

# Wiley Brief Urges Supreme Court to Consider Cybersecurity Risks in Major Case About Trademark Eligibility for Domain Names

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Washington, DC - Wiley Rein LLP today filed an *amicus* brief in the U.S. Supreme Court on behalf of the Internet Commerce Association (ICA) in *United States Patent and Trademark Office v. Booking.com B. V.*, an important case involving trademark protection for Internet domain names, which could have serious cybersecurity consequences. The brief argues that if the government's position prevails at the Supreme Court, it would upend decades of settled trademark law - as well as the legal tools organizations commonly use to prevent fraud and cybercrime resulting from abuse of the domain name system.

Wiley has participated in several high-profile trademark cases at the Supreme Court, but this case is particularly important for its cross-cutting impacts.

- Partner Megan L. Brown, who leads the firm's cybersecurity and privacy practices, said, "This case is a sleeper. I worry about harmful consequences from the government's theory on vital tools to prevent domain name abuse like typosquatting and cybersquatting." Ms. Brown added, "This brief is important because companies and consumers face mounting cybersecurity threats, and organizations already have few tools with which to fight back. The Supreme Court should consider these consequences before it accepts the government's novel trademark theory."
- Partner David E. Weslow, who litigates cybersquatting and related cases for companies across the economy, said, "The

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## Practice Areas

Privacy, Cyber & Data Governance

government's position is really remarkable and would upend settled trademark law. It would deprive organizations of the chance to show that they have established trademark rights in descriptive words when combined with a generic top-level domain. As we see increased reliance on the domain name system, including new top-level domains like ".law," ".homes," and ".club," this could have really unfortunate effects."

Wiley's multidisciplinary cyber and IP teams help clients across the globe manage risk, protect their data, and vindicate their rights.

### **Background on the ICA, the Brief, and Wiley's Participation**

The Internet Commerce Association is a nonprofit organization that advocates for the rights and interests of domain name owners and related service providers. The brief, filed in support of Booking.com, asks the Supreme Court to affirm the decision of the U.S. Court of Appeals for the Fourth Circuit holding that the addition of a top-level domain, such as .com, to an otherwise generic term may result in a protectible trademark where evidence demonstrates that the trademark's primary significance to the public as a whole is the source of a product or service, and not the product or service itself.

Mr. Weslow and Ms. Brown, along with Wiley partner Ari Meltzer and associate Jeremy J. Broggi, authored the brief on the ICA's behalf.

The case is in the Supreme Court at the request of the U.S. government, which is seeking reversal of the Fourth Circuit's decision in favor of a blanket determination that adding a generic top-level domain to an otherwise generic term can *never* result in a protectable trademark.

The Internet Commerce Association's brief explains how the rule sought by the government would harm the domain name system and put consumers at an increased risk of online victimization. Many domain name owners have heavily invested in the goodwill of their businesses in reliance on the understanding that descriptive domain names can obtain federal trademark registration and protection where the names have acquired distinctiveness. Reversing that settled expectation would unfairly devalue trademarked domain names, which are significant intellectual property assets.

For the same reason, the ruling sought by the government would discourage investment in new generic top-level domains recently established by the Internet Corporation for Assigned Names and Numbers (ICANN) and endorsed by the federal government. New top-level domains – such as ".homes," ".inc," ".doctor," ".law," ".bank," ".cars," ".news," ".cpa," ".ngo," and ".organic" – hold great promise for e-commerce and online security. But their adoption will be stunted if the government succeeds in foreclosing trademark protection for domain names en masse.

Finally, the brief explains how the government's position would eliminate critical legal tools for combatting cybercriminals who misuse domain names for fraud. Two of the most common malicious activities involving the domain name system are typosquatting and domain name hijacking, which allow cybercriminals to intercept

sensitive personal or financial information or infect consumers' computers with malware. Without the remedies provided by trademark law, it will be difficult for companies to protect consumers from cybercriminals who misuse domain names for malicious purposes, increasing risk for consumers.

To read the brief, please [click here](#).