

Booking it to the District Court

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by Cathy Dahl



A recent decision out of the federal district court for the Eastern District of Virginia overturned in part the Trademark Trial and Appeal Board's decision that the mark "Booking.com" is not registrable on the basis that the mark is generic.

Judge Brinkema presided over the case, and she determined that the mark BOOKING.COM had acquired secondary meaning for "hotel reservation services" in Class 43, but not for "travel agency services" in Class 39.

This case is unusual because the trademark applicant, Booking.com, B.V., did not appeal the refusal decision to the Court of Appeals for the Federal Circuit, but instead filed a civil suit against the Director of the U.S. Patent and Trademark Office. This allowed the Virginia federal court to review the record *de novo* and as the finder of fact. An appeal to the CAFC would have been decided based upon the record before the PTO and the PTO's factual findings would have been upheld if such facts were deemed to be supported by "substantial evidence." In the district court action, Booking.com supplemented the record by submitting a "Teflon survey." The ability to submit the additional evidence that measured consumer opinion regarding the genericness of BOOKING.COM likely prompted the path of a civil action, rather than the appeal to the CAFC.

Judge Brinkema determined that the issue raised in this case was one of first impression in the 4th Circuit in which the Eastern District of Virginia resides, and decided that ".com" in combination with a descriptive word is capable of identifying source, upon a showing of acquired distinctiveness. The PTO raised various policy arguments against recognizing ".com" as a source identifier, including that it would contravene the Lanham Act to find a generic term registrable simply by adding ".com."

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Booking.com submitted its Teflon survey results, in which 74.8 percent of the respondents identified BOOKING.COM as a brand name, along with information regarding its advertising expenditures, sales records, unsolicited media coverage, and the length and exclusivity of the use of the BOOKING.COM mark. With all of this evidence under consideration, the court disagreed with the PTO's conclusion that the mark is generic as to both Class 39 and 43 services, holding instead that the mark was descriptive. Then, as to the Class 43 hotel reservation services, the court concluded that Booking.com had made a sufficient showing of acquired distinctiveness, but not as to the Class 39 travel agency services. As such, the court ordered the PTO to issue registrations for the BOOKING.COM mark for services in Class 43, but denied registration for services in Class 39.

Takeaways

- As a strategy point, consider filing a civil action rather than an appeal to the CAFC under similar circumstances. Filing in district court for a *de novo* review will allow for the submission of additional evidence and a review of the facts *de novo*.
- Proving acquired distinctiveness in a descriptive term coupled with “.com” or other TLD may result in a registration on the Principal Register at the PTO, but consider enforceability of the mark. If third parties can make use of “_____booking.com,” what have you really carved out in terms of valuable trademark rights?

Looking Ahead

Individuals David Elliott and Chris Gillespie tried to register hundreds of domain names incorporating the word “google,” arguing that the word is now generic. The U.S. Court of Appeals for the Ninth Circuit determined that “google” is not a generic word. Arguably, use of the mark as a verb (think historically of use of “Xeroxed” or “Fedexed”) could ultimately lessen trademark rights and lead to genericide if a campaign to correct such use is left in disregard. Elliott and Gillespie have petitioned for *certiorari* before the U.S. Supreme Court. We will see if the Supreme Court will take the case and issue an opinion on this related issue.