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## When a “+” Doesn’t Add Anything in the Equation: Analyzing the Effect of the “+” on Trademark Law

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## When a “+” Doesn’t Add Anything in the Equation: Analyzing the Effect of the “+” on Trademark Law

### Cover Page Footnote

\* J.D.Candidate,2023,UniversityofGeorgiaSchoolofLaw.

**WHEN A “+” DOESN’T ADD ANYTHING IN THE  
EQUATION: ANALYZING THE EFFECT OF THE  
“+” ON TRADEMARK LAW**

*Vasilios Nasoulis\**

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\* J.D. Candidate, 2023, University of Georgia School of Law.

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## I. INTRODUCTION

An emerging issue in trademark law was brought up in a case when World Champ Tech (WCT) alleged that Peloton Interactive, Inc. (Peloton) infringed on their registered trademark “Bike+”.<sup>1</sup> The case was filed on April 30, 2021, in the U.S. District Court, Northern District of California.<sup>2</sup> WCT is a company that focuses on developing “the world’s best workout apps.”<sup>3</sup> WCT developed the app, Bike+, as a way to record and manage a cyclist’s progress and activities; they filed for a trademark registration of Bike+ in November of 2013.<sup>4</sup> The United States Patent and Trademark Office (PTO) officially registered the mark in the principle register on July 28, 2015, and WCT has been using the mark ever since.<sup>5</sup>

Peloton was founded in 2012 and it wanted to “bring the community and excitement of boutique fitness into the home.”<sup>6</sup> Peloton became popular for their indoor stationary bicycles.<sup>7</sup> In September 2020, Peloton launched a new model of its stationary bikes called “Bike+.”<sup>8</sup> Peloton’s use of Bike+ refers to the bike model itself, but WCT notes that Peloton’s Bike+ has an interactive screen that can be used to access Peloton’s fitness apps.<sup>9</sup> These apps are able to record data similarly to WCT’s Bike+ app.<sup>10</sup> Peloton’s use and promotion of the term Bike+, in relation to their new bike model, has led to the current trademark infringement claim.<sup>11</sup>

Peloton should never have been sued because there should never have been a trademark infringement case to begin with. WCT should not have been able to register “Bike+”. The PTO erred by granting the registration. The term “Bike+” should not be a protectable mark under trademark law. To correct this issue,

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<sup>1</sup> Complaint at 5, World Champ Tech LLC v. Peloton Interactive, Inc., No. 4:21-CV-03202 (N.D. Cal. Apr. 30, 2021).

<sup>2</sup> *Id.* at 1.

<sup>3</sup> *About Us*, WORLD CHAMP TECH, <https://www.worldchamptech.com/about> (last visited Sept. 29, 2021).

<sup>4</sup> BIKE+, Registration No. 4782695.

<sup>5</sup> *Id.*

<sup>6</sup> *The Peloton Story*, PELOTON, <https://www.onepeloton.com/company> (last visited Sept. 29, 2021).

<sup>7</sup> Tom Huddleston, *How Peloton Exercise Bikes Became a \$4 Billion Fitness Start-up with a Cult Following*, CNBC (Feb. 12, 2019, 6:01 PM), <https://www.cnbc.com/2019/02/12/how-peloton-exercise-bikes-and-streaming-gained-a-cult-following.html>.

<sup>8</sup> Kirsten Errick, *Peloton Sued for Infringement of Bike+ Mark*, L. ST. (May 3, 2021), <https://lawstreetmedia.com/tech/peloton-sued-for-infringement-of-bike-mark/>.

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

Peloton should petition to cancel the trademark, a process Peloton has relied on in past disputes.<sup>12</sup>

This Note will begin by discussing the characteristics of a trademark and the categories of distinctiveness that are used to classify marks. Part II will then discuss relevant case law that can be analogized to the current issue. There will also be a discussion of the appropriate steps the PTO must take when responding to an application for registration and possible solutions to the current issue.

Part III will focus on where “Bike+” falls on the distinctiveness spectrum. Whether or not the PTO made an error depends on where “Bike+” falls on the spectrum. This Note will conclude by determining that the PTO did err by granting the registration because “Bike+” is not inherently distinctive and WCT has not proven secondary meaning.

## II. BACKGROUND

### A. TRADEMARK LAW AND DISTINCTIVENESS

A trademark, as defined in the Lanham Act of 1946, is “any word, name, symbol, or device, or any combination thereof” that is “used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.”<sup>13</sup> People or companies can become trademark owners as soon as they start using the mark with specific goods or services.<sup>14</sup> Registering a trademark on the Principal Register with the United States Patent and Trademark Office (PTO) is optional, but registering does come with broader rights and protections for the owner than unregistered marks.<sup>15</sup> To qualify for registration, a trademark must fall into a certain protectable category.<sup>16</sup>

For a trademark to be registered with the PTO and gain the protections, the mark must be considered distinctive.<sup>17</sup> “Distinctive” is a term of art under trademark law and is the defining characteristic of a valid trademark; a designation cannot be considered a mark unless it has distinctiveness.<sup>18</sup> Section

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<sup>12</sup> See generally *Petition to Cancel*, at 1, Cancellation Proceeding Number 92076483, (T.T.A.B. Feb. 16, 2021) (demonstrating that Peloton knows how to petition to cancel a registration because the company is currently trying to cancel Mad Dogg Athletics’ Spinning® mark).

<sup>13</sup> 15 U.S.C. § 1127.

<sup>14</sup> *What is a Trademark?*, USPTO (Mar. 31, 2021), <https://www.uspto.gov/trademarks/basics/what-trademark>.

<sup>15</sup> *Id.*

<sup>16</sup> *Strong Trademarks*, USPTO (Mar. 31, 2021), <https://www.uspto.gov/trademarks/basics/strong-trademarks>.

<sup>17</sup> Wex Definitions Team, *Distinctive Trademark*, LEGAL INFO. INST., [https://www.law.cornell.edu/wex/distinctive\\_trademark](https://www.law.cornell.edu/wex/distinctive_trademark) (last updated June 2020).

<sup>18</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2 (5th ed. 2021).

2 of the Lanham Act states that “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register.”<sup>19</sup>

The strength of a trademark is sorted into four different categories: 1) generic, 2) descriptive, 3) suggestive, and 4) fanciful or arbitrary.<sup>20</sup> Fanciful, arbitrary, and suggestive designations are all considered inherently distinctive and are automatically considered valid marks.<sup>21</sup> Descriptive designations are not inherently distinctive, but they can still be protected as registered trademarks if the owner is able to prove that consumers associate the designation with the owner’s product or service.<sup>22</sup> This proof shows that the mark has “secondary meaning.”<sup>23</sup> Descriptive designations that do not have secondary meaning, as well as generic designations, can never be trademarks.<sup>24</sup>

Fanciful or arbitrary trademarks are the strongest marks.<sup>25</sup> Fanciful marks are entirely made-up terms that the trademark owner created to describe their product or service; these include Pepsi®, relating to soft drinks,<sup>26</sup> or Google®, relating to online services.<sup>27</sup> These marks have the greatest amount of protection because they require a larger and more expensive effort to educate the public on what this new word refers to.<sup>28</sup>

Arbitrary marks are in the same category as fanciful marks and also receive the highest amount of protection.<sup>29</sup> Arbitrary trademarks are words that have common meanings, but that word is unrelated to the product or service that the mark is used for.<sup>30</sup> Apple® for computers is a famous example of an arbitrary mark because the term “apple” is a common word for a fruit, but relating to computers, the mark is unique.<sup>31</sup>

Suggestive marks are the second strongest type of trademark.<sup>32</sup> These marks suggest a quality of the goods or services being provided without openly stating

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<sup>19</sup> 15 U.S.C. § 1052.

<sup>20</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>21</sup> 2 MCCARTHY, *supra* note 18.

<sup>22</sup> *Id.*; *see* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (stating that descriptive marks may acquire distinctiveness if the mark has “become distinctive of the applicant’s goods in commerce”).

<sup>23</sup> 2 MCCARTHY, *supra* note 18.

<sup>24</sup> *Id.*

<sup>25</sup> USPTO, *supra* note 14.

<sup>26</sup> *Id.*

<sup>27</sup> *Trademark Strength*, INT’L TRADEMARK ASS’N, <https://www.inta.org/fact-sheets/trademark-strength/> (Nov. 5, 2020).

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> USPTO, *supra* note 14.

<sup>32</sup> *Id.*

the quality.<sup>33</sup> Examples of suggestive marks include Coppertone®, which describes a suntanning oil that will make your skin a copper color<sup>34</sup>, and Airbus®, which describes an airplane used for transport.<sup>35</sup>

Descriptive marks are not inherently distinctive but can acquire distinctiveness through secondary meaning.<sup>36</sup> Descriptive marks do as they suggest and only describe the product they are associated with.<sup>37</sup> According to the United States Court of Customs and Patent Appeals, “[a] mark is merely descriptive if it immediately conveys to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used.”<sup>38</sup> To be a registered trademark, the mark must have secondary meaning.<sup>39</sup> Examples of descriptive marks that have secondary meaning, and are registered trademarks, are Sharp® for televisions and Holiday Inn® for hotel services.<sup>40</sup>

Generic terms are words that the general public thinks of as the common name for a good or the genus of the product.<sup>41</sup> These terms can never be protected as trademarks.<sup>42</sup> Generic terms cannot be registered as trademarks because they do not serve the function of distinguishing one producer’s goods from another.<sup>43</sup> Another way to determine if a mark is generic is to look at how the proponent of the trademark uses the term.<sup>44</sup>

If companies were allowed to register generic terms, other competitors would have a difficult time entering that market; they would have trouble conveying what their product is to the consumers.<sup>45</sup> An example would be if a company was able to register the term “pen” for their product, a pen. Their competitors would have trouble selling their pens because they would not be able to market them as pens; they would need to describe the product with longer, more convoluted titles.<sup>46</sup>

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<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

<sup>35</sup> INT’L TRADEMARK ASS’N, *supra* note 27.

<sup>36</sup> *Id.*; see *Park ‘N Fly, Inc., v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985) (holding that a descriptive mark “may be registered only if the registrant shows that it has acquired secondary meaning, *i.e.*, it ‘has become distinctive of the applicant’s goods in commerce’”) (quoting 15 U.S.C. 1052(e)).

<sup>37</sup> INT’L TRADEMARK ASS’N, *supra* note 27.

<sup>38</sup> *In the Matter of the Application of Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980).

<sup>39</sup> *Id.*

<sup>40</sup> INT’L TRADEMARK ASS’N, *supra* note 27.

<sup>41</sup> USPTO, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(c)(i) (2021).

<sup>42</sup> *Id.*

<sup>43</sup> 1 JEROME GILSON, GILSON ON TRADEMARKS § 2.02(2) (2021).

<sup>44</sup> 2 MCCARTHY, *supra* note 18 at § 12:13.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

With classifications of marks, it is important for lawyers and courts to draw the line between a descriptive mark and a suggestive mark.<sup>47</sup> The tests that courts use to determine if a mark is suggestive or descriptive are the imagination test, the competitors’ usage and need test, and usage by the media and dictionaries.<sup>48</sup> The most common test—and the test that will be used later in the analysis—is the imagination test.<sup>49</sup>

With this test, the more imagination that the customer must use to get some description of the good, the more likely the mark is suggestive and not merely descriptive.<sup>50</sup> Judge Weinfeld of the Southern District of New York formulated the test as “[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”<sup>51</sup>

To determine if there is enough imagination to make a mark suggestive, courts will look at how direct and immediate the link between the mark and the product is for consumers.<sup>52</sup> Suggestive marks will require a “multi-stage reasoning process” to go from the mark to an attribute of the product.<sup>53</sup>

While a court might have to go through more steps to determine if a mark is descriptive or suggestive, it can determine that a term is generic if it refers to a key aspect of the product.<sup>54</sup> Courts have had difficulty, however, when determining if a term that refers to an aspect of the product is generic or if it is descriptive.<sup>55</sup> Although there is debate on this determination, the result is the same: the mark is not inherently distinctive.<sup>56</sup> As previously discussed, generic terms can never be registered trademarks, and descriptive marks can only be registered if they acquired secondary meaning.

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<sup>47</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (discussing how suggestive, arbitrary, and fanciful marks are deemed inherently distinctive and are automatically protected); *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003) (“Although the dividing lines are not always clear, the distinctions are critical in a registration determination.”).

<sup>48</sup> 2 MCCARTHY, *supra* note 18 at § 11:66.

<sup>49</sup> *Id.* at § 11:67.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D. N.Y. 1968)).

<sup>52</sup> 2 MCCARTHY, *supra* note 18 at § 11:67.

<sup>53</sup> *Id.* (quoting *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496 (I.T.A.B. 1978)).

<sup>54</sup> 1 GILSON, *supra* note 43 at § 2.02(6)(a) (citing *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1367 (Fed. Cir. 2018)).

<sup>55</sup> 2 MCCARTHY, *supra* note 18 at § 12:20.

<sup>56</sup> *Id.*

## B. ROLE OF PATENT AND TRADEMARK OFFICE EXAMINING ATTORNEY

When a trademark application is filed with PTO, the application is assigned to an examining attorney to determine if the mark is eligible for registration.<sup>57</sup> The examiners must refuse registration to marks that merely describe the goods or services that are provided.<sup>58</sup> The reasons behind refusing registration to descriptive terms is to:

(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.<sup>59</sup>

For an examiner to refuse an application because the mark is merely descriptive or generic, they must support the refusal with evidence.<sup>60</sup> The law governing refusing a registration is Section 2(e)(1) of the Lanham Act.<sup>61</sup> If the mark appears to be generic, the examiner should not automatically refuse the registration, unless the applicant incorrectly asserts in the original application that their mark has acquired secondary meaning.<sup>62</sup> If the mark is deemed capable of registration but is descriptive, the examiner should provide the applicant with advice about asserting a claim of acquired secondary meaning.<sup>63</sup> This is done when the mark appears to be generic or merely descriptive and the applicant has not yet made the showing of acquired distinctiveness.<sup>64</sup> If the applicant then responds with a showing of secondary meaning, the examiner must review the evidence and determine if the mark is sufficient to show the mark is distinctive.<sup>65</sup>

## C. WAYS OF SHOWING THERE IS SECONDARY MEANING

An applicant must show that their mark has acquired distinctiveness to be registered on the principal register if their mark is considered descriptive.<sup>66</sup> Put

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<sup>57</sup> USPTO, *supra* note 41 at § 702.01.

<sup>58</sup> *Id.* at § 1209.

<sup>59</sup> *Id.* (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (C.C.P.A. 1978)).

<sup>60</sup> *Id.* at § 1209.02.

<sup>61</sup> *Id.* (noting that § 2(e)(1) of Lanham Act is codified at 15 U.S.C. § 1052(e)(1)).

<sup>62</sup> USPTO, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.02 (2021).

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

<sup>66</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

another way, an applicant must show that their mark has secondary meaning to show that their mark is not generic. This is done by showing that the main significance of the term to consumers is the producer and not the product.<sup>67</sup> The ultimate question becomes whether the mark being perceived by the consumers as a common name for the goods or being perceived as identifying the good’s source.<sup>68</sup>

Each Circuit Court has identified a version of a multifactor test to determine if there is secondary meaning.<sup>69</sup> A detailed test came out in 2021 from the court in *Snyder’s Lance* that identified twelve factors to consider: dictionary definitions; usage by plaintiffs; usage by competitors, industry insiders, and others; media references; press releases, other plaintiff created references, or business references; lawsuit references; false positive and intermediate references; generic references; “brand” identification references; consumer surveys; Google and social media references; and other available product names.<sup>70</sup>

Consumer surveys are often considered to be the best evidence for proving secondary meaning.<sup>71</sup> The standard format for a survey was developed in 1975<sup>72</sup> and is known as the “Teflon Survey”.<sup>73</sup> The survey teaches the respondent the difference between a trademark and a common name and then asks the respondents how they perceive certain terms.<sup>74</sup> This is a valuable tool that applicants can use to show their mark has acquired distinctiveness. The surveys, however, must be designed and interpreted with care because the words that are used can have different meanings and can be problematic.<sup>75</sup>

#### D. CASE LAW EXAMINING GENERICNESS

##### 1. *Goodyear’s Rubber Manufacturing Co. v. Goodyear Rubber Co.*

It is not a new concept that adding a generic designation to a generic term does not make that term distinct. In *Goodyear’s Rubber Manufacturing Co. v. Goodyear Rubber Co.*, the U.S. Supreme Court held that adding the term “company” to a

<sup>67</sup> *Snyder’s Lance, Inc. v. Frito-Lay N. Am.*, 542 F. Supp. 3d 371, 381 (W.D.N.C. 2021) (citing *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938)).

<sup>68</sup> *Id.* (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.* 786 F.3d 960, 965 (Fed. Cir. 2015)).

<sup>69</sup> *Converse, Inc. v. ITC Sketchers U.S.A., Inc.*, 909 F.3d 1110, 1119 (Fed. Cir. 2018).

<sup>70</sup> *Snyder’s Lance*, 542 F. Supp. 3d at 386-405.

<sup>71</sup> 3 JEROME GILSON, GILSON ON TRADEMARKS § 8.03(3)(b)(iii) (2021).

<sup>72</sup> See generally *E.I. DuPont de Nemours & Co. v. Yoshida Int’l.*, 393 F. Supp. 502, 525-26 (E.D.N.Y. 1975) (describing the formulation of a test to evaluate the distinctiveness of the TEFLON brand).

<sup>73</sup> 3 GILSON, *supra* note 71 at § 8.03(3)(b)(iv)(B)(I).

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* (citing *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298 (2020)).

descriptive or generic term does not make it protectable.<sup>76</sup> At the time, “Goodyear Rubber” was a descriptive term relating to a general good that was made with “Goodyear’s Invention”.<sup>77</sup> The court equated the use of “company” in this case to hypotheticals of companies being named “Wine Company”, “Cotton Company”, or “Grain Company”.<sup>78</sup> The court held that adding the term “company” to a name of a product that is in commerce, without any other specification, does not entitle the mark to exclusive rights.<sup>79</sup>

### 2. *In Re Hotels.com*

This concept was brought up again 121 years later in *In Re Hotels.com, L.P.*<sup>80</sup> In this case, the Trademark Trial and Appeal Board (TTAB) rejected the registration for the mark “HOTELS.COM” on the grounds that the mark was a generic term for the services provided.<sup>81</sup> The applicant argued that HOTELS.COM was not a generic term because (1) the mark is identifying an information source and travel agency, not an actual hotel, and (2) the term is not just “hotel”, and the “.com” part of the term negates the genericness.<sup>82</sup> The TTAB in this case determined that “hotels” names a key part of the service the applicant was providing and that adding “.com” to the name did not produce a new meaning.<sup>83</sup>

### 3. *In re 1800Mattress.com IP, LLC*

Decided by the Federal Circuit in the same year as *In re Hotels.com*, this case also addresses the problems with adding “.com” to a generic term.<sup>84</sup> In this case, Dial-A-Mattress appealed a TTAB decision to reject MATTRESS.COM from registration.<sup>85</sup> The court looked at whether MATTRESS.COM was a generic term, and the court used the following test to make that determination: “[f]irst, 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?”<sup>86</sup>

The parties in the case agreed that the genus of the services was “online retail store services in the field of mattresses, beds, and bedding.”<sup>87</sup> To consider the

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<sup>76</sup> 128 U.S. 598, 602-03 (1888).

<sup>77</sup> *Id.* at 602.

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 603.

<sup>80</sup> *In Re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009).

<sup>81</sup> *Id.* at 1301.

<sup>82</sup> *Id.* at 1301, 1303.

<sup>83</sup> *Id.* at 1304.

<sup>84</sup> *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361 (Fed. Cir. 2009).

<sup>85</sup> *Id.* at 1360-61.

<sup>86</sup> *Id.* at 1363 (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986)).

<sup>87</sup> *Id.*

genericness of the mark, the TTAB first looked at the terms of the mark separately.<sup>88</sup> TTAB determined that “mattress” identified a key aspect of Dial-A-Mattress’s service, and therefore was generic for the services provided;<sup>89</sup> that is, “mattress” referred to the genus of the service.<sup>90</sup> The TTAB also determined that “.com” is simply an abbreviation to indicate an organization in internet addresses and is generic.<sup>91</sup>

Once the components of the mark were analyzed separately, the TTAB then looked at the mark as a whole.<sup>92</sup> The TTAB concluded that the combination of the components did not add any new meaning to the term, making the term as a whole generic.<sup>93</sup> The court agreed with the analysis that the TTAB did to determine the genericness of the mark.<sup>94</sup>

#### 4. *Advertise.com, Inc. v. AOL Advertising, Inc.*

This case came out one year after *In re 1800Mattress.com* and used the same reasoning from that case.<sup>95</sup> *Advertise.com* discussed a district court’s holding that AOL’s mark, ADVERTISING.COM, is a descriptive mark and can be protected.<sup>96</sup> The Ninth Circuit ultimately disagreed with this finding and determined that ADVERTISING.COM was generic.<sup>97</sup> The Ninth Circuit mirrored what the Federal Circuit did in *In re 1800Mattress.com* and looked at the components of the mark separately to determine if the components were generic by themselves.<sup>98</sup>

The court concluded that “advertising” was a generic term by looking at the dictionary definition of the word.<sup>99</sup> The court also held that “.com” “refers ‘generically to almost anything connected to business on the internet.’”<sup>100</sup> The court determined that ADVERTISING.COM, taken as a whole, is still a generic term.<sup>101</sup>

AOL argued that because only one entity can own a domain name at a time, adding “.com” to a generic term will actually denote source.<sup>102</sup> The court

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<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 1361.

<sup>90</sup> *In re 1800Mattress.com IP*, 586 F.3d at 1363.

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*

<sup>94</sup> *Id.* at 1362-63.

<sup>95</sup> *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 977 (9th Cir. 2010) (stating that the analysis will look to what the genus of the service is and then analyze the mark separately first).

<sup>96</sup> *Id.* at 976.

<sup>97</sup> *Id.* at 981-82.

<sup>98</sup> *Id.* at 977.

<sup>99</sup> *Id.* at 977-78.

<sup>100</sup> *Id.* at 978.

<sup>101</sup> *Advertise.com*, 616 F.3d at 978-79.

<sup>102</sup> *Id.* at 980.

disagreed with this argument because it would create a per se rule that adding “.com” to a generic term will make that mark protectable.<sup>103</sup> Precedent showed that the PTO, TTAB, and Federal Circuit have all rejected this argument because it would give the owner of the mark rights to more than just the intellectual property of the domain name.<sup>104</sup>

5. *United States Patent and Trademark Office v. Booking.com*

In 2020, the “generic.com” case *United States Patent and Trademark Office v. Booking.com B.V.*<sup>105</sup> reached the Supreme Court. “Booking.com” is another hotel information and travel agency website, like hotels.com.<sup>106</sup> The company applied to register “Booking.com”, but the PTO rejected the application.<sup>107</sup> The PTO found that the term was generic and, thus, the mark could not be registered.<sup>108</sup> The PTO tried to impose a per se rule that said combining a generic term with “.com” is still generic.<sup>109</sup>

Booking.com sought review in the U.S. District Court for the Eastern District of Virginia.<sup>110</sup> Booking.com was able to introduce more evidence and was able to show the court that the mark was descriptive and had acquired secondary meaning.<sup>111</sup> The PTO appealed the part of the decision that determined “Booking.com” was not generic.<sup>112</sup> The Fourth Circuit Court of Appeals affirmed the District Court’s decision and likewise rejected the PTO’s assertion that adding “.com” to a generic term necessarily makes the term generic.<sup>113</sup> The Supreme Court affirmed the lower courts’ rulings and further held that this is not a correct rule to apply to all cases because the PTO has not followed this rule in the past when granting registration; the proposed rule would lead to the potential cancellation of previously registered trademarks.<sup>114</sup> The Court did admit there are some cases where this is true, but the rule was not automatic.<sup>115</sup>

The Court looked at several different factors to determine whether “Booking.com” was a generic or descriptive term.<sup>116</sup> The first factor was

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<sup>103</sup> *Id.*

<sup>104</sup> *Id.* at 980-81 (stating that allowing this per se rule would allow the owner to claim protection over almost any use of the generic term in a domain name).

<sup>105</sup> U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298 (2020).

<sup>106</sup> *Id.* at 2303.

<sup>107</sup> U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2301 (2020).

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 2303.

<sup>111</sup> *Id.*

<sup>112</sup> *Id.*

<sup>113</sup> *Booking.com*, 140 S. Ct. at 2304.

<sup>114</sup> *Id.* at 2305.

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* at 2304.

determining whether the mark named a class of goods or services.<sup>117</sup> The second factor was that, when a compound term is used, the distinctiveness test must rely on the meaning of the term as a whole.<sup>118</sup> The third factor, and perhaps the most important in the case, was how consumers viewed the mark.<sup>119</sup> The Supreme Court held, and the PTO eventually conceded, that consumers understood that “Booking.com” referred to a specific company.<sup>120</sup>

The PTO still urged that adding “.com” to a generic term should not make it distinctive.<sup>121</sup> They relied on the holding in *Goodyear* that adding “company” to a generic term does not make the mark distinctive.<sup>122</sup> The PTO argued that just as adding “company” to a generic term does not add any additional meaning that would distinguish the goods from other producer’s, adding “.com” to a generic term also does not add any additional meaning.<sup>123</sup>

The Court in this case disagreed with the PTO’s reasoning.<sup>124</sup> The Court held that “company” and “.com” are not the same because “.com” indicates a “source-identifying characteristic: an association with a particular website.”<sup>125</sup> Website domains can only be owned by one entity, meaning that when a consumer thinks about a “generic.com” they can be thinking about a particular website or particular producer of a good or service.<sup>126</sup> Therefore, a website name like Booking.com may distinguish their services from other providers and can be descriptive.<sup>127</sup>

The main takeaways from *Booking.com* are: (1) adding “.com” to a generic term does not always make the whole term generic,<sup>128</sup> (2) the distinctiveness of the term is dependent on the consumers’ beliefs,<sup>129</sup> and (3) there is a difference between adding company and adding “.com” to a generic term.<sup>130</sup>

If *In re Hotels.com*, *In re 1800Mattress.com*, and *Advertise.com* were heard after *Booking.com* was decided, those cases might have had different outcomes. The courts in those cases seemed to follow a rule more closely related to what the PTO advocated for in *Booking.com* where adding a generic term to another generic term will make that whole term generic. The Court in *Booking.com* looked at the

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<sup>117</sup> *Booking.com*, 140 S. Ct. at 2304.

<sup>118</sup> *Id.*

<sup>119</sup> *Id.*

<sup>120</sup> *Id.* at 2305.

<sup>121</sup> *Id.*

<sup>122</sup> *Booking.com*, 140 S. Ct. at 2305.

<sup>123</sup> *Id.* at 2306.

<sup>124</sup> *Id.*

<sup>125</sup> *Id.*

<sup>126</sup> *Id.*

<sup>127</sup> *Id.* at 2304-05.

<sup>128</sup> *Booking.com*, 140 S. Ct. at 2307.

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at 2306.

mark in the context of consumer perception.<sup>131</sup> Had the courts in *In re Hotels.com*, *In re 1800Mattress.com*, and *Advertise.com* followed the *Booking.com* approach, they might have come to the conclusion that because the public perceives those marks to be associated with one company, the marks could be descriptive with secondary meaning. For a full analysis, those courts could have looked deeper at the public perception of the individual marks.

#### E. PUBLIC PERCEPTION OF THE +

The use of the plus sign “+” in company names dates back to at least 1984 with the introduction of the French television channel, Canal+.<sup>132</sup> The trend did make it to mainstream companies until Google introduced its Google+ platform that was active from 2011 to 2019.<sup>133</sup> The + has since become a common symbol used in the name of streaming services.<sup>134</sup> Other industries from clothing brands to vineyards to law firms have moved to using the + in their names.<sup>135</sup>

Based on trademark precedent, including *Booking.com*, how the public perceives the + is important.<sup>136</sup> As of the late 2010s, the + has been used frequently with streaming services and has become somewhat synonymous with these types of services.<sup>137</sup> Despite this connection, however, many professionals in the branding field do not believe the + adds much value to a brand name, if any at all; Laurel Sutton, the cofounder of the brand-naming agency Catchword, said “[the +] doesn’t tell you anything at all. It doesn’t tell you what you’re getting;

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<sup>131</sup> *Id.* at 2307.

<sup>132</sup> Tiffany Hsu, *Why Plus Is a Minus When Naming Your Streaming Site*, N.Y. TIMES, <https://www.nytimes.com/2021/02/25/business/media/streaming-platforms-plus-signs.html> (last updated Feb. 26, 2021).

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* (including examples, such as ESPN+, Apple TV+, Disney+, BET+, AMC+, Discovery+).

<sup>135</sup> Katy Steinmetz, *From Disney+ to PB+J, How the Plus Sign Took Over the World*, TIME (Feb. 27, 2020, 1:58 PM), <https://time.com/5791267/plus-sign-brands-ampersand/>.

<sup>136</sup> *Booking.com*, 140 S. Ct. at 2304 (“[T]he relevant meaning of a term is its meaning to consumers.”).

<sup>137</sup> See Hsu, *supra* note 132 (“[T]he plus sign has become an all-purpose marker that signals endless hours of on-demand shows.”); Nancy Friedman, *What Do Plus Signs Add?*, THINKMAP VISUAL THESAURUS (July 15, 2021), <https://www.visualthesaurus.com/cm/candlepwr/what-do-plus-signs-add/> (“‘+’ had become a familiar signifier for ‘streaming,’ just as the e- and i- prefixes had signified ‘electronic’ and ‘internet’”); Jeff Beer, *Why Adding ‘Plus’ to the Name of Every Streaming Service is Actually Good*, FAST CO. (Sept. 26, 2020), <https://www.fastcompany.com/90555592/why-adding-plus-to-the-name-of-every-streaming-service-is-actually-good> (“That word and symbol [plus and +] becomes a great shorthand for streaming service in the consumer’s mind.”); Steinmetz, *supra* note 135 (the plus sign has become a sigil in the streaming wars).

it doesn’t say why it’s different. It’s just adding a superlative on the end—like saying ‘ultra’ or ‘supreme’ or ‘better.’”<sup>138</sup>

The + has also been described as a generic term and the “lowest common denominator.”<sup>139</sup> Given all these statements, there appears to be a consensus that the + does not add any defining characteristics to a mark—unless the + is connected to a streaming service—and should be considered generic.

#### F. WORLD CHAMP TECH’S MOBILE APP

World Champ Tech (WCT) uses the trademark “Bike+” relating to a “downloadable mobile application[] for recording and managing cycling activities.”<sup>140</sup> Users can download Bike+ from the App Store and the app is meant to be used with an Apple Watch.<sup>141</sup> The app’s multiple functions allow a person to track bicycle ride times, speeds, and distances; measure certain fitness metrics like maximum aerobic power and oxygen use rate; survey climbs during the ride; design workouts and have artificial intelligent coaching; and chart data and recovery information.<sup>142</sup> WCT’s Bike+ app does a lot to help a bicyclist know everything they need to know about their bicycle rides.

WCT has also developed a function for the app that allows the user to add a “quick launch complication” to their Apple Watch face.<sup>143</sup> This feature adds a circle to the main screen of a smart watch with just the word “Bike” in the circle.<sup>144</sup> WCT, for some reason, dropped the + and, by using this quick launch function, the company is only referring to their app by “Bike”.

The main function of the app is related to bikes. The app was designed to track biking activities.<sup>145</sup> A reasonable person could assume from the name of the app what the app’s main functions are.

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<sup>138</sup> Aric Jenkins, *Why Your Favorite Brand Names Are Starting to Look Like Math Problems*, FORTUNE (Apr. 27, 2019, 10:00 AM), <https://fortune.com/2019/04/27/branding-plus-sign/>; see also Steinmetz, *supra* note 135 (“[The +] suggests customers will be getting something extra without making it at all clear what that extra thing might be.”).

<sup>139</sup> Hsu, *supra* note 132.

<sup>140</sup> BIKE+, *supra* note 4.

<sup>141</sup> Bike+, WORLD CHAMP TECH, <https://www.worldchamptech.com/bikeplus> (last visited Oct. 17, 2021).

<sup>142</sup> *Id.*

<sup>143</sup> *Id.*

<sup>144</sup> *Id.*

<sup>145</sup> *Id.*

## III. ANALYSIS

## A. ANALOGIZING “+” AND “.COM”

As of early 2022, there is no case law about adding a + to a generic or descriptive term. Because of the lack of case law and the similarity of adding one generic term to another generic term, this Note analogizes adding a + to a term and adding “.com” to a term.

As the cases that have been discussed mentioned, adding “.com” to a generic term does not add any source identifying characteristics to the term.<sup>146</sup> According to how the public perceives the +, the + also does not add any source identifying characteristics to terms. The exception being when the + is part of a term that relates to a streaming service.<sup>147</sup> In this exception, terms like Disney+®, ESPN+®, and BET+® are able to convey the message that the term is associated with a streaming service.<sup>148</sup> WCT’s app is not a streaming service, however, so adding a + to a term like “Bike” can be analogous to adding “.com” to a term like “hotels”.

The analysis that the courts used in the cases relating to “.com” and generic terms can be used to analyze “Bike+”. Following *In re 1800Mattress.com* and *Advertise.com*, this analysis requires examining each component of the term separately before looking at the term as a whole.<sup>149</sup> This is where the public perception of the + becomes important.

This method is beneficial because adding a generic symbol to an already strong mark will make that new term eligible for trademark registration.<sup>150</sup> An example is Google+®. The trademark Google® is a strong and has been a protected mark since being registered in 2012.<sup>151</sup> Because Google was already protected and already a strong mark, when the company added a + to the name, the mark was still a strong mark because the mark was analyzed as a whole. Even if the + did

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<sup>146</sup> See *supra* secs. II(d)(2)-(4) (discussing the cases and how adding “.com” did not allow the generic term to be considered descriptive).

<sup>147</sup> Nancy Friedman, *What Do Plus Signs Add?*, THINKMAP VISUAL THESAURUS (July 15, 2021), <https://www.visualthesaurus.com/cm/candlepwr/what-do-plus-signs-add/>.

<sup>148</sup> *Id.*

<sup>149</sup> See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009) (discussing that the TTAB in that case looked at “mattress” and “.com” separately at first); *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 977 (9th Cir. 2010) (“[W]e are permitted to begin our inquiry by separately viewing the component parts of the mark.”).

<sup>150</sup> See Jenkins, *supra* note 138 (describing how using the + with a strong and well-known trademark, like Disney, does not add anything new and Disney was not “try[ing] to reinvent the wheel”).

<sup>151</sup> *Trademark Electric Search System (TESS)*, USPTO, <https://tmsearch.uspto.gov/bin/gate.exe?f=searchss&state=4801:01xl21.1.1> (last visited Oct. 20, 2021) (Type in search bar the registration number “4168118”. Use the drop-down menu for field and change to “Serial or Registration Number” and click “Submit Query”).

not add any value or any source identifying information, the trademark Google+® was still registerable because Google was already registered.

1. *Putting “Bike” on the Spectrum of Distinctiveness*

Using this method, if “Bike” is a strong trademark, then “Bike+” can be registered with no issue. For ease, this analysis begins at the strongest end of the distinctiveness spectrum and work down. Thus, the analysis will start by looking at whether Bike+ falls in the fanciful category and work down to looking at whether Bike+ is generic.

It is likely that “Bike” is not a made-up term like Pepsi® or Google®, where the main purpose of the term was to become a trademark.<sup>152</sup> According to Merriam Webster, the dictionary definition of “Bike” is “bicycle”<sup>153</sup>, and the definition of “bicycle” is “a vehicle with two wheels tandem, handlebars for steering, a saddle seat, and pedals by which it is propelled.”<sup>154</sup> Because “Bike” is not a made up term and is a word in the dictionary, the word cannot fall in the category of coined or fanciful terms on the trademark distinctiveness spectrum.

The next step would be to determine if “Bike” can be considered an arbitrary mark. An arbitrary mark must be a commonly used word that is unrelated to the product, like Apple® for computers.<sup>155</sup> For “Bike” to be an arbitrary mark for an app, the app could not be related to bicycles. WCT’s app, however, is directly related to bicycles and users’ workouts while riding bicycles<sup>156</sup>; therefore, “Bike” cannot be considered an arbitrary mark.

The last inherently distinctive category of marks is suggestive marks. As discussed earlier, the most common test used for determining whether a mark is distinctive or suggestive is the imagination test from Judge Weinfeld.<sup>157</sup> For the mark to be suggestive, consumers must go through multiple stages of thought to get from “Bike” to WCT’s app.

An example of a suggestive mark that requires imagination is Penguin® for food freezers<sup>158</sup>; a consumer will need to go from thinking about penguins, to freezing cold environments, and finally to a food freezer. Another example is Samson® for weight training machines<sup>159</sup>; a consumer would need to go from

<sup>152</sup> See 2 MCCARTHY, *supra* note 18, at § 11:5 (stating that coined or fanciful marks are words that were created for the sole purpose of becoming a trademark).

<sup>153</sup> *Bike*, MERRIAM-WEBSTER, <https://www.merriamwebster.com/dictionary/bike> (last visited Oct. 21, 2021).

<sup>154</sup> *Id.*

<sup>155</sup> INT’L TRADEMARK ASS’N, *supra* note 27.

<sup>156</sup> *Bike+*, WORLD CHAMP TECH, <https://www.worldchamptech.com/bikeplus> (last visited Oct. 17, 2021).

<sup>157</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2 (5th ed. 2021) (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D. N.Y. 1968)).

<sup>158</sup> *Id.* at § 11:67.

<sup>159</sup> *Id.*

thinking about Samson, to remembering that Samson is a Biblical character, to thinking about his superhuman strength, to thinking about getting strong, and finally to weight training equipment.

Looking now to how “Bike” relates to WCT’s app, a consumer does not need to go through this type of thought process to connect the term and the app. Because “Bike” “conveys an immediate idea of the ingredients, qualities or characteristics of the goods,”<sup>160</sup> the required imagination is not needed. A consumer can see the mark “Bike”, think of riding a bicycle, and then connect riding a bicycle to an app that tracks their data while riding a bicycle. Consumers will not have to make a large mental leap from the mark to the product or service. Therefore, “Bike” cannot be considered a suggestive term.

If WCT’s mark was simply “Bike” and not “Bike+”, the mark would not be inherently distinctive. This means that the mark is not protected without at least a showing of secondary meaning. Determining whether a mark is descriptive or generic depends on if the mark conveys to a consumer the ingredients, qualities, or characteristics of the good or service,<sup>161</sup> or if the mark refers to the genus of the good or service.<sup>162</sup> The genus of the good may be defined by using the applicant’s description of the good or service.<sup>163</sup>

WCT’s application says the goods or services the mark is used for are:

Downloadable mobile applications for recording and managing cycling activities, namely, the rider's average and maximum speed, rider's average and maximum power, heart rate, geographic route taken, outside air temperature, altercations with aggressive drivers, rider-entered route conditions, taking photos and uploading the same to an external computer server for personal review and viewing by others.<sup>164</sup>

The genus of the good is a mobile app that tracks a bicyclist’s data during a bike ride. “Bike+”, just by the name alone, cannot really be thought of as referring to this genus. If the good was a mobile app that sells bikes, then there could be a stronger argument that “Bike+” refers to the genus because bikes are being sold. This reasoning follows that in *In re 1800Mattress.com*.<sup>165</sup>

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<sup>160</sup> *Id.* (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

<sup>161</sup> 2 MCCARTHY, *supra* note 18, at § 11:19.

<sup>162</sup> USPTO, *supra* note 41.

<sup>163</sup> *Id.* at § 1209.01(c)(i).

<sup>164</sup> BIKE+, *supra* note 4.

<sup>165</sup> *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009).

In that case, the court determined that the genus was “online retail store services in the field of mattresses, beds, and bedding.”<sup>166</sup> The court held that “mattress” in the mark MATTRESS.COM referred to the mattresses in the genus.<sup>167</sup> This means that if the genus was a mobile app selling bikes, “Bike” in the mark would refer to the bikes in the genus and make the term generic. Because the genus is a mobile app that tracks data during a bike ride, however, then “Bike” would probably not qualify as generic under this type of analysis.

There is still a possibility that “Bike” can be a generic term if the term “refers to a key aspect” of the genus. This standard will sometimes cross the line into a descriptive analysis.<sup>168</sup> The term can be generic if the public understands the term refers to part of the genus, even if the public does not understand the term to refer to the genus as a whole.<sup>169</sup> For this analysis to be conclusive, the public’s perception of the mark “Bike” would need to be assessed in relation to the genus of WCT’s app.

Another factor that could weigh in favor of “Bike+” being generic is how WCT uses the mark.<sup>170</sup> WCT included the quick launch function for their app.<sup>171</sup> This function puts a circle on the main screen of the watch with just the word “Bike” in the circle.<sup>172</sup> WCT is referring to their “Bike+” app as simply “Bike” when users use this function. The user will see the word “Bike” and know that it is the button they need to select if they want to track their bike ride. Because WCT uses just the word “Bike” to refer to their app, this can be seen as the company using the term in a generic way.

The analysis now turns to the final category of the distinctiveness spectrum and looks at “Bike” as a descriptive mark. A descriptive mark must describe some quality or characteristic of the good or service.<sup>173</sup> “Bike”, in relation to the WCT’s app, can be considered descriptive. A key characteristic of the app is that the app can track data specifically during bike rides.<sup>174</sup> A consumer would most likely be able to understand “Bike” as describing this key characteristic of the app. If there was research done to show how the public perceives “Bike” relating to the app,

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<sup>166</sup> *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009).

<sup>167</sup> *Id.* at 1363.

<sup>168</sup> 1 GILSON, *supra* note 43, at § 2.02(6)(a) (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368 (Fed. Cir. 2018)).

<sup>169</sup> *Royal Crown Co.*, 892 F.3d at 1367 (quoting *In re Cordua Rests., Inc.*, 823 F.3d 584, 603 (Fed. Cir. 2016)).

<sup>170</sup> 2 MCCARTHY, *supra* note 18, at § 12:13 (discussing how the plaintiff’s use of the mark can determine genericness).

<sup>171</sup> *Bike+*, WORLD CHAMP TECH, <https://www.worldchamptech.com/bikeplus> (last visited Oct. 17, 2021).

<sup>172</sup> *Id.*

<sup>173</sup> 2 MCCARTHY, *supra* note 18, at § 11:19.

<sup>174</sup> *Bike+*, WORLD CHAMP TECH, <https://www.worldchamptech.com/bikeplus> (last visited Oct. 17, 2021).

then this could move the term from a descriptive one to a generic one. For the sake of this argument, “Bike” will be considered descriptive.

For the examining attorney to reject an application because the mark is merely descriptive, they only need to show that the mark describes one specific attribute of the good or service<sup>175</sup>; they do not need to show anyone else was using the mark, or that the mark describes all of the functions or characteristics of the good or service.<sup>176</sup> Therefore, “Bike” would be a descriptive mark and would be rejected.

## 2. *Looking at the + by Itself*

By determining that “Bike,” on its own, is not a strong, protectable trademark, the mark is not on the same level as Google® and Google+®. If “Bike” was a strong mark like Google®, then the analysis would be over and “Bike+” could be protected without any showing anything more. The analysis, however, is not finished and must continue by looking at whether the + provides something extra to the meaning of the term for Bike+ to be eligible for trademark registration.

The + needs to add something to the mark to make the mark inherently distinctive. If the + cannot add something to the mark, then WCT would have to at least show the mark has secondary meaning for the mark to be protected. This is where the public perception of the + becomes important to the analysis. As with “Bike,” it would be beneficial to look at the + by itself to determine what it means, to see how it can change the mark. As previously discussed, the + has been associated with streaming sites,<sup>177</sup> but the + has also been described as a superlative, like ultra or supreme.<sup>178</sup> The + has also even been described as generic.<sup>179</sup> For trademarks to be protectable and effective, they need to have some kind of source identifying characteristic.<sup>180</sup> According to professionals in marketing and the general public, the + does not have any source identifying characteristic, other than potentially letting the consumer know the product is a streaming service. WTC’s Bike+ app is not a streaming service like the ones that use the +.<sup>181</sup> Because the + does not have any source identifying characteristics and is considered a generic term, the + cannot be protected with a trademark registration on its own.

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<sup>175</sup> USPTO, *supra* note 41, at § 1209.01(b).

<sup>176</sup> *Id.*

<sup>177</sup> Friedman, *supra* note 147.

<sup>178</sup> Jenkins, *supra* note 138.

<sup>179</sup> Hsu, *supra* note 132.

<sup>180</sup> See 15 U.S.C. § 1127 (stating a trademark is used “to identify and distinguish [the consumer’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods”).

<sup>181</sup> Hsu, *supra* note 132 (including examples such as ESPN+, Apple TV+, Disney+, BET+, AMC+, Discovery+).

## B. ANALYZING “BIKE+” AS A WHOLE

Since neither part of the Bike+ mark (“Bike” and “+”) can be protected as trademarks on their own relating to WCT’s app, the mark must be analyzed as a whole.<sup>182</sup> To determine whether the mark as a whole is protectable, the public’s perception of the mark plays a key role as well as the level of distinctiveness of each term.

“Bike” is a descriptive mark at best, and the + in this instance is a generic term that adds no source identifying characteristics, meaning, the mark as a whole can be at best is descriptive.<sup>183</sup> This is discussed in the Trademark Manual of Examining Procedure:

When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive.<sup>184</sup>

Using this method of reasoning, if “Bike” and the + were both descriptive, and if when they were put together to form “Bike+”, they simply retained their descriptiveness, and the mark, as a whole, would be descriptive. If WCT’s app was a streaming service, then there might possibly be a new commercial impression. Without this, the mark “Bike+” is merely descriptive, if not generic. In the *Booking.com* case, the court held that “Booking.com” is descriptive because the public “primarily understands that ‘Booking.com’ does not refer to a genus, rather it is descriptive of services involving ‘booking’ available at that domain name.”<sup>185</sup> Following this reasoning, for “Bike+” to be a descriptive mark rather than a generic mark, the public would need to think of the mark as describing the service and not identifying the genus. Assuming a public survey would confirm this impression, this analysis will treat “Bike+” as a descriptive mark.

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<sup>182</sup> See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363 (Fed. Cir. 2009) (“Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.”) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005)).

<sup>183</sup> USPTO, *supra* note 41, at § 1209.03(d).

<sup>184</sup> *Id.* (citing *Duopross Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012)).

<sup>185</sup> *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2303 (2020) (quoting *Booking.com B.V. v. Matal*, 278 F.Supp.3d 891, 918 (E.D. Va. 2017)).

Even with this concession, “Bike+” still should not have been allowed to be registered.

As discussed, for a merely descriptive mark to be registered, the mark must have acquired secondary meaning.<sup>186</sup> Section II(c) of this Note describes the various ways that an applicant can show that their mark has acquired secondary meaning. WCT has not shown that their mark “Bike+” has acquired secondary meaning, and therefore, the mark cannot be considered distinctive.

### C. WHAT SHOULD HAVE HAPPENED WITH THE APPLICATION

When an applicant submits an application for registration, the lawyer assigned to examine the application must consider if the mark is merely descriptive, or if the mark is suggestive or arbitrary.<sup>187</sup> The examining attorney is allowed to request any additional documents from the applicant that would clarify any questions the examining attorney had.<sup>188</sup> If the mark is considered merely descriptive by the examining attorney, the application should be denied under section 2(e)(1) of the Trademark Act.<sup>189</sup> This section of the Act states that no trademark should be refused registration unless it “[c]onsists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive . . . .”<sup>190</sup>

The examining attorney appointed to review WCT’s application for “Bike+” should have refused the application under this rule. The attorney should have issued an office action with a refusal under section 2(e)(1).<sup>191</sup> If the mark appears to be capable of registration if not for the descriptiveness, then the examining attorney should provide the applicant with advice about asserting a claim of secondary meaning.<sup>192</sup>

After the examining attorney issues a refusal in the form of an office action, the applicant has a chance to respond. If the applicant responds by arguing that the mark is registrable without showing secondary meaning, the examining attorney must issue a final refusal under section 2(e)(1).<sup>193</sup> The applicant can also respond to the office action by asserting secondary meaning under section 2(f).<sup>194</sup> This section of the Lanham Act states that “nothing in this chapter shall prevent

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<sup>186</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:25 (5th ed. 2021).

<sup>187</sup> USPTO, *supra* note 41, at § 1209.02.

<sup>188</sup> *Id.*

<sup>189</sup> *Id.* at § 1209.02(a).

<sup>190</sup> 15 U.S.C. § 1052(e).

<sup>191</sup> USPTO, *supra* note 41, at § 1209.02(a).

<sup>192</sup> *Id.*

<sup>193</sup> *Id.*

<sup>194</sup> *Id.* at § 1209.02(a)(ii).

the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”<sup>195</sup>

Relating to WCT’s application for “Bike+”, the examining attorney should have issued a refusal under section 2(e)(1), and WCT should have had to respond with a claim of secondary meaning under section 2(f). WCT could have shown secondary meaning through a survey as discussed earlier or they could show “proof of substantially exclusive and continuous use . . . for the five years before . . . the claim of distinctiveness was made.”<sup>196</sup>

Because there was no distinctiveness claim made, there is no definite date to look five years prior from to determine use. There should have been a distinctiveness claim made because there should have been a refusal under section 2(e)(1). WCT should have been required to respond with that claim under section 2(f). Given the timeline of documents, this claim should have been made in 2014.<sup>197</sup> This would mean that WCT would have to show exclusive, substantial use starting in 2009. Looking at a document titled *Section 7 Request* that was filed on April 27, 2021, however, WCT asserted that the First Use Anywhere and First Use in Commerce dates was February 21, 2014.<sup>198</sup> Therefore, WCT was not using “Bike+” in commerce for five years before 2014 and could not make that assertion under section 2(f).

After WCT’s possible response under section 2(f), that would include their evidence of secondary meaning, the examining attorney would examine the evidence WCT provided for establishing secondary meaning.<sup>199</sup> If the evidence is not sufficient to establish secondary meaning, the attorney should issue a nonfinal action refusing registration.<sup>200</sup> Along with the nonfinal action, the examining attorney should also explain why the evidence is not sufficient and should suggest any other pieces of evidence that could be submitted.<sup>201</sup> WCT would then have another opportunity to submit evidence of secondary meaning.<sup>202</sup>

The new evidence would then be analyzed again by the examining attorney, and if this new evidence is sufficient, the mark would be accepted for registration.<sup>203</sup> If the evidence is still not sufficient, as would probably be the case with “Bike+”, then the examining attorney can issue a final refusal.<sup>204</sup>

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<sup>195</sup> 15 U.S.C. § 1052(f).

<sup>196</sup> *Id.*

<sup>197</sup> *Id.*

<sup>198</sup> *Trademark Status & Document Retrieval (TSDR)*, USPTO, <https://tsdr.uspto.gov/> (last visited Apr. 15, 2022) (type “86127620” in the search bar, click and “Documents”, and click on “Section 7 Request” from Apr. 27, 2021).

<sup>199</sup> U.S. PAT. & TRADEMARK OFF., *supra* note 41, at § 1212.02(h).

<sup>200</sup> *Id.*

<sup>201</sup> *Id.*

<sup>202</sup> *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

These steps in the registration process never took place in this case. The examining attorney granted WCT registration without any office actions, which treated “Bike+” as an inherently distinctive mark. This is where the examining attorney erred. They should have refused registration under section 2(e)(1) and forced WCT to show secondary meaning under section 2(f). If the examining attorney refused registration, then the examining attorney may have found the evidence insufficient and refused the registration of “Bike+”.

#### D. POLICY RATIONALE FOR DENYING “BIKE+” AS A REGISTERED MARK

Because the PTO allowed “Bike+” to be registered without WCT showing the mark has acquired secondary meaning, the PTO is essentially deciding that “Bike+” is inherently distinctive.<sup>205</sup> The PTO has given “Bike+” the same protections and status as an arbitrary mark like Apple® and a fanciful mark like Google®. This sets a dangerous precedent for trademarks going forward. The PTO’s decision could be seen as establishing a nearly per se rule similar to the rule the PTO tried to establish in *Booking.com*.<sup>206</sup> The difference being that the rule in *Booking.com* stated that generic.com marks are always generic,<sup>207</sup> and the rule in this case is that a descriptive term with a + added to it makes the term inherently distinctive.

This rule opens the door to companies having any generic or descriptive term—that would not be registerable by itself—as being protected and registered by adding the + to the mark. WCT is a prime example of a company trying to exploit this PTO ruling.

Because WCT were allowed to register “Bike+” for an app that tracks biking activities, on May 25, 2021, WCT filed applications for “Swim+”<sup>208</sup>, “Run+”<sup>209</sup>, “Ski+”<sup>210</sup>, “Walk+”<sup>211</sup>, and “Hike+”<sup>212</sup>. All of these marks function exactly the same as “Bike+”; the marks all track data corresponding to the corresponding activity. The marks are currently awaiting examination.<sup>213</sup> Following the PTO’s lead in allowing “Bike+” to be registered, then all of these marks should be able to be registered as well. The marks that WCT is trying to register are all descriptive marks, at best, for the same reasons that “Bike+” is descriptive at best. If the PTO allows these marks to be registered, the per se rule of adding the + to a descriptive term could be solidified.

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<sup>205</sup> 2 MCCARTHY, *supra* note 18, at § 11:2.

<sup>206</sup> U.S. Pat. & Trademark Off. v. *Booking.com B.V.*, 140 S. Ct. 2298, 2305 (2020).

<sup>207</sup> *Id.*

<sup>208</sup> *Trademark Status & Document Retrieval (TSDR)*, USPTO, <https://tsdr.uspto.gov/> (last visited Nov. 8, 2021) (type “90733006” into the search bar and click “Status”).

<sup>209</sup> *Id.* (type “90732968” into the search bar and click “Status”).

<sup>210</sup> *Id.* (type “90733038” into the search bar and click “Status”).

<sup>211</sup> *Id.* (type “90733196” into the search bar and click “Status”).

<sup>212</sup> *Id.* (type “90733021” into the search bar and click “Status”).

<sup>213</sup> *Trademark Status & Document Retrieval (TSDR)*, *supra* notes 202-206.

This rule goes against the purpose of a trademark, which is to be able to distinguish one entity’s goods from another.<sup>214</sup> Descriptive marks are not able to achieve this goal unless they have acquired secondary meaning. If the PTO allows these merely descriptive marks to be registered, then any mark that includes a + will be registerable even if the mark does not have any source identifying characteristics. The PTO should not encourage companies to trademark common words like “walk” and “swim”. These companies can get around the basic requirements of a trademark by simply adding a simple + to the end of a verb. The PTO should have refused WCT’s registration of “Bike+” until WCT was able to prove that “Bike+” had acquired secondary meaning.

#### E. POSSIBLE SOLUTIONS

##### 1. *Peloton Can Make an Incontestability Argument*

The best solution going forward is for the PTO to not issue registrations for a non-inherently distinctive term attached to a +. This solution, however, does not help the current case between Peloton and WCT. Because of this, Peloton should petition to cancel the registration.<sup>215</sup>

Because the mark “Bike+” was registered in 2015 and used for five consecutive years thereafter, WCT will argue that the mark has become incontestable under 15 U.S.C. § 1065. This would mean that Peloton would not be able to petition to cancel the registration because “the registration shall be conclusive evidence of the validity of the registered mark.”<sup>216</sup>

Peloton would be able to make a case, however, that WCT’s mark is not incontestable. Whether a court would find “Bike+” to be a generic or descriptive mark does not matter, in either scenario, because the mark would not be incontestable.<sup>217</sup>

##### 2. *WCT Can Try to Show Secondary Meaning*

Another possible solution would be for WCT to show their mark has acquired secondary meaning to justify the registration. As stated before, WCT can show secondary meaning through consumer surveys. Although WCT could show secondary meaning, the outcome does not appear probable. Although a quick Google search is not the most conclusive evidence against WCT, the search for

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<sup>214</sup> 15 U.S.C. § 1127.

<sup>215</sup> 15 U.S.C. § 1064.

<sup>216</sup> 15 U.S.C. § 1115(b).

<sup>217</sup> 15 U.S.C. § 1065(4) (“[N]o incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered”); 15 U.S.C. § 1115(b)(4) (“That the use of the name, term, or device charged to be an infringement is a use . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party . . .”).

the term “Bike+” does not lean in their favor. The page is dominated with links to and articles about Peloton’s Bike+ stationary bike.<sup>218</sup>

#### IV. CONCLUSION

In early 2022, Peloton and World Champ Tech found themselves working through the settlement process and convened for a settlement conference, with a settlement likely to be reached.<sup>219</sup> Regardless of the outcome of this case, WCT should never have been able to register “Bike+” as a trademark. The PTO should not have approved “Bike+” for registration in the first place. As the mark relates to the app that WCT has developed, “Bike+” does not have any source identifying characteristics and does not fall within an inherently distinctive category.

Even giving WCT the benefit of the doubt and conceding that “Bike+” could fall in the descriptive category, the mark should not have been registered. If the mark was considered generic, then there would be no need to go any further in the analysis. The result would have been the same as in *In re Hotels.com*<sup>220</sup> and *Advertise.com*<sup>221</sup>, where the mark is not permitted to be registered and has no standing to sue for infringement. If “Bike+” is descriptive, WCT could still justify the registration if they are able to show secondary meaning. But WCT should have been required to show secondary meaning before the registration was granted.

Courts may have to begin ruling on using the + with generic and descriptive marks. The + is a relatively new phenomenon that is becoming more and more commonplace. As more companies begin to use the symbol in their trademarks, courts will have to make certain rulings on them and set standards for what constitutes a protectable mark.

The courts have had to make these decisions regarding “.com” through the many cases previously discussed. Using the + could become the new trend that is equivalent to adding “.com” to a term. The PTO and the courts must establish rules covering the + before people begin to use the symbol to work around the system.

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<sup>218</sup> GOOGLE, <https://www.google.com> (last visited Apr. 15, 2022) (type “Bike+” in the search bar).

<sup>219</sup> World Champ Tech LLC v. Peloton Interactive, Inc., No. 4:21-CV-03202 (N.D. Cal. filed Apr. 30, 2021).

<sup>220</sup> *In Re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009).

<sup>221</sup> *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974 (9th Cir. 2010).