

ALERT

Supreme Court Ruling Protects Registered Domain Names, Preserving an Import Tool in the Fight Against Cybercrime

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On June 30, 2020 the U.S. Supreme Court issued a ruling in *U.S. Patent & Trademark Office v. Booking.com* that protects the intellectual property rights of domain name owners and preserves an important tool for combatting Internet-based fraud. The Court's 8-1 decision held that the term "Booking.com" was eligible for federal trademark registration. In so doing, the Court rejected the government's view that the combination of a generic word and ".com" is generic.

The decision allows the owners of registered domain names to obtain federal trademark protection where consumers perceive the mark as a whole to distinguish particular goods in commerce, and not to represent a generic class of goods. Specifically, the Court held that "[w]hether any given 'generic.com' term is generic . . . depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class." Applying that test to the travel reservation service Booking.com, the Court explained that "if 'Booking.com' were generic, we might expect consumers to understand Travelocity—another such service—to be a 'Booking.com.'" However, because the evidence showed that consumers "do not in fact perceive the term 'Booking.com' that way," the mark was eligible for federal trademark registration.

In an important part of the decision, the Court acknowledged that trademark registration provides greater protection to domain name owners under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (ACPA). Such protection is critical to preventing domain

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Practice Areas

Intellectual Property
Privacy, Cyber & Data Governance
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name abuse. The Internet Commerce Association, an *amicus curiae* in the case represented by Wiley, explained how the ACPA permits the owner of a registered trademark to oust cybercriminals who are attempting to harm unsuspecting consumers through malicious tactics such as typosquatting and domain name hijacking.

Wiley regularly assists clients with matters involving Internet anti-counterfeiting, copyright infringement, distribution of malware and viruses, domain name theft or hijacking, anti-spam laws and regulations, and social media disputes. The Supreme Court's decision will support the ability of generic.com domain name owners to rely on the ACPA and the Uniform Domain Name Dispute Resolution Process (UDRP) to protect their domain name assets.

Cory Hauser, a Law Clerk at Wiley, contributed to this alert.