

No.

In the Supreme Court of the United States

UNITED STATES PATENT AND TRADEMARK OFFICE;
ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR, UNITED
STATES PATENT AND TRADEMARK OFFICE, PETITIONERS

v.

BOOKING.COM B.V.

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT*

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Under the Lanham Act, 15 U.S.C. 1051 *et seq.*, generic terms may not be registered as trademarks. The question presented is as follows:

Whether the addition by an online business of a generic top-level domain (".com") to an otherwise generic term can create a protectable trademark.

RELATED PROCEEDINGS

United States District Court (E.D. Va.):

Booking.com B.V. v. Matal, No. 16-cv-425 (Aug. 9, 2017) (order on summary judgment)

Booking.com B.V. v. Matal, No. 16-cv-425 (Oct. 26, 2017) (order on defendants' motion to amend judgment and motion for expenses)

United States Court of Appeals (4th Cir.):

Booking.com B.V. v. United States Patent & Trademark Office, No. 17-2458 (Feb. 4, 2019, amended Feb. 27, 2019), petition for reh'g denied, Apr. 5, 2019 (defendants' appeal of partial grant of summary judgment)

Booking.com B.V. v. United States Patent & Trademark Office, No. 17-2459 (Feb. 4, 2019, amended Feb. 27, 2019), petition for reh'g denied, Apr. 5, 2019 (plaintiff's cross-appeal on expenses)

Supreme Court of the United States:

Booking.com B.V. v. United States Patent & Trademark Office, petition for cert. pending, No. 18-1309 (filed Apr. 10, 2019)

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PETITION FOR A WRIT OF CERTIORARI

The Solicitor General, on behalf of the United States Patent and Trademark Office and its Director, respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Fourth Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (App., *infra*, 1a-45a) is reported at 915 F.3d 171. The opinion of the district court on summary judgment (App., *infra*, 46a-107a) is reported at 278 F. Supp. 3d 891. The opinion of the district court on petitioners' motion to amend the judgment and motion for expenses (App., *infra*, 108a-135a) is not published in the Federal Supplement but is available at 2017 WL 4853755. The opinions of the Trademark Trial and Appeal Board (App., *infra*, 136a-

181a, 182a-224a) are not published in the United States Patents Quarterly but are available at 2016 WL 1045671 and 2016 WL 1045674, respectively.

JURISDICTION

The judgment of the court of appeals was entered on February 4, 2019. A petition for rehearing was denied on April 5, 2019 (App., *infra*, 225a-226a). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 1127 of Title 15 of the United States Code defines a “trademark” in relevant part as “any word, name, symbol, or device, or any combination thereof” that is “used by a person * * * to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. 1127. Other pertinent statutory provisions are reproduced in the appendix to this petition. App., *infra*, 227a-247a.

STATEMENT

This case involves respondent’s applications to register trademarks containing the term BOOKING.COM for online hotel reservation services. The United States Patent and Trademark Office (USPTO) refused registration. The agency concluded that the term “booking” is generic for the services as to which respondent sought registration, and that the addition of the generic top-level domain “.com” did not create a protectable mark. App., *infra*, 136a-181a, 182a-224a. Respondent sought review of that decision in the United States District Court for the Eastern District of Virginia, which held that the term BOOKING.COM was non-generic

and potentially protectable as a trademark. *Id.* at 46a-107a. The Fourth Circuit affirmed. *Id.* at 1a-45a.

1. a. A trademark is a “word, name, symbol, or device” used by a person “to identify and distinguish his or her goods” in commerce and “to indicate the source of the goods.” 15 U.S.C. 1127. Federal law does not create trademark rights. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017); *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Rather, trademarks have been protected by the common law and in equity since the founding, and the common law and statutes of many States continue to provide such protection today. *Tam*, 137 S. Ct. at 1751. Federal law, however, has long provided additional advantages. See Act of Feb. 20, 1905, ch. 592, 33 Stat. 724; Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 210-212. Since 1946, those advantages have been provided through the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*). As relevant here, the Lanham Act defines the term “trademark” and authorizes federal registration of trademarks if certain requirements are met. 15 U.S.C. 1051(a)(1), 1052(a)-(e), 1127.

For purposes of determining whether particular words or phrases can serve as trademarks, this Court has identified five categories of terms, listed in increasing order of distinctiveness and protectability: “(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; [and] (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.)). “A generic term is one that refers to the genus of which the particular product is a species.” *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). It is “the common name of a product or service itself,” and “identifies the general nature of an article.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d

455, 464 & n.10 (4th Cir.) (citation omitted), cert. denied, 519 U.S. 976 (1996). By declining to recognize generic names as trademarks, trademark law “protect[s] the linguistic commons by preventing exclusive use of terms that represent their common meaning.” App., *infra*, 2a. The courts of appeals have recognized as generic such terms as “Convenient Store” retail stores, “Crab House” seafood restaurants, “Consumer Electronics Monthly” magazine, and “Warehouse Shoes” retail stores. See *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001); *Sara Lee Corp.*, 81 F.3d at 464; *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1161 (7th Cir. 1996); *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 12-15 (2d Cir. 1975).¹

In contrast to a generic term, a descriptive term “describes the qualities or characteristics of a good or service,” *Park ’N Fly, Inc.*, 469 U.S. at 194, such as its “function, use, characteristic, size, or intended purpose,” *Retail Servs., Inc. v. Freebies Publ’g*, 364 F.3d 535, 539 (4th Cir. 2004) (citation omitted). See 4 Louis Altman & Malla Pollack, *Callmann on Unfair Competition, Trademarks and Monopolies* § 18:14, at 18-160 (4th ed. 2019) (“A generic term categorizes; it conveys information

¹ The Lanham Act originally referred to generic terms as those that constitute “the common descriptive name of an article or substance.” *Park ’N Fly, Inc.*, 469 U.S. at 193-194 (quoting 15 U.S.C. 1064(c) (1982)). In the Trademark Law Revision Act of 1988 (TLRA), Pub. L. No. 100-667, Tit. I, 102 Stat. 3935 (effective Nov. 16, 1989, see TLRA § 136, 102 Stat. 3948), Congress amended the statute to replace the phrase “common descriptive name” with the phrase “generic name,” *e.g.*, TLRA § 115, 102 Stat. 3940 (15 U.S.C. 1064(3) (1988)). See generally 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:21, at 12-106 to 12-107 (5th ed. 2019).

with respect to the nature or class of an article. A descriptive term, on the other hand, characterizes; it identifies the characteristics and qualities of the article, such as its color, odor, functions, dimensions or ingredients.”) (emphases omitted). Examples of descriptive terms include “After Tan post-tanning lotion, 5 Minute glue, King Size men’s clothing, and the Yellow Pages telephone directory.” *Sara Lee Corp.*, 81 F.3d at 464 (citing 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11.08, at 11-31 to 11-40 (3d ed. 1996)). Unlike generic terms, descriptive terms may be protected, but only if “the registrant shows that [the term] has acquired secondary meaning, *i.e.*, it ‘has become distinctive of the applicant’s goods in commerce.’” *Park ’N Fly, Inc.*, 469 U.S. at 194 (quoting 15 U.S.C. 1052(f) (1982)). A descriptive term has acquired secondary meaning, and may be registrable, “if in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Sara Lee Corp.*, 81 F.3d at 464 (citations and internal quotation marks omitted).

Suggestive, arbitrary, and fanciful marks “are deemed inherently distinctive and are entitled to protection.” *Two Pesos, Inc.*, 505 U.S. at 768. “Suggestive marks connote, without describing, some quality, ingredient, or characteristic of the product.” *Sara Lee Corp.*, 81 F.3d at 464 (providing examples of Coppertone® and Orange Crush®). “Arbitrary marks are comprised of words in common usage, but, because they do not suggest or describe any quality, ingredient, or characteristic of the goods they serve, are said to have been arbitrarily assigned.” *Ibid.* (providing examples of Camel® cigarettes and Apple® computers). “Fanciful marks are, in essence, made-up words.” *Ibid.* (providing examples of Clorox® and Kodak®).

b. When an applicant seeks to register a trademark, a USPTO examining attorney determines whether “the applicant is entitled to registration.” 15 U.S.C. 1062(a). An applicant who is dissatisfied with the examining attorney’s decision may appeal to the Trademark Trial and Appeal Board (TTAB), which renders a final decision on behalf of the USPTO. See 15 U.S.C. 1067, 1070. If the examining attorney finds that registration is proper, “[a]ny person who believes that he would be damaged by the registration” may file an opposition addressed to the TTAB. 15 U.S.C. 1063(a); see 37 C.F.R. 2.101(b); see also 37 C.F.R. 2.111 (permitting third parties to initiate cancellation proceedings). Both the examining attorney and the TTAB apply Federal Circuit precedents in deciding whether particular marks qualify for registration. See USPTO, *Trademark Trial and Appeal Board Manual of Procedure* § 101.03 (June 2018) (*TTAB Manual*).

Any party who is dissatisfied with the TTAB’s decision may file a direct appeal in the Federal Circuit. 15 U.S.C. 1071(a); see 37 C.F.R. 2.145(a). That court reviews “the decision from which the appeal is taken on the record before the [USPTO],” 15 U.S.C. 1071(a)(4), and reviews the USPTO’s factual findings for “substantial evidence,” *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed. Cir. 2003). Cf. *Dickinson v. Zurko*, 527 U.S. 150, 152, 165 (1999) (holding that courts of appeals must apply the deferential standards of review prescribed by the Administrative Procedure Act, 5 U.S.C. 701 *et seq.*, to the USPTO’s findings of fact under the materially similar patent scheme).

Alternatively, any party that is dissatisfied with the TTAB’s decision may file a civil action in federal district court. 15 U.S.C. 1071(b)(1); see 37 C.F.R. 2.145(c). Unlike in a direct appeal, the applicant and the USPTO may

conduct discovery, and the applicant may introduce evidence that the agency had no prior opportunity to consider. Where new evidence is introduced on an issue, “the judge resolves registration *de novo*.” *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1301 (2015); see 15 U.S.C. 1071(b)(3). Any appeal from the district court’s decision in such a proceeding is heard by the appropriate regional court of appeals. 28 U.S.C. 1291.

2. a. Respondent operates a website on which customers can book hotel accommodations. App., *infra*, 4a. In 2011 and 2012, respondent filed four federal trademark-registration applications for marks that included or consisted of the term “BOOKING.COM.” *Ibid.* As relevant here, the applications sought registration for use of the marks in connection with “online hotel reservation services.” *Ibid.*; see *id.* at 4a n.2.

The examining attorney refused registration on the ground that BOOKING.COM is generic as applied to the relevant services. See App., *infra*, 5a. The TTAB affirmed in three substantially similar opinions. *Ibid.*; see *id.* at 136a-181a, 182a-224a (TTAB decisions on two applications). The TTAB concluded that “relevant customers would understand the term BOOKING.COM to refer to an online reservation service for transportation and lodgings.” *Id.* at 218a; see *id.* at 176a. In reaching that conclusion, the TTAB relied on dictionary definitions of the terms “‘booking,’” and “.com”; the use of the term “‘booking’” by “numerous websites” and by respondent to refer to the relevant class of services; and “third-party domain names and trade names that include the designation ‘booking.com,’” such as “hotelbooking.com” and “ebooking.com.” *Id.* at 141a-169a, 187a-211a.²

² A domain name is a string of text that is used to look up a particular site or resource on the Internet. A top-level domain is the

The TTAB observed that its conclusion comported with prior decisions of the Federal Circuit, which had “held to be generic marks that were similar” to BOOKING.COM—such as “HOTELS.COM” and “LAWYERS.COM”—“on the basis of” “highly similar” evidence. *Id.* at 162a-163a, 170a, 205a-206a, 213a (citing *In re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009) and *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376 (Fed. Cir. 2007)).

b. Respondent sought review in the United States District Court for the Eastern District of Virginia, see 15 U.S.C. 1071(b), which reversed in relevant part, App., *infra*, 46a-107a. The court recognized that “the term ‘booking’ is generic” for the relevant class of services. *Id.* at 67a. It also observed that the Federal and Ninth Circuits had found the combination of similar generic terms and top-level domains like “.com” to be generic. *Id.* at 69a-72a, 77a-78a.

The district court nonetheless concluded that top-level domains like “.com” “are generally source identifying and that a mark composed of a generic [second-level domain] and a [top-level domain] is a descriptive mark eligible for protection upon a showing of acquired distinctiveness.” App., *infra*, 84a-85a. The court found that its “general[]” rule applied in this case because respondent’s “Teflon survey”—which respondent had introduced for the first time in the district court—showed

right-most portion of a domain name, such as “.com,” “.net,” “.org,” or “.gov.” Domain names also include second-level domains (*e.g.*, “uscourts.gov”) and may include third-level domains (*e.g.*, “ca4.uscourts.gov”). See, *e.g.*, *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 492-493 (2d Cir.), cert. denied, 530 U.S. 1262 (2000); *Brookfield Comm’ncs, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1044 (9th Cir. 1999). In the case of “booking.com,” “.com” is the top-level domain and “booking” is the second-level domain.

that “74.8 percent” of surveyed consumers “identified BOOKING.COM as a brand name.” *Id.* at 84a, 88a.

Having concluded that respondent’s proposed marks were descriptive, the district court held that, as applied to hotel reservation services, the marks had acquired secondary meaning. App., *infra*, 97a-104a. The court ordered the USPTO to register the marks as to two applications, and it remanded the other two applications for further agency fact-finding regarding design and color elements of the proposed marks. *Id.* at 106a-107a & n.23. The court subsequently amended its judgment to direct that the marks it had found distinctive be published for opposition in the USPTO’s Official Gazette, a necessary precondition for registration. *Id.* at 110a-116a; see 15 U.S.C. 1062(a).

3. The court of appeals affirmed. App., *infra*, 1a-27a.

a. The court of appeals concluded that BOOKING.COM, taken as a whole, is not generic because the relevant public would primarily understand the term to indicate respondent’s brand. App., *infra*, 9a-10a; see *id.* at 12a-13a. The court relied in significant part on respondent’s Teflon survey, rejecting the USPTO’s argument that such survey evidence is irrelevant to the question whether BOOKING.COM is generic. *Id.* at 16a-18a. The court acknowledged that, “[i]f a term is deemed generic, subsequent consumer recognition of the term as brand-specific cannot change that determination.” *Id.* at 11a. The court held, however, that this rule applies only where a term was “already deemed generic” by “a prior court” or was “previously commonly used” by the public. *Id.* at 21a & n.11.

In arguing that BOOKING.COM is generic, the government relied in part on this Court’s holding in *Good-year’s India Rubber Glove Manufacturing Co. v. Good-year Rubber Co.*, 128 U.S. 598 (1888), that the addition

of a corporate identifier such as “Company” to a generic term cannot create a protectable trademark. App., *infra*, 18a. The government contended that the *Goodyear* Court’s rationales for that conclusion apply equally to the addition of the top-level domain “.com” to a generic term. *Id.* at 18a-19a. The court of appeals rejected that argument, stating that “*Goodyear* was decided almost sixty years before the Lanham Act and, crucially, did not apply the primary significance test” that the court in this case applied. *Id.* at 19a.

The court of appeals stated that it was “not unsympathetic to the USPTO’s concerns that granting trademark protection over BOOKING.COM may prevent other companies from using the mark.” App., *infra*, 24a. But the court found “these concerns * * * assuaged by two considerations.” *Ibid.* The court first posited that, because trademark protection applies only to particular services—here, hotel reservation services—other businesses likely could continue to use domain names like “carbooking.com” or “flightbooking.com.” *Ibid.* Second, the court observed that a plaintiff in a future infringement suit would be required to show a likelihood of consumer confusion, which might be “more difficult” in the context of “unique” domain names. *Id.* at 24a-25a.

b. Judge Wynn dissented in relevant part. App., *infra*, 28a-45a (Wynn, J., concurring in part and dissenting in part). He explained that, because “trademark law does not protect generic terms,” a business can choose a non-generic domain name like Amazon.com, and exclude competitors from using close variants of that name; or it can choose a generic domain name that identifies the goods or services it provides, thereby easily attracting customers on the Internet but forgoing the benefits of trademark protection. *Id.* at 28a. Judge

Wynn would have held that BOOKING.COM falls into the latter category. *Id.* at 28a-29a.

Judge Wynn would have reversed the district court’s judgment on the ground that the court’s factual findings were premised on “legal error”—the court’s conclusion that the combination of “.com” and a generic term “is usually a descriptive mark eligible for protection upon a showing of secondary meaning.” App., *infra*, 30a n.2 (Wynn, J., concurring in part and dissenting in part) (citation omitted); see *id.* at 30a-32a. Judge Wynn stated that the majority’s “ultimate determination—that the proposed mark BOOKING.COM is descriptive—conflicts with the determination that *every other court* has reached” in similar cases. *Id.* at 32a; see generally *id.* at 32a-37a.

Judge Wynn further explained that the court of appeals’ decision undermined the rule that, no matter how much success the user of a generic term “has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” App., *infra*, 38a-39a (Wynn, J., concurring in part and dissenting in part) (quoting *Abercrombie & Fitch Co.*, 537 F.2d at 9) (emphasis omitted). Finally, Judge Wynn stated that the court’s decision “unjustifiably empowers [respondent] to monopolize language” and “freeze out potential competitors,” who cannot “use the term ‘booking’ in their own website domain names” without “fac[ing] the risk of a costly, protracted, and uncertain infringement lawsuit.” *Id.* at 41a-42a; see *id.* at 42a-45a.³

³ The court of appeals unanimously affirmed the district court’s determination that, under 15 U.S.C. 1071(b)(3), the USPTO was entitled to “all the expenses of the proceeding,” including the salary expenses of USPTO personnel who defended the action. App., *infra*,

4. The court of appeals denied the government’s petition for rehearing en banc. App., *infra*, 225a-226a.

REASONS FOR GRANTING THE PETITION

The court of appeals held that an applicant may obtain federal trademark protection for a generic term by adding “.com” to that term, so long as the relevant public would understand the combination to refer to a specific business. That holding contravenes established principles of trademark law, and it conflicts with decisions of the Federal and Ninth Circuits, the only other courts of appeals that have considered the protectability of “generic.com” terms.

More than 130 years ago, this Court held that the addition of an entity designation like “Company” to an otherwise-generic term like “wine,” “cotton,” or “grain” does not create a protectable mark, because “the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods.” *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888); see *id.* at 603. The same principle applies to the addition of the top-level domain “.com,” which denotes only that respondent operates an online business. It likewise has long been established

25a-27a (majority opinion); *id.* at 30a n.2 (Wynn, J., concurring in part and dissenting in part). The court of appeals subsequently deconsolidated respondent’s cross-appeal on expenses from the USPTO’s appeal, and it granted respondent’s motion to stay the mandate in the cross-appeal pending this Court’s decision in *Peter v. NantKwest, Inc.*, cert. granted, No. 18-801 (Mar. 4, 2019), which presents the question whether the USPTO may recoup the same types of personnel expenses under the parallel provision of the Patent Act of 1952, 35 U.S.C. 145. Respondent has filed a petition for a writ of certiorari on the expenses question, which remains pending. *Booking.com B.V. v. United States Patent & Trademark Office*, No. 18-1309 (filed Apr. 10, 2019).

that, no matter how successful “the user of a generic term” is “in securing public identification” between the term and its commercial user, the business “cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.). The decision below contravenes that principle by allowing respondent to rely on survey evidence of brand identification to obtain federal trademark protection for a generic term, thus “freez[ing] out” its competitors from using domain names that accurately categorize their services. App., *infra*, 41a (Wynn, J., concurring in part and dissenting in part).

The court of appeals’ decision conflicts with rulings of the Federal and Ninth Circuits, which have held that “generic.com” names similar to BOOKING.COM are unprotectable as trademarks. That division of authority is especially destabilizing because the Lanham Act’s judicial-review provisions allow dissatisfied parties to challenge TTAB decisions in either the Federal Circuit or an appropriate district court, and because district-court review generally will be available in the United States District Court for the Eastern District of Virginia, where the USPTO is located and where the Fourth Circuit’s decision in this case will be binding precedent. The decision below also is likely to have serious and immediate anticompetitive effects. See App., *infra*, 41a-45a (Wynn, J., concurring in part and dissenting in part). The petition for a writ of certiorari should be granted.

A. The Court Of Appeals’ Decision Is Wrong

In a divided decision, the court of appeals held that the term BOOKING.COM may be registered as a trademark, even though “booking” is a generic term for hotel

reservation services and a top-level domain like “.com” “does not itself have source-identifying significance.” App., *infra*, 20a; see *id.* at 20a n.9. That decision is contrary to this Court’s precedent, which recognizes that the addition of a corporate designation to a generic term does not render the combination non-generic. The court of appeals’ analysis conflates the question whether a term is generic with the distinct question whether a party seeking to register a descriptive term has established “secondary meaning,” *i.e.*, an association in the minds of consumers between the term and the party’s business.

1. In *Goodyear*, this Court decided a nineteenth-century analogue to the question presented here. The Goodyear Rubber Company sought to restrain Goodyear’s India Rubber Glove Manufacturing Company from using the name “Goodyear’s Rubber Manufacturing Company” or any equivalent. 128 U.S. at 599. The Court rejected that claim, holding that the term “Goodyear Rubber Company” was not “capable of exclusive appropriation.” *Id.* at 602. The Court explained that “Goodyear Rubber” was the common descriptive (*i.e.*, generic, see p. 4 n.1, *supra*) name for “well-known classes of goods produced by the process known as Goodyear’s invention,” and that “addi[ng] * * * the word ‘Company’ only indicate[d] that parties ha[d] formed an association or partnership to deal in [the relevant class of] goods, either to produce or to sell them.” *Goodyear*, 128 U.S. at 602. The Court further explained that “parties united to produce or sell wine, or to raise cotton or grain,” could not, by adopting the names “Wine Company, Cotton Company, or Grain Company, * * * impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles, and

to publish the fact to the world.” *Id.* at 602-603. This Court reaffirmed that ruling nearly two decades later, citing *Goodyear* with approval and reiterating that “one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right.” *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 137 (1905).

The same principle applies here. As the district court recognized and the court of appeals did not dispute, the term “booking” is generic for the class of hotel reservation services described in respondent’s trademark applications. See App., *infra*, 12a-25a, 67a. Thus, under *Goodyear*, respondent could not federally register “The Booking Company” or “Booking Inc.” as a trademark for the relevant class of services. By the same logic, respondent should not be permitted to federally register BOOKING.COM. Just as “addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in” the relevant class of goods or services, *Goodyear*, 128 U.S. at 602, addition of the top-level domain “.com” “communicates no more than the common meaning[] * * * that the applicant operates a commercial website via the internet,” *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009). The adoption of a “generic.com” domain name, “without other specification,” therefore cannot “create any exclusive right to the use of the name” as a trademark. *Goodyear*, 128 U.S. at 603.

The Court in *Goodyear* stated that recognition of a trademark in the name “Grain Company” or “Wine Company” would have interfered with competitors’ rights “to deal in such articles, and to publish the fact to the world.” 128 U.S. at 602-603. Similarly here, treating BOOKING.COM as a protectable trademark would allow a single entity to monopolize the term “booking”

with respect to the relevant online services and would impede respondent’s competitors from using it in their own domain names. “[G]rants trademark rights over a domain name composed of a generic term and a [top-level domain] grants the trademark holder rights over far more intellectual property than the domain name itself.” *Advertise.com, Inc. v. AOL Adver., Inc.*, 616 F.3d 974, 980 (9th Cir. 2010). “In addition to potentially covering all combinations of the generic term with any [top-level domain] (*e.g.*, ‘.com’; ‘.biz’; ‘.org’), such trademark protection would potentially reach almost any use of the generic term in a domain name.” *Id.* at 980-981. For instance, respondent might bring infringement suits against competitors operating domain names such as “roomsbooking.com,” “hotelbooking.com,” “ebooking.biz,” or any of “a vast array of simple, easy to remember domain names and designations that describe the services provided.” *Id.* at 981. Indeed, respondent informed the USPTO that it “considers the use * * * of EBOOKING.COM [by one of its competitors] to be a potential infringement.” C.A. App. 207.⁴

Both the Federal and Ninth Circuits have viewed *Goodyear* as applicable to “generic.com” domain names, in light of the similarities between the addition of “.com”

⁴ The court of appeals posited that, for various reasons, respondent might not ultimately succeed in an infringement suit against a competitor that used a different domain name. App., *infra*, 24a-25a. But “competitors seeking to avoid litigation risk and expenses—even if they might ultimately prevail * * * —will be chilled from using the term” “booking” in their own domain names. *Id.* at 44a (Wynn, J., concurring in part and dissenting in part); see, *e.g.*, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (“Competition is deterred * * * not merely by successful suit but by the plausible threat of successful suit.”).

and the addition of corporate identifiers like “Company” or “Inc.” See, e.g., *Advertise.com*, 616 F.3d at 982 (noting that “.com,” when added to a generic term, “indicates a commercial entity” [and] does not suffice to establish that the composite is distinctive, much as AOL would not have created a protectable mark by adopting the designation “Advertising Company”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004) (explaining that, “[a]lthough not a perfect analogy, the comparison of” top-level domains like .com “to entity designations such as ‘Corp.’ and ‘Inc.’ has merit,” because “[t]he commercial impression created by ‘.com’ is similar to the impression created by” those terms). Those courts therefore have held that adding “.com” to a generic term will create a protectable mark only in the “rare” case where the combined term carries additional meaning. See, e.g., *Advertise.com*, 616 F.3d at 981 (concluding that “ADVERTISING.COM” did not present the “rare case”); *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (stating that the addition of a top-level domain may create a registrable mark in the “unusual case” in which it “expand[s] the meaning of the mark”); *In re Oppedahl & Larson LLP*, 373 F.3d at 1175 (providing hypothetical example of a brick-and-mortar store called “tennis.net” that sells tennis nets); App., *infra*, 36a & n.4 (Wynn, J., concurring in part and dissenting in part) (providing hypothetical example of “rom.com” for a “website cataloguing and discussing romantic comedy movies of the 1980s, 1990s, and 2000s”).

The court below, by contrast, offered no sound reason for viewing this Court’s decision in *Goodyear* as inapposite. Instead, it largely dismissed that decision, explaining that “*Goodyear* was decided almost sixty years before the Lanham Act and, crucially, did not ap-

ply the primary significance test” that the court of appeals thought was appropriate. App., *infra*, 19a. But this Court has not overruled *Goodyear*, and courts, commentators, and the USPTO continue to recognize the decision’s basic principle that adding a corporate (or other entity-type) designation to a generic term does not create a protectable mark. See, e.g., *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1359 n.4 (11th Cir. 2007) (“The mere inclusion of ‘Inc.’ at the end of the name does not make generic words protectable.”); *In re Wm. B. Coleman Co.*, 93 U.S.P.Q.2d 2019, 2025 (T.T.A.B. 2010) (“[T]he term ‘company’ is simply a designation for a type of entity without source-identifying capability.”); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:39, at 12-159 (5th ed. 2019) (“Tacking a company organizational designation such as ‘Company,’ or ‘Inc.’ or ‘Partners’ cannot transform a generic name into a protectable trademark. Such company designations or their abbreviations are themselves generic and have no trademark significance.”).

The court of appeals likewise was incorrect in suggesting that *Goodyear*’s methodology has been overtaken by events. “[T]he purpose of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection,” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring in the result), not to abrogate this Court’s longstanding precedents. The fact that the *Goodyear* Court did not expressly apply the “primary significance test,” App., *infra*, 19a, enhances rather than detracts from the current salience of that decision. Because a name like “Booking Company” would merely tell the public that “parties have formed an association or partnership to deal” in booking services, *Goodyear*, 128 U.S. at 602, that name would be generic under *Goodyear*

even if consumers might infer that it refers to a particular business. There is no reason to differentiate, for trademark-registration purposes, between that name and the Internet analogue “BOOKING.COM.”⁵

2. In addition to disregarding this Court’s decision in *Goodyear*, the court of appeals erred in extending the concept of secondary meaning to generic terms. The court held that, because respondent had adduced evidence that consumers associate BOOKING.COM with its specific business, the district court had properly found the term non-generic.

That approach effectively eliminates the established distinction between generic and descriptive terms, and the rule that only the latter can become eligible for trademark protection if they become associated in the minds of consumers with a particular brand. As Judge Friendly explained, “no 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

⁵ Although no technological barrier precludes multiple firms from calling themselves “The Grain Company” or “Grain Inc.,” the Internet operates in such a way that each web address corresponds to a distinct website and thus, in the commercial context, to a distinct provider of goods or services. That distinction, however, provides no sound basis for treating *Goodyear* as inapposite here, and the court of appeals appropriately declined to rely on such a rationale. Other sources of law could restrict competitors’ use of the sorts of names that the *Goodyear* Court discussed. This Court did not suggest, however, that a term like “Grain Inc.” could be registered as a trademark if (for example) applicable state law allowed only one firm to incorporate in the State under that name. To the contrary, the decision in *Goodyear* was premised on this Court’s recognition that “[n]ames which are thus descriptive of a class of goods cannot be exclusively appropriated by any one.” 128 U.S. at 602.

right to call an article by its name.” *Abercrombie & Fitch Co.*, 537 F.2d at 9; see, e.g., *Royal Crown Co. v. The Coca-Cola Co.*, 892 F.3d 1358, 1370 (Fed. Cir. 2018); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 7-8 & n.2 (1st Cir. 1981); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 374-375 (1st Cir. 1980). While descriptive terms can acquire distinctiveness and become eligible for trademark protection, “if a word is generic it can never become a trademark.” *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979) (internal quotation marks omitted). Thus, even if a business successfully induced consumers to associate “The Grain Company” or “Grain, Inc.” with its particular grain-selling operations, those terms would remain generic and ineligible for trademark protection, since granting the business a legal monopoly on their use would unfairly restrict the ability of new market entrants to compete. See *Goodyear*, 128 U.S. at 602-603.

This Court has confirmed that a generic term remains generic even when the public has come to associate it with a single producer. In *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938), the National Biscuit Company had held a patent on “Shredded Wheat.” *Id.* at 117-118. After the patent expired, Kellogg Company began to sell a similar product—also called “Shredded Wheat”—and the National Biscuit Company brought suit alleging unfair competition. *Id.* at 113-115, 117-118. The Court held that “Shredded Wheat” was “the generic term of the article,” so that “the original maker of the product acquired no exclusive right to use” the term. *Id.* at 116. That was so even though, “due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people ha[d] come to associate the product, and as a consequence the name by which the product [wa]s generally

known, with the plaintiff's factory." *Id.* at 118. Because the term was generic, the Court explained, "[t]here [wa]s no basis * * * for applying the doctrine of secondary meaning." *Ibid.*

In keeping with that principle, courts of appeals have refused to rely on survey evidence purporting to show that consumers associate a generic term with a particular producer. See, e.g., *Miller Brewing Co.*, 605 F.2d at 995 (rejecting survey showing that consumers associated the term "light" beer with Miller Brewing Company, because such evidence "would not advance Miller's trademark claim"). Indeed, the Fourth Circuit had previously rejected survey evidence regarding consumers' understanding of the term "crab house" because the case did not "involv[e] a coined word for a commercial product (such as 'aspirin,' 'teflon,' or 'thermos') that is alleged to have become generic through common usage." *Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 255 (2001).

The court below thus erred in treating this case as requiring a factual inquiry into whether consumers associate BOOKING.COM with a particular brand. The court did not meaningfully grapple with *Kellogg Co.*, citing that case only for the tautology that "[a] term may be generic if * * * it was previously determined to be generic by a court." App., *infra*, 10a. The court also did not explain how a consumer survey could render BOOKING.COM potentially registrable when no similar survey could justify registration of "Booking Inc." See *Goodyear*, 128 U.S. at 602-603. While the court suggested that it was appropriate to rely on survey evidence because the combined term BOOKING.COM had not already been held generic and was not "previously commonly used," App., *infra*, 21a; see *id.* at 21a n.11,

the same could be said about any “Generic Inc.” combination when a firm first uses that name. Yet *Goodyear* and *Kellogg Co.* make clear that such terms are not protectable as trademarks, no matter how strongly the public comes to associate them with a particular business.⁶

The court of appeals’ reliance on respondent’s Teflon survey also is in significant tension with the principle that “[f]unctional features * * * cannot be the basis for trademark protection.” App., *infra*, 41a (Wynn, J., concurring in part and dissenting in part) (citing *America Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 822-823 (4th Cir.), cert. dismissed, 534 U.S. 946 (2001)); see also, e.g., *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001) (“Functionality having been established, whether MDI’s dual-spring design has acquired secondary meaning need not be considered.”); 15 U.S.C. 1052(e). Although the court stated that it did “not address” the district court’s reliance “on BOOKING.COM’s functional role as a web address,” App., *infra*, 21a n.10, respondent’s Teflon survey necessarily reflects that functionality. Under the domain-name addressing system, only one company may hold the rights to a particular domain name at a given time. To the extent that consumers’ association of BOOKING.COM with a particular business reflects a functional characteristic of the Internet and the domain-name system, it cannot support a determination that BOOKING.COM is protectable as a trademark.

⁶ In any event, the court of appeals erred in concluding that the term “booking.com” had not previously been in common usage. As the TTAB explained, the term was used within other businesses’ longer domain names. See p. 7, *supra*.

B. The Question Presented Warrants Review

The decision below conflicts with rulings of the Federal and Ninth Circuits, the only other courts of appeals that have considered the question presented here. The Lanham Act's scheme for judicial review of TTAB decisions renders that division especially problematic. And the court of appeals' decision here threatens to have significant anticompetitive effects for online businesses.

1. The Federal Circuit has long held that the addition of “.com” to an otherwise generic term generally does not cause the term to “lose its generic character.” *Hotels.com*, 573 F.3d at 1304. For example, the Federal Circuit affirmed the TTAB's determination that an online hotel booking company could not register HOTELS.COM as a trademark. *Id.* at 1304-1306; see *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363-1364 (Fed. Cir. 2009) (affirming denial of registration of MATTRESS.COM for online mattress store); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379-1380 (Fed. Cir. 2007) (affirming denial of registration of LAWYERS.COM insofar as it provided “information exchange about legal services”). The Federal Circuit reached that result even though the applicant had submitted survey evidence that “76% of respondents regarded HOTELS.COM as a brand name.” *Hotels.com*, 573 F.3d at 1305 (citation omitted).

The Ninth Circuit likewise has recognized that the addition of “.com” generally does not render a generic term protectable as a trademark. In *Advertise.com*, AOL, which owned trademark registrations including the mark ADVERTISING.COM, alleged that the use of ADVERTISE.COM infringed its mark. 616 F.3d at 976. The court reversed the grant of a preliminary injunction

to AOL, explaining that ADVERTISING.COM was generic because it merely “convey[s] the genus of the services offered under the mark: *internet* advertising.” *Id.* at 982.⁷

The court below suggested that its decision “comport[ed]” with those of the Federal and Ninth Circuits, because those courts have “left open the possibility that in ‘rare circumstances’ a [top-level domain] may render a term sufficiently distinctive to be protected as a trademark.” App., *infra*, 22a. But while the majority characterized the case before it as the “rare” case, *id.* at 23a, the present dispute has little in common with the “rare” cases hypothesized by the other courts of appeals. Those courts have left open the possibility of trademark registration where the addition of “.com” or another top-level domain to a particular generic term goes beyond simply indicating that a particular website is involved, and imparts new meaning in relation to the particular goods or services for which registration is sought. See *Advertise.com*, 616 F.3d at 979-980; *1800Mattress.com IP*, 586 F.3d at 1364; *Oppedahl & Larson LLP*, 373 F.3d at 1175; App., *infra*, 35a-38a (Wynn, J., concurring in part and dissenting in part). By contrast, BOOKING.COM—like the HOTELS.COM, MATTRESS.COM, LAWYERS.COM, and ADVERTISING.COM marks that the Federal and Ninth Circuits have found unprotectable—conveys only that respondent offers

⁷ The court in *Advertise.com* stated that “[i]t is not inconceivable but certainly highly unlikely that consumer surveys or other evidence might ultimately demonstrate that AOL’s mark is valid and protectable.” 616 F.3d at 982; see App., *infra*, 23a (quoting part of this language). The court did not explain that statement, which—to the extent it suggests that consumer recognition may cause a term to lose its generic character—is incorrect for the reasons already discussed. See pp. 19-22, *supra*.

online booking services. There is consequently little doubt that the Federal and Ninth Circuits would have reached a different result than the Fourth Circuit reached here.

2. The statutory scheme that governs judicial review of TTAB trademark-registration decisions renders the division among the courts of appeals particularly destabilizing. As discussed above, pp. 6-7, *supra*, parties dissatisfied with such decisions may appeal directly to the Federal Circuit, 15 U.S.C. 1071(a), and the USPTO therefore follows Federal Circuit precedent in examining trademark-registration applications, see *TTAB Manual* § 101.03. But aggrieved parties also may seek review in an appropriate district court. 15 U.S.C. 1071(b). Because the USPTO is headquartered in Alexandria, Virginia, venue ordinarily will be appropriate in the Eastern District of Virginia, subject to appellate review in the Fourth Circuit, where the decision below will be binding precedent.

Thus, if the USPTO approves a “generic.com” term for registration as a trademark in accordance with the Fourth Circuit’s decision in this case, third parties who unsuccessfully opposed the registration may appeal directly to the Federal Circuit, invoking that court’s precedents holding such marks to be generic and therefore unregistrable.⁸ But if the USPTO refuses registration, the applicant may seek review in the Eastern District of Virginia and may obtain registration if it can persuade a district court that consumers associate the term with its business. Under the reasoning of the court below,

⁸ In some cases, unsuccessful opponents of trademark registration might achieve the same result by establishing venue and filing civil actions in district courts within the Ninth Circuit.

the applicant may achieve that goal by presenting survey evidence that consumers understand the proposed “generic.com” mark to denote a particular business—a showing made easier by the functional reality that only one entity can hold the rights to a particular domain name. This Court’s review is necessary to protect the USPTO from that whipsaw and to ensure that federal trademark registration of such terms is governed by uniform rules.

3. Finally, the decision below threatens to cause serious and immediate anticompetitive harms. It creates incentives for participants in online commerce to quickly apply to register “generic.com” domain names as trademarks with the USPTO, and to file civil actions within the Fourth Circuit if the USPTO denies their applications. Registration of such domain names as trademarks will discourage competitors from using the generic names of their goods or services in their own domain names. App., *infra*, 41a-45a (Wynn, J., concurring in part and dissenting in part); see *Hotels.com*, 573 F.3d at 1304, 1306 (affirming the TTAB’s denial of registration for “HOTELS.COM,” and quoting with approval the TTAB’s reference to the “‘competitive need for others to use as part of their own domain names and trademarks, the term that applicant is attempting to register’”) (citation omitted). This Court’s review is warranted to ensure that trademark law fosters rather than hinders competition in the online marketplace.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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JULY 2019

APPENDIX A

**UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT**

No. 17-2458

BOOKING.COM B.V., PLAINTIFF-APPELLEE

v.

**THE UNITED STATES PATENT AND TRADEMARK
OFFICE; ANDREI IANCU, IN HIS OFFICIAL CAPACITY
AS UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
DEFENDANTS-APPELLANTS**

**AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION, AMICUS CURIAE**

No. 17-2459

BOOKING.COM B.V., PLAINTIFF-APPELLANT

v.

**THE UNITED STATES PATENT AND TRADEMARK
OFFICE; ANDREI IANCU, IN HIS OFFICIAL CAPACITY
AS UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
DEFENDANTS-APPELLEES**

**AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION, AMICUS CURIAE**

Argued: Oct. 31, 2018
Decided: Feb. 4, 2019
Amended: Feb. 27, 2019

Appeals from the United States District Court
for the Eastern District of Virginia, at Alexandria.
Leonie M. Brinkema, District Judge.
(1:16-cv-425-LMB-IDD)

Before: KING, DUNCAN, and WYNN, Circuit Judges.

DUNCAN, Circuit Judge:

The United States Patent and Trademark Office (the “USPTO”) and Booking.com (“Booking.com”) both appeal the district court’s summary judgment ruling regarding the protectability of the proposed trademark BOOKING.COM.¹ The USPTO appeals on the ground that the district court erred in concluding that BOOKING.COM is a protectable mark. Booking.com cross appeals, arguing that it should not be required to pay the USPTO’s attorneys fees under 15 U.S.C. § 1071(b)(3). For the reasons that follow we affirm as to both the appeal and the cross-appeal.

I.

Before we recount the facts of this case, we briefly discuss the legal trademark context in which it arises. Trademark law protects the goodwill represented by particular marks and serves the twin objectives of preventing consumer confusion between products and the sources of those products, on the one hand, and protecting the linguistic commons by preventing exclusive use of terms that represent their common meaning, on the

¹ Throughout this opinion, we use Booking.com to refer to the Plaintiff-Appellant and BOOKING.COM to refer to the proposed mark.

other. *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 339-40 (4th Cir. 2009).

In order to be protectable, marks must be “distinctive.” To determine whether a proposed mark is protectable, courts ascertain the strength of the mark by placing it into one of four categories of distinctiveness, in ascending order: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful. *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 393-94 (4th Cir. 2009). Marks falling into the latter two categories are deemed inherently distinctive and are entitled to protection because their intrinsic nature serves to identify the particular source of a product. In contrast, descriptive terms may be distinctive only upon certain showings, and generic terms are never distinctive. This dispute concerns only the first two of these four categories, with Booking.com arguing the mark is descriptive and the USPTO arguing it is generic.

A term is generic if it is the “common name of a product” or “the genus of which the particular product is a species,” such as LITE BEER for light beer, or CONVENIENT STORE for convenience stores. *OBX-Stock, Inc.*, 558 F.3d at 340. Generic terms do not contain source-identifying significance—they do not distinguish the particular product or service from other products or services on the market. *George & Co.*, 575 F.3d at 394. Accordingly, generic terms can never obtain trademark protection, as trademarking a generic term effectively grants the owner a monopoly over a term in common coinage. If protection were allowed, a competitor could not describe his goods or services as what they are. *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975).

In contrast, descriptive terms, which may be protectable, describe a “function, use, characteristic, size, or intended purpose of the product,” such as 5 MINUTE GLUE or KING SIZE MEN’S CLOTHING. *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996). In order to be protected, a descriptive term must have acquired secondary meaning. *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001). Secondary meaning indicates that a term has become sufficiently distinctive to establish a mental association in the relevant public’s minds between the proposed mark and the source of the product or service. *George & Co.*, 575 F.3d at 394.

Against this background, we consider the facts before us.

II.

Booking.com operates a website on which customers can book travel and hotel accommodations. It has used the name BOOKING.COM since at least 2006. In 2011 and 2012, Booking.com filed four trademark applications for the use of BOOKING.COM as a word mark and for stylized versions of the mark with the USPTO. Booking.com sought registration for, inter alia, Class 43 services, which include online hotel reservation services.²

² The applications also identified Class 39 services, which include “travel and tour ticket reservation services” and “online travel and tourism services.” *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 896-97 (E.D. Va. 2017). Because the district court found that the marks were only protectable as to Class 43 services and remanded with respect to Class 39 services, and Booking.com does not challenge

The USPTO examiner rejected Booking.com’s applications, finding that the marks were not protectable because BOOKING.COM was generic as applied to the relevant services. In the alternative, the USPTO concluded that the marks were merely descriptive and that Booking.com had failed to establish that they had acquired secondary meaning as required for trademark protection. After the examiner denied Booking.com’s motion for reconsideration, Booking.com appealed to the Trademark Trial and Appeal Board (the “TTAB”).

The TTAB affirmed the USPTO’s four refusals of registration in three separate opinions. These opinions all concluded that BOOKING.COM was a generic term for the services offered, and therefore ineligible for trademark protection, because “booking” generically refers to “a reservation or arrangement to buy a travel ticket or stay in a hotel room” or “the act of reserving such travel or accommodation”; “.com” indicates a commercial website; and consumers would understand the resulting composite BOOKING.COM to primarily refer to an online reservation service for travel, tours, and lodging, which are the services proposed in Booking.com’s applications. *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 896 (E.D. Va. 2017) (summarizing the TTAB’s findings). In the alternative, the TTAB concluded that BOOKING.COM is merely descriptive of Booking.com’s services and that Booking.com had failed to demonstrate that the mark had acquired secondary meaning, as required for trademark protection.

this ruling on appeal, we consider only whether BOOKING.COM is protectable as to Class 43 services.

Booking.com appealed the TTAB's decisions by filing this civil action under 15 U.S.C. § 1071(b) against the USPTO and the USPTO's director in the Eastern District of Virginia in April 2016.³ It argued that BOOKING.COM was a descriptive or suggestive mark eligible for protection. In support of its argument, Booking.com submitted new evidence to the district court. This evidence included a "Teflon survey,"⁴ indicating that 74.8% of consumers recognized BOOKING.COM as a brand rather than a generic service.

The district court held that although "booking" was a generic term for the services identified, BOOKING.COM *as a whole* was nevertheless a descriptive mark. The district court further determined that Booking.com had met its burden of demonstrating that the proposed mark had acquired secondary meaning, and therefore was protectable, as to the hotel reservation services described in Class 43. The court therefore partially granted Booking.com's motion for summary judgment, ordering the USPTO to register two of the marks and remanded for further administrative proceedings as to the other two.

The USPTO subsequently filed two motions. Pursuant to Federal Rule of Civil Procedure 59(e), the USPTO sought to amend the court's order requiring the

³ As we discuss further below, Booking.com could have appealed to the Federal Circuit but declined to do so.

⁴ Teflon surveys are the "most widely used survey format to resolve a genericness challenge." 2 *McCarthy on Trademarks* at § 12:16. These surveys explain the distinction between generic names and trademark or brand names and then ask survey respondents to identify a series of names as common or brand names.

USPTO to register the two trademarks, requesting instead that the court remand for further administrative proceedings. It also filed a motion for expenses pursuant to 15 U.S.C. § 1071(b)(3), which would require Booking.com to pay \$76,873.61 of the USPTO's expenses under 15 U.S.C. § 1071(b)(3). These expenses included the salaries of the PTO's attorneys and paralegals that worked on the defense action. The district court denied the USPTO's motion to amend as to the two marks, reasoning that they were registerable as trademarks and that no further administrative proceedings were necessary. However, the district court granted the USPTO's motion for expenses. Both the USPTO and Booking.com appealed. The USPTO and Booking.com challenge, respectively, whether BOOKING.COM is protectable, and whether Booking.com must pay the USPTO's attorneys fees.

III.

We turn first to the USPTO's contention that the district court erred in concluding that BOOKING.COM is a protectable trademark. According to the USPTO, BOOKING.COM is a generic, not a descriptive, term that can never be protected.

We review a district court's grant of summary judgment based on the conclusion that a mark is sufficiently distinctive to warrant trademark protection *de novo*. *Retail Servs. Inc. v. Freebies Publ'g*, 364 F.3d 535, 541-42 (4th Cir. 2004). The question of whether a proposed mark is generic is a question of fact that is subject to deferential review. *See Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014) (citing *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1533 (4th Cir. 1984)).

Critically to our analysis, the USPTO concedes that if BOOKING.COM may properly be deemed descriptive, the district court's finding that it has acquired secondary meaning was warranted. Rather, the USPTO only challenges the district court's determination that BOOKING.COM is not generic. Therefore, the limited question on appeal is whether the district court erred in finding that BOOKING.COM is not generic. For the reasons that follow, we conclude that the district court did not err in finding that there was no genuine issue of material fact on the issue of genericness and that, on these facts, BOOKING.COM is a protectable trademark.

Before undertaking our analysis, two issues pertinent to the genericness inquiry bear further elaboration: first, who bears the burden of proving genericness, and second, the framework for determining whether a proposed mark is generic.

A.

We have never directly addressed the issue of which party bears the burden of proving genericness on appeal when registration of a mark is denied.⁵ However, the Federal Circuit has long held, and we agree, that in registration proceedings, the USPTO “always bears the burden” of establishing that a proposed mark is generic. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir.

⁵ In trademark infringement proceedings, we have held that the burden of proof lies with the party claiming that a previously registered mark is generic because there is a presumption of validity. *See Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996). Where a mark is not registered, however, and the alleged infringer asserts genericness as a defense, the plaintiff bears the burden of proving that the mark is not generic. *See Ale House Mgmt. Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 140 (4th Cir. 2000).

2016); see *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (explaining that the burden of proving genericness “remains with” the PTO) (emphasis added). This is so because finding a mark to be generic carries significant consequence, as it forecloses an applicant from any rights over the mark—once a mark is determined to be generic, it can never receive trademark protection. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:12 (5th ed. 2018) (explaining that finding a mark to be generic is a “fateful step” as it may result in the “loss of rights which could be valuable intellectual property”).

We therefore hold here that the USPTO bears the burden of proving that BOOKING.COM is generic in the instant case.

B.

We next discuss the framework for determining whether a mark is generic. As we have discussed, generic terms are the “common name of a product or service itself.” *Sara Lee*, 81 F.3d at 464. To determine whether a term is generic, we follow a three-step test: (1) identify the class of product or service to which use of the mark is relevant; (2) identify the relevant consuming public; and (3) determine whether the primary significance of the mark to the relevant public is as an indication of the nature of the class of the product or services to which the mark relates, which suggests that it is generic, or an indication of the source or brand, which

suggests that it is not generic.⁶ *Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996).

Once a term is deemed generic, it cannot subsequently become non-generic. A term may be generic if, for example, it was previously determined to be generic by a court. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 117 (1938) (finding that “shredded wheat” was generic because a court had already deemed it to be so). A term may also be deemed generic where evidence suggests that a term was “commonly used prior to its association with the products [or services] at issue.” *Hunt Masters*, 240 F.3d at 254-55. In such cases of common usage, a court may find that a term is generic even without looking to evidence of consumer recognition. *Id.* For example, in *Hunt Masters*, we found that the term “crab house” was commonly used, as there

⁶ The Lanham Act codifies the primary significance test as the test for determining whether a registered trademark has become generic in *cancellation* of registration proceedings. 15 U.S.C. § 1064(3) (“The primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”); *see Glover*, 74 F.3d at 59. However, we and the Federal Circuit have also applied the primary significance test to determine genericness in registration proceedings. *See In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1362-63 (Fed. Cir. 2009) (applying a two-step genericness inquiry, asking in part whether the term sought to be registered is “understood by the relevant public to refer to that genus of goods or services”) (citation omitted); *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007) (same); *see also America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 822 (4th Cir. 2001) (determining that a mark was generic because the evidence “d[id] not reveal that the *primary significance* of the term” was the source rather than its generic meaning) (emphasis added).

were many restaurants called “crab houses” across the country, *id.* at 254 n.1, and concluded, therefore, that the district court did not err in declining to consider consumer survey evidence.

If a term is deemed generic, subsequent consumer recognition of the term as brand-specific cannot change that determination. *See Retail Servs., Inc.*, 364 F.3d at 547. Indeed, courts have explained that “no 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,” that user cannot claim the exclusive right through trademark protection to call the product or service by its common name. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

In this case, neither party disputes the district court’s finding at the first step: that the mark is used to identify the class or product to which it belongs—here, making hotel reservations for others. Nor do they disagree as to step two: that the relevant purchasing public consists of consumers who use hotel reservation services offered via the internet or in person. Instead, the dispute arises at the third step: the public’s understanding of what the term BOOKING.COM primarily refers to.

To ascertain the public’s understanding of a term, courts may look to “purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers, and other publications.” *Glover*, 74 F.3d at 59. For example, in determining that the term “ale house” was generic for a facility that serves both food and beer, we considered newspaper articles and restaurant reviews that referred to such facilities as “ale houses,” as well as the lack of evidence suggesting that it was not a

generic term for such institutions. *Ale House Mgmt., Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 140-41 (4th Cir. 2000).

In assessing whether a term is understood by the relevant public to primarily refer to the service or the source, we look to the proposed mark *as a whole*, see *Hunt Masters*, 240 F.3d at 254 (“[A] mark must be considered as a whole to determine its validity.”). Even where a proposed mark is a phrase or a compound term, such as “crab house” or “ale house,” the relevant inquiry is the public’s understanding of the entire mark, not its understanding of the mark’s separate components independently. *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920).

With this framework for genericness in mind, we turn to the USPTO’s contention on appeal that the district court erred in finding that BOOKING.COM is a descriptive, rather than a generic, mark.

C.

We hold that the district court, in weighing the evidence before it, did not err in finding that the USPTO failed to satisfy its burden of proving that the relevant public understood BOOKING.COM, taken *as a whole*, to refer to general online hotel reservation services rather than Booking.com the company. Because the USPTO concedes that, if the mark is descriptive, it is protectable, this ends our inquiry. In affirming the district court’s finding, we reject the USPTO’s contention that adding the top-level domain (a “TLD”) .com to a generic second-level domain (an “SLD”) like booking can never yield a non-generic mark. We turn first to

the district court’s finding on genericness before addressing the USPTO’s proposed rule.

i.

Genericness is a question of fact to which the district court, as the trier of fact, is accorded great deference.⁷ *See Swatch AG*, 739 F.3d at 155. Here, in finding that the public’s understanding of BOOKING.COM, taken as a whole, establishes it as a descriptive mark rather than a generic term, the district court relied on two main factors: the USPTO’s lack of evidence demonstrating that the public uses “booking.com” generically, and Booking.com’s Teflon survey. We conclude that the district court did not err in finding that the evidence weighed in favor of finding BOOKING.COM to be non-generic.

First, the district court found “highly relevant” the absence of evidence by the USPTO that consumers commonly refer to online hotel reservation services as “bookings.com.” *Booking.com B.V.*, 278 F. Supp. 3d at 914. Instead, the court determined that the USPTO’s evidence demonstrated that such services are referred to as “booking website(s),” or “booking site(s).” *Id.*

⁷ Specifically, we defer to the district court’s factual finding regarding the primary significance of the mark to the public—a finding for which the court applied the proper legal analysis—and *not* the court’s determination as to the trademark significance of the fact that a domain name like “booking.com” necessarily refers only to a single source. In fact, we conclude that the court erred in this latter determination, discussed *infra*; but contrary to the Dissent’s position, such error does not affect the court’s *separate* factual finding as to primary significance. *See Booking.com B.V.*, 278 F. Supp. 3d at 913-18.

While the USPTO identified other domain names that contain “booking.com”—such as “hotelbooking.com” and “ebooking.com”—to support its argument that the relevant public understands BOOKING.COM to refer to online hotel booking services, the district court did not err in finding this evidence less probative of common usage. It is true that some courts have found the use of a proposed mark in longer domain names to be evidence in support of finding that term generic. *See, e.g., Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 980-81 (9th Cir. 2010) (finding that the way in which ADVERTISING.COM was used in other domain names was evidence of genericness); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009) (same for HOTELS.COM); *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1380 (Fed. Cir. 2007) (same for LAWYERS.COM). We note, however, that although those courts recognized that the inclusion of the proposed mark in longer domain names was strong evidence of genericness, they nonetheless remained open to considering consumer surveys to determine the public’s understanding of the proposed mark. *See, e.g., In re Hotels.com*, 573 F.3d at 1304-05 (finding that the TTAB did not err in determining that the term was generic, citing in part concerns arising from the methodology of the applicant’s consumer survey). Moreover, using the characters “booking.com” or “bookings.com” in a longer domain name does not necessarily mean that BOOKING.COM is generic. Unlike “hotels” or “lawyers,” “booking” is used to describe a plethora of reservation services, including, for example, theatrical or musical engagements. *See Booking.com B.V.*, 278 F. Supp. 3d at 904 (quoting Random House: Unabridged Dictionary (2d ed. 1993)). Including book-

ing.com in a longer domain name therefore does not necessarily demonstrate that consumers would understand BOOKING.COM to identify any website that provides hotel reservation services. In fact, the record evidence demonstrates the opposite.

The USPTO challenges the court's weighing of this evidence, contending that the district court erred in emphasizing that the public does not *use* "booking.com" to refer to the relevant services, and instead should have evaluated whether the public would *understand* the term to refer to those services. We agree with the USPTO that the ultimate inquiry in determining whether a term is generic is what the public *understands* the proposed mark to mean. *Glover*, 74 F.3d at 59. Nonetheless, courts have considered usage to be probative of the public's understanding. Compare *In re Dial-A-Mattress*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (finding that a mark was not generic where there was no evidence that the relevant public referred to the class of shop-at-home mattress retailers as "1-888-M-A-T-R-E-S-S"), with *Frito-Lay N. Am. Inc. v. Princeton Vanguard, LLC*, 124 U.S.P.Q.2d 1184 at *6-10 (TTAB 2017) (finding "pretzel crisp" to be generic where the record evidence, including newspaper articles and food blogs, used the term to refer to the genus of snack products rather than a particular brand), and *Ale House Mgmt.*, 205 F.3d at 140-41 (finding "ale house" to be generic for facilities that serve food and beer where newspaper articles and restaurant reviews referred to such facilities as "ale houses"). It is therefore not error for a court to consider, as the court did

here, evidence of the public's use of a term in evaluating its primary significance to the public.⁸ And in any event, as we will discuss, the consumer surveys in this record suggest that the public primarily *understands* BOOKING.COM to indicate the company rather than the service.

Second, the district court also considered Booking.com's Teflon survey, which demonstrates that 74.8% of respondents identified BOOKING.COM as a brand name, rather than as a general reference to hotel reservation websites. Such consumer surveys are the "preferred method of proving genericness." *Princeton Vanguard, LLC v. FritoLay N. Am., Inc.*, 786 F.3d 960, 970 (Fed. Cir. 2015) (citation omitted). Indeed, courts have recognized that "[c]onsumer surveys have become almost de rigueur in litigation over genericness." *Berner Int'l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982-83 (3d Cir. 1993) (internal quotation marks and citation omitted). Accordingly, where, as here, the district court found that the survey was methodologically sound, the survey is strong evidence that the public does not understand BOOKING.COM to refer to the proposed mark's generic meaning.

On appeal, the USPTO does not contest the validity of the survey or its methodology. Instead, it relies on dicta in *Hunt Masters* to argue that the district court erred in considering the survey at all. 240 F.3d at 254-55. Its reliance is misplaced; our reasoning in that case

⁸ Because the relevant inquiry is what the mark's primary significance is to the public, we do not consider the district court's suggestion, relying on Booking.com's linguistic expert, that "linguistic understanding" cannot be divorced from use. *Booking.com B.V.*, 278 F. Supp. 3d at 914 (alteration and citation omitted).

does not apply here. In *Hunt Masters*, we considered whether the owners of “the Charleston Crab House,” who sought to enjoin a competitor from using the name “The Crab House,” had a protected proprietary interest in the term “crab house.” We declined to find such an interest because we determined that “crab house” was a generic term referring to a class of restaurants that serve crabs. *Id.* at 254. In so determining, we held that the district court did not err in declining to consider the plaintiff’s consumer survey. We explained that there are two ways in which terms may be classified as generic—“(1) where the term began life as a ‘coined term’” that had become generic through common usage, and “(2) where the term was commonly used prior to its association with the products at issue”—and that while consumer surveys are relevant to determining whether a term is generic in the former scenario, they are not in the latter. *Id.* at 254-55. Contrary to the USPTO’s contention, *Hunt Masters* does not control where, as here, the district court determined based on the dearth of evidence in the record that the proposed mark was not commonly used. As such, the proposed mark does not fall within the category of terms for which survey evidence is irrelevant.

Weighing the evidence before it, the district court did not err in finding that the USPTO did not satisfy its burden of showing that BOOKING.COM is generic. It is axiomatic that determinations regarding the relative weight of evidence are left for the trier of fact. *See In re Hotels.com*, 573 F.3d at 1305-06 (finding that the trier of fact, the TTAB, could reasonably have given controlling weight to dictionary definitions and similar uses of “hotels” with a .com suffix over a consumer survey with questionable methodology). Here, the district court,

acting as the trier of fact in reviewing Booking.com’s trademark application de novo, did not err in placing greater weight on the consumer survey over other evidence, like dictionary definitions, in assessing the primary significance to the public. *See Mars Sales Co.*, 987 F.2d at 982-83 (explaining that direct consumer evidence, e.g., consumer surveys and testimony, “is preferable to indirect forms of evidence” like dictionaries and trade journals).

We therefore conclude that the district court did not err in finding that BOOKING.COM is a descriptive, rather than generic, mark.

ii.

The USPTO nevertheless contends that adding the top-level domain “.com” to a generic second-level domain like “booking” is *necessarily* generic, and that the district court therefore erred in finding that BOOKING.COM was non-generic. The USPTO advances two theories as reasons for adopting a per se rule against protecting terms like BOOKING.COM. For the reasons that follow, we decline to adopt such an approach under either theory.

First, the USPTO relies on an 1888 Supreme Court case to argue that, as a matter of law, adding .com to a generic SLD like booking can never be nongeneric. In *Goodyear’s Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888), the Court held that the addition of commercial indicators such as “Company” to terms that merely describe classes of goods could not be trademarked, like “Grain Company” or, as the Dissent provides, “The Grocery Store.” According to the

USPTO, “.com” is analytically indistinct from “company,” as it is a generic identifier for an entity operating a commercial website, and therefore its addition to a generic term can never be protected. However, *Good-year* was decided almost sixty years before the Lanham Act and, crucially, did not apply the primary significance test. No circuit has adopted the bright line rule for which the USPTO advocates—indeed, sister circuits have found that when “.com” is added to a generic TLD, the mark may be protectable upon a sufficient showing of the public’s understanding through consumer surveys or other evidence. See, e.g., *Advertise.com, Inc.*, 616 F.3d at 982; *In re Hotels.com*, 573 F.3d at 1304-05. We similarly decline to do so here.

Second, the USPTO argues that the proposed mark is per se generic because it is nothing more than the sum of its component parts. It contends that “booking” is a generic term for hotel reservation services, that “.com” is generic for an online company, and that when combined the resulting composite is generic for the online booking services at issue here because a member of the relevant public would understand BOOKING.COM to name an online booking website. Therefore, the USPTO contends, BOOKING.COM is generic. We disagree that it is necessarily so.

We begin by discussing the genericness inquiry as it applies to compound terms. When confronted with a compound term like PRETZEL CRISPS, courts may consider as a first step the meaning of each of the term’s component marks; but as we explained in *Hunt Masters*, the ultimate inquiry examines what the public primarily perceives the term *as a whole* to refer to. 240 F.3d at 254. For example, in determining whether PRETZEL

CRISPS is generic, a court may first determine based on dictionary definitions and other competent sources that PRETZEL is primarily understood to refer to the genus of pretzels, and that CRISPS would be understood as primarily referring to crackers. *FritoLay N. Am., Inc.*, 124 U.S.P.Q.2d 1184 at *4, 21. But the court must also consider evidence—such as use in newspaper articles or food blogs—to determine whether the term PRETZEL CRISPS is perceived primarily to refer to a crispy pretzel or to a particular source. *Id.* at *22.

Where the proposed mark is a composite that includes .com, we clarify that, contrary to the district court’s suggestion, .com does not itself have source-identifying significance when added to an SLD like booking.⁹ *See, e.g., In re Hotels.com*, 573 F.3d at 1304 (explaining that the generic term “hotels” did not lose its generic character by placement in the domain name HOTELS.COM); *McCarthy on Trademarks*, § 7:17.50 (explaining that a TLD like .com “has no source indicating significance and cannot serve any trademark purpose”). Merely appending .com to an SLD does not render the resulting domain name non-generic because the inquiry is whether the public primarily understands

⁹ The district court concluded that a TLD like .com generally has source-identifying significance when added to an SLD like booking, and that a mark composed of a generic SLD like booking together with a TLD is usually a descriptive mark eligible for protection upon a showing of secondary meaning. We decline to adopt a rule that goes so far. Such a rule would effectively make *any* domain name distinctive, which oversteps the focus of our trademark jurisprudence on a mark’s primary significance to the public. However, because we find other evidentiary bases to affirm the district court, as discussed *supra*, our rejection of this approach does not alter the outcome of our inquiry.

the term *as a whole* to refer to the source or the proffered service.¹⁰

For the same reason, neither is it the case, as the USPTO would have it, that assuming booking and .com are each generic terms according to their respective dictionary definitions, and that together they describe the service provided, this necessarily ends the genericness inquiry. Within this inquiry, dictionary definitions, though “relevant and sometimes persuasive” to the genericness inquiry based on the assumption that such definitions generally reflect the public’s perception of a word’s meaning, are not necessarily dispositive or controlling. *Retail Servs., Inc.*, 364 F.3d at 544-45. Instead, where, as here, the court found that the term was not previously commonly used, it may consider additional evidence like consumer surveys in making its genericness determination.¹¹ This is particularly true where the mark involves a domain name. Unlike general terms such as “crab house,” *see Hunt Masters*, 240 F.3d at 254-55, looking to the component parts of a

¹⁰ Because we do not adopt the district court’s approach to the addition of TLDs to SLDs, we need not address the USPTO’s contention that the district court impermissibly relied on BOOKING.COM’s functional role as a web address to establish non-genericness, where functional features are precluded from trademark protection.

¹¹ As we have discussed, once a term has been deemed generic, consumer recognition will not save it from being generic. *See Retail Servs., Inc.*, 364 F.3d at 547. Here, BOOKING.COM was not already deemed generic because it had not been so determined by a prior court, and the district court expressly found that it was not commonly used. Accordingly, the USPTO’s reliance on cases where terms like “You Have Mail” and “Freebies” were found to be commonly used to argue that consumer recognition cannot render BOOKING.COM non-generic, is misplaced. *See America Online*, 243 F.3d at 822 and *Retail Services, Inc.*, 364 F.3d at 547.

domain name may not unambiguously represent the primary significance of the term as a whole given that the relevant public may recognize domain names to indicate specific locations on the internet. *See In re Hotels.com*, 573 F.3d at 1305 (acknowledging that “consumers may automatically equate a domain name with a brand name”) (citation omitted). Thus, even where the domain-name-as-mark technically describes the service provided, it does not necessarily follow that the public commonly understands the mark to refer to the service broadly speaking.

We therefore decline to adopt a per se rule and conclude that when “.com” is combined with an SLD, even a generic SLD, the resulting composite may be non-generic where evidence demonstrates that the mark’s primary significance to the public as a whole is the source, not the product.

This approach comports with that taken by our sister circuits, who have similarly declined to adopt a per se rule against protecting domain names, even where they are formed by combining generic terms with TLDs. *See, e.g., Advertise.com Inc.*, 616 F.3d at 978-79; *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005). These courts have left open the possibility that in “rare circumstances” a TLD may render a term sufficiently distinctive to be protected as a trademark. *See In re Steelbuilding.com*, 415 F.3d at 1299.

Tellingly, even where courts have found that the individual components of a domain name mark are independently generic, and that when added together the resulting composite merely describes the genus of the service provided, courts still considered other evidence such as consumer surveys in determining whether the

mark was generic. For instance, in determining whether ADVERTISING.COM was generic, the Ninth Circuit explained that even though both “advertising” and “.com” were generic, and that ADVERTISING.COM conveyed only the genus of the services offered, it was possible “that *consumer surveys or other evidence* might ultimately demonstrate that [the] mark is valid and protectable.” *Advertise.com, Inc.*, 616 F.3d at 982 (emphasis added); see *In re Hotels.com*, 573 F.3d at 1304-05 (considering a consumer survey regarding the public’s understanding of HOTELS.COM even though it determined that “hotels” and “.com” were independently generic and that the combination did not produce new meaning). While these courts have generally found the resulting composite of adding “.com” to certain SLDs to be generic,¹² they have nonetheless acknowledged that on rare occasions such marks may be non-generic. Here, the district court did not err in determining that this case presents one such rare occasion where the record evidence supported a finding that the USPTO failed to meet its burden of proving that the public primarily understood BOOKING.COM to refer to the genus of

¹² See, e.g., *In re Hotels.com*, 573 F.3d at 1304 (HOTELS.COM); *In re 1800Mattress.com IP, LLC*, 586 F.3d at 1364 (MATTRESS.COM); *In re Reed Elsevier Props., Inc.*, 482 F.3d at 1378 (LAWYERS.COM). We note, however, that on appeal from the TTAB, the Federal Circuit applies a more deferential standard of review—reviewing factual findings for substantial evidence—than that applied by the district court, which reviews the TTAB’s decision de novo. See *Shamas v. Focarino*, 784 F.3d 219, 225 (4th Cir. 2015). Given this deferential standard of review, the Federal Circuit may affirm a genericness holding where the district court, reviewing the extant evidence and any new evidence de novo, may have reached a different conclusion.

online hotel reservation services, rather than the company or brand itself.

We are not unsympathetic to the USPTO's concerns that granting trademark protection over BOOKING.COM may prevent other companies from using the mark. *See OBX-Stock, Inc.*, 558 F.3d at 339-40 (noting trademark law's twin concerns). However, these concerns are assuaged by two considerations. First, because trademarks only protect the relevant service—here, the district court granted protection as to hotel reservation services but not travel agency services—protection over BOOKING.COM would not necessarily preclude another company from using, for example, carbooking.com or flightbooking.com.¹³ Second, the purported overbreadth of the mark can be addressed in proceedings regarding the scope of the trademark's protection. To enforce a mark, a plaintiff must prove in a trademark infringement suit that there is a "likelihood of confusion"—that is, whether "the defendant's actual practice is likely to produce confusion in the minds of consumers about the origin of the goods or services in question." *George & Co.*, 575 F.3d at 393 (citation omitted); *Pizzeria Uno*, 747 F.2d at 1527. Infringement plaintiffs often must show "actual confusion." *George & Co.*, 575 F.3d at 393. Given that domain names are unique by nature and that the public may understand a domain name as

¹³ As the district court noted, WORKOUT.COM, ENTERTAINMENT.COM, and WEATHER.COM are registered marks that have not precluded domain names such as MIRACLEWORKOUT.COM, WWW.GOLIVE-ENTERTAINMENT.COM, and CAMPERSWEATHER.COM. *Booking.com B.V.*, 278 F. Supp. 3d at 911 & n.6 (taking judicial notice of such marks in the public record).

indicating a single site, it may be more difficult for domain name plaintiffs to demonstrate a likelihood of confusion.

In sum, adding “.com” to an SLD can result in a non-generic, descriptive mark upon a showing of primary significance to the relevant public. This is one such case. Based on the record before it, the district court properly found that the USPTO did not meet its burden of proving that “booking.com” is generic. We therefore affirm the court’s finding that BOOKING.COM is descriptive. Because the USPTO does not challenge the district court’s finding that BOOKING.COM has acquired secondary meaning where the mark is deemed descriptive, we affirm the district court’s partial grant of summary judgment finding that BOOKING.COM is protectable as a trademark.

IV.

We turn now to Booking.com’s contention that it should not be required to pay the USPTO’s attorneys fees under 15 U.S.C. § 1071(b)(3). Under the Lanham Act, a dissatisfied trademark applicant may seek review of an adverse ruling on his trademark application either by appealing the USPTO’s ruling to the Federal Circuit, 15 U.S.C. § 1071(a)(1), or by commencing a de novo action in a federal district court, *id.* § 1071(b)(1). If the applicant chooses to appeal to the Federal Circuit, the appeal is taken “on the record” before the USPTO, *id.* § 1071(a)(4), and the court defers to the USPTO’s factual findings unless they are unsupported by substantial evidence. *Shammas v. Focarino*, 784 F.3d 219, 225 (4th Cir. 2015). In contrast, if he chooses to appeal in a district court, the parties may conduct discovery and submit evidence beyond the record before the USPTO, which the

district court reviews de novo as the trier of fact. *Id.* Crucially, if the applicant decides to challenge the USPTO’s ruling in the district court, the applicant must pay “*all the expenses of the proceeding . . . whether the final decision is in favor of such party or not.*” 15 U.S.C. § 1071(b)(3) (emphasis added).

Pursuant to this statute, the district court granted the USPTO’s motion requiring Booking.com to pay \$76,873.61 of its expenses, \$51,472.53 of which constituted the prorated salaries of its attorneys and paralegals who worked on the matter. In reaching this decision, the district court relied on our precedent in *Shammas*, which held that “all the expenses of the proceeding” under § 1071(b)(3) includes attorneys fees. *Id.* at 224.

In so holding in *Shammas*, we first concluded that the “American Rule”—the bedrock principle that each litigant pays his own attorneys fees unless Congress has specifically and explicitly provided otherwise—was inapplicable to the provision because the rule applies “only where the award of attorneys fees turns on whether a party seeking fees has prevailed to at least some degree.” 784 F.3d at 223. Accordingly, we interpreted the phrase “all the expenses of the proceeding” for “its ordinary meaning without regard to the American Rule,” and concluded that it included attorneys fees. *Id.* at 224.

Whether the American Rule applies to § 1071(b)(3), however, has since been called into question. Relying on our decision in *Shammas*, the Federal Circuit previously held that a nearly identical provision of the Patent Act, 35 U.S.C. § 145, included attorneys fees. *Nantkwest, Inc. v. Matal*, 860 F.3d 1352, 1355 (Fed. Cir. 2017).

Subsequently, however, the Federal Circuit reversed its decision en banc, squarely rejecting our reasoning in *Shammas*; it now holds that attorneys fees are not covered under that provision. *Nantwest, Inc. v. Iancu*, 898 F.3d 1177, 1185 (Fed. Cir. 2018) (en banc). Moreover, the year after we decided *Shammas*, the Supreme Court applied the American Rule to a bankruptcy statute that did not mention a prevailing party. *See Baker Botts L.L.P. v. ASARCO LLC*, 135 S. Ct. 2158, 2165 (2015).

These subsequent developments suggest that the American Rule’s requirement that Congress “clearly and directly” express an intent to deviate from that rule may apply to § 1071(b)(3)—a statute that, if read to include attorneys fees, anomalously requires an appealing party to pay the prorated salaries of government attorneys.

Nonetheless, *Shammas* remains the law in this circuit, and as long as we continue to be bound by that precedent we must affirm the district court’s grant of attorneys fees.

V.

For the foregoing reasons, we affirm the district court’s partial grant of summary judgment to Booking.com as to the protectability of its trademark applications, and we affirm the district court’s grant of the USPTO’s motion for expenses.

AFFIRMED

WYNN, Circuit Judge, concurring in part and dissenting in part:

This case addresses a problem that Booking.com chose to bring upon itself. Because trademark law does not protect generic terms, an online business, like Booking.com, has two options in choosing its domain name. On the one hand, it can choose to operate under a generic domain¹ that describes the nature of the services it offers, and thereby attract the wealth of customers who simply search the web for that service. However, in electing that benefit, the entity accepts a trade-off. It must forego the ability to exclude competitors from using close variants of its domain name. On the other hand, the entity can choose to operate under a non-generic domain name—and thereby potentially limit, at least before it has built consumer awareness of its branding, the universe of potential customers who will find its business. Trademark law affords an entity that selects this latter option a special benefit. It can bar competitors from trading on any goodwill and recognition it generates in its domain name.

Booking.com chose the former approach—to operate under a generic domain name and forego the ability to

¹ A domain name, the string of text used to look up the internet protocol address for a particular internet site, is made up of a Top Level Domain and a Secondary Level Domain. The Top Level Domain is the final portion of the web address—such as “.com,” “.gov,” or “.edu”—that signifies the category of website: i.e. commercial, government, or educational. The Secondary Level Domain is the preceding part of the web address. Well-known Secondary Level Domains include “facebook,” “amazon” and “google.” Thus, in the domain name <http://www.booking.com>, “.com” is the Top Level Domain, whereas “booking” is the Secondary Level Domain.

exclude competitors from using close variants of its domain name. But in the face of recognizing that “booking” is a generic term, the district court creatively decided that combining the generic term “booking” with the generic top-level domain “.com” rendered it non-generic. In doing so, the district court’s judgment—which the majority opinion concedes was grounded in legal error, but nonetheless declines to set aside—allows Booking.com to have its cake and eat it too. Booking.com gets to operate under a domain that merely describes the nature of its business *and* exclude its competitors from doing the same.

Booking.com maintains that such a result is warranted to prevent “unscrupulous competitors [from] prey[ing] on its millions of loyal consumers,” Appellee’s Br. at 38. But to the extent Booking.com fears that its competitors are using the terms “booking” and “.com” in ways that might confuse its customers, “this is the peril of attempting to build a brand around a generic term.” *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974, 980 n.6 (9th Cir. 2010). Accordingly, although I agree with much of the analysis in the majority opinion,² I part ways with my colleagues’ decision to

² I agree with much of the analysis in the majority opinion. The majority opinion is correct that in determining whether a proposed trademark is a generic term not subject to protection, courts must “look to the proposed mark *as a whole*.” *Ante* at 12, 20 (emphasis retained). Accordingly, I join my colleagues and our sister circuits in declining “to adopt a per se rule against protecting domain names, even where they are formed by combining generic terms with [Top Level Domains].” *Ante* at 23. Also like my colleagues, I believe that on only “*rare* occasion[s]” should the combination of a generic Secondary Level Domain and a Top Level Domain result in a protectable trademark. *Ante* at 24 (emphasis added). And like my

nevertheless affirm the district court’s judgment that BOOKING.COM is a protectable trademark.

That decision rests upon my colleagues’ determination that the district court’s factual findings pertaining to genericness should be “accorded great deference,” *Ante* at 13, regarding whether a proposed mark is generic—*i.e.*, whether a proposed mark is nothing more than the “common name of a product or service itself,” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996)—which is a question of fact generally subject to clear error review, *see Swatch AG v. Beehive Wholesale, LLC*, 793 F.3d 150, 155 (4th Cir. 2015). But “we owe no deference to the district court’s findings if they are derived as a result of the court’s misapplication of the law.” *Sara Lee*, 81 F.3d at 464 (citation omitted); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1526 (4th Cir. 1984) (“[T]he clearly erroneous rule [will not] protect findings which have been made on the basis of the application of incorrect legal standards or made in disregard of applicable legal standards, such as burden of proof” (citations omitted)). When a finding derives

colleagues, I conclude the district court committed legal error in holding that “a [Top Level Domain] like .com generally has source-identifying significance when added to a[] [Secondary Level Domain] like booking, and that a mark composed of a generic [Secondary Level Domain] like booking together with a [Top Level Domain] is usually a descriptive mark eligible for protection upon a showing of secondary meaning.” *Ante* at 21 n.9. I also join my colleagues in the portion of the majority opinion affirming the district court’s granting of attorneys’ fees to the U.S. Patent & Trademark Office (“PTO”). *Ante* at 27. In particular, I agree that *Shammas v. Forcarino*, 784 F.3d 219 (4th Cir. 2015), remains the controlling precedent in this circuit.

from a district court’s “application of an improper standard to the facts, it may be corrected as a matter of law.” *United States v. Singer Mfg. Co.*, 374 U.S. 174, 194 n.9 (1963). In such cases, the clearly erroneous standard is no longer applicable. See *United States v. Rodriguez-Morales*, 929 F.2d 780, 783 (1st Cir. 1991) (“Of course, if the lower court applies the wrong legal standard, no deference attaches, and we must proceed to correct the error.”).

Here, the district court rendered the legal “conclu[sion]” that “when combined with a[] [Secondary Level Domain], a [Top Level Domain] generally has source identifying significance and the combination of a generic [Secondary Level Domain] and a [Top Level Domain] is generally a descriptive mark that is protectable upon a showing of acquired distinctiveness.” *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 909 (E.D. Va. 2017). Put differently, the district court concluded that, as a matter of law, “the combination of a generic [Secondary Level Domain] and a [Top Level Domain]” is *presumptively descriptive* and protectable upon a showing of acquired distinctiveness. *Id.*

Notably, in adopting this presumption, the district court expressly rejected the approach taken by the Federal Circuit in cases, like the instant case, involving a proposed trademark that combines a generic Secondary Level Domain with a Top Level Domain. See *id.* at 908-10. The majority opinion rejects that legal presumption but nevertheless defers to the district court’s factual finding that BOOKING.COM is descriptive, and therefore protectable, on the theory that that finding was *not tainted* by the district court’s legal error. See *Ante* at 21 n.9. But a close examination of the district

court’s opinion reveals that the district court’s legal error did play a role in the court’s ultimate determination that BOOKING.COM is descriptive.

In particular, because the district court *presumed* that “the combination of a generic [Secondary Level Domain] and a [Top Level Domain]” is descriptive, *Booking.com*, 278 F. Supp. 3d at 909, it subjected the registrant to a less onerous evidentiary burden for establishing descriptiveness than the law demands. This is evident for two reasons.

First, the district court’s ultimate determination—that the proposed mark BOOKING.COM is descriptive—conflicts with the determination that *every other court* has reached in cases, like the instant case, involving the registration or enforcement of a proposed mark composed of a generic Secondary Level Domain and a Top Level Domain.³ For instance, the Federal Circuit found

³ The district court found—and I agree—that “by itself, the word ‘booking’ is generic for the classes of hotel and travel reservation services recited in plaintiff’s applications.” *Booking.com*, 278 F. Supp. 3d at 905. Likewise, courts and commentators have long stated that a Top Level Domain is not protectable. For instance, the PTO has long stated that Top Level Domains “generally serve no source-identifying function.” TMEP § 1209.03(m) (5th ed. 2007). This position has been consistently held in federal courts. *See Advertise.com*, 616 F.3d at 978 (finding that a Top Level Domain merely reflects an online commercial organization). Additionally, the leading treatise on trademark law has stated that a Top Level Domain has no ability to distinguish one source from another. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:17.50 (5th ed. 2018) (“The ‘.com’ portion of the domain name has no trademark significance and is essentially the generic locator for all names in that top level domain.”). In this way, a Top Level Domain is similar to other common web address components, such as “http://www.” and “.html.” *Id.* Because all websites must contain

that the generic term “hotels” “did not lose its generic character by placement in the domain name HOTELS.COM.” *In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009). Instead, consumers would “immediately understand that HOTELS.COM identifies a website” that provides “information about hotels or making reservations at hotels.” *Id.* The Federal Circuit also affirmed the finding of the Trademark Trial and Appeal Board (the “Trademark Board”) that many other websites that used the word “hotels” in their domain names, such as “all-hotels.com” and “web-hotels.com,” demonstrated “a competitive need for others to use [the term] as part of their own domain names.” *Id.*

Likewise, in *In re Reed Elsevier Properties*, the Federal Circuit found it to be “abundantly clear” that the proposed mark in question, “LAWYERS.COM,” was generic because “the relevant public would readily understand the term to identify a commercial web site providing access to and information about lawyers.” 482 F.3d 1376, 1379-80 (Fed. Cir. 2007) (internal quotation marks omitted).

Similarly, in *In re 1800Mattress.com IP, LLC*, the Federal Circuit affirmed the Trademark Board’s decision that the proposed mark MATTRESS.COM was generic because customers would naturally recognize the

some form of Top Level Domain, such as “.com” or “.gov.,” there is no unique source-identifying information. Similarly, in trademark infringement analyses, Top Level Domains have long been considered irrelevant to the strength of one’s mark, as they only demonstrate, *inter alia*, a website’s commercial, governmental, or organizational nature. See *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (refusing to consider the “.com” portion of the web address when comparing marks in a case of potential infringement).

mark as referring to a commercial website providing retail services featuring mattresses. 586 F.3d 1359, 1364 (Fed. Cir. 2009). Notably, the Federal Circuit rejected the applicant’s argument—which Booking.com also advances in this case and on which the district court relied, see *Booking.com*, 278 F. Supp. 3d at 914—that the term could not be generic because consumers did not refer to the stores as “mattresses.com[s],” *id.* (quoting *In re 1800Mattress.com IP, LLC*, 586 F.3d at 1362). Instead, the court agreed with the Trademark Board that the relevant public would understand MATTRESS.COM to be “no more than the sum of its constituent parts”—an online provider of mattresses. *Id.* at 1363.

Like the Federal Circuit, the Ninth Circuit has found that a generic Secondary Level Domain combined with a Top Level Domain does not generally amount to a protectable mark. In *Advertise.com*, the court considered whether AOL’s claimed mark ADVERTISING.COM was protectable. 616 F.3d at 977. The district court below enjoined Advertise.com, a putative competitor of AOL’s Advertising.com, from using its trade name or any other name confusingly similar to ADVERTISING.COM, concluding that AOL would likely succeed on its claim that the standard text mark ADVERTISING.COM was descriptive. *Id.* The Ninth Circuit held that the district court abused its discretion in entering the injunction because—like in the instant case—the district court applied an incorrect legal standard in determining whether a mark composed of a generic Secondary Level Domain and Top Level Domain is enforceable. *Id.* at 982. Engaging in its own analysis under the appropriate legal standard, the court held that AOL was unlikely to succeed on the merits because

“ADVERTISING.COM still conveys only the generic nature of the services offered.” *Id.* at 981-82.

Lower courts have followed *Hotels.com*, *Reed-Elsevier Properties*, *1800Mattress.com*, and *Advertising.com* and refused to award trademark significance to proposed marks, like BOOKING.COM, combining a generic Secondary Level Domain with a Top Level Domain. *See, e.g., Borescopes R U.S. v. 1800Endoscope.com, LLC*, 728 F. Supp. 2d 938, 952 (M.D. Tenn. 2010) (finding that the use of the term “borescopes” in companies’ domain names “generically describes the class of product each sells”); *Image Online Design, Inc. v. Core Ass’n*, 120 F. Supp. 2d 870, 878 (C.D. Cal. 2000) (noting that “a [Top Level Domain] and other non-distinctive modifiers of a URL like ‘http://www’ have no trademark significance”); *In Re Eddie Zs Blinds & Drapery, Inc.*, 74 U.S.P.Q.2d 1037 at *6 (T.T.A.B. 2005) (determining that BLINDSANDDRAPERY.COM was not one of the “exceptional circumstances” that should forestall a finding of genericness); *In Re Martin Container, Inc.*, 65 U.S.P.Q.2d 1058 at *5 (T.T.A.B. 2002), *appeal dismissed*, 56 Fed. App’x. 491 (Fed. Cir. 2003) (finding CONTAINER.COM generic because the combination of “container” and a Top Level Domain “does not result in a compound term that has somehow acquired” the ability to function as an indication of source).

A second indication that the district court’s incorrect legal framework tainted its ultimate determination that BOOKING.COM is protectable is that BOOKING.COM is not like the types of marks courts have recognized as among the “rare” occasions when adding a generic Secondary Level Domain to a Top Level Domain does not create a generic mark. Because Top Level Domains

generally convey only that a business is web-based, it is “only in rare circumstances” that the combination of a generic Secondary Level Domain, on its own incapable of source identification, and “.com” will produce a composite mark that “expand[s] the meaning of the mark.” See, e.g., *Advertise.com*, 616 F.3d at 979 (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005)).

As an example of the “rare circumstance” in which a Top Level Domain could provide additional non-functional information, the Federal Circuit considered the possibility of a brick-and-mortar company that sold tennis equipment and operated under the name “tennis.net.” *In re Oppedahl & Larson, LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004). The court noted the “witty double entendre related to tennis nets” created by the combination of “tennis” and “.net” rendered such a usage distinguishable from a standard proposed mark combining a generic Secondary Level Domain with a Top Level Domain. *Id.*

Following *Oppedahl*'s reasoning, if we were presented with a situation in which the “.com” was used in a way that played upon or expanded the meaning of its ordinary use as a Top Level Domain, registration might be appropriate. For instance, a website cataloguing and discussing romantic comedy movies of the 1980s, 1990s, and 2000s called “rom.com” might expand upon the ordinary meaning of the Top Level Domain, as it would both describe the commercial nature of the website, as well as convey the subject matter of the website.⁴

⁴ “Rom com” is a common abbreviation for the “romantic comedy” genre of movies, whose plots revolve around the humorous developments and lighthearted tensions that occur in a romantic couple’s burgeoning relationship, while typically culminating in a happy

The tennis.net and rom.com examples are readily distinguishable from the instant case. The district court did not find—nor has Booking.com ever argued—that the combination of “booking”—a generic term—and “.com” amounts to a “witty double entendre” that expands the ordinary meanings of the proposed mark’s component parts. Rather, BOOKING.COM is a run-of-the-mill combination of a generic term with a Top Level Domain that creates a composite mark concerning the subject or business encompassed by the generic term—precisely the type of mark that the courts in *Hotels.com*, *Reed Elsevier Properties*, *1800Mattress.com*, and *Advertise.com* found did not amount to the “rare circumstance” that warranted affording the domain name trademark protection.

BOOKING.COM’s mark differs substantially from the types of proposed marks fitting into the “rare circumstances” in which a generic Secondary Level Domain and a Top Level Domain are protectable. This provides further evidence that the district court’s incorrect legal test tainted its ultimate factual determination. Because the district court erroneously believed that marks combining a generic Secondary Level Domain and Top Level Domain are presumptively protectable, it never examined—as it should have—whether BOOKING.COM amounted to one of the “rare circumstances” when such marks are protectable.

ending. See <https://www.merriam-webster.com/dictionary/rom-com>. Although rom.com differs from tennis.net in that the Secondary Level Domain arguably is not a generic term, as “rom” is a shorthand reference for romantic, the domain name rom (dot) com is, as a composite term, both a generic descriptor and a “witty” play on that descriptor.

The district court's incorrect legal test—the application of which my colleagues leave in place—upsets the careful balance the law has struck between assisting consumers to identify the source of goods and preserving the linguistic commons. Presumptively allowing protection of domain names composed of a generic Secondary Level Domain and Top Level Domain conflicts with the law's longstanding refusal to permit registration of generic terms as trademarks.

Fundamentally, the proscription against allowing generic terms to be trademarked stems from considerations regarding the monopolization of language. To permit generic terms to be trademarked “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975). This Court has long sought to foreclose such a result, holding that no single competitor has the right to “corner the market” on ordinary words and phrases, thereby enclosing the “public linguistic commons.” *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001); *see, e.g., Ashley Furniture Indus. v. Sangiacomo N.A.*, 187 F.3d 363, 369 (4th Cir. 1999) (noting that the trade name “Pet Store” for a shop that sold pets would be generic).

Importantly, the law forbids trademarking generic terms, even when a putative mark holder engages in successful efforts to establish consumer recognition of an otherwise 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 Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (emphasis added). Therefore, even advertising, repeated use, and consumer association will not warrant affording trademark protection to a generic term. See *Am. Online*, 243 F.3d at 821 (“[T]he repeated use of ordinary words . . . cannot give [a single company] a proprietary right over those words, even if an association develops between the words and [that company].”); see also *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1017 (9th Cir. 1979) (finding that even if a generic term becomes identified with a first user, trademark protection will not be available in the generic term).

The policy considerations underlying trademark law’s refusal to protect generic terms apply regardless of whether the putative mark holder is a traditional brick-and-mortar business or located in cyberspace. As the PTO argues, a grocery business called The Grocery Store would—and should—never receive trademark protection because the name is generic—regardless of whether consumers associated the name with a particular entity. However, under the district court’s erroneous approach—the consequences of which the majority leaves in place—if enough consumers recognized an online grocery business called “grocerystore.com,” that business would be entitled to trademark protection. There is no basis in law or policy for drawing such a distinction. Just as competing brick-and-mortar grocery stores need to make use of the term “grocery” to inform customers of the nature of their businesses, so too do competing internet grocery providers need to make use of the term “grocery” in their domain names.

The district court's treatment of marks combining generic Secondary Level Domains and Top Level Domains as presumptively protectable also conflicts with precedent foreclosing protection of marks that combine a generic term with a generic commercial designation (e.g., "Company," "Corp.," or "Inc."). More than a hundred years ago, the Supreme Court held that the addition of commercial designations like these does not transform otherwise generic terms into protectable marks. *See Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888).

Under *Goodyear's*, a brick-and-mortar reservation service operating under the term The Booking Company would not be able to receive a trademark in that name, regardless of the degree of brand recognition it generated or the number of consumers who identified it as a brand. *See Am. Online*, 243 F.3d at 821; *Abercrombie*, 537 F.2d at 9. Yet, under the district court's approach, the term BOOKING.COM is presumptively protectable. *Compare Advertise.com*, 616 F.3d at 982 ("That '.com,' when added to a generic term, 'indicates a commercial entity' does not suffice to establish that the composite is distinctive, much as AOL would not have created a protectable mark by adopting the designation 'Advertising Company.'").

The district court concluded that "*Goodyear's* reasoning regarding corporate designators does not apply with equal force to domain names" because "adding a [Top Level Domain] such as '.com' to a generic [Secondary Level Domain] does more than indicate that a company offers services via the internet; it indicates a unique domain name that can only be owned by one entity." *Booking.com*, 278 F. Supp. 3d at 910. But as

the Federal Circuit has explained, “[a]lthough not a perfect analogy, the comparison of [Top Level Domains] (i.e., ‘.com,’ ‘.org,’ etc.) to entity designations such as ‘Corp.’ and ‘Inc.’ has merit.” *Oppedahl*, 373 F.3d at 1175. “The commercial impression created by ‘.com’ is similar to the impression created by ‘Corp.’ and ‘Co.’, that is, the association of a commercial entity with the mark.” *Id.*

Additionally, the difference between an entity designation such as “Corp.” and a Top Level Domain recognized by the district court is attributable to the functional nature of the internet. Although most Top Level Domains do suggest a relationship with the internet, a domain name “serves the purely technological function of locating a Web site in cyberspace.” *McCarthy on Trademarks*, § 7:17.50. Functional features, however, cannot be the basis for trademark protection: “[E]ven if a functional feature has achieved consumer recognition (secondary meaning) of that feature as an indication of origin, the feature cannot serve as a legally protectable symbol.” *Am. Online, Inc.*, 243 F.3d at 822-23. Yet that is precisely what the district court’s legal test—the application of which my colleagues in the majority leave in place—does.

It is particularly important that we ensure that the district court’s ultimate finding that BOOKING.COM is descriptive, and therefore protectable, was not tainted by its erroneous legal test because, as the PTO argues, trademark registration will provide Booking.com with a weapon to freeze out potential competitors. As explained above, trademark law’s proscription on the registration of generic terms prevents firms from monopolizing

language and allows competitors to “describe [their] goods as what they are.” *CES Publ’g*, 531 F.2d at 13.

I believe that this Court’s affirmance of the district court’s judgment—even as it rejects the district court’s legal analysis—unjustifiably empowers Booking.com to monopolize language, thereby enclosing the linguistic commons and adversely affecting competitors in precisely the manner that trademark law seeks to forestall. Put simply, the majority opinion’s judgment will directly disadvantage Booking.com’s competitors by taking away their ability to use the term “booking” in their own website domain names. Indeed, any competitors that attempt to use the term “booking” will face the risk of a costly, protracted, and uncertain infringement lawsuit.

Booking.com and the majority opinion assert that the potential harm to competitors—and therefore consumers—is minimal because: (1) the doctrine of descriptive fair use will prevent Booking.com from monopolizing the term; (2) the protection of BOOKING.COM extends only to *hotel* reservations, not to other reservation services; and (3) domain names are unique. I find none of these assertions persuasive.

Descriptive fair use is an affirmative defense that allows a competitor to use words contained in a trademark in their ordinary sense to describe the competitor’s own goods or services to consumers. *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121-22 (2004). According to Booking.com, affording BOOKING.COM trademark protection will not adversely affect competition by depriving putative competitors from describing the nature of their business because such protection “will have no effect on competitors’ right to make descriptive fair use of the word

‘Booking.com.’” Appellee’s Br. at 38. The district court agreed, noting that even if Booking.com were to successfully assert a *prima facie* case of trademark infringement by showing a likelihood of confusion between BOOKING.COM and a competitor’s domain, the competitor could make use of the descriptive fair use doctrine to avoid liability.

For several reasons, I fear that the doctrine of descriptive fair use will provide Booking.com’s competitors cold comfort. I am not convinced that the descriptive fair use defense will provide significant protection to competitors using the term “booking” in their own domain names. As the Ninth Circuit has explained, “granting trademark rights over a domain name composed of a generic term and a [Top Level Domain] grants the trademark holder rights over far more intellectual property than the domain name itself.” *Advertise.com*, 616 F.3d at 980. Such trademark protection “would potentially reach almost any use of the generic term in a domain name.” *Id.* at 981 (noting that any one of the thirty-two other domain names containing some form of the word “advertise” would be placed at risk of a lawsuit). Thus, notwithstanding the doctrine of descriptive fair use, a firm that obtains a trademark in a domain name that describes the service the firm provides, like Booking.com, may have the power “to foreclose competitors from using a vast array of simple, easy to remember domain names and designations that describe [such] services.” *Id.*

Additionally, descriptive fair use is an affirmative defense, not an immunity from suit. Any online reservation business that chooses to include “booking” in its domain name will face the risk of defending an expensive

infringement lawsuit. As a result, commercial competitors seeking to avoid litigation risk and expenses—even if they might ultimately prevail on descriptive fair use grounds—will be chilled from using the term.

My colleagues in the majority also emphasize that the district court awarded Booking.com protection for the mark *only* for Class 43 hotel services, not Class 39 travel agency services, meaning that “protection over BOOKING.COM would not *necessarily* preclude another company from using, for example, carbooking.com or flightbooking.com.” *Ante* at 24 (emphasis added). But even assuming my colleagues’ optimism that Booking.com could not preclude competitors from using domain names containing the word “booking” is well-founded—a decidedly uncertain question, *see Advertise.com*, 616 F.3d at 980-81—I see no reason why Booking.com should be entitled to monopolize the generic term “booking” in the online hotel reservation industry by precluding competitors from using domain names like hotelbooking.com or ehotelbooking.com,⁵ which likewise describe such competitors’ services “as what they are.” *CES Publ’g*, 531 F.2d at 13. Put simply, there is no reason why monopolization of language should be allowed in the internet domain name context for *any* class of services when trademark law has consistently maintained that generic terms such as “booking” should be available in the public linguistic commons for all competitors to use.

⁵ Several hotel booking websites have domain names combining, in various ways, “booking” with “.com,” including “bookingcenter.com,” “ebookers.com,” “bookingwhiz.com,” “hotelbooking.com,” “bookit.com,” and “bookingbuddy.com.” J.A. 337-39.

Finally, my colleagues in the majority seek to assuage concerns that granting trademark protection over BOOKING.COM will prevent other companies from using variants of the mark by emphasizing that, to enforce the mark, Booking.com will have to prove that there is a “likelihood of confusion” with the allegedly infringing mark. *Ante* at 25. According to the majority, “[g]iven that domain names are unique by nature and that the public may understand a domain name as indicating a single site, it may be more difficult for domain name plaintiffs to demonstrate a likelihood of confusion.” *Id.* Even accepting my colleagues’ assumption that Booking.com will have difficulty proving likelihood of confusion—again, an uncertain question—affording protection to BOOKING.COM would still likely chill competition in the online booking space. Put simply, putative competitors may—and likely will—choose not to operate under domain names that include the word “booking”—even if that term best describes the service they offer—because they do not want to incur the expense and risk of defending an infringement action.

In sum, the district court’s opinion reveals that its incorrect understanding of the governing legal framework likely tainted its finding that BOOKING.COM is distinctive, and therefore protectable. Because the district court’s erroneous legal test factored into its ultimate factual determination as to descriptiveness, I cannot concur in my colleagues’ decision to affirm the district court’s judgment. Accordingly, with great respect for my good colleagues in the majority, I dissent.

APPENDIX B

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

No. 1:16-cv-425 (LMB/IDD)
BOOKING.COM B.V., PLAINTIFF

v.

JOSEPH MATAL, PERFORMING THE FUNCTIONS AND
DUTIES OF THE UNDERSECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
AND THE UNITED STATES PATENT AND TRADEMARK
OFFICE, DEFENDANTS

[Filed: Aug. 9, 2017]

MEMORANDUM OPINION

Plaintiff Booking.com B.V. (“Booking.com” or “plaintiff”) filed this civil action challenging the denial by the Trademark Trial and Appeal Board (“TTAB”) of the United States Patent and Trademark Office (“USPTO”) of four trademark applications involving the mark “BOOKING.COM” for services in Classes 39 and 43. One of the applications was for the word mark and three were for stylized versions of the mark. For each of the applications, the TTAB found plaintiff’s marks ineligible for registration as trademarks because it concluded that BOOKING.COM is generic for the services identified in

the applications or, alternatively, that it is merely descriptive and lacks acquired distinctiveness.

Before the Court are plaintiff and defendants' cross-motions for summary judgment. For the reasons that follow, plaintiff's Motion for Summary Judgment [Dkt. No. 63] will be granted in part and denied in part; defendants' Motion for Summary Judgment [Dkt. No. 60] will be granted in part and denied in part; and the USPTO will be ordered to register the mark BOOKING.COM as to the Class 43 services identified in plaintiff's applications but not as to the Class 39 services.

I. BACKGROUND

On December 1, 2011, plaintiff filed a federal trademark application, Serial No. 85485097 ("097 Application"), based on use, for the mark:



A3166. The services identified in the application (as amended) were:

Class 39: Travel agency services, namely, making reservations for transportation; travel and tour ticket reservation services; travel agency services, namely making reservations for transportation for tourists; provision of travel information; providing consultation related to making reservations for transportation, and travel and tour ticket reservation; all of the foregoing services rendered in-person and via the internet.

Class 43: Making hotel reservations for others in person and via the internet; providing personalized information about hotels and temporary accommodations for travel in-person and via the Internet; providing on-line reviews of hotels; consultation services related to making hotel reservations for others, provision of personalized information about hotels and temporary accommodations for travel, and on-line reviews of hotels.

Moskin Decl. [Dkt. No. 65-5] ¶ 2.

On June 5, 2012, plaintiff filed Application Serial No. 7911498 (“’998 Application”), for recognition in the United States of its International Registration (hereinafter referred to by the name of the authorizing treaty, “the Madrid Protocol”) for the mark:

BOOKING.COM

A4. The services identified in the application (as amended) were:

Class 39: 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.

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

Moskin Decl. [Dkt. No. 65-5] ¶ 3.

On November 7, 2012, plaintiff filed two federal trademark applications, Serial No. 79122365 (“’365 Application”) and Serial No. 79122366 (“’366 Application”), under the Madrid Protocol for the following marks:

The logo for Booking.com, featuring the word "Booking" in a dark blue font and ".com" in a lighter blue font.The logo for Booking.com, featuring the word "Booking" in white and ".com" in light blue, set against a dark blue rectangular background.

A2153, A1138. The services identified in the two applications (as amended) were limited to a subset of services in Class 43:

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 resort accommodations, whether or not based on the valuation of customers; information, advice and consultancy relating to the aforesaid services; aforesaid services also provided electronically.

Moskin Decl. [Dkt. No. 65-5] ¶ 4.

During review by the USPTO, all four applications followed the same procedural history. The examiner initially rejected each application on the ground that BOOKING.COM is merely descriptive of plaintiff's services and therefore unregistrable. A1074, A2089, A3765. After plaintiff objected that the mark BOOKING.COM had acquired distinctiveness, the examiner issued a new refusal, this time on the basis that the word mark is generic as applied to the relevant services and, in the alternative, that the mark is merely descriptive and that plaintiff had failed to establish acquired distinctiveness. A1074, A2089-90, A3766. For each application, plaintiff sought reconsideration of the new refusal and in each instance reconsideration was denied. A1075, A2090, A3766.

Plaintiff filed a Notice of Appeal for each application and requested consolidated briefing before the TTAB,

which was granted. A3766. The evidence submitted to the TTAB included dictionary definitions of the words “booking” and “.com;” print-outs of plaintiff’s webpages; examples from news articles and travel websites of terms such as “online booking services” and “booking sites,” used to refer to hotel reservation and travel agency services; examples of eight third-party domain names that include “booking.com;” a 2012 JD Power & Associates press release and survey results, indicating that Booking.com ranked highest in overall customer satisfaction; and a declaration from plaintiff’s director listing awards won by plaintiff and figures regarding plaintiff’s sales success, advertising campaigns, followers on social media, and unsolicited news articles. See Def. Mem. at 6; A1089-92.

Following the hearing, the TTAB affirmed the four refusals of registration in three separate opinions. See A1073-111 (denying the appeal for the ’998 Application), A2088-126 (denying the appeals for the ’365 and ’366 Applications), A3764-801 (denying the appeal for the ’097 Application). Although there are minor differences among the three opinions, all share the same central conclusions that “booking” refers to “a reservation or arrangement to buy a travel ticket or stay in a hotel room” or “the act of reserving such travel or accommodation;” that “.com” indicates a commercial website, which does not negate the generic character of the term “booking;” and that the combined term BOOKING.COM would be understood by consumers “primarily to refer to an online reservation service for travel, tours, and lodging,” which is consistent with the services proposed in the applications, making the mark generic for the services offered. See, e.g., A1092, A1096, A1107. In the alternative, the TTAB concluded that BOOKING.

COM is descriptive of plaintiff's services and that plaintiff "failed to demonstrate that the term has acquired distinctiveness." See, e.g., A1111.

On April 15, 2016, plaintiff filed this civil action under 15 U.S.C. § 1071(b) against Michelle Lee, who was then the USPTO Director ("the USPTO Director"),¹ and the USPTO (collectively "defendants"), challenging the USPTO's denial of registration of the four applications. The parties have filed the administrative record from the USPTO proceedings and both sides have produced new evidence on the questions of genericness and descriptiveness. Although the body of evidence before this Court is similar to what was before the TTAB, of significance, plaintiff has now submitted a "Teflon survey," which, as will be discussed below, is the most widely used survey format for measuring consumer opinion in a genericness challenge, and defendants have provided a report by a rebuttal expert. By way of relief, plaintiff asks the Court to reverse the decisions of the TTAB and order the USPTO Director to publish each application in the Principal Register. Compl., [Dkt. No. 1] at 17.

II. DISCUSSION

A. Standards of Review

A trademark applicant "dissatisfied with the decision" of the USPTO has two remedies under the Lanham Act: either "appeal to the United States Court of Appeals for the Federal Circuit," see 15 U.S.C. § 1071(a), or file a civil action against the USPTO Director in federal district court, see 15 U.S.C. § 1071(b). Under

¹ The USPTO Director position has since been vacated and is currently being filled in an acting capacity by Joseph Matal.

§ 1071(a), an appeal to the Federal Circuit is taken “on the record” before the USPTO, *id.* § 1071(a)(4), and the USPTO’s factual findings will be upheld if they are supported by “substantial evidence,” *see, e.g., Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000). In contrast, in a civil action under § 1071(b), “the district court reviews the record *de novo* and acts as the finder of fact.” *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014) (citing *Durox Co. v. Duron Paint Mfg. Co.*, 320 F.2d 882, 883-84 (4th Cir. 1963)).² Placement of a mark on the generic-descriptive-suggestive-

² Defendants try to distinguish *Swatch AG*, arguing that it does not apply to cases where “a party submits new evidence on only some discrete questions of fact but not others.” Def. Opp. at 4-5. This reading of the case law is indefensible. *Swatch AG* explicitly held, “where new evidence is submitted, *de novo* review of the entire record is required because the district court ‘cannot meaningfully defer to the [USPTO’s] factual findings if the [USPTO] considered a different set of facts.’” 739 F.3d at 155 (citing *Kappos v. Hyatt*, 132 S. Ct. 1690, 1700 (2012)) (alterations added). Indeed, the “dual capacity” standard of review endorsed by defendants—where the district court acts as appellate reviewer of facts found by the USPTO and fact-finder on issues for which there is new evidence—was held to be “erroneous” by the Fourth Circuit. *Id.* at 156. Were there any room for ambiguity about the applicability of *de novo* review, it was dispelled by the Fourth Circuit’s subsequent decision in *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015), which explained that § 1071(b) authorizes “[d]e novo civil actions” in which “[t]he district court reviews all the evidence *de novo* and acts as the trier of fact.” *Id.* at 225 (emphasis added) (citing *Swatch*, 739 F.3d at 155), *cert. denied sub nom. Shammas v. Hirshfeld*, 136 S. Ct. 1376 (2016). Moreover, even if defendants were correct that substantial evidence review applies when no new evidence has been submitted on a particular question of fact, Def. Opp. at 4 (citing *Dome Pat., LP v. Rea*, 59 F. Supp. 3d 52, 78-79 (D.D.C. 2014)), there is no basis to apply that standard here; rather, both parties acknowledge that genericness and descriptiveness determinations are questions of fact, Pl.

fanciful continuum is a question of fact. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1344 (Fed. Cir. 2001).

Upon the motion of a party, the district court must admit the USPTO record and give it the “same effect as if originally taken and produced in the suit.” § 1071(b)(3). “[T]he district court may, in its discretion, ‘consider the proceedings before and findings of the [USPTO] in deciding what weight to afford an applicant’s newly-admitted evidence.’” Kappos v. Hyatt, 132 S. Ct. 1690, 1700 (2012) (quoting Hyatt v. Kappos, 625 F.3d 1320, 1335 (Fed. Cir. 2010)). The district court also “has authority independent of the [USPTO] to grant or cancel registrations.” Swatch AG, 739 F.3d at 155 (citing § 1071(b)(1)).

Summary judgment is appropriate where the record demonstrates that “there is no genuine dispute as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). Although the Court must view the record “in the light most favorable to the non-moving party,” Dulaney v. Packaging Corp. of Am., 673 F.3d 323, 324 (4th Cir. 2012), “[t]he mere existence of a scintilla of evidence in support of the [nonmovant’s] position will be insufficient” to overcome a motion for summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 252 (1986); see also Am. Arms Int’l v. Herbert, 563 F.3d 78, 82 (4th Cir. 2009). Rather, a genuine issue of material fact exists only “if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” Anderson, 477 U.S. at 248. Summary judgment does

Mem. at 10; Def. Mem. at 10, and the new evidence before the Court bears on both of those questions.

not become disfavored simply because there is an “important, difficult or complicated question of law.” Lewis v. Coleman, 257 F. Supp. 38, 40 (S.D. W. Va. 1966); Bradacs v. Haley, 58 F. Supp. 3d 514, 521 (D.S.C. 2014).

The parties have “expressly agree[d] that if the Court determines after reviewing the briefs and evidence on summary judgment that any material issue of fact exists, the Court is authorized to resolve any such factual dispute.” [Dkt. No. 26] ¶ 4(B). Accordingly, the Court will make factual determinations as well as weighting decisions that are not normally appropriate on a motion for summary judgment.

B. Analysis

Although plaintiff filed four trademark applications, neither plaintiff nor defendants contend that the stylized elements described in those applications affect the protectability of the mark. Instead, the parties focus on the word mark BOOKING.COM and on where along the generic-descriptive-suggestive-fanciful continuum the mark is situated. Def. Mem. at 1-2; Pl. Mem. at 10-12. Therefore, rather than addressing each application individually, the Court will disregard the stylized elements and focus on the appropriate categorization of the word mark BOOKING.COM; however, because a multi-class application is regarded as a series of separate applications, the Court must independently assess the protectability of the mark for the two classes of services plaintiff claims in its applications, Classes 39 and 43. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 19:56.50 (4th ed.) (hereinafter McCarthy on Trademarks).

1. The Framework of the Lanham Act

The Lanham Act provides nationwide protection of trademarks. A trademark is “any word, name, symbol, or device, or any combination thereof” used “to identify and distinguish . . . goods [or services], including a unique product [or service], from those manufactured or sold by others and to indicate the source of the goods [or services], even if that source is unknown.” 15 U.S.C. § 1127. The Act has two purposes. The first is to prevent consumer confusion regarding the source of goods and services and to reduce consumers’ information costs by “quickly and easily assur[ing] a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items [or services] that he or she liked (or disliked) in the past.” Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159, 163-64 (1995) (emphasis in original). Second, the Act incentivizes brand investment by assuring the “producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product [or service],” *id.* at 164, thereby “secur[ing] to the owner of the mark the goodwill of his business,” Park ’N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 198 (1985). By allowing the producer to reap the benefits of consumer goodwill, trademark law “encourages the production of quality products [and services] and simultaneously discourages those who hope to sell inferior products [or services] by capitalizing on a consumer’s inability quickly to evaluate the quality of an item [or service] offered for sale.” Qualitex, 514 U.S. at 164 (internal quotation marks omitted). Thus, the Lanham Act reflects Congress’s conclusion that “[n]ational protection of trademarks is desirable . . . because [it] foster[s] competition and the maintenance of

quality by securing to the producer the benefits of good reputation.” Park 'N Fly, 469 U.S. at 198.

In keeping with these twin purposes, the Lanham Act identifies four categories of marks. “Arrayed in an ascending order which roughly reflects their eligibility [for] trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.” Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976). “A generic mark refers to the genus or class of which a particular product [or service] is a member and can never be protected.” Ashley Furniture Indus., Inc. v. SanGiacomo N.A., 187 F.3d 363, 369 (4th Cir. 1999). Examples include Light Beer for ale-type beverages and Thermos for vacuum-insulated bottles. Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 464 (4th Cir. 1996). A descriptive mark “describes a function, use, characteristic, size, or intended purpose” of the product or service, such as 5 Minute glue and the Yellow Pages telephone directory. Id. “Marks that are merely descriptive are accorded protection only if they have acquired a secondary meaning [also called ‘acquired distinctiveness’], that is, if in the minds of the public, the primary significance of a product [or service] feature or term is to identify the source of the product [or service] rather than the product [or service] itself.” Id. (internal citations omitted). Although eligible for protection in some instances, descriptive marks are considered weak marks. Shakespeare Co. v. Silstar Corp. of Am., 110 F.3d 234, 239-40 (4th Cir. 1997). Suggestive marks, such as Coppertone for sunscreen and Orange Crush for orange flavored soda, “connote, without describing, some quality, ingredient, or characteristic of the product [or service].” Sara Lee Corp., 81 F.3d at

464. Marks that are “comprised of words in common usage” but “do not suggest or describe any quality, ingredient, or characteristic of the goods [or services] they serve, are said to have been arbitrarily assigned.” Id. Examples of arbitrary marks include Tea Rose brand flour and Apple for computers. Id. Lastly, fanciful marks are “in essence, made-up words expressly coined for serving as a trademark,” such as Clorox for a bleach product and Kodak for photography-related products. Id. Because the “intrinsic nature” of suggestive, arbitrary, and fanciful marks “serves to identify a particular source of a product [or service],” these categories “are deemed inherently distinctive and are entitled to protection.” Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992).

2. Genericness

Because a generic mark, which is statutorily defined as “the common descriptive name of an article or substance,” Federal Trade Commission Improvements Act of 1980, Pub. L. No. 96-252, § 18, 94 Stat. 374, 391, by definition neither signifies the source of goods or services nor distinguishes the particular product or service from other products or services on the market, it cannot be protected as a trademark nor registered as one. Retail Servs., Inc. v. Freebies Publ’g, 364 F.3d 535, 538 (4th Cir. 2004) (citing Park ’N Fly, 469 U.S. at 194). To permit otherwise “would grant the owner of the [generic] mark a monopoly since a competitor could not describe his goods [or services] as what they are.” CES Publ’g Corp. v. St. Regis Publ’ns, Inc., 531 F.2d 11, 13 (2d Cir. 1975); see also Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc., 405 F. Supp. 2d 680, 688 (E.D. Va. 2005), aff’d, 227 F. App’x 239 (4th Cir. 2007)

(“[T]he goals of trademark protection . . . must be balanced by the concern that trademark protection not become a means of monopolizing language or stifling productive competition.”). To the contrary, such marks must remain in the public domain where they are free for all to use. See Am. Online, Inc. v. AT & T Corp., 243 F.3d 812, 821 (4th Cir. 2001) (explaining that trademark law “protects for public use those commonly used words and phrases that the public has adopted, denying to any one competitor a right to corner those words and phrases by expropriating them from the public ‘linguistic commons’”); 2 McCarthy on Trademarks § 12:2.

“The rub . . . is in trying to distinguish generic marks from [protectable marks].” Ashley Furniture Indus., 187 F.3d at 369. According to the test adopted by the Supreme Court in Kellogg Co. v. Nat’l Biscuit Co., a plaintiff seeking to establish a valid trademark as compared to a generic mark “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.” 305 U.S. 111, 118 (1938). A mark is not generic simply because it plays some role in denoting to the public what the product or service is; rather, a mark may serve a “dual function—that of identifying a product [or service] while at the same time indicating its source.” S. Rep. No. 98-627, at 5 (1984). Hence, Kellogg focuses on whether “the primary significance of the mark [is] indication of the nature or class of the product or service, rather than an indication of source.” Glover v. Ampak, Inc., 74 F.3d 57, 59 (4th Cir. 1996) (emphasis in original); see also Retail Servs., 364 F.3d at 544 (explaining that a generic mark “neither signifies the source of goods nor

distinguishes the particular product from other products on the market”).

Determining whether a mark is generic involves three steps: “(1) identify[ing] the class of product or service to which use of the mark is relevant; (2) identify[ing] the relevant purchasing public of the class of product or service; and (3) [determining whether] the primary significance of the mark to the relevant public is to identify the class of product or service to which the mark relates.” Glover, 74 F.3d at 59. Evidence of public understanding of the primary significance of a mark can come from “purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers, and other publications.” Id. The burden of proof rests with the party seeking to establish genericness, in this case the defendants, who must prove that the mark is generic by clear and convincing evidence. In re Cordua Restaurants, Inc., 823 F.3d 594, 600 (Fed. Cir. 2016).

a. Classes of Services

The first step in analyzing the proposed BOOKING.COM mark is to determine the classes of services (sometimes referred to as “genera of services”) at issue in each application. Glover, 74 F.3d at 59. The defendants recognize that the services identified in each registration vary, but summarize the classes of services as “online travel agency services, namely the arrangement of transportation and tours,” for Class 39 and “online hotel and lodging services” for Class 43. Def. Mem. at 17-18. Plaintiff does not appear to understand that this is a class specific analysis and argues that the USPTO’s “inability to adopt a single genus . . . requires reversal.” See Pl. Reply at 16-17 & n.5. This argument

is inconsistent with the longstanding principle that a single application to register multiple classes, *i.e.*, a combined application, is treated “as though it were a group of individual applications” requiring “separate analyses for each class of goods [or services].” Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1102 (C.C.P.A. 1976).

Plaintiff further criticizes the defendants’ “new proposed genera” for “ignor[ing] most of plaintiff’s actual services,” including “the information and search (or research) services . . . and business oriented services . . . used by hotels and other travel services seeking to advertise and list their accommodations for rental.” Pl. Opp. at 28. This critique is baseless for several reasons. As an initial matter, plaintiff overlooks that it too has taken a reductivist view of the class of service by defining the relevant class of services or genus as “travel agency services.” Pl. Mem. at 13. Further, plaintiff’s suggestion that the class of services should include specific services, such as business consulting, stems from plaintiff’s argument that a granular approach that emphasizes services that would not be described with the word “booking” can save its mark from genericness. See Pl. Opp. at 28 n.18 (“[T]here is no reason a broad specification of services or goods cannot be held distinctive for some of the services and not so for others.”). Defendants, on the other hand, maintain that “registration is properly refused if genericness is found as to any service specified in the application.” Def. Reply at 9. On this issue, defendants have the better of the argument. Registration must be refused if a mark “is the generic name of any of the goods or services for which registration is sought.” See Cordua Restau-

rants, 823 F.3d at 605 (quoting 2 McCarthy on Trademarks § 12:57). Therefore, even though plaintiff provides business consulting services, its mark will fail if it is generic as to plaintiff’s hotel reservation services. Similarly, even if, as plaintiff argues, the appropriate genus is “travel agency services,” to the extent that this encompasses hotel reservation services, plaintiff’s mark is not entitled to protection if it is generic for hotel reservation services. See Otokoyama Co. v. Wine of Japan Imp., Inc., 175 F.3d 266, 271 (2d Cir. 1999) (“Generic words for sub-classifications or varieties of a good are . . . ineligible for trademark protection.”).

In addition, as defendants acknowledge, “[p]laintiff is the master of its application, including the identification of services covered by it” and “[i]t was from the identification of services provided by plaintiff that the TTAB derived its recitation of the services.” Def. Opp. at 10; see also A1076 (describing the genus of services as an “accurate[] summar[y]” of the recitation provided by the plaintiff); A3768 (same). Because “the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [and services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods,” Octocom Sys., Inc. v. Houston Computer Servs., Inc., 918 F.2d 937, 942 (Fed. Cir. 1990), the identification of services in plaintiff’s applications “controls this analysis,” In re Dayan, 61 F. App’x 695, 696 (Fed. Cir. 2003). Although plaintiff’s applications reference a multitude of services, because “registration is properly refused if the word is the generic name of any of the goods or services for which registration is sought,” 2 McCarthy on Trademarks § 12:57, the Court need not analyze each service. Instead, it will focus on the broadest services

described in plaintiff's applications: "travel and tour ticket reservation services" for Class 39 and "[m]aking hotel reservations for others" for Class 43. Moskin Decl. [Dkt. No. 65-5] ¶¶ 2-4.

b. Relevant Purchasing Public

To define the relevant purchasing public, a court must look to the class of goods and services for which the trademark application was submitted. Cf. Glover, 74 F.3d at 59; Retail Servs., Inc. v. Freebies Publ'g, 247 F. Supp. 2d 822, 826 (E.D. Va. 2003), aff'd Retail Servs., 364 F.3d at 535. Here, the applications sought registration for travel, tour, and hotel reservation services, including those offered online, making consumers who use travel, tour, and hotel reservation services offered via the internet or in person the relevant purchasing public.

c. Primary Public Understanding

The next consideration is whether "the primary significance of the term in the minds of the consuming public is not the product but the producer." Kellogg, 305 U.S. at 118. The public's primary understanding of a mark "is derived from it as a whole, not from its elements separated and considered in detail;" therefore, "it should be considered in its entirety." Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545-46 (1920). Although "a mark must be considered as a whole," this "does not preclude courts from considering the meaning of individual words in determining the meaning of the entire mark." Hunt Masters, Inc. v. Landry's Seafood Rest., Inc., 240 F.3d 251, 254 (4th Cir. 2001). Accord-

ingly, this Court will consider the two elements “booking” and “.com” separately before considering them in combination.

i. “Booking”

Defendants’ argument that BOOKING.COM is generic rests primarily on its view of the meaning of “booking,” for which its primary sources are various dictionary definitions. “Although not controlling, ‘dictionary definitions are relevant and sometimes persuasive’ on the issue of genericness ‘based upon the assumption that dictionary definitions usually reflect the public’s perception of a word’s meaning and its contemporary usage.’” Retail Servs., 364 F.3d at 544-45 (citing 2 McCarthy on Trademarks at § 12:13). The definitions in the record, which are nearly identical to those relied on by the TTAB, include:

1. An engagement, as for a performance. 2. A reservation, as for accommodations at a hotel. American Heritage College Dictionary (3d ed. 1997).

1. a contract, engagement or scheduled performance of a professional entertainer. 2. a reservation. 3. the act of a person who books. Random House Unabridged Dictionary (2d ed. 1993).

1: the act of one that books 2: an engagement or scheduled performance . . . 3: RESERVATION; esp one for transportation, entertainment, or lodging 4: ORDER. Webster’s Third New International Dictionary (1993).

1: the act of one that books 2: an engagement or scheduled performance 3: RESERVATION. Merriam-Webster’s Collegiate Dictionary (11th ed. 2008).

Plaintiff points out that the primary definition of “booking” in the definitions produced by the defendants refers to a performance, as in a theatrical engagement, and that the word has numerous other meanings. Pl. Mem. at 21. Although this observation is correct, it does not advance plaintiff’s cause as “a word may have more than one generic use.” Abercrombie & Fitch, 537 F.2d at 11.

Defendants also cite evidence that plaintiff and its competitors routinely use the word “booking” in reference to their services. For example, plaintiff’s website uses “booking” as a noun, to describe a reservation, see A345 (“Sign in to manage your bookings.”); *id.* (“Latest booking 10 minutes ago.”), and as a verb, meaning to make a reservation, see A349 (“Our goal is to provide business and leisure travelers with the most accessible and cost effective way of discovering and booking the broadest section of accommodations in every corner of the world.”), as do its confirmation notices, which refer to the reservation as a “booking” in the subject line, see Def. Ex. A, PTO-00011. Similarly, plaintiff’s competitors use “booking” as both a noun and a verb in describing their services. For example, Hotwire, which provides services for making hotel, car, and flight reservations, advertises “easier booking,” *id.* at PTO-00322, Hotels.com claims to be the preferred choice “when it comes to booking the perfect hotel,” *id.* at PTO-000298, and Travelocity and Expedia offer services for “hotel booking,” *id.* at PTO-00326; PTO-00313, “vacation package booking,” PTO-00315, and “booking a rental car,” PTO-00327. “Booking” is also a common component of descriptors for hotel reservation and travel agency services. A 2016 New York Times article regarding the impact of online reservation services on hotel loyalty programs referred to “Hotels.com, Hotwire.com, Trivago.

com, and Travelocity.com” as “booking sites.” Id. at PTO-00261-64; see also id. at PTO-00286-92. And, Skift, an information platform for the travel sector, headlined an article discussing flight reservation services with reference to “booking sites.” Id. at PTO-00250-54. Finally, defendants identify fifteen third-party websites that include “booking.com” or “bookings.com” as components of their domain names. See id. at PTO-00148-65; A764-68, A772-81, A1085-86.

Plaintiff contends that this evidence is not enough to show that the word “booking” is “ever used as a generic term for travel agency services” and “has no relation whatsoever to plaintiff’s business consulting services.” Pl. Mem. at 21. This argument parallels plaintiff’s argument regarding the proper genus of services, which effectively contends that the term “booking” is too narrow to describe the broad “travel agency services” offered by plaintiff while simultaneously too general to capture plaintiff’s consulting services. But, this “heads I win, tails you lose” approach has no legal support. See Nat’l Nonwovens, Inc. v. Consumer Prod. Enters., 397 F. Supp. 2d 245, 252 (D. Mass. 2005) (rebuffing plaintiff’s “subtle rhetorical move that attempts to abstract [the genus] to a higher level of generality”). As explained above, it is well-established that “[a] registration is properly refused if the word is the generic name of any of the goods or services for which registration is sought.” Cordia Rests., 823 F.3d at 605 (citing 2 McCarthy on Trademarks § 12:57). This makes good sense. Otherwise, applicants could elude a finding of genericness by simply tailoring their recitation of the goods and services at issue to be broader or narrower than the linguistic scope of their generic or descriptive mark. Permitting such gamesmanship would defeat one of the central

purposes of the Lanham Act, which “is carefully crafted to prevent commercial monopolization of language that otherwise belongs in the public domain.” S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 573 (1987) (Brennan, J., dissenting).

The evidence presented by the defendants establishes that, by itself, the word “booking” is generic for the classes of hotel and travel reservation services recited in plaintiff’s applications. The dictionary definitions include as a meaning of “booking” a reservation or the act of making a reservation. Even more tellingly, plaintiff and its competitors use the term in this manner. This definition is also consistent with public usage, as indicated by the news sources quoted in the record. In this respect, the word “booking,” standing alone, is the common descriptive name for both the act of making a reservation and the reservation itself. This conclusion is equally true for hotel reservations and the wider set of reservations offered by a travel agency service, because hotel, flight, and tour reservations are all referred to as “bookings,” just as the act of making these types of reservations is often called “booking.” Based on this evidence, the Court finds that the term “booking” is generic for these types of services.

ii. Top-Level Domains

The finding that “booking” is a generic term does not end the analysis because the mark at issue is BOOKING.COM. Therefore the Court must consider whether the term resulting from combining “booking” with “.com” remains generic. According to dictionary definitions, “.com” refers to a “commercial organization (in Internet addresses),” American Heritage College

Dictionary (3d ed. 1997), or “[p]art of the internet address of many companies and organizations,” Dictionary.com, <http://www.dictionary.com/browse/-com> (last accessed Apr. 7, 2017). In addition, some dictionaries state that “the phrase dot-com is used to refer generically to almost anything connected to business on the Internet.” Id. Plaintiff argues that “.com” should be read as a top-level domain (TLD), in the same family as “.net,” “.org,” and “.edu.” Pl. Mem. at 22. A TLD can be contrasted with a second-level domain (SLD), which is the next level of organization in the domain name hierarchy. For example, in “booking.com,” “booking” is the SLD and “.com” is the TLD. According to plaintiff, the combination of “booking” and “.com” signals a domain name,³ which is a unique identifier capable of indicating the source of a product or service. Id. at 21, 23. The defendants, on the other hand, argue that “.com” is merely a term that denotes services offered via the Internet, and point to Federal Circuit cases holding that a TLD has no source identifying significance.

Although Federal Circuit case law on trademark is not controlling in this jurisdiction, it is persuasive authority. Because the parties acknowledge that there is no Fourth Circuit precedent regarding the source identifying significance of a TLD, Def. Mem. at 19 n.13, the reasoning of the Federal Circuit, which has addressed the role of TLDs in at least five cases, is a helpful starting point; however, it is important to appreciate that all of these opinions arose in § 1071(a) proceedings, in

³ A domain name is “any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.” 15 U.S.C. § 1127.

which the Federal Circuit reviewed the TTAB's decisions regarding genericness and descriptiveness for substantial evidence, which is a more deferential standard than the de novo review applicable in this civil action brought under § 1071(b).

The Federal Circuit first addressed the legal effect of combining a SLD consisting of a generic word (henceforth "generic SLD") and a TLD in In re Oppedahl & Larson LLP, 373 F.3d 1171 (Fed. Cir. 2004). There, the USPTO found that PATENTS.COM was generic for software that allowed consumers to track the status of U.S. trademark and patent applications. This holding relied on the conclusion that "patents" was generic and the Trademark Manual of Examining Procedure's instruction that "[b]ecause TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable." Id. at 1174-75 (citing 1209.03(m) Domain Names [R-2]). Before the Federal Circuit, the applicant argued that domain name marks were inherently distinctive and therefore all such marks were entitled to registration. Id. at 1176. The Federal Circuit rejected this argument and affirmed the USPTO, reasoning that "[t]elephone numbers and street addresses are also unique, but they do not by themselves convey to the public the source of specific goods or services." Id. at 1176-77. Nevertheless, the Federal Circuit cautioned that "a bright-line rule that the addition of a TLD to an otherwise descriptive term will never under any circumstances affect the registrability [sic] of a mark" would "be a legal error," concluding that the USPTO's policy was not a bright-line rule. Id. at 1175.

The Federal Circuit's next TLD case, In re Steel-building, 415 F.3d 1293 (2005), is the only case in which the Federal Circuit reversed the TTAB's finding that a domain name was generic, although it ultimately sustained the USPTO's denial of registration. In that case, the applicant sought registration of STEELBUILDING.COM for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems." Id. at 1296. On appeal, the Federal Circuit determined that the evidence did not support the TTAB's genericness finding because "[t]he applicant's web site permits a customer to first design, then determine an appropriate price, for its own unique design," and that the TTAB "misunderst[ood] the proper genus." Id. at 1298. With respect to the TLD, the court concluded that "[i]n [that] unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings" by "expand[ing] the mark to include internet services that include 'building' or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure." Id. at 1299. Although it rejected the genericness finding, the Federal Circuit affirmed the TTAB's alternative conclusion that the mark was descriptive for the online services specified in the application and that the applicant had failed to meet its burden of proving acquired distinctiveness. Id. at 1299-300. In a separate opinion that diverged from Oppedahl & Larson's conclusion that TLDs generally serve no source identifying function, Judge Linn argued that "[i]n the Internet world, domain-name recognition is a form of source identification" and argued that the case should be remanded to the TTAB for a reassessment of

the evidence. Id. at 1301 (Linn, J., concurring-in-part and dissenting-in-part).

The Federal Circuit's next case⁴ involved the mark HOTELS.COM, which the examiner concluded was descriptive for the class of services—"providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and global computer network"—and had not acquired secondary meaning. In re Hotels.com, L.P., 573 F.3d 1300, 1301 (Fed. Cir. 2009). The TTAB subsequently affirmed the rejection but on the alternative basis that HOTELS.COM is a generic term for hotel information and reservation services and that the addition of ".com" to "hotels" did not convert the generic term "hotels" into a protectable mark. Id. In reaching this conclusion, the TTAB relied on dictionary definitions of "hotel," computer printouts of the applicant's website featuring links to hotels, and the inclusion of the characters "hotel.com" in other domain names. Id. at 1301. The applicant presented rebuttal evidence, including sixty-four declarations from customers, vendors, and competitors, who each stated that "the term HOTELS.COM is not the common, generic name of any product, service, or field of study," as well as a Teflon survey drawn from 277 respondents in which 76% regarded HOTELS.COM as a brand name, both of which the TTAB declined to credit. Id. at 1304-05. On appeal, the Federal Circuit

⁴ The Federal Circuit briefly addressed domain name marks in 2007, but there the argument was not about the source identifying significance of TLDs but rather whether the USPTO properly determined the genus of services. In re Reed Elsevier Props. Inc., 482 F.3d 1376 (Fed. Cir. 2007).

concluded that “on the entirety of the evidence before the TTAB, and with cognizance of the standard and burden of proof borne by the USPTO, 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” and held that “Board’s finding that HOTELS.COM is generic was supported by substantial evidence.” Id. at 1305-06.

The USPTO also denied registration to MATTRESS.COM for services identified as “online retail store service in the field of mattresses, beds, and bedding” on the basis of genericness. In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1361 (Fed. Cir. 2009). The Federal Circuit affirmed, rejecting the applicant’s argument that because consumers did not refer to such stores as “mattresses.com’s” the term could not be generic and instead holding that “substantial evidence . . . support[ed] the Board’s conclusion that ‘[c]onsumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses.’” Id. at 1362, 1364. In addition, the court found that “[b]ecause websites operate under the term ‘mattress.com’ to provide mattresses, and they provide them online, the [TTAB] properly concluded that the relevant public understands the mark MATTRESS.COM to be no more than the sum of its constituent parts, viz., an online provider of mattresses.” Id. at 1363.

Although the Court recognizes the persuasive force of Federal Circuit cases, a number of factors caution

against crediting these precedents here. From a chronological perspective, the Federal Circuit's first TLD case, Oppehahl & Larson, which held that "TLDs generally serve no source-indicating function," was decided in 2004 when the internet was in its infancy and norms regarding domain names were just taking root. See 373 F.3d at 1176. Subsequent opinions have undermined Oppehahl & Larson's reasoning by recognizing that a TLD indicates a domain name and "domain-name recognition is a form of source identification." Steelbuilding, 415 F.3d at 1301 (Linn, J., concurring-in-part and dissenting-in-part). There also appears to be a tension between the Federal Circuit's statement that a per se rule that TLDs cannot be source identifying would be "legal error," Oppehahl & Larson, 373 F.3d at 1177, and the outcomes of these cases, which show that the USPTO's guidance on TLDs functions as a per se rule, see Oppehahl & Larson, 373 F.3d at 1177; Hotels.com, 573 F.3d at 1306; 1800Mattress.com, 586 F.3d at 1363. As discussed above, Steelbuilding is a notable exception, but as Professor McCarthy explains, this case "muddied the waters" and appears to be based on an "erroneous" characterization of STEELBUILDING.COM. 1 McCarthy on Trademarks § 7:17.50.

Beyond the tension within the cases, the Federal Circuit's TLD precedents also demonstrate the difficulty of distinguishing between generic and descriptive marks, an indeterminacy evidenced both by the anomalous holding in Steelbuilding and the multiple cases in which examining attorneys denied registration based on descriptiveness only to be affirmed by TTAB decisions concluding that the mark was actually generic, Oppehahl & Larson, 373 F.3d at 1173; Hotels.com, 573 F.3d

at 1301. As discussed below, because “categorizing trademarks is necessarily an imperfect science,” Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc., 618 F.3d 1025, 1033 (9th Cir. 2010), it would be imprudent to adopt a sweeping presumption denying trademark protection to a whole category of domain name marks in the absence of robust evidence that public ownership of this language is necessary for consumers and competitors to describe a class of products or services—evidence that does not appear in the Federal Circuit cases. Most importantly, in each of these TLD cases the Federal Circuit reviewed TTAB decisions under the deferential substantial evidence standard, a point that was repeatedly emphasized in the cases. See, e.g., Hotels.com, 573 F.3d at 1301. By contrast, under § 1071(b) this Court is required to conduct a de novo review. For all these reasons, this Court declines to rely on the Federal Circuit’s precedents regarding TLDs and will treat this question as an issue of first impression. And, for the reasons developed below, the Court concludes that, when combined with an SLD, a TLD generally has source identifying significance and the combination of a generic SLD and a TLD is generally a descriptive mark that is protectable upon a showing of acquired distinctiveness.

To illustrate this conclusion, it is helpful to consider the Federal Circuit’s reasoning in a case involving telephone numbers as marks. In 2001, before the Federal Circuit first confronted the issue of TLDs, it held that the mark 1-888-M-A-T-R-E-S-S was protectable as a descriptive mark. In re Dial-A-Mattress, 240 F.3d 1341, 1346 (Fed. Cir. 2001). In that case, the applicant applied to register 1-888-M-A-T-R-E-S-S as a service mark for “telephone shop-at-home retail services in the

field of mattresses.” Id. at 1343. The examining attorney rejected the mark as generic for the relevant services or, in the alternative, as a descriptive mark with insufficient evidence of acquired distinctiveness. Id. at 1344. The TTAB affirmed both rationales. Id. On appeal to the Federal Circuit, Dial-A-Mattress conceded that the area code in the mark was devoid of source identifying significance by itself and that the word “mattress,” no matter how creatively spelled, was generic for retail services in the field of mattresses; however, it argued that, considered in its entirety, the mark was not generic. Id. at 1345. The Federal Circuit agreed, holding that although area codes have no source identifying significance by themselves and the term “mattress” was generic, the combination of an area code and a generic term (1-888-MATRESS) was source identifying. Id. at 1346. Specifically, it was descriptive, as it indicated that “a service relating to mattresses [was] available by calling the telephone number.” Id. Yet, even though the telephone mnemonic was source identifying, the Federal Circuit explained that the applicant still needed to establish “acquired secondary meaning” (also termed “acquired distinctiveness”) in order to register the descriptive mark. Id. at 1347.⁵

⁵ Defendants attempt to distinguish Dial-a-Mattress by arguing that unlike “888,” “.com” has a recognized generic meaning and that 1-888-MATRESS was a mnemonic while BOOKING.COM is not. Def. Mem. at 10. Neither of these distinctions is persuasive because the Dial-a-Mattress court recognized that “888” was an area code, just as the Federal Circuit later recognized that “.com” is a TLD and, even though a domain name is not a mnemonic, it can function like a mnemonic by describing the associated goods or services.

The reasoning in Dial-a-Mattress maps seamlessly onto TLDs. Although a TLD, like an area code, has no source identifying significance by itself, in combination with a SLD, it indicates a domain name, which, like a telephone number, is unique. Moreover, like the mnemonic phone number 1-888-M-A-T-R-E-S-S, the combination of a TLD and a generic SLD creates a descriptive mark by indicating that services relating to the generic SLD are available by accessing the domain name. Finally, whether such a mark is entitled to trademark protection depends on whether the applicant can demonstrate that it has acquired distinctiveness. In short, TLDs generally do have source identifying value when used in conjunction with an SLD and a mark comprised of a generic SLD and a TLD is generally a descriptive mark entitled to trademark protection if the mark holder can establish acquired distinctiveness.

Defendants resist this conclusion. Beyond invoking the Federal Circuit cases, defendants' argument that a TLD does not have identifying significance relies principally on the Supreme Court's 1888 decision in Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co., 128 U.S. 598, 602 (1888), which held that adding terms such as "Corp.," "Inc.," and "Co." to a generic term does not add any trademark significance to an otherwise unregistrable mark. Def. Mem. at 13, 21. By analogy, defendants argue that "[a]dding '.com' to a generic term does not create a composite that is capable of identifying source, just as Plaintiff would not have created a protectable mark by adopting the designation 'Booking Company.'" Id. at 13. This analogy is unhelpful because Goodyear's reasoning regarding corporate designators does not apply with equal force to domain names. As the Supreme Court explained in Goodyear, the use of

a corporate designation had no source identifying value because it “only indicates that the parties have formed an association or partnership to deal in [particular] goods, either to produce or to sell them.” 128 U.S. at 602. By contrast, adding a TLD such as “.com” to a generic SLD does more than indicate that a company offers services via the internet; it indicates a unique domain name that can only be owned by one entity. In this respect, unlike a corporate designation, a TLD that functions as part of a domain name does have source identifying significance.

Defendants further argue that the public understands that a mark comprised of a generic SLD combined with a TLD is generic for that class of goods or services; however, they provide no evidence to support this position other than citations to the aforementioned Federal Circuit decisions. Def. Mem. at 13. As will be discussed below, defendants’ evidence shows that the public understands that such a mark represents a unique domain name indicating to consumers that the proprietor of the domain name provides goods or services relating to the generic term. Blair Rep. at 14 (arguing there is a “tendency for [some survey] respondents to think that any DOT-COM name is a brand”).

Next, citing Advertise.com, Inc. v. AOL Adver., Inc., 616 F.3d 974, 980 (9th Cir. 2010), defendants raise the policy argument that recognizing the source identifying significance of TLDs would create “a per se rule—in contravention of the Lanham Act—that the combination of ‘.com’ with any generic term renders it protectable.” Def. Mem. at 2, 17. In Advertise.com, the Ninth Circuit addressed AOL’s motion for a preliminary injunction against the registrant of ADVERTISE.COM on the

basis that the mark was confusingly similar to AOL's mark ADVERTISING.COM, ultimately holding that the combination of a generic SLD and a TLD was not eligible for protection. The Court understands defendants to be invoking Advertise.com's conclusion to argue that, if trademark law recognizes TLDs as source identifying, the addition of a TLD to a generic SLD would always result in a protectable mark. This argument overreaches. Acknowledging that combining a TLD with a generic SLD can produce a source identifying domain name is not tantamount to finding that all domain name marks are protectable. Rather, a generic SLD combined with a TLD creates a descriptive mark that is eligible for protection only upon a showing of acquired distinctiveness. Importantly, acquired distinctiveness is a much higher bar than uniqueness and requires an evidentiary showing that "in the minds of the public, the primary significance of a . . . term is to identify the source of the product rather than the product itself." Inwood Labs., Inc. v. Ives Labs., 456 U.S. 844, 851 n.11 (1982). In the trademark context, "source" does not refer to the location where a good or service may be found, e.g., at the website associated with a domain name, but to the "producer." Kellogg, 305 U.S. at 118. Therefore, domain name marks composed of a generic SLD and TLD, will be eligible for protection only when the applicant can show that "the primary significance" of the mark in the minds of the relevant consumers is the producer. Id. Such a showing is only possible where the owner of the mark has developed strong brand recognition.

The second policy concern raised by defendants is that granting trademark protections to domain names

with a generic SLD would prevent competitors from using the generic term in their domain names, hampering their ability to communicate the nature of their services. Def. Opp. at 25. This argument again echoes the Ninth Circuit’s analysis in Advertise.com, which reasoned that granting protection to such a mark would “grant[] the trademark holder rights over far more intellectual property than the domain name itself,” permitting mark holders to monopolize a wide swath of domain names, including those comprised of the generic SLD at issue and any other TLD (e.g., “advertise.net”; “advertise.biz”; “advertise.org”) as well other domain names that contain the generic word (e.g., “localadvertise.com”; “advertiseonline.com”). See 616 F.3d at 980-81. This argument, although initially alarming, does not withstand scrutiny.

The most obvious refutation of the monopolization concern is that domain names with a descriptive SLD, such as “steelbuilding,” are already eligible for protection upon a showing of secondary meaning. Steelbuilding.com, 415 F.3d at 1299; Oppedahl & Larson, 373 F.3d at 1173. Moreover, although the USPTO has registered marks with what it determined are descriptive SLDs, such as WORKOUT.COM, ENTERTAINMENT.COM, and WEATHER.COM, this has not stopped competitors from using the words “workout,” “entertainment,” or “weather” in their domain names. To the contrary, such related domain names abound and many, such as MIRACLEWORKOUT.COM, WWW.GOLIVE-ENTERTAINMENT.COM, and CAMPERSWEATHER.

COM, have actually been afforded trademark protection by being registered on the Principal Register.⁶

In addition, the descriptive nature of domain name marks with a generic SLD will significantly limit the protection they receive, thereby safeguarding competition and public use. It is axiomatic that “descriptive terms qualify for registration as trademarks only after taking on secondary meaning . . . with the registrant getting an exclusive right not in the original, descriptive sense, but only in the secondary one associated with the markholder’s goods.” KP Permanent Make-Up, 543 U.S. at 122. Beyond the circumscribed protection afforded to descriptive marks, competitors are also protected by the likelihood of confusion standard. As the Supreme Court emphasized in KP Permanent Make-Up, the party charging infringement bears the burden of proving that a competitor’s use of a mark is likely to confuse consumers. Id. at 118. This is a heavy burden for a plaintiff because likelihood of confusion rests on nine factors, which include the source identifying strength of the plaintiff’s mark, the degree of similarity between the marks, and the defendant’s intent.⁷ See, e.g., H. Jay

⁶ The Court may take judicial notice of information in the public record, Sec’y of State for Defence v. Trimble Navigation Ltd., 484 F.3d 700, 705 (4th Cir. 2007), such as registrations in the Principal Register.

⁷ The Fourth Circuit’s likelihood of confusion doctrine instructs courts to examine the following factors: “(1) the strength or distinctiveness of the plaintiff’s mark as actually used in the marketplace; (2) the similarity of the two marks to consumers; (3) the similarity of the goods or services that the marks identify; (4) the similarity of the facilities used by the markholders; (5) the similarity of advertising used by the markholders; (6) the defendant’s intent; (7) actual con-

Spiegel & Assocs., P.C. v. Spiegel, 652 F. Supp. 2d 639, 650 (E.D. Va. 2009), aff'd, 400 F. App'x 757 (4th Cir. 2010) (finding, on a motion for summary judgment, that the record was inconclusive as to whether SPIEGEL.LAW.COM was confusingly similar to SPIEGELAW.COM). Likelihood of confusion is particularly difficult to prove for descriptive marks because they are considered “weak” marks, see Shakespeare Co., 110 F.3d at 239-40, and “when the common element between two marks is a word which is ‘weak,’ the likelihood of confusion between the marks is reduced.” Pizzeria Uno Corp. v. Temple, 566 F. Supp. 385, 396 (D.S.C. 1983), aff'd, 747 F.2d 1522 (4th Cir. 1984). Moreover, even if the party charging infringement succeeds in establishing likelihood of confusion, the accused party can defend itself by demonstrating fair use.⁸ See KP Permanent Make-Up, 543 U.S. at 121 (“some possibility of consumer confusion must be compatible with fair use”). As the Supreme Court has explained, “[i]f any confusion results” from descriptive fair use “that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well

fusion; (8) the quality of the defendant’s product; and (9) the sophistication of the consuming public.” George & Co. LLC v. Imagination Entm’t Ltd., 575 F.3d 383, 393 (4th Cir. 2009).

⁸ Fair use is “use, otherwise than as a mark, . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin. . . .” 15 U.S.C. § 1115(b)(4). Descriptive or classic fair use “applies when the [dilution] defendant is using a trademark in its primary, descriptive sense to describe the defendant’s goods or services,” whereas “nominative fair use comes into play when the defendant uses the famous mark to identify or compare the trademark owner’s product.” Rosetta Stone Ltd. v. Google, Inc., 676 F.3d 144, 169 (4th Cir. 2012) (quotation marks omitted).

known descriptive phrase.” *Id.* (internal citation omitted). This principle is equally true in the context of domain names and will preclude holders of marks comprised of a generic SLD and a TLD from preventing competitors from using the generic term in other domain names.⁹

Defendants’ third policy concern, which again proves more imagined than real, is that granting trademark protection to domain names with generic SLDs would deprive competitors of the right to describe their goods and services as what they are. Def. Mem. at 11-12. As defendants elaborate, “Imagine being forbidden to describe a Chevrolet as a ‘car’ or an ‘automobile’ because Ford or Chrysler or Volvo had trademarked these generic words.” *Id.* at 12 (citing *Retail Servs.*, 364 F.3d at 538). Defendants appear to suggest that plaintiff’s competitors need to be able to describe themselves as “booking.coms.” Although concerns about monopoly are one of the animating forces behind the prohibition on registering generic marks, because each domain name is unique the Court is unpersuaded that the threat of monopoly applies with equal force to domain names.¹⁰

⁹ At oral argument, plaintiff conceded that other domain names involving the word “booking” are protected under the fair use doctrine.

¹⁰ In rejecting plaintiff’s applications, the TTAB observed that “[a]s domain name registrations are not perpetual, [the plaintiff] may be supplanted as the registrant of that Internet address or may voluntarily transfer its domain name registration to another.” A1103. A practical problem might arise if the plaintiff let the domain name registration lapse or transferred it but wanted to continue using the mark; however, because a trademark right would only enhance plaintiff’s incentive to maintain its registration the Court need not concern itself with this remote possibility. In addi-

Further, the monopoly argument appears to assume that certain terms must be left in the public commons because they have descriptive value and are needed by consumers and competitors alike; however, no evidence in this record supports the view that domain names are used as descriptive terms for classes of services. To the contrary, the record is replete with evidence that consumers are predisposed to think that a domain name refers to a particular entity. Blair Rep. at 14; In re Hotels.com, 87 U.S.P.Q.2d 1100, 1109 (T.T.A.B. Mar. 24, 2008) (according to the TTAB, “consumers may automatically equate a domain name with a brand name”). By this same logic, plaintiff’s competitors, such as Expedia and Travelocity, have no incentive to describe themselves as “booking.coms” because this risks diverting customers to the website of their competitor. In short, there is no evidence in this record indicating that permitting registration of a domain names with a generic SLD would result in the monopolization of descriptive terms that must be left free for public use.

Recognizing that the policy concerns regarding generic terms are a poor fit for marks comprised of a generic SLD and a TLD, the next question is whether the dual purposes of the Lanham Act—protecting consumers and incentivizing brand development—militate for or against protection. Generally, the consumer protection rationale favors trademark protection because brands minimize the information costs of purchasing decisions. Qualitex, 514 U.S. at 164. Although trade-

tion, this concern applies equally to personal names and alphanumeric telephone numbers, both of which are eligible for trademark protection. See 1 McCarthy on Trademarks §§ 7:13, 7:17.50, 13:1.

mark rights are disfavored when they would cause consumer confusion or impede competition, Am. Online, 243 F.3d at 821, because domain names are inherently unique and the scope of protection afforded to a domain name with a generic SLD will be narrow, the risk of consumer confusion or anticompetitive monopolies is remote. Rather, the evidence in this record shows that consumers are primed to perceive a domain name as a brand which militates for, not against, trademark protection for domain names. In addition, because online goods and services are a significant and ever-growing part of the economy, granting trademarks to producers who primarily offer goods and services online and brand themselves based on their domain name favors the interest of consumers by limiting the prospect of deception and confusion. Incidentally, this also protects the good will generated by producers, often at great effort and expense, and thereby incentivizes brand development.¹¹ In sum, the rationales animating the Lanham Act are aligned with the conclusions that TLDs are generally source identifying and that a mark composed of a generic SLD and a TLD is a descriptive mark eligible

¹¹ At first glance, it may not be immediately apparent why plaintiff, which uses a unique domain name as its mark, needs trademark protection; however, in the absence of protection, competitors could capitalize on plaintiff's goodwill by expropriating its brand identifiers by, for example, adopting a similar domain name and using the stylized elements of plaintiff's mark or advertising with a hyperlink labeled "Booking.com" that opened a different domain name. Without trademark protection, plaintiff might have some recourse in unfair competition and related torts, but outcomes in this area of law are difficult to predict and leave much to judicial discretion, see 1 McCarthy on Trademarks § 1.11, increasing plaintiff's business risk and leaving consumers more vulnerable to misinformation regarding plaintiff's brand.

for protection upon a showing of acquired distinctiveness.

iii. Evidence of Public Understanding Regarding Genericness

The Court now considers evidence of the public's understanding of BOOKING.COM, which may include "purchaser testimony, customer surveys, dictionary listings, newspapers, and other publications." Retail Servs., 247 F. Supp. 2d at 826. The most striking feature of the evidence in this record is the absence of evidence that consumers or producers use the term "booking.com" to describe the genera of services at issue, that is, hotel and travel reservation services. Pl. Mem. at 12. Defendants point to no purchaser testimony, consumer surveys, newspaper articles, websites, or other publications demonstrating that either the consuming public or plaintiff's competitors refer to travel and hotel reservation services offered online as "booking.coms." See Dial-a-Mattress, 240 F.3d at 1346. Instead, they rely heavily on a statement from the Federal Circuit that use "is irrelevant" and "the correct inquiry is whether the relevant public would understand, when hearing the term 'mattress.com,' that it refers to online mattress stores." Def. Mem. at 13 (citing 1800Mattress.com, 586 F.3d at 1364 (emphasis added)); see also Def. Opp. at 7, 18; Def. Reply at 13. In reaching this conclusion, the Federal Circuit cited H. Marvin Ginn v. Int'l Ass'n of Fire Chiefs, Inc.'s genericness test, which asks whether the "relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." 782 F.2d 987, 989-90 (Fed. Cir. 1986) (emphasis added). But 1800Mattress.com is not controlling authority, and the Fourth Circuit

has not adopted H. Marvin Ginn's test for genericness. In addition, even under this test, whether a mark is used to refer to a genus is certainly relevant; it simply is not dispositive. Importantly, in this de novo proceeding, the evidence before the Court indicates that “[l]inguistic understanding is not some further mental condition”; rather, in the words of Ludwig Wittgenstein, “meaning is use.” Leslie Rep., Pl. Ex. 2 [Dkt. No. 64-2] ¶ 78 (citing Philosophical Investigations § 43 (1953)).¹² Accordingly, the absence of evidence indicating that the consuming public uses the term BOOKING.COM to refer to a class of services, is highly relevant.

What evidence defendants have produced shows that the types of services offered by plaintiff are routinely referred to as “booking website(s),” “booking site(s),” etc. Def. Mem. at 21. According to defendants, “these same meanings are immediately conveyed by the term ‘booking.com,’” id. at 22; however, they offer no support for the argument that any composite term that communicates the same meaning as a generic term is itself generic. Id. Further, because domain names are unique, the Court is unpersuaded that BOOKING.COM has the same meaning as “a booking website” or “booking web-

¹² Defendants contend that the report of plaintiff’s linguistics expert, Dr. Sarah-Jane Leslie, must be excluded because her research on generics in the field of linguistics has no bearing on generics in the domain of trademark and is therefore inadmissible under Rule 702. Def. Mem. at 27. Although Dr. Leslie’s opinion is not relevant as legal expertise, her robust knowledge of linguistics is certainly relevant to the ultimate inquiry, which, as explained by Judge Learned Hand, “is merely one of fact: what do buyers understand by the word for whose use the parties are contending?” Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).

sites,” both of which could refer to any number of websites. Cf. Dial-a-Mattress, 240 F.3d at 1346 (“[A] phone number is not literally a genus or a class name.”).

Defendants also point to fifteen third-party websites that include “booking.com” or “bookings.com.” Def. Mem. at 23; PTO-0148-65 (identifying examples such as “dreamvacationbooking.com”; “vacationhomebooking.com”; and “bhutanbookings.com”). This evidence is unpersuasive because including the characters “b-o-o-k-i-n-g-.c-o-m” in a longer domain name is not the equivalent of describing one’s service as a “booking.com.” Indeed, a brief review of these websites indicates that they do not describe themselves as such.¹³ Moreover, accepting the defendants’ logic would result in privileging trademark protection for long SLDs over short ones simply because a shorter domain name’s set of characters is likely to be included in longer domain names. This is not the USPTO’s practice, as evidenced by its registration of marks like WORKOUT.COM, ENTERTAINMENT.COM, and WEATHER.COM notwithstanding the multitude of other domain names that uses these strings of characters. Therefore, the Court finds that defendants’ list of domain names does not constitute evidence that BOOKING.COM is used to refer to a genus of services.¹⁴

¹³ Defendants only included printouts of the websites’ home pages in their exhibits. To understand the context of this evidence, the Court visited the websites and reviewed each page to see how the proprietors of the sites described their services. None of the sites describes their services as a “booking.com,” rather they describe themselves using proper nouns, such as “Vacation Home Booking.”

¹⁴ In support of their argument, defendants cite Reed Elsevier, 482 F.3d at 1380, in which the Federal Circuit found that eight third-

Conversely, plaintiffs have adduced persuasive evidence that the consuming public understands BOOKING.COM to be a specific brand, not a generic name for online booking services. In particular, plaintiff produced a Teflon survey which revealed that 74.8 percent of respondents identified BOOKING.COM as a brand name. Poret Rep. at 29. Teflon surveys, which are the “most widely used survey format to resolve a genericness challenge,” 2 McCarthy on Trademarks at § 12:16, provide survey respondents with a primer on the distinction between the generic or common names and trademark or brand names, and then present respondents with a series of names, which they are asked to identify as common or brand names. Plaintiff’s survey was conducted by Hal Poret, a statistician with experience administering over 200 consumer surveys regarding trademarks. The survey was administered online to 400 respondents from March to April 2016. Poret Rep., Pl. Ex. 1 [Dkt. No. 64-1] at 8, 18, 25.

The survey began by explaining the distinction between “brand names” and “common names” and provided consumers with examples of three brand names (TOYOTA, CHASE, and STAPLES.COM) and three common names (AUTOMOBILE, BANK, and OFFICESUPPLIES.COM). Id. at 9. The survey then tested consumer’s understanding of the distinction between common and brand names by asking them to identify whether KELLOGG and CEREAL

party websites containing “lawyer.com” in their domain names supported the finding that LAWYERS.COM was generic. Def. Mem. at 23. Based on the reasoning set forth above, most notably the deferential standard of review applicable in the Federal Circuit, the Court finds Reed Elsevier unpersuasive.

were common or brand names. Id. at 10. Respondents who correctly answered that KELLOGG is a brand name and CEREAL is a common name continued with the survey while those who did not were excluded. Id. at 11. Following that initial screening, respondents were shown a series of terms, one at a time, and for each term were asked to answer the following question:

- “Do you think this is a . . .
 - Brand name
 - Common name
 - Don’t know”

Id. The list of terms and product descriptions shown to respondents were

- The term at issue:
 - “BOOKING.COM (Hotel and other lodging reservation services)”
- Three brand names:
 - “ETRADE.COM (Stock and investor broker services)”
 - “PEPSI (Cola and other soft drinks)”
 - “SHUTTERFLY (Photo-sharing and photo gift services)”
- Three common names
 - “SPORTING GOODS (Products used in sports and other physical activity)”
 - “WASHINGMACHINE.COM (Review and sales of washing machines)”

- “SUPERMARKET (Retail sale of food and other groceries)”

Id. at 11-13. There were four separate rotations in which these terms were presented to the respondents, in each of which the terms were ordered differently and with BOOKING.COM placed in a different position on the rotation “so as not to bias the responses to the term BOOKING.COM.” Id. at 13-14. There were also two versions of the survey language, one in which the phrase “brand name” always preceded the phrase “common name” (i.e., “This survey is about brand names and common names.”) and one in which this order was reversed. Id. at 9, 15. The following table displays the proportion of respondents who identified each trademark as a brand name versus a common name, compared to BOOKING.COM:

	BOOKING.COM	PEPSI	ETRADE.COM	SHUTTER-FLY
Brand name	74.8%	99.3%	96.8%	96.8%
Common name	23.8%	0.8%	3.0%	3.0%
Don't know	1.5%	0.0%	0.3%	0.3%

Id. at 28. The following table displays the proportion of respondents who identified each generic term as a brand name versus a common name, compared to BOOKING.COM:

	BOOKING.COM	SUPER-MARKET	SPORT-ING GOODS	WASHING-MACHINE.COM
Brand name	74.8%	0.0%	0.5%	33.0%
Common name	23.8%	100.0%	99.5%	60.8%
Don't know	1.5%	0.0%	0.0%	6.3%

Id. Poret concluded that in his opinion “these results strongly establish that BOOKING.COM is not perceived by consumers to be a generic or common name.” Id. at 29; see also E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc., 393 F. Supp. 502, 527 (E.D.N.Y. 1975) (finding that survey results indicating that 68% of consumers viewed Teflon as a brand name rebutted the claim that the mark was generic).

Defendants argue that plaintiff’s Teflon survey should be excluded pursuant to Hunt Masters, 240 F.3d at 255, where the Fourth Circuit held that in a genericness inquiry consumer surveys are not relevant “where a term was commonly used prior to its association with the products at issue” whereas surveys are relevant where the term at issue “began life as a ‘coined term.’” Def. Opp. at 12. Although “booking” is not a coined term, BOOKING.COM arguably is. More importantly, defendants have presented no evidence that BOOKING.COM is in the category of marks for which Hunt Masters forecloses reliance on consumer surveys, namely that it “was commonly used prior to its association with

the products at issue.” Id. Moreover, the Court finds that because domain names marks are relatively new to trademark law, public understanding is highly relevant to understanding how these marks are perceived. As a result, this case is not on all fours with Hunt Masters and plaintiff’s Teflon survey, which sheds light on how the composite mark BOOKING.COM is understood by consumers, is highly relevant.¹⁵

Defendants next attack the methodological soundness of plaintiff’s survey as a basis for excluding the report. Def. Opp. at 13. Defendants rely primarily on a comment by Poret, posted in a blog by a colleague in 2009, in which he remarked that because consumers often assume that domain names have source identifying significance, surveys testing TLD marks should be composed exclusively or primarily of TLD marks. Def. Ex. A at PTO-00366. During his deposition, Poret explained that he has since revised his views. Recognizing that consumers conventionally encounter an array of marks, including TLD and non-TLD marks, Poret is now of the opinion that it is unnatural to test brand recognition with only TLD marks. Poret Tr., Pl. Ex. A [Dkt. No. 72-1] at 18:8-19:21. Defendants make much of this change of opinion but point to no case law, scholarly authority, or principled justifications for conducting Teflon surveys comprised exclusively or even

¹⁵ Hunt Master’s holding has been criticized by the leading trademark treatise, which argues that by categorizing marks as coined or non-coined before determining the relevance of survey evidence, “[t]he Fourth Circuit assumed that which was to be decided. . . . It is an audacious thing for a court to state that consumer perception is irrelevant when the issue is whether a designation is perceived by the consuming public as a generic name or not.” 2 McCarthy on Trademarks § 12:17.50.

primarily of TLD marks. Def. Mem. at 26-27; Def. Opp. at 14-15.

Defendants also point to three alleged methodological flaws in Poret's survey identified by their expert, Dr. Edward Blair. Blair Rep., Def. Ex. B [Dkt. No. 61-3]. First, Dr. Blair contends that the survey population is under-inclusive because it was restricted to consumers who search for or make hotel or travel reservations online but plaintiff's trademark applications also reference services offered in person. Id. at 11-13. Poret's supplemental expert response explains that the survey focused on consumers who used online reservation services because the USPTO determined that BOOKING.COM was generic for a website service, thus "measuring consumer perception of BOOKING.COM in the online context squarely tested the context in which the chance of consumers understanding a mark ending in '.COM' to be generic was greatest." Poret Supp. Rep., Def. Ex. D [Dkt. No. 61-5] at 3.

Second, although Dr. Blair concedes that the survey explained and tested the distinction between dot-com brand names and common names, he contends that this educational component was insufficient because it did not focus specifically on dot-com names and respondents were not tested on their ability to distinguish between dot-com brand names and dot-com common names. Blair Rep. at 5-6, 14. Observing that 33% of respondents incorrectly identified WASHINGMACHINE.COM, one of the test terms, as a brand name, Dr. Blair contends that the educational portion of the survey was ineffective and respondents were predisposed to think that any dot-com name was a brand name. Id. Without conceding that this is a flaw in the survey design,

Poret explains that one can control for this predisposition by removing the respondents who answered that WASHINGMACHINE.COM is a brand name. Poret Supp. Rep. at 4. Even with that adjustment, of the remaining respondents, 65 percent identified BOOKING.COM as a brand name. *Id.* at 5.

Dr. Blair's third critique is that the responses varied based on the order in which the marks were presented, which he posits is an indication that respondents did not understand the distinction between dot-com brand names and common names and were answering based on context rather than actual knowledge. Blair Rep. at 19. Poret acknowledges that the results exhibit order effects but explains that all Teflon surveys have order effects, irrespective of whether they test dot-com or other marks. Poret Supp. Rep. at 8. "[T]he very reason that [Teflon] surveys include various orderings of the terms," he elaborates, "is because it is well known and expected that responses to terms often vary in this manner" and "providing various orderings is designed to control for this phenomenon." *Id.* (emphasis in original).

The Court is persuaded by Poret's responses and finds that Dr. Blair's critiques do not undermine the veracity of the survey results. "[N]o survey is perfect." Selchow & Righter Co. v. Decipher, Inc., 598 F. Supp. 1489, 1502 (E.D. Va. 1984). Poret's decision to limit the survey to online consumers was reasonable, the method used to instruct them on the distinction between generic and brand names was sufficient, and the ordering effects are, as Poret explains, both expected and appropriately controlled for by the survey design. In short, plaintiff's Teflon survey is reliable. It also provides the only actual evidence of consumers' understanding of BOOKING.

COM, because defendants “had an equal opportunity to conduct [their] own survey but chose not to” do so. Selchow & Righter, 598 F. Supp. at 1503.

Numerous courts agree that “direct consumer evidence, e.g., consumer surveys and testimony is preferable to indirect forms of evidence” such as dictionaries, trade journals, and other publications. See, e.g., Berner Int’l Corp. v. Mars Sales Co., 987 F.2d 975, 982 (3d Cir. 1993). Even the Federal Circuit, the source of authority upon which the USPTO principally relies, has held that “consumer surveys may be a preferred method of proving genericness.” BellSouth Corp. v. DataNational Corp., 60 F.3d 1565, 1570 (Fed. Cir. 1995). Therefore, the Court declines defendants’ invitation to rely on theoretical and indirect sources of consumer understanding, such as dictionary definitions, over plaintiff’s Teflon survey.

In sum, defendants have not met their burden of proving by clear evidence that BOOKING.COM is generic. To the contrary, the Court finds that the relevant consuming public primarily understands that BOOKING.COM does not refer to a genus, rather it is descriptive of services involving “booking” available at that domain name. Dial-a-Mattress, 240 F.3d at 1346 (finding that 1-8-8-8-M-A-T-R-E-S-S “immediately conveys the impression that a service relating to mattresses is available by calling the telephone number”). And, because “booking” is a broad enough term to refer to both hotel and travel reservation services, the Court finds that BOOKING.COM is descriptive of both the Class 39 and Class 43 services described in plaintiff’s applications.

3. Acquired Distinctiveness

As with any descriptive mark, BOOKING.COM is eligible for protection only upon a showing of secondary meaning or acquired distinctiveness. See Steelbuilding.com, 415 F.3d at 1299. To make this showing, the burden shifts to the applicant to demonstrate that “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” Inwood Labs., 456 U.S. at 851 n.11. “Saying that a trademark has acquired secondary meaning is shorthand for saying that a descriptive mark has become sufficiently distinctive to establish a mental association in buyers’ minds between the alleged mark and a single source of the product.” Retail Servs., 364 F.3d at 539 (citation and internal quotation marks omitted); see also Sara Lee, 81 F.3d at 464 (noting that “secondary meaning” exists when, “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself” (internal quotation marks omitted)); Perini Corp. v. Perini Constr., Inc., 915 F.2d 121, 125 (4th Cir. 1990) (“Secondary meaning is the consuming public’s understanding that the mark, when used in context, refers, not to what the descriptive word ordinarily describes, but to the particular business that the mark is meant to identify.”).

Proof of secondary meaning requires a “rigorous evidentiary” showing and courts consider six factors: “(1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) sales success; (4) unsolicited media coverage of the product; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark’s use.” Perini, 915 F.2d at 125. Secondary

meaning exists if a “substantial portion” of the relevant consuming public associates the term with the particular business, id., and the applicant bears the burden of proof, U.S. Search, LLC v. U.S. Search.com, Inc., 300 F.3d 517, 525-26 (4th Cir. 2002).

As explained above, applications containing multiple classes are treated as separate applications, 3 McCarthy on Trademarks § 19:56.50; therefore, the Court’s analysis of the evidence of secondary meaning must assess Class 39 and 43 independently. But, in the interest of efficiency, the Court will begin by summarizing the evidence in the record.

a. Evidence of Acquired Distinctiveness

With respect to advertising, plaintiff has submitted evidence of the number of visual impressions of BOOKING.COM by consumers. Although the secondary meaning test refers to “advertising expenditures,” Perini, 915 F.2d at 125, the Court is satisfied that the number of visual impressions is equally, if not more, probative of secondary meaning because it more closely approximates the number of consumers who have been exposed to a brand. Plaintiff aired BOOKING.COM branded television commercials that received 1.3 billion visual impressions from U.S. customers in 2015 and 1.1 billion impressions in 2016. Pl. Ex. A, Dunlap Decl. ¶ 9a. Its internet advertisements during these years received 212 million and 1.34 billion visual impressions from U.S. customers, respectively. Id. ¶ 9c. And its 2015 movie theater advertisements received approximately 40 million visual impressions from U.S. customers. Id. ¶ 9b. This is compelling evidence of plaintiff’s advertising efforts and is considerably more wide-reaching than the evidence used to satisfy the first factor in other Fourth Circuit

cases. See Resorts of Pinehurst, Inc. v. Pinehurst Nat'l Corp., 148 F.3d 417, 421-22 (4th Cir. 1998) (finding that the markholder had made “considerable advertising efforts and expenditure of money toward developing a reputation and goodwill” for its mark through a “nationwide marketing campaign” that involved “placing advertisements in numerous national golf publications such as Golf and Golf Digest magazines” and aggressively “seeking out major professional golf tournaments”).¹⁶

As to the second factor, plaintiff cites two surveys. The first is a 2012 JD Power & Associates survey recognizing plaintiff as having the highest customer satisfaction rate of any travel site in the United States. Pl. Mem. ¶ 27; Pl. Opp. at 14. Defendants argue that the survey is entitled to little weight because it does not reveal anything about what consumers understand BOOKING.COM to mean. Def. Opp. at 26. Plaintiff contends that the survey is an admissible form of evidence, Pl. Opp. at 14, but admissibility is not the problem. Surveys such as the JD Power & Associates survey are designed to gauge the relative popularity of a product not the source identifying effect of the mark. As a result, defendants

¹⁶ In response, defendants argue that there “are no advertising materials that show how [p]laintiff has sought to replace, in the minds of consumers, the general descriptiveness of the term with an impression of a single-source identification.” Id. This argument is wholly without merit. First, there is no legal basis for requiring a plaintiff to produce the content of its advertising materials to prove that the public recognizes its mark as a brand. Second, this argument simply begs the question, because notwithstanding the “general descriptiveness of [a] term,” whether consumers associate “the term with an impression of a single-source identification” is the essence of the secondary meaning inquiry.

are correct in arguing that the JD Power & Associates survey is not probative of secondary meaning and is entitled to minimal weight. Chase Fed. Sav. & Loan Ass'n v. Chase Manhattan Fin. Servs. Inc., 681 F. Supp. 771, 780-81 (S.D. Fla. 1987) (explaining that survey evidence is entitled to “slight weight” when it “derive[s] from questions that were not asked in a specific, limited and probative context, . . . and did not probe the primary significance of the term” (internal quotation marks omitted)).

Plaintiff also relies on the Teflon survey conducted by Poret, which indicated that 74.8 percent of consumers of online travel services recognize BOOKING.COM as a brand. Pl. Mem. ¶ 4; *id.* at 29. Although primarily used to determine whether a mark is generic, Teflon surveys are also a generally accepted way of measuring secondary meaning. See, e.g., Firefly Digital, Inc. v. Google, Inc., No. CIV.A. 6:10-0133, 2011 WL 6160222, at *5 (W.D. La. July 7, 2011); Schwan's IP, LLC v. Kraft Pizza Co., 379 F. Supp. 2d 1016, 1024 (D. Minn. 2005), *aff'd*, 460 F.3d 971 (8th Cir. 2006); March Madness Athletic Ass'n L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 809 (N.D. Tex. 2003), *aff'd*, 120 F. App'x 540, 2005 WL 147264 (5th Cir. Jan. 24, 2005); see also Innovation Ventures, LLC v. NVE, Inc., 90 F. Supp. 3d 703, 720 (E.D. Mich. 2015) (finding a Teflon survey probative of the strength of a protectable mark). In this Circuit, “survey evidence is generally thought to be the most direct and persuasive way of establishing secondary meaning.” U.S. Search, LLC, 300 F.3d at 526 n.13. And Professor McCarthy has identified survey evidence as one of a handful of types of direct evidence of consumer understanding—along with consumer testimony—as compared to the other secondary meaning factors,

which offer circumstantial evidence of brand recognition. 2 McCarthy on Trademarks § 15:30. Because plaintiff's Teflon survey is the only evidence in the record that speaks directly to how consumers understand plaintiff's mark, it weighs heavily in the secondary meaning analysis and the survey's finding that approximately three out of four consumers recognize BOOKING.COM as a brand indicates strong brand awareness. See IDV N. Am., Inc. v. S & M Brands, Inc., 26 F. Supp. 2d 815, 823 (E.D. Va. 1998) (holding that BAILEYS liqueurs had secondary meaning, based in part upon a "51% consumer awareness rating").

The third factor, record of sales success, is also well-established. Plaintiff's public filings reflect that its U.S. customers conduct billions of dollars' worth of transactions each year, Pl. Mem. ¶ 13,¹⁷ and, as of 2013, plaintiff's total transaction value, both in the United States and abroad, was over \$8 billion, see Prakke Decl., A2522, which is substantially higher than the sales success in other cases where courts in this Circuit have found secondary meaning. See, e.g., Worsham Sprinkler Co. v. Wes Worsham Fire Prot., LLC, 419 F. Supp. 2d 861, 869-72 (E.D. Va. 2006) (citing annual revenues averaging \$18-20 million); IDV N. Am., Inc., 26 F. Supp. 2d at 823 (finding that BAILEYS liqueurs' \$1 billion in sales over the course of a decade supported a finding of secondary meaning). In addition, plaintiff's mobile app,

¹⁷ BOOKING.COM annual sales revenues and gross transaction value for the last three years were filed under seal because this information is "competitively valuable and commercially sensitive, and its disclosure is likely to cause harm to the competitive position of Booking.com." [Dkt. No. 67] at 2. The Court is satisfied, based on its review of the sealed filings, that Booking.com has presented compelling evidence of sales success.

which can be used to search for hotels and make reservations, was downloaded approximately 1 million times in 2014, 1.9 million times in 2015, and 2.5 million times in 2016, Pl. Ex. A, Dunlap Decl. ¶ 7, which offers additional, circumstantial evidence of sales success and consumer brand recognition.

The fourth factor is unsolicited media coverage. In 2015 and 2016 the number of news articles published in the United States referencing BOOKING.COM was over 600 and 650, respectively. Pl. Ex. A, Dunlap Decl. ¶ 10. This compares very favorably to other cases where courts have found that media coverage demonstrated that a brand had achieved public prominence. Washington Speakers Bureau, Inc. v. Leading Authorities, Inc., 33 F. Supp. 2d 488, 496-97 (E.D. Va. 1999), aff'd, 217 F.3d 843 (4th Cir. 2000) (relying on evidence that a “news database search offered by [the markholder] disclosed hundreds of articles specifically referring to [the service] and its activities”).

Plaintiff identifies no evidence of the fifth factor, attempts to plagiarize the mark. Pl. Mem. at 29. But, a party need not prove all six factors and the Fourth Circuit has concluded that secondary meaning can exist even when “no attempts to plagiarize the mark were shown.” Perini, 915 F.2d at 126.

With respect to the sixth factor, length and exclusivity of use, plaintiff, which has been offering “online hotel reservation service” since 1996, operated from “1996 to June 2006 using the mark BOOKINGS. In June 2006, [plaintiff] modified its mark to BOOKING.COM and has been providing services under that mark since then.” Prakke Decl. A2522. Eleven years of uninterrupted use, in conjunction with the other factors, weighs in favor of

secondary meaning. See Teaching Co. P'ship v. Unapix Entm't, Inc., 87 F. Supp. 2d 567, 579-80 (E.D. Va. 2000) (finding that secondary meaning existed in a mark that had been used without interruption for eight years).

In addition, there is no evidence in the record that “any other party offering travel agency services refers to itself as a ‘Booking.com.’” Pl. Ex. C, Moskin Decl. ¶ 12. As previously discussed in the genericness evaluation, defendants point to fifteen third-party websites that include “booking.com” or “bookings.com,” Def. Mem. at 23, and one might argue that this is evidence that plaintiff has not enjoyed exclusive use. This argument fails because the mere existence of a registered domain name or even a website does not equate to its use as a “mark.” “[A] domain name does not become a trademark or service mark unless it is also used to identify and distinguish the source of goods or services.” 1 McCarthy on Trademarks § 7:17.50. Out of the millions of domain names, only a fraction play the role of a mark. Id. Indeed, the websites associated with the domain names cited by the defendants identify their services not by reference to their domain name but by phrases such as “Dream Vacation Booking” and “Vacation Home Booking.” Further, as explained above, these websites are not actually referring to themselves as “booking.coms,” therefore they are not using the term either descriptively or as a mark.

Finally, plaintiff has adduced evidence of its substantial social media following. As of 2016, over 5 million consumers had “liked” BOOKING.COM on Facebook

and over 100,000 “followed” BOOKING.COM on Twitter. Pl. Ex. A, Dunlap Decl. ¶ 12c.¹⁸ Although this evidence does not directly relate to any of the Perini factors, those factors are non-exhaustive, Shammas v. Rea, 978 F. Supp. 2d 599, 612 (E.D. Va. 2013), and, just as unsolicited media coverage offers circumstantial evidence of consumer awareness of a brand, the size of a producer’s social media following is indicative of the number of consumers who are familiar with a brand, interested in receiving additional information about it, and presumably tend to feel goodwill toward the producer.

In the face of this evidence, defendants argue that “although [p]laintiff has provided documents related to its commercial success, they do not demonstrate actual market recognition of ‘booking.com’ as a source indicator.” Def. Mem. at 30. This argument ignores the direct evidence of consumer understanding established by plaintiff’s Teflon survey and appears to challenge the very nature of the secondary meaning test, which acknowledges that five of the six factors—advertising expenditures, sales success, media coverage, attempts to plagiarize, and exclusivity of use—are all circumstantial evidence. 2 McCarthy on Trademarks § 15:30. Professor McCarthy acknowledges direct evidence “is not a requirement and secondary meaning can be, and most often is, proven by circumstantial evidence.” Id. In addition, it defies logic to suggest that billions of consumer impressions through advertising, billions of dollars in sales, and over 1,000 newspaper articles have no

¹⁸ This number likely includes a number of non-U.S. consumers, but even if only a fraction of these consumers were in the United States, this data point would still indicate widespread awareness among U.S. consumers.

bearing on whether consumers understand BOOKING.COM to be a source of reservation services.¹⁹

b. Class Specific Analysis

Having summarized the evidence of secondary meaning, the next step is to consider what this evidence means for the two classes of marks set forth in plaintiff's applications. Unfortunately, the evidence does not clearly differentiate between Class 39—travel agency services—and Class 43—hotel reservation services. Plaintiff's evidence often speaks simply of BOOKING.COM, and, where it does differentiate, it refers only to plaintiff's hotel reservation services. For example, the Dunlap Declaration, which is the source of plaintiff's evidence regarding advertising, sales success, and unsolicited media coverage, describes plaintiff as “the worldwide leader in online accommodation reservation services” and reports that plaintiff enables customers to make reservations at over “1,027,450 hotels and accommodation providers throughout the world.” Pl. Ex. A, Dunlap Decl. ¶¶ 3, 5. Other than referencing Booking.com's receipt of the “World's Leading Online Travel Agency Website” award in 2014 and 2015, Dunlap's declaration makes no reference to travel agency services.

¹⁹ Defendants also argue that “[u]se of a company name does not demonstrate consumer recognition as a brand.” Def. Mem. at 30. Defendants identifies no legal basis for drawing a distinction between a company name and a brand, nor is the Court aware of any. See Sara Lee, 81 F.3d at 464 (recognizing that EXXON, POLAROID, and APPLE, all the names of major companies, are also brands). Such a distinction might make sense in certain contexts. For example, consumer recognition of the company name Procter & Gamble would not necessarily be probative of consumer recognition of its brands, such as DAWN for dish soap. But, here, the company name and the brand name BOOKING.COM are one and the same.

In addition, the Pranke Declaration, which establishes the length and exclusivity of use, also portrays Booking.com as an “online hotel reservation service,” explaining that since 1996 plaintiff has been “providing hotels and consumers alike with an 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.” A2522. Likewise, plaintiff’s Teflon survey characterized Booking.com as providing “[h]otel and other lodging reservation services.” Pl. Ex. 1, [Dkt. No. 64-1] at B-000055. In light of the total absence of evidence that either the consuming public, or even Booking.com’s officers, associate BOOKING.COM with travel agency services, plaintiff has failed to carry its burden of establishing secondary meaning as to Class 39.²⁰

Conversely, the record demonstrates strong evidence of secondary meaning for Class 43 on five of the six secondary meaning factors: Plaintiff has established the existence of an extensive nationwide advertising campaign; a strong public perception that BOOKING.COM is a brand identifier, as evidenced by the Teflon survey; robust consumer sales; voluminous unsolicited media coverage; and a decade of exclusive use. This evidence is more than sufficient to demonstrate that “in the minds of the public, the primary significance of” BOOKING.COM “is to identify the source of the product rather than the product itself,” Sara Lee, 81 F.3d at 464, and

²⁰ Plaintiff briefly argues that the mark BOOKING.COM is suggestive. Pl. Mem. at 28; Pl. Opp. at 11-2. A suggestive mark is one that is “partially descriptive and partially fanciful.” Perini, 915 F.2d at 124. Plaintiff does not make a serious attempt to substantiate this claim, therefore the Court has not addressed it.

that plaintiff's mark is entitled to protection for the services identified in Class 43, as a descriptive mark.²¹

III. CONCLUSION

The question of whether a TLD has source identifying significance is a question of first impression in this Circuit. After carefully reviewing the Federal Circuit's precedent on this issue, the purposes of the Lanham Act, and the competition-protecting features built into the structure of trademark law, the Court has concluded both that a TLD generally has source identifying significance and that a mark composed of a generic SLD and a TLD is usually a descriptive mark eligible for protection upon a showing of secondary meaning. Applying these holdings to the facts of this case, the Court holds that BOOKING.COM is a descriptive mark and that plaintiff has 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.

For these reasons, in an order to be issued with this Memorandum Opinion, plaintiff's Motion for Summary Judgment will be granted in part and denied in part, defendants' Motion for Summary Judgment will be granted in part and denied in part, the USPTO will be ordered to register BOOKING.COM as to the Class

²¹ Documents in the record indicate that plaintiff has trademark registrations in the United Kingdom and New Zealand that are only for Class 43, although there is no evidence as to whether plaintiff sought protection for Class 39. A1557-60. In the European Union, Booking has registered its mark in Classes 35, 39, and 43. A1548-53.

43 services in the '998 Application and '097 Application,²² and the Court will remand applications '365 and '366 to the USPTO for further administrative proceedings consistent with the findings and conclusions of this Memorandum Opinion to determine whether the design and color elements in those two applications, in combination with the protectable word mark, are eligible for protection as to the Class 43 services.²³

Entered this 9th day of Aug., 2017.

Alexandria, Virginia

/s/ LMB
LEONIE M. BRINKEMA
United States District Judge

²² The '998 Application sought registration for BOOKING.COM in standard characters, as to the Class 43 services, therefore the Court's analysis of the wordmark is sufficient to conclude that it is entitled to protection. A1-6. The '097 Application involved design elements, specifically "a stylized depiction of the earth behind a briefcase," and the examiner and the TTAB both found that the stylized elements of the mark were registrable if plaintiff disclaimed the word mark. A3765-66, A3801. Inferring that this requirement demonstrates that the USPTO concluded that the stylized elements of the mark were eligible for protection, the USPTO will also be ordered to grant the '097 Application as to the Class 43 services.

²³ Both the '365 Application and '366 Application include design elements. The '365 application includes a specific font, with "Booking" in dark blue and ".com" in light blue, A2088-89, and the '366 application includes the same font enclosed in a dark blue colored box with the word "Booking" in white and ".com" in light blue, *id.* The TTAB concluded that these design and color elements were "not, in themselves, distinctive and that they therefore do not justify registration of the mark." A2122 (emphasis added).

APPENDIX C

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

No. 1:16-cv-425 (LMB/IDD)

BOOKING.COM B.V., PLAINTIFF

v.

JOSEPH MATAL, PERFORMING THE FUNCTION AND
DUTIES OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
ET AL., DEFENDANTS

[Filed: Oct. 26, 2017]

MEMORANDUM OPINION

This case involves plaintiff Booking.com B.V.'s ("Booking" or "plaintiff") appeals of the United States Patent and Trademark Office's ("USPTO" or "defendants") refusal to register four marks consisting of or containing the term BOOKING.COM,¹ which were affirmed by the Trademark Trial and Appeal Board ("TTAB") in three separate opinions. See Mem. Op. at 4-5 [Dkt. No. 87]. The parties submitted the issues on

¹ The four trademark applications at issue were Serial No. 85485097 (the "'097 Application"); Serial No. 79114998 (the "'998 Application"); Serial No. 79122365 (the "'365 Application"); and Serial No. 79122366 (the "'366 Application").

cross motions for summary judgment, which were partially granted in plaintiff's favor by an order directing the USPTO to register plaintiff's marks in the '998 and '097 Applications, and remanding the '365 and '366 Applications for further administrative proceedings consistent with the Memorandum Opinion [Dkt. No. 88]. That decision is at issue in defendants' Motion to Amend Judgment [Dkt. No. 94] and defendants' Motion for Expenses Pursuant to 15 U.S.C. § 1071(b)(3) [Dkt. No. 98] which are before the Court. The motions have been fully briefed. Finding that oral argument will not assist the decisional process, the motions will be resolved on the materials submitted.

I. DISCUSSION

A. Defendants' Motion to Amend Judgment

1) Standard of Review

Motions to alter or amend final judgments under Fed. R. Civ. P. 59(e) are discretionary and "need not be granted unless the district court finds that there has been an intervening change of controlling law, that new evidence has become available, or that there is a need to correct a clear error or prevent manifest injustice." Robinson v. Wix Filtration Corp., 599 F.3d 403, 411 (4th Cir. 2010). Reconsideration "is an extraordinary remedy that should be applied sparingly." Mayfield v. Nat'l Ass'n for Stock Car Auto Racing, Inc., 674 F.3d 369, 378 (4th Cir. 2012). "[M]ere disagreement does not support a Rule 59(e) motion." United States ex rel. Becker v. Westinghouse Savannah River Co., 305 F.3d 284, 290 (4th Cir. 2002) (quoting Hutchinson v. Staton, 994 F.2d 1076, 1082 (4th Cir. 1993)).

2) Analysis

The USPTO seeks a modification to the Order issued on August 9, 2017 [Dkt. No. 88], which required the USPTO to “register plaintiff’s marks in the ’998 Application and ’097 Application as to the Class 43 services.” It argues that the Court does not have authority to direct the USPTO to register a trademark because that duty is imposed on the Director of the USPTO by statute. See Def.’s Mot. to Amend at 3 (citing Gould v. Quigg, 822 F.2d 1074, 1079 (Fed. Cir. 1987)). Further, it points out that the USPTO cannot statutorily register a mark without publishing the application for opposition, under 15 U.S.C. § 1062(a). Id. It requests that the Court alter its judgment to remand the ’998 and ’097 Applications to the USPTO for “further administrative proceedings consistent with the findings and conclusions of the Court’s memorandum opinion.” Id.

Booking agrees that the Court cannot order the USPTO to register the mark, but responds that there are no further “administrative proceedings,” and the only course of conduct open to the USPTO is to publish the marks for opposition. Pl.’s Partial Opp. to Mot. Amend at 2 [Dkt. No. 97]. Booking argues that because the Court addressed all issues of fact and law with respect to the two Applications, there is nothing left for the agency to consider and it must follow its statutory mandate to publish the marks for opposition. Id. at 2-3.

Booking has the better argument. Under 15 U.S.C. § 1062(a), once an examiner determines that a trademark application appears to be entitled to registration, “the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office.”

15 U.S.C. § 1062(a) (emphasis added). Moreover, the USPTO's Trademark Manual of Examining Procedure ("TMEP") § 1708, provides that "[t]he Director has no authority to waive or suspend the requirement of a rule that is also a requirement of the statute." TMEP § 1708. The clear statutory requirement, based on this Court's determination that the '998 and '097 Applications are entitled to protection is to move forward and publish the marks for opposition.

This view as to the appropriate procedure is supported by the Federal Circuit's decision in In re Wella A.G., 858 F.2d 725 (Fed. Cir. 1988). In that case, the Federal Circuit reversed the refusal of the TTAB to register a trademark because the court found that the TTAB had misinterpreted § 2(d) of the Trademark Act and held that "the only issue for the [TTAB] to consider on the remand is whether, considering all the circumstances, there is a likelihood of confusion between the mark sought to be registered and the four Wella U.S. marks which under section 2(d) would warrant refusal of registration." Id. at 726. After the case was remanded, the TTAB denied registration on a new and separate ground that the applicant was not the owner of the mark, based on "additional views" of another judge appended to the opinion. Id. at 727. The applicant appealed again, and the court held that in refusing the mark on a new ground that had not been raised in the prior administrative proceeding or in the first appeal, the TTAB failed to carry out the court's instructions. Id. at 728.

In this case, the Court has gone further than the Federal Circuit did by determining that both the '998 and '097 Applications are eligible for protection under the

Trademark Act. See Mem. Op. at 50; see also Swatch AG v. Beehive Wholesale, LLC, 739 F.3d 150, 155 (4th Cir. 2014) (finding that in de novo review of USPTO decisions, the district court acts as trier of fact). Given those conclusions, the USPTO may not reconsider the factual findings or try to determine new grounds to refuse registration of the marks, but must proceed with the next statutory step in the registration process by publishing the two marks for opposition. 15 U.S.C. § 1062(a).

The issues involved in the cases defendants cite for the proposition that the Court's authority is limited to remanding the Applications to the agency for further action consistent with the corrected legal standards are distinguishable. For example, in PPG Industries, Inc. v. United States, the D.C. Circuit explained that there is no principal of administrative law that restricts an agency from reopening proceedings to take new evidence after the grounds on which it relied are found to be invalid. 52 F.3d 363, 365 (D.C. Cir. 1995). The court held that the agency should be allowed to take new evidence to determine whether its jurisdictional decision was valid. Id. at 366. Here, there is no new evidence for the USPTO to take on the issue of eligibility for registration of the '998 or '097 Applications. As agreed by the parties, the Court resolved all factual disputes in making its ruling on summary judgment. See Mem. Op. at 6 & n.2 (“[I]n a civil action under § 1071(b), the district court reviews the record de novo and acts as the finder of fact.”).

In certain situations, remand for further administrative action is appropriate, as when the agency in ques-

tion is vested with discretion in its chosen course of conduct. See NLRB v. Food Store Emps. Union, Local 347, 417 U.S. 1, 10-11 (1974) (holding that remand is proper “when a reviewing court concludes that an agency invested with broad discretion to fashion remedies has apparently abused that discretion by omitting a remedy justified in the court’s view by the factual circumstances”). See also FCC v. Pottsville Broadcasting Co., 309 U.S. 134 (1940), in which the plaintiff initially appealed the FCC’s denial of its application to construct a broadcasting station. Id. at 139-40. The D.C. Circuit reversed the FCC’s decision and remanded the matter back to the agency for further proceedings. Id. at 140. On remand, the FCC decided to hear argument on plaintiff’s application along with argument on two other applications that had been filed after the plaintiff’s to determine which, “on a comparative basis in the judgment of the Commission will best serve [sic] public interest.” Id. Although the plaintiff objected that the FCC’s conduct violated the remand and sought a writ of mandamus ordering the FCC to consider its application irrespective of the other two applications, the Supreme Court rejected this argument, holding that the only questions that had been determined in the original proceedings were legal questions and that the FCC was statutorily charged with “the duty of judging application[s] in the light of ‘public convenience, interest, or necessity.’” Id. at 145. The Court held that it was improper for a court to make these decisions whereas the FCC was duty bound to enforce the legislative policy committed to its charge. Id. In contrast with the duty of the FCC in Pottsville Broadcasting, the only option available to the USPTO based on the findings of this Court is to publish the marks for opposition because all

factual issues of eligibility have been resolved, and therefore the “legislative policy” of the USPTO is to publish the marks. See 15 U.S.C. § 1062(a).

Indeed, the USPTO has not identified any other proceeding or administrative procedure that it would need to undertake before publishing the marks. Its only argument is that the agency still has discretion to determine the manner and timing of further proceedings. See Def.’s Reply at 3. Defendants argue that the agency still retains discretion to “determine the manner and timing” of its own proceedings, citing 37 C.F.R. § 2.67, which allows the USPTO to suspend its actions “for a reasonable time for good and sufficient cause.” See Def.’s Mot. to Amend at 5. “The fact that a proceeding is pending before the Patent and Trademark Office or a court which is relevant to the issue of registrability of the applicant’s mark . . . will be considered prima facie good and sufficient cause.” 37 C.F.R. § 2.67. The USPTO claims that it does not act on orders involving applications or registrations until the time for an appeal has elapsed, and that this constitutes sufficient cause for it to delay publication of the marks at issue. Def.’s Reply [Dkt. No. 101] at 3.

This argument is unpersuasive. The regulation only states that actual pendency of a proceeding before the Patent and Trademark Office constitutes sufficient cause. Until the USPTO or the Solicitor General chooses to file an appeal, there is no pending proceeding. The USPTO points to no authority which holds that the government’s own internal deliberations constitute “proceedings” within the meaning of the regulation. Should the USPTO file an appeal to the Fourth Circuit, there would

be a pending proceeding sufficient to justify delaying any action by the agency.

In its opposition, Booking argues that the judgment should be amended to order USPTO to publish all four Applications, including the '365 and '366 Applications, for opposition. This ignores the Court's findings with respect to those two separate Applications. Section 1062(a) only requires the USPTO to publish marks for opposition after the examiner has determined that it appears the mark is "entitled to registration, or would be entitled to registration upon the acceptance of the statement of use." Here, the Court did not find that the '365 and '366 Applications were entitled to registration. Instead, the Court specifically remanded those Applications to the USPTO for administrative proceedings "to determine whether the design and color elements in those two applications, in combination with the protectable word mark, are eligible for protection as to the Class 43 services." See Mem. Op. at 50-51 & n.23.² There was no determination that these Applications should be registered. Because Booking offers no argument as to why the judgment with respect to the '365 or '366 Applications should be amended, the Court declines to amend the judgment in this manner.

Further, as the USPTO points out, if Booking's response is intended as a separate motion to amend the judgment under Rule 59(e), it is untimely. Rule 59(e) allows for a motion to amend to be filed no later than 28 days after the entry of the judgment; under Rule 6,

² Both the '365 and '366 Applications include design elements that the TTAB concluded were "not in themselves, distinctive and that they therefore do not justify registration of the mark." A2122.

this time may not be extended. The judgment was entered on August 9, 2017. [Dkt. No. 88]. Booking filed its response on September 13, 2017, which is over the 28 day time period to file such a motion. For these reasons, defendants' Motion to Amend Judgment [Dkt. No. 94] will be granted only as to amending the judgment to direct that the '998 and '097 Applications be immediately published in the Official Gazette of the Patent and Trademark Office and denied in all other respects.

B. Motion for Expenses

The USPTO has also moved for an order pursuant to 15 U.S.C. § 1071(b)(3) requiring Booking to pay \$76,873.61, which reflects the USPTO's "expenses of the proceeding." Def.'s Mot. Expenses at 1-2.³ The USPTO argues that these "reasonable expenses" include "the salaries of the PTO's attorney and paralegals attributed to the defense of the action," payments to expert witnesses, printing expenses, and travel expenses. *Id.* at 5. Section 1071(b)(3) provides that "all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not." The Fourth Circuit has interpreted this statute to include all of the reasonable expenses of the USPTO, including its personnel expenses, incurred during the litigation. *See Shammas v. Focarino*, 784 F.3d 219, 222-27 (4th Cir. 2015).

Booking objects to the motion, arguing that the motion for expenses violates the "American Rule;" that

³ This total amount consists of: \$1,660.05 in court reporter and transcription expenses; \$21,750.00 in expert fees; and \$51,472.53 in attorney/paralegal fees.

§ 1071(b)(3) violates the First Amendment right of access to the courts; that the requested fees are not of this proceeding and are not reasonable; and that there is no basis to require it to pay the USPTO's expert witness fees. Pl.'s Opp. to Mot. Expenses at 2-4 [Dkt. No. 102].

1. The American Rule

Booking first argues that the term “expenses” as used in § 1071(b)(3) is not specific enough to warrant departure from the American Rule, which provides that “each litigant pays his own attorney’s fees, win or lose, unless a statute or contract provides otherwise.” Hardt v. Reliance Standard Life Ins. Co., 560 U.S. 242, 252-53 (2010); In re Crescent City Estates, LLC, 588 F.3d 822, 825 (4th Cir. 2009).

Based on Fourth Circuit precedent, this argument fails. In Shammas v. Focarino, the Fourth Circuit examined a fee petition under § 1071(b)(3) and found that “in ordinary parlance, ‘expenses’ is sufficiently broad to include attorney’s fees and paralegals fees,” relying, in part, on definitions and explanations that standard legal dictionaries and treatises provide for the term “expense.” 784 F.3d at 222. Those resources include Wright & Miller on Federal Practice and Procedure which defines “expenses” as “includ[ing] all the expenditures actually made by a litigant in connection with the action,” including “attorney’s fees.” 10 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 2666 (3d ed. 1998). Similarly, Black’s Law Dictionary defines “expenses” as “expenditure[s] of money, time, labor, or resources to accomplish a result.” BLACK’S LAW DICTIONARY 698 (10th ed. 2014) (emphasis added). As the Fourth Circuit pointed out, the statute also “modified the term ‘expenses’ with the term ‘all,’ clearly indicating

that the common meaning of the term ‘expenses’ should not be limited.” Shammas, 784 F.3d at 222. Furthermore, “even though the PTO’s attorneys [are] salaried, . . . the PTO nonetheless incur[s] expenses when its attorneys [are] required to defend the [PTO] in the district court proceedings, because their engagement divert[s] the PTO’s resources from other endeavors.” Id. As a result, the Fourth Circuit held that “§ 1071(b)(3) requires a dissatisfied . . . trademark applicant who chooses to file an action in district court challenging the final decision of the PTO, to pay, as ‘all expenses of the proceeding,’ the salaries of the PTO’s attorneys and paralegals attributed to the defense of the action.” Id. at 227; see also Robertson v. Cooper, 46 F.2d 766, 767, 769 (4th Cir. 1931) (holding that, under a previous version of 35 U.S.C. § 145, the analogous patent provision, the word “‘expenses’ [includes] more than that which is ordinarily included in the word ‘costs,’” and as a result the PTO could recover an attorney’s travel expenses).

Moreover, the Fourth Circuit decided that “the American Rule [] applies only where the award of attorneys fees turns on whether a party seeking fees has prevailed to at least some degree.” Shammas, 784 F.3d at 223. The court went on to conclude “[t]hus a statute that mandates the payment of attorneys fees without regard to a party’s success is not a fee-shifting statute that operates against the backdrop of the American Rule.” Id. The Fourth Circuit relied, in part on the history of the Lanham Act to reach this conclusion, recognizing that § 1071(b)(3) originated from a similar provision in the Patent Act of 1836, and an amendment to that Act which established “a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office.” Id. at 226 (citing

Act of July 4, 1836, ch. 357, § 9, 5 Stat. 117, 121) (emphasis added). That provision demonstrates that Congress intended that the term “expenses,” as used in the Patent Act and later in the Lanham Act, contemplated that “expenses” should include the salaries of the agency employees. See id. at 226-27 (explaining that the Lanham Act incorporated the provisions of the Patent Act and allowed judicial review “under the same conditions, rules, and procedure[s] as are prescribed in the case of patent appeals or proceedings”).

Booking contends that the Fourth Circuit’s analysis in Shammas has been overruled by the recent Supreme Court decision in Baker Botts L.L.P. v. ASARCO LLC, 135 S. Ct. 2158 (2015), which addressed the proper interpretation of § 330(a)(1) of the Bankruptcy Code. That case involved determining whether the phrase “reasonable compensation for actual, necessary services,” which unquestionably allows attorneys to be compensated for services rendered in connection with the administration of a bankruptcy estate, also permits the attorneys to recover fees incurred in successfully defending their fee application. 135 S. Ct. at 2162-63. The Supreme Court held that the phrase did not authorize recovery of the fees the attorneys incurred in defending their compensation claim against the losing party, finding that deviations from the American Rule require “explicit statutory authority.” Id. at 2163 (quoting Buckhannon Bd. & Care Home, Inc. v. W. Va. Dep’t of Health & Human Res., 532 U.S. 598, 602 (2001)).

Baker Botts is not directly on point because it only interpreted provisions of the Bankruptcy Code, not the Trademark Act, see 135 S. Ct. at 2162, and its narrow holding is that § 330(a)(1) of the Bankruptcy Code does

not permit a bankruptcy court to award attorneys' fees for work performed in defending a fee application. *Id.* In contrast, the Fourth Circuit decision in Shammas is directly addressed whether 15 U.S.C. § 1071(b)(3) allows for the award of attorney fees and concluded that it does. 738 F.3d at 222. Because Baker Botts is not clearly contrary to the Fourth Circuit's decision, it cannot be said that Baker Botts overruled Shammas. See Shammas v. Lee, 187 F. Supp. 3d 659, 663 (E.D. Va. 2016) (reaching the same conclusion).⁴

Moreover, the Supreme Court has interpreted "expenses" to be a more broad term than "costs." See, e.g., Taniguchi v. Kan Pacific Saipan, Ltd., 132 S. Ct. 1997, 2006 (2012). In Taniguchi, the Court specifically distinguished "expenses" from the more limited term "costs," explaining that "costs" represents only a fraction of "expenses," relying specifically on the 1998 Wright & Miller treatise:

Although costs has an everyday meaning synonymous with expenses, the concept of taxable costs . . . is more limited. . . . Taxable costs are limited to relatively minor, incidental expenses[;]

⁴ Both the plaintiff and the USPTO in the Shammas case addressed the impact of Baker Botts while the Fourth Circuit considered rehearing, and again before the district court on a motion to vacate. See, e.g., Shammas v. Lee, 187 F. Supp. 3d 659, 662 (E.D. Va. 2016); Petition for Rehearing and Rehearing En Banc, Shammas v. Focarino, 738 F.3d 217 (4th Cir. 2015) (Dkt No. 42). The Fourth Circuit summarily denied the petitions for rehearing and summarily affirmed the district court's denial of the motion to vacate, impliedly rejecting the argument that Baker Botts affected its reasoning. See Shammas v. Lee, 683 F. App'x 195 (4th Cir. 2017) (unpublished).

. . . such items as clerk fees, court reporter fees, expenses for printing and witnesses, expenses for exemplification and copies, docket fees, and compensation of court-appointed experts. . . . Taxable costs are a fraction of the nontaxable expenses borne by litigants for attorneys, experts, consultants, and investigators. Id. at 2006 (emphasis added).

No party has identified any contrary authority in which the Supreme Court has held that the term “expense” categorically excludes attorneys’ fees.

Booking relies on the district court opinion in Nantkwest, Inc. v. Lee, 162 F. Supp. 3d 540, 543 (E.D. Va. 2016) to support its interpretation of Baker Botts and its effect on Shammas. In that case, which involved 35 U.S.C. § 145, the analogous fee-shifting statute for patent cases, the court found that the statute did not explicitly allow for the award of attorneys’ fees under the Supreme Court’s rationale in Baker Botts. 162 F. Supp. 3d at 543. The Nantkwest court reasoned that if Congress intends to provide for an award of attorneys’ fees, it either explicitly states so using the language “attorney’s fees,” or when using a broad term like “costs” or “expenses,” modifies the term to clarify its meaning. See id. (citing 11 U.S.C. § 363(n) (authorizing recovery of “any costs, attorneys’ fees, or expenses incurred”); 12 U.S.C. § 1464(d)(1)(B)(vii) (at the court’s discretion, obligating federal savings associations to pay “reasonable expenses and attorneys’ fees” in enforcement actions); 26 U.S.C. § 6673(a)(2)(A) (requiring lawyers who cause excessive costs to pay “excess costs, expenses, and attorneys’ fees”); Fed. R. Civ. P. 37(a)(5)(A) (requiring party at fault to pay “reasonable expenses . . . including attorney’s fees”)). This decision has

been reversed by a panel of the Federal Circuit, which expressed serious doubts about whether the American Rule applied to § 145 when, like § 1071(b)(3), the provision makes no reference to prevailing parties. See Nantkwest, Inc. v. Matal, 860 F.3d 1352, 1355 (Fed. Cir. 2017). The panel decision, in turn, has been vacated, pending en banc review by the Federal Circuit. See Nantkwest, Inc. v. Matal, 869 F.3d 1327 (Fed. Cir. 2017). Although the issue of whether attorneys' fees are recoverable is unclear as to § 145, the law in this circuit, reflected in the Fourth Circuit's Shammas decision, compels the Court to find that defendants' attorneys' fees are recoverable under § 1071(b)(3).⁵

2. The Constitutionality of § 1071(b)(3)

Plaintiff further contends that § 1071(b)(3) violates the First Amendment by interfering with the right to access the courts. Essentially, it argues that by imposing the USPTO's expenses on even a successful party, the statute unconstitutionally burdens an applicant's right to seek judicial review of USPTO decisions. Although the Supreme Court has recognized that "the right of access to the courts is an aspect of the First Amendment right to petition the Government for redress of grievances," Bill Johnson's Restaurants, Inc. v. NLRB, 461 U.S. 731, 741 (1988), this right is not unrestricted, but rather is subject to Congress's power to set

⁵ Although the Federal Circuit's en banc decision in Nantkwest v. Matal would be persuasive authority on the question presented here, the USPTO correctly points out that it would not be controlling in this context. See Def.'s Mot. Expenses at 8 n.1. Only the Fourth Circuit sitting en banc or the Supreme Court could directly overrule Shammas.

limits on the jurisdiction of the federal judiciary. Congress is neither “constitutionally required to create Article III courts to hear and decide cases within the judicial power of the United States,” nor to vest those courts that are created “with all the jurisdiction it was authorized to bestow under Article III.” Palmore v. United States, 411 U.S. 389, 400-01 (1973). Congress may constitutionally limit access to certain courts, and may constitutionally impose some costs on a litigant’s access. See United States v. Kras, 409 U.S. 434, 450 (1973) (refusing to adopt an “unlimited rule that a [litigant] at all times and in all cases has the right to relief without the payment of fees.”).

The Seventh Circuit directly addressed the question of whether fee-shifting statutes are constitutional under the First Amendment’s Petition clause in Premier Electrical Construction Co. v. National Electrical Contractors Ass’n, which concluded that “the proposition that the first amendment, or any other part of the Constitution, prohibits or even has anything to say about fee-shifting statutes in litigation seems too farfetched to require extended analysis.” 814 F.2d 358, 373 (7th Cir. 1987). That court correctly recognized that the imposition of costs or expenses to exercise a right cannot, in and of itself, violate the First Amendment. Id. (“The exercise of rights may be costly, and the first amendment does not prevent the government from requiring a person to pay the costs incurred in exercising a right.”). Indeed, extending Booking’s argument to its logical conclusion would also call into question the constitutionality of filing fees, statutory costs under 28 U.S.C. § 1920, costs for discovery requests, and other expenses that necessarily place a burden on a litigant’s access to a

court. It is well-settled that these types of reasonable expenses are constitutional. See, e.g., Roller v. Gunn, 107 F. 3d 227, 238 (4th Cir. 1997) (“If we were to adopt Roller’s argument, all filing fees would be unconstitutional, which, of course, they are not.”); Whittington v. Maes, 655 F. App’x 691, 698-99 (10th Cir. 2016) (holding that mandatory court filing fees do not violate the First Amendment).⁶

Additionally, the USPTO is funded by user fees. See Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 10, 125 Stat. 284, 316 (2011) (recognizing the USPTO as exclusively an applicant-funded agency); Figueroa v. United States, 466 F.3d 1023, 1028 (Fed. Cir. 2006). If it were required to defend each of its denial decisions in a de novo civil action, each applicant’s fees would have to be substantially increased. Section 1071(b)(3) was intended to be a “straightforward funding provision, designed to relieve the PTO of the financial burden that results from an applicant’s election to pursue the more expensive district court litigation.” Shammas, 784 F.3d at 226; see also Hyatt, 625 F.3d at 1337. As these types

⁶ The Supreme Court has struck down filing fee requirements in certain state court cases involving domestic disputes; however, these cases address situations where a filing fee presents an insurmountable barrier to the protection of certain fundamental rights. For example, in M.L.B. v. S.L.J., 519 U.S. 102 (1996), the Supreme Court held that Mississippi could not condition an appeal from the termination of parental rights on the payment of a record preparation fee. Similarly, in Boddie v. Connecticut, 401 U.S. 371 (1971), the Court held that Connecticut could not deny a married couple access to divorce proceedings due to an inability to pay court fees. The Court has made clear that in “the mine run of cases” which do not involve “state controls or intrusions on family relationships” filing fees may be required. See M.L.B., 519 U.S. at 123.

of economic decisions are well within the constitutional authority of Congress, Booking's constitutional argument fails. See Cox v. New Hampshire, 312 U.S. 569, 577 (1941) (holding that a governmental decision to impose fees on the exercise of First Amendment rights is constitutional if the fee is designed "to meet the expense incident to the administration of the act and to the maintenance of public order"); Kwong v. Bloomberg, 723 F.3d 160, 165 (2d Cir. 2013) (discussing Supreme Court cases regarding the constitutionality of governmental fees assessed in connection with activities protected by the First Amendment).

Plaintiff relies on BE & K Construction Co. v. NLRB and the Noerr/Pennington doctrine to support its position. In BE & K Construction, the Supreme Court held that, under the First Amendment, an employer's unsuccessful retaliatory lawsuit against unions could not serve as a basis for the NLRB to impose an administrative penalty, absent a finding that suit was also objectively baseless. 536 U.S. 516, 524 (2002); see also Darveau v. Detcon, Inc., 515 F.3d 334, 341 (4th Cir. 2008) (stressing that BE & K Construction affirms that "only those lawsuits that are retaliatory in intent and baseless in fact or law do not implicate First Amendment . . . concerns"). Similarly the Noerr/Pennington doctrine safeguards the First Amendment right to "petition the government for a redress of grievances" by immunizing citizens from antitrust liability that may attend the exercise of that right. See Eastern R.R. Presidents Conference v. Noerr Motor Freight, 365 U.S. 127, 138 (1961); Waugh Chapel S., LLC v. United Food & Commercial Workers Union Local 27, 728 F.3d 354, 362 (4th Cir. 2013). The Supreme Court has since extended the Noerr/Pennington doctrine to encompass "the approach

of citizens . . . to administrative agencies and to the courts.” Cal. Motor Transp. Co. v. Trucking Unlimited, 404 U.S. 508, 510 (1972). Plaintiff argues that under these precedents, § 1071(b)(3) fails to provide “the breathing space essential to [the] fruitful exercise” of the right to petition. See Pl.’s Opp. to Mot. Expenses at 16 (quoting BE & K Construction Co., 536 U.S. at 531).

This argument is unpersuasive. As an initial matter, there is an obvious distinction in context. The Noerr/Pennington doctrine and BE & K Construction Co. address the ability of federal agencies or individuals to penalize an entity for filing a lawsuit (to which the agency was not a party). See, e.g., BE & K Construction, 536 U.S. at 524; Cal. Motor Transp. Co., 404 U.S. at 510 (addressing whether a group of highway carriers could maintain an allegation of conspiracy to monopolize against competitors who organized to institute state and federal court proceedings to defeat applications by the plaintiffs). Nothing in that jurisprudence addresses whether Congress can constitutionally decide to require a party to pay “expenses” as part of filing a civil action in a district court. Indeed, as addressed above, multiple courts have held that Congress can impose such requirements as part of its constitutional power over the jurisdiction of federal courts. See

Further, Booking fails to properly recognize that, in this context, Congress has provided a means to access the federal courts for review of USPTO decisions that does not require the applicant to reimburse expenses. To avoid paying the USPTO’s expenses, an applicant may appeal directly to the Federal Circuit. See 15 U.S.C. § 1071(a). Both the Fourth Circuit and Federal Circuit have recognized that this alternative is the essence of

the judicial review scheme created by Congress for disappointed applicants in both the trademark and patent contexts. See Shammas, 784 F.3d at 225 (“If the dissatisfied applicant does not wish to pay the expenses of a de novo civil action, he may appeal the adverse decision of the PTO to the Federal Circuit.”); Hyatt v. Kappos, 625 F.3d 1320, 1337 (Fed. Cir. 2010). Indeed, the Federal Circuit stated that the alternative review scheme was enacted to “deter applicants from exactly this type of procedural gaming.” Hyatt, 625 F.3d at 1337. Although review in the Federal Circuit of agency action is subject to a more deferential standard than in the district court, the agency’s decision is still subject to robust judicial scrutiny. Given the clear weight of authority, the Court finds that requiring disappointed applications who opt to have de novo review of the USPTO’s decision to pay the USPTO’s expenses incurred in defending its decision does not violate the First Amendment.

3. Reasonableness of Expenses

Plaintiff further claims that, even if § 1071(b)(3) does include the USPTO’s attorneys’ fees, those fees are “fixed costs . . . little different from utility expenses,” because the USPTO would have paid the attorney’s salaries regardless of whether this proceeding occurred. Pl.’s Opp. to Mot. Expenses at 17. Therefore, salaries cannot be “of this proceeding” as required under § 1071(b)(3). Id.

This argument fails. Courts have awarded similar relief in the context of other salaried attorneys. See Shammas, 784 F.3d at 223 (recognizing that the USPTO “incurred expenses when its attorneys were required to defend the Director in the district court proceedings, because their engagement diverted the PTO’s resources

from other endeavors”); Raney v. Fed. Bureau of Prisons, 222 F.3d 927, 935 (Fed. Cir. 2000) (awarding salaried union attorneys an apportionment of their salaries because the litigation required the lawyers to divert their time away from other pending matters); Wisconsin v. Hotline Indus., Inc., 236 F.3d 363, 365-66 (7th Cir. 2000) (holding that salaried government employees could recover their fees as they relate to the government’s opposition to an improper removal of a state court case).

Moreover, Booking cannot credibly dispute that the USPTO attorneys and paralegals dedicated time and resources to defend this litigation when they could have otherwise applied those resources to other matters. Booking essentially endorses a rule that would theoretically permit an award if the USPTO retained outside counsel to defend its interests but not if it elected to proceed on its own. Logically, the meaning of “of the proceedings” cannot turn on the type of attorneys retained to defend the government’s interests. As the Federal Circuit has recognized, courts “must equally regard salaried attorneys’ time” and “tak[e] into account the opportunity costs involved in devoting attorney time to one case when it could be devoted to others.” Nantkwest, Inc. v. Matal, 860 F.3d 1352, 1360 (Fed. Cir. 2017) (quoting Raney, 222 F.3d at 934-35). Here, the USPTO attorneys and paralegals were diverted from other tasks and activities as a result of this litigation, therefore, the costs associated with their time are properly considered “expenses of this proceeding.”

Booking also challenges the USPTO’s request on the basis that the amount sought is not reasonable. A party seeking to recover fees bears the burden of demonstrating that those fees are reasonable. See

Hensley v. Eckerhart, 461 U.S. 424, 437 (1983). A reasonable fee request should exclude “hours that are excessive, redundant, or otherwise unnecessary.” Id. Booking’s primary argument is that the documentation submitted by the USPTO is insufficient to demonstrate that its request is reasonable. Courts have rejected fee requests on the basis of inadequate descriptions, where such descriptions have failed to provide sufficient information to determine why the time was necessary or relevant. See, e.g., Zhang v. GC Servs., LP, 537 F. Supp. 2d at 814-15 (E.D. Va. 2008); Pinpoint IT Servs. LLC v. Atlas IT Exp. Corp., No. 2:10-cv-516, 2012 WL 4475334, at *6 (E.D. Va. Sept. 27, 2012) (refusing to grant attorneys’ fees for tasks that had a general description such as “formulate response”).

With its motion, the USPTO submitted a salary chart for each of the employees who worked on this matter:

<u>USPTO employee</u>	<u>(hours & hour rate)</u>	<u>Personnel expense</u>
Mary Beth Walker, Attorney	(418 hours) (\$75.69/hr.)	\$ 31,638.42
Molly R. Silfen, Second Chair	(89.5 hours) (\$76.81/hr.)	\$ 6,874.46
Christina J. Hieber, Senior Counsel for Trademark	(29 hours) (\$81.43/hr.)	\$ 2,361.47
Thomas L. Casagrande, Deposition Counsel	(26 hours) (\$76.81/hr.)	\$ 1,997.06
Marynelle Wilson, Associate	(137 hours) (\$52.17/hr.)	\$ 7,147.29

Macia Fletcher, Paralegal	(31.75 hours) (\$45.79/hr.)	\$ 1,453.83
Total USPTO Personnel Expenses		\$ 51,472.53

See Def’s Mot. Expenses at 9. Each employee provided a sworn declaration stating their annual salary at the time of the litigation and the number of hours spent on this civil action and, in its reply memorandum, the USPTO supplemented the record with more detailed explanations of each employee’s tasks, based upon review of “contemporaneously created records.” Def.’s Reply Supp. Mot. Expenses at 17.

Booking argues that the time records attached to the USPTO’s motion do not include sufficient information, containing only generic descriptions such as “[l]itigate and support IP legal actions—dist ct—Sect 1071(b).” See Pl’s Opp. to Mot. Expenses at 20; Def.’s Mot. Expenses, Ex. D. at 5. Additionally, it contends that some of the arguments developed by the USPTO, such as the standard of review that should apply, were found by the Court to be “indefensible,” see Mem. Op. at 6 n.2 [Dkt. No 87], and the USPTO should not be reimbursed for time spent developing such arguments. Similarly, Booking points out that there is evidence of “over-staffing” because there were six individuals recording time on this matter. See Pl’s Opp. Mot. to Expenses at 23; see also Pinpoint IT Servs., LLC, 2012 WL 4475334, at *7 (discounting attorney fee award due to “overconferencing”).

A similar challenge to the nature of documentation that the USPTO has submitted to support its personnel expenses has been rejected in this district. In Realvirt

LLC v. Lee, the court found that “the level of specificity” requested “is not required because the PTO attorneys and paralegals are salaried government employees.” 220 F. Supp. 3d 695, 703 (E.D. Va. 2016) As such, the USPTO must use “the actual salaries of the lawyers and paralegal[s] instead of prevailing market rates” to calculate the attorneys’ fees, thereby allowing the PTO to be reimbursed for “the portion of its attorneys’ [and paralegals’] salaries that were dedicated to this proceeding.” Id. at 703-04. The court concluded that the “sworn declarations stating annual salaries and the hours spent on the case . . . adequately support[ed] the PTO’s requested” fees. Id.

Further, the records submitted demonstrate that there was a reasonable amount of time spent on each of the various discovery motions, depositions, and briefing. The USPTO explains that its personnel system does not allow for individual entries for the specific “tasks performed” or other specific time records like private law firms, id. at 16, and points out that it attempted to minimize the expenses in this litigation, for example by offering a briefing schedule limited to two briefs per side, rather than the three insisted upon by plaintiff. See id. at 18. The USPTO’s attorneys’ declarations do not show any cumulative time spent on the same task by multiple attorneys. Based on this analysis, the documentation submitted is sufficient to justify awarding the USPTO the full amount of the attorneys’ fees requested.⁷

⁷ Booking does not argue that the attorneys’ hourly rates are unreasonable. Indeed, the hourly rate being charged is far lower than the reasonable rates that have been adopted in this district for private attorneys. See Vienna Metro LLC v. Pulte Home Corp., No. 1:10-cv-502, Dkt. No. 263 (E.D. Va. Aug. 24, 2011) (finding that,

Booking further contends that there is “no statutory basis” on which to award the USPTO its expert fees, citing 28 USC § 1920, which allows a recovery of expert witness fees only where the expert is court appointed. See Pl.’s Opp. to Mot. Expenses at 24-25. It also argues that the USPTO’s citation to Taniguichi is not supportive because that case “merely distinguished the statutory meaning of ‘costs’ from the normal everyday meaning of ‘expenses.’” Id. at 25.

This argument is plainly incorrect. As discussed above, in Shammas, the Fourth Circuit broadly interpreted the term “expenses” as used in § 1071 (b)(3) to be consistent with its ordinary meaning, and to include fees for both attorneys and experts. Shammas, 784 F.3d at 222. This broad application is supported by Congress’s decision to include “all” as a modifier to the word “expenses,” suggesting it did not intend to limit the type of “expenses” recoverable by the USPTO. See id. Moreover, although the direct question in Taniguichi was whether the term “interpreter” applied to translations of written materials so as to allow a party to recover the “costs” of document translation, the Supreme Court recognized that the statutory use of “expenses” includes substantially more than the limited term “costs.” See

in 2011, reasonable rates included \$130-350/hr for paralegals; \$250-435/hr for lawyers with 1-3 years of experience; \$350-600/hr for lawyers with 4-7 years of experience; \$465-640/hr for lawyers with 8-10 years of experience; \$520-770/hr for lawyers with 11-19 years of experience). Here, the rate being charged for the attorney with the most experience—\$81.43 per hour for Ms. Hieber—is almost \$50 dollars below the lowest rate for paralegals. Had the USPTO hired outside counsel, or even charged the comparable market rate, Booking would be facing much higher expenses.

Taniguichi, 132 S. Ct. at 2006 (“Taxable costs are a fraction of the nontaxable expenses borne by litigants for attorneys, experts, consultants, and investigators.”); see also Arlington Cent. School Dist. Bd. of Educ. v. Murphy, 548 U.S. 291, 297 (2006) (distinguishing the statutory term “costs” from the broader term “expenses”). Indeed, courts have routinely awarded expert witness fees to the USPTO in both § 1071(b)(3) and § 145 actions as “part of the expenses of the proceeding.” See, e.g., Realvirt, 220 F. Supp. 3d at 704 (E.D. Va. 2016) (awarding \$50,160.00 in expert witness expenses); Hitachi Koki Co. v. Dudas, No. 2007-1504 (D.D.C. Mar. 30, 2017) (Dkt. No. 66) (awarding the USPTO \$59,866.43 in expert expenses); Taylor v. Matal, No. 15-1607 (E.D. Va. July 12, 2016) (requiring a plaintiff to post a \$40,000 bond to cover “anticipated expert expenses” among other expenses); Sandvik Aktiebolag v. Samuels, No. 89-3127-1FO, 1991 WL 25774, at *2 (D.D.C. Feb. 7, 1991) (ordering plaintiffs to pay USPTO expert expenses).

Booking also argues that the USPTO’s expert fees are unreasonable because it provided only a single invoice from its expert, Dr. Edward Blair, stating that he worked 43.5 hours at a rate of \$500/hr. See Pl.’s Opp. Mot. to Expenses at 18; Def.’s Mot. Expenses, Ex. C. In Sandvik Aktiebolag v. Samuels, a D.C. district court allowed the USPTO to recover expert fees, but analyzed the hours submitted for reasonableness. See 1991 WL 25774, at *2. Although Dr. Blair submitted only a single invoice, the total of 43.5 hours does not appear to be excessive given the nature of this case. The record demonstrates that Dr. Blair’s work included, after evaluating the four trademark applications at issue, the three separate TTAB opinions affirming the denial of registration, and plaintiff’s expert report, preparing his

own 30-page expert report and being deposed by Booking. See [Dkt. No. 61], Ex. B. at 3-6. Based on this record, the Court finds that the hours Dr. Blair billed were not unreasonable.

Finally, Booking claims that any expenses awarded should be offset against its own recoverable costs under Fed. R. Civ. P. 54(d)(1) as it is the prevailing party in this action. Pl.'s Opp. to Mot. Expenses at 25. The USPTO does not directly address this argument other than to point out that expert expenses are not a part of the compensable costs generally awarded to a prevailing party. Reply at 20; see also 28 U.S.C. § 1920 (listing the costs recoverable in a bill of costs); id. § 2412(a) (allowing an award for costs enumerated in § 1920 against the United States or a U.S. agency). There is nothing in this record prohibiting Booking, as the prevailing party, from submitting a bill of costs, which may offset some of the payment that it will owe to the USPTO.

II. CONCLUSION

For the above stated reasons, in an order to be issued with this Memorandum Opinion, defendants' Motion to Alter Judgment [Dkt. No 94] will be granted only to the extent that the Judgment Order will be amended to provide that the '998 and '097 Applications will be remanded to the United States Patent and Trademark Office to be immediately published in the Official Gazette of the Patent and Trademark Office, pursuant to 15 U.S.C. § 1062(a) and defendants' Motion for Expenses [Dkt. No. 98] will be granted.

135a

Entered this 26th day of Oct., 2017.

Alexandria, Virginia

/s/ LMB
LEONIE M. BRINKEMA
United States District Judge

APPENDIX D

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IN RE BOOKING.COM B.V.

Serial No. 79114998

Hearing: Jan. 5, 2016

Mailed: Feb. 18, 2016

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*

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.

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 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 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

* * * * *

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.

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

- 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

* * * * *

: 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

* * * * *

⁷ <dictionary.reference.com>, *id.* at 19.
⁸ <macmillandictionary.com>, Office Action of November 18, 2013 at 53.
⁹ <merriam-webster.com>, *id.* at 55.

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.”)

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

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.

the URL if no other domain suffix, such as .org or .edu, is typed in.¹⁴

* * * * *

.com:

Commercial organization.¹⁵

* * * * *

.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

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.

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.

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

* * * * *

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:

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

¹⁹ *Id.* at 54 (emphasis added).

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

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 “book-
ing” in various formulations as the name of travel reser-
vation 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 book-
ing websites, travel booking sites, flight booking site,
and travel booking online.²² Examples of use follow:

Most popular online booking sites for travelers

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

* * * * *

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

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

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

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 . . .

²⁴ <skift.com>, *id.* at 24, 29.

²⁵ <wired.com>, *id.* at 39-40.

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

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

* * * * *

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 trip. . . .²⁹

* * * * *

²⁷ <online.wsj.com>, *id.* at 71.

²⁸ <f-i.com>, *id.* at 84.

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

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

* * * * *

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?

³⁰ <lifehacker.com>, *id.* at 11-12.

³¹ <abcnews.go.com>, *id.* at 16.

³² <frommers.com>, *id.* at 24.

. . . 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
instantworldbooking.com	website called Instant World Booking.com, offering “Online booking for hotels, youth

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

³⁴ <hotelchatter.com>, *id.* at 32.

³⁵ <hotelchatter.com>, *id.* at 34.

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

	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

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.

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dubai-travelbooking.com website called dubai-travelbooking.com, offering hotel search.⁴³

Images of some of these websites are set forth below:

<http://www.ebooking.com/> 08/20/2014 11:55:40 AM



<http://www.instantworldbooking.com/> 10/29/2013 03:18:21 PM



<http://www.hotelbooking.com/index.html> 10/29/2013 03:16:45 PM



⁴³ *Id.* at 99-101.

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<http://www.blinkbooking.com/> 11/28/2012 11:28:08 AM



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



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





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

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.

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 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

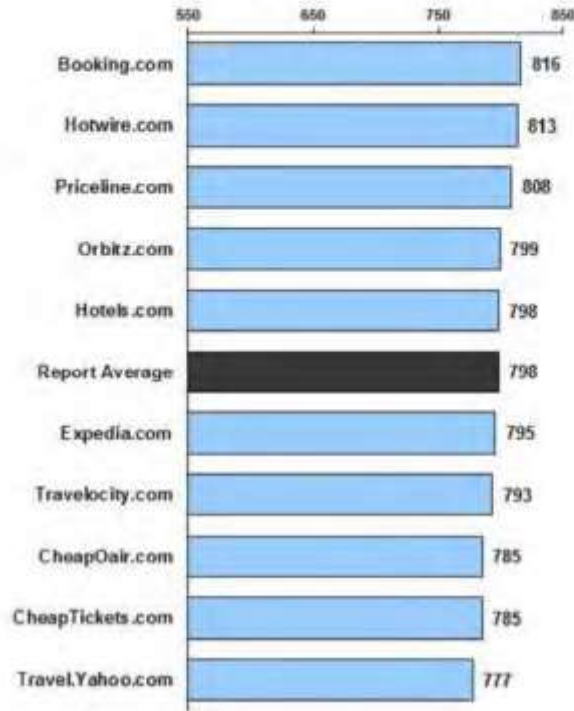
The chart accompanying the press release is set forth below:⁵⁰

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

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;

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.

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

- 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 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

⁵³ *Id.* at 85-90.

“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 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.”

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.

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 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

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 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.

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 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*,

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

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

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

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

[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.

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

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’”;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

⁶² *Id.* at 12, 55 TTABVUE 13.

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 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

⁶³ *Id.* at 3, 55 TTABVUE 4.

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.

(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 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 declaration 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:

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

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 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 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

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

⁶⁷ *Id.* at 18, 55 TTABVUE 19.

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

⁶⁸ *Id.* at 3, 55 TTABVUE 4.

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).

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

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.

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 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

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

BOOKING.COM. Rather, in that context, BOOKING.COM would be obviously and 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 travels, 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 customers 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.

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

- 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 Pranke 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 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

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

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.

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APPENDIX E

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IN RE BOOKING.COM B.V.

Serial No. 85485097

Hearing: Jan. 5, 2016

Mailed: Feb. 18, 2016

Before: SHAW, ADLIN and MASIELLO, Administrative Trademark Judges.

Opinion by MASIELLO, Administrative Trademark Judge:

Booking.com B.V. (“Applicant”) filed an application for registration on the Principal Register of the mark shown below:¹



¹ Application Serial No. 85485097 was filed on December 1, 2011 under Trademark Act Sections 1(a) and 44(e), 15 U.S.C. §§ 1051(a) and 1126(e).

The colors white, light blue, and dark blue are claimed as features of the mark. The design to the left of the wording is described in the application as “a stylized depiction of the earth behind a briefcase.”

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

Travel agency services, namely, making reservations for transportation; travel and tour ticket reservation services; travel agency services, namely, making reservations for transportation for tourists; provision of travel information; providing consultation related to making reservations for transportation, and travel and tour ticket reservation; all of the foregoing services rendered in-person and via the internet, in International Class 39;

Making hotel reservations for others in person and via the internet; providing personalized information about hotels and temporary accommodations for travel in-person and via the Internet; providing on-line reviews of hotels; consultation services related to making hotel reservations for others, provision of personalized information about hotels and temporary accommodations for travel, and on-line reviews of hotels, in International Class 43.

With respect to the Class 39 services, the Application is based solely on Applicant’s OHIM Registration No. 005752274, issued April 24, 2008, under Section 44(e). With respect to the Class 43 services, the Application is based on the above OHIM registration under Section 44(e) and on Applicant’s use of the mark in commerce, under Section 1(a), claiming January 12, 2005 as the date of first use and first use in U.S. commerce.

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, on the ground that this wording is merely descriptive of Applicant's services and, therefore, an unregistrable component of the mark under Trademark Act Section 6, 15 U.S.C. § 1056. When Applicant claimed, in the alternative, that BOOKING.COM has acquired distinctiveness and is entitled to registration under Section 2(f), 15 U.S.C. § 1052(f), the Examining Attorney maintained her requirement of a disclaimer on the ground that the wording in the mark is merely descriptive of Applicant's services and that Applicant's evidence is inadequate to demonstrate acquired distinctiveness; and on the ground that the wording in the mark is generic as applied to the services, and that therefore no amount of evidence purporting to demonstrate acquired distinctiveness could render the wording registrable. When the Examining Attorney made her refusals to register the mark final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded.

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 79114998.² 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.³ The cases were fully briefed, including extra

² Board order of December 12, 2014, 19 TTABVUE.

³ Board order of January 30, 2015, 21 TTABVUE.

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.

The Director of the USPTO “may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Trademark Act Section 6(a). The USPTO may require a disclaimer as a condition of registration if the term at issue is merely descriptive of any of the identified goods or services. *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). In this case, the Examining Attorney maintains that the wording BOOKING.COM is not only merely descriptive, but generic as applied to Applicant’s services. A generic term is “the ‘ultimate in descriptiveness.’” *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015).

A mark (or a component thereof) 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 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 services, namely, making reservations for transportation and providing related information and consultation, including such services performed online.

Class 43: Making hotel reservations in person and via the internet, providing related information and consultation, and providing online reviews of hotels.

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, from time to time, in arranging a reservation for transportation or for a room in a hotel, resort, or other lodging; in obtaining information or consultation regarding such reservations; and in reading online reviews of hotels. The Examining Attorney's refusal and supporting arguments focus almost exclusively on Applicant's *online* reservation services, and we will do the same.⁴ 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.*, 77 USPQ2d at 1089, *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

⁴ While Applicant's brief refers to its "brick and mortar services," 22 TTABVUE 28, there is no evidence showing that Applicant's services are available otherwise than online.

goods for which registration is sought.”). In our deliberations, we have considered all of the evidence of record. We summarize below the evidence that we found 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:

- : 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
- . . .
- : RESERVATION⁵

* * * * *

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.⁶

⁵ Definition at <merriam-webster.com>, Applicant’s response of October 11, 2013 at 71.

⁶ Definition at <macmillandictionary.com>, Office Action of May 23, 2014 at 69.

* * * * *

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’⁷

* * * * *

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

“wondered who had made the booking”

Synonyms: reservation⁸

* * * * *

an engagement, as for a lecture or concert.⁹

The Examining Attorney has also made of record the following definition of “.com”:

abbr.

commercial organization (in Internet addresses).¹⁰

⁷ Definition at <oxforddictionaries.com/us/definition/american_english>, *id.* at 61.

⁸ Definition at <vocabulary.com>, *id.* at 73.

⁹ Definition at <collinsdictionary.com/dictionary/American>, Applicant’s response of October 11, 2013 at 68.

¹⁰ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Fifth ed. 2011), Office Action of October 28, 2013 at 16.

* * * * *

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 specimen of use states:

To notify Booking.com of an invalid credit card, please login to the Extranet and go to the Bookings tab. . . . All reservations will be listed there by booking and arrival date. . . .

Overbooking:

If the hotel is overbooked please make every effort to accommodate the guest at a different hotel.¹¹

Applicant’s own website uses “booking,” both as a noun meaning a hotel reservation and as a verb meaning to make such a reservation:

We’ll match the price of the other deal if:

1. You contacted us immediately after booking with all the details of the other deal . . .
. . .
4. The conditions of your booking with us still allow penalty-free cancellations and modifications.¹²

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

¹¹ Application at 19.

¹² Office Action of October 28, 2013 at 22.

New York City
452 properties

. . .

Helmsley Park Lane Hotel * * * * from \$325
Score from 3590 reviews. *Very good, 8.1*
Latest **booking**: 32 minutes ago
There are 31 people looking at this hotel

Four Points by Sheraton Midtown—
Times Square * * * from \$299
Score from 875 reviews. *Very good, 8*
Latest **booking**: 13 minutes ago
There are 26 people looking at this hotel¹³

Similarly, third-party websites also use the term “booking” in various formulations as the name of travel reservation services. Such services have been called (among other things), booking travel, booking travel online, booking, booking system, booking sites, booking websites, online bookings, travel-booking, travel-booking sites, travel-booking website, online travel booking sites, hotel bookings, hotel website booking engine, hotel booking services, online hotel booking, mobile booking engine, and internet booking engines. Examples of use follow:

3 Myths About Booking Travel From the Source

. . . travelers who do not book directly with the airline will pay higher fees, . . . [T]he best deals I’ve found lately are the result of booking directly with a hotel or airline.¹⁴

¹³ *Id.* at 17 (emphasis added).

¹⁴ “3 Myths About Booking Travel From the Source,” The New York Times, September 26, 2012. Office Action of November 28, 2012 at 16-17.

* * * * *

Get your holiday off to a flying start by booking a cheap flight to hundreds of destinations ebookers offers.¹⁵

* * * * *

Smart, Simplified Online Bookings

Checkfront is a hosted real-time booking system for Tours, Activities & Hospitality.¹⁶

* * * * *

Booking Travel Online?

A couple of years ago, online travel-booking sites such as Expedia and Travelocity began issuing service-related manifestos . . .¹⁷

* * * * *

The Shift in Desktop to Mobile & Tablet Continues to Transform Hotel Bookings in Q1 2014.¹⁸

* * * * *

Hotel Reservation Solutions

Hotel Website Booking Engine

Mobile Booking Engine.¹⁹

¹⁵ <ebookers.com>, *id.* at 24.

¹⁶ <checkfront.com>, *id.* at 26.

¹⁷ “Booking Travel Online?,” Travel+Leisure, April 2008, *id.* at 30.

¹⁸ <genares.com>, Office Action of May 23, 2014 at 16.

¹⁹ <genares.com>, *id.* at 19.

* * * * *

At InnLink Central Reservations, we do more than provide central reservations services . . . Featuring . . . branded internet booking engines, mobile booking engines, . . . ²⁰

* * * * *

Hotel Booking—Expedia Guarantees the Best Price Book & Save on Hotel Booking.

. . .

Orbitz® Book Hotels—ORBITZ.com

. . .

6 best travel-booking tricks you're not using . . . A quirk of travel-booking systems is that they will show the lowest fare available to seat your entire party . . .

. . .

The Top Online Travel Booking Sites for January 2014²¹

* * * * *

How to Save Money When Booking Travel Online Websites like Expedia.com, Hotwire.com and Orbitz.com have all but eliminated the need for travel agents . . . [W]e persuaded CheapAir.com CEO Jeff Klee, Getaroom.com and Hotels.com co-founder Bob Diener, and Airfarewatchdog creator George Hobbica to divulge their own travel booking secrets.

²⁰ <innlink.com>, *id.* at 21.

²¹ <google.com> search results for “hotel booking,” *id.* at 75, 78.

. . .

“A lot of booking sites have eliminated flexible search,” . . . stressing that you should spend extra time looking at prices both on booking websites and directly on airline websites.²²

* * * * *

This Travel-Booking Website Loves it When You Call
. . . Plenty of people still want a fellow human for travel booking, . . . ²³

* * * * *

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.²⁴

* * * * *

When it comes to the gold standard of online hotel booking, one site comes to mind. Marriott.com²⁵

²² “How to Save Money When Booking Travel Online,” Huff Post Travel, October 22, 2013, Office Action of October 28, 2013 at 11-13.

²³ “This Travel-Booking Website Loves it When You Call,” Bloomberg Businessweek Technology, August 22, 2013, *id.* at 26-27.

²⁴ “2013 Best Hotel Booking Services Comparisons and Reviews,” TopTen Reviews, *id.* at 30-31.

²⁵ <marriott.com>, *id.* at 39.

* * * * *

Review or Cancel a Booking

Review your booking

Retrieve your booking to view/print your itinerary online

If you made your booking with Air New Zealand through our website or over the telephone you can view your booking online.²⁶

* * * * *

Manage My Booking

. . . Log in to your booking . . . Find my booking . . .²⁷

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>
hotelbooking.com	website called hotel-booking.com, offering “your best hotel web search engine.” ²⁸
instantworldbooking.com	website called Instant World Booking.com, offering “Online booking for hotels, youth

²⁶ <airnewzealand.com>, Office Action of November 28, 2012 at 22.

²⁷ <britishairways.com>, *id.* at 29.

²⁸ Website at <hotelbooking.com>, Office Action of October 28, 2013 at 41-42.

blinkbooking.com	hostels, and bed and breakfast accommodations at world heritage destinations.” ²⁹
francehotelbooking.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!” ³⁰
ebooking.com	website called Link Paris .com, offering to “find you a great Paris hotel” and hotel search for other French cities. ³¹
	U.S. Reg. No. 3888087, for “Travel agency services, namely, making reservations and bookings for temporary accommodations for others by means of the Internet.” ³²

²⁹ *Id.* at 46-48.

³⁰ Office Action of November 28, 2012 at 14-15.

³¹ Office Action of October 28, 2013 at 43-44.

³² Office Action of May 23, 2014 at 37-39.

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Images of some of these websites are set forth below:

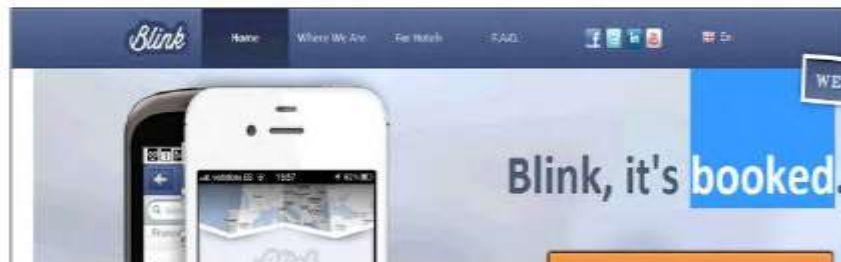
<http://www.hotelbooking.com/en/index.html> 10/29/2013 03:16:45 PM



<http://www.instantworldbooking.com/> 10/29/2013 03:19:23 PM



<http://www.blinkbooking.com/> 11/26/2012 11:28:08 AM



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



The record also includes evidence of domain names that combine “.com” with various combinations of the words “booking” or “book,” including the following:³³

Bookingbuddy.com

Fastbooking-hotels.com

Hotelbookingsolutions.com

Ebookers.com

BOOKINGWIZ.COM³⁴

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, accord-

³³ Office Action of October 28, 2013 at 34-38, 45, and Office Action of November 28, 2012 at 23-25.

³⁴ Reg. No. 3634936, Office Action of May 23, 2014 at 32-33.

ing to the J.D. 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

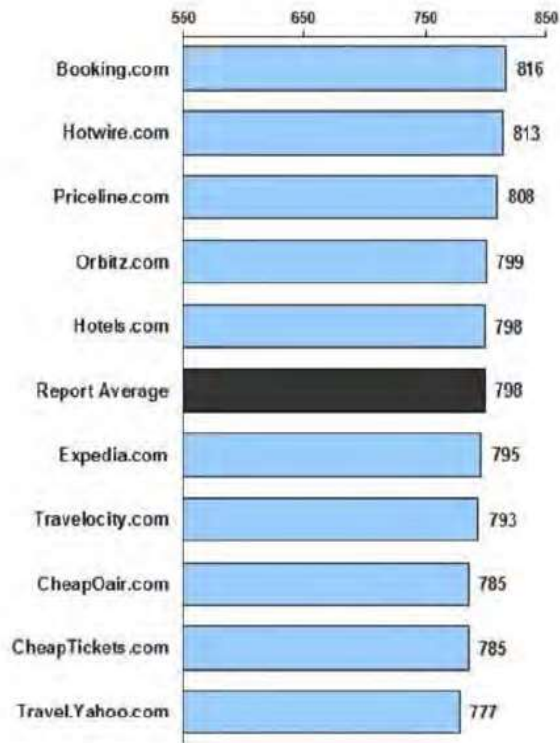
who made an online purchase from an independent travel website in the past 12 months. . . .³⁵

The chart accompanying the press release is set forth below:³⁶

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

Customer Satisfaction Index Ranking

(Based on a 1,000-point scale)



³⁵ Applicant's response of April 29, 2014 at 82-83.

³⁶ *Id.* at 84.

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The press release is supported by a declaration of Applicant's CFO, Olivier Bissier, 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); . . . ³⁷

The Bissier Declaration also states that Applicant has won awards for a 2013 advertising campaign; for "Best Tablet App"; and "Best Mobile Site."³⁸ 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;

³⁷ Declaration of Olivier Bissier, ¶ 11, Applicant's response of April 29, 2014 at 75.

³⁸ *Id.*

- 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.³⁹

(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 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,

³⁹ *Id.* at 83-90.

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.”⁴⁰ 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.⁴¹

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 transportation or hotel rooms. 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,

⁴⁰ Applicant’s brief at 21, fn5, 22 TTABVUE 22, referring to evidence submitted with Applicant’s Response of May 15, 2014 at 56-59 in Application Serial No. 79122366.

⁴¹ Applicant’s reply brief at 12, 25 TTABUE 13.

. . . [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 766.⁴² 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.⁴³ Applicant argues further:

⁴² 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.

⁴³ 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.” 24 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.

In each of the Office Actions, the Examiners have submitted evidence showing descriptive use of “book- ing” 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 . . . ⁴⁴

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 the wording of Applicant’s mark on the basis of evidence highly similar to

⁴⁴ Applicant’s brief at 7, 22 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 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.⁴⁵

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.

⁴⁵ Examining Attorney’s brief, 24 TTABVUE 13 (emphasis in original).

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*].⁴⁶

[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.⁴⁷

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

⁴⁶ Applicant’s brief at 5, 22 TTABVUE 6.

⁴⁷ *Id.* at 10, 22 TTABVUE 11 (emphasis in original).

[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’”;⁴⁸ 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:

⁴⁸ *Id.* at 12, 22 TTABVUE 13.

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 . . . ⁴⁹

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,⁵⁰ 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*

⁴⁹ *Id.* at 3, 22 TTABVUE 4.

⁵⁰ "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.

& 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. Aladdin 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 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 declaration 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.”⁵¹ 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,” 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 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

⁵¹ Applicant’s brief at 6, 22 TTABVUE 7.

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.”⁵² 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.⁵³ 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

⁵² Applicant’s brief at 14; *see also id.* at 24, 22 TTABVUE 15, 25.

⁵³ *Id.* at 18, 22 TTABVUE 19.

trusted brand in the field undermines the purposes of trademark law by betraying the trust consumers place in the brand.⁵⁴

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

⁵⁴ *Id.* at 3, 22 TTABVUE 4.

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).

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.”⁵⁵ 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

⁵⁵ *Id.* at 24-25, 22 TTABVUE 25-26; Applicant’s response of April 29, 2014 at 52-69; Applicant’s response of October 11, 2013 at 75-88.

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 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 "steel-building" 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."⁵⁶ We do not agree that, in the context of Applicant's identified services, customers would perceive any ambiguity or dual meaning in the term

⁵⁶ Applicant's brief at 27, 22 TTABVUE 28.

BOOKING.COM. Rather, in that context, BOOKING.COM would be obviously and immediately understood as having the meaning of booking transportation 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 to refer to an online reservation service for transportation 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 finding that BOOKING.COM is generic and, therefore, an unregistrable component of Applicant's mark within the meaning of Section 6 of the Trademark Act, and we affirm her refusal to register the mark absent a disclaimer of the exclusive right to use BOOKING.COM apart from the mark as shown.

3. The requirement of a disclaimer on the alternative ground of mere descriptiveness.

Bearing in mind the possibility that our finding that BOOKING.COM is generic may be reversed on appeal, we find it appropriate to consider the Examining Attorney's requirement of a disclaimer of BOOKING.COM on the alternative 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 distinc-

tiveness in order to allow registration of the mark without a disclaimer of the wording. *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 *transportation*); and there is no evidence that Applicant has in fact provided reservation services relating to transportation of passengers. All of the evidence of record relates to reservation services for lodging. In particular, we note that the Bissierier 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 customers all over the world can make reservations."⁵⁷ 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, registration of Applicant's mark in Class 39 without a disclaimer of BOOKING.COM must be refused, and we affirm the Examining Attorney's refusal as to Class 39.

⁵⁷ Bissierier declaration ¶ 2, Applicant's response of April 29, 2014 at 72.

(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 Bissierier 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. Bissierier 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.

- Charts from AttentionMeter,⁵⁸ showing the number of “Daily United States People” (apparently visitors to the <booking.com> website) between February 2, 2012 and July 30, 2012, ranging between less than 250,000 and more than 400,000. There are also charts purporting to show unique website visitors during unspecified periods between August 2011 and August 2012; however, they are not marked so as to indicate whether the visitors are U.S. persons or to indicate the period of time during which each measurement was made (*e.g.*, daily, weekly, monthly, *etc.*).
- Information (submitted as exhibits to the Bissierier 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).
- The non-verified declaration of Applicant’s outside counsel, stating that the mark has become distinctive through Applicant’s “substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five

⁵⁸ Applicant’s response of September 24, 2012 at 21-23.

years immediately before the date of this statement [September 24, 2012].”⁵⁹

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 a registrable component of Applicant’s mark.

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

⁵⁹ *Id.* at 9 (this statement of outside counsel apparently relates to the entire word-and-design mark that Applicant seeks to register).

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, a very strong demonstration 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 only five 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"⁶⁰ 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

⁶⁰ Applicant's response of April 29, 2014 at 93-94 (emphasis added).

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 determination 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); and we affirm the Examining Attorney's refusal to register Applicant's mark unless Applicant disclaims the exclusive right to use BOOKING.COM apart from the mark as shown.

Decision: The refusal to register Applicant's mark in the absence of a disclaimer of BOOKING.COM 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. Applicant is allowed until thirty (30) days from the date of this decision to submit to the Board a disclaimer (in proper form) of the designation BOOKING.COM, in which case this decision will be set aside. See Trademark Rule 2.142(g).

APPENDIX F

UNITED STATES COURT OF APPEALS
FOR THE FOURTH DISTRICT

No. 17-2458 (L)
(1:16-cv-00425-LMB-IDD)

BOOKING.COM B.V., PLAINTIFF-APPELLEE

v.

THE UNITED STATES PATENT AND TRADEMARK
OFFICE; ANDREI IANCU, IN HIS OFFICIAL CAPACITY AS
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,
DEFENDANTS-APPELLANTS

AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION, AMICUS CURIAE

No. 17-2459
(1:16-cv-00425-LMB-IDD)

BOOKING.COM B.V., PLAINTIFF-APPELLANT

v.

THE UNITED STATES PATENT AND TRADEMARK
OFFICE; ANDREI IANCU, IN HIS OFFICIAL CAPACITY AS
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,
DEFENDANTS-APPELLEES

AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION, AMICUS CURIAE

226a

Filed: Apr. 5, 2019

ORDER

The petition for rehearing en banc was circulated to the full court. No judge requested a poll under Fed. R. App. P. 35. The court denies the petition for rehearing en banc.

For the Court

/s/ Patricia S. Connor, Clerk

APPENDIX G

1. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall¹ specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

¹ So in original. The word "shall" probably should not appear.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of

the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

2. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the

United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under

section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

3. 15 U.S.C. 1071 provides:

Appeal to courts

(a) **Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure**

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 of this title or section 1141k of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an *ex parte* case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is

in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

4. 15 U.S.C. 1091 provides:

Supplemental register

(a) Marks registerable

In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the

convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes”, to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the

applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

5. 15 U.S.C. 1127 provides:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word “commerce” means all commerce which may lawfully be regulated by Congress.

The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm,

corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term “collective mark” means a trademark or service mark—

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.

Purchaser motivation shall not be a test for determining abandonment under this paragraph.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

The term “Act of March 3, 1881”, “Act of February 20, 1905”, or “Act of March 19, 1920”, means the respective Act as amended.

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

The term “domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

The term “Internet” has the meaning given that term in section 230(f)(1) of title 47.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such com-

merce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.