

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 TRADEMARK AND INTERNET
LAW PROFESSORS AS *AMICI CURIAE*
IN SUPPORT OF RESPONDENT**

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**STATEMENT OF INTEREST OF
*AMICUS CURIAE***

This brief is filed on behalf of the undersigned law professors identified in Appendix A.1.¹ Amici are

¹ Pursuant to Supreme Court Rule 37.2(a), all parties received appropriate notice of and consented to the filing of this brief. Pursuant to Rule 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of the brief. No person or entity, other than *amici*, their members, or their counsel, made a monetary contribution to the preparation or submission of this brief.

scholars whose research and teaching focus includes trademark law or whose expertise includes internet and domain name dispute law.² Amici have no direct interest in the outcome of this litigation.

SUMMARY OF ARGUMENT

As Justice Holmes correctly noted, “[a] word is not a crystal, transparent and unchanged; it is the skin of a living thought and may vary greatly in color and content according to the circumstances and time in which it is used.” *Towne v. Eisner*, 245 U.S. 418, 425 (1918). Like language generally, words used as trademarks draw meaning from and are transformed by consumer use over time. Indeed, trademark protection turns on consumer use and consumer perception. But the government’s proposed test would have this Court erroneously ignore the context of trademark use, in a manner that contravenes fundamental linguistics and the ways in which consumers interact with trademarks and create trademark meaning.

Courts adjudicate trademark infringement based on whether consumer confusion is likely. Trademark validity likewise turns on consumer use and perception. Some marks are protected from their first use in commerce because courts and examiners presume that consumers will automatically perceive them as source identifiers. Other marks are protected once they acquire trademark meaning. A mark derived from a descriptive term does not automatically merit registration on its first use in commerce. But the descriptive term qualifies for protection and registration when consumers vest it with trademark meaning. The proper focus

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

of the inquiry in every case is the primary significance of the claimed mark in the minds of the consuming public. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (holding that a term is not generic if “the primary significance of the term in the minds of the consuming public is not the product but the producer”).

Generic terms—if their primary significance to consumers is as the name for a category of goods—do not qualify for trademark protection. But, in some cases, terms once considered generic have acquired trademark meaning in the eyes of consumers, and courts have given legal effect to this commercial significance. For example, in the mid-19th century, *kiss* or *kisses* as it relates to candy was a generic term for a type of confection. *Kiss*, n., Oxford English Dictionary, <http://www.oed.com/view/Entry/103691> (last visited Feb. 13, 2020) (“Name for a small sweetmeat or piece of confectionery; a sugar-plum.”). But over time, consumers came to use *kiss* to refer to a particular chocolate confection sold by The Hershey Company. The Trademark Trial and Appeal Board, *In re Holmstead, Inc.*, No. 75/183,278 (T.T.A.B. Apr. 4, 2000) (unpublished) and a district court, *Hershey Co. v. Promotion in Motion, Inc.*, No. 07-1601, 2011 WL 5508481, at *9 (D.N.J. Nov. 7, 2011) (unpublished), independently recognized that the overwhelming evidence of consumer use favored recognizing KISS as a protectable trademark. Similarly, SINGER was once held generic by this Court as a designator for sewing machines. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 183 (1896). The SINGER mark was later reclaimed as a source identifier. *See, e.g., Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953).

In assessing trademark validity and trademark infringement, courts, examiners, and litigants analyze trademark meaning through the lens of consumer perception. Marks wax and wane as consumer use bestows and withdraws trademark meaning. Like the meaning of other communicative symbols, trademark meaning can change over time. Indeed, change is an essential feature of the trademark system, as it is in any other communicative system.

In a troubling distortion of this framework, the government proposes a rigid rule that would require courts and examiners to ignore evidence of consumer use and consumer perception. Instead, decision makers would base registration determinations on a static snapshot of the origin of the term or terms comprising a trademark. Rather than engage in the standard context-sensitive inquiry, examiners at the Patent and Trademark Office (“PTO”) would be forced to conclude that any mark combining an ostensibly generic term and a top-level domain like “.com” is generic, irrespective of the trademark meaning consumers have vested in the term. The government’s approach is inconsistent with the best understanding of how language changes and how consumers create trademark meaning.

In support of its proposed rule, the government incorrectly characterizes the occasional practice of denying protection to any mark combining generic terms and a top-level domain like “.com” as a per se rule. It tries to justify this proposed per se rule as consistent with its interpretation of this Court’s 19th-century opinion in *Goodyear’s India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888). But *Goodyear’s* is an artifact of its era, from a period when even descriptive marks were deemed incapable of acquiring trademark protection.

Goodyear's has been abrogated by this Court's precedent in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (holding that a term is not generic if “the primary significance of the term in the minds of the consuming public is not the product but the producer”). The Lanham Act cements that standard. *See* 15 U.S.C. § 1064(3) (the test for genericness of a mark is its “primary significance . . . to the relevant public”). Furthermore, *Goodyear's*, which held that a mark consisting of a generic term and “Corp.” cannot acquire trademark meaning, is distinguishable from this case.

The touchstone of trademark validity analysis is consumer perception. It is critical to consider use in commerce and use in context—consumers' understanding of and reaction to claimed trademarks—when determining whether a mark qualifies for trademark protection and registration.

The government's proposed rule stems in large part from a failure to appreciate that language—including commercial symbols like trademarks—is subject to constant change. Determining the genericness question solely by an appeal to dictionaries, as urged by the government, Pet. Br. at 8-9, invites courts and claimants to over-rely on a term's history, including obsolete meanings, instead of how it is actually used by sellers and consumers in commerce. As linguists understand, words and symbols—including commercial trademarks—are neither fixed nor unchangeable. Thus, a term's meaning in one context does not determine the meanings consumers will generate from it in a different context.

The government's proposal also relies on mistaken error-cost analysis. One might recognize that a generic term can acquire trademark meaning, but incorrectly presume it happens so rarely that error is best avoided

by ignoring that creation of trademark meaning when it occurs. The shift from the generic name of a good or service to the name of a source is what linguists call a narrowing shift. Research into language change shows that narrowing is not at all rare and, in fact, may be the most frequent type of language change.

The government's proposal further relies on a flawed analysis of competitive harm. When a majority of consumers perceives an ostensibly generic mark as a source signifier, those consumers are not indifferent to or unharmed by the use of a confusingly similar third-party mark. In fact, ignoring the development of source significance may well increase error costs in trademark litigation by reducing efficiency and increasing search costs imposed on consumers. But applying the primary significance test in cases where consumers have vested trademark meaning in an ostensibly generic term will properly manage potential competitive harm by setting a sufficiently high threshold for demonstrating that consumers view the claimed trademark as a source signifier.

ARGUMENT

I. CONSUMER USE IS THE CORE OF TRADEMARK LAW

Trademark meaning is determined by “collective, public use of the mark.” Jake Linford, *Trademark Owner as Adverse Possessor: Productive Use and Property Acquisition*, 63 Case W. Res. L. Rev. 703, 736 (2013). A mark that is inherently distinctive – and thus merits protection and is registrable from its first use in commerce – qualifies for that treatment because courts and examiners reasonably presume that consumers will perceive the mark as a source identifier. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768

(1992) (“because their intrinsic nature serves to identify a particular source of a product,” trademarks with a fanciful, arbitrary, or suggestive origin are “deemed inherently distinctive and are entitled to protection” without evidence of source significance). On the other hand, a descriptive term is not protected upon first use. It only qualifies for protection and registration if and when consumers vest it with trademark meaning, i.e., “secondary meaning.” *Id.* at 769 (“descriptive marks may acquire the distinctiveness which will allow them to be protected under the Act”).

Irrespective of its origin, any registered mark loses both its protected status and its qualification for registration when it undergoes a genericizing shift in its primary significance—when the *majority* of consumers stop viewing it as a source signifier and start seeing it as a generic product name. *See, e.g., American Thermos Prods. Co. v. Alladdin Indus.*, 207 F. Supp. 9, 20-22, 27-28 (D. Conn. 1962), *aff’d sub nom. King-Seeley Thermos Co. v. Alladdin Indus.*, 321 F.2d 577 (2d Cir. 1963) (finding THERMOS generic in light of survey results showing seventy-five percent of respondents used it as a generic term, despite trademark use by a minority of consumers). But a challenge to a registered mark on genericness grounds will fail if the mark’s primary significance is still source signifying—if the majority of consumers continue to use the mark as a source identifier. *E. I. DuPont de Nemours & Co. v. Yoshida Int’l*, 393 F. Supp. 502, 527-28 (E.D.N.Y. 1975) (finding TEFLON valid in light of survey evidence that sixty-eight percent of consumers perceived the term as a trademark, compared with thirty-one percent who felt it was generic).

As consumers interact with a mark, it can acquire and lose distinctiveness over time, and that change

turns in large part on consumer use and perception. A brand can fail because consumers decline to invest in it from the beginning or because consumers withdraw an investment made previously. *See, e.g.*, Deborah R. Gerhardt, *Consumer Investment in Trademark*, 88 N.C. L. Rev. 427, 450 (2010) (“If a brand succeeds, its meaning will not remain constant. Consumer perceptions about trademarks are dynamic and can change over time and in response to experience and other stimuli.”).

Courts assessing trademark validity recognize that trademark meaning reflects consumer use of the mark in context, generated in a dialogue among consumers and sellers. This same analysis, focusing on the primary significance of a mark in the minds of consumers, is the proper way to determine whether an ostensibly generic term qualifies for trademark protection and registration.

II. IGNORING EVIDENCE OF CONSUMER USE IS MISGUIDED, EVEN IN CASES OF OSTENSIBLE GENERICNESS

The government advocates for a new *per se* rule, asserting that courts and the PTO should ignore consumer use and consumer perception of trademark meaning in marks like Booking.com. The government’s proposed new approach is in error, an iteration of the *de facto* secondary meaning doctrine, which treats the generic nature of a mark as essentially unchangeable. Pet. Br. at 41; Tushnet Br. at 15. Under that doctrine, a court would withhold protection based on mark’s generic heritage, even when the public overwhelmingly associates it with a single source of origin. This Court has never adopted the *de facto* secondary meaning doctrine, and for good reason: The doctrine is out of step with the best current understanding of how

language changes and how consumers manage ambiguity, including in commercial contexts.

A. Words and symbols—including commercial trademarks—change as they are used.

Some who caution against extending trademark protection to terms with generic origins suppose that language is relatively fixed or unchanging. As the Court presumed in *Goodyear's*, a generic or descriptive term could never come to “indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied.” *Goodyear's*, 128 U.S. at 604. One who holds that view would look for evidence in a dictionary, for instance, that a word at some point identified a product sold or a service offered. The reviewer would then prioritize that generic meaning, no matter how outdated, over current consumer understanding.

As the First Circuit recognized, however, such singular reliance on historical sources is misguided. The test for genericness is instead the primary significance of a mark to the consuming public. “Where a generic association of a word or term has become obsolete and is discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word.” *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 8 n.2 (1st Cir. 1981). See also Laura A. Heymann, *The Grammar of Trademarks*, 14 Lewis & Clark L. Rev. 1313, 1342 (2010) (arguing that consumers can hold generic and source signifying meanings in mind simultaneously).

Linguists recognize the futility of relying on the origin of a word to discover some core or true meaning. They label the approach a fallacious “argument from etymology” or “etymological fallacy.” Geoffrey Hughes, *A History of English Words* 27 (2000) (“argument from etymology”); Thomas R. Lee & Stephen C. Mouritsen, *Judging Ordinary Meaning*, 127 *Yale L.J.* 788, 810 (2018) (“etymological fallacy”); Thomas R. Lee & James C. Phillips, *Data-Driven Originalism*, 167 *U. Pa. L. Rev.* 261, 288 (2019) (“[T]he historical pedigree of a word may direct us to an outmoded or even obsolete definition.”); Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 *Yale J. L. & Tech.* 110, 154–55 (2015) (summarizing literature explaining the fallacy). Linguists understand and teach that language changes continually as it is used. Discounting new meaning mistakenly strives to stunt the growth of language itself. C.S. Lewis, *Studies in Words* 18 (2d ed. 1967).

Instead, language is categorized by continual change. Words will change meaning “from one linguistically coded meaning to another.” Elizabeth Closs Traugott & Richard B. Dasher, *Regularity in Semantic Change* 1 (2002). Language change occurs when individuals need new ways to express new objects or ideas. Stephen Ullman, *Semantics: An Introduction to the Science of Meaning* 209-10 (1962). This change will eventually force old meanings out of the lexicon. For instance, in the middle ages, *code* was a term both for a baptism robe and for pitch or cobbler’s wax. Today, both meanings are long abandoned, and it would be peculiar to deny trademark meaning if consumers came to see CODE as a mark for wax, or pitch, and ceremonial clothing. Linford, *Linguistic Justification, supra*, at 124-125.

B. Error-cost analysis does not require ignoring trademark meaning in genericness cases.

i. Narrowing language change

Language change occurs in regular patterns. Linguists identify two common types of language change – widening and narrowing. Both types of change have implications for error-cost analysis in genericness cases. Words sometimes widen or broaden from a narrow, specific meaning to a broader, more categorical meaning. For example, *dog* used to refer to specific large or strong breeds of domesticated canines (and still does in Danish), but has since broadened to include any domesticated canine regardless of size. Willem B. Hollmann, *Semantic Change, in English Language: Description, Variation and Context* 525, 528 (Jonathan Culpeper et al. eds., 2009). The change in primary significance from a valid trademark to a generic product designation is also a type of widening. For example, the CELLOPHANE mark lost source significance when a court concluded the mark had primarily become the generic designation for a transparent sheet of semi-viscous paper ideal for preserving food. *DuPont Cellophane Co. v. Waxed Prod. Co.*, 85 F.2d 75, 82 (2d Cir. 1936). Trademark law thus gives legal effect to widening.

Words can also undergo a narrowing of meaning from a broad category to a prototypical member of that category. The shift from a generic product category to a source identifying trademark is a type of narrowing shift.

Some courts and scholars admit that narrowing occurs in the trademark space, but presume that it is exceedingly rare. *See, e.g.*, 2 J. Thomas McCarthy,

McCarthy on Trademarks § 12:30 (5th ed.). On that assumption, one might conclude that avoiding costly error requires discounting the evidence that a generic term acquires trademark meaning. The government strives to read *Goodyear's* as establishing a prophylactic rule in part on that basis.

Research instead shows that narrowing happens all the time, both generally, and in the trademark context. For example, *queen* once meant “wife” or “woman,” but the meaning narrowed to “king’s wife” or “female sovereign.” Dirk Geeraerts, *Theories of Lexical Semantics* 27 (2010). Similarly,

- in Old English, *hound* or *hund* once meant any kind of dog, but the meaning was restricted over time to long-eared hunting dogs. Terry Crowley & Claire Bown, *An Introduction to Historical Linguistics* 200 (4th ed. 2010).
- Similarly, the OE *dēor* narrowed from “animal” to today’s *deer*. Edward Finegan, *Language: Its Structure and Use* 476, 497 (5th ed. 2008).
- *Skyline* narrowed from any horizon to a horizon decorated by skyscrapers. Victoria Fromkin et al., *An Introduction to Language* 316 (10th ed. 2013).
- *Wife* narrowed from any woman of humble rank to a married woman or spouse. George Yule, *The Study of Language* 233 (4th ed. 2010).
- *Girl* narrowed from “child or young person of either sex” in Middle English to “female child” or “young woman.” Hollmann, *supra*, at 528.
- *Accident* narrowed from any unforeseen event to an unfortunate one. Francis Katamba, *English Words: Structure, History, Usage* 175 (2004).

- The Old English *steorfan*, meaning “to die,” narrowed in Modern English to *starve*, meaning “to die of hunger.” April M.S. McMahon, *Understanding Language Change 177-78* (1994).
- *Art* originally had general meanings connected to “skill,” “technique,” or “craft,” but is now primarily related to aesthetic skill in a fine art. Alan L. Durham, “Useful Arts” in the Information Age, 1999 *B.Y.U. L. Rev.* 1419, 1425 (1999).
- When the Constitution was drafted, *science* broadly referred to knowledge or learning, but has narrowed today to refer to the investigation of natural phenomena through observation and experimentation. Durham, *supra*, at 1425.
- *Sand* in Old English meant both the strip of land next to a body of water and the particulate matter common to that land. But when the German *shore* was borrowed to refer to the body of land, *sand* narrowed to the granular particles. C.M. Millward & Mary Hayes, *A Biography of the English Language* 205 (3d ed. 2012).

Indeed, narrowing may be the most frequent type of language change. Michel Breal, *Semantics: Studies in the Science of Meaning* 106 (Cust. Trans., 1964); McMahon, *supra*, at 178-79 (explaining restriction is the most natural form of language change); Robert P. Stockwell & Donka Minkova, *English Words: History and Structure* 158 (2001) (arguing restriction is an unnatural but “quite frequently” occurring change); Millward & Hayes, *supra*, at 205 (“The type of semantic change easiest to find between [Old and Middle English] is narrowing of meaning”).

The shift from the generic name of a good or service to a source signifier is another type of narrowing shift.

The reporters are replete with cases where consumers use an ostensible generic term as a source signifier. In some cases, courts have properly extended protection to marks with generic origins. For instance, in the 19th century, *kiss* once identified any small sweetmeat or piece of confection. Kiss, n., Oxford English Dictionary, <http://www.oed.com/view/Entry/103691> (“Name for a small sweetmeat or piece of confectionery; a sugar-plum.”). *Kiss* or *kisses* now brings to mind a particular brand of candy—the teardrop-shaped chocolates offered for sale by the Hershey Company. *In re Holmstead, Inc.*, No. 75/183,278 (T.T.A.B. Apr. 4, 2000) (crediting survey evidence that eighty percent of survey respondents viewed KISSES as source signifying, despite its generic etymology); *Hershey Co. v. Promotion in Motion, Inc.*, No. 07-1601, 2011 WL 5508481, at *9 (D.N.J. Nov. 7, 2011) (unpublished) (concluding, in light of “Hershey’s multiple Teflon surveys offering direct evidence of the primary significance of KISSES as a brand to consumers . . . that a reasonable fact finder could not find the KISSES mark generic”). In the KISSES cases, the tribunals correctly credited evidence of primary significance from the consumer perspective over the term’s dictionary definition.

Similarly, SINGER, once held by this Court to be generic for sewing machines, *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 183 (1896), subsequently acquired or (reacquired) distinctiveness and was “recaptured” from the public domain in the 1950s. *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953); *Singer Co. v. Unishops, Inc.*, 421 F.2d 1371, 1372 (C.C.P.A. 1970). Other cases reach similar results. *See, e.g., Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 853 (Fed. Cir. 1992) (OPRY as applied to country music held capable of acquiring source significance despite an earlier finding that the mark was

generic). *See also* Marc C. Levy, *From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine*, 95 Trademark Rep. 1197, 1208 (2005) (listing cases “where the USPTO has allowed the registration of trademarks that were formerly generic but had not started out as trademarks.”).

The GOODYEAR mark itself has in large part been retrieved from the public domain, shedding the generic or descriptive meaning previously attributed to rubber goods vulcanized using Charles Goodyear’s once-patented method. *See, e.g., Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 729 (D. Minn. 1965) (plaintiff Goodyear met its burden establishing secondary meaning for vinyl film for rain wear); *Goodyear Rubber Co. v. Fotre*, 95 F. Supp. 48, 49 (S.D. Cal. 1951) (same with regard to rubber welts for shoes). *See also* Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications*, 58 Hastings L.J. 299, 378-80 (2006) (describing Goodyear’s success in regaining trademark meaning in the GOODYEAR mark); *accord* McCarthy, § 12:30 (stating that GOODYEAR was reclaimed from the public domain). *But see Rettinger v. FTC*, 392 F.2d 454 (2d Cir. 1968) (holding that Goodyear Rubber is generic and in the public domain). This history of the narrowing shift experienced by GOODYEAR complicates the government’s reliance on *Goodyear’s* to justify the per se bar.

Unfortunately, some courts improperly reject the evidence of trademark meaning vested in a mark by consumers. For example, in *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999), the court discounted evidence that 98 percent of consumers viewed HOG as a source indicator for Harley-Davidson’s

motorcycles, and not as a generic designation for large motorcycles. *See also* Pet. No. 19-46, at 41-42 (listing other cases where courts discount evidence that consumers recognize trademark meaning in an ostensibly generic term). But even wrongly decided cases like *Grottanelli* refute the argument that narrowing incidents are exceptionally rare in the commercial context. Narrowing happens frequently enough that an error-cost analysis does not favor the government's preferred rule.

- ii. The PTO has not adopted a per se rule for similar cases.

The government styles its proposed rule as a prophylactic rule previously adopted by the PTO. But there is no per se rule. It is true that examining attorneys sometimes conclude a generic term followed with a top level domain (TLD) like “.com” is generic as combined, and thus reject an application to register such a term. The PTO sometimes mistakenly follows this approach even if the applicant provides evidence that the majority of consumers view the domain name as a source signifier and not as a generic designation. But the Trademark Manual of Examination Procedure sets no per se bar. Instead, it advises examiners that such a mark is only “[g]enerally . . . generic and without trademark or service mark meaning.” Trademark Manual of Examination Procedure § 1215.05 (Oct. 2018) (emphasis added). The Manual subsequently reminds examiners that “in rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a non-source-indicating TLD such as ‘.com’ or ‘.net.’” *Id.* § 1209.03(m).

The de facto secondary meaning doctrine tempts courts to mistakenly categorize compound words or phrases as generic, despite the well-established anti-

dissection rule that trademarks are protected as a whole and should be evaluated in their entirety. As this Court held in *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920), “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” The Manual thus instructs examiners that “when examining domain name marks, it is important to evaluate the commercial impression of the mark *as a whole* to determine whether the composite mark conveys any distinctive source-identifying impression apart from its individual components.” *Id.* § 1209.03(m) (emphasis added). As the Federal Circuit has frequently reminded the PTO and the Trademark Trial and Appeal Board, properly assessing whether registration should be refused on genericness grounds requires the examiner or the Board to “consider the relevant public’s understanding of the [mark] in its entirety.” *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 964-65 (Fed. Cir. 2015). Particularly relevant is the Federal Circuit’s admonition from *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005). “Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” (emphasis added).

Thus, a term like ‘booking’, combined with ‘.com’, starts its commercial life as a new term that can acquire trademark meaning if consumers use the term as a source signifier. The etymology of a component of the combined mark should not dominate the analysis. Instead, the use of the whole mark by consumers as a source indicator provides the best evidence of its primary significance.

iii. Genericness is not a type of functionality.

Subsection 2(f) of the Lanham Act lists the rare bases for preventing registration of a mark if that mark has become distinctive of an applicant's goods or services. Neither genericness nor descriptiveness is found among the listed exceptions. 15 U.S.C. § 1052(f). The closest statutory match is in subsection 2(e)(5), which prevents registration of a mark that "comprises any matter that, *as a whole*, is functional." 15 U.S.C. § 1052(e)(5). The government and amici equate genericness with functionality. Pet. Br. at 32, 40; Tushnet Brief at 12, n.6; EFF Brief at 8, 13-16. But treating questions of functionality and genericness as largely overlapping disserves both principles. Indeed, the cancellation provision of the Lanham Act clarifies that genericness and functionality are different bases for cancelling a registration. 15 U.S.C. § 1064(3).

Barring trademark protection in functional features stems from the fact that core aspects of products do not change over time, and that sellers will continue to need to copy those features to compete in the market for those products. The patent system is built on that understanding. When a product or process is patented, the public and competitors get the promise of eventual open competition after the patentee's window of protection closes. Once the patent expires, the product, or the process of making it, becomes part of the public domain. *See, e.g., Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 63 (1998) ("[T]he patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time"). The demand for a feature may change over time, but its function does not. For instance, vinyl turntables were once

ubiquitous in every home. Demand died off, but recently resurged. *See, e.g.*, Ed Christman, *Record Store Day: Just How Big Is the Resurgence?*, BILLBOARD, Apr. 18, 2013 (reporting an upsurge in vinyl sales from 990,000 in 2007 to 4.5 million in 2012). Through time, their function has remained generally unchanged.

The stasis of function does not resemble the flow of living languages. Linford, *Linguistic Justification, supra*, at 161-62. While functional features do not change, language frequently does, often in a direction that restricts or narrows meaning. Indeed, as Romeo Montague recognized in Shakespeare's play, the name of a thing is chimerical, while its features may be essential. William Shakespeare, *Romeo & Juliet*, act 2, sc. 2, in *The Oxford Shakespeare: The Complete Works of William Shakespeare* (W.J. Craig ed., 1914) (1597) ("What's in a name? that which we call a rose / By any other name would smell as sweet."). Respondent's position avoids conflating the fixed nature of functional features with the fluid nature of language.

iv. Courts have access to better evidence to analyze trademark use.

Relying on dictionaries to guide us to primary significance was likely the best interpretive tool available in the 19th century, but it is not the best the 21st century has to offer. Craig Hoffman, *Parse the Sentence First: Curbing the Urge to Resort to the Dictionary When Interpreting Legal Texts*, 6 N.Y.U. J. Legis. & Pub. Pol'y 401, 401 (2003) ("As with leeches in the Middle Ages, dictionaries sometimes address the interpretive puzzles judges are trying to solve, and the practice continues. However, just as medical science has progressed since the time of leech treatments, the science of linguistics has progressed since the time that scholars believed that dictionaries held the key to

sentence meaning.”). A prophylactic rule based on etymology is not necessary to avoid error because courts today have resources unavailable to courts in the *Goodyear’s* era, including survey evidence and data analysis of large amounts of text using platforms like Google or large corpora hosted by major universities. *See, e.g., Schering Corp. v. Pfizer Inc.*, 189 F.3d 218, 225 (2d Cir. 1999), *as amended on reh’g* (Sept. 29, 1999) (“Surveys are, for example, routinely admitted in trademark and false advertising cases to show actual confusion, genericness of a name or secondary meaning, all of which depend on establishing that certain associations have been drawn in the public mind.”); Shari Seidman Diamond & David J. Franklyn, *Trademark Surveys: An Undulating Path*, 92 Texas L. Rev. 2029, 2055 (2014) (observing that courts generally expect to see survey evidence in trademark disputes and may be skeptical of a party’s claims if they don’t offer a survey). *See also* Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 Cal. L. Rev. 351 (2014) (arguing that search evidence from Google can reveal whether consumers have invested a mark with trademark meaning); Neal A. Hoopes, *Reclaiming the Primary Significance Test: Dictionaries, Corpus Linguistics, and Trademark Genericide*, 54 Tulsa L. Rev. 407 (2019) (explaining how evidence from the Corpus of Contemporary American English (COCA), a freely available online database hosted by Brigham Young University, can sharpen genericness analysis).³ These tools allow a court to correctly identify language change and to avoid erroneously crediting false assertions of change.

³ COCA now contains more than 600 million words. <https://www.english-corpora.org/coca/>.

C. Ignoring the primary significance of a trademark imposes costs on consumers and harms competition.

Some critics argue that protecting a mark with generic etymology harms competing sellers. As the Court in *Goodyear's* asserted, allowing a firm to claim trademark rights in a generic term would “practically give [the firm] a monopoly in the sale of any goods other than those” it produces. *Goodyear's*, 128 U.S. at 603. Modern critics instead worry that trademark owners can force changes in consumer perception. On this view, if a firm selects a generic term as a trademark, it might successfully prevent competing vendors from communicating with consumers about their offered services.

This competition analysis overlooks how difficult it is to shape consumer perception. Mark owners cannot force language change. A linguistic innovator, like a trademark owner, can try to add a new meaning to the lexicon by using a word in a new way, but whether or not that use catches on does not depend on the innovator. For example, MTV used an advertising campaign in New York City in a failed attempt to insert new terms into the language, like *round* as a synonym of *cool*. If the new terms were adopted, the changes did not last, leading one scholar to conclude, “You cannot sell a language.” Seth Lerner, *Inventing English* 259 (2007). Some linguistic innovations never catch on, and are nonce formations, effectively meaningless to the general public. Jake Linford, *Valuing Residual Goodwill After Trademark Forfeiture*, 93 *Notre Dame L. Rev.* 811, 841 (2017); Hollmann, *supra*, at 535 (describing localized British use of *rude* for an attractive boy or girl); R.C. Simonini, Jr., *Word-Making in Present-Day English*, 55 *Engl. J.*

752 (1966) (cataloguing new words, some of which have entered the common vernacular, like *chortle* and *smog*, and some of which have not, like *slithy* and *twinight*). Consumers can be invited to vest a term with trademark meaning, but they cannot be forced to do so, irrespective of the mark owner's investment.

In addition, ignoring evidence of consumer perception runs counter to the dominant justification for trademark protection: reducing consumer search costs and preventing consumer confusion. Ignoring consumer perception imposes costs on consumers. Discounting this competitive harm would run afoul of the fundamental objectives underlying trademark law. Trademark law protects the public so that "in purchasing a product bearing a particular trade-mark which it favorably knows, [the consumer] will get the product which it asks for and wants to get." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782, n.15 (1992) (Stevens, J., concurring). For example, if the majority of consumers use BOOKING.COM as a source signifier, refusing registration makes it harder for the firm to watch for and prevent confusing uses of the mark. Consumers bear the costs of that inaction. Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 *Cardozo L. Rev.* 1789, 1832–33 (2007) ("If the 'primary significance' of a term in the commercial context is that of a source identifier, consumers generally do not benefit when competitors are allowed to use the word generically."); Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 *Va. L. Rev.* 2099, 2124 (2004) ("[E]rroneously failing to protect the word when it in fact serves as a source-identifying mark might be very costly if consumers end up confused about a competing firm's product.").

III. THE GOVERNMENT MISAPPLIES *GOODYEAR'S*

A. *Goodyear's* is abrogated.

In asserting its inflexible blanket rule, the government relies in significant part on this Court's holding in *Goodyear's India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888). But *Goodyear's* is an artifact of its era, when even descriptive marks were deemed incapable of acquiring trademark protection. See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 Wis. L. Rev. 158, 160 n.8. Indeed, some courts applying *Goodyear's* see it as a case about descriptiveness rather than genericness, perhaps stemming from *Goodyear's* equivocal language in labeling "Goodyear" as a term both descriptive and generic. *Compare Goodyear's*, 128 U.S. at 603-04 ("Nor can a generic name, or a name merely descriptive of an article of trade . . . be employed as a trademark.") *with id.* at 602 ("'Goodyear Rubber' are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one.").

In the decades following *Goodyear's*, both this Court and the Lanham Act have recognized that the primary significance test is the standard to apply in distinguishing generic terms from protected trademarks. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (holding that a term is not generic if "the primary significance of the term in the minds of the consuming public is not the product but the producer"); 15 U.S.C. § 1064(3) (the test for genericness of a mark is its "primary significance . . . to the relevant

public”). The Courts of Appeals in every circuit have recognized the primacy of the primary significance test. Resp. Br. 20; Pet.App.9a-10 & n.6 (collecting cases).⁴

In particular, Fourth and Federal Circuits have properly applied the primary significance tests to determine genericness in registration proceedings in this and other cases. *See, e.g., Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171, 183 (4th Cir. 2019), *as amended* (Feb. 27, 2019), *cert. granted*, No. 19-46, 2019 WL 5850636 (Nov. 8, 2019) (quoting *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 970 (Fed. Cir. 2015) (noting that consumer surveys are “the preferred method of proving genericness” and holding the district court did not err in relying upon Booking.com’s Teflon survey demonstrating 74.8% of respondents identified BOOKING.COM as a brand name)” (emphasis added).

⁴ *Goodyear’s* is not the only 19th century trademark case abrogated by congressional action. *Goodyear’s* relies on another abrogated case, *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 314 (1871). In *Canal Co.*, this Court held the term “Lackawanna” for coal could not be appropriated as a trademark because it was a “geographical name[]” that “point[s] only at the place of production, not to the producer.” But Congress exercised its legislative prerogative and reached a different conclusion. The Lanham Act still permits the government to refuse registration on the principal register when a trademark “[c]onsists of a mark which . . . is primarily geographically descriptive” of the applicant’s goods. 15 U.S.C. § 1052(e)(2). But if a geographically descriptive mark acquires trademark meaning, it qualifies for registration. *Id.* § 1052(f). Robert Brauneis & Roger E. Schechter, *Geographic Trademarks and the Protection of Competitor Communication*, 96 Trademark Rep. 782, 784 (2006); Barton Beebe, *Trademark Law: An Open-Source Casebook* 47 (v 6.0, 2019).

B. Goodyear's is distinguishable.

Even if the government's reading of *Goodyear's* was not abrogated, this case is distinguishable. A URL like Booking.com serves a different function than adding "Corp." to a generic term, and thus, the combination of "booking" and ".com" is potentially descriptive even if both terms are generic alone. Fifty different entities could be incorporated according to the laws of fifty different states, but a domain name points to one specific Internet address, which can be occupied by only one entity at a time.

Courts and scholars have likewise recognized that physical addresses, or other indicators of a singular source like radio call signs or frequency designations, can acquire source significance. See 1 McCarthy on Trademarks and Unfair Competition § 7:17.50 (5th ed.); Dan L. Burk, *Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks*, 1 Rich. J.L. & Tech. 1, *38-*39 (1995); Amasa C. Paul, *The Law of Trade-Marks, Including Trade-Names and Unfair Competition* § 48, at 69 (1903). For example, the Court of Appeals of New York recognized that a seller acquired trademark meaning in the address—No. 10 South Water Street—from where it first conducted its business. *Glen & Hall Mfg. Co. v. Hall*, 61 N.Y. 226, 230-31 (1874). Similarly, the New York Court of Chancery acknowledged one may acquire trademark rights in an address as consumers recognize "that he carries on business at a particular place." *Partridge v. Menck*, 1847 WL 4112 (N.Y. Ch. 1847). Thus, as the court noted in *Niles v. Fenn*, 12 Misc. Rep. 470, 471, 33 N. Y. S. 857 (Sup. Ct. N.Y. 1895), trademark goodwill is, *inter alia*, "the probability that the old patrons will continue customers at the old place." Historically, that location was physical, but it

can also be virtual, like a particular URL. The domain name is a designation of a single, virtual address, and capable of acquiring source significance.

When faced with a mark that combines an ostensibly generic term and a top-level domain like ‘.com’, or some other business designator like 1-800 or 1-888, many courts and examiners properly engage in a context sensitive inquiry to determine whether consumers have vested the term with trademark meaning. Marks like these have frequently been registered by the PTO, because they create a whole that is distinguishable from the sum of its parts and protectable as a trademark. *See, e.g.*, Trademark Reg. No. 3,601,346 (Apr. 7, 2009) (ART.COM for online retail store services for art); Trademark Reg. No. 5,420,240 (Mar. 6, 2018) (1-800-GOLFING for “On-line retail store services featuring golf equipment, golf equipment accessories, clothing, and apparel”); Trademark Reg. No. 2,675,866 (Jan. 21, 2003) (1800CONTACTS for, inter alia, “telephone order services in the field of contact lenses and related products”); Trademark Reg. No., 1,009,717 (Apr. 29, 1975) (1-800-FLOWERS for “receiving and placing orders for flowers and floral products.”); Trademark Reg. No. 3,833,549 (Aug. 17, 2010) (1800CONTACTS.COM for, inter alia, “on-line retail store services featuring contact lenses and related products”). *See also* Br. Resp. App’x.

IV. COMPETITION CONCERNS CAN BE CABINED BY THE PRIMARY SIGNIFICANCE TEST, BUT ACTIONS FOR UNFAIR COMPETITION WILL FAIL TO PROTECT CONSUMERS

Potential competitive harm can be managed with the primary significance test. Courts faced with a genericness challenge to a protected mark apply a

primary significance test to determine if the mark retains distinctiveness. As the Federal Circuit recognized, “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90 (Fed. Cir. 1986). The traditional “Teflon” and “Thermos” surveys applied in genericness disputes investigate and measure how consumers perceive and use the challenged mark. *See, e.g., E.T. Browne Drug Co. v. Cococare Prods, Inc.*, 538 F.3d 185, 193, 195 (3d. Cir. 2008); E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 Trademark Rep. 1118, 1122 (2009). For example, in *Ty, Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 530-31 (7th Cir. 2003), a survey conducted by the plaintiff’s expert found that sixty percent of respondents identified BEANIES as a brand name for soft plush toys filled with beads. The court concluded that this empirical data provided sufficient evidence that the primary significance of the mark was to designate the source of the plaintiff’s goods rather than the goods themselves.

As discussed above, the shift out of protection and into the public domain is justified when the majority of consumers see a term primarily as a product-designator. The law is willing to “sacrifice” the interests of consumers who still see a mark as source-signifying “as soon as a critical mass of consumers treats the term as generic,” because “the harm to consumers who associate the term with the entire class of goods outweighs the harm to the diminishing number who view it only as a mark.” Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 Hous. L. Rev. 777, 794 (2004).

But ignoring a shift from genericness to trademark meaning will increase consumer search costs for the majority of consumers who use and rely on the trademark in question. *See* Desai & Rierson, *supra*, at 1832-33; Bone, *supra*, at 2124. If trademark law is to reduce consumer search costs, courts should apply the same primary significance standard to determine whether a majority of consumers see an ostensibly generic term as a source signifier, rather than relying solely on dictionaries or the term's etymology.

The primary significance test can be applied to acquired distinctiveness cases when the claimed mark is ostensibly generic. A primary significance standard would require that more than fifty percent of consumers perceive the ostensibly generic mark as source signifying. A survey could be conducted to determine whether consumers see a term with generic origin as having acquired secondary meaning. Assuming a proffered survey met established criteria, if a majority of respondents identify the term as a trademark, the survey could help establish that the term has acquired secondary meaning and qualifies for trademark protection.

The primary significance standard is also a more exacting standard than the showing of secondary meaning required to secure protection in a descriptive mark. The level of consumer association necessary to establish secondary meaning varies from court to court and case to case, but some courts have found secondary meaning when surveys reflect consumer association in the thirty percent, or even the twenty percent range. *See, e.g., Shuffle Master Inc. v. Yehia Awada*, 83 U.S.P.Q. 2d 1054, 1057 n.1 (D. Nev. 2006) (“Various courts have held that (approximately thirty percent) recognition is probative of secondary meaning.”);

Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 295 (7th Cir. 1998) (finding survey results in the thirty percent range probative but not dispositive of secondary meaning); *McNeil-PPC v. Granutec, Inc.*, 919 F. Supp. 198, 203 (E.D.N.C. 1995) (thirty-eight percent); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (twenty-eight percent). But “[c]ourts have not found secondary meaning based upon survey percentages in the 10-percent range.” Gerald L. Ford, *Survey Percentages in Lanham Act Matters, in Trademark and Deceptive Advertising Surveys: Law, Science, and Design* 311, 317 & n.36 (Diamond & Swann, eds., 2012).

Finally, the government suggests that firms like Booking.com can acquire all the relief they need without trademark protection through actions for unfair competition. Pet. Br. at 34-35. But many courts refuse to extend unfair competition protection even when presented evidence of actual consumer confusion. For example, in *BellSouth Corp. v. White Director Publishers, Inc.*, 42 F. Supp. 2d 598, 612 (M.D.N.C. 1999), the court discounted evidence of consumer confusion on de facto secondary meaning grounds and denied unfair competition protection. Cases like *BellSouth* show that unfair competition law may fall short of protecting consumers when they vest an ostensibly generic term with trademark meaning and rely on it when making purchasing decisions.

Additionally, courts often attempt to remedy unfair competition by requiring the junior user to use a disclaimer disavowing its connection to the senior user. For example, in *Barton v. Rex-Oil Co.*, 2 F.2d 402, 406-07 (3d Cir. 1924), the court limited relief to an order requiring defendants to add a disclaimer to alleviate consumer confusion. However, research indicates

many disclaimers are ineffective. Gita Venkataramani Johar & Carolyn J. Simmons, *The Use of Concurrent Disclosures to Correct Invalid Inferences*, 26 J. Consumer Res. 307, 320 (2000); Jacob Jacoby & Robert Lloyd Raskopf, *Disclaimers in Trademark Infringement Litigation: More Trouble than They Are Worth?*, 76 Trademark Rep. 35, 36, 54-58 (1986); Mitchell E. Radin, *Disclaimers as a Remedy for Trademark Infringement: Inadequacies and Alternatives*, 76 Trademark Rep. 5, 9, 61-67 (1986). Indeed, some research suggests that disclaimers actually *increase* the likelihood that consumers will associate the product bearing the disclaimer with the source disclaimed. *See, e.g.*, Jacob Jacoby & George J. Szybillo, *Why Disclaimers Fail*, 84 Trademark Rep. 224 (1994).

* * *

If there is sufficient evidence that the majority of consumers have come to see a term as source-signifying rather than merely product-designating, the term should be protectable like any other trademark.

CONCLUSION

For the foregoing reasons, the judgment below should be affirmed.

Respectfully submitted,

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APPENDIX

APPENDIX

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