

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

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UNITED STATES PATENT AND TRADEMARK OFFICE;  
ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR,  
UNITED STATES PATENT AND TRADEMARK OFFICE,

*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 OF NEW YORK INTELLECTUAL  
PROPERTY LAW ASSOCIATION AS *AMICUS  
CURIAE* IN SUPPORT OF RESPONDENT**

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**QUESTION PRESENTED**

Under the Lanham Act, 15 U.S.C. § 1051 *et seq.*, generic terms may not be registered as trademarks. The question presented is 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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**STATEMENT OF INTEREST  
OF *AMICUS CURIAE***

This *amicus curiae* brief is submitted on behalf of the New York Intellectual Property Law Association (“the NYIPLA”). The NYIPLA is a professional membership association of over 1,000 attorneys in the New York City metropolitan area whose interests and practices lie in the areas of patent, trademark, copyright, trade secret, and other intellectual property laws.<sup>1</sup>

The NYIPLA’s members include a diverse array of attorneys specializing in trademark law, including in-house counsel for businesses that own, license, enforce, and challenge trademarks, as well as attorneys in private practice who advise a wide array of clients on trademark matters, including the procurement of trademark registrations through the U.S. Patent and Trademark Office (“USPTO”). Many of the NYIPLA’s member attorneys participate actively in trademark litigation, representing both owners and alleged infringers. The NYIPLA, its members, and the clients of its members share an interest in ensuring that the standards governing the

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<sup>1</sup> Consent of all parties has been provided for the NYIPLA to file this brief. Petitioners and Respondent provided consents to the filing of this *amicus curiae* brief in support of respondent in communications dated January 29, 2020, and January 24, 2020, respectively. No party’s counsel authored this brief in whole or in part. No party, or party’s counsel, contributed money that was intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, or its counsel, contributed money that was intended to fund the preparation or submission of this brief.

protectability and registrability of trademarks are reasonably clear and predictable.

The arguments in this brief were approved on February 14, 2020, by an absolute majority of the total number of officers and members of the Board of the NYIPLA (including such officers and Board members who did not vote for any reason including recusal), but do not necessarily reflect the views of a majority of the members of the Association or of the firms or other entities with which those members are associated.

After reasonable investigation, the NYIPLA believes that no member of its Board or Amicus Briefs Committee who voted to prepare this brief on its behalf, or any attorney in the law firm or corporation of such a Board or Committee member, or attorney, who aided in preparing this brief, represents either party to this litigation. Some Committee or Board members or attorneys in their respective law firms or corporations may represent entities that have an interest in other matters which may be affected by the outcome of this litigation.

The NYIPLA takes no position on the question presented and files this amicus brief to address the important evidentiary issue of when survey evidence should be considered in evaluating whether a term is generic and thus unprotectable as a trademark.

### **SUMMARY OF ARGUMENT**

Determining whether a term is generic, or whether a trademark has become generic over time, involves analysis of the primary significance of the

term to the relevant public. Consumer-survey evidence is often critical to this analysis. As stated by Professor J. Thomas McCarthy, “[c]onsumer surveys have become almost de rigueur in litigation over genericness.” J. Thomas McCarthy, 2 McCarthy on Trademarks & Unfair Competition (“McCarthy on Trademarks”) § 12:14 (5th ed. Nov. 2019). And rightfully so: there is often no better way to gauge public perception than to survey the public.

To be sure, in limited circumstances, a trier of fact may properly discount or even entirely reject survey evidence. Other evidence of the term’s generic nature may be so overwhelming that it overcomes survey results that suggest otherwise. Or the survey itself may be poorly executed or directed to the wrong issue.

In most cases, however, survey evidence is relevant and likely helpful in evaluating the public’s understanding of the primary significance of the term—whether, that is, the public views the term primarily as a generic term or as a brand. Accordingly, it is appropriate to consider consumer-survey evidence in determining whether BOOKING.COM, or any other term, is generic.

## **BACKGROUND**

Booking.com applied to register four trademarks containing the term BOOKING.COM for “online hotel reservation services.” Pet. App. 4a. The USPTO Examining Attorney refused registration of each of these trademarks, reasoning that the term “booking” was generic for hotel-

reservation services and merely adding the generic top-level domain “.com” did not suffice to create a protectable trademark. *Id.* at 5a.

Booking.com appealed these rejections to the Trademark Trial and Appeal Board (“TTAB”), which affirmed the Examining Attorney’s refusals. The TTAB considered evidence including dictionary entries; Internet evidence of third-party use of “booking” and “.com”; usage of “booking.com” as a component of other domain names and trade names; a J.D. Power & Associates survey regarding customer satisfaction with the Booking.com website; and testimony and exhibits regarding Booking.com’s advertising, sales, and marketing. *In re Booking.com B.V.*, No. 79114998, 69 TTABVUE 6–20 (T.T.A.B. Feb. 18, 2016); Pet. App. 136a. The TTAB affirmed the Examining Attorney’s refusals, finding that in the context of the relevant services, “BOOKING.COM would be . . . understood as having the meaning of booking travel, tours, and lodgings through an internet service” and, as a result, was generic. *Id.* at 34–35; Pet. App. 176a.

Booking.com sought review *de novo* in the United States District Court for the Eastern District of Virginia. In support of its argument to the district court, Booking.com submitted additional evidence including a survey demonstrating that 74.8% of consumers recognized BOOKING.COM as a brand rather than as a generic term.

Booking.com’s survey was conducted online with an initial group of 400 respondents, using the “Teflon” format, which provides survey respondents

with a primer on the distinction between generic or common names and trademark or brand names, and then presents respondents with a series of names that they are asked to identify as either common or brand names. *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 915 (E.D. Va. 2017). Here, the difference between brand names and common names was explained and respondents were presented with three brand names (TOYOTA, CHASE and STAPLES.COM) and three common names (AUTOMOBILE, BANK, and OFFICESUPPLIES.COM). *Id.* After testing the respondents' understanding of the difference between brand and common names using the terms KELLOGG and CEREAL and excluding those who did not answer correctly, the remaining respondents were asked to identify a series of terms as either a brand or common name. *Id.* at 915–16.

Respondents were assigned to one of four rotations that presented, in different order depending on the rotation, three common names, three brand names, and BOOKING.COM. *Id.* While 74.8% of respondents identified BOOKING.COM as a brand name, 96.8% to 99.3% of respondents identified PEPSI, SHUTTERFLY, and ETRADE.COM as brand names. *Id.* at 916. No respondents identified SUPERMARKET as a brand name, and only 0.5% of respondents identified SPORTING GOODS as a brand name. *Id.* Thirty-three percent of respondents identified WASHINGMACHINE.COM as a brand name. *Id.*

The USPTO submitted expert testimony criticizing the Booking.com survey, arguing, for

example, that because 33% of respondents incorrectly identified WASHINGMACHINE.COM as a brand name, the educational portion of the survey was ineffective and predisposed respondents to think that any dot-com name was a brand name. Booking.com submitted expert testimony in response to the survey critiques, noting, for example that any predisposition could be addressed by calculating percentages without counting respondents who answered that WASHINGMACHINE.COM is a brand name. Doing so would yield 65% of the remaining qualifying respondents identifying BOOKING.COM as a brand name.

After reviewing and assessing the evidence, the district court found the survey reliable, disagreed with the TTAB and ruled that BOOKING.COM was a protectable mark. In light of the “absence of evidence indicating that the consuming public uses the term BOOKING.COM to refer to a class of services,” together with the results of Booking.com’s survey, the district court held that the public did not primarily understand BOOKING.COM to “refer to a genus,” and instead “it is descriptive of services involving ‘booking’ at that domain name.” *Id.* at 914–18 (quoting *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001)). That court ordered the USPTO to issue registrations as to hotel- and lodging-reservation services based on Booking.com’s acquired-distinctiveness showing, comprising “an extensive nationwide advertising campaign; a strong public perception that BOOKING.COM is a brand identifier, as evidenced by the Teflon survey; robust consumer sales;

voluminous unsolicited media coverage; and a decade of exclusive use.” *Id.* at 923.

The Fourth Circuit affirmed. It held that the district court did not err in holding that the USPTO “failed to satisfy its burden of proving that the relevant public understood BOOKING.COM, taken *as a whole*, to refer to general online hotel reservation services rather than Booking.com the company.” *Booking.com B.V. v. USPTO*, 915 F.3d 171, 181 (4th Cir. 2019).

On appeal, the USPTO did not contest the validity of Booking.com’s survey or its methodology. Instead, the USPTO argued that the survey should not have been considered by the district court at all, relying on the Fourth Circuit’s 2001 *Hunt Masters* case, and asserting that because the term at issue is not a coined term, it is not necessary to determine whether the term has “become generic through common usage,” rendering [the] survey irrelevant. *Id.* at 183 (quoting *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254–55 (4th Cir. 2001) (because the plaintiff did not claim to have first coined the term, “it is not necessary to determine whether the term has become generic through common use, rendering [the] survey irrelevant.”)).

The Fourth Circuit rejected this argument because the district court had “determined based on the dearth of evidence in the record that the proposed mark was not commonly used.” *Id.* The Fourth Circuit contrasted the absence of evidence of common use of BOOKING.COM with the evidence of

common use of “Crab House” supporting its decision in *Hunt Masters*. *Id.* at 180, 183. In *Hunt Masters*, the circuit court explained, the district court did not err in declining to consider the survey evidence because evidence was presented that prior to Hunt Masters’ use of “crab house,” “the term ‘crab house’ was commonly used, as there were many restaurants called ‘crab houses’ across the country.” *Id.* at 180 (citing *Hunt Masters*, 240 F.3d at 254 n.1). But here, because of the dearth of evidence in the record, the district court had found BOOKING.COM was not commonly used and thus did not fall within the category of terms for which survey evidence is irrelevant according to the *Hunt Masters* dicta.

The Fourth Circuit also rejected the USPTO’s argument that, because the addition of an entity designation such as “company” to a generic term does not create a protectable mark, the same logic applies when adding a top-level domain like “.com” to a generic term. The Fourth Circuit declined to adopt the USPTO’s proposed “per se rule . . . where evidence demonstrates that the mark’s primary significance to the public as a whole is the source, not the product.” *Id.* at 186.

Following the decision, the USPTO sought certiorari, which this Court granted on November 8, 2019.

## ARGUMENT

### I. Courts Face a Difficult Challenge in Distinguishing Protectable Descriptive Marks From Generic Terms.

Generic terms—whether they began as generic or became so through genericide—are in the public domain, and courts must protect the public’s interest in their unfettered use. But the public also has an interest in ensuring that distinctive, protectable terms are afforded trademark protection. The “primary significance” test is an important tool for courts to assess whether a term is sufficiently distinctive to be a protectable mark or is generic.

A. Courts classify proposed trademarks in categories of generally increasing distinctiveness: “(1) generic; (2) descriptive; (3) suggestive, (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)). The latter three categories—suggestive, arbitrary, and fanciful terms—are inherently distinctive and protectable as trademarks. Terms that are otherwise merely descriptive may nevertheless acquire through use sufficient distinctiveness to become protectable and registrable.

Contrasted against distinctive marks are generic terms, those that identify only “the genus of which the particular product is a species,” which are not protectable, and “are not registrable as trademarks.” *Id.* (quoting *Park ’N Fly, Inc. v. Dollar*

*Park & Fly, Inc.*, 469 U. S. 189, 194 (1985)). Terms may be generic *ab initio* or may become generic through the process of genericide. In either case, a term is generic if it is commonly used to describe the products or services at issue and is not associated with one company.

Courts sometimes refer to a term as generic *ab initio*, meaning the term was not coined by the applicant and instead was commonly used to describe the products or services at issue before the applicant began to use it. *See, e.g., Genessee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 150 (2d Cir. 1997) (“Honey Brown” as applied to lager beer is generic *ab initio* due to honey wheat, honey porter, and honey cream ale beers already on the market); *see also Hunt Masters*, 240 F.3d at 254–55 (noting the significance to the genericness assessment of common use of “crab house” by many restaurants across the country while not specifically referring to the phrase “*ab initio*”).

Conversely, a term that was once a protectable trademark may become generic through “genericide.” This happens when the “public appropriates a trademark and uses it as a generic name for particular types of goods or services irrespective of [their] source.” *Elliott v. Google, Inc.*, 860 F.3d 1151, 1155–56 (9th Cir. 2017). Genericide “can occur ‘as a result of a trademark owner’s failure to police the mark, resulting in widespread usage by competitors leading to a perception of genericness among the public, who sees many sellers using the same term.’” *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007) (citing McCarthy on Trademarks § 12:1

(4th ed. 2007)). “Alternatively, ‘a term intended by the seller to be a trademark for a new product [can be] taken by the public as a generic name because customers have no other word to use to name this new thing.’” *Id.* (quoting McCarthy on Trademarks § 12:1 (4th ed.)).

**B.** A term can function as a trademark only if the term is perceived as a designation of origin associated with one producer of the product, not as just the name of those products when offered by many different suppliers. *See, e.g.,* McCarthy on Trademarks, *supra*, § 12:1. Generic terms are those that fail that test—they “are incapable of identifying source.” *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009). Affording trademark status to generic terms would effectively grant the owner of the term a monopoly over common words and phrases. Trademark law “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.’” *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001). As the Second Circuit has explained:

[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.

Importantly, these policy considerations apply regardless of whether the generic term in question was generic *ab initio* or became so through genericide. *Id.* at 9–10. Competitors should be free to use the genericized term, just as competitors should be free to use terms commonly used before the adoption of the term as a purported trademark. As stated by the Second Circuit in holding that THERMOS had become generic:

King-Seeley has enjoyed a commercial monopoly of the word “thermos” for over fifty years. During that period, despite its efforts to protect the trademark, the public has virtually expropriated it as its own. *The word having become part of the public domain, it would be unfair to unduly restrict the right of a competitor of King-Seeley to use the word.*

*King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963) (emphasis added).

C. Courts often face a difficult challenge in weighing the importance of ensuring that generic terms remain in the public domain against the equal importance of protecting descriptive marks that have acquired distinctiveness. That is because the line between the two categories is often unclear and hotly contested. *See, e.g.,* McCarthy on Trademarks,

*supra*, § 12:20 (“The generic–descriptive line is too often smudged by the courts and the USPTO”). Congress accordingly has directed courts to balance those competing concerns by determining the “primary significance” of the term to relevant consumers. 15 U.S.C. § 1064(3). In short, that means asking whether the public thinks the term means the genus or the species.

Courts and the PTO follow similar procedures for answering that question of fact—first identifying the genus of goods or services and then asking whether the relevant public primarily understands the term to refer broadly to that genus or specifically to products of a single source. *See* Trademark Manual of Examining Procedure (“TMEP”) § 1209.01(c)(i) (8th ed. Oct. 2018); *Booking.com B.V.*, 915 F.3d at 180–81. Evidence relevant to those inquiries includes purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers, and other publications. *Booking.com B.V.*, 915 F.3d at 180–81.; *see also* *PODS Enters., LLC v. U-Haul Int’l, Inc.*, No. 12-cv-01479-T-27MAP, 2015 WL 1097374, at \*3–\*5 (M.D. Fla. Aug. 11, 2015).

## **II. Courts May Properly Use Evidence From Well-Constructed Surveys in Assessing Genericness.**

Both the USPTO and the courts may consider survey evidence. *See, e.g.*, Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1208 n.10 (June 2019); *Classic Foods Int’l Corp. v. Kettle Foods, Inc.*, 468 F. Supp. 2d 1181, 1193 (C.D. Cal.

2007); E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 Trademark Rep. 1118 (2009). Indeed, properly constructed consumer surveys can be the most critical evidence in assessing whether a term is generic. As explained by Professor McCarthy, consumer perception is key:

To an extent not true in other fields of law, in trademark and false advertising disputes the perceptions of large groups of ordinary people are key factual issues. Both trademark validity and infringement turn largely on factual issues of customer perception.

6 McCarthy on Trademarks, *supra*, § 32:158.

As observed by the Fourth Circuit, consumer-perception survey evidence is certainly relevant with respect to trademarks, including .com trademarks, where the contention is that the trademark has become generic over time. *Booking.com B.V.*, 915 F.3d at 183 (“consumer surveys are relevant to determining whether a term” that “‘began life as a coined term’ . . . had become generic through common usage”).

Despite surveys’ importance, tribunals have occasionally declared that survey evidence is irrelevant in cases of terms that were not coined but were considered to be generic *ab initio*. More recently, the TTAB expressed that the Teflon survey format is relevant only for marks that are coined

terms alleged to have become generic through genericide. *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 U.S.P.Q.2d 1184 (T.T.A.B. 2017) (addressing the registrability of PRETZEL CRISPS and surveying cases discounting Teflon surveys for non-coined terms).

Where other evidence of public perception of the term is overwhelming, survey evidence, while still relevant to the analysis, may be properly discounted or even disregarded by the trier of fact. In addition, survey evidence may at times be directed to the wrong question or subject to valid criticisms in terms of methodology or format. However, a blanket proscription of surveys as irrelevant for certain types of terms ignores that the fact finder is tasked in all cases with assessing the “primary significance” of the term to the public. A survey will likely always be relevant (even if not ultimately persuasive) and should be considered and weighed with all other available evidence to reach the “primary significance” determination. *Primary Children’s Med. Ctr. Found. v. Scentsy, Inc.*, No. 11-cv-1141-TC, 2012 WL 2357729, at \*5 (D. Utah 2012), *as amended* (July 6, 2012) (“No matter how a term received its genesis, the ‘primary significance’ test is still of paramount importance to determine if the term is generic, and a consumer survey is a useful indicator of what that significance is to the relevant public.”). Whether or not the term is generic, after all, is an issue of fact. *Booking.com B.V.*, 915 F.3d at 182.

Not all surveys address the question of the brand-versus-common-name significance of the term. Surveys testing for secondary meaning as opposed to

genericness may generate responses reflecting the result of a trademark proponent's advertising and marketing campaigns and may be suspect and disregarded on that basis in a genericness inquiry. *See, e.g., Am. Online*, 243 F.3d at 821 (regarding AOL's efforts to protect YOU'VE GOT MAIL, "AOL's evidence of association may establish what is called 'de facto secondary meaning,' but such secondary meaning does not entitle AOL to exclude others from a functional use of the words); *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979) (survey purportedly proving that consumers have come to associate the word LIGHT with Miller's beer did not advance Miller's trademark claim, because Miller acknowledged that a generic word "can never become a trademark" and a survey cannot change "the meaning of a familiar, basic word in the English vocabulary").

Some surveys exhibit significant flaws in methodology. The *Hunt Masters* survey, for example, showed that 82% of the respondents associated the clearly generic term "hospital" with a specific hospital, providing potentially valid reasons to support disregarding or discounting the survey on that basis alone. Br. of Appellee, *Hunt Masters* (No 00-1235), 2000 WL 33990586, at \*42-43 (4th Cir. 2000).

Likewise, in *Sheetz of Delaware, Inc. v. Doctors Associates, Inc.*, 108 U.S.P.Q.2d 1341 (T.T.A.B. 2013), the TTAB assessed and then discounted the applicant's survey due to several criticisms of its methodology. The applicant submitted a *Teflon* survey in support of its attempt to register

FOOTLONG for sandwiches. *Id.* at 1359. To explain the difference between common names and brand names, the applicant's survey used "Quarter Pounder" and "Original Recipe" as examples of brand names. Because these examples are "highly descriptive terms that acquired distinctiveness," the explanation of the difference between brand and common names provided to respondents was "ambiguous, in a potentially significant way." *Id.* at 1361. The Board reasoned that survey respondents might be misled by the survey's use of descriptive terms with acquired distinctiveness and "mistakenly . . . think that a heavily advertised word like 'Footlong' has become the equivalent" of those terms. *Id.* For this and other reasons, the fact finder was entitled to disregard or discount the survey results in making the determination as to the primary significance of the term.

Similarly, in *Frito-Lay*, despite proposing a blanket rejection of the Teflon survey evidence offered by both parties as irrelevant due to the non-coined nature of the PRETZEL CRISPS term at issue, the TTAB provided its "thoughts on the proffered surveys, had they been admissible on the question of genericness." 124 U.S.P.Q.2d at 1196. Relying on *Sheetz*, the TTAB criticized the use of the term "Wheat Thins" as an example of a brand name used to instruct survey respondents on the difference between a brand name and a common name. *Id.* at 1197. Like the terms "Quarter Pounder" and "Original Recipe" in *Sheetz*, the TTAB concluded that the term "Wheat Thins" "is not a highly distinctive mark, and thus not a good example to participants of how to distinguish between a distinctive term and a

merely well-advertised highly descriptive or even generic term.” *Id.*

Survey evidence also may not overcome the import of other evidence of—or explanations for—public perception. In *Hunt Masters*, for example, the survey purporting to show that local residents in particular zip codes associated “crab house” with a particular restaurant was properly disregarded where the evidence showed rampant use of “Crab House” by many restaurants throughout the country including “Cap’n Zach’s Crab House, McKinleyville, CA; Del Mar Crab House, Denver, CO; Old Mill Crab House, Delmar, DE; Rustic Inn Crabhouse, Ft. Lauderdale, FL; Fulton’s Crab House, Orlando, FL; Shaw’s Crab House, Chicago, IL; Dirty Dick’s Crab House, Avon, NC; Rooney’s Ocean Crab House, Long Branch, NJ; Eddie’s Crab House, Philadelphia, PA; Hastings Crab House, Richmond, VA.” 240 F.3d at 254 n.1.

In many cases, however, other evidence including evidence of common use of the term, and the corresponding strong policy considerations for preventing one party to claim exclusive trademark rights in the commonly used term, may not be so clear. Because the test is the “primary significance” of the term to the public, properly constructed consumer surveys may indeed be relevant, regardless of whether the term is coined or not, to answer whether consumers understand the term to indicate one *source* as opposed to the *class* or *name* of the products or services at issue offered by many different sources. Indeed, while a fact finder may decide to assign limited evidentiary value to surveys

for various reasons including other evidence, as in *Classic Foods*, 468 F. Supp. 2d at 1193, it is erroneous to suggest that surveys attempting to answer the “primary significance” question are *inadmissible* for certain types of allegedly generic terms. *See, e.g., Reinalt-Thomas Corp. v. Mavis Tire Supply, LLC*, 391 F. Supp. 3d 1261, 1272–73 (N.D. Ga 2019) (recognizing that “[c]ourts have considered *Teflon* surveys to be appropriate in the context of a non-coined term” and citing McCarthy on Trademarks, § 12:17.50, in which Professor McCarthy criticized the rejection of survey evidence for non-coined terms because doing so “is to assume the result before making an analysis of that which is to be decided”); *see also* McCarthy on Trademarks addressing this issue, § 12:17.25, (confirming the author’s view that “[a] court or Trademark Board should not determine the issue simply by looking at the words and deciding on its own rather than weighing evidence of public usage from any competent source, including a survey.”).

## CONCLUSION

For the foregoing reasons, it is appropriate to consider survey evidence when assessing the primary significance of BOOKING.COM to the public and whether the term is protectable as a trademark.

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