

No.: 19-46

In The Supreme Court of the United States

—◆—
UNITED STATES PATENT AND TRADEMARK
OFFICE; ANDREW IANCU, in his official capacity as
Under Secretary of Commerce for Intellectual
Property and director of the United States Patent and
Trademark Office,

Petitioners,

v.

BOOKING.COM B.V.

Respondent.

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

**OPPOSITION TO PETITION FOR A WRIT OF
CERTIORARI**

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QUESTIONS PRESENTED

Is the decision of the District Court, affirmed by the Fourth Circuit, clearly erroneous in finding, as a factual matter, that the United States Patent and Trademark Office (“PTO”) failed to sustain its burden of proving by clear evidence that the name of one of the best-known on-line travel and hotel reservation services in the world, BOOKING.COM, is primarily used by consumers as a generic term for all online hotel reservation services, despite the PTO’s own admission that it is logically and grammatically impossible to use the name BOOKING.COM as a generic term for anything; despite the absence of any evidence that the name is actually used generically; and despite substantial affirmative evidence that BOOKING.COM is primarily recognized as a trademark?

Is there any basis to reject the Supreme Court’s longstanding precedent and the express statutory language of the Lanham Act, 15 U.S.C. 1051 *et seq.*, defining genericness as a factual question of the “primary significance” of a term among consumers, and instead redefining it as a legal question?

RULE 29.6 STATEMENT

Respondent Booking.com B.V. is a wholly owned subsidiary of Booking Holdings, Inc., f/k/a The Priceline Group, Inc., which is publicly traded.

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I. STATEMENT

Whether a trademark is generic is a question of fact. *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014); *In re Merrill, Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570 (Fed. Cir. 1987). The factual question of genericness is decided under the primary significance test first enunciated by the Supreme Court over 80 years ago. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (holding that a term is not generic if “the primary significance of the term in the minds of the consuming public is not the product but the producer”). This was later expressly incorporated into the Lanham Act, which states that the test for genericness of a mark is its “primary significance . . . to the relevant public.” 15 U.S.C. § 1064(3). The United States Patent and Trademark Office (“PTO”) in petitioning for certiorari, cites no authority to suggest otherwise.

Under settled law, the PTO had the burden of proving genericness by “clear evidence.” *In re Merrill, Lynch*, 828 F.2d at 1571; Trademark Manual of Examining Procedure § 1209.01(c)(i) (Oct. 2018) (hereinafter “TMEP”) (“The Examining Attorney has the burden of proving that a term is generic by clear evidence.”). That

was the burden applied by the District Court, and the Fourth Circuit concurred. Pet'r's App. at 8a-9a, 60a. Likewise, as an issue of fact, the standard of review applied by the Fourth Circuit on the question of genericness was one of clear error. *See* Pet'r's App. at 7a; *accord Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1526–27 (4th Cir. 1984) (“clearly erroneous” means “there is no evidence in the record supportive of it and also, when, even though there is some evidence to support the finding, the reviewing court, on review of the record, is left with a definite and firm conviction that a mistake has been made in the finding.”)¹

¹ Although the District Court reached its decision on cross motions for summary judgment, both parties had stipulated that the District Court was authorized to resolve any disputes of material fact. Pet'r's App. at 55a. Thus, rather than resort to the *de novo* standard typically employed on review of a decision on summary judgment, the Fourth Circuit properly reviewed the District Court's findings of fact for clear error. Pet'r's App. at 13a & n.7 (“Genericness is a question of fact to which the district court, as the trier of fact, is accorded great deference. . . . Specifically, we defer to the district court's

The PTO's petition for certiorari omits reference to the settled factual test of primary significance among consumers and does not address either its burden of proof or the standard of review applied below. It therefore identifies no error of fact in the decision of the District Court or in the Fourth Circuit's decision to affirm. Not only is there not a single piece of evidence that any consumers have ever used the trademark BOOKING.COM as a generic term to describe any class of services (*e.g.*, "I just logged on to my booking.com;" or "Expedia or Travelocity are some of several 'booking.coms'"), but the PTO itself conceded at the administrative level that "it is impossible to use BOOKING.COM in a grammatically coherent way to refer generically to anything," and that "it is not at all logical to refer to a type of product or service as a 'booking.com.'" Pet'r's App. at 166a.

Here, the evidence demonstrates that the primary significance of the name BOOKING.COM is as a trademark (and not to identify an entire class of goods or services). Nevertheless, the PTO urges this

factual finding regarding the primary significance of the mark to the public . . .").

Court to reframe the issue as a matter of law, such that the term BOOKING.COM can be deemed generic based simply on questionable interpretations of decisions made in other cases regarding other claimed trademarks and other facts. In none of the cases cited by the PTO was there an admission (by an administrative tribunal of the PTO itself) that the mark simply cannot be used generically; in none was there an admissible consumer survey confirming the primary significance of the term was as a trademark; in none was the mark in issue the leading brand in its field; and in none was there unrebutted scientific evidence confirming that the theory of genericness propounded by the party with the burden of proof was refuted by settled linguistic principles. Simple common sense indicates that, merely by looking at other decisions on other evidence concerning other “.com trademarks,” one cannot assess whether, as a matter of fact, consumers recognize BOOKING.COM as a trademark (or, rather, as a term that applies to all other travel agencies, such as Expedia or Travelocity, in the same way that “computer” refers to IBM, Apple, Hewlett Packard or other machines). This is particularly true given the status of BOOKING.COM as perhaps the best-known and most successful brand for such travel services.

No principle of jurisprudence supports deciding factual issues in this manner, nor does the Lanham Act permit any special carve-out for particular types of trademarks. There is simply one test of genericness applicable to all trademarks.

Nor does law or logic (or undisputed linguistic science presented in the District Court) permit assessing the elements “booking” and “.com” in isolation, and then postulating that if each could be assumed generic, the whole could likewise be deemed generic irrespective of the primary significance test as applied to the whole. As a starting point, blackletter law requires that marks cannot be dissected into individual elements. *Estate of P.D. Beckwith v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.”). *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, succinctly explained why there can be no such procedural short-cut in deciding the factual issue of genericness for compound terms such as BOOKING.COM:

[T]o determine whether a mark is generic ... the Board must first identify the genus of goods

or services at issue, and then assess whether the public understands the mark, as a whole, to refer to that genus. *Marvin Ginn*, 782 F.2d at 990. On appeal, Frito-Lay cites our decisions in *Gould* and *American Fertility* to suggest that the Board can somehow short-cut its analysis of the public's perception where "the purported mark is a compound term consisting merely of two generic words." ... [H]owever, there is no such short-cut, and the test for genericness is the same, regardless of whether the mark is a compound term or a phrase.

786 F.3d 960, 966 (Fed. Cir. 2015). For just this reason, COCA-COLA can be (and plainly is) recognized by consumers as a trademark despite simply being two generic terms separated by a hyphen. Likewise AMERICAN AIRLINES is simply two generic terms, but is hardly a generic term for all United States airlines.

Nor was there even any evidence that the individual element "booking" is used generically – for instance that the word

“booking” has ever been used by anyone to refer to reservation services in general (*e.g.*, “I just logged on to my booking;” or “Expedia is one of several ‘bookings’”). And controlling precedent (at least in the Federal Circuit) is that the element .com is descriptive, not generic. *In re Oppedahl & Larson*, 373 F.3d 1171, 1176 (Fed. Cir. 2004) (“Appellant’s identification of goods includes the use of the Internet. Accordingly, ‘.com’ is descriptive of this feature of the goods listed in the application”).

The PTO now asks this Court to jettison settled law and convert the factual issue of genericness into an issue of law. The PTO thus presents the question for this Court as “[w]hether the addition by an online business of a generic top-level domain (.com”) to an otherwise generic term can create a protectable trademark.” Pet’r’s Br. at (I). Although no court has ever so-ruled, the PTO hopes that this Court will create a new rule at odds with settled precedent under which marks can be dissected into separate pieces, and factual questions about the descriptiveness or genericness of the constituent elements set aside. Because the PTO admits (and prior cases have found) that some marks potentially fitting its criterion are registrable and protectable, it is also impossible to know how such a *per se*

rule would be applied.

Stated differently, the PTO seeks a *per se* rule that some class of marks are generic as a matter of law, even where it is unable to sustain its burden of proving that the primary significance to consumers is other than as a trademark. Despite the PTO's claims of a conflict between the decision below and decisions from the Federal and Ninth Circuits, none of the decisions cited by the PTO created a *per se* rule that a mark formed from an allegedly generic term and a top-level domain ("TLD") is generic as a matter of law, and relevant precedent holds that ".com" is descriptive, not generic. *Oppedahl & Larson*, 373 F.3d at 1176. Like the District Court and Fourth Circuit below, each of the decisions cited by the PTO determined genericness as a question of fact.²

² See *Advertise.com, Inc. v. AOL Advert., Inc.*, 616 F.3d 974 (9th Cir. 2010) ("[W]e create no *per se* rule against the use of domain names, even ones formed by combining generic terms with TLDs, as trademarks"); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1306 (Fed. Cir. 2009) ("The Board's finding that HOTELS.COM is

As noted above, the PTO is also simply incorrect that the Fourth Circuit decision in any way conflicts with prior Federal Circuit precedent. Indeed, the Federal Circuit's 2004 decision, *Oppedahl & Larson*, deemed the claimed mark PATENTS.COM descriptive (not generic), concluding that "TLD marks may obtain registration upon a showing of distinctiveness . . . [and] [t]he Board properly left that door open for this patents.com mark" 373 F.3d at 1176. The Federal Circuit likewise introduced this concluding section of its decision by specifically noting that it would be "legal error" to preclude registration of the ".com" trademark where secondary meaning is proven. *Id.* at 1175-76. It also noted separately that it would allow registration of .com marks without proof of acquired distinctiveness if the mark had some

generic was supported by substantial evidence."); *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009) (holding that "substantial evidence [supported] the Board's conclusion" that MATTRESS.COM is generic); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1380 (Fed. Cir. 2007) (holding that "substantial evidence [supported] the board's finding" that LAWYERS.COM is generic).

inherent distinctiveness, citing the hypothetical “Tennis.net” for example. *Id.* at 1175. The court further ruled that the element .com is descriptive, not generic. *Id.* at 1176. No *en banc* panel of the Federal Circuit has ever overruled *Oppedahl & Larson*, and thus it remains the controlling law in the Federal Circuit.³

Here, consistent with *Oppedahl & Larson*, the PTO conceded the existence of secondary meaning in the name BOOKING.COM, which the Fourth Circuit deemed critically important. Pet’r’s App. at 8a. Disregarding the facts, in what is simply a factual inquiry, the PTO instead now seeks to create a new rule under which evidence of primary significance and evidence of secondary meaning (*i.e.*, that consumers do actually recognize a term as a trademark) can be excluded as a matter of law based on some undefined *a priori* classification of

³ Because no *en banc* panel of the Federal Circuit has ever overruled *Oppedahl & Larson*, it remains controlling over later Federal Circuit decisions to the extent they are inconsistent. *See Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988); *McMellon v. United States*, 387 F.3d 329, 334 (4th Cir. 2004).

trademarks. The Lanham Act permits no such sub-class of marks and no case has ever held that genericness can be decided as a matter of law. Nor has the PTO even attempted to define with any precision what this subclass would be.

Oppedahl & Larson also demonstrates the PTO's error in citing *Goodyear's India Rubber Glove Manufacturing Co. v. Goodyear Rubber Co.*, as proof that ".com" marks cannot be protected. 128 U.S. 598 (1888). *Goodyear's*, decided 60 years before the Lanham Act (and 110 years before the commercial internet), made no finding of genericness, instead referring to "Goodyear Rubber" as descriptive terms. *Id.* at 602. Indeed, at the time, descriptive and generic terms were equally unprotectable under the common law. *Canal Company v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871). It was not until the Lanham Act that descriptive terms could be protected. This Court has previously distinguished decisions from before the enactment of the Lanham Act because the Act "significantly changed and liberalized the common law to 'dispense with mere technical prohibitions,' most notably, by permitting trademark registration of descriptive words . . . where they had acquired 'secondary meaning.'" *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 171

(1995).

Even assuming *Goodyear's* was referring to genericness under the common law of the day (as distinct from descriptiveness), it did not articulate the “primary significance” test, so it is impossible to know what standard it used. However, *Oppedahl & Larson* specifically distinguished *Goodyear's* in concluding both PATENTS.COM *and the element “.com” itself* are descriptive, not generic, and hence protectable on a showing of secondary meaning. *Oppedahl & Larson*, 373 F.3d at 1175-76. *Oppedahl & Larson* thus clarified that even if entity designations such as “Corp.” have no inherent source-identifying function (which is true of all descriptive terms), “TLDs immediately suggest a relationship to the Internet,” and therefore the Court found that *Goodyear's* “does not operate as a per se rule . . . with respect to TLDs.” *Id.* at 1175. In *In re Steelbuilding.com*, the Federal Circuit reiterated that “*Goodyear's* did not create a per se rule for TLD indicators” and found that the applicant’s “TLD indicator expanded the meaning of the [STEELBUILDING.COM] mark” and was therefore descriptive. 415 F.3d 1293, 1299 (Fed. Cir. 2005).

Indeed, common sense reveals how the element “.com” alters the meaning of words, as the primary meaning of “Amazon” is a river (or to classics scholars, a race of women warriors), yet addition of “.com” immediately changes its meaning. And while “staples” are any kind of necessity or a specific type of office supply to bind papers, Staples.com is a leading retailer of office supplies and a mark that was registered by the PTO.

Moreover, applying the Lanham Act (rather than the common law as it existed in 1888), the PTO itself has registered several such marks, including the well-known retail chain, THE LIMITED (Reg. Nos. 4,108,367 and 1,062,519); INC. (Reg. No. 3,303,369), INCORPORATED (Reg. No. 5,276,951) and COMPANY (Reg. No. 1,192,531). As a factual matter, the PTO is simply wrong in citing *Goodyear's*, conflating descriptiveness and genericness. Even these marks can acquire secondary meaning. It offered no contrary proof below and has no basis to argue otherwise now.

Similarly, and more directly relevant, the PTO regularly permits the registration of what it now refers to as “generic.com” marks (a term it never precisely defines). In addition to STAPLES.COM for online retail services for office supplies (Reg. No.

2,397,238), it has registered WEATHER.COM for “on-line publications . . . in the field[] of meteorology,” (Reg. No. 2,699,088), ANCESTRY.COM for “on-line electronic databases in the field of genealogy research,” (Reg. No. 3,568,993), ANSWERS.COM for “[p]roviding specific information as requested by customers via the Internet,” (Reg. No. 3,862,166), CHEAPTICKETS.COM for “travel agency services, namely, making travel arrangements; [and] making reservations and bookings for transportation,” (Reg. No. 2,665,841), and only two weeks after filing its Petition for Certiorari, the PTO issued a registration for “SCUBA.COM” for “[c]omputerized on-line retail store services in the field of scuba equipment,” (Reg. No. 5,807,062).⁴ These registrations

⁴ Many other such examples of marks the PTO has registered are in the record, including: LOCAL.COM; CHEAPROOMS.COM; MONEYLAUNDERING.COM; WWW.HEDGEFUNDRESEARCH.COM; WORKOUT.COM; PARTYDIGEST.COM; UNIVERSITYJOBS.COM; ORANGECOUNTY.COM; DEALER.COM; DIAPERS.COM; REPLACEYOURCELL.COM; SKI.COM;

demonstrate that the PTO's alleged concern with "serious and immediate anticompetitive harms" should be given little weight,⁵ Pet'r's Br. at 26, and fundamentally undermine the premise of its petition that a subclass of trademarks can, a priori, be refused protection irrespective of all evidence of actual consumer understanding. This is not to say such names are inherently distinctive; but as recognized in *Oppedahl & Larson*, admitting they may be descriptive does not preclude them from becoming protected if they acquire secondary meaning, and does not require redefining the plain statutory and precedential meaning of "generic" to say they literally have come to mean and to designate entire classes of goods and services.

BUYLIGHTFIXTURES.COM;
ENTERTAINMENT.COM;
DICTIONARY.COM; REGISTER.COM;
TUTOR.COM; WEBMD; BESTBUY.COM.

⁵ Furthermore, while the PTO expresses concern for "competitors operating domain names such as 'roomsbooking.com,' 'hotelbooking.com,' 'ebooking.biz,'" and ebooking.com, notably, none of these entities opposed Booking.com's applications when they were published for opposition.

While many such trademarks may be descriptive and unprotectable without proof of secondary meaning (perhaps without substantial proof of secondary meaning), in this case there was overwhelming evidence that the primary significance of BOOKING.COM is not as a generic term for all hotel reservation services but as a mark identifying Booking.com as the particular source of certain uniquely valued reservation services. For example, Booking.com presented survey evidence “indicating that 74.8% of consumers recognized BOOKING.COM as a brand rather than a generic service” (Pet’r’s App. at 6a), and in this case (unlike any other) the PTO expressly conceded that it is logically and grammatically impossible to use the term BOOKING.COM as a generic term for anything (Pet’r’s App. at 166a). Nor did the PTO offer any evidence to challenge the expert testimony of Princeton linguistics professor Sara Jane Leslie that as a matter of settled linguistic science, it is impossible for words to have meanings independent of use. Pet’r’s App. at 86a. In contrast to the evidence presented by Booking.com, the District Court noted as “striking . . . the absence of evidence that consumers or producers use the term booking.com to describe . . . hotel and travel reservation services.” Pet’r’s App. at 86a.

It is true that, without overruling *Oppedahl & Larson*, the Federal Circuit more recently has affirmed, on their facts and under a specific standard of review inapplicable here, administrative decisions of the PTO rejecting other .com marks, such as “HOTELS.COM” and “MATTRESS.COM.” *In re Hotels.com*, 573 F.3d 1300; *In re 1800Mattress.com*, 586 F.3d 1359.⁶ However, both the District Court and the Fourth Circuit correctly distinguished these cases as having been decided *on their facts* and the different *standards of review there at issue*. Pet’r’s App. at 23a & n.12, 74a. In none of the cases cited by the PTO was there an admission (by the PTO itself) that the mark simply cannot be used generically; in none was there an admissible consumer survey confirming the primary significance of the term was as a trademark; in none was the mark in issue the leading brand in its field; in none was there unrebutted scientific evidence confirming the theory of genericness was contrary to science. *See In re Hotels.com*, 573 F.3d 1300; *In re 1800Mattress.com*, 586 F.3d 1359; *In re Reed*

⁶ *But see In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001) (“Dial-A-Mattres” not used generically, hence not generic).

Elsevier Props., 482 F.3d 1376; *Advertise.com*, 616 F.3d 974. Nor does any principle of jurisprudence permit adjudicating purely factual issues in one case based on factual holdings in another where the claimant was not even a party. And none of these cases held that some class of trademarks can be deemed generic as a matter of law.

As noted, the PTO's petition nowhere even mentions the burden of proof it faced here much less the standard of review⁷ in the district court or on appeal. Even if the facts in the cases cited by the PTO were anything more than superficially similar to the facts here, those cases did not overrule *Oppedahl & Larson* (see *supra* note 3), and could not possibly justify reversing the purely factual determination in this case that the best-

⁷ Whether a trademark is generic is a question of fact which the PTO bears the burden of proving by "clear evidence." See *Swatch AG*, 739 F.3d at 155; *In re Merrill, Lynch*, 828 F.2d at 1570. A court's factual findings, including on the question of genericness, should not be disturbed unless they are clearly erroneous. See Pet'r's App. at 7a; *Pizzeria Uno Corp.*, 747 F.2d at 1526-27.

known brand in its field is indeed entitled to protection. Similarly, in *Advertise.com, Inc. v. AOL Advertising, Inc.*, the Ninth Circuit merely held that AOL, in seeking a preliminary injunction, failed to demonstrate that it was likely to succeed on the merits. 616 F.3d 974, 981-82 (9th Cir. 2010). The Court found that “Advertise.com is likely to rebut the presumption of validity and prevail on its claim that ADVERTISING.COM is generic” for “online advertising” or “internet advertising,” but at the same time the Court did not “foreclose the possibility that AOL might prove its case on a fully developed record.” *Id.* Furthermore, unlike the present case, even the limited factual record specifically supported the conclusion that it was grammatically possible to use the term generically, as in “Could you refer me to an advertising dot-com?” *Id.* at 978. Nor was there a survey or other evidence in *Advertise.com* that the claimed mark in issue was in fact widely recognized as a trademark – indeed as one of the top brands in its field. In fact, the Ninth Circuit noted that such evidence might alter the result. *Id.* at 982 (“It is not inconceivable but certainly highly unlikely that consumer surveys or other evidence might ultimately demonstrate that AOL’s mark is valid and protectable.”). There is thus no conflict with the factual findings here. Nor is there any legal basis to

convert the factual issue of genericness into one of law.

II. FACTUAL BACKGROUND

The record here confirms that Booking.com is one of the best-known travel and accommodations services in the United States (and the world), with unparalleled recognition and millions of active followers and users). For instance, referring only to the evidence expressly cited by the courts below, even as of September 2016, Petitioner's BOOKING.COM branded website had long-since been generating billions of dollars in U.S. revenues and transactions. *See* Pet'r's App. at 100a. Over 5 million Facebook members *voluntarily* liked Booking.com, and approximately 5.4 million U.S. customers *freely chose* to download its mobile application between 2014 and the close of evidence. *See* Pet'r's App. at 100a-103a. Over 1,200 U.S. news articles referenced BOOKING.COM between January 2015 and September 2016 alone. *See* Pet'r's App. at 100a-103a. Extensive other evidence cited by the courts show brand recognition. *See* Pet'r's App. at 97a-103a.

Although the mark BOOKING.COM was initially approved for registration, the

PTO changed course, withdrawing its approval and beginning a dispute that has lasted since 2012. In 2016, the PTO's administrative tribunal, the Trademark Trial and Appeal Board ("TTAB") concluded "it is impossible to use BOOKING.COM in a grammatically coherent way to refer generically to anything," and that "it is not at all logical to refer to a type of product or service as a 'booking.com.'" Pet'r's App. at 166a. Although there was also no evidence that consumers had ever used the term generically (as in "I logged on to my 'booking.com' to make a reservation), the TTAB nonetheless concluded that the name should be deemed generic because consumers might nonetheless somehow "understand" the term generically.

Booking.com thereafter sought de novo review under Section 1071 in the District Court for the Eastern District of Virginia. Pet'r's App. at 46a, 53a. Booking.com there presented an unrebutted consumer survey confirming that 74% of consumers of travel services recognize BOOKING.COM as a trademark. Pet'r's App. at 88a-95a. It also presented evidence of the vast extent of consumer use and recognition of the brand for travel services. It showed that the BOOKING.COM travel service was recently picked by the research and analytics firm,

JD Power and Associates, as having the highest customer satisfaction rate of any travel site in the United States. Pet'r's App. at 98a, 53a. The PTO offered no evidence to challenge Appellee's showing that BOOKING.COM enjoys unparalleled consumer loyalty in the travel industry and has *never* been used generically for such services. *See* Pet'r's App. at 85a-87a, 102a. Nor did the PTO challenge the evidence submitted by the Princeton-based linguistics expert that linguistic science refutes the TTAB's assumption that it is possible for terms to acquire meaning when it is logically and grammatically impossible actually to use the terms that way. *See* Pet'r's App. at 86a & n.12, 53a. Despite bearing the burden to prove genericness by clear evidence, the PTO never offered any evidence to rebut such scientific fact.

Booking.com further argued that to deny protection to BOOKING.COM would subvert the very purpose of the Lanham Act of protecting consumers by inviting competing businesses to deceive customers by exactly copying the name and falsely advertising who they are, while stripping Booking.com of its power to prevent such piracy and prevent consumer confusion.

To sustain its burden of proof, the

PTO also offered no direct evidence of the primary meaning of BOOKING.COM to any given class of consumers, such as a survey or evidence of actual use. *See* Pet'r's App. at 85a. Consistent with the TTAB finding that it is impossible to use BOOKING.COM generically, there is no evidence that any other businesses offering travel services or consumers using travel services have ever referred to such services as "Booking.coms" or even as "Bookings." *See* Pet'r's App. at 85a. Nor is there any evidence anyone has ever used the word "booking" to denote a class of travel services (e.g., "I just contacted my booking to make a reservation"). The PTO instead cited computer-generated searches of character strings of third party domain names, such as "instantworldbooking.com," in which one must hunt to find the characters "b-o-o-k-i-n-g.-c-o-m." *See* Pet'r's App. at 87a. As the District Court noted, none of these sites use the name BOOKING.COM generically (Pet'r's App. at 87a); nor is there any evidence how many (if any) consumers have even visited such sites.

The primary meaning of the word "booking" alone in the dictionaries the PTO cited is "an arrangement for a person or group (such as a singer or band) to perform at a particular place." *See* Pet'r's App. at

188a-189a.

The District Court agreed with Booking.com that its mark is protectable. Pet'r's App. at 106a. The PTO appealed to the Fourth Circuit, which, on February 4, 2019, affirmed that BOOKING.COM is a protectable trademark. Pet'r's App. at 25a. In that proceeding, the PTO conceded that BOOKING.COM enjoys secondary meaning. *Id.*

III. ARGUMENT

A. The PTO Misstates the Distinction Between Genericness and Descriptiveness

The PTO notes the distinctions between the five categories in which terms are classified for the purpose of determining distinctiveness and protectability of marks, namely: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). However, the PTO misstates the *quantum difference* between descriptive trademarks (such as "American Airlines," "International Business Machines," "Coca-Cola," "Citibank," "Bank of America," "Facebook," or "Patents.com") that communicate information about the products or services,

and truly generic terms. The PTO fails to mention that a generic term is not just “one that refers to the genus of which the particular product is a species,” but rather one whose *primary significance* is identifying such a genus – such as “computer” or “travel agent” or “automobile.” *Compare* Pet’r’s Br. at 3, *with Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 530 (7th Cir. 2003) (finding primary significance of BEANIES was as a source identifier when survey showed 60% believed it was a source identifier and 36% thought it was generic). The very fact that there are other actual generic terms for the services Booking.com provides (e.g., travel agent, travel reservations service) sharpens the contrast with the trademark BOOKING.COM and supports a finding of non-genericness. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (“There is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as ‘1-888-M-A-T-R-E-S-S.’ ‘Telephone shop-at-home mattresses’ or ‘mattresses by phone’ would be more apt generic descriptions.”).

Even if it is true that BOOKING.COM communicates information that the service provides travel reservation services, that at most only proves descriptiveness, not genericness, which requires considerably

more – namely that the primary meaning of the term to consumers is to designate an entire class of services. *In re Chamber of Commerce*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (“A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.”). Legally, there is a quantum difference between generic terms, which cannot be protected, from descriptive terms, such as AMERICAN AIRLINES (clearly communicating “an airline in America”) or PATENTS.COM (clearly communicating information about patents), *Oppedahl*, 373 F.3d at 1176-77, or STEELBUILDING.COM, *In re Steelbuilding.com*, 415 F.3d at 1298. Such terms simply require proof of secondary meaning to be protected. And here, the PTO already conceded the existence of secondary meaning, which strongly indicates the term is in fact primarily recognized as a trademark.

Even “suggestive” marks can communicate information about the goods or services but nonetheless are immediately protectable on adoption, such as FIRE CHIEF for a *magazine* for firefighters (as distinct from “fire chiefs” themselves), *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 991 (Fed. Cir.

1986), or SEATS, which is generic for chairs themselves but *cannot* be generic for reservation *services*, because it merely describes the end result (a seat), not the *service itself*. *In re Seats, Inc.*, 757 F.2d 274, 277-78 (Fed. Cir. 1985).⁸ Likewise, in *Elliot v. Google Inc.*, the Ninth Circuit held that

⁸ Appellant contends that BOOKING.COM is “suggestive” under *Perini Corp. v Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990). Considered alone, the element “BOOKING” ambiguously could imply many disparate things. Pet’r’s App. at 64a. Even the meaning “reservation” does not literally describe Appellant’s travel agency *services* as such, but only the *result* of one reservation-related service, just as “SEATS” is protectable for being at least descriptive if not suggestive. *In re Seats*, 757 F.2d at 277-78. The full trademark BOOKING.COM is not even a known word in the English language. Examples of marks *held* suggestive include: *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118 (9th Cir. 2014) (“Pom” for pomegranate juice); *Bose Corp. v. Int’l Jensen, Inc.*, 963 F.2d 1517 (Fed. Cir. 1992) (“Acoustic Research” for loudspeakers); *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540 (11th Cir. 1984) (“Citibank” for urban bank).

“GOOGLE” can be generic for internet searching (a verb) but not for “internet search engines.” 860 F.3d 1151, 1162-63 (9th Cir. 2017).

“[P]lacement of a mark on the fanciful-suggestive-descriptive-generic continuum is a question of fact.” *Oppedahl & Larson*, 373 F.3d at 1173. As the District Court here noted, precisely “because ‘categorizing trademarks is necessarily an imperfect science,’ 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 ...” Pet’r’s App. at 74a (quoting *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1033 (9th Cir. 2010)). The decision here of the district court, upheld by the Fourth Circuit, must now be upheld absent clear error.

In this case, as in many others like it, the primary significance (and hence non-genericness) of the mark was confirmed by consumer survey evidence. *See Berner Int’l Corp. v. Mars Sales Co.*, 987 F.2d 975, 982 (3d Cir. 1993) (“Consumer surveys have become almost de rigueur in litigation over genericness”); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 969

(Fed. Cir. 2015) (“We . . . have recognized that ‘consumer surveys may be a preferred method of proving genericness.’”). The survey here was conducted under settled standards and in a format that is accepted universally. Indeed, it was entirely within the discretion of the District Court to admit the “Teflon⁹” study presented here, a format routinely accepted in litigations where descriptive terms were found not generic. *Automobile Club of Southern Cal. v. The Auto Club, Ltd.*, 2007 WL 704892 at *4 (C.D. Cal. Mar 15, 2007) (AUTO CLUB); *In re Callaway Golf Co.*, 2001 WL 902004 at *7 (T.T.A.B. Aug 9 2001) (STEELHEAD for golf clubs); *Ty, Inc. v. Softbelly’s, Inc.*, 353 F.3d 528 (7th Cir. 2003) (BEANIES for beanbag toys); *Burger King Corp. v. Pilgrim’s Pride Corp.*, 705 F. Supp. 1522, 1525-26, (S.D. Fla. 1988),), *aff’d*, 894 F.2d 412 (11th Cir. 1990) (“CHICKEN TENDERS”); *Sportschannel Assocs. v. Commissioner of Patents and Trademarks*, 903 F. Supp. 418

⁹ A “Teflon” survey first instructs respondents on the difference between generic terms and trademarks, and then has them categorize the mark in issue along with other controls. *E.I. DuPont de Nemours & Co. v Yoshida Int’l, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975).

(E.D.N.Y. 1995) (SPORTSCHANNEL for cable channel devoted to sports); *March Madness Athletic Ass'n, LLC v. Netfire, Inc.*, 310 F. Supp. 2d 786, 804-09 (N.D. Tex. 2003) (MARCH MADNESS).

The PTO performed no survey of its own (or at least offered none in evidence) to support its burden of proof. The evidentiary decision by the district court (affirmed by the Fourth Circuit) to accept Booking.com's survey evidence here is not properly subject to review now. *PBM Prod., LLC v. Mead Johnson & Co.*, 639 F.3d 111, 123 (4th Cir. 2011) (“[O]bjections based on flaws in the survey's methodology are properly addressed by the trier of fact.”); *Honestech, Inc. v. Sonic Sols.*, 430 F. App'x 359, 360 (5th Cir. 2011) (“This court reviews a trial court's decision regarding the admissibility of expert testimony under an abuse of discretion standard, and it will reverse the district court only if ‘the ruling is manifestly erroneous.’ ‘Manifest error is one that is plain and indisputable, and that amounts to a complete disregard of the controlling law.’”).¹⁰

¹⁰ The PTO's suggestion that there was some defect in the survey because the

element “.com” is “functional” draws on comments of the dissenting Judge Wynn in the Fourth Circuit. However, the survey itself demonstrates that consumers don’t see BOOKING.COM as a non-generic mark simply because it ends in “.COM.” The survey also included WASHINGMACHINE.COM, which 60% of respondents thought was generic versus only 24% for BOOKING.COM. The dicta in *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 823 (4th Cir.), cert dismissed, 534 U.S. 946 (2001), cited by the PTO, concerning the functions served by the phrase “You Have Mail” is at best an unusual application of a doctrine applicable to the anticompetitive nature of allowing companies form obtaining perpetual, patent-like protection for a *product feature*. As this Court explained in *TraFFix Devices, Inc. v. Marketing Displays, Inc.*:

Discussing trademarks, we have said "in general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" *Qualitex*, 514

U.S. at 165 (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n. 10, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982)). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant nonreputation-related disadvantage." 514 U.S. at 165.

532 U.S. 23, 32 (2001).

However, even if functionality had any relevance to word marks, the limitless available URLs for travel sites defeats any suggestion that competitors need to use BOOKING.COM. Merely that a URL has "a function" is consistent with the name also being a trademark (e.g., AMAZON.COM). Indeed, to the extent that a ".COM" address functions as a means of identifying a particular webpage, all trademarks function in a similar fashion by identifying a source – that is not the type of function that the functionality doctrine is designed to address. It is also impermissible to dissect the mark BOOKING.COM into components. The very

Moreover, the case cited by the PTO, *Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251 (4th Cir. 2001), upholding a finding that an already (and admittedly) non-distinctive restaurant name, “Crab House,” was generic does not support a finding that the Fourth Circuit committed an abuse of discretion in agreeing with the district court that Booking.com’s survey was admissible. In *Hunt Masters*, the plaintiff had earlier *admitted* the ubiquitous name “crab house” was unprotectable when it disclaimed the term during prosecution of its trademark. *Id.* at 253. Since the term was already generic, it could not *later* be removed from the public domain. *See id.* at 255. The court nowhere suggested that proper “Teflon” surveys could be rejected any time there is a *dispute* about whether a mark is generic or not. Any such rule would be circular in first simply assuming a mark is generic on some *a priori* grounds. As the District Court and the Fourth Circuit correctly found, there is no evidence the mark BOOKING.COM was commonly used (or used at all) before its association with Booking.com. Pet’r’s App.

point of all of the evidence of consumer recognition of BOOKING.COM is to show that the name means far more than simply some web address.

at 17a, 91a-92a. To the contrary, the PTO admitted it was logically and grammatically impossible for the name to refer to anyone other than Booking.com.

More broadly, the error in the PTO's challenge to Booking.com's survey evidence is its circular reasoning to escape its burden of proof. Although it is true that once a mark is held generic, most courts will thereafter refuse to remove the mark from the public domain no matter how much proof of secondary meaning is offered, that is not the question here, where the coined term BOOKING.COM has never been held generic and there been no admission by Booking.com that it lacks distinctiveness. And no case (including any of those cited by the PTO) has ever held that, in the first instance, a mark can be deemed generic as a matter of law, irrespective of the evidence, so as to preclude the finder of fact from even assessing whether the primary significance of the mark to consumers is or is not to refer to the specific trademark owner or to an entire class of goods or services. Here, the PTO simply asks this Court to ignore all of the evidence that consumers do in fact recognize BOOKING.COM as a trademark (indeed, as perhaps the best-known name in the field of on-line reservation services) to satisfy an a priori conclusion that some undefined class

of trademarks should be deemed generic as a matter of law. As noted, no precedent has ever so-held, and the PTO has not even attempted to define the supposed legal rule it wishes to erect to avoid its burden of proof. Is STAPLES.COM no longer protectable? What about COCA-COLA? The Lanham Act creates no such special (inferior) class of trademarks, and no case has ever held that a fact-finder is not even permitted to consider survey evidence or other proofs to assess consumer understanding so as to relieve the party with the burden of proof of its responsibilities.

**B. Denying Registration of
BOOKING.COM Frustrates the
Purposes of the Lanham Act**

The PTO speculates that allowing the best-known internet travel service to register its name will somehow lead to abusive practices in the form of challenges to other domain names incorporating the character string “b-o-o-k-i-n-g-.c-o-m” such as “roomsbooking.com,” “hotelbooking.com,” and “ebooking.biz.” *See* Pet’r’s Br. at 16. Just as no principle of jurisprudence permits deciding the factual issue of genericness merely by analogy to other precedents, no principle of jurisprudence permits the denial of trademark protection based only on such

bare speculation of possible future improper motives. Not only does the PTO present no evidence that Booking.com is contemplating infringement suits against such sites, or that such suits would be successful, but contrary to the PTO's theory of significant risk to these websites, notably, none of these entities opposed Booking.com's applications when they were published for opposition. The PTO's inability to demonstrate any significant risk is entirely predictable if one pauses to consider the actual standard to prove likelihood of confusion (including readily available defenses) as well as the PTO's own admission that it is impossible to use the name BOOKING.COM to refer to anything other than Booking.com's services.

Enacting the Lanham Act in 1946, Congress recognized two reasons to protect trademarks: (1) "to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get"; and (2) "where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats." S. Rep. 1333, at 1 (1946), reprinted in 1946 U.S. Code & Cong. Serv. 1274, 1274. *Qualitex Co.*

v. Jacobson Prods. Co., 514 U.S. 159, 163-164 (1995) (“[B]y preventing others from copying a source-identifying mark, [trademark law] reduce[s] the customer’s costs of shopping and making purchasing decisions” by assuring them they can rely on known marks).¹¹ When Congress confirmed the meaning of the term “generic” in 1984, it explained:

Because of their importance to our nation’s commerce, trademarks long have been protected from appropriation and misuse by others, both to protect the consumer from deception and confusion and to insure that producers are rewarded for their investment in the manufacture and marketing of their product.

¹¹ “The trademark laws exist not to ‘protect’ trademarks, but . . . to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.” *James Burroughs, Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976).

S. Rep. No. 98-627, at 2, reprinted in 1984 U.S.C.C.A.N. 5718, 5719. Refusing to protect BOOKING.COM defeats the very purposes of the Lanham Act by encouraging third parties to trade on plaintiff's singular reputation and blatantly mislead consumers, including by falsely advertising themselves as being part of Booking.com or otherwise directly misleading consumers.

Dozens of accommodations services compete actively with Booking.com without any need to use the name. The PTO also asserted that registering BOOKING.COM might “deprive competing manufacturers of the right to call an article by its name” (Pet’r’s Br. at 19), which is impossible to reconcile with the PTO’s admission that it is *logically impossible* to use the name to denote travel agency services. Where, as here, there are ample readily available terms for the genus of services, such as “travel agency” or “travel site” or “accommodation site,” this is positive evidence that the disputed term is *not* generic. *Elliot v. Google*, 860 F.3d at 1162 (“Elliott must show that there is no way to describe ‘internet search engines’ without calling them ‘googles.’”), citing *Q-TIPS, Inc. v. Johnson & Johnson*, 108 F. Supp. 845, 863 (1952) (distinguishing the claimed mark, Q-TIPS, from the descriptor, “double-tipped

applicator”); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed. Cir. 2001) (“Telephone shop-at-home mattresses” or “mattresses by phone” more apt generic descriptions than “1-888-M-A-T-R-E-S-S”). Booking.com’s competitors such as Orbitz, Expedia, Travelocity, Trip Advisor all seem quite able to provide travel services under other trademarks without any need to use BOOKING.COM descriptively, much less generically. In the marketplace, BOOKING.COM uniquely identifies Booking.com and its services.

Registering BOOKING.COM will have no effect on the burden Booking.com would have to prove likelihood of confusion, which typically turns on a multipart test all jurisdictions follow, based on the seminal decision, *Polaroid v Polarad*, 287 F.2d 492, 493 (2d Cir. 1961). For the PTO to speculate whether or if Booking.com might challenge hypothetical use of names such as “roomsbooking.com” or “hotelbooking.com,” asks this Court to imagine unknown factual scenarios as to how closely a hypothetical third party was copying the overall appearance of the Booking.com website; how competitive such a service might be; what parts of the market are targeted and how sophisticated are the users; what is the intent of the hypothetical user and whether

there is evidence of actual confusion. Nor would registration of the mark BOOKING.COM deprive third parties of the right to make *descriptive fair use* of the word “booking” – for travel, theatrical engagements, or other uses. *See* 15 U.S.C. § 1115(b)(4); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004). Denying registration will only free unscrupulous competitors to prey on its millions of loyal consumers by falsely advertising as “Booking.com” or making deceitful direct promotions. Given the extraordinary popularity of Booking.com, such risks are substantial.

Judge Posner noted in *Ty, Inc. v. Softbelly’s Inc.*, that “[t]o determine that a trademark is generic and thus pitch it into the public domain is a fateful step.” 353 F.3d at 531. For the PTO to conclude that the consumer-ranked top accommodations website with literally *millions* of active followers and a 74% recognition rate as a brand is not permitted to protect the trust reposed in the service by millions of loyal customers or the millions of dollars it has invested in its name is a step that should not be lightly taken. It is entirely unsupported by the evidence and frustrates the very purpose of the Lanham Act

IV. CONCLUSION

For the foregoing reasons, the PTO petition for certiorari should be denied.

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Respectfully submitted,

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