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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
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Submission	SUPPLEMENTAL BRIEF TO ADVISE OF NEW FEDERAL CIRCUIT CASE
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Vanguard clarifies that the legal standard for assessing the genericness of “compound terms” and “phrases” is the same: the PTO must prove that the relevant public primarily understands the mark *as a whole* to refer to the genus of goods or services at issue.

Federal Circuit Decision

In *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 U.S.P.Q.2d 1949 (T.T.A.B. Feb. 28, 2014), the Board in the first instance acknowledged that the ultimate inquiry is whether the mark as a whole is generic, but stated that “in cases where the proposed mark is a compound term (in other words a combination of two or more terms in ordinary grammatical construction), genericness may be established with evidence of the meaning of the constituent words. By contrast, where the proposed mark is a phrase . . . the Board cannot simply cite definitions and generic uses of the constituent terms of a mark; it must conduct an inquiry into the meaning of the disputed phrase as a whole.” *Princeton Vanguard*, Slip Op. at 9. Under this analytical framework, the Board found the mark PRETZEL CRISPS to be generic. 109 U.S.P.Q.2d at 1960.

The Federal Circuit reversed the Board on the basis that it had applied the incorrect legal standard. Slip Op. at 19. Specifically, the Federal Circuit clarified that there is no “compound term” and “phrase” dichotomy in the standard for analyzing whether a mark is generic. Rather, “there is only one legal standard for genericness: the two-part test set forth in *Marvin Ginn*¹... [T]o determine whether a mark is generic under that test, the Board must first identify the genus of goods or services at issue, and then assess whether the public understands the mark, *as a whole*, to refer to that genus.” Slip Op. at 9 (internal citations omitted, emphasis in original).

¹ *Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 U.S.P.Q. 528 (Fed. Cir. 1986).

Applicability to Present Case

The Examiners here consistently have applied this incorrect legal standard in assessing the alleged genericness of BOOKING.COM. In her Appeal Brief, the Examiner likewise states:

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... 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.'

Examiner's Appeal Brief at 12-13 (citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987)) (brackets and emphasis in original). This reasoning is directly contrary to the holding in *Princeton Vanguard*.

As Applicant has repeatedly asserted, a genericness inquiry must consider the mark, *as a whole*. It is not sufficient for the Examiner to proffer evidence of the meaning of the individual elements of a mark in lieu of evidence that the mark, *as a whole*, is likely to be viewed as generic by the relevant public. In this case, the only record evidence related to use and public perception of BOOKING.COM *as a whole* shows that the relevant public recognizes the wording as a source-identifying trademark. Applying an incorrect test, the Examiner has not shown or attempted to show otherwise.

Applicant requests that the Board consider the Federal Circuit decision in *Princeton Vanguard* in analyzing the facts and arguments of this consolidated appeal.

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Respectfully submitted,
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