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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. 78/277,681

Mark: HOTELS.COM

Applicant: Hotels.com, L.P.

Filing Date: July 23, 2003

04-26-2007
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

APPLICANT'S APPEAL BRIEF

Applicant, by its attorneys, hereby submits this brief in support of its appeal filed May 6, 2005. For the reasons set forth below, Applicant respectfully requests that the Board reverse the refusal to register HOTELS.COM on the grounds that the mark is merely descriptive of the recited services and/or generic of them.[1]

[1] The final refusal of registration (November 22, 2004) refused registration under Section 2(e)(1) of the Act on descriptiveness grounds but also indicates that Applicant's Section 2(f) evidence of acquired distinctiveness is of no help because the mark is considered a generic description as applied to the recited services. The Examining Attorney's denial (May 25, 2005) of Applicant's request for reconsideration also refers to the alleged merely descriptive nature of the mark as well as referring to the mark as generic. The Examining Attorney's denial (February 24, 2007) of Applicant's second reconsideration request also refers to the mark as merely descriptive and, also, as generic.

As is clear from the record in this case and in this appeal brief, Applicant does not dispute the descriptiveness refusal but believes that the record clearly supports Applicant's position that the mark has acquired distinctiveness under Section 2(f) of the Act. Applicant does not believe that the mark is generic as applied to the services and believes that the evidentiary record in this case clearly supports its position that the mark is not generic.

I. Background.

Applicant seeks registration of the mark HOTELS.COM for services described as:

> "providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network," in Int. Class 43.[2]

Registration has been refused on the grounds that HOTELS.COM is descriptive and/or generic of the services recited in Applicant's application.[3]

Following the filing of a Notice of Appeal and a denial of Applicant's request for reconsideration, Applicant requested that proceedings be suspended pending a decision in related Application Serial No. 76/414,272 for the mark HOTELS.COM and Design for services identical to those set forth therein. The Board, on July 26, 2005, suspended action on the appeal pending final disposition of related Application Serial No. 76/414,272.

II. The TTAB Decision in the Prior Proceeding.

The mark sought to be registered in Applicant's prior Application Serial No. 76/414,272 comprises the term HOTELS.COM together with the design of a bellman carrying a suitcase. The issues in that prior proceeding are identical to that presented herein, namely, the genericness

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[2] Applicant originally sought registration of the mark, in addition to the services described above, for:

> "providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation of others by means of telephone and the global computer network," in Int. Class 39.

During the prosecution of the application, Applicant divided out the Class 39 services since the refusal of registration was only directed to the Class 43 services. Subsequently, on March 15, 2005, Applicant was issued Reg. No. 3,015,723 for the mark for the Class 39 services. Applicant has claimed ownership of this prior registration.

[3] See f.n. 1, *supra*.

or non-genericness of the term HOTELS.COM as applied to the recited services and, if not generic, whether HOTELS.COM has acquired distinctiveness under Section 2(f) of the Act.[4]

In the Board's September 11, 2006 decision in the earlier case, a copy of which is attached hereto, the Board found that the description of services in the application was an apt specification of the genus of services; that the recited services are available to all customary customers of the services, given the absence of restrictions in the application as to channels of trade or classes of consumers and that, based on the evidentiary record presented, HOTELS.COM was a generic designation as applied to the recited services. The Board, therefore, affirmed the disclaimer requirement.

The Board further concluded that, in the event the term was ultimately held not generic, the evidence of record was sufficient to demonstrate acquired distinctiveness of the term HOTELS.COM for the recited services and the Board, therefore, reversed the Examining Attorney's refusal to accept the evidence of acquired distinctiveness.

Subsequently, on October 24, 2006, the Board denied Applicant's request for reconsideration in the prior case and Applicant thereafter submitted the required disclaimer.

III. Applicant's "Teflon" Genericness Survey.

Following the Board's decision in the prior Application Serial No. 76/414,272 and resumption of action on the appeal in this case, Applicant took the extraordinary step of commissioning a "Teflon" type genericness survey to test whether the purchasing public considers HOTELS.COM to be a generic designation for the recited services. Following

[4] Because of the design element present in Serial No. 76/414,272, the genericness issue was present in the context of whether HOTELS.COM was required to be disclaimed apart from the mark as a whole or whether the term had acquired distinctiveness under Section 2(f).

completion of the survey, Applicant requested that this application be remanded to the Examining Attorney for consideration of the newly obtained survey evidence. This request was granted and the case was remanded to the Examining Attorney who maintained her refusal of registration in an Office Action dated February 24, 2007. The Board, on February 28, 2007, then reset the time for filing Applicant's appeal brief.

IV. Issues for Determination.

1. Whether the term HOTELS.COM is generic as applied to the services recited in Applicant's application.

2. If the term HOTELS.COM is not generic as applied to Applicant's services, whether Applicant has demonstrated that the mark has acquired distinctiveness pursuant to Section 2(f) of the Act.

V. Argument.

It is Applicant's position, as set forth below, that the term HOTELS.COM is not a generic designation as applied to the services set forth in the application. Rather, the term is, at most, a term believed to be descriptive of a feature or characteristic of Applicant's services. Applicant submits that, in this case, it has submitted substantial and persuasive evidence that, as applied to the services recited in the application, the term HOTELS.COM is not a generic designation and that the term has acquired distinctiveness such that consumers recognize the term as referring to services emanating exclusively from Applicant. For these reasons, the mark should be registrable pursuant to Section 2(f) of the Trademark Act.

A. HOTELS.COM Is Not The Generic Name For Applicant's Services.

It is clear that, in order to find a term to be generic, it must be shown that the relevant purchasing public understands the term to primarily be the common or class name for the goods or services. See: TMEP Section 1209.01(c), citing In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ 2d 1807 (Fed. Cir. 2001); In re American Fertility Society, 188 F.3d 1341, 51 USPQ 2d 1832 (Fed. Cir. 1999).

The test for genericness set out by the Board's reviewing court has been in place for many years. See: H. Marvin Ginn v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). That test asks what is the class of goods and services at issue and asks whether the relevant purchasing public understands the designation primarily to refer to that class of goods or services.

It is also clear and beyond dispute that it is the PTO Examining Attorney who has the burden of proving a term is generic and this must be done by clear evidence. See: In re Merrill, Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ 2d 1141 (Fed. Cir. 1987).

1. The Examining Attorney's Evidence Does Not Support Her Genericness Holding.

It is clear that it is the Examining Attorney's burden to demonstrate that HOTELS.COM is generic for Applicant's services and that the burden of proving genericness must be met under a "clear evidence" standard. See: In re Merrill Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ 2d 1141 (Fed Cir. 1987); In re Volvo White Truck Corp., 16 USPQ 2d 1417 (TTAB 1990).

In the Merrill Lynch case, the Court reversed the Board's holding that CASH MANAGEMENT ACCOUNT was generic as applied to stock brokerage services, administration

of money market fund services and providing loans against securities services. The Court found that the Examining Attorney's "clear evidence" burden was not met in that case and that the mixture of uses unearthed by the NEXIS database did not show, by clear evidence, that the financial community viewed and used the term as a common descriptive term for Applicant's services.

In the Volvo White Truck case, the Board reversed the Examining Attorney's genericness refusal to register INTEGRAL SLEEPER for over the highway heavy duty trucks and truck tractors. In that case, the Examining Attorney had made of record literature from publishers, literature from third party competitors and a dictionary definition of INTEGRAL in support of the genericness refusal.

The Board, recognizing that the Examining Attorney had a duty to demonstrate genericness by clear evidence, concluded that this heavy burden had not been met. The Board concluded that the evidence contained ambiguities and that, while it was possible that the trade regarded the term as a generic designation, the Examining Attorney did not meet the heavy evidentiary burden required in genericness cases. The Board, therefore, resolved its doubt on the issue in favor of the Applicant, reversing the refusal of registration.

As noted by the Board in the Volvo White Truck case, any doubt on the genericness issue must be resolved in favor of the Applicant. See: In re Bel Paese Sales Co., 1 USPQ 2d 1233 (TTAB 1986).

In the present case, it is the Examining Attorney's position that the term HOTELS describes the most important and/or central characteristic of Applicant's services; that third party hotel reservation websites exist in connection with temporary lodging and hotel services; that

this evidence demonstrates that temporary lodging and hotel services are the same genus; and that the mark is generic because it consists of the generic term HOTELS combined with the top level domain (TLD) .COM which TLD signifies to the public that the user of the domain name is a commercial entity.

The Examining Attorney's "evidence" comprises a dictionary definition of "hotel," excerpts from Applicant's own materials showing that Applicant's services include information about hotels and that Applicant provides services where one can reserve or book a hotel room and, further, includes excerpts from third party web sites which engage in reservations services where one can reserve or book a hotel room.

It is submitted that the Examining Attorney has failed in this case to support her heavy burden of demonstrating genericness by "clear evidence." The Examining Attorney's genericness "evidence" in this case simply does not come close to showing the relevant purchasing public's understanding of the term HOTELS.COM and it submitted that the Examining Attorney's evidentiary submission in this case is substantially weaker than those showings made in the Merrill Lynch and Volvo White Truck cases where the Examining Attorney's "clear evidence" burden was found not to have been met.

In the present case, while the Examining Attorney has cited the Marvin Ginn case, *supra*, she has failed to clearly set out the Marvin Ginn test by indicating the class of services at issue and whether the relevant public understands the term HOTELS.COM to primarily refer to that class of services.

While the Examining Attorney's failure to specify the apt genus of services has left Applicant somewhat in the dark as to the basis for the genericness refusal, the Board, in its

September 11, 2006 decision involving Applicant's earlier HOTELS.COM and Design Application Serial No. 76/414,272, concluded that the description of services in that application (which is identical to the description of services in this application) was an apt specification of the genus and that the relevant class of purchasers of these services comprise all "...customary customers of the services, including those needing 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."[5]

Based on the Board's prior decision in Applicant's companion case covering the identical services as those set forth herein, Applicant assumes that the relevant class of services at issue under the Marvin Ginn test are the services described in this application. Applicant maintains, however, that the Examining Attorney has not demonstrated by clear evidence that the relevant public understands HOTELS.COM primarily to refer to that class of services and that, in fact, the evidence of non-genericness in this case, as summarized below, clearly shows that the relevant purchasing public associates HOTELS.COM solely with Applicant and with services of the type described in the application provided by Applicant and Applicant alone.

2. Applicant's Evidence of Non-Genericness.

Aside from the fact that, as noted above, the Examining Attorney has not met her burden of demonstrating, by clear evidence, that the term HOTELS.COM is generic as applied to Applicant's recited services, Applicant's record presented herein includes significant and compelling evidence that the term is not generic.

[5] September 11, 2006 TTAB decision in Serial No. 76/414,272, at p. 23.

a. Applicant's Declarations.

Applicant submitted, during the prosecution of this application, some 64 declarations from Applicant's customers, vendors, competitors and others in the field that support Applicant's position that the term HOTELS.COM is not generic as applied to the services set forth in the application. These declarations are probative evidence that the relevant public[6] recognizes the term HOTELS.COM not as referring to a class or category of the services described in the application, but, rather, as referring to such services which originate from one and only one source -- Applicant. These declarations specifically aver that the declarants are acquainted with the hotel reservation, transportation and travel agency industry as consumers; that the declarants do not perceive the term HOTELS.COM to be the generic name of any services but, rather, the declarants recognize that the term HOTELS.COM is a well known mark used in connection with hotel reservation, transportation and travel agency services by telephone and the global computer network and that, as such, the term indicates that such services offered under this designation emanate from, or originate with, Applicant and only Applicant.[7]

The foregoing evidence, it is submitted, in addition to serving as evidence of the distinctiveness that Applicant has acquired in the mark, also serves as evidence on the non-generic nature of Applicant's mark and bears directly on the critical issue relating to the heart of the genericness inquiry, namely, the relevant public's understanding of the term in question.

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[6] As the Board concluded, at p. 23 of its prior decision, since there are no restrictions in the designation of services as to channels of trade or classes of consumers, it must be assumed that the services are available to all customary consumers of these services. Given that broad interpretation, all of the declarants would be potential consumers of Applicant's services.

[7] See: Ex. D-1 through D-64 filed October 24, 2004 in response to the August 11, 2004 Office Action.

b. Applicant's "Teflon" Genericness Survey.

As noted above, action on this appeal was suspended pending disposition of the appeal in Applicant's companion application Serial No. 76/414,272 for the mark HOTELS.COM and Design. Applicant believed (and continues to believe) that the term HOTELS.COM is not generic as applied to the recited services. Nevertheless, the Board's September 11, 2006 decision in Serial No. 76/414,272 affirmed the genericness refusal in that case and the Board's October 24, 2006 decision in Serial No. 76/414,272, denied Applicant's request for reconsideration.

Following the Board's October 24, 2006 decision denying Applicant's request for reconsideration in connection with Serial No. 76/414,272, Applicant made a decision 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 services described in Applicant's application.

Because of the unusual and extremely expensive nature of conducting a nationwide consumer survey in the context of an application for registration, it was reasonable and appropriate, it is submitted, to defer undertaking 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 clearly have obviated the necessity for such survey evidence, with its attendant expense.

Once Applicant received the Board's October 24, 2006 denial of its request for reconsideration in the earlier case, Applicant, through its attorneys, promptly began the process

of identifying and interviewing recognized survey experts, following which Applicant retained its survey expert, Thomas D. Dupont, Ph.D. The survey was thereafter constructed, conducted and completed.

Applicant's genericness survey comprised a classic "Teflon" survey including some 277 respondents comprising males and females over 18 years old who had either stayed at a hotel or motel within the last 12 months or who planned to stay at a hotel or motel in the next 12 months.[8]

As the Board can see from a review of the survey evidence which is of record herein, the survey was conducted with respondents being explained the difference between a brand name and a common name and respondents were tested for their comprehension of the concept.[9]

Respondents were then asked about several 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?"

As shown by the survey results of record herein, the term HOTELS.COM was widely regarded as a brand name by 76% of respondents.[10] Inasmuch as the weight of authority considers the principal or majority view controlling in a determination of whether a term is generic or non-generic, it is submitted that a survey result of 76% of respondents perceiving

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[8] The universe of respondents was selected based on the Board's September 11, 2006 decision in the earlier case wherein the Board found the services in the application to be an apt specification of the genus and wherein the Board concluded 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.

[9] Only respondents who understood the concept continued with the survey.

[10] 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% of respondents. By contrast, SEARCH ENGINE, NAIL SALON and FLORIST were widely recognized as common names.

HOTELS.COM as a (non-generic) brand name for Applicant's services is significant and compelling evidence of the non-genericness of the term. This is the conclusion of Dr. Dupont, whose expert qualifications in the field of survey research are of record herein.

Similar levels of results in "Teflon" surveys conducted in other cases have been given substantial weight in the determination of the issue of genericness. 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).

In the present case, while the Board remanded the case to the Examining Attorney to consider the survey evidence, the Examining Attorney thereafter declined to withdraw the refusal of registration (February 24, 2007 Office Action). It is clear from the Examining Attorney's comments on the survey evidence that she has totally misconstrued the nature and purpose of this evidence, incorrectly asserting that the survey evidence was submitted to bolster Applicant's Section 2(f) claim.[11]

In view of the Examining Attorney's failure to meet her heavy "clear evidence" burden of proof on the genericness issue, and in view of the Applicant's compelling evidence of non-genericness comprising some 64 declarations and, most significantly, comprising Applicant's

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[11] The reference to Applicant's nationwide genericness survey was limited to essentially two sentences in the Examining Attorney's February 24, 2007 Office Action as follows:

> "The applicant has added survey evidence to bolster their Section 2(f) claim. Where registration is sought for generic matter, the matter is unregistrable."

It appears from the foregoing that the nature and purpose of the survey has been misunderstood by the Examining Attorney.

nationwide consumer survey conducted by a nationally recognized consumer survey expert which clearly demonstrates that the term HOTELS.COM is perceived as a (non-generic) brand name by a large majority of the relevant class of purchasers for the services recited in Applicant's application, it is submitted that the record supports a conclusion that the mark is not generic for the recited services.

B. The Mark HOTELS.COM, Even If Descriptive Of The Recited Services, Has Acquired Distinctiveness.

As discussed above, the evidentiary record on the genericness issue in this case is qualitatively different from the one presented in the earlier case, most notably due to the nationwide genericness survey and this qualitatively different record mandates a reversal of the Examining Attorney's genericness refusal in this case.

Assuming the Board agrees that this record supports a reversal of the Examining Attorney's genericness refusal, it is submitted that Applicant's showing of acquired distinctiveness is sufficient to warrant registration under Section 2(f) of the Act.[12]

In this case, the evidentiary record supporting Applicant's claim of acquired distinctiveness is essentially the same as in Applicant's earlier case. As noted above, the Board, in its prior decision, reversed the Examining Attorney's refusal to accept Applicant's acquired distinctiveness evidence, concluding that Applicant had provided significant evidence of such acquired distinctiveness and that, therefore, such evidence would be sufficient for registration of

[12] The Board is respectfully requested to rule on the acquired distinctiveness issue, in the alternative, even if the genericness refusal is affirmed. This request is made so that all issues presented herein are ruled on. If, for example, Applicant loses on the genericness issue and appeals the Board's decision, a reversal of the Board's decision will avoid a remand to consider the acquired distinctiveness issue.

the term on the Principal Register under Section 2(f), assuming that HOTELS.COM was found not to be generic of Applicant's recited services.

The record in this case is essentially the same as that in the earlier case and, therefore, it is submitted that the Board should reverse the Examining Attorney on the acquired distinctiveness issue for the same reasons the Board reversed the Examining Attorney on this issue in the earlier case. In this case, Applicant's evidence of acquired distinctiveness is extensive and may be summarized as follows:

1. Applicant's Consumer Declarations.

As discussed above in the section of the brief relating to the genericness issue, Applicant submitted some 64 declarations from customers, competitors and vendors of Applicant as well as other persons familiar with Applicant's services provided under the mark. These declarations, while relevant to the issue of the non-generic nature of Applicant's mark, are also relevant on the issue of acquired distinctiveness. The declarations are probative to show that the declarants recognize the term HOTELS.COM as referring to Applicant as a single and unique source for the services recited in Applicant's application.

2. Declaration of Linda Essary (and Exhibits).

The evidence presented by Linda Essary, Applicant's Compliance Manager, may be summarized as follows:

a. From 2002 until the date of the Essary declaration on August 3, 2004, Applicant's revenues broke down to $945 million in 2002, $1.32 billion in 2003 and an estimated $1.58 billion in 2004.

b. From 2002 until the August 3, 2004 date of the Essary declaration, Applicant's advertising expenditures of its services rendered under the HOTELS.COM mark was at least $121 million, broken down to over $89 million for network and cable television, as well as in-flight video ads, $16.9 million for print ads, $4.8 million for radio ads and over $20.3 million for billboard ads.

c. Applicant's website, www.hotels.com, which prominently features the HOTELS.COM mark, receives up to over 473,000 unique visitors each day which translates to over 7.5 million unique visitors per month and up to 90 million unique visitors each year. Page views of Applicant's web site average over 2 million per day which translates to over 63 million page views per month and over 756 million page views per year.

d. Applicant, through a predecessor in interest, used the domain name www.hotel.com and the mark HOTEL.COM to promote its travel related services from 1997 to 2001, at which time Applicant began directing all web traffic from www.hotel.com to the current www.hotels.com web site.

e. The exhibits attached to the Essary declaration include representative advertisements of Applicant's services rendered under the HOTELS.COM mark, including print, television, video and miscellaneous ads. The exhibits further show a list of cable and network television stations where Applicant's HOTELS.COM ads have appeared. The exhibits further include a collection of media references to Applicant, its HOTELS.COM mark and its services offered under the mark. The exhibits further include an on-line market study conducted by Applicant evidencing consumer recognition of the HOTELS.COM mark as an indication of source.

3. Declaration of Elizabeth Hart (and Exhibits).

Applicant submitted the August 4, 2004 declaration and exhibits of Elizabeth Hart, a trademark paralegal working for Applicant's trademark counsel at that time.[13] This evidence shows that Applicant, through predecessors in interest, offered travel related services under the HOTEL.COM mark and, thereafter, the HOTELS.COM mark for a number of years prior to 2002, going back as early as 1997.

The sum and substance of Applicant's massive evidentiary showing is that, as applied to the services described in Applicant's application, the term HOTELS.COM has come to be exclusively associated with Applicant and with Applicant's services. Consumers, competitors and others in the travel field immediately recognize travel related services rendered under the HOTELS.COM mark as originating exclusively with Applicant. Applicant has enjoyed tremendous success as a result of its massive efforts to associate the HOTELS.COM mark exclusively with Applicant and its services. The record shows that these efforts have been hugely successful. The term HOTELS.COM clearly has acquired distinctiveness through Applicant's extensive use and promotion of the mark and the Board itself recognized and acknowledged this strong secondary meaning in its decision in the earlier case. The Board is again requested to find that such secondary meaning exists in the term HOTELS.COM for the services recited in the application.

[13] Ms. Hart has since left her position at the firm of Applicant's trademark counsel.

VI. Conclusion.

For the reasons stated above, Applicant's mark HOTELS.COM is registrable for the services recited in the application pursuant to Section 2(f) of the Act.

Based on the record before the Board in this case, the term cannot be considered generic as applied to Applicant's services. The Examining Attorney has not met her heavy burden on the genericness issue, which requires a showing of genericness by "clear evidence." Moreover and most importantly, Applicant has made of record in this case the results of a nationwide consumer survey on the genericness issue, which results clearly demonstrate that the term HOTELS.COM is perceived as a brand name rather than a generic name by a substantial majority of respondents, which respondents comprise a statistically valid sample of Applicant's potential customers. These survey results, together with the other evidence of record, justify and mandate a reversal of the Examining Attorney's genericness refusal.

On the issue of acquired distinctiveness, the record presented herein is essentially the same record as presented in the earlier case. In the earlier case, the Board correctly concluded that the acquired distinctiveness evidence was sufficient to allow registration of the mark, in the event the term HOTELS.COM was ultimately found to be a non-generic term. There is nothing in this case which warrants a contrary ruling on the acquired distinctiveness issue.

Accordingly, it is respectfully requested that the Examining Attorney's refusal of registration be reversed and Applicant's mark passed to publication, pursuant to the provisions of Section 2(f) of the Act.

Respectfully submitted,

HOTELS.COM, L.P.

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Enclosures: September 11, 2006 TTAB Decision in Serial No. 76/414,272

Hearing:
January 31, 2006

This Opinion is Not Citable as Precedent of the TTAB

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

examining attorney considered the evidence submitted in responses to the first and second office actions and addressed it. Further, three months after the final refusal, applicant filed an amendment to allege use; and prior to expiration of the appeal period, applicant filed a request for reconsideration containing additional arguments on the issue of acquired distinctiveness. When the examining attorney subsequently issued an office action on applicant's request for reconsideration, the action did not assert any insufficiency in the amendment to allege use. We take the examining attorney's silence on the matter as indicating the amendment to allege use was acceptable in all respects. Therefore, because the application before us has been acceptably amended to assert use of the mark in commerce, and because the examining attorney has not objected to any of the proffered evidence of acquired distinctiveness, we have considered all such evidence as properly of record.

Applicant included with the amendment to allege use a request that the application be divided, because the examining attorney's assertion of genericness had been stated to apply only to the Class 43 services. By the request to divide, applicant sought to have the proposed mark be freed for registration for its Class 39 services.

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

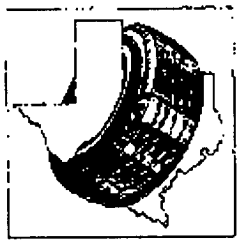
dictionary and encyclopedia definitions, of both "hotels" and ".com," as well as of terms set forth in applicant's identification of services. The examining attorney also relies on some of applicant's evidence of acquired distinctiveness and on applicant's specimens, as support for the contention that "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

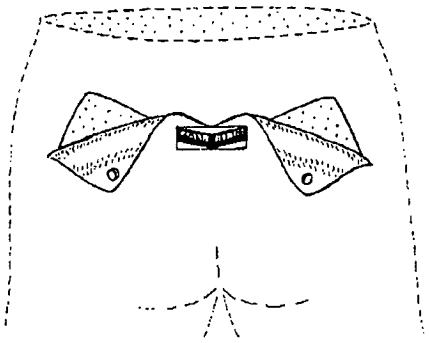
applicant and its web site. Only one of these shows the composite mark proposed for registration. Another, from the June 27, 2004 issue of the Sheboygan (WI) Press, includes a reprint of a page from applicant's web site, and that page shows the "hotels.com" designation clearly separate from the bellman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

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[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

www.hotellocators.com and **www.TheDiscountHotel.com**. The second search, conducted on www.lodging.net, includes links to "hotels.com" (which we presume to be applicant), "**www.choicehotels.com**," "www.discounthotels.cc," "www.hotellocators.com," and "**a1-discount-hotels.com**." And the third search, conducted on Google, retrieved links to "www.hotels.net" (under the heading "Hotel Reservations"), "www.hotellinks.com" (under the heading "Hotels Search Engine") and another listing of "**www.choicehotels.com**." See Office action of May 3, 2005 denying applicant's request for reconsideration (bold emphasis added).

The examining attorney also has noted the manner of use of the term "hotel(s)" on applicant's website, specifically noting that applicant uses the term "hotels" as the designation for a tab that will access lodging information;[4] that applicant uses the designations "find a hotel," "hotel + air = save," "hotel + air + car = save," "hotels by amenities," and "hotels near an address" as other tabs on the web page. Brief, pp. 4-5. At the top of the web page are also the proposed mark and the designation "Welcome to hotels.com." Attachment to May 3, 2005 office action denying request for reconsideration. Also

[4] There is also a tab for accessing information on "suites, condos, bed & breakfast."

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

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[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.