ESTTA Tracking number: **ESTTA666309**
Filing date: **04/13/2015**

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	Reply Brief
Attachments	APPLICANTS REPLY BRIEF.pdf(398807 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	04/13/2015

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

APPLICANT'S REPLY BRIEF

Applicant, Booking.com B.V. respectfully submits the following reply brief in support of its appeal of the 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"). The deadline to file this Reply Brief is Sunday, April 12, 2015. Applicant is thus timely filing it on Monday, April 13, 2015.

I. INTRODUCTION

The Examiner acknowledges that "[e]ach case is decided on its own facts, and each mark stands on its own merits." *AMF Inc. v. Am Leisure Prods, Inc.*, 474 F.2d 1403, 1406, 177 U.S.P.Q. 268, 269 (C.C.P.A. 1973). Yet, the Examiner declines to address most of the facts presented, including the recognition BOOKING.COM has achieved as the consumer-ranked

most trusted accommodations service in the country, as determined by the independent research service, JD Power. The Examiner likewise cherry-picks selective facts in failing to address the bulk of Applicant's evidence of secondary meaning. The Examiner further declines to acknowledge, much less distinguish, century-old controlling law, including *Estate of P.D. Beckwith v. Comm'r of Patents*, 252 U.S. 538 (1920), which confirmed the bedrock legal principle that a mark must be assessed in its entirety, not in pieces. This principle has been affirmed innumerable times since, including in cases assessing genericness (as at least one of the Examiners acknowledged). *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 U.S.P.Q.2d. 1807 (Fed. Cir. 2001). And rather than apply the primary significance test established in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938), and reaffirmed repeatedly since, the Examiner conflates the legal definitions of descriptiveness and genericness, attempting only to demonstrate that the word "booking" (alone) has a descriptive or suggestive meaning, without ever showing the mark BOOKING.COM is used by consumers to identify an entire class of services. Nor has the Examiner even properly defined the supposed class or genus of goods or services, which she now attempts by inexplicably excluding the majority of the services actually specified.

The proposal to strip BOOKING.COM of its status as a trademark and the identifier of the consumer-ranked most trusted accommodations service in the country is, moreover, impossible to reconcile with the very purpose of trademark law of protecting the right of the consumer to place his or her trust in indications of source of origin. The Examiner has not even tried, and she does not dispute that stripping the most trusted brand in the field of trademark protection is a betrayal of that trust.

These are not modest omissions or oversights. Every one of them requires rejecting the Examiner's conclusions that entail fundamentally redefining the legal concept of "genericness" so as to deny Applicant all trademark rights without any proper evidence that the "primary significance" of the name BOOKING.COM is as a generic term for an entire class of services. For all the reasons outlined below, the Examiner has not met her heavy burden to show by clear evidence that BOOKING.COM is generic or lacking secondary meaning pointing exclusively to Applicant, and the refusals to register should be reversed.

II. DEFINING THE GENUS AND RELEVANT CONSUMERS

Applicant and the Examiner agree that the determination of whether a mark is generic requires a two-step inquiry: (1) defining the genus of goods and/or services at issue; and (2) determining whether the relevant public understands the designation primarily to refer to that genus of goods and/or services. *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363, 92 U.S.P.Q.2d 1682, 1684 (Fed. Cir. 2009).

The Examiner objects to the Applicant's definition of the genus as "travel agency services" on the puzzling grounds that "Applicant's suggested genus is inaccurate since it encompasses services outside the scope of the International Class 043 services set forth in this application." (Examiner's Brief, unnumbered p. 5). The Examiner has apparently overlooked that "travel agency services" are the precise category of services claimed in Class 39 in applications Serial Nos. 79/114,998 and 85/485,097. Moreover, the additional services listed in Class 43 in the various applications, (*e.g.*, hotel reservation services, holiday accommodation reservation services and resort reservation services, providing information about hotels, hotel accommodations and resorts accommodations, information, advice and consultancy relating to making hotel reservations and others), are all the types of services that are typically provided by

travel agencies. Therefore, "travel agency services" is an accurate description of the genus of Applicant's services. The Examiner has not attempted to explain why it is not.

Instead, the Examiner concludes, without analysis, that the genus of services is "hotel reservation services," based simply on her observation that several of the services recited in the applications appear duplicative. This conclusion goes against the Examiner's own reasoning that the genus of services should encompass the full range of Applicant's services. Whereas "travel agency services" are broad enough to cover both the Class 39 and Class 43 services offered by Applicant, the much narrower and more specific alleged genus "hotel reservation services" covers none of the services in Class 39, and few of the services in Class 43, namely:

> 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;.
>
> 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 conclusion that the genus of services is merely "hotel reservation services" is plainly incorrect. Applicant again submits that the genus of services at issue (covering services in Classes 39 *and* 43) is "travel agency services." Travel agency services are not limited to reserving hotel rooms. To the extent any such services fall outside Class 43 (as the Examiner

notes), the remedy is not the Procrustean one of destroying Applicant's trademark, but rather, simply to acknowledge the actual scope of the services claimed.[1]

The Examiner identifies the relevant consumers as "all customary consumers of the services, including those who would need information on hotels and other forms of temporary lodging, or who would need to book or make reservations for the same." Notwithstanding the Examiner's circular definition that the relevant consumers of the services are "customary consumers of the services," Applicant submits that the relevant consumers 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. The Examiner's brief utterly fails to show that those consumers use the term BOOKING.COM generically (or even descriptively to refer to the full range of services provided). On this ground alone the refusals to register should be reversed.

III. CONTROLLING LAW

A. Examiner Ignores Supreme Court Precedent.

In its opposition brief, the PTO has not addressed the seminal Supreme Court precedent, *Estate of P.D. Beckwith,*, 252 U.S. 538, or explained why it has chosen to ignore one of the bedrock first principles of trademark law confirmed there by the Supreme Court, namely 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 . . ." *Id.*

---

[1] Unlike the cases cited by the Examiner, *In re Greenliant Sys. Ltd.*, 97 U.S.P.Q.2d 1078, 1082 (TTAB 2010), *In re Wm B. Coleman Co.*, 93 U.S.P.Q.2d 2019 (TTAB 2010), and *In re CyberFinancial.Net Inc.*, 65 U.S.P.Q.2d 1789 (TTAB 2002), BOOKING.COM is not a correct name for either the genus of the services (travel agency services) or the subject matter of the genus (travel and accommodations).

at 545-46. Rather than even mention *Estate of P.D. Beckwith* or address the first principle of trademark law that the commercial impression of a trademark is derived from it as a whole, not its component pieces, the Examiner states incorrectly – and without *any* citation – that a genericness analysis somehow does not require viewing the mark as a composite whole. (Examiner's Brief, unnumbered page 8). The Examiner is simply wrong. The Federal Circuit has confirmed to the contrary: genericness, like all trademark analysis, begins and ends with the entire mark (even if the individual elements can be considered as part of the analysis). *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 U.S.P.Q.2d 1807. *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 71 U.S.P.Q.2d 1370, 1374 (Fed Cir. 2004), likewise held that in assessing descriptiveness, the beginning and ending point is to view the mark in its entirety. The Examiner's fundamental error requires reversing the refusal to register.

Nor has the PTO mentioned a second seminal case, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938), much less explained why it likewise has chosen to ignore the guiding and controlling principle the Supreme Court established 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" (emphasis added). Instead, as explained below, the Examiner rests content to find a descriptive or suggestive meaning for the word "booking" alone as applied to a subset of Applicant's services, without ever addressing whether relevant consumers use the name BOOKING.COM to identify an entire class of services (even as limited improperly to hotel reservation services).

If there is a basis for distinguishing these cases or departing from settled law, the Examiner has failed to even try to explain that basis and, therefore, has not sustained her heavy burden of proving genericness.

B. In re Hotels.com is Inapplicable.

The Examiner makes a point of stating that genericness is highly fact-specific and that the primary significance among consumers of one alleged ".com" trademark does not necessarily apply to other ".com" trademarks. (Examiner's Brief, unnumbered page 15). Yet, the Examiner relies primarily on *In re Hotels.com,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009), without any effort to explain why the facts and issues there are controlling here or how that one decision frees her from applying settled law (law that was never even questioned in *In re Hotels.com*).

There is no indication that the applicant in *In re Hotels.com* raised the specific legal issues raised here. Here, Applicant has specifically argued that *Estate of P.D. Beckwith* and a century of subsequent cases, which require that a mark be considered in its entirety, is controlling law. There is no indication that the TTAB or the Federal Circuit court gave any consideration to *Estate of P.D. Beckwith* in the *In re Hotels.com* decisions, as this seminal case is not mentioned in those decisions (or by the Examiner here). Not only did *In re Hotels.com* nowhere suggest that it meant to depart from *Estate of P.D. Beckwith* (which of course it could not possibly overrule), it also did not purport to reexamine *In re Dial-A-Mattress* or countless other precedents, holding that a mark must be analyzed in its entirety to assess genericness.

In re Hotels.com distinguished *In re Dial-A-Mattress* on the basis that, unlike a telephone number which is a ten-digit number that can only be used by one entity at a time, multiple domain names can potentially contain the same root terms. However, Applicant has invoked *In re Dial-A-Mattress* for the proposition that a mark must be considered in its entirety. Even though the Federal Circuit there acknowledged that "(888)" was devoid of source-identifying significance and that "MATRESS" was a generic term for "mattresses," it 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. The Examiner here has failed to explain why the Federal Circuit's analysis in *Dial-A-Mattress* is not equally applicable here.

These controlling cases are fundamentally at odds with the Examiner's analytical approach of refusing even to consider BOOKING.COM in its entirety. Only by *en banc* decision could the Federal Circuit overturn its prior precedents, Fed. Cir. R. 35(a)(1), and it cannot overturn the Supreme Court. *In re Hotels.com*, which did not purport to establish any broad principles applicable to other .com marks, is, on its face, thus limited to its facts.

Regarding the facts of the respective cases, the principal issues in *In re Hotels.com* were the inadequacies of a survey conducted by the Applicant and the unpersuasiveness of 64 identical cookie-cutter declarations.[2] Here, by contrast, the PTO never purported to criticize the reliability or correctness of the JD Power survey finding BOOKING.COM to be the most trusted brand in the field. Certainly there was no evidence that "Hotels.com" had become the most trusted brand in the field. Moreover, the specification in *In re Hotels.com* was for hotel reservations only.[3] Further, unlike this case, where even the dictionary definitions for the word "booking" show its primary significance to be theatrical arrangements, the word "hotel" has one and only one meaning.[4] (Nor are there any known exact synonyms for "hotel," whereas the English language

---

[2] Ironically, the Examiner chides the Applicant in this case for not submitting similar declarations (Examiner's Brief unnumbered page 20), notwithstanding that the *In re Hotels.com* declarations were afforded virtually no probative value by the TTAB.

[3] The specification of services for Serial No. 78/277681 was: "providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network," in Class 43.

[4] 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, 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."

is rich with actual generic terms competitors can use for Applicant's services, such as "travel agency," "travel site," "accommodations site" etc.). 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) – often within the same article or advertisement – is *prima facie* evidence that the consuming public distinguishes between the two terms and that the relevant consumers perceive Applicant's mark as a source-identifier.

Utterly at odds with the Examiner's exclusive reliance on a holding that the third-party mark, HOTELS.COM was not registrable, the Examiner urges the Board to reject evidence as to how regularly the PTO registers other .com marks incorporating wholly descriptive terms (*see* Appeal Brief, p. 24 n. 6) because "[e]ach case is decided on its own facts, and each mark stands on its own merits." *AMF Inc.*, 474 F.2d at 1406, 177 U.S.P.Q. at 269. The point is, such .com marks plainly can and regularly do function as trademarks; that one such mark (HOTELS.COM) was rejected implies little about the specific facts here or the merits of this case.

If the Examiner wishes to take the position that consumers cannot tell the difference between the term "BOOKING" alone and "BOOKING.COM" or in fact do not distinguish between the two, it would be the Examiner's burden to prove that position by "clear evidence" (see *infra* Section IV). Whether that standard was met in *In re Hotels.com* does not mean it has been met here. Just as anyone can tell the difference between the river "Amazon" and the retailer "Amazon.com" or between the generic term for metal fasteners (or supplies in general) and the retailer "Staples.com," it is scarcely conceivable that consumers simply cannot tell the

---

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.

difference between the fundamentally ambiguous word "booking" (having multiple meanings) and the most trusted travel agency BOOKING.COM. Yet the Examiner has not even endeavored to satisfy her burden of identifying the relevant class of customers, much less identifying the genus of services or any actual use of the term in a generic sense by relevant consumers. Nor has she attempted to show how consumers could have come to recognize BOOKING.COM as the most trusted accommodations service if they were unable even to distinguish it from other accommodations services.

IV. DESCRIPTIVENESS NOT SUFFICIENT TO PROVE GENERICNESS

Proceeding from the false premise that the genus of services is "hotel reservations services," the Examiner circularly concludes that "booking" of hotel rooms merely describes the services. (Examiner's Brief, unnumbered p. 5).

More important, the Examiner has again misstated the test of genericness by conflating mere descriptiveness with genericness. While it is true that the *descriptiveness* of a mark is assessed simply in view of the goods specified,[5] the *genericness* of a term requires a deeper analysis. It requires proof that members of the relevant public *primarily* use *the actual term sought to be protected* to refer to the genus of goods or services in question. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 U.S.P.Q.2d 528, 530 (Fed. Cir. 1986). Under this test, the record evidence would have to demonstrate that the relevant public *primarily* uses BOOKING.COM (the term sought to be protected) to refer to travel agency services in

---

[5] In all of the cases cited by the Examiner, *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 U.S.P.Q.2d 1753 (Fed. Cir. 2012), *In re The Chamber of Commerce of the U.S.*, 102 U.S.P.Q.2d 1217 (Fed. Cir. 2012), *In re Polo Int'l Inc.*, 51 U.S.P.Q.2d 1061 (TTAB 1999), *In re Digital Research Inc.*, 4 U.S.P.Q.2d 1242 (TTAB 1987), and *In re American Greetings Corporation*, 226 U.S.P.Q. 365 (TTAB 1985), the only issue before the respective tribunals was the *descriptiveness* of the mark. The Examiner has cited no case dispensing with the primary significance test in assessing genericness.

general (the genus of services in question) as distinct from Applicant's travel agency services. This is plainly not the case.

In the leading case *H. Marvin Ginn*, the Federal Circuit reversed the TTAB for similarly conflating descriptiveness and genericness and failing to consider the primary significance of the term itself among consumers in determining whether the term is generic. *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). The Federal Circuit summarized the TTAB's erroneous reasoning as follows:

> [The Board reasoned] that "Fire Chief" designates a very particular and definable target audience to which Ginn's and other's [sic] publications were directed. The board reasoned that "the fact that a 'fire chief,' by definition, is a person in the fire service, rather than a magazine . . . is not conclusive of that term's non-genericness." Moreover, said the board, "that a term does not designate a particular class of magazine, is not crucial to a genericness holding, if the term designates a definable target audience to which the publication is directed." 225 U.S.P.Q. at 946. The board then found, *inter alia*, that Ginn's "magazine FIRE CHIEF is and has always been edited, circulated, and promoted with a view primarily to fulfill the needs and professional interests of fire chiefs." Based on these findings and the statements of law noted above, the board concluded that "the term 'Fire Chief' would be perceived by the relevant public as a generic or common descriptive term for a magazine of the type in respect of which the registration sought to be cancelled is used.

Id. The Federal Circuit reversed the TTAB, finding this reasoning to be clear error based on its own two step genericness analysis. In the first step, the Federal Circuit defined the genus of goods as "magazines directed to the field of firefighting." In the second step, the Federal Circuit concluded there was no record evidence that suggests the relevant portion of the public refers to a class of firefighting *publications* as "Fire Chief," nor is "Fire Chief" the name of the fire-fighting industry. Thus, while the Federal Circuit agreed that "Fire Chief" was *descriptive* of the target audience of the magazines, it was not *generic* for the class of goods. There was no evidence that the *primary significance* of "Fire Chief" was "magazines directed to the field of firefighting."

This critical second step of the two-step analysis is entirely missing from the Examiner's analysis here. There is no evidence that, to the relevant class of consumers, the *primary* significance of "BOOKING.COM" is "travel agency services" in general. Merely to argue that a term describes one feature of the goods or services misses the heart of the meaning of genericness: is the *primary significance* of the term to relevant consumers to identify the entire class of goods or services?[6] The Examiner cites no pertinent authority to support replacing the primary significance test with a mere descriptiveness test and, hence, could not be more incorrect in asserting that the existence of other meanings of the word "booking" (such as criminal bookings or its actual primary meaning in U.S. dictionary, theatrical bookings") are irrelevant. Such other meanings might matter less if only descriptiveness were at issue, but are highly relevant to genericness. The existence of alternate meanings of the wording at issue precisely calls into question what is the "primary" significance of the term "booking" (not even BOOKING.COM) to consumers. *See, e.g., Calista Enters. v. Tenza Trading Ltd.*, 43 F. Supp. 3d 1099, 2014 U.S.Dist. Lexis 109509 at *43 (D. Ore. 2014) (competing dictionary definitions of the individual terms raised a genuine issue of material fact as to the primary significance of the composite mark). Indeed, it is fundamentally inconsistent for the Examiner both to assert that the Board should give weight to dictionary definitions of the word "booking" while at the same time telling the Board to shield its eyes from some of those definitions (including the *primary* definition) that undermine the Examiner's argument.

---

[6] As Applicant previously argued, the Examiners' arguments all seem to confuse mere descriptiveness with genericness. On appeal, the Examiner continues to conflate the two by relying on *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 71 U.S.P.Q.2d 1370 (Fed Cir. 2004), which held only that the claimed mark "Patent.com" was *descriptive* (not generic), and in so doing reaffirmed the signal importance of *P.D. Beckwith* and *Dial-A-Mattress* in requiring that marks be construed in their entireties, not broken into constituent elements.

Likewise, the clarifying language that appears in virtually all of the third-party use of "bookings," including the USPTO ID Manual and in dictionary definitions, is evidence that the relevant public does not use or understand the designation sought to be registered – BOOKING.COM (not "hotelbooking.com" or "travelbooking.com") – to refer to a general class of goods or services. The word "booking" simply is not used on its own in this manner. This contrasts sharply with HOTELS.COM where the root term "hotels" is the common commercial name for a type of temporary accommodation (for which there is *no* exact synonym) without the need for any clarification or qualifying language explaining the meaning of "hotels."

Laying aside that applicant's mark is BOOKING.COM, not "booking," there is no evidence that the primary significance of this term among consumers is to name the entire class of applicant's services, even if the name is suggestive of or descriptive of those services. Indeed, it is undisputed that none of Applicant's competitors (such as Expedia, Orbitz or Travelocity) refer to themselves as "BOOKING.COM's." The Examiner includes examples of a few domain names in which the term "booking" appears as *part* of the URL to support the proposition that competitors need to use BOOKING.COM to describe competing services. (Examiner's Brief, unnumbered page 13). 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. Moreover, of the eight domain names cited in the Examiner's brief, only four even use the letter

string "booking.com" in the URL. (Examiner's Brief, unnumbered page 13). Because each is modified by other specific terms (*e.g.*, "securehotelbooking.com"), they confirm that "booking.com" alone is ambiguous and has no clear meaning (much less the primary meaning of designating an entire class of services). All are irrelevant to prove genericness (except to *disprove* that the name "BOOKING.COM" alone is generic!). The other four (bookingbuddy.com, fastbooking-hotels.com, Marriott.com, hotelbookingsolutions.com) are likewise wholly irrelevant.

The most that the Examiner's evidence shows is that the word "booking" is descriptive or suggestive of some of applicant's services; not that any consumers use the word "booking," much less applicant's actual mark, BOOKING.COM, as a generic term for travel agency services. There is no evidence, for instance, that a single consumer of such services has ever said (or would ever say) something like "I called my '*booking*' to plan a trip" or "I went online to my 'BOOKING.COM' to reserve a hotel room." If the Examiner wishes to argue that "BOOKING.COM" is descriptive or suggestive of travel agency services, that at least is intellectually coherent and could be argued in a manner consistent with the TTAB policy and Federal Circuit holding in *In re Oppedahl & Larsen LLP*, *supra*, of treating .com trademarks combining descriptive terms with the TLD designator as *descriptive* (not generic). But that alone does not signify that the primary significance of the name BOOKING.COM is to denote an entire class of travel agency services. Indeed, there is no need for subtle legal arguments to address the actual test of genericness, which is the primary significance of the term to ordinary consumers. The test is based on simple semantics and grammar, and if you cannot use the word as a generic term in a sentence, it clearly is not generic.

In this instance, it also requires betraying the trust of the millions of consumers who have made BOOKING.COM the most trusted accommodations service in this country. Why the Examiner believes such an exercise is proper exercise of the PTO or can be reconciled with the broader purpose of the Lanham Act of preventing consumer confusion is not clear – because the Examiner has not attempted to say.

V. EVIDENCE OF GENERICNESS NOT 'CLEAR AND CONVINCING'

The Examiner has a heavy burden to show by "clear evidence[7]" that the primary significance of the mark in issue, BOOKING.COM, is generic. As a matter of *fact*, the primary significance of the name BOOKING.COM plainly is to designate only Applicant's accommodations and travel agency services, which is why it is the **consumer-ranked most trusted** accommodations website in the United States (Ser. No. '366, Resp. dated May 15, 2014, pp. 84-94). Yet the PTO disregards this central fact, as well as every other fact that is inconsistent with what appears to be a preconceived conclusion. Indeed, the Examiner does not dispute that consumers in fact rely on BOOKING.COM as identifying the most trusted accommodations site, but nonetheless urges this Board to betray the trust of such consumers, hence defeating the very purpose of the Lanham Act, which is to protect consumers against the confusing and deceptive use of recognized trademarks.

The Examiner does expressly acknowledge the fundamental rule that "[e]ach case is decided on its own facts, and each mark stands on its own merits," *AMF Inc.*, 474 F.2d at 1406, 177 U.S.P.Q. at 269, yet conspicuously fails to address the facts here. The key facts are these: There are no third party uses of BOOKING.COM that refer to anything other than Applicant and

---

[7] *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1576, 1571 (Fed. Cir. 1987); *Trademark Manual of Examining Procedure* 1209.01(c)(i) (8th Ed., revised April 2013).

its services. The relevant public routinely distinguishes between BOOKING.COM and "booking" in the Examiners' own evidence, using BOOKING.COM as a source-identifier to refer to Applicant and "booking" as a descriptive term. There is no evidence in the record that competitors need to use BOOKING.COM to accurately name their services and, indeed, Applicant's competitors, such as Travelocity, Orbitz, Hotwire, TravelZoo and other travel and accommodations sites all manage to convey the nature and content of their services without using BOOKING.COM. There are myriad other common commercial names for Applicant's services, including travel agency services, accommodations sites, travel sites, online travel company (which are actually used in the industry), such that competitors will be able to accurately describe all features of their services even if Applicant is permitted to protect the rights it has developed over many years in the specific mark BOOKING.COM. Applicant has been recognized by consumers and by the industry as the most trusted provider.

As noted at the outset, these are not modest omissions or oversights. Every one of them requires rejecting the Examiner's conclusions that entail fundamentally redefining the legal concept of "genericness" so as to strip Applicant of all trademark rights without even a whisper of evidence that its trademark, BOOKING.COM has **ever** been used **by anyone** as a generic term, much less that the "primary significance" of the term is as a generic indication for *something* (still undefined in view of the Examiner's inexplicable choice of genus), and without any suggestion how, grammatically, it is even possible to use the trademark generically.

Ignoring the fact that customers plainly do recognize BOOKING.COM as a trademark, and indeed have made it the most trusted accommodations service in the country, the Examiner offers only her bald conclusion that "each of the terms BOOKING and .COM has a clear and readily understood meaning." (Examiner's Brief at unnumbered p. 9), citing *In re Gould Paper*

Corp., 834 F.2d 1017, 5 U.S.P.Q.2d 1110, 1111 (Fed. Cir. 1987). The Examiner ignores that *Dial-A-Mattress* imposed a significantly higher and more specific burden on the Examiner than that applied fourteen years earlier in *In re Gould*:

> We conclude that the board applied the wrong test in holding that the Director meets his burden of proving an alphanumeric telephone number generic merely by showing that it is composed of a non-source-indicating area code and a generic term. "The 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. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920). The Director must produce evidence of the meaning the relevant purchasing public accords the proposed mnemonic mark "as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1348, 51 U.S.P.Q.2d at 1836; see also *H. Marvin Ginn Corp.*, 782 F.2d at 990-91, 228 U.S.P.Q. at 530. ***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.

In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001) (emphasis added). 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 compound word SCREENWIPE in *In re Gould* that can be used in a grammatically coherent fashion to refer generically to any number of wipes for computer screens, it is *impossible* to use BOOKING.COM in a grammatically coherent way to refer generically to anything.

VI. EXAMINER IGNORES ACQUIRED DISTINCTIVENESS EVIDENCE

The Examiner gives virtually no consideration to Applicant's substantial evidence of acquired distinctiveness.

The Examiner discounts the JD Power and Associates survey evidence recognizing BOOKING.COM as first in consumer satisfaction by asserting – without any citation to legal authority – that "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." (Examiner's Brief, unnumbered page 19). It makes no sense, however, to assume consumers could rank BOOKING.COM as performing better than other comparable service providers, such as Hotwire and Priceline (the providers ranked second and third, respectively), if the consumers did not recognize BOOKING.COM as identifying a single source of services. The Examiner certainly has not attempted to explain her position. Moreover, the Examiner's conclusion controverts settled case law and legislative history. "Trademarks provide a short-hand means of enabling the buyer to distinguish the goods of one producer from the goods of others." *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 300 (3d Cir. 1986). "[T]he primary significance of the mark to consumers is to identify a product or service which emanates from a particular source, known or unknown, for it still provides the assurance to the public that the product is of uniform quality and performance." S. Rep. No. 98-627, 98th Cong., 2d Sess., 5 (1984), reprinted in [1984] U.S. Code Cong. & Ad. News, 5718, 5722 Senate Report (internal citations and quotations omitted); *accord In re DC Comics*, 689 F.2d 1042, 1054, 215 U.S.P.Q. (BNA) 394 (C.C.P.A. 1982) (Nies, J., concurring). Thus, by recognizing that services provided under BOOKING.COM are of a high quality, consumers are thereby also recognizing that the mark BOOKING.COM identifies a single source of services. As explained in the record, the JD Power and Associates award is based on a survey of over

2,000 consumers who made an online purchase from an independent travel website within the past 12 months. ('366, Resp. to Office Action dated May 15, 2014 at 55). Thus, the consumer opinion measured by this survey is that of the "relevant public" for this genericness and secondary meaning determination. The only actual evidence regarding the mark confirms that the relevant public clearly views BOOKING.COM as a source-identifier.

The Examiner also asserts, again without any citation to legal authority, that Applicant's very high revenues demonstrate the success of Applicant's website, but do not demonstrate that the relevant consumers have to come to view BOOKING.COM as Applicant's mark. This distinction defies logic. Applicant's services are offered through Applicant's website which is branded with Applicant's applied-for mark. The Examiner has failed to explain how it is possible that over 10 million unique U.S. customers seek out Applicant's services through its branded website on a monthly basis and conduct billions of dollars' worth of transactions through that website if those consumers fail to recognize BOOKING.COM as identifying a single source. Moreover, the record is replete with screenshots from Applicant's website that show BOOKING.COM used in a trademark manner on the website. (*See, e.g.*, Office Action dated Nov. 16, 2013 at 105-110).

The Examiner has not even addressed the plethora of other evidence of acquired distinctiveness submitted by Applicant including that:

a) the total transaction value of mobile accommodation reservations made through the BOOKING.COM website *more than doubled* from over $3 billion in 2012 to over $8 billion in 2013, demonstrating significant and growing consumer trust and recognition in Applicant's brand and service;

b) over 625,000 room nights are reserved through Applicant's BOOKING.COM service *every day*;

c) Applicant's broadcast and digital advertising has reached many millions of American consumers, including over 20 million (20,000,000) American consumers through commercials broadcast in movie theaters prior to feature films

and over 19 million (19,000,000) American consumers through Internet commercials streamed on websites such as Hulu.com, Tremor.com, and YouTube.com;

d) Applicant's BOOKING.COM branded website receives, on average, 10.3 *million* unique visitors from the United States *per month*, demonstrating broad consumer recognition of Applicant's mark as a source-identifier;

e) Over 2 million Americans have affirmatively sought to join Applicant's BOOKING.COM mailing list, demonstrating significant consumer loyalty;

f) Over 2.7 million members of the relevant public have "liked" Applicant's brand and nearly 58,000 members of the relevant public are "talking about" Applicant's brand on Facebook.com, higher than other accommodations and travel companies such as TRAVELOCITY, HOTELS.COM, TRAVELZOO, and ORBITZ;

g) Over 53,200 members of the relevant public are "following" Applicant's brand on the micro-blogging website Twitter, more than other travel and accommodations sites like HOTELS.COM, TRIVAGO, and HOTWIRE;

h) Customers frequently use @bookingcom to engage Applicant in dialogue through Twitter, demonstrating recognition of BOOKING.COM as a unique source identifier;

i) A search for Applicant's mark BOOKING.COM on the Google News service generated over two thousand (2,000) unsolicited news articles;

j) There are tens of thousands of unsolicited consumer reviews of the BOOKING.COM service on third party review websites, demonstrating significant consumer recognition of BOOKING.COM as pointing to a single source of services;

k) Applicant has received industry awards from Hospitality Sales & Marketing Association International and Mobile Travel and Tourism;

l) Applicant owns a Principal registration for BOOKING.YEAH, a Supplemental registration for BOOKINGS.COM, and a Principal registration for B-dot logo, and uses these marks together so as to build a unified "BOOKING (dot)" brand.

m) Applicant has been using the mark BOOKING.COM since June 2006, a period of nearly nine years.

The social media and mailing list figures demonstrate that millions of members of the relevant public recognize BOOKING.COM as a trademark and are sufficiently engaged with that brand to request advertisements from Applicant through these channels. This is concrete

evidence that Applicant's efforts to develop distinctiveness have succeeded, and customers recognize BOOKING.COM as a source identifier. The sheer volume of unsolicited news articles and unsolicited consumer reviews discussing Applicant's BOOKING.COM service also demonstrates an enormous public recognition of Applicant's mark as a source identifier.

VII. REQUEST FOR ORAL HEARING

A separate request for oral hearing is being filed concurrently with this Reply Brief.

VIII. CONCLUSION

"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). The Examiner does not dispute that refusing to protect the mark identifying the most trusted travel accommodations service in the United States 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 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. As a matter of law and fact, BOOKING.COM functions as a trademark identifying Applicant as the source of the travel agency services offered under the mark and must not be pitched into the public domain.

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

or 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: April 13, 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 CONTENTS

Page(s)

I. INTRODUCTION 1

II. DEFINING THE GENUS AND RELEVANT CONSUMERS 3

III. CONTROLLING LAW 5

A. Examiner Ignores Supreme Court Precedent. 5

B. In re Hotels.com is Inapplicable. 7

IV. DESCRIPTIVENESS NOT SUFFICIENT TO PROVE GENERICNESS 10

V. EVIDENCE OF GENERICNESS NOT 'CLEAR AND CONVINCING' 15

VI. EXAMINER IGNORES ACQUIRED DISTINCTIVENESS EVIDENCE 18

VII. REQUEST FOR ORAL HEARING 21

VIII. CONCLUSION 21

TABLE OF AUTHORITIES i

TABLE OF AUTHORITIES

Page(s)

Cases

A.J. Canfield Co. v. Honickman,
808 F.2d 291 (3d Cir. 1986) 17

AMF Inc. v. Am Leisure Prods, Inc.,
474 F.2d 1403, 177 U.S.P.Q. 268 (C.C.P.A. 1973) 1, 9, 15

Calista Enters. v. Tenza Trading Ltd.,
43 F. Supp. 3d 1099 (D. Ore. 2014) 12

DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.,
103 U.S.P.Q.2d 1753 (Fed. Cir. 2012) 10

Estate of P.D. Beckwith v. Comm'r of Patents,
252 U.S. 538 (1920) ..... passim

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) 10, 11, 16

In re American Greetings Corporation,
226 U.S.P.Q. 365 (TTAB 1985) 10

In re CyberFinancial.Net Inc.,
65 U.S.P.Q.2d 1789 (TTAB 2002) 4

In re DC Comics,
689 F.2d 1042, 215 U.S.P.Q. (BNA) 394 (C.C.P.A. 1982) 18

In re Dial-A-Mattress Operating Corp.,
240 F.3d 1341, 57 U.S.P.Q.2d. 1807 (Fed. Cir. 2001) 2, 7, 11, 16

In re Digital Research Inc.,
4 U.S.P.Q.2d 1242 (TTAB 1987) 10

In re Gould Paper Corp.,
834 F.2d 1017, 5 U.S.P.Q.2d 1110 (Fed. Cir. 1987) 16, 17

In re Greenliant Sys. Ltd.,
97 U.S.P.Q.2d 1078 (TTAB 2010) 4

In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.,
828 F.2d 1576 (Fed. Cir. 1987) 14

In re Oppedahl & Larsen LLP,
373 F.3d 1171, 71 U.S.P.Q.2d 1370 (Fed Cir. 2004) 6, 11, 14, 16

In re Polo Int'l Inc.,
51 U.S.P.Q.2d 1061 (TTAB 1999) 10

In re The Chamber of Commerce of the U.S.,
102 U.S.P.Q.2d 1217 (Fed. Cir. 2012) 10

In re Vicki Roberts,
87 U.S.P.Q.2d 1474 (TTAB 2008) 13

In re Willhiam H. Eilberg,
49 U.S.P.Q.2d 1955 (TTAB 1998) 13

In re Wm B. Coleman Co.,
93 U.S.P.Q.2d 2019 (TTAB 2010) 4

James Burroughs, Ltd. v. Sign of the Beefeater, Inc.,
540 F.2d 266, 192 U.S.P.Q. 555 (7th Cir. 1976) 21

Kellogg Co. v. National Biscuit Co.,
305 U.S. 111 (1938) 2, 6

Ty, Inc. v. Softbelly's Inc.,
353 F.3d 528 (7th Cir. 2003) 21

Statutes

15 U.S.C. § 1052(e)(1) 22

Rules

Fed. Cir. R. 35(a)(1) 7

Other Authorities

S. Rep. No. 98-627, 98th Cong.,
2d Sess., 5 (1984), reprinted in [1984] U.S. Code Cong. & Ad. News,
5718, 5722 Senate Report 18

Trademark Manual of Examining Procedure 1209.01(c)(i)
(8th Ed., revised April 2013) 14