

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
January 5, 2016

Mailed:
February 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Booking.com B.V.

Serial No. 79114998

Jonathan E. Moskin and Katherine Califa of Foley & Lardner LLP
for Booking.com B.V.

Caitlin Watts-Fitzgerald, Trademark Examining Attorney, Law Office 111
(Robert L. Lorenzo, Managing Attorney).

Before Shaw, Adlin and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Booking.com B.V. (“Applicant”) filed an application for extension of protection to the United States of its International Registration of the standard character mark shown below:¹

BOOKING.COM

The services identified in the application (as amended) are:

¹ Application Serial No. 79114998 was filed on June 5, 2012 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1104711 dated December 15, 2011.

Arranging of tours and arranging of tours online; reservation and sale of travel tickets and online reservation and sale of travel tickets; information, advice and consultancy regarding the arranging of tours and the reservation and sale of travel tickets; provision of information relating to travel and travel destinations; travel and tour agency services, namely, travel and tour ticket reservation services; travel agency services; tourist agency services; providing online travel and tourism services, namely, providing online travel and tour ticket reservation services, online travel agency services, online tourist agency services and providing online information relating to travel and travel destinations, in International Class 39;

Making hotel reservations for others; holiday accommodation reservation services and resort reservation services, namely, providing hotel room reservation services and resort hotel reservation services and providing online hotel and resort hotel room reservation services; providing information about hotels, holiday accommodations and resorts accommodations, whether or not based on the valuation of customers; providing information, advice and consultancy relating making hotel reservations and temporary accommodation reservations; providing online information, advice and consultancy relating making hotel reservations and temporary accommodation reservations, in International Class 43.

The Examining Attorney refused the requested extension of protection under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of Applicant's services. When Applicant claimed, in the alternative, that Applicant's mark had acquired distinctiveness and is entitled to registration under Section 2(f), 15 U.S.C. § 1052(f), the Examining Attorney issued a new refusal on the ground that the mark is generic as applied to the services; she also maintained, in the alternative, the mere descriptiveness refusal and found Applicant's showing of acquired distinctiveness to be insufficient.

When the Examining Attorney made the refusals final, Applicant requested reconsideration and simultaneously appealed to this Board. The Examining Attorney denied the request for reconsideration and this appeal proceeded.²

At Applicant's request, this case was consolidated with three other pending appeals of refusals to register the marks in Applicant's related application Serial Nos. 79122365, 79122366 and 85485097.³ Applicant chose to address all four cases in a single set of briefs, having been granted leave to exceed the page limit for its main brief.⁴ The cases are fully briefed, including extra supplemental briefs filed by both Applicant and the Examining Attorney. An oral hearing was held January 5, 2016. The evidentiary record in this case is sufficiently different from the records of the other applications that we find it appropriate to issue a separate decision.

A mark is generic if it refers to the class or category of goods or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) ("Marvin Ginn"). The test for determining whether a mark is generic is its primary significance to the relevant public. *In re American Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *Marvin Ginn, supra*. Making this determination "involves a two-step

² The application was examined through final refusal and Applicant's request for reconsideration by Sharon A. Meier of Law Office 112. It was then assigned to the current Examining Attorney.

³ Board order of December 12, 2014, 52 TTABVUE.

⁴ Board order of January 30, 2015, 54 TTABVUE.

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?" *Marvin Ginn*, 228 USPQ at 530. The examining attorney has the burden of establishing by clear evidence that a mark is generic. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re American Fertility Soc'y*, *supra*; and *Magic Wand Inc.*, *supra*. "Doubt on the issue of genericness is resolved in favor of the applicant." *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

1. The genus of Applicant's services.

Our first task under *Marvin Ginn* is to determine, based on the evidence of record, the genus of Applicant's services. Because the identification of goods or services in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, generally "a proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration." *Magic Wand*, 19 USPQ2d at 1552, *citing Octocom Sys., Inc. v. Houston Computer Servs.*, Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The recitations of services in Classes 39 and 43 can be accurately summarized as follows:

- Class 39: Travel agency and tourist agency services; arranging tours; reservation and sale of travel and tour tickets; providing related information, advice and consultation; providing information regarding travel and travel destinations; including such services performed online.
- Class 43: Making hotel reservations and resort reservations; providing information, advice and consultation about hotels, holiday accommodations and resort accommodations; including such services

performed online.

We consider the foregoing summaries to suitably express the genus of the services in each class.

2. Public understanding of the term BOOKING.COM.

We next consider whether BOOKING.COM would be understood by the relevant public primarily to refer to each genus of services discussed above. The relevant public consists of all persons having an interest in arranging a reservation for travel, for a tour, or for a room in a hotel, resort, or other lodging; or in obtaining information, advice or consultation regarding such reservations or regarding travel, travel destinations, or holiday accommodations. The Examining Attorney's refusal and supporting arguments focus almost exclusively on Applicant's *online* reservation services, and we will do the same.⁵ Registration is properly refused if the mark is generic with respect to *any one* of the services for which registration is sought in a given International Class. *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished); *Cf. In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005), quoting, *Application of Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 48 (CCPA 1975) ("Our predecessor court ... has stated that registration should be refused if the mark is descriptive of any of the goods for which registration is sought."). In our deliberations, we have considered all of the evidence

⁵ While Applicant's brief refers to its "brick and mortar services," 55 TTABVUE 28, there is no evidence showing that Applicant's services are available otherwise than online.

of record. We summarize below and discuss the evidence that we find most highly relevant and probative regarding the public's understanding of Applicant's mark.

(a) Salient evidence of record.

As evidence of the relevant public's understanding of Applicant's mark, the Examining Attorney and Applicant made of record various definitions of the word "booking," including:

1. An engagement, as for a performance by an entertainer.
2. A reservation, as for accommodations at a hotel.⁶

1. a contract, engagement, or scheduled performance of a professional entertainer.
2. reservation (def 5).
3. the act of a person who books.⁷

1. an arrangement to buy a travel ticket, stay in a hotel room, etc. at a later date *Increasingly, travelers are using the Internet for both information and bookings.*

make a booking: *You can make a booking on the phone with a credit card.*

2. an arrangement made by a performer to perform at a particular place and time in the future.⁸

⁶ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fourth ed. 2009), Office Action of September 28, 2012 at 16.

⁷ <dictionary.reference.com>, *id.* at 19.

⁸ <macmillandictionary.com>, Office Action of November 18, 2013 at 53.

- : an arrangement for a person or group (such as a singer or band) to perform at a particular place
- : an arrangement to have something (such as a room) held for your use at a later time
- ...
- : RESERVATION⁹

the act of reserving (a place or passage) or engaging the services of (a person or group)

“wondered who had made the booking”

Synonyms: reservation¹⁰

1. An act of reserving accommodations, travel, etc., or of buying a ticket in advance:

‘the hotel does not handle group bookings’

‘early booking is essential’

1.1 An engagement for a performance by an entertainer:

‘TV show bookings were mysteriously canceled’¹¹

Overview of noun booking

The noun booking has 2 senses (first 2 from tagged texts)

1. (6) engagement, booking – (employment for performers or performing groups that lasts for a limited period of time; “the play had bookings throughout the summer.”)

⁹ <merriam-webster.com>, *id.* at 55.

¹⁰ <vocabulary.com>, Office Action of July 20, 2014 at 234.

¹¹ <oxforddictionaries.com/us/definition/american_english>, *id.* at 222.

2.(1) booking, reservation – (the act of reserving (a place or passage) or engaging the services of (a person or group); “wondered who had made the booking”)¹²

The Examining Attorney has also made the following definitions of record:

.com (dot-com):

Part of the Internet address of many companies and organizations. It indicates that the site is commercial, as opposed to educational or governmental.

Note: The phrase *dot-com* is used to refer generically to almost anything connected to business on the Internet.¹³

.com:

(1) (.COMmercial) A top-level Internet domain used by businesses, although individuals register .com names as well. Since .com (dot-com) was the original commercial domain name on the Internet, it is the most coveted, and all major companies in the U.S. and many companies worldwide have .com Web sites. Web browsers default to adding .com to the end of the URL if no other domain suffix, such as .org or .edu, is typed in.¹⁴

.com:

Commercial organization.¹⁵

¹² <poets.notredame.ac.ip>, Office Action of November 18, 2013 at 65.

¹³ <dictionary.reference.com>, Office Action of September 28, 2012 at 23.

¹⁴ Computer Desktop Encyclopedia (1981-2013), Office Action of November 18, 2013 at 74.

¹⁵ THE AMERICAN HERITAGE ABBREVIATIONS DICTIONARY (Third ed. 2005), Office Action of September 28, 2012 at 24.

.com:

abbr.

commercial organization (in Internet addresses).¹⁶

.com:

1. A file extension used for PC programs, especially those that run under DOS (for example, command.com, win.com).
2. A domain type used for Internet locations that are part of a business or commercial enterprise (for example, www.cnet.com).¹⁷

The Examining Attorney made of record excerpts from numerous websites that use the term “booking” to describe Applicant’s online services and similar online services provided by others. Notably, Applicant’s own materials make liberal use of the term “booking.” Applicant’s own website uses “booking,” both as a noun meaning a hotel reservation and as a verb meaning to make such a reservation:

Our Vision

Booking.com is an informative, user-friendly website – that guarantees the best available prices. Our goal is to provide business and leisure travelers with the most accessible and cost-effective way of discovering and **booking** the broadest selection of accommodations in every corner of the world.¹⁸

¹⁶ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fifth ed. 2011), Office Action of July 20, 2014 at 134.

¹⁷ Glossary definition at <www.cnet.com>, Office Action of September 28, 2012 at 25.

¹⁸ <booking.com>, Office Action of April 22, 2013 at 56 (emphasis added).

Easily manage all your **bookings**¹⁹

Welcome to Booking.com Customer Service
Change your booking or make a request: it's easy, instant
and secure!²⁰

Applicant's website sets forth a selection of available hotels in various cities, indicating when the latest "booking" was made at the particular hotels:

New York City
417 properties

...

Helmsley Park Lane Hotel **** from \$428
Score from 2890 reviews. *Very good, 8.1*
Latest **booking**: 18 minutes ago
There are 22 people looking at this hotel

New York Marriott Marquis *** * from \$299
Score from 1194 reviews. *Very good, 8.3*
Latest **booking**: 41 minutes ago
There are 14 people looking at this hotel²¹

Similarly, third-party websites also use the term "booking" in various formulations as the name of travel reservation services. Such services, when provided online, have been called (among other things) booking websites, hotel booking sites, hotel booking websites, online hotel booking websites, hotel-only booking sites, travel booking websites, travel booking sites, flight booking site, and travel booking online.²² Examples of use follow:

Most popular online booking sites for travelers

¹⁹ *Id.* at 54 (emphasis added).

²⁰ <booking.com>, Office Action of July 20, 2014 at 51.

²¹ <booking.com>, Office Action of April 22, 2013 at 52-53 (emphasis added).

²² Office Action of September 28, 2012 at 32-47.

TripAdvisor.com is the world's second-most popular booking site, according to new data. So who's first?²³

The Top Online Travel Booking Sites for January 2014

[reader comment] I like Travelocity and TripAdvisor, there is very good advantage of booking online is to check out past clients reviews for restaurants, hotels and flights ...²⁴

The Super-Slick UX of Virgin America's New Booking Site.

THE RESULT IS A SITE THAT GETS FLYERS BOOKED NEARLY TWICE AS FAST, ON ANY KIND OF DEVICE.²⁵

Room 77 hotel search

Search and save on over 200,000 hotels worldwide

We search dozens of booking sites...²⁶

Free Travel Free-For-All Among Online Booking Sites
Orbitz, Expedia and Hotels.com Sweeten Reward-Points
Deals to Keep Travelers From Just Browsing

...

Even infrequent travelers can collect booking-site points on top of airline miles and credit-card paybacks, and sometimes double-dip on hotel points, too.²⁷

²³ <travel.cnn.com>, Office Action of July 20, 2014 at 20.

²⁴ <skift.com>, *id.* at 24, 29.

²⁵ <wired.com>, *id.* at 39-40.

²⁶ <room77.com>, *id.* at 65 (ellipsis in original).

²⁷ <online.wsj.com>, *id.* at 71.

CAN WE MAKE THE BOOKING PROCESS MORE PLEASANT?

Airline bookings evolved from paper and fax machines to online website containers. Unfortunately that is how they remain to this day ...²⁸

Five great travel booking sites

...

Dohop.com

Strictly for booking plane trips entirely outside of the U.S., such as a flight between Paris and Rome.

...

Venere.com

...

Any booking site can point you to large, widely known hotels. But you might prefer to stay in a charming inn or a small property on your next trip²⁹

Five Best Cheap Travel Booking Sites

...

We asked you earlier in the week which sites were your favorite when it comes to booking travel.

...

Kayak promises to be your single destination for airfare, hotel booking, car rental, and even entire vacation packages. The secret to Kayak's "search one and done" motto is in the hundreds of travel and booking sites that Kayak digs through to provide you the lowest possible price on travel.³⁰

²⁸ <f-i.com>, *id.* at 84.

²⁹ <cnn.com>, Office Action of April 22, 2013 at 9-10.

³⁰ <lifehacker.com>, *id.* at 11-12.

New Flight Booking Site Lets Users ‘Pick Two, Get One’³¹

Best and Worst Hotel Booking Websites³²

2013 Best Hotel Booking Services Comparisons and Reviews

...
Hotel Booking Services Review

Why Hotel Booking Services?

... you will almost certainly benefit from using a hotel booking service to research the best lodging deals.³³

Hotel booking site, Tingo.com arrived on the scene about a year ago, promising to give money back to hotel guests if the rates dropped after they made their reservation but before they arrived for their stay.³⁴

Luxury Hotel Booking Site “Want Me Get Me” Launched Today³⁵

The Examining Attorney has made of record evidence of third-party domain names and trade names that include the designation “booking.com”:

<u>Domain name</u>	<u>Nature of use</u>
ebooking.com	website called ebooking.com, offering online hotel reservations. ³⁶

³¹ <abcnews.go.com>, *id.* at 16.

³² <frommers.com>, *id.* at 24.

³³ <hotel-booking-services-review.toptenreviews.com>, *id.* at 28-29.

³⁴ <hotelchatter.com>, *id.* at 32.

³⁵ <hotelchatter.com>, *id.* at 34.

instantworldbooking.com	website called Instant World Booking.com, offering “Online booking for hotels, youth hostels, and bed and breakfast accommodations at world heritage destinations.” ³⁷
hotelbooking.com	website called hotelbooking.com, offering “your best hotel web search engine.” ³⁸
blinkbooking.com	website offering mobile application called Blink: “In just a few taps, you can book a room in Europe’s best hotels: it’s that simple!” ³⁹
eurobookings.com	website called eurobookings.com offering search of hotels in Europe. ⁴⁰
francehotelbooking.com	website called Link Paris .com, offering to “find you a great Paris hotel” and hotel search for other French cities. ⁴¹
homesstaybooking.com	website for matching homestay hosts with guests. ⁴²
dubai-travelbooking.com	website called dubai-travelbooking.com, offering hotel search. ⁴³

Images of some of these websites are set forth below:

³⁶ Office Action of July 20, 2014 at 97-98. *See also* U.S. Reg. No. 3888087, *id.* at 198-200.

³⁷ *Id.* at 107-110.

³⁸ *Id.* at 155-156.

³⁹ *Id.* at 113-114.

⁴⁰ *Id.* at 111-112.

⁴¹ *Id.* at 157-158.

⁴² *Id.* at 105-106.

⁴³ *Id.* at 99-101.

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<http://www.ebooking.com/> 06/20/2014 11:55:40 AM



www.ebooking.com Hotels on ebooking.com - Online Hotel Reservations - booking hotels

Search Hotels

Destination

<http://www.instantworldbooking.com/> 10/28/2013 03:19:23 PM

The homepage of Instant World Booking.com has a yellow and green header with the site's name. It includes a search bar for "Search Hotel Rates" and social media links for Facebook and Twitter. On the right is a red "Login" button. Below the header, there are buttons for "Travelers", "work with us", "reviews", and "my bookings". A sidebar on the left allows users to "Book hotels, hostels, and more" and select a location, arrival date (Oct 29, 2013), and nights (2). The main area features a globe and a grid pattern.

<http://www.hotelbooking.com/en/index.html> 10/28/2013 03:16:45 PM

hotelbooking.com

your best hotel web search engine

Offers

Hotels in Italy

Florence	from 37€
Pisa	from 39€

[Home](#) | [Book Online](#) | [Hotels in Italy](#) | [Hotels in Europe](#) | [Worldwide Hotels](#)

Customer Support

<http://www.blinkbooking.com/> 11/26/2012 11:28:06 AM

The homepage of Blink booking.com features a dark blue header with the "Blink" logo, navigation links for "Home", "Where We Are", "For Hotels", "F.A.Q.", and language selection ("En"). Below the header, there are two smartphones displaying travel-related apps. To the right, a large blue banner with white text reads "Blink, it's booked." There is also a small graphic of a speech bubble with the text "WE'LL BE BACK".

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<http://www.eurobookings.com/> 06/20/2014 12:32:49 PM

The screenshot shows the eurobookings.com homepage. At the top left is the logo 'eurobookings.com' with the tagline 'The Hotel Specialist!'. A small illustration of a person carrying a suitcase is to the left of the logo. On the right, there's a language selection dropdown set to 'English' and a link to 'Travel News | My'. Below the header, a banner says 'Find the lowest rates for Hotels in Europe!' followed by a paragraph about finding budget or luxurious hotels across Europe. To the right, a large orange box titled 'Search Hotels in Europe' contains a 'Destination' input field with placeholder text '- City, Airport, Region, Country, or I' and a link 'or Browse Destinations'.

<http://www.francehotelbooking.com/> 10/28/2013 03:17:41 PM

The screenshot shows the France Hotel Booking website. The main navigation bar includes links for 'NORMANDY TOURS', 'MONT ST. MICHEL TOURS', 'LOIRE VALLEY TOURS', 'CHAMPAGNE DAY TRIPS', 'PARIS AIRPORT TRANSFERS', 'CABARET SHOWS', and 'PARIS'. Below the navigation, a section titled 'LINK PARiS .com' features a large 'LINK PARiS .com' logo with a stylized Eiffel Tower icon. A blue button below it says 'Learn the ABC's of Booking a Hotel in France' with an info icon.

<http://www.dubai-travelbooking.com/> 06/20/2014 12:00:14 PM

The screenshot shows the Dubai Travel Booking website. The header features the 'Dubai-Travel' logo with a globe and a red airplane. Below the header is a search form with a large blue background. The search form includes fields for 'City Name' (with a placeholder 'City Name'), 'Check-in' (with a date '28'), 'Check-out' (with a date '28'), 'Guests' (set to '1'), and 'Rooms' (set to '1'). A green 'Search' button is at the bottom right of the form.

The record also includes evidence of domain names that combine “.com” with various combinations of the words “booking” or “book,” including the following:

Bookingbuddy.com⁴⁴

Fastbooking-hotels.com⁴⁵

Hotelbookingsolutions.com⁴⁶

Ebookers.com⁴⁷

BOOKINGWIZ.COM⁴⁸

To demonstrate public understanding of BOOKING.COM, Applicant has made of record and focuses heavily upon a two-page, 2012 J.D. Power & Associates press release relating to its rankings of independent travel websites based upon a consumer survey, accompanied by a one-page chart. Neither the survey itself nor any supporting or background material about the survey is of record. Salient excerpts of the press release are set forth below:

J.D. Power and Associates Reports:

Pricing Is the Strongest Driver of Satisfaction with Independent Travel Websites

Booking.com Ranks Highest in Overall Satisfaction among Independent Travel Websites

... Satisfaction with the price paid on a travel website drives high overall satisfaction among consumers with their overall website experience, according to the J.D.

⁴⁴ *Id.* at 148-150.

⁴⁵ *Id.* at 151.

⁴⁶ *Id.* at 159.

⁴⁷ *Id.* at 122-4.

⁴⁸ Reg. No. 3634936, Office Action of July 20, 2014 at 193-4.

Power and Associates 2012 Independent Travel Website Satisfaction ReportSM released today.

“... the highest-ranked travel websites in overall satisfaction all have significantly higher price satisfaction scores than the report average,” said Sara Wong Hilton ... “While other factors certainly affect overall satisfaction, 75 percent of online travel website consumers indicate price as a primary purchase reason, so there is no denying price greatly impacts the overall website experience.”

The report measures consumers’ overall satisfaction with their purchase experience on an independent travel website, which consists of a vacation package, flight, hotel or rental car. The report examines seven factors (listed in order of importance): competitiveness of pricing; usefulness of information; availability of booking/reservation options; website/online store; ease of booking/reserving; competitiveness of sales and promotions; and contact with customer service. ...

Independent Travel Website Satisfaction Rankings

Booking.com ranks highest with a score of 816, performing particularly well in availability of booking/reservation options; ease of booking/reserving; and pricing. Following Booking.com in the rankings are Hotwire.com (813) and Priceline.com (808).

The 2012 Independent Travel Website Satisfaction Report is based on responses from 2,009 consumers who made an online purchase from an independent travel website in the past 12 months. ...⁴⁹

The chart accompanying the press release is set forth below:⁵⁰

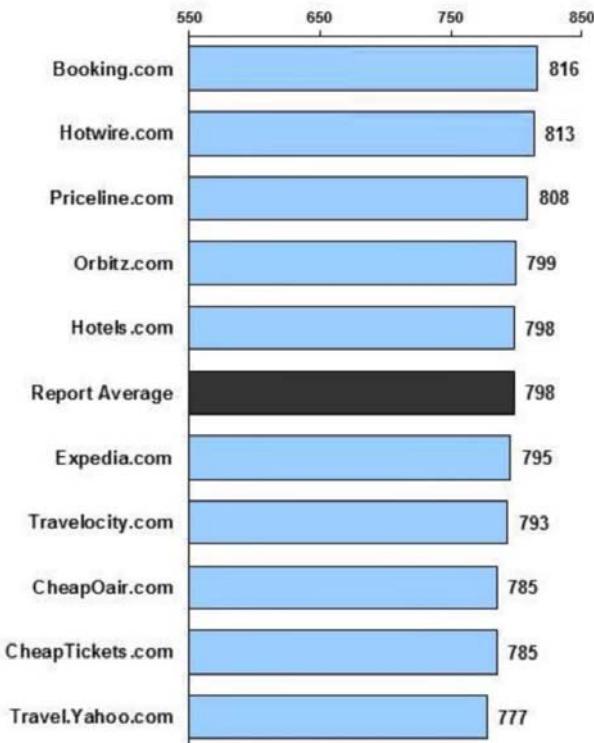
⁴⁹ Applicant’s response of May 19, 2014 at 93-4.

⁵⁰ *Id.* at 95.

J.D. Power and Associates
2012 Independent Travel Website
Satisfaction ReportSM

Customer Satisfaction Index Ranking

(Based on a 1,000-point scale)



The press release is supported by a declaration of Applicant's Director, Rutger Marinus Prakke, stating:

Applicant's BOOKING.COM service has received numerous industry awards, including, for example:

- J.D. Power and Associates, a premier research and analytics firm, ranked BOOKING.COM First in Consumer Satisfaction among independent travel websites based on a consumer survey (awarded in 2013); ...⁵¹

⁵¹ Declaration of Rutger Marinus Prakke, ¶ 11, Applicant's response of May 19, 2014 at 87. There are two slightly different versions of the Prakke declaration in the record. See also the version filed with Applicant's response of March 29, 2013. The version filed on May 19, 2014 is the more comprehensive version.

The Prakke Declaration also states that Applicant has won awards for a 2013 advertising campaign; for “Best Tablet App”; and “Best Mobile Site.”⁵² It also sets forth figures for the following aspects of Applicant’s business:

- countries served;
- accommodations-providers accessible via the service;
- transaction value (worldwide) of accommodation reservations made;
- unique monthly U.S. visitors to website;
- roomnights reserved daily (worldwide);
- languages in which the service is offered;
- U.S.-based subscribers to Applicant’s newsletters;
- television channels on which commercials have been aired;
- American consumers reached through commercials in movie theatres and streamed internet commercials;
- Facebook “likes” and “talking about”;
- Twitter followers;
- number of unsolicited news articles found in a Google News search.⁵³

(b) Discussion.

It is clear from the dictionary definitions that an accepted meaning of “booking” is a reservation or arrangement to buy a travel ticket or stay in a hotel room; or the act of reserving such travel or accommodation. It is also clear from the Internet evidence that the term “booking” has been widely used to describe the service of

⁵² Prakke declaration, ¶ 11, Applicant’s response of May 19, 2014 at 87.

⁵³ *Id.* at 85-90.

arranging reservations for hotel rooms or air travel, as described in Applicant's recitation of services and as comprehended by the applicable genera of services.

Applicant contends that the dictionary definitions show that the primary descriptive meaning of "booking" does not relate to travel, but to theatre bookings, referring to definitions such as "a contract, engagement, or scheduled performance of a professional entertainer"; "An engagement, as for a performance by an entertainer"; and "an arrangement for a person or group (such as a singer or band) to perform at a particular place." Applicant also refers to definitions from THE ONLINE SLANG DICTIONARY and URBAN DICTIONARY, showing that "book" as an adjective may mean "cool," that "to book" may mean "to leave quickly," and that "booking" may mean "running really fast."⁵⁴ Applicant argues:

The existence of alternate meanings of the wording at issue precisely calls into question what is the "primary" significance of the term "booking" (not even BOOKING.COM) to consumers. ... Indeed, it is fundamentally inconsistent for the Examiner both to assert that the Board should give weight to dictionary definitions of the word "booking" while at the same time telling the Board to shield its eyes from some of those definitions (including the *primary* definition) that undermine the Examiner's argument.⁵⁵

Applicant's arguments are unavailing. The question before us is the understanding of "the relevant public," which in this case consists of persons having an interest in reservations for travel, tours, or hotel rooms. Those persons would be exposed to the mark in the context of those services and, accordingly, that is the

⁵⁴ Applicant's brief at 21, fn5, ⁵⁵ TTABVUE 22, referring to evidence submitted with Applicant's Response of May 19, 2014 at 54-65.

⁵⁵ Applicant's reply brief at 12, 58 TTABUE 13.

context in which we must consider the primary meaning of the term at issue. In one of the most lucid discussions of this point, *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976), the Court acknowledged that in the spectrum of distinctiveness (generic/descriptive/ suggestive/arbitrary/fanciful) “a term that is in one category for a particular product may be in quite a different one for another, ... [and] a term may have one meaning to one group of users and a different one to others ...,” 189 USPQ at 764; and that “a word may have more than one generic use.” 189 USPQ at 766.⁵⁶ See also *Gear Inc. v. L.A. Gear California Inc.*, 670 F. Supp. 508, 4 USPQ2d 1192, 1197 (S.D.N.Y. 1987) (“that the word ‘gear’ is more frequently used in its several other meanings than as a term for wearing apparel” does not save it from a finding of genericness for apparel; “the term at issue is still generic if its principal meaning in the relevant market is generic”), *vacated in part, dismissed*, 13 USPQ2d 1655 (S.D.N.Y 1989); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1588 (TTAB 2014) (meteorological meanings of “cloud” irrelevant as to whether CLOUDTV is generic for computer goods and services); and *In re Rosemount Inc.*, 86 USPQ2d 1436, 1439 (TTAB 2008) (“It is well established that we must look to the meaning of the term within the context of the identified goods.”).

Applicant correctly points out that we must consider its mark in its entirety.⁵⁷

⁵⁶ In *Abercrombie*, the word “safari,” as applied to apparel, was at issue. The fact that “safari” had a specific meaning in the unrelated context of “an expedition into the African wilderness” did not prevent the Court from finding the term generic in the field of fashion apparel. 18 USPQ at 766.

⁵⁷ We must point out that the Examining Attorney was wrong to say, in her brief, “Applicant is *incorrect* in its brief in claiming that the required standard for a finding of

Applicant argues further:

In each of the Office Actions, the Examiners have submitted evidence showing descriptive use of “booking” and “.com” separately as evidence that the composite mark BOOKING.COM is generic. This analytical structure sets a lower bar for genericness for domain name marks than other marks, ignores the realities of the marketplace and is contrary to settled law.

There is no evidence whatsoever that consumers isolate and separately consider “BOOKING” and “.COM” in Applicant’s mark ...⁵⁸

We do not agree that the Examining Attorney’s approach is improper. In *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009), in which the mark HOTELS.COM was at issue, the Court said, “We discern no error in the Board’s consideration of the word ‘hotels’ for genericness separate from the ‘.com’ suffix.” 91 USPQ at 1535. The Court implicitly approved the same approach in *In re Reed Elsevier Props. Inc.*, 77 USPQ2d 1649 (TTAB 2005), *aff’d*, 82 USPQ2d 1378 (Fed. Cir. 2007), in which the Board considered separate dictionary definitions of “lawyer” and “.com”; and the Court expressly approved this approach in *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (“[T]he Board considered each of the constituent words, “mattress” and “.com,” and determined that they were both generic. ... The Board then considered the mark as a whole ...”) In all of these cases, the Court held to be generic marks that were similar in structure to Applicant’s mark on the basis of evidence highly similar to

genericness is that the *composite* mark BOOKING.COM as a full phrase be generic.” 57 TTABVUE 12 (emphasis in original). The opposite is true: to affirm the Examining Attorney’s refusal we must find that a mark, in its entirety, is generic.

⁵⁸ Applicant’s brief at 7, 55 TTABVUE 8.

that now before us. The fact that “booking” and “.com” appear in dictionaries separately, but not together, does not mean that their combination cannot be generic. The relevant analysis under *Marvin Ginn* is to determine what relevant customers would understand from the combination of these two terms. As the Court stated in *Hotels.com*, “the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM.” 91 USPQ2d at 1535.

Addressing Applicant’s mark as a whole, the Examining Attorney contends:

Each of the terms BOOKING and .COM has a clear and readily understood meaning and the combined term communicates just as clearly and directly that Applicant operates a commercial website that provides its customers with *booking* information and reservation *booking* services.⁵⁹

This contention is supported by the dictionary definitions, quoted above, indicating that “booking” means “reservation” or “an arrangement to buy a travel ticket, stay in a hotel room, etc. ...” and that “.com” is an abbreviation meaning “commercial organization (in Internet addresses).” It is also supported by the Internet evidence showing how third parties use the words “booking” and the suffix “.com”; and how they use the combination “booking.com” as a component of domain names and trade names.

Applicant suggests that the question before us is as follows:

... the Examiners must show that the “primary significance” of BOOKING.COM “to the relevant consuming public” is simply to designate the genus or

⁵⁹ Examining Attorney’s brief, 57 TTABVUE 13 (emphasis in original).

class of services identified in the applications [citing *Magic Wand*].⁶⁰

[The question is whether] the *entire term* is used or recognized by consumers to designate a genus of goods or services *and that the primary significance* of such usage is the generic designation. ... BOOKING.COM is not literally a genus or class name, but it at most contains elements descriptive or suggestive of the class.⁶¹

The above formulations overstate the rule that we must apply. *Marvin Ginn* does not require that the public use a term to designate the genus; only that the public understand the term to refer to the genus. *Marvin Ginn* does not require that a term literally be the name of the genus; only that it be understood primarily to refer to the genus. This degree of flexibility was clear in *Marvin Ginn* and was restated with clarity by the Federal Circuit in *In re 1800Mattress.com*:

The test is not only whether the relevant public would itself *use* the term to describe the genus, but also whether the relevant public would *understand* the term to be generic. See *H. Marvin Ginn*, 782 F.2d at 990 (describing the test as whether the term is “understood by the relevant public primarily to refer to [the appropriate] genus of goods or services”). Thus, it is irrelevant whether the relevant public refers to online mattress retailers as “mattress.com.” Instead, as the Board properly determined, the correct inquiry is whether the relevant public would understand, when hearing the term “mattress.com,” that it refers to online mattress stores.

92 USPQ2d at 1685 (emphasis in original). Thus, while it might be true that “it is impossible to use BOOKING.COM in a grammatically coherent way to refer generically to anything”; or that “it is not at all logical to refer to a type of product

⁶⁰ Applicant’s brief at 5, 55 TTABVUE 6.

⁶¹ *Id.* at 10, 55 TTABVUE 11 (emphasis in original).

or service as a ‘booking.com’”;⁶² that does not mean that this term could not be understood primarily to refer to an online service for making bookings. In other words, the test is not whether the public can use the term in a grammatically correct sentence, but whether the public understands the term to refer to the genus.

The Examining Attorney’s contentions as to the public’s understanding of the combination BOOKING.COM are supported by the dictionary evidence; the internet evidence showing how third parties use the words “booking” and the suffix “.com”; and, perhaps most importantly, the evidence of how third parties use the combination “booking.com” as a component of domain names and trade names in the field of travel and hotel reservations. We must, however, balance the Examining Attorney’s evidence against Applicant’s evidence of public perceptions, including the J.D. Power survey. Applicant argues:

It defies logic that consumers would rank BOOKING.COM as the most trusted accommodations website if consumers failed to recognize BOOKING.COM as a source-identifier. Stated another way, if BOOKING.COM merely designated a type or category of services, consumers would not be able to attribute any particular level of quality to services offered under the designation. This is plainly not the case ...⁶³

It bears noting, before we proceed, that Applicant’s characterization of the J.D. Power survey as showing that Applicant is “the most trusted accommodations website” is a substantial overstatement. As the press release, quoted above, indicates, the survey related to customers’ “satisfaction,” and trust was not one of

⁶² *Id.* at 12, 55 TTABVUE 13.

⁶³ *Id.* at 3, 55 TTABVUE 4.

the seven factors measured by the survey. Even if we were to accept the J.D. Power press release for the truth of the matters asserted in it,⁶⁴ we find that it is at best a very indirect demonstration of what relevant customers understand “booking.com” to mean. The press release tells us that survey subjects were asked about seven factors – pricing; information provided; booking options; the online “store”; ease of booking; sales and promotions; and customer service – with respect to specific travel websites. These are not the types of questions that would be posed to subjects of a typical genericness survey (*e.g.*, a “Teflon” or “Thermos” survey), which would test whether subjects perceive a term as a brand or a generic term. *See E. I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975); *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 134 USPQ 98 (D. Conn. 1962), *aff'd sub nom. King-Seeley Thermos Co. v. Alladin Indus., Inc.*, 321 F.2d 577, 138 USPQ 349 (2d Cir. 1963). What the survey does tell us is that participants had used Applicant’s website and expressed a higher level of satisfaction with it (based on some unknown combination of the seven factors) than with other competing websites. Although this survey tells us something about Applicant’s business success – *i.e.*, that its customers are highly satisfied – it says little or nothing about what customers understand the term BOOKING.COM to mean. (Even if the survey had posed more directly relevant questions, the data presented to the Board are extremely non-specific: we do not know the actual

⁶⁴ “The Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding.” TBMP § 1208.

questions that were posed to the survey subjects, nor do we have their responses or a tabulation of their responses, much less an expert's opinion on the validity and meaning of the survey's results.)

We have considered all of Applicant's evidence, including the testimony in its representative's declarations and the exhibits thereto. These materials demonstrate the scope of Applicant's business and the success that Applicant has achieved in marketing its services. However, compared to the J.D. Power survey, the information these materials provide is even farther afield from the crucial question: whether customers perceive BOOKING.COM as a brand or a generic term. The fact that Applicant has served many customers, or that its advertising and other communications have reached many customers and potential customers, does not answer this central question.

By contrast, the Examining Attorney's evidence is directly relevant to the question of public perception. We accept the dictionary definitions as evidence of the generally accepted meanings of the component terms of Applicant's mark; and the Internet evidence of actual third-party uses of the component terms and the combined term "booking.com" is presented with sufficient context to allow us to understand the use and public perception of these terms.

In *Hotels.com, supra*, where the USPTO relied on evidence of genericness similar to the Examining Attorney's evidence here, the applicant presented in rebuttal a "Teflon" genericness survey showing that 76% of respondents perceived the term at

issue as a brand name; together with 64 declarations of individuals stating that the term was not generic. Noting the Board's critique of the survey, the Court found:

[O]n the entirety of the evidence before the TTAB, and with cognizance of the standard and burden of proof borne by the PTO, the TTAB could reasonably have given controlling weight to the large number of similar usages of "hotels" with a dot-com suffix, as well as the common meaning and dictionary definition of "hotels" and the standard usage of ".com" to show a commercial internet domain. We conclude that the Board satisfied its evidentiary burden, by demonstrating that the separate terms "hotel" and ".com" in combination have a meaning identical to the common meaning of the separate components. The Board's finding that HOTELS.COM is generic was supported by substantial evidence.

91 USPQ2d at 1537. The applicant's evidence in *Hotels.com* was far more extensive and supportive of allowing registration than is Applicant's evidence in this case.

In *In re Reed Elsevier Props. Inc.*, 82 USPQ2d 1378 (Fed. Cir. 2007), the Court found evidence similar to the evidence in this case sufficient to demonstrate genericness:

[I]n determining what the relevant public would understand LAWYERS.COM to mean, the board considered eight websites containing "lawyer.com" or "lawyers.com" in the domain name, e.g., *www.massachusetts-lawyers.com*, *www.truckerlawyers.com*, and *www.medialawyer.com*. It discussed the services provided by these websites in order to illuminate what services the relevant public would understand a website operating under Reed's mark to provide. These websites are competent sources under *In re Merrill Lynch*, 828 F.2d at 1570, and they provide substantial evidence to support the board's finding.

82 USPQ2d at 1381. See also *In re 1800Mattress.com IP LLC*, 92 USPQ2d at 1684 ("[H]ere, the Board permissibly gave controlling weight to the large number of

similar uses of ‘mattress.com’ as well as the common meanings of ‘mattress’ and ‘.com.”).

Applicant argues that the existence of “ample readily available terms for the genus of services, such as ‘travel agency’ (or even ‘travel site’ or ‘accommodation site’)” constitutes “positive evidence the disputed term is *not* generic.”⁶⁵ This is a fallacy. The existence of numerous alternative generic terms does not negate the genericness of any one of them. In *1800Mattress.com*, the Court said:

We also disagree with Dial-A-Mattress's assertion that there can only be one generic term, which is “online mattress stores.” Instead, any term that the relevant public understands to refer to the genus of “online retail store services in the field of mattresses, beds, and bedding” is generic.

92 USPQ2d 1685. The cases upon which Applicant relies, *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *Elliott v. Google Inc.*, 45 F. Supp.3d 1156 (D. Arizona 2014); and *Salton, Inc. v. Cornwall Corp.*, 477 F. Supp. 975 (D.N.J. 1979), do not support the principle that Applicant posits; they do not hold that a failure to show competitive need disproves genericness, but only that it lends no support to a claim of genericness. In any event, in the case before us there is evidence of competitors’ use of the designation “booking.com” as a part of trade names and domain names that describe the nature of their services (e.g., “hotelbooking.com,” “instantworldbooking.com,” “ebooking.com,” and “francebooking.com,” among others). If such businesses could not use “booking.com” as a part of their domain names or trade names, they could be meaningfully

⁶⁵ Applicant’s brief at 6, 55 TTABVUE 7.

hampered in their ability to communicate the nature of their online booking services. In *Reed Elsevier*, the Board relied on similar evidence, 77 USPQ2d at 1657 (“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.”); and the Federal Circuit subsequently affirmed the finding of genericness. *Reed Elsevier*, 82 USPQ2d 1378.

Applicant argues that it is impossible for a term in the form of a domain name, like “booking.com,” to identify an entire class or genus of goods or services precisely because “a specific URL can identify only one entity.”⁶⁶ In fact, a URL points not to an *entity*, but to one specific Internet *address*, which can be occupied by any entity that secures the address by entering into an arrangement with the registrar of that address. As domain name registrations are not perpetual, Applicant may be supplanted as the registrant of that Internet address or may voluntarily transfer its domain name registration to another. Moreover, Applicant’s argument ignores the use of “booking.com” by third parties to identify their internet addresses.

Applicant also argues that refusing to register its mark would be contrary to the policies underlying trademark law and the Trademark Act, stating that Congress’s “two purposes” were (1) to protect the public from source confusion; and (2) to protect a business’s investment of energy, time, and money from misappropriation by pirates.⁶⁷ Applicant argues:

Given the stature of the brand among consumers, the purposes of trademark law are advanced by permitting Applicant to protect its great investment in its mark and

⁶⁶ Applicant’s brief at 14; *see also id.* at 24, 55 TTABVUE 15, 25.

⁶⁷ *Id.* at 18, 55 TTABVUE 19.

to protect consumers against the confusion that would inevitably result if others were free to copy the name. Denying registration to the most trusted brand in the field undermines the purposes of trademark law by betraying the trust consumers place in the brand.⁶⁸

Applicant's policy argument addresses the reasons for protecting *marks*, but neglects to mention the policy underlying the legal exclusion of generic matter from the category of "marks." That policy is based upon concerns relating to fair competition:

Generic terms, by definition incapable of indicating sources, are the antithesis of trademarks, and can never attain trademark status. [Citation omitted.] The reason is plain:

To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, *even when these have become identified with a first user*, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.

In re Merrill Lynch, 4 USPQ at 1142, quoting *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 188 USPQ 612, 615 (2d Cir. 1975) (emphasis added). See also *In re Pennington Seed Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1763 (Fed. Cir. 2006). As in *Merrill Lynch*, courts have repeatedly noted the possibility that a business might invest in, and acquire name recognition in, an unprotectable generic term:

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise *and what success it has achieved in securing public identification*, it cannot deprive competing manufacturers of the product of the right to call an article by its name.

⁶⁸ *Id.* at 3, 55 TTABVUE 4.

Abercrombie & Fitch, 189 USPQ at 764, citing *J. Kohnstam, Ltd. v. Louis Marx and Co.*, 280 F.2d 437, 126 USPQ 362, 364 (CCPA 1960) (emphasis added).

While it is always distressing to contemplate a situation in which money has been invested in a promotion in the mistaken belief that trademark rights of value are being created, merchants act at their peril in attempting, by advertising, to convert common descriptive names, which belong to the public, to their own exclusive use. *Even though they succeed* in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect.

Weiss Noodle Co. v. Golden Cracknel and Specialty Co., 290 F.2d 845, 129 USPQ 411, 414 (CCPA 1961) (emphasis added).

Applicant seeks to demonstrate that the USPTO has registered numerous marks in the form of a domain name in which a generic term is combined with a top-level domain indicator like “.com.”⁶⁹ Such demonstrations of purportedly inconsistent conduct of the USPTO are not persuasive, because we must decide each case on its own merits, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985), and are not bound by the USPTO’s allowance of prior registrations. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). In any event, in this case the proffered registrations do not support Applicant’s position. That is, the purportedly “generic” terms are registered not for the services that the terms directly identify, but for other services that are obliquely related to the terms. For example, DICTIONARY.COM is not registered for

⁶⁹ *Id.* at 24-25, 55 TTABVUE 25-26; Applicant’s response of May 19, 2014 at 66-83; Applicant’s response of October 22, 2013 at 70-82.

providing an online dictionary, but for online games and promoting the goods and services of others. Reg. No. 4184950. ENTERTAINMENT.COM is not registered for providing entertainment of any kind, but for advertising services, promoting the goods and services of others, and discount programs. Reg. No. 4294532, registered under Section 2(f).

Applicant compares the present case to *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005), in which the Court reversed the Board's finding that STEELBUILDING.COM is generic. In that case, evidence before the Court persuaded it that the applicant's services, as identified in the application, included not only the retail sale of steel buildings but also the online, interactive design and manufacture of structures made of steel; and that in that context customers would appreciate the dual meaning of "steelbuilding" as used in the applicant's mark (*i.e.*, a building made of steel and the process of designing and constructing a structure with steel). In this case, Applicant urges that its services are not merely reservation services but also include "soliciting and collating user-generated content such as reviews of lodgings and other travel related items"; and that customers would appreciate that BOOKING.COM "conveys much more than mere 'reservation' services."⁷⁰ We do not agree that, in the context of Applicant's identified services, customers would perceive any ambiguity or dual meaning in the term BOOKING.COM. Rather, in that context, BOOKING.COM would be obviously and

⁷⁰ Applicant's brief at 27, 55 TTABVUE 28.

immediately understood as having the meaning of booking travel, tours, and lodgings through an internet service.

We therefore find that the Examining Attorney's dictionary and usage evidence demonstrates, *prima facie*, by clear evidence, that relevant customers would understand the term BOOKING.COM primarily to refer to an online reservation service for travel, tours, and lodgings; and that Applicant's evidence of its business success and high level of customer satisfaction does not rebut this showing. Accordingly, we affirm the Examining Attorney's refusal to register Applicant's mark on the ground that BOOKING.COM is generic.

3. The refusal, in the alternative, on grounds of mere descriptiveness.

Bearing in mind the possibility that our finding that Applicant's mark is generic may be reversed on appeal, we find it appropriate to consider the Examining Attorney's refusal to register the mark on the ground that it is merely descriptive of Applicant's services and that Applicant has failed to demonstrate that it has acquired distinctiveness.

The dictionary and usage evidence submitted by the Examining Attorney demonstrates, at the very least, that BOOKING.COM is very highly descriptive and would require significant evidence of acquired distinctiveness in order to allow registration of the mark. *Yamaha Int'l 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.).

(a) Applicant's services in Class 39.

Initially we note that the application does not make any claim that Applicant has used its mark for any of the services identified in Class 39 (*i.e.*, services relating to reservations for *travel and tours*); and there is no evidence that Applicant has in fact provided reservation services relating to tours or the transportation of passengers. All of the evidence of record relates to reservation services for lodging. In particular, we note that the Prakke declaration refers only to Applicant's "online hotel reservation service through which hotels all over the world can advertise their rooms for reservation and through which consumers all over the world can make reservations."⁷¹ Therefore, there is no evidence to support a finding that BOOKING.COM has acquired distinctiveness with respect to Applicant's identified services in Class 39. Accordingly, we affirm the Examining Attorney's refusal under Section 2(e)(1) as to the services in Class 39.

(b) Applicant's services in Class 43.

Applicant has made of record the following evidence showing the scope and success of its business in the field of reservations for hotels and other lodging:

- The J.D. Power survey discussed above.
- The Prakke declaration stating that Applicant commenced use of BOOKING.COM in June, 2006; that Applicant's websites have averaged 10.3 million unique visitors from the United States per month; that there are over 2.2 million U.S.-based subscribers to Applicant's newsletters, which are distributed two or three times per month; that Applicant has advertised extensively on television, the internet, and in movie theatres; that in the first quarter of 2013, its movie theatre commercials reached over 20 million U.S. consumers;

⁷¹ Prakke declaration ¶ 2, Applicant's response of May 19, 2014 at 85.

and its streamed advertisements on third-party internet websites reached 19 million U.S. consumers; and that Applicant's services under the BOOKING.COM mark have received notice in the press and in the hospitality and advertising industries. Mr. Prakke also states his belief that BOOKING.COM "is recognized as a source-identifier and has become distinctive of Applicant's services through its substantial sales and great commercial success, as well as its substantially exclusive and continuous use of the mark in U.S. Commerce for many years."

The declaration states the number of roomnights booked daily (625,000) and the transaction value of its reservations in 2012 and 2013 (exceeding \$3 billion and \$8 billion, respectively); however, these figures are not limited to services provided to U.S. customers. The declaration also sets forth figures for Twitter followers and Facebook "likes," but again these are not limited to U.S. persons.

- Information (submitted as exhibits to the Prakke declaration) regarding Applicant's receipt of a Gold level Adrian Award from Hospitality Sales & Marketing Association International; and "Best Tablet App" and "Best Mobile Site" awards for 2014 from Mobile Travel & Tourism.
- Five news items taking note of Applicant's business (from NBCNews.com; Orlando Business Journal; Adweek; Los Angeles Times; and Hospitality Net).

This evidence would not under any circumstances render a generic term registrable. *See In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). Assuming for the sake of analysis that BOOKING.COM is not generic, but highly descriptive, we must consider whether the evidence suffices to render the term registrable under Section 2(f).

The Examining Attorney's evidence showing that third parties make use of the term "booking.com" in their trade names and domain names seriously undercuts Applicant's claim to have made "substantially exclusive" use of the term, as well as Applicant's claim to have acquired distinctiveness. *See Levi Strauss & Co. v.*

Genesco, Inc., 742 F.2d 1401, 222 USPQ 939, 940-1 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); and *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 11058 (Fed. Cir. 1999) (“The examples of use of the phrase by others in its descriptive form support the board’s conclusion that the mark had not acquired distinctiveness.”) Such evidence confirms what is suggested by the evidence of the meanings of the terms “booking” and “.com” and the ways in which people use these terms: that is, the combination of these terms not only appears to be a likely way for people to describe reservation services provided online, but has actually already been adopted for that purpose by businesses in Applicant’s field.

In view of the highly descriptive nature of BOOKING.COM and its actual use in the marketplace by third parties, very strong evidence of acquired distinctiveness would be required to render the term registrable. We find Applicant’s demonstration of its business success to be insufficient for this purpose, especially because it does not focus on demonstrating actual market recognition of BOOKING.COM as a source indicator. The press notices are few in number, and while one of them refers to Applicant as a “[h]otel booking giant,” the same article also states, “even though *many Americans are unfamiliar with the brand*, Booking.com is the largest hotel-booking site in the world ...”⁷² The record contains

⁷² Applicant’s response of May 19, 2014 at 105-6 (emphasis added).

no statements by customers indicating the degree of their recognition of the term as Applicant's source-indicator; and the record has very few examples of Applicant's advertising materials to show how Applicant has sought to replace, in the minds of consumers, the general descriptiveness of the term with an impression of single-source identification. The press release relating to the J.D. Power survey, which neither sets forth the questions asked nor the answers received from the survey respondents, does not present the unmediated views of consumers, but merely an undetailed digest of their responses, indicating general satisfaction with Applicant's services. Considering that the structure of the term BOOKING.COM indicates that it refers to an internet address, the survey does not show that customers recognize BOOKING.COM as a single-source indicator, but only that they were satisfied with the services provided at a particular internet address. Overall, we find Applicant's evidence to be too sparse and equivocal to indicate that a term as highly descriptive as BOOKING.COM has acquired distinctiveness under Section 2(f). We therefore affirm the Examining Attorney's refusal to register Applicant's mark on the ground that BOOKING.COM is merely descriptive and that Applicant has failed to demonstrate that the term has acquired distinctiveness within the meaning of Section 2(f).

Decision: The refusal to register Applicant's mark is AFFIRMED on the ground that BOOKING.COM is generic as applied to Applicant's services; and on the ground that BOOKING.COM is merely descriptive of Applicant's services and has not been shown to have acquired distinctiveness.