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Subject: U.S. TRADEMARK APPLICATION NO. 85485097 - BOOKING.COM - 096981-0108 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85485097 **MARK:** BOOKING.COM	
CORRESPONDENT ADDRESS: JONATHAN E MOSKIN FOLEY & LARDNER LLP 90 PARK AVE NEW YORK, NY 10016-1314	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp **TTAB INFORMATION:** http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Booking.com B.V.	
CORRESPONDENT'S REFERENCE/DOCKET NO: 096981-0108 **CORRESPONDENT E-MAIL ADDRESS:** ptomailnewyork@foley.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1140888

INTRODUCTION

In this case, Applicant appeals the Trademark Examining Attorney's Final Refusal of the proposed mark, "BOOKING.COM" in standard character, "BOOKING.COM" appearing in a stylized font, and "BOOKING.COM" with designs, for use with services identified in Classes 39 and 43. Registration has been finally refused because the proposed mark appears to be generic as applied to the proposed services. Moreover, because of the generic nature of the mark as well as an insufficiency of proof to support the claim of acquired distinctiveness, Applicant's 2(f) claim under the Trademark Act fails to overcome the registration refusal. *See* 15 U.S.C. §1052(f); 37 C.F.R. §2.41; TMEP §§1212 *et seq.* Accordingly, it is respectfully requested that the Board affirm the refusal of the proposed marks.

STATEMENT OF THE CASES

Applicant applied to register BOOKING.COM with a design (Serial No. 85485097), BOOKING.COM in standard character (Serial No. 79114998), BOOKING.COM stylized (Serial No. 79122365) and BOOKING.COM stylized (79122366) for travel reservation and travel accommodation services in Classes 39 and 43.

Serial No. 85485097 had a filing date of 12/1/2011, and was refused registration based on the following requirements: the mark description and color claim required amendment, the identification of services was indefinite, and a disclaimer was required of the wording BOOKING.COM. The Applicant responded on 9/24/2015 to acceptably amend the description of the mark, color claim, and identification of services, while arguing against the disclaimer, insisting it was not descriptive and in the alternative had acquired distinctiveness under Section 2(f). After inadvertently issuing a final refusal as to the disclaimer, the examiner reissued a new nonfinal action on 4/11/2013, maintaining the disclaimer requirement based on the genericness of the wording and, in the alternative, arguing the evidence under 2(f) was insufficient. In Applicant's response on 10/11/2013, the Applicant argued against the genericness of the wording and, in the alternative, insisted the evidence of 2(f) sufficient to permit registration on the Principal Register. The examiner issued a final action on the case on 10/28/2013, maintaining the disclaimer requirement based on the genericness of the wording and, in the alternative,

argued that the 2(f) evidence was insufficient for so highly descriptive a term as BOOKING.COM. On 4/29/2014, the applicant submitted a request for reconsideration on the same issues which was denied on 5/23/2014.

Serial No. 79114998 was filed on 6/5/2012, and a refusal was issued under Section 2(e)(1) on 9/28/2012 for being merely descriptive, along with requirements to amend the identification of services, as well as a request for information in light of the descriptive nature of the mark. The Applicant responded on 3/29/2013 to the request for information and argued against the 2(e)(1) refusal, asserting a 2(f) claim of acquired distinctiveness in the alternative. Applicant also amended their identification. Issuing a new nonfinal office action on 4/22/2013 as a result of the claim of acquired distinctiveness, the examiner rejected the 2(f) claim by noting the mark was generic and therefore incapable of registration under Section 2(f). The examiner argued in the alternative that the 2(f) claim demonstrated insufficient evidence and thus likewise maintained the 2(e)(1) refusal for being highly descriptive. In Applicant's response on 10/22/2013, the Applicant argued against the genericness of the mark and, in the alternative, insisted the evidence of 2(f) sufficient to permit registration on the Principal Register. The examiner issued a final action on the case on 11/18/2013, maintaining the refusal under Section 2(e)(1) as to the genericness of the mark and, in the alternative, that the 2(f) evidence was insufficient for so highly descriptive a mark. On 5/19/2014, the applicant submitted a request for reconsideration on the same issues which was denied on 7/20/2014.

Serial Nos. 79122365 and 79122366 were filed on 11/7/2012, and in office actions issued on 3/17/2013 the marks were refused under Section 2(e)(1) for being merely descriptive, and requiring the applicant to amend the description of the mark and identification of services. The Applicant responded on 9/17/2013 with acceptable amendments and arguing against the statutory refusal, claiming it was distinctive and, in the alternative, that under 2(f) the mark had acquired distinctiveness. The examiner issued new nonfinal office actions on 11/16/2013, rejecting the applicant's 2(f) claim by noting the marks were generic and therefore incapable of registration under Section 2(f). The examiner argued in the alternative that the 2(f) claim demonstrated insufficient evidence and thus likewise maintained the 2(e)(1) refusals for being highly descriptive. Applicant responded on 5/15/2014 arguing the marks were inherently distinctive and, in the alternative, were not generic and had acquired distinctiveness under 2(f). On 6/30/2014, the examining attorney issued final actions on the issues, arguing the applied for marks were generic and, in the alternative, the evidence of acquired distinctiveness under 2(f) was not

sufficient to overcome the 2(e)(1) refusal. The applicant submitted requests for reconsideration of this refusal on 10/13/2014, and the requests were refused for the same reasoning on 11/4/2014.

The instant appeals followed, and all such appeals on the cases were consolidated beneath a single examining attorney.

ISSUES ON APPEAL

1. Whether registration has been properly refused because "BOOKING.COM" is generic for the listed services in Classes 39 and 43, and therefore legally incapable of functioning as a source identifier in commerce under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1);
2. Alternatively, if it is not generic, whether the Applicant has met the burden of proof in establishing that the proposed mark is sufficiently distinctive as to register or register without disclaimer under Section 2(f). 15 U.S.C. §1052(f)

Reigning precedent and law, as well as common sense and marketplace necessity, require a finding of genericness in these cases, as the term BOOKING is the generic genus for the services under the mark as perceived by consumers seeking such booking (travel reservation) services.

ARGUMENTS

I. BOOKING.COM IS GENERIC

Generic terms require refusal because they are common names that the relevant purchasing public understands primarily as describing the genus of applicant's goods and/or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *see* TMEP §1209.01(c). They are by definition, incapable of indicating a particular source of goods and/or

services and cannot be registered as trademarks and/or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). Refusal is required because registering generic terms "would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

In considering the significance of the wording, it is important to note that in addition to common names, the name of a key ingredient, characteristic, or feature of goods and/or services may also be refused as generic for those goods and/or services. *See In re Northland Aluminum Prods. Inc*., 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); TMEP §§1209.01(c) *et seq.* Additionally, terms that identify the function or purpose of a product or service may be generic as well. TMEP §1209.03(p); *see, e.g.*, *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (holding SCREENWIPE generic for an anti-static cloth used for cleaning computer and

television screens); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389, 1391 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers for use on permanent press products). Accordingly, terms that are not the name of a specific service may also be found to be generic.

In this case, in concluding that the proposed mark is generic for the services in Classes 39 and 43, the following two-step generic inquiry was followed. The first step involved determining the genus of services at issue, and the second step involved showing that the relevant public understands the designation to primarily to refer to that genus of services. *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs*, *Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

1. The Genus of Applicant's Services and The Relevant Public for the Services

Regarding the first part of the inquiry, the genus of the services is often defined by an applicant's identification of services. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In the present consolidation of cases, the identifications of services are as follows:

> "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" [in International Class 039]

> "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" [in International Class 39]

> "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 making hotel reservations and temporary accommodation reservations; providing online information, advice and consultancy relating making hotel reservations and temporary accommodation reservations" [in International Class 43]

> "Hotel reservation services for others; holiday accommodation reservation services and resort reservation services, namely, providing hotel room reservation services and resort hotel reservation services and providing online hotel and resort hotel room reservation services; providing information about hotels, hotel accommodations and

> resorts accommodations, whether or not based on the valuation of customers; information, advice and consultancy relating to the aforesaid services; the aforesaid services also provided electronically" [in International Class 043].

> "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" [in International Class 43].

Given the duplicate and/or encompassing wording throughout the identification (e.g., "hotel reservation services", "hotel room reservation services", "online hotel and resort hotel room reservation services"), the identification, and thus the genus, is summarized as "Hotel reservation services" and related "information, advice and consultancy". The relevant public consists of all customary consumers of the services, including those who would need information on hotels and other forms of temporary lodging, or would need to book or make reservations for the same.

Applicant's responses have taken exception with this characterization of the genus, stating: "Applicant's Services are Not Properly Classified as "Hotel Reservation Services"."

Applicant instead claims that its services are "travel agency services." Applicant's suggested genus is inaccurate since it encompasses services outside the scope of the *International Class 043* services set forth in this application. (*See* SN 79122365 outgoing on 6/30/2014 at 2 from the U.S. Acceptable Identification of Goods and Services Manual, which show "travel agency services" encompassing International Class 036 and 039 services that are outside the scope of this identification.)

Furthermore, even assuming that Applicant's overly broad characterization of the genus was somehow correct, an applied-for mark may be found generic where the identification is broadly worded and encompasses the narrower category of goods and/or services named in the mark. *See, e.g.*, *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010) (holding NANDRIVE generic for "electronic integrated circuits" because NAND drives were types of solid state flash drives, a subcategory of applicant's broadly worded "electronic integrated circuits"); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019,

2024-25 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for electric candles, a subcategory of applicant's broadly worded "lighting fixtures"); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002) (holding BONDS.NET generic for information and electronic commerce services regarding financial products because bonds were a subcategory of applicant's broadly worded "financial products").

2. The Meaning of BOOKING.COM to the Relevant Public

Regarding the second part of the inquiry, Applicant takes exception with the evidence of record clearly demonstrating that the wording in the mark is essentially the apt or common name for the genus of their services. Applicant alternately claims that the evidence refers to secondary or non-United States meanings of the wording in question.

Evidence of the public's understanding that a designation primarily refers to the genus of specific goods and/or services may be obtained from any competent source, such as dictionaries, trade journals, magazines, catalogs, newspapers, and other publications. *See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); In re Northland Aluminum Prods., Inc., 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985). In addition, material obtained from third-party Internet websites is generally accepted as competent evidence. *See In re Country Music Ass'n*, 100 USPQ2d 1824, 1829 (TTAB 2011); TBMP §1208.03; TMEP §710.01(b). Further, research databases such as LEXIS/NEXIS® are also considered a source of competent evidence. *See In re Leatherman Tool Grp., Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988); TMEP §1209.01(c)(i).

With respect to Applicant's arguments concerning secondary dictionary definitions, the determination of whether a mark is merely descriptive (or in this case generic) is made **in relation to an applicant's services**, not in the abstract. [Emphasis added.] *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on

disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

This is of course relevant to whether wording is generic because a generic term is "the ultimate in descriptiveness." *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), quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961). TMEP §1209.02(a).

Therefore, Applicant's repetitive discussions concerning primary or alternate definitions of the "mark" wording are wholly unpersuasive since they (once again) fail to consider the wording *in relation to the identified services*. For example, Applicant's discussion in SN 79122365 of "criminal bookings" is irrelevant. The record contains multiple, *United States* dictionary entries for "booking" *as it pertains to the identified services*, which is how the purchasing public would be encountering the mark and, as a result, defines the established standard for determining a term's descriptiveness/genericness:

"A reservation, as for accommodations at a hotel."

The American Heritage Dictionary of the English Language, Fourth Edition, at http://education.yahoo.com/reference/dictionary. (*See* SN 79122365 TICRS Outgoing, 03/18/13, at 3-4.)

"To arrange for … lodgings … in advance; reserve."

The American Heritage Dictionary of the English Language, Fourth Edition, at http://education.yahoo.com/reference/dictionary. (*See* SN 79122365 TICRS Outgoing, 11/16/13, at 2-5.)

"An arrangement to have something (such as a room) held for your use at a later time."

Merriam-Webster Dictionary, at www.merriam-webster.com. (*See* SN 79122365 TICRS Outgoing, 11/16/13 at 11-13, as well as attached "About Us" entry, which states in pertinent part, "For more than 150 years, … Merriam-Webster has been America's leading and most-trusted provider of language information.")

"An arrangement to … stay in a hotel room, etc. at a later date".

Macmillan Dictionary, at www.macmillandictionary.com. (*See* SN 79122365 TICRS Outgoing, 11/16/13 at 14-15. The entry notes that "this is the American English definition of booking", and also includes the following usage example, "Increasingly, travelers are using the Internet for both information and bookings.")

In addition to the three American English dictionaries referenced above, the previously supplied entry from the Cambridge Dictionaries Online admittedly includes the abbreviations "US" and "UK" before its definition of "booking" ("an arrangement you make to have a hotel room … at a particular time in the future"). However, the attached entry for "book" from http://dictionary.cambridge.org/dictionary/american-english clarifies any question concerning the relevant American meaning of the term. Thus, the term BOOKING 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.

If the applicant is still unsure as to the correct, *relevant* meaning of this term, previously attached entries from the U.S. Acceptable Identification of Goods and Services Manual show "booking" appearing as the generic, common commercial name for International Class 043 services such as those specified in the instant application. *See* SN 79122365 TICRS Outgoing, 6/30/2014 at 7. It is also noted that previously supplied Lexis-Nexis news excerpts showing generic use of the term "booking" were limited to *United States* news sources. *See* SN 79122365 TICRS Outgoing, 11/16/2013 below the action's signature block.

Throughout its brief, Applicant improperly argues that the addition of the top-level domain ".COM" to the generic term "booking" somehow saves its "mark" from genericness. However, as has

been noted previously (in all consolidated applications) Applicant's arguments fail to properly apply the appropriate legal standards. Applicant is *incorrect* in its brief in claiming that the required standard for a finding of genericness is that the *composite* mark BOOKING.COM as a full phrase be generic. This has never been the established standard and, in the highly analogous case of HOTELS.COM, the TTAB did not find the mark generic based upon use of the *whole mark* HOTELS.COM generically by other sources. It is sufficient, then and now, that HOTELS and BOOKING be found generic under the substantial weight of evidence provided by the examiners.

Notably in HOTELS.COM, the TTAB explicitly stated "[t]he term HOTELS.COM is no more registrable than the generic word "hotels," alone." In re Hotels.com, L.P., 2008 TTAB LEXIS 60 at 14 (Trademark Trial & App. Bd., Mar. 24, 2008). As with the applicant in this instant case, in HOTELS.COM, the Applicant attempted to argue that the term HOTELS.COM was not the common, generic name of any product, services, or field of study. Neither the TTAB nor the affirming Federal Circuit found this to be an accurate depiction of the test for genericness with respect to ".COM" domain name trademark applications. In re Hotels.com, L.P., 91 USPQ2d 1532 (Fed. Cir. 2009). It is therefore clear that if BOOKING alone is unregistrable as generic, the composite mark BOOKING.COM would be no *more* registrable beneath this line of case law unless the combination resulted in a new or incongruous meaning.

In the applied-for marks at issue in these appeals, the term "BOOKING" is combined with the top-level domain (TLD) ".COM". Attached and previously supplied dictionary evidence shows that the TLD ".com" is defined as

> "Part of the Internet address of many companies and organizations. It indicates that the site is commercial, as opposed to educational or governmental."

(*See* previously attached entry from http://dictionary.reference.com, citing The American Heritage New Dictionary of Cultural Literacy, Third Edition, 2005., referenced from SN 79122365 TICRS Outgoing, 6/30/2014 at 8-9.)

The previously attached http://dictionary.reference.com entry for ".com" also includes the following explanatory note:

> "The phrase dot-com is used to refer *generically* to almost anything connected to business on the Internet."

[Emphasis added.]

Because a TLD will usually be perceived as part of an Internet address of commercial (for-profit) organizations, such TLD generally serves no source-indicating function and adding it to an otherwise unregistrable mark typically does not render the mark registrable. TMEP §1209.03(m); *see In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Hotels.com, LP*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009); TMEP §1215.05; *cf. In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) ("Only in rare instances will the addition of a TLD indicator to a descriptive [or generic] term operate to create a distinctive mark.").

In the present case, the TLD combined with the generic wording adds no source-identifying significance but retains only its significance as a TLD. Each of the terms BOOKING and .COM has a clear and readily understood meaning and the combined term communicates just as clearly and directly that Applicant operates a commercial website that provides its customers with *booking* information and reservation *booking* services. The Federal Circuit has held that "the PTO has satisfied its evidentiary burden [on genericness] if...it produces evidence including dictionary definitions that 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." *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). Accordingly, the relevant public would understand this designation comprising generic wording and a TLD to refer primarily to the genus.

Although Applicant is correct there is no bright line rule that the addition of .COM to an otherwise generic term will *never* affect registrability, the Court of Appeals for the Federal Circuit has nevertheless stated that, as a general rule, the addition of a TLD to otherwise unregistrable wording 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). 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 significance capable of identifying source or acquiring distinctiveness. When combined, the wording and the TLD retain their common meaning.

That the "mark" fails to form some unitary whole with an alternate meaning is further emphasized by its de minimis stylization showing the primary (generic) term "Booking" appearing in a different color than the added, secondary (generic) term ".com".

The November 16, 2013 Office Action for SN 79122365 contained numerous examples of generic use of wording in the applied-for "mark", but Applicant discounted this evidence because it claims "the majority of these uses are modified by terms such as 'hotel' or 'travel' to clarify the meaning of the … term 'booking'". However, this argument is unpersuasive given that the very dictionary definitions of "booking" included such "clarifying language".

Furthermore, previously attached U.S. news excerpts from www.lexis.com beneath the signature block of SN 79122365 TICRS outgoing 6/30/2014 show numerous examples of *generic* use of the wording in question both *before* and *during* Applicant's stated eight years of use:

1995-2005

> Last week Holiday Inn became the first major hotel chain to offer online bookings.

Don't consider the best rate given by an on-line booking service or a hotel's central reservations office to be carved in stone.

The addition of online booking capabilities is a continuation of Hilton Hotels' dedication to innovation and emerging technologies …

… Pegasus Systems provides the technology that facilitates electronic booking of hotel rooms worldwide.

It's no surprise that the on-line booking of flights, hotels and rental cars is growing.

Pegasus Systems processes Internet hotel reservations via its own online booking service, TravelWeb …

I pointed my browser to TravelWeb, an online booking service for 18,000 hotels and resorts worldwide.

More than three-quarters of the top 75 airlines, hotels and car rental companies offer online booking.

Washington, D.C.'s tourism office has teamed up with a hotel-booking service to provide on-line booking …

We will help … the hotel reservations business with online bookings …

He has operated it as a … hotel booking site since 1997.

Visitors Information by the Visitors Information Service … already offers online booking for hotels.

Hoteldiscount.com is one of the fastest growing hotel booking sites on the Internet …

Next, I searched for hotels. I had my choice of several online booking services.

Both sites allow online booking of lodging, which ranges from simple hotels to mansions

…I checked several online booking services: Travelscape, Hotel Discount Network and Quikbook.

... a Web site dedicated to condos, vacation rentals and time-shares, complementing their hotel-booking site, www.hoteldiscount.com.

Is there room for another online booking service for hotels? Hotwire.com, following in the footsteps of Travelocity.com, Expedia.com and Priceline …

... in September 1998 launched USAHotelGuide.com, a highly successful online hotel booking site.

Several European hotel booking sites can be found through (go europe.about.com).

They're developing a new site that will list hotels offering park and fly and allowing online booking …

Online hotel room booking site Hotel Reservations Network briefly sliced its 50-day moving average.

CHECK EXPEDIA.COM AND TRAVELOCITY.COM: The two largest online booking sites have become excellent hotel-space distributors because the size of these sites enables them to negotiate good deals with hotels. So the sites may have better rates than the hotels.

Hyatt, which pioneered the first fully functional hotel online booking in 1995 …

Here's a rundown of the most popular hotel booking sites and who they're best for.

Now, though, online travel agencies like Expedia and hotel booking sites like Hotels.com are making broad improvements.

Despite big promises from Travelweb (www.travelweb.com), we were disappointed with the hotel booking site …

In late August, we did an online search of five hotel booking sites (Travelocity.com, Expedia.com, Orbitz.com, Quikbook.com and Hotels.com) …

2005-present

Stayful also gives independent boutique hotels a solution that no other online booking service has offered in the past …

Mac users who search for hotels on the Orbitz online booking service are initially directed to more expensive hotels …

Whatsonwhen publishes an online calendar of events around the world and operates online booking service for hotels, among other services.

He stressed that the city is not suing individual hotels, just the online booking services.

TripExpert, a new hotel booking website … celebrates its launch today.

… advised Genstar Capital LLC on its $930 million sale of hotel booking website TravelClick to private equity firm Thoma Bravo LLC.

… Cuiabá's four game days averaged more than $500, according to data from the hotel booking site Trivago …

… kinds of investments that the firm has made in companies like Snapchat and the last-minute hotel booking site Hotel Tonight.

… I do recommend looking intoTingo.com , a hotel booking site that refunds the difference to your credit card if the hotel lowers your rate …

A search Monday on Hotels.com - a popular hotel booking website - netted the information that 32 area hotels were booked solid for Monday night …The site compares rates offered by hundreds of thousands of hotels and 200 hotel booking websites worldwide …

Last month, it became the first hotel booking site to add price forecasting …

… there's even luxurypaw.com, a pet-friendly hotel booking site that allows you to use your pet's weight as part of the hotel search criteria.

… developed a campaign to introduce lasvegas.com, its hotel room reservation booking site.

[Emphasis added in all.]

Applicant may also see dozens of previously attached articles from CNN, Huffington Post, Room77.com, etc. in which the phrases “booking website(s)” and “booking sites” are used frequently to describe a **host** of such sites for Applicant’s competitors. (See SN 79114998 outgoing of 7/20/2014 at 2-28 and 41-76). It is clear from this evidence that “booking website” and “booking site” identifies a particular type of website. “BOOKING,” therefore, is utilized as the generic genus for these types of services and to identify such websites broadly, rather than to identify Applicant in particular. Applicant’s own website

describes its services on the company overview section as “the world leader in **booking** accommodations online. (visited on June 19, 2014, see SN 79114998 outgoing of 7/20/2014 at 29-40.)

Competitive necessity is a factor which militates toward the finding of a term as being descriptive and, in this case, generic. The examining attorneys have 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 offering similar and identical services:

- www.**booking**buddy.com
- fast**booking**-hotels.com
- www.marriott.com/online-hotel-**booking**.mi
- www.hotel**booking.com**
- www.francehotel**booking.com**
- www.hotel**booking**solutions.com
- www.instantworld**booking.com**
- www.securehotel**booking.com**

[Emphasis added in all.]

The Trademark Trial and Appeal Board, in HOTELS.COM, relied upon similar “hotel” domain names, in part, in finding that hotel services were the “focus” of Applicant’s services and, in turn, that he mark HOTELS.COM as a whole was generic. It can be seen, then and here, from the web pages that BOOKING and BOOKING.COM are frequently used as part of the domain names of others to denote websites that provide booking information and reservation booking services, i.e., the service provided by Applicant’s website. *See In re Hotels.com, supra* at 13-14. It is clear from the website and promotional materials of the applicant as well as the websites of third-parties that consumers who are interested in finding booking information or booking reservations at hotels, booking flights, etc., would immediately understand that BOOKING.COM identifies a website that provides such services. *See In re Reed Elsevier Properties Inc*., 482 F.3d 1376, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007) (Affirming the Board's finding that

LAWYERS.COM is generic for online information exchange in the fields of law, legal news, and legal services, the Court noted that third-party websites are competent sources to determine what the relevant public would understand LAWYERS.COM to mean and provide substantial evidence to support the Board's decision). Indeed, Applicant's assertion that "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" flies in the face of this jurisprudence, in which domain names have in fact been found generic when the root term is generic and their TLD fails to add further source-identifying significance. *Applicant's Brief, Page 24.*

The major reasons for protecting highly descriptive or generic designations are: (1) to prevent the owner of a mark from inhibiting competition in the same of particular services; 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. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

Applicant's arguments thus ignore the competitive need for others to use the generic term "booking" with or without the equally generic TLD ".com" as demonstrated by the aforementioned domains and evidence of use of BOOKING in the marketplace for such services provided by competitors.

This case is also distinguishable from Applicant's cited *In Re Dial-A-Mattress Operating Corp*., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cit. 2001). In that case, the Federal Circuit reversed the Board's holding affirming the genericness refusal to register 1-888-Matress as a mark for "telephone shop-at-home services in the field of mattresses." There are similarities between a telephone number and a domain name, in that each typically can be used by only one entity at a time. However, as explained in *In re Martin Container, Inc*., 65 USPQ2d 1058 (TTAB June 11, 2002) and *In re CyberFinancial.Net*, supra, although telephone numbers are unique, i.e., a given ten-digit number can be used by only one entity at a time, domain names may be up to sixty-three numbers or characters (plus the characters used to identify the TLD), so that many domain names could contain the same root terms (such as "booking.com"), combining them with different numbers, letters or words as prefixes and/or suffixes. Therefore, particularly in light of the fact that the evidence of record clearly establishes that this precise occurrence has come to pass, removing BOOKING.COM from the public domain through an exclusive

grant of trademark usage to the applicant would result in an unfair burden upon numerous competitor websites to cease utilizing such domains and terminology lest they risk suit from the applicant.

Applicant also contends that its "mark" is registrable in the United States because it happens to be registered in foreign countries. However, this contention is irrelevant. As Applicant is undoubtedly aware, the instant application's extension for protection is examined as a *United States* application under the same standards as any other application for registration on the Principal Register. 15 U.S.C. §1141h. TMEP §§1901 and 1904.02(a).

Finally, Applicant also references numerous third party registrations for *unrelated* marks, and wishes "to know by what principle" these marks are "protected". In response, the examining attorney notes that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). If the applicant is truly seeking a guiding "principle", it should look no further than the following:

> "Each case is decided on its own facts, and each mark stands on its own merits."

See AMF Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Nor do these third-party registrations establish that there is an Office practice holding such marks are generally registrable. See *In re First Draft, Inc.,* 76 USPQ2d 1183 (TTAB 2005).

Applicant is also reminded that its September 17, 2013 communication includes a concession that the applied-for mark is in fact generic. In the September 17, 2013 response, Applicant asserts that the applied-for mark "Booking.com" is the "legal equivalent" of the term "Bookings", which (as attached and previously supplied evidence clearly demonstrates) is the generic name for the identified services.

3. Conclusion

The term BOOKING is generic for the services being provided. The examining attorney has not taken "the legal concept of genericness [and] fundamentally redefined and deprived [it] of all meaning" (Applicant's Brief, page 2), nor have the examiners "create[d] legal theories as shortcuts to simplify findings of genericness." (Applicant's Brief, Page 13). To the contrary, the longstanding test for genericness has been applied and the Applicant's proposed mark found to be generic, as it both 1) identifies the genus of Applicant's services, and 2) consumers encountering it in relation to such services would understand it to be primarily referencing that genus of services. Applicant's proposed trademark does not identify a single source, but rather, names its genus and the addition of .COM reinforces its lack of source identifying significance. As in the highly analogous case of HOTELS.COM, it is clear that third party usage of BOOKING and BOOKING.COM in identifying their services by their common, generic genus and in identifying commercial websites offering information on bookings, militates overwhelmingly toward such a finding.

II. IN THE ALTERNATIVE, MARK IS MERELY DESCRIPTIVE AND INSUFFICIENT EVIDENCE HAS BEEN SUBMITTED OF ACQUIRED DISTINCTIVENESS

1. Mark/Wording "BOOKING.COM" is Merely Descriptive

In the alternative, if the applied-for mark is ultimately determined not to be generic by the appellate tribunal, then the applied-for mark is nevertheless refused for being merely descriptive of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g.*, *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

As noted above, the determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

It is first noted that the record contains no less than four American English dictionary entries defining the term "booking" as making an "arrangement" or "reservation" for "lodging" or a "hotel room". The record also contains dictionary definitions for the generic TLD ".com", noting that it is "used to refer generically to almost anything connected to business on the Internet".

Thus, given the evidence of record, this Applicant's assertion that the mark is "inherently distinctive" for "hotel reservation services" strains credulity. Since the supplied dictionary definitions, news excerpts and web page screen captures refer to "booking" as a type or class of services, the applied-for mark is *at best* highly descriptive.

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 goods and/or 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).

As previously noted, Applicant's services are described as follows:

In the present consolidation of cases, the identifications of services are as follows:

> "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" [in International Class 039]

> "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" [in International Class 39]

> "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 making hotel reservations and temporary accommodation reservations; providing online information, advice and consultancy relating making hotel reservations and temporary accommodation reservations" [in International Class 43]

> "Hotel reservation services for others; holiday accommodation reservation services and resort reservation services, namely, providing hotel room reservation services and resort hotel reservation services and providing online hotel and resort hotel room reservation services; providing information about hotels, hotel accommodations and resorts accommodations, whether or not based on the valuation of customers; information, advice and consultancy relating to the aforesaid services; the aforesaid services also provided electronically" [in International Class 043].

> "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" [in International Class 43].

In this case, the evidence shows that someone who knows Applicant's services will certainly understand "BOOKING.COM" to convey information about those services. Specifically, the record amply demonstrates, through U.S. dictionary definitions and numerous instances of the use of BOOKING on competitor and consumer websites to identify similar and identical services, that the term has a commonly understood and highly descriptive meaning with respect to the services at issue.

Specifically, BOOKING is defined as "a reservation, as for accommodations at a hotel," "to arrange for … lodgings … in advance; reserve," etc. *For all applicable definitions, reference this brief pages 8-9.* These definitions, coupled with the ample third party usage to refer to the service provided rather than to the Applicant, show that when considered with respect to the specified

services, "BOOKING" is a term of art used to refer to a reservation or the act of making such a reservation. Thus, in the context of the services, the descriptive meaning is clear: BOOKING.COM immediately informs a consumer that the Applicant is providing booking information, and a means of acquiring a booking, on a commercially available website.

2. 2(f) Distinctiveness has Not Been Sufficiently Established

Generally, where registration has been refused as descriptive and Applicant believes that its mark has acquired distinctiveness, the Applicant may seek registration on the Principal Register under Trademark Act Section 2(f). See 15 U.S.C. §1052(f). However, the burden of proving that a mark has acquired distinctiveness is on the applicant. Yamaha Int'l Corp. v. Yoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); In re Meyer & Wenthe, Inc., 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01.

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *see In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); TMEP §1212.05(a). In the case of generic marks, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances. *See In re Bongrain*, 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). Furthermore, where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods and/or services would be less likely to believe that it indicates source in any one party, more evidence is required. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657 (TTAB 1986).

On the question of distinctiveness, each case is decided on its own merits but the following factors are generally considered in the determination: (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 and/or services, such as unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); *see In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971). In this regard, an applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin. Allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark. TMEP §1212.06(b);

see In re Boston Beer Co., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

In the current case, Applicant claims that "BOOKING.COM" has become distinctive of Applicant's goods and services based upon its continuous and exclusive use in commerce, transaction revenues accumulated through the website in question, advertising examples and expenditures, media coverage, and consumer rankings and awards. However, in this case because the mark has been shown to be generic a distinctiveness claim does not overcome the refusal. *See In re Bongrain*, 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) However, should the Board determine that the mark is descriptive, Applicant has not sufficiently met it's burden to show that consumers have come to view "BOOKING.COM" as an indicator of origin.

With respect to Applicant's use in commerce, Applicant's claim of eight years use is wholly insufficient to establish acquired distinctiveness in the applied-for mark given its *highly* descriptive nature. While Applicant touts its television advertising, its own supporting evidence notes that "its first ever- TV campaign" is little more than two years old. Further, BOOKING.COM appears in a number of other website domain names in commerce, making the exclusivity claim questionable in light of the high degree of similarity in these domain names and their usage.

Taken as a whole, the additional evidence of acquired distinctiveness pursuant to Trademark Act Section 2(f) is not persuasive. That the applicant has high revenues in connection with the activities at issue, and has significant advertising expenditure does not mean that the mark has achieved distinctiveness. Standing alone, the sales figures only demonstrate the success of applicant's **website**, but not that the relevant consumers have come to view BOOKING.COM as applicant's mark. These statements and exhibits merely tend to show that applicant has undertaken extensive promotions and that it has achieved commercial success. See *In re Busch Entertainment Corp*., 60 USPQ2d 1130 (TTAB 2000); *In re Franklin Mint Corporation,* 209 USPQ 172, 174 (TTAB 1980) and *In re Behre Industries Inc.*, 203 USPQ 1030 (TTAB 1979). See also *In re Leatherman Tool Group Inc*., 32 USPQ2d 1443 (TTAB 1994). Further, consumer ranked surveys merely express a purchasing individual's satisfaction with the quality of the services – it does not in any way speak to a consumer's comprehension of BOOKING.COM as being viewed as a trademark. A finding by this tribunal that the mark has not acquired distinctiveness in no way speaks to whether the Applicant is providing useful and well-received services in commerce, only that the mark they have chosen to utilize for the provision of such services is so highly descriptive as to

have failed to acquire distinctiveness in commerce, as it couples a TLD with the *highly* descriptive term for such services as Applicant provides – *booking* services. Moreover, the advertising materials provided by the applicant do not appear to educate the public to associate the proposed mark with a single source, but are instead scattered throughout, as previously discussed, with *descriptive* uses of "BOOKING" throughout various portals and the FAQ.

In the HOTELS.COM case, the applicant presented vastly more evidence under Section 2(f) in an effort to demonstrate distinctiveness than the instant applicant. For example, they produced over 60 declarations from consumers, vendors and competitors in the field, as well as a consumer survey which purported to demonstrate that HOTELS.COM was perceived as a brand name instead of a common name. Though the survey was found to be flawed in its procedure, this was at the very least an effort by an applicant of the sort which might purport to show consumer recognition of a domain as a brand rather than merely identifying the commercial domain for the named "booking" services. No evidence of this character is provided by the Applicant in this case.

Accordingly, the Applicant's distinctiveness claim has been properly rejected, as the burden of demonstrating distinctiveness under this Section lies upon the Applicant, and insufficient evidence of this nature.

III. CONCLUSION

Although the examining attorney agrees, as Applicant points out, that any doubt on the question of genericness must be resolved in favor of publishing the mark for opposition, the examiner disagrees with Applicant that its evidence is sufficient to raise any such doubt about the genericness of BOOKING.COM. The wording of the proposed mark identifies the genus of services – reservation or "booking" services – provided via a commercial website, and any consumer with knowledge of such services would perceive the mark as referring to that genus. A substantial weight of dictionary evidence, commercial usage, and third party use militate toward a finding of its genericness.

In the alternative, the mark is so highly descriptive that the proffered evidence of 2(f) is insufficient, as Applicant has nowhere provided evidence of any sort to indicate that the mark is

perceived as a *brand* in commerce identifying the Applicant as a source. The whole of Applicant's evidence speaks only to the success of their website and consumer satisfaction with the quality of such services.

Although it is indeed a fateful step to "determine that a trademark is generic and thus pitch it into the public domain," such step is rendered less fateful when – as here – the grant of such a trademark on matter already widely claimed in that very same public domain by third parties would be unconscionable in its impact.

Respectfully submitted,

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