

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
November 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Booking.com B.V.

—
Serial No. 85485097

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ORDER OF REMAND

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).

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Before Shaw, Adlin and Masiello, Administrative Trademark Judges.

By the Board:

Booking.com B.V. (“Applicant”) filed the instant application for registration on the
Principal Register of the mark shown below for services in Classes 39 and 43:



The Examining Attorney required, as a condition of registration, that Applicant disclaim the exclusive right to use BOOKING.COM apart from the mark as shown, under Trademark Act Section 6, 15 U.S.C. § 1056. Applicant claimed that BOOKING.COM has acquired distinctiveness and is entitled to registration under Section 2(f), 15 U.S.C. § 1052(f). Nonetheless, the Examining Attorney maintained the requirement of a disclaimer on the ground that BOOKING.COM is generic. We affirmed the Examining Attorney's requirement as a condition to registration. (34 TTABVUE).

Applicant sought review of our decision under Trademark Act § 21(b), 15 U.S.C. § 1071(b), by way of a civil action in the United States District Court for the Eastern District of Virginia, *Booking.com B.V. v. Matal*, No. 1:16-cv-425. On cross-motions for summary judgment, the Court held that the word mark BOOKING.COM is a descriptive mark eligible for registration upon a showing of secondary meaning, and that Applicant had "carried its burden of demonstrating the mark's secondary meaning as to the hotel reservation services described in Class 43 but not as to the travel agency services recited in Class 39."¹ The Court granted in part and denied in part each party's motion for summary judgment.

In its Amended Judgment Order,² the Court remanded this application to the USPTO to be published for opposition in the *Official Gazette* as to the Class 43

¹ *Booking.com B.V. v. Matal*, No. 1:16-cv-425, 2017 U.S. Dist. LEXIS 126320 (E.D. Va. Aug. 9, 2017).

² *Booking.com B.V. v. Matal*, No. 1:16-cv-425 (E.D. Va. Oct. 26, 2017) (ECF No. 112) (amended order).

services only.³ The Court entered judgment for the USPTO as to the Class 39 services and entered judgment for Applicant as to the Class 43 services. The effect of the Court's decision and Amended Judgment Order was to reverse the USPTO's finding that the mark is generic as applied to the services and to leave in place, as to the Class 39 services only, the Examining Attorney's requirement of a disclaimer.

The Board hereby **REMANDS** the application to the Examining Attorney to take the necessary actions in accordance with USPTO procedures and consistent with the Court's order to make the application ready for publication in Class 43 only. Because this is a multi-class application, the Examining Attorney should advise Applicant that it may:

1. Delete the Class 39 services from the application, thereby making it ready for publication; or
2. Divide the application, by class, into two applications, thereby making the Class 43 application ready for publication. *See* 37 C.F.R. § 2.87, TMEP §§ 1110-1110.11(a) and 1403.03. Under this option, the Examining Attorney's requirement of a disclaimer would stand as to the Class 39 services; however, Applicant could seek further review of the Court's order with respect to the Class 39 application; or
3. Enter a disclaimer, as to the services in Class 39 only, of the exclusive right to use BOOKING.COM apart from the mark as shown. This option would make the application ready for publication in both Classes 39 and 43.

The Examining Attorney should allow Applicant a response time consistent with standard examination procedures in which to exercise its options and such

³ Normally, the Board would wait to act on a court order in a § 21(b) civil action until after the period to appeal the district court's judgment expires or, if an appeal is taken, until after the appeal and any remands are decided. However, the amended judgment Memorandum Opinion makes clear that the Office may not suspend proceedings here unless and until a notice of appeal is filed. *Booking.com B.V. v. Matal*, No. 1:16-cv-425 (E.D. Va. Oct. 26, 2017) (ECF No. 110) (mem. op.).

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additional time as may be reasonably necessary to address any new issues that may arise in connection with the division of the application, the deletion of the Class 39 services, or the entry of a disclaimer. When the application is ready for publication for opposition, the Examining Attorney should approve it for publication in the *Official Gazette* in due course.