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SUPREME COURT OVERTURNS *per se* TRADEMARK RULE

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In an 8-1 decision in the case UNITED STATES PATENT AND TRADEMARK OFFICE ET AL. v. BOOKING.COM B. V., the Supreme Court has overturned a decades-long *per se* rule in the USPTO regarding the registrability of certain domain names. Read the full decision here: https://www.supremecourt.gov/opinions/19pdf/19-46_8n59.pdf

The ruling now allows for the registration of trademarks consisting of a generic term plus a top-level domain such as ".com" or ".net." In trademark law, a generic term is a one that defines of an entire category of goods, like "cars" or "computers," and is not afforded trademark protection because it would give such a trademark holder a monopoly on a term necessary for all competitors.

Since the 1880's, the USPTO has refused registrations for trademarks that consist of a generic term and a corporate designation such a "Co." or "Inc." With the development of the internet, the USPTO expanded the *per se* exclusion to trademarks consisting of a generic term plus ".com."

The Booking.com decision has put an end to the rule. Justice Ginsberg, writing for the majority, stated that consumers do not view or refer to all travel booking websites as a "booking.com." Since registration of "booking.com" would not prevent competitors from using the term "booking" on its own, and since all domain names are unique and no one else could use "booking.com." the Court held that there is no reason there should be a *per se* bar on such registrations, *if the applicant can prove secondary meaning*, i.e. consumers have come to identify the mark with the applicant.

That is the key here. Just because you now *can* get a registration for a trademark consisting of a generic term plus a top level, you will still have to provide evidence demonstrating secondary meaning.

Do you have a trademark or other Intellectual Property you want to protect? Please contact us by phone at [732.747.7100](tel:732.747.7100) or by email info@marksklein.com to discuss this issue and/or if we can assist in any way.

Brent "Giles" Davis counsels and represents clients on intellectual property, complex commercial litigation, and entertainment matters. As trial counsel, he has obtained favorable verdicts for his clients in jury and bench trials in both state and federal courts and settlements in a wide variety of trademark, copyright and trade secrets cases. Giles can be reached at brent@marksklein.com.

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