

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 THE INTERNATIONAL
TRADEMARK ASSOCIATION AS
AMICUS CURIAE
IN SUPPORT OF RESPONDENT**

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INTERESTS OF THE AMICUS CURIAE

The International Trademark Association (“INTA”)¹ is a not-for-profit global organization dedicated to the support and advancement of trademarks and related intellectual property. Founded in 1878 as the United States Trademark Association, INTA has more than 7,200 member organizations from 191 countries. Its members include trademark and brand owners, as well as law firms and other professionals who regularly assist in the creation, registration, protection, and enforcement of trademarks.

INTA was founded in part to encourage the enactment of federal trademark legislation after the United States’ first trademark act was invalidated on constitutional grounds. In connection with subsequent legislation, INTA has been instrumental in making recommendations and assisting legislators with trademark law. Of particular note in this case, an INTA representative testified at Senate hearings

¹ Pursuant to Supreme Court Rule 37.6, this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel for a party. No party or counsel for a party, nor any other person or entity other than amicus curiae, its members, and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.3(a), both Petitioner and the Respondent have consented to the filing of this brief.

regarding the 1984 amendments to Lanham Act Section 1064, which codified the primary-significance test that is central to this case.

INTA also has participated as amicus curiae in numerous cases in this Court² and other courts across the country. Moreover, INTA's members are frequent participants in litigation both in courts and in

² Cases in which INTA has filed amicus briefs in this Court include:

Romag Fasteners, Inc. v. Fossil, Inc., Fossil Stores I, Inc., Macy's, Inc., And Macy's Retail Holdings, Inc., No. 18-1233 (U.S. argued Jan. 14, 2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 1652 (2019); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988).

administrative proceedings before the United States Patent and Trademark Office (“PTO”) and the Trademark Trial and Appeal Board (“TTAB”), with respect to the Lanham Act.

SUMMARY OF THE ARGUMENT

INTA has no vested interest in whether Respondent registers BOOKING.COM as a trademark, but it has serious concerns about the arguments that the PTO advances to justify blocking the registration. For three reasons that transcend the instant case, INTA opposes the PTO’s proposed per se rule.

First, because classifying a term as generic has tremendous consequences for brand owners (on both sides of any dispute) and consumers, it is essential that decisions in this difficult area be based on the facts of each case. This is in part due to the inherent difficulty of drawing a line between generic and descriptive marks. Imposing a per se rule would immunize decisions from evidence of consumer perception, which ought to be the guiding light.

It is especially important to avoid rigid rules in the evolving jurisprudence relating to domain names. Although this case involves only the .com generic top-level domain (“gTLD”), a per se rule could spill over to more than 1500 (and growing) other gTLDs. Many of these new gTLDs may interact with a second-level

domain (“SLD”) in unpredictable ways that are different from domain names ending in “.com.”

Second, all admissible evidence, including reliable survey evidence, should be considered to determine whether a term is generic. Properly conducted Teflon surveys are highly relevant and should always be considered to determine whether a term is generic.

The misguided cases that have excluded Teflon surveys have not applied the Lanham Act’s primary-significance standard, which is applicable to all marks, not just coined terms. This test acknowledges that a term challenged as generic may have dual meanings (one generic; the other brand) and requires the trier of fact to determine which is “primary.” Cases that exclude surveys as irrelevant wrongfully assume the disputed conclusion that the generic meaning is primary.

Most importantly, cases that exclude surveys of consumer perception ignore the will of Congress. When Congress codified the primary-significance test in 1984, it intended that survey evidence would be admissible to determine the primary significance of any marks challenged as generic, not just coined terms.

These cases also misread this Court's precedent. This Court has never held that evidence of consumer perception cannot be considered to evaluate a claim of genericness. On the contrary, this Court's decisions in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938), and *San Francisco Arts and Athletics Inc. v. U.S. Olympic Committee*, 483 U.S. 522 (1987), teach that evidence of consumer perception is relevant when classifying a term as generic versus descriptive.

Third, modern decisions regarding trademark protection for phone numbers and geographic terms provide a better legal framework than this Court's obsolete ruling in *Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888), which was decided prior to adoption of the Lanham Act. Domain names are more like telephone numbers and geographic locations than the business designations discussed in *Goodyear*. Many cases have classified geographic locations and telephone numbers as descriptive, rather than generic, and therefore protectable upon proof of acquired distinctiveness. A domain name, which is registered to a single owner also represents a unique location, and, similarly, should be considered descriptive and not generic.

ARGUMENT

1. **THE COURT SHOULD AVOID A PER SE RULE BECAUSE DRAWING THE BLURRY LINE BETWEEN GENERIC AND DESCRIPTIVE MARKS RESULTS IN SIGNIFICANT CONSEQUENCES**

Because decisions classifying trademarks on the spectrum of distinctiveness are hugely consequential, they must be based on evidence rather than per se rules. The avoidance of per se rules is especially important in our rapidly evolving digital world.

1.1 Correctly identifying generic terms is important to brand owners and the public alike.

The basic economic rationale of trademark law is that trademarks reduce consumer search costs and promote economic efficiency. *See* William Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J. L. & Econ. 265 (1987). But the economic rationale also supports appropriate limitations on trademark rights. *See* Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines In Trademark Law*, 97 Trademark Reporter 1223 (2007).

The law should accordingly support an appropriate balance of protection. Consumers will be misled if they incorrectly believe a generic term is a product sold by only one company. *See Dogan, supra*, at 1242-44. In contrast, if competitors cannot use generic terms to describe their products, the public will suffer the inefficiency in locating competing products. *See Deven R. Desai & Sandra L. Rierson, Confronting the Genericness Conundrum*, 28 *Cardozo L. Rev.* 1789, 1829-30 (2007).

1.2 It is notoriously difficult to distinguish between generic terms and descriptive marks.

It has always been difficult to distinguish between generic terms and descriptive trademarks. As the district court here lamented, “The rub . . . is trying to distinguish generic marks from [protectable marks].” App. to Pet. Cert. 59a, *quoting Ashley Furniture Indus., Inc. v. Sangiacomo N.A.*, 187 F.3d 363, 369 (4th Cir. 1999); *see also* A.L. Fletcher, *Separating Descriptive Sheep from Generic Goats*, 103 *Trademark Reporter* 487, 501 (2013) (“Quite simply, the problem is that it is impossible to foresee with tolerable accuracy where courts, or the PTO, will draw the line between generic names and descriptive terms.”).

Not surprisingly,³ the litigation results have been inconsistent. For example, the Fifth and Seventh Circuits disagreed on the classification of ALO. The Seventh Circuit found ALO to be a generic term for cosmetics. *American Aloe Corp. v. Aloe Creme Laboratories, Inc.*, 420 F.2d 1248, 1252 (7th Cir. 1970). Reaching a different conclusion, the Fifth Circuit concluded that ALO was merely descriptive. *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845, 848 (5th Cir. 1970).

³ The lack of a reliably clear distinction between generic terms and descriptive marks was unabashedly acknowledged in Congressional hearings relating to the 1946 Lanham Act. *See, e.g.*, an exchange between Senator Lucas (Illinois) and Henry J. Savage (representing the National Association of Manufacturers):

Senator Lucas. “What is the objection to that, gentlemen?”

Mr. Savage. “What is the difference between a descriptive and a generic term?”

Senator Lucas. “Yes; that is what I would like to know.”

Mr. Savage. “That is one of the things that probably will be litigated for years.”

TRADE-MARKS, S. 895: Hearings Before A Subcomm. Of the Comm. on Patents, 77 Cong. 43 (1942).

Paradoxically, THERMOS was held to be generic for vacuum insulated bottles, but POLY PITCHER was deemed to be a protectable mark for polyethylene pitchers. *Compare King-Seeley Thermos Co. v. Aladdin Indus., Inc.* 321 F.2d 577 (2d Cir. 1963) with *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961). *Compare Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137 (2d Cir. 1997) (finding HONEY BROWN generic when used on brown ales brewed with honey); with *Schmidt v. Quigg*, 609 F. Supp. 227, 230 (E.D. Mich. 1985) and *Schmidt v. Honeysweet Hams, Inc.*, 656 F. Supp. 92, 96 (N.D. Ga. 1986) (HONEY BAKED HAM not generic, but rather descriptive). And the TTAB issued inconsistent decisions on SOFTSOAP. *Compare In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 1981 WL 40467 (T.T.A.B. 1981) (SOFTSOAP held to be a generic name) with *In re Minnetonka Inc.*, 3 U.S.P.Q.2d 1711, 1987 WL 124303 (T.T.A.B. 1987) (SOFTSOAP is not a generic name).

Given this inconsistency, a per se rule would inevitably detach litigation outcomes from the true facts of the cases. If a per se rule represents an assessment that the outcome of any case is so predictable and obvious that there is no need to conduct a particularized factual investigation, then the opposite is true here.

1.3 The rapid evolution of domain names further counsels against per se rules not tied to the facts of a case.

Although a trademark containing the .com gTLD is before the Court, the decision in this case may have consequences for other TLDs. Although the question presented is limited to .com, the Court's decision may affect future treatment of hundreds, even thousands, of other TLDs.

Consumers will encounter the newer gTLDs in many ways different than they perceive the .com suffix. Newer gTLD suffixes, which are approaching 1500⁴ in number, differ from each other in their inherent meaning as symbols in ordinary language, and in their meanings as top level domain suffixes. They therefore differ in their ability to modify second level domain names. This is true for country-code top level domain name suffixes (for example, .US, .CC, .LY, and .TV), for the original generic top level domain name suffixes apart from .COM (i.e. .NET and .ORG), and for the new generic top level domain name

⁴ See nTLDStats, *New gTLD Summary*, https://ntldstats.com/?fbclid=IwAR3K59iW8WqXu8RA4TBZK6W_DDe3SvDY6-SWB74iwZGga6cxai-3wNGC8 (last visited Feb. 17, 2020).

suffixes added over the past few years (i.e. .XYZ, .GURU, .CLUB).

Because the new gTLD suffixes were not selected according to any taxonomic system, they contain a seemingly arbitrary set of categories of symbols. TLD suffixes now include dictionary words (.GURU, .CLUB, .TOP), acronyms (.CPA, .DIY, .VIP), brand names (.CHANEL, .INTEL), geographical descriptors (.NYC, .BOSTON, .BERLIN), product categories (.GROCERY, .WATCHES), and Internet neologisms (.APP, .LOL, .MEME).

As many of the new gTLDs place no restrictions on the content of the second level domain name, and no restrictions on who may register those names, the number of potential domain names in the form [generic term].[gTLD suffix] is thus in the millions. The consumer may encounter, for example, CANDY.GURU, CANDY.XYZ, CANDY.DIY, CANDY.NYC, and CANDY.CLUB. Some of these names will be descriptive and some will be inherently registrable.

No per se rule can predict the primary significance of an infinite array of [generic term].[gTLD suffix] names. Accordingly, it would be better to proceed on a case-by-case basis and avoid per se pronouncements.

2. ALL ADMISSIBLE EVIDENCE, INCLUDING RELIABLE SURVEY EVIDENCE, SHOULD BE CONSIDERED TO DETERMINE WHETHER A TERM IS GENERIC

The PTO argues that the Respondent's Teflon survey is irrelevant⁵ because a showing of commercial success cannot convert a generic term into a trademark. As a corollary, the PTO also argues, based on cases like *Hunt Masters, Inc. v. Landry's Seafood Restaurant, Inc.*, 240 F.3d 251 (4th Cir. 2001), that Teflon surveys may only be used to show that coined terms have not become generic. Pet'r's Br. 36, 40-43.

INTA opposes this contention for reasons that transcend the current case. Although the Fourth Circuit panel distinguished *Hunt Masters* "based on the dearth of evidence in the record that the proposed mark was not commonly used," App. to Pet. Cert. 17a, . INTA would go beyond this narrow ruling. Properly conducted Teflon surveys ought *always* be considered when offered to assist determination of whether a term is generic. Admissibility should not depend on whether the subject term is "commonly used."

⁵ Ironically, the TTAB had faulted the Respondent for *not* offering a survey, which "would test whether subjects perceive a term as a brand or a generic term." J.A. 339.

2.1 Properly conducted Teflon surveys are highly relevant and should always be considered to determine whether a term is generic.

It is widely acknowledged that surveys provide the best evidence of consumer perception, *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 969 (Fed. Cir. 2015); *See also Berner Int’l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982-83 (3d Cir. 1993). “Indeed, survey evidence may be the most practical manner of approaching the evaluation of public reaction in such cases.” *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 639 (8th Cir. 1984) (stating that to determine if a phrase is generic without survey evidence would be asking the district court “to *assume* what it had to *find*”) (emphasis in original). “While no evidence is dispositive, consumer surveys offer the most specific, empirical evidence of what the public thinks.” Vanessa Bowman Pierce, *If It Walks Like a Duck and Quacks Like a Duck, Shouldn’t It Be a Duck? How a “Functional” Approach Ameliorates the Discontinuity Between the “Primary Significance” Test for Genericness and Secondary Meaning*, 37 N.M.L. Rev. 147, 161 (2007); *See also* Shari Seidman Diamond and David J. Franklyn, *Steps Toward Evidence-Based IP: Trademark Surveys: An Undulating Path*, 92 Tex. L. Rev. 2029, 2033 (2014).

2.2 The primary-significance standard is applicable to all marks, not just coined terms.

In *Kellogg*, this Court held that the trademark proponent “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” When Congress passed the Lanham Act in 1946, Section 14 provided for cancellation “at any time if the registered mark becomes the common descriptive name of an article or substance on which a patent has expired.” 15 U.S.C. § 1064(c) (14(c)) (now section 14(3)) (1946). For decades, courts equated “common descriptive name” with generic. See 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 12:21 (5th ed. 2019). In 1984,⁶ Congress amended Section 14(c) in response to the controversial decision in *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 684 F.2d 1316, (9th Cir. 1982), which had excluded a Teflon survey and ruled that the trademark MONOPOLY was generic based on a misguided standard. To undo the effects of that ruling, Congress amended Section 14(c) to clarify that this Court’s primary-significance test,

⁶ In 1962, Congress amended that Section to delete “on which a patent has expired . . .” H.R. 4333, 87th Cong. (1962).

Kellogg, 305 U.S. at 118,⁷ applied to cancellation actions:

At any time if the registered mark becomes the generic name for the goods or services . . . A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. *The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.*

Lanham Act § 14(3), 15 U.S.C. § 1064(3) (emphasis added). Significantly, nowhere does the text suggest that the primary-significance test would only apply to coined marks.

The primary-significance test is not limited to determining whether coined terms have become generic. The “Shredded Wheat” mark at issue in

⁷ See *Genesee Brewing Co.*, 124 F.3d at 144: “The ‘primary significance test’ is the law of the land; it was adopted by the Supreme Court in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938), and subsequently codified by Congress in the Trademark Clarification Act of 1984, Pub. L. No. 98-620, § 102, 98 Stat. 3335 (codified at 15 U.S.C. § 1064).”

Kellogg was not a coined term—in Nabisco’s patents “the term ‘shredded’ is repeatedly used as a descriptive of the product.” 305 U.S. at 117. And the text of Section 14(c) does not limit the test to any category along the spectrum of distinctiveness. *Berner Int’l Corp.*, 987 F.2d at 981 (district court’s holding that primary-significance test applied only to coined words reversed: “We find this reasoning unpersuasive . . . the 1984 amendments uniformly prescribe the primary-significance test. Congress has not chosen to limit this test to only cases of invented or coined words.”).

Although the primary-significance test is codified in Section 14, which controls cancellation actions, the test is derived from *Kellogg*, and accordingly, is more widely applicable. It is generally conceded⁸ that the primary-significance test applies to the evaluation of trademark applications. McCarthy § 12:57.

⁸ In the instant case, the Board framed the issue as whether “[t]he test for determining whether a mark is generic is its primary significance to the relevant public.” J.A. 312. The district court similarly stated that the proponent of the mark “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” App. to Pet. Cert. 59a.

2.3 Cases that have excluded Teflon surveys have not applied the primary-significance test.

None of the cases that the PTO relies on to support its irrelevance argument, Pet'r's Br. 42-43, apply the primary-significance standard that governs the determination of genericness. The Fourth Circuit, in *Hunt Masters*, makes no mention of the primary-significance standard. It merely follows *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990 (7th Cir. 1979), which was decided before the Trademark Clarification Act of 1984, and which also did not apply the primary-significance standard. Instead, the Court ignored *Kellogg* and referenced Judge Hand's earlier opinion in *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y.1921), observing:

When Judge Learned Hand said that whether a word is generic depends on what "buyers understand by the word," . . . He was referring to a coined word for a commercial product that was alleged to have become generic through common usage. He was not suggesting that the meaning of a familiar, basic word in the English vocabulary can depend on associations the word brings to consumers as a result of advertising.

Miller, 605 F.2d at 995. Even if one ignores the failure to consider *Kellogg's* primary-significance test, Judge Hand's opinion in *Bayer* does not support *Miller's* conclusion. There is nothing in *Bayer* that suggests limiting the test to only coined terms. On the contrary, Judge Hand asserts expansively that "The single question, as I view it, *in all these cases*, is merely one of fact: what do the buyers understand by the word for whose use the parties are contending?" *Bayer*, 272 F. at 509 (emphasis added). And when he wrote "all these cases," he was not referring to only cases involving coined trademarks. Indeed, one of the referenced case, *Hughes v. Alfred H. Smith Co.*, 209 F. 37 (2d Cir. 1913), held that IDEAL (certainly "a familiar, basic word in the English vocabulary") could be registered as a trademark even if it was descriptive.⁹ Clearly, Judge Hand was not limiting the buyer's understanding test to coined terms.

When they excluded surveys to show consumer perception, cases like *Hunt Masters* and *Miller* erred because they failed to apply the primary-significance test. All reliable evidence of consumer perception,

⁹ "We are satisfied that the word 'Ideal' so applied to a brush is not descriptive and therefore was entitled to registration as a trade-mark. But even if it were descriptive, it was in use for ten years prior to the passage of the Trade-Mark Act of 1905. It would therefore be entitled to registration." *Hughes*, 209 F. at 39.

including Teflon surveys, should be admitted to determine the primary significance that consumers associate with a disputed term.

2.4 Rejecting evidence of consumer understanding because the subject term is generic wrongly assumes the disputed conclusion that the mark is generic.

The primary-significance test contemplates that some terms may have more than one meaning and then calls on the trier of fact to determine which is the “primary” meaning. As Judge Brinkema correctly observed in this case:

A mark is not generic simply because it plays some role in denoting to the public what the product or service is; rather, a mark may serve a “dual function—that of identifying a product [or service] while at the same time indicating its source.” S. Rep. No. 98–627, at 5 (1984). Hence, *Kellogg* focuses on whether “the primary significance of the mark [is] indication of the nature or class of the product or service, rather than an indication of source.”

App. to Pet. Cert. 59a. This dual meaning scenario obviously applies to marks that straddle the line between generic and descriptive, with the outcome

depending on whether the brand connotation is “primary.”¹⁰

Excluding Teflon survey results because the mark is generic presumes that there is only one meaning to the disputed term—the generic meaning. It also deprives the trier of fact of evidence bearing on which meaning—brand or generic—is primary. How can a trier of fact presume to determine the “primary” significance of a term without receiving evidence of consumer understanding?

Professor McCarthy finds it “audacious” that a court would not consider survey evidence to determine the primary meaning of a mark:

To state that consumer perception is irrelevant for a non-coined “generic” word (like SHELL, or

¹⁰ See *Genesee Brewing Co.*, 124 F.3d at 144 (Under the primary-significance test “a trademark need not only and exclusively indicate the producer (the ‘source’), but may, instead, serve a ‘dual function—that of identifying a product while at the same time indicating its source,’ *Canfield*, 808 F.2d at 300 (quoting S. Rep. No. 98-627, 98th Cong. 5 (1984)). ‘[A] mark is not generic merely because it has some significance to the public as an indication of the nature or class of an article. In order to become generic the principal significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.’ *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 580 (2d Cir. 1963).”).

IVORY or HARP) is to assume the result before making an analysis of that which is to be decided . . . It is an audacious thing for a court to state that consumer perception is irrelevant when the issue is whether a designation is perceived by the consuming public as a generic name or not.

McCarthy § 12:17.50 (collecting cases).

2.5 When Congress codified the primary-significance test in 1984, it intended that survey evidence would be admissible to determine the primary significance of any marks challenged as generic.

When Congress codified the primary-significance test in 1984, it was aware of and contemplated continued reliance on Teflon survey evidence to inform the evaluation of genericness allegations. Indeed, it was the exclusion¹¹ of a Teflon survey in the infamous *Anti-Monopoly* case that prompted the 1984 amendments to correct the error. During Senate

¹¹ “The results of this [Teflon] survey had no relevance to the question in this case. Under the [Teflon] survey definition, ‘Monopoly’ would have to be a ‘brand name’ because it is made by only one company. This tells us nothing at all about the primary meaning of ‘Monopoly’ in the minds of consumers.” *Anti-Monopoly*, 684 F.2d at 1323.

hearings regarding the amendment, Senator Hatch asked Michael Grow, the representative from INTA's predecessor, the United States Trademark Association:

Senator Hatch . . .

Let me ask this question: Much of the evidence used by the courts to determine genericness is comprised of surveys assessing public attitudes about a trademark. What kind of surveys do the courts use under the traditional standard of the last 60 years, and how is the *Anti-Monopoly* standard altering the nature and the reliability of this survey evidence? Would S. 1990 remedy the evidentiary concerns of those who are experts in this field?

Mr. Grow. First of all, as far as surveys that have been used in the past, one of the most common types of surveys that has been used is what is sometimes referred to as a brand name survey, in which consumers are asked straightforwardly to give their reaction to a list of marks and generic names.

This test has been accepted by numerous courts in the past. It was rejected by the court in *Anti-*

Monopoly because the court felt that the questions were phrased improperly.

But that type of survey evidence and many other types of survey evidence have been found to be valuable by judges who obviously cannot go out and interview every member of the public to determine what the primary significance of the term in issue. As long as surveys are designed properly and are conducted in accordance with acceptable principles of survey research, they can be valuable sources of information.

The legislation as presently drafted would provide a means for courts and others to recognize that the traditional standards that have been employed with respect to survey research are acceptable, that the novel and radically different type of survey that was devised by the ninth circuit is not something that would be acceptable.

*The Trademark Clarification Act of 1983, S. 1990:*¹²
Hearing Before The Subcomm. on Patents, Copyrights

¹² Senate bill 1990 (S. 1990), the subject matter of the Senate hearings held in 1983, eventually became H.R. 6163 and finally Public Law 98-620 amending the Lanham Act to include the primary-significance test.

and Trademarks, 98 Cong. 38 (1984) (Statement of Michael Grow, United States Trademark Association representative) (Located online at the University of New Hampshire Franklin Pierce Law School IP Mall: https://ipmall.law.unh.edu/sites/default/files/hosted_resources/lipa/trademarks/S.%20Hrg.%2098-901,%20The%20Trademark%20Clarification%20Act%20of%201983,%20Subcomm.%20%28Feb.%201,201984%29.pdf).

Confirming Congress’ intent to allow Teflon surveys in all genericness disputes, Senator Hatch called attention to an article—Arthur J. Greenbaum, Jane C. Ginsburg, and Steven M. Weinberg, *A Proposal for Evaluating Genericism After Anti-Monopoly*, 73 Trademark Reporter 2, 115 (1983)—that he said “deserves recognition” because it “explains that the courts have misconstrued the doctrines of genericness.” He accordingly directed that the article be made part of the Senate record. *The Trademark Clarification Act of 1983, S. 1990: Hearing Before The Subcomm. on Patents, Copyrights and Trademarks*, 98 Cong. 62 (1984) (Statement of Senator Orrin G. Hatch). The following passages were included in of the Senate hearing record:

The manner in which a trademark proprietor and the public use the term at issue affords some indication of public perception of the

term, but this alone is not enough. The best gauge of the public's primary understanding, we believe, combines examination of these uses with evaluation of the results of a survey based on the survey endorsed in *E.I. DuPont v. Yoshida* [393 F. Supp. 502 (E.D.N.Y. 1975)] (the TEFLON-EFLON Survey), and rejected by the *Anti-Monopoly* appellate court.

Greenbaum, *supra*, at 118 (Hrg. Record p. 80). And further:

[H]aving been approved by several courts, this kind of survey is probably the most widely-used device to gauge trademark significance. Universal adherence to this test would eliminate the current confusion and inconsistency which judicial subscription to different tests now promotes.

Greenbaum, *supra*, at 119-20 (Hrg. Record p. 81-82).

The hearing testimony makes it clear that Congress intended the 1984 amendments to fully sanction Teflon surveys in all genericness disputes—not just those involving coined terms. There is no mention of limiting their use to coined terms.

2.6 This Court has never held that evidence of consumer perception cannot be considered to evaluate a claim of genericness.

The PTO opposes consideration of the Teflon survey based on cases that prohibit the consideration of consumer perception evidence to elevate a generic word to protectable status. Pet'r's Br. 36, 38-40. Most courts adhere to this assertion and Professor McCarthy calls any contrary analysis "aberrant." McCarthy § 12:46. INTA does not challenge the rule,¹³ the validity of which is not before the Court, but the rule should not be extended, as happened in *Miller* and *Hunt Masters*, to bar evidence of consumer

¹³ It must be acknowledged, however, that the text of the Lanham Act does not support this assertion, at least not explicitly. As the Seventh Circuit observed in *Miller Brewing*: "We note that a literal reading of the Lanham Act might lead to the conclusion that a generic name that has acquired a secondary meaning is entitled to registration." 605 F.2d 990, 994 n.7 (7th Cir. 1979). Section 2 of the Lanham Act requires that no trademark "shall be refused registration on the principal register on account of its nature," and then lists exceptions. Curiously, Section 2 does not list generic terms as one of the prohibited categories. McCarthy acknowledges the omission, but opines that generic terms may not be registered because they are not capable of distinguishing the goods or services. McCarthy § 12:57. Of course, this begs the question. If, like "merely descriptive" terms, generic terms were not disqualified from acquiring distinctiveness, then they would distinguish the goods or services upon proof of secondary meaning.

perception, in this case a Teflon survey, when deciding whether a mark is generic or descriptive.

This Court's decision in *Kellogg*, which is the precursor of the primary-significance standard codified into the Lanham Act in 1984, does not prohibit evidence of consumer perception—it implicitly invites it. Although the Court found that Nabisco had proved that “many people have come to associate” the name of the product with Nabisco, this was not enough: “[B]ut to establish a trade name in the term ‘Shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer. This it has not done.” *Id.* at 118.

The clear implication is that, if the facts had been reversed, and the facts had indicated that the primary significance of “shredded wheat” had been to indicate “the producer,” then the Court would not have found the mark to be generic.¹⁴ This Court did

¹⁴ See Desai, *supra*, at 1823-24 endorsing this reading:

Viewed in this light, the lesson to be learned from *Shredded Wheat* is that a term is “generic” and hence not a valid trade name when it has failed to acquire or has lost its secondary meaning—when its source-identifying capacity is not or is no longer its “primary significance.”

not say that evidence of consumer perception was irrelevant. Instead, it was relevant, but Nabisco failed as a matter of evidence to prove that the primary significance was “the producer.” The case in no way suggests that evidence of consumer understanding of the primary significance of the term would have been excluded as irrelevant. On the contrary, if evidence like the Teflon survey admitted here had been offered in *Kellogg*, the outcome may have been different.

This Court relied on acquired distinctiveness evidence to rebut a genericness claim in *San Francisco Arts and Athletics Inc. v. U.S. Olympic Committee*, 483 U.S. 522, (1987), where it rejected the contention that Congress violated the First Amendment when it gave the Olympic Committee rights in the term “Olympic.” Although “Olympic” had been considered generic in the nineteenth century when the modern Olympic movement began:

Congress reasonably could find that since 1896, the word “Olympic” has acquired what in

In *Shredded Wheat*, Justice Brandeis found that “shredded wheat” lacked secondary meaning, primarily because it was “the term by which the biscuit in pillow-shaped form [was] generally known by the public.” Even though the term “shredded wheat” apparently retained some degree of source-identifying capacity, this was the “subordinate meaning” of the term and not its “primary significance.”

trademark law is known as secondary meaning—it “has become distinctive of the [USOC’s] goods in commerce.” . . . Because Congress reasonably could conclude that the USOC has distinguished the word “Olympic” through its own efforts, Congress’ decision to grant the USOC a limited property right in the word “Olympic” falls within the scope of the trademark law, and thus certainly within constitutional bounds.

Id. at 534-5, citing *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985) and *Trademark Cases*, 100 U.S. (10 Otto) 82, 92 (1879).

INTA does not challenge the view that acquired distinctiveness cannot change the trademark status of a generic term, except insofar as that purported rule serves as a foundation for excluding surveys or other evidence of consumer perception. This Court has never so held and the Lanham Act text does not support such an exclusionary rule.

3. GOODYEAR IS INAPPOSITE, AS .COM IS NOT ANALOGOUS TO “COMPANY”

3.1 *Goodyear* is obsolete.

The PTO argues that in *Goodyear*, this Court would not consider evidence of either party’s extensive

use of “Goodyear” because the term was “descriptive of a class of goods.” *128 U.S.* at 602; *See* Pet’r’s Br. 38-39.

Goodyear is clearly obsolete. In 1888 when *Goodyear* was decided, neither descriptive nor generic terms could be protected as “technical trademarks,” which referred to marks that we would today refer to as arbitrary, fanciful, or coined. Consequently, courts in 1888 had no reason to distinguish between descriptive and generic marks as neither could be recognized as a trademark. Much has changed since then.

In particular, descriptive marks can be protected upon proof of acquired distinctiveness. As a result, McCarthy observes that “pre-Lanham Act cases are no longer valid.” McCarthy § 12:20. (“Prior to the Lanham Act, courts often failed to draw a clear distinction between the categories of ‘descriptive’ and ‘generic name’ . . . Modern Courts will not recognize pre-Lanham Act common law decisions that state that a generic name is capable of protection upon the acquisition of a secondary meaning.”); Desai, *supra*, at 1816–17. Indeed, the GOODYEAR mark has been

registered for decades and ranks as one of the country’s best-known marks.¹⁵

Similarly, the key precedent upon which *Goodyear* relied—*Canal Company v. Clark*, 80 U.S. 311 (1871)—ruled that a geographic location could not serve as a technical trademark. Under the Lanham Act, geographic terms can be protected upon proof of acquired distinctiveness. McCarthy §§ 14.1 and 14.9.

3.2 Modern case law regarding phone numbers and geographic terms provides a better legal framework than *Goodyear*, without a per se rule.

The PTO relies almost exclusively on *Goodyear* to support its assertion that a gTLD can never have source-identifying significance. Instead of offering factual proof that adding .com to a generic term does not create a potentially protectable mark, the PTO baldly equates .com and other gTLDs with business entity designations (such as “company” or “Inc.”) and leaves it at that. In doing so, the PTO ignores more relevant case law. Considering how gTLDs function in

¹⁵ See *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 729 (D. Minn. 1965) (holding that plaintiff had “met its burden of proof on the issue of secondary meaning” and therefore had a protectable trademark).

today's market, it is clear that the more apt analogy is to phone numbers as opposed to company designations.

Business designations like “company” are not analogous to “.com” or any other gTLD. Modern case law concerning phone numbers and geographic terms provides a better legal framework for analyzing the registrability of domain names as trademarks than *Goodyear*. Domain names, which identify a digital location on the Internet, are more similar to phone numbers, which identify a calling location—and to addresses, which identify a physical location—than to entity designations such as “corporation,” “Inc.,” and “co.”

A key characteristic shared by domain names and phone numbers is that each can only identify one unique location (whether telephonic, or digital) on a communications network. The technology limits an Internet domain name to a single owner. Only one Internet address can contain the domain name “booking.com.”¹⁶

¹⁶ The PTO argues (at 32) that distinguishing *Goodyear* on this basis wrongly protects functional features, but it does not explain why. It does not argue that BOOKING.COM is barred from registration because it is functional. In fact, the PTO has registered thousands of marks that include “.com” and offers detailed guidance on how to register such marks. *See* Examiner's

In contrast, more than one company can have the same name. Business names are registered on a state-by-state basis, thus it is possible that multiple companies can share the same name. For example, there is a “Sunshine Air Conditioning, Inc.” in Florida, and another one in California. Nebraska and Iowa each have a “Heartland Motors, Inc.” While consumers are inured to the co-existence of multiple corporate names, they know well that only one website is associated with a particular domain name.

The PTO argues that granting the Respondent a trademark registration for the term BOOKING.COM would be anticompetitive and injure consumers. However, denying the Respondent a registration, and thereby allowing others to use the identical domain

Manual § 1215 (“Marks composed in whole or in part of domain names”). There is no functionality problem here because Respondent only seeks protection for its use of BOOKING.COM *as a trademark*. The Examiner’s Manual § 1215.02, explains that “[t]he mark . . . must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a website.” Moreover, domain names do not perform a function in and of themselves without other elements of Internet protocols. A domain name, by itself, is not an address and is not functional. The domain name BOOKING.COM is not an Internet address—the URL “https://www.booking.com” is an Internet address. And even then, the URL is “functional” only when it is used as a URL in a browser. It is not used functionally when presented, for example, in advertising, as a trademark.

name, would potentially lead to confusion in the market. If a third party were to use BOOKING.COM to advertise its competing services, consumers might naturally assume such services came from the Respondent because in fact, only one Internet address is identified utilizing the domain name BOOKING.COM.

Another distinction between entity designations and domain names is that entity designations, for the most part, tend not to modify any other element in a trading name, and thus tend only to signify the particular form of legal organization of the ownership of a business. Thus, the addition of entity identifiers does not create a source-identifying phrase in examples such as REAL ESTATE PARTNERSHIP, FRUIT COMPANY, and SHOES CORPORATION. Furthermore, it is commonplace parlance to use phrases consisting of generic terms added to corporate identifiers to identify a genus of companies (“The developer is a real estate partnership”; “they work for a swimwear company”). Thus, the primary significance of a phrase such as REAL ESTATE PARTNERSHIP will likely be to identify the genus and not a single source. Here, in contrast, the record contains no evidence that the relevant consumers or trade use BOOKING.COM to identify a genus—no evidence in the form of “the organizer is a booking.com,” or “they work for a booking.com.”

The principle emerging from cases addressing the registrability of phone numbers and other location indicators is that the name or location is descriptive and may be registrable upon a showing of acquired distinctiveness, even if the location indicator is combined with a generic term. This is the legal framework that should apply to the case at hand.

The seminal vanity phone number case is *In re Dial-A-Mattress*, 240 F.3d 1341 (Fed. Cir. 2001). In that case, the applicant sought to register 1-888-M-A-T-R-E-S-S for “telephone shop-at-home retail services in the field of mattresses.” *Id.* at 1343. The PTO rejected the mark as generic or, in the alternative, as descriptive with insufficient evidence of acquired distinctiveness. *Id.* at 1344. The TTAB affirmed. *Id.* On appeal, the Federal Circuit held that, although area codes have no source identifying significance by themselves and the term “mattress” was generic, the combination of an area code and a generic term (1-888-MATRESS) was descriptive. *Id.* at 1346. The Federal Circuit found that the mark was descriptive, because it indicated that “a service relating to mattresses [was] available by calling the telephone number.” *Id.* The Federal Circuit explained that the applicant still needed to establish “acquired secondary meaning” to register the descriptive mark. *Id.* at 1347.

The same analysis applies to the case at hand. While the term “booking” is purportedly generic for reservation services, by adding “.com” the Respondent has created a descriptive mark that indicates that a service related to reservations is available by visiting the website. Whether the Respondent can prove that it has acquired distinctiveness, and is thereby entitled to registration, is another issue on which INTA does not opine.

The majority of other cases¹⁷ considering phone numbers are aligned with *In re Dial-A-Mattress* and employ an analysis in which an alphanumeric phone number may become a trademark, including phone numbers that include a generic term. *See Murrin v. Midco Communications, Inc.*, 726 F. Supp. 1195 (D. Minn. 1989) (defendant used the same mark and number in five New York City area codes; the parties conflicted in both wanting to use the mark and number with a nation-wide 800 number); *Bell v. Kidan*, 836 F. Supp. 125 (S.D.N.Y. 1993) (718-CALL-LAW v. 800-LAW-CALL; motion for preliminary

¹⁷ Not all phone number cases follow *In re Dial-A-Mattress*. *See Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, (3d Cir. 1992); *800 Spirits Inc. v. Liquor by Wire, Inc.*, 14 F. Supp. 2d 675 (D.N.J. 1998). However, the Third Circuit’s opinion in *Dranoff-Perlstein Associates* was criticized by *Express Mortg. Brokers, Inc. v. Simpson Mortg., Inc.*, 31 U.S.P.Q.2d 1371, 1373 n.2, (E.D. Mich. 1994).

injunction denied); *Express Mortgage Brokers, Inc. v. Simpson Mortgage, Inc.*, 31 U.S.P.Q.2d 1371 (E.D. Mich. 1994) (while “369-CASH” is descriptive of mortgage brokerage services, acquired distinctiveness was proven; defendant’s “1-800-760-CASH” was likely to cause confusion, and preliminary injunction was granted); *555-1212.com, Inc. v. Communication House Int’l, Inc.*, 157 F. Supp. 2d 1084, (N.D. Cal. 2001) (holding that 555-1212.com was descriptive as used for telephone directory assistance website, but holding that no acquired distinctiveness was proven); *see also* McCarthy § 7:13.

As the Eastern District of Virginia noted below, the analysis employed in phone number cases “maps seamlessly onto TLDs.” App. to Pet. Cert. 76a.

This treatment of vanity telephone number cases is in harmony with case law concerning the protectability of geographic terms as well. *See Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 U.S.P.Q.2d 1487, (T.T.A.B. 1990) (While an address is capable of use as a trademark, it is usually not so used. “PARK AVENUE NEW YORK,” used as part of the background design on BENSON & HEDGES cigarettes, was held not used as a trademark, but only as an address of the corporate headquarters of Philip Morris, Inc.); *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1113-14, (N.D.

Cal. 2010) (Street name “Sand Hill” is descriptive of the location of both parties and no secondary meaning found); *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 14:7 (4th ed. 2004) (“Is the mark the name of the place or region from which the goods actually come? If the answer is yes, then the geographic term is probably used in a descriptive sense, and secondary meaning is required for protection.”)

When considering how gTLDs actually function in our society today, it is clear that they are analogous to these other types of location identifiers (as opposed to entity designations). While a consumer may have dialed 1-888-Mattress in 2001 to buy a mattress, today it is just as likely, if not more so, that a consumer would purchase the same mattress on a website. As such, the proper legal framework to apply in the case at hand is *In re Dial-A-Mattress* and the other phone number cases.

CONCLUSION

INTA urges the Court to reject per se rules, endorse and encourage reliance on reliable survey evidence to determine consumer understanding in all cases, not just those involving coined terms, and reject *Goodyear* as obviously obsolete.

Respectfully submitted,

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