

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 SALESFORCE.COM, INC., THE HOME
DEPOT, INC., AND BA SPORTS NUTRITION, LLC
AS AMICI CURIAE IN SUPPORT OF
RESPONDENT**

LEE D. SOFFER
GENERAL COUNSEL
BA SPORTS NUTRITION, LLC
17-20 Whitestone Expressway
Whitestone, NY 11357
(718) 989-0155
LSoffer@drinkbodyarmor.com

*Counsel for Amicus Curiae BA
Sports Nutrition, LLC*

THOMAS G. HUNGAR
Counsel of Record
HOWARD S. HOGAN
JOSHUA M. WESNESKI
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 887-3784
thungar@gibsondunn.com

*Counsel for Amici Curiae
Salesforce.com, Inc. and The
Home Depot, Inc.*

TABLE OF CONTENTS

	<u>Page</u>
INTEREST OF AMICI CURIAE	1
INTRODUCTION AND SUMMARY OF ARGUMENT	2
ARGUMENT	4
I. Distinctiveness Is A Factual Question	4
A. The Lanham Act Requires An Individualized, Fact-Based Assessment Of Distinctiveness.....	5
1. The Text Of The Lanham Act Requires Factual Assessments Of Distinctiveness.....	6
2. The Government’s Rule Is Unsupported By The Law	14
B. Per Se Exclusions Are Disfavored In Trademark Law	18
II. A Fact-Based Inquiry Is Consistent With The Lanham Act’s Purpose And Design	21
CONCLUSION	28
APPENDIX - EXEMPLAR LIST OF BRANDS AND VALUES	

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Abercrombie & Fitch Co. v. Hunting World, Inc.</i> , 537 F.2d 4 (2d Cir. 1976)	4, 12
<i>Am. Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp.</i> , 622 F. Supp. 673 (N.D. Ill. 1985).....	22
<i>Am. Online, Inc. v. AT&T Corp.</i> , 64 F. Supp. 2d 549 (E.D. Va. 1999), <i>aff'd in part, vacated in part</i> , 243 F.3d 812 (4th Cir. 2001).....	12
<i>Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.</i> , 684 F.2d 1316 (9th Cir. 1982).....	8
<i>B & B Hardware, Inc. v. Hargis Indus., Inc.</i> , 575 U.S. 138 (2015).....	24
<i>Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.</i> , 76 F.3d 743 (6th Cir. 1996).....	11
<i>Bayer Co. v. United Drug Co.</i> , 272 F. 505 (S.D.N.Y. 1921)	11, 14
<i>Bd. of Supervisors of La. State Univ. v. Smack Apparel Co.</i> , 438 F. Supp. 2d 653 (E.D. La. 2006)	24

<i>Berner Int’l Corp. v. Mars Sales Co.</i> , 987 F.2d 975 (3d Cir. 1993)	11, 12
<i>Blinded Veterans Ass’n v. Blinded Am. Veterans Found.</i> , 872 F.2d 1035 (D.C. Cir. 1989)	19
<i>Boston Duck Tours, LP v. Super Duck Tours, LLC</i> , 531 F.3d 1 (1st Cir. 2008)	19
<i>Cal. Cooler, Inc. v. Loretto Winery, Ltd.</i> , 774 F.2d 1451 (9th Cir. 1985).....	17, 27
<i>Coca-Cola Co. v. Gemini Rising, Inc.</i> , 346 F. Supp. 1183 (E.D.N.Y. 1972)	20
<i>Colt Def. LLC v. Bushmaster Firearms, Inc.</i> , 486 F.3d 701 (1st Cir. 2007)	14
<i>Dial-A-Mattress Franchise Corp. v. Page</i> , 880 F.2d 675 (2d Cir. 1989)	23
<i>In re Dial-A-Mattress Operating Corp.</i> , 240 F.3d 1341 (Fed. Cir. 2001)	23
<i>Donchez v. Coors Brewing Co.</i> , 392 F.3d 1211 (10th Cir. 2004).....	11
<i>E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.</i> , 393 F. Supp. 502 (E.D.N.Y. 1975)	14

<i>In re E.I. DuPont DeNemours & Co.</i> , 476 F.2d 1357 (C.C.P.A. 1973).....	17
<i>E.T. Browne Drug Co. v. Cococare Prods., Inc.</i> , 538 F.3d 185 (3d Cir. 2008)	11
<i>Elliot v. Google Inc.</i> , 45 F. Supp. 3d 1156 (D. Ariz. 2014), <i>aff'd</i> , 860 F.3d 1151 (9th Cir. 2017)	15
<i>Estate of P.D. Beckwith, Inc. v. Comm’r of Patents</i> , 252 U.S. 538 (1920).....	16
<i>Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.</i> , 198 F.3d 1143 (9th Cir. 1999).....	19
<i>Forum Corp. of N. Am. v. Forum, Ltd.</i> , 903 F.2d 434 (7th Cir. 1990).....	11
<i>Goodyear’s Rubber Manufacturing Co. v. Goodyear Rubber Co.</i> , 128 U.S. 598 (1888).....	15, 16
<i>Gozlon-Peretz v. United States</i> , 498 U.S. 395 (1991).....	10
<i>H.W. Carter & Sons, Inc. v. William Carter Co.</i> , 913 F. Supp. 796 (S.D.N.Y. 1996).....	25
<i>Harley-Davidson, Inc. v. Grottanelli</i> , 164 F.3d 806 (2d Cir. 1999)	20

<i>Hershey Co. v. Promotion in Motion, Inc.</i> , No. 07-CV-1601, 2011 WL 5508481 (D.N.J. Nov. 7, 2011).....	15
<i>Howe Scale Co. v. Wyckoff, Seamans & Benedict</i> , 198 U.S. 118 (1905).....	16
<i>Kellogg Co. v. Nat'l Biscuit Co.</i> , 305 U.S. 111 (1938).....	8
<i>Knights Armament Co. v. Optical Sys. Tech., Inc.</i> , 654 F.3d 1179 (11th Cir. 2011).....	11
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 543 U.S. 111 (2004).....	27
<i>Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.</i> , 192 F.3d 337 (2d Cir. 1999)	11
<i>Lexmark Int'l, Inc. v. Static Control Components</i> , 572 U.S. 118 (2014).....	10
<i>Nature's Bounty, Inc. v. Basic Organics</i> , 432 F. Supp. 546 (E.D.N.Y. 1977)	8
<i>In re Nett Designs, Inc.</i> , 236 F.3d 1339 (Fed. Cir. 2001)	11

<i>Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.</i> , 469 U.S. 189 (1985).....	6, 10, 15
<i>Peoples Fed. Sav. Bank v. People's United Bank</i> , 672 F.3d 1 (1st Cir. 2012)	11
<i>Qualitex Co. v. Jacobson Prods. Co.</i> , 514 U.S. 159 (1995).....	6, 16, 18, 19, 22
<i>Reese Publ'g Co. v. Hampton Int'l Commc'ns, Inc.</i> , 620 F.2d 7 (2d Cir. 1980)	12
<i>Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.</i> , 601 F.2d 1011 (9th Cir. 1979).....	27
<i>Swatch AG v. Beehive Wholesale, LLC</i> , 739 F.3d 150 (4th Cir. 2014).....	11
<i>TCPIP Holding Co. v. Haar Commc'ns, Inc.</i> , 244 F.3d 88 (2d Cir. 2001)	20
<i>Timelines, Inc. v. Facebook, Inc.</i> , 938 F. Supp. 2d 781 (N.D. Ill. 2013).....	15
<i>Truck Equip. Serv. Co. v. Fruehauf Corp.</i> , 536 F.2d 1210 (8th Cir. 1976).....	25
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	4, 22

<i>Ty Inc. v. Softbelly's Inc.</i> , 353 F.3d 528 (7th Cir. 2003).....	20
<i>Union Carbide Corp. v. Ever-Ready Inc.</i> , 531 F.2d 366 (7th Cir. 1976).....	19, 27
<i>WSM, Inc. v. Hilton</i> , 724 F.2d 1320 (8th Cir. 1984).....	11
<i>Xtreme Lashes, LLC v. Xtended Beauty, Inc.</i> , 576 F.3d 221 (5th Cir. 2009).....	11
<i>Zobmondo Entm't, LLC v. Falls Media, LLC</i> , 602 F.3d 1108 (9th Cir. 2010).....	11

Statutes

15 U.S.C. § 1052	6
15 U.S.C. § 1052(a).....	6, 9, 21
15 U.S.C. § 1052(d).....	21
15 U.S.C. § 1052(e)(1).....	7, 28
15 U.S.C. § 1052(e)(3).....	9, 21
15 U.S.C. § 1052(e)(5).....	9, 21
15 U.S.C. § 1052(f).....	3, 6, 7, 9, 12, 16, 21, 28
15 U.S.C. § 1053	3, 6, 7
15 U.S.C. § 1064(3).....	3, 8

15 U.S.C. § 1065	13
15 U.S.C. § 1091(a).....	7
15 U.S.C. § 1114(1)(a)	28
15 U.S.C. § 1115(b)(4)	28
15 U.S.C. § 1116	10
Pub. L. No. 66-163, 41 Stat. 533 (repealed 1946).....	6
Pub. L. No. 104-98, § 3, 109 Stat. 985	20
Pub. L. No. 109-312, § 2, 120 Stat. 1730, <i>codified at</i> 15 U.S.C. § 1125(c)(1)	21

Other Authorities

Ellen P. Aprill, <i>The Law of the Word: Dictionary Shopping in the Supreme Court</i> , 30 Ariz. St. L.J. 275 (1998).....	12
Robert C. Denicola, <i>Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols</i> , 1982 Wis. L. Rev. 158	22, 25
Deven R. Desai & Sandra L. Rierson, <i>Confronting the Genericism Conundrum</i> , 28 Cardozo L. Rev. 1789 (2007)	12, 20, 22

Michael J. Freno, <i>Trademark Valuation: Preserving Brand Equity</i> , 97 Trademark Rep. 1055 (2007)	27
Neal A. Hoopes, <i>Reclaiming the Primary Significance Test: Dictionaries, Corpus Linguistics, and Trademark Genericide</i> , 54 Tulsa. L. Rev. 407 (2019).....	26
Internet Corporation for Assigned Names and Numbers, <i>List of Top-Level Domains</i> , https://bit.ly/31qbORv (last visited Feb. 17, 2020)	18
Rita M. Irani, <i>The Importance of Record Evidence to Categorize Marks as Generic, Descriptive, or Suggestive</i> , 83 Trademark Rep. 607 (1993)	15
Robert N. Klieger, <i>Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection</i> , 58 U. Pitt. L. Rev. 789 (1997)	25
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (5th ed. 2019).....	5, 8, 9, 12, 14, 15
S. Rep. No. 98-627 (1984)	8, 9
S. Rep. No. 1333 (1946)	6, 16, 22

Squarespace, *Claim Your Domain*,
<https://bit.ly/2OtEUdn> (last visited
Feb. 17, 2020)27

INTEREST OF AMICI CURIAE¹

Amici curiae are businesses that own or intend to own trademark rights in various distinctive marks that customers have come to associate with amici. They have an interest in protecting those marks from infringement by competitors or imitators who may seek to take advantage of the goodwill that amici have developed with their customers. They also have an interest in the crafting of sensible, flexible rules that appropriately reflect the balance between protection of valid trademarks and unfettered usage of generic terms to describe products and services.

This case is of importance to amici because the government has proposed a *per se* rule prohibiting trademark registration for marks consisting of a generic term and a “top-level domain.” Judicial creation of such *per se* rules would threaten to undermine amici’s interest in protecting their trademarks. Amici have obtained trademarks by investing in their marks and establishing distinctiveness in the marketplace. They expect that if their trademarks are challenged—or if they seek to obtain additional trademarks—they will be able to protect their trademarks by adducing evidence that customers actually understand their trademarks to identify goods or services from a particular source. The government’s position here, however, threatens to undermine that well-established legal framework by inviting the creation of inflexible

¹ Pursuant to Supreme Court Rule 37.6, counsel for amici curiae states that no counsel for a party authored this brief in whole or in part, and no party or counsel for a party, or any other person other than amici curiae or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. All parties have consented in writing to the filing of this brief.

bright-line rules that operate to divest businesses of substantial investments in their trademarks and encourage the arbitrary rejection or cancellation of trademarks, even where the public has come to understand a particular mark as distinctive in identifying the trademark owner's goods or services. That approach is antithetical to the text and purposes of the Lanham Act, harmful to consumers, and destructive of the reasonable, investment-backed expectations of countless trademark owners like amici.

For the above reasons, amici have a substantial interest in the proper resolution of the question presented in this case.

INTRODUCTION AND SUMMARY OF ARGUMENT

Elevating the convenience of bright-line rules above statutory text and structure, judicial precedent, the interests of consumers, and the realities of the marketplace, the government takes the extraordinary position that this Court should manufacture an arbitrary and atextual per se rule categorically prohibiting trademark registration of any mark consisting of a generic term and a "top-level domain" (e.g., .com, .net, .org). Gov't Br. 15. The Lanham Act precludes judicial creation of such a rigid, bright-line rule that appears nowhere in the statutory text, and the government's approach is also irreconcilable with the purpose and design of the Act. Nothing in the Lanham Act permits, let alone requires, this Court to fabricate a rigid rule that prevents a factfinder from assessing the facts and circumstances of a particular mark to determine whether the Act's standard for distinctiveness has been satisfied.

I. The Lanham Act makes clear that the question whether a mark is distinctive and therefore entitled to registration is quintessentially a factual one. Although the Act sets forth several categorical prohibitions against trademark registration of certain marks (e.g., a person cannot receive a trademark for the Great Seal of the United States), its restriction against registration of “merely descriptive” marks is expressly *not* categorical. Rather, in all cases not falling within the Act’s categorical prohibitions, a registrant may obtain a trademark for a mark consisting of descriptive terms if the mark “has become distinctive of the applicant’s goods [or services] in commerce.” 15 U.S.C. § 1052(f); *id.* § 1053; *see also id.* § 1064(3) (in a cancellation proceeding, the court tests the mark’s “primary significance”). That inquiry necessarily requires a fact-based assessment of how the consuming public actually understands a particular mark. Resort to broad, unbending rules like the one proposed by the government here is inconsistent with the statutory text and structure. The fact that this case involves a “top-level domain” does nothing to alter that analysis.

This Court and others have rightly expressed strong disapproval of judicially fashioned bright-line rules in the context of trademark law. While some categories of marks may in practice be less likely to obtain distinctiveness than others, that does not justify a rule that ignores the *possibility* that a mark in one of those categories may nonetheless achieve such significance in the minds of consumers that trademark protection is warranted. And Congress, too, has repeatedly rejected this kind of categorical rule in the trademark context, including by amending the Federal Trademark Dilution Act to reject a judicially fashioned *per se* rule of exclusion.

II. A flexible fact-based inquiry also accords with the twin goals of the Lanham Act—protecting consumers from confusion and ensuring that trademark holders retain the goodwill and reputation generated through investment—while the government’s inflexible rule does not. A host of valuable trademarks would be at risk were the Court to endorse the logic of the government’s per se rule. And the government’s policy concern regarding monopolization of dictionary terms ignores the numerous mechanisms already in place to protect against any such attempts.

ARGUMENT

I. DISTINCTIVENESS IS A FACTUAL QUESTION

Courts applying the Lanham Act have long recognized that marks may be divided into one of five buckets across a spectrum of 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)). Marks found to be on the “high” end of the distinctiveness spectrum when evaluated on an appropriate record—those that are “arbitrary” (e.g., APPLE, for computers) or “fanciful” (e.g., KODAK)—are inherently distinctive and entitled to trademark protection. *See ibid.* A mark will be found to be “suggestive” (e.g., COPPERTONE)—and therefore also inherently distinctive, even though it suggests something about the relevant product or service—if the record establishes that it “requires imagination, thought and perception to reach a conclusion as to the nature of goods,” such as by “convey[ing] an immediate idea of the ingredients, qualities or characteristics of the goods.” *Abercrombie & Fitch Co.*, 537 F.2d at 11 (quo-

tation marks omitted). “Descriptive” marks, however—those that do more than indirectly suggest something and actually describe the nature of a good or service—require a factual showing that they have acquired distinctiveness and can assist consumers in distinguishing one provider of goods or services from another before being registered on the principal register. Marks shown to be purely “generic,” in contrast, are not eligible for trademark protection. *See* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:2 (5th ed. 2019).

The sole question in this case is whether BOOKING.COM falls into the “generic” bucket or the “descriptive” bucket. The government does not challenge the lower court’s determination that BOOKING.COM has acquired “secondary meaning” in the marketplace—that is, customers understand that the mark identifies the services of a particular provider—and therefore is protectable if it is “descriptive.” Pet. App. 8a. Instead of allowing Booking.com to use evidence to test whether its mark is generic or descriptive, however, the government offers a *per se* rule to resolve that question, saying that a term that is generic on its own (e.g., WEATHER) can *never* become distinctive through the addition of a top-level domain (e.g., WEATHER.COM). The government’s rule is contrary to law and should be rejected.

A. The Lanham Act Requires An Individualized, Fact-Based Assessment Of Distinctiveness

The government’s request for a categorical prohibition against “generic.com” trademarks is inconsistent with the text of the Lanham Act, which (with

express exceptions that are not implicated here) contemplates individualized factual inquiries into the distinctiveness of proposed trademarks.

The Lanham Act was passed in 1946 pursuant to Congress's view that "a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985) (quotation marks omitted) (quoting S. Rep. No. 1333, at 6 (1946)). Although common law had long provided protection for distinctive marks—and Congress had codified certain limited elements of that law, *see, e.g.*, Act of Mar. 19, 1920, Pub. L. No. 66-163, 41 Stat. 533 (repealed 1946)—the Lanham Act "significantly changed and liberalized the common law" of trademarks, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995). Most critically, Congress for the first time afforded trademark protection to descriptive terms that had "acquired 'secondary meaning'" (i.e., distinctiveness), a class of marks unprotected at common law. *Ibid.*; *see also* 15 U.S.C. § 1052(f).

1. The Text Of The Lanham Act Requires Factual Assessments Of Distinctiveness

The Lanham Act announces a general rule permitting registration of any mark "by which the goods [or services] of the applicant may be distinguished from the goods [or services] of others." 15 U.S.C. § 1052; *see id.* § 1053. The Act then sets forth a discrete list of exceptions to that general rule—for example, insignia of the United States or an unlicensed portrait of a living person cannot be registered. *Id.* § 1052(a)–(e). One of those exceptions provides that a trademark shall not issue for a mark that, "when used on or in connection with the goods [or services] of the

applicant is merely descriptive . . . of them.” *Id.* § 1052(e)(1); *see id.* § 1053.²

The Act provides that most of the statutory exceptions to registration (such as insignia of the United States) are categorical bars to registration, meaning that marks of those types cannot be registered no matter how distinctive they are. 15 U.S.C. § 1052(f) (mandating registration of marks that have become distinctive “[e]xcept as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5)”). Importantly, however, Congress expressly exempted all other types of marks from that categorical bar, specifically including the exception in Section 1052(e)(1) for “merely descriptive” marks. As to the latter category of marks, Congress declared in unambiguous terms that “*nothing in [this Act] shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods [or services] in commerce.*” *Id.* § 1052(f) (emphases added). Thus, Congress spoke directly to the question of whether to impose per se bans on registration of certain types of marks, and expressly declined to follow that approach for “merely descriptive” marks, instead mandating an inherently factual inquiry into whether the mark has “become distinctive.”

Similarly, when a challenger seeks to *cancel* an existing trademark on the ground that it has become

² In addition to the “principal register,” the Lanham Act also permits an applicant to register a mark on the “supplemental register” if the mark is “capable of distinguishing applicant’s goods or services” but not actually distinctive at present. 15 U.S.C. § 1091(a). Such marks receive only minimal protection from unfair competition. Throughout this brief, amici use “register” to refer to registration on the principal register pursuant to 15 U.S.C. §§ 1052, 1053.

merely “the generic name for the goods or services,” the Lanham Act again requires a factual assessment of whether the mark possesses the requisite distinctiveness, stating that “[t]he primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services.” 15 U.S.C. § 1064(3); *see also Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (setting forth the “primary significance” test). Although the primary significance test applies, under the statute, only at the cancellation stage, it often is used also at the initial registration stage, interchangeably with the distinctiveness standard of 15 U.S.C. § 1052(f). *See* 2 McCarthy, *supra* § 12:57 (“[T]here is no reason not to apply [the primary significance test] with equal force to the initial attempt to register an allegedly generic term.”); *see also Nature’s Bounty, Inc. v. Basic Organics*, 432 F. Supp. 546, 552 (E.D.N.Y. 1977) (applying the two tests interchangeably). If the primary significance of a mark is to distinguish the owner’s goods or services from those of its competitors, by definition it is not generic; if its primary significance is instead to identify a general class of goods or services, it necessarily lacks distinctiveness.³

³ The “primary significance” test was added to the statute in 1984 to overturn the Ninth Circuit’s decision in *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, holding that MONOPOLY was a generic term because although customers associated MONOPOLY with a particular board-game producer, the producer’s identity was not their primary motivation for purchasing the game. 684 F.2d 1316, 1323–26 (9th Cir. 1982). The legislative history makes clear that the amendment was not intended to change the law, but to “reaffirm[] and clarif[y] the established principles of trademark law existing before the *Anti-Monopoly* decision.” S. Rep. No. 98-627, at 8 (1984). It also confirms that

Whether proceeding under Section 1052’s test for distinctiveness or under Section 1064’s equivalent test for “primary significance” in a cancellation case, the distinctiveness of a mark depends on the particular facts and circumstances. As noted above, Congress specifically addressed the question whether to impose categorical bars on registration for particular classes of marks, and in fact did so for the specific classes set forth in 15 U.S.C. § 1052(a)–(d), (e)(3), and (e)(5), but expressly *rejected* such a categorical approach for other marks, including those that are or could be viewed as “merely descriptive,” *id.* § 1052(f). And for those marks that are not subject to an express categorical prohibition set forth in the statute, the Lanham Act expressly mandates a fact-based assessment of whether the mark “has become distinctive of the applicant’s goods in commerce,” *ibid.*, i.e., whether the “primary significance” of the mark is to identify a unique producer or seller of goods or services, *see* 2 McCarthy, *supra*, § 12:4 (“[T]he key issue in determining genericness . . . is[] what does the public think the word connotes—the generic name of the product or a mark indicating merely one source of that product?”).

Congress has therefore set forth precisely which characteristics make a mark categorically ineligible for protection, and which are instead subject to the flexible and fact-based distinctiveness inquiry under

the primary-significance test seeks to distinguish marks that “identif[y] . . . particular products or services with a particular source, even if the actual source is unknown,” and thus operate “in the mind of the consumer as an indicator of source, sponsorship, approval or affiliation” on the one hand, from marks that are generic in that they “do[] not perform one or more of these functions, but rather serve[] merely as the common descriptive name for the article in question,” on the other. *Id.* at 2.

Section 1052(f). The critical contrast between those two classes of marks precludes adoption of the government’s proposed per se rule. By expressly delineating these two distinct classes of marks, Congress made clear that only the specifically enumerated prohibitions are to act as categorical bars to registration, and that other barriers must be assessed on a case-by-case basis. The government seeks to override that congressional determination by fiat, but fundamental principles of statutory construction preclude that result: *Expressio unius est exclusio alterius*. See, e.g., *Gozlon-Peretz v. United States*, 498 U.S. 395, 404 (1991) (“Where Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” (alteration and quotation marks omitted)).

Consistent with those established principles, this Court has refused to read additional limitations into the Lanham Act beyond those provided in the text. In *Park ’N Fly*, the Court rejected the contention that the authorization in the Lanham Act for courts to grant injunctions “according to the principles of equity” (15 U.S.C. § 1116) conferred a power to dismiss infringement claims based on the trial court’s view that an otherwise incontestable mark lacked secondary meaning. 469 U.S. at 202–03. The Court explained that reading such power into the equitable clause would “vitiat[e] the more specific provisions” of the statute. *Id.* at 203; see also *Lexmark Int’l, Inc. v. Static Control Components*, 572 U.S. 118, 128 (2014) (“We do not ask whether in our judgment Congress *should* have authorized [the plaintiff’s] suit, but whether Congress in fact did so.”). An inflexible approach to distinctiveness similarly lacks any grounding in the text of the

Act, and, if adopted, would “vitiat[e]” the specific categorical prohibitions to registration set forth in the statute.

Unsurprisingly, courts have long understood that assessing whether a mark is distinctive and whether its “primary significance” is as a generic term or instead as an identifier of a particular supplier is a fact-based inquiry, relying “in all cases upon a mark’s meaning to consumers.” *Berner Int’l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982 (3d Cir. 1993); *see also Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921) (Hand, J.) (“The single question, as I view it, in all these cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending?”).

The federal courts of appeals have thus long recognized that whether a term is “generic,” “descriptive,” or something else is a question of fact. *See Peoples Fed. Sav. Bank v. People’s United Bank*, 672 F.3d 1, 15 (1st Cir. 2012); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 344 (2d Cir. 1999); *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 192 (3d Cir. 2008); *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009); *Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, 76 F.3d 743, 748 (6th Cir. 1996); *Forum Corp. of N. Am. v. Forum, Ltd.*, 903 F.2d 434, 438 (7th Cir. 1990); *WSM, Inc. v. Hilton*, 724 F.2d 1320, 1325–26 (8th Cir. 1984); *Zobmondo Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1216 (10th Cir. 2004); *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 654 F.3d 1179, 1188 (11th Cir. 2011); *In re Nett Designs, Inc.*, 236 F.3d

1339, 1341 (Fed. Cir. 2001). Leading secondary authority is in accord. *See* 2 McCarthy, *supra*, § 12:12 (“Genericness is a question of fact.”).

The reason that fact-based analyses are required is that the distinction between generic and non-generic marks (such as descriptive marks that possess secondary meaning) is a complex issue. The line between these two categories is rarely a “bright” one. *Reese Publ’g Co. v. Hampton Int’l Commc’ns, Inc.*, 620 F.2d 7, 10 (2d Cir. 1980). And as the Lanham Act recognizes in directing registration of marks that “ha[ve] become distinctive,” 15 U.S.C. § 1052(f) (emphasis added), meaning can change over time, *see Abercrombie & Fitch Co.*, 537 F.2d at 9 (“[A] term may shift from one category to another in light of differences in usage through time”); Deven R. Desai & Sandra L. Rierison, *Confronting the Genericism Conundrum*, 28 Cardozo L. Rev. 1789, 1849 (2007) (“[M]ost words have more than one meaning, and those meanings can and will change over time.”). Even dictionaries are imperfect guides to meaning, as they do not always reflect the unique ways in which terms may be used in a particular context. *See, e.g., Berner Int’l Corp.*, 987 F.2d at 983 (“Dictionary entries also reflect lexicographical judgment and editing which may distort a word’s meaning or importance.”); *Am. Online, Inc. v. AT&T Corp.*, 64 F. Supp. 2d 549, 564 (E.D. Va. 1999) (discounting evidence from dictionaries in favor of record evidence revealing the “true meaning” of the term as used in the mark), *aff’d in part, vacated in part*, 243 F.3d 812 (4th Cir. 2001). Indeed, “[b]ecause of the inevitable time delay between collection of citations and publication of a dictionary, dictionaries must lag behind current use of the language.” Ellen P. Aprill, *The Law of the Word: Dictionary Shopping in the Supreme Court*, 30 Ariz. St. L.J. 275, 287 (1998).

The need for a fact-based assessment is confirmed by the numerous registered trademarks that consist simply of two or more seemingly generic terms. While a combination of two otherwise generic terms may at one point be insufficiently distinctive to warrant trademark protection, that combination may over time come to have an alternative “primary significance” to consumers as a means of distinguishing a particular brand of goods or services:⁴

- BANK OF AMERICA
(Reg. No. 853,860)
- GENERAL ELECTRIC
(Reg. No. 1,448,350)
- HOME SHOPPING NETWORK
(Reg. No. 2,009,383)
- NEW YORK STOCK EXCHANGE
(Reg. No. 924,870)
- TV GUIDE
(Reg. No. 1,767,448)
- U.S. NEWS
(Reg. No. 1,550,917)
- WAFFLE HOUSE
(Reg. No. 1,463,113)

A determination as to whether any of the above were or remain distinctive marks is not subject to mechanical rules. Yet the government’s argument here invites per se rules rendering entire classes of generic terms categorically nondistinctive, even when combined with other terms to form a distinctive mark.

⁴ Each of the listed marks has been designated as “incontestable” pursuant to 15 U.S.C. § 1065.

That approach is inconsistent with a faithful application of the Lanham Act, and with the government's own practice in registering countless marks that consist of nothing more than a combination of seemingly generic terms. *See* Resp. Br. App.

2. The Government's Rule Is Unsupported By The Law

In the certiorari briefing, the government acknowledged the general need for fact-based assessments of distinctiveness, but nevertheless insisted that there is a special, unwritten rule applicable only to corporate suffixes ("Co.," "Inc.," etc.) and top-level domains. Cert. Reply 6–7. No such rule exists. Regardless of whether a top-level domain or some other term is at issue, the question at all times is whether consumers recognize a mark as denoting a particular source rather than merely a type of product. *See Bayer Co.*, 272 F. at 509; *see also Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705 (1st Cir. 2007) ("[A] generic term answers the question 'What are you?' while a mark answers the question 'Where do you come from?"). That determination, as numerous courts have recognized, requires an assessment of several types of permissible evidence. *See* 2 McCarthy, *supra*, § 12:13 (listing types of evidence relevant to genericness).

Evidence regarding distinctiveness does not lose its value simply because of the *type* of generic or descriptive terms at issue. For nearly 45 years, varying types of consumer surveys have been accepted as evidence of whether a term is "generic" or "descriptive." *See, e.g., E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975) (Teflon survey). Those surveys have been considered relevant

evidence in a host of high-profile and high-stakes disputes regarding questions of genericness. *See Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1166–67 (D. Ariz. 2014) (whether GOOGLE is generic), *aff'd*, 860 F.3d 1151 (9th Cir. 2017); *Timelines, Inc. v. Facebook, Inc.*, 938 F. Supp. 2d 781, 792–93 (N.D. Ill. 2013) (whether TIMELINES is generic); *Hershey Co. v. Promotion in Motion, Inc.*, No. 07-CV-1601, 2011 WL 5508481, at *4 (D.N.J. Nov. 7, 2011) (whether Hershey’s KISSES is generic). The notion that such empirical evidence may be disregarded entirely in *any* circumstance not subject to a statutory categorical bar is antithetical to the Lanham Act’s design: “It is an audacious thing for a court to state that consumer perception is irrelevant when the issue is whether a designation is perceived by the consuming public as a generic name or not.” 2 McCarthy, *supra*, § 12:17.25. That admonition resonates with equal force regardless of whether a top-level domain or some other generic signifier is at issue. *See also* Rita M. Irani, *The Importance of Record Evidence to Categorize Marks as Generic, Descriptive, or Suggestive*, 83 Trademark Rep. 607, 609–16 (1993) (cataloguing other forms of record evidence relevant to consumer perception).

This Court’s pre-Lanham-Act decision in *Goodyear’s Rubber Manufacturing Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), does not justify a different analysis. The Court has recognized that the Lanham Act altered the law of trademarks in several fundamental ways. *See, e.g., Park ’N Fly*, 469 U.S. at 199 (“There is no question that the Lanham Act altered existing law concerning trademark rights in several respects.”). Among the most significant of those changes is that, in contrast to prior law, the Lanham Act permits trademark registration of descriptive words that have acquired distinctiveness. Before the

Lanham Act, trademark law “would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade,” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920), regardless of whether the mark had obtained secondary meaning.

Importantly, this Court’s decision in *Goodyear* was expressly premised on that now-discarded rule of law; the Court reasoned that “[n]ames which are thus *descriptive* of a class of goods cannot be exclusively appropriated by any one.” 128 U.S. at 602 (emphasis added). Expressly relying on that understanding of the law, the *Goodyear* Court concluded that “‘Goodyear Rubber’ are terms *descriptive* of well-known classes of goods” and the “addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods,” so the prohibition against trademark protection for “descriptive” terms was controlling. *Ibid.* (emphasis added); see also *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 137 (1905) (relying on *Goodyear* for the proposition that “such descriptive names could not be exclusively appropriated”).

Congress specifically dispensed with that categorical prohibition against registration of “descriptive” terms in the Lanham Act, and replaced it with a fact-intensive inquiry that examines whether the descriptive term has “acquired ‘secondary meaning.’” *Qualitex Co.*, 514 U.S. at 171; see also 15 U.S.C. § 1052(f). The legislative history likewise confirms that the Lanham Act was intended “[t]o remedy constructions of the [existing trademark] acts which have in several instances obscured and perverted their original purpose.” S. Rep. No. 1333, at 5 (1946). The

foundational premise of *Goodyear* is thus no longer good law, and the case therefore cannot control the proper interpretation or application of the Lanham Act. See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (noting the purpose of the Lanham Act to increase trademark protection and thus considering the “pre-Lanham Act decisions presented [in that case] to be inapt” (footnote omitted)). The government’s reliance on *Goodyear* is fundamentally misplaced and should not be permitted to override Congress’s decision to reject the unduly rigid requirements of prior law in favor of broad trademark protection for any mark shown as a matter of fact to be distinctive.

Outside of *Goodyear*, the government offers no principled reason for treating top-level domains any differently from the host of generic terms that may be combined with other generic terms to form potentially distinctive marks. It contends that “[t]he addition of ‘.com’ does not create a protectable mark, because it conveys only that respondent operates a commercial website via the Internet.” Gov’t Br. 15. That tautology does nothing other than to define the meaning of “.com” in a vacuum, contrary to the settled principle that “the validity of a trademark is to be determined by viewing the trademark as a whole.” *Cal. Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985). “Bank” conveys nothing more than a financial institution (of which there are thousands in America), but it takes on unique, distinctive meaning when used in a compound mark such as BANK OF AMERICA that has, by dint of decades of investment in developing brand identity, acquired demonstrable distinctiveness. Moreover, there are numerous top-level domains other than “.com” that, while still generic, actually do convey more substantive meaning

about a product or service. *See* Internet Corporation for Assigned Names and Numbers, *List of Top-Level Domains*, <https://bit.ly/31qbORv> (last visited Feb. 17, 2020) (listing, among others, “.basketball,” “.photography,” and “.weather”). The government’s categorical rule would swallow up a legion of distinctive marks.

B. Per Se Exclusions Are Disfavored In Trademark Law

Even beyond the plain text of the Lanham Act, this Court and other courts have recognized the undesirability of per se rules in the trademark context.

In *Qualitex*, this Court considered whether a registrant could obtain a trademark for a color. 514 U.S. at 160–61. The Court rejected the lower court’s attempt to fashion a per se prohibition against a color trademark, finding that “no special legal rule prevents color alone from serving as a trademark.” *Id.* at 161. The Court added it could not “find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark.” *Id.* at 163. And it went on to explain that “[i]t is the source-distinguishing ability of a mark—not its ontological status as a color, shape, fragrance, word, or sign—that permits it to serve” the “basic objectives of trademark law.” *Id.* at 163–64.

Qualitex confirms the impropriety and undesirability of judicially fashioned per se prohibitions against registration of potentially distinctive marks. Surely the vast majority of the color spectrum may not be appropriated by trademark holders for their exclusive use. But that does not mean that a per se prohibition against registration of color trademarks for particular goods or services is justified: “[C]olor alone, *at*

least sometimes, can meet the basic legal requirements for use as a trademark.” *Qualitex Co.*, 514 U.S. at 166 (emphasis added). The same reasoning applies to sounds, which also may be registered and protected by trademark law—provided they are sufficiently distinctive. *See, e.g.*, MGM – Entertainment – Roaring lion, Reg. No. 73,553,567; Intel – Computer hardware, operating systems, etc. – Chimes, Reg. No. 75,332,744; ESPN – Entertainment – Sports programming – Six musical notes, Reg. No. 75,676,156. True, many generic terms, even when combined with others, will never achieve distinctiveness such that trademark protection is warranted, but as shown above, “at least sometimes” they will. *Qualitex Co.*, 514 U.S. at 165. It therefore is inappropriate to adopt a test that refuses to acknowledge even the possibility that consumers will come to recognize such a mark as distinctive.

The courts of appeals are in accord. Courts have uniformly rejected the claim that two generic terms cannot, when combined, unite to form a single, descriptive term. *See, e.g., Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1149 (9th Cir. 1999) (rejecting the “generic plus generic equals generic approach” (quotation marks omitted)); *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1041 (D.C. Cir. 1989) (“[W]ords which could not individually become a trademark may become one when taken together.” (quotation marks omitted)); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) (same). This “anti-dissection rule” situates a term in “its proper context” and permits a court to fully examine the circumstances surrounding a mark’s distinctiveness. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 18–19 (1st Cir. 2008).

This aversion to categorical rules accords with the more general notion that a judicial declaration that a term is “generic” and “thus pitch[ed] . . . into the public domain is a fateful step.” *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531 (7th Cir. 2003) (Posner, J.). Current doctrine treats terms adjudged to be “generic” by a court as ineligible in perpetuity for trademark protection, see *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 811 (2d Cir. 1999), although the basis for that rule is dubious, see Desai & Rierson, *supra*, at 1849–50, and is nowhere expressed in the Lanham Act. Prudence dictates caution before declaring entire *categories* of terms per se ineligible for protection as a matter of law for all time.

Congress, too, has expressed its disapproval of bright-line trademark rules. Prior to 2006, some courts had held that the Federal Trademark Dilution Act—which provided a separate cause of action against uses that dilute a “famous” mark even if they do not cause consumer confusion, see Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 985—applied only to those marks that were inherently distinctive, and not to those that had acquired distinctiveness, see *TCPIP Holding Co. v. Haar Commc’ns, Inc.*, 244 F.3d 88, 95 (2d Cir. 2001). In 2006, Congress rejected that bright-line prohibition and instead provided that descriptive marks that had acquired distinctiveness (e.g., COCA-COLA⁵) are entitled to protection against dilution so long as the owner can separately establish that the mark is not

⁵ See, e.g., *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189 n.7 (E.D.N.Y. 1972) (“The name ‘Coca-Cola’ is derived from the Andean coca leaf plant and the African cola nut, extracts of which gave the beverage its flavor.”).

only “distinctive, inherently or through acquired distinctiveness,” but also “famous” under a flexible four-factor test. *See* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1730, *codified at* 15 U.S.C. § 1125(c)(1). This amendment confirms Congress’s aversion—codified in the Lanham Act itself—to categorical trademark rules beyond those expressly set forth in the statute. The government’s position—which would mean that a mark that satisfies all of the factors for fame could nevertheless be denied protection—cannot be squared with Congress’s insistence on a fact-based approach.

* * *

The Lanham Act mandates registration of a mark that “has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f). None of the Act’s several categorical exceptions to that rule is applicable here. *See id.* § 1052(a), (d), (e)(3), (e)(5). The Lanham Act therefore does not contemplate the erection of other per se rules barring registration of distinctive marks, and indeed, courts have long engaged in fact-based assessments to determine whether a mark is entitled to protection. The government’s position is squarely contradicted by the text and structure of the Act and by decades of case law and practice, and should be rejected.

II. A FACT-BASED INQUIRY IS CONSISTENT WITH THE LANHAM ACT’S PURPOSE AND DESIGN

Even setting aside the text of the Lanham Act, its purpose and design call for a flexible, fact-based approach to distinctiveness. Per se rules, on the other hand, ignore the Act’s goal of protecting consumers, and divest companies of the goodwill they have worked hard to earn.

Trademark law—as codified by the Lanham Act—serves two goals: (1) to “protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get,” and (2) to ensure that “where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.” S. Rep. No. 1333, at 3 (1946); *see also Two Pesos, Inc.*, 505 U.S. at 782 n.15 (same). “The concept of customer confusion is . . . the touchstone of traditional trademark theory.” Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 Wis. L. Rev. 158, 160. But at the same time, “the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.” *Qualitex Co.*, 514 U.S. at 164. Per se rules that prohibit the registration of entire classes of terms without any assessment of how the public recognizes those terms—or of the investment that producers have made in building a brand—undermine both those goals.

First, as noted above, the meaning of certain terms or marks changes over time. *See* Desai & Rier-son, *supra*, at 1849. A term like “American Airlines” may at one point in time be simply a description of any airline that operates in America, but through public outreach and sustained usage, it may (and clearly has) become synonymous with a particular producer. *See Am. Airlines, Inc. v. A 1-800-A-M-E-R-I-C-A-N Corp.*, 622 F. Supp. 673, 683 (N.D. Ill. 1985). Indeed, even the word “American,” when used in a particular context (such as air travel), may become distinctive in

that context. *Ibid.* Likewise, a mnemonic telephone number—like 1-888-M-A-T-R-E-S-S—may start out as a nondistinctive signifier of a company that sells mattresses over the phone, but can acquire distinctive meaning over time. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001); see also *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 678 (2d Cir. 1989) (“Companies doing significant business through telephone orders frequently promote their telephone numbers as a key identification of the source of their products.”).

Extending trademark protection to such marks protects consumers from imposters who might attempt to capitalize on the goodwill or customer loyalty of a mark’s owner. The numerous examples above of terms that have acquired distinctiveness over time are relevant because they reflect shifting *consumer* understanding. Trademark law recognizes and fosters the development of such consumer understanding and seeks to fend off those who would seek to misappropriate it. In the *American Airlines* case, for example, the infringing mark was a telephone number strategically purchased and marketed to dupe customers into believing they were purchasing flights directly from American Airlines. See *Am. Airlines, Inc.*, 622 F. Supp. at 675–76. Even the mark at issue here—BOOKING.COM—has its imposters in the form of websites that slightly alter the spelling in hopes of exploiting respondent’s goodwill by deceiving careless consumers. *E.g.*, bo0king.com, b00king.com.⁶

The government is incorrect that protections outside of trademark registration are sufficient to protect consumers from confusion. Gov’t Br. 34–35. This

⁶ Readers are advised not to visit these websites themselves.

Court has recognized that “[r]egistration is significant” because of the “important legal rights and benefits” it confers on trademark owners. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015) (quotation marks omitted). In particular:

Registration, for instance, serves as “constructive notice of the registrant’s claim of ownership” of the mark. It also is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.” And once a mark has been registered for five years, it can become “incontestable.”

Id. at 142–43 (citations omitted). The loss of these protections harms consumers, who are consequently more vulnerable to attempts by others to take advantage of their brand loyalty.

Second, trademark protection of these types of marks will encourage investment into new branding identities and reward those companies that build loyalty with customers. Distinctiveness is not obtained overnight—it is the product of “the expenditure of great effort, skill and ability.” *Bd. of Supervisors of La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 660 (E.D. La. 2006) (quotation marks omitted). Creating source-identifying meaning in an otherwise non-distinctive mark is difficult because it entails not just investing in marketing and advertising to establish the mark’s distinctiveness, but also developing a product or service that customers actually *desire* and will associate favorably with the mark. Having made such investments, trademark law recognizes “the

businessman's right to enjoy business earned through investment in the good will and reputation attached to a trade name." *H.W. Carter & Sons, Inc. v. William Carter Co.*, 913 F. Supp. 796, 804 (S.D.N.Y. 1996) (quotation marks omitted); *see also Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir. 1976) ("Full and fair competition requires that those who invest time, money and energy into the development of goodwill and a favorable reputation be allowed to reap the advantages of their investment.").

Trademark law is needed to protect that investment: "[C]ompanies often invest thousands or even millions of dollars in the development of trademarks that soon become targets of unscrupulous infringers or clever appropriators." Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. Pitt. L. Rev. 789, 792 (1997). Absent adequate protection, the trademark holder loses the benefit of its investment—not only may consumers be diverted from the brand they intend to purchase, but "any subsequent dissatisfaction [with the product] will be at the expense of the [original] user's reputation and good will." Denicola, *supra*, at 163.

Accepting the government's per se rule in this case—and thereby opening the door to similar categorical rules—could destabilize billions of dollars of brand investment. The government's rule would undermine the long-understood principle that distinctiveness is a factual question and would serve as an invitation for lower courts to begin fashioning similar categorical prohibitions based on the same unfounded fears asserted here. A survey of the most valuable brands in the United States demonstrates the point—numerous businesses brand their companies with

trademarks that consist only of generic or descriptive words that customers have come to associate with a particular source of origin. *Cf.* Neal A. Hoopes, *Reclaiming the Primary Significance Test: Dictionaries, Corpus Linguistics, and Trademark Genericide*, 54 *Tulsa L. Rev.* 407, 408 (2019) (a trademark “often remains among a company’s most valuable assets”). To give just two examples from among the most valuable brands, COCA-COLA (~\$80.3 billion) and BANK OF AMERICA (~\$15.1 billion) could have their marks subjected to legal challenges if the logic of the government’s position here were to prevail (leading to yet additional *per se* rules), potentially threatening to divest those companies of the distinctive marks they have spent years (and invested millions, if not billions, of dollars) developing.⁷ The harm to these businesses from *per se* rules that exclude admittedly distinctive marks is not hypothetical—it is measured in real dollars. It thus benefits none of the intended beneficiaries of the Lanham Act—neither consumers nor trademark holders—to impose categorical rules that turn a blind eye to reality and strip businesses of their hard-earned reputation and goodwill.

As for the government’s parade of horrors, Gov’t Br. 26–30, there is no reason to believe they will come to pass. Rejection of the government’s categorical rule will not entitle holders of domain names to monopolize the dictionary—a registrant cannot simply tack on “.com” to any generic term and expect to receive a trademark. A mark’s “validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark *as*

⁷ A fuller list is set forth in the Appendix.

a whole.” *Cal. Cooler, Inc.*, 774 F.2d at 1455 (emphasis added); see also *Union Carbide Corp.*, 531 F.2d at 379 (“Dissecting marks often leads to error.”). The question in this case is not whether a top-level domain renders *every* generic term distinctive, but rather whether it is *possible*, upon presentation of sufficient evidence, to obtain a trademark for such a mark. The government’s per se rule allows for no such fine distinctions.

Moreover, other obstacles will prevent trademark holders from monopolizing “dictionary” terms. See, e.g., AIPLA Amicus Br. 18. First, obtaining a *trademark* is much more challenging than simply obtaining the rights to a *domain name*, which can be purchased in a matter of seconds online. See Squarespace, *Claim Your Domain*, <https://bit.ly/2OtEUdn> (last visited Feb. 17, 2020). Obtaining a trademark, on the other hand, can be an expensive and time-consuming process, entailing registration fees, administrative and legal fees, fees associated with designing the mark, and fees associated with advertising and developing the mark. See Michael J. Freno, *Trademark Valuation: Preserving Brand Equity*, 97 Trademark Rep. 1055, 1058–60 (2007). And even if a domain name is descriptive of a registrant’s goods or services (e.g., CARS.COM), the registrant must still establish that the mark is not *merely* descriptive, and that it has developed a “secondary meaning” to the consuming public. *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1018 (9th Cir. 1979); see also 15 U.S.C. § 1052(e)(1), (f).

Second, there are a variety of legal obstacles and defenses—for example, the requirement of establishing a likelihood of confusion, see *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S.

111, 117 (2004) (citing 15 U.S.C. § 1114(1)(a)), or the defense of fair use, *see* 15 U.S.C. § 1115(b)(4)—that may apply depending on the facts of an individual case. Rejection of the government’s per se rule will not spur a “run-on-the-Internet” to register domain names that have not acquired distinctiveness.

Trademark laws protect consumers from deceptive or misleading uses of recognized brand names. They also ensure that businesses are permitted to reap the rewards of their hard-earned goodwill. Imposing an atextual categorical prohibition against an entire class of potentially distinctive marks serves neither of those goals.

CONCLUSION

For the foregoing reasons, the judgment of the court of appeals should be affirmed.

Respectfully submitted.

LEE D. SOFFER
GENERAL COUNSEL
BA SPORTS NUTRITION, LLC
17-20 Whitestone Expressway
Whitestone, NY 11357
(718) 989-0155
LSoffer@drinkbodyarmor.com

*Counsel for Amicus Curiae BA
Sports Nutrition, LLC*

THOMAS G. HUNGAR
Counsel of Record
HOWARD S. HOGAN
JOSHUA M. WESNESKI
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 887-3784
thungar@gibsondunn.com

*Counsel for Amici Curiae
Salesforce.com, Inc. and The
Home Depot, Inc.*

February 19, 2020

APPENDIX

APPENDIX – EXEMPLAR LIST OF BRANDS AND
VALUES

Brand	Value (in Billions)*
International Business Machines	\$82.3
Coca-Cola	\$80.3
The Home Depot	\$53.8
United Parcel Service	\$49.9
Salesforce	\$28.6
Netflix	\$27.6
General Electric	\$22.0
Bank of America	\$15.1
US Bank	\$14.1
American Airlines	\$9.3
Pizza Hut	\$8.1
Southwest Airlines	\$6.5

* *US Top Brands 2020 | Top 100 Countdown*, BrandZ, <https://www.brandz.com/US> (last visited Feb. 11, 2020). Brand values are truncated to the first decimal place.