
Patent & Trademark Office v. Booking.com B.V., No. 19-46

Today, the Supreme Court held by a vote of 8-1 that adding “.com” to an otherwise generic term (such as “booking” for hotel-booking services) may yield a non-generic name that is eligible for trademark protection, so long as consumers do not perceive the combined name (e.g., “Booking.com”) as a generic term for a class of goods or services.

Background: As a rule, the U.S. Patent & Trademark Office (“PTO”) will not grant a trademark covering the generic term for a good or service (like “booking” for hotel-booking services). In contrast, a term that *describes* what a particular business does (like “Park ‘N Fly” for airport parking) may be granted a trademark.

In this case, the PTO adopted a *per se* rule that adding “.com” to a generic term does not make the combined term protectable – it is still generic. And under this *per se* rule, the PTO rejected Booking.com’s application to trademark “Booking.com.”

Booking.com sought review of the PTO’s decision in federal court, where it presented survey evidence establishing that consumers perceive “Booking.com” to be descriptive of the services provided by the Booking.com website, rather than as a generic term for hotel-booking services generally. Accepting that evidence and rejecting the PTO’s *per se* rule against registering “generic.com” terms, the lower courts ruled that “Booking.com” is eligible for trademark protection.

Issue: Whether an online business can create a protectable trademark by adding “.com” to an otherwise generic term.

Court’s Holding: In an opinion written by Justice Ginsburg and joined by Chief Justice Roberts and Justices Thomas, Alito, Sotomayor, Kagan, Gorsuch, and Kavanaugh, the Supreme Court held that “[a] term styled ‘generic.com’ is a generic name for a class of goods or services only if the term has that [generic] meaning to consumers.” Because Booking.com had proven to the lower federal courts that consumers perceive “Booking.com” to be descriptive, not generic, the Supreme Court upheld the lower courts’ decision that the name is eligible for trademark protection.

Justice Sotomayor wrote a concurring opinion, emphasizing that consumer-survey evidence is not “the be-all and end-all” in determining consumer perceptions; other sources such as dictionaries and common usage may inform whether a term is generic or descriptive.

Justice Breyer dissented, embracing the PTO’s *per se* rule that a generic term plus “.com” is still generic and cannot be granted trademark protection as a matter of law.