USPTO Issues New Exam Guide for Generic Top-Level Domain Marks

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On October 28, 2020, the USPTO released Examination Guide 3-20 providing the recommended procedure for examining trademark applications for registration that involve terms with generic top-level domains (gTLDs), such as .com and .biz (generic.com terms). This Guide has been published following the recent US Supreme Court's June decision in *USPTO v. Booking.com B.V.* (140 S. Ct. 2298 (2020)).

In the *Booking.com* case, the Supreme Court rejected the longstanding *per se* rule that generic.com terms are automatically generic. Specifically, the Court ruled the mark BOOKING.COM to be non-generic and eligible for registration. Neither party in the case disputed that "booking" is generic for the hotel reservation services that were associated with the mark. A consumer survey provided by Booking.com demonstrated that consumers do not perceive booking.com as a class of services. While the USPTO argued in favor of a *per se* rule that any pairing of a generic word with a ".com" is generic, or said differently, that pairing ".com" with a generic word should not make the combination non-generic and therefore registerable. Ultimately, the Supreme Court found that "booking.com" is not a generic term because, as shown in the lower court record, consumers do not perceive the term to mean a class of online hotel-reservation services. The Court reasoned that whether "booking.com" is generic depends on whether the term as a whole signifies the class of online hotel-reservation services to consumers, which the Court noted might be the case if a consumer looking for these services would ask a frequent traveler to name her favorite booking.com provider, which is not how consumers think of the site. As such, the Court indicated the record shows that consumers do not perceive the term "booking.com" to so signify a class of online hotel-reservation services and therefore not *per se* generic – leaving open the possibility that a mark could acquire sufficient distinctiveness to be registerable.

The new USPTO Guide indicates that while under *Booking.com* generic .com marks are neither *per se* generic nor *per se* non-generic, they are likely to be at least highly descriptive. When a mark is deemed highly descriptive, that classification increases the burden on an applicant trying to support a claim that the proposed mark has acquired distinctiveness under section 2(f) of the trademark statute (15 U.S.C. § 1052(f)).

The Guide further reiterates the Supreme Court's warning in *Booking.com* that any consumer surveys submitted to support a 2(f) claim for a proposed generic.com mark must be properly designed and interpreted to ensure they accurately and reliably represent consumer perception of a proposed mark.

Further, the Guide indicates this new recognition that registered generic.com marks may merit a narrow scope of protection. This narrow scope can be taken into account by examiners when considering whether to cite an existing generic.com mark against a proposed mark with the same terms.

The *Booking.com* case has now been transformed into USPTO examination procedure for analyzing whether a generic term combined with a gTLD to result in a mark that has acquired sufficient distinctiveness to be registerable. In light of this decision and Guide, applicants should now consider whether existing long-time marks making use of domain names might be registerable under this new guidance. In addition, when creating new marks and securing protection for those marks, additional consideration should now be given as to whether variations of the mark including the gTLD might possibly be protected with additional trademark registrations.

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