

To Register a “Generic.com” Term, Show that Consumers Perceive It As Not Generic

Minding Your Business Blog on December 2, 2020

The U.S. Patent and Trademark Office has issued [guidance](#) on how it will treat applications to register “generic.com” terms in the wake of the Supreme Court’s June 30, 2020 decision in [United States Patent and Trademark Office v. Booking.com](#).

We [previously wrote](#) about the Supreme Court’s *Booking.com* decision, which affirmed the Fourth Circuit’s decision that the mark BOOKING.COM was registrable and not generic. The Supreme Court’s decision tracked the arguments in an [amicus brief](#) we submitted on behalf of consumer perception specialists and academics from leading U.S. universities.

The *Booking.com* decision held that a proposed “generic.com” trademark—which consists of a generic term plus a generic top-level domain (or gTLD) such as “.com”—is neither automatically generic (and therefore not registrable) nor automatically registrable. Therefore, as the USPTO guidance now confirms, the USPTO must evaluate all of the available evidence to determine whether consumers would perceive a proposed generic.com mark as (1) the generic name of a class of goods and/or services (in which case it would not be registrable) or (2) capable of serving as a source indicator (in which case the proposed mark may be registrable).

The USPTO guidance explains that a term is generic and not registrable if “the relevant consumers would understand the primary significance of the term, as a whole, to be the name of the class or category of the goods and/or services identified in the application.” In that case, the USPTO will refuse registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), and provide relevant supporting evidence. A generic.com mark may also be refused registration if the specimen of use shows the generic.com term being used solely as a website address and not in a trademark or service mark manner.

An applicant may overcome a Section 2(e)(1) refusal by showing the generic.com term has acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f). The USPTO notes that a “significant amount of actual evidence” that the “generic.com” term has acquired distinctiveness will typically be needed, because by its nature, a generic.com term is highly descriptive and consumers may be less likely to believe it indicates a specific source. Although in other contexts, acquired distinctiveness may be shown by a verified statement that the applicant has used the mark substantially exclusively and continuously in commerce for five years, such evidence would not be sufficient for a generic.com term, according to the USPTO guidance. Evidence of acquired distinctiveness may include consumer surveys; consumer declarations; other evidence of the duration, extent, nature, and exclusivity of the applicant’s use; advertising expenditures; statements from the trade or public, and other types of evidence.

The USPTO noted with respect to consumer surveys in particular that any such survey must be properly designed and interpreted (likely by a survey expert) to ensure it is an accurate and reliable representation of consumer perception of the proposed mark. A detailed survey report should be provided to the USPTO. In the *Booking.com* case, the applicant successfully showed that BOOKING.COM was not generic by, among other things, submitting the results of a survey showing that consumers perceive BOOKING.COM as a brand, not as a generic class of hotel-reservation services. If, however, the available evidence suggests a “generic.com” term is capable of indicating source, but is insufficient to show the term has acquired distinctiveness, registration of the term on the Supplemental Register (rather than the Principal Register) may be allowed.

The USPTO’s guidance applies to any proposed mark consisting of a combination of a generic term and a generic TLD such as .com, .net, .org, .biz, or .info.

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