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## TRADEMARKS IN CONVERSATION: ASSESSING GENERICISM AFTER *BOOKING.COM*♦

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### ABSTRACT

*It is a fundamental principle of U.S. trademark law that to serve as a trademark, a word or phrase must “indicate the source” of the goods or services with which it is associated and, conversely, that a term that is understood to be the common name of a good or service is “generic” and cannot be protected as a trademark. Yet it still seems difficult to determine exactly what each concept means, particularly when the actual “source” of any goods or services might be opaque to consumers.*

*In part, this difficulty comes from the fact that status as a trademark or as a generic term is necessarily contextual. The Supreme Court’s 2020 opinion in United States Patent and Trademark Office v. Booking.com B.V. emphasized the relevance of consumer understanding to this inquiry. Words are not inherently generic or distinctive out of context; APPLE is a trademark for computers but not for fruit.*

*Although individuals encounter trademarks in a variety of settings, we ultimately care about this understanding in the context of a consumer’s experience, since that is where relevant confusion is operationalized. To use a supermarket analogy, the consumer is, at least conceptually, first searching for the right aisle (“soft drinks” or “colas”) and then searching among the shelves for the product they want (“Pepsi” rather than “Coca-Cola”). The genericism inquiry is therefore about assessing terms to determine whether they are related to an aisle search or a shelf search.*

*Framing the inquiry in this way can help us to see that the question is ultimately about consumer understanding of terms, not consumer use of terms. Looking at how consumers talk about trademarks, whether through corpus analysis, surveys, dictionaries, or other sources, can be helpful, but it is equally important to consider how consumers understand those communications. By thinking of trademarks as elements of*

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*conversations among consumers, and borrowing from Gricean implicature, we might be able to determine whether a term is related to finding the right aisle or related to finding the right product on the shelf.*

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### INTRODUCTION

It is a fundamental principle of U.S. trademark law that in order to serve as a trademark, a word or phrase must “indicate the source” of the goods or services with which it is associated and, conversely, that a term that is understood to be the common name of a good or service is “generic” and cannot be protected as a trademark.<sup>1</sup> During the seventy-five years of the Lanham Act’s existence, courts and commentators have put forward various phrasings to describe what it means to serve as a trademark<sup>2</sup> and various ways of describing genericism, and yet it still seems difficult to determine exactly what each concept means, particularly when the actual “source” of any goods or services might be opaque to consumers.<sup>3</sup>

In part, this difficulty comes from the fact that status as a trademark (and, conversely, status as a generic term) is necessarily contextual. The Supreme Court’s 2020 opinion in *United States Patent and Trademark Office v. Booking.com B.V.*<sup>4</sup>—which rejected a per se rule that would

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<sup>1</sup> 15 U.S.C. § 1127 (2018) (definition of “trademark”); *id.* § 1064(3) (permitting petitions to cancel a registration of a mark “[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered . . .”).

<sup>2</sup> The Supreme Court’s opinion in *Qualitex*, to take just one example (albeit relating to color or trade dress), talks about a trademark as something that “signal[s],” “indicates,” “identifies,” and “distinguish[es]” source. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–66 (1995); *see also, e.g.*, Barton Beebe, *Search and Persuasion in Trademark Law*, 103 MICH. L. REV. 2020, 2021 (2005) (describing trademarks as “designations of source”).

<sup>3</sup> *See, e.g.*, James Brooke, *Factory Jobs Move Overseas as Japan’s Troubles Deepen*, N.Y. TIMES (Aug. 31, 2001), <https://www.nytimes.com/2001/08/31/business/factory-jobs-move-overseas-as-japan-s-troubles-deepen.html> [<https://perma.cc/8CWX-XECF>] (quoting the chief economist for Merrill Lynch Japan, who referred to the “Nike model,” in which “you do the brand management in Seattle and the manufacturing in Indonesia”); Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 388–89 (2011).

<sup>4</sup> U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298 (2020).

deem generic all claimed trademarks that consist of a generic term for the goods or services at issue plus a lexical unit equivalent to the top-level domain “.com”—emphasized the relevance of consumer understanding to this inquiry, relying on the “undisputed principle that consumer perception demarcates a term’s meaning.”<sup>5</sup> Thus, even though “booking” is a generic term for the act of making travel reservations, and “.com” indicates a business that operates on the Internet,<sup>6</sup> the unchallenged evidence in the case indicated that consumers do not understand “Booking.com” to refer to online hotel-reservations services generally. Rather, consumers recognize “Booking.com” as the name of a company; hence, the term is not generic in that context.

The Court was correct when it reaffirmed that a trademark’s status as such depends on consumer understanding, whether that understanding is assumed (as in the case of a mark deemed inherently distinctive for a particular good or service) or assessed (as in the case of a mark deemed descriptive for a particular good or service, which requires evidence of acquired meaning).<sup>7</sup> Words are not inherently generic or distinctive out of context; APPLE is a trademark for computers but not for fruit. Consumer understanding is the touchstone because the goal, ostensibly, is to facilitate the consumer experience in the marketplace. A consumer looking for running shoes will have a variety of terms they would expect to see during that search—“athletic shoes,” “running shoes,” or “sneakers,” perhaps—and so producers of those shoes should be able to use those terms to indicate that their products are in the same class of goods as their competitors, if not necessarily of the same quality. By contrast, consumers expect to see trademarks as distinguishing goods among that class—Nike running shoes as opposed to New Balance running shoes.

Thus, the concept of a trademark as a “source identifier,” although now standard vocabulary in the trademark literature, may not be an intuitive description to consumers of how trademarks function. Consumers who prefer and search out Budweiser beer or Levi’s jeans may not understand those trademarks to indicate or distinguish the “source” of those products, to the extent that “source” means producer. If asked, such consumers might say that the trademark names the product

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<sup>5</sup> *Id.* at 2304 n.3.

<sup>6</sup> See Joanna Glasner, *Dot’s in a Name No More*, WIRED (Aug. 31, 2001, 2:00 AM), <https://www.wired.com/2001/08/dots-in-a-name-no-more/> [<https://perma.cc/Y698-6SVS>] (describing publicly traded companies that dropped the “.com” in their corporate names in favor of “new names less closely associated with the financially troubled new economy”).

<sup>7</sup> *Cf.*, e.g., Beebe, *supra* note 2, at 2021 (“Trademarks exist only to the extent that consumers perceive them as designations of source.”); 15 U.S.C. § 1052(f) (2018) (permitting registration of a merely descriptive term “which has become distinctive of the applicant’s goods in commerce”).

itself—in other words, that there is Budweiser beer and Michelob beer, just as this person is named Jennifer and that one is named Amanda.<sup>8</sup> So “source identifier” in this context incorporates a notion of the producer as the source of the qualities or characteristics with which the good or service is associated—Budweiser beer indicates “the beer made by the producer that makes Budweiser with the set of qualities associated with that producer’s beer.” The concept of the producer is necessary, lest we fall into the trap of characterizing a trademark as generic because it represents *some* set of qualities available to all producers.<sup>9</sup>

Although individuals encounter trademarks in a variety of settings, we ultimately care about this understanding in the context of a consumer’s experience, since that is where relevant confusion is operationalized. In that environment, consumers are searching for two things: the type of good they want and the particular brand of that good.<sup>10</sup> To use a supermarket analogy, the consumer is, at least conceptually, first searching for the right aisle (“soft drinks” or “colas”) and then searching among the shelves for the product they want (“Pepsi” rather than “Coca-Cola”), even though the consumer might not separate out those searches in their mind. The genericism inquiry is therefore about assessing terms to determine whether they are related to an aisle search or a shelf search. Competitors, for their part, need to be able to use the term that will allow

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<sup>8</sup> Cf. John F. Coverdale, Comment, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHI. L. REV. 868, 875 (1984) (“Because most consumer goods are in this sense more than mere fungible commodities, a trademark today does not evoke in the minds of consumers separate and independent concepts of product and source, but rather evokes a ‘brand image.’”); Arthur J. Greenbaum, Jane C. Ginsburg & Steven M. Weinburg, *A Proposal for Evaluating Genericism After “Anti-Monopoly,”* 73 TRADEMARK REP. 101, 102 (1983) (noting that “a trademark can simultaneously identify both the goods and their source”); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 653 (2004) (noting that the “primary significance” standard of the Trademark Clarification Act of 1984, 15 U.S.C. § 1064(3), “does little to solve the problem at the root of the genericness inquiry” because “a trademark that is more distinctive of its product than its producer, as most trademarks are, would appear still to risk being found generic”).

I have offered elsewhere the analogy of a label on a file folder, in that trademarks serve to collect various types of information about the trademarked good or service. Laura A. Heymann, *What Is the Meaning of a Trademark?*, in RESEARCH HANDBOOK ON TRADEMARK LAW REFORM 250, 256 (Graeme B. Dinwoodie & Mark D. Janis eds., 2021). The issue is complicated to some extent by the development of brand personas. See Laura A. Heymann, *The Scope of Trademark Law in the Age of the Brand Persona*, 98 VA. L. REV. IN BRIEF 61 (2012).

<sup>9</sup> See, for example, the much-criticized opinion in *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 684 F.2d 1316, 1326 (9th Cir. 1982), which Congress responded to by enacting 15 U.S.C. § 1064(3).

<sup>10</sup> Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1792 (2007) (“[W]e contend that the genericism doctrine should be reanchored to focus on the mark’s ability to act as a source identifier for the consumer in commercial contexts. By refocusing the genericism question on consumer contexts rather than non-consumer contexts, the doctrine may better reflect a term’s ability to perform more than one function in language, depending on the user of the term and the context of the term’s use.”).

them to be grouped with comparable goods in the aisle search and to use trademarks as one method of winning the competition in the shelf search.

Framing the inquiry in this way can help us to see that the question is ultimately about consumer *understanding* of terms, not consumer *use* of terms. As many commentators have discussed,<sup>11</sup> consumers use trademarks in both source-identifying and non-source-identifying ways in typical discourse—they talk of “googling” information on the Internet or making a “xerox” of a document, even though, if asked, they will say that they recognize GOOGLE and XEROX as trademarks. Looking at how consumers talk about trademarks, whether through corpus analysis, surveys, dictionaries, or other sources, can be helpful, but it is equally important to consider how consumers understand those communications. By thinking of trademarks not simply as instances of producers speaking to consumers but also as elements of conversations among consumers, we might be able to determine whether a term is about finding the right aisle or about finding the right product on the shelf.

#### I. THE *BOOKING.COM* DECISION

The company Booking.com B.V. had filed four applications with the U.S. Patent and Trademark Office (USPTO) to register the mark BOOKING.COM for hotel reservation services and travel agency services (some plus a design).<sup>12</sup> Each application was ultimately refused by the examining attorney on the grounds that BOOKING.COM was generic for those services or, in the alternative, that the term was merely descriptive of those services and so unregistrable.<sup>13</sup> The Trademark Trial and Appeal Board (TTAB) affirmed the refusals, concluding that consumers would see BOOKING.COM as referring simply to “an online service for making bookings,” rather than a particular source of such a service<sup>14</sup> and that similar businesses that wanted to include “booking.com” in their names and domain names (for example, “hotelbooking.com”) would be “meaningfully hampered in their ability to communicate the nature of their online booking services.”<sup>15</sup>

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<sup>11</sup> See discussion *infra* note 91.

<sup>12</sup> From 1996 to June 2006, the company offered its service under the mark BOOKINGS, but it changed its name to BOOKING.COM in June 2006. Declaration Under 37 C.F.R. § 2.20 of Acquired Distinctiveness Under Section 2(f), ¶ 2 (Nov. 7, 2012), Joint App. at 16, U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298 (2020) (No. 19-46).

<sup>13</sup> *In re Booking.com B.V.*, No. 85485097, 2016 WL 1045674, at \*2 (T.T.A.B. Feb. 18, 2016).

<sup>14</sup> *Id.* at \*11.

<sup>15</sup> *Id.* at \*13. The TTAB also affirmed the alternative ground for denial that the term was merely descriptive without acquired distinctiveness. *Id.* at \*18. The TTAB’s review of the refusals of the other applications were issued in separate opinions but on the same grounds. See *In re Booking.com B.V.*, Nos. 79122365, 79122366, 2016 WL 1045672 (T.T.A.B. Feb. 18, 2016); *In re Booking.com B.V.*, No. 79114998, 2016 WL 1045671 (T.T.A.B. Feb. 18, 2016).

Booking.com B.V. then filed suit pursuant to 15 U.S.C. § 1071(b) in the U.S. District Court for the Eastern District of Virginia, which serves as a means of appealing decisions from the TTAB but allows both sides to introduce new evidence into the record. On cross-motions for summary judgment, the court held that “the relevant consuming public primarily understands that BOOKING.COM does not refer to a genus, rather it is descriptive of services involving ‘booking’ available at that domain name.”<sup>16</sup> As such, it went on to conclude that there was no evidence in the record that “consumers or producers use the term ‘booking.com’ to describe the genera of services at issue, that is, hotel and travel reservation services”; rather, “[w]hat evidence defendants have produced shows that the types of services offered by plaintiff are routinely referred to as ‘booking website(s),’ ‘booking site(s),’ etc.”<sup>17</sup> The court also took note of a newly introduced *Teflon* survey<sup>18</sup> on behalf of the company, in which 74.8% of respondents identified BOOKING.COM as a brand name.<sup>19</sup>

The U.S. Court of Appeals for the Fourth Circuit affirmed in a 2–1 decision.<sup>20</sup> The court began by setting forth the framework for its analysis:

To determine whether a term is generic, we follow a three-step test: (1) identify the class of product or service to which use of the mark is relevant; (2) identify the relevant consuming public; and (3) determine whether the primary significance of the mark to the relevant public is as an indication of the nature of the class of the product or services to which the mark relates, which suggests that it is generic, or an indication of the source or brand, which suggests that it is not generic.<sup>21</sup>

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<sup>16</sup> *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 918 (2017), *amended by* No. 1:16-cv-00425, 2017 WL 4853755 (E.D. Va. Oct. 26, 2017), *aff’d sub nom. Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171 (4th Cir. 2019), *aff’d*, 140 S. Ct. 2298 (2020), *and judgment vacated*, 141 S. Ct. 187 (2020). The Eastern District of Virginia went on to conclude that the company had established secondary meaning as to hotel reservations services but not as to travel agency services. *Id.* at 923.

<sup>17</sup> *Id.* at 914. The case also involved a dispute over attorney’s fees, which is not relevant to this Article.

<sup>18</sup> See *infra* text accompanying notes 97–102 (discussing *Teflon* surveys).

<sup>19</sup> *Booking.com*, 278 F. Supp. 3d at 915. The survey expert had also included WASHINGMACHINE.COM in the list with the expectation that respondents would, by contrast, identify it as a generic term; 33% of respondents nevertheless identified it as a brand name. *Id.* at 916. See *infra* text accompanying notes 103–114 (discussing the survey).

<sup>20</sup> *Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171, 175 (4th Cir. 2019), *aff’d*, 140 S. Ct. 2298 (2020), *and judgment vacated*, 141 S. Ct. 187 (2020). The USPTO conceded that if BOOKING.COM were deemed descriptive, it would not challenge the lower court’s finding on secondary meaning. *Id.* at 179. The company did not challenge the district court’s decision as to travel agency services. *Id.* at 177 n.2.

<sup>21</sup> *Id.* at 180.

It then noted that “the consumer surveys in this record suggest that the public primarily understands BOOKING.COM to indicate the company rather than the service.”<sup>22</sup> It found unpersuasive any concerns about overenforcement, noting that, for example, a plaintiff still has to show a likelihood of confusion in order to prevail in an infringement suit.<sup>23</sup>

The U.S. Supreme Court, in an 8–1 opinion written by Justice Ginsburg, affirmed.<sup>24</sup> (Justice Sotomayor wrote a concurring opinion, and Justice Breyer dissented.) The Court began by noting the three “guiding principles” that were “common ground” in the case: that a generic term “names a ‘class’ of goods or services, rather than any particular feature or exemplification of the class”; that a compound term is analyzed as a whole; and that “the relevant meaning of a term is its meaning to consumers.”<sup>25</sup> It then concluded that because “Booking.com,” taken as a whole, does not signify to consumers “the class of online hotel-reservation services”—in other words, based on the evidence below, which the USPTO left unchallenged on appeal, consumers do not refer to Travelocity as a “Booking.com”—the term was not generic for those services.<sup>26</sup> To the extent there were concerns about the broad scope of enforcement of such marks, the Court noted that doctrines such as descriptive fair use served to limit those rights and preserve space for others using the term in its descriptive sense.<sup>27</sup>

The USPTO had urged the Court to conclude that the particular compound form at issue—a generic term for the relevant goods or services plus “.com”—should not be recognized as a trademark regardless of consumer perception of the compound term on the grounds that such terms are generic as a matter of law pursuant to the Court’s 1888 decision in *Goodyear’s India Rubber Glove Manufacturing Co. v.*

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<sup>22</sup> *Id.* at 183 (emphasis omitted).

<sup>23</sup> *Id.* at 186–87. Judge Wynn dissented from the majority opinion. *See id.* at 188 (Wynn, J., dissenting).

<sup>24</sup> U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298 (2020). I previously analyzed the Court’s opinion at Laura A. Heymann, Response, United States Patent and Trademark Office v. Booking.com B.V.: *How Do We Know When Something Is a Name?*, GEO. WASH. L. REV. ON THE DOCKET (July 2, 2020), <https://www.gwlr.org/booking-com-b-v-how-do-we-know-when-something-is-a-name> [<https://perma.cc/ECD7-PD9B>]. Perhaps not surprisingly, my discussion here mirrors that analysis.

<sup>25</sup> *Booking.com*, 140 S. Ct. at 2304; *see also id.* at 2304 n.3 (noting “the undisputed principle that consumer perception demarcates a term’s meaning”); 15 U.S.C. § 1064(3) (2018) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

<sup>26</sup> *Booking.com*, 140 S. Ct. at 2304–05.

<sup>27</sup> *Id.* at 2307–08 (citing, *inter alia*, 15 U.S.C. § 1115(b)(4)). Justice Breyer, in dissent, found competition concerns to be a compelling reason to deny protection to “[generic].com” marks. *Id.* at 2314–16 (Breyer, J., dissenting). For an argument that descriptive terms should not receive trademark protection, see Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003).

*Goodyear Rubber Co.*<sup>28</sup> *Goodyear* involved a dispute between the Goodyear Rubber Company and Goodyear's India Rubber Glove Manufacturing Company, which had used various shortened versions of its name to sell its product, including "Goodyear Rubber Company."<sup>29</sup> At the time, as the Court noted, "Goodyear Rubber" was what we would call today a generic term, indicating rubber produced according to the once-patented process developed by Charles Goodyear.<sup>30</sup> Hence, the Court held that the plaintiff could not prevent the defendant from using the term and gained no rights from the fact that its name was the "Goodyear Rubber Company" since "[t]he addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or sell them."<sup>31</sup> The USPTO in *Booking.com* thus argued that the name of a company that consisted of a compound of a generic term for a product or service plus ".com" could not be protected as a trademark because it, likewise, conveyed only that the product or service indicated by the generic term was available online.<sup>32</sup> The Court, in rejecting this argument, noted that such an "unyielding legal rule" was incompatible with the principle that "whether a term is generic depends on its meaning to consumers."<sup>33</sup> *Goodyear*, the Court noted, was simply an example of a compound term "yield[ing] no additional meaning to consumers capable of distinguishing the goods or services."<sup>34</sup>

In the wake of the Court's decision, the USPTO issued an Examination Guide to provide updated guidance to examiners on "generic.com" applications.<sup>35</sup> That guidance conveyed, accurately, that there could no longer be any per se rule rejecting "generic.com" applications as generic but that each application must be reviewed on its

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<sup>28</sup> *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598 (1888).

<sup>29</sup> *Id.* at 599–602.

<sup>30</sup> *Id.* at 602. The Goodyear Tire & Rubber Company now holds several registered trademarks consisting of or incorporating "Goodyear," including GOODYEAR, Registration No. 4,494,937, issued March 11, 2014, for tires.

<sup>31</sup> *Goodyear*, 128 U.S. at 602.

<sup>32</sup> *Booking.com*, 140 S. Ct. at 2305–06.

<sup>33</sup> *Id.* at 2306.

<sup>34</sup> *Id.* (emphasis omitted). Justice Breyer disagreed with this characterization of *Goodyear*. *See id.* at 2311 (Breyer, J., dissenting) ("[T]he *Goodyear* principle is sound as a matter of law and logic . . . [W]here a compound term consists simply of a generic term plus a corporate designation, the whole is *necessarily* no greater than the sum of its parts.") (emphasis in original); *id.* at 2312 ("Like the corporate designations at issue in *Goodyear*, a top-level domain such as '.com' has no capacity to identify and distinguish the source of goods or services. It is merely a necessary component of any web address. When combined with the generic name of a class of goods or services, '.com' conveys only that the owner operates a website related to such items.") (citation omitted).

<sup>35</sup> U.S. PAT. & TRADEMARK OFF., USPTO-T-9, EXAMINATION GUIDE 3-20, GENERIC.COM TERMS AFTER *USPTO v. BOOKING.COM* (Oct. 2020).



own evidence.<sup>36</sup> Such evidence, the USPTO noted, could include trade usage, consumer surveys, dictionaries, and usage by consumers and competitors, “the same types of evidence examining attorneys traditionally consider when assessing genericness.”<sup>37</sup> In particular, the USPTO noted, “evidence of the ‘generic.com’ term used by third parties as part of their domain names (e.g., ‘[adjective]generic.com’) in connection with the same or similar goods and/or services” would be an example of evidence that would support a genericness finding.<sup>38</sup>

The Court’s opinion, Justice Sotomayor’s concurrence, and Justice Breyer’s dissent all highlighted the need for careful attention to survey evidence in a genericism inquiry. The majority, citing an amicus brief by several trademark scholars, noted that “[s]urveys can be helpful evidence of consumer perception but require care in their design and interpretation.”<sup>39</sup> Justice Sotomayor, emphasizing this point, further noted that “[f]laws in a specific survey design, or weaknesses inherent in consumer surveys generally, may limit the probative value of surveys in determining whether a particular mark is descriptive or generic in this context.”<sup>40</sup> Justice Breyer, for his part, found survey evidence to have “limited probative value in this context” because survey results might well yield association with a term that is evidence of something other than trademark significance, which he believed to be true of the company’s *Teflon* survey in the case.<sup>41</sup>

While Justice Breyer’s concern might be warranted in some cases, the survey evidence submitted by the company in the *Booking.com* case, which the USPTO did not challenge on appeal, indicated that the respondents saw “Booking.com” as a trademark. This was likely the case because the company did not simply offer services at the URL [www.booking.com](http://www.booking.com)<sup>42</sup> but also used and advertised “Booking.com” as the

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<sup>36</sup> *Id.* at 2.

<sup>37</sup> *Id.* For an example of TTAB review post-*Booking.com*, see *In re GJ & AM, LLC*, 2021 U.S.P.Q.2d 617 (T.T.A.B. 2021), in which the TTAB reversed the examiner’s refusal to register COOKINPELLETS.COM on the grounds that it was generic for the identified goods but affirmed the refusal to register the mark on the grounds that it was merely descriptive and had not acquired secondary meaning.

<sup>38</sup> U.S. PAT. & TRADEMARK OFF., *supra* note 35, at 3 (brackets in original). To be consistent with the Court’s opinion, however, this guidance should be relevant only to the extent that consumers’ awareness of such domain names causes them to consider “[generic term].com” as generic for a class of goods or services. The existence of the *domain name* [www.hotelbooking.com](http://www.hotelbooking.com), for example, does not necessarily mean that consumers will not see “Booking.com” as the *trademark* of an online travel-reservation company. See discussion *infra* note 42.

<sup>39</sup> *Booking.com*, 140 S. Ct. at 2307 n.6 (citing Brief for Trademark Scholars as Amici Curiae in Support of Neither Party at 18–20, *Booking.com*, 140 S. Ct. 2298).

<sup>40</sup> *Id.* at 2309 (Sotomayor, J., concurring). Justice Sotomayor further suggested that a genericism finding could have been appropriate based on the evidence, but that question was not before the Court. *Id.*

<sup>41</sup> *Id.* at 2313–14 (Breyer, J., dissenting).

<sup>42</sup> While correctly noting that consumer perception is key to the genericness inquiry, the Court did

name of the company, which is also how media outlets referred to the company in their reporting.<sup>43</sup> Justice Breyer concluded that this name “informs the consumer of the basic nature of its business and nothing more,”<sup>44</sup> but, in this respect, Booking.com is no different from the names of other well-known services with registered trademarks, such as The Weather Channel and The Container Store.<sup>45</sup>

More fundamentally, Justice Breyer’s dissent viewed competitive need not simply as a justification for *why* generic terms are not protected but as a means of determining *whether* a term is generic—suggesting, in other words, that a term’s status can be determined apart from consumer understanding. Thus, in critiquing the survey proffered by Booking.com, he wrote, “If someone were to start a company called ‘Washingmachine.com,’ it could likely secure a similar level of consumer identification by investing heavily in advertising. Would that somehow transform the nature of the term itself? Surely not.”<sup>46</sup> But it is not clear

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get off track in one respect. In rejecting the USPTO’s argument that a “[generic].com” term could never be distinctive of source, the Court wrote that such a term “might also convey to consumers a source-identifying characteristic: an association with a particular website,” since “only one entity can occupy a particular Internet domain name at a time.” *Id.* at 2306 (majority opinion). But that confuses the nature of the registration at issue in the case. The company was seeking to register “Booking.com” not as a URL, which is the province of the domain name registry system, but as a trademark for its online travel reservation business, much like “Starbucks” serves as a trademark for a chain of coffee shops, while its URL is [www.starbucks.com](http://www.starbucks.com). The fact that a URL necessarily is associated with only one website does not make a trademark that is lexically equivalent to that URL source-distinctive any more than the fact that 123 Main Street indicates a single address means that the phrase “123 Main Street” necessarily serves as a trademark for any goods or services offered there. *See* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:17.50, Westlaw (5th ed., database updated Mar. 2021) (“[A] domain name does not become a trademark or service mark unless it is also used to identify and distinguish the source of goods or services.”). Although it would have been an extremely ill-advised business decision, Booking.com B.V. could have offered its services under the trademark BOOKING.COM but at a different URL altogether. Justice Breyer, in his dissent, also conflated the two. *See Booking.com*, 140 S. Ct. at 2312 (Breyer, J., dissenting) (“The meaning conveyed by ‘Booking.com’ is no more and no less than a website associated with its generic second-level domain, ‘booking.’”).

Relatedly, the fact that a company has “.com” in its name might mean that the term as a whole is descriptive of the goods or services it offers—here, that the company called Booking.com offers the ability to book travel reservations online. That conclusion, however, does not render the term unregistrable; as the courts below found, it means that the applicant must present evidence of acquired meaning in order to register the term.

<sup>43</sup> *See, e.g.*, Patrick Scott, *Have App, Will Travel Like a Local. Hopefully*, N.Y. TIMES (June 6, 2019), <https://www.nytimes.com/2019/06/06/travel/have-app-will-travel-like-a-local-hopefully.html> [<https://perma.cc/7CFE-UKXE>] (quoting “Booking.com’s vice president of global experiences”).

<sup>44</sup> *Booking.com*, 140 S. Ct. at 2309 (Breyer, J., dissenting).

<sup>45</sup> THE WEATHER CHANNEL, Registration No. 1,696,588 (issued June 23, 1992, for “meteorological services,” disclaiming only “weather”); THE CONTAINER STORE, Registration No. 1,164,143 (issued Aug. 4, 1981, for “retail store services in the area of household accessories, storage items, storage systems, and space organizers,” disclaiming only “store”). *But see In re The Consumer Protection Firm PLLC*, Nos. 87445801, 87444846, 2021 WL 825503, at \*11 (T.T.A.B. Mar. 2, 2021) (finding that “The Consumer Protection Firm” refers to a category of “legal services concerning the laws related to consumer protection” and so is generic).

<sup>46</sup> *Booking.com*, 140 S. Ct. at 2314 (Breyer, J., dissenting).

why this would not, in fact, transform the nature of the term. Indeed, this is precisely what Booking.com B.V. did—it started a company with a name in the form of [generic].com, invested heavily in advertising the name of that company, and transformed the term from something that would otherwise have been perceived merely as the lexical equivalent of a domain name to something that the majority of the consumers surveyed recognized as the name of a particular company.<sup>47</sup>

*Booking.com* thus confirms that the inquiry as to whether a term is generic is, and has long been, based on consumer perception in context.<sup>48</sup> Evidence of that perception may be gleaned from a variety of sources, but there is no Platonic ideal of genericness that can be assessed through factors or qualities other than consumer understanding.<sup>49</sup> The question then becomes what the nature of this understanding is and how we determine it.

## II. WHAT DOES GENERICISM MEAN?

The siren song of the term “source” feels almost inescapable this many years after the Lanham Act’s enactment. Saying that a trademark must be distinctive or indicative of source is easy to do; determining what source distinctiveness means is considerably more difficult. Although Barton Beebe has thoughtfully clarified that “source distinctiveness” should be distinguished from “differential distinctiveness” (the extent to which a mark is different from other marks),<sup>50</sup> the definition of “source distinctiveness” understandably cannot help but include the term “source”: if consumers recognize it “as a designation of the source of the product to which it is affixed rather than as, say, a decoration on or description of that product.”<sup>51</sup> Asking whether consumers understand a trademark to reflect “source” is a more challenging exercise this many years removed from a system where trademarks and producers had more of a one-to-one relationship.

Where a term is *not* distinctive of source, it might be because consumers consider it to be the common name for the good or service

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<sup>47</sup> *See id.* (“The survey participants who identified ‘Booking.com’ as a brand likely did so because they had heard of it, through advertising or otherwise.”).

<sup>48</sup> *Cf., e.g., Wolfe v. Goulard*, 18 How. Pr. 64, 69 (N.Y. Sup. Ct. 1859) (“[N]o person can acquire a right to the exclusive use of words, applied as the name of an article sold by them, if in their ordinary acceptance they designate the same or a similar article.”).

<sup>49</sup> 2 MCCARTHY, *supra* note 42, § 12:11 (“The danger of the approach of those courts that have discarded the ‘buyer understanding’ test is that it can lead to assuming that which is to be decided. To state that one seller cannot ‘appropriate’ a term which is the ‘generic name’ of something as a trademark for that thing is to assume that that term is in fact a ‘generic name’ of that thing. But in many cases, the very dispute is whether that term is a generic name of that thing.”).

<sup>50</sup> Beebe, *supra* note 2, at 2028–31.

<sup>51</sup> *Id.* at 2028–29.

(airlines) or because consumers initially consider it to be a description of the qualities or characteristics of the good or service (“American airlines,” as distinguished from “French airlines”). Consumer understanding as to each can change over time, such that a term once considered to be a trademark might come to be understood as the common name for the good or service (such as “escalator”) *in spite of* advertising,<sup>52</sup> while a term once considered to be a mere description of the good or service might come to be understood as a trademark *because of* advertising (such as AMERICAN AIRLINES).<sup>53</sup>

As Judge Hand asked in *Bayer Co. v. United Drug Co.*, the “single question” in such cases “is merely one of fact: What do the buyers understand by the word for whose use the parties are contending?”<sup>54</sup> The Lanham Act tells us that this answer depends on the “primary significance” of the mark<sup>55</sup> “to the relevant public,”<sup>56</sup> and courts attempting to conceptualize this understanding often resort to the scientific language of genus and species—that the generic term is the genus of which the trademarked good is the species.<sup>57</sup> Ultimately,

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<sup>52</sup> See *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BL) 80 (Dec. Comm’r Pat. 1950). The reverse—a term understood to be the common name for a good or service comes to be known as a source indicator—happens very rarely. One often mentioned example is “Singer” for sewing machines. The term “Singer” once referred to a machine produced according to the technique in Singer’s expired patent but has now come to indicate the Singer company. See *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Singer Mfg. Co. v. Redlich*, 109 F. Supp. 623 (S.D. Cal. 1952). See generally Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J.L. & TECH. 110 (2015) (describing the ways in which words change meaning over time).

<sup>53</sup> See AMERICAN AIRLINES, Registration No. 4,939,082 (issued Apr. 19, 2016, for, *inter alia*, air transport of passengers). A Notation to File, dated September 16, 2015, indicates that the registration was issued pursuant to 15 U.S.C. § 1052(f).

<sup>54</sup> *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

<sup>55</sup> 15 U.S.C. § 1064(3) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”); see also *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (“[T]o establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”). Section 1064 pertains to the cancellation of registrations but is now widely understood to also apply to the granting of registrations.

<sup>56</sup> 15 U.S.C. § 1064(3); see also *Bayer*, 272 F. at 510 (determining that “Aspirin” was understood as a trademark by manufacturing chemists, and retail druggists but as a generic term by the general public). Of course, there can be more than one generic term for a good, such as “car,” “automobile,” and “motor vehicle.”

<sup>57</sup> Early cases include *Singer*, 163 U.S. at 179 (noting that the argument that “Singer” could not be generic for sewing machines because many different types of machines existed “fail[s] to distinguish between genus and species”); *Buffalo Specialty Co. v. Van Cleef*, 227 F. 391, 394 (7th Cir. 1915) (in trademark dispute over the term “Neverleak” for a tire fluid, noting that “[t]ire fluid” was the name of the genus, and “Neverleak” was the name of appellant’s species” and so served as a trademark); *Bayer*, 272 F. at 513 (“The validity of a trade-mark does not, indeed, rigidly depend upon its meaning only the differential between a genus, defined by the kind of goods, and a species, defined by that kind when emanating from the owner.”). On the usefulness of this terminology, see Greenbaum et al. *supra* note 8, at 110 (“Imposition of this Linnean classification system does nothing to advance analysis of the central question . . . . In fact, the genus-species test’s application of irrelevant biological rubrics tends to substitute for analysis.”).

however, consumers not trained in the law might say that whether a term is generic or can serve as a trademark depends not on any conceptual vocabulary but rather on whether the term is perceived as akin to a proper name or as the common name for a good or service.

Many might have an intuitive sense of this distinction with respect to personal names. We know, for example, that “Fido” is a proper name and “dog” is a common name.<sup>58</sup> In such circumstances, as D. Geoffrey Hall has written with respect to children’s ability to distinguish between the two, both semantic and syntactic cues help us to decide whether a word is a proper noun or a common noun. As Hall writes,

The first of these cues is *semantic*: properties of certain kinds of objects make them good candidates for receiving proper nouns. The individuality of the members of many kinds of animate objects, like people and pets, is important, but the individuality of members of other kinds, such as pencils or socks, is not. A second cue is *syntactic*: certain linguistic markers make some words better candidates for being proper nouns. In English, proper nouns typically are not preceded by determiners (e.g., we say “Garfield”), whereas count nouns may be preceded by determiners (e.g., we say “a cat” or “the pet”).<sup>59</sup>

Thus, while the same lexical unit might serve both as a common noun and as a proper noun (for example, the concept of “faith” and the personal name “Faith”), the cues that Hall describes typically allow us to determine which one is meant in a particular context.

Trademarks complicate this framework, however, in multiple ways. First, because trademarks are the names of products and services in a commercial space rather than a personal space, goods that would not take proper names in a nontrademark world take the equivalent of proper names in a trademark world. We might not expect our socks to bear a proper name as a semantic matter (in other words, unless we are particularly fond of them, we do not typically call our socks Fluffy or Fido), but our socks might very well bear the name Bombas or Nike in the marketplace.<sup>60</sup>

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<sup>58</sup> Several studies have examined the ways in which children come to distinguish between proper names and common names. See, e.g., Susan A. Gelman & Marjorie Taylor, *How Two-Year-Old Children Interpret Proper and Common Names for Unfamiliar Objects*, 55 CHILD DEV. 1535, 1539 (1984) (reporting results of study in which the experimenters assigned nonsense names and words to toys (“Zav” versus “a zav”) and asked children to categorize them); see also, e.g., Nancy Katz, Erica Baker & John Macnamara, *What’s in a Name?: A Study of How Children Learn Common and Proper Names*, 45 CHILD DEV. 469 (1974); D. Geoffrey Hall, *Acquiring Proper Nouns for Familiar and Unfamiliar Animate Objects: Two-Year-Olds’ Word-Learning Biases*, 62 CHILD DEV. 1142 (1991).

<sup>59</sup> Hall, *supra* note 58, at 1142.

<sup>60</sup> Hence, we see the other common way of describing a trademark as answering the question “Who

Second, because of the way we talk about trademarked goods, syntactic clues are also not as helpful. We might not typically use determiners before a proper name (we say “Fido,” not “a Fido” or “the Fido”), but it is not uncommon to use trademarks with determiners, despite the canard that trademarks are adjectives that modify a common noun. Thus, we might not often spell out, “I plan to buy a Ford automobile” or “I’d like to order a Budweiser beer,” but we might well say, “I plan to buy a Ford” or “I’d like to order a Budweiser.”

Third, and relatedly, because trademarks are indicative of the source of a product and not the individual product purchased by a consumer, trademarks used in this way appear to refer solely to the product itself but in reality refer additionally to the producer of that product. In other words, the assertion “I plan to buy a Ford” means “I plan to buy a car made by the company that manufactures Fords with the set of qualities associated with a Ford that are not associated with other brands of cars,” and the assertion “I’d like to order a Budweiser” means “I’d like to order a beer made by the producer that makes Budweiser with the set of qualities associated with a Budweiser that are not associated with other brands of beer.”<sup>61</sup>

Thus, when a trademark is used by a speaker to represent a class of goods (such as “kleenex” for facial tissues generally), the question is whether that usage will be understood as referencing a set of class descriptions (a paper product used to blow one’s nose) or also a set of distinctive qualities (the thickness or softness associated with the Kleenex brand). When only the first becomes the understood usage, we can say that the term has become generic; when the word, in some usages, still references quality indicators, it has retained trademark significance in such contexts.<sup>62</sup> As Dan Sperber and Deirdre Wilson describe it, these are “cases of category extension,” meaning “extending a word with a relatively precise sense to a range of items that clearly fall outside its linguistically-specified denotation but that share some contextually

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are you?” rather than “What are you?” See 1 MCCARTHY, *supra* note 42, § 3:9.

<sup>61</sup> Ronald R. Butters & Jennifer Westerhaus, *Linguistic Change in Words One Owns: How Trademarks Become “Generic,”* in STUDIES IN THE HISTORY OF THE ENGLISH LANGUAGE II: UNFOLDING CONVERSATIONS 111, 112 (Anne Curzan & Kimberly Emmons eds., 2004) (“A trademark thus is really a kind of proper noun, but one that still refers to a class of things (e.g., Mercedes automobiles) rather than to a unique entity (e.g., Mercedes Norton, the first author’s third-grade music teacher) or place (e.g., Mercedes, Texas).”).

<sup>62</sup> My thinking here has been influenced by a discussion by Karen Sullivan and Eve Sweetser, although I depart from the authors’ suggestion that the use of “kleenex” for tissues not made by Kimberly-Clark is imputing “Kleenex-level Tissue Qualities” to the other product. Karen Sullivan & Eve Sweetser, *Is “Generic Is Specific” a Metaphor?*, in MEANING, FORM, AND BODY 309, 317–18 (Fey Parrill, Vera Tobin & Mark Turner eds., 2010).

relevant properties with items inside the denotation.”<sup>63</sup> The goal is to determine when the specified denotation no longer pertains.

In some ways, genericism can be considered akin to the doctrine of functionality for product features. Both concepts embody the idea that competitors need access to certain aspects associated with a good in order to compete effectively in the market—either a term that represents the common name for the product or service one is selling or a product feature that is desired by consumers for non-source-identifying reasons (assuming that feature is not protected by a patent). But there is only so much that can be gained by referring to genericism as the equivalent of functionality. De jure functionality, as a matter of trademark law, is a doctrine that denies trademark protection for a feature *despite* the feature’s serving as a source indicator; it is a doctrine justified by the policy that a competitor is free to copy a functional product feature if it is not protected by a patent.

Under that doctrine, an entity cannot assert trademark rights in a product feature that is deemed to be functional even if the entity can show that the feature is distinctive of source. To take the example from *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, the Supreme Court’s signal case on utilitarian functionality, the dual-spring sign stand design at issue in the case could not be claimed as protectable trade dress despite the fact that years of patent exclusivity had arguably led consumers to understand the design as indicating Marketing Displays, Inc. (MDI) as the source of the stands.<sup>64</sup> Since the patent had expired, TrafFix was entitled as a matter of patent law to copy the design and compete in the market for such sign stands, and the Court held that this interest outweighed any interests in prohibiting use of the feature as a matter of trademark law.<sup>65</sup> In other words, the Court did not hold that the dual-spring design was not distinctive of source; it held that MDI had no trademark rights in the design *despite* the possibility of its being distinctive of source.<sup>66</sup> By contrast, a finding that a term is generic is not a conclusion that a term should be available to competitors despite its serving as a source indicator; a finding that a term is generic is a determination that a term does not serve as a source indicator. Thus, while a generic term could be said to be de facto functional, in that the use of a generic term serves the important function of allowing efficient conversation about goods and

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<sup>63</sup> Dan Sperber & Deirdre Wilson, *A Deflationary Account of Metaphors*, in *THE CAMBRIDGE HANDBOOK OF METAPHOR AND THOUGHT* 84, 91 (Raymond W. Gibbs, Jr. ed., 2008).

<sup>64</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

<sup>65</sup> *Id.* at 29 (discussing the “well-established rule that trade dress protection may not be claimed for product features that are functional”).

<sup>66</sup> *Id.* at 35 (“MDI cannot gain the exclusive right to produce sign stands using the dual-spring design by asserting that consumers associate it with the look of the invention itself.”).

services, little is gained by introducing a concept of de jure functionality into the mix.

Likewise, if, as Justice Breyer suggested in his dissent in *Booking.com*, we should exclude certain terms from protection despite their serving as a source identifier because we are concerned about the scope of trademark rights<sup>67</sup>—that an entity that can secure rights in “booking.com” will seek to extend those rights to enjoin the use of “hotelbooking.com” and so forth—we should be clear that the principle motivating that argument is not that the term at issue is generic. Rather, the principle is that there is a competing policy that should deny trademark protection to the term despite its serving as a source indicator, just as *TrafFix* denied protection to the dual-spring design in question regardless of any evidence that consumers perceived the trade dress of the feature as a source indicator. And, similar to *TrafFix*, because such a principle would operate outside of the genericism inquiry, it would need not only its own doctrinal name but also a test to determine when such limitations should apply.<sup>68</sup>

Alternatively, courts could, in particular cases, determine remedies that would achieve limitations on scope without altering the genericism inquiry. One example comes from *Genesee Brewing Co. v. Stroh Brewing Co.*, in which the court enacted something akin to defense-side genericism by holding that the phrase “Honey Brown” was generic as applied to defendant’s ales while leaving open the possibility that the phrase could continue to serve as a trademark for plaintiff’s lager.<sup>69</sup> The nominative/descriptive fair use hybrid that characterizes the space given to comparative advertising (“compare to”) or private label or store brand trade dress<sup>70</sup> might be another source of inspiration.

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<sup>67</sup> See generally Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197 (2016).

<sup>68</sup> See, e.g., Vincent N. Palladino, *Genericism Rationalized: Another View*, 90 TRADEMARK REP. 469 (2000) (proposing a multifactor test for genericism based on competitive need).

<sup>69</sup> *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137 (2d Cir. 1997). In my view, the court in *Louboutin v. Yves Saint Laurent* created a form of defense-side aesthetic functionality by amending Louboutin’s registration for a red outsole so that it covered only a red outsole contrasting with the remainder of the shoe. *Christian Louboutin, S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 225 (2d Cir. 2012) (“Although . . . we determine that the Mark as it currently stands is ineligible for protection *insofar as it would preclude competitors’ use of red outsoles in all situations*, including the monochromatic use now before us, we conclude that the Mark has acquired secondary meaning—and thus the requisite ‘distinctness’ to merit protection—when used as a red outsole contrasting with the remainder of the shoe.”) (emphasis added).

<sup>70</sup> Cf. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002) (“The nominative fair use analysis is appropriate where a defendant has used the plaintiff’s mark to describe the plaintiff’s product, even if the defendant’s ultimate goal is to describe his own product. Conversely, the classic fair use analysis is appropriate where a defendant has used the plaintiff’s mark only to describe his own product, and not at all to describe the plaintiff’s product.”) (footnote and emphases omitted).



The focus on consumer understanding might also seem to some to run up against what is perceived as a doctrinal rule that a generic term can never gain trademark status, no matter the efforts of an entity to make it so. This rule was articulated perhaps most famously in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,<sup>71</sup> the source of the ubiquitous “spectrum of distinctiveness.” In describing the nature of generic terms, the Second Circuit noted that because the Lanham Act provides for cancellation of registered marks if they have become generic,

even proof of secondary meaning, by virtue of which some “merely descriptive” marks may be registered, cannot transform a generic term into a subject for trademark . . . . [N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.<sup>72</sup>

But the cases the court cites for this proposition are examples of what has been called “de facto secondary meaning”—an association between a manufacturer and a term that results from exclusivity or market share but that is not an association reflecting source distinctiveness.<sup>73</sup> For example, if a product is new and so is available only from one company, consumers might associate the common name of the product with that company. If a group of consumers were asked with which company they associated the term “self-driving car,” many of them might (at the time of this writing) say “Tesla.” But that is not “secondary” meaning, since “self-driving car” continues to be the common name of the product for such consumers; rather, it is simply a reflection—bound up with the vague term

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<sup>71</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

<sup>72</sup> *Id.* at 9. At the time, section 14 of the Lanham Act provided for cancellation of a registration if the mark had become “the common descriptive name of an article or substance.” *Id.* The statutory language now provides for cancellation if, *inter alia*, the mark “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” 15 U.S.C. § 1064(3) (2018).

<sup>73</sup> *See, e.g.*, *J. Kohnstam Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960) (affirming refusal to register “matchbox” for toy vehicles when term for packaging was in the dictionary and had been in use for toys prior to applicant’s use of it; even if applicant was the sole user of the term for toys for a period thereafter, and so “the public might [have] come to associate that source with the name by which the merchandise is called,” the term remained generic “no matter how much money or effort [the producer] pours into promoting the sale of the merchandise”); *In re Performed Line Prods. Co.*, 323 F.2d 1007, 1008 (C.C.P.A. 1963) (affirming refusal to register “Performed” for accessories for electrical cables and similar goods given applicant’s own descriptive use of the term; the fact that competitors used different terms to describe products shaped in advance of use and evidence of applicant’s advertising and sale volume did not change the nature of the term); *Weiss Noodle Co. v. Golden Caracknel & Specialty Co.*, 290 F.2d 845, 847–48 (C.C.P.A. 1961) (discussing cases “in which various marks had in fact come to indicate origin or had acquired what we may call ‘de facto secondary meanings,’ due to temporary use by no one other than the applicant, for example, yet which cannot be registered” and noting that although companies that invest in advertising might “succeed in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect”).

“association”<sup>74</sup>—of the market share (and so top-of-mind status) Tesla currently holds. The concept can be further confused by surveys that present a product term to respondents and ask whether “one company makes this or more than one company makes this,” since in cases in which one manufacturer holds a strong market share, the answer might be “one.”<sup>75</sup>

The first use of the term “de facto secondary meaning” in a reported case appears to be in *In re Deister Concentrator Co.*, in which the court concluded that the USPTO appropriately refused registration for a rhomboidal shape for ore concentrating and coal cleaning tables.<sup>76</sup> Noting that the evidence in the case led to the conclusion that the shape was functional and thus subject to copying, and referencing the Supreme Court’s 1938 opinion in *Kellogg Co. v. National Biscuit Co.* (the “shredded wheat” case),<sup>77</sup> the *Deister* court noted a distinction between what it called “a de facto ‘secondary meaning’ and one to which courts will attach legal consequences.”<sup>78</sup> This distinction, the court wrote, meant that

as to some words and shapes the courts will never apply the “secondary meaning” doctrine so as to create monopoly rights. The true basis of such holdings is not that they cannot or do not indicate

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<sup>74</sup> The lack of specificity around what kind of association is legally relevant can also prove problematic in dilution cases. In *Nike, Inc. v. Nikepal Int’l, Inc.*, for example, the court determined that because the six statutory factors that a court “may consider” to determine “whether a mark or trade name is likely to cause dilution by blurring” favored Nike, including whether there is “[a]ny actual association between the mark or trade name and the famous mark,” there was a likelihood that Nike would suffer dilution if Nikepal were allowed to continue use of its name. *Nike, Inc. v. Nikepal Int’l, Inc.*, No. 2:05-cv-01468, 2007 WL 2782030, at \*6, \*8 (E.D. Cal. Sept. 18, 2007); see also 15 U.S.C. § 1125(c)(2)(A) (2018). The court did not, however, make a determination, based on these factors, that dilution was indeed likely to occur. See also Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel H. Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611, 617 (2019) (presenting experimental evidence that “even when consumers associate a junior mark with a famous senior mark, this association does not necessarily result in any impairment of the ability of the senior mark to identify and distinguish its source and other associations”).

<sup>75</sup> *Cf., e.g., E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975) (concluding that plaintiff’s survey asking about a product “made by one company” showed evidence that the term “Teflon” was a brand name).

<sup>76</sup> *In re Deister Concentrator Co.*, 289 F.2d 496, 502 (C.C.P.A. 1961).

<sup>77</sup> In *Kellogg*, the Court rejected the National Biscuit Co.’s claim to trademark rights over the term “shredded wheat,” given that the term was the generic name of the product, and noted that what National Biscuit Co. claimed to be secondary meaning was actually only evidence

that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff’s factory at Niagara Falls. But to establish a trade name in the term “shredded wheat” the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer. This it has not done.

*Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

<sup>78</sup> *Deister*, 289 F.2d at 503.

source to the purchasing public but that there is an overriding public policy of preventing their monopolization, of preserving the public right to copy.<sup>79</sup>

Thus, the court used the term “de facto secondary meaning” not as the basis for holding a product feature unprotectable under trademark law but to describe existing source association for a product feature already deemed unprotectable under trademark law.

As applied to product features, the court’s holding—derived in part from *Kellogg* and echoed in the Court’s later opinion in *TrafFix*—reflects competition policy. It is unclear from the opinion the precise nature of the evidence regarding consumer perception as to the table shape—in other words, whether it was an association emanating from market share or an association suggesting source distinctiveness. Regardless, the doctrine that says that functional features should be available to competitors to copy despite evidence of source distinctiveness reflects, as the *Deister* court notes, “an overriding public policy . . . of preserving the public right to copy.”<sup>80</sup>

But it is more difficult to see how this works for word marks, despite the *Deister* court’s reference to them.<sup>81</sup> An “overriding public policy” of preserving the public’s right to use certain words as common names for goods or services despite public understanding of those words as source indicating has to be rooted in the conclusion that those words are not, in fact, source indicating.<sup>82</sup> The *Abercrombie* court acknowledged this, in my opinion, when it referred to

a series of well known cases holding that when a suggestive or fanciful term has become generic as a result of a manufacturer’s own advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue.<sup>83</sup>

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<sup>79</sup> *Id.* at 504.

<sup>80</sup> *Id.*

<sup>81</sup> 2 MCCARTHY, *supra* note 42, § 12:47 (noting that “[i]n the context of the ‘functionality’ issue, rejecting proof of trademark status as ‘de facto secondary meaning’ has some semantic meaning” but that courts that have taken the phrase from such cases and used it for genericism disputes have “misapplied it”).

<sup>82</sup> *Id.* § 12:46 (“In the context of generic names disputes, so-called ‘de facto secondary meaning’ is a misnomer. . . . [E]vidence of secondary meaning (such as a survey) is evidence of trademark significance and is evidence negating a genericness challenge.”); *see also* Vincent N. Palladino, *Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys*, 92 TRADEMARK REP. 857, 857 (2002) (“The notion that secondary meaning and genericness are opposite sides of the same coin follows logically from the nature of trademarks.”).

<sup>83</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976) (citing *Bayer Co. v. United Drug Co.*, 272 F. 505 (2d Cir. 1921); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75 (2d Cir. 1936); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963)).

Thus, the suggestion that genericism is the equivalent of functionality, the “rule” of “once generic, always generic,” and the concept of “de facto secondary meaning” all seem to be rooted in the idea of genericism as a state of nature, existing separate from considerations of how language is used and understood. But there are no lexical or other characteristics that tell us why “car” is generic for a particular kind of motor vehicle apart from the fact that speakers of English understand it in precisely this way, at this moment in time,<sup>84</sup> just as speakers of French understand “voiture” in the same way. It is only in the disputed cases, of course, that we need to resort to sources beyond our own intuition to make this determination.

### III. HOW SHOULD CONSUMER PERCEPTION BE DETERMINED?

If categorizing a term as generic or as a trademark depends on consumer understanding, where should we look for evidence of understanding and how should we assess it? As the Court noted in *Booking.com*, “Evidence informing that inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.”<sup>85</sup> This does not mean, of course, that we need the same amount of evidence in every case to conclude that a term is generic. If an automobile manufacturer attempted to claim trademark rights in the word “car,” administrative efficiency would counsel that very little beyond the court’s own understanding, as reflecting common knowledge, would be needed (with, perhaps, a citation to the dictionary for good measure), even though each of us might have a different picture in our minds when asked to imagine what a “car” looks like.

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<sup>84</sup> Cf. Linford, *supra* note 52 (describing the ways in which words change meaning over time).

<sup>85</sup> U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298, 2307 n.6 (2020). *But see* Desai & Rierison, *supra* note 10, at 1833 (rejecting evidence such as dictionary definitions and media uses as not indicative of “what should be the core question in any genericism determination: whether the mark is functioning as a source-identifier in the relevant commercial context”).

Consumer perception can, of course, be influenced by design elements and placement, among other choices. Possidonia F.D. Gontijo, Janice Rayman, Shi Zhang & Eran Zaidel, *How Brand Names Are Special: Brands, Words, and Hemispheres*, 82 *BRAIN & LANGUAGE* 327, 335 (2002) (“[W]e suggest [based on an experiment] that the visual representation of proper names, brand names and also that of abbreviations is an intrinsic part of their identities. The visual features are clues to the lexical category to which a word belongs.”); Thomas R. Lee, Glenn L. Christensen & Eric D. DeRosia, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, 57 *EMORY L.J.* 575, 575 (2008); David Luna, Marina Carnevale & Dawn Lerman, *Does Brand Spelling Influence Memory? The Case of Auditorily Presented Brand Names*, *J. CONSUMER PSYCH.* 36, 37–38 (2013) (“Through the lexical (or direct) route, a top-down process occurs as individuals access the spelling of a word by retrieving its lexical representation from long term memory. That is, individuals access the spelling of the target word by referring to a representation in memory of that word or another word that contains the same pronunciation pattern.”).

In more difficult cases, the ability to collect and search information online provides a rich resource of evidence as to consumer understanding. Corpora have become increasingly discussed as a source of consumer perception, in part because corpora exist free from the bias of litigation—they are uses in the wild, as it were.<sup>86</sup> Social media provides another corpora-like source of consumer perception, as Alexandra Roberts has thoughtfully examined in this issue,<sup>87</sup> so long as we keep in mind that the use of certain sites—and, indeed, access to the Internet itself—will be mediated by characteristics such as educational level and socioeconomic class.<sup>88</sup> Lisa Larrimore Ouellette has advocated for using Google search results to determine whether “most users searching for a term are looking for a particular source or whether they are looking for a product in general,” given that Google’s algorithms are designed to provide results responsive to what users are looking for.<sup>89</sup>

It is also important to interpret this evidence in a way that helps to answer the question at hand. The lack of capitalization, particularly on social media, is not necessarily evidence of consumer understanding of a term as generic, nor is the absence of a paired generic term or use of a mark as a noun (such as when one orders “a coke”). Conversely, given that Microsoft Word autocorrects certain lowercase words to capitalize them (such as, at this writing, Kleenex and Velcro) and Google does not, at this writing, enable case-sensitive search (such that searches for “kleenex” will return results for “Kleenex”),<sup>90</sup> observed uses of capitalization might not be evidence of consumer recognition of the term as a trademark. Similarly, consumers can use marks in ways that resemble generic uses or as a verb while still recognizing the term as a trademark (such as when an individual asks someone to “xerox” a document or “google” information).<sup>91</sup> In short, as Neal Hoopes has noted,

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<sup>86</sup> See Quentin J. Ullrich, *Corpora in the Courts: Using Textual Data to Gauge Genericness and Trademark Validity*, 108 TRADEMARK REP. 989 (2018).

<sup>87</sup> Alexandra J. Roberts, *Mark Talk*, 39 CARDOZO ARTS & ENT. L.J. 1001 (2021).

<sup>88</sup> For example, according to information provided by Yelp, as of June 2021, 76% of U.S. Yelp users have attended at least some college, and 79% of U.S. Yelp users have an annual income of \$60,000 or above. *Fast Facts*, YELP, <https://www.yelp-press.com/company/fast-facts/default.aspx> [<https://perma.cc/C6TH-ZEVA>] (last visited Sept. 10, 2021).

<sup>89</sup> Lisa Larrimore Ouellette, *The Google Shortcut to Trademark Law*, 102 CALIF. L. REV. 351, 398, 401 (noting that “Google generally provides sites [in its search results] related to what users search for (which it has profit-based incentives to do)” and that “it evaluates algorithm changes based on whether the change increases the frequency with which users click on the top search results”).

<sup>90</sup> See *How to Search on Google*, GOOGLE SEARCH HELP, <https://support.google.com/websearch/answer/134479> [<https://perma.cc/T5MP-TDP9>] (last visited Apr. 23, 2021) (“A search for New York Times is the same as a search for new york times.”).

<sup>91</sup> See, e.g., *Elliot v. Google, Inc.*, 860 F.3d 1151, 1159 (9th Cir. 2017) (declining to find GOOGLE generic even though some members of the public used “google” as a verb); Itamar Simonson, *An Empirical Investigation of the Meaning and Measurement of “Genericness,”* 84 TRADEMARK REP. 199, 214 (1994) (suggesting that “genericness measures should identify (1) the share of buyers for whom the disputed name has just one meaning as a generic term or a trademark, (2) the share of

“[L]inguistic data alone—including dictionary definitions, newspaper and magazine examples, and corpus linguistic data—cannot conclusively show how the public perceives a mark. This is so because linguistic data reflects usage.”<sup>92</sup>

Because of the opportunity to clarify and ask follow-up questions, consumer surveys, while considerably more expensive to conduct than corpus analysis, can provide a more nuanced window into consumer understanding. Two types of surveys have traditionally been deployed in genericism cases. The first has come to be known as a *Thermos* survey, after the term at issue in the case in which it was first approved.<sup>93</sup> In a *Thermos* survey, qualified respondents are asked a series of questions that begins with describing a class of goods to the respondent, then asking the respondent, for example, what word or words they would use in order to obtain the item in a store, what other words they might use for such an item, and whether the respondent can identify the names of any manufacturers who make such an item.<sup>94</sup> Thus, for example, a *Thermos* survey testing the trademark BUBBLE WRAP might begin by asking respondents whether they are familiar with a product that is used to wrap fragile items for shipping and consists of a sheet of plastic with pockets of sealed air. If the respondent indicates such a familiarity, they might then be asked what word or words they would use to obtain this item in a store, whether they can think of any other words for such an item, and whether they can identify the names of any manufacturers of such an item.<sup>95</sup> In this example, if consumers have difficulty identifying the product as anything other than “bubble wrap,” that might give the Sealed Air Corporation pause as to the continuing strength of its trademark.<sup>96</sup>

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buyers for whom the disputed name has a dual meaning, and (3) which meaning of dual functioning names is more commonly used”); Thomas E. Murray, *From Trade Name to Generic: The Case of Coke*, 43 NAMES 165 (1995); Butters & Westerhaus, *supra* note 61, at 121 (“Lexicographical practice ought to be based on the fact that, while people do use trademarks as verbal shorthand, they are generally aware that they are, in reality, speaking synecdochically: that a *Band-Aid*<sup>®</sup> is a special kind of plastic bandage, that *Jello*<sup>®</sup> is a special kind of gelatin dessert, and that a reference to a ‘*Disney*’ *Beanie*<sup>®</sup> is just a convenient synecdoche and not compelling evidence of genericide.”); Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313 (2010); Timothy Greene, *Trademark Hybridity and Brand Protection*, 46 LOY. U. CHI. L.J. 75, 92 (2014) (“Trademark hybridity . . . recognizes that a term need not be understood for either its generic or its source identifying function. According to hybridity, both functions can, and do, coexist—depending on the context in which the term is used.”).

<sup>92</sup> Neal A. Hoopes, *Reclaiming the Primary Significance Test: Dictionaries, Corpus Linguistics, and Trademark Genericide*, 54 TULSA L. REV. 407, 431 (2019).

<sup>93</sup> *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9 (D. Conn. 1962), *aff’d sub nom. King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963).

<sup>94</sup> 2 MCCARTHY, *supra* note 42, § 12:15.

<sup>95</sup> The interpretation of responses to this last question should not run afoul of trademark law’s anonymous source doctrine, which does not require consumers to know the corporate name of the company that makes a product so long as they recognize the trademarks that the company uses for the product. *See* 1 *id.* § 3:12.

<sup>96</sup> *See* BUBBLE WRAP, Registration No. 1,247,076 (issued Aug. 2, 1983, for “cellular cushioning

The second kind of genericism survey is known as a *Teflon* survey, after the term at issue in the case in which it was first approved.<sup>97</sup> In a *Teflon* survey, the respondent is first given a minicourse in the difference between a brand name and a common name, typically by being given examples of each that are presumed to be obvious (such as “Chevrolet” as an example of a brand name and “car” as an example of a common name). The respondent is then tested with at least one additional example (e.g., “Is ‘Pepsi’ a common name or a brand name? Is ‘cola’ a common name or a brand name?”). Respondents who answer correctly are then presented with a list to sort into one of the two categories, with the trademark at issue included among the list.<sup>98</sup> The idea is that by comparing the results for the trademark at issue with the results for other words in the list, one can determine whether the mark at issue is understood by consumers as a source indicator or as a generic term.

Although a *Teflon* survey is now generally considered to be the preferred method,<sup>99</sup> both types of surveys have their positives and negatives.<sup>100</sup> A *Thermos* survey, unlike a *Teflon* survey, is rooted in the consumer experience, as it asks consumers to imagine themselves asking for an item in a store. But it might, in some instances, be open to misinterpretation. Consider, for example, the consumer who uses “kleenex” in casual conversation to refer to any kind of facial tissue but who also understands that KLEENEX is a trademark for one particular facial tissue. Such a consumer might answer the question “If you were to ask a store clerk for an item that you would use to blow your nose, what word would you use?” with “kleenex” regardless of this understanding. The follow-up question “Can you think of any other words you would use to describe this item?” might elicit the term “facial tissue” or “tissue,” but unless the respondent understands the question to be asking for other terms that *one* might use for that item, the answer might not be as useful as originally thought.<sup>101</sup>

A *Teflon* survey might be seen as comparatively easier to administer and code, since answers require little in the way of interpretation. But a *Teflon* survey can also prove problematic. First, the survey’s format must

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packaging material which contains entrapped bubbles of air or other gases”).

<sup>97</sup> *E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975).

<sup>98</sup> 2 MCCARTHY, *supra* note 42, § 12:16.

<sup>99</sup> E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TRADEMARK REP. 1118, 1131 (2009) (“Since *E. I. Du Pont de Nemours*, 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.”).

<sup>100</sup> See Ullrich, *supra* note 86, at 995–1001 (describing benefits and drawbacks of both kinds of surveys).

<sup>101</sup> There are, of course, concerns regarding this kind of survey more generally, such as the possibility of interpreter or interviewer bias or coding issues.

convey to consumers that words serve as trademarks not in the abstract but in context. A truly correct answer to the question as to whether any term is a brand name or a common name should be “I don’t know—it depends on the good or service with which it is associated.” Thus, the question “Is ‘diesel’ a brand name or a common name?,” if presented with no additional explanatory material, should yield the answer “It depends,” since “diesel” would be considered generic for a type of fuel used in motor vehicles and would be an arbitrary mark for clothing.<sup>102</sup> Additionally, the choice of terms used for the minicourse or the pretest might influence consumers in their understanding of what it means to be a trademark. In the example given above, the use of “Pepsi” to represent a trademark might unintentionally convey that trademarks must be fanciful or arbitrary terms.

This concern was present in the *Teflon* survey submitted by Booking.com B.V. in *Booking.com*,<sup>103</sup> where the terms in the minicourse identified as trademarks were TOYOTA, CHASE, and STAPLES.COM, while the terms identified as generic were AUTOMOBILE, BANK, and OFFICESUPPLIES.COM.<sup>104</sup> According to the survey expert, STAPLES.COM and OFFICESUPPLIES.COM were included to minimize the chance that respondents would think that any “.com” term was a trademark:

This allows us to compare the perceptions of BOOKING.COM to other DOT-COM terms that clearly do or do not function as brands in order to assess whether consumer perception of BOOKING.COM as a brand name meaningfully exceeds the rate at which respondents will answer that a generic term with “.com” at the end is a brand.<sup>105</sup>

But it is not obvious why STAPLES.COM “clearly” functions as a brand while OFFICESUPPLIES.COM does not, except to the extent that the juxtaposition of STAPLES.COM and OFFICESUPPLIES.COM indicated to consumers that the comparison they were intended to make was between Staples, the brand name of an office supply chain, and “office supplies.” While the company does hold a registration for STAPLES.COM,<sup>106</sup> it is likely that respondents did not see that term as a

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<sup>102</sup> See DIESEL, Registration No. 1,564,710 (registration for various types of apparel).

<sup>103</sup> Expert Report of Hal Poret: Survey to Assess Whether BOOKING.COM Is Perceived to Be a Trademark or a Generic Name, Joint App. at 35–134, U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298 (2020) (No. 19-46).

<sup>104</sup> *Id.* at 44–45. The terms in the survey, which was conducted online, were presented visually to respondents and in all uppercase letters, which I have replicated here.

<sup>105</sup> *Id.* at 43.

<sup>106</sup> STAPLES.COM, Registration No. 2,397,238 (registration for “mail order catalog services via a global computer network featuring office supplies” and other goods). When visited in September 2021, the URL <https://www.staples.com> did not feature “STAPLES.COM” as a name anywhere on



whole as the name of the company; rather, they recognized it as the website for the company Staples. And although no company currently holds a federal trademark registration for OFFICESUPPLIES.COM, the company Officesupplies.com, Inc., did succeed in registering it on the Supplemental Register in 2001 for office equipment and related goods, based on a conclusion by the examiner that the mark was merely descriptive but capable of becoming distinctive (although the registration was cancelled in 2008 for failure to file a Section 8 declaration of use).<sup>107</sup>

The survey confused things further when it moved on to the sorting task. Respondents who correctly answered the post-minicourse test (which asked them to characterize the terms “Kellogg” and “cereal”) were then told:

You will now see a series of **bolded** terms, one at a time, that you may or may not have seen or heard before. Under each term, you will also see a description of products or services for that term. For each term shown in bold, please answer whether you think the term is a ***brand*** name or a ***common*** name in the context of the products or services described. Or if you don’t know, you may select that option.<sup>108</sup>

Some of the language in these instructions might have cued respondents to think of the survey as a test of their ability to guess correctly. Although the instructions tell respondents that they “may or may not have seen or heard” the terms they will be shown, they are then told to indicate “whether you think the term is a brand name or a common name in the context of the products or services described.” Respondents were told that “if you don’t know, you may select that option,” but asking “whether you *think* the term is a brand name or a common name,” rather than something like “whether, in your experience, you *understand* the term to be a brand name or a common name” ran the risk of divorcing the responses from the consumer experience.

The list of terms that respondents were asked to identify as either a brand name or a common name (or to answer that they didn’t know) were accompanied by product descriptions. In addition to BOOKING.COM, the list included three brand names and descriptions and three “generic (i.e., common name) terms.”<sup>109</sup> The three brand names and their descriptions were ETRADE.COM (described as “Stock and investor broker services”); PEPSI (described as “Cola and other soft drinks”); and SHUTTERFLY (described as “Photo-sharing and photo gifts service”).

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the home page; the page title in the browser tab was “Staples® Official Online Store.”

<sup>107</sup> OFFICESUPPLIES.COM, Registration No. 2,478,700 (issued on the Supplemental Register on Aug. 14, 2001; cancelled on May 16, 2008).

<sup>108</sup> Expert Report of Hal Poret, *supra* note 103, at 46 (emphases in original).

<sup>109</sup> *Id.* at 47.

The three generic terms were SPORTING GOODS (described as “Products used in sports and other physical activity”); WASHINGMACHINE.COM (described as “Reviews and sales of washing machines”); and SUPERMARKET (described as “Retail sale of food and other groceries”).<sup>110</sup> The fact that 74.8% of respondents identified BOOKING.COM as a brand name while only 33% of respondents identified WASHINGMACHINE.COM as a brand name led the expert to conclude that a meaningful percentage of consumers understood BOOKING.COM to be a brand name for reasons other than its lexical formation.<sup>111</sup>

The description for WASHINGMACHINE.COM, however, was inaccurate. Unlike “supermarket,” the term “washingmachine.com” is not a term used by consumers in any way except as part of a URL; as a URL, [www.washingmachine.com](http://www.washingmachine.com) immediately redirects (as of this writing) to the site of the online home goods store Wayfair at [www.wayfair.com](http://www.wayfair.com). The company does sell washing machines, but its site could not reasonably be described, as the survey implies, as a site that *only* provides reviews and sales of washing machines.<sup>112</sup> And even though this survey’s respondents were told they could answer that they didn’t know how to characterize a term, only 6.3% of respondents answered “don’t know,”<sup>113</sup> despite likely never having encountered or used the term WASHINGMACHINE.COM.<sup>114</sup>

This example suggests that a *Teflon* survey might not capture consumer understanding in the marketplace; rather, it might capture only whether respondents are good students. Respondents might correctly sort the given list into either the trademark category or the common name category based on what they have been told about the mark (by the company’s educational advertising campaign, for example), or based on their hunches about what is likely to look like a generic term, but that does not necessarily correspond to how the consumer understands the

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<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 66–67.

<sup>112</sup> Wayfair registered the domain in November 1999. See *ICANN Lookup*, <https://lookup.icann.org/lookup> (search for WASHINGMACHINE.COM). A search of the Internet Archive’s Wayback Machine indicates that the URL has redirected to Wayfair’s site since as early as September 2017. See *Wayback Machine*, <https://archive.org> (search for WASHINGMACHINE.COM).

<sup>113</sup> Expert Report of Hal Poret, *supra* note 103, at 66. Of the seven terms tested, the percentage responding “don’t know” was highest for WASHINGMACHINE.COM at 6.3%. Zero respondents answered “don’t know” with respect to SUPERMARKET and SPORTING GOODS; 0.3% of respondents answered “don’t know” with respect to each of ETRADE.COM and SHUTTERFLY.COM; and 1.5% of respondents answered “don’t know” with respect to BOOKING.COM. *Id.* at 65–66.

<sup>114</sup> *Cf.* Greenbaum et al., *supra* note 8, at 119 n.49 (suggesting that *Teflon* surveys should include an “I never heard of it” response to capture respondents who “have no basis for a choice, as opposed to persons who have encountered the term, but simply are not sure of its meaning”).

term in the context of a purchasing experience.<sup>115</sup> If the goal is to obtain that kind of assessment, it may be that the *Thermos* survey's format, if not its list of questions, is the better method. To rethink that list, I turn to Grice's theory of conversational implicature.

#### IV. TRADEMARKS AS CONVERSATION

H.P. Grice famously introduced the idea of conversational implicature to explain how we engage in effective communication despite utterances that, on their face, appear to be nonresponsive. Grice first introduced the Cooperative Principle—the idea that participants to a conversation act rationally and toward a mutual goal of effective conversation. He defined the Cooperative Principle thus: “Make your conversational contribution such as is required, at the stage at which it occurs, by the accepted purpose or direction of the talk exchange in which you are engaged.”<sup>116</sup> In order to conform with the Cooperative Principle, participants in a conversation will generally follow several categories of maxims that will, per Grice, “in general, yield results in accordance with the Cooperative Principle,” the categories being Quantity, Quality, Relation, and Manner.<sup>117</sup>

When an utterance appears to violate one of the maxims, a hearer will typically interpret it so that the utterance does conform with the Cooperative Principle. That conformity may rely on what Grice called implicature—the unstated communication that makes what seems like a nonconforming statement cooperative. Thus, a speaker who says *p* but implicates *q* will communicate *q* so long as the speaker is observing these conversational maxims and the hearer understands (and the speaker expects the hearer to understand) that *q* is what makes saying *p* consistent with the Cooperative Principle.<sup>118</sup>

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<sup>115</sup> This might be the result of an overbroad survey universe. Many consumers who “know” that VELCRO, for example, is a trademark might never use the term that way in a purchasing experience because they are purchasers of products with hook-and-loop fasteners, not purchasers of fasteners separately.

<sup>116</sup> H.P. Grice, *Logic and Conversation*, in 3 SYNTAX AND SEMANTICS: SPEECH ACTS 41, 45 (Peter Cole & Jerry L. Morgan eds., 1975).

<sup>117</sup> The category of Quantity contains two maxims (“1. Make your contribution as informative as is required (for the current purposes of the exchange). 2. Do not make your contribution more informative than is required.”). *Id.* at 45. The category of Quality comprises a “supermaxim” (“Try to make your contribution one that is true.”) and two more specific maxims (“1. Do not say what you believe to be false. 2. Do not say that for which you lack adequate evidence.”). *Id.* at 46. The category of Relation contains a single maxim (“Be relevant.”). *Id.* And the category of Manner includes the supermaxim “Be perspicuous” and “various maxims” such as “1. Avoid obscurity of expression. 2. Avoid ambiguity. 3. Be brief (avoid unnecessary prolixity). 4. Be orderly.” *Id.*

<sup>118</sup> *Id.* at 49–50; see also Kent Bach, *The Top 10 Misconceptions About Implicature*, in DRAWING THE BOUNDARIES OF MEANING 21, 24 (Betty J. Birner & Gregory Ward eds., 2006) (“As listeners, we presume that the speaker is being cooperative (at least insofar as he is trying to make his communicative intention evident) and is speaking truthfully, informatively, relevantly, and otherwise appropriately. If an utterance superficially appears not to conform to any of these

Of these, the category of Quantity is most relevant for our discussion here and comprises two maxims: “1. Make your contribution as informative as is required (for the current purposes of the exchange). 2. Do not make your contribution more informative than is required.”<sup>119</sup> Grice gives as an example a professor who is recommending a student for a position in philosophy and writes in the reference letter solely, “Mr. X’s command of English is excellent, and his attendance at tutorials has been regular.”<sup>120</sup> On its face, this communication would appear to violate the maxim of Quantity, since in a reference letter, one would expect the writer to say something about the individual’s qualifications for the job at hand. Because this letter has not done this, the reader of the letter, who assumes that the writer intends a cooperative communication, will understand the writer’s implicature: that they cannot say anything positive about the individual’s relevant qualifications for the position. The writer, moreover, expects the hearer to make this assumption; hence, the writer does not have to include this statement in the letter.

Context can also be relevant to the concept of implicature. For example, person *X* might say to person *Y*, “Why does this soup taste so terrible?” and person *Y* might respond, “Smith made it.” On its face, “Smith made it” is not a response to “Why does this soup taste so terrible?”; a direct response would be “Because it has too much salt” or “Because the cream in it was spoiled.” In context, however, the response “Smith made it” is a responsive communication, assuming that both parties know Smith and know that Smith has a reputation for not being a good cook.

As Jennifer Saul writes, the notion of cooperation is key to this analysis.<sup>121</sup> A speaker might intend for the hearer to understand that an implicature is required, but if the hearer fails to similarly understand, or if the speaker and the hearer lack a shared context, the communication will fail. To give an example, imagine that person *A* asks person *B* if they would like some soup, and person *B* says, “I’m a vegan.” Person *B*’s statement is not directly responsive to the offer of soup (as the answer “No, thank you” would be), but it might be said to implicate that *B* cannot eat the soup because its ingredients are not consistent with a vegan diet. But, as Saul suggests (giving a different example), for that statement to be conversationally implicated, person *A* must understand what it means

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presumptions, the listener looks for a way of taking it so that it does conform. He does so partly on the supposition that he is intended to. As speakers, in trying to choose words to make our communicative intentions evident, we exploit the fact that our listeners presume these things.”)

<sup>119</sup> Grice, *supra* note 116, at 45.

<sup>120</sup> *Id.* at 52.

<sup>121</sup> Jennifer M. Saul, *Speaker Meaning, What Is Said, and What Is Implicated*, 36 *NOÛS* 228 (2002).

to be a vegan (and, presumably, be familiar with the ingredients in the soup). This is true even though person *A* understands that person *B* is giving a reason for refusing the soup (and thus does not doubt person *B*'s compliance with the Cooperative Principle) and so might need to ask, "What is there in the soup that you cannot eat?" in order for the communication to be successful.<sup>122</sup>

These principles can inform the consideration of generics as a linguistic matter. Take, for example, the sentence "The dog is a very food-motivated animal." How does the listener know whether "the dog" refers to dogs as a class or to a particular dog? The text of the sentence itself is not likely to resolve this question—on its face, "the dog" can bear either meaning. Thus, the listener uses the context of the utterance to determine which sense is meant. If the sentence "The dog is a very food-motivated animal" is uttered at the beginning of a science documentary discussing the nature and characteristics of dogs, the hearer is likely to interpret the term "the dog" as a generic. If, on the other hand, the sentence is uttered as part of a conversation involving how to care for the speaker's two pets ("Here's what you need to know. The dog is a very food-motivated animal. The cat will never respond to a treat."), the hearer will understand the phrase "the dog" to refer to a specific animal.

As Renaat Declerck has suggested, an understanding of which is meant "depends in part on the semantics of the sentence and partly on pragmatic reasoning (which merges the semantics with information that is available from the context and from the language user's general knowledge of the world)."<sup>123</sup> Declerck thus draws from Grice's maxim of Quantity a principle that he refers to as the *maximal-set principle*, which stipulates that "when the speaker uses a description referring to a set, the hearer has a right to assume that the intended set is the largest possible set of entities satisfying the description and the NP [noun phrase]—inherent and contextual restrictions."<sup>124</sup> As an example, he contrasts the utterances "I like roses" and "I grow roses":

In the case of *I like roses* the reference of the noun phrase *roses* is restricted neither by the form of the NP itself, nor by the context, nor by pragmatic factors. The hearer will therefore conclude that the reference is here to the largest set of entities satisfying the description

<sup>122</sup> *Id.* at 234. Saul terms this "utterer-implicature." *Id.* at 235; *see also id.* at 241 ("Speakers have authority over what they utterer-implicate, but they can't fully control what they conversationally implicate."). Saul contrasts this with "audience-implicature," in which "audiences have authority over what is audience-implicated." *Id.* at 242. Thus, "[a] claim which is both utterer-implicated and audience implicated, then, will be one which is successfully communicated: the speaker tried to implicate it, and the audience took it to be implicated." *Id.* at 243.

<sup>123</sup> Renaat Declerck, *The Origins of Genericity*, 29 LINGUISTICS 79, 80 (1991).

<sup>124</sup> *Id.* at 83.

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*roses*, that is, the generic set of roses. On the other hand, in *I grow roses* it is clear that there are contextual restrictions on the referent set: the spatio-temporal restrictions inherent in *I grow* make it impossible for the referent set to be the generic set of roses. In this case the scope of the maximal-set principle is limited by our pragmatic knowledge of the world.<sup>125</sup>

We can draw from this literature to inform our understanding about how individuals communicate about trademarks in a particular context. When the individual on the sofa says to a companion, “Can you get me some [K]leenex?” the other individual understands:

I can’t hand them a couple of Kleenex brand tissues, since there aren’t any at hand. Presumably, they don’t expect me to leave here and go in search of a Kleenex brand tissue. So, in order to make this utterance cooperative, I need to assume that the person is using “Kleenex” not to refer to a brand of tissues, but to refer to the tissues next to me on the table.

And because the speaker expects the hearer to understand this, the speaker does not need to add, “By the way, I mean a tissue from the box on the table, regardless of who makes it.” As with the previous examples, context will aid interpretation; if the individual who asks, “Can you get me some [K]leenex?” has just sneezed, that will assist with interpreting the sentence.<sup>126</sup>

Contrast this with the speaker of the same sentence, “Can you get me some [K]leenex?” but now said to an individual heading off to the store. This is a possible example of Jennifer Saul’s “utterer-implicature”<sup>127</sup> in that the speaker might intend for the hearer to purchase any brand of facial tissue, or, conversely, might intend for the speaker to purchase only Kleenex brand tissue. This will be a successful conversational implicature if the hearer and the speaker have a shared understanding such that the hearer will know which of the two requests is meant. In order to know which has resulted, we must either know what further conversation has taken place (for example, if the hearer asks, “Which brand of kleenex did you want?”) or observe the result of this conversation (the hearer returns with a box of facial tissues, at which

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<sup>125</sup> *Id.*; see also Grice, *supra* note 116, at 44 (giving the example of the sentence “He is in the grip of a vice” and noting that context allows the hearer to determine whether the meaning is metaphorical (the individual is trapped in a difficult situation) or literal (the individual is caught in a tool)).

<sup>126</sup> Sperber & Wilson, *supra* note 63, at 92 (“[In the sentence ‘Here’s a Kleenex,’] the implication *It can be used to blow one’s nose* is activated in the hearer’s mind not only by the word ‘Kleenex’ but also by the fact that he has just been sneezing.”).

<sup>127</sup> See discussion *supra* note 122.

point it is determined whether the hearer has satisfied the speaker's request).

Another example: In parts of the southern United States, the utterance at a restaurant "I'd like a coke, please" satisfies the Cooperative Principle because the server understands, and the speaker expects the server to understand, that the word "coke" is being used to denote any kind of soft drink.<sup>128</sup> So when the server replies, "What kind of coke would you like?," that is not a question aimed at determining whether "coke" is being used to refer to any soft drink or a brand name; it is being used to elicit a brand name, much as would the question "What brand of beer would you like?" Thus, the speaker would typically respond with something like "a Sprite," "a Dr. Pepper," or even "a Coke." As above, observing only one part of the conversation does not give us a full sense of how the term at issue is being understood.

Thinking of marks as elements of a conversation, and adjusting surveys accordingly, reinforces the twofold rationale behind not according trademark protection to generic terms: (1) consumers do not understand generic terms as source-indicating, and so such terms do not satisfy the definition of what it means to be a trademark, and (2) relatedly, consumers understand generic terms to be the common name of the good or service itself, and so producers cannot compete effectively unless they can use those terms to communicate to consumers that they are providing the same type of good or service as their competitors. Under this framework, it matters less what words individuals *say and mean* for such goods or services and more what words they *hear and understand*. In short, genericism analyses should minimize simply asking respondents to report about their understanding in favor of formats that allow observation of that understanding.<sup>129</sup>

How, then, might we incorporate the concept of trademarks as conversation into determinations of whether a given term is generic? In the limited space of a symposium contribution, I do not intend here to provide a comprehensive consideration of such evidence, or even of surveys in particular. But, for existing evidence, such as corpora and social media, we should ensure that we are reading terms in context—not only what a speaker says but how other participants to the conversation react. Where possible, researchers should observe not only how a mark is used online but also how such uses are responded to, such as in discussion

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<sup>128</sup> Murray, *supra* note 91, at 167.

<sup>129</sup> Cf. NATALIE SCHILLING, *SOCIOLINGUISTIC FIELDWORK* 77 (2013) (noting that "people's reports of their linguistic usage may or may not match up with what they do in non-research contexts"); Ullrich, *supra* note 86, at 1006 ("[P]eople are not very good at observing their own speech, let alone explaining it to surveyors.") (citing SCHILLING).

threads or comment sections, to confirm consumer understanding. Consumer surveys might involve not asking consumers about their views of terms but asking them to engage in a variety of online search tasks, taking into account the ways in which search results and other groupings of items have an effect on what consumers perceive as the relevant “shelf.”

We might also consider a variation on the *Thermos* survey that focuses less on the words the respondent would use and more on how the respondent would interpret a given utterance using the term. For example, taking “Kleenex” as our example, a survey might display a number of unbranded facial tissue boxes or packages and ask the respondent (orally, via a recording, or in unmarked text), “If I were to ask you to go to the store and buy some [K]leenex, which of these, if any, would satisfy that request?” The respondent would then be asked to select one or more of the images, to check a box that says, “none of these,” or to check a box that says, “I need more information.” The respondent would then have the opportunity to explain their decision. An alternative question would display a variety of unbranded tissue boxes or packages; the respondent would then be asked:

Imagine you were in a supermarket, and you were looking for the shelf with these products. Supermarkets typically have signs hanging above each aisle indicating the types of products that are in that aisle. Imagine that the aisle contained only these products. What word or words would you expect to see on the sign for the aisle where these products are located?<sup>130</sup>

Still another possibility might be to ask the respondent about alternative common names for the product at issue, rather than about the disputed trademark—such as, “If I were to ask you to go to the store and buy some facial tissue, which of these would satisfy that request?”—in order to determine the viability and understanding of claimed generic terms.

Ultimately, any choice as to method and evidentiary sources involves a tradeoff between cost and administrability and the robustness of the result. The suggested survey formats above require interpretation

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<sup>130</sup> Cf. Palladino, *supra* note 82, at 886 (suggesting, in a *Teflon* survey, after the minicourse is given and the product shown, “If this type of product were made by more than one company, what do you believe those companies would call the product [in offering to sell it to you]?” although this phrasing might suggest that the interviewer is seeking examples of brand names, given the framing the minicourse provided) (alteration in original). See also, e.g., Brendan Palfreyman Esq. (@B\_Palfreyman), TWITTER (May 7, 2021, 8:53 PM), [https://twitter.com/B\\_Palfreyman/status/1390832224992329732](https://twitter.com/B_Palfreyman/status/1390832224992329732) (posting photograph of store shelves with various brands of shampoo with the shelf header “Head & Shoulders”); Trademarks Are Magic (@TimberlakeLaw), TWITTER (May 7, 2021, 10:14 PM), <https://twitter.com/TimberlakeLaw/status/1390852460915433476> (posting photograph of supermarket aisle header reading “Popsicles”); cf. HEAD & SHOULDERS, Registration No. 729,556; POPSICLE, Registration No. 2,421,400.



of the results, and so one might well conclude that the preference for *Teflon* surveys in genericism cases is a reasonable one, despite that format's "total up the points" approach.<sup>131</sup> And while advances in online surveys might make a version of *Thermos*-type engagement more appealing, risk-averse litigants may be understandably reluctant to adopt new formats that may not find favor in court.

#### CONCLUSION

There are reasons to critique the Court's opinion in *Booking.com*. But the opinion's core conclusion—that the trademark status of a word fundamentally depends on consumer understanding—is correct. Indeed, it is difficult to understand how else we might determine the meaning of a word, even if we sometimes assume consumer understanding rather than assess it. Gaining complete clarity on how consumers understand trademarks is likely to remain an impossible task. But by viewing trademarks as part of conversational exchanges—where we recognize that what is not said might be as important to understanding as what is said—we might, after seventy-five years of the Lanham Act, get a bit closer to the question we're trying to answer.

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<sup>131</sup> Cf. Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel H. Steckel, *The Role of Consumer Uncertainty in Trademark Law: An Experimental and Theoretical Investigation* 5 (May 28, 2021) (unpublished manuscript), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3854730](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3854730) (criticizing the leading trademark survey formats for "inquir[ing] into consumer beliefs without providing any way for respondents to indicate the strength with which they hold a particular belief") (emphasis omitted); *id.* at 15–25 (testing alternatives to the *Teflon* survey format).