

Parsing Survey Results In Booking.com's TM Genericism Fight

By Rich Franciosa and Marie Minasi (March 6, 2020, 3:24 PM EST)

On March 23, the U.S. Supreme Court will hear arguments from the U.S. Patent and Trademark Office and Booking.com BV concerning whether Booking.com is a generic mark.

The USPTO contends that, as “booking” is generic for reservation services and “.com” is generic for online services, the combination of these generic terms does not constitute a protectable trademark.

Booking.com — along with 12 third parties, such as intellectual property associations, consultants and scholars, operating companies and brand owners who have filed amicus briefs — disagrees.[1]

Booking.com also contends that its Teflon survey, a common survey format to test genericness, found that 75% of survey participants view Booking.com as a brand name, which, along with other evidence, “should end this case.”[2]

On a standalone basis, 75% seems somewhat compelling, however, in the context of all survey findings, the evidence may not be as persuasive as Booking.com suggests.

Survey participants were presented with a series of names with descriptions, which they were asked to identify as brand names or common names in April 2016. The survey instructed its 400 participants that brand names “are names that companies use to identify who a product or service comes from,” while common names “are words used to identify a type of product or service.”[3]

The survey provided examples of brand names and examples of common names to educate participants.[4] Booking.com's expert disclosed that he included both a brand name and common name example that ended in .com to illustrate that not all domain names are brand names.

More than 96% of survey participants found that Pepsi, Shutterfly and Etrade.com were outright brand names, and more than 99% of participants found that “supermarket” and “sporting goods” were outright common names.[5]



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The remaining two names, Booking.com and Washingmachine.com, had mixed results. Booking.com, which was described as “hotel and other lodging reservation services,” was identified as a brand name by 75% of survey participants.[6] Washingmachine.com, which is a common name and was described as providing “reviews and sales of washing machines,” was falsely identified as a brand name by 33% of survey participants.[7]

Booking.com's expert justified Booking.com as a brand name as it had exceeded Washingmachine.com by a margin of 42% (75% less 33%). He also pointed to this margin as evidence that the number of survey participants who identified Booking.com as a brand name was “not the product of any flaw in the survey process that leads to a [domain name] being improperly deemed a brand because it is a web address.”[8]

One might expect the disparity to be larger than 42% as Booking.com has had a significant commercial presence. For instance, Booking Holdings Inc., the parent company to Booking.com, spent \$11 billion in advertising between 2006 and 2015 to “aggressive[ly]” market and promote Booking.com, Priceline.com, Kayak.com and others.[9] In 2015, Booking.com exceeded 100 million user accounts and had its one billionth guest stay.[10] Booking.com cited its availability in 224 countries and 43 languages and its more than 500 billion site visits in 2015.[11]

In contrast, Washingmachine.com had a limited commercial presence during the same 2006 through 2015 time period. Between 2010 and 2012, specifically, the site was not registered as a domain name. Beginning in 2013, the site redirected visitors to a different web address.[12] The commercial presence disparity can be further observed using Google Trends, which captures the relative interest in search terms on Google, over the same 2006 to 2015 period in the U.S.[13] Washingmachine.com had no interest relative to Booking.com, which continually grew from 2006 and reached significantly high interest levels in 2013, 2014 and 2015.

Although Washingmachine.com has a limited market presence, 132 out of the 400 survey participants (or 33%) still identified it as a brand name.[14] The opposing expert pointed to this survey result as evidence that despite Booking.com's expert's efforts to educate survey participants and to control bias, certain participants may link a domain name to a brand name.

In response, Booking.com's expert revised his initial opinion to exclude the 132 participants. For the remaining 268 participants, Booking.com's expert determined that 65% identified Booking.com as a brand name. Despite a 10 percentage point decrease from the expert's initial findings, he concluded that the 65% rate still justified Booking.com as a brand name because it was “far above 50% and virtually double the rate of [participants who responded] that it is a common name.”[15]

By excluding the 132 participants, Booking.com's expert implies that a common name, like “supermarket” or “sporting goods,” should be closer to 0% brand name recognition, and, presumably, a brand name, like Pepsi and Shutterfly, should be closer to 100% brand name recognition. The expert's revised survey findings suggest that Booking.com is neither.

Washingmachine.com and Booking.com were also the only names that did not result in consistent results among the different groups of survey participants. To conduct the survey, Booking.com's expert divided survey participants equally into four groups, which were each presented with the series of names in a different order. Among the four groups, recognition of Washingmachine.com and Booking.com as a brand name ranged from 17% to 58% and 53% to 94%, respectively.[16]

The opposing expert again pointed to this survey result as evidence that “respondents were not effectively educated or tested regarding the distinction between [domain] brand names and common names” and that the order of presentation impacted the results.[17]

Booking.com’s expert disagreed and did not adjust his survey findings for this critique. He suggested the various orders are standard features in a Teflon survey “to control for this phenomenon” and continued to reason that, in each variation, Booking.com exceeded 50% brand name recognition.[18] However, Booking.com’s expert did not acknowledge that Washingmachine.com, a common name, exceeded 50% brand name recognition in one of the groups.

The survey findings demonstrate domain names may have control and exclusivity advantages that nondomain names lack, and interpreting the domain name survey findings in a traditional manner may not be suitable given this potential bias.

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[1] SCOTUSblog, <https://www.scotusblog.com/case-files/cases/united-states-patent-and-trademark-office-v-booking-com-b-v>.

[2] Booking.com B.V. v. Joseph Matal and USPTO, 16-cv-00425, document number 64-1, pp. 10, 18-19 (Teflon survey); The Teflon survey presented terms including booking.com, washingmachine.com, etrade.com, Pepsi, Shutterfly, sporting goods and supermarket to the 400 survey participants. USPTO, et al. v. Booking.com B.V., No. 19-46, Brief of Booking.com B.V., dated February 12, 2020, pp. 12-13.

[3] Teflon survey, p. 10.

[4] Ibid.

[5] Teflon survey, pp. 18-19.

[6] Teflon survey, pp. 13-14, 18-19.

[7] Ibid.

[8] Ibid; USPTO, et al. v. Booking.com B.V., No. 19-46, Joint Appendix, dated January 6, 2020, (Joint Appendix) p. 162.

[9] Booking Holdings Inc. (formerly known as Priceline.com Inc. and The Priceline Group Inc), Form 10-Ks from 2006 to 2015.

[10] Booking Holdings Inc., Q4 2015 Earnings Call dated February 17, 2016, p. 6.

[11] Joint Appendix, p. 146.

[12] For example, see Internet Archive, http://web.archive.org/web/2012*/washingmachine.com (accessed March 1, 2020).

[13] For example, see USPTO, et al. v. Booking.com B.V., No. 19-46, Brief of Amici Curiae Survey Scholars and Consultants in support of Respondent, p. 15; <https://trends.google.com/trends/explore?date=2006-01-01%202015-12-31&geo=US&q=booking.com,washingmachine.com> (accessed March 1, 2020). A value of 0 means there was not enough information for this term.

[14] 25 participants responded “don’t know” if washingmachine.com is a brand name or common name.

[15] USPTO, et al. v. Booking.com B.V., No. 19-46, Joint Appendix, dated January 6, 2020, pp. 164-166. Of the 132 participants, 7 found booking.com to be a common name; adding these 7 participants back to the survey population would decrease the revised findings from 65 percent to 63 percent.

[16] Booking.com B.V. v. Joseph Matal and USPTO, 16-cv-00425, document number 61-3, pp. 11, 18 (Response to Teflon survey).

[17] Response to Teflon Survey, p. 20.

[18] Joint Appendix, p. 170.