

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 *AMICI CURIAE* SURVEY
SCHOLARS AND CONSULTANTS IN
SUPPORT OF RESPONDENT**

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INTEREST OF AMICI CURIAE¹

Amici curiae are academics who teach at leading colleges and universities throughout the United States and consultants who specialize in the analysis of consumer perceptions, in particular in the field of trademark law. Amici have written extensively in the field of surveys and marketing, including consumer perceptions and behavior, brands and branding, and applications of marketing-research methods such as consumer surveys to analyze consumer perceptions. They write to bring to the Court's attention consumer-perception analysis and evidence relevant to assessing whether a domain name is generic.

Amici are as follows:

- Cornerstone Research is a consulting company that specializes in designing, conducting, and analyzing consumer surveys, as well as economic and financial analysis in commercial litigation matters and regulatory proceedings.
- NERA Economic Consulting is a global firm of experts dedicated to applying survey methods and other rigorous, quantitative principles to complex business and legal challenges.
- Dominique M. Hanssens is the Distinguished Research Professor of Marketing at the

¹ Pursuant to Supreme Court Rule 37.6, amici curiae state that no counsel for any party authored this brief in whole or in part and that no entity or person, aside from amici curiae, their members, and their counsel, made any monetary contribution toward the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.3, counsel of record for all parties have consented to this filing.

Anderson School of Management, University of California, Los Angeles.

- Barbara E. Kahn is the Patty and Jay H. Baker Professor of Marketing at The Wharton School, University of Pennsylvania.
- George Mantis is President of the Mantis Group, which designs, executes and reports on consumer surveys for use in trademark litigation.
- Sara Parikh is President of Willow Research, which designs, executes and reports on consumer surveys for trademark litigation and commercial purposes.
- Dave Reibstein is the William Stewart Woodside Professor and Professor of Marketing at The Wharton School, University of Pennsylvania.
- Joel Steckel is Professor of Marketing and Vice Dean for Doctoral Education at the NYU Stern School of Business.
- Ronald T. Wilcox is the NewMarket Corporation Professor of Business Administration at the Darden School of Business, University of Virginia.

Amici have no financial stake in any of the parties to this litigation or the result in this case, other than their scholarly interest in the correct application of trademark law and consumer research and survey principles.

SUMMARY OF ARGUMENT

Courts determine whether a trademark is generic by analyzing its primary significance to consumers. It is well established that marks should be analyzed as a whole. Thus, when a mark is a composite of two or more terms, it is the meaning of the full mark that counts, not the meanings of its individual components.

The government asks this Court to treat domain names differently from all other marks. Whereas all other composite marks are analyzed for their primary significance as a whole, the government urges the Court to adopt a new rule for domain names. According to the government, if a domain name's root (second-level domain ("SLD")) and suffix (top-level domain ("TLD")) are each generic when viewed in isolation, that means the domain name is generic too. But analyzing consumer perception of a composite mark's root and suffix individually is not the same as analyzing the mark as a whole. The government's suggested approach is therefore inconsistent with settled law.

The Court should treat domain names like every other type of mark. How consumers perceive the mark should be assessed on a case-by-case basis. Survey evidence should weigh heavily in this analysis, as it is the preferred form of evidence of consumer perception. Market evidence of consumer usage and understanding of the mark should be considered as well.

Here, the evidence demonstrates that BOOKING.COM is not generic. Respondent conducted a "Teflon" survey, which is the most accepted type of survey for testing genericness. In a Teflon survey, survey participants are given a "mini-course" about the difference between a generic term and a brand name and

then take a “mini-test” to confirm they understand the distinction. Participants who pass this test are qualified to participate in the survey and are then shown different terms, including the mark at issue, and are asked to categorize them as a generic term or a brand name. In Respondent’s survey, nearly 75% of qualified participants answered that BOOKING.COM is a brand, well above the majority threshold that supports a finding that the mark is not generic.

The Teflon survey’s finding is buttressed by market evidence of consumer usage and understanding of BOOKING.COM. Consumers did not begin using the term “booking.com” in Google searches until after Respondent adopted that term, indicating that it was not a pre-existing term commonly used to refer to the genus of online hotel-reservation services. Likewise, online search data further reveal that very few consumers use this term for purposes other than to find out information about Respondent.

ARGUMENT

Surveys and other evidence of consumer perception are integral to evaluating trademark rights because “in trademark law, validity and infringement are issues of public perception.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:158 (5th ed. 2019) (“McCarthy”). For this reason, and others discussed below, Amici oppose the government’s proposed per se rule that domain names consisting of the combination of a generic domain name suffix (TLD) and generic domain name root (SLD) necessarily result in a generic mark. This approach would lead courts to hold that marks like BOOKING.COM are generic even in the face of irrefutable evidence that consumers primarily

perceive the mark as a brand. That would be a mistake. The better approach is to assess the genericness of domain-name trademarks on a case-by-case basis, as courts do with all other marks, taking into account all competent evidence of how consumers perceive the mark in question.

I. THE COURT SHOULD EVALUATE WHETHER A DOMAIN NAME IS GENERIC BY ANALYZING ITS PRIMARY SIGNIFICANCE TO CONSUMERS WHEN VIEWED AS A WHOLE

Courts assess a mark's genericness by analyzing whether its "primary significance" to consumers is as a term for a genus of goods or services or as a brand. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938); *Elliott v. Google, Inc.*, 860 F.3d 1151, 1156 (9th Cir. 2017); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015); *Nartron Corp. v. STMICROELECTRONICS, Inc.*, 305 F.3d 397, 404–05 (6th Cir. 2002); *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997); *Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996).

When applying the primary significance test to a composite mark, courts analyze the mark as a whole to determine its meaning to consumers. *See, e.g., Estate of PD Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545–46 (1920) ("The commercial impression of a trademark [should be] derived from it as a whole, not from its elements separated and considered in detail."); *Courtenay Commc'ns Corp. v. Hall*, 334 F.3d 210, 215 (2d Cir. 2003) (holding that a composite mark "must be treated as a whole for classification purposes"); *Princeton Vanguard*, 786 F.3d at 969 (holding that the Board erred by analyzing the terms PRETZEL and CRISPS

individually when the record was replete with evidence of the public's perception of the mark as a whole).

Even if a composite mark consists entirely of generic components, it may be protectable if the “whole [is] greater than the sum of its parts.” *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1348 (Fed. Cir. 1999). *See also Clicks Billiards, Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001) (“Words which would not individually become a trademark may become one when taken together” (quoting *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 379 (7th Cir. 1976))).

The government urges the Court to deviate from this settled law by adopting a blanket rule that, in the case of domain names, adding a generic root (SLD) to a generic suffix (TLD) necessarily results in a generic and non-registrable mark, arguing that this is the logical extension of *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), *see* Pet. Mem. 18, despite that *Goodyear* pre-dated the Lanham Act and did not apply the primary significance test. But .COM is always generic for a domain name when viewed in isolation, so the government’s test collapses to merely looking at whether the domain name’s root is generic when it is viewed in isolation. That cannot be right.

Analyzing every piece of a mark in isolation is not the same as analyzing the mark as a whole. Thus, courts have rejected similar attempts to shortcut the genericness analysis. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345 (Fed. Cir. 2001) (rejecting argument that “because it is undisputed that both (888) and ‘MATRESS’ are generic, joining the two together creates a term with no additional meaning than the individual meanings of each of its constituent parts”);

In re Am. Fertility Soc’y, 188 F.3d at 1347 (“The Board cannot simply cite definitions and generic uses of the constituent terms of a mark . . . in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole”); *Berner Int’l Corp. v. Mars Sales Co.*, 987 F.2d 975, 983 (3d Cir. 1993) (“Even though the words ‘air’ and ‘door’ are generic enough in isolation, the phrase ‘air door’ may very well have a unique, non-generic meaning to the relevant consuming population.”).

Just like with other types of marks, combining a generic root with a generic suffix can produce a composite domain name with its own meaning that is not generic. *See, e.g., In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (holding that .COM expanded the meaning of STEELBUILDING to include goods and services beyond steel building, namely building or designing steel structures on a website); *see also* App. to Resp’t Br. (citing domain name marks registered by the PTO, including FLIGHTS.COM for travel agency services, and CONCERT.COM for an online ticket agency for sporting and entertainment events). Accordingly, domain names should be treated like all other composite marks and analyzed as a whole—not in pieces—to determine their primary significance to relevant consumers.

II. RESPONDENT’S TEFLON SURVEY RELIABLY TESTED CONSUMER PERCEPTION OF BOOKING.COM AND FOUND THAT THE MARK IS PRIMARILY PERCEIVED AS A BRAND

The primary significance test used to evaluate whether a mark is generic is focused on how a term is perceived in the minds of the relevant consuming public. McCarthy § 12:4. Scholars have recognized that “a brand

is something that resides in the minds of consumers.”² A brand is “a distinguishing name and/or symbol (such as a logo, trademark, or package design) intended to identify the goods or services of either one seller or a group of sellers, and to differentiate those goods or services from those of competitors.”³ Whether or not marks associated with a brand serve this identifying purpose depends on consumers’ ability to recognize the brand and to retrieve information relating to the brand from their memory.⁴ Thus, a determination of whether a mark is a brand necessitates analysis of consumer perception.

“One of the most scientific methods of determining the mental associations of the relevant purchaser class is to conduct a survey of the purchasers themselves.” McCarthy § 15:42. Surveys provide a rigorous means to observe, evaluate, and quantify the mental state of an aggregate group of people. Shari Seidman Diamond, *Reference Guide on Survey Research*, Reference Manual on Scientific Evidence (3d ed. Fed. Judicial Ctr. 2011) (“Diamond”), at 364. In litigation, surveys have been used in a variety of ways, including to understand consumer beliefs and preferences, to establish or refute discrimination claims, and to establish or refute commonality claims in class-action matters. *See id.* at 364-65.

² Kevin Lane Keller, *Strategic Brand Management: Building, Measuring, and Managing Brand Equity* 36 (4th ed., Pearson Educ. Ltd., Essex, Eng. 2013) (“Keller”).

³ David A. Aaker, *Managing Brand Equity: Capitalizing on the Value of a Brand Name* 7 (Free Press, New York, N.Y.).

⁴ Keller, *supra* note 2, at 71–76.

In Lanham Act cases, survey evidence is often pivotal because trademark law sits squarely at the intersection of legal protections and consumer perceptions. *See* McCarthy § 32:158 (“[I]n trademark law, validity and infringement are issues of public perception”); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 422 (2015) (“The commercial impression that a mark conveys must be viewed through the eyes of a consumer” (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253 (Fed. Cir. 2012))). Indeed, surveys have become “almost de rigeur” in trademark litigation over genericness, McCarthy § 12:14, and have been recognized as the preferred form of evidence of a mark’s primary significance. *Princeton Vanguard*, 786 F.3d at 969; *Berner*, 987 F.2d at 982; *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 118 n.4 (1st Cir. 2006).

There are two primary survey approaches used to evaluate genericness: the “Teflon” format and the “Thermos” format. The Teflon format, which is the type of survey Respondent conducted here, derives its name from the approach used in *E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975). It is the “most judicially accepted format for testing for genericness.” McCarthy § 12:16.⁵

⁵ The Thermos survey derives its name from the approach used in *American Thermos Products Co. v. Aladdin Industries, Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d sub nom. King-Seely Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963). In a Thermos survey, participants are asked to review a description of a product and then to imagine going to a store and to ask for the product. This “what would you ask for” type survey has been accepted, but has been criticized for its potential to overestimate genericness in the case of a very strong trademark (e.g., COKE). *See* McCarthy § 12:15.

In a Teflon survey, potential survey participants are screened to make sure they are representative of the relevant consuming public (i.e., potential purchasers of the category of goods or services). Here, Respondent's survey was conducted among 400 consumers who search for or make hotel or travel arrangements online. Joint Appendix ("JA") 43.

Once a participant has been qualified for the survey, the survey "begins with a brief lesson explaining the difference between brand names and common names." *Elliott v. Google, Inc.*, 860 F.3d 1151, 1160 n.7 (9th Cir. 2017). This component of the survey is often referred to as a "mini-course" in the distinction between a generic term and a brand name. *E.T. Browne Drug Co. v. Cococare Prods.*, 538 F.3d 185, 195 (3d Cir. 2008) (citing McCarthy § 12:16).

To ensure that participants have understood the "mini-course" and are qualified to make distinctions between brand and generic names (based of course on their own perceptions), they next undergo a "mini-test" where they review "terms (such as 'washing machine' and 'Chevrolet'), asking whether they are common names or brand names." *E.T. Browne*, 538 F.3d at 195. Participants who do not give correct answers to each of the "test" genericness example questions are excluded from the survey, ensuring that the remaining participants understand the distinction between generic terms and trademarks and that participants are paying attention. McCarthy § 12:16. Here, participants were asked separately whether KELLOGG and CEREAL were brand or common names. JA 46. Only participants who correctly answered by indicating that KELLOGG was a brand name, and CEREAL was a common name, in response

to the respective questions, were allowed to continue. *Id.* This procedure ensured that all participants who ultimately took the survey about the relevant term, BOOKING.COM, understood the task at hand and were paying sufficient attention to the survey.

The remaining participants who “pass” the mini-test are then asked whether a series of product or service names—including the disputed mark—are brand names or common names. *E.T. Browne*, 538 F.3d at 195; McCarthy § 12:16; Diamond at 401. In Respondent’s survey, participants were shown seven terms, including BOOKING.COM. Three of these were trademark (brand name) terms, three were generic (common name) terms, and one was BOOKING.COM. JA 46–47. The terms included ETRADE.COM and WASHINGMACHINE.COM as comparators of a brand name and common name, respectively, that include DOT-COM. *Id.* at 50. As was the case in the mini-test, for each term, participants were asked to indicate whether the term is a trademark (brand name), or a generic term (common name). *Id.* at 46–47.⁶

⁶ To avoid bias, the order of the seven terms was rotated among participants. JA 48–50. In addition, two versions of the survey were conducted. In the first version, taken by half of the participants, the mini-course began with an explanation of brand names, whereas in the second version, taken by the other half of the participants, the explanation about common names came first. *Id.* at 43–44. In the first version of the survey, when participants were asked about a term, brand name was listed before common name in the answer choices, and vice versa in the second version. *Id.* at 50–51. These are standard precautions to prevent response-order bias. *See* Diamond at 396. In addition, Teflon surveys also typically give participants the option to answer “Don’t know,” as was the case here. JA 47.

How the majority of participants answer that they perceive the disputed mark indicates whether it is a brand name or a generic name. McCarthy § 12:14. In other words, majority understanding controls. *Id.* § 12:6; E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 Trademark Rep. 1118, 1142 n.91 (2009). Across the 400 survey participants in Respondent's survey, 74.8% indicated that BOOKING.COM was a brand name. JA 53. This is well over the majority (>50%) threshold needed to establish that the mark is not a generic term.

As for the benchmark comparators, participants correctly identified the three other brand-name comparators as brand names, including ETRADE.COM. JA 65. Likewise, participants correctly identified the three generic terms as such, including WASHINGMACHINE.COM. *Id.* at 66. The results for the benchmark terms validate the survey's reliability and indicate that the results are not due to guessing. In addition, these results confirm that the survey does not simply produce results indicating that any DOT-COM name is a brand name. Rather, the survey reflects that consumers generally do draw a distinction between brand and common DOT-COM names.

Professor Rebecca Tushnet and other scholars (the "Trademark Scholars") offer several criticisms of Respondent's survey in their Amicus Brief. They ignore the fact that the government has waived any objection to the survey's validity or methodology. Pet. App. 16a. In any event, those criticisms are unpersuasive.

The Trademark Scholars' first criticism is that participants were "trained" to recognize DOT-COM terms as brand names. Trademark Scholars' Br. 18–19. This is supposedly evidenced by the fact that 33% of participants said that WASHINGMACHINE.COM is a brand name, whereas all or nearly all participants shown SUPERMARKET and SPORTING GOODS recognized those terms as common names. *Id.* This is not the relevant takeaway from the results for WASHINGMACHINE.COM. As noted above, what matters is that a majority of participants thought WASHINGMACHINE.COM was a generic term, whereas a majority answered that BOOKING.COM was a brand name.

The Trademark Scholars' second criticism is that the 74.8% "gross" recognition of BOOKING.COM is not the true measure of the recognition level as a brand name, but instead the "net" recognition should be determined by subtracting out the percentage of participants who thought WASHINGMACHINE.COM was a brand name from the percentage who opined that BOOKING.COM is a brand. Trademark Scholars' Br. 20-21. This is counter to standard and accepted practice for a Teflon survey. While the Trademark Scholars cite McCarthy for the proposition that majority use of a term controls, McCarthy in this passage is not talking about net usage. *See McCarthy* § 12:6.

For several reasons, in a Teflon survey it is unnecessary and improper to subtract one result from another to derive a "net" level of association. First, as previously explained, the Teflon survey design includes a mechanism, i.e., the mini-test, to exclude participants who are potentially guessing or inattentive. This step

ensures that the answers given later in the survey are more reliable.

Second, controls used to net or subtract gross rates are used only in surveys designed to test a causal proposition. Diamond at 397. For example, in a likelihood of confusion survey, half of the participants are typically placed in a “control group” that answers the same questions as the “test group,” but the control group is shown a stimulus that is different from the stimulus being tested in the “test group.” *Id.* at 398–99. This allows the researcher to assess whether confusion measured by the survey is caused by the disputed mark, as opposed to other factors, such as pre-existing beliefs. *Id.* But in a Teflon survey, the goal is not to determine *why* consumers view a particular term as a brand or a generic, but rather to establish *how* the majority views a particular term, regardless of the reasons for the belief. As a result, it is accepted practice that control groups are not used in Teflon surveys, nor are the response rates for other terms subtracted to derive a “net” rate of association. *See* Jacob Jacoby, *Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys*, 92 Trademark Rep. 890 (2002), § IV.A.

The sole takeaway from the results for WASHINGMACHINE.COM is that they confirm participants could distinguish between brand names and common names and thus validate the survey’s finding that the consuming public views BOOKING.COM as a brand.

III. BOOKING.COM IS PRIMARILY USED ON THE INTERNET AS A BRAND NAME

The survey's results are further validated by other data. To determine a mark's primary significance to consumers, courts (and the PTO) consider evidence from "any competent source." *Princeton Vanguard*, 786 F.3d at 965 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985)); *see also Schwan's IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 976 (8th Cir. 2006) (affirming finding that BRICK OVEN was generic where evidence showed the term was "commonly used" before either party began using it to describe their pizza); *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (holding that usage of a term in newspapers and magazines is "a strong indication of the general public's perception" of the mark). In the case of domain names—and particularly in the case of a genus that involves e-commerce (e.g., online hotel-reservation services)—the internet is a logical place to look to see how consumers use the term.

One resource that courts should consider in this context is a database maintained by Google called Google Trends, which indexes the relative frequency of search terms used on Google over the period from 2004 to the present.⁷ These data provide a reliable way to assess how consumer usage of a term on the

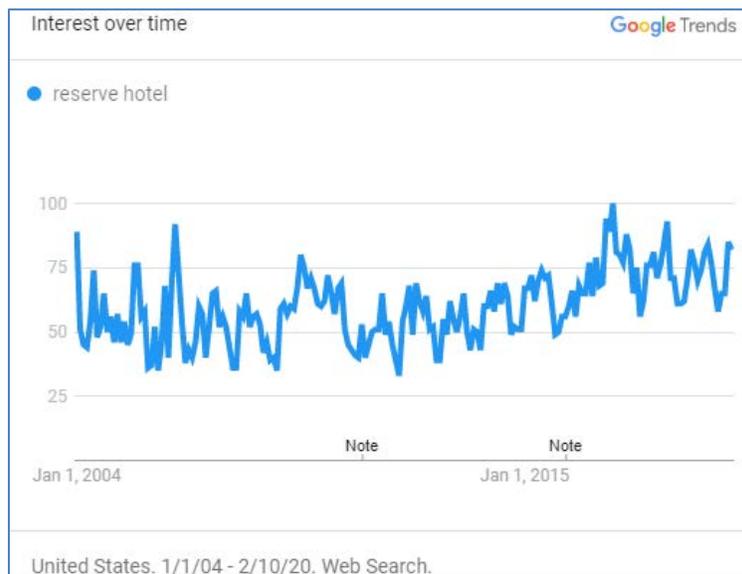
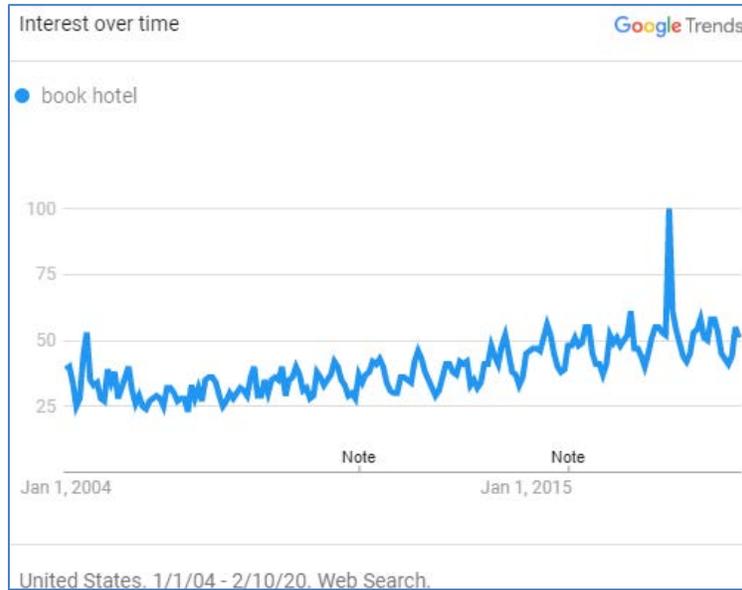
⁷ <https://trends.google.com/> (last visited Feb. 13, 2020); *see also* <https://medium.com/google-news-lab/what-is-google-trends-data-and-what-does-it-mean-b48f07342ee8> (last visited Feb. 13, 2020).

internet has changed over time.⁸ These data are properly the subject of judicial notice because the accuracy of Google's records of searches conducted on its website cannot reasonably be questioned. *See* Fed. R. Evid. 201(b); *Pahls v. Thomas*, 718 F.3d 1210, 1216 n.1 (10th Cir. 2013) (taking judicial notice of information from Google Maps).

Here, Google Trends data support the Teflon survey's conclusion that BOOKING.COM is not generic. For context, below are Google's trend charts for the search terms "book hotel" and "reserve hotel" in the U.S. from 2004 to present, respectively.⁹

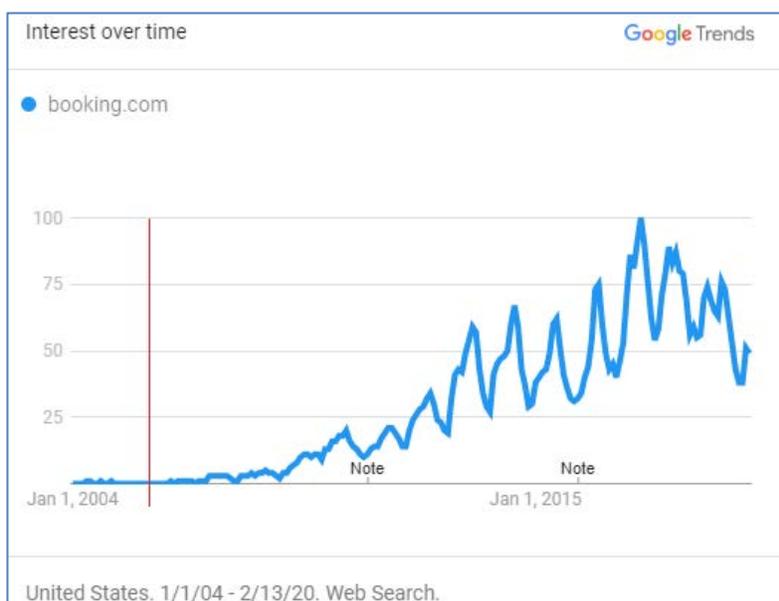
⁸ Google Trends data are widely relied upon in peer-reviewed research. *See, e.g.*, Teng Y, et al., *Dynamic Forecasting of Zika Epidemics Using Google Trends*, PLoS ONE 12(1): e0165085 (2017). The government recently cited Google Trends data to this Court in *Frank v. Gaos*, 139 S. Ct. 1041 (2019). *See* Supplemental Reply Brief for the United States as Amicus Curiae Supporting Neither Party, 2018 WL 6788369, at *4 (Dec. 21, 2018).

⁹ Google Trends data for "book hotel," <https://trends.google.com/trends/explore?date=all&geo=US&q=book%20hotel> (last visited Feb. 10, 2020); Google Trends data for "reserve hotel," <https://trends.google.com/trends/explore?date=all&geo=US&q=reserve%20hotel> (last visited Feb. 10, 2020). In each of the Google Trends graphs shown below, there are two notes automatically inserted by Google, which explain that Google's algorithm for tracking search trends was improved in 2011 and 2016.



If consumers commonly use “booking.com” to refer to online hotel-reservation services in general, instead of Respondent specifically, one would expect to see a similar trend for search interest in “booking.com.” But

as shown below, before Respondent started doing business as BOOKING.COM in 2006, virtually nobody searched for “booking.com.” It was only after Respondent’s adoption of this term that consumers began widely searching for it.¹⁰



This demonstrates that BOOKING.COM was not a pre-existing generic term for online hotel-reservation services that Respondent adopted, but rather is a term Respondent coined in 2006.

In addition, Google Trends data associated with “booking.com” reflect that this term is primarily searched to find information relating to Respondent.

¹⁰ Google Trends data for “booking.com,” <https://trends.google.com/trends/explore?date=all&geo=US&q=booking.com> (last visited Feb. 13, 2020). For the Court’s convenience, Amici have added a red line to divide searches from before and after 2006.

Google Trends captures data on other search terms that are most frequently searched with the original search term.¹¹ When consumers search for “booking.com” on Google, they most frequently also search for specific attributes about Respondent, such as Respondent’s contact number, login page, or promotion codes.¹² The same trend occurs when consumers search for Respondent’s competitors.¹³ Because a generic product category does not have a contact number, login page, or promotion codes, that consumers search for these specific attributes in conjunction with the term “booking.com” indicates that they understand and are using that term to refer to a brand and not a generic product category.

¹¹ “Trends Help,” <https://support.google.com/trends/answer/4355000?hl=en> (last visited Feb. 13, 2020).

¹² See Google Trends data for “booking.com,” <https://trends.google.com/trends/explore?q=booking.com&geo=US> (last visited Feb. 13, 2020) (identifying top “related queries” such as “booking.com number,” “booking.com login,” “booking.com coupon” and “booking.com customer service number”).

¹³ That is, when consumers search for “expedia.com,” “hotels.com” or “airbnb.com” on Google, they often also search for specific attributes about those companies, such as their contact number, login page, or promotion codes. See Google Trends data for “expedia.com,” <https://trends.google.com/trends/explore?q=expedia.com&geo=US> (last visited Feb. 13, 2020); Google Trends data for “hotels.com,” <https://trends.google.com/trends/explore?q=hotels.com&geo=US> (last visited Feb. 13, 2020); Google Trends data for “airbnb.com,” <https://trends.google.com/trends/explore?q=airbnb.com&geo=US> (last visited Feb. 13, 2020). These online reservation services are mentioned in the “Competition” section of Booking Holdings Inc.’s 2019 10-k. See Booking Holdings Inc. Annual Report (Form 10-K) (Feb. 27, 2019), at 5.

In fact, the search query “booking.com” was used to navigate to Respondent’s competitors in less than 1 percent of searches, according to SimilarWeb, an online market intelligence platform that records the top organic (i.e., non-paid) keyword search terms used to arrive at a given web page.¹⁴ In contrast, the search queries “booking.com” and “booking com” were among the top five most popular queries used by consumers to arrive at booking.com.¹⁵ This indicates that, unlike generic search terms such as “hotels” or “flights” which are used to navigate to various online travel-booking websites, the term “booking.com” is specifically used to refer to Respondent’s brand, not the genus of online hotel-reservation services.

CONCLUSION

The government’s suggested per se rule that, in the case of domain names, a generic root and generic suffix always produce a generic combined mark would lead to the conclusion that some marks are generic even though consumers actually perceive them as a brand. BOOKING.COM is a perfect example of how the government’s approach would lead to an erroneous result. All of the available consumer-perception evidence concerning BOOKING.COM

¹⁴ Competitors analyzed include Expedia.com, Airbnb.com, and Hotels.com. See <https://www.similarweb.com/website/expedia.com>; <https://www.similarweb.com/website/airbnb.com>; <https://www.similarweb.com/website/hotels.com> (last visited Feb. 13, 2020).

¹⁵ See <https://www.similarweb.com/website/booking.com> (last visited Feb. 13, 2020).

demonstrates that this mark is primarily perceived as a brand.

Rather than adopting an approach that conflicts with marketplace realities and longstanding law, the Court should analyze domain-name trademarks like all other types of trademarks. That is, the Court should assess how such marks are perceived by consumers, taking into account any reliable evidence of consumer perception that is available, including survey evidence, which is the most reliable indicator of how consumers perceive a mark. Because that was the approach taken by the court of appeals, its judgment should be affirmed.

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