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Subject: U.S. TRADEMARK APPLICATION NO. 79143993 - EPIC SANA LUXURY CONCEPT HOTELS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79143993

MARK: EPIC SANA LUXURY CONCEPT HOTELS

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: SANA Hotels and Resorts Limited

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N/A

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INTERNATIONAL REGISTRATION NO. 1195575

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant, SANA Hotels and Resorts Limited ("Applicant"), has appealed the Trademark Examining Attorney's ("Examining Attorney") final refusal to register the proposed mark EPIC SANA LUXURY CONCEPT HOTELS in stylized form and design, with a disclaimer of the wording "EPIC" and "LUXURY CONCEPT HOTELS", for, in relevant part, "providing temporary accommodation," under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Registration was refused on the Principal Register on the grounds that applicant's mark is likely to be confused with the registered mark SANA RESORT & HOTEL in stylized form and design, with a disclaimer of the wording "RESORT & HOTEL", in U.S. Registration No. 3583748, for "full service hotel, hotel, resort hotels, resort lodging services, and tourist inns."

The refusal under Trademark Act Section 2(d) is the only issue on appeal. It is respectfully requested that the refusal to register these services be affirmed.

STATEMENT OF FACTS

I. On January 15, 2014, Applicant filed a request for extension of protection under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), for the mark EPIC SANA LUXURY CONCEPT HOTELS, in stylized form and design, for, in relevant part, "temporary accommodation," in International Class 43.

II. On April 17, 2014, the Examining Attorney refused registration on the ground that the applied-for mark was confusingly similar to the marks in U.S. Registration Nos. 3453879, 3583748, and 3698111, under Trademark Act Section 2(d). In addition, applicant was required to satisfy the following requirements: (1) amend the identification of services, in part, (2) provide a mark description, (3) provide an explanation of the mark's significance, and (4) disclaim the descriptive wording "LUXURY CONCEPT HOTELS".

III. On October 17, 2014, Applicant provided a Response to Office Action, in which applicant submitted arguments in response to the refusal under Trademark Act Section 2(d).

Applicant also amended the identification of services, in part, provided a mark description, disclaimed the wording “EPIC” and “LUXURY CONCEPT HOTELS”, and provided a translation of wording in the mark.

IV. On November 24, 2014, the Examining Attorney issued a Final Office Action. In that action, the Examining Attorney withdrew the Section 2(d) Refusal with respect to U.S. Registration Nos. 3453879 and 3698111, accepted the amended identification of services, the mark description, and the disclaimer of the wording “EPIC” and “LUXURY CONCEPT HOTELS”, and made final the refusal under Section 2(d) with respect to the mark in U.S. Registration No. 3583748.

V. On April 8, 2015, Applicant filed the present appeal with the Trademark Trial and Appeal Board (“Board”).

ISSUE ON APPEAL

The only issue on appeal is whether Applicant's use of the mark EPIC SANA LUXURY CONCEPT HOTELS for, as amended in relevant part, “providing temporary accommodation” in International Class 43, is confusingly similar to the mark in U.S. Registration No. 3583748, SANA RESORT & HOTEL for “full service hotel, hotel, resort hotels, resort lodging services, and tourist inns,” also in International Class 43.

ARGUMENT

LIKELIHOOD OF CONFUSION

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of

confusion determination is resolved in favor of the registrant. *In re Power Distrib., Inc.*, ___ USPQ2d ___, Ser. No. 77825939, 2012 TTAB LEXIS 402, at *12 (Sept. 29, 2012); TMEP §1207.01(d)(i); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.* Applicant's arguments regarding the differences in the overall appearance of the marks is unpersuasive.

I. APPLICANT'S AND REGISTRANT'S SERVICES ARE LEGALLY IDENTICAL

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the relevant services, namely, "providing temporary accommodation," and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification, namely, "full service hotel, hotel, resort hotels, resort lodging services, and tourist inns."

As established in the Examining Attorney's Office action dated April 17, 2014, "a hotel is an establishment that provides lodging paid on a short-term basis."[1] Further, in the November 24, 2014 Office action, the trademark examining attorney attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence established that hotel and lodging services are types of temporary accommodation.[2] Applicant has made no argument against the relatedness of the services. Accordingly, the services are legally identical for likelihood of confusion purposes.

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[1] *See* p. 4.
[2] *See e.g.*, U.S. Registration Nos. 4607959 and 4634474 at pp. 5-7, 16-18.

II. THE SHARED TERM "SANA" IS THE DOMINANT, SOURCE-IDENTIFYING ELEMENT OF BOTH MARKS

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Further, while marks must be compared in their entireties and should not be dissected, individual components of a mark may be weighed to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark . . . ."); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). One feature of a mark may be more significant or dominant in creating a commercial impression, and greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751; TMEP §1207.01(b)(viii), (c)(ii).

In the present case, Applicant's mark EPIC SANA LUXURY CONCEPT HOTELS is confusingly similar to the registered mark SANA RESORT & HOTEL because both marks contain the term SANA, which is the most significant element of the marks. The additional wording EPIC and LUXURY CONCEPT HOTELS in

applicant's mark, the additional wording RESORT & HOTEL in registrant's mark, and the different design features in the marks do not obviate the similarity of the marks, such that consumer confusion is likely.

Although the marks share the dominant term SANA, applicant contends that consumer confusion would be unlikely in the marketplace "because both applicant's and registrant's marks are composite marks whose design features, stylization, and additional words are sufficiently different."[3] Applicant argues, "[w]hen viewed in its entirety, prospective consumers would not likely believe that applicant's mark is associated with registrant's mark due to the overall differences in both marks."[4] Finally, applicant asserts that consumers are more likely to focus on the term EPIC in the applied-for mark because it is the first word in the mark.[5] However, these arguments are unpersuasive.

First, for a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Here, the word portion, rather than the minimal design features, of the marks is more likely to be impressed upon the minds of potential consumers and used when calling for the services. Additionally, consumers

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[3] *See* Applicant Appeal Br. at p.3.
[4] *Id.* at p.5.
[5] *Id.*

are likely to believe applicant's mark is a luxury sub-brand of the registered mark, which makes the overall difference in appearance appropriate.

Second, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). Here, the wording EPIC and LUXURY CONCEPT HOTELS has been disclaimed apart from the applied-for mark; and the wording RESORT & HOTEL has been disclaimed apart from the registered mark.

With respect to the applied-for mark, as established in the April 17, 2014 Office action, the wording LUXURY CONCEPT HOTELS merely describes a type, characteristic or feature of applicant's temporary accommodation services.[6] Thus, this wording has little to no source-identifying capacity. Applicant has made no argument against the descriptiveness of this wording. Further, in its Response to Office action dated October 17, 2014, applicant voluntarily disclaimed the term EPIC and argued that it is merely descriptive or laudatory for its services.[7] Specifically, applicant claimed, "[t]he wording 'EPIC' has recently entered modern day language to mean 'surpassing the usual or ordinary… impressive in quality…awesome.'"[8] Applicant went on to state, "while the word 'EPIC' may not have been descriptive when the cited marks registered, in recent years, it has come to have a new meaning as a laudatory

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[6] *See evidence* at pp. 4-38.
[7] *See* p.1.
[8] *See id; see also Applicant's dictionary evidence* at p.2.

adjective. Prospective consumers would therefore view the word 'EPIC' as descriptive of a hotel that surpasses the usual or ordinary, or that is impressive in quality."[9]

"Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive" because "[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services]." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*., 695 F.3d 1247, 1256, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); see *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK merely laudatory and descriptive of applicant's bicycle racks being of superior quality); In re The Boston Beer Co., 198 F.3d at 1373-74, 53 USPQ2d at 1058-59 (holding THE BEST BEER IN AMERICA merely laudatory and descriptive of applicant's beer and ale being of superior quality); TMEP §1209.03(k). In fact, "puffing, if anything, is more likely to render a mark merely descriptive, not less so." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d at 1256, 103 USPQ2d at 1759. Here, the "About Us" section regarding the relevant services on applicant's website, http://www.sanahotels.com/en/about-us/concepts/epic/, states, "EPIC is an absolutely *extraordinary* category of hotels"[10] [emphasis added]. Thus, in agreement with Applicant, and as established by the evidence, the term EPIC is merely laudatory and descriptive of the alleged merit of applicant's temporary accommodation services. And, although it is the first word in the mark, it merely modifies the source-identifying term SANA. This is further supported by applicant's use of the term SANA, shown multiple times on its website without the term EPIC (e.g., SANA HOTELS, SANA HOTELS ACADEMY, SANA EXCELLENCE and design, SANA STYLE and design, etc.).[11] Accordingly, given that the wording EPIC and

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[9] *See* p.1.
[10] *See evidence* p. 2 of April 17, 2014 Office action.
[11] *Id.*

LUXURY CONCEPT HOTELS is merely descriptive and/or laudatory of applicant's services, consumers will view the dominant term SANA as the source-identifying element of the mark.

With respect to the registered mark, the wording RESORT & HOTEL was disclaimed apart from the mark for being merely descriptive of or generic for registrant's services, rendering the term SANA the more dominant, source-identifying element of that mark. This is supported by the dominant size and location of the term SANA in relation to the other wording in the mark.

In sum, the dominant word SANA shared by both marks creates the same overall commercial impression. The use of additional descriptive and/or laudatory wording does not obviate the fact that the marks, when considered as a whole, stimulate the same mental reaction. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b). Lastly, where the services of an applicant and registrant are virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. See United Global Media Grp., Inc. v. Tseng, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b). Here, the marks are legally identical.

Therefore, when considering the overall commercial impression created by the marks, a likelihood of confusion exists.

CONCLUSION

The services of the parties are legally identical, such that there is a lesser degree of similarity required between the marks. Applicant's applied-for mark EPIC SANA LUXURY CONCEPT HOTELS is likely to cause confusion with the registered mark SANA RESORT & HOTEL because the marks share the dominant, source-identifying term SANA, which creates the same overall commercial impression in both marks. Therefore, because confusion is likely, the applied-for mark must be refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Any doubt regarding this likelihood of confusion determination was resolved in favor of the registrant. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

For the foregoing reasons, the Examining Attorney respectfully requests that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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