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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85485097

MARK: BOOKING.COM

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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

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EXAMINING ATTORNEY'S SUPPLEMENTAL APPEAL BRIEF

INTRODUCTION

The Applicant filed a Supplemental Brief, upon the belief that a recent decision from the Federal Circuit bears directly and immediately upon the proceedings. Specifically, their supposition is that the case in question, *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc., (*hereafter, *Princeton Vanguard*),

alters the applicable law or standards at issue in this proceeding. Appeal No. 14-1517 (Fed. Cir. May 15, 2015). For the reasons which follow, *Princeton Vanguard* neither constitutes a divergence in the case law and standards for determining genericness, nor is it a sufficiently analogous case to the facts at hand to warrant special consideration.

LEGAL STANDARD FOR DETERMINING GENERICNESS

First and foremost, the legal standard for determining genericness has not changed, nor does *Princeton Vanguard* represent an adjustment in that standard or the legal precedence which has long governed this area of trademark law. Specifically, the longstanding line of precedence still follows the dictates of *In re Gould Paper Corp*., 834 F.2d 1017 (Fed. Cir. 1987) and *In re Am. Fertility Soc'y*, 188 F.3d 1341 (Fed. Cir. 1999), and it is clear from the penned decision of the Federal Circuit that these cases and their legal guidelines are still considered precedential. Nowhere in the decision does the Federal Circuit suggest that the Trademark Trial and Appeal Board, nor examining attorneys, cease to rely upon these longstanding lines of cases and guidance.

Rather, the Federal Circuit merely notes that the Board, in the case of their analysis of PRETZEL CRISPS, applied the incorrect standard in differentiating their treatment according to whether the mark at issue was a compound term or a phrase. The test which the Federal Circuit highlights as being correct, however, is the *very same test* which the examining attorney has already applied herein: that, first, the genus of goods or services be identified (which in the instant case, is *booking services for travel and accommodation reservations*) and, second, that the examiner and the Board assess whether the public understands the mark to *refer* to that genus of goods or services. This, too, was demonstrated by the examining attorney via copious uses of the term BOOKING in use by both the Applicant themselves on their own websites in describing the nature of their services, by third parties on their own booking websites, and further, by numerous entities utilizing both BOOKING *and* BOOKING.COM as a portion of

their website URLs for booking websites for travel accommodations, the very same services offered by the Applicant in part. Applicant's mark is a commercial website (".COM") for *booking travel and accommodations* (BOOKING). The relevant standard insisted upon by the Federal Circuit, therefore, *was* in fact applied in this case and further, *Princeton Vanguard* as a result does **not** constitute any divergence from the current standards of practice for determining genericness.

FACTS AT HAND ARE NOT ANALOGOUS

Finally, the facts at hand for *Princeton Vanguard* are not analogous, here, regardless. *Princeton Vanguard*, whether it involved a compound term or a phrase, does *not* involve the use of a top level domain (hereafter "TLD") as part of the mark. A strong, unbroken line of cases, better discussed in the examining attorney's initial brief, have made the guidelines for establishing whether a mark containing a TLD is considered generic quite explicit. *See, e.g., In re Hotels.com, L.P., 2008 TTAB LEXIS 60 at 14 (TTAB, Mar. 24, 2008)*. Of specific and *highly* relevant note, here, is that the HOTELS.COM case **also** rose to the level of the Federal Circuit, and the mark was *affirmed* as being generic. There, the **Federal Circuit** agreed that the correct legal standard for the second part of the test, in assessing whether the public would view a mark containing a TLD as being generic for goods/services, was whether the word attached to the TLD was generic for such goods/services, and that the addition of the TLD did not in any way alter the mark such that it was greater than the sum of its generic term and the commercial online entity indication of ".COM." *In re Hotels.com, L.P.*, 91 USPQ2d 1532 (Fed. Cir. 2009). This was, in essence, the appropriate test for viewing the mark in its entirety when such a park constitutes, in part, a TLD.

This is, in part, one reason why Applicant's reliance on *Steelbuilding.com* is misguided; in that case, the determination that the mark was not generic turned not upon the addition of ".COM," but rather on the dual meaning of "steel building" as being either a building made of steel, as well as the act

of building *with* steel. Here, BOOKING possesses no such double entendre with respect to travel agency *booking* services.

In addition, the examining attorney takes this opportunity to bring to the attention of both the Board and the Applicant a far more analogous case which was likewise decided in the interim between briefing and the present. The Board affirmed a refusal to register BUYAUTOPARTS.COM on the Supplemental Register, finding the term to be generic for "on-line retail store service featuring auto parts." *In re Meridian Rack & Pinion DBA buyautoparts.com*, 114 USPQ2d 1462 (TTAB 2015).

In this precedential case, the Board explicitly noted that more than one term may be generic with regard to a particular product or services, which directly counters the Applicant's previous arguments that, because there are other words besides BOOKING available for reservations, BOOKING "cannot" be generic. *In re 1800Mattress.com*, 92 USPQ2d at 1685 ("We also disagree with [the] assertion that there can only be one generic term …. Instead, any term that the relevant

public understands to refer to the genus … is generic."). The Board has often held that a term that names the "central focus" or "key aspect" of a service is generic for that service. *See, e.g., In re*

Hotels.com LP, 573 F.3d 1300, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) ("hotels" identified the "central focus" of online lodging information and reservation services for lodging information and reservation services and therefore HOTELS.COM found generic); *In re Tires, Tires, Tires Inc.,* 94

USPQ2d 1153, 1157 (TTAB 2009) (where "tires" was the generic name of the goods sold in retail stores, being a "key aspect" of such services, TIRES TIRES TIRES was found generic for retail tire stores); *see also In re Candy Bouquet International, Inc.,* 73 USPQ2d 1883, 1891 (TTAB 2004) ("candy bouquet" is generic name for a certain type of gift package; therefore, "Candy Bouquet" is generic for retail, mail, and computer order services in the field of gift packages of candy); *In re A La Vieille Russie, Inc.,* 60 USPQ2d

1895, 1900 (TTAB 2001) (a term that is generic for a particular class of goods is also deemed generic for the services of selling those goods; “RUSSIANART” is generic for the services of selling such art).

Second, the Board found use of the phrase “BUY AUTO PARTS” by the Applicant on their own website to advertise their services to be highly persuasive that the phrase was considered a generic identification of the service being offered. Similarly, the examining attorney in the instant proceeding has shown that BOOKING.COM frequently has utilized the term “BOOKING” to describe the travel agency reservation services being offered.

Lastly, the Applicant in *BUYAUTOPARTS.COM* argued – as does the Applicant in BOOKING.COM – that, *even if* BUYAUTOPARTS was considered generic, the addition of “.COM” changed the commercial impression of the phrase and created a distinctive mark. The Board was unpersuaded, noting that ".com" is widely understood to refer to online commerce, and therefore the entire term BUYAUTOPARTS.COM as a whole is generic for applicant's services. Moreover, the Board remarked that the addition of a top level domain indicator to the generic name of the central focus or subject matter of a service does *not* transform the composite phrase into a registrable mark. *See In re 1800Mattress.com*, 92 USPQ2d 1682 (“mattress.com” is generic for online retail stores services selling mattresses); *In re Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (“hotels.com” is generic for reserving hotel rooms via a website); *In re Reed Elsevier Properties, Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (“lawyers.com” is generic for website providing information about law and lawyers).

CONCLUSION

Contrary to the Applicant’s assertions, the relevant standard for determining the genericness of a mark has not changed and, further, a far more analogous precedential case out of the Board in the interim reiterates the standard for determining the genericness of a TLD mark.

Respectfully submitted,

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