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INTELLECTUAL PROPERTY

BOOKING.COM and public perception

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by Donvay Wegierski, Director

The United States Supreme Court of Appeal has held that the US trade mark applications pending for **booking.com** are not generic and therefore protectable as trade marks. The SCA accepted the survey evidence submitted that the public perceives the mark as a brand name for a travel reservation booking service and not simply a web address. With many businesses operating e-commerce platforms using marks as domain names ending with top level domains or country code level domains, the **booking.com** ruling is welcomed, recognising the importance of public perception of trade marks.

The general principle, regardless of territory, is that a trade mark is acceptable for registration provided it is capable of distinguishing the goods and/or services of one party from those of others. A mark that comprises generic or common words should not be exclusive to one party, the trade mark registries requiring that those elements be endorsed with disclaimers separately and apart from the mark as a whole. In this instance, the word "booking" for online travel reservation services and the top level domain name ("TLLD") ".com" are each conceivably generic.

The **booking.com** matter has been pending for some time, sent to the Supreme Court of Appeal as a consequence of the USPTO (US Patent and Trade Mark Office) disagreeing with the District court's ruling that the mark **booking.com** is not generic. This ruling is significant persuading the SCA that the "primary significance test of the mark" as perceived by the public is relevant rather than what previous cases prescribe, which consider the addition of other commercial words to a mark such as the word "company", as describing a class of goods, which consequently cannot be a trade mark.

Booking.com originated in Amsterdam twenty-four years ago. With a global reach offering more than twenty eight million accommodation listings it is likely to be the world's leading online travel reservation service. Understandably, many brand owners would not be in a position to defend a ruling that a mark is in fact generic, the burden of proof being onerous and costly particularly with regards survey evidence.

A fine line – avoiding genericide

The **booking.com** matter is also a reminder of best practices to avoid a mark from becoming generic, otherwise referred to as "genericide" as was the demise of several established marks including cellophane, thermos, elevator, aspirin, velcro and liquorice allsorts.

Genericide happens when a mark is misused either by a competitor or a consumer when referring to specific goods and/or services. Avoiding genericide is a fine line since the more popular the mark, the more likely it is that it will be used in association with a particular action for example: "I googled recipes" as opposed to "I used Google to search for recipes" or "I Instagramed my photos" rather than "I posted my photos on Instagram".

The following measures can assist:

- Marketing strategies can include the use of a noun together with the mark for example "Booking.com a travel online reservation service" or "Google an online web searching service";
- The addition of a noun is especially important when introducing tag-lines and embarking on advertising campaigns, which also educates and informs;

- Use the TM symbol (for pending applications) or ® symbol (registered) when referring to the mark, which should also include using the mark in internal communications;
- Retain sales and marketing records, which can assist with proving that a mark has "acquired distinctiveness" which should also be territory specific;
- Monitor printed and online publications and the internet to ensure proper use of the mark. This can include Google Alerts, which flag the use of brands and trade marks.



Donvay Wegierski

Director

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