
Intellectual Property Case Update: USPTO v. Booking.com B.V.

By Gerald P. Schneeweis / Nov 26, 2019

U.S. Supreme Court agrees to decide whether the addition of “.com” to a website service’s term for hotel booking services can allow the term to function as a registrable service mark upon proof of “acquired distinctiveness.”

On November 8, 2019 the U.S. Supreme Court granted the U.S. Patent And Trademark Office’s Petition for Writ of Certiorari for review of the 4th Circuit Court of Appeals’ decision affirming the district court’s order directing the USPTO to allow federal registration of “BOOKING.COM” as a trademark.

The case concerns whether the term is “generic” (and thus incapable of serving as a trademark) or “descriptive,” which means that it is capable of serving as a trademark and registrable, upon proof of “secondary meaning” that the term functions in the minds of consumers as a unique source of goods or services.

“BOOKING.COM” is used by the Respondent (Booking.com B.V.) to promote its online hotel reservation services. It obtained an international registration of Booking.com in 2011 and in June of 2012 filed an application with the USPTO seeking to obtain registration of the mark in the U.S.

The USPTO’s examining attorney refused to allow the mark to be registered on the grounds that the term was generic as applied to the relevant services.

The applicant appealed this decision to the Trademark Trial and Appeal Board (“TTAB”) which affirmed the refusal to register the term. It focused on the inadequacy of the applicant’s evidence in support of acquired distinctiveness, finding it “sparse and equivocal” and inadequate to establish that the term acted as a source identifier in the minds of the relevant public.

Booking.com BV appealed the TTAB’s decision to the U.S. District Court for the Eastern District of Virginia. The district court found that, based on a *new* survey that showed 74.8% of polled customers primarily identified Booking.com with the provider of those services, there was sufficient evidence to show that the mark was not generic, but instead “descriptive” and entitled to federal registration.

The USPTO, joined by the American Intellectual Property Association as *amicus curiae*, then appealed to the 4th Circuit Court of Appeals which, in a 2-1 decision, upheld the district court’s finding that the term was not simply generic, but instead, descriptive. The court found that the USPTO had the burden of proving that the term was generic, and it upheld the district court’s determination that it had failed to do so. Although it recognized that “Booking” is itself a generic term, a majority of the 4th Circuit panel held that the USPTO hadn’t met its burden of showing that “Booking” combined with “.com” was incapable of being anything other than generic:

“We hold that the district court, in weighing the evidence before it, did not err in finding that the USPTO failed to satisfy its burden of proving that the relevant public understood BOOKING.COM, taken as a whole, to refer to general online reservation services rather than Booking.com the company. Because the USPTO concedes that, if the mark is descriptive, it is protectable, this ends our inquiry.”

(*Booking.com, B.V. v. United States Patent and Trademark Office*, 915 F.3d 171, 181 (4th Cir. 2019).)

The panel also distinguished the decisions from the 9th Circuit and Federal Circuit that held that the addition of “.com” can’t transform a generic term into a descriptive mark:

“Unlike ‘hotels’ or ‘lawyers,’ ‘booking’ is used to describe a plethora of reservation services, including, for example, theatrical or musical engagements.” (*Id.*, at 182.)

The court’s reasoning was that if there is sufficient proof that consumers commonly understand the word “booking” to mean a process by which one can obtain a *variety* of tickets or reservations, (not just hotel reservations) such as sporting events or concert tickets online, then “Booking.com” can denote a single source for hotel reservations.

The USPTO’s position throughout the proceedings has been that that the term is necessarily generic and cannot be properly viewed as descriptive, because the word “booking” is the name for the very services provided by the applicant themselves, and can’t function as a legally-protected unique source provider that would exclude other reservation providers from using the word “booking” in their own business name or mark. It further contends that the 4th Circuit Court of Appeals’ decision directly conflicts with established precedent from the 9th Circuit and Federal Circuit that held that the use of “.com” with a generic term, like the use of “Inc.” or “corporation” with a generic term, doesn’t transform the combined name into a “descriptive mark.” It also argues that the court shouldn’t have even considered survey evidence as the court should have found the term to be generic in the first instance—which all the survey evidence in the world couldn’t change. It further argues that allowing registration of “BOOKING.COM” would improperly limit competition by

other online reservation systems.

If the Supreme Court determines that BOOKING.COM is generic and not descriptive, it presumably won't need to decide whether the applicant/respondent Booking.com B.V. submitted sufficient evidence to show acquired distinctiveness or secondary meaning that would allow it to proceed to registration. If the Court decides that the term is descriptive and not generic, it could still take the opportunity to rule on the adequacy of the survey evidence and provide guidance on the required level of proof for practitioners, applicants and the USPTO itself.

The Supreme Court will likely issue a decision by mid-year.