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SCOTUS Opinion: Generic.com Names Can Be Trademarked

30 Jun 2020

In *U.S. Patent and Trademark Office v. Booking.com B.V.*, the Office declined to grant a trademark to "Booking.com," which was a site that provided travel-reservation services, because, in its view, the name was generic, and generic names are not eligible for trademark protection. The district court disagreed, determining that "Booking.com" was not generic even though the term "booking" was. The Fourth Circuit affirmed.

The Court, in an 8-1 decision by Justice Ginsburg, also affirmed, holding that consumers understood "generic.com" names to be specific to that provider's identity, and thus distinguishable from a competitor. In other words, no consumer would think that Travelocity, a similar travel-reservation service, would be a "booking.com." The majority further rejected the argument that adding ".com" to a generic name was no different than adding "Inc." or "Co." to a generic name, since a "generic.com" site was unique from other .com sites. Justice Sotomayor concurred, stating that she only agreed that the Office could not have a per se rule determining that all generic.com names were generic, but that the facts might warrant that conclusion in certain cases. Justice Breyer dissented, arguing that fusing a generic ".com" after a generic name did not create a non-generic, trademarkable term.

A link to the opinion is here: https://www.supremecourt.gov/opinions/19pdf/19-46_8n59.pdf

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TAGGED: Trademark, U.S. Patent and Trademark Office v. Booking.com B.V., generic