

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
January 5, 2016

Mailed:  
February 18, 2016

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.*

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Serial No. 79122365  
Serial No. 79122366

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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.

Opinion by Masiello, Administrative Trademark Judge:

Booking.com B.V. (“Applicant”) filed two applications for extension of protection to  
the United States of two International Registrations for the marks shown below:

U.S. Serial No. 79122365

**Booking.com**

The colors dark blue and light blue are claimed as a  
feature of the mark;<sup>1</sup> and

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<sup>1</sup> Application Serial No. 79122365 was filed on November 7, 2012 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1140887 dated November 7, 2012.

U.S. Serial No. 79122366



The colors dark blue, light blue, and white are claimed as a feature of the mark.<sup>2</sup>

The services identified in the two applications (as amended) are the same:

Hotel reservation services 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, hotel accommodations and resorts accommodations, whether or not based on the valuation of customers; information, advice and consultancy relating to the aforesaid services; the aforesaid services also provided electronically, in International Class 43.

In each case, the original Examining Attorney<sup>3</sup> 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 marks have acquired distinctiveness and are entitled to registration under Section 2(f), 15 U.S.C. § 1052(f), the Examining Attorney issued new refusals on the ground that the marks are generic as applied to the services; he also maintained, in the alternative, the mere descriptiveness refusals and found Applicant's showings of acquired

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<sup>2</sup> Application Serial No. 79122366 was filed on November 7, 2012 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1140888 dated November 7, 2012.

<sup>3</sup> The applications were examined through final refusal and Applicant's request for reconsideration by Nelson B. Snyder, III of Law Office 107. They were then assigned to the current Examining Attorney.

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distinctiveness to be insufficient. When the Examining Attorney made each of the refusals final, Applicant requested reconsideration and simultaneously appealed to this Board. The Examining Attorney denied the request for reconsideration and these appeals proceeded.

At Applicant's request, these two cases were consolidated with two other pending appeals of refusals to register the marks in Applicant's related applications Serial Nos. 79114998 and 85485097.<sup>4</sup> 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.<sup>5</sup> 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 records in Serial Nos. 79122365 and 79122366 are essentially identical. Accordingly, we issue our decision regarding them in this single order. Our citations refer to the record in Serial No. 79122366 unless otherwise noted. The other two of the four consolidated cases have somewhat different evidentiary records; separate decisions in those cases will issue in due course.

Applicant and the Examining Attorney have focused virtually all of their attention on the word portion of Applicant's marks, BOOKING.COM, with little discussion of the color and design elements. We too will first address the obviously more important word portion of the marks.

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

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<sup>4</sup> Board order of December 12, 2014, 10 TTABVUE.

<sup>5</sup> Board order of January 30, 2015, 12 TTABVUE.

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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 Am. 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 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 Am. 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.

Applicant’s recitation of services describes, in a variety of ways, lodging accommodation reservation services, e.g. “hotel room reservation services,” “holiday accommodation reservation services” and “resort hotel reservation services,” including such services provided “online” and “electronically.” It also describes “providing information” and “information, advice and consultancy relating to the aforesaid services.”

The Examining Attorney suggests that the genus of the services is “hotel

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reservation services.”<sup>6</sup> Applicant contends that the relevant genus is the broader “travel agency services.”<sup>7</sup> Applicant argues that the “information” and “information, advice and consultancy” services listed in the recitation “are all the types of services that are typically provided by travel agencies”; and argues that the designation “travel agency services” is broad enough to cover all of the identified services, while “the much narrower and more specific alleged genus ‘hotel reservation services’ covers ... few of the services in Class 43.”<sup>8</sup>

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. Therefore, 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). In this case, the recitation of services in each application is substantially more precise than the general term “travel agency services.” Moreover, the words “travel agency” are not used, and there is no reference to a fundamental element of typical travel agency services, which is making arrangements for transportation. We note the following dictionary definitions:

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<sup>6</sup> Examining Attorney’s brief, 15 TTABVUE 8.

<sup>7</sup> Applicant’s brief at 6, 13 TTABVUE 7.

<sup>8</sup> Applicant’s reply brief at 3-4, 16 TTABVUE 4-5.

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travel agency: “an office or enterprise engaged in selling, arranging or furnishing information about personal transportation or travel.”

2433 WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (1993).

travel agent: “a person engaged in selling or arranging personal transportation, tours, or trips.”

*Id.*

travel agency: “a business that accommodates travelers, as by securing tickets, arranging for reservations, and giving information.”

2014 RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (2<sup>nd</sup> ed. 1987).<sup>9</sup>

The recitations’ reference to “information, advice and consultancy,” expressly related to the core “aforesaid services” of helping customers to make lodging reservations, does not convert the identified services to travel agency services such as those offered by a full-scale travel agency. Therefore, the genus of “travel agency services” is substantially broader than the services set forth in the applications and would merely draw our attention away from the more precise questions before us. We note, moreover, that the evidence of record regarding Applicant’s actual activities does not show that Applicant provides reservation services relating to transportation.

Accordingly, focusing on the actual wording of the recitations of services, the genus of Applicant’s services is “hotel room reservation services and other lodging

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<sup>9</sup> The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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reservation services, with related information, advice and consultancy, including such services provided online.”

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 the genus of hotel room and lodging reservation services. The relevant public consists of all persons having an interest in arranging a reservation for a room in a hotel, resort, or other lodging. The Examining Attorney’s refusal and supporting arguments focus almost exclusively on Applicant’s *online* reservation services, and we will do the same.<sup>10</sup> Registration is properly refused if the mark is generic with respect to *any one* of the services for which registration is sought. *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”).

(a) Salient evidence of record.

With respect to the relevant public’s understanding of Applicant’s marks, the Examining Attorney and Applicant have made of record various definitions of the word “booking,” including:

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<sup>10</sup> While Applicant’s brief refers to its “brick and mortar services,” 13 TTABVUE 28, there is no evidence showing that Applicant’s services are available otherwise than online.

: 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

...

: RESERVATION<sup>11</sup>

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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.<sup>12</sup>

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1. An engagement, as for a performance by an entertainer.

2. A reservation, as for accommodations at a hotel.<sup>13</sup>

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1. a contract, engagement, or scheduled performance of a professional entertainer.

2. reservation ( def 5 ).

3. the act of a person who books.<sup>14</sup>

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an engagement, as for a lecture or concert.<sup>15</sup>

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<sup>11</sup> <merriam-webster.com>, Office Action of November 16, 2013 at 61.

<sup>12</sup> <macmillandictionary.com>, Office Action of November 16, 2013 at 64.

<sup>13</sup> <education.yahoo.com/reference/dictionary>, Office Action of March 17, 2013 at 10-11.

<sup>14</sup> <dictionary.reference.com>, Applicant's response of May 15, 2014 at 47.

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

***com:***

ABBREVIATION COMPUTING

commercial organization: used in the email and website addresses of companies.<sup>16</sup>

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***.com:***

abbr.

commercial organization (in Internet addresses).<sup>17</sup>

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***.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.<sup>18</sup>

The Examining Attorney has also made of record excerpts from numerous websites that use the term “booking” to describe Applicant’s online services and similar online services of others. Such services have been called (among other things):

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<sup>15</sup> <collinsdictionary.com/dictionary/American>, Applicant’s response of May 15, 2014 at 43.

<sup>16</sup> MACMILLAN DICTIONARY, at <macmillandictionary.com>, Office Action of November 16, 2013 at 81.

<sup>17</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fifth ed.2011), Office Action of November 16, 2013 at 154.

<sup>18</sup> Definition at <dictionary.com>, Office Action of November 16, 2013 at 79.

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Booking service;<sup>19</sup> hotel booking service;<sup>20</sup> booking online;<sup>21</sup>

Booking website;<sup>22</sup> booking sites;<sup>23</sup>

Hotel booking websites;<sup>24</sup> hotel booking site;<sup>25</sup> hotel booking.<sup>26</sup>

The record contains numerous other uses of the word “booking” in similar contexts, in phrases such as “online travel booking sites”;<sup>27</sup> “online hotel-room booking company”;<sup>28</sup> “hotel-only booking sites”;<sup>29</sup> “finalize the booking”;<sup>30</sup> “vacation-booking websites” and “booking app”;<sup>31</sup> and “travel booking websites.”<sup>32</sup> Notably, Applicant’s

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<sup>19</sup> “Expedia to pay Baltimore \$1.6M,” Dolan Media Newswires, June 20, 2011. Office Action of November 16, 2013 at 46-47. “Online hotel brokers can proceed with Durham County, North Carolina tax challenge,” Dolan Media Newswires, June 7, 2013, Office Action of November 16, 2013 at 17-18.

<sup>20</sup> “How to Get Spring Break Or Basketball Playoff Hotels at Up To 50% Off,” University Wire, March 20, 2013, Office Action of November 16, 2013 at 23-24.

<sup>21</sup> “Booking Travel Online?,” Travel + Leisure, April 2008, Office Action of November 16, 2013 at 147-8.

<sup>22</sup> “How to Save Money When Booking Travel Online, at <huffingtonpost.com>, October 22, 2103, Office Action of November 16, 2013 at 149-52. (at 151-2); <usatoday.com>, Office Action of March 17, 2013 at 30-31.

<sup>23</sup> <hotelpricescompare.com>, Office Action of March 17, 2013 at 13-14.

<sup>24</sup> <frommers.com>, Office Action of March 17, 2013 at 8-9; <hotelpricescompare.com>, Office Action of March 17, 2013 at 13-14; <budgettravel.com>, *id.* at 17-18.

<sup>25</sup> <budgettravel.com>, Office Action of March 17, 2013 at 22-23.

<sup>26</sup> <budgettravel.com>, *id.* at 17-18.

<sup>27</sup> “Booking Travel Online?,” Travel + Leisure, April 2008, Office Action of November 16, 2013 at 147-8.

<sup>28</sup> “Expedia to pay Baltimore \$1.6M,” Dolan Media Newswires, June 20, 2011. Office Action of November 16, 2013 at 46-47.

<sup>29</sup> <frommers.com>, Office Action of March 17, 2013 at 8-9;

<sup>30</sup> <budgettravel.com>, *id.* at 22-23.

<sup>31</sup> <cntraveler.com>, *id.* at 25-27.

<sup>32</sup> <usatoday.com>, *id.* at 30-31.

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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.<sup>33</sup>

Easily manage all your **bookings** <sup>34</sup>

Applicant’s website sets forth a selection of available hotels in various cities, indicating when the latest “booking” was made at various hotels:

New York City  
421 properties

...

Helmsley Park Lane Hotel \*\*\*\* from \$230  
Score from 2574 reviews. Very good, 8.1  
Latest **booking**: 10 minutes ago  
There are 26 people looking at this hotel

New York Marriott Marquis \*\*\*\* from \$299  
Score from 1042 reviews. Very good, 8.3  
Latest **booking**: 2 hours ago  
There are 16 people looking at this hotel<sup>35</sup>

The Examining Attorney has made of record excerpts of websites whose domain names include the designation “booking.com” or “bookings.com”:

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<sup>33</sup> <booking.com>, *id.* at 12 (emphasis added).

<sup>34</sup> *Id.* at 35-36 (emphasis added).

<sup>35</sup> *Id.* (emphasis added).

<u>Domain name</u>	<u>Nature of website</u>
hotelbooking.com	website called hotelbooking.com, offering “your best hotel web search engine.” <sup>36</sup>
francehotelbooking.com	website called Link Paris .com, offering to “find you a great Paris hotel” and hotel search for other French cities. <sup>37</sup>
instantworldbooking.com	website called Instant World Booking.com, offering “Online booking for hotels, youth hostels, and bed and breakfast accommodations at world heritage destinations.” <sup>38</sup>
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!” <sup>39</sup>
cancunhotelbooking.com	website called Cancun Hotel Booking.com offering “Cancun Hotel Reservation – Best Price Guarantee!” <sup>40</sup>
drakehotelbookings.com	website of The Drake Hotel, with function marked “BOOK THIS HOTEL.” <sup>41</sup>
ezyhotelbooking.com	website of ezyHotelBooking, offering “Web based booking software and reservation manager for your hotel.” <sup>42</sup>
frbobookings.com	website of FRBObookings.com “Making Vacation Properties ‘For Rent by Owner’ Easy.” <sup>43</sup>

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<sup>36</sup> Website at <hotelbooking.com>, Office Action of November 16, 2013 at 179-80.

<sup>37</sup> Office Action of November 16, 2013 at 181-2.

<sup>38</sup> *Id.* at 184-6.

<sup>39</sup> *Id.* at 131-2.

<sup>40</sup> Office Action of November 4, 2014 at 62.

<sup>41</sup> *Id.* at 64.

<sup>42</sup> *Id.* at 69.

<sup>43</sup> *Id.* at 71.

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netbookings.com website of NETBOOKINGS providing “Online Availability and Reservation System options.”<sup>44</sup>

roomsbooking.com website called roomsbooking.com, with “Featured Hotel Deals.”<sup>45</sup>

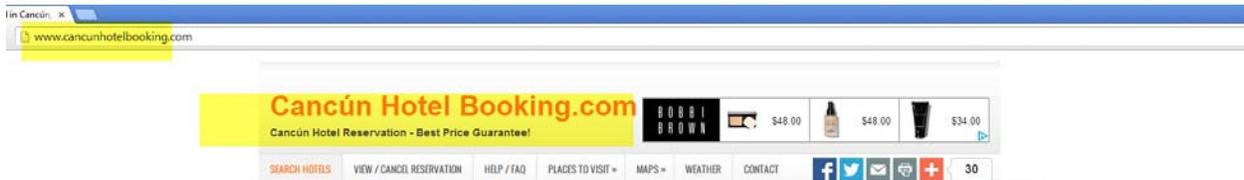
treehousebookings.com website of Treehouse Lodge, stating, “BOOK A TREE HOUSE.”<sup>46</sup>

Some of these websites make clear trade name use of designations that include “booking.com,” as shown below:

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



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

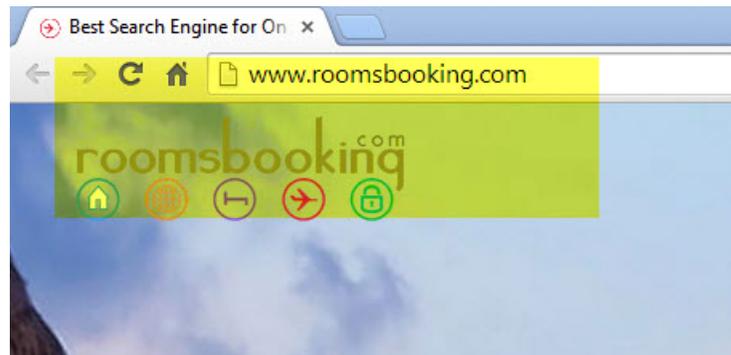


<sup>44</sup> *Id.* at 72.

<sup>45</sup> *Id.* at 73.

<sup>46</sup> *Id.* at 74.

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The record also includes evidence of domain names that combine “.com” with various combinations of the words “booking” or “book,” including the following:<sup>47</sup>

- Bookingcenter.com
- Bookingplusinc.com
- Bookingwiz.com
- Hotelbookingsolutions.com
- Fastbooking-hotels.com
- Bookingbuddy.com
- Ebookers.com
- Hotelbook.com
- Quikbook.com
- Bookit.com

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<sup>47</sup> See *id.* at 59-74 and Office Action of November 16, 2013 at 130-174.

To demonstrate public understanding of BOOKING.COM, Applicant has made of record and focuses heavily on a two-page, 2012 press release by J.D. Power & Associates 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. Power and Associates 2012 Independent Travel Website Satisfaction Report<sup>SM</sup> 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**

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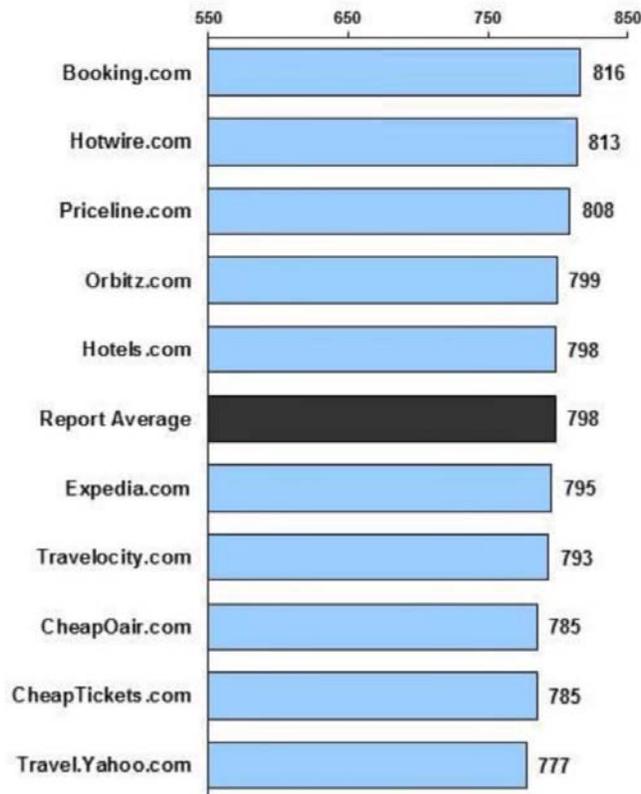
Booking.com ranks highest with a score of 816, performing particularly well in availability of booking/reservation options; ease of booking/reserving; and pricing. Following Booking.com in the rankings are Hotwire.com (813) and Priceline.com (808).

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. ...<sup>48</sup>

The chart accompanying the press release is set forth below:<sup>49</sup>

**J.D. Power and Associates  
2012 Independent Travel Website  
Satisfaction Report<sup>SM</sup>**

**Customer Satisfaction Index Ranking**  
*(Based on a 1,000-point scale)*



<sup>48</sup> Applicant's response of September 17, 2013 at 31-32.

<sup>49</sup> *Id.* at 33.

The press release is discussed in the declaration of Applicant's Director, Rutger Marinus Prakke, which states:

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); ...<sup>50</sup>

The Prakke Declaration also states that Applicant has won awards for a 2013 advertising campaign; for "Best Tablet App"; and "Best Mobile Site."<sup>51</sup> It also sets forth figures for the following aspects of Applicant's business:

- countries served;
- accommodations-providers accessible via the service;
- transaction value of accommodation reservations made (worldwide);
- 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;

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<sup>50</sup> Declaration of Rutger Marinus Prakke, ¶ 11, Applicant's response of May 15, 2014 at 85.

<sup>51</sup> *Id.*

- number of unsolicited news articles found in a Google News search.<sup>52</sup>

Applicant also submitted a declaration from its legal counsel Jaap van den Broek which contains color examples of web advertising; details of an advertising campaign in partnership with Fandango.com (online movie ticket vendor); references to unsolicited customer reviews; information regarding Applicant's presence on Twitter and Facebook; and information regarding Applicant's use of colors, logos and other marks.<sup>53</sup>

(b) Discussion.

It is clear from the dictionary definitions that an accepted meaning of "booking" is a reservation for a room in a hotel; and it is clear from the internet evidence that the term "booking" has been widely used to describe the service of arranging reservations for hotel rooms, as described in Applicant's recitation of services and as comprehended by the applicable genus.

Applicant contends that the dictionary definitions show that the primary descriptive meaning of "booking" does not relate to travel, but instead 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," when used

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<sup>52</sup> *Id.* at 83-90.

<sup>53</sup> Declaration of Jaap van den Broek, Applicant's response of October 13, 2014 at 50-61. (Applicant apparently did not file certain exhibits referred to in the Broek declaration.)

as an adjective, may mean “cool,” that “to book” may mean “to leave quickly,” and that “booking” may mean “running really fast.”<sup>54</sup> 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.<sup>55</sup>

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 “hotel room reservation services and other lodging reservation services, with related information, advice and consultancy, including such services provided online.” Those persons would be exposed to the mark in the context of those services and, accordingly, that is the 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

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<sup>54</sup> Applicant’s brief at 21, fn5, 13 TTABVUE 22, referring to evidence submitted with Applicant’s Response of May 15, 2014 at 56-59.

<sup>55</sup> Applicant’s reply brief at 12, 16 TTABUE 13.

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766.<sup>56</sup> *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 each mark in its entirety.<sup>57</sup>

Applicant argues that:

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.

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<sup>56</sup> 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.

<sup>57</sup> 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 genericness is that the *composite* mark BOOKING.COM as a full phrase be generic.” 15 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.

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

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 Properties 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 marks on the basis of analysis and evidence that were highly similar to those 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

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<sup>58</sup> Applicant’s brief at 7, 13 TTABVUE 8.

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not lose its generic character by placement in the domain name HOTELS.COM.” 91  
USPQ2d at 1535.

Addressing the term BOOKING.COM 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.<sup>59</sup>

This contention is supported by the dictionary definitions, quoted above, indicating that “booking” means “reservation” or “an arrangement to ... stay in a hotel room ...” and that “.com” is an abbreviation meaning “commercial organization (in Internet addresses)” and is “Part of the Internet address [that] indicates that the site is commercial ...” 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 class of services identified in the applications [citing *Magic Wand*].<sup>60</sup>

[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

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<sup>59</sup> Examining Attorney’s brief, 15 TTABVUE 13 (emphasis in original).

<sup>60</sup> Applicant’s brief at 5, 13 TTABVUE 6.

literally a genus or class name, but it at most contains elements descriptive or suggestive of the class.<sup>61</sup>

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 was restated 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 or service as a ‘booking.com’”;<sup>62</sup> 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.

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<sup>61</sup> *Id.* at 10, 13 TTABVUE 11.

<sup>62</sup> *Id.* at 12, 13 TTABVUE 13.

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 combinations "booking.com" and "bookings.com" as components of domain names and trade names in the field of 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 ...<sup>63</sup>

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 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,<sup>64</sup> we find that it is at best a

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<sup>63</sup> *Id.* at 3, 13 TTABVUE 4.

<sup>64</sup> "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.

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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. *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 subjects 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 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 representatives' 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 Properties Inc.*, 82 USPQ2d 1378 (Fed. Cir. 2007), the Court found evidence similar to that 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

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site’)” constitutes “positive evidence the disputed term is *not* generic.”<sup>65</sup> 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 designations “booking.com” and “bookings.com” as parts of trade names and domain names that describe the nature of their services (e.g., “hotelbooking.com,” “ezhotelbooking.com,” “drakehotelbookings.com,” and “roomsbooking.com,” among others). If such businesses could not use “booking.com” as a part of their domain names or trade names, they would be meaningfully 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.”);

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<sup>65</sup> Applicant’s brief at 6, 13 TTABVue 7.

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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.”<sup>66</sup> 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. 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.<sup>67</sup> 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 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

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<sup>66</sup> Applicant’s brief at 14; *see also id.* at 24, 13 TTABVUE 15, 25.

<sup>67</sup> *Id.* at 18, 13 TTABVUE 19.

field undermines the purposes of trademark law by betraying the trust consumers place in the brand.<sup>68</sup>

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.

*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).

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<sup>68</sup> *Id.* at 3, 13 TTABVUE 4.

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.”<sup>69</sup> 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, ENTERTAINMENT.COM is not registered for providing entertainment of any kind, but for advertising services, promoting the

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<sup>69</sup> *Id.* at 24-25, 13 TTABVUE 25-26; and Applicant’s response of May 15, 2014 at 67-83.

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goods and services of others, and discount programs. Reg. No. 4294532, registered under Section 2(f).<sup>70</sup>

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 was 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."<sup>71</sup> 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 immediately understood as having the meaning of booking lodgings through an internet service.

We therefore find that the Examining Attorney's dictionary and usage evidence demonstrates, *prima facie*, that relevant customers would understand the term

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<sup>70</sup> Applicant's response of May 15, 2014 at 79.

<sup>71</sup> Applicant's brief at 27, 13 TTABVUE 28.

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BOOKING.COM to refer to an online reservation service for lodgings; and that Applicant's evidence of its business success and high level of customer satisfaction does not rebut this showing. To complete our consideration of Applicant's marks in their entireties, we next consider whether the design elements of the marks would justify registration notwithstanding our finding that BOOKING.COM is generic for the identified services.

3. The design elements of the marks.

If the design elements of Applicant's marks were found to be distinctive, whether inherently or through acquired distinctiveness, registration of the marks on the Principal Register would be permissible, provided that Applicant were to disclaim the exclusive right to use the wording of the marks. (Applicant has not requested a registration in such form, nor indicated any willingness to enter such a disclaimer.) One of Applicant's marks is presented in stylized letters in two colors and the other is presented in stylized letters with a rectangular "carrier," in three colors. We must decide whether these design and color elements are sufficiently distinctive, whether inherently or through acquired distinctiveness, to create a commercial impression separate and apart from the generic term BOOKING.COM. *In re Northland Aluminum Prods, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) ("The Board also correctly found that the form of the lettering of the mark is 'not so distinctive as to create a commercial impression separate and apart from the term BUNDT.' ... The record is devoid of evidence of public recognition of this overall format as a trademark." [citing *G. D. Searle*, 360 F.2d at 655-656, 149 USPQ at 623]); *see also In*

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*re Cordua Rests. LP*, 110 USPQ2d 1227, 1232 (TTAB 2014) (“[T]he display of Applicant’s mark, consisting primarily of stylized letters, does not make the applied-for matter registrable, despite the genericness of the term CHURRASCOS, since it does not create a separate commercial impression over and above that made by the generic term.”).

The lettering in which the marks are presented is conventional. There is no evidence of record indicating that the font has style elements that are unusual in any way; if there are any refinements in the font that could distinguish it from conventional lettering styles, they consist only of a slight rounding of the corners of the letters. Customers would not recognize the style of lettering as an indicator of source. The blue rectangular carrier in one of the marks is extremely conventional and certainly would not be perceived as a source-indicating element. The color schemes of light blue and dark blue; and of light blue, dark blue, and white are, inherently, insufficiently distinctive to indicate source. All of the design and color elements, considered together, are, inherently, not so distinctive as to create a commercial impression separate and apart from the term BOOKING.COM.

Applicant has submitted a substantial amount of evidence to show that BOOKING.COM has allegedly acquired distinctiveness, but none of it focuses on the design and color elements of the marks; it does not demonstrate that the color or design elements have received particular notice or have developed market recognition as an indicator of Applicant as the source of services. We find that the

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respective design elements of the two marks at issue are not, in themselves, distinctive and that they therefore do not justify registration of the marks.

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

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

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

Applicant's evidence of acquired distinctiveness focuses on the wording BOOKING.COM and does not address the specific stylized marks at issue in this appeal. 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; 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., supra*. Assuming for the sake of analysis that Applicant's marks are not generic, but highly descriptive, we must consider whether the evidence suffices to render them 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

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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 Applicant's marks and the actual use of BOOKING.COM in the marketplace by third parties, very strong evidence of acquired distinctiveness would be required to render the marks 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 ...”<sup>72</sup> The record contains 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 marks on the ground that they are merely descriptive and that Applicant has failed to demonstrate that they have acquired distinctiveness within the meaning of Section 2(f).

**Decision:** The refusal to register Applicant’s marks is AFFIRMED on the ground that they are generic as applied to Applicant’s services; and on the ground

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<sup>72</sup> Applicant’s response of May 15, 2014 at 106-7 (emphasis added).

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that they are merely descriptive of Applicant's services and have not been shown to have acquired distinctiveness.