

Of Lawyers, Hotels, and Mattresses: The Federal Circuit's Ever-expanding Genericness Test for [Thing].com Marks

By Thomas L. Casagrande

To date, the Federal Circuit has grappled with the registrability of five [THING].COM trademarks:

- patents.com;
- steelbuilding.com;
- lawyers.com;
- hotels.com; and
- mattress.com.

In all five cases, the Federal Circuit affirmed the refusal of the U.S. Patent and Trademark Office (USPTO) to register the mark.¹ Its rationale, however, seems to have changed over time. It rejected the first two marks on descriptiveness grounds, but the latter three on genericness grounds.

This article argues that, in its [THING].COM jurisprudence, the Federal Circuit initially and correctly held that such marks were not generic for online services involving the “thing” at issue and correctly employed its descriptiveness analysis to require a showing of secondary meaning before permitting registration. More recently, however, the Federal Circuit has expanded its genericness test in a way that is contrary to prior precedent. This expanded genericness test seems to contradict how consumers view [THING].COM marks. The article concludes that while many [THING].COM marks may well be descriptive (and thus would require proof of secondary meaning to qualify for registration), very few could (or should) be considered generic.

Overview of the Federal Circuit's Standards for Determining Whether a Mark Is Distinctive Enough to Qualify for Registration

“In order to be registered, a mark must be capable of distinguishing the applicant's goods from those of others.”² Marks that are generic for, or merely descriptive of, the goods or services in connection with which they are used do not qualify as “inherently distinctive,”³ i.e., inherently incapable of distinguishing the owner's goods or services.

Genericness

A generic term describes the “genus” of the goods or services being sold. In other words, it “is the common descriptive name of a class of goods or services.”⁴ A generic term cannot serve as a trademark.⁵ The Federal Circuit's benchmark test for genericness is “whether members of the public use or understand the term sought to be protected to refer to the genus of goods or services in question.”⁶ The Federal Circuit's widely cited *Marvin Ginn* decision describes the inquiry this way:

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?⁷

Under Federal Circuit precedent, the public's understanding is generally shown through evidence that the public “uses” the asserted mark to identify the genus of goods or services or that the public “refers to” the genus of goods or services by the asserted mark.⁸ A mark's “[a]ptness [as a generic term] is insufficient to prove genericness.”⁹ The Federal Circuit has looked to evidence such as purchaser testimony, consumer surveys, dictionaries, newspapers, and trade journals.¹⁰

Even if a mark consists of two or more words used together (a “compound”), the mark nevertheless must be assessed as a whole. It is insufficient to assess whether the individual terms alone are generic, unless it is “clearly proven” that the mark as a whole is no less generic than the sum of its parts.¹¹ The shortcut embodied in this latter exception is attributed to the Federal Circuit's decision in *In re Gould Paper Corp.*,¹² which held that the compound term SCREENWIPE was generic for cloths for cleaning computer and television screens.¹³ In *Gould*, the Federal Circuit held that, “[i]n this instance, the terms [“screen” and “wipe”] remain as generic in the compound as individually, and the compound thus created is itself generic.”¹⁴ Until its 2009 decision in *In re Hotels.com*,¹⁵ the Federal Circuit limited application of the “compound word,” or *Gould*, doctrine, however, to true compound words, i.e., to a unitary term formed by the union of multiple words.¹⁶

Because genericness is an incurable disqualification from achieving trademark status, the USPTO must prove it by “clear evidence.”¹⁷

Mere Descriptiveness

The Federal Circuit has pointed out that a mark that is “not literally a genus or class name” but that describes the class is not generic but descriptive.¹⁸ “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.”¹⁹ However, if a mark requires imagination, thought, or perception to arrive at the qualities or characteristics of the goods, then the mark is suggestive, and thus is inherently distinctive.²⁰

As with genericness, the perception of the relevant purchasing public is the benchmark for determining descriptiveness.²¹ Descriptiveness is considered in relation to the particular goods for which registration is sought, the context in which the term is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.²² As with the genericness inquiry, the mark must be considered as a whole.²³

The Precursor to the [THING].com Decisions: The Case of the 1-800-[T-H-I-N-G] Mark

Before the prevalence of the Internet for shopping at home, there were retailers who conducted shop-at-home businesses through the use of 1-800-[T-H-I-N-G] toll-free, mnemonic telephone numbers. *In re Dial-A-Mattress Operating Corp.*²⁴ was an appeal from a refusal to register the mark 1-888-M-A-T-R-E-S-S.²⁵ The TTAB had determined that the mark was generic, or, in the alternative, merely descriptive and without secondary meaning.²⁶ On appeal, the Federal Circuit reversed, holding that 1-888-M-A-T-R-E-S-S was not generic²⁷ and that the applicant had made out a prima facie showing of acquired distinctiveness.²⁸

The Federal Circuit first applied its traditional, two-step genericness inquiry.²⁹ It determined that the “genus” was “telephone shop-at-home services for retail mattresses.”³⁰ As to the second step (whether the public would understand the mark to refer to the genus), the Federal Circuit first rejected the TTAB’s application of the *Gould* “compound word” test³¹ to 1-800 marks:

In re Gould does not apply here because “1-888-M-A-T-R-E-S-S”—a mnemonic formed by the union of a series of numbers and a word—bears closer conceptual resemblance to a phrase than a compound word. It is devoid of source-indicating significance, but “(888)” is not a word and is not itself a generic term for selling by telephone.³²

Instead, the court rejected the TTAB’s determination that the mark was generic because

there was no evidence that the relevant public refers to the class of shop-at-home mattress retailers as “1-888-M-A-T-R-E-S-S.” “Telephone shop-at-home mattresses” or “mattresses by phone” would be *more apt generic descriptions*. Like the title “Fire Chief” for a magazine in the field of fire fighting, a phone number is *not literally a genus or class name*, but is *at most descriptive* of the class.³³

The Federal Circuit’s [THING].COM Decisions

Three years after upholding the registrability of a 1-800-[THING] mark in *Dial-A-Mattress*, the Federal Circuit entertained its first appeal over a [THING].COM mark. In each of its five precedential [THING].COM decisions, the Federal Circuit refused registration of the mark. Over time, however, its primary rationale has shifted from “mere descriptiveness” to genericness.

In re Oppedahl & Larson LLP, 2004 (Held: Descriptive)

The Federal Circuit’s first [THING].COM case was its 2004 decision in *Oppedahl & Larson*.³⁴ Oppedahl & Larson filed an application to register the trademark PATENTS.COM for software designed to track patent applications and issued patents.³⁵ The TTAB determined that PATENTS.COM was merely descriptive because “patents” described a feature of the goods and “.com,” like “Inc.” or “Corp.,” lacked trademark significance.³⁶ The Federal Circuit agreed with the TTAB that the term “patents” is a descriptive feature of the software.³⁷ The court further noted that the addition of “.com” typically conveys to consumers only the impression of a company on the Internet,³⁸ although it noted that this was “not a bright-line, per

se rule.”³⁹ Finally, the Federal Circuit held that the combination of these two descriptive components did not change the result as the mark as a whole was descriptive.⁴⁰ Importantly, however, the court left open the possibility that a [THING].COM mark could be registered if it later acquired secondary meaning.⁴¹

In re Steelbuilding.com, 2005 (Held: Descriptive)

*In re Steelbuilding.com*⁴² presented slightly different circumstances. The TTAB had refused registration of the mark STEELBUILDING.COM on the grounds that it was generic or, in the alternative, merely descriptive of the applicant’s services, which were described as “computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems.”⁴³ The Federal Circuit again affirmed the refusal to register, but it rejected the finding of genericness.

On the issue of genericness, the Federal Circuit ruled that the TTAB, in defining the relevant “genus” as “the sale of pre-engineered ‘steel building’ on the Internet,” misunderstood the applicant’s services. Specifically, it held that the TTAB “failed to acknowledge the interactive design feature of the applicant’s goods and services.”⁴⁴ As to the second aspect of the genericness test, the court determined that there was sufficient evidence that “‘STEELBUILDING,’ in common usage, is a compound word used to mean either ‘steel building’ or ‘steel buildings.’”⁴⁵

The Federal Circuit’s final criticism of the TTAB’s genericness ruling was that it erroneously applied a per se rule that attaching “.com” at the end of a mark does nothing to add to an asserted mark’s distinctiveness.⁴⁶ The court noted that, in the “unusual” case before it, the addition of the suffix “.com” “expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings.”⁴⁷

Turning to descriptiveness, however, the Federal Circuit held that the term “steelbuilding” described a significant feature of the applicant’s services.⁴⁸ The court also agreed that, for descriptiveness purposes, the addition of the suffix “.com” simply meant that the services were performed in an online environment.⁴⁹

In re Reed Elsevier Properties Inc., 2007 (Held: Generic)

*In re Reed Elsevier Properties Inc.*⁵⁰ was the first decision in which the Federal Circuit held that a [THING].COM trademark was generic. The mark at issue was LAWYERS.COM for “providing access to an online interactive database featuring information exchange in the fields of law, lawyers, legal news, and legal services.”⁵⁰ The TTAB defined the “genus” as “a web site with a database of information covering the identified topics of law, legal news and legal services” and further determined that “a central and inextricably intertwined element of that genus is information about lawyers and information from lawyers.”⁵¹

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On appeal, the Federal Circuit upheld the TTAB's analysis of the genus. Trying to differentiate the word "lawyers" from the genus, Reed Elsevier argued that it was not trying to register the mark "for selling lawyers or offering services of lawyers."⁵² The Federal Circuit, however, rejected the argument, adopting instead a novel "integral part" or "focus" test: "as Reed and Martindale-Hubbard [sic] should know, for better or worse, *lawyers are necessarily an integral part* of the information exchange about legal services."⁵³

The Federal Circuit's discussion of what the relevant public would understand LAWYERS.COM to mean was terse. The court pointed out that

Reed does not take issue with [the] finding that the relevant public "would readily understand the term to identify a commercial web site providing access to and information about lawyers." Instead, it merely reargues that information about lawyers and providing information to assist in contacting lawyers is discrete from information about the law, legal news, and legal services. This contention is of no moment, because, as set out above, in the context of Reed's website these services are not discrete.⁵⁴

The court also noted that the TTAB properly considered "eight websites containing 'lawyer.com' or 'lawyers.com' in the domain name . . . in order to illuminate what services the relevant public would understand a website operating under Reed's mark to provide."⁵⁵

In re Hotels.com, 2009 (Held: Generic)

In *Hotels.com*, the TTAB found the mark HOTELS.COM generic for "providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network."⁵⁶ Just as the Federal Circuit first did (without explanation) in the *Reed* decision, the TTAB in *Hotels.com* looked at the "focus" of the claimed services.⁵⁷

On appeal, Hotels.com argued that it does not offer hotel services but serves instead as "an information source and travel agency."⁵⁸ Thus, it argued that the HOTEL component of its mark was not generic. It further argued that the term HOTELS.COM is not synonymous with hotels.⁵⁹ Finally, Hotels.com pointed to its substantial evidentiary presentation to the TTAB, including a survey that "showed that 76% of respondents regarded HOTELS.COM as a brand name for a business that makes hotel reservations and provides information about hotels"⁶⁰ and 64 declarations from customers, vendors, and competitors, all attesting that the term HOTELS.COM was not generic.⁶¹

But the Federal Circuit again found "no error" in the TTAB's genericness analysis.⁶² As to the TTAB's legal analysis, the court upheld the TTAB's seemingly incongruous "conclusion that 'hotels' indicates the genus of hotel information and reservation services."⁶³ Without discussing *Dial-A-Mattress's* impact,⁶⁴ the court applied *Gould's* rule for "compound word" marks for the first time to a [THING].COM trademark.⁶⁵ Using *Gould*, the Federal Circuit accepted the TTAB's finding that the term HOTELS.COM communicates no more than the common meanings of the individual components, "hotels" and ".com."⁶⁶

As to Hotels.com's substantial evidentiary presentation, the Federal Circuit did not criticize the TTAB's rejection of the survey results purporting to show that 76% of respondents thought that HOTELS.COM was a brand name.⁶⁷ Moreover, the Federal Circuit did not take the TTAB to task for what appeared to be another incongruous observation that "consumers may automatically equate a domain name with a brand name."⁶⁸ Yet this statement would seem by itself to negate the very conclusion that the TTAB drew (and which the Federal Circuit affirmed), for if consumers tend to view domain names as brand names, that would almost automatically refute the notion that domain names are simultaneously the genus of the goods or services.

In re 1800MATTRESS.COM, 2009 (Held: Generic)

Most recently, the Federal Circuit ruled that the mark MATTRESS.COM was generic for "online retail store services in the field of mattresses, beds, and bedding."⁶⁹ The TTAB held the mark generic based primarily on the new "focus" test and the fact that several other mattress-related online businesses used "mattress.com" in their domain names.⁷⁰

The Federal Circuit approved the TTAB's practice of giving "controlling weight" to evidence that others use ____ [thing].com for online [thing]-related businesses in determining that a [THING].COM mark is generic.⁷¹

Expanding its genericness test further, the Federal Circuit also held that "it is *irrelevant* whether the relevant public refers to online mattress retailers as 'mattress.com'"⁷²—ignoring prior precedent deeming such evidence not only relevant, but pivotal.⁷³

How the Federal Circuit's [THING].COM Jurisprudence Went Wrong and How to Fix It

The Federal Circuit's first two [THING].COM decisions were unexceptional, reflecting relatively straightforward application of settled principles. In each of its next three [THING].COM decisions, however, the court progressively (and, arguably, impermissibly)⁷⁴ broadened its genericness inquiry.

The Lawyers, Hotels, and Mattress Trilogy's Expansion of the Genericness Analysis

The first—and most significant—departure from, and broadening of, prior genericness precedent took place in *Reed Elsevier*. *Reed Elsevier* did so in two ways. First, it broadened the "genus" inquiry to include "things" that are a "focus," or an "integral" aspect, of the services.⁷⁵ The panel, however, did not address whether this analysis would expand the genericness inquiry to overlap with the descriptiveness inquiry, which looks to whether the mark conveys an ingredient, feature, characteristic, or quality of the good or service.⁷⁶ One can see how this new "focus" or "integral aspect" test represents a broadening of the genericness analysis by observing that it may well have led to a different result in the seminal *Marvin Ginn* case. In *Marvin Ginn*, the mark FIRE CHIEF—the title of a magazine about firefighting and for fire chiefs—was held *not* to be generic,⁷⁷ yet it is clear that fire chiefs are a focus or integral aspect of the magazine.

The analysis also appears to depart from *Steelbuilding.com*. In *Steelbuilding.com*, the court indicated that, while

steel buildings are the primary focus of (or “integral” to) the service, there is in addition an interactive design component and online functionality.⁷⁸ Thus STEELBUILDING.COM was not the generic name for all these services combined.⁷⁹ In *Reed Elsevier*, the same could be said for LAWYERS.COM. The genus encompassed more than the offering of lawyers’ services, including search and rating functions and legal news.

In addition, by asking whether the sought [THING] was an “integral” part, or the “focus,” of the services, the *Reed Elsevier* panel effectively rigged the genus inquiry against trademark status and in favor of genericness. If the USPTO is permitted to determine—in the first step of the genericness test—whether the [THING] is an integral part of the defined genus, and then, in the second step, ask whether the consuming public understands the [THING] to refer to the [THING], it is difficult to see which [THING].COM trademarks could ever survive this circular test and rise beyond generic.

The second point of expansion—where the *Reed Elsevier* panel held that consumers would “readily understand” LAWYERS.COM to identify a website that provides information about lawyers—appears contrary to the rule that mere “aptness” as a generic term is insufficient if the consuming public doesn’t actually use the term to refer to the class of services.⁸⁰ In actuality, the *Reed Elsevier* panel’s observation appears more appropriate in the descriptiveness inquiry, which looks at whether the mark “conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.”⁸¹ Specifically, consumers would know that the site has something to do with lawyers, but what? Is it a lucky law firm that got the best domain name? A law firm rating service? An engine to search for lawyers? A legal search tool? A professional networking site?

Third, the *Reed Elsevier* panel permitted consideration of other websites under the names “_____lawyers.com” to determine what the public would think about the proposed mark.⁸²

The *Hotels.com* panel applied the newly expanded *Reed Elsevier* “focus” or “key aspect” test and determined that the genus of hotel information and reservation services is “hotels,”⁸³ which predictably (and necessarily) led to a finding that “hotels” is understood to refer to “hotels.” And despite the *Dial-A-Mattress* ruling limiting *Gould*’s “compound word” test to unitary compound words composed of two words,⁸⁴ the court expanded use of *Gould* to the joinder of a word with the suffix “.com.”⁸⁵ Finally, the *Hotels.com* panel looked to whether there were other “_____hotels.com” websites offering services that overlapped with those of *Hotels.com*.⁸⁶

The final expansion (so far) came in *1800MATTRESS.COM*, where the panel called “irrelevant” one type of evidence that historically had been one of the focal points of the genericness inquiry: whether the consuming public refers to the genus by the asserted mark, i.e., whether the public actually uses the term generically.⁸⁷

The Fix

The path to “fixing” the Federal Circuit’s ever-expanding genericness analysis as to [THING].COM marks is straightforward: the rule of “interpanel accord.” Under this rule, when prior decisions conflict, the panel identifying the conflict is

bound by the earlier precedent (here, genericness precedent predating the *Lawyers, Hotels, and Mattress Trilogy*), until the conflict is resolved.⁸⁸ Such conflicts may be resolved *en banc* or by the Supreme Court.⁸⁹ Thus, the next panel presented with the question of whether a [THING].COM mark is generic need only acknowledge how the *Reed Elsevier*, *Hotels.com*, and *1800MATTRESS* decisions each departed from settled precedent, and then apply pre-*Trilogy* genericness precedents faithfully.

The question “why?” remains: Does the *Lawyers, Hotels, and Mattress Trilogy* represent an unintentional and unwitting expansion of the genericness test, or does it reflect an unspoken hostility toward [THING].COM marks? Perhaps the Federal Circuit (and the USPTO) are concerned about whether registrants of [THING].COM marks will turn litigious and try to use infringement suits to chill competition and/or to stop noncompeting uses of _____thing.com websites—a result they could not achieve under the ICANN regime governing the registration of domain names.⁹⁰ But the nature of these marks—which are tied to the “first to register” regime for domain names—almost necessarily makes for extraordinarily “crowded fields,” which severely restricts a [THING].COM registrant’s ability to obtain judicial relief.⁹¹ Moreover, if such suits become a chill on competition, Congress could amend the Lanham Act to address it.

In any event, [THING].COM trademarks would almost always face a difficult descriptiveness hurdle. It would be far more intellectually honest to address them under settled descriptiveness principles than to try to discourage further applications through the unjustified broadening of previously settled genericness principles. ■

Endnotes

1. The Federal Circuit has appellate jurisdiction over registration decisions of the USPTO’s Trademark Trial and Appeal Board (TTAB). 15 U.S.C. § 1071(a). The TTAB is an administrative adjudicative body that hears appeals from final decisions of trademark examiners’ registration decisions. 15 U.S.C. § 1070.

2. *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003) (citations omitted).

3. *See, e.g., id.* Generic marks can never be registered, *see, e.g., In re Hotels.com*, 573 F.3d 1300, 1302 (Fed. Cir. 2009), but “merely descriptive” marks can if, through use, they gain “acquired distinctiveness” (a/k/a “secondary meaning”). *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173–74 (Fed. Cir. 2004).

4. *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986).

5. *See, e.g., Lawrence Mfg. Co. v. Tenn. Mfg. Co.*, 138 U.S. 537, 547, 11 S. Ct. 396, 400 (1891); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001).

6. *Marvin Ginn*, 782 F.2d at 989–90 (citations omitted); *cf. Dial-A-Mattress*, 240 F.3d at 1346 (mark not generic where it is “not literally a genus or class name, but is at most descriptive of the class”) (emphasis added) (citing *Marvin Ginn*, 782 F.2d at 991).

7. 782 F.2d at 990.

8. *See, e.g., In re Am. Fertility Soc’y*, 188 F.3d 1341, 1345–48 (Fed. Cir. 1999). In *Fertility*, the Federal Circuit concluded that its precedents required evidence of public use of the mark as a generic term unless the mark combined multiple words into a single-word mark and it was plain that the mark as a whole had no different meaning than its constituent parts. *See id.* at 1346–48. Similarly, the later *Dial-A-Mattress* decision also found it dispositive that “there is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers

as ‘1-888-M-A-T-R-E-S-S.’” 240 F.3d at 1346 (emphasis added) (citing *Marvin Ginn*, 782 F.2d at 991); see also *In re Merrill Lynch, Pierce, Fenner, and Smith*, 828 F.2d 1567, 1569–70 (Fed. Cir. 1987).

9. *Fertility*, 188 F.3d at 1347.

10. See, e.g., *Merrill Lynch*, 828 F.2d at 1570.

11. See *Fertility*, 188 F.3d at 1348.

12. 834 F.2d 1017 (Fed. Cir. 1987).

13. See *id.* at 1019.

14. *Id.*

15. 573 F.3d 1300 (Fed. Cir. 2009); see *infra*, notes 56–68 and accompanying text.

16. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345 (Fed. Cir. 2001) (“The *In re Gould* test is applicable only to ‘compound terms formed by the union of words’ where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends ‘no additional meaning to the term.’”) (citation omitted); *id.* at 1346 (“*In re Gould* does not apply here because ‘1-888-M-A-T-R-E-S-S’ a mnemonic formed by the union of a series of numbers and a word bears closer conceptual resemblance to a phrase than a compound word.”) (citation omitted); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1348 (Fed. Cir. 1999) (holding that “*Gould* is limited, on its facts, language, and holding, to compound terms formed by the union of words,” and refusing to apply *Gould* to SOCIETY FOR REPRODUCTIVE MEDICINE); cf. *Cummins Engine Co. v. Cont’l Motors Corp.*, 359 F.2d 892, 894 (C.C.P.A. 1966) (TURBODIESEL generic for turbo-charged diesel engines).

17. See, e.g., *Fertility*, 188 F.3d at 1571; *In re Merrill Lynch, Pierce, Fenner, and Smith*, 828 F.2d 1567, 1571 (Fed. Cir. 1987); cf. *In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393 (Fed. Cir. 1994) (“A strong showing is required when the Office seeks to establish that a term is generic, not descriptive, for specific goods or services to which the applicant has attached it.”) (citation omitted). “Clear evidence” is equivalent to “clear and convincing” evidence. See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009).

18. *Dial-A-Mattress*, 240 F.3d at 1346 (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 991 (Fed. Cir. 1986)); see also *In re Northland Alum. Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985) (differentiating a “mark that is merely descriptive, but not the common name of the goods”).

19. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963–64 (Fed. Cir. 2007); see also *Dial-A-Mattress*, 240 F.3d at 1346 (“A trademark is descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the product.”) (citation omitted).

20. *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001); *In re Quick-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980).

21. See *Dial-A-Mattress*, 240 F.3d at 1346.

22. See *Bayer*, 488 F.3d at 963–64.

23. See, e.g., *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174 (Fed. Cir. 2004).

24. 240 F.3d 1341 (Fed. Cir. 2001).

25. *Id.* at 1344.

26. *Id.*

27. *Id.* at 1346.

28. *Id.* at 1348.

29. *Id.* at 1344; see also *supra* n.7 and accompanying text.

30. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001).

31. See *supra* notes 11–14 and accompanying text.

32. *Dial-A-Mattress*, 240 F.3d at 1346 (citation omitted).

33. *Id.* (citations omitted; emphasis added).

34. 373 F.3d 1171 (Fed. Cir. 2004).

35. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1172 (Fed. Cir. 2004).

36. *Id.* at 1173.

37. *Id.* at 1176.

38. *Id.*

39. *Id.* at 1177.

40. *Id.* at 1176. The Federal Circuit rejected the argument that [THING].COM marks are inherently distinctive because they necessarily can be associated with only one owner. *Id.* at 1176–77.

41. *Id.* at 1176.

42. 415 F.3d 1293 (Fed. Cir. 2005).

43. *In re Steelbuilding.com*, 415 F.3d 1293, 1296 (Fed. Cir. 2005).

44. *Id.* at 1298.

45. *Id.* (citation omitted).

46. *Id.* at 1299 (the addition of “.com” “expanded the mark to include internet services that include ‘building’ or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure”).

47. *Id.*

48. *Id.*

49. *Id.* at 1300.

50. *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007).

51. *Id.*

52. *Id.* at 1379.

53. *Id.*; see also *id.* (“lawyers, not surprisingly, are a focus”); see *infra* notes 75–79 and accompanying text.

54. *Reed Elsevier*, 482 F.3d at 1379–80.

55. *Id.* at 1380.

56. *In re Hotels.com*, 573 F.3d 1300, 1301 (Fed. Cir. 2009).

57. See *id.* at 1301, 1304.

58. *Id.* at 1303.

59. *Id.*

60. *Id.* at 1305.

61. *Id.* at 1304–05.

62. *Id.* at 1304.

63. *Id.* This conclusion appears to be incongruous because hotels are not the same thing as “hotel information and reservation services.” Rather, “hotels” are more accurately characterized as an ingredient or aspect of the claimed information and reservation services. See *In re Seats, Inc.*, 757 F.2d 274, 277 (Fed. Cir. 1985) (“The term ‘seats’ may be generic in relation to chairs or couches or bleachers. It is clearly not generic to [ticket] reservation services.”). Thus viewed, it would seem that HOTELS.COM fits more comfortably within the definition of a descriptive mark rather than a generic mark. See, e.g., *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (genericness rejected where there was no evidence that the relevant public referred to the genus by the asserted mark “1-888-M-A-T-R-E-S-S,” and more apt names for the genus would have been “telephone shop-at-home mattresses” or “mattresses by phone”; the court noted that “1-888-M-A-T-R-E-S-S” was more descriptive than generic); see generally *supra*, at notes 18–23 and accompanying text (discussing descriptiveness generally).

64. See *infra* notes 83–86 and accompanying text.

65. The Federal Circuit previously applied the *Gould* “compound word” analysis to the combination of the words “steel” and “building” in the compound “STEELBUILDING,” but not to the combination of “STEELBUILDING” with “.COM.” See *In re Steelbuilding.com*, 415 F.3d 1293, 1298–99 (Fed. Cir. 2005).

66. *In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009).

67. *Id.*

68. *Id.*

69. *In re 1800MATTRESS.COM*, 586 F.3d 1359, 1361 (Fed. Cir. 2009).

70. *Id.* at 1362.

71. *Id.* at 1363–64.

72. *Id.*

73. See, e.g., *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1346–48 (Fed. Cir. 1999); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 991 (Fed. Cir. 1986).

74. A subsequent panel does not have the power to depart from

precedent set by prior panels. *See, e.g.,* *Barclay v. United States*, 443 F.3d 1368, 1373 (Fed. Cir. 2006) (“Panels of this court are bound by previous precedential decisions until overturned by the Supreme Court or by this court en banc.”).

75. *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1378, 1379 (Fed. Cir. 2007).

76. *See, e.g., In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963–64 (Fed. Cir. 2007); *Dial-A-Mattress*, 240 F.3d at 1346; *In re Quik Print Copy Shops, Inc.*, 616 F.2d 523 (C.C.P.A. 1980).

77. *Marvin Ginn*, 782 F.2d at 991 (holding that *FIRE CHIEF* magazine, while marketed to fire chiefs and about firefighting, was not the name of the fire-fighting industry nor was it what the public called the firefighting industry). If the *Reed Elsevier*’s new “focus” or “integral aspect” test were applied to *FIRE CHIEF*, it would appear clear that fire chiefs would have been held to be a “focus” or “integral aspect” of *FIRE CHIEF* magazine. Conversely, applying *Marvin Ginn*’s analysis to *LAWYERS.COM*, it is equally clear that “lawyers.com” would not be generic because it is not the name of a service of providing online information about the law, lawyers, and legal news, nor does the public call such a service “lawyers.com.”

78. *In re Steelbuilding.com*, 415 F.3d 1293, 1298 (Fed. Cir. 2005) (“Applicant sells steel buildings on line, but the record indicates it provides services beyond mere sales.”).

79. *See also In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393 (Fed. Cir. 1994) (“the phrase ‘the sofa and chair company’ is not generic” for “retail store services featuring custom upholstered furniture” because “the common meaning of the phrase does not clearly include the specificity of this particular custom upholstery service”).

80. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1347 (Fed. Cir. 1999).

81. *See Bayer*, 488 F.3d at 963–64; *Dial-A-Mattress*, 240 F.3d at 1346.

82. *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1380 (Fed. Cir. 2007).

83. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009). It also found that and that “.com” adds no more than a reference to a commercial website.

84. *See Dial-A-Mattress*, 240 F.3d at 1345 (refusing to apply *Gould* to 1-888-M-A-T-R-E-S-S).

85. *Hotels.com*, 573 F.3d at 1304.

86. *Id.*

87. *In re 1800MATTRESS.COM*, 586 F.3d 1359, 1364 (Fed. Cir. 2009); *but see In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (“There is no evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as ‘1-888-M-A-T-R-E-S-S.’ . . . [A] phone number is not literally a genus or class name.”); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1347 (Fed. Cir. 1999) (“AMERICAN BAR ASSOCIATION is certainly an apt name for a national association of lawyers; however, it is not used as a generic name for national associations of lawyers.”); *id.* at 1348 (“[T]here was no evidence produced that the term is used by the relevant public to refer to a similar class”); *In re Merrill Lynch, Pierce, Fenner, and Smith*, 828 F.2d 1567, 1569–70 (Fed. Cir. 2008) (“It seems elementary that one must find out how people in the trade and the purchasers use the terms with respect to the involved goods”) (citation omitted); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 991 (Fed. Cir. 1986) (“[W]e can discern no record evidence which suggests that the relevant portion of the public refers to a class of fire fighting publications as ‘Fire Chief.’”). In addition, the *1800MATTRESS* panel also uncritically perpetuated the application of the *Gould* test to [THING].com marks. *1800MATTRESS.COM*, 586 F.3d at 1363.

88. *See, e.g., Autogenomics, Inc. v. Oxford Gene Tech. Ltd.*, 566 F.3d 1012, 1027 (Fed. Cir. 2009).

89. *See, e.g., Barclay v. United States*, 443 F.3d 1368, 1373 (Fed. Cir. 2006).

90. Indeed, in a recent decision, the Ninth Circuit explicitly mentioned this as a reason for following recent Federal Circuit precedent and holding that *ADVERTISING.COM* was generic. *See Advertise.com, Inc. v. AOL Advertising, Inc.*, 2010 WL 3001980 at *5 (9th Cir. Aug. 3, 2010).

91. *See generally Miss World (UK) Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (crowded field means narrow scope of protection).