



## CONNECTING THE DOT-COMS IN TRADEMARK DISPUTE

### Generic terms can't be turned into protectable brand names

By **GEORGE A. PELLETIER JR.**

It's well established that generic terms aren't eligible for protection as trademarks or service marks. Some marketers, however, might try to bypass that problem by adding the suffix ".com" to an otherwise generic term in hopes of transforming it into a protectable brand name. The U.S. Court of Appeals for the Federal Circuit squared off with such a party in the case *In re HOTELS.COM*.

Hotels.com LP applied to register the mark "HOTELS.COM" for the services of "providing information for others about temporary lodging [and] travel agency services, namely making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." The application was refused by the U.S. Patent and Trademark Office (USPTO), and the Trademark Trial and Appeal Board affirmed the refusal to register the mark on the ground that the mark is a generic term for hotel information and reservations.

On appeal, the applicant claimed that the dot-com component of the mark negates the generic nature of the word "hotels." Viewed in its entirety, the applicant urged, the mark is not a generic name but a source indicator of the applicant's services.

Notably, Hotels.com originally included services in its application that were not subject of the USPTO's generic refusal, "providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation for others by means of telephone and the

global computer network." These services were divided from the original application and proceeded to registration with a claim of acquired distinctiveness.

#### The Board's Reservations

The Trademark Trial and Appeal Board pointed to dictionary definitions and other web sites that provide information about hotels and reservations to show that such sites are referred to as "hotel information sites" and "hotel reservation sites."

It listed several sites that combine "hotels" and ".com," such as all-hotels.com ("hotels, travel, discount hotels — reservations and lodgings") and web-hotels.com ("hotel reservations and bookings"). In the board's view, this evidence demonstrated a competitive need for others to use the terms as part of their own domain names and trademarks, supporting the finding that "hotels" indicates the generic genus of hotel information and reservation services.

In the context of *HOTELS.COM*, the board found that the word "hotels" names a key aspect of the applicant's services and concluded that "HOTELS.COM" is properly seen in the same way and as having the same meaning as "hotels" alone. The combination "HOTELS.COM" "communicates no more than the common meanings of the individual components; that is, that the applicant operates a commercial web site via the Internet, that provides information about hotels, but adds nothing as an indication of source."

#### Court Checks In

The Federal Circuit held that the Trademark Trial and Appeal Board did not err in evaluating the generic nature of "hotels"

separate from ".com." It agreed that, for the mark at issue, the generic term "hotels" does not shed its generic character merely by inclusion of the .COM component. The applicant presented



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rebuttal evidence intended to show "HOTELS.COM" is perceived as a brand indicating a single source. In a survey, for instance, 76 percent of respondents regarded the mark as a brand name.

The Federal Circuit, however, found that the board could reasonably have given controlling weight to the large number of similar usages of "hotels" with ".com," as well as the common meaning and dictionary definition of "hotels" and the standard usage of ".com." Thus, ultimately, the court ruled that the Board's finding that "HOTELS.COM" is generic was supported by substantial evidence.

#### Future Results

This case shows that trademark protection cannot be obtained for an inherently generic mark — even when evidence shows that the mark is commonly perceived as a brand. And the result in *HOTELS.COM* is likely to be the same for future attempts to trademark the combination of a generic word and ".com." ■

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