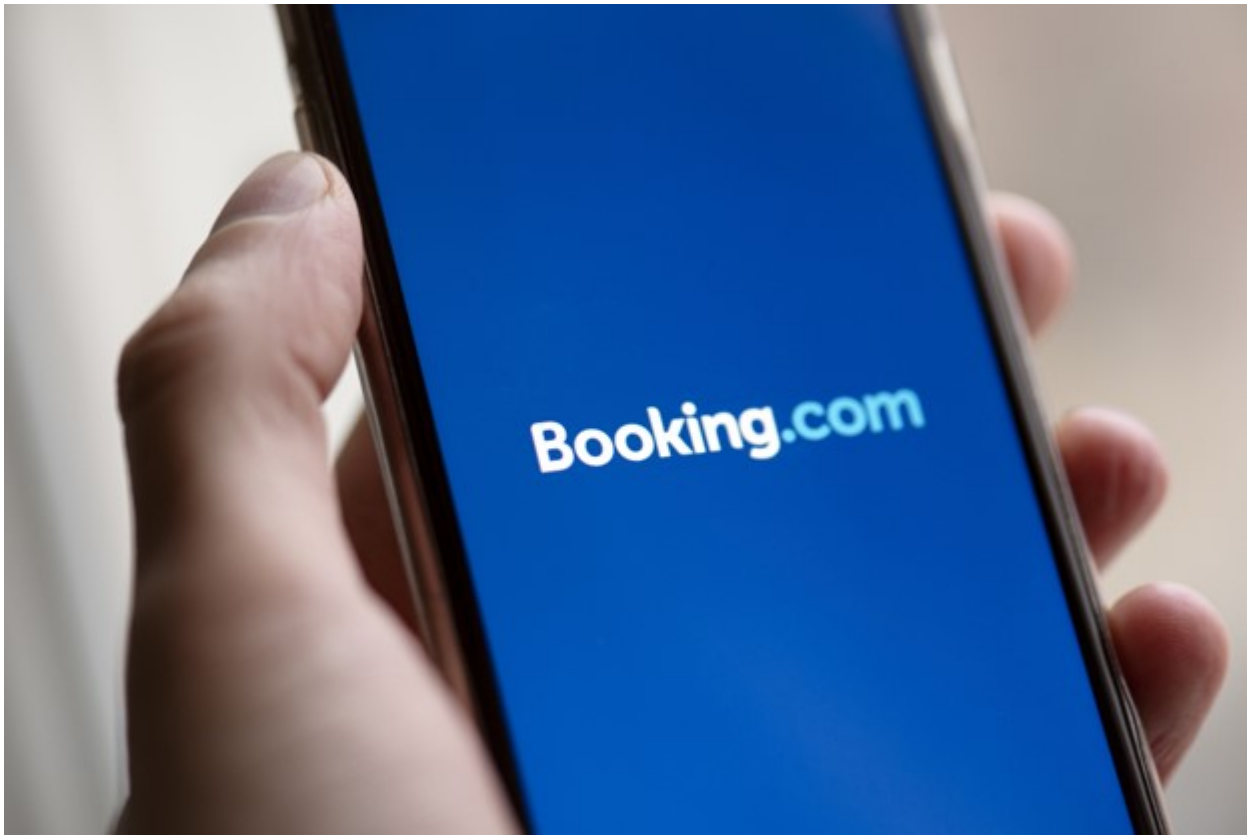
HOGE · FENTON

TROUBLE FOR .COM TRADEMARKS



The Supreme Court ruled in November that it will hear an appeal from the 4th Circuit brought by the USPTO. The primary issue is whether a generic term plus ".com" can function as a trademark and should be granted registration. The 4th Circuit found that such a mark could be registered where the term as a whole (**BOOKING.COM**) was found to not be generic and where there is survey evidence indicating that 74% of consumers identified the term as a brand. In addition, it is possible that the Court will weigh in on whether an attorney's fees award to the PTO in a case they lost was allowable, a USPTO policy that has been recently struck down in the context of patent appeals.

Hoge Fenton Trademark attorney, **Dana Brody-Brown**, predicts the court will uphold the Circuit Court decision and find that, while not all generic plus ".com" names are protectable, this must be a fact-specific inquiry and, where there is evidence that consumers recognize the term in question as a brand, it should be protected as a trademark. No matter how the Supreme Court rules, the case promises to clarify the law around protection for domain names used as trademarks.

Related Attorneys

- Dana Brody-Brown