

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 COALITION OF
.COM BRAND OWNERS AS AMICI CURIAE
IN SUPPORT OF RESPONDENT**

—◆—
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STATEMENT OF INTEREST OF AMICI CURIAE¹

Amici Curiae is composed of a coalition of businesses that are similarly-situated to Respondent in that they own brands that consist of an arguably generic term combined with the “.com” top-level domain.

Amici Curiae consist of the following parties:

Backgroundchecks.com, LLC is a leading provider of background checks. Backgroundchecks.com, LLC and its predecessors have used the BACKGROUNDCHECKS.COM brand since 1999. The BACKGROUNDCHECKS.COM database includes 650 million criminal and related records from all 50 states, along with more than 22 million photographs.

Cars.com, LLC operates a leading digital automotive marketplace that connects vehicle shoppers with sellers and original equipment manufacturers, empowering shoppers with the resources and information to make informed buying decisions. Cars.com has used its CARS.COM brand since 1998 and has since expanded to include the CARS.COM mobile application, which is the most downloaded mobile application in its category. The CARS.COM platform includes a database of

¹ Pursuant to Rule 37.6, amici curiae certify that no counsel for a party authored this brief in whole or in part and that no person or entity, other than amici, its members or its counsel, has made a monetary contribution to the preparation or submission of this brief. SUP. CT. R. 37.6. Further, pursuant to Rule 37.2(a), amici curiae certify that all parties have provided written consent to the filing of this brief.

approximately 4.4 million vehicle listings from U.S.-based dealerships and vehicle sellers.

Debt.com LLC offers expert advice about getting out—and staying out—of debt—under its DEBT.COM brand, which it and its predecessors have used since 2004. Each year, the DEBT.COM brand and advertisements are displayed over 500 million times and viewed by over 80 million people. The DEBT.COM website has received over ten million page views; helping tens of thousands of consumers resolve more than one billion dollars in debt.

Since 1995, Dictionary.com, LLC and its predecessors have operated a leading online dictionary and thesaurus under its DICTIONARY.COM and THESAURUS.COM brands, respectively. DICTIONARY.COM receives 5.5 billion annual word searches and has 70 million monthly users, and over 1.6 million social media followers. THESAURUS.COM had more than 2.5 billion views over the last year.

Homes.com, Inc. operates a leading home real estate database under its HOMES.COM brand. The HOMES.COM website currently features nearly 2.4 million listings for homes for sale, along with over 313,000 listings for homes for rent. Homes.com, Inc.'s affiliate, Franchise Ventures, LLC, operates a franchise recruitment website under its FRANCHISE.COM brand. The FRANCHISE.COM website has helped more than one million people find and open franchise businesses. Homes.com, Inc. and its predecessors have used the HOMES.COM and FRANCHISE.COM brands since 1995.

HSP EPI Acquisition, LLC d/b/a Entertainment is the largest supplier of promotional and discount products, provided through mobile, online and printed discounts which are utilized for loyalty programs and fundraising purposes throughout the U.S. and Canada since 1962. The ENTERTAINMENT.COM®, DININGADVANTAGE.COM®, and SAVERSGUIDE.COM® brands, among other “.com” brands registered to Entertainment, have been used since 2011. They provide consumers over 500,000 offers that save consumers money and provide advertising for over 50,000 businesses. The Entertainment websites have 21 million members.

Jerky.com, LLC operates the leading website for premium meat snacks, gourmet snacks, and jerky gifts under its JERKY.COM brand. Jerky.com has used the JERKY.COM brand since 1998. Jerky.com offers 100 different kinds of dried meats and other foods under its JERKY.COM brand.

Newspapers.com is the largest online newspaper archive consisting of 567 million+ pages of historical newspapers from over 16,000 newspapers from the 1700s–2000s. The NEWSPAPERS.COM website is owned and operated by Ancestry.com Operations Inc. The NEWSPAPERS.COM brand has been used since 2012. The NEWSPAPERS.COM website has over 650,000 active subscribers.

Omega World Travel, Inc. operates an online travel website featuring one of the internet’s largest cruise specialists under its CRUISE.COM brand. It

has used the CRUISE.COM brand since 1996. The CRUISE.COM website currently offers thousands of different cruise options per month from over 40 different cruise lines. Omega World Travel also has a CRUISE.COM brick-and-mortar travel agency located in Dania Beach, Florida.

Politics.com, LLC operates an online social news platform under its POLITICS.COM brand. The POLITICS.COM website enables users to find, share, and discuss a variety of different topics.

RentPath, LLC provides digital marketing solutions as an internet listing service to owners of rental homes, condos, townhomes, and duplexes under its RENTALS.COM brand. RentPath provides similar services to owners of multi-family rental apartments under its RENT.COM brand. RentPath and its predecessors have used the RENTALS.COM and RENT.COM brands since 2001. Every month, millions of unique visitors come to RENTALS.COM and RENT.COM to find homes, apartments, and condos for rent.

Tutor.com, Inc. operates an online tutoring service under its TUTOR.COM brand. Tutor.com, Inc. has used its TUTOR.COM brand since 1998. Tutor.com has delivered more than 18 million one-to-one online tutoring sessions.

Wine.com, LLC offers the largest selection of wines in the world through its WINE.COM website and mobile application. Wine.com has used the WINE.COM brand since 1999. Wine.com sells over two million bottles per year throughout the United States

and has made approximately \$1 billion in sales, both online and by mail order, under its WINE.COM brand.

Workout.com, LLC operates an online resource offering advice about physical fitness, diet, and supplements under its WORKOUT.COM brand. Workout.com, LLC and its predecessor in interest have used the WORKOUT.COM brand since 1999.

Since 2009, Offers.com, a subsidiary of Ziff Davis LLC, has used the OFFERS.COM brand to operate a leading website of coupon codes, product deals and discounts for more than 20,000 stores and brands. Consumers can find more than 217,000 coupon codes, deals and discounts on the OFFERS.COM website in nearly every product category.

The Amici Curiae are collectively referred to herein as the “Coalition.”

In light of the nature of the Coalition’s brands consisting of an arguably generic term coupled with a “.com” top-level domain, the Coalition has a unique perspective to share with respect to the types of trademark infringements that they encounter in the marketplace and the importance of federal trademark registration to stop such infringements.



SUMMARY OF ARGUMENT

The USPTO advocates for a per se rule that a generic term coupled with a top-level domain can never be registered. There are many U.S. businesses,

including Respondent and the Coalition, that own brands consisting of an arguably generic term coupled with a top-level domain. Under the USPTO's proposed rule, none of these businesses could obtain a trademark registration for their brands. Foreclosing any possibility of registration would make it more difficult for these businesses to stop consumer confusion in the marketplace, notwithstanding the fact that these businesses encounter the same types of infringements and counterfeiting that other brand owners encounter.

The USPTO argues that Respondent and other similarly-situated businesses do not need a trademark registration to stop consumer confusion due to the availability of unfair competition and passing off claims that do not require registration. But, as this Court has recognized, the fact that other potential claims that do not require federal trademark registration are available does not diminish the importance of federal trademark registration as a tool to combat consumer confusion in the marketplace.

Fears that Respondent and similarly-situated businesses would use registrations of their marks to bring frivolous infringement claims are unwarranted. Neither the case law nor the record support the USPTO's conclusion that Respondent, the Coalition, or other similarly-situated businesses would use registrations of their marks to assert weak or baseless claims. In fact, there are numerous disincentives for asserting such claims, including the possibility of an award of attorneys' fees to a defendant in a trademark infringement case. Moreover, this Court should rule

only on the issue presented in this case—i.e., whether BOOKING.COM is per se un-registrable—not on whether Respondent would have a plausible infringement claim against hypothetical third-party infringements.

A per se rule is unnecessary because the USPTO routinely evaluates whether a compound mark consisting of two generic terms is eligible for registration under the primary significance test on a case-by-case basis. Here, too, the USPTO is capable of evaluating whether a generic term combined with a top-level domain is eligible for registration without the need for a per se rule. Moreover, the per se rule violates this Court’s longstanding precedent that a mark cannot be dissected, but instead must be considered as a whole. Lastly, despite the USPTO’s arguments to the contrary, this Court’s decision in *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.* does not support the application of a per se rule to Generic.com marks.

The USPTO’s per se rule barring registration of all Generic.com marks prevents Respondent, the Coalition, and similarly-situated businesses from ever obtaining a trademark registration, even if their mark is source-identifying. This not only harms Respondent, the Coalition, and similarly-situated businesses, but it also harms U.S. consumers. For these reasons, the Coalition respectfully urges this Court to affirm the Fourth Circuit’s ruling.



ARGUMENT

I. **The USPTO Advocates for a Per Se Rule Prohibiting the Registration of Generic.com Marks.**

The USPTO argues that “the addition of ‘.com’ to a generic term does not create a protectable mark.” Brief for the Petitioner (“Pet.”) at 18. In support of this position, the USPTO cites to the *Trademark Manual of Examining Procedure* (TMEP), which states, “Generally, a mark comprised of generic term(s) combined with a non-source identifying [top-level domain] is generic and without trademark or service mark significance.” Pet. at 23 (quoting TMEP § 1215.05 (Oct. 2018)).

Despite the TMEP’s acknowledgement that there is no per se rule, the USPTO now advocates for a de facto per se rule that would prohibit federal registration of any Generic.com mark. *See* Pet. at 18 (“the addition of a top-level domain to a generic term does not create a registrable trademark”); Pet. at 21 (“the adoption of a ‘generic.com’ domain name, without other specification, cannot create any exclusive right to the use of the name as a trademark”) (internal quotations omitted); Pet. at 26 (“Permitting federal registration of ‘generic.com’ terms would undermine [Congress’s goal to foster fair competition]”); *see also* Brief for the American Intellectual Property Law Association as Amicus Curiae in Support of Neither Party (“Brief for the AIPLA”) at 13 (“Although the TMEP advocates against a per se bar to granting trademark protection for generic terms combined with gTLDs, the PTO’s position here—namely, that the addition by an online business

of a gTLD to an otherwise generic term can never create a protectable trademark—appears at odds with the TMEP’s language.”).

The USPTO’s proposed rule prohibiting registration of any Generic.com mark is not consistent with the goals of the Lanham Act, this Court’s precedent or the language of the TMEP.

II. The USPTO’s Per Se Rule Conflicts with the Purpose and Goals of the Lanham Act, Namely the Avoidance of Consumer Confusion.

Congress enacted the Lanham Act in 1946 to protect consumers from deception and avoid confusion in the marketplace. *See* 15 U.S.C. § 1127 (“The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce.”). In passing the Lanham Act, Congress expanded the concept of trademark infringement, introduced a statutory prohibition against unfair competition, and established additional rights conferred by federal trademark registration, including the concepts of constructive notice and incontestability. 1 *McCarthy on Trademarks and Unfair Competition* § 5:4 (5th ed.).

In 1988, Congress amended the Lanham Act by enacting the Trademark Law Revision Act. 1 *McCarthy on Trademarks and Unfair Competition* § 5:9 (5th ed.). As this Court explained, “[t]he legislative history of the 1988 amendments to the Lanham Act reaffirms

Congress' goals of protecting both businesses and consumers with the Lanham Act." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 784 (1992) (Stevens, J., concurring), citing S. Rep. 100-515, 4, 1988 U.S.C.C.A.N. 5577, 5580 ("Trademark protection is important to both consumers and producers. Trademark law protects the public by making consumers confident that they can identify brands they prefer and can purchase those brands without being confused or misled. Trademark laws also protects trademark owners. When the owner of a trademark has spent considerable time and money bringing a product to the marketplace, trademark law protects the producer from pirates and counterfeiters.").

The USPTO's proposed per se rule prohibiting registration of BOOKING.COM and similar marks is in direct conflict with the purpose of the Lanham Act and Congress' goals of protecting both consumers and businesses.

A. The USPTO's Per Se Rule Would Harm Many U.S. Businesses.

Booking.com is far from the only U.S. business impacted by the USPTO's position that use of ".com" together with an otherwise generic term can never create a protectable trademark. Many other similarly-situated U.S. businesses, including the Coalition, have invested substantially in brands that consist of an arguably generic term combined with a top-level domain, and many consumers have come to recognize some of

those brands as indicators of source. Collectively, the members of the Coalition have invested over \$1 billion in advertising and promoting their Generic.com brands.

For example, Amicus Cars.com has been a leading digital automotive marketplace connecting buyers and sellers of automobiles since 1998. Like Booking.com, Cars.com invests substantially in promoting its CARS.COM brand. From 2010–2019, Cars.com spent in excess of \$865 million to advertise and promote its CARS.COM brand. Cars.com’s advertising efforts include, but are not limited to, television commercials, print advertising, online advertising, and social media campaigns. In the last five years alone, Cars.com invested over \$110 million in television advertising. From 2008–2013, Cars.com’s television advertising included numerous Super Bowl commercials, each of which prominently featured the CARS.COM brand. *See, e.g.,* Cars.com 2013 Super Bowl TV Commercial, “Wolf Drama,” iSpot.tv (last visited on Jan. 21, 2020), <https://www.ispot.tv/ad/7dSJ/cars-com-2013-super-bowl-wolf-drama>.

Due to Cars.com’s extensive advertising and promotion, consumers have been widely exposed to the CARS.COM brand. As a result, the Cars.com website averages over 23.1 million unique visitors per month. *See Cars.com Reports Third Quarter 2019 Results*, Cars.com (Nov. 6, 2019), <https://www.cars.com/articles/cars-com-reports-third-quarter-2019-results-412317/>. Cars.com’s social media accounts have thousands of followers, including over 527,000 Facebook followers, 191,000 YouTube followers, nearly 125,000 Twitter followers, and nearly 14,000 Instagram followers. Such

widespread exposure to the CARS.COM brand and use of the Cars.com website has contributed to Cars.com's success. In 2018 alone, Cars.com's revenues were over \$662 million. *See Cars.com Reports Fourth Quarter and Full Year 2018 Results*, Investor.Cars.com (Feb. 28, 2019), <https://investor.cars.com/news/press-release-details/2019/Carscom-Reports-Fourth-Quarter-and-Full-Year-2018-Results/default.aspx>. Moreover, Cars.com employs 1,546 people in the United States and has received five JD Powers Awards.

As a result of such extensive advertising, promotion, and brand exposure, some Generic.com marks have become well-known to consumers as indicators of source distinct from other domain names that have not been extensively used or promoted. The Coalition, Respondent, and similarly-situated businesses should not be automatically foreclosed from trademark registration, especially where these brands have garnered significant consumer recognition in the marketplace.

B. The USPTO's Per Se Rule Would Harm Consumers by Making It More Difficult for Brand Owners to Stop Consumer Confusion.

Brand owners such as Booking.com and the members of the Coalition routinely face infringing and counterfeit uses of substantially identical marks that result in consumer confusion. The USPTO's per se rule prohibiting registration of BOOKING.COM and similar marks would make it more difficult for these

companies to combat such infringing and counterfeit uses, leading to increased consumer confusion.

The AIPLA recognized this consequence of the USPTO's per se rule, stating "if 'genericname.com' had acquired source-identifying distinctiveness and trademark protection were *not* afforded to such a term, a competitor could theoretically open a storefront called 'genericname.com' and confuse consumers that it is associated with the business operating under that URL." Brief for the AIPLA at 15.

This is precisely what happens in the marketplace. Cars.com, for example, discovered that an unaffiliated car dealership adopted the identical CARS.COM mark as the name of its storefront and featured the CARS.COM mark prominently on its signage, as shown below.



Contrary to the view expressed by some legal academics, these types of infringements are not the exclusive provenance of trademark owners whose brands do not include “.com” and such infringements are not mitigated merely by the “exclusivity of the domain name system.” Brief of Trademark Scholars as Amici Curiae in Support of Neither Party (“Tushnet Brief”) at 14. The adoption of the USPTO’s per se rule barring registration of all Generic.com marks would open the floodgates for copycats to trade on the goodwill developed by these brand owners and to falsely claim that they are affiliated with, or sponsored by, these brand owners.

Indeed, members of the Coalition routinely face the same types of cybersquatting, phishing attempts, and counterfeit uses of their marks as other brand owners. For example, cybersquatters registered the Offers.com.vn and Offers.com.br domain names, trading on consumer recognition of the OFFERS.COM brand. The quickest and least expensive way to stop cybersquatting is to file a complaint under the Uniform Domain-Name Dispute-Resolution Policy (“UDRP”). 5 McCarthy on Trademarks and Unfair Competition § 25A:21 (5th ed.). Since the implementation of the UDRP in 2000, the WIPO Arbitration and Mediation Center has processed approximately 45,000 UDRP cases and the ADR Forum has processed nearly 28,000 UDRP cases. Domain Name Dispute Resolution, World Intellectual Property Organization (last visited on Feb. 10, 2020), <https://www.wipo.int/amc/en/domains/>; Domain Name Dispute Proceedings and Decisions, ADR

Forum (last visited on Feb. 10, 2020), <https://www.adrforum.com/domain-dispute/search-decisions>.

The UDRP, however, requires complainants to establish trademark rights to bring a successful claim. UDRP ¶4(a)(i) (Aug. 26, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> (complainant must establish that the domain name is “identical or confusingly similar to a trademark or service mark in which the complainant has rights”); *see also* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, World Intellectual Property Organization (last visited on Feb. 8, 2020), <https://www.wipo.int/amc/en/domains/search/overview3.0/#item13>. If this Court holds that BOOKING.COM and similarly-situated marks are generic, Respondent, the Coalition and all similarly-situated brand owners would be precluded from using the UDRP process to stop blatant cybersquatting of their marks because they could not establish that they have trademark rights as required by Paragraph 4(a)(i) of the UDRP. *Compare Decision Analyst, Inc. v. Doug C. Dohring*, WIPO Case No. D2000-1630 (WIPO Feb. 6, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1630.html> (denying transfer of *Opinionsurvey.com* and finding “opinion survey” was generic for the services offered by both parties, in part because the respondent had applied to register the trademark OPINIONSURVEY.COM and the USPTO rejected the application on the ground that it was generic) and *Electronic Commerce Media, Inc. v. Taos Mountain*, NAF Claim Number FA0008000095344 (ADR Forum Oct. 11, 2000), <https://>

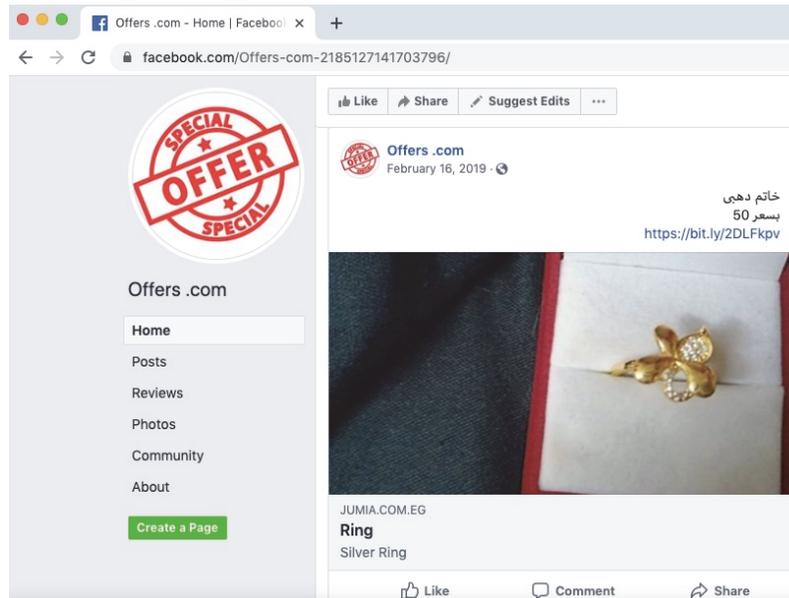
www.adrforum.com/Domaindecisions/95344.htm (rejecting respondent's claim that EC.COM is generic for "electronic commerce" because complainant's federal trademark registration for EC.COM constitutes "*prima facie* evidence of the mark's validity" and ordering transfer of domain name to complainant).

Members of the Coalition also routinely face fraudulent uses of their marks. For example, criminal actors have fraudulently induced consumers to make wire payments to them by using the CARS.COM mark as part of a "spoofed" email address or website claiming to act as an escrow agency or vehicle delivery service for a vehicle listing posted by a third party on the Cars.com site. These criminal actors are able to prey on such consumers for the simple reason that consumers understand that the CARS.COM mark is a strong brand and is associated with a single source.

The most expeditious way for brand owners to stop such fraudulent activity is for them to contact the domain name registrars and/or web hosting companies associated with such "spoofed" email accounts or fraudulent content and to request that they immediately shut down the fraudulent account or content. Some domain name registrars and web hosting services, however, require brand owners to provide evidence of a trademark registration before they will voluntarily shut down a domain name that is being used to "spooft" a trademark that is incorporated into an email address or featured on a website for such purposes. *See, e.g., Trademark/Copyright Infringement, GoDaddy* (last visited on Feb. 7, 2020), <https://www.godaddy.com/legal/>

agreements/trademark-copyright-infringement (requiring trademark registration to submit a trademark complaint); Copyright and Trademark Policies, Namecheap (last visited on Feb. 7, 2020), <https://www.namecheap.com/legal/general/copyright-trademark-policies/> (same); Trademark Infringement Form, Wix (last visited on Feb. 7, 2020), <https://www.wix.com/about/trademarkform> (same); Trademark/Copyright, Hostinger (last visited on Feb. 7, 2020), <https://www.hostinger.com/trademark-copyright-infringement> (same).

Coalition members have likewise discovered individuals or entities that impersonate them in online marketplaces and on social media platforms by using identical or closely similar marks. For example, Coalition member Ziff Davis, LLC recently discovered a Facebook account that used its identical OFFERS.COM mark to promote the sale of various products:



But many social media platforms, such as LinkedIn, SnapChat, and TikTok, along with online marketplaces, such as Alibaba, require a trademark owner to produce evidence of ownership of a trademark registration as a prerequisite to removing infringing listings or posts. *See* LinkedIn Contact Us (last visited on Jan. 23, 2020), <https://www.linkedin.com/help/linkedin/ask/TS-NTMI> (requiring trademark registration to submit trademark complaint); Snapchat Support, Contact Us (last visited Jan. 23, 2020), <https://support.snapchat.com/en-US/i-need-help?start=5693695504416768> (same); TikTok Report Trademark Infringement (last visited Jan. 23, 2020), <https://www.tiktok.com/legal/report/Trademark?lang=en> (same); IPP Platform Instructions, Alibaba Group (last visited on Jan. 23, 2020), <https://ipp.alibabagroup.com/instruction/en.htm#material2>

(documents needed to set up an IPP account and submit a complaint include “proof of intellectual property rights, such as a copy of official trademark/copyright/patent certificate”). Online marketplace Amazon recently established the Amazon Brand Registry to provide brand owners with tools to find and take down infringing content on Amazon, but only owners of registered trademarks can use it. *See* Amazon Brand Registry Eligibility Requirements (last visited on Jan. 23, 2020), <https://brandservices.amazon.com/eligibility> (“Brands must have a registered and active text or image-based trademark”).

The inability to obtain a U.S. trademark registration almost invariably delays, and may entirely foreclose, a brand owner’s ability to shut down such infringing and fraudulent activity. As a result, the USPTO’s per se rule would increase the likelihood that consumers will be confused and deceived by such activity, thereby obstructing the goals of the Lanham Act.

III. The Potential Availability of Claims that Do Not Require Ownership of a Federal Trademark Registration Is Not an Adequate Substitute to Rights Conferred by Registration.

The USPTO argues it is “unclear what practical advantage respondent would derive from federal registration” because respondent has “ample protection against unfair competition even without federal trademark registration of BOOKING.COM.” Pet. at 30, 34;

see also Pet. at 16 (“[t]rademark protection is not necessary to protect respondent’s investment in the name BOOKING.COM” because “[o]ther legal rules protect respondent from third party’s attempts to trade on its reputation or mislead consumers”).

The possibility that Respondent and the members of the Coalition could potentially assert *other* claims—such as unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), or common law passing off—ignores the central question at issue before this Court, namely whether the combination of an otherwise generic term with “.com” is per se barred from registration on the ground that it is generic. The question of whether or not alternative claims that do not require federal registration are available to address hypothetical infringements is irrelevant because this Court has already set forth the numerous practical advantages of federal registration.

In *Matal v. Tam*, this Court recognized that federal trademark registration confers “important legal rights and benefits on trademark owners who register their marks,” including the following:

Registration on the principal register (1) serves as constructive notice of the registrant’s claim of ownership of the mark; (2) 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 (3) can make a mark incontestable once a mark has been registered for five years.

137 S. Ct. 1744, 1753 (2017) (internal quotations and citations omitted). Likewise, in *Iancu v. Brunetti*, this Court reiterated that “registration gives trademark owners valuable benefits” and “. . . forecloses some defenses in infringement actions.” 139 S. Ct. 2294, 2297–98 (2019) (internal quotations and citations omitted); see also *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 172 (2015) (“Registration is a creature of the Lanham Act, which confers important legal rights and benefits on trademark owners who register their marks.”) (internal quotations omitted).

Thus, as this Court has repeatedly recognized, the Lanham Act confers numerous exclusive benefits and rights to the owners of a trademark registration. This Court has confirmed that these rights are important notwithstanding the existence of other claims that do not require federal registration, such as unfair competition claims under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), or common law passing off.

Congress, too, has recognized that registration rights are important. For example, Congress amended the Lanham Act several times to better protect registered marks from counterfeiting. See Public Law No. 98–473, October 12, 1984, 98 Stat. 1837 (granting courts power to grant ex parte seizure order and mandatory money remedies in counterfeiting cases); Public Law No. 110–403, October 13, 2008, 122 Stat. 4256 (increasing damages and penalties available in counterfeiting cases under 15 U.S.C. § 1117(c)). Unfortunately,

the scourge of counterfeiting has increased exponentially since 2008. According to a January 24, 2020 report by the U.S. Department of Homeland Security:

Counterfeiting is no longer confined to street-corners and flea markets. The problem has intensified to staggering levels, as shown by a recent Organisation for Economic Cooperation and Development (OECD) report, which details a 154 percent increase in counterfeits traded internationally—from \$200 billion in 2005 to \$509 billion in 2016.

Combating the Trafficking in Counterfeit and Pirated Goods, Report to the President of the United States, U.S. Department of Homeland Security, Office of Strategy, Policy & Plans (Jan. 24, 2020), https://www.dhs.gov/sites/default/files/publications/20_0124_plcy_counterfeit-pirated-goods-report_01.pdf at 4. A major contributor of this increase in counterfeiting activity is the rise of “third-party online marketplaces [that] can quickly and easily establish attractive ‘store-fronts’ to compete with legitimate businesses.” *Id.* at 11. As discussed above, some third-party platforms effectively require evidence of a registered trademark in order to expeditiously remove infringing or counterfeit listings. In its January 24, 2020 Report, DHS recommends that all e-commerce platforms establish a “Terms of Service” agreement that allow the platform to “terminate or suspend a seller account based on the use or reference to a username that is confusingly similar to a **registered** trademark” (emphasis added). *Id.* at 35. Ownership of

a registered trademark therefore is a critical tool for brand owners to effectively combat counterfeiting, particularly online.

The fact that some “.com” brand owners offer services through a website does not mean, as the Tushnet Brief suggests, that, “[a]s a result of the exclusivity of the domain name system even in the absence of trademark protection, there is limited if any opportunity for traditional counterfeiting.” Tushnet Brief at 14. Businesses that operate a website under a “.com” brand can and do sell products bearing that brand, and such products can be the subject of “traditional counterfeiting.”

For example, Coalition member Jerky.com sells a variety of beef jerky and other meat products bearing the JERKY.COM mark. These products are not only sold on the www.jerky.com website, but also in brick and mortar stores and third-party websites. The USPTO’s per se rule would forever bar Jerky.com from asserting claims for counterfeiting of its JERKY.COM mark because the definition of a counterfeit mark requires that the mark be registered. 15 U.S.C. § 1116(d)(1)(B)(i). The USPTO’s per se rule likewise would bar Jerky.com from seeking to recover treble or statutory damages for use of a counterfeit JERKY.COM mark. 15 U.S.C. § 1117(b) and (c). There is no reason to believe, however, that Jerky.com’s products are less likely to be counterfeited than other products. If anything, such products would be more likely to be counterfeited if Jerky.com is precluded from seeking treble or statutory

damages against counterfeiters because it is barred from ever registering its JERKY.COM mark.

This is merely one example of how the availability of claims that do not require ownership of a federal trademark registration are not an adequate substitute to rights conferred by registration. Yet, the USPTO's per se rule barring registration of all Generic.com marks prevents Booking.com, the Coalition, and similarly-situated businesses from ever employing any of the numerous benefits of trademark registration, even if their mark is source-identifying.

IV. The USPTO's Purported Fears of Overreach Are Unfounded and Unsupported by Case Law.

The USPTO, as well as Amicus Electronic Freedom Foundation ("EFF"), express concern that Booking.com and owners of similar Generic.com marks would necessarily seek to enforce their trademark rights in a manner that is frivolous, anti-competitive, or would otherwise prevent others from using truly generic terms. The USPTO argues that treating BOOKING.COM as a protectable trademark "would allow a single entity to monopolize the term 'booking' with respect to the relevant online services and would impede respondent's competitors from using it in their own domain names." Pet. at 16. These concerns are a red herring.

A. Booking.com and Similarly-Situated Brand Owners Already Are Deterred from Asserting Frivolous Trademark Infringement Claims.

Frivolous trademark infringement claims can be brought by overzealous trademark owners based upon relatively strong, or relatively weak, trademarks. In either case, trademark owners face a significant deterrent to over-extending their rights: the possibility of an award of defendant's attorneys' fees in an "exceptional case" under Section 35 of the Lanham Act. 15 U.S.C. § 1117(a). In enacting Section 35, "Congress specifically endeavored to afford protection to defendants 'against unfounded suits brought by trademark owners for harassment and the like.'" *Noxell Corp. v. Firehouse No. 1 Bar-B-Que Restaurant*, 771 F.2d 521, 524–25 (D.C. Cir. 1985) (J. Ginsburg) ("Congress intended to authorize fees for defendants subjected to 'harassment' by trademark owners.") (citing S. Rep. 1400, 93d Cong., 2d Sess. 5, 6 (1974)). District courts can and will use their discretion to award attorneys' fees to successful defendants where plaintiffs assert frivolous or bad faith trademark infringement claims.

In fact, the USPTO itself has recognized that the possibility of an award of attorneys' fees to a defendant deters plaintiffs from bringing overreaching trademark infringement claims. *See* Report to Congress, Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting (April 2011), <https://www.uspto.gov/sites/default/files/trademarks/notices/TrademarkLitigationStudy.pdf>. In

its April 2011 report to Congress, the USPTO concluded that “the potential for an award of attorneys’ fees is an existing deterrent to misuse of the litigation process in trademark disputes.” *Id.* at 13. The USPTO also quoted a Seventh Circuit decision explaining that one instance of an exceptional case under Section 35 of the Lanham Act is “if the losing party was the plaintiff and was guilty of abuse of process in suing.” *Id.* (quoting *Nightingale Home Healthcare, Inc. v. Anodyne Therapy, LLC*, 626 F.3d 958, 963-64 (7th Cir. 2010)). The risk of having to pay defendant’s attorneys’ fees is a protective measure against any hypothetical overreach by Booking.com and similarly-situated brand owners.

Since the USPTO’s report in 2011, this Court clarified in *Octane Fitness, LLC v. Icon Health & Fitness* that a case can be considered exceptional under Section 285 of the Patent Act without a showing of bad faith. 572 U.S. 545 (2014). Instead, an “exceptional case” means simply “one that stands out from others with respect to the substantive strength of a party’s litigation position (considering both the governing law and the facts of the case) or the unreasonable matter in which the case was litigated.” *Id.* at 554; *see also Highmark Inc. v. Allcare Health Management System, Inc.*, 572 U.S. 559 (2014) (holding that “all aspects of a district court’s exceptional-case determination under §285 should be reviewed for abuse of discretion”). This standard substantially relaxes the requirements for finding a case exceptional, and has been interpreted by the circuit courts to apply to trademark infringement

cases. See *LHO Chicago River, LLC v. Perillo*, 942 F.3d 384 (7th Cir. 2019); *Evoqua Water Techs., LLC v. M.W. Watermark, LLC*, 940 F.3d 222, 235 (6th Cir. 2019); *Sleepy’s LLC v. Select Comfort Wholesale Corp.*, 909 F.3d 519, 530–31 (2d Cir. 2018); *Scholz v. Goudreau*, 901 F.3d 37, 49–50 (1st Cir. 2018); *Tobinick v. Novella*, 884 F.3d 1110, 1117–18 (11th Cir. 2018); *Romag Fasteners, Inc. v. Fossil, Inc.*, 866 F.3d 1330, 1334–36 (Fed. Cir. 2017); *SunEarth, Inc. v. Sun Earth Solar Power Co.*, 839 F.3d 1179, 1180–81 (9th Cir. 2016) (en banc); *Baker v. DeShong*, 821 F.3d 620, 624–25 (5th Cir. 2016); *Georgia-Pacific Consumer Prods. LP v. von Drehle Corp.*, 781 F.3d 710, 721 (4th Cir. 2015); *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 314–15 (3d Cir. 2014).

All trademark owners, particularly owners of marks such as BOOKING.COM, therefore must carefully consider their likelihood of success for any trademark infringement claim before bringing it or risk paying defendant’s attorneys’ fees. See, e.g., *Donut Joe’s, Inc. v. Interveston Food Services, LLC*, 116 F.Supp.3d 1290, 1294 (N.D. Ala. 2015) (after granting defendant’s motion for summary judgment on plaintiff’s trademark infringement claims, the court also granted defendant’s attorneys’ fees based in part on the weakness of plaintiff’s marks “due to their nature as descriptive marks lacking secondary meaning” and “widespread third-party use of the elements of Donut Joe’s marks”); see also *Fla. Int’l Univ. Bd. of Trustees v. Fla. Nat’l Univ., Inc.*, No. 13-21604-CIV, 2017 WL 3610583, at *6 (S.D. Fla. Aug. 11, 2017), *report and recommendation*

adopted, No. 13-CV-21604, 2018 WL 4409885 (S.D. Fla. June 25, 2018) (after granting defendant’s motion for summary judgment on plaintiff’s trademark infringement claims, court also granted defendant’s attorneys’ fees based in part on the weakness of plaintiff’s litigation position); *Mattel, Inc. v. Walking Mountain Productions*, No. CV99-8543RSWL(RZW), 2004 WL 1454100 (C.D. Cal. 2004) (pre-*Octane* decision awarding over \$1.5 million in attorneys’ fees to artist who prevailed in an “objectively unreasonable and frivolous” trademark and copyright infringement case brought by Mattel based on defendant’s photographs of BARBIE dolls).

Trademark owners must carefully consider the merits of their trademark infringement claims not only at the time of suit, but also when making pre-litigation threats. Indeed, the mere transmission of a cease and desist letter can result in a declaratory judgment suit in which a Court may award attorneys’ fees to the declaratory judgment plaintiff. *See, e.g., Renna v. County of Union New Jersey*, 114 U.S.P.Q.2d 1658, 2015 WL 1815498 (D. N.J. 2015) (awarding attorneys’ fees under Section 1117(a) to plaintiff who sought a declaratory judgment that her use of defendant’s purported trademark did not constitute an infringement on the ground that defendant asserted trademark rights that it knew, or should have known, did not exist and defendant’s pre-litigation cease and desist letters were baseless); *see also Industrial Models, Inc. v. SNF, Inc.*, 716 F. App’x 949, 959–60 (Fed. Cir. 2017) (affirming award of attorneys’ fees to plaintiff on summary judgment for

declaratory judgment of non-infringement of trade dress under the Lanham Act under *Octane Fitness* standard).

B. Courts Routinely Adjudicate Likelihood of Confusion Between Marks and the Fair Use of Terms Other than as Marks.

In addition to awarding attorneys' fees for frivolous claims, courts also routinely determine whether a trademark owner has overreached as part of the adjudication of likelihood of confusion central to all trademark infringement claims. One of the important likelihood of confusion factors utilized by the courts is the strength of the plaintiff's mark. *See Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416 (6th Cir. 2017) (no likelihood of confusion between registered ORDERLINK mark and use of UPS ORDERLINK in part because plaintiff's ORDERLINK mark was weak due to the fact that it described plaintiff's services); *Grayson O Co. v. Agadir Int'l LLC*, 856 F.3d 307 (4th Cir. 2017) (no likelihood of confusion between registered F 450 mark and use of HAIR SHIELD 450° PLUS in part because plaintiff's F 450 mark was weak); *Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 830 F.3d 1242, 1257 (11th Cir. 2016) (no likelihood of confusion between registered FLORIDA INTERNATIONAL UNIVERSITY mark and use of FLORIDA NATIONAL UNIVERSITY mark in part because plaintiff's mark was weak); *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504 (6th Cir. 2007) (no likelihood of confusion between registered

LEELANAU CELLARS mark and use of CHATEAU DE LEELANAU VINEYARD AND WINERY in part because plaintiff's mark was descriptive and weak). As these cases illustrate, courts are perfectly capable of determining the strength or weakness of a plaintiff's mark and applying the likelihood of confusion factors to determine whether trademark infringement has occurred.

Likewise, courts routinely determine whether a trademark owner has overreached when adjudicating descriptive fair use defenses, even at the motion to dismiss and summary judgment stages. *See, e.g., Sorensen v. WD-40 Co.*, 792 F.3d 712, 722–726 (7th Cir. 2015) (affirming summary judgment in favor of defendant on the ground that defendant's use of "Inhibitor" was descriptive fair use, despite plaintiff's incontestable federal registration of THE INHIBITOR); *Kassa v. Detroit Metro Convention & Visitors Bureau*, 150 F. Supp. 3d 831, 840 (E.D. Mich. 2015), *aff'd*, 672 F. App'x 575 (6th Cir. 2017) (granting defendant's motion to dismiss in part because defendant's use of the phrase "Welcome to the D" was descriptive fair use, despite plaintiff's federal trademark registration of that phrase). Moreover, a defendant claiming fair use "has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith." *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004). Because courts are capable of adjudicating fair use defenses quickly and efficiently where appropriate, and defendants asserting a fair use

defense are not required to negate likelihood of confusion, concerns that allowing registration of BOOKING.COM and similar marks will lead to “expensive, and thus competition-detering, litigation” are unwarranted. *See* Tushnet Brief at 14, n. 8 (“the multifactor test for assessing whether a descriptive use is fair all but ensures expensive, and thus competition-detering, litigation”).

As detailed by the cases cited above, courts are more than capable of analyzing the likelihood of confusion factors and fair use defenses. The USPTO’s purported fears regarding the anti-competitive impact of the registration of BOOKING.COM and similar marks are, thus, unwarranted.

V. Potential Enforcement of the BOOKING.COM Mark Is Not Before This Court.

Not only are fears of overreach unfounded, the potential enforcement of the BOOKING.COM mark is not even before this Court. The only issue before this Court is the registrability of BOOKING.COM, not the scope of protection that should be accorded to that mark or whether Respondent could or could not successfully enforce its mark against hypothetical third parties that use “BOOKING” “EBOOKING.COM” or “HOTELBOOKING.COM.” Whether or not Respondent’s ownership of a federal registration for BOOKING.COM could be used to enjoin such third-party uses depends entirely on hypothetical facts that were not at issue before the district court, including, most notably, facts

relevant to a judge or jury in determining whether a plaintiff has met its burden of proving likelihood of confusion. See *CRST Van Expedited, Inc. v. E.E.O.C.*, 136 S. Ct. 1642, 1653 (2016) (“It is not the Court’s usual practice to adjudicate either legal or predicate factual questions in the first instance.”) (citing *Adarand Constructors, Inc. v. Mineta*, 534 U.S. 103, 110 (2001) (per curiam)); see also *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1009 (2017) (same).

Thus, this Court should only decide the narrow question presented in the writ of certiorari: whether BOOKING.COM is capable of federal trademark registration. SUP. CT. R. 14(a) (“Only the questions set out in the petition [for a writ of certiorari], or fairly included therein, will be considered by the Court.”); *Lebron v. Nat’l R.R. Passenger Corp.*, 513 U.S. 374, 379 (1995) (“As this Court’s Rule 14.1(a) and simple prudence dictate, we will not reach questions not fairly included in the petition.”); *Yee v. City of Escondido, Cal.*, 503 U.S. 519, 535–37 (1992) (same).

VI. The USPTO Does Not Need a Per Se Rule to Evaluate Generic.com Marks.

The USPTO and EFF argue that a per se rule is necessary for the USPTO when evaluating the registrability of Generic.com marks. In fact, a per se rule is not mandated by either practical or precedential considerations.

A. The USPTO Regularly Evaluates the Registrability of Marks Consisting of Two Otherwise Generic Terms Without a Per Se Rule and Is Capable of Doing So Here.

EFF argues the USPTO will be unduly burdened if this Court does not establish a per se rule barring all registrations of Generic.com marks. *See* Brief of Amicus Curiae Electronic Frontier Foundation in Support of Petitioners (“Brief of EFF”) at 18 (“forcing the PTO to prove that the combination—i.e., booking.com—as a whole is generic” will be “not just an unduly burdensome task for the PTO; it is often an impossible one”).

Yet, the USPTO routinely evaluates the registrability of compound terms that consist of two or more arguably generic terms under the “primary significance” test. *See Alcatraz Media, Inc. v. Watermark Cruises*, 107 U.S.P.Q.2d 1750 (T.T.A.B. 2013) (applying primary significance test and finding ANNAPOLIS TOURS is not generic for conducting guided tours); *see also In re Virtual Indep. Paralegals, LLC*, Serial No. 86947786, 2019 WL 1453034 at *13 (T.T.A.B. Mar. 27, 2019) (applying primary significance test to evaluate whether VIRTUAL INDEPENDENT PARALEGALS is generic for paralegal services). In reviewing the public’s understanding of a mark, “the USPTO can consider evidence from ‘any competent source, such as consumer surveys, dictionaries, newspapers and other publications.’” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015) (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985)).

Likewise, the USPTO can evaluate Generic.com marks by considering the mark's primary significance to the relevant public, along with evidence of the public's understanding of that mark, such as consumer surveys like the one submitted by Respondent to the lower court. Indeed, the USPTO has already demonstrated an ample ability to make these determinations for a wide variety of marks that consist of domain names, granting registration for some (e.g., ART.COM, BEAUTY.COM, BUSES.COM, FRUITS.COM), but not others (e.g., HOTELS.COM, LAWYERS.COM, SPORTS-BETTING.COM).

B. The USPTO's Per Se Rule Is Predicated upon the Dissection of the BOOKING.COM Mark, Which Violates This Court's Precedent.

Not only is the USPTO's proposed per se rule antithetical to the "primary significance" test for determining whether a mark is generic under Section 1064(3) of the Lanham Act (as explained by Respondent at 19–34), but it also violates this Court's precedent that compound marks may not be dissected—a principle that the Tushnet Brief considers to be "black-letter trademark law." Tushnet Brief at 5.

This Court has long held that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc. v. Comm'r of*

Patents, 252 U.S. 538, 545–46 (1920). The Federal Circuit takes the same view:

[W]hen determining whether a mark with multiple components is registrable, the Board may not dissect the mark into isolated elements. The Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components. To perform its analysis, the Board must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.

Earnhardt v. Kerry Earnhardt, Inc., 864 F.3d 1374, 1378–79 (Fed. Cir. 2017) (internal quotations and citations omitted). For example, the Federal Circuit determined the TTAB improperly evaluated the registrability of the mark **Snap!** when it separated the word “SNAP” from the broken exclamation point, stating “[b]ecause a mark must be considered as a whole, the Board may not ‘dissect’ the mark into isolated elements.” *Duo-ProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345 (Fed. Cir. 2001) (citing *Beckwith*, 252 U.S. at 545-46)); see also *Princeton Vanguard*, 786 F.3d at 969 (“Where, as here, the record is replete with evidence of the public’s perception of the term PRETZEL CRISPS as a whole, it is unclear why the Board would resort to analyzing the terms individually or why it would believe doing so

would aid its analysis.”). Despite this Court’s precedent, the USPTO advocates for a per se rule that requires the very dissection of compound marks that this Court forbids.

C. *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co. Does Not Extend to Domain Names.*

The USPTO supports its per se rule based upon this Court’s decision in *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.* 128 U.S. 598 (1888) (holding the combination of a generic word and “Company” is not entitled to trademark protection). The Coalition agrees with Respondent that the test applied in *Goodyear’s* has been legislatively superseded by the “primary significance” test articulated in Section 1064(3) of the Lanham Act. 15 U.S.C. § 1064(3). However, even if this Court does not abrogate *Goodyear’s*, that decision is distinguishable because a domain name is very different from “Inc.” or “Company.”

In its 1888 *Goodyear’s* decision, this Court determined that “descriptive” terms combined with “Company” should not be entitled to trademark protection out of a then-plausible concern that many others would also use the same combination of words—indeed both plaintiff and defendant in that case used “Goodyear Rubber” with “Company.” *Goodyear’s*, 128 U.S. at 599. From 1888 to today, it has been possible for a multitude of companies to use the combination of a generic term and “Company.” By contrast, domain names are unique

identifiers and no other business can use the identical BOOKING.COM domain name. The Court’s concerns about the multitude of potential corporate name registrations in 1888 therefore should not animate its decision here. Permitting federal trademark registration of BOOKING.COM does not threaten “to preclude competitors from calling their products and services by their common names, thereby diminishing competition and harming consumers” because such competitors cannot use the identical domain name, Booking.com. Pet. at 18. Moreover, Respondent’s ownership of a protectable trademark in BOOKING.COM does not—without proof of a likelihood of confusion—preclude others from registering domain names that incorporate the mark, such as HOTELBOOKING.COM or EBOOKING.COM.

Because the registration of BOOKING.COM as a trademark does not preclude others from using “booking” or owning domain names that incorporate “booking,” the Supreme Court’s 1888 concerns about protecting the public commons—particularly the ability to use trade names that combine a generic term with “Inc.” or “Company”—are inapplicable to Generic.com marks today. *Goodyear’s* therefore does support the application of a per se rule here. See *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (finding STEELBUILDING.COM was not generic, *Goodyear’s* “did not create a per se rule” for Generic.com marks, and “a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration”).



CONCLUSION

The USPTO disregards the goals of the Lanham Act and this Court's precedent by arguing that a generic term coupled with a top-level domain can never be registered. As described above, this per se rule is unwarranted and thwarts the goals of the Lanham Act. Instead, the assessment of whether a mark consisting of a generic term coupled with ".com" should proceed under the primary significance test on a case-by-case basis. As such, the Coalition respectfully urges this Court to affirm the Fourth Circuit's ruling.

Respectfully submitted,

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