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

Proceeding	85485097
Applicant	Booking.com B.V.
Applied for Mark	BOOKING.COM
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Date	10/13/2014

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



In re **BOOKING.COM**, Serial No. 85/485,097
Applicant: Booking.com B.V.
Filed: December 1, 2011
Examining Attorney: Caitlin Watts-Fitzgerald, Law Office 111



In re: **BOOKING.COM**, Serial No. 79/114,998
Applicant: Booking.com B.V.
Filed: June 5, 2012
Examining Attorney: Sharon A. Meier, Law Office 112

MOTION TO SUSPEND EX PARTE APPEALS

On August 11, 2014, Applicant filed a Motion to Consolidate its *ex parte* appeals in **BOOKING.COM & Design, Serial No. 85/485,097** and **BOOKING.COM, Serial No. 79/114,998** for purposes of briefing, oral hearing and final decision. In light of the similarity of the records and issues in these cases, that motion was granted on August 19, 2014. The Consolidated Appeal Brief is due on October 18, 2014. Because October 18, 2014 falls on a Saturday, the deadline is automatically extended to the next business day, October 20, 2014.

Applicant requests that the consolidated appeal of **BOOKING.COM & Design, Serial No. 85/485,097** and **BOOKING.COM, Serial No. 79/114,998** be suspended pending review of Applicant's Request for Reconsideration in its two additional **BOOKING.COM (Stylized)** applications, **Serial No. 79/122,365** and **Serial No. 79/122,366**.

For the Board's ease of reference, the following chart summarizes the procedural posture of each of the four applications.

Mark	Status
BOOKING.COM Serial No. 79/114,998	<i>Consolidated with Serial No. 85/485,097</i> Consolidated Appeal Brief due October 20, 2014 (extended from October 18, 2014)
 Serial No. 85/485,097	<i>Consolidated with Serial No. 79/114,998.</i> Consolidated Appeal Brief due October 20, 2014 (extended from October 18, 2014)
Booking.com Serial No. 79/122,365	Request for Reconsideration and Notice of Appeal filed October 13, 2014. Awaiting Examiner Snyder's decision.
 Serial No. 79/122,366	Request for Reconsideration and Notice of Appeal filed October 13, 2014. Awaiting Examiner Snyder's decision.

Final Office Actions have issued in both Serial No. 79/122,365 and Serial No. 79/122,366 alleging that the applied-for marks are generic or, in the alternative, that they are descriptive and have not acquired distinctiveness. Applicant submitted a Request for Reconsideration *and* Notice of Appeal in each application on October 13, 2014.

If Applicant's Requests for Reconsideration are favorably reviewed, and either application is approved for publication, then that determination will be material to the evaluation of the consolidated appeals of Serial No. 85/485,097 and Serial No. 79/114,998. The approval of either Serial No. 79/122,365 and/or Serial No. 79/122,366 would also likely impact Applicant's decision whether to continue with the consolidated appeal.

If, on the other hand, the Request for Reconsideration is denied in each of the applications, then Applicant will move to consolidate the appeals of all four applications. There are common issues of law and fact in each of the four pending applications. In all four cases, the Examining Attorneys have argued that "BOOKING.COM" lacks the capacity to distinguish

Applicant's services from those of others and that, even if the wording is capable of functioning as a mark, Applicant has not proven acquired distinctiveness. Applicant strenuously disputes both positions and contemplates raising very similar issues of law and fact as to both refusals.

Applicant has not yet filed its Appeal Brief in any of the cases; thus, the appeals are in the same procedural position.

For these reasons, Applicants believes that suspension of the consolidated appeal is in the interest of both Applicant and the Trademark Trial and Appeal Board. It will eliminate duplicative filings with the Board and will conserve the Board's judicial resources.

Accordingly, Applicant requests that the consolidated appeal of BOOKING.COM & Design, Serial No. 85/485,097 and BOOKING.COM, Serial No. 79/114,998 be suspended pending review of Applicant's Requests for Reconsideration in BOOKING.COM (Stylized), Serial No. 79/122,365 and BOOKING.COM (Stylized), Serial No. 79/122,366.

Respectfully submitted,

FOLEY & LARDNER LLP

Dated: October 13, 2014

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