

No. 19-46

In the Supreme Court of the United States

UNITED STATES PATENT AND TRADEMARK OFFICE,
ET AL., PETITIONERS

v.

BOOKING.COM B.V.

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT*

REPLY BRIEF FOR THE PETITIONERS

NOEL J. FRANCISCO
*Solicitor General
Counsel of Record
Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

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Under this Court’s decision in *Goodyear’s India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), respondent could not register as a trademark the term “Booking Company” or “Booking Inc.” for the class of hotel reservation services at issue here. The term “booking” is generic for those services, Pet. App. 67a, and the addition of “Company” or “Inc.” would “only indicate[] that parties have formed an association or partnership to deal in” them. *Goodyear*, 128 U.S. at 602. Thus, no matter how strongly the public came to associate “Booking Company” or “Booking Inc.” with respondent’s brand, respondent could not “exclusively appropriate[]” the term and “impair the equal right of others engaged in similar business to use similar designations.” *Id.* at 602-603.

Like the court of appeals, respondent provides no sound reason why “BOOKING.COM” should receive trademark protection when “Booking Inc.” could not.

The addition of “.com,” a top-level domain, “does not itself have source-identifying significance.” Pet. App. 20a. And respondent’s assertion (Br. in Opp. 1) that “[w]hether a trademark is generic is a question of fact” is no answer to *Goodyear*’s holding that “Generic Company” names, “without other specification,” are not “capable of exclusive appropriation.” 128 U.S. at 602-603.

The court of appeals’ erroneous determination that BOOKING.COM is protectable as a trademark and entitled to registration warrants this Court’s review. It conflicts with decisions of the Federal and Ninth Circuits, which have held on materially similar facts that HOTELS.COM, ADVERTISING.COM, LAWYERS.COM, and MATTRESS.COM are all generic. That circuit conflict is especially destabilizing because aggrieved parties generally may seek judicial review of Trademark Trial and Appeal Board (TTAB) trademark-registration decisions in either the Federal Circuit or the Eastern District of Virginia. This Court’s review is necessary to correct the court of appeals’ error and to ensure that uniform rules govern federal trademark registration of terms consisting of a generic word and a top-level domain.

A. The Court Of Appeals’ Decision Is Wrong

1. a. In *Goodyear*, this Court held that the addition of an entity designation like “Company” or “Inc.” to a generic term like “wine,” “cotton,” or “grain” does not create a protectable mark, but instead “only indicates that parties have formed an association or partnership to deal in such goods.” 128 U.S. at 602; see *id.* at 603 (“[N]or will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.”). The same principle applies here. The district court recognized, and the court of appeals did not dispute, that

“booking” is generic for the class of hotel reservation services described in respondent’s applications. Pet. App. 12a-25a, 67a. The addition of “.com” does not create a protectable mark, because it conveys only that respondent “operates a commercial website via the internet.” *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009). Thus, just as no company could register a trademark in “Booking Inc.,” respondent should not be permitted to register a trademark in “BOOKING.COM.”

b. Respondent addresses *Goodyear* only briefly. Respondent points out (Br. in Opp. 11-12) that *Goodyear* predated the Lanham Act, 15 U.S.C. 1051 *et seq.*, and that the Court referred to the words “Goodyear Rubber” as “descriptive,” at a time when descriptive terms were not protectable. 128 U.S. at 602. But the better reading of *Goodyear* is that the Court considered “Goodyear Rubber” to be the *common* descriptive—*i.e.*, generic, see Pet. 4 n.1—name for the class of goods. The Court likened “Goodyear Rubber” to “wine,” “cotton,” and “grain,” which are all generic terms. 128 U.S. at 602-603.

Even if the *Goodyear* Court had used the term “descriptive” in its modern sense, that would make no difference. *Goodyear*’s relevance here is its holding that adding an entity designation like “Company” or “Inc.” to an otherwise unprotectable word does not create a protectable mark. 128 U.S. at 602-603. This Court has never overruled *Goodyear*, nor suggested that it is a product of pre-Lanham Act thinking. And courts, commentators, and the United States Patent and Trademark Office (USPTO) have interpreted the decision to hold that adding a corporate (or other entity) designation to generic terms does not create a protectable mark. Pet. 18.

Respondent contends (Br. in Opp. 12) that *Goodyear* is distinguishable because “it did not articulate the ‘primary significance’ test.” But neither this Court’s subsequent decisions nor the Lanham Act’s adoption of that test has overruled *Goodyear*. And under *Goodyear*, because the addition of “.com” “only indicates” that respondent uses a website “to deal in” booking services, “BOOKING.COM” is ineligible for trademark protection even if consumers understand that the term refers to respondent’s business. 128 U.S. at 602; see Pet. 18-19.

Respondent cites (Br. in Opp. 7-8, 12) *In re Oppedahl & Larson, LLP*, 373 F.3d 1171 (Fed. Cir. 2004), for the proposition that the term “.com” is descriptive. But because the parties there did not dispute that “patents.com” was *at least* descriptive for the relevant class of computer software, *id.* at 1174, the Federal Circuit had no need to determine whether “.com” is generic. See *Advertise.com, Inc. v. AOL Adver., Inc.*, 616 F.3d 974, 979-980 & n.4 (9th Cir. 2010). And the court confirmed that adding “.com” “to an otherwise unregistrable mark will typically not add any source-identifying significance, similar to the analysis of ‘Corp.’ and ‘Inc.’ in *Goodyear’s*.” *Oppedahl & Larson LLP*, 373 F.3d at 1177; see *id.* at 1175. Subsequent Federal Circuit decisions have likewise recognized that, because “.com” generally conveys only that a business has an online presence, “registrability does not depend on the .com combination.” *Hotels.com*, 573 F.3d at 1304; see *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009); see also *Advertise.com*, 616 F.3d at 978-979.¹

¹ Respondent suggests (Br. in Opp. 13) that “.com” alters the meaning of words,” because “the primary meaning of ‘Amazon’ is a river,” but “Amazon.com” conveys an online retailer. That example demonstrates only that “Amazon” is not a generic term for retailers.

Goodyear also refutes respondent’s contention (Br. in Opp. 5) that the TTAB erred in purportedly “assessing * * * ‘booking’ and ‘.com’ in isolation.” The *Goodyear* Court considered the terms “Goodyear Rubber” and “Company” separately before determining whether the combination could function as a protectable trademark. 128 U.S. at 602-603. Subsequent courts likewise have found it appropriate to “weigh the individual components of [a proposed] mark” before “determin[ing] whether the mark as a whole * * * conveys any distinctive source-identifying impression.” *Oppedahl & Larson LLP*, 373 F.3d at 1174-1175.

Respondent’s examples (Br. in Opp. 6, 13-14 & n.4) of registered marks do not support the court of appeals’ decision. Many of respondent’s “purportedly ‘generic’ terms are registered not for the services that the terms directly identify, but for other services that are obliquely related.” Pet. App. 175a, 217a. Moreover, the purported inconsistencies that respondent identifies are between decisions of individual USPTO examining attorneys, not between precedential decisions of the TTAB. Since 2002, decisions of the TTAB and the USPTO’s *Trademark Manual of Examining Procedure (TMEP)* have consistently stated that purported trademarks taking the form “generic.com” are no more registrable for the goods or services for which the term is generic than is the generic term itself. See *In re Martin Container Inc.*, 65 U.S.P.Q.2d 1058, 1060 (T.T.A.B. 2002); *TMEP* § 1215.05 (Oct. 2018); *TMEP* § 1215.05 (Jan. 2002).

The same is true of “Staples.com,” *ibid.*: “staples” is not generic for the sale of office supplies. “[T]he primary reason that a consumer is likely to associate a domain name with a source is that the *second-level domain*”—*e.g.*, “Amazon” or “Staples”—“is distinctive.” *Advertise.com*, 616 F.3d at 981.

2. a. In addition to disregarding *Goodyear*, the court of appeals improperly extended the concept of secondary meaning to generic terms. Pet. 19-22. It relied heavily on respondent's survey showing that consumers associate BOOKING.COM with respondent's specific business. Pet. App. 16a-18a. That approach conflates generic terms, which are not eligible for trademark protection even upon a showing of secondary meaning, with descriptive terms, which are potentially registrable if secondary meaning is established. See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847-848 (C.C.P.A. 1961).

b. Respondent does not meaningfully address the distinction between generic and descriptive terms. Instead, respondent repeatedly asserts (e.g., Br. in Opp. 1, 3, 5, 7, 10, 18, 35) that a mark's generic character presents a "factual" question that may be decided on the basis of consumer surveys. It is true that, in the usual case where a purported trademark is alleged to be generic, the determination whether the mark is protectable depends on whether consumers understand it as the common name of a product or service. The presence or absence of that consumer understanding is an issue of fact, as to which survey evidence may be highly probative. This Court's decision in *Goodyear* makes clear, however, that a term like "Grain Company" can be generic and therefore unprotectable *even if* consumers in a given market have come to associate it with a particular source. See Pet. 21-22. Respondent's survey evi-

dence provides no basis for disregarding that legal principle, or for declining to apply it to the internet analogue “BOOKING.COM.”²

Like the court of appeals (Pet. App. 10a, 21a), respondent suggests (Br. in Opp. 33-34) that the legal principle described above is limited to circumstances where a court previously has held (or the applicant has admitted) that the combined term is generic, or where the combined term was commonly used before its association with the applicant. Under respondent’s approach, a party could register “Grain Inc.” as a trademark so long as the registrant was the first market participant to use the term and had obtained a significant public following. Limiting *Goodyear* in that manner finds no support in that decision, and it would unfairly disadvantage new market entrants by “depriv[ing] competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9; see Pet. 19-20.

3. Respondent’s other attempts to defend the decision below are unpersuasive. Respondent states (Br. in Opp. 16) that the TTAB “expressly conceded that it is logically and grammatically impossible to use the term BOOKING.COM as a generic term for anything.” But the TTAB made no such concession. See Pet. App. 166a. In any event, it is similarly unlikely that consumers would use the term “Grain Incs.” to refer to incorporated grain merchants as a class; yet *Goodyear* makes clear that “Grain Inc.” would not be protectable as a

² Respondent cites (Br. in Opp. 28-30) cases in which a mark’s generic character “was confirmed by consumer survey evidence.” But none of those cases involved a generic term combined with an entity designation or top-level domain.

trademark. See 128 U.S. at 603 (“Names of such articles cannot be adopted as trade-marks * * * ; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.”).

Respondent further contends (Br. in Opp. 25) that “[t]he very fact that there are other * * * generic terms for the services Booking.com provides (e.g., travel agent, travel reservations service)” shows that “Booking.com” itself is not generic. But courts and the TTAB have rejected the argument that “there can only be one generic term” for a particular good or service, e.g., *1800Mattress IP*, 586 F.3d at 1364; accord Pet. App. 171a, and the decisions respondent cites (Br. in Opp. 38-39) do not support its contention. In this case, moreover, the TTAB and the courts below had before them “evidence of competitors’ use of the designation ‘booking.com’ as a part of trade names and domain names that describe the nature of their services.” Pet. App. 171a, 213a. And to the extent respondent has made exclusive use of the term “BOOKING.COM,” that simply reflects that respondent paid for the exclusive right to use as a domain name that precise term. It does not negate its competitors’ legitimate interest in using the term as part of their own longer domain names. See Pet. 16, 21-22 & n.6.

B. The Question Presented Warrants Review

1. The Federal and Ninth Circuits have long held that the addition of “.com” to an otherwise-generic term generally does not cause the term to “lose its generic character.” *Hotels.com*, 573 F.3d at 1304; see *Advertise.com*, 616 F.3d at 981-982. Accordingly, those courts have found that HOTELS.COM, MATTRESS.COM, LAWYERS.COM, and ADVERTISING.COM are all generic for the relevant class of goods or services. *Hotels.com*, 573 F.3d

at 1304-1306; *1800Mattress.com IP*, 586 F.3d at 1363-1364; *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379-1380 (Fed. Cir. 2007); *Advertise.com*, 616 F.3d at 982.

Respondent observes (Br. in Opp. 17) that, under the statutory scheme governing review of trademark-registration decisions, the Federal Circuit reviews the TTAB's factual findings for substantial evidence, while a district court resolves registration de novo if new evidence is introduced, and the court of appeals reviews that court's factual findings for clear error. See Pet. 6-7. But the Ninth Circuit applies the same standard as the Fourth Circuit did here. And nothing suggests that the standard of review was decisive in the relevant Federal Circuit cases. That court's decisions recognize that, where “.com” evokes only “a commercial internet domain,” its addition to a generic term does not render the combination protectable. *1800Mattress.com IP*, 586 F.3d at 1364. That principle is squarely at odds with the lower courts' decisions in this case, which recognize that “book-ing” is generic, but nevertheless hold that “BOOKING.COM” is descriptive and protectable upon a showing of secondary meaning.

Contrary to respondent's suggestion (Br. in Opp. 17), the Federal and Ninth Circuit cases cited in the certiorari petition involved materially similar facts. In *Hotels.com*, for example, the proposed mark (HOTELS.COM) shared the same structure as BOOKING.COM; the applicant sought registration for the same class of services; and the applicant relied on a consumer survey showing “that 76% of respondents regarded HOTELS.COM as a brand name,” compared to the 74.8% result here. Compare *Hotels.com*, 573 F.3d at 1305 (citation omitted), with Pet. App. 4a, 6a, 16a. In each case, moreover, the TTAB relied on the use of the combined term within other

(longer) domain names to support its finding that the disputed mark was generic. Compare *Hotels.com*, 573 F.3d at 1304, with Pet. App. 141a-169a, 187a-211a; accord *Advertise.com*, 616 F.3d at 977-980 (similar facts). There is thus little doubt that the Federal and Ninth Circuits would have found “BOOKING.COM” to be generic. See Pet. 23-25.³

2. The statutory scheme governing judicial review of trademark-registration decisions makes the disagreement among the circuits especially destabilizing. Parties dissatisfied with such decisions may appeal directly to the Federal Circuit, 15 U.S.C. 1071(a), or seek review in an appropriate district court, 15 U.S.C. 1071(b). A challenger that chooses the latter mode of review ordinarily can file suit in the Eastern District of Virginia, where the USPTO is headquartered and where the decision below will be binding. The USPTO thus faces a whipsaw: Whether it continues to apply Federal Circuit precedent or instead follows the Fourth Circuit’s decision here, a party dissatisfied with a TTAB decision likely can obtain its preferred result through choice of forum. See Pet. 25-26. Respondent’s silence on this practical difficulty confirms that this Court’s review is necessary to establish uniform rules governing federal trademark registration of “generic.com” terms.

3. Review also is warranted because the decision below threatens significant anticompetitive harms. “[G]ranting trademark rights over” “generic.com” terms

³ Respondent relies in part (Br. in Opp. 4-5, 16, 20-22) on the testimony of its linguistics expert and on evidence regarding BOOKING.COM’s popularity and customer satisfaction. But the court of appeals declined to give the former any weight, Pet. App. 16a n.8, and the district court stated that the latter was “not probative of secondary meaning,” *id.* at 99a; see *id.* at 98a-99a.

“grants the trademark holder rights over far more intellectual property than the domain name itself,” because it “potentially cover[s] all combinations of the generic term with any” top-level domain, as well as “almost any use of the generic term in a domain name.” *Advertise.com*, 616 F.3d at 980-981; see Pet. App. 41a-45a (Wynn, J., concurring in part and dissenting in part). Trademark protection thus would permit respondent (and other “generic.com” businesses) to bring infringement suits against a variety of competitors. See Pet. 26. While respondent contends (Br. in Opp. 36, 39-40) that those suits might ultimately fail, “[c]ompetition is deterred * * * not merely by successful suit but by the plausible threat of successful suit,” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000); see Pet. 16 n.4. Permitting respondent to register BOOKING.COM as a trademark threatens just such a deterrent effect.

* * * * *

For the foregoing reasons and those stated in the petition for a writ of certiorari, the petition should be granted.

Respectfully submitted.

NOEL J. FRANCISCO
Solicitor General

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