ESTTA Tracking number: **ESTTA655160**
Filing date: **02/10/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85485097
Applicant	Booking.com B.V.
Applied for Mark	BOOKING.COM
Correspondence Address	JONATHAN E MOSKIN FOLEY & LARDNER LLP 90 PARK AVE NEW YORK, NY 10016-1314 UNITED STATES IPdocketing@foley.com, jmoskin@foley.com, kcalifa@foley.com, sschoep-fer@foley.com
Submission	Appeal Brief
Attachments	CONSOLIDATED APPEAL BRIEF.pdf(695072 bytes)
Filer's Name	Jonathan E. Moskin
Filer's e-mail	IPdocketing@foley.com, jmoskin@foley.com, kcalifa@foley.com, sschoep-fer@foley.com
Signature	/Jonathan E. Moskin/
Date	02/10/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re , **Serial No. 85/485,097**
Filed by Booking.com B.V. on Dec. 1, 2011
Examining Attorney: Caitlin Watts-Fitzgerald, Law Office 111

In re: **BOOKING.COM, Serial No. 79/114,998**
Filed by Booking.com B.V. on June 5, 2012
Examining Attorney: Sharon A. Meier, Law Office 112

In re: **BOOKING.COM Stylized letters, Serial No. 79/122,365**
Filed by Booking.com B.V. on November 7, 2012
Examining Attorney: Nelson B. Snyder III, Law Office 107

In re: **BOOKING.COM Design and Stylized letters, Serial No. 79/122,366**
Filed by Booking.com B.V. on November 7, 2012
Examining Attorney: Nelson B. Snyder III, Law Office 107

CONSOLIDATED APPEAL BRIEF

This is a consolidated appeal of the trademark Examiners' refusal to register the trademarks BOOKING.COM, Serial No. 79/114,998; BOOKING.COM with Globe and Suitcase Design, Serial No. 85/485,097; BOOKING.COM in Stylized Letters, Serial No. 79/122,365, and BOOKING.COM in Stylized Letters, Serial No. 79/122,366 (collectively, the "BOOKING.COM Marks") on the ground that "BOOKING.COM" is generic within the meaning of Section 2(e)(1) of the Trademark Act or, in the alternative, that the mark is descriptive and has not acquired distinctiveness.

INTRODUCTION

Applicant offers the top-rated and "most trusted" accommodations site in the United States under the mark BOOKING.COM. Applicant has applied to register BOOKING.COM (word mark), Serial No. 79/114,998; BOOKING.COM with a Design, Serial No. 85/485,097;

BOOKING.COM in Stylized Letters, Serial No. 79/122,365 and BOOKING.COM in Stylized Letters, Serial No. 79/122,366 for a variety of travel related services.[1]

The application for BOOKING.COM and Design, Serial No. 85/485,097, was initially approved for publication on the Principal Register on October 13, 2012 based on acquired distinctiveness as to "BOOKING.COM." (Ser. No. '097, PTO Action dated Oct. 16, 2012). However, the application was then withdrawn from publication and a disclaimer of BOOKING.COM was required. (Ser. No. '097, PTO Action dated Nov. 28, 2012).

The central questions on appeal are whether the mark BOOKING.COM is capable of functioning as a trademark and, if so, whether the mark has acquired distinctiveness. Applicant submits that unless the legal concept of "genericness" is fundamentally redefined and deprived of all meaning, the answer to both questions must be yes. Applicant further submits that the

---

[1] Serial No. 85/485097 covers Class 39: 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; Class 43: 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.; Serial No. 79/114,998 covers Class 39: Arranging of tours and arranging of tours online; reservation and sale of travel tickets and online reservation and sale of travel tickets; information, advice and consultancy regarding the arranging of tours and the reservation and sale of travel tickets; provision of information relating to travel and travel destinations; travel and tour agency services, namely, travel and tour ticket reservation services; travel agency services; tourist agency services; providing online travel and tourism services, namely, providing online travel and tour ticket reservation services, online travel agency services, online tourist agency services and providing online information relating to travel and travel destinations; Class 43: Making hotel reservations 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, holiday accommodations and resorts accommodations, whether or not based on the valuation of customers; providing information, advice and consultancy relating to making hotel reservations and temporary accommodation reservations; providing online information, advice and consultancy relating to making hotel reservations and temporary accommodation reservations. Serial No. 79/122366 covers 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 Serial No. 79/122365 covers 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.

examiners have failed to address (and also misconstrued) controlling law; have taken fundamentally contradictory positions to one another; have failed to carry their own factual burdens; and have failed to address the facts and legal arguments presented by Applicant.

Booking.com is the ***consumer-ranked*** most trusted accommodations website in the United States. (Ser. No. '366, Resp. dated May 15, 2014, pp. 84-94).[2] It defies logic that consumers would rank BOOKING.COM as the most trusted accommodations website if consumers failed to recognize BOOKING.COM as a source-identifier. Stated another way, if BOOKING.COM merely designated a type or category of services, consumers would not be able to attribute any particular level of quality to services offered under the designation. This is plainly not the case, as consumers associate a very high level of quality with the BOOKING.COM brand, resulting in the consumer-ranked award by JD Power & Associates that is of record in this appeal.

Given the stature of the brand among consumers, the purposes of trademark law are advanced by permitting Applicant to protect its great investment in its mark and to protect consumers against the confusion that would inevitably result if others were free to copy the name. Denying registration to the most trusted brand in the field undermines the purposes of trademark law by betraying the trust consumers place in the brand. In support of this destructive enterprise, the Examiners have been unable to identify even a single use by anyone other than applicant of the name BOOKING.COM. All of Applicant's competitors seem quite able to provide accommodation reservation services under trademarks such as Orbitz, Expedia, Travelocity, Trip Advisor, and others without any need to use the term BOOKING.COM as a

---

[2] The records for the applications at issue in this appeal contain much of the same evidence. For the sake of brevity, Applicant will cite to the record of only one application, when possible. The page citation refers to the page number of the PDF as downloaded from TSDR.

descriptor or as a genus name. In the marketplace, BOOKING.COM uniquely identifies Applicant and its services. As a matter of law (and common sense) there simply cannot be a generic term designating only one thing. It is the very antithesis of genericness.

ARGUMENTS

I. BOOKING.COM IS NOT GENERIC

A. Applicable Law

Genericness is a question of fact. *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1378, 82 U.S.P.Q.2d 1378 (Fed Cir. 2007). The burden to establish the fact of genericness rests squarely on the Examining Attorney. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1576, 1571 (Fed. Cir. 1987). The Examining Attorney must satisfy that burden by **clear evidence**. *Trademark Manual of Examining Procedure* 1209.01(c)(i) (8th Ed., revised April 2013) ("The Examining Attorney has the burden of proving that a term is generic by clear evidence.").

The Supreme Court has explained that to demonstrate whether a claimed mark is generic, the relevant inquiry is whether the "*primary* significance of the term in the minds of the consuming public is not the product but the producer." *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (emphasis added). "A generic term is one that does not distinguish the goods of one producer from the goods of others. 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 product is a species.'" *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 373-74 (1st Cir. 1980) (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)). As Professor McCarthy alternately put it, "A mark answers the buyer's question 'Who are you? Where do you come from? Who vouches for you? But the [generic] name of the product answers

the question 'What are you?'" J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:01 (4th ed. 2014) ("*McCarthy's*").

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 or that is already registered to refer to the genus or category of goods in question." Resolution of the issue "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." *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q.2d 528, 530 (Fed. Cir. 1986). More specifically, the Examiners must show that the "primary significance" of BOOKING.COM "to the relevant consuming public" is simply to designate the genus or class of services identified in the applications (*see* note 3, *supra*). *See, e.g., Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641-42, 19 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1991).

"The salient question is the primary significance of the term <u>to the consumer</u>." S. Rep. No. 98-627, at 5, reprinted in 1984 U.S.C.C.A.N. 5718, 5722 (emphasis added). Hence, primary significance is determined by "the use and understanding of the [mark] <u>in the context of purchasing decisions</u>." *McCarthy's* § 12:8 (4th ed. 2014) (quoting *Restatement (Third) of Unfair Competition*, § 15 cmt. c (1995)) (emphasis added). The Examiners here have presented absolutely no evidence of consumer understanding, in purchasing contexts or otherwise. In contrast, Applicant has presented ample evidence that consumers recognize, use, and understand BOOKING.COM to refer uniquely to Applicant and its services, including a consumer-ranked first place award by JD Power and Associates as the "most trusted" accommodations site in the country, other industry awards, significant interaction between Applicant and customers on

social media, extensive sales, and unsolicited media coverage. (Ser. No. '366, Resp. dated May 15, 2014, pp. 83-130; Resp. dated Oct. 13, 2014, pp. 50-61). Without consumer recognition of BOOKING.COM as a source-identifier, none of the market success enjoyed by Applicant would be possible.

B. Two-Step Inquiry

The Examiners have not explicitly addressed the two-step inquiry required to assess genericness. It is unclear from the Denials of the Request for Reconsideration what any of the Examiners considers to be the genus of services or who are the relevant consumers for this genus.

Applicant submits that the genus of services at issue is "travel agency services." Other generic terms commonly used to refer to on-line travel agency services include "accommodations sites" or "travel sites." The relevant consumers of this genus of services are ordinary consumers who wish to obtain more information about various travel options and purchase or reserve travel related services. The relevant consumers for the business-oriented services, such as providing consulting services in the field of making hotel reservations and temporary accommodations reservations are accommodations providers seeking to advertise and list their accommodations for rental. There is no evidence in the record that this relevant consuming public "use[s] or understand[s] the designation sought to be registered", namely, BOOKING.COM, primarily to refer to travel agency services as such. Moreover, where, as here, there are ample readily available terms for the genus of services, such as "travel agency" (or even "travel site" or "accommodation site"), this is positive evidence the disputed term is *not* generic. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341,1346, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001) ("Telephone shop-at-home mattresses" or "mattresses by phone" more apt generic descriptions); *Elliot v. Google Inc.*, ___ U.S.P.Q. ___, 2014 BL 253506, 2014 U.S. Dist.

Lexis 127352 (D. Ariz. Sept. 10, 2014) ("internet search engine" the genus to which Google belongs), citing *Q-TIPS, Inc. v. Johnson & Johnson*, 99 U.S.P.Q. 183, 108 F. Supp. 845, 863 (1952) (distinguishing the claimed mark, Q-TIPS, from the descriptor, "double-tipped applicator.").

C. Examiners Conflate Descriptiveness with Genericness

In each of the Office Actions, the Examiners have submitted evidence showing descriptive use of "booking" and ".com" *separately* as evidence that the *composite* mark BOOKING.COM is generic. This analytical structure sets a lower bar for genericness for domain name marks than other marks, ignores the realities of the marketplace and is contrary to settled law.

There is no evidence whatsoever that consumers isolate and separately consider "BOOKING" and ".COM" in Applicant's mark any more than they isolate and separately consider the two generic terms "COCA" and "COLA" in the famous mark COCA-COLA. Indeed, trademark law has always required that marks be considered in their entirety. *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920); *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988). Conspicuously, none of the Examiners has ever addressed such controlling law established by the Supreme Court a century ago. For this reason alone, the refusals to register cannot be sustained.

In the closely analogous case, *Dial-A-Mattress*, the Federal Circuit acknowledged that "(888)" was devoid of source-identifying significance and that "MATRESS" was a generic term for "mattresses" yet held that the composite mark "1-888-MATRESS," *when considered in its entirety*, was not generic. *In re Dial-A-Mattress*, 57 U.S.P.Q.2d at 1811. Except for the Denials of the Requests for Reconsideration in connection with Applications Serial Nos. 79/122,365 and 79/122,366 in which the Examiner took a position directly contrary to his own prior analysis and

the analyses of the other two Examiners, the Examiners have scarcely acknowledged Applicant's repeated citations to such bedrock principles that a mark must be considered in its entirety nor attempted to apply or distinguish such fundamental principles from the present case.

BOOKING.COM is consistently presented and marketed as a unitary mark, and no reason has been suggested why ordinary consumers will perceive it as anything but a unitary mark in which the whole is greater than (or at least different from) the sum of its parts. This is readily apparent from the evidence submitted by the Examiners and by Applicant and is obviously true of marks that parallel domain names. (*See, e.g.*, Ser. No. '366, PTO Action dated Nov. 15, 2013, pp. 155-160 and Resp. dated Oct. 13, 2014, pp. 50-61). For instance, "Amazon" is a river (or to classics scholars a tribe of wild women). However, the composite term "Amazon.com" is immediately recognizable as a particular business. So too, "staples" means either basic necessities or small metal fasteners, but Staples.com (Reg. No. 2397238) uniquely refers to an office supply store. The PTO has registered dozens of such marks where an arguably descriptive term is joined with a TLD extension. (*See infra* note 6). Just so, in each and every third party reference to Applicant's mark, BOOKING.COM is treated as a trademark. It is always capitalized or otherwise set apart from surrounding text and it is always used to refer to a single source, namely, Applicant. (*See, e.g.*, Ser. No. '366, PTO Action dated Nov. 15, 2013, pp. 23-25 and Resp. dated May 15, 2014, pp. 99-116). In contrast, when third parties use the word "booking" on its own, they use the term quite differently, as a general descriptive term. *Id.*; (Ser. No. '366, PTO Action dated Nov. 16, 2013, pp. 27-48). That the general public uses BOOKING.COM to mean one thing (Applicant and its services) and uses "booking" to mean other things (such as theatrical engagements or the act of making a reservation (*see infra* note 5 showing the actual dictionary definitions of "booking" in which travel reservations are not even

the primary meaning)) – often within the same article or advertisement – is *prima facie* evidence that the consuming public does not consider the two designations to be equivalent and that the relevant consumers perceive Applicant's mark as a source-identifier.

In this regard, the Examiners misconstrue *Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 U.S.P.Q.2d 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 of the whole. To the contrary, the Federal Circuit specifically relied on *Estate of P.D. Beckwith* in explaining:

> 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 noted 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 U.S.P.Q.2d 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 Examiners perform only *half* of the task by never even considering the mark as a whole, much less attempting to assess the primary significance of the entire term to relevant consumers. All of the evidence is directed to the alleged genericness of "BOOKING" as a standalone term. Moreover, the examiners conflate the meaning of the legal category of mere descriptiveness, which was at issue in *Oppedahl & Larsen*, with genericness. 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 or recognized by consumers to designate a genus of goods or services *and* that the *primary significance* of such usage is the generic designation. As stated by the Federal Circuit, "Like the title 'Fire Chief' for a magazine in the field of firefighting, a phone number is not literally a genus or class name, but is at most descriptive of the class." *In re Dial-A-Mattress*, 57 U.S.P.Q.2d at 1811. Likewise, the domain name BOOKING.COM is not literally a genus or class name, but at most contains elements descriptive or suggestive of the class.

There is a world of difference between a generic term and a descriptive term, yet the Examiners never acknowledge there is any difference whatsoever and never purport to analyze the genericness or not of the entire applied-for mark, BOOKING.COM. The refusals are thus contrary to the PTO policy explained in *Oppedahl & Larsen*, and contrary to a century of precedent that a mark must be viewed in its entirety.

Until the Denials of the Requests for Reconsideration in Applications Serial Nos. 79/122,365 and 79/122,366, dated November 4, 2014, the Examiners here never once even

mentioned the bedrock rule that trademarks must be viewed in their entirety. Even in these final two office actions, however, the Examiner's position is fundamentally at odds with his own prior position and the position of the other two Examiners who entirely ignore the requirement that a mark be viewed in its entirety; and is, of course, inconsistent with the first Examiner in these cases, who approved the mark for publication! (Ser. No. '097, PTO Action dated Oct. 13, 2012).

Examiner Snyder relies primarily on *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), in which the court overruled the TTAB and found the mark 1-888-MATTRESS was *not* generic for reasons directly applicable here. In *Dial-A-Mattress,* the Federal Circuit specifically relied on *Estate of P.D. Beckwith* (a controlling case never mentioned by any of the Examiners) in concluding as follows: "Analyzing the '1-888-M-A-T-R-E-S-S' mark as a whole, substantial evidence does not support the conclusion that the mark is generic. There is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as '1-888-M-A-T-R-E-S-S.,'" 57 U.S.P.Q.2d at 1811, citing *H. Marvin Ginn Corp.*, 782 F.2d at 991, 228 U.S.P.Q.2d at 532.

In re Dial-A-Mattress did discuss *In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987), also cited by Examiner Snyder. There the Board held the term "Screenwipe" was generic for wipes for computer screens because "the ordinary grammatical construction" of the combined term did not differ regardless how the terms were arranged. *In re ActiveVideo Networks, Inc.*, 111 U.S.P.Q.2d 1581, 1602-03 (TTAB 2014), also cited by Examiner Snyder, likewise held that CLOUDTV formed a grammatically coherent phrase and hence was generic. However, distinguishing *In re Gould*, the Federal Circuit explained in *Dial-A-Mattress*:

> *In re Gould* does not apply here because "1-888-M-A-T-R-E-S-S" — a mnemonic formed by the union of a series of numbers and a word — bears closer conceptual

> resemblance to a phrase than a compound word. *See In re The Am. Fertility Soc'y*, 188 F.3d at 1348-49, 51 U.S.P.Q.2d at 1837 (explicitly limiting the holding of *In re Gould* to "compound terms formed by the union of words"). It is devoid of source-indicating significance, but "(888)" is not a word and is not itself a generic term for selling by telephone.

As a matter of law, *In re Gould* does not apply here. Consistent with *Dial-A-Mattress*, and indeed, consistent with *Oppedahl & Larsen*, ".com" is not a word in the English language and is not itself a generic term for travel agency services or any of the other services offered by Applicant. Rather, ".com" is a combination of a punctuation mark and three letters. It is a now-familiar reference to one top level domain, but it is first and foremost an addressing tool in the DNS computer language, not a word in the English language. Precisely because (as recognized in *Oppedahl & Larsen)*, the TLD designation ".com" is not a word but has a specific technical meaning and function as a referent to a single unique address, unlike the terms CLOUDTV and SCREENWIPE, that can be used in a grammatically coherent fashion to refer to any number of cloud-based television services or wipes for computer screens, it is *impossible* to use BOOKING.COM in a grammatically coherent way to refer generically to anything. Indeed, there is not a single piece of evidence that any consumer ever has used the term in such a manner. As Applicant repeatedly has observed, ordinary consumers would never say "I called my 'booking.com' to get a reservation" or "I logged on to my 'booking.com' to find a hotel." Such usage is, of course, grammatically nonsensical. This is precisely why the Examiners' analogy to the SCREENWIPE and CLOUDTV cases fails. While it may be grammatically logical to refer to a type of product or service as "a screen wipe" or "a cloud TV" – and indeed, the records in both cases included examples of such uses by the relevant consuming public – it is not at all logical to refer to a type of product or service as "a booking.com." A consumer might say "I called BOOKING.COM to get a reservation" or "I logged on to BOOKING.COM to find

a hotel," but such grammatically intelligible speech would be proper trademark usage in reference to the one and only accommodations service using this name.

No precedent has been cited extending the logic of *In re Gould* to a domain name mark. If there had been, it would be impossible for the PTO to have registered any of the dozens of such marks it has registered (see *infra*, note 6). To the contrary, as in *In re Dial-A-Mattress*, where the Federal Circuit explained that "'Telephone shop-at-home mattresses' or 'mattresses by phone' would be more apt generic descriptions," 57 USPQ2D at 1811, here, "travel agency service," "accommodations site" or "travel site" would be more apt generic descriptions.

Applicant further questions the logical basis of extending *In re Gould* beyond the facts of that case. Genericness is a question of fact. *In re Reed Elsevier Props., Inc.*, 482 F.3d at 1378. Although it may be appealing to create legal theories as shortcuts to simplify findings of genericness, the Supreme Court has established that ultimately the test is what do *consumers* understand as the primary meaning of the term. *Kellogg Co.*, 305 U.S. at 118. A court simply cannot establish a legal rule, in advance, that purports to determine how consumers will understand heretofore unknown combinations of words (or in this case, a word and a DNS address). As Judge Markey famously noted, "[t]he public is both unaware of, and distinctly disinterested in" decisions by the USPTO. *In re Clorox Co.*, 578 F.2d 305, 308 (C.C.P.A. 1978). If such a broad test as that laid out in *In re Gould* could replace facts, the famous trademark COCA-COLA would have to be cancelled, as it is simply a combination of two generic terms and "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." However, that broad test would ignore the realities of the marketplace in which COCA-COLA functions as a strong trademark.

Unless and until the Supreme Court reverses *Kellogg Co.*, consumer understanding of the primary significance of a mark remains the test.

The Examiners' positions that BOOKING.COM is generic requires fundamentally redefining the term "generic" – both as a matter of law and language. Just as the Federal Circuit recognized in *In re Dial-A-Mattress* that a phone number can reach only one entity and, thus, the claimed mark, 1-888-MATTRES can identify only one source, so, too, a specific URL can identify only one entity. 57 U.S.P.Q.2d at 1811. For this very reason, there is only one "Booking.com" and it identifies only one entity: Applicant and Applicant's services. Because a generic term, by definition, identifies a *class* or *genus* of goods or services, a term such as BOOKING.COM that is capable of pointing to one, and only one, thing cannot be generic. It is the very antithesis of genericness.

The applied-for mark BOOKING.COM creates a unique and separate commercial impression from the word "BOOKING" alone. This is borne out again and again in the evidence submitted by the Examiners themselves and by Applicant: consumers use and recognize Applicant's mark solely to refer to Applicant and its services, but they use the term "booking" alone to refer to a variety of reservation services. Because of the inherent ambiguity of the word, even when the word "booking" is used for travel reservations (in the evidence submitted by the several Examiners) it is all-but uniformly accompanied by other descriptive language, such as "travel booking" or "hotel booking" or the like. (Ser. No. '366, PTO Action dated Nov. 16, 2013, pp. 15-49). Therefore, even if the top level domain ".COM" is not considered source-identifying indicia *per se,* it does contribute to a distinct overall commercial impression such that the relevant public perceives BOOKING.COM as fundamentally different from "booking" alone.

There is not a single piece of evidence in the record showing BOOKING.COM used by the relevant consumers to refer to an entire category or type of service offered by Applicant; there is no dictionary definition of BOOKING.COM; nor is there a single piece of evidence of use of the supposed generic term 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. Consumers refer to and call for Applicant's services by the mark BOOKING.COM (not "booking" alone), demonstrating recognition of Applicant's mark as a source-identifier. (Ser. No. '366, Resp. dated May 15, 2014, pp. 87-116 and Resp. dated Oct. 13, 2014, pp. 50-61). 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, repeated across related brands.[3] (Ser. No. '366, Resp. dated Oct. 13, 2014, pp. 50-61).

The Board has recognized that even a punctuation mark can materially alter the meaning of a term. *See Guitar Straps Online, LLC*, 103 U.S.P.Q.2d 1745 (T.T.A.B. 2012) (finding that the addition of a question mark to the mark GOT STRAPS changed the commercial impression of the mark as a whole). Even if the word "booking" alone were assumed (for argument's sake) to be entirely descriptive and ".com" were deemed not to add one iota to the distinctiveness or trademark significance of the term, this is not sufficient, in and of itself, to hold that the combined mark lacks the capacity to distinguish Applicant's services, because BOOKING.COM plainly has a different meaning and commercial impression than "booking" alone. The question posed in genericness cases, as stated in *Marvin Ginn*, is: "What do the buyers understand by the

---

[3] Examiner Snyder repeatedly argues, incorrectly, that Applicant has somehow conceded that its mark is generic. This is simply not true. In its September 17, 2013 response in Ser. No. '366, Applicant argued that it should be permitted to "tack on" its prior use of BOOKINGS.NL to establish acquired distinctiveness in BOOKING.COM. In any event, Examiner Snyder rejected this argument in the Office Action dated November 16, 2013. Examiner Snyder rejected the argument that BOOKING.COM and BOOKINGS.NL are legal equivalents and Applicant never conceded or meant to suggest its mark could be reduced to the word "BOOKING" or ("BOOKINGS") alone.

word for whose use the parties are contending." In this regard, the *specific* word claimed as a mark must be assessed. *Timelines Inc. v. Facebook Inc.,* 108 U.S.P.Q.2d 1993, 938 F. Supp. 2d 781 (N. D. Ill. 2013) (generic use of the word "timeline" did not render generic actual trademark TIMELINES). The actual term Applicant is seeking to register is BOOKING.COM not "Booking." If buyers do not understand the difference between the noun "booking" or the verb "to book" and the internet site and trademark BOOKING.COM, Applicant could not likely remain in business, let alone be America's top-rated accommodations site.

In *In re Festival of Vitamins, LLC*, Serial No. 85/33160 (TTAB 2013) (non-precedential), 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 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 U.S.P.Q.2d 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 Examiners in this case shows inconsistent use of the words at issue, such as use of "travel booking," "travel-booking," "hotel-booking," "booking sites," and the like, which undermines the contention that the primary significance of the mark BOOKING.COM is generic. There is simply no evidence of any use of BOOKING.COM except use by or referring to Applicant. Further, any use of "booking" to refer to travel reservation services is modified by other wording. There is no evidence whatsoever of third parties - much less the relevant class of consumers - using the applied-for mark BOOKING.COM to refer to any service other than those offered by Applicant.

Even if BOOKING.COM is an apt name for a travel agency service, it is not the **generic** name for that service. The Federal Circuit 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 U.S.P.Q.2d 1832, 1836 (Fed. Cir. 1999); *see also In re Country Music Ass'n Inc.*, 100 U.S.P.Q.2d 1824, 1828 (TTAB 2011). Likewise, the record in this case is replete with examples of actual generic terms for Applicant's services, e.g., Online Travel Sites, Accommodation Sites, Hotel Search, Online Hotel Reservations, Central

Reservation Services, and the like.[4] (Ser. No. '998, PTO Action dated July 20, 2014, pp. 34 *et seq*.). There is simply no evidence that BOOKING.COM bridges the gap between an apt name for travel agency services and the generic name for that service. All the evidence is to the contrary.

In enacting the Lanham Act in 1946 Congress recognized the two purposes served by protecting trademarks: (1) "to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get"; and (2) "where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats." S. Rep. 1333, at 1 (1946), reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1274. The Supreme Court likewise has explained the basis for trademark protection:

> "[B]y preventing others from copying a source-identifying mark," trademark law "reduce[s] the customer's costs of shopping and making purchasing decisions, * * * for it quickly and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past."

Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 163-164 (1995) (brackets in original; citation and internal quotation marks omitted). In clarifying the meaning of the term "generic" forty years after initial enactment of the Lanham Act, Congress again confirmed:

> Because of their importance to our nation's commerce, trademarks long have been protected from appropriation and misuse by others, both to protect the consumer

---

[4] The Examiners have submitted evidence of articles using phrases such as "online travel booking sites" to support the proposition that BOOKING.COM is generic. Even in these types of articles, the authors distinguish between descriptive use of "booking" alone and Applicant's mark BOOKING.COM. For example, one such article states: "We're starting 2014 by looking at the top online booking sites in travel . . . Booking.com is still the king in travel, by a large margin, over Expedia and TripAdvisor." (Ser. No. '998, PTO Action dated July 20, 2014, pp. 24-25). This plainly shows that the relevant public distinguishes between use of "online booking sites" and BOOKING.COM and does ***not*** perceive BOOKING.COM as designating a generic category or type of service.

> from deception and confusion and to insure that producers are rewarded for their investment in the manufacture and marketing of their product.

S. Rep. No. 98-627, at 2, reprinted in 1984 U.S.C.C.A.N. 5718, 5719. Refusing to protect Applicant's mark defeats the very purposes of the Lanham Act as it encourages third parties to trade on Applicant's singular reputation and will lead to consumer confusion. "The trademark laws exist not to 'protect' trademarks, but . . . to protect the consuming public from confusion, concomitantly protecting the trademark owner's right to a non-confused public." *James Burroughs, Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276, 192 U.S.P.Q. 555, 563 (7th Cir. 1976) (Markey, J. sitting by designation). For example, the concern with preventing confusion lay at the heart of the Board's signal decision in *In re Diamond Walnut Growers, Inc.,* 204 U.S.P.Q. 507 (T.T.A.B. 1979), determining that a jointly owned mark should be registered so as to protect applicants' – and consumers' - shared interests in preventing confusion and deception of trusting purchasers. Protection of consumers as well as Applicant's enormous investment in its uniquely respected mark thus counsels in favor of passing the BOOKING.COM Marks to registration.

Judge Posner noted in *Ty, Inc. v Softbelly's Inc.*, 353 F.3d 528 (7th Cir. 2003), that "[t]o determine that a trademark is generic and thus pitch it into the public domain is a fateful step." *Id.* at 531. For the Examiners to conclude that the ***consumer-ranked*** "most trusted" accommodations website is not permitted to protect the millions of dollars it has invested in its name or to eviscerate the trust reposed in the service by millions of loyal customers by protecting them from use of confusingly similar names is a step that should not be lightly taken. It is indeed entirely unsupported by the evidence.

D. Failure to Prove by Clear Evidence

The Examiners have the burden of proving a term is generic by clear and convincing evidence. *In re Merrill, Lynch,* 828 F.2d at 1571. The Examiners must prove (1) that the term applied for (BOOKING.COM) is the genus of the goods/services covered by the application, and (2) that the term sought to be registered is understood by the relevant public *primarily* to refer to that genus of goods/services. The Examiners have not met their burden on either of these points.

The evidence of record assembled by the Examiners consists of:

(1) printouts from websites using the term "booking" to refer to reservations (almost all of which are modified by terms such as "hotel" or "travel" or "site" to clarify the meaning of the inherently ambiguous term "booking"). (Ser. No. '998, PTO Action dated Apr. 22, 2013, pp. 7-42).

(2) Dictionary definitions of "booking" and ".com", separately, from various sources. In the majority of these definitions, the *primary* definitions listed for "booking" have nothing to do with Applicant's services. (Ser. No. '366, PTO Action dated Nov. 16, 2013, pp. 52-67, 79-82)

(3) Printouts from Applicant's website, which clearly show the difference between the use of the trademark BOOKING.COM and any descriptive use of "booking" alone. (Ser. No. '998, PTO Action dated Apr. 22, 2013, pp. 52-57 and PTO Action dated July 20, 2014, pp. 47-57).

(4) Registrations for various marks which contain "booking services" in the identification of services – again with the inherently ambiguous term "booking" clarified by additional wording such as hotel-booking services or travel-booking services. If "booking" were indeed a genus of services, then "booking services" would be an acceptable identification of services for trademark registrations; but it is not. (Ser. No. '366, PTO Action dated Nov. 16, 2013, pp. 83-128).

(5) Printouts from the USPTO Identification of Goods and Services Manual for descriptions of goods containing the term "booking"; again each description of services modifies the term "booking" to clarify the meaning of the inherently ambiguous term "booking." A description of "booking services" -- and certainly "BOOKING.COM services" – in an application for registration would not be considered sufficiently clear by the U.S. Patent and Trademark Office. (Ser. No. '998, PTO Action dated July 20, 2014, pp. 95-96).

As a preliminary matter, Applicant objects to all of the evidence submitted by the Examiners that originates with non-American sources, such as evidence from non-American dictionaries and websites originating outside the United States with no proven connection to the U.S. market. The relevant consumers for purposes of U.S. registration are U.S. consumers. Materials prepared by or targeted to non-U.S. consumers are irrelevant.

Conspicuously absent from the Examiner's evidence is any dictionary definition of BOOKING.COM.[5] Nor is there any evidence that the relevant consuming public *primarily* understands the mark "BOOKING.COM" to refer to any genus of goods or services. It is scarcely imaginable that a consumer, wishing to speak to his or her human travel agent, might say "I am going to call my BOOKING.COM" or "I am going to drive over to the BOOKING.COM to pick up my tickets." Likewise, there is no evidence that consumers in the online world refer to any of the many competing accommodations and travel sites such as

---

[5] According to the evidence provided by the Examiners, the primary descriptive meaning of "booking" is for theater bookings, not travel. *See* **Dictionary.com** noun 1. a contract, engagement, or scheduled performance of a professional entertainer. 2. reservation 3. the act of a person who books. http://dictionary.reference.com/browse/booking?s=t; *See also* **MerriamWebster.com**. 1 an arrangement for a person or group (such as a singer or band) to perform at a particular place; 2. an arrangement to have something (such as a room) held for your use at a later time; 3. soccer : the act of officially recording the name of a player who has broken the rules in a game. http://www.merriam-webster.com/dictionary/booking; **Collins American Dictionary** (previously attached), noun: an engagement, as for a lecture or concert. http://www.collinsdictionary.com/dictionary/american/booking?showCookiePolicy=true; **The Online Slang Dictionary**, adjective, "cool. From predictive software used in cell phone text messaging. "Book" and "cool" share the same key sequence"; verb, "to leave quickly." http://onlineslangdictionary.com/meaning-definition-of/booking; **Urban Dictionary**, verb, "running really fast" http://www.urbandictionary.com/define.php?term=booking. Hence, by law, the primary meaning even of "booking" alone (which is not Applicant's trademark) is not for travel services.

Travelocity, Expedia, Orbitz, or any others, as "Booking.coms" or even "Bookings." Similarly, there is no evidence that travel agents in the brick and mortar world or the online world call themselves "Booking.coms" or even "Bookings."

Also conspicuously absent is any evidence of a competitive need for third parties to use Applicant's mark BOOKING.COM. The major reasons for not protecting generic terms as marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products. 15 U.S.C. § 1052. That competitors can describe their services without using the term in issue is positive proof the term is not generic. *Dial-A-Mattress*, 57 U.S.P.Q.2d at 1811; *Elliot v. Google Inc.*, *supra*, ___ U.S.P.Q.2d at __, 2014 U.S. Dist. Lexis 127352 at *38, citing *Salton, Inc. v Cornwall Corp.*, 477 F. Supp. 975, 886 (D.N.J. 1979). Here, the record is devoid of any evidence that Applicant's competitors need to use BOOKING.COM to adequately describe their own services.

The Examiners include examples of a few domain names in which the term "booking" appears to support the proposition that there is a competitor need to use BOOKING.COM to describe competing services. (Ser. No. '998, PTO Action dated July 20, 2014, p. 9). Preliminarily, the Trademark Trial and Appeal Board has repeatedly held that use of wording in a domain name, without more, "merely indicates the location on the Internet where [a] Web site appears. It does not separately identify [any] services as such." *In re Willhiam H. Eilberg*, 49 U.S.P.Q.2d 1955 (TTAB 1998); *In re Vicki Roberts*, 87 U.S.P.Q.2d 1474 (TTAB 2008). Therefore, examples of bare domain names – where the mark BOOKING.COM is not separately used on the website itself to describe the competitor's services – are not persuasive evidence that

there is a competitor need to use Applicant's mark.

More important, substantively, not one of the uses cited by the Examiners shows use of the composite term that is the actual trademark, BOOKING.COM. As noted, the United States Supreme Court has held, and it has always been an the unquestioned first principle of trademark law, that "[t]he commercial impression of a trade-mark 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 . . ." *Estate of P.D. Beckwith, Inc.*, 252 U.S. at 545-46; *In re Hutchinson Technology, supra* (Board erroneously failed to consider the term HUTCHINSON TECHNOLOGY as a whole). Even disclaimed elements of a mark must be considered in evaluating the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985). The Examiners have at no point sought to reconcile their views with this first principle of trademark law. Indeed, because Applicant's mark also serves as a URL, it must by definition point to only one unique address on the internet. As a matter of law, it could not function even as a URL (much less as a trademark) if others could use the term to refer to an entire genus of services. Although Applicant recognizes that the PTO has long held that the TLD ".com" itself has no source indicating function, it plainly contributes to the overall meaning of the mark, BOOKING.COM, just as "(888)" which was devoid of source-indicating significance, contributed to the overall meaning of 1-888-MATRESS, such that the alphanumeric phone number could, and did, function as a mark. *In re Dial-A-Mattress*, 57 USPQ2d at 1811. In this case, as amply demonstrated by the evidence submitted by the Examiners and by Applicant, the addition of ".com" plainly adds meaning to the mark such that BOOKING.COM is used and understood by consumers as having a completely different meaning from "booking." Indeed, the addition of ".com" thoroughly transforms the source-indicating function of the word. Thus, as shown above

in the examples of the names Amazon.com and Staples.com, the addition of ".com" changes the overall meaning or commercial impression of the term – even though it does not add any "witticism" or double entendre such as the oft-quoted hypothetical mark "Tennis.Net." Certainly it is the Examiners' burden to show otherwise or that there should be some exception to the rule established a century ago by the Supreme Court. The Examiners here make no effort to do so. The pretense that the four characters ".com" in BOOKING.COM can simply be ignored does violence to the English language and to simple common sense.

Bearing in mind that the analysis of genericness is a question of fact, the format of trademarks as domain names virtually assures that the term cannot become generic because, by definition, only one entity can use that name. Indeed, the very fact that the top-level domain .com signifies to the public that the user of the domain name is a commercial entity (which supports the actual PTO rule that designation ".com" alone has no *source identifying* significance, *not* that it has no meaning whatsoever) makes it virtually impossible, conceptually, for that single commercial entity to designate an entire genus of goods or services. Thus, by example, the descriptive term "dictionary" is likely generic, but adding to it the TLD designation ".com" immediately signifies to the public that the user of the domain name is a commercial entity. Not surprisingly, the PTO has registered DICTIONARY.COM and dozens of other similar names in which the second level domain is plainly descriptive or even generic, but where the mark as a whole was found capable of distinguishing the owner's services.[6] This is entirely

---

[6] As attached to Ser. No. '366, Resp. dated May 15, 2014, pp. 13-14: Reg. No. 4473679 - WWW.HEDGEFUNDRESEARCH.COM; Reg. No. 4102997 - LOCAL.COM; Reg. No. 4473656 - CHEAPROOMS.COM; Reg. No. 4473546 - MONEYLAUNDERING.COM; Reg. No. 4460827 - WORKOUT.COM; Reg. No. 4337199 - PARTYDIGEST.COM; Reg. No. 4449876 - UNIVERSITYJOBS.COM; Reg. No. 4447376 - REPLACEYOURCELL.COM; Reg. No. 4446472 - BUYLIGHTFIXTURES.COM; Reg. No. 4212218 - ORANGECOUNTY.COM; Reg. No. 4294532 - ENTERTAINMENT.COM; Reg. No. 4374363 - DEALER.COM; Reg. No. 4367264 - SKI.COM; Reg. No. 4319981 - DIAPERS.COM; Reg. No. 3,566,509 - ANCESTRY.COM; Reg. No. 3,862,166 - ANSWERS.COM; Reg. No. 4,184,950 - DICTIONARY.COM; Reg. No. 3,556,668. 3,072,366 (and others) - REGISTER.COM; Reg. No. 3,860,755 - TUTOR.COM;

consistent with the rule enunciated in *Dial-A-Mattress* and *In re Gould*, because ".com" is not a word in the English language; it is an addressing convention in the DNS system. None of the Examiners has even attempted to distinguish the present case from these cases factually or legally. The very premise of the holding in *In re Oppedahl & Larsen*, 373 F.3d at 1173, 71 U.S.P.Q.2d at 1371, is that the term .com does have a descriptive meaning. The Examiners disregard the actual basis of the decision and strip *all* meaning from .com, such that it is no longer even part of the mark.

E. The Authorities Relied On in Support of the Refusal are Inapt

The Examiners cite to several ".com" cases to support the conclusion that BOOKING.COM is generic.[7] As a matter of law, the facts in these cases as to consumer perceptions of marks other than BOOKING.COM prove nothing as to the consumer perceptions of the mark in issue. These cases are factually distinguishable and do not support the conclusion that the wording "BOOKING.COM" is incapable of functioning as a source-identifier. In each of the cited cases, there are literally no other meanings for the terms sought to be registered with ".com" other than the subject matter of the services offered through the websites. Each of the terms MATTRESS, HOTELS, LAWYERS, BLINDS AND DRAPERY (used together) and CONTAINER has only one, immediately identifiable and understandable meaning.

Reg. No. 3,927,183 - WEATHER.COM; Reg. No. 2,349,285 (and others) – WEBMD; Reg. No. 2665841 - CHEAPTICKETS.COM; Reg. No. 2397238 - STAPLES.COM; and Reg. No. 2638360 - BESTBUY.COM.

[7] *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 U.S.P.Q.2d 1682 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding), *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 U.S.P.Q.2d 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"), *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 U.S.P.Q.2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"), *In re Eddie Z's Blinds & Drapery, Inc.*, 74 U.S.P.Q.2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet), and *In re Martin Container, Inc.*, 65 U.S.P.Q.2d 1058, 1061 (TTAB 2002) (CONTAINER.COM generic).

Laying aside the impossible premise that consumer perceptions of one mark permit inferences as to consumer perceptions of an entirely different mark, and focusing only on the isolated fact that the claimed marks in issue also could serve as domain names, in sharp contrast to the names in all of the cases cited by the Examiners, the term "BOOKING" is fundamentally ambiguous because it can refer to many different things (*see supra* note 4), including entertainment bookings, theatrical bookings and criminal bookings, securities contracts as well as a slang usage for being bookish. The first *and primary* definition for the term "booking" is "[a]n engagement, as for a performance by an entertainer." Therefore, based on the evidence of record assembled by the Examiners, BOOKING.COM cannot be "understood by the relevant public *primarily* to refer to that genus of goods or services" because more information is needed by the consuming public to understand any specific meaning about the term. The mark BOOKING.COM, unlike the cited examples, simply does not convey a readily identifiable common name for a type or genus of goods or services.

The other cases cited by the Examiners in fact held that the marks were *descriptive*, not generic, of the services at issue. *See Oppedahl & Larsen*, *supra*, (PATENTS.COM merely descriptive); *In re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, 1203 (TTAB 2003) (OFFICE.NET merely descriptive). These cases *support* Applicant's contention that BOOKING.COM is likewise capable of functioning as a source identifier.

Understanding that consumer perceptions must be judged on a case-by-case basis, the most relevant ".com" case conceptually is *In re Steelbuilding.com*, 415 F.3d 1293 (Fed. Cir 2005), where the court reversed the TTAB's holding that STEELBUILDING.COM was generic. The Federal Circuit held that the Board construed the genus of the applicant's services too narrowly and wrongly dismissed the addition of the top level domain ".com" despite its

expansion of the meaning of STEELBUILDING.COM. The Federal Circuit held that the fact that services other than "steel buildings" were offered was an important distinction. Further, the addition of ".com" expanded the mark to include Internet services such as building and designing steel structures on the website and then calculating the appropriate price.

This same logic applies to Applicant's mark BOOKING.COM. The apt genus of service is "travel agency services," not merely reservation services. Applicant's services are offered both in person and online. Thus, the addition of ".com" expands the mark to make a mental connection in the minds of consumers between Applicant's brick and mortar services and its online services. It also expands the mark to include Internet services such as soliciting and collating user-generated content such as reviews of lodgings and other travel related items. Like STEELBUILDING.COM, when taken as a whole, BOOKING.COM conveys much more than mere "reservation" services. Viewing all of the facts presented, including the absence of any evidence that consumers recognize BOOKING.COM as the generic name of any product or service, it is submitted the mark should be passed to registration and consumer loyalty to the most trusted accommodations site in United States commerce should not be betrayed.

II. BOOKING.COM IS INHERENTLY DISTINCTIVE

Applicant maintains that BOOKING.COM is inherently distinctive and suggestive because even the word "BOOKING" is inherently ambiguous and conveys no concrete information about Applicant's services. BOOKING.COM is not a known word in the English language and, taken as a whole, does not directly describe Applicant's services. If the Board maintains the position that BOOKING.COM is descriptive, then, in the alternative, Applicant pleads that BOOKING.COM has acquired distinctiveness for the reasons stated below.

III. IN THE ALTERNATIVE, BOOKING.COM HAS ACQUIRED DISTINCTIVENESS

In determining whether the applied-for mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by Applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) Applicant's efforts in the United States to associate the mark with the source of the goods, such as in unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *Id.*; 37 C.F.R. § 2.41.

A. Length and Exclusivity of Use of the Mark

Applicant has been using BOOKING.COM since at least as early as 2006, a period of approximately eight years. (Ser. No. '366, Resp. dated May 15, 2014, p. 86). Prior to adopting the mark BOOKING.COM, Applicant used the similar marks BOOKINGS and BOOKINGS.NL. *Id.* Applicant owns a Supplemental Registration for BOOKINGS.COM and a Principal Registration for BOOKING.YEAH. *Id.* p. 59.

Applicant conducts an enormous amount of business under the BOOKING.COM mark. 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. *Id.* p. 84. Over 625,000 room nights are reserved through Applicant's BOOKING.COM service <u>*every day*</u>. *Id.* p. 86. Applicant offers its BOOKING.COM service in more than 40 languages. *Id.* The total transaction value of mobile accommodation reservations made through the BOOKING.COM website more than <u>doubled</u> from over $3 billion in 2012 to over <u>$8 billion in 2013</u>. *Id.* p. 84. As of February 2015, Applicant advertises close to 600,000 properties on its website and over 750,000 room nights are reserved every day.

The sheer breadth of the business carried out under the BOOKING.COM mark means that a staggering number of customers are not only exposed to Applicant's mark – but affirmatively seek out Applicant's BOOKING.COM branded services to purchase travel related services. If Applicant's mark did not carry some distinctive quality that allowed customers to recall and seek out Applicant's services then it would be impossible for Applicant's business to thrive, as it has.

B. Nature of Advertising

The record contains numerous examples of Applicant's unique and innovative advertising. 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. For example, Applicant ran web banners on the popular travel site TripAdvisor.com.[8] (Ser. No. '366, Resp. dated Oct. 13, 2014, pp. 51-52). 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 accommodation websites, generally. *Id.* Applicant's use of the descriptive phrase "Planet Earth's #1 Accommodation Site" in close 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.*

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

---

[8] 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).

with or in close proximity to its B-dot Logo (Reg. No. 4,460,494). 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.* pp. 59-60. 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.

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. *Id.* p. 60. The unified branding contributes to the inherent distinctiveness of Applicant's stylized BOOKING.COM Marks, Ser. No. '365 and Ser. No. '366.

C. Type and Expense of Advertising

Applicant has consistently reached millions of American consumers over several years through its widespread advertising of its BOOKING.COM marks. (Ser. No. '366, Resp. dated May 15, 2014, pp. 84-86). Applicant has reached millions of American television viewers through BOOKING.COM television commercials aired on all the major networks and other national channels. These channels include 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. *Id.* p. 86. Applicant reached approximately 6.6 million viewers in a one week promotion on Fandango.com in October 2013. (Ser. No. '366, Resp. dated Oct. 13, 2014, pp. 55).

Applicant's BOOKING.COM branded website receives, on average, 10.3 million unique visitors from the United States per month and over thirty million (30,000,000) unique visitors

worldwide each month. (Ser. No. '366, Resp. dated May 15, 2014, p. 85). The fact that millions of individuals seek out Applicant's services on a regular basis demonstrates broad consumer recognition of Applicant's mark as a source-identifier.

There are over 2.2 million United States-based subscribers to newsletters branded under the BOOKING.COM mark. *Id.* p. 86. These newsletters advertise Applicant's BOOKING .COM services and are sent out an average of 2-3 times per month. *Id.* This is significant because it means that over 2 million individuals in the U.S. actively sought to join Applicant's BOOKING.COM mailing list, demonstrating the customer loyalty of over 2 million individuals in the U.S. to the BOOKING.COM brand and service. Furthermore, this type of direct, personalized interaction between Applicant and its customers cements the BOOKING.COM brand as a source-identifier.

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. *Id.* p. 87. 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. *Id.*

Applicant's extensive advertising provides wide and significant exposure to Applicant's mark. Furthermore, the customer interactions with the brand – joining Applicant's mailing list, seeking out Applicant's commercials on web video channels like YouTube – demonstrate that Applicant's efforts to develop distinctiveness have succeeded, and customers recognize BOOKING.COM as a source identifier.

D. Unsolicited Media Coverage and Consumer Commentary

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 (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 (2014);

- Mobile Travel & Tourism awarded BOOKING.COM the "Best Tablet App" (2014);

- Mobile Travel & Tourism awarded BOOKING.COM the Best Mobile Site. (2014).

Id. p. 86. 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.

On the social media website, Facebook.com, over 2.7 million people have "liked" BOOKING.COM and nearly 58,000 consumers are "talking about" BOOKING.COM. (Ser. No. '366, Resp. dated Oct. 13, 2014, p. 58). 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" BOOKING.COM on Facebook is much higher than comparable accommodations and travel companies such as TRAVELOCITY, HOTELS.COM, TRAVELZOO, and ORBITZ. *Id.*

On the micro-blogging site Twitter, over 53,200 people are "following" BOOKING.COM. *Id.* pp. 56-58. This is more than comparable travel and accommodations sites like HOTELS.COM, TRIVAGO, and HOTWIRE. *Id.* Customers frequently use @bookingcom to engage Applicant in dialogue through Twitter. *Id.* This further demonstrates that consumers recognize and use "BOOKING.COM" to refer to Applicant and to access Applicant's services.

A search for Applicant's mark BOOKING.COM on the Google News service generated over 2,000 unsolicited news articles. (Ser. No. '366, Resp. dated May 15, 2014, p. 87). The

sheer volume of unsolicited news articles discussing Applicant's BOOKING.COM service demonstrates an enormous public recognition of Applicant's mark as a source identifier.

There are tens of thousands of unsolicited consumer reviews of the BOOKING.COM service on third party review websites, including 9,672 reviews on Review Center (with an average rating of 4.4 out of 5 stars) and 57,396 reviews on Feefo (with an aggregate rating of 94%). *Id.* p. 67 This demonstrates significant consumer recognition of BOOKING.COM as pointing to a single source of services.

In short, 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, Applicant's social media following, and the numerous consumer and industry awards Applicant has received.

CONCLUSION

For the foregoing reasons, the refusals to register on the basis of § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), for the reason that BOOKING.COM is allegedly generic, descriptive, and that Applicant has failed to prove acquired distinctiveness under Section 2(f) should be reversed in each of the subject applications.

Respectfully submitted,
FOLEY & LARDNER LLP

Dated: February 10, 2015

Jonathan E. Moskin, Esq.
Katherine Califa, Esq.
90 Park Avenue
New York, NY 10016-1314
Phone: (212) 682-7474
E-mail: IPDocketing@foley.com

TABLE OF AUTHORITIES

Cases

Abercrombie & Fitch Co. v. Hunting World, Inc.,
537 F.2d 4 (2d Cir. 1976) 4

Elliot v. Google Inc.,
___ U.S.P.Q. ___, 2014 BL 253506,
No. 12-cv-1072-PHX-SMM (D. Ariz. Sept. 10, 2014) 7, 22

Estate of P.D. Beckwith, Inc. v. Comm'r of Patents,
252 U.S. 538 (1920) 7, 9, 11, 23

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.,
782 F.2d 987, 228 U.S.P.Q.2d 528 (Fed. Cir. 1986) 5, 11

In re 1800Mattress.com IP LLC, 586 F.3d 1359, 92 U.S.P.Q.2d 1682 (Fed. Cir. 2009) 25

In re ActiveVideo Networks, Inc.,
111 U.S.P.Q.2d 1581 (TTAB 2014) 11

In re American Fertility Soc'y,
188 F.3d 1341, 51 U.S.P.Q.2d 1832 (Fed. Cir. 1999) 12, 17

In re Clorox Co.,
578 F.2d 305 (C.C.P.A. 1978) 13

In re Country Music Ass'n Inc.,
100 U.S.P.Q.2d 1824 (TTAB 2011) 17

In re Dial-A-Mattress Operating Corp.,
240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) ..... passim

In re Diamond Walnut Growers, Inc.,
204 U.S.P.Q. 507 (T.T.A.B. 1979) 19

In re Eddie Z's Blinds & Drapery, Inc., 74 U.S.P.Q.2d 1037 (TTAB 2005) 25

In re Festival of Vitamins, LLC,
Serial No. 85/33160 (TTAB 2013) 16, 17

In re Gould Paper Corp.,
834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) 11, 12, 13, 25

In re Hotels.com, L.P., 573 F.3d 1300, 91 U.S.P.Q.2d 1532 (Fed. Cir. 2009) 25

In re Hutchinson Technology,
852 F.2d 552 (Fed. Cir. 1988) 7, 23

In re Martin Container, Inc., 65 U.S.P.Q.2d 1058 (TTAB 2002) 25

In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.,
828 F.2d 1576 (Fed. Cir. 1987) 4, 17, 20

In re Microsoft Corp.,
68 U.S.P.Q.2d 1195 (TTAB 2003) 26

In re Nat'l Data Corp.,
753 F.2d 1056, 224 U.S.P.Q.2d 749 (Fed. Cir. 1985) 9, 23

In re Reed Elsevier Properties Inc., 482 F.3d 1376, 82 U.S.P.Q.2d 1378 (Fed. Cir. 2007) 25

In re Reed Elsevier Props., Inc.,
482 F.3d 1376, 82 U.S.P.Q.2d 1378 (Fed Cir. 2007) 4, 13

In re Steelbuilding.com,
415 F.3d 1293, 75 U.S.P.Q.2d 1420 (Fed. Cir. 2005) ..... passim

In re Vicki Roberts,
87 U.S.P.Q.2d 1474 (TTAB 2008) 22

In re Willhiam H. Eilberg,
49 U.S.P.Q.2d 1955 (TTAB 1998) 22

James Burroughs, Ltd. v. Sign of the Beefeater, Inc.,
540 F.2d 266, 192 U.S.P.Q. 555 (7th Cir. 1976) 19

Keebler Co. v. Rovira Biscuit Corp.,
624 F.2d 366 (1st Cir. 1980) 4

Kellogg Co. v. National Biscuit Co.,
305 U.S. 111 (1938) 4

Magic Wand, Inc. v. RDB, Inc.,
940 F.2d 638, 19 U.S.P.Q.2d 1551 (Fed. Cir. 1991) 5

Oppedahl & Larsen LLP,
373 F.3d 1171, 71 U.S.P.Q.2d 1370 (Fed. Cir. 2004) ..... passim

Q-TIPS, Inc. v. Johnson & Johnson,
99 U.S.P.Q. 183, 108 F. Supp. 845 (1952) 7

Qualitex Co. v. Jacobson Prods. Co.,
514 U.S. 159 (1995) 18

Timelines Inc. v. Facebook Inc.,
108 U.S.P.Q.2d 1993, 938 F. Supp. 2d 781 (N. D. Ill. 2013) 16

Ty, Inc. v Softbelly's Inc.,
353 F.3d 528 (7th Cir. 2003) 19

Statutes

15 U.S.C. § 1052 22

15 U.S.C. § 1052(e)(1) 9, 34

37 C.F.R. § 2.41 27

Other Authorities

§ 2(e)(1) of the Trademark Act 1, 9, 34

McCarthy on Trademarks and Unfair Competition, § 12:01 (4th ed. 2014) 5

McCarthy's § 12:8 (4th ed. 2014) 5

Restatement (Third) of Unfair Competition, § 15 cmt. c (1995) 5