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Sent: 5/23/2014 12:16:25 PM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85485097 - BOOKING.COM - 096981-0108 - Request for
Reconsideration Denied - Return to TTAB - Message 1 of 7

Attachment Information:

Count: 5

Files: genares-1.jpg, genares-2.jpg, genares-3.jpg, Genbook-1.jpg, 85485097.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85485097

MARK: BOOKING.COM



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Booking.com B.V.

CORRESPONDENT'S REFERENCE/DOCKET NO:

096981-0108

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/23/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated 10/28/2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

Applicant has refuted in their request for consideration both that 1) BOOKING.COM is descriptive and thus must be disclaimed, and 2) that the 2(F) evidence is insufficient for a claim of acquired distinctiveness in the alternative.

At the outset, the examining attorney wishes to remark that the attorney for the applicant appears to have merged the two issues at hand into a single issue – the distinctiveness of the *mark as a whole*. The current and previous examining attorney have always been in accord that the mark as a whole possesses distinctive, and thus registrable, material. Thus, Applicant's claim that the office has "inexplicably contradicted itself" is false and misleading.

To the contrary, in the first Office Action issued by the previous examiner on March 23, 2012, the *disclaimer requirement for BOOKING.COM* was, in fact, issued. The subsequent examiner, representing the office herein and on all subsequent actions, has maintained and rendered final this same requirement. The Applicant therefore must prove to the Office and the Board *not* that the **mark as a**

whole is registrable and distinctive, but that the *particular language* BOOKING.COM is either 1) not descriptive in order to avoid having to disclaim the language, or 2) has acquired distinctiveness under 2(F) and is therefore not generic, in order to register under 2(F) in part as to the language BOOKING.COM. There has never been any discussion or insinuation by *either* examining attorney that the design elements would not carry the mark onto the Principal Register – the issue has always solely been the literal element BOOKING.COM as being incapable, and thus requiring a disclaimer.

Thus, due to the explanations and arguments which follow, the examining attorney herein DENIES the request for reconsideration, having neither been swayed by applicant's arguments nor provided with amendments to the application which would satisfy the outstanding requirements.

A. "BOOKING.COM" IS MERELY DESCRIPTIVE AND MUST THEREFORE BE DISCLAIMED IN AN OTHERWISE REGISTRABLE MARK

The Applicant has argued that the word BOOKING is "suggestive of the underlying services, not merely descriptive." *Applicant's Request for Reconsideration (RFR), Page 3*. However, the applicant has not applied the correct standard for determining the descriptiveness of language in a mark.

The central crux of the Applicant's argument as to the suggestiveness of the mark is that the word BOOKING can have multiple meanings. However, this is *not* borne out by the Applicant's evidence or argument. While the Applicant is correct that a booking can be for "entertainment bookings, theatrical bookings," etc., *these are all types of bookings (i.e., reservations)*. Therefore, there remains a central meaning of BOOKING (a reservation) of which the Applicant's examples are simply various *types*.

Further, the fact that a word may have multiple meanings is *not decisive* to a determination of descriptiveness when there is no double entendre or other indication that one of these secondary/alternative meanings is being called to a consumer's mind or awareness. The Applicant is *not* utilizing a mark which would call to mind for consumers an impression, for example, of a criminal being "booked." To the contrary, **taken as a whole**, the mark demonstrates a globe and a briefcase, clearly and *immediately* implicating to a consumer that the booking is likely a *travel-related* booking.

Further, it is well established that the descriptiveness and genericness of a term is judged **in relation to the Applicant's services, and not in the abstract**. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 217-18 (C.C.P.A. 1978); TMEP §1209.01(b).

Here, a consumer with knowledge of Applicant's services would perceive BOOKING as having only a *single* meaning, which is descriptive (and generic) for such services as being the primary purpose or focus of such services: "booking" consumers, i.e., aiding in obtaining reservations ("bookings") for travel, lodging, etc.

Thus, it is not in fact "vague and ambiguous," but rather conveys **immediate** information regarding Applicant's services with a *high* degree of particularity by identifying a number of Applicant's services by their common commercial name. The Applicant has not provided any caselaw or evidence as to why BOOKING.COM's literal element should be examined and determined in the abstract rather than in reference to its services, nor why it would be dissected from the consumer impression of the mark as a whole with its relevant design elements when a consumer is encountering it.

The design element clearly implicates travel, BOOKING has a commonly known and understood meaning as the making of a reservation, or the reservation itself, and when encountered with knowledge of Applicant's services a consumer would clearly understand it to refer to these types of travel agency services – the making of reservations.

Competitive necessity is another factor which militates toward the finding of a term as being descriptive (and generic). The examining attorney has previously provided a substantial weight of evidence indicating the competitive necessity and use by others of the term BOOKING as a generic term for a reservation, or the making of a reservation. There are, further, numerous instances of the use of BOOKING and .COM utilized by competitors in their own website names.

See previous attachments, 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
- www.securehotelbooking.com

Therefore, it is apparent that BOOKING is indeed utilized quite commonly, and in a descriptive (and generic) fashion, for *precisely* the services Applicant is offering.

The Applicant has further, this time, offered no arguments that the addition of .COM changes the descriptiveness of the mark.

The Court of Appeals for the Federal Circuit has stated that, as a general rule, the addition of a TLD to otherwise unregistrable wording (**i.e., merely descriptive or generic**) does not add source-indicating significance except in “unique” or “exceptional” circumstances. *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1372-74 (Fed. Cir. 2004). Therefore, it is sufficient for the examining attorney to demonstrate the descriptiveness of BOOKING, and that the addition of .COM would *merely* be perceived by the public as a TLD with no unique source identifying significance. In the *Oppedahl* decision, referring to an illustrative hypothetical mark discussed by the court during oral argument, the court gave the following explanation for possible “unique” or “exceptional” circumstances:

This hypothetical applicant’s mark consists of a descriptive term – “tennis” – and a TLD – “.net.” The “net” portion alone has no source-identifying significance. The hypothetical mark as a whole, as is immediately apparent, produces a witty double entendre relating to tennis nets, the hypothetical applicant’s product. Arguably, the attachment of the TLD to the other descriptive portion of the mark could enhance the prospects of registrability for the mark as a whole. This hypothetical example illustrates that, although **TLDs will most often not add any significant source-identifying function to a mark**, a bright-line rule might foreclose registration of a mark with a TLD component that can demonstrate distinctiveness.

In re Oppedahl, 373 F.3d at 1175, 71 USP2d at 1373 (emphasis added).

In this case, no such exceptional circumstances exist. The non-TLD portion of the mark is unregistrable, and the addition of the TLD does not create a witty double entendre or add any other unique significance capable of identifying source or of acquiring distinctiveness. When combined, the wording and the TLD retain their common meanings - BOOKING indicates the act of making travel and related reservations, and the .COM is merely a TLD indicating it is a commercial entity.

The examining attorney has provided a wealth of evidence indicating the use of BOOKING *descriptively* for Applicant's services, and Applicant has failed to provide **any** evidence to rebut the assertion that the .COM, in this case, does not create a wittiness, a double entendre, etc. such that its addition to BOOKING would constitute one such "exceptional" circumstance as outlined by the *Oppedahl* court. *For example, see additional attached article from Huffington Post, in which the phrases "booking website(s)" and "booking site" are used frequently to describe a host of such sites for Applicant's competitors. "Booking," therefore, is utilized at the very least descriptively for these types of services and to identify such websites broadly, rather than to identify Applicant in particular.* Therefore, consumers are likely to view the entirety of the mark BOOKING.COM as being an indicator of a commercial internet website for booking.

This is, therefore, a prima facie case that the language BOOKING.COM is merely descriptive of Applicant's services and must be disclaimed.

B. IN THE ALTERNATIVE, THE APPLICANT'S 2(F) EVIDENCE IS INSUFFICIENT, AS THE LITERAL ELEMENT OF APPLICANT'S MARK IS GENERIC

The Applicant correctly states that a generic term is one that "does not distinguish the [services] of one producer from the [services] of another. Instead, it is one that either by definition or through common use 'has come to be understood as referring to the genus of which the particular [services] are a species.'" *Applicant's RFR, Page 4-5.*

This is, here, precisely what BOOKING.COM is to the public: a generic designation referring to the genus of services Applicant is, in part, providing via an online commercial website.

The Applicant has made four arguments against the finding of BOOKING.COM as generic for their services, and the examining attorney addresses them hereafter.

1. **Applicant's services are not properly classified as booking services**

The Applicant notes that the genus of Applicant's services are "travel agency services" and include a broad array of such services in person and online. They then proceed to list out examples of such services, conveniently omitting the services which do, in fact, reference reservation services.

To be found generic, it is **not necessary** for the wording to describe *all* services being provided. For example, in the case *re 1800Mattress.com IP, LLC* [586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009)], the court found MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding." The fact that "beds and bedding" were among the goods being sold (that is, it was not *just* for mattresses) did not impact the legal conclusion drawn by the court. Because MATTRESS was generic for *some* of the goods being sold through the online retail store services, this was sufficient for a finding of genericness.

Further, in the case *In re Hotels.com, L.P.*, [573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009)] the court found HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." It *did not matter* that the sole service of the applicant was not the provision of information about *hotels*, but was sufficient that the word HOTELS was generic for a *type* of temporary lodging about which such reservations and booking services could relate.

Thus, the genus of Applicant's services being "travel agency services" does *not* render the mark distinctive and non-generic. Rather, because *making reservations for transportation*, for example, is considered a **type** of travel agency service of which BOOKING is the generic name, this is sufficient for this language to be found generic of this genus of services. The Applicant acknowledges that the reservation service is a form their genus of services takes by the phrasing of their very identification, "travel agency services, **namely, making reservations for transportation.**"

Thus, in keeping with the HOTELS.COM case, BOOKING.COM would likewise be the generic name for the Applicant's genus of services, as booking *is* a travel agency service. There was far *less* relation between the mark at issue and the services it was deemed generic for in HOTELS.COM, where it was considered the *subject matter* of the booking/reservation services identified in the application. Here, Applicant has *listed* the verbatim services which would be described as booking/reservation services *in* their identification.

Nor does focusing on such services constitute "pigeon-holing" any more than the two aforementioned cases would, in which MATTRESS was *also* generic for bedding and beds.

It is unclear, from Applicant's arguments, *why* they do not believe their listed services constitute reservation services. The following language, in particular, appears to have no *other* conceivable description:

"Travel agency services, namely, **making reservations** for transportation; travel and tour ticket **reservation services**; travel agency services, namely, **making reservations** for transportation for tourists; provision of travel information; providing **consultation related to making reservations** for transportation, and travel and tour ticket reservation; all of the foregoing services rendered in-person and via the internet"

"**Making hotel reservations** for others in person and via the internet; providing personalized information about hotels and temporary accommodations for travel in-person and via the Internet; providing on-line reviews of hotels; **consultation services related to making hotel reservations** for others, provision of personalized information about hotels and temporary accommodations for travel, and on-line reviews of hotels"

“Reservation services” clearly constitute and include booking such reservations – and Applicant explicitly states “reservation services” and “making reservations” among the listed services being provided. See also, for example, the two attached third party websites:

- Genares Worldwide Hospitality Distribution and Reservation Services (which includes links to booking engines)
- InnLink Central Reservation Services (offering group reservation services, branded internet booking engines, mobile booking engines)

BOOKING is therefore considered a central type of reservation service, even separate and apart from the fact that Applicant explicitly lists “making reservations” among its services. BOOKING is defined as “an act of reserving accommodations, travel, etc., or of buying a ticket in advance.” *See Office Action of March 23, 2012, Attachment 1.* Therefore, for travel agency services which are defined by the Applicant as *making reservations for transportation, etc.*, the term BOOKING.COM is generic of this genus of services.

2. The burden of “clear evidence” that the mark is generic has not been met

The Applicant, though failing to note the examining attorney’s previously submitted dictionary evidence of the primary definition of BOOKING as “an act of reserving accommodations, travel, etc., or of buying a ticket in advance” (*see Office Action of March 23, 2012, Attachment 1*) further argues that the evidence submitted across all office actions is insufficient to determine that the term sought to be registered is understood by the relevant public primarily to refer to the travel agency services of reserving and “booking” such reservations on behalf of consumers.

The applicant, however, is incorrect that the relevant standard is that the public must utilize the **precise phrase** BOOKING.COM in common vernacular in order for it to be generic. As .COM is a TLD with no source identifying significance and, as previously discussed, does not create a double entendre or secondary meaning apart from its TLD significance, it is sufficient here that BOOKING **standing alone** be utilized generically with respect to Applicant’s services by the purchasing public. The relevant standard for genericness is not use of the identical mark **and** top level domain in a single rendition. It is sufficient that the term argued as generic, BOOKING, be found such for this genus of services, and that the addition of .COM does not alter or render unique/creative the commercial impression created by the wording as a whole. (Applicant is advised, again, to note the similarities with the HOTELS.COM case, in which the requisite evidence that established genericness was *never* that consumers would have ever

referred to the mark in whole as HOTELS.COM generically in conversation or business. This would be a virtually unreachable standard given top level domains are not customarily spoken when discussing services.)

Applicant's argument about the mark being examined in its entirety does not *change* the standard for genericness of a **literal element**. The literal element, BOOKING.COM, can be disclaimed separate and apart from the design element. Its meaning, and the genericness of the *literal words*, is not altered by the addition of a design element. Further, Applicant's desire that the mark be considered as a whole **undermines** their claims that consumers would not immediately know what definition or type of "booking" is being referred to, as the accompanying image of the globe and travel bag *emphasize* the travel/lodging reservation definition through association.

Further, the applicant's insistence that the examining attorney has not correctly examined the mark as a whole is misguided. Evidence of examination of the proposed mark "as a whole" is plainly set forth throughout the application record. Although the examining attorney's review of the proposed mark has reached a conclusion with which applicant disagrees, it does not follow that no consideration of the entire proposed mark has been made. In this regard, and despite applicant's insistence that its mark be regarded as a full phrase, the examining attorney has correctly considered the combination of "BOOKING" and the TLD ".COM" as a "compound word" for purposes of a genericness analysis. *See In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB June 11, 2002); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1792 (TTAB 2002).

When a term is a compound word, the examining attorney may establish that the term is generic by producing evidence that each of the constituent words is generic or otherwise possesses no trademark significance, and that the separate words retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d at 1111. This precise formula has, as noted above, been analyzed and followed, and both BOOKING and .COM are argued as generic, and without any double entendre or novel meaning arising from their joining.

It is relevant, here, to note the relevant consumers of Applicant's various travel agency and reservation services, which would be those individuals who travel and vacation and therefore would require tickets for transportation, lodging, etc. to facilitate such trips.

Among such individuals, as displayed by the vast breath of previous printouts showing the generic use of *booking* referring to such services from **other companies and third parties** (demonstrating it has always been, and always shall, as a term belong in the public domain), the word BOOKING is generic for Applicant's genus of services, that is, the **specific** travel agency services which Applicant has enumerated, nearly all of which are defined as the making, or consultation for making, reservations related to travel and lodging.

Therefore, the examining attorney has, by clear evidence of use of the term generically by the relevant public, and thus their obvious perception of such a term as *being* generic for such services, established a case for the genericness of the literal element BOOKING.COM.

Applicant's reference to Amazon.com is irrelevant, since the company in question is not attempting to register a generic term for their goods/services. The ".COM" in the mark is not being "ignored" – it is simply, as a matter of law for determining genericness, only taken into account legally when it is serving as something *more* than merely the top level domain attached to a generic term (as in the TENNIS.NET case, previously referenced. *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1372-74 (Fed. Cir. 2004).)

Further, it was well established in the HOTELS.COM case that the dot-com domain designation does not impart registrability to a generic term. Applicant's argument, that the dot-com component of BOOKING.COM negates any generic nature of the word "booking," is *precisely the same argument* which the TTAB expressly rejected in their HOTELS.COM decision, and noted that the combination of HOTELS and .COM did not produce a new meaning in combination, and thus did not avoid genericness. Specifically, the Board noted that HOTELS.COM is properly viewed in the same way and having the same meaning as the word "hotels" by itself. *In re Hotels.com*, 87 USPQ2d at 1105.

The TTAB found that the composite term HOTELS.COM communicates no more than the common meanings of the individual components, that is, that the applicant operates a commercial website via the internet, that provides information about hotels, but adds nothing as an indication of source. *Id.*; see also, e.g., *In re Gould Paper Corp.*, 834 F.2d 1017, 1018 (Fed.Cir.1987) (holding that the compound term "SCREENWIPE" is generic as applied to wipes for cleaning monitor screens).

Further, Applicant's attempt to deflect the competitive need for BOOKING misstate the law. It would not be necessary for purposes of likelihood of confusion that the full trademark BOOKING.COM be utilized by a competitor in their trademark on *identical services* in order for confusion to be found likely. As it is

well established that the .COM possesses no source identifying significance, it would be potentially sufficient that the dominant portion of Applicant's literal mark – BOOKING – be utilized in a successively filed application in order for confusion to be potentially found likely given this is the *whole* of the literal element of Applicant's mark.

And there are, as shown attached, numerous current registrations which utilize the term BOOKING within their registered trademarks, demonstrating a substantial competitive use and competitive need for the term. *See attached registrations, Bookingbuddy, Bookingmarkets, Bookingwiz.com, Flexible Booking, LookingforBooking, Booking frog, Booking Hub, Booking.yeah, and Gurubooking, and Ebooking.com. (And the examining attorney notes that EBOOKING.COM has a design element, and was registered with the whole of EBOOKING.COM disclaimed, making it highly analogous to the instant case.)*

Just as BOOKING is disclaimed wherever not unitary, and otherwise highly commonly utilized, it is established that it is generic and necessary for competitive use.

3. The Authorities Relied Upon by the Examining Attorney are distinguishable

The applicant argues that, *purely* because BOOKING may have multiple meanings, this sufficiently distinguishes it from all precedential and .COM cases relied upon by the examining attorney.

As already discussed previously, the Applicant impermissibly dissects their mark by claiming that a consumer could conceivably perceive the mark as referring to *any* of these other purported meanings. Specifically, the mark is **not** merely a wordmark, but is accompanied by imagery of a globe and travel bag which explicitly and singularly call to a consumer's mind the prospect of *travel bookings*, not either entertainment, criminal, etc. bookings.

It is therefore *not* the least bit ambiguous with respect to the Applicant's services. Rather, it is the generic term for a reservation of the type Applicant offers in its services.

Further, for example, CONTAINER has more than one meaning – a consumer encountering the word *in isolation of that applicant's services* may instead have perceived it to mean storage containers of the sort for food, beverage, etc. as these are all likewise referred to as *containers* – and indeed, much more frequently in common useage than it would be used to refer to metal shipping containers, which are the *second* sub-set definition rather than its primary understanding. Even so, because the mark is examined *in reference to the services* rather than in the abstract, it was sufficient for the TTAB in that case that **one** meaning of container be considered generic for the services, which were “retail store services and retail services offered via telephone featuring metal shipping containers” and “rental of metal shipping containers.” *See attached definition.*

Similarly, the words BLINDS and DRAPERIES have more than one meaning. BLINDS can mean to deprive of sight, can be a plural for “blind” which is a type of window covering, or can be a plural of the word BLIND which can be a hiding screen used by hunters to conceal themselves from animals outdoors. *See attached definitions.* DRAPERY can refer either to “cloth coverings hanging in loose folds,” “long curtains of heavy fabric,” or “artistic arrangement of clothing in sculpture or painting.”

Therefore, once again, multiple meanings were available but the court found it sufficient that there was a meaning *with respect to the services at issue* which was generic and therefore incapable.

The *primary* definition of a booking is a reservation for travel, etc. *See attachments of multiple definitions.* This is reinforced by the design elements of Applicant's own mark, thus a consumer would be highly likely to associate it as a travel reservation use of the term BOOKING.

Applicant's heavy reliance upon STEELBUILDING.COM is therefore misguided; in that case, *steel building* is not the *generic name* for the services being provided. Here, however, a BOOKING or travel reservation IS the generic name for one of the services the applicant is providing (making reservations for transportation; travel and tour ticket reservation services; travel agency services, namely, making reservations for transportation for tourists; providing consultation related to making reservations for transportation, and travel and tour ticket reservation; all of the foregoing services rendered in-person and via the internet” and “Making hotel reservations for others in person and via the internet; providing personalized information about hotels and temporary accommodations for travel in-person and via the Internet; providing on-line reviews of hotels; consultation services related to making hotel reservations for others, provision of personalized information about hotels and temporary accommodations for travel, and on-line reviews of hotels). The applicant attempts to claim that BOOKING is not generic for the broad identification of “travel agency services,” but this is **not** how Applicant's identification reads. In all cases, “travel agency services” has been *blatantly narrowed* to particular services through the use

of “namely” and the addition of *reservation services* with particularity. Thus the applicant cannot claim it is identifying broad travel agency services when, instead, they have explicitly narrowed to services for which BOOKING is the generic category.

Applicant’s reliance on the STEELBUILDING.COM case is further improper, as the Court there held that the mark was not properly considered generic because the services, identified vaguely as “retail services,” could not be limited to the genus of selling steel buildings. *Id.* at 1422. The court also noted that the combination of STEEL and BUILDING could be interpreted both as a generic reference to steel buildings as well as a non-generic reference to “the building of steel structures.” *Id.* The applicant’s *identified services* also encompassed online software tools whereby consumers could custom design buildings for purchase. Based on this interpretation, the court also concluded that the addition of the suffix “.COM” provided source-identifying significance to the extent it expanded the meaning of the mark to reflect online building design aspects of the applicant’s identified services. *Id.* at 1424.

This is not the case here. Applicant’s identification of services also is not open to interpretation as to the actual nature of the services provided. Unlike the “retail services” discussed in the cited opinion, applicant’s services are clearly *booking services* in sundry forms.

Nonetheless, applicant argues that the presence of additional services and capacities on its website necessarily alter the connotation of the proposed mark. As indicated, the test to determine whether a proposed mark is generic turns upon the primary significance that the term would have to the relevant public. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Applicant’s inclusion of additional services still *related to and considered a type of booking service* does not alter the **primary** nature of its services.

Therefore, the wording BOOKING.COM in applicant’s broader design mark does *not* offer some broader interpretation of Applicant’s services, but rather identifies Applicant’s predominant purpose of business – travel and lodging *booking services*.

4. Similarly Situated Marks Have Been Found Registrable

The Applicant attempts to point to other registered marks as proof that their own wording is sufficiently distinctive to be registered without a disclaimer of BOOKING.COM.

It is well established law that the fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issues of descriptiveness and/or genericness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is descriptive or generic does not **become** registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving **different** records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Lean Line, Inc.*, 229 USPQ 781, 783 (TTAB 1986); TMEP §1209.03(a). The question of genericness is determined based on the evidence of record at the time each registration is sought.

This is because it would be impossibly burdensome for such cases to, essentially, be *re-examined* in order to determine why the instant mark is distinguishable from those which came before.

For example, WORKOUT.COM, one of Applicant's cited cases which is purportedly evidence that Applicant's mark should be allowed without a disclaimer was for "computerized on-line retail store services via a global computer network in the field of exercise programs, exercise equipment, and supplements, namely, dietary, food, herbal, mineral, nutritional and vitamin supplements."

Therefore, contrary to Applicant's mark BOOKING.COM for the offering of *booking* services, the Registrant in this case was utilizing WORKOUT.COM for a broad array of retail store services, none of which were the offering of *workouts*.

The individual circumstances of all such cases cannot be reexamined in all cases to determine why they were allowed. Instead, it is the prerogative of the examining attorney and, eventually, the TTAB to determine **this particular case** beneath its own facts and record.

Further, the examining attorney is not – contrary to applicant’s impassioned explanation on Page 18 of their brief – attempting to render Applicant’s “loyal users” bereft of the services and quality to which they are accustomed. However, it is well established law that *no* amount of expenditures or marketing can render generic language registrable, therefore it is not within the scope of the examining attorney’s capacity to allow registration purely based upon appeals to sympathy.

5. Applicant Cannot Prove Acquired Distinctiveness of a Generic Mark

The Applicant has argued, in the alternative to BOOKING.COM not requiring a disclaimer to begin with, that they have provided sufficient evidence under Section 2(F) of acquired distinctiveness of the mark.

At the outset, as the applicant cites to a previous but *different* mark in use, as well as a Supplemental Registration of a *different* mark, it is worth noting that the sole relevant factor is evidence of the duration of use of BOOKING.COM itself. It is clear that it must legally be the *same mark* which is being used previously, and for which other registrations have issued, in order for it to bear on a claim of 2(F). *TMEP 1212.09(a)*, “[A]pplicant must establish, through the appropriate submission, the acquired distinctiveness **of the same mark** in connection with specified other goods and/or services.” 37 C.F.R. §2.41(b); 37 C.F.R. §2.41(b).

Likewise, an applicant may not base a claim of acquired distinctiveness under Trademark Act Section 2(f) on ownership of a registration on the Supplemental Register. *In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983); *TMEP* §1212.04(d).

Applicant has provided evidence of high sales figures and significant advertising expenditures for the services at issue; however, such evidence is not dispositive of whether the proposed mark has acquired distinctiveness. Such extensive sales and promotion may demonstrate the commercial success of applicant’s services, but not that relevant consumers view the matter ***as a mark*** for such services. *See In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Busch Entm’t Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

Similarly, applicant's advertising expenditures are merely indicative of its *efforts* to develop distinctiveness; not evidence that the mark has acquired distinctiveness. See *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). The evidence of followers on social media and of unsolicited media coverage may flout the quality and provision of applicant's services, but this does not preclude a finding that the term sought to be registered is still generic. Numerous of the cases the examining attorney has cited to have demonstrated advertisement/media proof, consumer recognition surveys, etc. See, for example, *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network;" during which case the Applicant submitted over 60 declarations from customers, vendors, competitors, etc. in support of public recognition, as well as the survey responses of 277 consumers and the percentage of which had perceived HOTELS.COM as a brand name).

However, in all cases, *because* the mark sought to be registered was a generic term attached to .COM, such consumer recognition and expenditures were not found sufficient, nor were statistics of usage by such consumers.

Finally, BOOKING is simply too deeply rooted a term of art in the travel industry for applicant to acquire distinctiveness in BOOKING.COM and thereby receive such a broad claim of use on a term which had so high a competitive need. "Hotel booking" and "travel booking," and the term booking itself, are utilized widely and are not associated with a particular service or source of such services. See *attachments from Google*. It is a term of art in the travel reservation and lodging reservation industry, and its sole usage cannot be granted to a single applicant.

CONCLUSION

In conclusion, the examining attorney notes that 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. *Bd. of Trs. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970)); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010); see TMEP §1212.05(a).

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013).

However, it is widely accepted as established that **no** amount of purported proof that a **generic** term has acquired secondary meaning can transform that term into a registrable trademark or service mark. *See In re Bongrain Int'l (Am.) Corp.*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1212.02(i).

Particularly in a marketplace which demonstrates an overwhelming competitive use and need for the generic term BOOKING, and the dozens of websites and marks which *already* utilize this term in their own marks, domains and business, there is both a legal and an overwhelming public interest in preserving this generic term for broad usage.

As a result, in sum, the required disclaimer of BOOKING.COM is not withdrawn, 2(F) evidence to prove acquired distinctiveness of a generic mark is insufficient, and the request for reconsideration is therefore DENIED for the aforesaid reasons.

/Caitlin Watts-FitzGerald/

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