

Hearing:
January 31, 2006

This Opinion is Not
Citable as Precedent of
the TTAB

Mailed:
October 24, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hotels.com, L.P.

Serial No. 76414272

On Request for Reconsideration

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Sughrue Mion PLLC for Hotels.com, L.P.

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111 (Craig D. Taylor, Managing Attorney).

Before Walters, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hotels.com, L.P., a limited partnership of Texas,
sought registration of a composite word and design mark
including the term HOTELS.COM in a stylized form of
lettering. The examining attorney required applicant to
include a disclaimer of "hotels.com," which the examining
attorney determined to be generic for the identified
services.

On appeal, the Board upheld the disclaimer requirement, agreeing that the term is generic. Applicant now seeks reconsideration of that decision. Specifically, applicant argues that even if the examining attorney is viewed as having established a prima facie case of genericness, a point that applicant does not concede but assumes for the purpose of its request for reconsideration, applicant provided direct evidence that more than 60 declarants from among the relevant public do not view the term HOTELS.COM as a generic term. Applicant contends the Board either did not consider this evidence or did not accord this evidence proper weight. "To the extent the Board found this evidence to be merely evidence of de facto secondary meaning, or merely evidence of an association of the generic term with Applicant, the Board's decision is believed to be erroneous." Req. for Recon., p. 4. Accordingly, applicant contends that our decision requires correction.

The direct evidence on which applicant relies as support for its request for reconsideration consists of 64 declarations submitted as attachments to a declaration of Gregory S. Porter, general counsel and secretary of applicant. The Porter declaration introduces the attached declarations with the following statement:

9. As a result of the extensive use and advertising of the HOTELS.COM mark in connection with Hotels.com, L.P.'s online services, the mark has come to be widely recognized by the public and industry as denoting Hotels.com, L.P.'s services. Attached hereto as Exhibit D are 64 declarations from customers, competitors, and vendors of Hotels.com, L.P., and other persons familiar with the online services provided by Hotels.com, L.P. under the HOTELS.COM mark.

Because of the introductory phrase in the above quoted paragraph, "[a]s a result of the extensive use and advertising of the HOTELS.COM mark," we construe this paragraph as referring back to the information provided on use and advertising in paragraphs 3-8 of the Porter declaration. These paragraphs in the declaration pertain to applicant's claim of acquired distinctiveness.

Before further discussing the declaration evidence and applicant's request for reconsideration, it will be helpful to review some of the procedural history of the application and appeal, so as to view the evidence in context. When the declarations were filed, applicant was maintaining the alternative positions that "hotels.com" is inherently distinctive, and that even if the term is not inherently distinctive, it has acquired distinctiveness. In its response to the first office action, applicant contended that "hotels.com" is inherently distinctive because no two entities can have the same internet domain name. Applicant

also argued that the term has, at least, acquired distinctiveness. The Porter declaration and the 64 declarations submitted therewith were included with applicant's response to the second office action, and were stated by applicant to constitute "evidence of 'secondary meaning.'" Response of December 19, 2003, p. 2.

In contrast to these responses to office actions, applicant did not pursue on appeal the argument that "hotels.com" is inherently distinctive. Applicant conceded in both its main brief and reply brief that the term is descriptive, but argued that the term is not generic and has acquired distinctiveness. We did not construe the Porter declaration and the declarations attached thereto as evidence that the declarants recognize the term "hotels.com" as inherently source indicating both because they were offered as evidence of secondary meaning and because the appeal did not present a claim of inherent distinctiveness. As recognized by applicant, however, we did consider the declarations as evidence of acquired distinctiveness.

In its request for reconsideration, applicant does not argue that the declarations should have been considered as evidence of inherent distinctiveness. However, applicant does argue that the declarations are not merely evidence of

de facto distinctiveness of a generic term, and should have been considered in the first instance as significant evidence of the "non-genericness" of "hotels.com."

We note that applicant, in the section of its main appeal brief wherein it argued that "hotels.com" is not generic, did not reference the declarations as support for this contention; rather, applicant expressly relied on the declarations only in that section of its main brief wherein it asserted that the term "hotels.com" has acquired distinctiveness. We find applicant's argument, raised for the first time in a request for reconsideration, that the declaration evidence should be considered as evidence on "non-genericness" to be inappropriate. However, to the extent that we did not expressly address these declarations as pertaining to the issue of "non-genericness" in our decision, we do so now.

A review of the declarations reveals that they are essentially form declarations. An index of the declarations lists 18 of them as "business declarations" and the remaining 46 as "consumer declarations." Each of the declarations sets forth not the declarant's own words, but a set of statements that vary very little. The first statement in each of the businessperson declarations states that the declarant is "engaged in and thoroughly acquainted

with the business of hotel reservations, transportation and travel agency services,"¹ while the first statement in each of the consumer declarations states only that the declarant is "acquainted with the hotel reservation, transportation and travel agency industry as a consumer." Each business declarant, save two, then states, "to me personally, and among those persons involved in the hotel reservation, transportation and travel agency industry, the term HOTELS.COM is not the common, generic name of any product, service, or field of study."² Each consumer declarant states, "to me personally, the term HOTELS.COM is not the common, generic name of any product, service, or field of study." Clearly, the second statement in each of the 64 declarations is the same, except that the business declarants purport to speak not only for themselves but also as to the understanding of others involved in the industry. By the remaining statements in each of the 64 declarations, each declarant states that the term

¹ One of the 18 business declarations does not use the words "engaged in" but does use the words "thoroughly acquainted with." Another (exh. D-6) does not use the language quoted above, but instead recites the name of the declarant, his employer and what he does on the job for his employer.

² One business declarant substitutes "persons thoroughly acquainted with in [sic]" for the words "persons involved in." The other business declarant (exh. D-6) that does not use the exact phrase quoted above speaks only for himself, not for others in the industry.

"hotels.com" is a mark and serves as an indication of source.

Applicant's current argument that the declarations are evidence of "non-genericness" makes a very fine distinction, and there is no evidence that the declarants were intending, by signing what are clearly form declarations, to make such a fine point. There is no indication that the declarants are familiar with the distinctions between inherently distinctive marks and terms that have acquired distinctiveness, or between a generic term and a descriptive term. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1759 (TTAB 1991) (form declarations found to "lack persuasiveness on the issue of the primary significance of the term 'MULTI-VIS' to the purchasing public" when there was no indication that the declarants were "familiar with such technical concepts as mere descriptiveness, distinctiveness and the definition of a trademark.").

Each declaration bears a caption showing its relevance to the involved application and includes "Attorney Docket No. 2488.5." The statements that "hotels.com" is not generic, is a mark, and serves to indicate source are conclusory only. There are no explanations why the declarants believe these statements to be true. Further,

the caption to each declaration lists "MARK: HOTELS.COM & DESIGN." Thus, even if an individual asked to complete a declaration form had not reached an independent conclusion as to whether "hotels.com" was a mark or a generic term, the caption would suggest the answer. Form declarations that may not "actually reflect the views of the declarants" are entitled to "little weight." In re EBSCO Industries Inc., 41 USPQ2d 1913, 1916 (TTAB 1996).

The relevant public for determining genericness in this case is the general public, i.e., anyone who might need information about hotel rooms, or need to reserve a hotel room. Such a relevant public would include both business and leisure travelers, and the declarations submitted by applicant are asserted to be from both of these subclasses of the relevant public.³ The Porter declaration, however, explains that some of the businessperson declarations are from "customers" and "vendors" of applicant. Such businessperson declarants, being familiar with applicant, would not necessarily be reflective of the average business traveler not conditioned to associate "hotels.com" with applicant. See EBSCO Industries, supra (the only evidentiary value of

³ Tim Schmuckal, corporate counsel for Expedia, Inc., submitted declarations both as a businessperson and as a consumer.

declarations from declarants familiar with the applicant goes to the issue of acquired distinctiveness).

Finally, we note that 34 of the 64 declarations, including a majority of the consumer declarations, are from individuals employed by Interval Travel, Interval International Limited, or Interval International, Inc. (Interval declarants). Since 7 of the 34 Interval declarants are classified among the businessperson declarants that may already be familiar with applicant, we find it difficult to consider any real distinction between those 7 and the other 27 Interval "consumer" declarants. In other words, all 34 of these declarants may be particularly familiar with applicant and its use of "hotels.com." Similarly, there are also declarants from Collins & Scanlon LLP and from Expedia, Inc. listed in both the business and consumer lists of declarants. Thus, these declarants, too, may be particularly familiar with applicant.

Under these circumstances, we do not consider these declarants representative of the average member of the relevant public, be it a business traveler or a leisure traveler.

In conclusion, we do not find any error in our initial consideration of the evidence of these declarants, or in

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our decision not to accord the declarations significant probative value in determining how the relevant public perceives the term "hotels.com." The request for reconsideration is denied.