Book It: Supreme Court Holds Booking.com Is Registrable as a Trademark

Intellectual Property Alert

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How appropriate that the first-ever Supreme Court case to consider whether trademarks used on the internet can be registered should also be the first in which oral argument was conducted remotely. The issue in this historic case is whether Booking.com, the travel reservations website, is entitled to a federal trademark registration for "Booking.com."

A generic term stands for a class of goods or services, rather than the source of those goods or services, and is never entitled to trademark protection. Thus, when Booking.com sought to register its domain name as a trademark, the United States Patent and Trademark Office (USPTO) denied registration, holding that "booking" is just a generic term for making travel reservations and that merely adding a top-level domain name like ".com" does not elevate the term to one that is protectable.

Booking.com appealed the decision to a federal district court and offered evidence, including consumer surveys, showing that consumers perceive "Booking.com" to be a brand name rather than a generic term for making reservations over the internet. Based on this evidence, the district court reversed the USPTO and held that the term could be registered. The USPTO appealed this decision, but the appeals court affirmed, also holding that Booking.com is not generic. The USPTO then appealed to the Supreme Court.

The USPTO argued for a bright-line rule that would hold any combination of a generic term and a generic top-level domain name like ".com" unregistrable as a trademark. The USPTO further argued that Booking.com is generic because the term "booking" alone is generic for the services Booking.com offers and the addition of ".com" does not transform Booking.com into a non-generic term. The Court disagreed with the USPTO's argument and agreed with Booking.com, ultimately ruling 8-1 that Booking.com is not generic and is protectable as a trademark.

In reaching its conclusion, the Court rejected the USPTO's *per se* rule and instead focused its inquiry on whether consumers perceive Booking.com to be generic. The Court also held that the term "Booking.com" cannot be broken down to its constituent parts—namely, "booking" and ".com"—but rather must be viewed as a whole. The Court held that because "Booking.com" viewed as a whole is not generic to consumers, it is not a generic term.

This decision carries with it many implications for other companies, particularly those that operate on the internet, that

may wish to register trademarks similarly composed of a purported generic term and a top-level domain name.

McCarter & English has a team of lawyers with expertise in trademark law ready to assist with any trademark-related needs.