

No. 19-46

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IN THE  
**Supreme Court of the United States**

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UNITED STATES PATENT AND  
TRADEMARK OFFICE, *et al.*,

*Petitioners,*

*v.*

BOOKING.COM B.V.,

*Respondent.*

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ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE FOURTH CIRCUIT

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**BRIEF FOR *AMICI CURIAE* BOSTON  
PATENT LAW ASSOCIATION IN SUPPORT  
OF RESPONDENT**

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**INTEREST OF THE *AMICUS CURIAE*<sup>1</sup>**

Founded in 1924, the Boston Patent Law Association (“BPLA”) is one of the oldest intellectual property law associations in the country. The BPLA sponsors educational programs and forums for its nearly 1,000 members on topics such as patents, trademarks, copyrights, and licensing, among others. BPLA members—attorneys, scholars, licensing executives, and other professionals—serve a broad range of clients in numerous industries that create and rely on intellectual property in both the brick-and-mortar world *and* in the virtual world of websites and social media. BPLA members are on the front lines of trademark practice: they represent their clients in trademark prosecution in the United States Patent and Trademark Office (USPTO), in trademark licensing and portfolio development, and in trademark disputes in federal courts and other venues. The BPLA has thus gained valuable insights on both trademark law and practice and also on how trademarks work in the business world.

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1. The BPLA has no financial interest in any party or in the outcome of this case. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amici curiae*, its members, or its counsel made a monetary contribution to its preparation or submission. The parties have consented to the filing of this brief. This brief is submitted solely on behalf of the BPLA as its consensus view. The stated arguments and positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member. All work to prepare and submit this brief were provided on a *pro bono* basis by McCarter & English, LLP.

Over the years, the BPLA has prepared and filed a number of *amicus* briefs in this Court and other courts. For example, the BPLA recently submitted *amicus* briefs to this Court in *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.* (2019) and *Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC* (2018). The BPLA submits *amicus* briefs and otherwise works to educate the public on intellectual property law because, over nearly 100 years of existence, it has seen first-hand that strong intellectual property rights benefit the American economy and society generally. Indeed, in those periods in which—due to inconsistent enforcement or political trends—intellectual property rights were weakened, innovation and economic growth stalled and even declined. Thus, the BPLA has a substantial interest in seeing that intellectual property law—in this case, trademark law—develops in a clear, predictable, and consistent way so as to promote commerce, fair competition, and the public good.

## **INTRODUCTION AND SUMMARY OF ARGUMENT**

Trademarks are perhaps the most commercial of the intellectual property rights. Unlike patents and copyrights, which encourage and protect innovation and originality regardless of commercialization, trademark rights vest only after the marks are first used in connection with the sale of goods or services. Also unlike patents and copyrights, trademark rights become stronger as the trademarked goods or services become more successful and thus more appreciated by consumers. As such, the strength of a trademark, and indeed whether a term or symbol even qualifies for trademark protection, depends not just on the labors of the manufacturer or merchant but also on how consumers perceive the trademark.

In keeping with the commercial nature of trademarks, the main function of trademark law is to prevent consumer confusion in the marketplace and thus to enable consumers to associate a particular good or service with a single source. Trademark law promotes fair competition while preventing deception, counterfeiting, and other unfair business practices. All along, trademark law focuses on the consumer's perception of the trademark. Consumer perception is a significant focus of numerous inquiries in trademark law, including, for example, likelihood of confusion, secondary meaning, and genericness.

In practice before any tribunal, trademark lawyers (such as members of the BPLA) rely on a range of evidence to establish the consumer's perception of a trademark, including, for example, witness testimony, business records, press clippings, advertisements, and consumer surveys. Consumer surveys are increasingly the most well-regarded form of evidence because they most directly measure overall consumer sentiment.

That is what is wrong with the position of the USPTO and its *amicus* supporters—it fails to give proper credit to survey evidence showing that consumers overwhelmingly perceive BOOKING.COM to be a brand rather than a generic term. The USPTO, or any tribunal for that matter, should not be permitted to decide an issue merely by pointing to a dictionary definition while ignoring more direct and more relevant evidence.

Moreover, the USPTO and its *amicus* supporters are asking the wrong questions. The question is not whether “Booking” is, by itself, a generic term. The question is not whether “.com” is, by itself, a generic term. Nor is the question whether adding “.com” to an otherwise generic



term makes the combined term a source indicator (*i.e.*, a trademark). Rather, the question is, and should be, whether consumers regard the combination *as a whole* to be a source indicator.

Accordingly, the BPLA will discuss two points in this brief. First, consumer perception is the *sine qua non* of trademark law. Whether considering genericness, secondary meaning, likelihood of confusion, or any other trademark inquiry, consumer perception rightly focuses on the mark as a whole, not on its constituent parts considered separately. Consumer surveys, such as so-called *Teflon* and *Thermos* surveys that ask whether or not a term is generic, are important factors in the analysis and cannot be ignored. Consumer surveys have a long history of use in trademark cases and are often considered material and highly persuasive evidence. In short, in deciding whether a term like BOOKING.COM is generic or not, all available evidence should be considered and, in the hierarchy of evidence, consumer surveys and other direct evidence of consumer perception should be given more weight than dictionaries and other second-hand evidence.

Second, contrary to the apparent position of the Electronic Frontier Foundation (EFF), strong trademark rights, including in particular trademark registrations, are vital to preventing consumer confusion and fraud on the Internet. While the EFF points to the Domain Name System (DNS) as somehow providing a means for online businesses to distinguish themselves from infringers, that is not how things actually work. There are many tricks that unscrupulous bad actors can use to divert customers from legitimate online businesses, such as through cybersquatting, spoofing, phishing, and other means of

mimicking the domain names of others. In practice, a domain name owner still needs superior trademark rights to protect itself and to prevent harm to consumers.

## ARGUMENT

### I. THE FOCUS OF TRADEMARK LAW IS CONSUMER PERCEPTION

As prefaced above, the main function of trademark law is to prevent consumer confusion and thus to enable consumers to associate a particular good or service with a single source, even if that source is unknown or distant. *See* 15 U.S.C. § 1127; *see also Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (“[T]rademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s costs of shopping and making purchasing decisions’ . . . for it quickly and easily assures a potential customer that this item . . . is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.”) (internal citation omitted); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 783 (1992) (one purpose of trademark law “is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get”) (citation omitted); *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 121 (1938) (competitor’s obligation “is not to insure that every purchaser will know the maker but to use every reasonable means to prevent confusion”); Anne M. McCarthy, *The Post-Sale Confusion Doctrine: Why the General Public Should Be Included in the Likelihood of Confusion Inquiry*, 67 *Fordham L. Rev.* 3337, 3340 (1999) (main goal of trademark law is to prevent consumer confusion).

Trademark law promotes fair competition while preventing deception, counterfeiting, and other unfair business practices. *See, e.g., Two Pesos*, 505 U.S. at 767–68 (“The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition’”) (citing 15 U.S.C. § 1127); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (“National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation”) (citation omitted).

Because trademark law seeks to prevent consumer confusion, it is natural that the focus of trademark law be on consumer perception. *Kellogg*, 305 U.S. at 121; 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:83.50 (5th ed. 2019) (weighing evidence of consumer perception is a key element in commercial strength of a mark); Michael S. Mireles, Jr., *Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law*, 44 Ind. L. Rev. 427, 455 (2011) (“legal protection for trademark law is based upon consumer perception”). How a mark is perceived by the relevant consuming public helps determine issues such as likelihood of confusion, secondary meaning, tacking, and even genericness. *See, e.g., Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 421 (2015) (test for tacking relies on the commercial impression that two marks make on the ordinary consumer); *Qualitex*, 514 U.S. at 163 (“over time, customers may come to treat a particular color on a product or its packaging . . . as signifying a brand”); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) (“To establish secondary meaning, a

manufacturer must show that, *in the minds of the public*, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”) (emphasis added); *Kellogg*, 305 U.S. at 119 (a mark is not generic if “the primary significance of the term *in the minds of the consuming public* is not the product but the producer”) (emphasis added).

As argued below, the consumer’s perception of a mark (also known as “commercial impression”) depends on the mark as a whole, not on its constituent pieces considered separately. Consumer surveys are often the best evidence of commercial impression. That is no less the case when deciding whether a term or symbol is generic.

#### **A. The Commercial Impression of a Mark Depends on the Mark as a Whole**

“The commercial impression of a trade-mark is derived from its whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety.” *Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920). For composite marks like BOOKING.COM, the so-called “anti-dissection rule” is indispensable because “the whole [of a composite mark] may be greater than the sum of its parts.” *In re Am. Fertility Soc.*, 188 F.3d 1341, 1348 (Fed. Cir. 1999); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 968 (Fed. Cir. 2015) (“Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark”). Even the EFTF concedes that an applicant may try to prove that a “combination is greater than the

sum of its parts and primarily signifies the source of its goods or services to consumers.” EFF.Br. at 18.

Determining the commercial impression of a mark is important at every stage of a trademark’s life cycle. Thus, the anti-dissection rule applies not only to evaluate whether a mark is protectable, such as in a genericness or a descriptiveness inquiry, but also as part of the confusion analysis. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345–46 (Fed. Cir. 2001) (requiring the USPTO to weigh the entire commercial impression of a mark when assessing whether to register a mark); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423 (6th Cir. 1999) (endorsing the anti-dissection rule, “which serves to remind courts not to focus only on the prominent features of the mark, or only on those features that are prominent for purposes of the litigation, but on the mark in its totality”). The USPTO itself has long applied the anti-dissection rule when examining trademarks. Thus, the USPTO’s sudden and unexplained departure from its long-time rule will upset expectations of trademark creators and practitioners.

### **1. The Proposed *Per Se* Rule Violates USPTO Procedures**

The USPTO’s “Trademark Manual of Examining Procedure (TMEP) is a reference work that sets forth the practices and procedures that are followed in connection with the prosecution of applications to register marks at the [USPTO].” 67 Fed. Reg. 18176 (Apr. 15, 2002). “[TMEP] contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys

are required or authorized to follow in the examination of trademark applications.” TMEP at Foreword (Oct. 2018 ed.). Examining attorneys, brand owners, and trademark practitioners rely on TMEP for guidance in determining whether a proposed “word, name, symbol, or device, or any combination thereof” constitutes a trademark. 15 U.S.C. § 1127.

Since at least as early as the Fourth Edition of the TMEP published in April 2005—and thus for at least the last 15 years, well before Booking.com sought to register its marks—the USPTO has acknowledged the importance of evaluating the overall commercial impression of a domain name to determine whether it is protectable as a trademark. *See* TMEP §§ 1209.03(m), 1215.05 (4th ed. Apr. 2005) (“When examining domain name marks, it is important to evaluate the commercial impression as a whole, including the TLD indicator.”). In undertaking this evaluation, the USPTO requires examining attorneys to consider both whether “the gTLD may be capable of source-indicating significance, and whether the composite mark conveys any distinctive source-identifying impression apart from its individual components.” TMEP § 1209.03(m) (Oct. 2018 ed.).

While TMEP instructs examining attorneys to evaluate evidence for the individual elements of a proposed domain name mark, it also compels them to consider the significance of the proposed mark as a whole “to determine whether the addition of a gTLD has resulted in a mark that conveys a source-identifying impression.” *Id.* at § 1209.03(m); *see also In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363–64 (Fed. Cir. 2009) (the USPTO first considered each component of MATTRESS.COM, namely,

the words “mattress” and “.com,” and determined that they were both generic and then considered the mark as a whole and determined that the combination added no new meaning).

Under the USPTO’s proposed *per se* rule, however, only the separate components of a GENERIC.COM mark—namely, the generic top level domain (*e.g.*, .COM) and the generic second level domain (here, “GENERIC”)—would need to be assessed. If both components of the composite mark are found to be generic, the inquiry ends, and the composite mark is ruled to be generic without considering the mark as a whole. This *per se* rule violates the anti-dissection rule, the USPTO’s long-standing practice, and the expectations of brand owners and trademark practitioners.

## **2. Adopting the USPTO’s Proposed *Per Se* Rule Will Lead to the Absurd Conclusion that Trademark Examiners Have Mistakenly Registered Scores of GENERIC.COM Marks**

TMEP has informed examining attorneys, brand owners, and practitioners for at least the last 15 years that “there is no *per se* rule that the addition of a non-source-identifying gTLD to an otherwise generic term can never under any circumstances operate to create a registrable mark.” TMEP § 1215.05 (Oct. 2018 ed.) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005)) (internal citations omitted); *see also, e.g.*, TMEP § 1215.05 (Sept. 2007, 5th ed.) (same); TMEP § 1215.05 (Apr. 2005, 4th ed.) (stating there is no *per se* rule that “[t]he addition of a TLD . . . to an otherwise unregistrable mark

does not add any source-identifying significance”). Indeed, the USPTO has registered numerous GENERIC.COM marks over the years (*see* Res.App. at 1a–11a) and has even recently approved an application for SYNTHESIZERS.COM (Serial No. 88344065) covering “Musical instrument digital interface (MIDI) master computer keyboards” (*i.e.*, synthesizers).

The USPTO’s proposed *per se* rule is a reversal of longstanding USPTO procedure. With the adoption of a *per se* rule, the USPTO would also have the Court ignore the long-established case law and rules that guide the USPTO’s trademark examining attorneys in their examination of potential trademarks. Because case law and long-standing USPTO procedures directly conflict with the proposed *per se* rule, this Court should reject it.

#### **B. Consumer Surveys Are Often the Best Evidence of Consumer Perception**

Consumer surveys have long been used in trademark matters to establish consumer perception of trademarks. These surveys have been used to aid the likelihood of confusion, secondary meaning, and tacking analyses, among others. *Exxon Corp. v. Texas Motor Exch. of Houston, Inc.*, 628 F.2d 500, 506 (5th Cir. 1980) (giving “substantial weight” to plaintiff’s survey in determining likelihood of confusion); *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1262 (9th Cir. 2001) (considering survey evidence in secondary meaning analysis); *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013) (noting that “commercial impression” is integral to tacking analysis and “should be resolved by considering . . . consumer survey evidence”), *aff’d*, 574 U.S.



418 (2015). Consumer surveys have become so important that courts have rejected the position of litigants for failing to submit survey evidence. *See, e.g., Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991) (holding that mark's challenger failed to meet its burden of proving that term was generic because challenger "supplied no survey evidence of consumer understanding"); *ZP No. 314, LLC v. ILM Capital, LLC*, 335 F. Supp. 3d 1242, 1259 (S.D. Ala. 2018) (marks lacked secondary meaning because the plaintiff "presented no survey evidence" to show consumers' perception).

Consumer surveys are widely used to learn more about consumer perceptions not just in the legal context but in the broader business world. *See generally* Nick Wreden, *Using Surveys to Get the Information Your Business Needs*, 5 Harvard Mgmt. Comm'n Letter No. 10, October 2002, <https://hbswk.hbs.edu/archive/using-surveys-to-get-the-information-your-business-needs-survey-says-identify-your-objectives>; Keith D. Klein & R. Andrew Chereck, *Surveys: Business Tools and Valuable, But Often Overlooked, Evidence*, *The Franchise Lawyer* Vol. 16 No. 4, Fall 2013. Surveys allow businesses to learn and understand more about consumers than other data does. Indeed, surveys allow the inquirer to gain invaluable insight that cannot otherwise be uncovered from other evidence. Stephen Hurley, *The Use of Surveys in Merger and Competition Analysis*, 7 *J. Comp. L. & Econ.* 45, 46 (2010) ("The importance of surveys is due to the fact that, in the absence of sufficient recent data from the parties, surveys can be commissioned to get a better understanding about how the market . . . works"). As discussed in the next section, the importance of survey

evidence is no less true when it comes to the genericness inquiry.<sup>2</sup>

### C. Consumer Surveys Help Determine Whether a Term is Generic or Not

“A generic term is one that refers to the genus of which the particular product is a species.” *Park ‘N Fly*, 469 U.S. at 195. Courts use the primary significance test, codified in the Lanham Act, to determine whether a term is generic. 15 U.S.C. § 1064(3); *Genessee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997) (stating “[t]he primary significance test is the law of the land”). A term is not generic when “the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Kellogg Co.*, 305 U.S. at 118. “The critical issue in genericness cases is whether members of the relevant public primarily . . . understand the term sought to be protected to refer to the genus of goods or services in question.” *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1367 (Fed. Cir. 2018) (citations omitted). “An inquiry into the public’s understanding of a

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2. Once very expensive, surveys are becoming cheaper, faster, and more accurate. In the pre-Internet days, survey experts would conduct “mall intercept” surveys by standing in a shopping mall or other public place and asking shoppers to fill out a survey on paper. That method was laborious. Now, surveys are typically conducted over the Internet and can reach a larger or more targeted audience, saving time and money in the process. Gabriel M. Gelb *et al.*, *Internet Surveys For Trademark Litigation: Ready or Not, Here They Come*, 97 Trademark Reporter 1073, 1082 (2007) (Internet surveys are “faster and cheaper than [] traditional mall or telephone counterparts. Since results are digitalized . . . it is not unusual for survey results to be known two or three days” after survey launches).

mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark,” *Steelbuilding.com*, 415 F.3d at 1297; *see also Beckwith*, 252 U.S. at 545–46.

Both direct and indirect evidence can be used to determine the primary significance of a term to consumers. *See Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996) (listing “purchaser testimony, consumer surveys, listings and dictionaries[,] . . . newspapers, and other publications” as evidence to show primary significance”) (citations omitted). But direct evidence of consumers’ understanding of a term, such as consumer surveys, are a “preferred method of proving genericness.” *Princeton Vanguard*, 786 F.3d at 969; *see also Berner Int’l Corp. v. Mars Sales, Co.*, 987 F.2d 975, 982–83 (3d Cir. 1993) (“Consumer surveys have become almost de rigueur in litigation over genericness. Judges are now used to survey evidence and often expect to receive evidentiary assistance by surveys in resolving generic disputes”) (citations omitted); *cf. Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1148 (9th Cir. 1999) (explaining that dictionary definitions—which are indirect evidence—may be considered but are “not determinative” of “how a term is understood by the consuming public”).

Consumer surveys have become so important in genericness cases that courts have criticized parties that fail to present consumer survey evidence. *See, e.g. Gimix, Inc. v. JS&A Grp., Inc.*, No. 80 C 6592, 1982 WL 52164, at \*1 (N.D. Ill. Jan. 13, 1982) (“Neither side in this case has produced any consumer surveys . . . Both sides are at fault for such laxness.”), *aff’d sub nom. Gimix, Inc. v. JS & A Grp., Inc.*, 699 F.2d 901 (7th Cir. 1983); *Nat’l Fed’n of*

*the Blind, Inc. v. Loompanics Enters. Inc.*, 936 F. Supp. 1232, 1247–48 (D. Md. 1996) (holding that challenger failed to prove that mark was generic where challenger only “cite[d] dictionary definitions” and produced “no surveys”); *Triple-I Corp. v. Hudson Assocs. Consulting, Inc.*, 713 F. Supp. 2d 1267, 1285 (D. Kan. 2010) (finding a mark generic where “[t]he Court has not been provided with any survey evidence . . . that consumers . . . associate this mark with a particular source”); *Zurco, Inc. v. Sloan Valve Co.*, 785 F. Supp. 2d 476, 489 (W.D. Pa. 2011) (refusing to grant summary judgment on issue of genericness and criticizing moving party for its “fail[ure] to provide any direct consumer evidence, whether by testimony or survey”).

The preferred models of genericness surveys are known as the “*Teflon* survey” and the “*Thermos* survey.”<sup>3</sup> The *Teflon* format, which Booking.com submitted to the District Court, has become the more used and accepted method for analyzing a genericness question.<sup>4</sup> See E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 Trademark Reporter

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3. A *Thermos* survey “puts the respondent in an imaginary situation . . . and asks how the respondent would ask for the type of good for which the trademark is alleged to be generic.” *Elliot v. Google, Inc.*, 860 F.3d 1151, 1160 (9th Cir. 2017) (internal citation omitted).

4. Courts have admitted and considered *Thermos* surveys since at least 1962. See *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 21 (D. Conn. 1962) (considering “*Thermos*” survey evidence to determine whether term “*Thermos*” had become generic), *aff’d sub nom., King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963); *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 197 (3d Cir. 2008) (considering *Thermos* survey and noting survey created a question of fact as to genericness).

1118, 1131 (2009) (“*Teflon* surveys have been the preferred format for genericness surveys, as reflected by U.S. court opinions and U.S. Trademark Trial and Appeal Board decisions in which they have been approved.”); *see also Hershey Co. v. Promotion in Motion, Inc.*, No. 07-1601, 2011 WL 5508481, at \*4 (D.N.J. Nov. 7, 2011) (finding that “the *Teflon* surveys in this matter were validly conducted” and “provided strong probative evidence of consumer perception”); *March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 809 (N.D. Tex. 2003) (considering *Teflon* survey to determine genericness), *aff’d*, 120 Fed. Appx. 540 (5th Cir. 2005); *Invisible Fence, Inc. v. Fido’s Fence, Inc.*, No. 3:09-CV-25, 2013 WL 6191634, at \*3 (E.D. Tenn. Nov. 26, 2013) (denying motion to exclude *Teflon* survey); *Timelines, Inc. v. Facebook, Inc.*, 938 F. Supp. 2d 781, 791–92 (N.D. Ill. 2013) (considering *Teflon* survey that showed 69% of consumers viewed term as generic); *Intel Corp. v. Advanced Micro Devices, Inc.*, 756 F. Supp. 1292, 1297 (N.D. Cal. 1991) (noting that *Teflon* survey was “an important piece of evidence” the court used in finding term was generic).

A *Teflon* survey focuses on whether a name is a common name (*i.e.*, generic) or a brand name (*i.e.*, a trademark). A *Teflon* survey first educates participants on the distinction between a brand name and a common name. Then it shows participants numerous terms—including the term at issue—and asks “whether they are common names or brand names.” *E.T. Browne*, 538 F.3d at 195 (describing a *Teflon* survey as “essentially a mini-course in the generic versus trademark distinction, followed by a test.”) (internal citation omitted); *see generally E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975). Consumers’ responses are used

to prove that “the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Kellogg*, 305 U.S. at 118. Booking.com’s *Teflon* survey is the only direct evidence of consumer perception of the BOOKING.COM mark that either side submitted in this case.

A consumer survey is thus a critical piece of evidence in deciphering the primary significance of a proposed trademark in the minds of the consuming public. If the Court were to adopt the USPTO’s proposed *per se* rule, then consumer survey evidence, and all other direct evidence of consumers’ perception of a proposed mark for that matter, will be eliminated from the genericness inquiry.

The USPTO now argues that Booking.com’s *Teflon* survey should not be considered in determining whether BOOKING.COM is generic. Pet.Br. at 36. The USPTO relies on its assertion that the relevant consuming public would perceive BOOKING.COM to be generic based only on indirect evidence, while arguing that the only direct evidence of consumers’ perception of BOOKING.COM (*i.e.*, the survey) can safely be ignored. *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 896 (E.D. Va. 2017). The USPTO thus improperly replaces the consumers’ perspective with its own perspective, even though the question of whether a mark is generic depends entirely on consumer perception. 15 U.S.C. § 1064(3) (genericness depends on “[t]he primary significance . . . to the relevant public”); *Royal Crown Co.*, 892 F.3d at 1367. The USPTO’s attempt to circumvent the primary significance test by introducing a *per se* rule that effectively removes consumer perception from the genericness evaluation should not be tolerated by this Court.

## II. STRONG TRADEMARK RIGHTS ARE VITAL TO PREVENTING UNFAIR COMPETITION ON THE INTERNET

Strong trademark rights are needed to prevent consumer confusion on the Internet and thus to keep the Internet safe for commerce. The BPLA made this same point about ten years ago in an *amicus* brief submitted to the Massachusetts Appeals Court:

The BPLA views this case as one about maintaining the usability of the Internet. The law does not, and should not, allow a third party to use the goodwill earned by another to divert consumers, either directly or indirectly, to its website. . . . The Superior Court's ruling, however, threatens orderly use of the Internet by allowing or encouraging parties to hijack trademarks to trick Internet users into visiting their sites. . . .

If parties are allowed to litter search results with links and advertisements that purport to be affiliated with a well-known brand in a confusingly similar fashion, the usability of the Internet would be significantly impaired and the value of the intellectual property associated with that goodwill would be significantly reduced.

*Amicus Curiae* Brief of Boston Patent Law Ass'n, at 2–4, in *Jenzabar, Inc. v. Long Bow Group, Inc.*, 977 N.E.2d 75 (Mass. App. Ct. 2011), available at <https://www.bpla.org/page/7>.



As argued below, the world has changed since the *Goodyear* case of 1888. Today, this Court and the USPTO apply the “primary significance” test to analyze genericness. A better analogy would be to the cases in which mnemonic phone numbers were not treated as generic. Finally, contrary to the EFF’s position, the Domain Name System by itself does little to prevent confusion and unfair competition on the Internet. Trademark rights, particularly trademark registrations, are crucial to proper Internet policing via popular dispute-resolution procedures like the UDRP. Even the EFF has relied on its trademark to prevent confusion on the Internet.

#### **A. Evolution of Marketing: From Paper to Cyberspace**

The *Goodyear* case was litigated in the 1880s, and its application to today’s online shopping experience is tenuous at best. Blind application of *Goodyear* ignores the more modern “primary significance” test for trademarks, articulated 50 years later in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938), and codified in the Lanham Act at 15 U.S.C. § 1064(3). Applying the holding of that antiquated case on a *per se* basis ignores the reality that consumers have become used to identifying the source of goods or services through their website domain names. Consumer marketing and advertising have evolved since 1880 from pamphlets, print advertisements, and mail order catalogs, to radio and television, and now to online advertising. In the decades before the commercial Internet, specific sources of goods and services were identified through the use of vanity phone numbers consisting of generic terms. The GENERIC.COM domain names are simply the next evolutionary phase. There are



many good reasons to permit the extension of trademark rights to those GENERIC.COM domain names that meet the same standards as the vanity phone numbers, and, as discussed below, there is an existing expedited process to protect consumers from bad actors.

### **B. Mnemonic Telephone Numbers Set the Stage**

As the District Court noted, “it is helpful to consider the Federal Circuit’s reasoning in a case involving telephone numbers as marks.” *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 909 (E.D. Va. 2017) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001)). Mnemonic telephone numbers use letters corresponding to the numbers on a telephone dial to allow a caller to reach a specific entity. These vanity numbers are analogous to domain names in that the area code prefix is analogous to the gTLD suffix used in a domain name (e.g., .com, .net, .org). The many examples of such phone numbers include 1-800-FLOWERS, which was registered as a trademark in 1975. *See* Res.App. at 13a–16a.

The 2001 Federal Circuit case is discussed at some length by the parties and other *amici*. Less noted is that it was preceded by *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675 (2d Cir. 1989). At the time, Dial-A-Mattress could be reached by consumers calling numbers corresponding to various local area codes + MATTRES (628-8737), all advertised with the slogan “DIAL-A-MATTRESS and drop the last ‘S’ for savings.” *Id* at 676. When the defendant obtained the 800 number and advertised 800-MATTRESS, customers were diverted. The Second Circuit articulated the basic principle about trademark rights in purportedly “generic” vanity phone

numbers. To the Second Circuit, avoiding customer confusion was key:

Dial-A-Mattress is not seeking protection against a competitor's use of the word 'mattress' solely to identify the competitor's name or product. What the plaintiff seeks is protection against a competitor's use of a confusingly similar telephone number and a confusingly similar means of identifying that number . . .

Plaintiff does not lose the right to protection against defendant's use of a confusingly similar number and a confusingly similar set of letters that correlate with that number on the telephone dial just because the letters spell a generic term. The principles limiting protection for the use of generic terms serve to prevent a marketer from appropriating for its exclusive use words that must remain available to competitors to inform their customers as to the nature of the competitor's business or product. These principles do not require that a competitor remain free to confuse the public with a telephone number or the letters identifying that number that are deceptively similar to those of a first user.

*Id.* at 678.

Any argument that domain names should not be registerable because they are functional is belied by the decades-long history of USPTO registrations of telephone numbers and the cases on enforcement of those rights

by courts. *See* Res.App. at 13a–16a. Vanity telephone numbers act just like modern domain names in pointing a consumer to a specific source of goods or services. Yet, “to support a refusal of registration on the ground that a telephone number is generic, . . . it is not enough to show that the telephone number consists of a non-source-indicating area code and a generic term. The examining attorney must show evidence of the meaning the relevant purchasing public accords the proposed alphanumeric mark as a whole.” TMEP § 1209.03(l) (Oct. 2018 ed.). In 2020, the only real difference between these types of marks is which of the many features of a smartphone the consumer uses to reach the source of the goods or services.

### **C. Trademark Registrations Are Important to Prevent Confusion and Thus Maintain the Usability of the Internet**

The USPTO and several *amici*, including the EFF and Trademark Scholars, raise the possibility that trademark owners may overreach by sending meritless cease-and-desist letters. But as the USPTO itself recognized, sending such letters before filing suit reduces the burden on the judicial system and encourages settlement of valid claims. *See* USPTO, *Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting*, <https://www.uspto.gov/sites/default/files/trademarks/notices/TrademarkLitigationStudy.pdf> (visited Feb. 17, 2020). Many such letters are polite, professional, and meritorious. Indeed, one authored in 2012 by in-house counsel for the JACK DANIEL’S brand (now the newly appointed Commissioner of Trademarks) went viral for its restraint. Scott Graham, *Longtime Guardian of Jack Daniels Brand to Run*

*Trademarks at PTO*, Law.com (Feb. 5, 2020), <https://www.law.com/nationallawjournal/2020/02/05/longtime-guardian-of-jack-daniels-brand-to-run-trademarks-at-pt0/?slreturn=20200114171312> (visited Feb. 17, 2020). These letters are sent under many different circumstances and are not limited by whether or not the mark is GENERIC.COM. To the extent this is a problem (it is not), it cannot be solved by eviscerating an entire class of marks.

Neither the parties nor other *amici* have adequately addressed very real problems in cyberspace: phishing,<sup>5</sup> cybersquatting,<sup>6</sup> dissemination of ransomware,<sup>7</sup> and other bad acts that fool computer users by mimicking well-known trademarks. These acts can result in serious data breaches. In 2017, there were over 53,000 incidents and 2,216 confirmed data breaches worldwide. *See* Hadley L.

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5. “Phishing is a form of social engineering by which an attacker (the phisher) attempts to fraudulently retrieve confidential information or sensitive credentials from legitimate users (consumers) by mimicking electronic communications from a trustworthy source (spoofing) in an automated fashion.” J. Scott Larson, *Enforcing Intellectual Property Rights to Deter Phishing*, 22 No. 1 *Intell. Prop. & Tech. L.J.* 1, 1 (2010).

6. Cybersquatting is when an “[i]ndividual[] attempt[s] to profit from the Internet by reserving and later reselling or licensing domain names back to the companies that spent millions of dollars developing the goodwill of the trademark.” *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996).

7. Ransomware is a type of “malware that locks your keyboard or computer to prevent you from accessing your data until you pay a ransom.” Deborah R. Farringer, *Send Us the Bitcoin or Patients Will Die: Addressing the Risks of Ransomware Attacks on Hospitals*, 40 *Seattle U. L. Rev.* 937, 953 (2017).

Matarazzo, Lynn A. Toops, *Data Breaches Come in All Sizes*, Trial, June 2019, at 36, 38 (citing Verizon, *2018 Data Breach Investigations Report* at 4 (11th ed., Apr. 2018), [https://enterprise.verizon.com/resources/reports/2018/DBIR\\_2018\\_Report.pdf](https://enterprise.verizon.com/resources/reports/2018/DBIR_2018_Report.pdf)).

Even more alarming, in 2019 the average cost of a data breach was \$3.92 million. Larry Ponemon, *What's New in the 2019 Cost of a Data Breach Report*, Security Intelligence (July 23, 2019), <https://securityintelligence.com/posts/whats-new-in-the-2019-cost-of-a-data-breach-report/> (visited Feb. 17, 2020). It is expected that “the number of data breaches will reach an all-time high [in 2020]. The number of data breaches increased by 54% in the first half of 2019, with nearly 4,000 publicly disclosed breaches during that time. In total, more than 4.1 billion records have been exposed [in 2019].” Isaac Kohen, *Five Cyber Risks that will Define 2020*, Help Net Security (Jan. 6, 2020), <https://www.helpnetsecurity.com/2020/01/06/cyber-risks-2020/> (visited Feb. 17, 2020).

Due to rapid globalization and technological advancements, the reach of bad actors is expanding, making businesses and the consumer data they hold vulnerable. Trademark rights are an important weapon in the fight against fraudsters and others who would lure the unsuspecting person into downloading malware or releasing information that can be used against consumers.

In cyberspace, the rights of trademark owners are complicated by geography and by the European Union’s General Data Protection Regulation (EU) 2016/679 (“GDPR”). Geography is complex in that many domain names, including those gTLDs which end with .com, can

be registered by anyone, anywhere on the planet, and the registrars themselves may be outside the United States. Wikipedia, <https://en.wikipedia.org/wiki/.com> (visited Feb. 13, 2020). Until the GDPR went into effect on May 25, 2018, domain name registrars were often able to make public the names and addresses of registrants. Now, however, this data is deemed to be personal information under GDPR, and is usually unavailable regardless of the location of the registrant. Brian J. Winterfeldt, *et al*, *The Impact of GDPR on Online Brand Enforcement: Lessons Learned and Best Practices for IP Practitioners*, American Bar Association, Landslide Webinar Series, Vol. 11, No. 4 (2019).

Given the jurisdictional issues presented by the global scope of the Internet, since 1999 a quasi-judicial process has evolved to arbitrate domain name disputes through use of mandatory contractual provisions between the domain name registries and their customers. These provisions are required by ICANN.<sup>8</sup> Many domain names (including all .com and .org domains) are subject to ICANN’s Uniform Domain-Name Dispute-Resolution Policy (“UDRP”) or similar processes that address trademark-abusive practices across borders. Under the UDRP, disputes arising from abusive registrations of domain names are addressed by expedited administrative proceedings filed with an approved dispute-resolution service provider.

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8. The Internet Corporation for Assigned Names and Numbers (ICANN) helps coordinate the Internet Assigned Numbers Authority (IANA) functions, which are key technical services critical to managing the continued operations of the Internet’s underlying address book, the Domain Name System (DNS). Welcome to ICANN!, <https://www.icann.org/resources/pages/welcome-2012-02-25-en> (last visited Feb. 17, 2020).

See ICANN, UDRP Policy, <https://www.icann.org/resources/pages/help/dndr/udrp-en> (last visited Feb. 17, 2020). Thousands of such actions are filed every year at a cost that is a small fraction of the cost of trademark litigation. See World Intellectual Property Organization, Statistics, Total Number of Cases per Month for Year 2019, [https://www.wipo.int/amc/en/domains/statistics/cases\\_yr.jsp?year=2019](https://www.wipo.int/amc/en/domains/statistics/cases_yr.jsp?year=2019) (last visited Feb. 17, 2020); Zohar Efroni, *A Guidebook to Cybersquatting Litigation: The Practical Approach in a Post-Barcelona.com World*, 2003 U. Ill. J.L. Tech. & Pol'y 457, 470 (2003).

The UDRP process allows for relatively inexpensive and expedited procedures for mandatory arbitration, which is followed by a time-limited opportunity to appeal an adverse decision to a court. See, e.g., ICANN Rules, <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (last visited Feb. 17, 2020).

The resolution of a matter under the UDRP typically takes about 45 days if uncontested, and there are standardized complaint and response forms with strict word or page limits. See WIPO Supplemental Rules for UDRP Policy, <https://www.wipo.int/amc/en/domains/supplemental/eudrp/newrules.html> (last visited Feb. 17, 2020). The cost to file such proceedings are low. For instance, WIPO fees are \$1500 for one domain name and one arbitrator/panelist. WIPO, Schedule of Fees Under the UDRP, <https://www.wipo.int/amc/en/domains/fees/> (last visited Feb. 17, 2020). A complainant may seek cancellation or transfer of domain names using the UDRP process, provided the complainant proves the following elements:

- (i) the domain name is identical or confusingly

similar to a trademark or service mark in which the complainant has rights; and

(ii) the registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

ICANN, UDRP Policy, § 4(a), <https://www.icann.org/resources/pages/policy-2012-02-25-en> (visited Feb. 17, 2020).

One of the major providers of the arbitration service is the World Intellectual Property Organization (WIPO). Based on the experience of arbitrators over the past 20 years, WIPO has compiled guidance for parties appearing before them. In 2017, it issued the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition. In an answer to the question, “Do registered trademarks automatically confer standing to file a UDRP case?” WIPO answered, “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.” WIPO, <https://www.wipo.int/amc/en/domains/search/overview3.0/> (visited Feb. 17, 2020).

While it is possible for a complainant to prove such rights by submission of evidence of secondary meaning similar to what is shown in court (importantly, including consumer surveys), the presence of a trademark registration in the name of the complainant makes enforcement under the UDRP process easier and less



costly.<sup>9</sup>

The EFF itself has at least twice availed itself of the UDRP process, and its successes provide a good illustration of the circumstances under which such cases are brought and how the process works. In each case, success was grounded in the EFF's ability to demonstrate "the disputed domain name is identical or confusingly similar to a *trademark or service mark in which the Complainant has rights.*" See *Electronic Frontier Foundation v. WhoisGuard Protected, Whoisguard Inc./Jan Hasko*, D2017-1355, 2017 WL 4235815, at \*3 (WIPO Sept. 13, 2017) (emphasis added). In August 2015, EFF discovered that the domain name <electronicfrontierfoundation.org> was being used to serve malicious code to people who went to that site rather than to EFF's own website, which is found at <eff.org>. Visitors were redirected to the legitimate website, but only after being infected with malware, in a phishing attack that EFF discovered may have been run by a group linked to the Russian government. See Cooper Quintin, *New Spear Phishing Campaign Pretends to be EFF*, Electronic Frontier Foundation (Aug. 27, 2015), <https://www.eff.org/deeplinks/2015/08/new-spear-phishing-campaign-pretends-be-eff> (visited Feb. 17, 2020). EFF used its registered trademark in the UDRP action to establish its rights and to assert that the respondent was using a domain name identical or confusingly similar

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9. UDRP panelists take record ownership of the relevant trademark very seriously. For example, in *NBA Props. Inc., v. Adirondack Software Corp.*, D2000-1211, 2000 WL 35643697, at \*4 (WIPO Dec. 8, 2000), the panel denied the request to transfer the domain name <knicks.com> because the record owner of the trademark KNICKS was Madison Square Garden, L.P., not the licensee NBA Properties, Inc.

to EFF's registered trademark. *Electronic Frontier Foundation v. Shawanda Kirlin*, D2015-1628, 2015 WL 7424214, at \*2 (WIPO Nov. 10, 2015). After meeting that crucial, first prong of the test, EFF contended that the facts "strongly suggest that the disputed domain name was registered for the purpose of supporting a phishing campaign, *i.e.* an attempt to discover sensitive information such as usernames, passwords or personal details, by confusing consumers into believing that the attacker, to whom information is actually being provided, is in fact a different, trustworthy entity to whom consumers desire to provide information." *Id.*

The UDRP Panel had some difficulty in resolving an apparent discrepancy between the EFF's description of itself in the complaint as a nonprofit California corporation, while the trademark registration certificate was issued to a Massachusetts corporation. The panelist searched the USPTO's database to match the address of the trademark owner to the EFF's address given in the UDRP Complaint. "[G]iven that the name of the Complainant is the same as the name of the trademark owner of record, that they have the same address, and that the Respondent did not contest the trademark rights of the Complainant, the Panel is prepared to accept that the Complainant has rights to the trademark ELECTRONIC FRONTIER FOUNDATION." *Id.* The Panel found that the Respondent's conduct constituted both bad faith registration and use and thus ordered the domain to be transferred to EFF. *Id.*

Two years later, EFF filed another UDPR action, this time involving <electronicfrontier.org>. *Electronic Frontier Foundation v. WhoisGuard Protected*,

*Whoisguard Inc./Jan Hasko*, D2017-1355, 2017 WL 4235815, at \*3 (WIPO Sept. 13, 2017). This domain name was being used to post a copy of the EFF website as it had existed a year earlier, including reproductions of EFF’s own registered trademark. EFF asserted that the public would perceive that the “Respondent either is the Complainant or is authorized, sponsored, or endorsed by the Complainant despite there being no such relationship.” *Id.* EFF “submits that the pairing of ‘electronicfrontier’ with the ‘.org’ gTLD is more likely to give the public the wrong impression that the site is operated by” EFF. *Id.* EFF was concerned that “the disputed domain name could be used for illegitimate phishing purposes,” referring to its own 2015 case in which malware was served. *Id.* The panel relied on the EFF’s rights in its registered trademark to order a transfer. *Id.*

Because the EFF had registered its trademark, it had trademark protection against bad actors in cyberspace and was able to quickly and efficiently obtain orders to transfer domain names to it. Both cases took about three months to resolve from the date that EFF learned of the problem. That speed and efficiency was supported by valid trademark registrations. EFF advances a theory that would eviscerate the UDRP process, yet it took advantage of it when it was itself the victim of attack. There is no reason others should be unable to avail themselves of these same advantages if they can prove that their domain names meet the “primary significance” test.

**CONCLUSION**

As argued above, the BPLA contends that domain name marks like BOOKING.COM must be assessed as a whole, based on consumer perception. Thus, the BPLA respectfully urges the Court to reject the USPTO's proposed *per se* rule and to affirm the judgment below.

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