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IN THE
Supreme Court of the United States

UNITED STATES PATENT
AND TRADEMARK OFFICE, *et al.*,

Petitioners,

v.

BOOKING.COM B.V.,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FOURTH CIRCUIT

**BRIEF OF TRADEMARK SCHOLARS AS *AMICI*
CURIAE IN SUPPORT OF NEITHER PARTY**

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Cited Authorities

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15 U.S.C. § 1125(b)	23
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*Cited Authorities**Page***OTHER AUTHORITIES**

- LOUIS ALTMAN, 3 CALLMANN ON UNFAIR
COMPETITION, TRADEMARKS AND MONOPOLIES
(4th ed. 2019) § 21:386, 9
- Caitlin P. Canahai & Mark P. McKenna, *The
Case Against Product Configuration
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- Richard Craswell, “Compared to What?": *The
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- Shari S. Diamond, *Control Foundations:
Rationales and Approaches, in Trademark
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(SHARI S. DIAMOND & JERRE SWANN EDS., 2012) ...20
- Shari Seidman Diamond, *Reference Guide
on Survey Research, in Reference
Manual On Scientific Evidence*
(FEDERAL JUDICIAL CENTER 2D ED. 2000).....21
- William T. Gallagher, *Trademark and
Copyright Enforcement in the Shadow of
IP Law*, 28 SANTA CLARA COMPUTER & HIGH
TECH. L.J. 453, 487 (2012).....10

Cited Authorities

	<i>Page</i>
Leah Chan Grinvald, <i>Policing the Cease-and-Desist Letter</i> , 49 U.S.F. L. REV. 409 (2015)	10
<i>Homoglyph Attack Generator</i> , IRONGEEK.COM, https://www.irongeek.com/homoglyph-attack-generator.php?encoded=xn--bkin-37b01soza.xn--om-vfc&decode=%3C%3C+Decode	21
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William M. Landes and Richard A. Posner, <i>The Economics of Trademark Law</i> , 78 TRADEMARK REPORTER 267, 290–97 (1988)	12
Mark A. Lemley & Mark McKenna, <i>Irrelevant Confusion</i> , 62 STAN. L. REV. 413 (2010)	23
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Glynn S. Lunney, Jr., <i>Trademark’s Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly</i> , 106 CAL. L. REV. 1195, 1208–1213 (2018)	23
2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:39 (5th ed. 2019)	<i>passim</i>

Cited Authorities

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William McGeveran & Mark P. McKenna, <i>Confusion Isn't Everything</i> , 89 NOTRE DAME L. REV. 253 (2013)	14
Mark P. McKenna, <i>Property and Equity in Trademark Law</i> , 23 MARQ. INTELL. PROP. L. REV. (forthcoming 2020) (available at https://ssrn.com/abstract=3502613)	22
Mark P. McKenna, <i>The Normative Foundations of Trademark Law</i> , 82 NOTRE DAME L. REV. 1839 (2007)	23
Kenneth Port, <i>Trademark Extortion: The End of Trademark Law</i> , 65 WASH. & LEE L. REV. 585 (2008)	10
Rebecca Tushnet, <i>Registering Disagreement: Registration In Modern American Trademark Law</i> , 130 HARV. L. REV. 867, 872 (2017)	9
WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELLECTUAL PROPERTY ORGANIZATION, https://www.wipo.int/amc/en/domains/guide/	23

INTEREST OF THE *AMICI CURIAE*

This brief is filed on behalf of the undersigned law professors identified in Appendix A.¹ *Amici* are scholars whose research and teaching focus includes trademark law.² *Amici* have no direct interest in the outcome of this litigation.

SUMMARY OF THE ARGUMENT

Amici take no position on whether BOOKING.COM is generic, but write to encourage the Court to be cautious in resolving this case, which involves a generic term combined with a common top-level domain name identifier (.com). Trademark applications raise almost infinitely varied scenarios, including generic terms combined with other elements, and the top-level domain name identifier has some specific features that make it analogous to functional matter. Whatever rule the Court adopts should be highly attentive to the risks to competition of over-assertion of registered marks that are largely or entirely comprised of generic elements. Because courts deciding infringement cases are often unfamiliar with the context of a trademark registration, they may miss limitations on the scope of the registered mark that the Trademark Office believed existed and, as a result, enforce broader

1. Pursuant to Rule 37.6, *Amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *Amici* and their counsel made a monetary contribution to its preparation or submission. The parties have consented to the filing.

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

rights than the registrants should actually have. Ordinary businesses receiving cease and desist letters are even more unlikely to have the expertise to understand the limits on a registration. This practical reality should guide the Court's standards for registrations with generic components.

Relatedly, the Court should reaffirm the basic principle that “de facto secondary meaning” does not give rise to protectability as a trademark. Courts have long distinguished between “de facto secondary meaning” and secondary meaning “to which courts will attach legal consequences.” *Application of Deister Concentrator Co.*, 289 F.2d 496, 503 (C.C.P.A. 1961). De facto secondary meaning refers to an association between a generic term and a particular producer that is usually the result of an extended period of market dominance, whether achieved through advertising or through lack of competition. For example, in *Kellogg*, consumers may have associated the generic term “shredded wheat” with the National Biscuit Company merely because that company was long the only producer of shredded wheat, not because consumers believed any “shredded wheat” product came from the National Biscuit Company. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (holding that there was “no basis here for applying the doctrine of secondary meaning” where the evidence showed only that, due to a long period of exclusive production, “many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff’s factory”). Because of the need to protect potential and future competition, a generic term cannot be appropriated as a trademark even if it has de facto secondary meaning. *Id.*; see also *Deister*, 289 F.2d at 503

("[T]he courts will not support exclusive rights in any word or shape which, in their opinion, the public has the right to use in the absence of patent or copyright protection.").

The practical exclusivity afforded by domain name registration means that there may often be de facto secondary meaning in domain names, which can be difficult to distinguish from true trademark secondary meaning. This easily elided distinction affects how the Court should evaluate Booking.com's survey, which purports to show secondary meaning.

But the fact that de facto secondary meaning does not lead to trademark status does not mean it is irrelevant to the law. Even when a term is not protectable as a trademark, narrower unfair competition remedies may be available to prevent true passing off. As this Court explained in *Kellogg*, when a term is generic or a product shape is functional, neither can be protected as a trademark and others may not be enjoined from competing using the term or shape. *Kellogg*, 305 U.S. at 116–17. Those competitors, however, may be required to distinguish themselves in the market by adding identifiers or otherwise differentiating their use, if the competitors' use might deceive consumers. *Id.* at 122; *Blinded Veterans Ass'n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) (Ginsburg, J.). Thus, a rule that strongly protects competition by denying registration to generic terms does not leave consumers exposed to clever bad actors.

ARGUMENT

I. Registration Presents Many Variations; .com Is an Unusual and Limited Scenario

a. Many Claimed Trademarks Involve Unregistrable and Unprotectable Matter

The question presented in this case is a narrow one—whether the addition of the .com top-level domain to an otherwise generic term can transform the term into a potentially registrable trademark. Although the precise issue is narrow, it is an example of a broader pattern in which applicants for trademark registration add other matter to a descriptive or generic term and claim that the resulting symbol as a whole is not merely descriptive or generic. Word marks can be stylized, for example, and in those cases the stylization may—or may not—be enough to make an otherwise non-distinctive term protectable. In *Star Industries, Inc. v. Bacardi & Co. Ltd.*, the court found Star’s “O” design for orange-flavored vodka sufficiently stylized to be protectable because “[t]he ‘O’ was rendered as a vertical oval, with the outline of the ‘O’ slightly wider along the sides (about one quarter inch thick) and narrowing at the top and bottom (about one eighth inch thick); the outline of the ‘O’ [was] colored orange and decorated with two thin gold lines, one bordering the inside and one bordering the outside of the outline.” 412 F.3d 373, 383 (2d Cir. 2005). *See also In re Miller Brewing Co.*, 226, U.S.P.Q. 666 (T.T.A.B. 1985) (holding that the genericness of the word “lite” did not make the stylized mark **lite** unprotectable); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560 (Fed. Cir. 1987) (finding the logo **sweats dd** protectable on

account of design elements, despite use of the generic word “sweats”).³

By contrast, the Trademark Trial and Appeal Board found this stylization of “mozzarella” insufficient to distinguish it from the generic word itself:



In re Grande Cheese Co., 2 U.S.P.Q.2d 1447, 1449 (T.T.A.B. 1986) (“We believe that whatever impact the style of the lettering may have is lost in the significance which the ‘marks’ have as highly descriptive or generic notations and we believe that the ‘marks,’ considered in their entirety, create only a single commercial impression, that is, that of a highly descriptive or generic notation.”).

The same concept applies with respect to generic terms that are modified not by stylization but by other words. It is black-letter trademark law that, when determining distinctiveness, composite marks are to be considered as a whole and not dissected into their constituent parts. *See, e.g., Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012); *Blinded Veterans*, 872 F.2d at 1041. Thus, adding words to an otherwise generic term might in some cases

3. Stylization is also frequently the basis on which the Trademark Office distinguishes one mark from another that consists of the same words in standard characters. So, for example, Coca-Cola owns federal registrations of COCA-COLA (Reg. No. 238,145) and the stylized *Coca-Cola* (Reg. No. 238,146), both for “beverages and syrups for the manufacture of such beverages.”

make the mark as a whole inherently distinctive or capable of acquired distinctiveness (not generic) notwithstanding the inclusion of generic words. *See Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 491 (2d Cir. 1988) (emphasizing the “long-standing view that the nongeneric components of a mark must be compared in the context of the overall composite mark”).

In considering whether additional matter can render generic terms protectable, however, not all matter is equal. Courts often have maintained, for example, that verbal elements of a mark predominate over stylization and graphic elements, such that the additional matter has no effect on consumers' perception of the composite. *See, e.g.*, LOUIS ALTMAN, 3 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES (4th ed. 2019) § 21:38 [hereinafter CALLMANN] (“The general rule is that words dominate over graphics.”); *Chum Ltd. v. Lisowski*, 198 F. Supp. 2d 530, 538 (S.D.N.Y. 2002) (different logos not relevant for TV programs); *In re Northland Organic Foods Corp.*, 2008 WL 4674565 (T.T.A.B. 2008), *aff'd*, 337 Fed. App'x. 878 (Fed. Cir. 2009) (similar words dominate over different designs); *In re Jakob Demmer Kg*, 219 U.S.P.Q. 1199, 1983 WL 50191 (T.T.A.B. 1983) (different design marks with identical verbal matter are dominated by the words). Likewise, generic words like “company” add nothing to a mark's commercial impression. *See, e.g.*, 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:39 (5th ed. 2019) [hereinafter MCCARTHY]; *In Re Wm. B. Coleman Co., Inc.*, 93 U.S.P.Q.2d 2019, 2027 (T.T.A.B. 2010) (“[T]he term ‘company’ is simply a designation for a type of entity without source-identifying capability.”).

When a composite mark is comprised only of generic terms, courts assess distinctiveness by asking whether the whole creates a commercial impression that is more than the sum of its parts, in which case it may be capable of serving as a trademark, or whether the whole is simply a sequence of generic elements each with its generic meaning, in which case it cannot serve as a trademark. See *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1348 (Fed. Cir. 1999) (holding that the Trademark Office erred in finding the phrase SOCIETY FOR REPRODUCTIVE MEDICINE generic when it only considered the genericness of each individual component without considering the meaning of the composite); *Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153, 1161 (7th Cir. 1996) (finding WAREHOUSE SHOES generic because “[its] generic components produce[d] a generic composite and signif[ied] nothing more than a warehouse-type store that sells shoes”); *In re Gould Paper Corp.*, 834 F.2d 1017, 1018 (Fed. Cir. 1987) (finding SCREENWIPE generic because the combination of the generic terms “screen” and “wipe” did not render the mark unique or incongruous).

Because of the variety of marks containing unprotectable matter and the need for competitors to remain free to use unprotectable matter, the Court should require trademark claimants to clearly identify what makes their claimed marks distinctive. The Court’s holding should also make clear that composite marks are not inherently more than the sum of their parts.

b. Where a Mark Contains Unprotectable Matter, Courts Must Be Attentive to the Scope of Rights

Identifying unprotectable elements in otherwise protectable marks is critical in order to identify the proper scope of the rights conferred by trademark law. The protectability of marks containing unprotectable matter is predicated on the contribution of the additional matter to a distinctive commercial impression—whether that be color, stylization, additional words, or images. The protection afforded composite marks should therefore be narrow and should discount similarity of unprotectable components. *See, e.g., In re Miller Brewing Co.*, 226 U.S.P.Q. at 670 (“It should be emphasized however, that the rights represented by this registration will be extremely narrow, residing solely in applicant’s particular display of the word ‘LITE’, without any rights in the word ‘LITE’ per se, so that the registration could be used as a basis for precluding the use and/or registration by another of ‘LITE’ for the same or similar goods only if the third-party use is in the same or a confusingly similar style of lettering.”); *cf. Gruner+Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072 (2d Cir. 1993) (finding plaintiff’s registered stylized mark for descriptive term “Parents” had secondary meaning limited to its typeface and placement on magazine cover; not infringed by competing magazine “Parents Digest”). When scope is not properly policed, parties are able to bootstrap registration into anticompetitive protection for a term that is useful or even necessary to others to compete. *See* Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197 (2016).

In practice, courts in infringement actions often unwittingly increase the scope of registrations by according presumptive validity to a registration without appreciating the subtle distinctions the Trademark Office relied upon in registering the mark. *See* CALLMANN, *supra*, § 21:56 (listing numerous cases in which non-distinctive element of mark dominated and was held to support a finding of confusing similarity despite lack of conceptual distinctiveness, including ADJUST for manually operated shower valves, CASH for mortgage brokers, and CREAM for hair creams); *see also* Rebecca Tushnet, *Registering Disagreement: Registration In Modern American Trademark Law*, 130 HARV. L. REV. 867, 872 (2017) (“Applicants and the PTO spend much time and effort crafting the equivalent of an exquisitely detailed origami crane: a precisely delineated valid mark. Rather than considering the details, courts then ask the equivalent of ‘is this paper folded?’ by according presumptive validity to what the mark, at first glance, appears to be. Not only is this process a waste of resources, but it also leads courts to misunderstand the proper scope of a registration.”).⁴ And ordinary businesses are often even less equipped to grasp the limits of a registration asserted against them.

The risk of overextension means that it is important to be cautious in determining that additional matter sufficiently differentiates a claimed mark from a generic or descriptive term at the core of a purported composite

4. The same problem arises in cases involving unregistered marks, where the court’s own validity determinations often do not translate to scope limitations that are faithfully observed at the infringement stage. *See* Lemley & McKenna, *Scope*, *supra*, at 2249–56. Difficulty managing scope, then, is not an issue unique to registration.

mark. Otherwise, registrants may end up with de facto monopolies over descriptive or generic terms, despite the theoretical limits on their registrations. The smaller the increment of non-generic material that is incorporated into a mark containing generic elements, the greater the risk of its anticompetitive assertion.

There is a point at which the game is no longer worth the candle in terms of granting protection as a mark. As this Court explained with respect to product design trade dress claims, because product design usually serves purposes other than source identification, overprotection through trademark law is very likely to harm consumers and competition. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213–14 (2000). The same is true with respect to overprotection of claimed marks that are near the genericity line, which enable anticompetitive threats by trademark claimants. *Id.* at 214 (“Competition is deterred . . . not merely by successful suit but by the plausible threat of successful suit . . .”). Indeed, even the plausible threat of an unsuccessful suit can have major competition-impairing effects. *See* Leah Chan Grinvald, *Policing the Cease-and-Desist Letter*, 49 U.S.F. L. REV. 409 (2015); William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 453, 487 (2012) (“[A]ggressive and bullying enforcement tactics can work and are sometimes part of the IP owner’s overall enforcement strategy. They are effective, in part, because many targets do not have the resources to defend a trademark or copyright claim on the legal merits in court.”); Kenneth Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585 (2008)

(reviewing published cases involving overclaiming of rights).⁵

Because of these persistent dynamics between initial protection and the scope of enforced rights, whatever rule this Court adopts should be attentive to the risks of overassertion of the scope of a registration. The need to consider the practical scope of a registration when assessing initial validity is especially important given the potential availability of unfair competition even without a valid and registrable trademark, as discussed in Part II.

c. The .com Situation Implicates Special Concerns Relating to Competition

i. A Top-Level Domain Performs a Practical Function

This case has special features even by comparison to cases involving additions to otherwise generic terms, since the addition here (the .com top-level domain) has uniquely functional characteristics. When used as a domain name, booking.com has a clear non-trademark function—it instructs a user’s computer where to go to retrieve content. Even when booking.com is advertised, the .com portion of the purported mark serves the purpose of identifying it as a domain name.

5. Depending on the amount in controversy, the 2015 American Intellectual Property Law Association (AIPLA) survey reported average trademark litigation costs through the end of discovery of \$150,000 to \$900,000. AIPLA, Report of the Economic Survey 2015, at 38–39 (2015), <http://files.ctctcdn.com/e79ee274201/b6ced6c3-d1ee-4ee7-9873-352dbe08d8fd.pdf>.

That means the closest analogy here is not to cases involving the addition of corporate references (such as “inc.” or “corp.”), but to those in which the claimed mark serves a non-trademark function.⁶ While that issue arises most commonly in product configuration trade dress cases, words and images sometimes raise analogous concerns. *See, e.g., America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 820 (4th Cir. 2001) (finding “You Have Mail” to be generic and unprotectable in significant part because of the term’s functional use to “simply inform[] subscribers, employing common words to express their commonly used meaning, of the ordinary fact that they have new electronic mail in their mailboxes”).

An accurate image of a paperclip on a box of paperclips communicates that paperclips will be in the box. Even though the image cannot itself be used to hold paper together, the need for freedom to compete to provide—and to advertise—paperclips makes a non-stylized image of a paperclip unregistrable on its own. *See Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.*, 647 F.3d 723, 731–732 (7th Cir. 2011) (holding that an accurate depiction of a functional product cannot be an infringement); *see also* MCCARTHY, *supra*, § 7:77 (“An accurate image of a functional and utilitarian product can be regarded as the equivalent of the utilitarian shape itself. If it is the equivalent of the shape, then the picture itself

6. Functionality and genericness are conceptually linked and serve the same limiting purposes to protect competition. *See, e.g., W.T. Rogers, Co. v. Keene*, 778 F.2d 334, 339 (7th Cir. 1985) (the concepts implement the “same principle”); William M. Landes and Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REPORTER 267, 290–97 (1988) (“The concept of functionality . . . is a parallel concept to genericness.”).

is ‘functional’ and should not be capable of appropriation as a trademark for one seller of that product.”⁷ Similarly, the addition of .com communicates that a consumer will find the seller at the corresponding URL ending in .com, even if in some advertising the consumer cannot actually click on “booking.com.”

ii. The Practical Exclusivity of a Domain Name Enhances Concerns About Scope

Importantly, for terms with top-level domains, the non-trademark function of the top-level domain stems from the exclusivity of the domain name system. Unless the applicant fails to renew its domain name registration,

7. The PTO has often applied this principle. *See, e.g., In re Pingel Enterprise Inc.*, 46 U.S.P.Q.2d 1811, n.5, 1998 WL 320157 (T.T.A.B. 1998) (illustration of a functional fuel valve petcock for motorcycles cannot be registered as a trademark for vehicle parts; “for purposes of determining the issues of de jure functionality and acquired distinctiveness, it simply makes no difference in this appeal whether we regard the matter which applicant seeks to register, as shown on the drawing submitted with the application, as either the product configuration of applicant’s petcock or a ‘logo’ thereof”); *In re Lighting Systems, Inc.*, 212 U.S.P.Q. 313, 1981 WL 40452 (T.T.A.B. 1981) (holding that a picture of a functional shape is itself functional and unregistrable); *In re Capri Macaroni Corp.*, 173 U.S.P.Q. 630 (T.T.A.B. 1972) (picture of colored macaroni not valid as a mark for macaroni: “The so-called color combination is merely dictated by the ingredients used in the manufacture of the vegetable macaroni. In essence what applicant is seeking to register is the goods and that is not a trademark”); *Textron Inc. v. Pilling Chain Co., Inc.*, 175 U.S.P.Q. 621, 1972 WL 17819 (T.T.A.B. 1972) (illustration of functional zipper cannot be trademark for zippers; “registration on the Principal Register . . . would give it prima facie rights by which it could theoretically exclude opposer and other zipper manufacturers from illustrating their products on their goods or in their advertising”).

the domain name system gives it practical, indefinitely renewable exclusivity: its website will be found at that domain name, regardless of what happens in the world of trademarks.

As 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. Instead, one likely consequence of recognizing trademark rights in a generic term plus .com would be to allow the applicant to assert anticompetitive claims against nonidentical uses that rely on the generic meaning. In this case, that could be domain names such as hotelbooking.com or booking.home. Given the flexibility of the multifactor confusion test, which assesses overall similarity of the parties' uses, claims based on a registration for BOOKING.COM might even be made against advertising that included phrases like "book your stay at home.com."⁸ *Amici* recognize that Respondent disclaims any anticompetitive intent, and we do not suggest Respondent acts in bad faith, but that general promise of restraint is hard to enforce (and, of course, others who may take advantage of the availability of registration for similar generic terms combined with .com have not made the same promise). Numerous domain names consist of generic terms with top-level domains, from pets.com to mattress.com to flowers.com.

8. Such a use would almost certainly qualify as descriptive fair use. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004). Still, the multifactor test for assessing whether a descriptive use is fair all but ensures expensive, and thus competition-detering, litigation. See *Kelly-Brown v. Winfrey*, 659 F. App'x 55, 58 (2d Cir. 2016); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 605 (9th Cir. 2005); See also William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 NOTRE DAME L. REV. 253, 282–84 (2013).

For that reason, the Fourth Circuit's assurance that other businesses can continue to use domain names like *carbooking.com* or *flightbooking.com*, Pet. App. 44a, is unduly optimistic. In *America Online*, for example, the majority correctly found "You've Got Mail" to be generic because of the functional manner in which it was used to indicate that the user had received mail. *America Online*, 243 F.3d at 820. The dissent in that case argued that "You've Got Mail" was not generic because it was not the best available generic term, given its grammatical structure, *id.* at 824 (Luttig, J., dissenting). Notably, however, the dissenting judge ignored the fact that the plaintiff had actually sued AT&T for using "You Have Mail," exactly the generic term the dissent preferred. *Id.* (Luttig, J., dissenting). Unfortunately, absent an extremely robust practice of awarding fees to prevailing defendants in such cases, courts can do little to prevent claims beyond the proper scope of a registration. For this reason, the assessment of genericness should explicitly take into account the risks of aggressively asserted scope.

II. Whatever Rule this Court Adopts Should Not Rely on the De Facto Secondary Meaning Possessed by Domain Names

a. The General Rule That Distinguishes De Facto Secondary Meaning from De Jure Secondary Meaning is Important to the Overall Functioning of the Trademark System.

Whatever the Court's conclusion with respect to *Booking.com*, the Court should be very clear that the uniqueness of a top-level domain name cannot in itself generate protectable secondary meaning. Domain

names are, given the current operation of the internet, unique, so it would not be surprising if they developed de facto secondary meaning. The address “1600 Pennsylvania Avenue” is similarly associated with only one governmental entity. But an address—physical or virtual—is not the same thing as a trademark. In *Kellogg*, the fact that National Biscuit Company (Nabisco) had a patent on the shape of shredded wheat biscuits meant that it had the exclusive right to sell biscuits in that shape during the patent period. *Kellogg*, 305 U.S. at 117. When the patent expired, Nabisco had been the sole producer of pillow-shaped biscuits for many years. The public had, correctly and entirely unsurprisingly, come to expect that pillow-shaped biscuits came from Nabisco. *Id.* at 118–19. Despite those consumer expectations, this Court held that Nabisco did not own trademark rights either in the phrase “shredded wheat” or in the shape of the biscuits themselves. *Id.* at 121. As this Court explained, consumers’ association of a generic term with a particular producer that results simply from the fact that the consumers were exposed to advertising of that term by that producer is not meaning that the trademark system should be twisted to protect. *Id.* at 120.

The distinction between de facto and de jure secondary meaning has many benefits for the overall trademark system. It protects competition and effective communication. *Diester*, 289 F.2d at 504 (“The true basis of such holdings is not that they cannot or do not indicate source to the purchasing public but that there is an overriding public policy of preventing their monopolization, of preserving the public right to copy.”). Denying trademark protection for generic terms also encourages market participants to choose and promote

trademarks that are more distinctive, so that they will have something protectable when competition begins. In *Kellogg*, for example, that was the brand name National Biscuit (quickly abbreviated to Nabisco). And denying trademark protection to generic terms even in the presence of de facto secondary meaning recognizes that, as a practical matter, some consumer expectations are extremely thin: even when consumers make a de facto association between a generic term and a particular producer, that does not mean that they expect any product with that name to come from the same producer, especially once they start to see other producers providing the product. Thus, granting trademark rights in a generic term in itself is not necessary to protect consumers.

Parties cannot claim trademark rights in generic terms even when their de facto secondary meaning results from resounding success in the face of competition. As the Court of Customs and Patent Appeals explained with respect to the generic term “sudsy ammonia,” success in sales resulting from greater advertising and production than competitors was “no ground for impairing the rights of those others, though they be small, to be free from possible restraint in the use of the common descriptive names of their products.” *Roselux Chemical Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 862–63 (C.C.P.A. 1962);⁹ see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“No matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has

9. What courts once called “common descriptive names” are, in modern terms, “generic.” See, e.g., *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 972 (Fed. Cir. 2018).

achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.”); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 848 (C.C.P.A. 1961) (“[M]erchants act at their peril in attempting, by advertising, to convert common names, which belong to the public, to their own exclusive use. Even though they succeed in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect.”).

b. The Difference Between De Facto Secondary Meaning and De Jure Secondary Meaning Can Be Especially Difficult to Evaluate Using Surveys, Including the One Offered by Booking.com.

Consumers’ correct understanding of a domain name’s exclusivity may lead them to conflate that exclusivity with true trademark meaning. As a result, surveys might seem to suggest secondary meaning in a .com that is really de facto secondary meaning and not protectable trademark meaning. Thus, courts in domain name cases need to look at surveys very carefully to ensure they are proving what their proponents say they are proving. For example, Booking.com’s survey trained survey respondents about the difference between trademarks and generic terms using a .com domain name (STAPLES.com) as an example of a valid trademark rather than the well-known-on-its-own Staples name. *See* Pet. App. 88a. This training suggested to respondents that heavily advertised .com names could readily be trademarks and may well have distorted the survey’s results. *Cf. Sheetz of Delaware, Inc. v. Doctors Associates Inc.*, 108 U.S.P.Q.2d 1341 (T.T.A.B.

2013) (holding that a survey with “ambiguous” training examples wrongly suggested to respondents that “heavily advertised” terms straddling the line between generic and descriptive were trademarks; such a survey was not entitled to much weight).

Although the survey used an unknown .com example (OFFICESUPPLIES.COM) as a training example of a generic term, Pet. App. 88a,¹⁰ it did not fully grapple with the general public understanding that any given string that ends in .com will always resolve to a single website. Notably, despite its attempt to train respondents and despite the use of screener questions that required respondents to correctly categorize the non-.com terms KELLOGG and CEREAL in order for their other answers to be counted, the survey nonetheless induced 33% of those respondents to identify the generic WASHINGMACHINE.COM as a brand name.¹¹ Over 6% more were not sure if it was a brand name or generic. Pet. App. 91a. The survey produced that result even though 100% of the same respondents recognized SUPERMARKET as generic (99.5% recognized SPORTING GOODS as generic), indicating that they grasped the general distinction. *Id.*

While there is a significant gap between the 33% who deemed WASHINGMACHINE.COM to be a brand name and the 74.8% who deemed BOOKING.COM to be a brand name, the fact that the survey induced one-third of respondents to identify a concededly generic domain name

10. Officesupplies.com does not appear to have an independent commercial existence, although that domain name currently redirects to officesupply.com.

11. Washingmachine.com presently redirects to Wayfair.com.

as a brand name indicates the serious difficulties inherent in trying to use a survey to distinguish between de facto secondary meaning based on domain name exclusivity and trademark meaning. *See Miller Brewing Co. v. Joseph Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979) (because “light” was “a familiar, basic word in the English vocabulary,” its trademark status could not be evidenced by “associations the word brings to consumers as a result of advertising”); cf. Richard Craswell, “*Compared to What?*”: *The Use of Control Ads in Deceptive Advertising Litigation*, 65 ANTITRUST L.J. 757, 771 (1997) (noting that, where control stimuli produce very high objectively wrong responses, there may be underlying problems with the survey’s choices); *Kate Spade LLC v. Saturdays Surf LLC*, 950 F. Supp. 2d 639, 647 (S.D.N.Y. 2013) (control group confusion of over 34% raised “serious” questions about validity of infringement survey).

Relatedly, the Court should take into account that the relevant percentage for BOOKING.COM is its net recognition, rather than its gross 74.8% recognition, which includes some amount of “noise.” *See, e.g.,* MCCARTHY §32:187 (“[A] survey control is always necessary to pin down causation: whether survey responses in fact reflect the thing the survey is designed to prove, whether it is secondary meaning or that the accused mark causes confusion or some other issue.”) (citing Shari S. Diamond, *Control Foundations: Rationales and Approaches, in Trademark and Deceptive Advertising Surveys* 202 (SHARI S. DIAMOND & JERRE SWANN EDS., 2012)). The best estimate of that noise, given the survey, is 33% (taking WASHINGMACHINE.COM as the best control because it is relevantly similar to BOOKING.COM but

concededly not protectable).¹² Netting out the “noise,” the survey would estimate of 41.8% recognition—a number meaningfully below the generally accepted 50% or more needed to demonstrate “primary significance.” MCCARTHY §12:6 (“The result of the primary significance rule is that majority usage controls.”).

III. Unfair Competition Remains an Alternative to Trademark Protection Where De Facto Secondary Meaning Exists

Booking.com’s best case for some kind of relief involves not ordinary trademark infringement (because it to disclaims a wide scope for its rights), but deliberate deception.¹³ Fortunately, to the extent the Court is

12. See Shari Seidman Diamond, *Reference Guide on Survey Research*, in *Reference Manual On Scientific Evidence* at 229, 257 (Federal Judicial Center 2d ed. 2000) (a control should share “as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed”).

13. For example, bad actors might use homographs to fool internet users into thinking that they are visiting a known website by registering a domain name using non-Latin characters that emulate the Latin characters. See *IDN Homograph Attack*, WIKIPEDIA, https://en.wikipedia.org/wiki/IDN_homograph_attack. Although browsers have defenses against this kind of attack and although ICANN, which manages the domain name system, has attempted to put measures in place to prevent registrations of domain names of this type, those measures are not perfect. See *id.* Thus, it is theoretically possible that a bad actor could register a domain name that looked, to a human, like booking.com. See *Homoglyph Attack Generator*, IRONGEEK.COM, <https://www.irongeek.com/homoglyph-attack-generator.php?encoded=xn--bkin-37b01soza.xn--om-vfc&decode=%3C%3C+Decode> (showing

concerned that bad actors could use de facto secondary meaning to mislead consumers, unfair competition remedies are available to guard against truly deceptive uses of generic terms. Unfair competition is a limited residual doctrine that has long provided claims against those who, by means other than use of a trademark, attempt to pass off their goods as though they were the plaintiff's. *See* Mark P. McKenna, *Property and Equity in Trademark Law*, 23 MARQ. INTELL. PROP. L. REV. (forthcoming 2020) (available at <https://ssrn.com/abstract=3502613>).

These unfair competition principles have a very long pedigree at common law. Modern courts frequently describe § 43(a) of the Lanham Act, 15 U.S.C. §1125(a), as a partial codification of unfair competition and as the source of these rules. *See Blinded Veterans*, 827 F.2d at 1046. The relationship between common law unfair competition and § 43(a) is a complicated one beyond the scope of this case. *See* McKenna, *Property and Equity in Trademark Law*, *supra*. Most saliently, not all applications of § 43(a) are subject to the limits that apply to generic terms. Unregistered (but unambiguously protectable) trademarks, for example, are enforced under § 43(a) on substantially the same terms as registered marks. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). But where unfair competition is used as a residual claim in the context of generic terms or functional matter, these limitations apply.

the code used to produce one such URL, using several non-Latin characters that are difficult to distinguish visually from Latin characters). The attacker could then attempt to capture users' information or install programs on their computers if they clicked on this URL in an email.

Unfair competition is more limited than trademark rights in two critical respects.¹⁴ First, unfair competition focuses only on true risks of passing off—deceiving consumers into believing that one’s goods in fact are those of another. *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 940 (explaining that “passing off” occurs when consumers think they are dealing with one party but are really dealing with another); *see also* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1860–62 (2007). A far broader and more amorphous range of “confusion” is actionable under modern trademark law, which allows trademark owners to sue, and even win, on the theory that consumers might think that the parties had some sort of relationship, even though consumers understand with whom they are dealing. *See* Glynn S. Lunney, Jr., *Trademark’s Judicial De-Evolution: Why Courts Get Trademark Cases Wrong Repeatedly*, 106 CAL. L. REV. 1195, 1208–1213 (2018); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV.

14. There are differences between registered and unregistered marks—for example, registration gives access to some specific benefits, such as the ability to exclude counterfeit goods through Customs and Border Protection. *See* 15 U.S.C. §§ 1124, 1125(b) (2012). Here, however, we focus on the difference between unfair competition as such and protection for trademarks, whether registered or unregistered. Some private agreements also look to national law; for example, the Uniform Domain Name Dispute Resolution (UDRP) process requires complainants to establish the existence of trademark protection in some country, whether via registration or the common law, in order to proceed. *See WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <https://www.wipo.int/amc/en/domains/guide/>. But this Court’s decision should not turn on the availability or lack thereof of UDRP arbitration.

413, 422–26 (2010). Unfair competition is therefore much narrower than modern trademark law and thus provides competitors with much greater certainty in their ability to use generic terms as part of their advertising and promotion than a multifactor confusion test or multifactor descriptive fair use defense.

Second, unfair competition remedies in the absence of trademark rights are very different than trademark remedies. Specifically, in no case can the remedy consist of an injunction against use of the generic term itself. The remedies are limited to a requirement of labeling or other means of distinguishing the uses. *See, e.g., Kellogg*, 305 U.S. at 122 (contemplating the possibility of unfair competition remedies focused on labeling or packaging rather than on the words “shredded wheat,” but concluding that Kellogg had sufficiently distinguished its product); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 203–04 (1896). With these limitations, competition and consumer protection can be balanced. *Belmora, LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 713 (4th Cir. 2016) (explaining that Belmora could be required to distinguish its Flanax product from Bayer’s Mexican Flanax product despite Bayer’s lack of trademark rights in the United States); *Home Builders Ass’n of Greater St. Louis v. L & L Exhibition Mgmt. Inc.*, 226 F.3d 944, 950 (8th Cir. 2000) (“A generic trademark or functional trade dress is not protected from copying. But if it has acquired secondary meaning, § 43(a) relief may be appropriate to require the copier to take reasonable measures to eliminate public confusion as to the source of its competing product or service.”); *see also* Caitlin P. Canahai & Mark P. McKenna, *The Case Against Product Configuration Trade Dress* at 13 (available at <https://ssrn.com/abstract=3336366>) (describing the role of unfair competition remedies in the product configuration context,

“which would police confusing labeling or packaging and ensure that sellers adequately distinguished their competing goods by use of other indicators, all while allowing copying of the product design itself”).

Critically, where unfair competition/passing off principles operate, it is not enough to allege that the defendant used a generic term and that such use caused confusion. Something more is required, consistent with the rule that the generic term itself must remain free for all to use. *Blinded Veterans*, 872 F.2d at 1046 (holding that evidence of de facto secondary meaning and of use of a generic term was insufficient to establish passing off claim where plaintiff failed to point to “specific actions” by defendant which increased risk of confusion); *Liquid Controls*, 802 F.2d at 939–40 (“[I]f a term [is] generic, use of that term alone [cannot] give rise to an unfair competition claim, even if many people [have] come to associate the term with the plaintiff,” but courts may act to require a defendant “to adequately identify itself as the source”); *BellSouth Corp. v. White Directory Publishers, Inc.*, 42 F. Supp. 2d 598, 614 (M.D.N.C. 1999) (mere use of generic symbol cannot be the basis for liability in the absence of additional evidence of “affirmative steps which increased the likelihood of confusion”); *Miller Brewing*, 605 F.2d at 997–98 (LITE for beer was generic, but Miller could state a claim for unfair competition against another light beer producer if it could allege confusion arising from coloring and styling of labels, “advertising calculated to lead to confusion,” or “any cause except [defendant’s] use of the word light in [its] product name”); McCARTHY, *supra*, § 12:48 (“In the author’s opinion, in order to obtain some form of relief on a ‘passing off’ claim, the user of a generic term must prove some false or confusing usage by the newcomer above and beyond mere use of the generic name.”).

Using unfair competition, then, a court would not enjoin mere use of the term “booking” as part of a domain name or other formulations like booking.org. But it would readily be able to enjoin defendants who deceptively emulate booking.com using non-Latin fonts or make other deceptive uses of booking.com in advertising, as well as just as it could enjoin uses of confusingly similar layouts, color schemes, or logos on websites. Courts could also require additional matter to allow reasonable consumers to distinguish those other sites, if that matters were not already present. See *Kellogg*, 305 U.S. at 122 (“The obligation resting upon [defendant] Kellogg Company is not to insure that every purchaser will know it to be the maker but to use every reasonable means to prevent confusion”); *Blinded Veterans*, 872 F.2d at 1043 (“[T]he subsequent competitor cannot be prevented from using the generic term to denote itself or its product, but it may be enjoined from passing itself or its product off as the first organization or its product. Thus, a court may require the competitor to take whatever steps are necessary to distinguish itself or its product from the first organization or its product.”).

CONCLUSION

In resolving this dispute, the Court should set a standard that takes into account the effects of registration on the overall trademark system, including the potential scope of any registration, and it should keep in mind the availability of unfair competition remedies under §43(a) of the Lanham Act as a backstop when generic terms have de facto secondary meaning.

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