

BOOKING.COM AND THE SHRINKING HYPERLINGUISTIC COMMONS

Rachel Paige Thompson[†]

I. INTRODUCTION

How much of the cultural lexicon should corporations control, especially as that lexicon moves online? In *United States Patent & Trademark Office v. Booking.com B.V.*,¹ the U.S. Supreme Court allowed a company to cordon off a large swath of both our shared linguistic commons and our hyperlinguistic commons. In *Booking.com*, the Supreme Court rejected the U.S. Patent and Trademark Office’s (USPTO) per se rule that a generic term, such as “booking,” plus a generic top-level domain name, such as “.com,” necessarily yields an unprotectable generic mark.² The decision aligns with precedent, but in doing so, it ignores how new technology and new media operate outside the usual linguistic structures underlying American trademark law. It also ignores the protections already provided under contract law and the domain name system, affording a company double assurance that a generic word may belong to it.

In Part II, this Note begins by situating the purpose of trademark law—consumer protection—in the abstract functioning of the distinctiveness spectrum. When determining eligibility for trademark protection, trademark law classifies marks into several categories of distinctiveness,³ and the incentive structure of trademark law becomes clear through an analysis of these categories. Creative terms should be easy for companies to protect because those terms do not deplete the linguistic commons, and it should be difficult, if not impossible, for companies to claim a linguistically valuable term for themselves. Commonplace terms that many competitors would want or even need to use in marketing their products and services, like “grocery” or

DOI: <https://doi.org/10.15779/Z38T43J405>.

© 2021 Rachel Paige Thompson.

[†] J.D. 2022, University of California, Berkeley, School of Law. Sincere thanks to Professor Talha Syed, my fellow students in the 2020 Law & Technology Writing Workshop at Berkeley Law, and the Berkeley Technology Law Journal editors.

1. 140 S. Ct. 2298 (2020). Interestingly, this was the first case in United States Supreme Court history where the Justices conducted oral argument remotely. Adam Liptak, *Supreme Court Hears First Arguments via Phone*, N.Y. TIMES (May 4, 2020), <https://www.nytimes.com/2020/05/04/us/politics/supreme-court-coronavirus-call.html> [<https://perma.cc/UUQ4-L768>].

2. 140 S. Ct. at 2301.

3. See *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

“sandwich” or “shoes,” should not fall under the control of any single company. To determine distinctiveness and thereby trademark eligibility, factfinders use the primary significance test,⁴ but this test’s imprecision allows wealthy companies to gain protection for highly useful words and phrases.

Part II moves on to explain domain names, the subject of contention in *Booking.com*, including the overarching framework and processes for managing them. How someone acquires a domain name, how that system interacts with existing trademarks, and how the market for domain names has matured and expanded—all of this groundwork helps show that domain names are unlike traditional word marks. These differences create inefficiencies and redundancies when the trademark system is overlaid on the domain name system.

With this background, this Note moves on in Part III to provide an overview of *Booking.com* as it moved through the USPTO and the court system. The confusion at every step about whether the BOOKING.COM mark was generic or descriptive is a prime example of the shortcomings inherent in the primary significance test. In applying this test, courts ask what the relevant consuming public thinks of a term that is being considered for trademark protection to determine whether a mark is distinctive and may receive trademark protection.⁵ As this Note explains, the Supreme Court issued a predictable decision, holding that a domain name made up of generic parts could receive protection under trademark law.⁶ But in so doing, the Court elided the more fundamental question of why the precedential primary significance test should apply here, to the new commercial context introduced by online services, in the first place. And even beyond *Booking.com* and domain names, the primary significance test has faced criticism for decades.⁷ This case presented a missed opportunity for the Supreme Court to revisit the degree to which public perception matters, and how it can be determined accurately.

Part IV attempts to answer how an accurate distinctiveness determination should be made for marks including generic top-level domain names, always keeping consumer protection as the animating principle undergirding trademark law. In doing so, this Note builds on Justice Breyer’s dissent,⁸ as

4. *See* Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

5. *See id.*

6. *Booking.com*, 140 S. Ct. at 2301.

7. *See, e.g.*, Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323 (1980); John F. Coverdale, Note, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHI. L. REV. 868 (1984); Stephen R. Baird, Note, *Putting the Cart Before the Horse in Assessing Trademark Validity—Toward Redefining the Inherently Generic Term*, 14 J. CORP. L. 925, 927 (1989).

8. *Booking.com*, 140 S. Ct. at 2309–16 (Breyer, J., dissenting).

well as scholarly suggestions for how to adapt the distinctiveness spectrum.⁹ Public perception is malleable, especially because it is measured by consumer surveys paid for by large companies with strong marketing and advertising power. Instead of focusing on consumer comprehension, this Note suggests that examining attorneys at the USPTO could ask how protecting the applied-for mark and its component terms would impact competitors acting in good faith. If others would have a viable fair use defense, then the mark should perhaps not enjoy protection in the first place. But this proposal could vitiate the current trademark system, returning it to the era where only inherently distinctive terms could receive protection.

Although replacing the focus on the consumer with a question about impact on competitors is desirable, this Note nonetheless offers an alternative and more palatable method for preventing the overprotection of domain names. Building off the work of new media theorists, this Note proposes a new category for factfinders to consider during the eligibility stages of a trademark application: executable matter. This category recognizes that parts of a mark might look like natural language and sound like natural language but, in reality, are coded elements that, when used for their executable purpose, should not receive trademark protection. In other words, “.com” operates more as code, appended onto other terms in order to trigger an operation within a system, than as communicative language. These are hyperlinguistic elements, and the domain name system regulates our hyperlinguistic commons.

This proposition, that executable elements of a trademark are ineligible for protection, leads to a discussion about how and why the *Booking.com* decision was wrong on even narrower grounds. It evaluated a domain name using the same framework factfinders use for words—but generic.com domains do not fit neatly into a framework developed around natural language. Arguably, the domain name system already provides greater protections than the trademark system. A generic.com domain owner is the only one who can own that domain, and nefarious lookalikes can be sued under unfair competition laws.¹⁰ Trademarks, on the other hand, can have multiple meanings and connotations. Some terms have to be disclaimed in the registration process, and some of the protections are weak. Seeking principal register trademark status for a generic.com domain, then, speaks to the tendency toward monopolization of language. Part IV concludes by outlining exactly how the distinctiveness

9. See *supra* note 7.

10. See J. Thomas McCarthy, *Trademarks, Cybersquatters and Domain Names*, 10 DEPAUL J. ART TECH. & INTELL. PROP. L. 231, 231 (2000); see also Lisa Carroll, *A Better Way to Skin the Cat: Resolving Domain Name Disputes Using State Unfair Competition Law*, 18 IPL NEWSL. 1 (2000).

spectrum could be modified to exclude executable elements from trademark protection, either by examining attorneys at the USPTO or by Congress.

II. BACKGROUND

Booking.com was wrongly decided on two fronts. First, in uncritically following precedent, it moved modern trademark law even further away from its original consumer-protection purposes. Second, it overlaid an already-strained intellectual property framework on top of an existing infrastructure and market. This Part provides the background necessary for grounding this dual analysis, beginning with a discussion of the distinctiveness spectrum and moving on to an examination of the domain name system and its relevant statutes and actors.

A. PURPOSES OF TRADEMARK LAW AS EMBODIED BY THE DISTINCTIVENESS SPECTRUM

At its core, trademark law protects consumers.¹¹ It allows buyers to create associations with brands and products and to trust these associations. Producers, in turn, enjoy a monopoly over certain expressions that, unlike other intellectual property protections, can “last in perpetuity.”¹² Restrictions on language and symbols are balanced with stamping out malicious deception and keeping consumer search costs low.¹³ One foundational example of this balancing is the distinctiveness requirement for trademark eligibility, found in the Lanham Act:

11. See Glynn S. Lunney, *Trademark Monopolies*, 48 EMORY L.J. 367, 417 (1999) (“Originally, trademark law was justified on grounds of preventing consumer deception.”); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1695 (1999) (“We give protection to trademarks for one basic reason: to enable the public to identify easily a particular product from a particular source.”). *But see* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1840–41 (2013) (“[T]rademark law was not traditionally intended to protect consumers. Instead, trademark law, like all unfair competition law, sought to protect producers from illegitimate diversions of their trade by competitors.”); KONSTANTINOS KOMAITIS, *THE CURRENT STATE OF DOMAIN NAME REGULATION: DOMAIN NAMES AS SECOND-CLASS CITIZENS IN A MARK-DOMINATED WORLD* 25 (2010) (“A trademark serves multiple and multi-dimensional purposes that extend [sic] from consumer protection to market efficiency to the institution of values, such as responsibility and obligation to others.”).

12. See Folsom & Tepley, *supra* note 7, at 1358.

13. See Wayne F. Osoba, Note, *The Legislative Response to Anti-Monopoly: A Missed Opportunity to Clarify the Genericness Doctrine*, 1985 U. ILL. L. REV. 197, 198 (“The law . . . must balance the protection of trademarks against the public policy of free competition by preventing the monopolization of common terminology.”).

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them

(f) Except as expressly excluded in [certain] subsections . . . of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.¹⁴

Distinctive marks, those that can distinguish goods in the marketplace, are presumed eligible for strong trademark protection; nondistinctive marks, those that merely describe products, may acquire distinctiveness and become eligible for weak trademark protection.¹⁵

In *Abercrombie & Fitch, Co. v. Hunting World, Inc.*,¹⁶ Judge Friendly provided a seminal explanation of the four categories of distinctiveness and their relationship to trademark eligibility and protection. Inherently distinctive¹⁷ marks, divided into arbitrary/fanciful and suggestive,¹⁸ occupy one end of the

14. 15 U.S.C. § 1052.

15. It is “conventional wisdom” that “stronger marks always receive broader protection.” Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339, 1344–45 (2017). In trademark law, the scope of protection speaks to the “range of marks that if employed by a defendant . . . would be held to be infringing.” *Id.* at 1347. An inherently distinctive mark receives stronger and broader protection than a mark that has acquired distinctiveness. *See* U.S. PAT. & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1207.01(b)(ix) (Oct. 2018), <http://tmep.uspto.gov/> [<https://perma.cc/5NLP-A6KG>] (“[M]erely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word.”).

16. 537 F.2d 4 (2d Cir. 1976).

17. Inherent distinctiveness could simply be presumed secondary meaning by another name. Under this interpretation, arbitrary and suggestive marks are not in and of themselves distinct. Rather, they can be presumed to carry secondary meaning, and this presumption keeps administrative costs low. *See* Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2130 (2004).

18. It is not self-evident that suggestive marks should be presumed distinctive. Some scholars have argued that suggestive marks are more akin to descriptive than arbitrary marks and that applicants should be required to show secondary meaning when attempting to register them. *See* Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367, 1373–74 (2015) (“[T]he inherent distinctiveness line in trademark law should be redrawn, and a suggestive mark should be protected only if the mark owner can provide evidence of source significance.”).

spectrum. These marks are thought to require an imaginative leap on the part of the consumer. APPLE is an arbitrary mark when used for technology products because it carries little to no immediate connotation; it does not tell consumers anything more than which company produced the item at hand. COPPERTONE, when used for sunscreen, and JAGUAR, when used for sports cars, are examples of suggestive marks. They trade on the consumer connecting some quality of the thing named with some quality of the product or service sold. Both arbitrary/fanciful and suggestive marks are presumed distinctive and are automatically protected because it is unlikely that other producers will be constricted by such protection. Whether or not “jaguar” is trademarked, an automobile manufacturer can advertise its cars effectively and attractively, and the boundaries of the protection are defined by the class of products or services for which it is trademarked. Although another automaker could not use “jaguar,” a footwear designer conceivably could.

On the other end of the spectrum, there are descriptive and generic marks. As the name implies, descriptive marks describe the product or service, like HOLIDAY INN for a hotel or QUIK-DRI for a hairdryer.¹⁹ In contrast, generic marks are described as “the genus of which the particular product is a species.”²⁰ These terms are the general name of the product, like “computer store” or “brick oven pizza.” At common law, neither category was eligible for trademark protection, but the Lanham Act carved out an exception for merely descriptive marks that gain some secondary meaning in commerce.²¹ Secondary meaning refers to an additional association with a mark that consumers develop based on encounters with the mark in the market.

While descriptive marks may now acquire distinctiveness and become eligible for weak protection, as opposed to the strong protection afforded

19. Factfinders often struggle with determining the line between suggestive and descriptive marks. See Edward J. Heath & John M. Tanski, *Drawing the Line Between Descriptive and Suggestive Trademarks*, 12 COM. & BUS. LITIG. 11, 11 (2010) (“In theory, the distinction between ‘descriptive’ and ‘suggestive’ marks is clear. In practice, however, the line is a blurry one.”).

20. *Hunting World*, 537 F.2d at 9. Courts began affording trademark protection to certain descriptive marks which had acquired secondary meaning around 1938, and this exception was later codified in the Lanham Act. Elizabeth A. Horkey, *1-800-I-AM-VAIN: Should Telephone Mnemonics Be Protected as Trademarks?*, 3 J. INTELL. PROP. L. 213, 226 n.61 (1995). In 1989, Congress amended the Lanham Act to change “common descriptive name” to “generic name.” 2J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:21 (5th ed. 2017). Before and even after this change, courts were often imprecise in their use of “descriptive” and “generic.” See *id.*

21. *Hunting World*, 537 F.2d at 9.

inherently distinctive marks,²² generic marks may never be trademarked.²³ Indeed, if arbitrary or fanciful marks become generic, they are stripped of trademark protection—a process referred to as genericide. This categorical prohibition is rooted in the consumer-centric purposes of trademark law: buyers benefit when sellers may freely use common language to describe and explain their products and services.²⁴

In determining where a mark falls on the spectrum, USPTO examining attorneys consider evidence such as “the dictionary, puffery, competitors’ need, competitors’ use, and imagination tests.”²⁵ They also look to rhetorical devices like “incongruity, musicality, or double entendre . . . as a proxy for distinctiveness.”²⁶ These tests have been described as “ill-defined and haphazardly-applied,” leading factfinders to be accused of “overprotecting” descriptive marks.²⁷ Sometimes, like in *Booking.com*,²⁸ consumer survey evidence will be provided, although this can be cost-prohibitive because the applicant covers the price of creating and executing the survey.²⁹

Specifically, to determine whether a mark is or has become generic, factfinders apply the primary significance test.³⁰ As Judge Learned Hand put it

22. See Beebe & Hemphill, *supra* note 15, at 1344–45.

23. *Hunting World*, 537 F.2d at 9 (“[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.”). *But see* Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 878 (2017) (“There is no ontologically ‘nontrademarkable’ class of symbols. Anything that is capable of distinguishing the source of goods or services—known as being ‘distinctive’—can serve as a mark.” (internal citations omitted)).

24. See Hans Zeisel, *The Surveys that Broke Monopoly*, 50 U. CHI. L. REV. 896, 897 (1983) (“Giving a competitor trademark protection for whatever word he chooses . . . might impoverish the language of commerce.”); Osoba, *supra* note 13, at 198 (“The law . . . must balance the protection of trademarks against the public policy of free competition by preventing the monopolization of common terminology.”).

25. Alexandra J. Roberts, *How to Do Things with Word Marks: A Speech-Act Theory of Distinctiveness*, 65 ALA. L. REV. 1035, 1038 (2014).

26. *Id.*

27. *Id.* at 1039, 1085–86.

28. U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298, 2313–14 (2020) (Breyer, J., dissenting).

29. Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1017 (2012) (“Consumer surveys are expensive to create and time consuming to administer.”).

30. U.S. PAT. & TRADEMARK OFF., *supra* note 15, § 1209.01(c)(i). Following *Booking.com*, the USPTO issued special instructions for generic.com domain names. U.S. PAT. & TRADEMARK OFF., EXAMINATION GUIDE 3-20: GENERIC.COM TERMS AFTER *USPTO V. BOOKING.COM* (Oct. 2020), <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-3-20.pdf> [<https://perma.cc/9JEB-8L73>].

a century ago, “What do the buyers understand by the word for whose use the parties are contending?”³¹ Phrased another way, in the “minds of the consuming public,” does the primary significance of the term correspond to the product or the producer?³² If the mark primarily signifies the product, then the mark is generic and unprotectable. In 1979, the Ninth Circuit infamously deviated from this test, resulting in an amendment to the Lanham Act, which codified the primary significance test as to genericide.³³

The primary significance test focuses mainly on public perception of a mark, but its application is muddy. How is public perception determined? Who is the relevant public? How does the stark binary between genus and species map onto the realities of language? The shortcomings of the test have been exposed by contradictory decisions: some circuits find a term to be generic, while others find the same term to be descriptive.³⁴ To remedy this, scholars have long called for a new test, with the form of their suggestions depending on their interpretations of the purposes and policies underlying trademark law.³⁵

B. DOMAIN NAMES

Booking.com suffers both theoretically and functionally. It miscarries the foundational goals of trademark law, and in doing so it overlooks the protections provided by a preexisting system for allocating space in the virtual marketplace. To understand the latter, it is essential to explain some of the structure and economics of domain names, as well as the relevant statutes and actors.

In the early years of the internet, as more sites proliferated and the online landscape grew more complex, the domain name system (DNS) was developed as a scaling solution, allowing “hierarchical host names” (e.g.,

31. *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

32. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 111–12, 118 (1938).

33. *See Osoba*, *supra* note 13, at 199. In *Anti-Monopoly*, the Ninth Circuit used the consumer motivation test rather than the primary significance test. The motivation test asked whether consumers provided product-related reasons or source-related reasons for buying the product. The Lanham Act does not codify the primary significance test as to determining whether an as yet unprotected mark should be categorized as generic or descriptive in the first instance. *See* 15 U.S.C. § 1052 (lacking the primary significance test in distinguishing between descriptive and generic marks). Courts, and even the Trademark Manual of Examining Procedure, nonetheless lift the test from the genericide section and apply it to the initial determination of genericness for a trademark application. *See Booking.com*, 140 S. Ct. 2298, 2304 n.3 (listing cases and a section from the Trademark Manual of Examining Procedure that apply the primary significance test from genericide to determine genericness in the first instance).

34. *See Folsom & Teply*, *supra* note 7, at 1351 (explaining that the Seventh Circuit found “alo” to be generic for cosmetics, while the Fifth Circuit found it to be descriptive).

35. *See supra* note 7.

“www.google.com”) to lead users directly to an internet address.³⁶ This replaced a number-based system, similar to phone numbers, which had required users to memorize IP addresses (e.g., “128.0.0.1”).³⁷ This simple switch implicated trademark law and its semiotics.³⁸

Today, domain names consist of a top-level domain (.com) and a second-level domain (booking).³⁹ The Internet Corporation for Assigned Names and Numbers (ICANN), founded in 1998, manages the “allocation and assignment of names in the root zone of the Domain Name System . . . and coordinates the development and implementation of policies concerning the registration of second-level domain names in generic top-level domains.”⁴⁰ ICANN maintains agreements with the organizations that operate current top-level domains, and it coordinates the release of new top-level domains.⁴¹

To register a domain name, a user first visits a domain name registrar, like GoDaddy.com or Google Domains, and searches for an available domain name.⁴² Not all registrars are licensed to sell all top-level domains, especially country-specific endings like .in for India or .be for Belgium.⁴³ Some registrars offer top-level domains like .buzz and .health, but .com remains the most used top-level domain on the internet.⁴⁴ Once the user finds a domain name that is

36. BARRY M. LEINER, VINTON G. CERF, DAVID D. CLARK, ROBERT E. KAHN, LEONARD KLEINROCK, DANIEL C. LYNCH, JON POSTEL, LARRY G. ROBERTS & STEPHEN WOLF, INTERNET SOC’Y, A BRIEF HISTORY OF THE INTERNET 8–9 (1997), https://www.internetsociety.org/wp-content/uploads/2017/09/ISOC-History-of-the-Internet_1997.pdf [<https://perma.cc/22QT-EUWN>].

37. *Id.*

38. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 703 (2004) (describing the trademark system as “an agent in its own struggle to establish itself as the preeminent system of classification”).

39. For a more complete explanation of the DNS, see KOMAITIS, *supra* note 11, at 41–45.

40. *Bylaws for Internet Corporation for Assigned Names and Numbers*, art. 1 § 1.1(a)(i), ICANN (Nov. 28, 2019), <https://www.icann.org/resources/pages/governance/bylaws-en> [<https://perma.cc/M6KX-8VB4>].

41. See generally *New Generic Top-Level Domains*, ICANN, <https://newgtlds.icann.org/en/> (last visited Apr. 21, 2022) (providing information about newly delegated generic top-level domains).

42. See *General Questions*, ICANN, <https://www.icann.org/resources/pages/faqs-84-2012-02-25-en#2> (last visited Apr. 21, 2022); *List of Accredited Registrars*, ICANN, <https://www.icann.org/registrar-reports/accreditation-qualified-list.html> (last visited Apr. 21, 2022).

43. See *Root Zone Database*, IANA, <https://www.iana.org/domains/root/db> (last visited Apr. 21, 2022); see also *ccTLDs – What Are Country Domain Names?*, IONOS (Sept. 16, 2020), <https://www.ionos.com/digitalguide/domains/domain-extensions/cclds-all-you-need-to-know-about-country-code-domains/> [<https://perma.cc/DN6T-4TB4>].

44. See *What Are the Most Popular TLDs/Domain Extensions in 2020?*, ICDSOFT (Feb. 10, 2020), <https://www.icdsoft.com/blog/what-are-the-most-popular-tlds-domain-extensions/> [<https://perma.cc/8AYJ-8GEG>].

eligible for registration, the user pays a fee to register it and an annual fee to renew it.

The inevitable interaction between a language-based internet addressing system and trademark law was recognized from the outset, and trademark lobbyists used this interaction to push for the creation of regulatory schemes and bodies.⁴⁵ A statement of policy appearing in the *Federal Register* and providing the basis for ICANN's establishment addressed the "trademark dilemma," which centered on the fear that cyberspace could not function as an effective market if businesses could not protect their trademarks.⁴⁶ It called for the creation of a dispute resolution process aimed at preventing "cybersquatting and cyberpiracy," while leaving legitimate disputes to be settled in the "appropriate court."⁴⁷ Such legitimate disputes include cases where "two parties [have] legitimate competing interests in a particular mark."⁴⁸

By December of 1999, the Uniform Dispute Resolution Policy (UDRP) was in place and guiding proceedings, the first of which involved *worldwrestlingfederation.com*.⁴⁹ Complainants can bring disputes to a dispute resolution provider approved by ICANN, such as the World Intellectual Property Organization or the National Arbitration Forum.⁵⁰ The UDRP sets out three elements that must be presented in every complaint: confusion, lack of legitimate interest, and bad faith. Complainants must show how the allegedly infringing domain is confusingly similar to a trademark; that the alleged infringer lacks a right to or legitimate interest in the domain; and in what way the domain was registered and used in bad faith.⁵¹ The only remedies

45. See KOMAITIS, *supra* note 11, at 40 ("The current environment concerning the regulation of domain names is a direct consequence of the political pressure and economic rationalization pursued by trademark lobbying.").

46. Management of Internet Names and Addresses, 63 Fed. Reg. 31,741, 31,746 (June 10, 1998).

47. *Id.* at 31,747.

48. *Id.*

49. *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*, ICANN (Feb. 25, 2012), <https://www.icann.org/resources/pages/schedule-2012-02-25-en> [<https://perma.cc/SFG9-MBBE>].

50. *List of Approved Dispute Resolution Service Providers*, ICANN (Feb. 25, 2012), <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> [<https://perma.cc/Y779-CT3X>]; Elizabeth G. Thornburg, *Going Private: Technology, Due Process, and Internet Dispute Resolution*, 34 U.C. DAVIS L. REV. 151, 161 (2000).

51. *Rules for Uniform Domain Name Dispute Resolution Policy*, § 3(b)(ix), ICANN (Mar. 11, 2015), <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> [<https://perma.cc/R9C6-64HV>].

are cancellation or transfer of the disputed domain name.⁵² When registering a domain, owners agree to participate in the UDRP if an issue arises, much like agreeing to arbitration.⁵³

For example, in January of 2020, an individual registered the domain name “tommybahamaboomer.com.”⁵⁴ Tommy Bahama is a fashion brand that sells “island-inspired apparel,” and its mark TOMMY BAHAMA is on the principal register.⁵⁵ Tommy Bahama filed a complaint against the individual registrant in March of 2020, alleging that the domain had been registered in bad faith and was confusingly similar to its own trademark.⁵⁶ The registrant failed to respond to the complaint, and ultimately the domain was transferred to Tommy Bahama in April of 2020.⁵⁷

Along with the UDRP, the Anticybersquatting Consumer Protection Act (ACPA), codified at 15 U.S.C. § 1125(d) and enacted in 1999, offers trademark owners recourse in the federal courts. Broadly, the ACPA requires a showing of (1) bad faith intent to profit from the mark; and (2) that the owner registers, traffics in, or uses a domain name that is identical or confusingly similar to a distinctive or famous mark.⁵⁸ ACPA litigation is more expensive and time-consuming than UDRP proceedings, but the courts are better equipped to handle complex cases and have the ability to offer more remedies.⁵⁹ To clarify: the UDRP is an arbitration-like proceeding, whereas ACPA proceedings are federal civil lawsuits.

Before the ACPA and the creation of this centralized allocation and resolution system, web “speculators” had preemptively purchased desirable, non-trademarked domain names.⁶⁰ Currently, the UDRP only covers

52. See *Uniform Domain Name Dispute Resolution Policy*, § 4(i), ICANN (Aug. 26, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [<https://perma.cc/3XEG-WX3C>].

53. See, e.g., *Domain Registration Agreement*, NAMECHEAP, <https://www.namecheap.com/legal/domains/registration-agreement/> (last visited Apr. 21, 2022).

54. *Tommy Bahama Grp., Inc. v. Russell Pike*, Case No. D2020-0502, Administrative Panel Decision (WIPO Arb. & Mediation Ctr. 2020).

55. *Id.*

56. *Id.*

57. *Id.*

58. See 15 U.S.C. § 1125(d)(1)(A); see also Tamara Kurtzman, *CYBER CENTER: The Continued Hijacking and Ransoming of the Domain Name System by Modern-Day Corporate Privateers*, BUS. L. TODAY (June 20, 2016), https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/ [<https://perma.cc/K5GU-5WWN>].

59. Jordan A. Arnot, *Navigating Cybersquatting Enforcement in the Expanding Internet*, 13 J. MARSHALL REV. INTELL. PROP. L. 321, 332–34 (2014).

60. Jamie Murphy & Brian L. Massey, *Domain-Name Speculators Buy Up Web Real Estate and Toss the Dice*, N.Y. TIMES (Feb. 21, 1997), <https://archive.nytimes.com/>

trademark infringement cases, such as someone unaffiliated with McDonald's purchasing mcdonalds.com and holding out for an inflated price.⁶¹ It does not cover an individual or company purchasing a generic domain name, like hotels.com or candy.com, and attempting to sell that domain to Hyatt or Hershey's.⁶²

This latter category accounts for several of the most expensive published domain name sales.⁶³ More than a decade ago, Toys.com sold at auction for \$5.1 million to ToysRUs.⁶⁴ Typing Toys.com into the browser today redirects to Toysrus.com. Before receiving trademark protection, the president of Hotels.com spent \$11 million to purchase the domain name.⁶⁵ The infamous Pets.com domain from the dot-com boom sold to its rival, PetSmart, upon bankruptcy.⁶⁶ Typing Pets.com into the browser redirects to Petsmart.com. In

www.nytimes.com/library/cyber/week/022197domain.html [https://perma.cc/9P6D-BXV4].

61. See ICANN, *supra* note 52; see also Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141, 152–53 (2001) (“[T]he UDRP covers only a narrow segment of the myriad intellectual property disputes currently percolating in cyberspace. In essence, the UDRP establishes fast and inexpensive online procedures that allow trademark owners to recapture domain names held by persons who register and use domain names containing those marks in bad faith.”).

62. See Julia Hörnle, *The Uniform Domain Name Dispute Resolution Procedure: Is Too Much of a Good Thing a Bad Thing?*, 11 SMU SCI. TECH. L. REV. 253, 254 (2008) (“The UDRP was drafted narrowly for the purpose of combating the Internet phenomenon known as cybersquatting. Cybersquatting is the registration of a domain name similar to a trademark for an illegitimate purpose”); Karl Maersch, *ICANN’t Use My Domain Name? The Real World Application of ICANN’s Uniform Domain-Name Dispute Resolution Policy*, 34 J. MARSHALL L. REV. 1027, 1036 (2001) (explaining that the UDRP was developed to address disputes where a “person with no rights in the trade or service mark registers the mark” as a second-level domain); see also Doug Isenberg, *Why ‘Generic’ Domain Names Are Inappropriate for UDRP Complaints*, GIGALAW BLOG (June 9, 2015), <https://giga.law/blog/2015/06/09/why-generic-domain-names-are-inappropriate-for-udrp-complaints> [https://perma.cc/4NW7-W2CK]. But see Thornburg, *supra* note 50, at 167 (citing a domain name resolution decided by the World Intellectual Property Organization Arbitration and Mediation Center involving cybersquatting and a generic second-level domain name).

63. See KOMATIS, *supra* note 11, at 48 (“The domain <loans.com> generated the extravagant amount of \$3 million because of its genericness and its ability to encapsulate the sector of providing services for loans.”).

64. Chris Irvine, *Top 10 Most Expensive Domain Names*, THE TELEGRAPH (Mar. 10, 2010), <https://www.telegraph.co.uk/technology/news/7412544/Top-10-most-expensive-domain-names.html> [https://perma.cc/292P-MRLF].

65. *I Bought Hotels.com Name for \$11m*, BBC (Nov. 2, 2012), http://news.bbc.co.uk/today/hi/today/newsid_9765000/9765923.stm [https://perma.cc/D3ZU-ZNY3]; Irvine, *supra* note 64.

66. Melinda Patterson Grenier, *Pets.com Transfers Domain Name to Former Rival Petsmart.com*, WALL ST. J. (Dec. 5, 2000), <https://www.wsj.com/articles/SB97599845454193456> [https://

March 2020, “domain investor” Jon Schultz purchased about a dozen coronavirus-related domain names, hoping to turn a profit.⁶⁷

The value of these generic domain names speaks to the competitive advantage that comes with such a web address. As with property, some online locations are more valuable and more desirable than others. Their value also illustrates which bodies of law operate effectively in this sphere; under the current system, owning a domain name is like renting property or entering into a contract.⁶⁸ And, although trademark law is applied in many domain name cases, intellectual property and its underlying principles may fail to map onto the domain name system.⁶⁹

III. BOOKING.COM

Booking.com was an 8-1 affirmance of the Fourth Circuit with Justice Ginsburg writing for the majority, Justice Sotomayor writing a concurrence, and Justice Breyer writing alone in dissent. The procedural history of this case illustrates the quiet erosion of the distinctiveness spectrum, which is a symptom of the more fundamental shift away from consumer protection as the core of trademark law.

A. PRE-SUPREME COURT

Beginning in 2011, Booking.com, a company, filed four separate trademark applications for the mark “booking.com.”⁷⁰ The USPTO rejected them all,

perma.cc/28YH-8ZCS]; Robert McMillan, *Turns Out the Dot-Com Bust's Worst Flops Were Actually Fantastic Ideas*, WIRED (Dec. 8, 2014), <https://www.wired.com/2014/12/da-bom/> [<https://perma.cc/W9M3-TK2J>].

67. Brandy Zadrozny, *Who Owns Coronavirus.com? Behind the Lucrative Profiteering on Website Domains*, NBC NEWS (Mar. 27, 2020), <https://www.nbcnews.com/news/amp/ncna1170411> [<https://perma.cc/3BUZ-QWS2>].

68. See Emily Hurtt, *What's in a Name: The Rights to Domain Names Under Various Principles of Law*, 85 U. CIN. L. REV. 839, 855 (2017) (explaining how contract and property law can map onto domain name rights, but that “intellectual property law is largely developed around the need to incentivize individuals to create . . . [T]his underlying purpose is not served in the context of domain names. Domain names are not registered to incentivize internet users to create; rather, they serve a functional purpose”); see also KOMAITIS, *supra* note 11, at 13 (“[D]omain names do not always perform the same functions as trademarks and ought not to be associated with the goodwill of a product or a service. For these and other considerable differences domain names should find their own place and individuality within legal theory.”).

69. See Hurtt, *supra* note 68, at 855–56.

70. Booking.com B.V. v. Matal, 278 F. Supp. 3d 891, 896 (E.D. Va. 2017), *amended*, No. 116CV425LMBIDD, 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), *as amended* (Feb. 27, 2019), *aff'd*, 140 S. Ct. 2298 (2020), and *cert. granted, judgment vacated*, 141 S. Ct. 187 (2020), and *aff'd sub nom.* Booking.com B.V. v. U.S. Pat. & Trademark Off., 915 F.3d 171 (4th Cir. 2019), *as amended*

finding that the mark was “merely descriptive of plaintiff’s services.”⁷¹ After Booking.com objected, the examining attorney found that acquired distinctiveness had not been proven and, in the alternative, that the mark was generic.⁷² Booking.com appealed, and the Trademark Trial and Appeal Board (TTAB) affirmed, specifically concluding that the addition of “.com” failed to transform the generic “booking.”⁷³

Booking.com then filed a civil action in the Eastern District of Virginia.⁷⁴ The district court found generally that “a mark composed of a generic [second-level domain] and a [top-level domain] is usually a descriptive mark eligible for protection upon a showing of secondary meaning.”⁷⁵ This conclusion contradicted the Federal and Ninth Circuits, which had considered similar terms, such as LAWYERS.COM, MATTRESS.COM, and ADVERTISING.COM, and held that the addition of a generic top-level domain failed to presumptively transform a generic term into a protectable term.⁷⁶ Nonetheless, based on the facts of this case, including survey evidence that had not been submitted with the trademark application, the court found specifically that Booking.com had “carried its burden of demonstrating the mark’s secondary meaning” and so was entitled to have it registered by the USPTO.⁷⁷

The USPTO appealed this decision to the Fourth Circuit.⁷⁸ Although the court of appeals considered the district court’s general rule to be incorrect, it affirmed the ruling based on the facts.⁷⁹ It held, “[A]dding ‘.com’ to [a second-level domain] can result in a non-generic, descriptive mark upon a showing of

(Feb. 27, 2019), and *aff’d*, 140 S. Ct. 2298 (2020), and *cert. granted, judgment vacated*, 141 S. Ct. 187 (2020).

71. *Id.* at 897.

72. *Id.*

73. *Id.* at 898.

74. *Id.* at 895.

75. *Id.* at 923.

76. *See, e.g., In re Reed Elsevier Props.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007) (“[I]t is abundantly clear that LAWYERS.COM is generic for the services identified.”); *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009) (“[B]ecause Dial-A-Mattress presented no evidence that ‘.com’ evoked anything but a commercial internet domain, this is not a case in which the addition of ‘.com’ affects the genericness of the mark.”); *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 980 (9th Cir. 2010) (rejecting the proposed per se rule that the addition of a top-level-domain to a generic term resulted in a protectable mark); *see also KOMAITIS*, *supra* note 11, at 49–51.

77. *Booking.com*, 278 F. Supp. 3d at 923.

78. *Booking.com B.V. v. U.S. Pat. & Trademark Off.*, 915 F.3d 171, 185 n.9 (4th Cir. 2019), *as amended* (Feb. 27, 2019), *cert. granted*, 140 S. Ct. 489 (2019), and *aff’d*, 140 S. Ct. 2298 (2020), and *cert. granted, judgment vacated*, 141 S. Ct. 187 (2020).

79. *Id.*

primary significance to the relevant public.”⁸⁰ Judge Wynn dissented, arguing in part that companies should be required to choose between an unprotected but valuable generic domain name and a protected yet less valuable non-generic domain name; they should not enjoy the benefits of both.⁸¹

At each stage the presumption shifted. The USPTO and TTAB argued for a per se rule against protecting certain domain names, depending on the distinctiveness categorization of the second-level domain. The district court, based on the same facts, the same precedent, and the same statute, came to the opposite conclusion. It devised a new rule, providing that the addition of a top-level domain to a generic second-level domain created a new descriptive term. Although the court of appeals held this rule to be legal error, it considered that error harmless.

B. SUPREME COURT

In an 8–1 decision authored by Justice Ginsburg, the Supreme Court affirmed the Fourth Circuit, holding that “[b]ecause ‘Booking.com’ is not a generic name to consumers, it is not generic.”⁸²

The Court faithfully applied the primary significance test in its reasoning. According to the Court’s statutory interpretation, 15 U.S.C. § 1064(3), which “govern[s] cancellation of registration,” evidences the primacy of consumer perception.⁸³ Under this section, Congress requires the factfinder to consider “the relevant public” when determining whether a registered mark has become generic.⁸⁴ In other words, if the relevant public perceives a once-distinct mark as generic, then that mark is no longer eligible for protection. The central question in *Booking.com*, however, was not genericide; *Booking.com* centered around the initial distinctiveness determination.⁸⁵ The sections that do address registration eligibility focus instead on the kinds of evidence that can be shown to prove secondary meaning and overcome the exclusion of “merely descriptive” marks.⁸⁶

Regardless, in assessing the primary significance of a mark in the minds of consumers, the Court first dispensed with the USPTO’s argument that the

80. *Id.* at 187.

81. *Id.* at 189 (Wynn, J., dissenting).

82. U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298, 2305 (2020).

83. *Id.* at 2304.

84. 15 U.S.C. § 1064(3).

85. The Court dispensed with this differentiation, which the USPTO raised in its briefing, explaining that the courts and the USPTO’s own training manual regularly apply the primary significance test to both an initial determination of genericness and to a determination of genericide. 140 S. Ct. at 2304 n.3.

86. 15 U.S.C. § 1052(e)–(f).

addition of a generic top-level domain to a generic second-level domain resulted in nothing more than a generic term.⁸⁷ As the Court explained, appending “.com” to a generic term could “convey to consumers a source-identifying characteristic: an association with a particular website.”⁸⁸ The USPTO, on the other hand, suggested a more comprehensive per se rule against protecting generic.com terms, which would have rendered some of its own determinations invalid.⁸⁹

Having addressed the USPTO’s proposed rule, the Court moved on to a discussion of the distinctiveness determination, affirming the court of appeals’s finding of harmless error as to the district court’s finding of distinctiveness based on the consumer survey evidence provided by Booking.com.⁹⁰ According to Booking.com’s expert’s interpretation of these “Teflon survey” results, 74.8% of respondents identified “booking.com” to be a brand name, while only 30% identified the control, “washingmachine.com,” to be a brand name.⁹¹ The USPTO did not challenge these findings. According to the Eastern District of Virginia, the Fourth Circuit, and the Supreme Court, these results indicated that the primary significance of “booking.com” was source-identifying, not identifying a class of products.

Along with considering the survey evidence, the Court also engaged in a linguistic thought experiment: would a consumer consider another booking company, like Travelocity or Expedia, to be “a Booking.com”?⁹² If so, the term is generic. If not, the term is capable of distinguishing goods in the marketplace and serving a source-identifying function. This resembles the “who-are-you/what-are-you” test, which posits that protectable marks can answer questions like, “Who are you? Where do you come from? Who do you vouch for?” while the generic names can answer only, “What are you?”⁹³

The Court also addressed concerns about the “animating policies” of trademark law, highlighting the weak protections descriptive terms receive and the limited anticompetitive impacts that may follow the Court’s holding.⁹⁴ The Court did not consider the domain name context to be meaningfully distinct

87. *Booking.com*, 140 S. Ct. at 2305.

88. *Id.* at 2306.

89. *Id.* at 2305 (“The PTO’s own past practice appears to reflect no such comprehensive rule.”).

90. 15 U.S.C. § 1064(3).

91. Brief for Respondent at 12, *Booking.com*, 140 S. Ct. 2298 (No. 19-46), 2020 WL 833244.

92. *Booking.com*, 140 S. Ct. at 2305.

93. *Filipino Yellow Pages, Inc. v. Asian J. Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (internal quotation marks omitted).

94. *Booking.com*, 140 S. Ct. at 2307.

from any other context; all of the anticompetitive ramifications that might stem from protecting BOOKING.COM would also stem from protecting any other descriptive mark in any other commercial situation.⁹⁵ In the Court's view, so long as other descriptive marks could be protected in other contexts, BOOKING.COM should be protectable as well. Similarly, the availability of other avenues for relief, such as unfair competition law, failed to alter the Court's interpretation of protectability under the Lanham Act.⁹⁶

In her concurrence, Justice Sotomayor questioned the probative value of consumer surveys but ultimately sided with the majority in rejecting the USPTO's per se rule.⁹⁷ She pointed to “[f]laws in a specific survey design, or weaknesses inherent in consumer surveys generally” to explain that consumer surveys were not the “be-all and end-all.”⁹⁸ Further, she explained that the USPTO could have found booking.com to be generic based on “dictionary and usage evidence,” which would have changed the underlying question of the case.⁹⁹ But as it stood, the USPTO did not contest the consumer perception determination as supported by the survey results; it argued that looking to consumer perception was unnecessary because BOOKING.COM was a generic compound.

Justice Breyer dissented, taking issue with the majority's willingness to offer protection to generic terms that have acquired secondary meaning. As he explained, “[The Lanham Act] extended trademark protection to descriptive marks that have acquired secondary meaning. But it did not disturb the basic principle that *generic* terms are ineligible for trademark protection.”¹⁰⁰ He considered a generic top-level domain to function like “Inc.” or “Co.” at the end of a business entity's name. Under *Goodyear Co. v. Goodyear Rubber Co.*,¹⁰¹ a trademark case from 1888, such generic commercial designations, when combined with other generic terms, created nothing more than a generic compound. While the majority held that the Lanham Act liberalized this common law principle, Breyer found *Goodyear* to be controlling.¹⁰²

95. *Id.* at 2308 (“All descriptive marks are intuitively linked to the product or service and thus might be easy for consumers to find using a search engine or telephone directory. The Lanham Act permits registration nonetheless.”).

96. *Id.* (“We have no cause to deny Booking.com the same benefits Congress accorded other marks qualifying as nongeneric.”).

97. *Id.* at 2309 (Sotomayor, J., concurring).

98. *Id.*

99. *Id.*

100. *Id.* at 2311 (Breyer, J., dissenting) (internal citations omitted).

101. 128 U.S. 598 (1888).

102. 140 S. Ct. at 2311 (Breyer, J., dissenting) (“I cannot agree with respondent that the 1946 Lanham Act ‘repudiate[d] *Goodyear* and its ilk.”).

In addition to differing on doctrine, Justice Breyer also departed from the majority as to the efficacy of consumer surveys, especially when the term at issue is exclusive by definition.¹⁰³ Linguistic markers like “the” and “co.” signal single entities, much like “.com,” which might give survey respondents a misleading sense of source identification.¹⁰⁴ “The Shoe Company” might read like a brand because it sounds like an official place that sells shoes.¹⁰⁵ In other words, survey results can be misleading—a third of the survey respondents believed washingmachine.com was a brand. As Justice Breyer pointed out, the difference is not due to the innate distinctiveness of BOOKING.COM but rather the advertising surrounding it.¹⁰⁶

Justice Breyer closed his dissent by considering the anticompetitive ramifications of the majority’s holding.¹⁰⁷ Like Judge Wynn argued in his Fourth Circuit dissent, Justice Breyer emphasized the “valuable piece of online real estate” that generic.com domain owners enjoy.¹⁰⁸ This competitive advantage is not tied to the goods or services being offered but instead to the luck and resources of someone operating in a first-come, first-serve system. For generic domain names, trademark law duplicates existing protections while stifling competition.

IV. ANALYSIS

This Part explains that, although the majority predictably aligned with precedent settled by cases like *Bayer Co. v. United Drug Co.*,¹⁰⁹ it did so without interrogating whether those precedents served the purposes of trademark law, especially as applied in new contexts. The anticompetitive effects that come with protecting merely descriptive marks are amplified in the domain name sphere. Companies have the ability to capture a piece of not only the linguistic commons, but also the online commons. With these purposes and this context in mind, this Part offers a new distinctiveness category that would improve the validity analysis under trademark law. This new category would encompass executable matter, such as top-level domain names, and explicitly exclude that category from trademark protection.

103. *See id.* at 2313 (“[S]urvey evidence has limited probative value in this context.”).

104. *See id.* at 2312.

105. *See id.* (“‘Wine Company’ expresses the generic concept of a company that deals in wine . . .”).

106. *Id.* at 2314.

107. *Id.*

108. *See id.* at 2315.

109. 272 F. 505, 509 (S.D.N.Y. 1921).

A. BOOKING.COM WAS A MISSED OPPORTUNITY TO REVIVE
GENERICNESS AND REAFFIRM CONSUMER PROTECTION AS THE CORE
OF TRADEMARK LAW.

Under the majority's reasoning, any term could be eligible for trademark protection, so long as evidence is presented to show that the term is source-identifying to consumers.¹¹⁰ Such evidence would push a term past the generic threshold and into the descriptive category. Once in that category, the applicant would need to prove acquired distinctiveness, an analysis that closely resembles the primary significance test.¹¹¹

Whether or not a mark is eligible for registration depends on whether it is generic, and according to the Court, this status is determined by consumers.¹¹² Paradoxically, this deference to consumers is antithetical to consumer protection; it defeats the very purpose of the distinctiveness requirement. Any term is eligible regardless of where it falls on the spectrum, and the only question left is the scope of protection afforded.

The majority's reliance on the genericide section of the Lanham Act fails to acknowledge the underlying purpose of that section: to render an entire category of terms ineligible for trademark protection.¹¹³ This section indicates that Congress intended for there to be a black hole of genericity. For determining whether a once-distinct mark had been swallowed by this black hole, Congress explicitly referred factfinders to the perceptions of the relevant public.¹¹⁴ Indeed, where else would the factfinder look?

On the other hand, for unregistered terms the factfinder proceeds from a different starting point: into which distinctiveness category does this proposed mark fall? Public perception can render an inherently distinctive mark generic, but public perception cannot render a generic term distinct. This axiom reveals the consumer protection purposes justifying the existence of the

110. Other commentators have recognized this reduction of the distinctiveness spectrum to a stark binary as the essential question at the heart of a trademark validity determination. See Beebe, *supra* note 38, at 671; Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1350 (2010) (describing the fundamental trademark validity test as whether "consumers understand the word in question to be the proper name of a brand of product or service or the common name of a product or service").

111. See Beebe, *supra* note 38, at 671 (explaining that eligibility is a binary distinction, making a non-generic determination equivalent to a descriptive-with-secondary-meaning determination).

112. *Booking.com*, 140 S. Ct. at 2305.

113. See 15 U.S.C. § 1064(3).

114. See *id.* ("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.").

distinctiveness spectrum and the generic marks category. No matter how much a company invests, a generic term remains a generic term for trademark purposes.¹¹⁵ Under the primary significance test as conceived by the Supreme Court and lower courts, however, the reasoning becomes circular: generic terms cannot be protected, but whether or not something is a generic term in the first place depends on consumer perception.

Moreover, trademark law has not always kept pace with linguistic evolutions, expressive changes, and semantic shifts.¹¹⁶ This disconnect has led scholars to reconsider how factfinders should evaluate distinctiveness. Some believe the prohibition against protecting generic terms should be lifted,¹¹⁷ reasoning within a traditional trademark context:

[P]roducers of goods or services typically do not choose obviously generic names as trademarks. They have no incentive to do so, for (1) the name can and will be duplicated by competitors (with no legal redress); and (2) for that reason, it serves no source-identifying purpose.¹¹⁸

But *Booking.com* located the weaknesses in this reasoning. It found a system that dissuades duplication by competitors and always implies, to some degree, a source. In this way trademark law lags behind developments in linguistics,¹¹⁹ and, as discussed below, it may also lag behind technological advancements.

115. *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“[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.”).

116. See Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J.L. & TECH. 110, 117 (2015) (“While trademark law reflects many regular forms of semantic shift, the doctrine of trademark incapacity drives a wedge between the law of trademark acquisition and the reality of semantic shift.”); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 398 (1990) (“[A]s trademark owners have begun to capitalize on the salience of these symbols in the culture, the justifications that formerly delineated the scope of the law have lost significance.”).

117. See, e.g., Linford, *supra* note 116; Deven R. Desai & Sandra L. Rierison, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789 (2007); Sandra L. Rierison, *Toward a More Coherent Doctrine of Trademark Genericism and Functionality: Focusing on Fair Competition*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 691 (2017). In these articles, the authors locate the purpose of trademark law in the common law tradition of unfair competition. On the other hand, this Note’s interpretation of the goals of trademark law subordinates unfair competition to the broader, more fundamental purpose of consumer protection. As this Note argues, unfair competition is not prevented for its own sake, but rather because unfair competition disserves the consuming public.

118. Desai & Rierison, *supra* note 117, at 1810–11.

119. For further writing on how trademark law could benefit from linguistics, see Graeme B. Dinwoodie, *What Linguistics Can Do for Trademark Law*, in TRADE MARKS AND BRANDS: AN

The Supreme Court could have used this as an opportunity to develop a new test for determining whether a mark is generic or descriptive. Justice Breyer flirted with such a shift by referring to the generic “nature” of certain terms, which suggests that, just as terms can be inherently distinctive, other terms can be inherently generic.¹²⁰ If a term is by nature generic, then no shift in public perception could change that nature. What Justice Breyer failed to address is how examining attorneys and courts should determine which terms are by nature generic. This determination might be simple for single words—“shoes,” “laptops,” and “blouses” are all clear examples of generic product categories. But the analysis gets trickier when generic terms are strung together and the result is considered as a whole. In *Goodyear*, the Supreme Court devised a shortcut for a specific situation: generic term + generic company designation = unprotectable mark.¹²¹ But, because the majority in *Booking.com* was unconvinced that “.com” and “Co.” operated equivalently, the discussion defaulted back to the primary significance test and, with it, manipulable public perception.¹²²

Despite the primary significance test being the default for factfinders, a variety of new and modified tests have been put forth by scholars over the past four decades.¹²³ Some tests ask factfinders to ignore non-commercial evidence altogether, focusing solely on evidence about how consumers understand a proposed mark to function in the marketplace.¹²⁴ This would foreclose the use

INTERDISCIPLINARY CRITIQUE 140 (Lionel Bently, Jennifer Davis & Jane C. Ginsburg eds. 2008).

120. See U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2310 (2020) (Breyer, J., dissenting).

121. See *Goodyear Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 604 (1888) (“‘Goodyear Rubber’ are terms descriptive of well-known classes of goods . . . Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them . . . The designation ‘Goodyear Rubber Company’ not being subject to exclusive appropriation, any use of terms of similar import, or any abbreviation of them, must be alike free to all persons.”).

122. See 140 S. Ct. at 2305–06 (“According to the PTO, adding ‘.com’ to a generic term—like adding ‘Company’—‘conveys no additional meaning that would distinguish [one provider’s] services from those of other providers.’ . . . That premise is faulty.”).

123. See, e.g., *supra* note 7; see also Jason K. Levine, *Contesting the Incontestable: Reforming Trademark’s Descriptive Mark Protection Scheme*, 41 GONZ. L. REV. 29, 71 (2005).

124. See Desai & Rierson, *supra* note 117, at 1854 (“Under our proposed approach, however, . . . [t]he court would first examine whether [the term] had any source identifying qualities. If that inquiry failed to demonstrate that [the term] retained any level of source identification, the inquiry would end because, absent source-identification, the term is not functioning as a trademark. If, however, source identification were found, the court would examine whether the competitors required the term to enter and compete in the market. The defendant would bear the burden of showing that there was no other commercially viable way

of dictionary definitions and media uses.¹²⁵ Others believe that generic terms should be protectable in certain circumstances, again hinging on consumer comprehension.¹²⁶ These proposals are a distilled version of the primary significance test; they give exclusive power to public perception in commercial contexts.¹²⁷ In doing so, these tests isolate and intensify the central weakness of the primary significance test: relying on impressionable public understanding to determine which marks receive protection.

Rather than focusing on consumers, another option for factfinders would be to inquire about competitors. This would put “fair use first,”¹²⁸ which some scholars have argued for in other areas of the distinctiveness inquiry. For example, Alexandra Roberts offers, “[The speech-act test] simply asks whether a hypothetical competitor could use one or more of the trademark’s component terms in good faith to describe its own product if the term is defined in accordance with contemporary usage.”¹²⁹ Roberts introduced this test to address the problem of overprotecting descriptive terms. By inquiring about competitors’ speech, she posits, consumers are better protected because more descriptive terms will be available for common use.

This fair use first test could be modified to replace the primary significance test altogether, serving as the initial hurdle applicants would need to clear in order to obtain a trademark. If applied to the genericness determination, this fair use first test would categorically exempt generic terms from eligibility—as the Lanham Act codified. For *Booking.com* in particular, competitors would have good faith reasons to use both “booking” and “.com” separately, as well as “booking.com” as part of a larger term.¹³⁰ This approach, making fair use an analytical tool in deciding initial eligibility rather than an after-the-fact

in which to refer to a given product.”); Heymann, *supra* note 110, at 1333 (“[O]nce it has been determined that a word functions as a mark—that it can and does function as a proper name of a X product or service—its degree of metaphor is irrelevant to its validity.”).

125. See Desai & Rierson, *supra* note 117, at 1836.

126. See Rierson, *supra* note 117, at 756 (“A court dispensing equitable remedies (which are typical in trademark infringement cases) should shape such remedies in a manner sufficient to prevent the consumer fraud and unfair competition that may result when words or product features have acquired distinctiveness, but nonetheless cannot be protected from trademark infringement as a result of the genericism or functionality doctrine.”).

127. A question beyond the scope of this Note is how intellectual property scholars using semiotic frameworks define the relevant consuming public for purposes of the primary significance test.

128. Roberts, *supra* note 25, at 1081–85.

129. *Id.* at 1078.

130. The Court rejected an argument that “.com” was functional and, like with trade dress, could not be protected. *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2306 n.5 (2020). Looking at it from the hypothetical competitor’s perspective, however, the generic top-level domain does seem more like a necessity and less like a choice.

defense would better protect potential junior mark holders and later entrants. Their language needs would be considered at the outset of the trademark eligibility decision, rather than asserted only as a shield when a senior mark holder brings an enforcement action.

Under this Note's conception of this new test, however, focusing on fair use first could unravel the current trademark system and vitiate the Lanham Act's express protection of descriptive terms that have acquired secondary meaning. Although this solution could bring the trademark system closer to its consumer protection roots, it cuts against Supreme Court jurisprudence and USPTO practices.

B. A NEW DISTINCTIVENESS CATEGORY WOULD ALLOW THE CURRENT LEGISLATIVE SCHEME TO PERSIST, WHILE GUARDING AGAINST THE MONOPOLIZATION OF LANGUAGE.

Rather than overhaul the current trademark eligibility determination by discarding the primary significance test, factfinders could instead recognize a new category along the distinctiveness spectrum: executable matter. Executable matter refers to the parts of a term that operate outside of linguistic communication. The "1-800" in a phone number and the ".com" in a web address, for instance, trigger an operation in a system—they ring a phone or take a user to a site, and without this function they would lose their value. While the basic question in *Booking.com* centered on whether a top-level domain was generic or descriptive, another solution could have been to acknowledge that it, as executable matter, was essentially neither.

In order to rethink the proper categorization of a top-level domain, this Note borrows from the fields of new media theory and literary criticism. This is in keeping with the intersection of trademark law and linguistics/semiotics, an overlap pioneered by the intellectual property scholars whose arguments are discussed in the previous Section. Some of these commentators applied their cross-field frameworks to *Booking.com*,¹³¹ but in doing so they may have overlooked the unique functions of quasi-linguistic matter like ".com." As new media theorists have explained, "Code that runs on a machine is performative

131. See, e.g., Rebecca Tushnet, *A Few Thoughts on the Booking.com Argument*, TUSHNET.COM (May 7, 2020), <https://tushnet.com/2020/05/07/a-few-thoughts-on-the-booking-com-argument/> [https://perma.cc/MV6X-4K3F]; Jake Linford, USPTO v. Booking.com – *A Linguistic Justification for 'Generic Trademarks'*, WRITTEN DESCRIPTION (June 16, 2020), <https://writtendescription.blogspot.com/2020/06/uspto-v-booking-com-linguistic.html>. Linford also contributed to a brief arguing that the trademark incapacity doctrine, which treats the generic nature of a trademark as immutable, is misguided. See Brief of Trademark and Internet Law Professors as Amici Curiae in Support of Respondent, *Booking.com*, 140 S. Ct. at 2298 (No. 19-46), 2020 WL 1028360.

in a much stronger sense than that attributed to language [C]ode running in a digital computer causes changes in machine behavior”¹³² Or, put differently, code is “*hyperlinguistic*. Code is a language, but a very special kind of language. *Code is the only language that is executable.*”¹³³ Instead of treating top-level domain names like language, this Note proposes treating them like code. The domain names do something—they take an internet user to a particular website. Without this function, the trademark application for BOOKING.COM likely would never have been filed.

Indeed, looking backward, this category of executable matter may have existed before the concept of code as performative language had been developed. It may have justified the outcomes in the cases discussed in *Booking.com*. For example, in *Goodyear* company designations were considered generic pieces of language—but what if instead they were viewed as being purely legally operative, with at most a shadow of linguistic meaning? Put differently, when appended to a company name, designations like “inc.” and “co.” *do* something. They flag to consumers the type of organizational category a business falls into, while also speaking that category into existence. They describe the legal positioning of an entity, and through this description reify the legal framework. When articulated with this legal function, “inc.” and “co.” are not linguistic but rather executive, and they should be considered non-distinctive.

Or, even more similar to the function of “.com” in a domain name, take the case of mnemonic telephone numbers like 1-800-FLOWERS.¹³⁴ Can these numbers receive trademark protection? Courts struggled with this problem three decades ago, sometimes treating mnemonic phone numbers as run-of-the-mill word marks requiring a comparative distinctiveness analysis, and other times protecting an admittedly generic mnemonic.¹³⁵ With the new category of executable matter, those telephone digits, 1-800-, would be excluded from receiving protection. The trademark applicants include the numbers because the numbers do something—they indicate to consumers what buttons to press on their telephone to connect with the applicant—not because the numbers are creative or catchy. By design, the digits are destination-identifying, not source-identifying.

132. KATHERINE N. HAYLES, MY MOTHER WAS A COMPUTER: DIGITAL SUBJECTS AND LITERARY TEXTS 50 (2005).

133. ALEXANDER R. GALLOWAY, PROTOCOL: HOW CONTROL EXISTS AFTER DECENTRALIZATION 165 (2004).

134. Horkey, *supra* note 20, at 213.

135. *Id.* at 230–37 (“The courts have forced mnemonics into the traditional [trademark] categories even though their technological anomalies require special consideration.”).

With the introduction of new technological platforms, the executable nature of these terms may be disarticulated. Under this Note's theory, 1-800-FLOWERS could receive protection today if applicants showed that it was being used in commerce not as a phone number, but as something else, like a website address. Similarly, company designations could be disarticulated in ways that would allow for trademark protection, like using "inc." as the name of a magazine. In the future, the internet as we now understand it may shift. URLs may fall out of use, and then, if Booking.com elects to keep the nostalgic appendage of a top-level domain name, it should finally be allowed trademark protection. This further protects consumers by promoting fair competition on popular platforms; as long as companies are vying for domains, the executable piece of a domain name lies beyond the reach of trademark.

For *Booking.com*, applying this new category post-hoc results in a simple analysis. Before looking at the compound term, a factfinder would ask the threshold question of whether any part of the mark constituted executable matter. If so, then that part of the mark is ignored for the distinctiveness analysis. For BOOKING.COM, this means that the mark's eligibility would have hinged on just the word "booking," which is easily categorized as a generic term.

C. TRADEMARK LAW IS REDUNDANT AND INEFFICIENT WHEN APPLIED IN THE DOMAIN NAME CONTEXT.

Consumer protection, semiotics, and executability aside, the domain name system infrastructure and market both provide ample protection for companies and their investments. Providing trademark protection for full domain names in this context is redundant and inefficient.

Because of regulatory bodies like ICANN, consumers can trust that a domain name resolves to the correct website.¹³⁶ As discussed above, according to the domain name system only one entity can be recognized as the owner of a particular domain name at a particular time. This could be offered as evidence of source identification for trademark purposes, as the majority relied on it.¹³⁷ But when considered in the context of the domain name system, this exclusivity function of websites reveals how unnecessary trademark protection really is.¹³⁸ Because a domain name corresponds to one and only one website,

136. Thornburg, *supra* note 50, at 159 ("[T]here can be no more than one amazon.com.").

137. U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2306 (2020).

138. See Brief for Elec. Frontier Found. as Amicus Curiae in Support of Petitioners at 17, *Booking.com*, 140 S. Ct. at 2298 (No. 19-46), 2020 WL 256707 ("Trademark law should reinforce the organizational structure of the DNS by limiting protection to domain names that combine [generic top-level domains] with non-generic [second-level domains] that can actually serve a unique distinguishing function."); see also Thornburg, *supra* note 50, at 159 n.28 ("The

competitors are incentivized to *avoid* associations with a generic web address; confusion runs the risk of a consumer ending up at the competitor's website. If generic.com domains necessarily signal a single entity, as the Supreme Court found, then such domains do not require the protection trademark law provides.

Furthermore, the measures Congress put in place for regulating trademarks and domain names reveal the extent to which it expected the systems to meaningfully interact. ICANN, UDRP, and ACPA all protect domain names that incorporate a registered trademark from being held hostage by squatters. This organization, policy, and statute could each evolve in purpose and in scope, but in their current form they conceive of only the second-level domain, such as “booking,” as the trademarkable part of a domain name.¹³⁹ Trademark applications for generic.com domains were being filed before ICANN was formally established—this is not a new issue to the trademark-domain intersection.¹⁴⁰

Now that the Supreme Court has injected intellectual property protection into an area more akin to real property or contract rights, new questions will arise that regulatory bodies are not equipped to resolve. For example, if Booking.com were to lose ownership of its domain, could another entity purchase it and use it? And would the trademark protection transfer to the new company? Could a company trademark a generic.com domain that it uses but doesn't own?¹⁴¹ If a company did receive trademark protection for a domain name it did not currently own, could it then request a proceeding pursuant to the UDRP? As mentioned above, trademark rights last in perpetuity, so even when the domain registration ends, the trademark protection continues.

uniqueness of second-level domain names means that domain name holders will have broader rights than those granted by trademark law, where multiple companies can have the same trademark so long as there is no danger of confusion.”).

139. Indeed, many commentators argue that the regulatory regime *should* evolve. See KOMAITIS, *supra* note 11, at 172–84 (cataloging reforms at the regulatory and techno-legal levels that would provide a more balanced approach and end the abuse of the DRP system); Hörnle, *supra* note 62, at 289 (detailing changes that would address the UDRP's “several serious procedural deficiencies”); David A. Simon, *An Empirical Analysis of Fair Use Decisions Under the Uniform Domain-Name Dispute-Resolution Policy*, 53 B.C. L. REV. 65, 129 (2012) (explaining how ICANN should reform the UDRP to eliminate “U.S. favoritism”).

140. See, e.g., U.S. Trademark Application Serial No. 75/408570 (filed Dec. 19, 1997) (cars.com); U.S. Trademark Application Serial No. 74/625099 (filed Jan. 24, 1995) (casino.com).

141. See Laura A. Heymann, *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/UK4M-2H7E].

Furthermore, offering trademark protection to a generic.com domain will cause changes in the market beyond those addressed by Justice Breyer's dissent. As he explained, this decision will likely have a chilling effect, dissuading "others from using variants on the registered mark."¹⁴² In addition, trademarking of a generic.com domain will devalue all slightly similar domain names. Because "ebooking.com" or "booked-up.com" or other neighboring domain names could infringe on the registered trademark, they necessarily carry some risk for any potential buyer. *Booking.com* will also impact the worth of any generic.com domain because there is now the possibility of trademark protection. A currently non-protected generic.com domain could, with the right consumer survey and the right advertising, become eligible for trademark protection.

At the same time, the domain name market is not a perfect system. Just as *pets.com* and *toys.com* now redirect to well-known brand websites, *Booking.com* could conceivably have purchased the same domain names that will be chilled or devalued by the Court's decision. Put differently, it's possible that *Booking.com* could have achieved an internet monopoly by buying up domains somewhat similar to its own domain. This alternative means to the same end raises a fundamental question: why did *Booking.com* pursue trademark protection in the first place? It alleged at oral argument that it would not enforce its protection against similar domain names.¹⁴³ Trademark litigation is expensive, consumer surveys are expensive, and, according to *Booking.com*, the active benefits of having a trademark on the principal register will not be enjoyed.

One explanation is that *Booking.com* does not need to formally initiate litigation to ward off potential competition. If potential competitors search for BOOKING.COM in the trademark database today, they will find it in the principal register. In reality, *Booking.com* holds very weak protection over the mark,¹⁴⁴ but business owners who lack a legal background or legal counsel may not be aware of the scope of protection. Indeed, trademark disputes are often

142. 140 S. Ct. at 2315.

143. Transcript of Oral Argument at 55–56, *Booking.com*, 140 S. Ct. 2298 (No. 19-46) ("JUSTICE ALITO: You would not—your client would not object to the registration of any trademark that simply made a slight variation in *Booking.com*? That would be fine? All of those companies could register their trademarks? . . . Would your client object to that? . . . MS. BLATT: They don't and have not and would not. Now, if there was fraud and somebody ripping off the goodwill based on *Booking.com*, I'm sure they'd want to sue, but it—it would be very hard to bring that lawsuit. Very hard.")

144. *Booking.com*, 140 S. Ct. at 2308 ("Booking.com concedes that 'Booking.com' would be a 'weak' mark.")

resolved in the pre-litigation stages.¹⁴⁵ Companies often send cease-and-desist letters, reportedly even when the arguments in those letters lack merit, and the threat of suit is often enough to push the alleged infringer to choose a different mark.¹⁴⁶ Booking.com could also initiate complaints under the UDRP now that it possesses the trademark.

By design, the domain name system protects companies and their investments. There is an exclusivity inherent in the one-owner-one-domain structure, which incentivizes competitors to avoid confusingly similar web addresses. And if an entity did try to cause confusion, then unfair competition laws are always available for recourse. Other laws and regulatory bodies also safeguard valid trademarks in the domain space. Adding traditional trademark protection atop all of this frustrates the system, creating redundancies and inefficiencies that work against the underlying purposes of trademark law.

D. IMPLEMENTING POSSIBLE SOLUTIONS

The once-clear poles of the distinctiveness spectrum have been pulled together. At this point, what purpose does the spectrum serve? Generic and descriptive have collapsed into one category: not inherently distinctive but can acquire secondary meaning. Suggestive, arbitrary, and fanciful make up the other category: inherently distinctive.

Allowing consumers to determine genericness fails to protect consumers, but there are options for strengthening the distinctiveness requirement. In the wake of *Booking.com*, like in the wake of *Anti-Monopoly*, Congress could amend the Lanham Act and strengthen the spectrum. It could require that both descriptive *and* suggestive marks require a showing of secondary meaning to be placed on the principal register.¹⁴⁷ It could also clarify how initial genericness is determined, making the primary significance test applicable only to cases of genericide. Under this Note's interpretation, factfinders should not look to consumer opinions to determine whether an applied-for mark is generic. Instead, they should make the threshold distinctiveness determination with consumer protection as their prime motivation, focusing on what component terms should remain available for collective use. The registration process needs reforming,¹⁴⁸ and this is one place to start.

145. William Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA HIGH TECH. L.J. 453, 456 (2012).

146. *Id.* at 485–87.

147. *See* Linford, *supra* note 18, at 1416.

148. *See* Tushnet, *supra* note 23, at 871–72 (“Registration provides opportunities to limit trademark’s current structurelessness.”).

Congress could also leave the existing legal framework and decades of precedent alone, while nonetheless undoing *Booking.com*. 15 U.S.C. §§ 1052(a)–(e) enumerate categorical exemptions from trademark eligibility, including insignia of the United States and the portrait of a deceased President of the United States during the life of his widow. Congress could add a new subsection excluding generic second-level and top-level domain compounds. This would still leave the examining attorneys, and potentially the courts, to determine genericness as to the domain name parts, but it would create an initial presumption that domain names like *booking.com* are non-trademarkable when attached to services that match the generic term. This maps onto the nearly per se rule that the USPTO advanced in *Booking.com*. It would undo existing trademark decisions,¹⁴⁹ but it would also create more predictability and administrability. And, regardless of the trademark decision, those domains would continue to belong to their owners.

Furthermore, as Justice Breyer pointed out in his dissent, even without trademark protection, unfair competition law protects companies against malicious, deceptive advertising.¹⁵⁰ Being denied a position on the principal register does not leave a company stranded.

Ultimately, there are many options to reform the distinctiveness spectrum. Factfinders could take Congress at its word and only apply the primary significance test to questions of genericide. For determining whether an applied-for mark is generic, then, examining attorneys and courts could justifiably employ a different test, though this would contradict existing practice and the dicta of the Supreme Court. Congress could amend the Lanham Act to nullify this precedent and clear the way for factfinders. In the alternative, Congress could carve out an exception solely for generic.com domain names, making them presumptively unprotectable, but potentially causing the disorder the Court warned of when dismissing the USPTO's per se rule.

Finally, and most preferably, courts and USPTO examining attorneys could begin drawing upon this Note's proposed new category, executable matter, in making distinctiveness determinations. This option leaves the overarching legal framework untouched but evolves one area within that framework to better align with the current structures and incentives of the domain name system.

149. See Brief for Respondent at 1a–11a, *Booking.com*, 140 S. Ct. 2298 (No. 14-96), 2020 WL 833244.

150. *Booking.com*, 140 S. Ct. at 2316 (Breyer, J., dissenting) (“[U]nfair-competition law will often separately protect businesses from passing off and false advertising.”).

V. CONCLUSION

In writing about trademarks, scholars, courts, and even this Note often describe trademark terms as being created by companies. Bayer gave us “aspirin.”¹⁵¹ Kellogg’s gave us “shredded wheat.”¹⁵² This description is only half true; the public “authors” trademarks, too.¹⁵³ Without consumers associating a symbol with a product and then purchasing that product, the words and marks would not carry any significance. This is why, at first blush, it seems intuitive to ground any trademark inquiry in relevant consumer understandings. Trademark terms are our terms, and so we should decide their capacity for distinguishing goods and sources in the marketplace.

But this is not the question that consumer surveys generally ask. They ask how consumers think a term operates based on controls and comparisons, but they fail to inquire about how consumers think a term *should* operate. If trademark power devolves in the public, then the tests should go beyond assessing consumer comprehension or public perception. They should evaluate whether the respondents believe language restrictions should be allowed for the words at issue. Put differently, do consumers know what’s at stake when they indicate that WASHINGMACHINE.COM is a brand?

I doubt that there will be a people’s PTO anytime soon. In the meantime, it bears repeating that trademark rights and domain name contract rights operate differently. Trademarks are context dependent. So long as there is not confusion or dilution, two identical trademarks can exist to identify different goods or services.¹⁵⁴ JAGUAR is a live trademark for the vehicle manufacturer, as well as for a plumbing and bathroom fixture provider.¹⁵⁵ The same word carries multiple meanings and associations simultaneously. In this way, domain names only approximate language—they still operate like IP addresses and lead to only one place. Even if a domain name carries multiple associations, its purpose is to operate within the internet system. Because of this, the well-established linguistic hypotheticals and consumer surveys fall short when applied in this new context without accounting for the fundamental differences. Domain names, indicated by the appendage of “.com,” answer

151. Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

152. Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 111–12 (1938).

153. See Steven Wilf, *Who Authors Trademarks?*, 17 CARDOZO ARTS & ENT. L.J. 1 *passim* (1999).

154. See Thornburg, *supra* note 50, at 159.

155. PF Waterworks LP succeeded in registering JAGUAR over Jaguar Land Rover Ltd.’s opposition. Jaguar Land Rover Ltd. v. PF Waterworks LP, Opposition No. 91240200 (T.T.A.B. 2019).

neither “Who are you?” nor “What are you?” They answer—and execute—an entirely new question: Where do I go to find you?

The American trademark system has arguably allowed for the “depletion” and “congestion” of useful, viable candidates for emerging brands to use as trademarks.¹⁵⁶ The same logic applies even more forcefully to the by-design scarcity of domain names.¹⁵⁷ Perhaps without realizing it, we use our language in the “shadow of trademark rights,”¹⁵⁸ despite the promise that our public perception is what ultimately invests and imbues a mark with legal significance.

This Note used *Booking.com* to illustrate how this overcrowding has unfolded. Courts’ uncritical applications of longstanding precedents have eroded certain safeguards for the linguistic commons¹⁵⁹ and expanded trademark protection for mark owners.¹⁶⁰ As this Note cataloged, there are a variety of potential solutions that would restore consumer protection to the heart of the federal trademark analysis. Although the Supreme Court avoided reworking the system in *Booking.com*, changes could be implemented by examining attorneys, lower courts, and even Congress.

The distinctiveness spectrum is a foundational piece of American trademark law. In theory, it incentivizes creativity and protects our shared linguistic commons, all in the name of promoting fair competition and protecting consumer interests. But language and technology change; meanwhile, the distinctiveness analysis has failed to evolve in tandem. Until URLs fall out of fashion, domain names should be controlled solely under contract rights and the existing domain name infrastructure, safely beyond the reach of trademark law.

156. See Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945 (2018).

157. See *id.*

158. See *id.* at 1025.

159. See Daniel J. Hemel & Lisa Larrimore Ouellette, *Trademark Law Pluralism*, 88 U. CHI. L. REV. 1025, 1026 (2021) (“Scholars and judges of trademark law have come to recognize in recent years that the pool of words, sounds, and symbols that are readily available to signify new goods and services is not unlimited . . . Earlier arrivals already have devoured the most memorable marks, leaving slim pickings for latecomers. The resulting pressure is pushing trademarks into regions once considered part of the ‘linguistic commons’—most recently, in a 2020 Supreme Court decision that a generic name with ‘.com’ appended to it, like ‘Booking.com,’ was potentially eligible for federal trademark registration.”).

160. See McKenna, *supra* note 11, at 1899, 1915 (explaining how “courts steadily expanded the scope of trademark law during the twentieth century” such that “[v]irtually every significant doctrinal development in the last century has given mark owners greater control over the use and meaning of their marks”).

