

July 1, 2020

**Maybe “.com” Can Add Distinctiveness to Your Trademark:  
Supreme Court Holds “Booking.com” is Registrable as a Trademark**

If you have discussed trademark law with us, you have probably been told that you cannot have trademark rights in words that are generic to the goods or services you provide. If you sell wine, you will not have trademark rights in the term “wine”. Everyone has the right to say what they sell. But following a recent Supreme Court holding, you might be able to acquire trademark rights in a generic word if your use of a top-level domain like “.com” actually serves as a distinguishing identifier with your generic word.

Booking.com, as you probably know, provides online booking services. The U.S. Patent and Trademark Office (USPTO) had rejected its trademark registration application for “Booking.com” as “generic,” taking the position in subsequent appeals that, like “company” or “LLC”, the top-level domain “.com” does not add distinctiveness to an otherwise generic word such as “booking” for identifying booking services. On June 30<sup>th</sup>, the U.S. Supreme Court rejected the USPTO’s position and held that “.com” can be distinctive enough to act as a trademark where, as in this case, Booking.com had supplied evidence that consumers understood “Booking.com” to identify it as a particular source of services rather than as a class of services as a whole. Consumers knew that “Booking.com” was a particular business at a particular website, and that its competitor Travelocity was not “Booking.com”.

We take this opportunity to clarify these important principles for your own branding. A “generic” term is descriptive of a class of goods or services as a whole, such as “wine” for the sale of wine or “haircuts” for providing haircuts. A generic term is not distinctive enough to act as a trademark. A “descriptive” term, for example “First National Bank” for banking, immediately conveys a feature, quality or characteristic of the trademark user’s goods and services. A descriptive term can acquire distinctiveness to be enforceable as a trademark and even be registrable on the USPTO’s “supplemental” register, but such is not ideal. If you are in the process of branding, we always recommend staying out of the legal mess of generic or descriptive terms used as your branding. The strongest trademarks are words that are arbitrary in relation to the goods and services you provide, for example, Firestone for the sale of tires (“fire” and “stone” have nothing to do with tires), or marks that are “suggestive” of your goods and services, for example “Dairy Queen” for the sale of ice cream.

In light of the Supreme Court’s holding, consider reaching out to your attorney if you have been holding off on registration because you believe your trademark to be generic and if your company’s brand identity is so closely related to its internet domain that your company is primarily identified by consumers as “generic trademark.com.” You may be able to obtain exclusive rights to your generic trademark after all. As always, we are here to guide your marketing strategy in a way that is beneficial for trademark enforcement and control over what is sometimes your company’s most valuable asset - its brand.