

No. 19-46

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IN THE  
**Supreme Court of the United States**

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UNITED STATES PATENT & TRADEMARK OFFICE ET AL.,  
*Petitioners,*

v.

BOOKING.COM B.V.,  
*Respondent.*

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**On Writ of Certiorari to the  
United States Court of Appeals  
for the Fourth Circuit**

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**BRIEF FOR THE AMERICAN INTELLECTUAL  
PROPERTY LAW ASSOCIATION AS *AMICUS  
CURIAE* IN SUPPORT OF NEITHER PARTY**

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**QUESTION PRESENTED**

Whether the addition by an online business of a generic top-level domain (“.com”) to an otherwise generic term can create a protectable trademark.

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## INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (“AIPLA”) is a national bar association representing the interests of approximately 12,000 members engaged in private and corporate practice, government service, and academia.<sup>1</sup> AIPLA’s members represent a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of trademark, patent, copyright, trade secret, and unfair competition law as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA has no stake in any of the parties to this litigation or in the result of this case, other than its

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<sup>1</sup> In accordance with Supreme Court Rule 37.6, AIPLA states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than AIPLA and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to the litigation in this matter; (ii) no representative of any party to this litigation participated in the authorship of this brief; and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

interest in the correct and consistent interpretation of the laws affecting intellectual property.<sup>2</sup>

### **SUMMARY OF ARGUMENT**

Pursuant to the Lanham Act, the addition of a generic top-level domain to an otherwise generic term can, under certain circumstances, create a protectable trademark. The entitlement of such a mark to federal protection should be evaluated on case-by-case basis without the application of a *per se* rule of genericness.

### **BACKGROUND**

According to the evidence submitted to the district court, Booking.com is a travel and accommodations website that, since at least 2006, has used BOOKING.COM as its public facing name for customers in the United States and around the world.<sup>3</sup> In 2011 and 2012, Booking.com filed four separate trademark registration applications with the United States Patent and Trademark Office (“PTO”) for a word mark and stylized versions of BOOKING.COM (the “Marks”).<sup>4</sup> The PTO examiner

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<sup>2</sup> AIPLA has the consent of the parties to file this amicus brief, pursuant to Supreme Court Rule 37.3(a). Petitioners consented by letter dated December 18, 2019. Respondent consented by email dated December 19, 2019.

<sup>3</sup> This brief uses “Booking.com” to refer to Respondent and “BOOKING.COM” to refer to the proposed mark at issue.

<sup>4</sup> The amended applications identified two services:

Class 39 services, which included “[t]ravel agency services, namely, making reservations for transportation; travel and tour

initially rejected Booking.com's applications on the basis that BOOKING.COM was merely descriptive of Booking.com's services. In response, Booking.com claimed that the Marks had acquired distinctiveness. The examiner again rejected the applications, finding that BOOKING.COM was generic as applied to Booking.com's services; in the alternative, the examiner maintained the basis for the original refusals and found that Booking.com had failed to establish acquired distinctiveness. Booking.com moved for reconsideration and at the same time appealed the refusals to the Trademark Trial and Appeal Board ("TTAB"). The examiner denied Booking.com's motion for reconsideration.

The TTAB affirmed the examiner's four refusals, concluding "that 'booking' refers to 'a reservation or arrangement to buy a travel ticket or stay in a hotel room' or 'the act of reserving such travel or accommodation'; that '.com' indicates a commercial website, which does not negate the generic character of the term 'booking'; and that the combined term BOOKING.COM would be understood by consumers 'primarily to refer to an online reservation service for travel, tours, and lodging,' which is consistent with the services proposed in the applications." *Id.* at 898 (quoting A1092, A1096, A1107). The TTAB concluded alternatively that

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ticket reservation services." *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 896 (E.D. Va. 2017).

Class 43 services, which included "[m]aking hotel reservations for others in person and via the internet; providing personalized information about hotels and temporary accommodations for travel in-person and via the Internet; providing on-line reviews of hotels." *Id.*

BOOKING.COM was merely descriptive of Booking.com's services and Booking.com had failed to demonstrate acquired distinctiveness.

In April 2016, Booking.com appealed the TTAB decision and commenced a civil action pursuant to 15 U.S.C § 1071(b) against the PTO in the United States District Court for the Eastern District of Virginia. The court conducted a de novo review of the record, which included evidence—such as news articles and websites, third-party rankings of Booking.com, and Booking.com's sales figures, advertising campaigns, and social media followers—that Booking.com had previously submitted to the TTAB to support its contention that the Marks were not generic and had acquired secondary meaning. Booking.com also submitted new evidence in the form of a “Teflon survey” showing that 74.8% of survey respondents identified BOOKING.COM as a brand name. The district court granted summary judgment in favor of Booking.com for Class 43 services only, finding the Marks protectable for those services because the BOOKING.COM combination mark was not generic; it was only merely descriptive, and Booking.com had demonstrated secondary meaning of the Marks for hotel services. The court determined that, although “booking” was a generic term, the “evidence is more than sufficient to demonstrate that ‘in the minds of the public, the primary significance of BOOKING.COM ‘is to identify the source of the product rather than the product itself.’” See *Booking.com B.V.*, 278 F. Supp. 3d at 923 (quoting *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996)).

The PTO appealed this determination to the United States Court of Appeals for the Fourth Circuit. The court affirmed and held that combining a generic top-level domain, such as “.com,” with an otherwise generic term may result in a protectable mark where evidence, such as survey evidence, demonstrates that the mark’s primary significance to the public is the source of the product, and not the product itself. *See Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171, 179, 183-184, 187 (4th Cir. 2019), *as amended* (Feb. 27, 2019), *cert. granted sub nom. Patent & Trademark v. Booking.com B.V.*, No. 19-46, 2019 WL 5850636 (U.S. Nov. 8, 2019). The PTO then petitioned this Court for a writ of certiorari, which was granted. This appeal followed.

## ARGUMENT

### I. A GENERIC TERM COMBINED WITH A GENERIC TOP-LEVEL DOMAIN IS NOT *PER SE* GENERIC

There should be no *per se* rule that a mark composed of a generic top-level domain (“gTLD”) and an otherwise generic term is incapable of ever receiving federal trademark protection. A mark containing a gTLD as a component should be treated like any other mark and evaluated on its merits. AIPLA submits that the combination of a gTLD and an otherwise generic term *can*, in limited circumstances, result in a protectable mark.

## A. TOP-LEVEL DOMAINS AND TRADEMARK LAW

### 1. A BRIEF HISTORY OF gTLDs

The Internet is a global network made up of smaller interconnected networks that individuals and businesses can use to engage in commerce through mediums such as the World Wide Web. *See Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999). Due to the extensive nature of these interconnected networks, every site on the Internet has a dedicated “Internet Protocol” (“IP”), delineated by a unique string of numbers. *See id.* (“Each web page has a corresponding domain address, which is an identifier somewhat analogous to a telephone number or street address”); *see also* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 25A:10, 25A:11 (5th ed. 2019). Because IP addresses are lengthy and difficult to memorize, a system called the Domain Name System (“DNS”) was developed to allow users to connect easily with other individuals or businesses on the Internet. *See id.*, § 25A:11. As part of the DNS, each distinct website on the Internet can be accessed by its Uniform Resource Locator (“URL”), which consists of a “second level domain” such as “nytimes” or “whitehouse” that pinpoints each website and a “top-level domain” or TLD that corresponds to various categories (“edu” for educational institutions and “gov” for government entities, for example). *See Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1230 (N.D. Ill. 1996); McCarthy, § 25A:11. When DNS first became widespread, only a few TLDs existed, including “.com,” “.net,” and “.org.” *See McCarthy,*

§ 25A:12. In 1998, however, the U.S. Department of Commerce designated the Internet Corporation for Assigned Names and Numbers (“ICANN”) to oversee DNS and, as part of that, top-level domains. *Id.* Following this transfer, in 2000, and then again in 2005 and in subsequent years, ICANN approved the addition of top-level domains such as “.info,” “.biz,” “.mobi,” and “.pro,” along with sponsored domains. *Id.*, § 25A:14. Today, there are over 1,500 TLDs. See ICANN, List of Top-Level Domains, <https://www.icann.org/resources/pages/tlds-2012-02-25-en> (last visited Jan. 13, 2020).

## 2. PROTECTABLE MARKS

In 1946, Congress enacted the Lanham Act in part to protect trademarks used nationally and internationally. See S.Rep. No. 1333, 79th Cong., 2d Sess., 5 (1946). Courts interpreting the Act have identified four main categories of terms that correspond with eligibility for trademark protection. In order of most protectable to not protectable at all, these categories are: (1) fanciful or arbitrary; (2) suggestive; (3) descriptive; and (4) generic. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

Descriptive marks—which mainly describe an applicant’s goods or services—are not registrable unless the mark has acquired secondary meaning. See *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985). To acquire secondary meaning, the term must “become sufficiently distinctive to establish mental association in buyers’ minds between the alleged mark and a single source of the

product.” *Retail Servs., Inc. v. Freebies Publ’g*, 364 F.3d 535, 539 (4th Cir. 2004); *see also* 15 U.S.C § 1052; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 770 (1992). The applicant can demonstrate secondary meaning through, among other things, the length and manner of use of the mark, volume of sales, manner of advertising, consumer-survey evidence, and direct consumer testimony. *See Bd. of Supervisors for Louisiana State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 476 (5th Cir. 2008). Examples of descriptive marks that have acquired secondary meaning include “SHARP” for televisions or “DIGITAL” for computers.

### 3. GENERIC TERMS

Generic terms afford the applicant no protection. These are typically terms that are a common descriptive name of the category of the product or service. *See Park ‘N Fly, Inc.*, 469 U.S. at 194. The generic term thus refers to the group of which the particular product is a member. *Id.* (“A generic term is one that refers to the genus of which the particular product is a species”). “A generic mark describes a product in its entirety, and, therefore, neither signifies the source of goods nor distinguishes the particular product from other products on the market.” *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 394 (4th Cir. 2009) (internal citations and quotation marks omitted). Generic terms are never protectable because “[t]o allow trademark protection for generic terms . . . would grant the owner of the mark a monopoly, [because] a competitor could not describe [its] goods as what they are.” *CES Pub. Corp. v. St. Regis Publications, Inc.*,

531 F.2d 11, 13 (2d Cir. 1975). Generic terms include common product names like “CAR,” “CIGARETTE,” and “LITE BEER.”

While a previously protectable mark can become generic, a generic term, standing alone, can never attain protectable status. *See generally Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 116 (1938). Typically, courts will hold that a term is generic because it was already found to be generic in a previous determination or because it is a commonly used term. *Id.*; *see also Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 255 (4th Cir. 2001) (holding that a term may be deemed generic where there is evidence “the term was commonly used prior to its association with the products at issue”). In either case, even where an applicant has submitted evidence tending to show some degree of secondary meaning, its generic status cannot be undone. “[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9; *accord J. Kohnstam, Ltd. v. Louis Marx and Company*, 280 F.2d 437, 440 (C.C.P.A. 1960).

When the PTO refuses registration on the grounds that a proposed mark is generic, it “bears the burden of establishing that a proposed mark is generic [], and must demonstrate generic status by clear evidence.” *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009) (internal citation omitted)

(citing *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987)); *see also* Trademark Manual of Examining Procedure (“TMEP”) § 1209.01(c)(i) (Oct. 2018 ed.). “Evidence of the public’s understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers, and other publications.” TMEP § 1209.01(c)(i). Importantly, “[t]he test for genericness is the same whether the mark is a compound term or a phrase, and the examining attorney should include, if available, evidence showing use of the mark as a whole in the record.” *Id.* (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 968 (Fed. Cir. 2015)). Once an examiner determines that a proposed mark is generic, and the TTAB affirms this ruling, the applicant can seek further review in federal court by arguing that the TTAB’s conclusions are arbitrary, capricious, or unsupported by substantial evidence. *See Bridgestone/Firestone Research, Inc. v. Auto. Club De L’Quest De La France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001).

To conclude that a particular term is generic, courts generally use a three-part analysis: (1) identify the class of product or service to which use of the mark is relevant; (2) identify the relevant purchasing public of the class of product or service; and (3) determine that the *primary significance* of the mark to the relevant public is to identify the class of product or service to which the mark relates. *See Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996). If the applicant shows that the mark’s primary significance is to identify the source or brand (i.e., the applicant’s product or service), rather than the class of product or

service, the mark may be distinctive and capable of protection. *Id.*; see *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. at 118 (to demonstrate that a potentially generic mark is protectable, the asserting party “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer”).

#### 4. THE PTO'S TREATMENT OF gTLDs

The PTO's Trademark Manual of Examining Procedure instructs that “[g]enerally, a mark comprised of a generic term(s) combined with a non-source-identifying gTLD is generic and without trademark or service mark significance.” TMEP § 1215.05. The TMEP states that “there is no *per se* rule that the addition of a non-source-identifying gTLD to an otherwise generic term can never under any circumstances operate to create a registrable mark.” *Id.* “[I]n rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a gTLD such as ‘.com’ or ‘.net’ that will render it ‘sufficiently distinctive for trademark registration.’” *Id.* (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005)). “Thus, to establish that a mark comprising a generic term with a non-source-identifying gTLD is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.” TMEP § 1215.05.

Although the TMEP advocates against a *per se* bar to granting trademark protection for generic terms combined with gTLDs, the PTO's position

here—namely, that the addition by an online business of a gTLD to an otherwise generic term can never create a protectable trademark—appears at odds with the TMEP’s language. AIPLA disagrees with the PTO’s position in this case.

**B. GENERICNESS OF A MARK SHOULD BE EVALUATED ON A CASE-BY-CASE BASIS**

Nothing justifies a blanket rule that adding a gTLD such as “.com” to an otherwise generic term can never create a protectable trademark. The TMEP correctly advises that the resultant compound term requires a fact-specific inquiry—the same as any other compound term. In some cases, adding a gTLD to a generic term may create a compound term that merely describes the product or service being offered, but is not itself a generic term. In that situation, an applicant should be afforded the opportunity to show that the term has acquired secondary meaning and become distinctive and source-identifying for the applicant’s goods or services. *See* 15 U.S.C § 1052(f); *see also Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982) (“To establish secondary meaning, a[n] [entity] must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself”).

Under the Lanham Act, whether a term is generic is determined by identifying the *primary significance* of that term to the public. *See* 15 U.S.C § 1064(3) (“The primary significance of the registered mark to the relevant public [is] ... the test for determining whether the registered mark has become

... generic.”). When a gTLD is combined with an otherwise generic term, the PTO must assess the primary significance of the entire mark, not just its individual components. It is well settled that “[w]ords which could not individually become a trademark may become one when taken together.” See *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001) (quoting *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976), cert. denied, 429 U.S. 830 (1976)). “Certain terms may connote more than the sum of their parts and we must take care to decide the genericness of these terms by looking to the whole.” *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 938 (7th Cir. 1986).

This position is consistent with this Court’s pre-Lanham Act jurisprudence as well. In *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), the Goodyear Rubber Company sought the exclusive right over its name to restrain Goodyear’s India Rubber Glove Manufacturing, from using “Goodyear’s Rubber Manufacturing Company” or similar names. The Court determined that the name “Goodyear Rubber Company” was not protectable because “Goodyear Rubber” described “well-known classes of goods produced by the process known as ‘Goodyear’s Invention’” and entities cannot gain the exclusive use of names that are descriptive of a common class of goods. *Id.* at 599. The Court stated that “[t]he addition of the word ‘Company’ only indicates that the parties have formed an association or partnership to deal in such goods.” *Id.* It reasoned that there were many parties or entities that sell wine, or raise cotton or grain, and those entities may

refer to themselves as “Wine Company,” “Cotton Company,” or “Grain Company.” A generic descriptor such as “Company,” therefore, could not be added to another generic term to create a protectable mark that would impair the rights of others to use those common designations. *Id.*; *Howe Scale Co. of 1886 v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 137 (1905) (reiterating “[t]he principle that one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right”).

Unlike “Company,” however, gTLDs can serve, and have served, as a brand identifier when used as part of a combination mark. It is certainly possible, for instance, that consumers perceive a combination such as CARS.COM as referring to a particular source or brand rather than describing any online business dedicated to automobiles. Booking.com, for its part, introduced survey evidence demonstrating that 74.8% of consumers recognized BOOKING.COM as a brand rather than a generic service, as well as evidence showing extensive sales, popularity, and advertising campaigns associated with its brand. The PTO has, in fact, *already registered* numerous marks containing gTLDs, including WORKOUT.COM, ENTERTAINMENT.COM, and WEATHER.COM.

gTLDs present a unique circumstance because only one person or entity can operate under a particular URL. This exclusivity, therefore, makes illusory the argument that granting trademark protection for a generic term combined with a gTLD would restrain others from using a title to which they have a common right. *See Howe Scale*, 198 U.S. at

137. In other words, the owner of the “genericname.com” URL is the exclusive user of that URL independent of trademark law. Indeed, if “genericname.com” had acquired source-identifying distinctiveness and trademark protection were *not* afforded to such term, a competitor could theoretically open up a storefront called “genericname.com” and confuse consumers that it is associated with the business operating under that URL.

Further, the recent proliferation of available gTLDs—including .accountant, .cat, .coop, .doctor, .jobs, .law, .lawyer, .name, .tel, and .travel, to name a few—has made it even less advisable to adopt a blanket rule that any gTLD added to a generic term is *per se* generic. Courts have observed that, for example, adding “.net” to the mark “tennis” might result in an overall mark (“tennis.net”) that is distinctive. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004). Similarly, in the case of a website cataloguing and discussing romantic movies, adding “.com” to “rom” might result in an overall mark (“rom.com”) that is distinctive. *See Booking.com B.V.*, 915 F.3d at 192.

Even the expression of the punctuation adds a potential element of distinctiveness. An entity selling polka-dotted dresses could potentially protect “POLKA.COM” as a descriptive or suggestive mark. A grammatical website could potentially obtain protection for the term “DOT.DOT.” With gTLDs numbering over one thousand, there are countless potentially distinctive marks that could be formed from generic terms that allow individuals and businesses to create a protectable brand without

eroding the anti-competitive concerns fundamental to trademark law. Thus, whether adding a gTLD to a generic term creates a distinctive mark should be decided on a case-by-case basis.

To be sure, the addition of a gTLD to an otherwise generic term will not always—and, in fact, may rarely—create a protectable mark. *See, e.g., In re Steelbuilding.com*, 415 F.3d at 1297 (“Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark”); *In re Hotels.com, L.P.*, 573 F.3d at 1304 (“We agree with the TTAB that *for the mark here at issue*, the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM.”) (Emphasis added). It is the PTO’s obligation (and that of the courts) to examine each mark on its face to determine whether it is protectable. *See In re Hotels.com, L.P.*, 573 F.3d at 1303 (stating that “[i]n the generic-descriptive-suggestive-arbitrary-fanciful continuum of words and their usage as marks of trade, there is no fixed boundary separating the categories; each word must be considered according to its circumstances”).

Accordingly, the PTO should evaluate gTLDs combined with generic terms the same way it evaluates other compound terms: first look to the dictionary definitions of the individual components and then consider whether other evidence, such as surveys, articles, advertisements, or sales figures, better demonstrates the primary significance of the proposed mark. *See, e.g., In re Steelbuilding.com*, 415 F.3d at 1297 (“An inquiry into the public’s understanding of a mark requires consideration of the

mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.”); *Hunt Masters*, 240 F.3d at 254 (in analyzing whether the term “CRAB HOUSE” was protectable, the court first examined the meaning of the individual words “crab” and “house” and rejected the applicant’s surveys only because the combined term was commonly used before its association with the restaurant at issue); *Frito-Lay N. Am., Inc.*, 124 U.S.P.Q.2d 1184 at \*4-19, \*21-23 (in determining the genericness of the composite mark, “PRETZEL CRISPS,” the court first looked at the dictionary definitions and then considered the available record evidence, such as media references, expert surveys, and consumer feedback).

## **II. THE COURT SHOULD BE MINDFUL OF ANTI-COMPETITIVE CONCERNS**

AIPLA nevertheless urges caution regarding the potential anti-competitive consequences of allowing trademark protection for compound terms composed of a generic term and a gTLD.

*First*, there should be no alteration to the rule that a term already found to be generic cannot thereafter be elevated to protectable status, “no matter . . . what success it has achieved in securing public identification.” *Abercrombie & Fitch Co.*, 537 F.2d at 9; *see also Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. at 116.

*Second*, *Goodyear's* overarching concern that an entity should not be able to obtain a trademark that would give them a monopoly in the sale of goods commonly sold by others should not be overlooked. While *Goodyear's* concerns are mitigated somewhat here by the exclusivity of URL ownership discussed above, gTLD composite marks should nevertheless be limited to the applicant's use of the specific terms in combination. For example, the PTO should require the owner of "TOYS.COM" (if it has acquired distinctiveness and is otherwise protectable) to disclaim any right to use "TOYS" or ".COM" apart from the proposed mark as shown. This would potentially allow the trademark owner to argue that a competitor using "TOYZ.COM" is likely to confuse, but should not preclude the use of the generic term "toys" with another gTLD (e.g., "TOYS.BIZ").

Indeed, in most cases, a composite mark consisting of a generic term and a gTLD should protect only against a competitor's confusing use of that mark and the distinct domain name associated with that mark. *See Booking.com B.V.*, 278 F. Supp. 3d at 911 (the registered marks WORKOUT.COM, ENTER-TAINMENT.COM, and WEATHER.COM, did not preclude domain names such as MIRACLE-WORKOUT.COM, WWW.GOLIVE-ENTERTAINMENT.COM, and CAMPERSWEATHER.COM, respectively).

## CONCLUSION

As set forth above, AIPLA respectfully submits that whether a gTLD added to an otherwise generic term forms a protectable mark is a question that

should be evaluated on a case-by-case basis, and a *per se* rule that a mark consisting of a generic term and a gTLD is generic should be rejected.

Respectfully submitted,

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