

**Refusal of application for a European Union trade mark
(Article 7 and Article 42(2) EUTMR)**

Alicante, 21/10/2022

CHIEVER BV
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PAÍSES BAJOS*Application No:* **018353147***Your reference:* **TM25103EU00/MBO/sb***Trade mark:**Mark type:* **Figurative mark***Applicant:* **Booking.com BV
Herengracht 597
1017CE Amsterdam
PAÍSES BAJOS****I. Statement of the facts**

The Office raised an objection on 07/01/2021 pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR because it found that the trade mark applied for is descriptive and devoid of any distinctive character. The reasons are set out in the letter of objection, which forms an integral part of this decision. It is accessible through the enclosed link.

II. Summary of the applicant's arguments

The applicant, after three extensions, submitted its observations on 19/07/2021, which may be summarised as follows.

1. Booking.com owns various trade mark registrations for the trade mark 'BOOKING.COM', registered at the Office, the Benelux Office for Intellectual Property (BOIP) and the UK Intellectual Property Office (UKIPO) (Annex 5). The present sign has been accepted by the BOIP and UKIPO without the need for any evidence of acquired distinctiveness. In addition, the applicant owns various marks consisting of, or containing, the denomination 'BOOKING.COM' worldwide (Annex 6). Some EU IP offices and the German Supreme Court have already confirmed the reputation, or acquired distinctiveness, of the mark 'BOOKING.COM' (Annexes 7 and 8).
2. The prior EUTM registrations of 'BOOKING.COM' only differ from the present application in typeface or colours. The services for which protection is sought are

identical or closely similar to the services in the present application. The present application includes more specific services, which are covered by the broader terms of the prior registrations, even when they fall in different classes. Examples are included.

3. The meaning of '.com' provided by the Office appears to be obsolete as nowadays even the largest tech companies (Amazon, Apple, Facebook, Google, Netflix) do not use '.com' and still operate online (Annex 11).
4. The Office has not considered the mark as a whole and has only examined its separate elements. The applicant does not claim either of the elements 'booking' or '.com'.
5. No one uses the term 'booking.com' to describe any platform that provides travel-related reservation services. When searching for 'BOOKING.COM' in different search engines, the results almost exclusively relate to the applicant's company, except some competitors who try to profit from the reputation of the mark 'BOOKING.COM' (Annex 12).
6. In the past, the Office has registered marks composed of terms such as 'booking', '.com', and 'company' (Annex 13). The mark 'BOOKING.COM' is more distinctive than some of the marks mentioned above.
7. The Office did not provide reasoning for each of the services for which protection is sought as to why the sign is considered descriptive and non-distinctive. The mark cannot be descriptive for at least the following services:

Class 35 *Advertising services; marketing and promoting services; providing searchable online guides and listings for sales purposes; processing orders and sales orders; data processing; compilation and systemization of information into computer databases; database management; business information services provided on-line from a computer database or the internet; commercial information agencies providing business information, including marketing or demographic data; online ordering services; procurement services; providing interactive websites and databases relating to user ratings, reviews, referrals, comments and recommendations for commercial or advertising purposes; price analysis; price comparison services; providing, organization, management and administration of consumer loyalty programs to promote travel services, hospitality services, transportation services and retail services of others; providing user reviews for commercial and advertising purposes.*

Class 36 *Payment services, namely processing payments for the purchase of goods and services of others via an electronic communications network or other global computer network; providing purchase protection services.*

Class 41 *Providing newsletters; providing user reviews, ratings, comments and recommendations; publishing of user reviews, ratings, comments and recommendations.*

Class 42 *Providing online search engines to locate and compare prices, ratings, referrals, comments and reviews; providing a online web facilities or online platform where users can post and view ratings, reviews and recommendations; providing online web facilities for making and processing payment transactions.*

III. Reasons

Pursuant to Article 94 EUTMR, it is up to the Office to take a decision based on reasons or evidence on which the applicant has had an opportunity to present its comments.

After giving due consideration to the applicant's arguments, the Office has decided to maintain the objection.

Under Article 7(1)(c) EUTMR, 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.

'The signs and indications referred to in Article 7(1)(c) [EUTMR] are those which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or service in respect of which registration is sought' (26/11/2003, T-222/02, Robotunits, EU:T:2003:315, § 34).

A word mark that is descriptive of characteristics of the goods or services for the purposes of Article 7(1)(c) EUTMR is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 7(1)(b) EUTMR.

Article 7(1)(b) EUTMR is intended to preclude registration of trade marks that are devoid of distinctive character which alone renders them capable of guaranteeing the identity of the origin of the marked product to the consumer or end user (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532). The finding that a sign is devoid of distinctiveness within the meaning of Article 7(1)(b) EUTMR is not conditional on a finding that the wording concerned is commonly used (12/02/2004, C-265/00, Biomild, EU:C:2004:87).

Article 7(2) EUTMR states that Article 7(1) EUTMR applies notwithstanding that the grounds of non-registrability obtain in only part of the European Union.

The Office responds to the applicant's arguments as follows.

1. As regards the national decisions referred to by the applicant, according to case-law:

the European Union trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system ... Consequently, the registrability of a sign as a European Union trade mark must be assessed by reference only to the relevant Union rules. Accordingly, the Office and, if appropriate, the Union judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted under national legislation harmonised with Directive 89/104 or in a country belonging to the linguistic area in which the word sign in question originated.

(27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 47).

Therefore, when assessing the case, the Office is not bound by the national decisions referred to by the applicant.

In addition, references to national registrations in Member States that do not have English as a language, and in which the sign may well be distinctive without necessarily being so throughout the EU, cannot be accepted as relevant in this case (03/07/2003, T-122/01, Best Buy, EU:T:2003:183, § 40). This applies also to registration in third countries.

Annex 6 contains a list of applicant's trade mark registrations in different countries worldwide. Many of these countries don't have English as official language and their relevant consumers may not have basic understanding of English. Moreover, it is not known whether the marks were accepted on the basis of acquired distinctiveness through use. Lastly, some registrations contain different (figurative) representation of the sign. The figurative threshold in some countries can be different from the threshold applied by the Office.

As regards the reputation of the mark 'Booking.com' recognised by some EU IP offices or the German Supreme Court, this is irrelevant when assessing inherent distinctiveness of the present sign. To be inherently distinctive, the sign must be able, without consumers' prior knowledge, to identify applicant's goods or services as originating from a particular undertaking and distinguish them from those of other undertakings.

2. The fact that the Office has accepted past registrations of the applicant's marks 'Booking.com' with different figurative, or stylised, elements and for different (although similar to some degree) goods or services cannot entitle the applicant to the same outcome. Every application undergoes an individual examination and must be examined on its own motion taking into account the sign and its relation with the goods and services for which protection is sought.

It is true that the Office should attempt to be consistent. Previous decisions of the Office may therefore be invoked and, if a genuinely comparable precedent is cited, the Office must consider whether it should be followed. The Office must nonetheless decide in each case whether, on the basis of a correct interpretation of the legislation, the mark applied for is eligible for registration.

Accordingly, if in previous cases the Office has maybe incorrectly taken an overly generous approach, that error should not be compounded by following such an approach in a subsequent case. The present decision is consistent with the Office's practice on absolute grounds and in conformity with the case law of the Courts. Fundamentally, within the scope of European harmonised trade mark law and even more so within the Office's examination practice, attempts should be made to ensure that the same results are reached in comparable cases (12/02/2009, C-39/08, 'Volkshandy', EU:C:2009:91). Neither identical registrations nor registrations by the EUIPO in respect of similar trademarks constitute grounds for nevertheless allowing applications that are devoid of distinctive character (13/02/2008, C-212/07, 'Hairtransfer', § 44, EU:C:2008:83).

3. The meaning of '.com' provided by the Office in its notice of 07/01/2021 referred to the sign and not to the applicant's company name. It is true that companies such as Amazon, Apple, Facebook (unlike Booking.com) do not have the suffix '.com' in their company name, but their websites operate under domain names www.amazon.com, www.apple.com, www.facebook.com, etc. Therefore, the Office maintains that the

 Booking.com

sign
internet.

merely indicates that the services can be reserved online, on the

Top level domain endings, such as '.com', only indicate the place where information can be found on the internet and thus cannot render a descriptive or otherwise objectionable mark registrable. Therefore, booking.com is as objectionable for the services for which protection is sought as the term 'booking' alone. This was confirmed by the General Court in its judgment of 21/11/2012, [T-338/11](#), PHOTOS.COM, EU:T:2012:614, § 22, where it was stated that the element '.com' is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, it may also indicate that the goods and services covered by the trade mark application can be obtained, or viewed, online, or are internet related. Accordingly, the element in question must also be considered devoid of distinctive character in respect of the goods or services concerned.

4. The applicant argues that the trade mark must be assessed as a whole. The Office agrees that, since the trade mark at issue is made up of several components, it must be considered as a whole when its distinctive character is assessed. However, consideration as a whole is not incompatible with the examination of each of the trade mark's individual components in turn (19/09/2001, T-118/00, Tabs (3D), EU:T:2001:226, § 59).

While the Office examined the individual components of the trade mark, it also established the meaning of the sign as a whole, as it would be perceived by the relevant public, namely as reservation online.

5. The applicant argues that no other competitors make use of the same combination. However, the distinctive character of a trade mark is determined on the basis of the fact that the relevant public can immediately perceive the trade mark as designating the commercial origin of the goods or services in question. Lack of prior use does not automatically indicate such a perception (15/09/2005, T-320/03, Live richly, EU:T:2005:325, § 88).
6. The applicant argues that the Office has accepted a number of similar registrations, containing terms 'booking', '.com' and 'company' (Annex 13). However, established case-law states that 'decisions concerning registration of a sign as a European Union trade mark ... are adopted in the exercise of circumscribed powers and are not a matter of discretion'. Accordingly, the registrability of a sign as an EUTM must be assessed solely on the basis of the EUTMR, as interpreted by the EU judicature, and not on the basis of previous Office practice (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47; 09/10/2002, T-36/01, Glass Pattern, EU:T:2002:245, § 35).

'It is clear from the case-law of the Court of Justice that observance of the principle of equal treatment must be reconciled with observance of the principle of legality according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another' (27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 67).

Furthermore, the cases quoted by the applicant are not directly comparable to the current application as they do not contain identical verbal elements, goods/services or figurative elements. Almost all figurative marks contain additional figurative devices which could be sufficient to accept the marks. Moreover, some of the marks were registered more than 15 years ago and the Office practice has evolved over the years.

7. The applicant argues that the Office has not provided specific reasoning for each of the services for which protection is sought. However, it is sufficient that a ground for refusal applies to a single homogenous category of goods and/or services. A homogenous category is considered a group of goods and/or services that have a

sufficiently direct and specific link with each other (02/04/2009, T-118/06, Ultimate fighting championship, EU:T:2009:100, § 28). Where the same ground(s) for refusal is/are given for a category or group of goods/services, only general reasoning for all the goods/services concerned may be used (15/02/2007, C-239/05, The Kitchen Company, EU:C:2007:99, § 38).

The Office considers that the services for which protection is sought form a homogenous category because they all form part of the booking experience.

It is irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 7(1)(c) EUTMR does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially (12/02/2004, C-363/99, POSTKANTOOR, EU:C:2004:86, § 102).

The services listed by the applicant for which the sign should not be descriptive are the following:

- Class 35** *Advertising services; marketing and promoting services; providing searchable online guides and listings for sales purposes; processing orders and sales orders; data processing; compilation and systemization of information into computer databases; database management; business information services provided on-line from a computer database or the internet; commercial information agencies providing business information, including marketing or demographic data; online ordering services; procurement services; providing interactive websites and databases relating to user ratings, reviews, referrals, comments and recommendations for commercial or advertising purposes; price analysis; price comparison services; providing, organization, management and administration of consumer loyalty programs to promote travel services, hospitality services, transportation services and retail services of others; providing user reviews for commercial and advertising purposes.*
- Class 36** *Payment services, namely processing payments for the purchase of goods and services of others via an electronic communications network or other global computer network; providing purchase protection services.*
- Class 41** *Providing newsletters; providing user reviews, ratings, comments and recommendations; publishing of user reviews, ratings, comments and recommendations.*
- Class 42** *Providing online search engines to locate and compare prices, ratings, referrals, comments and reviews; providing a online web facilities or online platform where users can post and view ratings, reviews and recommendations; providing online web facilities for making and processing payment transactions.*

The Office submits that these services are supportive or ancillary services. For example, data processing in Class 35 and payment processing in Class 36 would be ancillary to the reservation of temporary accommodation in that the consumers data

(e.g. name, surname) and payment information (credit card details) are processed at the moment of booking. Similarly, providing newsletters, user reviews, ratings, etc. in Class 41 or providing online search engines to locate and compare prices in Class 42 accompany the reservation services. Nowadays, it is common on the relevant market that a simple act of booking online (of accommodation, flight, car) is accompanied by a variety of supportive services, such as the advertising of attractions, recommendation of restaurants, booking of tours, car rental, purchasing of insurance, publishing of reviews of other customers, providing of loyalty programs.

The rest of the services against which the Office raised the objection and which the applicant did not include in the list to be accepted, are the following:

Class 36 *Insurance; the aforementioned services in relation to the travel and hospitality industry, provided by others.*

Class 39 *Trip, travel and transportation information, advice, search and reservation services; providing a searchable databases and listings related to information on travel experiences, travel destinations, transportation and travel related services and topics; search and reservation services for travel and transport, flights, car rental, tours, taxi rides and airport transfers; providing information and links to website of others related to travel information and services, geographic information, map images and trip routing; ticket reservation services (travel and transport); providing travel information, namely reviews, ratings, comments and recommendations of travel service providers, tours, local attractions (sightseeing services), the rental of vehicles, transportation, including flights, car rentals, transfer and taxi; providing user reviews, ratings, comments and recommendations in the field of travel, travel destinations and transportation; the aforementioned services being provided via an online platform, portal or other global computer network. the aforementioned services being provided via an online platform, portal or other global computer network.*

Class 41 *Reservation, information and search services for cultural and sporting activities and events, local attractions, amusement and theme parks, entertainment, events, including concerts and shows; the aforementioned services being provided via an online platform, portal or other global computer network.*

Class 42 *Computer services, namely operating and providing online web facilities for others for making travel, hospitality, transportation, entertainment, taking out insurances, cultural and sports related reservations; providing an online platform for others in the field of locating, describing, providing availability, pricing of hotels and other temporary accommodations, bars, restaurants, car rentals, transportation services, tours, activities, attractions and other services provided in the travel and hospitality industry.*

Class 43 *Reservation, information and search services for hotels and other temporary accommodation, bars, restaurants and meals; providing searchable computer databases and listings in relation to information on hotels and other temporary accommodation, bars, restaurants and meals; providing information and links to website of others in relation to temporary accommodations, bars and restaurants; providing user*

reviews, ratings, comments and recommendations of temporary accommodations, bars and restaurants; consultation services in the field of accommodation reservation services; providing user reviews, ratings, comments and recommendations in the field of hotels and other temporary accommodations, restaurants, bars; the aforementioned services being provided via an online platform, portal or other global computer network.

The Office submits that these services are reservation services (the actual booking services in Classes 39, 41 and 43), services accompanying the reservation such as providing searchable databases, providing information, providing user reviews in Classes 39, 41 and 43, ancillary services in Class 36 that can be reserved online, as well as services in Class 42 that provide online web facilities and platforms for making reservation.



Therefore, the Office maintains that the sign  describes the kind and means of purchasing of the services in question and relevant consumers will not recognise it as an indication of origin for these services.

IV. Acquired distinctiveness

In addition to the abovementioned arguments, in reply to the Office's objection letter of 09/01/2021, the applicant included a claim that the sign applied for had acquired distinctive character through use within the meaning of Article 7(3) EUTMR. Since it was not clear whether the claim was intended to be a principal or a subsidiary one pursuant to Article 2(2) EUTMR, the Office asked the applicant in its letter of 06/04/2022 to clarify the nature of the claim. The applicant in its letter of 23/05/2022 indicated that the claim was intended to be a principal one.

In support of the claim, the applicant submitted evidence of use on 19/07/2021.

The evidence to be taken into account is the following:

- Booking.com is one of the world's leading digital travel companies and one of the most trusted names in the travel industry. Annexes 1, 2, 3, 3a, 3b and 4 are enclosed showing this recognition (e.g. rankings in Best Global Websites, awards won, reputation recognised by third parties).
- Booking.com was called to account before the European Commission, which demonstrates that it is an important and major player in the European Union economy (Annex 9).
- Other parties refer to 'BOOKING.COM' in their arguments before the Office, which demonstrates that it is a well-known trade mark (Annex 10).
- Booking.com's revenue was USD 15.06 billion in 2019, USD 15.52 billion in 2018 and USD 12.68 billion in 2017. Booking.com revenue constitutes 89 % of Booking Holdings Inc. Annual Report of Booking Holding is enclosed (Annex 14).
- A declaration made by Maria Rocha Barros, the Chief Legal Officer at Booking.com, referring to the earlier declaration provided in the opposition proceeding

No B 3 094 036 and adding information regarding 41 attachments (described below) (Annex 15).

- Attachments 1-3: a listing of more than 28 million accommodations worldwide, including the EU, also showing numbers per EU country; extracted from different sources indicating that 1.5 million room-nights are booked via booking.com every day.
- Attachment 4: types of properties available, and their corresponding numbers.
- Attachment 5: a spreadsheet of all EU accommodation reservations between 2016 and 2020, including the total transaction value and the net state commission received by Booking.com.
- Attachment 6: information on Booking Experiences, a product launched in 2016, which enables travellers to book everything for their travel (tours, cruises, museums, car hire, taxi, etc.) in a central place.
- Attachments 7 and 7a: an overview, and total number, of attractions on offer.
- Attachment 8: a partnership with TUI on tours, attractions and experiences.
- Attachment 9: an overview of visits of the car rental services website (www.booking.com/cars) since 2019.
- Attachment 10: the number of car reservations per year (2016-2020) from IP addresses originating in various countries, including EU countries.
- Attachment 11: the number of flight reservations made through Booking.com in 2019 and 2020.
- Attachment 12: Flights Help Center screenshot.
- Attachment 13: an extract from an article informing that Ryanair sued Booking.com, which demonstrates the notoriety of Booking.com flight products.
- Attachment 14: information about food and drinks on booking.com and the European Broadcasting Union website.
- Attachment 15: booking.com/communities extract.

Consumers encounter the mark 'Booking.com' many times before the trip (e.g. in a confirmation email, reminder email).

- Attachment 16: a copy of an article in Digital Magazine from 13/10/2017 recognising Booking.com as a tech powerhouse.

Booking.com technology solutions include Connectivity Solutions, Pulse App, Extranet, online payment tools, messaging tools, Booking.com app and other.

- Attachments 17 and 18: copies of articles on Booking.com about the evolution of online payments and the communication of payment solutions to Booking.com partners.

- Attachment 19: an extract from Github where Booking.com makes some of its technology available as open source projects.
- Attachment 20: an article from Gecko Routes listing the Booking App as the most downloaded travel app in the EU.
- Attachment 21: an extract from Condor indicating that 87 % of travellers rate the mobile experience on Booking.com as the number one experience in the travel industry.
- Attachment 22: figures showing the investments by Booking.com on its Pay Per Click (PPC) advertising per year and by EU country between 2016 and 2020.
- Attachment 23: an extract from Wikipedia highlighting that Booking.com and its sister companies were the top spenders in the travel and tourism category for Google Adwords in 2016, spending 3.5 billion USD in PPC advertising.
- Attachment 24: an extract from eBizMBA listing Booking.com as the best travel website in March 2021 with 40 million monthly visitors.
- Attachment 25: an extract from similarweb, ranking booking.com first in Travel and Tourism and Accommodation categories.
- Attachment 26: an extract from Skift, showing Booking.com as the most popular online travel booking site in 2014.
- Attachment 27: an extract from Smartertravel, comparing Booking.com with its competitors.
- Attachment 28: an extract from www.jerseyislandholidays.com , indicating that Booking.com is the most used travel site across the world.
- Attachment 29: extracts from Booking.com, showing information sent to partners regarding different events, market trends, webinars, etc.
- Attachments 30, 31 and 32: an extract from www.partner.booking.com , a website dedicated to support accommodation providers that list on Booking.com, including extract from Click.Magazine.
- Attachment 33: articles about the Eurovision Song Contest Sponsorship 2021
- Attachments 34, 35 and 36: Exposure screenshots and audience breakdowns across 4 UEFA tournaments and an ICC Cricket World Cup; extracts from UEFA website.
- Attachment 37: extracts from the UEFA website featuring Booking.com as a EURO 2020 partner, including screenshots from the matches.
- Attachment 38: an extract from sponsorship.sportbusiness.com featuring Booking.com, in global partnership with UEFA and some accompanying advertising activities.
- Attachment 39: an extract from www.cricketworldcup.com about the ICC and Booking.com global partnership.

- Attachment 40: an extract from Wikipedia indicating that the 2019 Cricket World Cup was the most-watched cricket competition of 2019.
- Attachment 41: an overview of media references to Booking.com in relation to all its goods and services between 2016 and 2020, from Belgium, Denmark, Germany, Spain, France, Croatia, Italy and Sweden.

Assessment of the evidence

Under Article 7(3) [EUTMR], the absolute grounds for refusal laid down in Article 7(1)(b) to (d) [EUTMR] do not preclude registration of a mark if, in relation to the goods or services for which registration is requested, it has become distinctive in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) [EUTMR], the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d) [EUTMR], which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader ...

First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as specific percentages ...

Second, in order to have the registration of a trade mark accepted under Article 7(3) [EUTMR], the distinctive character acquired through the use of that trade mark must be demonstrated in the part of the European Union where it was devoid of any such character under Article 7(1)(b) to (d) [EUTMR] ...

Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, *inter alia*: the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) [EUTMR] is satisfied ...

Fourth, according to the case-law, the distinctiveness of a mark, including that acquired through use, must also be assessed in relation to the goods or services in respect of which registration is applied for and in the light of the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect ...

(10/11/2004, T-396/02, Karamelbonbon, EU:T:2004:329, § 55-59; 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 75; 18/06/2002, C-299/99, Remington, EU:C:2002:377, § 63).

In its notice of 09/01/2021, the Office indicated that the relevant public was the English-speaking public. For the purposes of the assessment of the geographical extent of use of the

Booking.com

sign, the English-speaking part of the public is considered to be the public in Ireland and Malta, countries in which English is the official language. Moreover, given that the mark is made up of everyday English words, countries in which English is not an official language – but their public possesses sufficient command of English – are also considered as the relevant public.

It is not necessary to determine the exact meaning of European English-speakers. The number of countries where basic English can be understood is greater than the number of countries where English is the native language. The Court has already confirmed that a basic understanding of English by the general public in the Scandinavian countries, the Netherlands and Finland, is a well-known fact (26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23).

A trade mark must be assessed in relation to the services for which protection is sought and in relation to the perception of the relevant public.

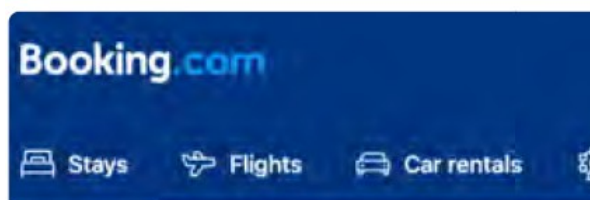
The Office has carefully examined all the evidence submitted and found it insufficient to prove that the mark applied for has become distinctive because of the use that has been made of it, in the relevant territory, under the circumstances referred to in Article 7(3) EUTMR. The burden of proof lies with the applicant who has claimed that the sign for which registration is sought has acquired distinctiveness.

The Office will now proceed to analyse the different pieces of evidence.

Many of the articles in Annexes 1, 2, 3, 3a and 3b mention Booking.com as a company and

Booking.com

not about the applicant's mark. For example, part of the text on page 4 of Annex 1 reads: 'Amsterdam-based Booking.com, which operates the world's largest hotel **booking** site with 425,000 hotels and counting, has announced that it's recorded a staggering jump in mobile **bookings** last year, in yet another testament of the global growth curve in mobile commerce.' The word 'booking' is clearly used in a descriptive context, as a synonym of 'reservation'. Moreover, where Booking.com is shown as a trade mark, it is depicted in a white and blue typeface, as seen, for example, on pages 5 and 13 of Annex 2.





Annex 3 shows the list of the top 10 most valuable Dutch brands. Fourth place belongs to **Booking.com**

The Top 10 Most Valuable Dutch Brands				
The top three brands in the Dutch ranking – Royal Dutch Shell, Philips, and Heineken – account for nearly half of the ranking's total value.				
1	2	3	4	5
				
Energy	Technology	Beer	Travel Services	Banks
Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)
14,947	11,860	11,619	9,409	6,529
6	7	8	9	10
				
Telecom Providers	Telecom Providers	Banks	Retail	Banks
Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)	Brand Value 2021 (USD\$ mil)
4,219	2,614	2,596	1,990	1,921

This information, apart from the fact that we do not know the criteria for the ranking, does not show the present sign but the sign in dark and light blue.

Annex 3a contains an extract from an article in Travel & Hospitality Awards recommending Booking.com for booking accommodation and extract from Research and Markets reporting Booking.com as the leading website globally in the category 'accommodation and hotels' as of April 2021. Annex 3b contains an extract from World Travel Awards. These pieces of evidence say nothing about the recognition of the sign by the relevant consumers in the relevant territory. Moreover, the ranking from 2021 is not relevant to the present case as it refers to the period after the filing date of the present application (11/12/2020). As regards the World Travel Awards, the voters can be from all over the world and not only from the relevant territories.

Annex 4 is a copy of the submission for Opposition No B 3 094 036, based on EUTM No 8 955 353 'BOOKING.COM', which was upheld under Article 8(5) EUTMR (Reputation).

The method of assessing or analysing the evidence of use or reputation is different to the method of assessing or analysing the evidence related to acquired distinctiveness. Of particular importance are the differences related to the geographical extent, given that in relation to acquired distinctiveness, the evidence should be related to all the relevant territories, whereas in relation to reputation, a substantial part of the relevant territory would be enough. This would mean that the Office could have considered, in the abovementioned opposition decision, that evidence in countries other than those relevant to the current proceedings would be enough in order to consider 'BOOKING.COM' reputed or well known throughout the European Union. Moreover, in the abovementioned decision, well-known character was only established in relation to certain services in Classes 35, 39 and 43.

However, the current application contains more services.

The figures such as the number of reservations, investment on advertising, subscriptions for newsletters, brand awareness, are submitted only for Germany, the Netherlands and Sweden. No evidence from Ireland and Malta is submitted. Moreover, these figures are not supported by any official evidence, such as invoices.

Booking.com

In general, the different exhibits in Annex 4 do not refer to the present sign, Below are some screenshots referring to different depictions of the sign.

Exhibits 1-3:



Exhibit 6:

Booking.com

Posted in group: **dev.emailmarketing.proofs**

Booking.com

Exhibit 9 and 10:

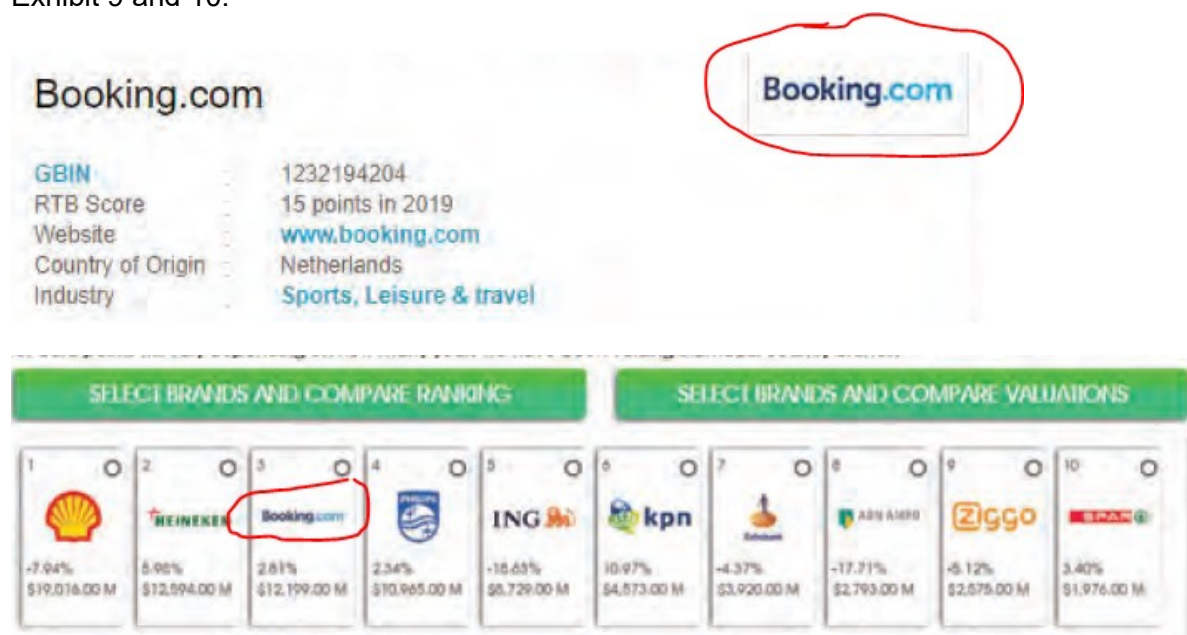


Exhibit 18:

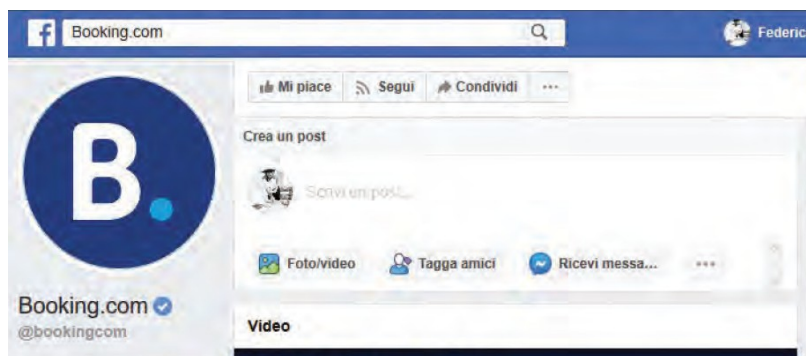
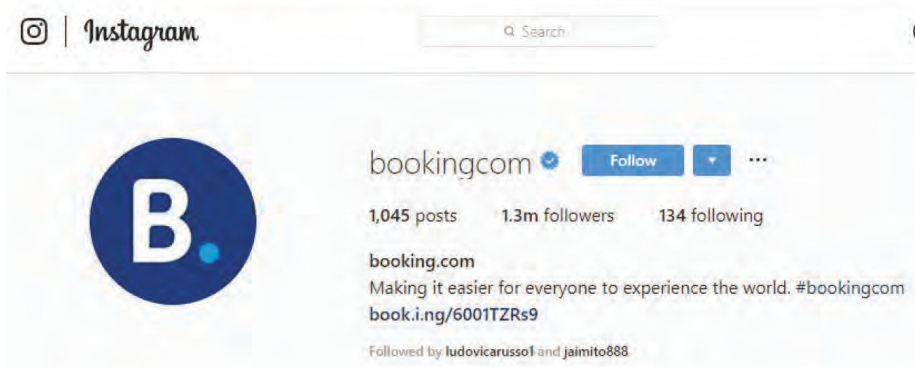
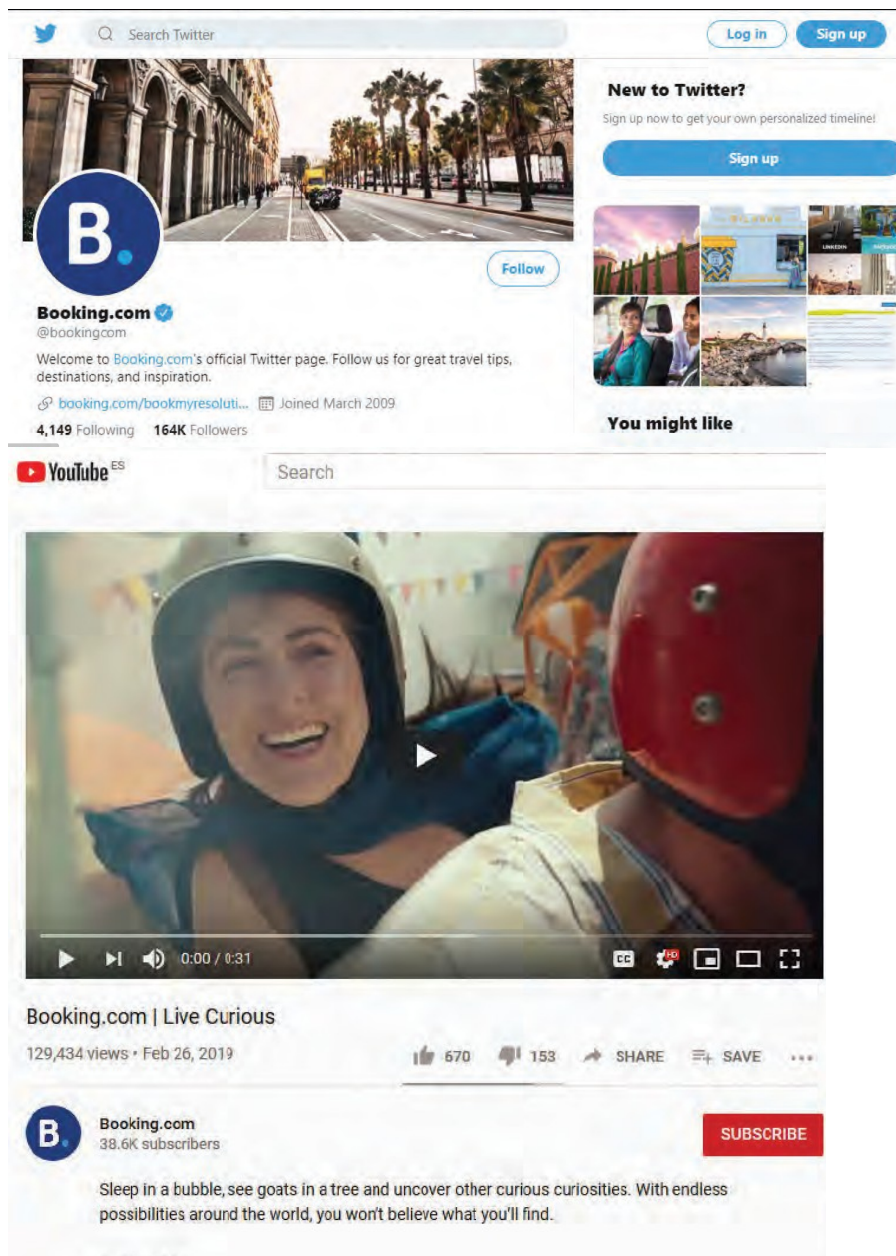


Exhibit 21:





These exhibits, apart from the fact that they show no relation to the relevant consumers'

perception of the sign , are irrelevant because they do not demonstrate the sign for which protection is sought.

The decisions from WIPO, French INPI or UKIPO in exhibit 7 confirming notoriety of the mark Booking.com are irrelevant as they refer to opposition proceedings and not to the acquired distinctiveness.

The information from the brand awareness study and exhibit 8 are a relevant piece of evidence but it is limited to the territories of Germany, the Netherlands and Sweden and, therefore, insufficient to prove acquired distinctiveness in the relevant territories.

The 'Best Global Website' rankings in exhibit 11 are not about the consumers' perception of the sign. It is an analysis of different aspects of websites by a single person or an

outsourced company according to a scoring methodology.

Who analyzes these websites?

Report author John Yunker reviews every website — and has done so for all 11 editions of the report. No work is outsourced. This historical understanding of each website (combined with one-on-one interviews with many of the executives who manage these global websites) provides valuable and actionable findings and recommendations.

and

Scoring Methodology

The Report Card analyzes each website according to the following four criteria:

- **Global Reach (Languages):** The website supports enough languages to reach a wide global audience. To receive a maximum score, the website must support 43 languages.
- **Global Navigation:** Web users can quickly and easily find their localized content, regardless of what language they speak.
- **Global/Mobile Architecture:** The website leverages global templates to support global branding while still allowing room for local customization. The website is also accessible via mobile devices, and language parity is maintained with the PC website. Responsive websites and mobile apps are also noted.
- **Localization & Social:** The website is relevant to the user's locale and culture and provides functionality on par with the global website. Local-language social media are also supported and well promoted on the local websites.

Booking.com

There is no mention about analysing consumers' perception of the sign in relation to the services for which protection is sought.

Exhibit 12 includes the Top 500 most valuable US brands. Since the US is not a relevant territory, this ranking is irrelevant for the assessment of the acquired distinctiveness of the present sign.

Exhibits 13 and 15 are in Dutch, which is not an official language for Office proceedings. They show different rankings of Booking.com, which are insufficient pieces of evidence.

The reports from exhibit 14 (UK RepTrak) relate to the territory of the United Kingdom. The UK did not form part of the EU at the time of objection and is, therefore, not a relevant territory. Consequently, this piece of evidence is irrelevant.

Exhibit 16 contains a copy from the booking.com website, showing over 4 million reviews from guests. Apart from the fact that the website bears a different sign, these are the reviews of different properties, and they say nothing about the consumers' recognition of the sign

Booking.com

. Moreover, the reviews come from all over the world and not only from the relevant territories.

Exhibit 17 contains a sample of letters received from hotels, confirming recognition of the mark. The submitted sample mentions BOOKING.COM as a 'well-known trade mark and one of the leading trade marks in the field of hotel reservations in Mexico'.

therefore consider the mark BOOKING.COM to be a well-known trademark and one of the leading trademarks in the field of hotel reservation in Mexico.

Mexico is not a relevant territory in the present case and this evidence is, therefore, irrelevant.

Exhibits 18 and 19 contain information about the partnership of Booking.com with UEFA (including the sponsorship of EURO 2020) and the ICC. Besides the fact that different depictions of the sign appear in the advertisements, EURO 2020 took place in June-July 2021 (due to the Covid-19 pandemic), which is after the filing date of this application.

Exhibit 20 contains extracts from magazines and newspapers from Germany, the Netherlands and Sweden. These articles mostly inform about some new products or activities of the company Booking.com but nothing can be derived about the perception of



the sign in the relevant territories.

The references to the numbers of followers on social media platforms in exhibit 21 do not provide any information about where the viewers are from (they could be from anywhere in the world). More importantly, the logos on these platforms do not coincide with the present sign. Moreover, the Office believes that simply making the sign available to the public (e.g. via social media) does not automatically translate into a perception of the mark, and even less into its recognition by the relevant consumer.

Regarding Annex 9 demonstrating that Booking.com is an important and major player in the European Economy because it was called to account before the European Commission, this evidence does not reflect the consumers' perception of the sign. Moreover, the evidence contains reference to the company Booking.com and not to the trade mark applied for.

In the same vein, the fact that other parties refer to booking.com in their arguments before the Office (Annex 10) says nothing about the sign and its perception by the relevant public.

The figures in the Annual Report in Annex 14 are not supported by any independent evidence such as invoices. Moreover, the report is for Booking Holding worldwide, it is not

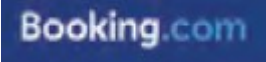


detailed how much revenue the sign earned in the relevant EU territory.

As regards the declaration by the Chief Legal Officer at Booking.com, Maria Rocha Barros, as far as the probative value of this kind of evidence is concerned, statements drawn up by the applicant itself, or its employees, are generally given less weight than independent evidence. This is because the perceptions of the applicant may be more or less affected by its personal interests in the matter. However, this does not mean that such statements do not have any probative value at all. The final outcome depends on the overall assessment of the evidence in the particular case. The probative value of such statements depends on whether or not they are supported by other types of evidence or evidence originating from independent sources. In view of the foregoing, the remaining evidence must be assessed in order to see whether or not the contents of the declaration are supported by the other items of evidence.

A lot of evidence in attachments 1-3 that lists the number of accommodations on offer comes from the applicant's own website and is, therefore, attributed less value than if it was coming from an independent source. In addition, there is no supportive evidence, such as invoices to trip providers or end consumers which would corroborate the information about the reservations.

The properties on offer in different countries listed in attachment 4 have no relation with the

sign . In addition, the extracts from the website bear the coloured logo  and not the sign applied for.

The spreadsheet of EU accommodation reservations between 2016 and 2020 (attachment 5) has no probative value on its own. It is not backed up by any supporting evidence such as invoices. Moreover, a link between the reservations and the consumers

 perception of the sign is missing. In other words, it cannot be concluded that consumers booked the accommodation because they recognise the present sign as coming from the applicant or they were simply redirected to the applicant's website through a general search engine.

The information about Booking Experiences (attachment 6) is irrelevant for the assessment of acquired distinctiveness of the present sign. It only describes the product and explains what it offers.

The overview and total number of attractions on offer (attachments 7 and 7a) as well as partnership with TUI (attachment 8) are irrelevant. They do not have any link with the perception of the sign.

Visits of the website www.booking.com/cars from attachment 9 do not indicate whether the website was accessed intentionally or as a result of a simple internet search without looking for the applicant's services. Moreover, the extracts from the website demonstrate the sign in colour.

No other evidence (such as invoices) was submitted to support the number of car reservations (attachment 10) and flight reservations (attachment 11).

The Flights Help Center screenshot (attachment 12) is irrelevant for the assessment of acquired distinctiveness. It is a mere screenshot from applicant's website in which the coloured logo appears.

The extract from an article informing that Ryanair sued Booking.com (attachment 13) is irrelevant. It can demonstrate the notoriety of Booking.com but not the acquired distinctiveness of the sign in relation to the services in the relevant territory.

Information about food and drinks on booking.com and the European Broadcasting Union website (attachment 14) is also irrelevant. This is purely information about food and drinks in different places. There is no proof that the relevant consumers recognise the sign as originating from the applicant in relation to the relevant services.

The information about the travel communities (attachment 15) is an extract from the

applicant's website bearing the white and blue logo and has no relation with the perception



of the sign

The fact that consumers encounter the mark Booking.com many times before the trip (e.g. on a confirmation email, reminder email) is irrelevant because this happens after the consumers have made the booking. It is not known if the consumers later repeat their choice



because they perceive the sign

as originating from the applicant.

Attachment 16 is simply a magazine article, mainly citing the applicant's employees. There is nothing about the relevant consumers and their perception of the sign in relation to the relevant services.

Information about Booking.com technology solutions (e.g. Connectivity Solutions, Pulse App, Extranet, online payment tools, messaging tools, Booking.com app) is also merely information about the different solutions, it has no connection with the present sign.

Attachments 17 and 18 are just extracts from the applicant's website about the evolution of online payments and communication of payment solutions to Booking.com partners. Nothing is mentioned about brand recognition.

The profile on Github (attachment 19) bears a figurative element preceding the Booking.com name.



It is unknown what proportion of the relevant public in the relevant territories, and in relation



to the relevant services, associates the sign

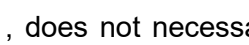
with the applicant.

Attachment 20 mentions Booking App as the most downloaded travel app in the EU. However, a mark that differs from the present sign is used in the rankings. In addition, the fact that an app is downloaded does not translate into the consumers' recognition of the sign as originating from a particular undertaking.

Attachment 21 is about evaluating the mobile experience, not the perception of the sign by the relevant public.

Attachment 22 contains figures showing the investments by Booking.com on its Pay Per Click (PPC) advertising per year and EU country between 2016 and 2020. This piece of evidence contains the mark  and thus without any additional evidence it is supposed that the clickable image/text is . In addition, the fact that a



consumer clicks on an advertisement, even on , does not necessarily mean that they will identify the applicant and would look for its sign for future purchases. The consumer may click on the advertisement simply because they are looking for a reservation

website.

The amount spent on advertising mentioned in Wikipedia (attachment 23) does not automatically translate into higher recognition of the sign by the relevant consumers. The effect of the advertising is not known.

Attachments 24-28 contain extracts from different websites listing Booking.com as the best website in different categories and a subjective review of different hotel booking sites including Booking.com. However, the criteria for ranking (and most importantly whether consumers' perception was taken into account) and the territories where the voters come



from are unknown. Moreover, different logos are included in the rankings, and



. Moreover, the fact that the website booking.com is the most used does



not automatically mean that it is because consumers recognise the sign as coming from the applicant.

Attachments 29-32 are information from the applicant itself dedicated to partners. In addition,

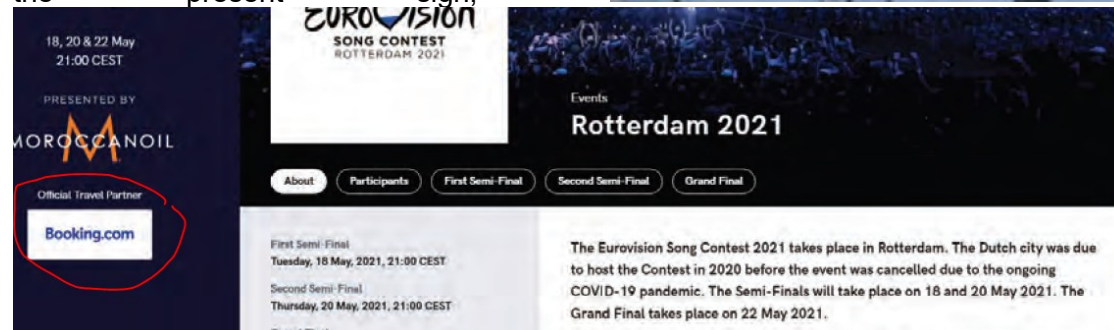
Booking.com

different signs appear on the extracts, and Booking.com

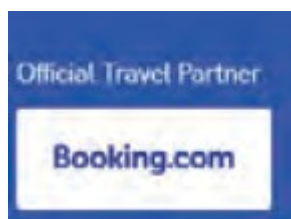
The sponsorship at the Eurovision Song Contest 2021 (attachment 33) took place after the filing date of the present application (11/12/2020). Therefore, it cannot be taken into account for the assessment of acquired distinctiveness of the present sign. The evidence must prove that distinctiveness through use was acquired prior to the EUTM application's filing date. In addition, the sponsorship of an event (even as big as Eurovision) does not tell how the relevant consumers reacted to the sign displayed in different places during the event and if they would memorise the sign as originating from the applicant for future purchases. Moreover, from the evidence provided, the sign mostly appears in depictions that differ from



the present sign,



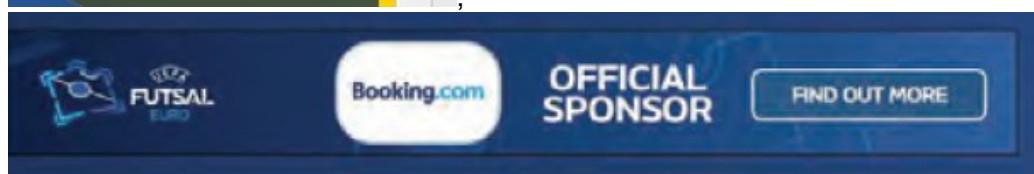
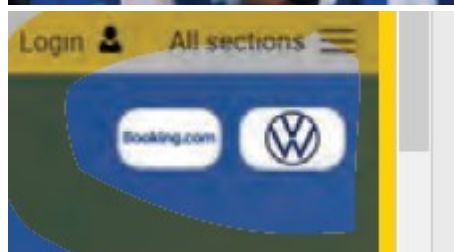
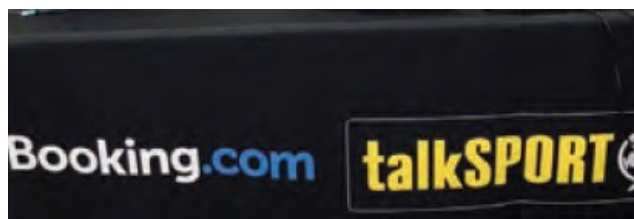
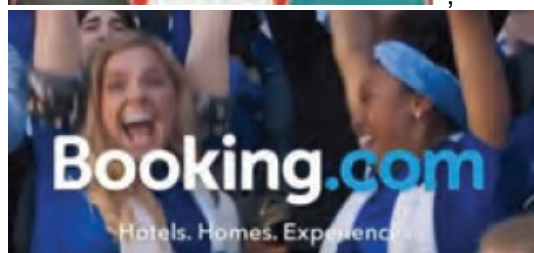
and



Similarly, the sign in the screenshots in attachments 34-36 (exposure at 4 UEFA tournaments and the ICC Cricket World Cup; extracts from UEFA website) is mostly



displayed in a different format,

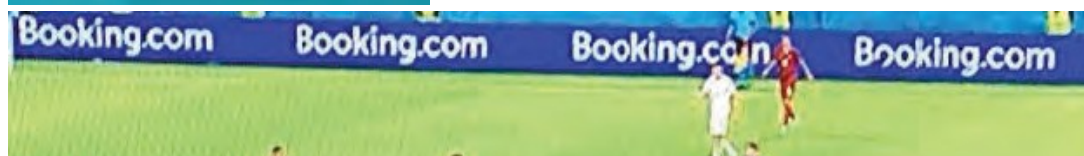


and



Attachment 37 contains extracts from the UEFA website featuring Booking.com as a EURO 2020 partner, including screenshots from the matches. Due to the Covid-19 pandemic, the EURO 2020 tournament took place in June-July 2021, which is after the filing date of the present application. Even if the evidence was to prove the acquired distinctiveness of the sign, it cannot be taken into account.

Moreover, different logos are present in the screenshots.

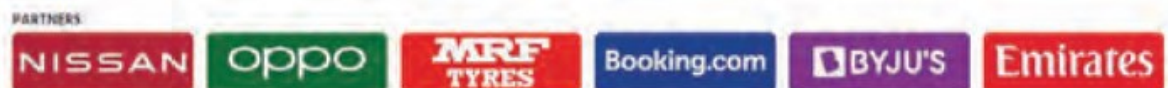


and



Attachment 38 is also irrelevant for the consumers' perception of the sign. Some advertising activities (related to EURO 2020, which was held in June-July 2021) took place after the filing date of the present application (e.g. the box turned into a hotel room).

Attachment 39 is the extract from cricketworldcup.com about the ICC and Booking.com global partnership also demonstrates the sign in a different depiction.



Moreover, the world cup took place in the UK, which was not an EU territory anymore at the time when the objection was issued. Therefore, evidence related to the UK is considered irrelevant.

An extract from Wikipedia indicating that the 2019 Cricket World Cup was the most-watched cricket competition of 2019 (attachment 40) is irrelevant. We do not know where the audience came from. Moreover, cricket is not as popular in the EU as it is outside of it (Australia, India, New Zealand, the UK, etc.)

Overview of media references to Booking.com (attachment 41) come from Croatia, Germany, Denmark, Spain, France, Italy, Belgium and Sweden. Nothing has been submitted from Ireland or Malta. In any case, reference in the media does not indicate anything about the relationship between the end consumer and the sign for which protection is sought.

Overall, a great part of the evidence comes from the applicant's own website and contains different depictions of the sign. Furthermore, the evidence submitted does not allow for the



conclusion that the relevant public will recognise the sign

as coming from the applicant.

According to the General Court, a distinction must be made between direct proof of acquisition of distinctive character (e.g. surveys, evidence of the market shares held by the mark, statements from chambers of commerce and industry or other trade and professional associations) and secondary evidence (e.g. sales volumes and advertising material, duration of use) that is merely indicative of the mark's recognition on the market. Although secondary evidence may serve to corroborate direct proof, it cannot replace it.

If the documents submitted were related to all the relevant territories (including Ireland and Malta), they would still be considered secondary evidence. There is no direct proof, such as market share, turnover, statements from chambers of commerce and industry or other trade and professional associations, or any indication of the proportion of the relevant public who, because of the mark, identify the services as originating from a particular undertaking.

The evidence submitted is unconvincing and inadequate to conclude, with the necessary degree of safety and without speculation, that at least a significant part of the relevant public in the European Union considers that the sign applied for refers to the applicant's services (07/06/2007, R 667/2005-G, CARDIOLOGY UPDATE).

Nothing can be derived from the information regarding the level of consumer recognition of the mark applied for in the relevant markets. More tellingly, there is nothing to demonstrate how significant the presence of the mark is in Ireland and Malta – countries in which English

Booking.com

is an official language. It is impossible to assess the distinctive character of with respect to these countries, because there is no data to allow even a guess at the proportion of the relevant public who would identify the relevant services as originating from the applicant (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230).

Booking.com

The claim that the sign forms a trade mark that has acquired distinctiveness through use under Article 7(3) EUTMR fails for want of proof. Acquired distinctiveness must be proved with solid evidence, beyond mere speculation or likelihood, and must be proved for the goods or services for which protection is sought (07/06/2007, R 667/2005-G, CARDIOLOGY UPDATE). Overall, the evidence is not sufficient for the mark to be accepted.

Conclusion

For the abovementioned reasons, the claim that the trade mark applied for has acquired distinctive character through use pursuant to Article 7(3) EUTMR is rejected.

V. Conclusion

For the reasons mentioned above in this decision, and pursuant to Article 7(1)(b) and (c) EUTMR and Article 7(2) EUTMR, the application for EUTM No 18 353 147 is hereby rejected for all the services claimed.

According to Article 67 EUTMR, you have a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.



Stanislava MIKULOVA

You can download the attachments from your Office User Area by using the links below:

L110 - Notice of grounds for refusal of application for a European Union trade mark - 09/01/2021	https://euipo.europa.eu/copla/document/336hzA
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