

Blog Post

Not All Domain Names Are Registrable, Even After Booking.com

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The question of whether a generic term combined with the .com gTLD extension could serve as a trademark was settled last July, when the U.S. Supreme Court ruled that the proposed trademark <booking.com> could not *automatically* be deemed to be generic, but could be registrable if consumers perceived the mark as a source identifier. *USPTO v. Booking.com B.V.*, ___ US ___, 141 S. Ct. 187, 207 L. Ed. 2d 1113 (2020) (blogged [here](#)).

The USPTO Trademark Trial and Appeal Board has now indicated how it will review such applications. In a precedential decision in *In re The Consumer Protection Firm PLLC* (T.T.A.B. 2021), the Board affirmed the refusal to register the trademarks THE CONSUMER PROTECTION FIRM and THECONSUMERPROTECTIONFIRM.COM & Design logo for “legal services” on the ground that they were generic; though the Board permitted registration of the logo on the Supplemental Register with a disclaimer of the term “The Consumer Protection Firm.”

Genericness

The determination of genericness involves a two-part test: (1) what the genus of the goods or services at issue is, and (2) whether the proposed mark is understood by the relevant public primarily to refer to that genus. *In re Reed Elsevier*, 82 U.S.P.Q.2d 1378, 1380 (Fed. Cir. 2007), *citing H. Marvin Ginn Corp. v.*

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There was no dispute that the genus at issue is defined by the identification of services in the applications, namely, “legal services.” The main issue presented in this case was whether the public could perceive the applied-for trademarks as trademarks and not merely generic terms.

The Examining Attorney submitted “a plethora of explanatory uses of ‘consumer protection,’ ‘consumer protection firm’ and ‘consumer protection law firm’” by the Applicant and competitor law firms that practice “consumer protection law.” However, the Applicant argued that, when the entire phrase THE CONSUMER PROTECTION FIRM is searched on the Internet, the search results pointed to the Applicant. In short, the Applicant’s position rests on the notion that adding “THE” made the difference in the understanding of consumers that THE CONSUMER PROTECTION FIRM primarily refers to the Applicant itself.

The Board disagreed, explaining that “it is well settled that adding the definite article ‘the’ to a generic term or phrase generally does not add any source-indicating significance or otherwise affect the term’s or phrase’s genericness.” *See, e.g., In re The Place Inc.*, 76 U.S.P.Q.2d 1467, 1468 (T.T.A.B. 2005) (holding THE GREATEST BAR merely descriptive of restaurant and bar services; “the definite article THE . . . add[s] no source indicating significance to the mark as a whole”); *Conde Nast Publ’ns Inc. v. Redbook Publ’g Co.*, 217 USPQ 356, 357, 360 (TTAB 1983) (holding THE MAGAZINE FOR YOUNG WOMEN a “common descriptive or ‘generic’ name of a class or type of magazine” and incapable of indicating source; “[t]he fact that the slogan also includes the article ‘The’ is insignificant. This word cannot serve as an indication of origin, even if applicant’s magazine were the only magazine for young women.”).

The Board also found little value in the Applicant's evidence of search engine results that directed a user to the Applicant's social media sites, various articles about the Applicant and interviews with its attorneys. As the Board noted, these "speak less to the source-identifying significance of THE CONSUMER PROTECTION FIRM than to efforts by Applicant's lawyers to make their law firm visible in social media and elsewhere on the Internet." The Board found that the Applicant did not support the premise that THE CONSUMER PROTECTION FIRM functions as a service mark simply because it appears higher within the search engine's search results, adding "[w]e are not privy to Google's page ranking algorithm, and we cannot simply assume that the order of appearance in search results is an indicator of the trademark significance of Applicant's Proposed Marks."

By contrast, the Examining Attorney's evidence showed use of "Consumer Protection" by three organizations — Super Lawyers, Findlaw, and LawInfo — as a "filter" for a category of law, allowing consumers to narrow their search for attorneys and law firms that practice in this area of the law. The Board found this to be "the most direct evidence" that consumers understand "Consumer Protection" to be "a category of legal practice in which some lawyers and law firms specialize."

Evaluating the record as a whole, the Board found sufficient evidence that the proposed word mark "THE CONSUMER PROTECTION FIRM" refers to a "class or category" of "legal services," namely, legal services concerning the laws related to consumer protection, and is understood by the relevant public primarily to refer to that subgenus of legal services. Accordingly, the word mark was found to be generic.

The Board next evaluated the applied-for logo. First, the Board noted that the Applicant, by disclaiming FIRM.COM on the Supplemental Register, conceded that this term is generic. However, the Examining Attorney did not provide evidence that *the design*

elements of the mark were incapable of protection. Therefore, the Board was “constrained to find that the Examining Attorney failed to show that the mark as a whole is generic.”

The Board therefore affirmed both refusals but allowed the Applicant thirty days within which to disclaim THE CONSUMER PROTECTION FIRM.COM and obtain registration of the logo on the Supplemental Register.

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The Applicant in this case received limited protection with a Supplemental Registration and every word disclaimed. Essentially, the Applicant obtained federal protection on the logo’s color scheme and arrangement. Still, the trademark will be displayed with a Circle-R symbol. That alone may deter others from adopting the mark or logo, so long as the potential user does not look too carefully at the prosecution history behind the mark and logo.

This information is intended to inform firm clients and friends about legal developments, including recent decisions of various courts and administrative bodies. Nothing in this Practice Update should be construed as legal advice or a legal opinion, and readers should not act upon the information contained in this Practice Update without seeking the advice of legal counsel. Prior results do not guarantee a similar outcome.