

Request for Reconsideration after Final Action

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Input Field	Entered
SERIAL NUMBER	79122366
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
Please see arguments attached in the evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
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ORIGINAL PDF FILE	evi_20487401-20141013154231288657_. Exhibit C - Declaration.pdf
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DESCRIPTION OF EVIDENCE FILE	The Request for Reconsideration after Final Action in addition to Exhibits A - C
SIGNATURE SECTION	
ORIGINAL PDF FILE	HS_20487401-154231288_. Executed Declaration.pdf
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SIGNATORY'S NAME	Jaap van den Broek
SIGNATORY'S POSITION	Legal Counsel
RESPONSE SIGNATURE	/Katherine P. Califa/
SIGNATORY'S NAME	Katherine P. Califa
SIGNATORY'S POSITION	Attorney of record, Maryland bar member
SIGNATORY'S PHONE NUMBER	202-672-5300
DATE SIGNED	10/13/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Oct 13 16:54:00 EDT 2014
TEAS STAMP	USPTO/RFR-204.87.40.1-201 41013165400411780-7912236 6-5009181ad293db33bde60d1 525b8caec45d7edbc168893cf 78f3567295657c1f7-N/A-N/A -20141013154231288657

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79122366** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see arguments attached in the evidence section.

EVIDENCE

Evidence in the nature of The Request for Reconsideration after Final Action in addition to Exhibits A - C has been attached.

Original PDF file:

[evi_20487401-20141013154231288657 . Response to Final OA.pdf](#)

Converted PDF file(s) (15 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

[Evidence-15](#)

Original PDF file:

[evi_1-20487401-20141013154231288657 . Exhibit A - In re Brinks.pdf](#)

Converted PDF file(s) (11 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

Original PDF file:

[evi_20487401-20141013154231288657 . Exhibit B - In re Festival of Vitamins.pdf](#)

Converted PDF file(s) (15 pages)

[Evidence-1](#)

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[Evidence-3](#)

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Original PDF file:

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Converted PDF file(s) (13 pages)

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[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

SIGNATURE(S)

Declaration Signature

Original PDF file:

[HS_20487401-154231288 . Executed Declaration.pdf](#)

Converted PDF file(s) (12 pages)

[Signature File1](#)

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[Signature File8](#)

[Signature File9](#)

[Signature File10](#)

[Signature File11](#)

[Signature File12](#)

Signatory's Name: Jaap van den Broek

Signatory's Position: Legal Counsel

Request for Reconsideration Signature

Signature: /Katherine P. Califa/ Date: 10/13/2014

Signatory's Name: Katherine P. Califa

Signatory's Position: Attorney of record, Maryland bar member

Signatory's Phone Number: 202-672-5300

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79122366

Internet Transmission Date: Mon Oct 13 16:54:00 EDT 2014

TEAS Stamp: USPTO/RFR-204.87.40.1-201410131654004117

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A-N/A-20141013154231288657

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:



Serial No.: 79/122,366

Filing Date: November 7, 2012

Applicant: Booking.com B.V.

Examiner: Nelson B. Snyder III
Law Office 107

RESPONSE TO FINAL OFFICE ACTION

Applicant has applied to register the following stylized mark for travel agency services in

Class 43:



Mark:

Class 43: Hotel reservation services for others; holiday accommodation reservation services and resort reservation services, namely, providing hotel room reservation services and resort hotel reservation services and providing online hotel and resort hotel room reservation services; providing information about hotels, hotel accommodations and resorts accommodations, whether or not based on the valuation of customers; information, advice and consultancy relating to the aforesaid services; the aforesaid services also provided electronically

In a Final Office Action dated June 30, 2014, the U.S. Patent and Trademark Office maintained and made final the refusal to register the mark BOOKING.COM (Stylized) on the basis that the mark is alleged to be generic. Applicant submits that BOOKING.COM is not generic or descriptive and, to the extent the mark is considered descriptive, the evidence of

acquired distinctiveness submitted by Applicant proves that the mark has acquired substantial secondary meaning and is entitled to registration on the Principal Register under Section 2(f). Applicant realleges and incorporates by reference its previous arguments and evidence.

It is well-settled that any analysis of mere descriptiveness must consider the commercial impression of the entire trademark, not the individual meaning of the component terms viewed separately. *See e.g., In re Harrington*, 219 U.S.P.Q. 854, 855 (T.T.A.B. 1983) (COLLEGE ACADEMY not merely descriptive of educational services). Therefore, it is improper to dissect a mark and separately analyze the individual words or linguistic elements that it may incorporate. *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988) (Board erroneously failed to consider the term HUTCHINSON TECHNOLOGY as a whole); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.”).

Moreover, the examiner mis-cites *Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1372-74 (Fed. Cir. 2004) for the proposition that a unitary mark can be broken into composite pieces for purposes of assessing genericness. What *Oppedahl & Larsen* actually held was that the claimed mark “patents.com” was merely descriptive, not that it was generic. In so holding, the Federal Circuit relied on the Trademark Office policy that “if a proposed mark is composed of merely descriptive term(s) combined with a TLD, the examining attorney must refuse registration on the Principal Register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. *See* TMEP §1215.04.” It did not say that a mark can be broken into component pieces to assess separately whether each is generic

and then simply assume that the whole is generic without any evidence of genericness. To the contrary, the Federal Circuit explained:

The law requires that a mark be “considered in its entirety.” *Beckwith*, 252 U.S. at 546. In *Dial-A-Mattress*, this court required the Board to consider marks using telephone area codes, i.e., “1-888-MATRESS,” as a whole to determine the commercial impression of the mark. *Dial-A-Mattress*, 240 F.3d at 1345-46. Even though the area code (888) standing alone was “devoid of source-indicating significance,” the analysis in *Dial-A-Mattress* required the Board to weigh the entire commercial impression, including the (888) prefix, when assessing the registrability of the mark. *Id.*

Oppedahl & Larsen thus explained that “the Board may weigh the individual components of the mark *to determine the overall impression* or the descriptiveness of the mark and its various components.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749 (Fed. Cir. 1985) (emphasis added). The court re-emphasized the point in its conclusion that: “When examining domain name marks, the PTO must evaluate the commercial impression of the mark as a whole, including the TLD indicator.”

Here, the Examiner performs only *half* of the task by never even considering the mark as a whole. Moreover, the Examiner conflates the meaning of the legal category of mere descriptiveness, which was at issue in *Oppedahl & Larsen*, with genericness. It is hardly clear the Examiner recognizes there is any difference between the two. But the differences are significant. It is one thing to say that consumers can, in an additive manner, recognize the combination of two descriptive elements such as “patents” and “.com” as indicating a website with information about patents. It is another thing entirely to say the *entire term* is used by consumers as designating a genus of goods or services. There is a quantum difference between

the two, yet the Examiner never even acknowledges there is any difference and never purports to analyze the genericness or not of the entire term BOOKING.COM.

The critical difference between Applicant's position and the Examining Attorney's position is that Applicant maintains that its mark must be considered as a unitary whole, i.e., BOOKING.COM (Stylized), whereas the Examining Attorney insists that it is proper to disregard the ".com" portion of Applicant's mark and focus solely on the term "booking."¹

In *In re Brink's Mfg. Co., Inc.*, Serial No. 75/472,290 (TTAB 2000) (non-precedential, copy attached as **Exhibit A**), the applicant applied to register the mark VAN LADDER for truck-mounted work platforms and aerial booms. The Examining Attorney refused registration under Section 2(e)(1) on the basis that the mark was generic as applied to van-mounted ladders because the mere combination of two words, each with separately generic character, into a compound word does not necessarily produce a registrable term. The Examining Attorney went on to argue that the composite mark would be perceived by the purchasing public as the common name for

¹ The Examining Attorney argues incorrectly that Applicant's "September 17, 2013 communication includes a concession that the applied-for mark is in fact generic. In the September 17, 2013 response, Applicant asserts that the applied-for mark 'Booking.com' is the 'legal equivalent' of the term 'Bookings', which (as attached and previously supplied evidence clearly demonstrates) is the generic name for the identified services." *Office Action Dated June 30, 2014, unnumbered page 10*. Applicant made this statement in the context of arguing that it should be permitted to "tack on" its prior use of BOOKINGS.NL to establish acquired distinctiveness in BOOKING.COM. The Examining Attorney rejected this argument in the Office Action dated November 16, 2013, stating "With respect to Applicant's claim of longtime use, it is first noted that Applicant's claim of seventeen years' use is not in fact for the applied-for mark Booking.com. As indicated in the September 17, 2013, [sic] Applicant has only used the applied-for 'mark' for seven years." Therefore, the Examining Attorney has rejected the notion that BOOKING.COM and BOOKINGS are legal equivalents but Applicant never conceded or meant to suggest its mark could be reduced to the word "BOOKING" or ("BOOKINGS") alone.

For the sake of clarity, Applicant does not, and has not, conceded that BOOKING.COM is generic. Applicant's argument with respect to tacking was made in the alternative, i.e., that if the U.S. PTO doctrine in which the addition or deletion of a top level domain name such as ".com" is generally considered not to be a material difference applies, then BOOKINGS and BOOKING.COM should be considered legally equivalent. However, it is and always has been Applicant's position that this analytical structure is flawed: consumers perceive BOOKING.COM as a unique source identifier and distinguish between trademark use of BOOKING.COM and any descriptive use of booking alone.

applicant's goods because the combination would have no different meaning than its constituent words. The Examining Attorney in *In re Brinks* offered only a single piece of evidence of the exact mark, "van ladder", appearing anywhere. *Id.* at 7. The Board held:

There is simply no evidence that the relevant consumers use this term to refer to the category or type of product made by applicant. Moreover, as applicant has pointed out, an extension ladder is only a part of applicant's goods, which consist of a work platform mounted on top thereof, there is no dictionary definition of this term, and there is no evidence of use of this mark by competitors or by consumers to refer to a category of product. In view of the paucity of evidence that these words have been use generically, we cannot say that the relevant public understands the mark sought to be registered to refer primarily to a genus or category of product. The Office has failed to carry its burden of proof on the issue of genericness.

Id. at 8-9. *In re Brink's* is highly similar to the instant case. The mere argument that "booking" and ".com" separately have a descriptive meaning is not sufficient to hold that BOOKING.COM as a whole would be understood by the relevant purchasing public as a *type or category* of travel related services. As demonstrated by the evidence of advertising submitted herewith and shown previously in connection with this application, BOOKING.COM is used by Applicant as a composite mark. Consumers refer to and call for Applicant's services by the mark BOOKING.COM (not "booking" per se), demonstrating recognition of Applicant's mark as a source-identifier. Further, Applicant's family of marks, which include "B." in logo form and BOOKING.YEAH emphasize that the "dot" in "BOOKING.COM" is an integral component of the mark, not a mere URL designation. There is not a single piece of evidence in the record showing BOOKING.COM used by the relevant consumers to refer to a category or type of service offered by Applicant, nor is there a dictionary definition of BOOKING.COM, nor is there a single piece of evidence of use of the precise mark by competitors. There is simply no

evidence that the relevant public understands or uses BOOKING.COM to refer primarily to a genus or category of product.² The record in *In re Brink* had more evidence of genericness than the present record, and still the Board reversed the refusal to register. Accordingly, the genericness refusal in the present case should be withdrawn.

In another apt case, *In re Festival of Vitamins, LLC*, Serial No. 85/33160 (TTAB 2013) (non-precedential, copy attached as **Exhibit B**), the applicant applied to register ANTI-AGING NATURALS for dietary and nutritional supplements. The Examining Attorney refused registration on the grounds that the mark was generic for the goods, citing to dictionary definitions of “anti”, “anti-aging” and “natural,” evidence from the internet showing use of the terms “anti-aging” and “natural” as adjectives modifying the names of various products, including dietary or nutritional supplements, and evidence from the internet showing use of “anti-aging” and “natural” together as modifiers, e.g., “The anti aging natural supplements that used to be...”, “PureZen Anti Aging Natural supplements” and similar evidence.

While the evidence indicates that “anti-aging natural” may be considered an appropriate chain of descriptors for goods such as applicant’s supplements, it does not show that these words are a unitary phrase rather than individual adjectives that happen to be placed together. To the contrary, the record contains numerous examples of use of these words in formats that are inconsistent with use of a unitary, generic term. In particular, these words have

² The Office Action issued June 30, 2014 once again includes the same URL’s previously included, namely, www.bookingbuddy.com, fastbooking-hotels.com, www.marriott.com/online-hotel-booking.mi, www.hotelbooking.com, www.francehotelbooking.com, www.hotelbookingsolutions.com, www.instantworldbooking.com, and www.securehotelbooking.com. As Applicant previously noted, examples of websites containing the character string “booking” somewhere in the URL does not demonstrate a competitive need for others to use BOOKING.COM to name or describe their product or service. Applicant does not claim exclusive rights to “booking”; it claims exclusive rights to BOOKING.COM (Stylized). None of the URL evidence shows a competitive need for third parties to use BOOKING.COM to describe or name their product or service; indeed only one of the websites uses the character string “booking.com” as part of the actual trademark for the website, but it does not use the term “booking.com” alone as a trademark. Moreover, URL’s such as www.bookingbuddy.com, fastbooking-hotels.com, www.marriott.com/online-hotel-booking.mi, and www.hotelbookingsolutions.com, are wholly irrelevant because they do not even contain the letter string “booking.com” anywhere in the URL.

been placed in reverse order; separated by a comma or other punctuation; separated by other words; or other variations. For example, the advertisements at <juvenon.com> and <purezenhealth.com>, quoted above, use both “anti aging natural supplements” and the reversed form “natural anti aging supplements.” The articles quoted above from Newsday, The Charlotte Observer and Global Cosmetic Industry show the words at issue interrupted by punctuation, in the forms “‘anti-aging’ natural” and “anti-aging, natural.” We also note [there are examples] in which ANTI-AGING and NATURAL are used as separate adjectives... These examples of inconsistent use of the words at issue undermine the contention that the mark is generic. Because a finding of genericness must be supported by clear evidence of generic use, *In re Merrill Lynch*, 4 USPQ2d at 1143, and because the record fails to prove that the mark at issue is a unitary term that is understood by the relevant public primarily to refer to the genus of applicant’s goods, we find that the mark has not been shown, by clear evidence, to be generic for applicant’s goods.

Id. at 8-9. As in *In re Festival of Vitamins, LLC*, the evidence proffered by the Examining Attorney shows inconsistent use of the words at issue, which undermines the contention that the mark BOOKING.COM is generic. There is simply no evidence of use of BOOKING.COM except use by or referring to Applicant. Further, any use of “booking” alone to refer to travel reservation services is modified by other wording. There is no evidence whatsoever of “booking” or BOOKING.COM to refer to the key services offered by Applicant such as providing information about hotels, hotel accommodations and resorts accommodations, providing information about accommodations based on the valuation of customers, and information, advice and consultancy relating to the aforesaid services. Even if BOOKING.COM is an apt name for a travel agency service, it is not the generic name for that service. Aptness is insufficient to prove genericness. The Federal Circuit Court of Appeals has drawn a clear

distinction between an apt name and a generic one, providing the following example by way of illustration:

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 (see, e.g., NATIONAL ASSOCIATION OF WOMEN LAWYERS; FEDERAL BAR ASSOCIATION; AMERICAN HEALTH LAWYERS ASSOCIATION; NATIONAL LAWYERS ASSOCIATION).

In re American Fertility Soc’y, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999); *see also In re Country Music Ass’n Inc.*, 100 USPQ2d 1824, 1828 (TTAB 2011).

To designate a mark as generic is a “fateful step” that must be proved by “clear evidence.” *See, e.g., Ty, Inc. v Softbelly’s Inc.*, 353 F.3d 528 (7th Cir. 2003). Even small differences between how wording is used by the public and how wording appears in a mark can be sufficient to avoid a finding of genericness – in the *In re Festival of Vitamins, LLC* case, the fact that a comma appeared between “anti-aging” and “natural” in the evidence submitted by the Examining Attorney was deemed significant by the Board. In this case, given the lack of any use whatsoever of BOOKING.COM by third parties, and in light of the manner in which BOOKING.COM is used by Applicant, BOOKING.COM is a unitary mark that functions as an indicator of source.

Generic terms are, by definition, incapable of indicating a particular source of goods and/or services, and cannot be registered as trademarks and/or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). The Federal Circuit has explained that “[t]he critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered... to refer to the genus or category of goods in question.”

Evidence of the public’s understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *See Merrill Lynch*, 4 USPQ2d at 1143; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). These types of materials are intended to serve as an indication of how the relevant consumer is likely to perceive and encounter the mark in the marketplace. Applicant maintains that its mark– when considered in its entirety – is not only capable of functioning as a mark, but does indeed function as a mark.

To assist the Examining Attorney in understanding how Applicant’s mark is used and viewed in the marketplace, Applicant submits as **Exhibit C** a Declaration signed by Jaap van den Broek, Legal Counsel for Applicant (“Declaration”), which contains numerous examples of Applicant’s unique and innovative advertising. Through its various forms of advertising, Applicant has consistently reached millions of American consumers over several years. (Declaration ¶4). Applicant’s BOOKING.COM mark is always used in a unitary fashion and displayed in such a manner that consumers are likely to perceive “BOOKING.COM” as a unitary and distinctive mark. *Id.*

For example, Applicant ran web banners on the popular travel site TripAdvisor.com.³ Given the nature of use, prominent placement, and use of a contrasting color scheme in which the color of the BOOKING.COM mark is tied to the color of the “action” button on the banner, consumers viewing these advertisements perceived BOOKING.COM as the brand name for Applicant’s services, not as a generic term naming travel websites, generally. (Declaration ¶¶ 5-6). Applicant’s use of the descriptive phrase “Planet Earth’s #1 Accommodation Site” in close

³ TripAdvisor.com is itself a registered mark notwithstanding that it is simply a combination of two descriptive or generic terms (Reg. Nos. 4,454,774 and 3,171,193).

proximity to its BOOKING.COM trademark further underscores that consumers are likely to recognize Applicant's mark as a distinctive trademark rather than as a descriptor or generic category name. *Id.*

Applicant also partnered with the popular online movie ticket website Fandango to run a special Halloween-themed advertising campaign. As part of this campaign, Applicant created mock movie posters and movie shorts about "travel horrors." (Declaration ¶¶ 7-12). These promotions reached approximately 6.6 million viewers, increased web traffic to Applicant's website, and further cementing Applicant's brand as creative, fun, and unconventional. *Id.* Importantly, in each of these advertisements, the BOOKING.COM mark appears as a prominent, unitary mark and is used in such a way that consumers are likely to perceive it as a source-indicator rather than as a generic or descriptive term for a type of travel website. *Id.*

That consumers perceive BOOKING.COM as a source identifier is not mere conjecture; it is evident from the tens of thousands of unsolicited customer reviews and comments about BOOKING.COM available online. Each of these customer reviews plainly uses and recognizes BOOKING.COM as a trademark identifying a single source, not as a generic term referring to travel websites generally. (Declaration ¶14 and Exhibits).

The fact that consumers perceive BOOKING.COM as a source indicator is also evident from the interactions between consumers and Applicant on social media. For example, over 53,200 individuals "follow" Booking.com on the social media site *Twitter*. This is more "followers" than comparable accommodation sites such as HOTELS.COM (51,300 followers), TRIVAGO (16,700 followers) and HOTWIRE (18,500 followers). (Declaration ¶15). Consumers regularly use the Twitter handle "@bookingcom" to call for Applicant or identify its

services, again demonstrating recognition of BOOKING.COM as pointing uniquely and exclusively to Applicant. (Declaration ¶16).

Over 2.7 million individuals have “liked” Applicant’s BOOKING.COM branded page on the social media site *Facebook*. (Declaration ¶17). The number of “likes” by consumers demonstrates strong customer loyalty and recognition of BOOKING.COM as a distinctive trademark. For context, the number of individuals that have “liked” the BOOKING.COM page on Facebook is significantly higher than those that have liked the pages of comparable travel companies such as Travelocity (291,792 “likes”), Hotels.com (2,203,236 “likes”), TravelZoo (1,748,350 “likes”), and Orbitz (581,764 “likes”). *Id.*

In addition, Applicant frequently promotes its BOOKING.COM mark in conjunction

with or in close proximity to its B-dot Logo  (Reg. No. 4,460,494). (Declaration ¶14).

For example, on the Booking.com main website the B-dot Logo appears as the “favicon” adjacent to the word mark BOOKING.COM in the browser tab. *Id.* This type of advertising underscores to consumers that BOOKING.COM must be viewed as a unitary mark in which the “dot” is an integral component of the mark. *Id.*

Applicant’s family of marks, including its BOOKING.COM, B-dot Logo, and BOOKING.YEAH (Reg. No. 4491012) marks use a consistent dark blue, light blue, and white color scheme, letter stylization and overall look. (Declaration ¶15). The unified branding contributes to the distinctiveness of Applicant’s applied-for mark.

Consumers encountering Applicant's mark in the marketplace must view it as a distinctive source-identifier given the manner and prominence of the use, as demonstrated by the examples attached to this response. The Examiner has cited no contrary evidence.

Based on the evidence of record, and supplemented by the evidence submitted herein, Applicant's mark does, in fact, function as a source-identifier in the minds of consumers. Therefore, by definition, it cannot be a generic term.

Applicant reincorporates by reference its previous evidence of acquired distinctiveness which included, among other evidence:

- Applicant owns a Principal Register registration for BOOKING.YEAH, a Supplemental Register registration for BOOKINGS.COM, and a Principal Register registration for B-dot logo.
- The first use of the related mark BOOKINGS.COM by Applicant or its predecessor-in-interest is June 11, 1995, a period of over nineteen years. The first use of the related mark BOOKINGS.NL by Applicant or its predecessor-in-interest is December 9, 1996, a period of nearly eighteen years.
- Applicant has been using BOOKING.COM since at least as early as 2006, a period of approximately eight years.
- In connection with its mark BOOKING.COM, Applicant offers customers the ability to make reservations at over 446,000 hotels and accommodations-providers in over 200 countries.
- Over 625,000 room nights are reserved through Applicant's BOOKING.COM service *every day*.

- Applicant offers its BOOKING.COM service in more than 40 languages.
- The total transaction value of mobile accommodation reservations made through the BOOKING.COM website more than doubled from over \$3 billion in 2012 to over \$8 billion in 2013.
- Applicant has reached millions of American television viewers through BOOKING.COM television commercials aired on the national channels: ABC, CBS, NBC Sports, Fox Soccer, MSNBC, TBS, TNT, A&E, History, USA, Comedy Central, Bravo, HGTV, FX, IFC, Travel, Style, E!, TNT, AMC, ESPN, BBC, DIY, Fox Soccer, NBA TV, Science Channel, TLC, Nat Geo, SYFY, Spike, and TruTV, among others.
- In the first quarter of 2013, Applicant reached over 20 million (20,000,000) American consumers through BOOKING.COM commercials broadcast in movie theaters prior to feature films.
- In the first quarter of 2013, Applicant reached over 19 million (19,000,000) American consumers through BOOKING.COM Internet commercials streamed on websites such as Hulu.com, Tremor.com, and YouTube.com.
- Applicant's BOOKING.COM branded website receives over thirty million (30,000,000) unique visitors each month.
- Applicant's BOOKING.COM branded website has received an average of 10.3 million unique visitors from the United States per month in the beginning of 2014.
- There are over 2.2 million United States-based subscribers to newsletters branded under the BOOKING.COM mark. These newsletters advertise Applicant's BOOKING.COM services and are sent out an average of 2-3 times per month. *Id.* ¶9.

- A search for Applicant's mark BOOKING.COM on the Google News service generated over 2,000 unsolicited news articles.
- Applicant's BOOKING.COM service has received numerous industry awards, including, for example:
 - J.D. Power and Associates, a premier research and analytics firm, ranked BOOKING.COM First in Consumer Satisfaction among independent travel websites based on a consumer survey (awarded in 2013);
 - Hospitality Sales & Marketing Association International, the hospitality industry's leading advocate for intelligent, sustainable hotel revenue growth, awarded Booking.com a "Gold" level Adrian Award for its 2013 BOOKING.YEAH advertising campaign (awarded in 2014);
 - Mobile Travel & Tourism awarded BOOKING.COM the "Best Tablet App" (awarded in 2014);
 - Mobile Travel & Tourism awarded BOOKING.COM the Best Mobile Site. (awarded in 2014).

These awards demonstrate significant recognition of BOOKING.COM as an indicator of source both from end consumers and from Applicant's peers in the travel industry.

The wording in Applicant's mark, BOOKING.COM, has acquired distinctiveness through its long use in the United States, its significant advertising campaign educating customers to identify the mark as an indicator of source, and significant consumer exposure to the mark. The success of Applicant's efforts to acquire secondary meaning are evident from the vast unsolicited media coverage of Applicant and its mark, the numerous consumer and industry awards Applicant has received, and the evidence submitted herewith showing consumers discussing and calling for Applicant's services by use of its BOOKING.COM mark.

CONCLUSION

The wording in Applicant's mark is inherently distinctive or, in the alternative, has acquired distinctiveness through use and does not need to be disclaimed. Accordingly, Applicant requests that the disclaimer requirement be withdrawn and that its application be passed to publication. A Notice of Appeal is being submitted with this response.

The fateful step of destroying one of the best known trademarks in the travel industry should not lightly be taken, nor should the Examiner in doing so undermine the ability of the Applicant to protect the goodwill it has developed and its ability to protect consumers from confusion. Applicant thus respectfully requests that the Examiner review again and respond to the extensive evidence and legal arguments actually presented in this and the prior office action responses before taking the needless and incorrect fateful step of undermining the Applicant's trademark.

/Katherine Califa/
Jonathan Moskin
Katherine Califa
FOLEY & LARDNER LLP
90 Park Ave.
New York, New York 10016
(212) 338-3572
Attorneys for Applicant
October 13, 2014

EXHIBIT A

12/27/00

THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Brink's Mfg. Co., Inc.*

Serial No. 75/472,290

Edmund J. Sease of Zarley McKee Thomte Voorhees & Sease for
Brink's Mfg. Co., Inc.

David Stine, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney)

Before Simms, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Brink's Mfg. Co., Inc. (applicant), a Minnesota
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark VAN
LADDER for truck-mounted work platforms and aerial booms.¹
The application has been amended to seek registration under

¹ Application Serial No. 75/472,290, filed April 22, 1998, based upon allegations of use since September 7, 1968. In the original application, applicant claims ownership of Supplemental Registration No. 904,505, issued December 15, 1970, of the mark VAN LADDER and design. Office records show that this registration has expired.

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the provisions of Section 2(f) of the Act, 15 USC § 1052(f).

The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC § 1052(e)(1), arguing that applicant's mark is generic as applied to van-mounted ladders, and that, even if applicant's mark is not generic, applicant's evidence of acquired distinctiveness is insufficient to permit registration on the Principal Register. Applicant and the Examining Attorney have submitted briefs.²

Essentially, it is the Examining Attorney's position that applicant's goods are ladders for use on vans (among other vehicles), in other words, van ladders. Relying upon dictionary definitions, which the Examining Attorney submitted with his appeal brief, the Examining Attorney argues that the mere combination of two words, each with separately generic character, into a compound word does not necessarily produce a registrable term. In this case, the Examining Attorney argues that applicant's combination is generic since it would be perceived by the purchasing

² On page 14 of applicant's appeal brief, applicant requested an oral argument. Trademark Rule 2.142(e)(1) states that a request for oral hearing should be by separate notice. Because applicant did not request oral argument by separate notice, the request was not seen until this case was assigned for decision. Accordingly, and in view of the disposition of this case, the request for oral argument is considered moot.

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public as the common name for applicant's goods because the combination would have no different meaning than its constituent words. In this regard, the Examining Attorney relies upon *In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Even if the term VAN LADDER were not considered generic, the Examining Attorney argues that, because of the highly descriptive nature of applicant's mark, a greater showing of acquired distinctiveness is required. In this regard, the Examining Attorney criticizes the declaration of the inventor of applicant's device in several respects. The Examining Attorney maintains that the declaration contains no evidence of the perception of applicant's mark in the relevant trade; argues that the fact that competitors use different terms does not mean that applicant's mark is not generic, because products may have more than one generic name; and argues that the declaration is only circumstantial evidence in that there is no evidence of actual recognition of applicant's mark as an indication of origin in the relevant market. The Examining Attorney states that the commercial success of a product per se does not necessarily show that applicant's mark has become distinctive of its goods.

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Genericness

Applicant's attorney and the Examining Attorney do not dispute the test for determining genericness. The primary significance of a mark to the relevant public is the test for determining whether a mark is generic. See Section 14(3) of the Act, 15 USC § 1064(3). A term is generic if it names the class of goods or services to which it is applied. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted, the test for determining whether a term is generic is its primary significance to the relevant public; that is, whether the term is used or understood, by purchasers or potential purchasers of the goods at issue, primarily to refer to the class of such goods. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *H. Marvin Ginn Corp.*, *supra*. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs and other publications. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, *supra*, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed.

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Cir. 1985). The Office has the burden of proving genericness with clear evidence. In re Merrill Lynch, Pierce, Fenner, & Smith Inc., *supra*.

The only evidence which the Examining Attorney has submitted are dictionary definitions. As noted above, the Examining Attorney has placed strong reliance upon the *Gould* decision. However, we believe that the more recent decision, In re America Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), substantially limits *Gould*. In *America Fertility*, the Board had found that evidence, such as dictionary definitions, third-party applications and registrations as well as articles from the Nexis computer search system reflecting uses of the term "reproductive medicine," were sufficient evidence to conclude that the phrase SOCIETY FOR REPRODUCTIVE MEDICINE was a generic name of applicant's services. The Court reversed, stating that the Board had not applied the correct test for genericness. The Court said that the Office must be able to satisfy the elements of the *Marvin Ginn* test--that is, that there be evidence that the term sought to be registered was the genus of the goods at issue and that there be evidence of the understanding by the relevant public that the asserted mark refers primarily to that genus of goods. The Court stated, at 1836-37:

Aptness is insufficient to prove genericness... As the PTO produced no evidence at all of the public's understanding of the phrase as it relates to the Society's services, it clearly failed to carry its burden. The Board cannot simply cite definitions and generic uses of the constitute terms of a mark, or in this case, a phrase within the mark, in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark, or a phrase within the mark, generic.

In contrast to *Gould*, this is not a case where the PTO has clearly proven that the mark as a whole is no less generic than its constituents. Rather, this is a case where, like *Merrill Lynch* and *Marvin Ginn*, there was no evidence produced that the term is used by the relevant public to refer to a similar class (in the instance case, the class of services provided by societies). Therefore, the Board erred in finding that the proven genericness of the words, "society," and "reproductive medicine," without more rendered generic the phrase SOCIETY FOR REPRODUCTIVE MEDICINE.

Gould is limited, on its facts, language, and holding, to compound terms formed by the union of words. It is legally erroneous to attempt to apply the language quoted below to phrases consisting of multiple terms, which are not "joined" in any sense other than appearing as a phrase.

The compound immediately and unequivocally describes the purpose, function and nature of the goods as *Gould* itself tells us. *Gould* has simply joined the two most pertinent and individually generic terms applicable to its product, and then attempts to appropriate the ordinary compound thus created as its trademark. In this instance, the terms remain as generic in the compound as individually, and the compound thus created is itself generic.

Gould, 834 F.2d at 1019, 5 USPQ2d at 1112 (citations omitted).

The correct legal test, which was not applied by the Board, is set forth in *Marvin Ginn* and is to be applied to a mark, or a disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts. Properly interpreted, *Gould* does not justify a short-cut around this test, but rather found that the evidence presented met this burden...

The Board erred in applying the wrong legal test, which it derived from *Gould*, to the facts at issue here. The correct legal test for genericness of phrases, as set forth in *Marvin Ginn*, requires evidence of "the genus of goods or services at issue" and the understanding by the general public that the mark refers primarily to "that genus of goods or services." *Gould* provides additional assistance in determining the genericness of compound words only, and holds that if the PTO can prove (1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms. The PTO here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public that the terms "society" and "reproductive medicine" have individually. The Board must now apply the *Marvin Ginn* test to the phrase as a whole, and not focus only on the individual terms.

Here, as applicant has pointed out, there is but a single piece of evidence (supplied by applicant) that the term "van ladder" has appeared anywhere, and that is in an editorial appearing in the St. Petersburg Times of March 10, 1989, in the following context:

Editor: Before we get a second license plate, we should be more observant of the one we have. But how can we when there are trailer hitches, van ladders, license plate frames, overhanging truck loads, plus the lights that the manufacturer installed so we can observe at night that are not working. In those states that have two plates, how many times has a moving car license on the front been copied by law enforcement? Vehicle violations should be ticketed not only by the state but also by county and city law enforcement agencies.

Except for this one instance (where it is arguable that the term was used to refer to a ladder attached to a van for climbing to the top thereof, and not to refer to an aerial ladder and platform of the type sold by applicant), there is no evidence that this phrase has been exposed to the public, except by applicant. There is simply no evidence that the relevant consumers use this term to refer to the category or type of product made by applicant. Moreover, as applicant has pointed out, an extension ladder is only a part of applicant's goods, which consist of a work platform mounted on top thereof, there is no dictionary definition of this term, and there is no evidence of use of this mark by competitors or by consumers to refer to a category of product. In view of the paucity of evidence that these words have been use generically, we cannot say that the relevant public understands the mark sought to be registered to refer primarily to a genus or category of

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product. The Office has failed to carry its burden of proof on the issue of genericness.

Acquired Distinctiveness

Having concluded that applicant's mark is not generic, we turn to the evidence of secondary meaning, which we conclude presents a prima facie case of acquired distinctiveness. In this regard, applicant submitted the declaration of the inventor of the extension ladder now made by applicant, covered by a patent issued in 1969. Among other things, that inventor, Eugene Faulstich, states that the asserted mark has been used since September 1968 (that is, for over 30 years); that this mark has been registered by this Office (on the Supplemental Register); that in the patent covering this device, the term VAN LADDER has not been used generically to describe the extension ladder unit anchored on a truck with an electrically powered shaft connected to a cable which extends and raises the ladder; that applicant's product may be used on a variety of vehicles including service vans, flatbed, pickup and utility trucks, four-wheel-drive vehicles, utility vehicles, station wagons and off-road tractors; that, over the years, millions of dollars in sales have been realized so that now applicant's mark is one of the best known names in the industry; that

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competitors do not use this term (as evidenced by brochures of those companies) and that they are able to compete effectively without use of applicant's mark; and that the generic term for applicant's goods is "portable aerial boom/bucket" or simply "aerial lift."

Upon careful consideration of this declaration, and in the absence of countervailing evidence, we conclude that applicant has demonstrated a prima facie case of acquired distinctiveness. There is adequate circumstantial evidence of buyer exposure, including the length of time of applicant's use of this mark. If we had any doubt in this matter, that doubt should be resolved in favor of publication. In re Women's Publishing Co. Inc., 23 USPQ2d 1876 (TTAB 1992) (DECORATING DIGEST held merely descriptive but not generic for applicant's magazines, finding applicant's mark to have acquired distinctiveness.

Decision: The refusal of registration is reversed.

EXHIBIT B

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
September 10, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

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In re Festival of Vitamins, LLC

—
Serial No. 85331608

—
Matthew H. Swyers of The Trademark Company for Festival of Vitamins, LLC.

Barbara Brown, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

—
Before Seeherman, Wellington, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Festival of Vitamins, LLC has applied to register on the Principal Register the mark ANTI-AGING NATURALS in standard character form for goods identified as “Dietary and nutritional supplements,” in International Class 5.¹

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant’s mark merely describes the goods. In response, applicant asserted that its mark had

¹ Application Serial No. 85331608, filed on May 26, 2011 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), with a claim of first use and first use in commerce of May 27, 2005.

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acquired distinctiveness and requested that its mark be registered under the provisions of Section 2(f), 15 U.S.C. § 1052(f). The examining attorney then refused registration on the ground that applicant's mark is generic for applicant's goods and is, accordingly, not capable of acquiring distinctiveness within the meaning of Section 2(f). When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed appeal briefs.

There are two primary questions before the Board. The first is whether the mark ANTI-AGING NATURALS is the generic name of applicant's goods. If the mark is not the generic name of those goods, the second question, arising from applicant's concession that its mark is merely descriptive of its goods,² is whether applicant has demonstrated that its mark has acquired distinctiveness so as to justify registration.

1. Genericness.

A mark is a generic name if it refers to the class or category of goods or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) ("*Marvin Ginn*"). The test for determining whether a mark is generic is its primary significance to the relevant public. *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB*

² A claim of acquired distinctiveness under Section 2(f) is a concession that the matter to which the claim pertains is not inherently distinctive and, accordingly, not registrable on the Principal Register absent proof of acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

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Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *Marvin Ginn, supra*. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530. The examining attorney has the burden of establishing by clear evidence that a mark is generic. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re American Fertility Society, supra*; and *Magic Wand Inc., supra*. “Doubt on the issue of genericness is resolved in favor of the applicant.” *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

As noted above, our first task under *Marvin Ginn* is to determine, based on the evidence of record, the genus of respondent's services. A proper genericness inquiry in an *ex parte* matter focuses on the description of goods or services set forth in the application. *In re Country Music Association Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011). We find that the genus of goods at issue in this case is adequately defined by applicant's identification of goods, namely, “dietary and nutritional supplements.” *See id.*; *In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1112 (TTAB 2010).

We next consider whether applicant's mark would be understood by the relevant public primarily to refer to the genus of dietary and nutritional supplements. The examining attorney has submitted evidence from online

dictionaries that indicates that the following terms have the meanings set forth below:

anti- or ant-	c.	Counteracting; neutralizing: <i>antacid</i> . ³
anti-aging	adj.	delaying the effects of aging, having an effect in decelerating the effects of aging; used to impede the effects of aging; used to reduce the impact of aging. ⁴
aging	1.	The process of growing old or maturing. ⁵
natural	1.	Existing in or formed by nature (opposed to artificial): <i>a natural bridge</i> . ⁶

On the basis of these definitions, and relying upon the adjectival meaning of “natural,” the examining attorney argues, “ANTI-AGING means counteracting the process of growing old and NATURALS, in the noun form, identifies a natural product.”⁷

The examining attorney has also submitted evidence from the internet showing use of the terms “anti-aging” and “natural” as adjectives modifying the names of various products, including dietary or nutritional supplements. Moreover,

³ Definition found at <education.yahoo.com>, submitted with Office action of September 15, 2011. The examining attorney’s brief indicates that this definition is from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Third Edition.

⁴ Definition found at <dictionarist.com>, submitted with Office action of January 30, 2012.

⁵ *Id.*

⁶ Definition found at <dictionary.reference.com>, submitted with Office action of September 15, 2011.

⁷ Examining attorney’s brief at 6.

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she has submitted such evidence showing use of “anti-aging” and “natural” together as modifiers.⁸ Among these, we note in particular the following:

The anti aging natural supplements that used to be just another “health food craze” have been proven to be a beneficial addition to your life and diet. ... Natural anti aging supplements are a smart way to provide your body with the essential nutrients you’re missing.

Advertisement at <juvenon.com>.

PureZen™ Anti Aging Natural supplements including anti aging vitamins, anti aging herbs, and anti aging nutritional supplements are true all-natural anti aging supplements that are designed to enhance your health and wellbeing....

...
Natural Anti Aging Supplements Resources:: natural anti aging supplements

Advertisement at <purezenhealth.com>.

anti aging natural supplements

... The B-vitamins help to combat stress and hence may indirectly act as an anti aging natural supplement. ... Anti aging natural supplements are gaining ground and is headed for a gigantic leap forwards. How far these supplements are actually effective differs from individual to individual....

Advertisement at <indianchild.com>.

Prohormones as well as anti aging natural supplements can help to increase testosterone and growth hormone levels in men while providing faster increases in muscle size and strength.

Advertisement from <paramount-supplements.com>.

⁸ The examples of usage that follow were all submitted with the Office action of August 2, 2012.

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Dr. Theodore, an Australian MD who focuses on Anti Aging natural medicine, believes he has found a unique and long term solution to this common problem....

“Impotence Can Be Reversed with New Medical Program,” American Consumer News, December 28, 2010.

She is a walking advertisement for the line of “anti-aging” natural skin care products she has developed and hopes to market.

“A Perfect Guest,” Newsday, March 15, 2001.

Ray Lewis, a chiropractor, will give a free seminar on anti-aging, natural health and healing, and therapeutic use of essential oils....

“Happenings,” The Charlotte Observer, November 5, 1999.

Next up, tarte is launching an anti-aging, natural lipstick with aBORBA nutraceutical core....

“Sweet tarte: taking inside-out beauty to heart,” Global Cosmetic Industry, October 1, 2007.

The examining attorney has also submitted samples of commercial materials (discussed *infra*) in which the word NATURALS (including the final letter S) is used.⁹

In order to demonstrate genericness under *Marvin Ginn*, the evidence of record must prove that the mark is “understood by the relevant public primarily to refer to [the] genus of” applicant’s goods. 228 USPQ at 530. The evidence before us is insufficient to prove that ANTI-AGING NATURALS is a generic term because it does not demonstrate that the public understands the term primarily to refer to the genus of applicant’s goods.

⁹ All submitted with the Office action of August 2, 2012.

Applicant's mark is ANTI-AGING NATURALS, and the examining attorney argues that, as used in the mark, "NATURALS, in the noun form, identifies a natural product."¹⁰ However, none of the evidence, including the dictionary definitions, supports her contention that NATURALS may be used as a noun to mean "natural product" or "natural products." Rather, the evidence from Dictionary.com indicates that, as a noun, "natural" may be used to designate a person having innate talents; a musical pitch; "an idiot"; blackjack (in cards); and "Afro."¹¹

The bulk of the examining attorney's evidence shows that the words "anti-aging" and "natural" (without a final letter S) have been used together as adjectives to describe certain things, but none of this shows generic usage of NATURALS as having the meaning "natural products."¹²

The examining attorney has submitted some evidence in which the word NATURALS (including the final letter S) appears.¹³ However, from the context it is unclear whether the word NATURALS is being used as a generic term within the trade name or trademark or as a source-identifying part of the trade name or trademark. These examples include WHISTLER NATURALS ("Whistler Naturals

¹⁰ Examining attorney's brief at 6.

¹¹ Definition found at <dictionary.reference.com>, definitions numbered 32 through 36, submitted with Office action of September 15, 2011.

¹² We acknowledge that there are cases in which the Board has found the addition of an "s" is irrelevant in assessing the meaning of a mark when it changes a term from the singular to the plural. *See, e.g., Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1998 (TTAB 1986); *In re Vanilla Gorilla L.P.*, 80 USPQ2d 1637 (TTAB 2006). But in this case, by changing the term from an adjective to a noun, it makes a significant difference in the meaning of the word.

¹³ Submitted with the Office action of August 2, 2012.

Serial No. 85331608

anti-aging natural Skin Care has everything you need...”); L.A. NATURALS botanical supplements; NORDIC NATURALS supplements; SOURCE NATURALS (“Source Naturals was created in 1982 with the primary goal to support each individual’s potential to enjoy optimal health”); NAVITAS NATURALS products (“...Navitas Naturals makes 100% organic, raw, vegan, kosher, sustainably-grown and gluten-free products...”); NEEMAURA NATURALS supplements; and LIVING ORCHARD NATURALS (“I recommend Living Orchard Naturals products if you are committed to a healthy lifestyle.”) Overall, the evidence does not demonstrate that the public understands ANTI-AGING NATURALS to be a generic term for the identified goods.

While the evidence indicates that “anti-aging natural” may be considered an appropriate chain of descriptors for goods such as applicant’s supplements, it does not show that these words are a unitary phrase rather than individual adjectives that happen to be placed together. To the contrary, the record contains numerous examples¹⁴ of use of these words in formats that are inconsistent with use of a unitary, generic term. In particular, these words have been placed in reverse order; separated by a comma or other punctuation; separated by other words; or other variations. For example, the advertisements at <juvenon.com> and <purezenhealth.com>, quoted above, use both “anti aging natural supplements” and the reversed form “natural anti aging supplements.” The articles quoted above from Newsday, The Charlotte Observer and Global Cosmetic Industry show the words at

¹⁴ Submitted with the Office action of August 2, 2012.

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issue interrupted by punctuation, in the forms “‘anti-aging’ natural” and “anti-aging, natural.” We also note the following articles in which ANTI-AGING and NATURAL are used as separate adjectives:

Anti-aging and natural products expected to grow in Europe, North America.

“Demand Growth Slows, But Niche Opportunities Remain,” Chemical Week, September 27, 2010, p. 65.

... anti-aging and natural foods.

“In Brief,” News Sentinel (Knoxville, Tennessee), October 21, 2002, p. E2.

Aging Fabulous tells you about anti-aging the natural way.

“Splendid Saturday reads,” Her Accessories, April 26, 2008.

... skin creams with miraculously anti-ageing [sic] ‘natural’ herbs....

“This ‘nature’ fad is just not natural,” GP, September 29, 2003, p. 27.

Dr. Elisha’s all natural anti aging skin care products....

Advertisement at <www.elishea.com>.

Best Anti Aging / Natural Anti Aging

Facebook page at <facebook.com/pages/Best-Anti-Aging-Natural-Anti-Aging/391571134216430>.

Shea Butter: Anti-Aging Natural Skin Care

...

One of the most effective natural anti-aging skin care ingredients available is shea butter.

Web page at <pbase.com>

Okay, we are going creative here and combining anti-aging natural skin care with a great party recipe.

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...

Related Posts:

- Natural Anti-Aging Skin Care: Breasts, Face and Body Lifts (Slideshow)
- Natural Anti-Aging Skin Care

Web page at <antiagingpress.org>.

Whistler Naturals anti-aging natural Skin Care has everything you need for your anti-aging skin care routine.

...

Our natural anti-aging skin care line is free from harsh preservatives....

Advertisement at <whistlernaturals.com>.

These examples of inconsistent use of the words at issue undermine the contention that the mark is generic. Because a finding of genericness must be supported by clear evidence of generic use, *In re Merrill Lynch*, 4 USPQ2d at 1143, and because the record fails to prove that the mark at issue is a unitary term that is understood by the relevant public primarily to refer to the genus of applicant's goods, we find that the mark has not been shown, by clear evidence, to be generic for applicant's goods.

2. Acquired distinctiveness.

We next address the examining attorney's refusal to register applicant's mark under Section 2(e)(1) on the ground that applicant's mark merely describes the goods; and the examining attorney's rejection of applicant's claim that its mark has acquired distinctiveness and is entitled to registration under Section 2(f).

As we have noted above at footnote 2, applicant's invocation of Section 2(f) as the basis upon which it seeks registration removes from consideration any question

Serial No. 85331608

as to whether applicant's mark is inherently distinctive, leaving only the issue of whether the mark has acquired distinctiveness. *Yamaha International Corp.*, 6 USPQ2d at 1005.

The burden of showing that the mark has acquired distinctiveness is on applicant. *Id.* at 1006. The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970). “[T]he evidence required is in proportion to the degree of nondistinctiveness of the mark at issue.” *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009); *see also In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985). Typically, more evidence is required where a mark is so highly descriptive that purchasers would be less likely to believe that it indicates source in any one party. *See In re Bongrain Int’l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1728 fn4 (Fed. Cir. 1990) (“the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning” (quoting *Yamaha International*, 6 USPQ2d at 1008)).

In support of its claim of acquired distinctiveness, applicant has submitted the verified statement¹⁵ of its principal Huitt Danvers that “The mark has become distinctive of the goods/services through the applicant’s substantially exclusive and

¹⁵ Response filed October 28, 2011.

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continuous use in commerce for at least the five years immediately before the date of this statement [October 28, 2011].” Ms. Danvers’ declaration also states that:

- applicant actually commenced use of its mark in May, 2005;
- the mark has been used on thousands of product labels and products, representing a total of 15 labels and products (plus several revisions);
- the marked products have been marketed on <amazon.com> since 2005; and are marketed on “Amazon.com affiliated websites”;
- marked products are sold on 20 websites owned by applicant;
- sales have been made in the United States, in Europe through a distributor, and on Amazon’s UK website; and applicant has two registered websites in China;
- applicant has spent over \$12,000 on product development, including label design and preparation and art expenses;
- applicant has spent over \$100,000 on manufacturing;
- applicant has spent over \$5,000 on product advertising, including ads through Google, Yahoo, and comparison shopping venues;
- applicant has spent over \$600 on registering and maintaining 20 web addresses.

Applicant also submitted copies of seven labels for seven distinct products under the proposed ANTI-AGING NATURALS mark.¹⁶

As we discussed in part 1 of this decision, the record shows that the designation “anti-aging” (or “anti aging”) is used to identify a category of nutritional supplements or, at the very least, to describe a characteristic of goods that are

¹⁶ *Id.*

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similar in general nature to applicant's goods, including nutritional supplements. The record also contains evidence of at least seven third-party products that are marketed under trademarks or trade names that include the designation NATURALS, indicating that customers would not readily perceive this term as an indicator of a single source of goods. The combination of these two non-distinctive components results in a designation that is highly descriptive and very weak in source-indicating potential. Accordingly, applicant's burden of showing that its mark has acquired distinctiveness as a source-indicator is a heavy one, requiring substantial evidence. Under such circumstances, applicant's reliance on substantially exclusive and continuous use of the mark since 2005, and the activities detailed in its declaration, are not sufficient to demonstrate that the mark has acquired distinctiveness.

Applicant's total expenditures of \$5600 on advertising and website maintenance are quite modest and not indicative of substantial success in bringing applicant's mark to the attention of the public. The costs of product development and manufacture do not tell us anything about the extent of public recognition of the mark or the goods. The fact that applicant's goods have been marketed internationally through the internet and through other channels does not indicate widespread recognition of the mark in the United States. We also point out that, although applicant has asserted substantially exclusive and continuous use of its mark since 2005, it has not provided any information about what its sales figures in the United States have been. In short, a much greater degree of detail regarding

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applicant's marketing efforts and sales would be required for us to conclude that the public recognizes ANTI-AGING NATURALS as a trademark for the goods identified in the application.

Having considered all of the evidence and arguments of record, including those not expressly discussed herein, we find that applicant has failed to demonstrate that its mark has acquired distinctiveness. Accordingly, the mark is not entitled to registration under Section 2(f).

Decision: We reverse the refusal on the ground that applicant's mark is generic, but we affirm the refusal under Trademark Act Section 2(e)(1) on the ground that applicant's mark is merely descriptive of its identified goods.

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:



Serial No.: 79/122,366

Filing Date: November 7, 2012

Applicant: Booking.com B.V.

Examiner: Nelson B. Snyder III
Law Office 107

DECLARATION UNDER 37 C.F.R. § 2.20

The undersigned, Jaap van den Broek, hereby declares as follows:

1. I am an authorized representative of the Applicant corporation and am authorized to sign this Declaration on behalf of the Applicant. I base this declaration on my personal knowledge and my complete access to the relevant books and records of Booking.com B.V.

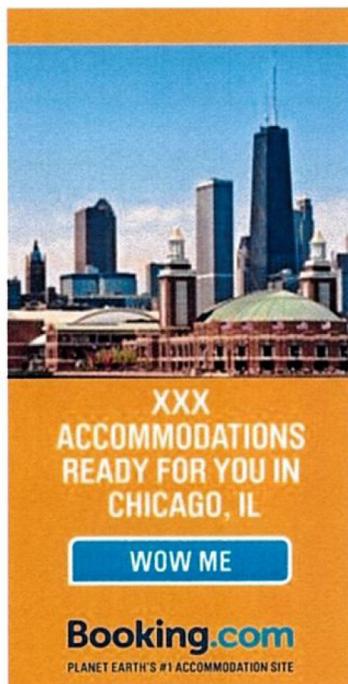
2. Based on my experience, it is clear to me that Applicant's BOOKING.COM mark is distinctive and that it functions as a source-identifier for Applicant and its online accommodation reservation services.

3. Applicant has advertised its BOOKING.COM mark extensively in the United States through web advertisements, television commercials, movie theatre previews, cross-linking partnerships with other major websites, social media participation, direct mailings, and other channels of advertising.

4. Through its various forms of advertising, Applicant has consistently reached millions of American consumers over several years. As the examples in this declaration show, Applicant's BOOKING.COM mark is always used as a unitary mark and displayed in such a

manner that consumers are likely to perceive “BOOKING.COM” as a unitary and distinctive mark.

5. The following web banners were displayed on the homepage of the popular travel website TripAdvisor.com in May 2013.



6. In each of the foregoing advertisements, BOOKING.COM is used as a unitary mark. Given the nature of use, prominent placement, and use of a contrasting color scheme in which the color of the mark is tied to the color of the “action” button, BOOKING.COM is presented to consumers viewing these advertisements as the brand name for Applicant’s services, not as a generic term naming travel websites, generally. Applicant’s

use of the descriptive phrase “Planet Earth’s #1 Accommodation Site” in close proximity to its trademark BOOKING.COM further underscores that consumers are likely to recognize Applicant’s mark as a distinctive trademark. The descriptive term for the services is “Accommodation Site;” the trademark is BOOKING.COM.

7. BOOKING.COM partnered with the popular online movie ticket vendor Fandango.com for a Halloween-themed promotion from October 25, 2013 to October 31, 2013. Fandango sells approximately 80% of all online movie tickets.

8. The BOOKING.COM promotion on Fandango included a special “House of Horrors” tab on the home page for Fandango. When a user clicked on the tab, he or she would reach a “House of Horrors” home page featuring BOOKING.COM-created and branded movie posters and short videos about humorous “travel horrors.” The following chart shows the user’s experience from the home page, to the “House of Horrors” page, to a BOOKING.COM listing housed on the Fandango website.



9. Complementing this promotion, Booking.com also purchased the rights to the background “skin” on the Fandango website as shown below with “The Queen Anne Hotel” mock movie “presented by” BOOKING.COM.



10. Booking.com also created posters for mock movies, such as “The Gettysburg Hotel” “presented by” BOOKING.COM. The credits at the bottom of the movie poster provide information about the BOOKING.COM service and the actual Gettysburg Hotel.

Booking.com
PRESENTS



THE GETTYSBURG HOTEL

STAY IF YOU DARE.

BOOKING.COM PRESENTS ONE OF AMERICA'S MOST HAUNTED HOTELS. THE GETTYSBURG HOTEL, A HISTORICAL GRANDEUR,
119 ELEGANT ROOMS, AND SEVERAL FALLEN SOLDIERS WHO REST IN PEACE. A NIGHTMARE FOR ALL GHOST HUNTERS,
CONSIDERED BY BOOKING.COM THE WIDEST RANGE OF ACCOMMODATIONS INCLUDING HAUNTED HOTELS.
© 2020 BOOKING.COM

11. Visitors that clicked on the BOOKING.COM promotions on the Fandango website were directed to related content on the BOOKING.COM website, which resulted in an increase in web traffic to the BOOKING.COM website.



12. The Fandango promotion reached approximately 6.6 million viewers.

13. Through these and other creative, fun, and unconventional promotions, Booking.com has set itself apart as a unique service provider and has cultivated a distinctive public image and brand. In each of these advertisements, the BOOKING.COM mark appears as a prominent, unitary mark and is used in such a way that consumers are likely to perceive it as a source-indicator rather than as a generic or descriptive term for a type of travel website.

14. That consumers perceive BOOKING.COM as a source indicator is not mere conjecture; it is evident from the tens of thousands of unsolicited customer reviews and comments about BOOKING.COM available online. Each of these customer reviews plainly uses and recognizes BOOKING.COM as a trademark identifying a single source, not as a generic term referring to travel websites generally. Attached as Exhibit 1 to this Declaration are true and correct printouts from *Review Center* which has 9,672 reviews for BOOKING.COM with an average rating of 4.4 out of 5 stars (<http://www.reviewcentre.com/reviews195173.html>) and *Feefo* which has 57,396 reviews for BOOKING.COM with an aggregate rating of 94% (http://www.feefo.com/GB/en/reviews/Bookingcom_gb/?id=575437&mode=service).

15. The fact that consumers perceive BOOKING.COM as a source indicator is also evident from the interactions between consumers and Applicant on social media. For example, over 54,300 individuals “follow” Booking.com on the social media site Twitter. Based on publicly available data from www.twitter.com, this is more “followers” than comparable travel accommodation sites such as HOTELS.COM (51,400 followers), TRIVAGO (16,700 followers) and HOTWIRE (18,500 followers). True and correct screenshots taken September 24, 2014 of portions of the Twitter pages for these companies showing the number of “followers” are reproduced below.

TWEETS	VOLGEND	VOLGERS
18,6K	2.637	54,3K

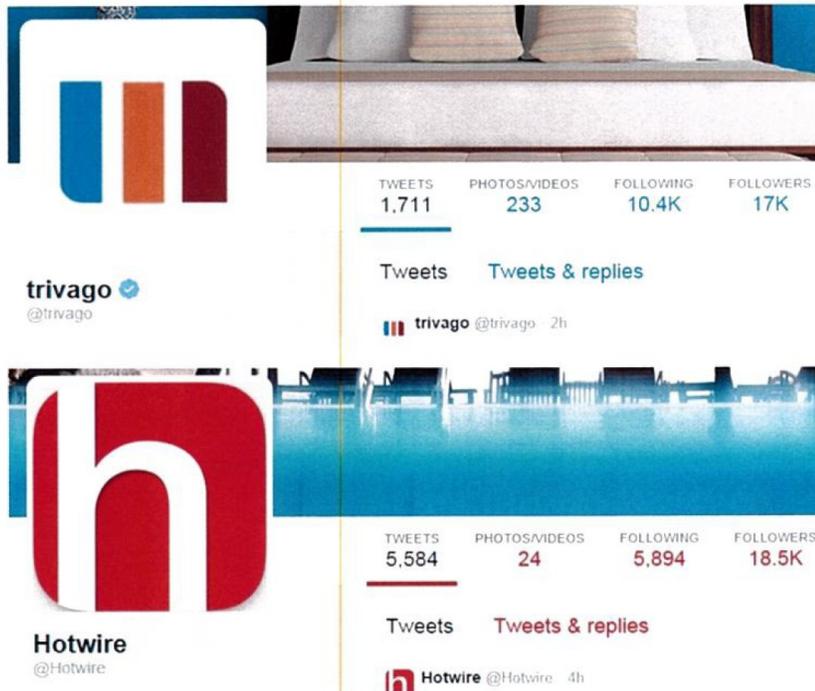
Booking.com ✓
@bookingcom
Welcome to Booking.com's official Twitter page. Follow us f

TWEETS	PHOTOS/VIDEOS	FOLLOWING	FOLLOWERS
12.6K	210	3,697	51.4K

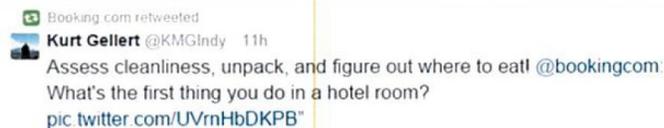
Hotels.com ✓
@hotelsdotcom

Tweets Tweets & replies

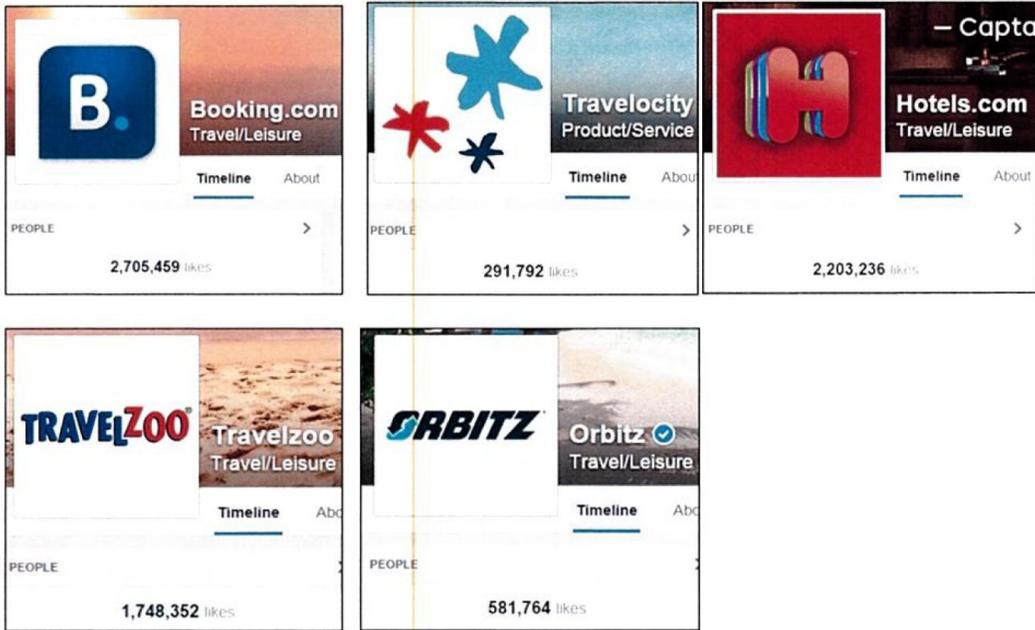
Hotels.com @hotelsdotcom 20m



16. Customers regularly communicate directly with Applicant through Twitter. Below are screenshots taken September 23, 2014 of customers using the Twitter handle @bookingcom to contact Applicant. This further demonstrates that consumers perceive BOOKING.COM as a unitary mark that points uniquely and exclusively to Applicant, rather than as a generic name for a type of travel service.



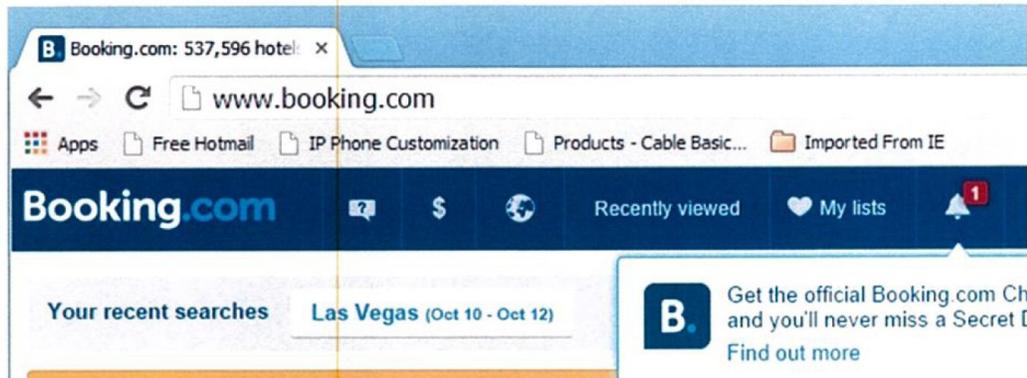
17. Over 2,705,400 individuals have “liked” Booking.com’s BOOKING.COM branded page on the social media site Facebook. The number of “likes” by consumers demonstrates strong customer loyalty and recognition of BOOKING.COM as a brand. For context, the number of individuals that have “liked” the BOOKING.COM page on Facebook is significantly higher than those that have liked the pages of comparable companies such as Travelocity (291,792 “likes”), Hotels.com (2,203,236 “likes”), TravelZoo (1,748,350 “likes”), and Orbitz (581,764 “likes”), based on publicly available data from www.facebook.com. True and correct screenshots taken September 23, 2014 of portions of the Facebook pages for the above-referenced companies showing the number of “likes” are reproduced below



14. Booking.com frequently promotes its BOOKING.COM mark in conjunction with

or in close proximity to its B-dot Logo  (Reg. No. 4,460,494).¹ An example of this type of advertising is the Booking.com main website which uses the B-dot Logo as the “favicon” in the browser tab. The B-dot Logo appears adjacent to the word mark BOOKING.COM. The B-dot Logo also appears in alerts to customers and in the BOOKING.COM mobile app. This type of advertising underscores to consumers that BOOKING.COM must be viewed as a unitary mark in which the “dot” is an integral component.

¹ Copies of Applicant’s registrations for the B-dot Logo and BOOKING.YEAH are attached as Exhibit 2 to this Declaration.



15. Applicant's family of marks, including its BOOKING.COM, B-dot Logo, and BOOKING.YEAH (Reg. No. 4491012) marks use a consistent dark blue, light blue, and white color scheme, letter stylization and overall look. The unified branding contributes to the distinctiveness of Applicant's applied-for mark. An example of a BOOKING.YEAH advertisement appears below.



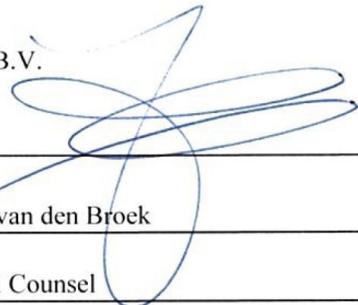
16. Based on the above evidence and my knowledge of the business, I am quite certain that the subject mark is recognized as a source-identifier by the relevant consumers.

17. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such

willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application and accompanying declaration are true; all statements are made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Date: October 10, 2014

Applicant,
Booking.com B.V.

By: 

Name: Jaap van den Broek

Title: Legal Counsel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:

The logo for Booking.com, featuring the word "Booking" in white and ".com" in blue, set against a dark blue rectangular background.

Serial No.: 79/122,366

Filing Date: November 7, 2012

Applicant: Booking.com B.V.

Examiner: Nelson B. Snyder III
Law Office 107

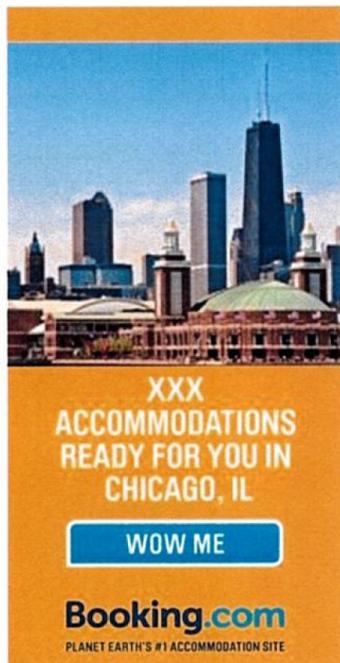
DECLARATION UNDER 37 C.F.R. § 2.20

The undersigned, Jaap van den Broek, hereby declares as follows:

1. I am an authorized representative of the Applicant corporation and am authorized to sign this Declaration on behalf of the Applicant. I base this declaration on my personal knowledge and my complete access to the relevant books and records of Booking.com B.V.
2. Based on my experience, it is clear to me that Applicant's BOOKING.COM mark is distinctive and that it functions as a source-identifier for Applicant and its online accommodation reservation services.
3. Applicant has advertised its BOOKING.COM mark extensively in the United States through web advertisements, television commercials, movie theatre previews, cross-linking partnerships with other major websites, social media participation, direct mailings, and other channels of advertising.
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© 2020 BKCM

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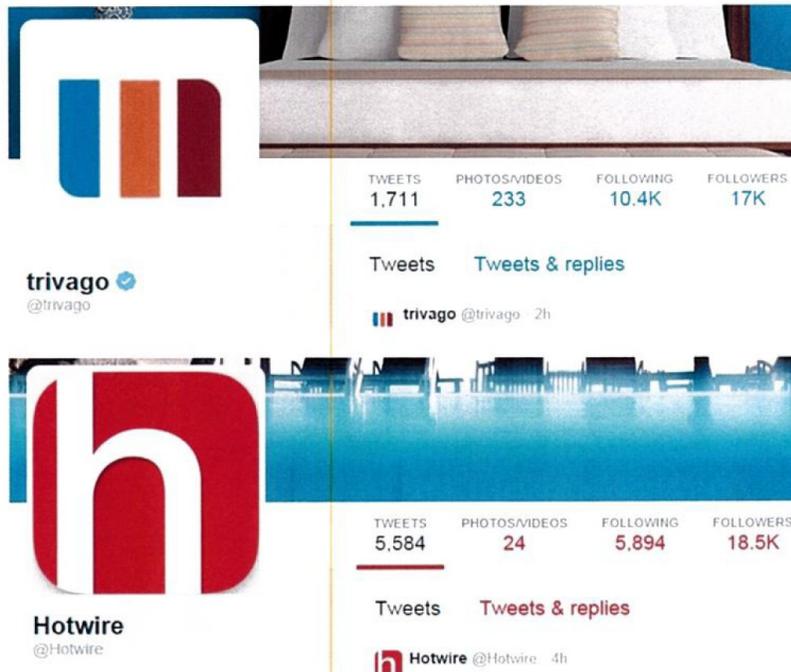
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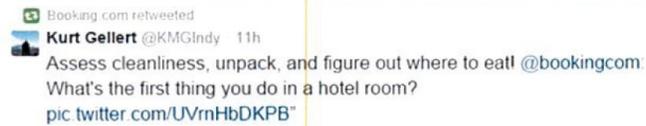
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15. The fact that consumers perceive BOOKING.COM as a source indicator is also evident from the interactions between consumers and Applicant on social media. For example, over 54,300 individuals “follow” Booking.com on the social media site Twitter. Based on publicly available data from www.twitter.com, this is more “followers” than comparable travel accommodation sites such as HOTELS.COM (51,400 followers), TRIVAGO (16,700 followers) and HOTWIRE (18,500 followers). True and correct screenshots taken September 24, 2014 of portions of the Twitter pages for these companies showing the number of “followers” are reproduced below.

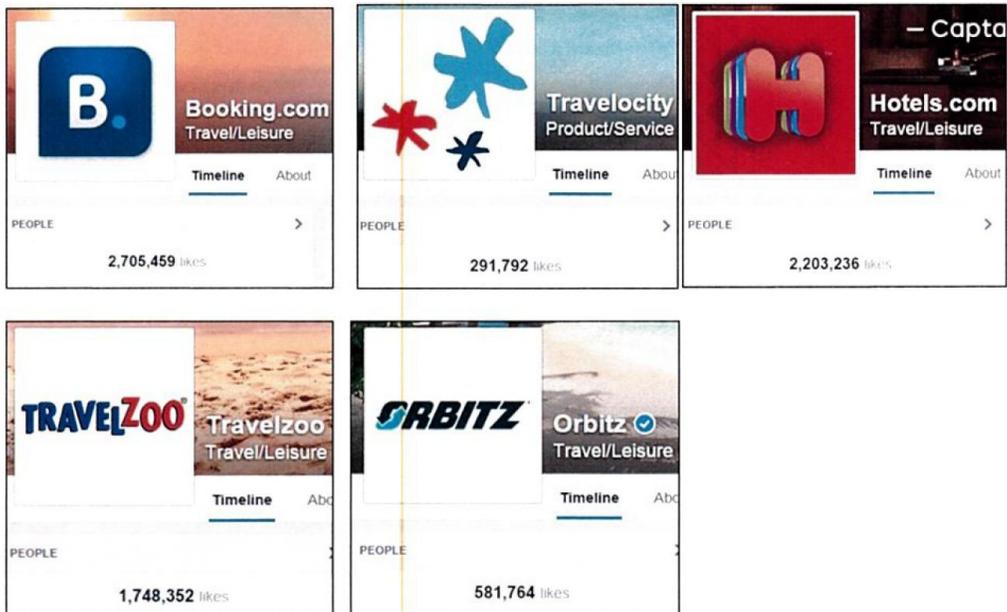




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17. Over 2,705,400 individuals have “liked” Booking.com’s BOOKING.COM branded page on the social media site Facebook. The number of “likes” by consumers demonstrates strong customer loyalty and recognition of BOOKING.COM as a brand. For context, the number of individuals that have “liked” the BOOKING.COM page on Facebook is significantly higher than those that have liked the pages of comparable companies such as Travelocity (291,792 “likes”), Hotels.com (2,203,236 “likes”), TravelZoo (1,748,350 “likes”), and Orbitz (581,764 “likes”), based on publicly available data from www.facebook.com. True and correct screenshots taken September 23, 2014 of portions of the Facebook pages for the above-referenced companies showing the number of “likes” are reproduced below



14. Booking.com frequently promotes its BOOKING.COM mark in conjunction with

or in close proximity to its B-dot Logo  (Reg. No. 4,460,494).¹ An example of this type of advertising is the Booking.com main website which uses the B-dot Logo as the “favicon” in the browser tab. The B-dot Logo appears adjacent to the word mark BOOKING.COM. The B-dot Logo also appears in alerts to customers and in the BOOKING.COM mobile app. This type of advertising underscores to consumers that BOOKING.COM must be viewed as a unitary mark in which the “dot” is an integral component.

¹ Copies of Applicant’s registrations for the B-dot Logo and BOOKING.YEAH are attached as Exhibit 2 to this Declaration.



15. Applicant's family of marks, including its BOOKING.COM, B-dot Logo, and BOOKING.YEAH (Reg. No. 4491012) marks use a consistent dark blue, light blue, and white color scheme, letter stylization and overall look. The unified branding contributes to the distinctiveness of Applicant's applied-for mark. An example of a BOOKING.YEAH advertisement appears below.



16. Based on the above evidence and my knowledge of the business, I am quite certain that the subject mark is recognized as a source-identifier by the relevant consumers.

17. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such

willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application and accompanying declaration are true; all statements are made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Date: October 10, 2014

Applicant,
Booking.com B.V.

By:  _____

Name: Jaap van den Broek

Title: Legal Counsel