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PATENT & TRADEMARK OFFICE

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Attorney Ref.: 800832/S8232/GDK/mwp

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

In re the Matter of:

Application Serial No. 78/277681

Mark: HOTELS.COM

Applicant: Hotels.com, L.P.

Filing Date: July 23, 2003

APPLICANT'S REQUEST FOR REMAND OF APPLICATION TO EXAMINING ATTORNEY TO CONSIDER NEW EVIDENCE PURSUANT TO TRADEMARK RULE 2.142(d)

Applicant, by its attorney, hereby requests that action on the appeal continue to be suspended[1] and that the application be remanded to the Examining Attorney to consider newly obtained, significant evidence which bears on the issue on appeal, namely, the genericness or non-genericness of Applicant's mark, HOTELS.COM.

I. Background.

Applicant has sought to register the instant mark HOTELS.COM as well as the mark HOTELS.COM and Design,[2] both for services described as: "providing information for others about hotel reservations and temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network.

[1] Action on the appeal in this case has been suspended pursuant to the Board's July 26, 2005 Order.

[2] Serial No. 76/414,272 filed May 30, 2002.

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In both cases, the Examining Attorney has finally refused registration on the ground that the term HOTELS.COM is generic as applied to the recited services. In the instant case, the entire mark has been refused registration on genericness grounds. In the companion application, which involves the term HOTELS.COM together with a design component, the genericness refusal was manifested in the context of requiring a disclaimer of the assertedly generic designation HOTELS.COM, apart from the mark as shown.

It is Applicant's position, in both cases, that while HOTELS.COM may be descriptive of the recited services, it is not generic for those services and that the marks should be allowed registration on the Principal Register, pursuant to Section 2(f) of the Act, based on the extensive evidence of acquired distinctiveness, which evidence has been made of record in both cases.

Because the HOTELS.COM and design application, Serial No. 76/414,272 was filed earlier in time and was earlier ripe for appeal compared to this instant application, Applicant filed, on July 13, 2005, a request to suspend action on this appeal in order to allow the Board to decide the appeal in the HOTELS.COM and Design application Serial No. 76/414,272.

Applicant's request for suspension was granted by the Board, in an order dated July 26, 2005, and action on this appeal was suspended pending final determination in Serial No. 76/414,272.

II. <u>The Board Decision in Serial No. 76/414,272</u>.

Following appeal briefs and oral argument in Serial No. 76/414,272, the Board issued a decision on September 11, 2006. That decision, a copy of which is enclosed herewith, held that, based on the record before the Board, the term HOTELS.COM was generic and the Board, therefore, affirmed the Examining Attorney's requirement for a disclaimer of HOTELS.COM.

The Board's September 11, 2006 decision further held that, in the event it was ultimately held that the term HOTELS.COM was not generic, the evidentiary record was sufficient to demonstrate acquired distinctiveness of the term and the Board, therefore, reversed the Examining Attorney's refusal to accept the evidence of acquired distinctiveness of record in that case.

Applicant subsequently filed a request for reconsideration of the Board's September 11, 2006 decision and, on October 24, 2006, the Board denied the request for reconsideration. A copy of the Board's October 24, 2006 decision is enclosed herewith. Applicant, thereafter on December 19, 2006, submitted the required disclaimer of HOTELS.COM and it is expected that the HOTELS.COM mark and design will issue into a registration in due course.

III. Newly Obtained Evidence on the Issue of Genericness.

Following the Board's October 19, 2005 decision denying Applicant's Request for Reconsideration of the Board's decision in the HOTELS.COM and Design application Serial No. 76/414,272, Applicant decided to take the difficult, expensive and extraordinary step (in the context of an application for registration) of commissioning a nationally recognized survey expert to conduct a nationwide consumer survey to test consumer perceptions as to whether consumers perceive HOTELS.COM as a brand name or as a common (generic) name for the recited services.

Because of the unusual and expensive nature of this survey type evidence, in the context of an application for registration, it is submitted that it was reasonable, under the circumstances, not to undertake to obtain this survey evidence until the Board issued its decision in the earlier HOTELS.COM and Design application Serial No. 76/414,272. A favorable decision in the

earlier case would have obviated the need to obtain this survey evidence, with its attendant expense. Once Applicant received the Board's October 24, 2006 denial of Applicant's Request for Reconsideration, Applicant, through its attorneys, promptly began to identify and interview survey experts, following which Applicant retained its survey expert, Thomas D. Dupont, Ph.D., commissioned the survey and the survey was thereafter conducted and recently completed.

A. Applicant's Survey

Applicant conducted a classic "Teflon" genericness survey involving 277 Respondents comprising males and females over 18 years old who had either stayed at a hotel or motel in the last 12 months or who planned to in the next 12 months.[3]

After explaining to Respondents the differences between a brand name and a common name, and being tested for comprehension of the concept,[4] Respondents were asked about eight names of retail businesses, in randomized order. The question about HOTELS.COM, which illustrates the form of the question, was:

> "for a business that makes hotel reservations and provides information about hotels, would you say HOTELS.COM is a brand name or a common name?"

[3] In the Board's September 11, 206 decision in the HOTELS.COM and Design case, Serial No. 76/414,272, the Board found the services in Applicant's application to be an apt specification of the genus (p. 22). The Board concluded (p. 23) that the services are available to all customary consumers including those who would need information on hotels and other types of temporary lodging, or would need to book or make hotel reservations.

[4] Only Respondents who understood the concept continued with the survey.

As shown in the survey results attached hereto, HOTELS.COM was widely regarded as a brand name by 76% of the respondents.[5] Inasmuch as the weight of authority considers the principal or majority view controlling in a determination of genericness, it is submitted that a survey result of 76% perceiving HOTELS.COM as a (non-generic) brand name for Applicant's services is significant evidence of the non-genericness of the term. This is the conclusion of Dr. Dupont, Applicant's survey expert, and similar results in "Teflon" surveys conducted in other cases have been given substantial weight on this issue. See: McCarthy on Trademarks and Unfair Competition, Section 32:192 (2006), citing Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 160 USPQ 777 (S.D. N.Y. 1968); E.I. du Pont de Nemours & Co. v. Yoshida International, Inc., 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975).

Based on the facts and circumstances described herein, it is submitted that justice requires that Applicant's recently obtained survey evidence be considered as part of the evidentiary record in this case. As explained above, Applicant was justified in not going to the time and expense of conducting a nationwide genericness survey until it was clear that Applicant would be otherwise unable to prevail on the genericness issue, based on the evidentiary record, in view of the Board's decision (based on the identical evidentiary record) in the companion case of HOTELS.COM and design Serial No. 76/414,272.

B. Requested Action by Examining Attorney.

Given the overwhelming evidence of non-genericness as demonstrated in Applicant's survey, the Examining Attorney is respectfully requested to withdraw the genericness refusal.

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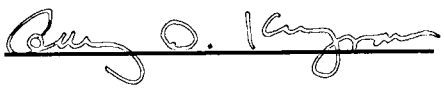
[5] TOYS R US and DAIRY QUEEN were recognized as brand names by more than 90% of Respondents, while AMAZON.COM was recognized as a brand name by 87%. By contrast, SEARCH ENGINE, NAIL SALON and FLORIST were widely recognized as common names.

Moreover, since the Board, in its September 11, 2006 decision in connection with the HOTELS.COM and Design application Serial No. 76/414,272, specifically found that Applicant's evidence of acquired distinctiveness was sufficient to warrant registration on the Principal Register, if the term HOTELS.COM was ultimately found non-generic, and since the evidence of acquired distinctiveness presented herein is the same as that presented in the earlier case, the Examining Attorney is respectfully requested to pass Applicant's mark to publication, pursuant to Section 2(f) of the Trademark Act.

Enclosed herewith are copies of the survey documents, including the survey expert's Statement of Responsibility, an explanation of the objective, methodology and conclusions of the survey, a summary of the survey findings, a summary of the survey expert's qualifications, and a copy of the questionnaire materials.

Respectfully submitted,

HOTELS.COM, L.P.

By: 

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Date: January 16, 2007

Enclosures: Survey
September 11, 2006 TTAB Order
October 24, 2006 TTAB Order

Survey To Determine Whether Consumers Perceive "HOTELS.COM" as a Brand Name or Generic Name

Submitted To:
Sughrue Mion PLLC

January, 2007

D² Research
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Kinnelon, NJ 07405
(973) 492-0100

#141-3-07

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STATEMENT OF RESPONSIBILITY

I, Thomas D. Dupont, Ph.D., designed and supervised the conduct of the survey described herein. All statements of findings and conclusions are my own. It is my opinion that my survey meets or exceeds the survey standards set forth in the Manual for Complex Litigation, Fourth, i.e.,

(a) The population was properly chosen and defined.

(b) The sample chosen was representative of that population.

(c) The questions asked were clear and not leading.

(d) The data gathered were accurately reported.

(e) The data were analyzed in accordance with accepted statistical principles.

(f) The survey was conducted by qualified persons following proper interview procedures.

(g) The process was conducted so as to ensure objectivity.

My findings and conclusions are set forth on the pages which follow.

The total cost of this survey, including my time to design and report it, will be approximately $24,000.

My qualifications, including publications in the past ten years and testimony in the past four years are appended in the section entitled "Expert Qualifications."

Dated this 15th day of January, 2007

Thomas D. Dupont, Ph.D.

INTRODUCTION

A. Objective

The survey described here was conducted to determine whether consumers perceive "HOTELS.COM" as a brand name or as a generic (common) name.

B. Method

A national probability double blind telephone survey was conducted employing the "Teflon"[1] methodology among 277 males and females age 18 and over in the continental United States who have stayed at a hotel or motel in the past 12 months or plan to in the next 12 months. Respondents were read a series of names, one at a time, and for each were asked whether it is a brand name or a common name. These terms were defined for respondents using the following examples:

- For a business that sells gasoline, SHELL would be a brand name and SERVICE STATION would be a common name.
- For a business that sells clothing, GAP would be a brand name and BOUTIQUE would be a common name.
- For a business that sells fast food, McDONALD'S would be a brand name and RESTAURANT would be a common name.

Respondents were screened for concept understanding by asking:

- For a business that sells HAIRCUTS, would you say BARBER SHOP is a BRAND NAME or a COMMON NAME?
- For a business that sells INSURANCE, would you say STATE FARM is a BRAND NAME or a COMMON NAME?

Anyone who did not reply that BARBER SHOP is a common name and STATE FARM is brand name was eliminated from the survey. Twenty-seven respondents (10%) were eliminated on those grounds, leaving an analytical sample of 250.

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[1] E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 525-527, 185 U.S.P.Q. 597, 615-16 (E.D.N.Y. 1975).

A more expansive description of the procedure may be found in the chapter entitled DETAILED METHODOLOGY. A copy of the questionnaire is appended.

CONCLUSIONS

The survey showed that 76% of respondents regarded HOTELS.COM as a brand name for a business that makes hotel reservations and provides information about hotels. Based on that I conclude that HOTELS.COM is considered by consumers to be a brand name.

SUMMARY OF FINDINGS

After hearing an explanation of the difference between a brand name and a common name, and being tested for comprehension of the concept (only those who understood the concept continued with the survey), respondents were asked about eight names of retail businesses, in randomized order. The question about HOTELS.COM, which illustrates the form of the question, was:

> "For a business that makes HOTEL RESERVATIONS AND PROVIDES INFORMATION ABOUT HOTELS, would you say HOTELS DOT COM is a BRAND NAME or a COMMON NAME?"

As shown in Table 1, DAIRY QUEEN and TOYS R US were recognized as brand names by more than 90% of respondents, and AMAZON.COM was very close behind at 87%. HOTELS.COM was also widely regarded as a brand name, by 76% of respondents. FLORIST, NAIL SALON and SEARCH ENGINE were widely regarded as common names.

Table 1

Perceptions of Whether Name is Brand Name Or Common Name (Base = 250 Respondents)

	Brand %	Common %	Other %	Don't Know %
TOYS R US	95	4	-	1
DAIRY QUEEN	92	6	*	1
AMAZON.COM	87	8	-	4
HOTELS.COM	76	20	-	4
SEARCH ENGINE	15	74	-	11
NAIL SALON	11	84	-	5
FLORIST	6	93	-	1

* Less than 0.5%

DETAILED METHODOLOGY

A. Sampling and Interviewing Specifications

A national probability sample of random telephone numbers was drawn to represent all residential telephone numbers in the 48 contiguous states and DC. In this way the sampling frame represented both listed and unlisted numbers and is statistically projectable to all telephone households in the United States (except Alaska and Hawaii).

From this national probability sample professional interviewers conducted calls to randomly select one person age 18 or over in each household to be surveyed. Screening questions identified qualified respondents, defined as persons who had either stayed at a hotel or motel in the past 12 months or planned to do so in the coming 12 months. The interview was conducted using computer-assisted telephone interviewing in which the survey questions appeared on the interviewer's monitor and the results were entered directly into the computerized database. A paper copy of the electronic questionnaire is appended.

Interviews were initiated with 277 qualified respondents. Twenty-seven respondents (10% of those initially interviewed) did not sufficiently understand the "brand name – common name" distinction, in that they were unable to correctly answer that "BARBER SHOP" is a common name and "STATE FARM" is a brand name. Survey results reported here are based on the 90% (250 respondents) who did understand the distinction.

The survey was double blind; neither interviewers, supervisors nor the respondents knew the identity of the client or the purpose of the survey. All interviewing was conducted January 5-10, 2007.

The 95% confidence limit sampling error associated with this survey is +/- 5%; if the survey was repeated 100 times, 95 times out of 100 the percentage of respondents replying that HOTELS.COM is a brand name would be within five percentage points above or below the 76% recorded in this survey.

B. Respondent Characteristics

The following table shows the gender and age of the survey respondents.

Respondent Age And Gender

	TOTAL %
Male	50
Female	50
18 - 24	5
25 – 34	9
35 – 44	19
45 – 54	23
55 - 64	23
65 OR OLDER	21
BASE	**250**

C. Validation

The standard method for validation of telephone surveys is monitoring, in which a supervisor listens in on interviews in progress. In this survey 82 (33%) of the interviews were monitored, a figure well in excess of the standard (15% - 20%) for such surveys.

EXPERT QUALIFICATIONS OF THOMAS D. DUPONT, Ph.D.

Background

I am an expert in the field of survey research and consumer behavior.

I received a B. A. in Psychology from Lake Forest College in 1965, a M.S. in Industrial Psychology from Purdue University in 1968 and a Ph.D. from Purdue in Consumer Psychology in 1970. From 1968-1970 I was on the teaching staff at Indiana University-Purdue University at Indianapolis, first as an Instructor and later as Assistant Professor, both in the Psychology department.

I am President of D^2 Research, located in Kinnelon, NJ. D^2 Research is a survey research and consulting firm that specializes in the application of social science research techniques to the field of marketing and consumer communications. The firm's clients include Abbott Laboratories, Coca-Cola, Hershey, Hertz, Johnson & Johnson, Kimberly-Clark, Sara Lee, and Schering-Plough.

Prior to forming D^2 Research in 1993 I was president of Oxtoby-Smith, Inc. in New York City. Oxtoby-Smith, which was founded in 1956 and ceased operations in November 1993, was a research and consulting firm that conducted a broad array of marketing and communications research for corporate clients. During the firm's existence it conducted over 4,000 surveys on a variety of topics. I was continuously employed by Oxtoby-Smith from 1970 until I resigned in March, 1993. I was President from 1989 - 1993; before that I held a succession of professional staff positions, beginning as a Project Director and ending as Executive Vice President.

Over the past 36 years I have personally conducted hundreds of research assignments on a variety of topics. The range of products and services I have studied has included alcoholic and non-alcoholic beverages, air travel, apparel, automobiles, food, financial services, proprietary drugs, telecommunications, and many others.

Aside from the projects I have personally conducted, I have had supervisory responsibility for many more, numbering in the thousands.

Among the professional associations in which I hold membership are the Market Research Council and the International Trademark Association. I have been active in the work of the Advertising Research Foundation (ARF) as a member of the Technical Advisory Committee, the Copy (Advertising) Research Council and the Research Quality Council. I have also spoken before the ARF Annual Conference and taught at the ARF "Smart" Seminar at the 1993 Annual Conference. In 1991 I was Chairman of the ARF Workshop on Research Quality.

I am active in the Council of American Survey Research Organizations (CASRO), the trade association of the U.S. survey research industry whose 300+ member firms conduct the vast majority of U.S. marketing research. I served as a member of the Board of Directors from 1990 - 1995, and was Chairman of the Board in 1993.

I have spoken extensively in the field of survey and marketing research and have previously testified in the federal courts as an expert on survey research.

Publications In The Past Ten Years

"Use of Surveys and Survey Experts in Trademark Litigation," Practical Tips on Trademark Litigation, American Bar Association, Section of Intellectual Property Law, April, 2001

"The Value of the Survey Expert in Lanham Act Deceptive Advertising Challenges," Advanced Consumer Protection -- Mastering The Challenge, American Bar Association, Section of Antitrust Law, February, 1998

"Analysis of Consumer Perception Surveys, " Transcript Proceedings: NAD Workshop VI: Consumer Perception Communication Surveys, National Advertising Division, Council of Better Business Bureaus, June 1996

"How Researchers Can Be Effective Partners in the Advertising Development Process," Quirk's Marketing Research Review, March 1996

Testimony In The Past Four Years

2006

Hasbro v. MGA Entertainment, D. RI (P.I. Hearing)

Juicy Couture, et. al v. L'Oreal USA. et. al, S.D. NY (Deposition & Trial)

Bay State Savings Bank v. Baystate Financial Services, D. MA (Deposition)

Ty, Inc. v. Softbelly's, Inc., N.D.IL (Trial)

2005

TAP Pharmaceuticals v. AstraZeneca, D. DE (Deposition)

Nissan North America v. Audi A.G., E.D.MI (Deposition)

Peaceable Planet, Inc. v. Ty, Inc., N.D. IL (Trial)

Sara Lee Corporation v. Amine Mahmoud, TTAB (Deposition)

Ty, Inc. v. Softbelly's, Inc., N.D.IL (Deposition)

2004

BellSouth v. Hawk Communications, N.D.GA (P.I. Hearing)

In Re Gator Corporation Trademark and Copyright Litigation, N.D.GA (Deposition)

3m Company v. Intertape Polymer Group, et. al., D. MN (Deposition)

2003

Pharmacia Corp. v. GlaxoSmithKline Consumer Healthcare, D. NJ (Deposition and P.I. Hearing)

McNeil – PPC, Inc. v. Bayer Corporation, D. NJ (Deposition)

Playtex v. Georgia-Pacific, S.D.N.Y. (Deposition)

Healthnet v. Health Net, S.D.WV (Deposition)

QUESTIONNAIRE MATERIALS

TRAVEL SURVEY

Hello, this is _____ of Western WATS, a public opinion research company. We're conducting a very short opinion survey today -- 5 minutes or less -- and I'd like to ask you a few questions. This is a real survey; I am not selling anything or asking for contributions.

1. For this survey I am supposed to interview people age 18 and over. In order for the survey to be scientifically valid, there is a system for picking who in your household I should interview. I need to speak with the person age 18 or over whose birthday is coming up next. Is that you, or someone else?

RESPONDENT	1	CONTINUE
SOMEONE ELSE	2	ASK TO SPEAK TO, MAKE APPT. IF NECESSARY

2. Record gender of respondent

MALE	1
FEMALE	2

RE-INTRODUCE YOURSELF IF NEW RESPONDENT

3. In which of the following categories is your age?

UNDER 18	1	→ TERMINATE
18 - 24	2	
25 – 34	3	
35 - 44	4	
45 - 54	5	
55 - 64	6	
65 OR OLDER	7	
REFUSED	8	→ TERMINATE

4. In the past 12 months, have you:

a. Taken a trip involving air travel?
   Yes
   No

b. Stayed at a hotel or motel?
   Yes
   No

c. Rented a car?
   Yes
   No

5. In the next 12 months, do you think you will:

a. Take a trip involving air travel?
   Yes
   No

b. Stay at a hotel or motel?
   Yes
   No

c. Rent a car?
Yes
No

PROGRAMMER: MUST BE YES TO 4b OR 5b. OTHERWISE TERMINATE

6. In this survey I'm going to ask you about some different words or names and ask you whether you think they are brand names or common names. For example.

- For a business that sells gasoline, SHELL would be a brand name and SERVICE STATION would be a common name.
- For a business that sells clothing, GAP would be a brand name and BOUTIQUE would be a common name.
- For a business that sells fast food, McDONALD'S would be a brand name and RESTAURANT would be a common name.

Do you understand what I mean?

YES	1	CONTINUE
NO	2	REPEAT Q6
NOT SURE	3	REPEAT Q6

PROGRAMMER: IF NO/NOT SURE AFTER SECOND READING, TERMINATE

7. Now let me ask you about some other words or names. For each name, please tell me whether you think it is a BRAND NAME or a COMMON NAME. For any name, if you don't know or have no opinion, just tell me so.

8. For a business that provides HAIRCUTS, would you say BARBER SHOP is a BRAND NAME or a COMMON NAME?

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3

9. For a business that sells INSURANCE, would you say STATE FARM is a BRAND NAME or a COMMON NAME?

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3

PROGRAMMER:

If respondent gave boxed answer to both of the preceding questions, proceed with the rest of the interview.

If the respondent gave one or more answers that were not boxed, terminate the interview.

RANDOMIZE ORDER OF Q. 10-16

10. For a business that sells BOOKS, would you say AMAZON DOT COM is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

11. For a business that sells FLOWERS, would you say FLORIST is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

12. For a business that does INTERNET SEARCHES, would you say SEARCH ENGINE is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

13. For a business that sells ICE CREAM, would you say DAIRY QUEEN is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

14. For a business that sells TOYS, would you say TOYS R US is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

15. For a business that does MANICURES, would you say NAIL SALON is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

16. For a business that makes HOTEL RESERVATIONS AND PROVIDES INFORMATION ABOUT HOTELS, would you say HOTELS DOT COM is a BRAND NAME or a COMMON NAME?

INTERVIEWER: If response is "both" or some other response that doesn't fit in any of the categories, record it as an "other" and type in the answer verbatim.

BRAND NAME	1
COMMON NAME	2
DON'T KNOW	3
OTHER (Specify)	4

CLOSE INTERVIEW AS FOLLOWS: Thank you very much for giving us your opinions. I would just like to verify that your phone number is _____ (CORRECT NUMBER IF NECESSARY).

And may I please have your name?

NAME _____

Thank you very much. Goodbye.

Hearing:
January 31, 2006

This Opinion is Not Citable as Precedent of the TTAB

Mailed:
October 24, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

DOCKETED BY:
RESPONSE DUE:
SUGHRUE MION TM DEPT

Serial No. 76414272

On Request for Reconsideration

Gary D. Krugman, Kevin G. Smith and Jody H. Drake of Sughrue Mion PLLC for Hotels.com, L.P.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hotels.com, L.P., a limited partnership of Texas, sought registration of a composite word and design mark including the term HOTELS.COM in a stylized form of lettering. The examining attorney required applicant to include a disclaimer of "hotels.com," which the examining attorney determined to be generic for the identified services.

On appeal, the Board upheld the disclaimer requirement, agreeing that the term is generic. Applicant now seeks reconsideration of that decision. Specifically, applicant argues that even if the examining attorney is viewed as having established a prima facie case of genericness, a point that applicant does not concede but assumes for the purpose of its request for reconsideration, applicant provided direct evidence that more than 60 declarants from among the relevant public do not view the term HOTELS.COM as a generic term. Applicant contends the Board either did not consider this evidence or did not accord this evidence proper weight. "To the extent the Board found this evidence to be merely evidence of de facto secondary meaning, or merely evidence of an association of the generic term with Applicant, the Board's decision is believed to be erroneous." Req. for Recon., p. 4. Accordingly, applicant contends that our decision requires correction.

The direct evidence on which applicant relies as support for its request for reconsideration consists of 64 declarations submitted as attachments to a declaration of Gregory S. Porter, general counsel and secretary of applicant. The Porter declaration introduces the attached declarations with the following statement:

> 9. As a result of the extensive use and advertising of the HOTELS.COM mark in connection with Hotels.com, L.P.'s online services, the mark has come to be widely recognized by the public and industry as denoting Hotels.com, L.P.'s services. Attached hereto as Exhibit D are 64 declarations from customers, competitors, and vendors of Hotels.com, L.P., and other persons familiar with the online services provided by Hotels.com, L.P. under the HOTELS.COM mark.

Because of the introductory phrase in the above quoted paragraph, "[a]s a result of the extensive use and advertising of the HOTELS.COM mark," we construe this paragraph as referring back to the information provided on use and advertising in paragraphs 3-8 of the Porter declaration. These paragraphs in the declaration pertain to applicant's claim of acquired distinctiveness.

Before further discussing the declaration evidence and applicant's request for reconsideration, it will be helpful to review some of the procedural history of the application and appeal, so as to view the evidence in context. When the declarations were filed, applicant was maintaining the alternative positions that "hotels.com" is inherently distinctive, and that even if the term is not inherently distinctive, it has acquired distinctiveness. In its response to the first office action, applicant contended that "hotels.com" is inherently distinctive because no two entities can have the same internet domain name. Applicant

also argued that the term has, at least, acquired distinctiveness. The Porter declaration and the 64 declarations submitted therewith were included with applicant's response to the second office action, and were stated by applicant to constitute "evidence of 'secondary meaning.'" Response of December 19, 2003, p. 2.

In contrast to these responses to office actions, applicant did not pursue on appeal the argument that "hotels.com" is inherently distinctive. Applicant conceded in both its main brief and reply brief that the term is descriptive, but argued that the term is not generic and has acquired distinctiveness. We did not construe the Porter declaration and the declarations attached thereto as evidence that the declarants recognize the term "hotels.com" as inherently source indicating both because they were offered as evidence of secondary meaning and because the appeal did not present a claim of inherent distinctiveness. As recognized by applicant, however, we did consider the declarations as evidence of acquired distinctiveness.

In its request for reconsideration, applicant does not argue that the declarations should have been considered as evidence of inherent distinctiveness. However, applicant does argue that the declarations are not merely evidence of

de facto distinctiveness of a generic term, and should have been considered in the first instance as significant evidence of the "non-genericness" of "hotels.com."

We note that applicant, in the section of its main appeal brief wherein it argued that "hotels.com" is not generic, did not reference the declarations as support for this contention; rather, applicant expressly relied on the declarations only in that section of its main brief wherein it asserted that the term "hotels.com" has acquired distinctiveness. We find applicant's argument, raised for the first time in a request for reconsideration, that the declaration evidence should be considered as evidence on "non-genericness" to be inappropriate. However, to the extent that we did not expressly address these declarations as pertaining to the issue of "non-genericness" in our decision, we do so now.

A review of the declarations reveals that they are essentially form declarations. An index of the declarations lists 18 of them as "business declarations" and the remaining 46 as "consumer declarations." Each of the declarations sets forth not the declarant's own words, but a set of statements that vary very little. The first statement in each of the businessperson declarations states that the declarant is "engaged in and thoroughly acquainted

with the business of hotel reservations, transportation and travel agency services,"[1] while the first statement in each of the consumer declarations states only that the declarant is "acquainted with the hotel reservation, transportation and travel agency industry as a consumer." Each business declarant, save two, then states, "to me personally, and among those persons involved in the hotel reservation, transportation and travel agency industry, the term HOTELS.COM is not the common, generic name of any product, service, or field of study."[2] Each consumer declarant states, "to me personally, the term HOTELS.COM is not the common, generic name of any product, service, or field of study." Clearly, the second statement in each of the 64 declarations is the same, except that the business declarants purport to speak not only for themselves but also as to the understanding of others involved in the industry. By the remaining statements in each of the 64 declarations, each declarant states that the term

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[1] One of the 18 business declarations does not use the words "engaged in" but does use the words "thoroughly acquainted with." Another (exh. D-6) does not use the language quoted above, but instead recites the name of the declarant, his employer and what he does on the job for his employer.

[2] One business declarant substitutes "persons thoroughly acquainted with in [sic]" for the words "persons involved in." The other business declarant (exh. D-6) that does not use the exact phrase quoted above speaks only for himself, not for others in the industry.

"hotels.com" is a mark and serves as an indication of source.

Applicant's current argument that the declarations are evidence of "non-genericness" makes a very fine distinction, and there is no evidence that the declarants were intending, by signing what are clearly form declarations, to make such a fine point. There is no indication that the declarants are familiar with the distinctions between inherently distinctive marks and terms that have acquired distinctiveness, or between a generic term and a descriptive term. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1759 (TTAB 1991) (form declarations found to "lack persuasiveness on the issue of the primary significance of the term 'MULTI-VIS' to the purchasing public" when there was no indication that the declarants were "familiar with such technical concepts as mere descriptiveness, distinctiveness and the definition of a trademark.").

Each declaration bears a caption showing its relevance to the involved application and includes "Attorney Docket No. 2488.5." The statements that "hotels.com" is not generic, is a mark, and serves to indicate source are conclusory only. There are no explanations why the declarants believe these statements to be true. Further,

the caption to each declaration lists "MARK: HOTELS.COM & DESIGN." Thus, even if an individual asked to complete a declaration form had not reached an independent conclusion as to whether "hotels.com" was a mark or a generic term, the caption would suggest the answer. Form declarations that may not "actually reflect the views of the declarants" are entitled to "little weight." In re EBSCO Industries Inc., 41 USPQ2d 1913, 1916 (TTAB 1996).

The relevant public for determining genericness in this case is the general public, i.e., anyone who might need information about hotel rooms, or need to reserve a hotel room. Such a relevant public would include both business and leisure travelers, and the declarations submitted by applicant are asserted to be from both of these subclasses of the relevant public.[3] The Porter declaration, however, explains that some of the businessperson declarations are from "customers" and "vendors" of applicant. Such businessperson declarants, being familiar with applicant, would not necessarily be reflective of the average business traveler not conditioned to associate "hotels.com" with applicant. See EBSCO Industries, supra (the only evidentiary value of

[3] Tim Schmuckal, corporate counsel for Expedia, Inc., submitted declarations both as a businessperson and as a consumer.

declarations from declarants familiar with the applicant goes to the issue of acquired distinctiveness).

Finally, we note that 34 of the 64 declarations, including a majority of the consumer declarations, are from individuals employed by Interval Travel, Interval International Limited, or Interval International, Inc. (Interval declarants). Since 7 of the 34 Interval declarants are classified among the businessperson declarants that may already be familiar with applicant, we find it difficult to consider any real distinction between those 7 and the other 27 Interval "consumer" declarants. In other words, all 34 of these declarants may be particularly familiar with applicant and its use of "hotels.com." Similarly, there are also declarants from Collins & Scanlon LLP and from Expedia, Inc. listed in both the business and consumer lists of declarants. Thus, these declarants, too, may be particularly familiar with applicant.

Under these circumstances, we do not consider these declarants representative of the average member of the relevant public, be it a business traveler or a leisure traveler.

In conclusion, we do not find any error in our initial consideration of the evidence of these declarants, or in

our decision not to accord the declarations significant probative value in determining how the relevant public perceives the term "hotels.com." The request for reconsideration is denied.

Hearing:
January 31, 2006

This Opinion is Not Citable as Precedent of the TTA

Mailed:
September 11, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

Serial No. 76414272

Gary D. Krugman, Kevin G. Smith and Jody H. Drake of Sughrue Mion PLLC for Hotels.com, L.P.[1]

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hotels.com, L.P., a limited partnership of Texas, filed an application on May 30, 2002 to register the proposed mark set forth below for services identified as "providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation for others by means of

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[1] The attorneys from the Sughrue law firm assumed responsibility for the application following issuance of the examining attorney's final refusal to register the proposed mark.

telephone and the global computer network," in Class 39; and for "providing information for others about hotel reservations and 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.

hotels.com

When filed, the application stated applicant's intention to use the proposed mark in commerce for the respective services in each class. It is clear from the record, however, that the proposed mark was already in use for both classes of services. In fact, when responding to the examining attorney's initial office action, applicant asserted that it began using the proposed mark "following the launch of Applicant's hotels.com website on March 25, 2002." Resp. of March 25, 2003.

The examining attorney's first two office actions included certain requirements for amendment of the mark drawing included with the original application. Applicant has complied with those requirements and the quality of the

drawing is no longer in issue. In contrast, with the third office action, the examining attorney made final a requirement advanced in the initial action and continued in the second action, specifically, a requirement that applicant include a disclaimer of exclusive rights in the term "hotels.com."

The examining attorney contends that "hotels.com" is generic for applicant's Class 43 services. Accordingly, the examining attorney refused to accept applicant's claim, made in response to the first and second office actions, that "hotels.com" has acquired distinctiveness as a mark and therefore need not be disclaimed. The third office action also made final the refusal to accept the evidence of acquired distinctiveness. We note that applicant's proffer of such evidence was, in fact, premature. Even though the record is clear that the mark was in use when the application was filed, the application was, throughout the referenced exchange of office actions and responses, based on intent to use. A claim of acquired distinctiveness usually can only be made in regard to an application based on use or amended to claim actual use of the mark in commerce.

The question whether the proposed mark has acquired distinctiveness is, however, an issue in this appeal. The

The request to divide was promptly processed and the application was divided, with the Class 39 services covered by the newly created application and the Class 43 services remaining in the application that is the subject of this appeal.

The proposed mark eventually was registered for applicant's Class 39 services and applicant, in the involved application, has included a claim of ownership of that registration (Reg. No. 2918738). Applicant has also included a claim of ownership of Reg. No. 2793744 for the mark 1 800 USA HOTELS.COM, in standard character or typed form. This other mark is registered for "Discount travel agency services, namely, making reservations and bookings for transportation," in Class 39, as well as for "Discount travel agency services, namely, making reservations and booking for temporary lodging," in Class 43. Reg. No. 2918738 is registered on the Principal Register without any disclaimer or resort to Section 2(f); Reg. No. 2793744 is registered under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), i.e., on a claim of acquired distinctiveness of the mark 1 800 USA HOTELS.COM.

Applicant timely filed a notice of appeal from the examining attorney's refusal to register the proposed mark for applicant's Class 43 services and, as noted above, also

filed a request for reconsideration. By its request for reconsideration, applicant amended the identification of services to delete the words "hotel reservations and," so that the resulting identification in Class 43 reads "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." The examining attorney acknowledged the amendment in the office action denying the request for reconsideration.

After applicant's request for reconsideration was denied, this appeal was resumed and was fully briefed. Applicant requested a hearing and oral arguments were presented by counsel for applicant and by the examining attorney.[2]

Applicant's Objection to Evidence

A preliminary matter requiring attention is applicant's objection, set forth in its reply brief, to the evidence attached to the examining attorney's brief. While applicant acknowledges both that the evidence was presented

[2] In a separate matter, we note that applicant filed a notice of appeal from the refusal of the examining attorney to register HOTELS.COM, in standard character form, for the services at issue in this appeal. At the request of applicant, however, that appeal has been suspended pending disposition of the instant appeal.

by the examining attorney as "dictionary and encyclopedic evidence," and that the Board can take judicial notice of standard reference works, applicant contends that this evidence, besides being untimely, includes many references derived from online sources or web pages and these are "of unknown origin, unknown reputation and unknown accuracy." Reply brief, p. 2, fn 1. We agree that approximately half of the sources offered by the examining attorney to provide definitions of various terms bear no indication that they are available in printed form, or derived from a printed work. In contrast, 11 of the attachments are merely online or web presentations from standard printed reference works.

There are four definitions retrieved from the Merriam-Webster Online Dictionary ("travel agency," "accommodation," "reservation" and "hotel"), and three retrieved from "Bartleby.com" ("accommodation," "hotel" and ".com"), with the Bartleby pages specifically stating that the source of the definitions is The American Heritage Dictionary of the English Language, Fourth Edition (2000). There is also a page retrieved from the Encyclopaedia Britannica Online, which indicates that its definition of "hotel" is "from the full 32 volume encyclopedia"; and there is a page from "AskOxford.com" which features a definition of "hotel" from the printed Compact Oxford

English Dictionary. Finally, there are two pages retrieved from "Cambridge" dictionaries, with one page featuring a definition of "hotel" from the Cambridge Dictionary of American English, while the other page features a definition of ".com" from the Cambridge Advanced Learner's Dictionary; and each of these two web pages notes the source and availability of the printed volumes. We sustain applicant's objection to the majority of the attachments to the examining attorney's brief, but have considered those we have referenced above, because it appears clear that these web page definitions have their origin in printed works and are appropriate items of which to take judicial notice. Cf. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999) (The Board will not take judicial notice of definitions found only in on-line dictionaries and "*not available in a printed format.*")(emphasis added).

Other Evidence of Record

Having resolved the question of how to treat the evidence attached to the examining attorney's brief, we now turn to a review of what other evidence is of record. Because the examining attorney has refused registration on the ground that applicant's proposed mark is generic, the evidence on which the examining attorney relies consists of

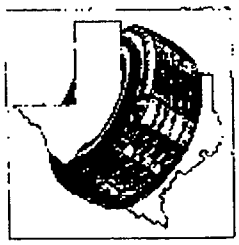
dictionary and encyclopedia definitions, of both "hotels" and ".com," as well as of terms set forth in applicant's identification of services. The examining attorney also relies on some of applicant's evidence of acquired distinctiveness and on applicant's specimens, as support for the contention that "hotels" conveys, to the relevant public, more than just hotel services and can also mean hotel reservation or booking services. Finally, the examining attorney also relies on certain reprints from office records regarding registrations owned by applicant, on reprints of web pages from applicant's web site, and on various other web pages or listings of the results of searches conducted on the web.

Applicant's contributions to the evidentiary record primarily consist of evidence offered in support of its claim that the "hotels.com" portion of the proposed mark, although it may be descriptive (see brief, p. 5), is not generic and has acquired distinctiveness sufficient to allow for registration of the entire mark without the disclaimer required by the examining attorney. Applicant contends that "hotels.com" is not generic, that the mark as a whole is unitary, and that the examining attorney's evidence is insufficient to establish genericness.

Specific consideration of the evidence of genericness and of acquired distinctiveness follows, in conjunction with our discussion of each of those issues. We begin, however, with the question whether applicant's proposed mark is unitary.

Is the Proposed Mark Unitary?

Applicant's first argument in this appeal is that its proposed mark is unitary, because its literal ("hotels.com") and design (the bellman) elements create a single commercial impression and the proposed mark cannot be divided into separable components. Brief, p. 3, citing TMEP Section 1213.05(f) and In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227 (TTAB 1986). The mark in the Texsun Tire case is set forth below:



The inquiry into whether a proposed mark is unitary is a factual determination and "requires the Board to determine 'how the average purchaser would encounter the mark under normal marketing of such goods.'" In re Slokevage, 441 F.3d 957, 78 USPQ2d 1395, 1398 (Fed. Cir.

2006), citing Dena Corp. v. Belvedere Int'l Inc., 950 F.2d 1555, 1561, 21 USPQ2d 1047 (Fed. Cir. 1991) (citations in Dena omitted in Slokevage). Accordingly, while there are many reported decisions of the Federal Circuit and the Board that deal with the question of whether the elements of a proposed mark are unitary or not, they provide little aid in resolving the factual question presented by the case at hand. We do note, however, that the Texsun Tire case on which applicant relies did not deal directly with a requirement by an examining attorney that the applicant in that case disclaim a portion of the composite mark. In fact, prior to the appeal of a substantive refusal of registration, applicant had already disclaimed the design of the tire. Texsun Tire, 229 USPQ at 228. The majority, dealing with the substantive refusal of registration on the ground that the mark was primarily geographically descriptive, found the examining attorney's focus on the map of Texas alone, notwithstanding the disclaimer of the tire design, to be in error and found that the proposed mark was "a unitary composite mark which is unique and fanciful… the mark involved herein is not merely a map but a unique combination of parts which may not be fragmented into its various pieces for purposes of analysis and which,

in the distinctive form presented, competitors have no need to utilize." Id. at 229.

If there is a lesson to be learned from Texsun Tire, it is that we should focus on whether the composite proposed for registration by the instant applicant is "a unique combination of parts," i.e., the focus of the factual inquiry is not on whether the parts themselves are unique, but whether the combination is unique and one that "may not be fragmented." It is only when the elements of the proposed mark form an inseparable whole that the mark is to be considered unitary. Slokevage, 78 USPQ2d at 1399.

In the case at hand, applicant argues that the elements in its proposed mark are unitary because they "are contiguous and actually touch one another." Brief, p. 3. The examining attorney acknowledges that factors that have been considered when determining whether elements in a composite mark are unitary include "whether lines or other design features physically connected the elements, the relevant location of the elements, and the meaning of the terminology as used in connection with the services," and that "in some instances, because of the visual presentation of the design and word(s), the components are considered unitary and not subject to disclaimer." Brief, p. 3. Nonetheless, the examining attorney argues that close

examination of the mark drawing itself reveals that the bellman is actually separated from the term "hotels.com" because "the design element is spatially, slightly forward of the word portion, as if the bellman slightly stepped forward from the wording." Id. The examining attorney also argues that the elements are not merged by any weaving of the design and wording; that, as used on applicant's website, the word portion is presented in red and the design element in black and white, thus distinguishing the two elements; and that the pictorial and literal elements have different connotations. Brief, pp. 3-4.

In its reply brief, applicant argues that any visual separation of the elements that might be attributable to a portrayal of the composite in multiple colors is irrelevant, as applicant has not sought to register the proposed mark with any claim to particular colors. Reply brief, pp. 2-3. We agree with applicant that, because it has not sought to register the proposed mark in any particular colors, if it is registered applicant will be free to use any colors and will not be restricted to the colors presently utilized on its website. Further, as the record makes clear, the proposed mark is often utilized in advertisements that appear in publications in black and white, such as in a newspaper. Nonetheless, because the

Slokevage and Dena decisions state that we must consider "how the average purchaser would encounter the mark under normal marketing," and because representations of the mark in color would be included in normal marketing that would be seen by the average consumer, we do not discount the significance of the differences in color noted by the examining attorney. We add, however, that this is only one piece of evidence to be considered in the factual determination we must make.

The operative identification includes two services, specifically, "providing information for others about temporary lodging" and "travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network." On the record, we must assume that the former service is also provided by means of telephone and the global computer network (i.e., the Internet). There is nothing to indicate that applicant, for example, only publishes information about lodging in magazines or guidebooks. To be clear, the record shows that applicant utilizes many forms of advertising, including magazines or other publications, in "the normal marketing of" its services; and those means of advertising are to be considered in assessing "how the average purchaser would

encounter the [proposed] mark." The fact remains, though, that the services themselves are provided by telephone or via the Internet; and that fact is to be considered in the assessment not of whether the proposed mark is unitary but whether the "hotels.com" portion is descriptive or generic.

Attachments to applicant's December 19, 2003 response to the examining attorney's second office action include numerous advertisements and they almost uniformly show the composite mark proposed for registration, i.e., with no separation between the two elements. The record, however, includes a number of examples of use by applicant of the elements of its composite mark with a clear separation between them or as distinct elements of ads. There is, for example, one reprint of applicant's web page from 2003 that shows the "hotels.com" and bellman elements on same page but with clear space between them.

The declaration of Linda Essary, applicant's Compliance Manager, was submitted with applicant's September 30, 2004 request for reconsideration. Exhibit 1 to the Essary declaration includes numerous advertisements and other promotional pieces that would be seen by the average purchaser of applicant's services. Many of these show the composite mark proposed for registration. In one, however, a photo of an advertisement above the entrance to

Madison Square Garden, a viewer from street level would perceive the term "hotels.com" as more dominant, because of its larger size, and might not be clear as to the nature of the associated figure. Numerous other ads show the elements of the composite presented separately, albeit in the same advertisement; still others show only the "hotels.com" element. For example, one exhibit appears to be both sides of a brochure and one side shows not only the composite mark but also each of the elements used separately. The Greater Miami & The Beaches Visitor Guide lists just the "hotels.com" element. An ad in a publication entitled Nevada Events & Shows, poking fun at the Elvis Presley impersonator phenomenon, uses the two elements of the mark separately, fashioning the bellman with Elvis Presley-like hair adjacent to, but separate from a tagline reading "Hotels.com. Thank you. Thank you very much." A reprint of a web page from "frommers.com" features applicant's composite mark in a link to applicant's web site, but a reprint of a web page from "www.bill-me-later.com" includes the "hotels.com" element in the same stylized script as the involved mark but without the bellman in its link to applicant's web site.

Exhibit 3 to the Essary declaration consists of references in wire reports and news articles about

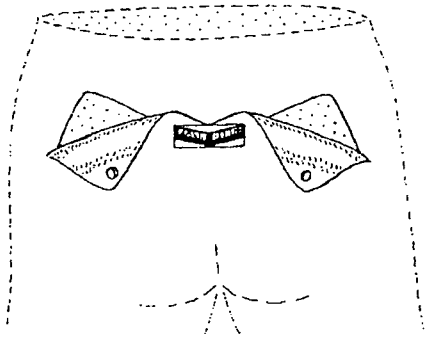
applicant and its web site. Only one of these shows the composite mark proposed for registration. Another, from the June 27, 2004 issue of the Sheboygan (WI) Press, includes a reprint of a page from applicant's web site, and that page shows the "hotels.com" designation clearly separate from the bellman character.

The second declaration submitted with applicant's request for reconsideration is by Elizabeth Hart, a paralegal at applicant's counsel's firm. This was used to introduce the results of Internet searches for archived pages for "hotel.com" and "hotels.com." Numerous pages from the latter search show only use of "hotels.com" without the bellman character.

We find "hotels.com" to be the dominant portion of the composite mark, when viewed from a distance, or when printed in smaller size in an advertisement. In either of these forms of presentation, the bellman figure is less distinct. We also find that applicant has often utilized "hotels.com" and the bellman character as separate elements in its ads. Finally, many consumers exposed to applicant's services through news articles or publications listing applicant's website as one of many providing similar services, will be exposed only to the "hotels.com" element. Consumers exposed to these uses, when subsequently being

exposed to the composite, will perceive the elements of the composite as presented together but not as inseparable. Likewise, even consumers who are exposed to the composite first, but later see ads showing the separate elements apart, or who are exposed to a listing featuring only "hotels.com" will come to view the elements as related but not unitary.

We also consider, as additional evidence that the proposed mark is not unitary, applicant's pursuit of protection for the individual elements of the composite. See Slokevage, 78 USPQ2d at 1400. In Slokevage, the applicant was seeking registration of trade dress that combined the words FLASH DARE!, a design element and a product configuration (see below), and had separately registered the words on the Principal Register, had obtained a design patent on the flaps configuration, and had registered the flap design as a mark on the Supplemental Register. Notwithstanding that the various elements proposed for registration as a composite mark were all contiguous or touching, the Board found applicant's pursuit of separate registrations for different elements to be evidence the elements were not unitary, and the Federal Circuit affirmed that finding on appeal.



In the case at hand, the record shows that applicant has a separate application pending for the term "hotels.com" and has a separate registration for its bellman design. Thus, we consider this as additional evidence of the non-unitary nature of the elements in the composite mark. We add, however, that, unlike the report of the Slokevage decision, this case includes a good deal of evidence regarding marketplace use of the elements of the composite that is probative of why consumers would perceive the elements of applicant's mark as related but not as unitary or inseparable.

On the evidence of record, we conclude that applicant's proposed mark is not unitary. The mark consists of two readily distinguishable elements - the term "hotels.com" and the bellman design. As shown in the drawing of the mark, the wording appears in a bold solid font, whereas the bellman is rendered in a slight-appearing

line drawing with only his jacket a solid black or other color. The design of the bellman and the wording touch, but just barely; and the bellman appears to be walking away from the words, which, in terms of the overall commercial impression, implies a separateness rather than a merging of the wording and the bellman. This visual impression of separateness is further emphasized for consumers by the extensive evidence, noted above, that the elements, as actually used, often appear separately and, when appearing together, as in the applied-for mark, the wording and bellman design elements are shown in quite different colors. Accordingly, the examining attorney may require disclaimer of the "hotels.com" element if that element is shown to be either generic or descriptive and without acquired distinctiveness.

Is "hotels.com" generic?

1. *The genus of services and relevant public*

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir.

1987). The critical issue to determine is whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" Ginn, *supra*, 228 USPQ at 530.

The determination of the genus involved can have an impact on the subsequent determination of what the relevant public considers the proposed mark or portion thereof to mean. Thus, the genus issue may, as in this case, be a subject of disagreement. See, e.g., In re American Institute of Certified Public Accountants, 65 USPQ2d 1972, 1981 (TTAB 2003).

Applicant initially argues that the examining attorney did "not clearly set out" the genus of services and, based on the office action denying applicant's request for reconsideration, may have presumed that "hotel services" is the genus in question. Brief, p. 5. Applicant goes on to

argue that it does not provide hotel services or any lodging services. Id. On the other hand, applicant concedes that its services relate to providing information about lodging and to making reservations and bookings for lodging; and concedes that these services "can in many instances, relate to information about hotels and can relate to reservations and bookings involving hotels." Brief, p. 5. In the end, applicant argues that the relevant class of services is "travel agency services, specifically, travel agency services rendered over the telephone and online." Brief, p. 6; see also, reply brief, p. 3.

In the office's brief, the examining attorney focuses initially on the identification of services and the specimen of use as evidence of what is the genus in this case. Brief, pp. 4-5. However, the examining attorney then goes on to conclude, "The plain meaning of the wording used in the recitation shows that hotel information and hotel reservation/booking services are the identified classes of services at issue." Brief, p. 5.

In this case, however, as in Accountants, we find the recitation of services to be an apt specification of the genus. We do not adopt either the examining attorney's proposed limitation of the genus set out by the

identification, i.e., a limitation that would have us read the identification as if it involved only hotels and not other forms of lodging; but neither do we adopt the applicant's suggestion that the genus is "travel agency services," which is broader than travel agency services restricted to assisting with booking and reservations for temporary lodging, and which also leaves out applicant's information services.

The next question is to determine the relevant class of purchasers for applicant's services. Because there are no restrictions in the identification of services as to channels of trade or classes of consumers, we must assume that the services are available to 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, for business or leisure needs, as an alternative residence during construction or renovation of a primary residence, for conferences or special events, or for any other reason.

2. *What does hotels.com mean to the relevant public?*

During prosecution of the involved application, applicant deleted the words "hotel reservations" from its identification of services. Applicant has not, however, argued that because of the deletion "hotels.com" cannot be

perceived as generic, and applicant has conceded that hotel information services and reservations/booking services for hotels are encompassed within its identification.[3] In essence, applicant has argued that "hotel(s)" would be seen as generic for the relevant public for hotel services but applicant does not provide such services. Accordingly, applicant reasons, "hotels.com" cannot be considered by the relevant public to be generic for the identified services.

Applicant aligns its proposed mark with certain ".COM" (or "dot com") marks that have been found by the Court of Appeals for the Federal Circuit or the Board to be descriptive, and distances its proposed mark from other ".COM" marks the Board has found to be generic. Compare In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (Court reversed the Board's decision finding

[3] In the Board's relatively recent decision of In re Reed Elsevier Properties Inc., 77 USPQ2d 1649 (TTAB 2005), that applicant argued that the proposed mark LAWYERS.COM could not be refused as generic because applicant had deleted the reference to "lawyers" in its identification of services. That applicant also argued that the identification of its "online interactive database featuring information exchange" in certain fields did not include "lawyers" as a field and information on "lawyers" could not be read to be part and parcel of any of the remaining fields. Reed, 77 USPQ2d at 1651. In essence, the applicant in Reed argued that, because the meaning of "lawyers.com" to the relevant public had to be assessed in light of the identified services, and because the identification did not use or encompass the term "lawyers," the proposed mark could not have a generic meaning for the relevant public. The Board rejected that argument and applicant in this case has not made a similar argument.

STEELBUILDING.COM to be generic and found it merely descriptive); In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (Court affirmed Board's finding that PATENTS.COM was descriptive); and In re Microsoft Corp., 68 USPQ2d 1195 (TTAB 2003) (Board found OFFICE.NET to be descriptive); with In re Eddie Z's Blinds and Drapery, Inc., 74 USPQ2d 1037 (TTAB 2005) (Board found BLINDSANDDRAPERY.COM generic); In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002) (Board found BONDS.COM to be generic); and In re Martin Container, Inc., 65 USPQ2d 1058 (TTAB 2002) (Board found CONTAINER.COM to be generic). Applicant, however, has failed to note that in Oppedahl and Microsoft, the marks were refused only on descriptiveness, not genericness, grounds.

We must focus on the factual inquiry of whether "hotels.com" is understood by the relevant public to refer primarily to the identified services. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, *supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

"Hotel" is defined as meaning "[a]n establishment that provides lodging and usually meals and other services for travelers and other paying guests." The American Heritage Dictionary of the English Language (4th ed. 2000) (as posted at the Bartleby.com website). Other dictionary definitions of the term of record are similar. A more prosaic definition also serves well: "hotel … a building where you pay to have a room to sleep in." Cambridge Dictionary of American English.

".Com" is defined as "abbreviation: commercial organization (in Internet addresses)," The American Heritage Dictionary of the English Language (4th ed. 2000) (as posted at the Bartleby.com website). We also take judicial notice of the following definition of "TLD": "(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the *generic* top-level domains, such as .com, .org, and .net…." McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001) (emphasis added).

The examining attorney also relies on reprints of the results of three Internet searches. One, conducted on the NexTag website, includes links to "HotelSale.com," "HotelClub.com," "**OnlineHotels.com**" and under "Additional Resources" are the full web addresses for

significant, in the examining attorney's view, are applicant's reprint from its November 1999 website, proclaiming the site to be the "#1 hotel finder," and a question posed in a survey that web site visitors are asked to complete, which asks, survey respondents to "Please list any travel or hotel sites other than hotels.com, which you frequent." See, respectively, exhibit D to the declaration of Elizabeth Hart and exhibit 4 to the declaration of Linda Essary.

The examining attorney argues that this evidence establishes that the relevant public will not only perceive "hotels" as generic for a business providing hotel services, but also as generic for a hotel finder or hotel reservations site, i.e., for a provider of the services at issue in this case. Given that "hotels" is generic for the involved services, the examining attorney concludes that the addition of ".com," to form the compound "hotels.com" is likewise generic, because the ".com" portion is equally generic and merely designates a commercial enterprise doing business on the Internet. In essence, the examining attorney is arguing that the relevant public will, when considering the term "hotels.com" think of it as an answer to the question "what am I?" (a hotel information and reservations site on the Internet) rather than as an answer

to the question "who am I?" (a particular source of hotel information and hotel booking/reservations services).[5] In this regard the examining attorney relies on In re Gould Paper Corp., supra, for the proposition that the compound term created when two terms are united may be just as generic as the individual terms, if the joined terms retain their separate meanings. Brief, p. 5.

Applicant, in its March 25, 2003 response to an office action, argued that it owns a domain name for "hotels.com" (in addition to "hotel.com"), and "[b]ecause no two entities can register the same domain name, each individual domain name, when considered in its entirety, is unique." The Board has rejected this argument, however, because it is possible that numerous entities could use a term such as "hotels.com" or "container.com," by adding a distinguishing prefix. See Martin Container, supra, 65 USPQ2d at 1061.

Applicant also argues that this case is akin to the Steelbuilding.com case, supra, in that the addition of the TLD ".com" to "hotels" expands the meaning of hotels, and

[5] As applicant observed in its December 19, 2003 response to an office action, "generic designations answer the question 'What am I?'." See also, 2 McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed. database updated June 2006) ("A mark answers the buyer's questions 'Who are you? Where do you come from?' 'Who vouches for you?' But the name of the product answers the question 'What are you?'").

does not merely form a compound that conveys the meanings of the separate terms. In support of this argument, applicant notes that the applicant in Steelbuilding.com was observed by the Federal Circuit to be using its mark for more than just steel buildings and was using it for a service that allowed web site visitors to design or build their own steel buildings and then calculate the appropriate price before ordering. Reply brief, p. 4. In this case, applicant asserts, its "services go beyond simply providing information about and assisting customers with reservations and bookings of hotel rooms. Applicant's information and travel agency services also relate to other types of non-hotel lodgings, including condos, vacation homes, bed and breakfasts, spas, etc." Id. at pp. 4-5. Applicant's argument, however, is misplaced. In essence, applicant is arguing that "hotels.com" cannot be generic for services that provide information on, or facilitate booking of reservations for, a wider array of lodging than hotels. However, if the term is generic for that aspect of applicant's services that deals with hotels, then it does not matter that it arguably might not be generic for services that deal with condos, spas or other types of lodging. See In re Analog Devices, Inc., 6 USPQ2d 1808 (TTAB 1988), *aff'd in a decision marked not citable as*

precedent, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); see also Eddie Z's, supra, 74 USPQ2d at 1042 ("So long as BLINDSANDDRAPERY.COM is generic for one of the recited services, it must be refused registration. It need not be shown to be generic for each of the recited services."). In addition, while in the Steelbuilding.com case "steelbuilding" could be viewed as referring to either a building of steel or the designing and building of a steel building, there is no such dual meaning that can be applied to the term "hotels.com."

Reference to the decision of In re Seats, Inc., 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985), is also helpful in assessing the case at hand. The Seats case involved an application to register SEATS as a mark for "ticket reservation and issuing services for various events by means of a computer," and the Federal Circuit stated: "The term 'seats' may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservation services. Contrary to the Board's statements, Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service…." Id. at 367-68. Just as Seats, Inc. was not selling seats, applicant here is not selling hotels, or even providing hotel services, but it is there that the similarity with

the Seats case ends. Though the Federal Circuit noted the Board's concern with "a need of others to use SEATS in describing the present services," there is no indication in the Seats decision that the Board actually had before it evidence of use of the term by other purveyors of ticket reservation and issuance services. In contrast, the record in this case evidences use of "hotel.com" and "hotels.com" as part of the domain names of third-party web sites; and those web sites appear to provide information to prospective users of hotels that is the same as or very similar to that provided by applicant's web site. In short, this case does not involve a perceived need for others to use a term, but involves a demonstrated use of the term by others. The relevant public will, therefore, perceive use of "hotels.com" as indicating a web site focused on hotels and, specifically, providing information about hotels and the possibility of reserving a hotel room.

We find that "hotels.com" is a generic term and the requirement that it be disclaimed is affirmed. Because we find the term generic, evidence of de facto secondary meaning, or of an association of the generic term with applicant cannot change the result and make the term registrable. See In re Northland Aluminum Prods., Inc., 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985).

If not generic has "hotels.com" acquired distinctiveness?

Applicant has requested, in its brief and at oral argument, that the Board consider and rule on its alternative claim of acquired distinctiveness, even in the event "hotels.com" is found to be generic. We agree that it is appropriate to do so. See Analog Devices, supra. If it is ultimately determined that our decision herein is incorrect and that "hotels.com" is not generic for the identified services, we would at least consider it to be a highly descriptive term requiring significant evidence of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1571, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (The kind and amount of evidence of acquired distinctiveness required to secure a registration will necessarily vary with the subject matter for which registration is sought). In this case, applicant has provided significant evidence of acquired distinctiveness.

With its response to the second office action, applicant included a declaration from Gregory S. Porter, applicant's general counsel and secretary. Mr. Porter stated that, as of the December 18, 2003 date of his declaration, applicant was averaging 156,000 visitors a day at its website; that approximately 2,000 other web sites

included links to applicant's site; that in 2002 alone, approximately 30 million dollars were spent on advertising on national, local, network and cable television advertising, as well as on in-flight ads screened on airliners; that approximately one million dollars had been spent on print ads in travel-related publications, in-flight magazines and in publications of general circulation, such as The New Yorker; that approximately 29 million dollars had been spent on on-line ads; and that applicant has displayed its proposed mark on billboards at major U.S. airports, train stations and sports venues. Mr. Porter also submitted with his declaration the declarations of 64 individuals familiar with applicant's proposed mark and services.

To support its request for reconsideration of the final refusal of registration, applicant included the previously mentioned declaration of Linda Essary, applicant's compliance manager, dated August 3, 2004. Attached to this declaration, as already discussed, were numerous advertisements. Ms. Essary also attested to applicant's revenue of 945 million dollars in 2002, 1.32 billion dollars in 2003, and estimated that applicant's revenue for 2004 would be 1.58 billion dollars. In regard to cumulative amounts spent on advertising, Ms. Essary

testified to amounts far in excess of what Mr. Porter had reported less than a year earlier. Finally, Ms. Essary reported that the number of visitors to applicant's web site had increased to approximately 475,000 per day.[6]

This evidence would not render a generic term registrable, see Northland Aluminum, supra, but it would be sufficient to allow for registration of even a highly descriptive term.

Decision: The examining attorney's requirement that applicant provide a disclaimer of "hotels.com," because applicant's composite mark is not unitary and the term is generic, is affirmed. The refusal of registration in the absence of a disclaimer will be set aside and the mark published for opposition if applicant, no later than 30 days from the mailing date hereof, submits an appropriate disclaimer. See Trademark Rule 2.142(g).

In the event the term "hotels.com" is ultimately held not generic, the examining attorney's refusal to accept the evidence of acquired distinctiveness is reversed.

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[6] We also note that applicant relies on its claim of use of its mark since 1997, but that claim is to use of the mark "in another form," specifically, as "hotel.com." While we agree that "hotel.com" is so close to "hotels.com" that use of the former would be considered probative evidence of applicant's claim that the latter has become distinctive, we need not rely on this to find acquired distinctiveness in "hotels.com." The evidence discussed above is sufficient.