Under *Booking.com*, generic.com terms are neither *per se* generic, nor *per se* non-generic.<sup>20</sup> However, given the nature of these terms, the available evidence will likely support a conclusion that they are, at least, highly descriptive, and thus consumers would be less likely to believe that they indicate source in any party. Thus, for generic.com terms, applicants will generally have a greater evidentiary burden to establish that the proposed mark has acquired distinctiveness.<sup>21</sup>

Accordingly, evidence of five years' use or reliance solely on a prior registration for the same term will usually be insufficient to support a Section 2(f) claim for a generic.com term.<sup>22</sup> Typically, the applicant will need to provide a significant amount of actual evidence that the generic.com term has acquired distinctiveness in the minds of consumers.<sup>23</sup>

Evidence submitted in support of the Section 2(f) claim may include consumer surveys; consumer declarations; declarations or other relevant and probative evidence showing the duration, extent, and nature of the applicant's use of the proposed mark, including the degree of exclusivity of use; related advertising expenditures; letters or statements from the trade or public; and any other appropriate evidence tending to show that the proposed mark distinguishes the goods or services to consumers.<sup>24</sup>

Regarding consumer surveys, in particular, the Supreme Court cautioned that they must be properly designed and interpreted to ensure that they are an accurate and reliable representation of consumer perception of a proposed mark.<sup>25</sup> Therefore, an applicant submitting a survey must carefully frame its questions and provide a report, typically from a survey expert, documenting the procedural aspects of the survey and statistical accuracy of the results.<sup>26</sup> 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.<sup>27</sup> If this information is not provided, the examining attorney may request it under 37 C.F.R. §2.61(b).

If the examining attorney determines that the evidence of record establishes that the generic.com term is, in fact, a generic name for the identified goods and/or services, the examining attorney must refuse registration on the ground that the term is generic and indicate that the claim of acquired distinctiveness does not overcome the refusal.<sup>28</sup> The statutory basis for this refusal is Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, for goods, or Sections 1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, for services. In addition to this refusal, the examining attorney must issue or maintain, in the alternative, a refusal under Trademark Act Section 2(e)(1) on the ground that the proposed mark is merely descriptive.<sup>29</sup> This refusal must separately explain why the showing of acquired distinctiveness is insufficient to overcome the descriptiveness refusal even if the proposed mark is ultimately deemed not to be generic.<sup>30</sup>

## **2. Supplemental Register**

If the application itself or a subsequent submission requests registration on the Supplemental Register, and the evidence supports a determination that the proposed generic.com term is generic, registration must be refused under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127.<sup>31</sup>

If the examining attorney determines that the available evidence establishes that the proposed generic.com term is at least capable of indicating source but is insufficient to show that the term has acquired distinctiveness, the examining attorney may allow registration on the Supplemental Register, if otherwise appropriate.<sup>32</sup>

## **C. Generic.com Terms Combined with Other Matter**

Examining attorneys must follow existing disclaimer policy and procedure when examining proposed marks containing generic.com terms and other matter.<sup>33</sup> If the examining attorney determines that, based on the evidence, the generic.com term is incapable of serving as a source indicator and is separable from the other matter in the proposed mark,

a disclaimer of the term is appropriate, whether registration is sought on the Principal Register or Supplemental Register.<sup>34</sup> Generally, when disclaiming a generic.com term, the term must be disclaimed in its entirety, rather than disclaiming the generic term and the generic top-level domain separately.<sup>35</sup>

If an applicant claims acquired distinctiveness in part as to a generic.com term that is combined with other matter, the evidence of acquired distinctiveness should be evaluated in accordance with [section II.B.1](#) above.

#### **D. Failure to Function**

Examining attorneys must also consider whether the specimen of use shows the generic.com term being used solely as a website address and not in a trademark or service mark manner. If so, a refusal on the ground that the proposed mark fails to function as a trademark or service mark is appropriate.<sup>36</sup> The statutory basis for this refusal is Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, for goods, or Sections 1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, for services. The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a mark is Sections 23(c) and 45 of the Trademark Act, 15 U.S.C. §§1091(c), 1127.

#### **E. Section 2(d) Considerations**

In *Booking.com*, the Supreme Court recognized that registered generic.com terms may be subject to a narrower scope of trademark protection, noting that “[w]hen a mark incorporates generic or highly descriptive components, consumers are less likely to think that other uses of the common element emanate from the mark’s owner.”<sup>37</sup>

Accordingly, examining attorneys may take this into account when considering whether a prior registration for a generic.com term that contains the same generic or highly descriptive terms that appear in a proposed mark should be cited under Trademark Act Section 2(d). Generally, in these circumstances, if there is other matter in either of the marks that would allow consumers to differentiate them, the examining attorney may reasonably determine that confusion as to source is not likely.<sup>38</sup> However, each case must be considered on its own merits, with consideration given to all relevant likelihood-of-confusion factors for which there is evidence of record.<sup>39</sup>

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<sup>1</sup> See *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2301, 2020 USPQ2d 10729, at \*2 (2020).

<sup>2</sup> *Id.* at 2307, 2020 USPQ2d 10729, at \*7.

<sup>3</sup> *Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff’d*, *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2301, 2020 USPQ2d 10729, at \*2 (2020)

<sup>4</sup> See *Booking.com*, 140 S. Ct. at 2307, 2020 USPQ2d 10729, at \*7.

<sup>5</sup> See *id.*

<sup>6</sup> See *id.*

<sup>7</sup> See *id.* at 2304, 2020 USPQ2d 10729, at \*5; *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *Trademark Manual of Examining Procedure* (TMEP) §1209.01(c)(i).

<sup>8</sup> See *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 968, 114 USPQ2d 1827, 1832 (Fed. Cir. 2015); TMEP §1209.01(c)(i); see also *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535-36 (Fed. Cir. 2009) (evidence of similar usages of “hotels.com” in domain names of others providing hotel information and reservation services supported a prima facie case of genericness); *In re Reed Elsevier Props.*, 482 F.3d 1376, 1379-80, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007) (evidence of eight websites containing “lawyer.com” or “lawyers.com” in the domain name constituted substantial evidence to support the Trademark Trial and Appeal Board’s (TTAB) finding that “LAWYERS.COM” is generic for the service of providing an online interactive database featuring information exchange in the field of law, legal news, and legal services).

<sup>9</sup> See *Booking.com*, 140 S. Ct. at 2306, 2020 USPQ2d 10729, at \*7; see also TMEP §1209.01(c)(i).

<sup>10</sup> *Booking.com*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at \*7 n.6.

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- <sup>11</sup> See, e.g., *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) (“Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.”).
- <sup>12</sup> See *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (affirming the TTAB’s finding that HOTELS.COM is generic for “providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network,” based on various definitions of “hotel,” printouts from hotel reservation search websites showing “hotels” as the equivalent of or included within “temporary lodging,” and evidence from the applicant’s website); TMEP § 1209.01(c)(i).
- <sup>13</sup> See *In re 1800Mattress.com IP*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2001) (affirming the TTAB’s conclusion that MATTRESS.COM is generic for “online retail store services in the field of mattresses, beds, and bedding,” where the TTAB considered each of the constituent words, “mattress” and “.com,” and determined that they were both generic, and then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term “mattress.com” in the website addresses of several online mattress retailers who provide the same services as the applicant); *In re Hotels.com, L.P.*, 573 F.3d at 1306, 91 USPQ2d at 1537; TMEP §1209.01(c)(i).
- <sup>14</sup> See TMEP §1209.02(a).
- <sup>15</sup> See *id.*
- <sup>16</sup> See *id.*
- <sup>17</sup> See TMEP §816.04.
- <sup>18</sup> See TMEP §1209.02(a).
- <sup>19</sup> See generally TMEP §§1212.01-1212.02.
- <sup>20</sup> See *Booking.com*, 140 S. Ct. at 2307, 2020 USPQ2d 10729, at \*7.
- <sup>21</sup> See *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018); *In re Nat’l Ass’n of Veterinary Technicians in Am.*, 2019 USPQ2d 269108, at \*6 (TTAB 2019); *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at \*9 (TTAB 2019); see also TMEP §1212.01.
- <sup>22</sup> See TMEP §§1212.04-1212.04(a), 1212.05(a).
- <sup>23</sup> See TMEP §§1212.06-1212.06(e)(vi).
- <sup>24</sup> See 37 C.F.R. §2.41; TMEP §§1212.06-1212.06(e)(vi).
- <sup>25</sup> See *Booking.com*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at \*7 n.6.; *accord id.* at 2309, 2020 USPQ2d 10729, at \*9 (Sotomayor, J., concurring) (“Flaws in a specific survey design, or weaknesses inherent in consumer surveys generally, may limit the probative value of surveys in determining whether a particular mark is descriptive or generic in this context.”).
- <sup>26</sup> See TMEP §1212.06(d).
- <sup>27</sup> See *id.*
- <sup>28</sup> See TMEP §§1209.02(a)(ii), 1209.02(b).
- <sup>29</sup> See *id.*
- <sup>30</sup> See *id.*
- <sup>31</sup> See TMEP §1209.02(a)(i).
- <sup>32</sup> See TMEP §§815-815.02.
- <sup>33</sup> See generally TMEP §§1213-1213.11.
- <sup>34</sup> See TMEP §1213.03(b).
- <sup>35</sup> See TMEP §1213.08(b).
- <sup>36</sup> See TMEP §1202.
- <sup>37</sup> *Booking.com*, 140 S. Ct. at 2307, 2020 USPQ2d 10729, at \*7.
- <sup>38</sup> Cf. TMEP §1207.01(d)(iii) (“[A]ctive third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services.”).
- <sup>39</sup> See TMEP §1207.01.