

2019-1214

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**IN RE GJ & AM, LLC,**  
Appellant

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Appeal from the United States Patent and Trademark Office,  
Trademark Trial and Appeal Board (Ser. No. 86/858,003)

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**SUPPLEMENTAL BRIEF FOR APPELLEE, DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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July 16, 2020

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## I. INTRODUCTION

The Director submits this supplemental brief in response to the Court’s July 2, 2020, order directing the parties to state “their positions relating to the appropriate action to be taken by the court as a result of the Supreme Court’s decision in [*United States Patent and Trademark Office v.*] *Booking.com* [B.V., No. 19-46],” issued on June 30, 2020. Dkt. 66.

In *Booking.com*, the Supreme Court was presented solely with the legal question whether a generic term combined with the top level domain “.com” results in a combination that is necessarily generic. Op. at 1. The Supreme Court rejected a rule that a “generic.com” term is always generic and also rejected a rule that such a term is automatically non-generic. Op. at 11. In support of a rule that a “generic.com” term is generic, the USPTO had pointed to *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598 (1888), which held that the addition of a generic corporate designation like “company” or “Inc.” to a generic term does not create a protectable trademark. The Court disagreed with this reading of *Goodyear*, explaining that *Goodyear* “reflects a more modest principle harmonious with Congress’ subsequent enactment [of the Lanham Act]: A compound of generic elements is generic if the combination yields no additional meaning to consumers capable of distinguishing the goods or services.” Op. at 10. The Court held that “[w]hether any given ‘generic.com’ term is generic . . .

depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.” Op. at 11. The Court noted that evidence to inform this inquiry can include consumer surveys if carefully designed, as well as “dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.” *Id.* n. 6.

## **II. ARGUMENT**

### **A. This Court Can Affirm The TTAB By Affirming the Merely Descriptive Refusal**

The Supreme Court’s decision in *Booking.com* does not require the Court to do anything other than what the Court would ordinarily do: decide this already-submitted appeal. There are two separate refusal grounds on review before the Court: (1) that COOKINPELLETS.COM is generic; or, alternatively (2) it is merely descriptive and Appellant has not met its burden to prove the term has acquired distinctiveness. The Supreme Court’s decision in *Booking.com* implicates only the genericness refusal ground, and the Court need not address the genericness refusal to decide this appeal. If the Court determines substantial evidence supports the merely descriptive and lacks acquired distinctiveness refusal ground, the Court should affirm the Board’s decision on that basis alone without reaching the genericness refusal, as it has done in other cases presenting alternative

refusals of genericness and lack of acquired distinctiveness. *See, e.g., In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332 (Fed. Cir. 2015).

**B. Under *Booking.com*, This Court Can Also Affirm the Genericness Refusal**

If the Court is inclined to address the genericness refusal, the Court should affirm because the Board did exactly what *Booking.com* requires in finding that COOKINPELLETS.COM is generic: it based its finding on the evidence in the record bearing on consumer perception of that term as a whole in relation to “processed wood fuel in the nature of pellets for use in barbecue grills.” Consumer perception was the focus of the Board’s genericness analysis, which began by stating that “COOKINPELLETS.COM is generic if people who grill, smoke or otherwise cook food using wood pellets perceive the term COOKINPELLETS.COM as a class of goods when it is used in connection with ‘processed wood fuel in the nature of pellets for use in barbecue grills.’” Appx28. The Board then considered all of the evidence bearing on consumer perception of the components “cookinpellets” and “.com” and their combination as COOKINPELLETS.COM, which included dictionary definitions, evidence that “cookin” and “cooking” are equivalent terms, and third-party generic use of “cooking pellets.” The Board also considered Appellant’s evidence of its sales, marketing expenditures, social media presence, customer reviews and forums, and third-party seller websites.

Although the Board likened “.com” to “company” (Appx 31-33), the Board did not just apply a legal rule—now rejected by the Supreme Court—that “generic.com” terms are necessarily generic. The Board evaluated the evidence and found it showed that COOKINPELLETS.COM as a whole is generic because no new meaning is created by the combination of the generic components. Appx32. Rather, the term would be perceived by people who grill, smoke, or otherwise cook food using wood pellets as referring to a company that sells cooking pellets. *Id.* The Board considered Appellant’s evidence that some consumers associate COOKINPELLETS.COM with Appellant, but given the lack of evidence concerning the size of the market, properly found that it failed to outweigh the other evidence that the primary significance of the term to consumers would be as a generic term. Appx34, Appx45.

The Board properly weighed the evidence, and its genericness finding is supported by substantial evidence in the record. The Supreme Court’s decision in *Booking.com* does not require the Board to have weighed the evidence of consumer perception of COOKINPELLETS.COM differently in this case; in fact, in *Booking.com*, the question whether the evidence before the courts below demonstrated that consumers in fact perceived BOOKING.COM as a trademark was not before the Supreme Court. As Justice Sotomayor’s concurrence observed, “the PTO may well have properly concluded, based on such dictionary and usage

evidence, that Booking.com is in fact generic for the class of services at issue here, and the District Court may have erred in concluding to the contrary. But that question is not before the Court.” Concurring Op., Sotomayor, J., at 2. Indeed, the majority explained that not all “generic.com” marks will be non-generic. Op. 11. Rather, it will depend on the evidence in each case.

### **III. CONCLUSION**

For these reasons, the Supreme Court’s decision in *Booking.com* does not impact this Court’s ability to decide this appeal. The appropriate action for the Court to take is to affirm the Board’s decision on either or both of the refusal grounds presented. The Court can decide this appeal by affirming the merely descriptive and lacks acquired distinctiveness refusal ground without reaching the genericness refusal. If the Court is not inclined to affirm either refusal, the Board should have the opportunity to reconsider its genericness finding in light of *Booking.com* through a remand.

July 16, 2020

Respectfully submitted,

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**RULE 32(a)(7)(C) CERTIFICATE OF COMPLIANCE**

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing  
SUPPLEMENTAL BRIEF FOR APPELLEE – DIRECTOR OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE complies with the type-volume  
limitation required by the Court’s rule. The total number of words in the foregoing  
brief, excluding the items set forth in Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b),  
is 1071 words, calculated using the Microsoft Word® software program.

July 16, 2020

/s/ Christina J. Hieber  
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**CERTIFICATE OF SERVICE**

I hereby certify that on July 16, 2020, I electronically filed the foregoing SUPPLEMENTAL BRIEF FOR APPELLEE—DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE using the Court’s CM/ECF filing system. Counsel for appellant was electronically served by and through the Court’s CM/ECF filing system per Fed. Cir. R. 25(e).

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