

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.
Respondent.

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

**BRIEF OF PROFESSOR PETER N. GOLDER,
Ph.D. AND OTHER MARKETING
ACADEMICS AS *AMICI CURIAE*
IN SUPPORT OF RESPONDENT**

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INTERESTS OF THE *AMICI CURIAE*

This brief is filed on behalf of Professor Peter N. Golder, Ph.D., and the other marketing professors identified in Appendix A.¹ *Amici* are academic professors and scholars who have conducted extensive research using empirical evidence and methods in the field of marketing. *Amici* teach at leading MBA programs in the United States.² *Amici* have no direct interest in the outcome of this litigation. Their interest is that the Court be aware of the extensive empirical evidence and methods commonly used in the marketing discipline to understand consumer perceptions and usage, which are highly informative as to whether a term is generic.

SUMMARY OF THE ARGUMENT

The USPTO asks the Court to adopt a *per se* rule denying trademark protection for the combination of a generic term with an internet top-

¹ No party or their counsel authored this brief in whole or in part, or made a monetary contribution intended to fund the preparation or submission of the brief. Analysis Group, Inc., www.analysisgroup.com, paid for the printing of this brief by Counsel Press. Analysis Group has no affiliation with any party and received no payment from any party in connection with this matter. All parties have consented to the filing of this brief.

² *Amici's* institutional affiliations are provided only for purposes of identification.

level domain identifier (a “[generic].[tld]”). Adoption of this *per se* rule would preclude courts from considering a vast array of empirical evidence—distinct from and complementary to that offered by consumer surveys—that is probative as to whether such a combination is perceived by the relevant public as a generic name for the focal product category. *Amici* seek to inform the Court of the abundance and availability of such empirical evidence, which has been used extensively by marketing scholars, including *amici*, to generate reliable, valid assessments of consumer perceptions and usage.

ARGUMENT

1. THE PROPOSED *PER SE* RULE WOULD PRECLUDE CONSIDERATION OF RELEVANT EMPIRICAL EVIDENCE, COMPILED THROUGH RELIABLE METHODS, THAT IS PROBATIVE WHEN ASSESSING GENERICNESS

1.1 OVERVIEW

The test for determining genericness is based on the term’s “primary significance . . . to the relevant public.” 15 U.S.C. § 1064(3). The USPTO’s proposed *per se* rule would excuse the government from its obligation to offer evidence that the “relevant public” understands the primary significance of a term (such

as BOOKING.COM) to be a generic term rather than a trademark, and would permit challengers and fact-finders to ignore contrary empirical evidence of consumer perception.

It is scientifically possible to assess the primary significance of a term to consumers through reliable empirical evidence. *Amici* are marketing professors and scholars who, through this brief, aim to educate the Court about the variety of empirical evidence that is both commonly used by scholars and readily available to courts to measure consumer perception. *Amici* oppose adopting a *per se* rule that renders such evidence unnecessary or irrelevant because doing so would frustrate exploration of the truth.

1.2 Empirical evidence drawn from a variety of public historical records can aid the assessment of the potential genericness of a “[generic].[tld]” term.

Among its goals, trademark law seeks to prevent the exclusive appropriation of generic terms by private entities. The rationale is that competing manufacturers of a product “cannot [be] deprive[d]...of the right to call an article by its name.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F. 2d 4, 9 (2d Cir. 1976). Indeed, the *Goodyear* decision

relied upon by the USPTO echoes this concern for respecting the rights of “all persons . . . to deal in . . . articles [of commerce], and to publish the fact to the world.” *Goodyear’s India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888).

A relevant question for assessing genericness, therefore, is whether the proposed mark functions—or previously functioned—as the name of the focal article of commerce. For the purposes of this brief, we call that name the “common category name.”³ Determination of common category name(s) is an *empirical* exercise rooted in understanding the language used by and perceptions of consumers, producers, reporters, analysts, and other social actors (i.e., the Lanham Act’s “relevant public”) when referring to the product category. In short, if a specific term exists as a common category name, then the historical public record should contain evidence of that usage. Alternatively, the historical public record may show that a specific term is distinct from the common category name. Hence, a methodologically sound examination of the public understanding and

³ *Amici*’s use of “common category name” does not imply that there can be only one name for a product category.

usage of a term is undoubtedly probative as to its genericness.

The specific question before this Court—whether the addition by an online business of a generic top-level domain (such as “.com”) to an otherwise generic term can create a protectable trademark—can be viewed as a question of empirical existence. If at least a single instance of a non-generic “[generic].[tld]” exists or could exist, the Court’s question must be answered in the affirmative. The *per se* rule advanced by the USPTO would ignore the empirical nature of genericness in favor of a theoretical and uniform assessment that all “[generic].[tld]” terms—even those that do not yet exist—must be necessarily generic by their very nature. Such a rule would impose undue limitations on assessments of trademark protection eligibility and would prevent courts from considering the critical role that empirical evidence of consumer perception and usage can play in determining whether a mark is generic or non-generic.

Trademark law seeks to achieve a balance between, on one hand, preserving generic terms for use in the “linguistic commons,” and, on the other hand, permitting the use of non-generic terms by companies to build brands that facilitate commerce and yield substantial benefits to consumers and

companies alike. The Fourth Circuit eloquently expressed this balance:

“[T]he law of trademarks intends to protect the goodwill represented by marks and the valid property interests of entrepreneurs in that goodwill against those who would appropriate it for their own use. But it likewise protects for public use those commonly used words and phrases that the public has adopted, denying to any one competitor a right to corner those words and phrases by expropriating them from the public ‘linguistic commons.’ Enforcing these conflicting policies creates line-drawing problems that are not always easily solved.” *America Online, Inc., v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001).⁴

Particularly in the context of rapidly evolving technology and communications, where the introduction of new terms is commonplace and new

⁴ See also Vincent N. Palladino, *Genericism Rationalized: Another View*, 90 TRADEMARK REP. 469, 476 (2000) (“The issue after all is how the law should treat the term at issue in order to facilitate competition in a market for goods or services. Evidence reflecting the operation of the market, including the term’s role within the market, may well be more important than [mere] dictionary definitions.”)

sources are invented to capture the usage of these terms, a *per se* rule that precludes consideration of empirical evidence would harm the very balance that trademark law seeks to achieve.

1.3 An abundance of relevant empirical evidence is available to assist courts in assessing the potential genericness of a “[generic].[tld]” term.

Empirical evidence of the relevant public’s understanding of a “[generic].[tld]” term exists in a variety of print and digital forms. The empirical sources described in this brief are archival in nature, allowing observation of the historical and current usage of a term.⁵ As such, they offer a distinct and complementary perspective to that provided by consumer surveys.⁶ Archival sources collect evidence

⁵ “[Historical analysis] is based on neutral observers and factual data recorded at the time [an event occurs].” Joseph Johnson & Gerard J. Tellis, *Drivers of Success for Market Entry into China and India*, 72 J. MKTG. 1, 6 (2008).

⁶ “The benefits of using the historical method include lower survival and self-report bias, ability to assess causality through longitudinal analysis, and new insights from a fresh reading of history.” Ashish Sood & Gerard J. Tellis, *Technological Evolution and Radical Innovation*, 69 J. MKTG. 152, 155 (2005) (hereinafter, “Sood and Tellis 2005”).

of consumers' perceptions and usage in natural or real-world settings.⁷ This "ecological validity," as it is known in marketing and other research disciplines, has the virtue of existing independent of any researchers' efforts to study a particular phenomenon.⁸

Archival sources may also be used to examine contemporaneous uses of a term at past points in time. This benefit may be of particular importance in disputes where it is alleged that the term of interest

⁷ "Consumer perception undergirds every major trademark doctrine. How consumers respond to products, trademarks, and branding efforts are topics about which empirical data is readily ascertainable." Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 2018 (2019). "[H]istorical method has several strengths that make it appropriate for studying marketing phenomena...First, the method is helpful in collecting and evaluating data for longitudinal analysis... it can be used to corroborate findings from existing data (e.g., PIMS) or obtain new or more precise measures of constructs in quantitative models... it provides an approach for dealing with complex phenomena that cannot be studied adequately in a laboratory or with readily available data." Peter N. Golder, *Historical Method in Marketing Research with New Evidence on Long-Term Market Share Stability*, 37 J. MKTG. RES. 156, 167 (2000) (hereinafter, "Golder 2000").

⁸ Golder (2000) notes the authenticity of archival documents written "for the sole purpose of making a record." Golder 2000, at 160. See also John E.G. Bateson & Michael K. Hui, *The Ecological Validity of Photographic Slides and Videotapes in Simulating the Service Setting*, 19 J. CONS. RES. 271-81 (1992).

previously functioned as a common category name, but subsequently became associated with a private entity.⁹ To the extent that the term in question was *ever* used as the common category name, residual evidence of such usage likely would persist in the archival records. As one prominent example, the Internet Archive’s “Wayback Machine”¹⁰ enables researchers to access voluminous historical versions of prominent webpages that would not be available through contemporary search engines.¹¹

⁹ “An understanding of temporal changes requires attention to the time order of events that is best obtained by the historical approach.” Rajesh K. Chandy & Gerard J. Tellis, *The Incumbent’s Curse? Incumbency, Size, and Radical Product Innovation*, 64 J. MKTG. 1, 5 (2000). *See also* Jake Linford, *A Linguistic Justification for Protecting ‘Generic’ Trademarks*, 17 YALE J. L. & TECH. 110, 130-145 (2015) (describing semantic shift in the context of generic terms and trademarks).

¹⁰ Internet Archive, available from <https://archive.org/web/>.

¹¹ “For any researcher needing information about the history of a website—whether on a one-off basis or for large-sample analysis—the Internet Archive is the natural choice. With copies of 150 billion pages dating back to 1996 (Internet Archive 2011), the Internet Archive provides no-charge access to prior versions of most online materials, facilitating all manner of historic analysis. Seamans and Zhu (2010) use the Internet Archive to gather historic data on Craigslist postings to explore relationships between the entry of Craigslist into a market and newspaper circulation and pricing.” Benjamin Edelman, *Using*

To make the best use of evidence from the public historical records, courts may find it helpful to examine three sources in particular: “voice of the consumer” analyses; reports from a wide range of media sources; and materials and filings available from industry participants themselves.¹²

1.3.1 The “*voice of the consumer*” documents the public understanding and use of generic and non-generic terms.

Empirical evidence generated by *consumers* in the ordinary course of their activities is commonly characterized in marketing science (and practice) by the term “voice of the consumer.”¹³ Granular and

Internet Data for Economic Research, 26 J. ECON. PERSPECTIVES 189, 195 (2012).

¹² This brief focuses on the primary empirical sources used today. Significantly, however, the *per se* rule advanced by the USPTO would also preclude future courts from considering empirical evidence that may be generated by technologies *yet to be invented*. These unforeseen sources potentially could yield additional probative empirical evidence of genericness. For example, prior to the advent of the internet and social media, courts may not have anticipated this additional source of empirical evidence of consumers’ perceptions and usage.

¹³ The voice of the consumer is “a hierarchical set of ‘customer needs’” and has become “a key criterion in total quality

wide-ranging evidence of consumer perceptions and usage can be found in the public record of consumer discussions of products or services, in the form of testimonials, online reviews, discussion boards, social media postings, online search queries, and consumer engagement metrics from search engines.¹⁴ It is common for companies to track the “voice of the consumer” in their ordinary course of business via consumer tracking studies; such internal studies are typically available in litigation and are relevant for assessing how consumers perceive and use the term of interest.

management.” Abbie Griffin & John R. Hauser, *The Voice of the Customer*, 12 MKTG. SCI. 1, 2 (1993).

¹⁴ “Facilitated by developments in online technologies, consumers can easily contribute their thoughts and opinions to the marketplace through discussion groups, product ratings and reviews, and blogs.” Wendy W. Moe & David A. Schweidel, *Online Product Opinions: Incidence, Evaluation, and Evolution*, 31 MKTG. SCI. 372, 372 (2012). “User-generated content (UGC), such as online reviews, social media, and blogs, provides extensive rich textual data and is a promising source from which to identify customer needs more efficiently. UGC is available quickly and at a low incremental cost to the firm.” Artem Timoshenko & John R. Hauser, *Identifying Customer Needs from User-Generated Content*, ELSEVIER BV 1, 6 (2018). *See also* Matthew Gentzkow & Jesse M. Shapiro, *Media Bias and Reputation*, 114 J. POL. ECON. 280, 308 (2006); Gita V. Johar, Michel T. Pham, & Kirk L. Wakefield, *How Event Sponsors Are Really Identified: A (Baseball) Field Analysis*, J. ADV. RES., 183, 184 (2006).

To the extent that consumers use and understand a term as a common category name, that will often manifest itself in these public sources.¹⁵ For example, a consumer’s online review may assess the virtues of a particular purchased product or service relative to other products or services in the category by making use of both a term that serves as common category name and terms specific to individual brands.

1.3.2 *Media reports can be used to supplement and augment “voice of the consumer” evidence.*

Empirical evidence generated in *media reports* provides complementary evidence to the “voice of the consumer.”¹⁶ Media sources serve as observers and

¹⁵ “Evidence of genericness may take the form of direct testimony of members of the relevant public or direct evidence of use; consumer survey or poll results; use of the term in books, newspapers, or periodicals or in dictionaries and other texts on contemporary word-usage; use of the term by the trademark registrant or competitors; or any of the preceding together with expert testimony derived from the foregoing sources.” Robert E. Moore, *From Genericide to Viral Marketing: on ‘Brand’*, 23 LANGUAGE & COMMUN 331, 345 (2003).

¹⁶ “[D]ictionary definitions, usage in the media, testimony of persons in the trade, and finally and less circumstantial, consumer surveys” have been used by courts to consider genericness. Scott Brown, *I Tweeted on Facebook Today: Re-*

reporters of consumer perception and usage. Relevant media sources include newspapers, magazines, and trade journals.¹⁷ Certain elements of social media may also perform similar roles for observing and reporting usage.

A term used by consumers may be referenced in media reports once it has reached a certain threshold of prominence.¹⁸ Such prominence could be either as a common category name or as an identifier of an individual entity or brand. In certain instances, a brand identifier may transition into a common category name, a phenomenon referred to in the marketing (and legal) literature as “genericide.”¹⁹ To

Evaluating Trademark Genericide of Internet-Based Trademarks, 7 I/S 457, 462 (2012) (hereinafter “Brown 2012”).

¹⁷ “Newspaper or magazine reports are often rated high in authenticity.....” Golder 2000, at 160.

¹⁸ “[N]ewspapers perform for a wide, generalized audience, which means that historical analysis of newspaper text can give us an idea of the shared social meaning of a consumption practice...As cultural objects, newspaper articles both reflect and further influence public opinion.” Ashlee Humphreys, *Semiotic Structure and the Legitimation of Consumption Practices: The Case of Casino Gambling*, 37 J. CONS. RES. 490, 493-94 (2010).

¹⁹ “A number of factors may account for the linguistic deterioration of trademarks into generic words: misuse of the mark by its holder in advertising and labeling, insufficient policing, improper use of the trademarked word, or the absence of a short and simple alternative name for the product. Most

the extent that such a transition occurs, or vice versa, media often bear witness to these transitions.²⁰

1.3.3 *Other industry participants, including the company seeking protection and its competitors, generate materials that can be useful in distinguishing generic from non-generic terms.*

Informative empirical evidence may also be generated by *other industry participants*, potentially including the company seeking protection of the term, as well as its competitors, and where applicable, distributors, retailers, and third-party service

significant is the propensity of trademark owners to encourage the public to adopt their marks as generic “household” words ... Nevertheless, a firm may follow certain procedures that will prevent ‘genericide.’” Dorothy Cohen, *Trademark Strategy*, 50 J. MKTG. 61, 69 (1986). *See also*, Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1024-25 (2012).

²⁰ “Generic usage of a mark in media, such as trade journals and newspapers, can be a ‘strong indication of the general public’s perception’ that a term is generic.” Brown 2012, at 462, citing *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95 (2d Cir. 1989).

providers.²¹ Company websites, press releases, print advertising, television, and online venues, as well as annual and quarterly reports, SEC filings, and other corporate presentations, can inform fact finders as to whether a term is used to designate an individual competitor in the market or the common category name.²² In addition, industry analysts and regulators, in their roles as market monitors, are likely to adopt the terms and associated meanings used by consumers and industry participants. Consequently, this usage will be embedded in publicly available documents such as analyst reports, financial reports, and findings from regulatory or government investigations. Such reports from industry

²¹ “The role of intermediaries, retailers, resellers, and other installers is not insignificant either, since these are often the main actors trivializing the use of a brand name.” Bernard Cova, *Re-branding Brand Genericide*, 57 BUSINESS HORIZONS 359, 361 (2014). A large body of marketing and branding literature exists using newspaper data and press releases, as well as company annual reports, articles, and websites. See, e.g., Ashlee Humphreys, *Megamarketing: The Creation of Markets as a Social Process*, 74 J. MKTG. 1 (2010) (hereinafter “Humphreys 2010”); Ruby P. Lee & Rajdeep Grewal, *Strategic Responses to New Technologies and Their Impact on Firm Performance*, 68 J. MKTG. 157 (2004).

²² For example, Sood and Tellis (2005) used “technical journals, industry publications, white papers published by R&D organizations, and annual reports of industry associations” to analyze technological evolution and competition. Sood and Tellis 2005, at 156.

participants and monitors may provide additional useful evidence on consumers' perceptions and usage with respect to potential genericness.

1.4 Reliable methodologies exist to analyze the abundance of empirical evidence to assess the potential genericness of terms.

Academic researchers in the field of marketing regularly employ a wide range of reliable and certified methodologies to analyze the types of archival sources described above.²³ For example, web scraping has been used to compile relevant online customer reviews; textual analysis algorithms have been developed to analyze online customer reviews;²⁴ and

²³ See, e.g., Gerard J. Tellis, Stefan Stremersch, & Eden Yin, *The International Takeoff of New Products: The Role of Economics, Culture, and Country Innovativeness*, 22 MKTG. SCI. 188 (2003); Robert Aitken & Adriana Campelo, *The Four Rs of Place Branding*, 27 J. MKTG. MGMT. 913 (2011); Humphreys 2010; Peter N. Golder & Gerard J. Tellis, *Growing, Growing, Gone: Cascades, Diffusion, and Turning Points in the Product Life Cycle*, 23 MKTG. SCI. 207 (2004).

²⁴ For example, Ghose, Ipeirotis, and Li (2012) analyzed user-contributed opinions and user-generated product reviews, and Ghose and Yang (2009) and Yang and Ghose (2010) analyzed paid search advertising. Anindya Ghose, Panagiotis G. Ipeirotis, & Beibei Li, *Designing Ranking Systems for Hotels on Travel Search Engines by Mining User-Generated and Crowdsourced Content*, 31 MKTG. SCI. 493 (2012); Anindya Ghose & Sha Yang, *An Empirical Analysis of Search Engine Advertising: Sponsored*

the historical research method is frequently applied to compile, critically evaluate, and analyze all types of archival empirical evidence.²⁵ These and other methods²⁶ have been certified as scientifically valid during the peer-review process required for acceptance in academic publications.²⁷

Search in Electronic Markets, 55 MGMT. SCI. 1605 (2009); Sha Yang & Anindya Ghose, *Analyzing the Relationship Between Organic and Sponsored Search Advertising: Positive, Negative, or Zero Interdependence*, 29 MKTG. SCI. 602 (2010).

²⁵ “Historical analysis can augment our considerable social science knowledge about ongoing or stable patterns in consumer behavior and allow us to analyze patterns of change, understand volatile episodes, and establish causal linkages between such episodes.” Ruth Ann Smith & David S. Lux, *Historical Method in Consumer Research: Developing Causal Explanations of Change*, 19 J. CONS. RES. 595, 606 (1993).

²⁶ For example, academics have used a variety of statistical methodologies to analyze archival data. Debanjan Mitra & Peter N. Golder, *Whose Culture Matters? Near-Market Knowledge and Its Impact on Foreign Market Entry Timing*, 39 J. MKTG. RES. 350 (2002). Jonathan D. Bohlmann, Peter N. Golder, & Debanjan Mitra, *Deconstructing the Pioneer’s Advantage: Examining Vintage Effects and Consumer Valuations of Quality and Variety*, 48 MGMT. SCI. 1175 (2002). Dmitri G. Markovitch & Peter N. Golder, *Findings—Using Stock Prices to Predict Market Events: Evidence on Sales Takeoff and Long-Term Firm Survival*, 27 MKTG. SCI. 717 (2008).

²⁷ “[H]istorical analysis...offers well-formed models and tests of these models...A prime strength of historical analysis is its use of independent and dependent variables very useful and appealing for theorists, executives, and both marketing and

Knowledge generated from empirical evidence using methodologies meeting the standards of scientific validity can provide a number of benefits for fact finders.

a) *Triangulation*. Triangulation across multiple data sources captures the variety of voices in the marketplace: consumers, producers, reporters, analysts, and other social actors.²⁸

b) *Interpretability*. These data are easy to present and understand because they are derived from people's everyday language and lives.²⁹ Data

financial analysts." Arch G. Woodside, CASE STUDY RESEARCH: THEORY, METHODS AND PRACTICE 30-31 (2010).

²⁸ "Is there corroboration from an equally credible witness?" Golder 2000 at 159. "Triangulation is broadly defined by Denzin (1978: 291) as 'the combination of methodologies in the study of the same phenomenon.'" Todd D. Jick, *Mixing Qualitative and Quantitative Methods: Triangulation in Action*, 24 ADMIN. SCI. Q. 602, 602 (1979). See also, John U. Farley, Donald R. Lehmann, & Alan Sawyer, *Empirical Marketing Generalization Using Meta-Analysis*, 14 MKTG. SCI. G36 (1995).

²⁹ Interpretability is integral to drawing reliable conclusions on consumer behavior. For example, Baca-Motes et al. (2013) ensured interpretability by observing hotel guest behaviors while they were unaware of the experiment. Katie Baca-Motes, Amber Brown, Ayelet Gneezy, Elizabeth A. Keenan, & Leif D. Nelson, *Commitment and Behavior Change: Evidence from the Field*, 39 J. CONS. RES. 1070, 1070 (2013).

may be compiled into chronologies and descriptive statistics, or even, in some cases, modeled.³⁰

c) *Authenticity*. Data sources can be evaluated on authenticity criteria, e.g., temporal or geographic proximity to an event, purpose of the written record, reputation of source, expertness of reporter, reliance on primary sources.³¹

d) *Credibility*. Data elements from authentic sources can be evaluated on credibility criteria, e.g., personal interests, biases, independence.³²

e) *Reliability*. Reliability means that the methodological approaches employed will produce

³⁰ “Interpretive criticism: Evaluate and determine the author’s meaning.” Golder 2000, at 159. For example, empirical data can be used to model “changing consumer needs.” Hai Che, Tülin Erdem, & T. Sabri Öncü, *Consumer Learning and Evolution of Consumer Brand Preferences*, 13 QUANTITATIVE MKTG. & ECON., 173, 174 (2015).

³¹ “Are witnesses reliably recorded? Investigation of authorship: Who wrote the document, and where, when, and under what circumstances was it written? Is the author able to report correct information? Classify authenticity of sources based on temporal and geographic proximity to event being recorded, purpose of written record, and expertness of author.” Golder 2000, at 159.

³² “Is the author willing to report correct information, or are there personal interests or biases? Evaluate independence of observations.” Golder 2000, at 159.

consistent results.³³ The wide variety of data sources and data elements within each source make it easy to assess the reliability of a study's findings and the conclusions that are drawn from them.³⁴

The empirical evidence discussed above derives from natural settings and does not rely on researchers establishing direct contact with consumers. Certain other *amici* caution that in response to a direct question, consumers potentially could classify a *generic* “[generic].[tld]” term as a *non-generic* brand name by virtue of “the general public understanding that any given string that ends in .com will always resolve to a single website.”³⁵ Regardless whether those *amici* are correct or incorrect with respect to direct-question surveys, the empirical evidence discussed in this brief is not vulnerable to such a critique, in that recognition of a term as a brand name

³³ Consistency allows for the “generalizability of research results beyond the lab into other contexts.” Russell S. Winer, *Experimentation in the 21st Century: The Importance of External Validity*, 27 J. ACAD. MKTG. SCI. 349, 349 (1999).

³⁴ For example, Srinivasan, Lilien, and Rangaswamy (2004) used multiple sources to increase the reliability of their data. Raji Srinivasan, Gary L. Lilien, & Arvind Rangaswamy, *First in, First out? The Effects of Network Externalities on Pioneer Survival*, 68 J. MKTG. 41, 46 (2004).

³⁵ Brief of Trademark Scholars as *Amici Curiae* in Support of Neither Party, at 19.

in archival empirical evidence reflects the “true trademark meaning” that those *amici* recognize as protectable.³⁶ For example, media sources would recognize a “[generic].[tld]” term as indicative of a specific single company only if the company had achieved sufficient prominence to warrant such recognition.

Precision and rigor are, of course, critical for analyzing empirical evidence. In analyzing the public record, care should be taken to distinguish usage of the term in question by itself from usage of the term or part of the term as a component of a separate and different term. For example, properly structured analysis of empirical evidence in media articles would have appropriately recognized American Airlines and AmericaWest Airlines as distinct terms identifying different entities, even though “America” and “Airlines” are shared elements between the terms. More germane to the current dispute, properly structured analysis of empirical evidence would distinguish between use of BOOKING.COM by itself and use of a longer term containing it, e.g. HOTELBOOKING.COM.

³⁶ Brief of Trademark Scholars as *Amici Curiae* in Support of Neither Party, at 18.

The empirical approaches discussed here are aligned with trademark law’s concern for, on the one hand, respecting the rights of parties to advertise their goods as what they are, while, on the other hand, respecting the rights of trademark owners to distinguish their goods from those of others. Empirical evidence concerning the term at issue, including whether it has been used to define the category or has a primary significance associated with a single source, bears directly on its genericness or protectability and should be considered by a fact-finder in determining whether the term may be appropriated by a single entity.

CONCLUSION

Amici urge the Court to reject the proposed *per se* rule and instead to consider scientifically valid empirical evidence that can assist in determining the “primary significance [of a term] to the relevant public.” Accepting the proposed *per se* rule would foreclose the opportunity for courts to consider such empirical evidence in evaluating whether a “[generic].[tld]” name is perceived by consumers as a generic category name in the context of a particular case—despite the clearly probative nature of such evidence.

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APPENDIX

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