



THE TIPSHEET

State Bar of Texas Intellectual Property Law Section

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Update from the Chair



by Leisa Talbert Peschel

Prior to the current pandemic, I learned (the hard way) that there are two primary reactions to overwhelming stressful circumstances. The first is to bury your head in the sand and wait for the circumstances to pass. The second is to adapt and embrace change. The Intellectual Property Law Section intends to adapt.

For many years, our Section has focused on offering Texas IP lawyers in-person opportunities to learn and network. While we look forward to the time when our members can reconvene together, we are now looking for new ways to safely connect and continue the good work of the Section. I strongly encourage each of you to join one of our committees and help us adapt to the new circumstances by bringing your fresh ideas and perspectives. Our committees are set up consistent with our mission to educate, connect, and serve our members and the IP community in Texas and more information on each may be found at: <https://texasbariplaw.org/committees/>.

This past summer the USPTO and our Trademark Committee, under the leadership of Marylauren Ilagen, quickly transitioned to host an entirely virtual Trademark Nuts & Bolts Bootcamp followed by live TTAB hearings. By hosting this event in a virtual format, we had much higher attendance than we would have expected at an in-person event. We hope to capitalize on the success of this program to offer similar learning opportunities in other substantive areas of IP law.

Another recent change was the postponement of our annual Advanced IP Litigation course (formerly, Advanced Patent Litigation) from July to an online program October 15–16. The star-studded lineup of speakers should be reason enough to attend but for those with fall birthdays, this represents a rare opportunity to earn the majority of your CLE requirements (12.25 hours, 2 hours

ethics) in a short two-day course. The course also includes a virtual happy hour and live speaker chats. Registration and more information may be found by going to TexasBarCle.com, clicking on Webcasts, then Advanced Intellectual Property Litigation.

While we embrace new formats for our regularly planned activities, we also encourage each of you to send us your ideas for new ways in which we can serve you, our members, and the IP community in Texas. Please feel free to contact me at lpeschel@jw.com or another member of the council with your ideas.



Lisa Talbot
Peschel

SCOTUS Rules Registration Proper for “Booking.com”

By David Baker



For years, trademark attorneys confidently have cautioned business clients proposing an application to register a generic trademark with the U.S. Patent and Trademark Office (the “PTO”) that any such application was destined to be a losing proposition. A generic trademark is a trademark or brand name that, due to its popularity or significance, is (or, in the case of formerly protected marks, has become) the generic name for, or synonymous with, a general class of product or service. The PTO was loathe to register such marks because of the impact on other companies also using the name. Then, this past July, the U.S. Supreme Court issued a ruling that turned that advice on its head.

In a landmark trademark decision, the U.S. Supreme Court held that BOOKING.COM is entitled to federal trademark protection. By so ruling, the Court also rejected the longstanding PTO rule against simply combining a generic term with “.com” to yield a protectable trademark.

“Whether any given ‘generic.com’ term is generic, we hold, depends on whether consumers, in fact, perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class,” Justice Ruth Bader Ginsburg wrote on behalf of the Court in *United States Patent and Trademark Office v. Booking.com B.V.*

Booking.com operates a website on which customers can book hotel accommodations. In 2012, the company filed four federal trademark-registration applications for marks that included or consisted of the term “Booking.com.” The applications sought registration for use of the marks in connection with “online hotel reservation services.”

However, the PTO had refused registration of the BOOKING.COM marks, concluding that the term “booking” is generic for the services as to which Booking.com sought registration. Moreover, according to the PTO, the addition of the generic top-level domain “.com” did not create a protectable mark. It merely signified the use of the phrase as a domain name.

Why It Matters

Now, it appears, the PTO will be forced to issue federal registrations and, thereby, protection, to trademarks that combine a generic term with a domain name extension. In fact, the Supreme Court's decision in *United States Patent and Trademark Office v. Booking.com B.V.* seems to provide assurance to brand owners that the PTO may no longer apply a *per se* rule to reject trademark applications for "generic.com" marks.

From now on, each application for such a trademark must be evaluated to determine whether the applied-for term conveys a source identifying meaning to consumers. Thus, the Court's decision dramatically expands the availability of trademark protection for domain names and likely limits the number of such terms that will be ineligible for protection because of being generic.

2020-2021 SECTION OFFICERS & COUNCIL

The officers and council members for the Section were elected at the Annual Meeting this summer. They are as follows:

	Name	Firm	City
Chair	Leisa Talbert Peschel	Jackson Walker	Houston
Chair-Elect	Michael Locklar	Adolph Locklar	Houston
Immediate Past Chair	Derrick Pizarro	Pizarro Allen PC	San Antonio
Vice Chair	Joe Cleveland	Brackett & Ellis, PC	Fort Worth
Secretary	Devika Kornbacher	Vinson & Elkins LLP	Houston
Treasurer	Thomas Kelton	Haynes & Boone	Richardson
Newsletter Officer	Michael Smith	Siebman, Forrest, Burg & Smith	Marshall
Website Officer	Austin Teng	Thompson & Knight	Dallas
Council			
Term ends 2021	Craig Stone	Phillips 66	Houston
	Nick Guinn	Gunn Lee & Cave	San Antonio
	Elise Selinger	Patterson + Sheridan	Dallas
Term ends 2022	David Cho	AT&T Services	Dallas
	Michele Connors	Cirrus Logic	Austin
	Kat Li	McKool Smith	Austin
Term ends 2023	Yocel Alonso	Alonso PLLC	Sugar Land
	Marylauren Ilagen	Mary Kay Inc.	Addison
	George W. Jordan, III	Norton Rose Fulbright US LLP	Houston

IP SECTION COMMITTEES

Much of the Section's work is performed by committees, which help carry out its mission of educating, connecting and serving the Section's members. This year's committees and chairs are as follows:

Activities	Committees	Committee Chairs/Officers
<i>Educate:</i>	Copyright	Justen S. Barks
	Patent	Roshan Mansinghani
	Trademark	Mery Pimentel
	Trade Secret	Heath Coffman
	Newsletter	Michael Smith
	Advanced IP CLE	Mike Locklar
	Advanced Pat. Lit.	Kirby Drake
<i>Connect:</i>	Women in IP	Danielle "DJ" Healey
	Diversity	Chris Joe
	New Members	Jen Kuhn
	New Lawyers	Kristi Hubbard
<i>Serve:</i>	Pro Bono	Joe Cleveland
	Public Relations	Erin Choi
	Tex IP Law	J Mike Locklar
	TALA	Kirby Drake
	IP Legends	Herb Hammond

OTHER HAPPENINGS

Paul DeVerter (1932 – 2020)



Paul DeVerter passed away on August 19, 2020. He was an officer in a number of legal organizations including Secretary of the HIPLA and served as Chair of the State Bar of Texas Patent, Trademark and Copyright Section from 1969-70. His full obituary is here <https://www.legacy.com/amp/obituaries/houstonchronicle/196682316>.

TEXAS IP CALENDAR

IP AGGIES WEBINAR SERIES



Texas A&M School of Law's Intellectual Property Aggies (IPA) student organization is presenting its *Fall IP Speaker Series* featuring a broad range of IP practitioners and topics revolving around Intellectual Property. The Speaker Series is held every other Wednesday at 12:00 noon (Central), starting on August 26th, 2020, and continues through October. The series is open to students, faculty, practitioners, and others who are interested in Intellectual Property Law. Those interested in attending can register through the provided link on the flyer or go to <https://info.law.tamu.edu/ipa-series>.

HIPLA and IPIL Fall Institute



HIPLA and IPIL at the UH Law Center have announced that registration is now open for the 36th Annual Institute on Intellectual Property Law, which will be held on October 1-3, 2020, at Moody Gardens Hotel in Galveston, Texas. This year's Fall Institute will feature The Honorable Jeffrey V. Brown of the U.S. District Court for the Southern District of Texas as the Keynote Speaker, The Hon. Wallace Jefferson, Alexander Dubose Jefferson LLP (former Chief Justice of the Texas Supreme Court) as the Diversity Speaker, the Judicial Panel will feature The Hon. Peter Bray, The Hon. Christina A. Bryan, and The Hon. Andrew M. Edison, and many more outstanding speakers and panelists. This year's conference will allow registrants to attend both in-person and virtually. Go to <https://www.hipla.org/event-3941257> to register for the Fall Institute and for other details. You can also click the following link to view the 2020 Fall Institute brochure: http://law.uh.edu/fall2020ipinstitute/2020_Fall_IP_Institute_brochure.pdf

CALL FOR SUBMISSIONS

The TIPSHEET welcomes the submission of articles for potential publication in upcoming issues, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or adding an event to the calendar, please email michaelsmith@siebman.com.

Article Submission Guidelines

STYLE: Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

LENGTH: We accept a wide range of articles, with most falling into the 500-2500 word range.

FOOTNOTES AND ENDNOTES: Please use internal citations.

PERSONAL INFO: Please provide a one-paragraph bio and a photograph, or approval to use a photo from your company or firm website.

If you have any questions, please email michaelsmith@siebman.com.

NOTE FROM NEWSLETTER OFFICER



By Michael C. Smith

I hope you have enjoyed this issue of the IP Section's quarterly newsletter. If you're interested in contributing an article, news or otherwise working with me on the newsletter, please email at michaelsmith@siebman.com. I'd enjoy working with you!

A handwritten signature in black ink that reads "Michael C. Smith". The signature is written in a cursive, flowing style.