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Booking.com SCOTUS victory raises survey status

This week's US Supreme Court decision that Booking.com is not generic might lead to a larger use of consumer surveys



By [Rani Mehta](#)

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With the US Supreme Court ruling that generic terms tied to top-level domain names are eligible for trademark registration, a debate about the best way to approach consumer surveys could soon kick off, lawyers say.

Eight SCOTUS justices ruled in Booking.com's favour and against the USPTO's assertion that a dot com term could not be federally registered as a trademark, in [USPTO v Booking.com](#) on June 30.

John Strand, shareholder at Wolf Greenfield & Sacks in Boston, says the case will probably lead to a larger use of consumer surveys in cases on genericness.

“The case will reinforce how important consumer surveys are when you’re looking at whether a mark is generic or not. Surveys are probably one of the better ways to figure out how consumers view a particular mark.”

In Justice Ruth Bader Ginsburg’s majority opinion, she noted that consumers did not perceive Booking.com in a generic way. “Because ‘Booking.com’ is not a generic name to consumers, it is not generic,” she wrote. Only Justice Stephen Breyer dissented from the ruling.

David Bernstein, Debevoise & Plimpton partner in New York City, who filed the Booking.com brief as co-counsel, says the court’s focus on what the name meant to consumers was one of the key takeaways of the ruling.

“What we’ve learned from the Supreme Court is that consumer perception is the most important thing when it comes to protecting trademarks. And that’s something we’ve known for a long time. Trademarks are all about protecting consumers,” he says.

Lawyers add that the ruling could motivate more domain name owners to file for protection, but that its effects will be more limited for other brands, especially in the fashion industry.

Scrutinising surveys

Strand at Wolf Greenfield notes that Justice Breyer questioned whether consumer surveys really show how consumers view products.

In Breyer’s dissent, he said surveys are supposed to show whether consumers associate a term with a single source. But he argued that a generic term can achieve the same association if its producer experiences a period of exclusivity in the market or invests heavily in advertising.

Breyer pointed out that one survey showed that 75% of respondents believed Booking.com was a brand name and 33% respondents in the same survey incorrectly thought Washingmachine.com was one too.

He said that if someone started a company called Washingmachine.com and invested heavily in advertising, the company could achieve a similar level of consumer identification.

Strand says district courts will scrutinise surveys to see if consumers view a name as a trademark or if they only think the name is a brand because it has a dot com at the end. “That’s something that a lot of survey artists will be debating over the next couple years,” he says.

Open questions

Daniel Frohling, partner at Loeb & Loeb in Chicago, says that because the court limited its decision to a narrow issue, it left open the question of how evidence of a mark's significance will be analysed.

“There will be disputes about how courts evaluate the survey evidence and the extent to which the survey evidence really reflects the primary meaning of the term,” he says.

Although 33% of respondents falsely recognised Washingmachine.com as a brand, when this chunk was removed, 64% still recognised Booking.com as a trademark. Therefore, the booking company's attorneys were still able to use the survey to argue that the mark had acquired actual recognition with consumers.

The effect of the case on surveys might not be limited to matters of genericness.

Ted Davis, partner at Kilpatrick Townsend in Atlanta, says courts may be more receptive to survey evidence about descriptive marks that have acquired secondary meaning and be more open to survey evidence in instances of infringement.

He adds that it's unlikely the Supreme Court's opinion in this case will change the rules governing how surveys must be conducted. He notes that there are already general rules on how to conduct surveys that will be admissible in court, and most of these rules are well established.

Bernstein at Debevoise says the decision will remind people that surveys are among the key pieces of evidence that a court can consider. But he says the court's decision makes it clear that there is other evidence that's important, such as how terms are used in the dictionary and how consumers and competitors use them.

In the short term, this decision could motivate more companies to try to register generic names paired with top-level domains. Strand at Wolf Greenfield notes that there are other companies that are dot com brands.

“I have a feeling they're going to be more active in pursuing registration,” Strand says.

Bucking the trend

But while trademark protection may be available for more dot com brands, not every company will want to follow in Booking.com's footsteps.

Alan Behr, partner at law firm Phillips Nizer in New York City, points out that [in the oral arguments](#) the attorney for Booking.com said marks like the brand are relatively weak.

Booking.com attorney Lisa Blatt, partner at Williams & Connolly in Washington DC, used this to argue that a trademark registration for Booking.com would not give the company a monopoly on the term 'booking.'

Weak marks in the fashion industry aren't a good idea, Behr says.

He notes that someone could theoretically register a domain name like menssocks.com and have a basis for protection. But he says this would still be a weak basis because someone else could register menssocks.info.

"Then you get into a lawsuit involving survey evidence and experts about whether that's confusingly similar or not."

Because of this, companies in fashion should be wary of picking a generic name, even if a marketing person really loves it, Behr says.

"When in doubt in fashion, go for a strong mark. It will pay itself back many times over in benefits. The fact that the court had concurring and dissenting opinions shows that when you have a mark that's just over the line, like Booking.com, you're going to have questions."

Most brand owners would undoubtedly prefer not to have to argue in front of the Supreme Court to get a trademark registration in the first place. But those that do have to fight for their marks would be wise to take advantage of any evidence, including consumer surveys, that's available to them.

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