UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/277681

APPLICANT: Hotels.com, L.P.

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If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: HOTELS.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: 24488.17

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

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Applicant is requesting reconsideration of a final refusal dated November 22, 2004.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied.* The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

This application has been divided and the services for International Class 39 have proceeded to publication under Section 2 (f). The claim of ownership for the prior registrations is acceptable and made of record. Please note however, that the claim of ownership for these registrations will not be enough to allow the present application to register under Section 2(f). The examining attorney maintains the Section 2(e)(1) refusal below.

Reconsideration Denied - Mark is Merely Descriptive

Registration was refused because the proposed mark is merely descriptive of applicant's goods and/or services, and because applicant's present claim of acquired distinctiveness is insufficient. Trademark Act Sections 2(e)(1) and 2(f), 15 U.S.C. §§1052(e)(1) and 1052(f); *In re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156 (C.C.P.A. 1973); *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 173 USPQ 820 (S.D.N.Y. 1972); *In re MetPath, Inc.*, 1 USPQ2d 1750 (TTAB 1986); *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); *In re Interstate Folding Box Co.*, 167 USPQ 241 (TTAB 1970).

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL.

The applicant applies to register the mark HOTELS.COM for use in connection with 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 term HOTELS describe the most important and/or central characteristic of the services. Specifically, the applicant is providing services concerning temporary lodging. The examining attorney refers to the applicant's website which features a search engine for finding hotels. A feature of the applicant's services is to assist individuals in finding and researching hotels otherwise known as temporary lodging. Please see definition below as further proof of the descriptive nature of the mark:

ho·tel (ho-tèl') *noun*
An establishment that provides lodging and usually meals and other services for travelers and other paying guests.

noun, attributive
Often used to modify another noun: *hotel guests; hotel furnishings.*

[French *hôtel*, from Old French *hostel*, hostel. See hostel.][1][1]

The examining attorney refers to the excerpted articles from the examining attorney's search of the Internet using the GOOGLE® search engine in which hotel reservation websites appeared in reference to temporary lodging and hotel services in numerous stories. See attachments. The submitted stories are a representative sample of the stories retrieved by the indicated search. Sample search summary page(s) and representative stories from the search have both been provided. Search result summary pages have probative value since search engine results as well as Web site contents are equally accessible to the consuming public and both constitute evidence that the public may be exposed to the term. See *In re Fitch ICBA Inc.*, 64 USPQ2d 1058 (TTAB 2002). Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. TMEP §710.01 (b). *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-1 (TTAB 1998). With regard to evidence the Trademark Trial and Appeal Board has also stated that newswire stories have probative value because of the increasing use of the personal computer to obtain news and information, see *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003); and that foreign publications and English language websites have probative value since the Internet is a tool widely available to all. See *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002) at note 5.

Such evidence demonstrates that temporary lodging and hotel services are the same genus. Furthermore evidence that hotel reservation websites exist demonstrates that there is a market for such services and that third parties in this market use the term generically. The examining attorney also incorporates the evidence included in the final office action.

The proposed mark is generic because it consists of the generic term or terms HOTELS combined with the top-level domain (TLD) .COM, and is therefore generic for applicant's goods and/or services. Thus the proposed mark is unregistrable on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). TMEP §§1209.03(m) and 1215.05. The TLD will be perceived by prospective customers as part of an Internet address, and, therefore, has no source identifying significance. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.").

The top-level domain (TLD) ".COM" signifies to the public that the user of the domain name is a commercial entity. *Interactive Products Corp. v. a2z Mobile Office Solutions, Inc.*, 66 USPQ2d 1321, 1322 (6th Cir. 2003) citing *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d. 1316, 1318-1319, 46 USPQ2d 1511, 1513 (9th Cir. 1998); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002).

Terms which describe the most important or central characteristics of the goods or services should be and have been held to be legally generic. See *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM held generic for providing information regarding financial products and services which included bonds); *In re Martin Container, Inc.*, 65

USPQ2d 1058 (TTAB 2002) (CONTAINER.COM held generic when used in connection with "retail store services and retail store services offered via telephone featuring metal shipping containers); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART held generic for dealership services in field of fine art, antiques, furniture and jewelry); *In re Log Cabin Homes Ltd.* 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES is generic term when used in connection with building designs and stores selling kits for building log homes, and is therefore not registrable, since record contains several hundred articles that use term with all lower case letters in manner that does not indicate applicant as source of services, and applicant offers no evidence regarding perceptions of competitors, dealers, or ultimate consumers. An applicant cannot obtain exclusive service mark rights in a word or term for the architectural design of a particular type of building when that word or term is a generic name for the particular type of building.); *In re Central Sprinkler Company*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC mark for "automatic sprinklers for fire protection", installed primarily in attics, is generic and thus non-registrable, since term would be understood by relevant public as referring to narrow category of sprinklers for fire protection of attics, and since term "Attic" directly names most important aspect of applicant's goods, namely that these sprinklers are used in attics. The fact that applicant chose to not include the term "sprinkler" in the mark ATTIC does not avoid a finding of genericness, where the goods were automatic sprinklers for fire protection of attics); *In re Web Communications* 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS is generic for "consulting services to businesses seeking to establish sites on global computing network" since phrase is term in general use to describe "communications . . . via the Web," and thus member of relevant public primarily would understand term as reference to type of consulting services offered, rather than as source of service.); *In re Medical Disposables Co.* 25 USPQ2d 1801(TTAB 1993) (MEDICAL DISPOSABLES is generic as applied to applicant's disposable products used in medical institutions since "medical disposables" covers the entire class of products intended for medical use and which have in common the fact that they are to be disposed of following a single use. Any or all of these products may be identified by the common term "medical disposables."); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS held generic with respect to soil and stain removers for use on permanent press fabrics). See also, *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE held generic for stores that specialize or feature sale of lingerie); *In re Wickerware*, Inc., 227 USPQ 970 (TTAB 1985) (WICKERWARE held incapable of functioning as a services mark to identify applicant's mail-order and distributorship services in the field of wicker furniture and accessories).

The applicant's arguments that the genus of the goods/services at issue are broader than posited by the Examining Attorney are not persuasive. It is a common argument that no matter how generic a proposed mark appears to be for the category of good/services at issue, that the genus is even broader so that the proposed mark is merely descriptive rather than generic. The genus argued by the applicant is much broader than the genus properly applicable to the goods/services at issue here and would properly be placed at a much higher and more inclusive level. See discussion at *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, footnote 3 (TTAB 2001) (RUSSIANART held generic for dealership services in field of fine art, antiques, furniture and jewelry, with the relevant genus of services being "art dealership services in the field of Russian art" rather than merely "art dealership services" or, as applicant argued, merely "dealership services" and citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) where the court found the applicable genus of goods to be not merely "magazines," but rather the defendants particular "class of magazines," i.e. magazines directed to the field of firefighting.")

The evidence clearly shows that the applicant's services consist of providing information about and access to hotels. Each declaration provided by the applicant specifies that the declarant is thoroughly acquainted with the business of hotel reservations. Clearly as used by the applicant, the term hotels, contrary to the applicant's assertion, refers to more than merely the services of operating a hotel-lodging establishment. Broadly, the term also identifies a variety of related services. As shown by the affidavits listed under Exhibit D, consumers recognize the term to refer to more than merely lodging providers. The evidence shows that as used by the applicant, the term generically refers to hotel booking and reservation services. Please see Exhibit D provided by the applicant. The specimens show the wording generically used as the common descriptor of a key feature of the services, namely, providing hotel information and booking assistance.

The applicant included numerous third-party registrations in their response. Please note that third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. A proposed mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

Evidence of Acquired Distinctiveness

Please note that the amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985). More evidence is needed where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods and/or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984). However, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances. *See Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978).

Where registration is sought for generic matter, the matter is unregistrable. *See, e.g., H. Marvin Ginn Corp. v. International Association of Fire Chiefs*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), and cases cited therein ("A generic term ... can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of § 2(e)(1) and is incapable of acquiring de jure distinctiveness under § 2(f)."). *See also In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services."). Therefore, where the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant's goods or services is of no avail. TMEP section 1212.02(I). Therefore, the claim is denied.

Please note that the applicant's claim of ownership of a prior registration alone is insufficient evidence of distinctiveness in this case because the mark is highly descriptive of the goods and/or services. *See* TMEP §1212.04(a). *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

Accordingly, applicant's request for reconsideration is *denied.* The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

(1) $325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or

(2) $375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be $325 per class, and if such payments are made with a paper response, the fee will be $375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks

P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at http://www.uspto.gov/teas/index.html.

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