

THIS OPINION
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THE T.T.A.B.

Hearing:
May 22, 2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Children's Inn at NIH
v.
Vinod Bhandari

Opposition No. 91120549
to application Serial No. 75255103
filed on March 10, 1997

Alan S. Cooper and Alisa C. Key of Howrey LLP for The
Children's Inn at NIH.

Vinod Bhandari, *pro se*.

Before Quinn, Taylor and Wellington, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Vinod Bhandari filed an application to register the
mark KIDS INN ("INN" disclaimed) for "hotel and motel
services; [and] restaurant services" in International Class
42.¹

The Children's Inn at NIH (National Institutes of
Health) opposed registration based on likelihood of

¹ Application Serial No. 75255103, filed March 10, 1997, alleging
a bona fide intention to use the mark in commerce.

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confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Opposer alleges that applicant's mark, if used in connection with applicant's services, would so resemble opposer's previously used and registered mark CHILDREN'S INN ("INN" disclaimed) for "lodging services for use of children and their families who are patients at NIH" in International Class 42,² as to be likely to cause confusion. Opposer also alleges that applicant's mark would cause dilution of the distinctive quality of opposer's mark.³

Applicant, in his answer, denied the salient allegations of likelihood of confusion and dilution.

The record consists of the pleadings; the file of the involved application; trial testimony of Randolph Schools, president of the recreation and welfare association at NIH, with related exhibits, taken by opposer; a status and title copy of opposer's pleaded Registration No. 2034869, applicant's responses to certain interrogatories and requests for admission, and excerpts from printed publications, all introduced by way of opposer's notices of reliance; and excerpts from printed publications, a copy of a prior Board decision involving the opposed application,

² Registration No. 2034869, issued February 4, 1997; cancelled (see infra).

³ Although the Board denied opposer's motion to amend the notice of opposition to assert a claim of mere descriptiveness, opposer did amend the opposition, pursuant to an earlier Board order, to set forth a legally sufficient dilution claim, alleging that its

and third-party registrations made of record through applicant's notices of reliance. Both parties filed briefs,⁴ and both appeared at an oral hearing held before the Board.

The parties have raised evidentiary objections in their respective briefs. Opposer's objections go to the relevancy and probative value of certain documents introduced by applicant. (Brief, pp. 3-5) We will consider these objections when weighing the probative value to be accorded to this evidence. Applicant's objections essentially go to opposer's characterization in its brief of what the evidence establishes. (Brief, pp. 3-5) Suffice it to say, our decision on the merits rests on our view of what the record establishes, and not on what opposer contends that the record establishes.

Lastly, opposer, in its reply brief, objects to evidence that applicant submitted for the first time with his brief. The objection is sustained. Exhibits and other evidentiary materials attached to a party's brief on the

mark became famous before the filing date of applicant's application.

⁴ To the extent that applicant attempted to raise a laches defense for the first time in his brief at final hearing, such defense was neither pleaded nor tried. More significantly, such defense is not available in an opposition proceeding. *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) [laches runs from the time from which action could be taken against the trademark rights inhering upon registration]. Accordingly, no consideration has been given to applicant's allegations relating thereto.

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case can be given no consideration unless they were properly made of record during the time for taking testimony. See, e.g., *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.5 (TTAB 1986). See also TBMP §704.05(b) (2d ed. rev. 2004). Thus, we have declined to consider this improperly submitted evidence.⁵

Opposer operates a privately funded lodging facility on the grounds of the National Institutes of Health ("NIH") outside of Washington, D.C. The idea for such a facility dates back to 1983 when a group envisioned one to serve families whose children were undergoing treatment at NIH. The vision was for a home-like residence, allowing families more room than the traditional hotel/motel room. The residence was designed to keep a family together in the midst of a family crisis, to reduce stress, and to promote self-help and mutual support. Between 1987-1989, a fund-raising organization, Friends of the Children's Inn, was formed, and ground breaking on the facility took place in 1988. During this time, fundraising continued through the use of local television and radio advertisements, and civic organizations such as the Rotary and Lions clubs contributed to the effort. A group of Congressional spouses also were involved, and one of them promoted the facility on The Today Show in a nationally televised broadcast. Publicity began

⁵ Even if considered, the evidence does not compel a different

result on the merits.

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to spread, and opposer started to receive contributions from around the country. The facility opened with thirty-six bedrooms in June 1990, marked by a ceremony attended by President George Bush and First Lady Barbara Bush. Other dignitaries also attended, and the event garnered national press coverage. Opposer's facility has continued to be the subject of press coverage, with articles referring to opposer's CHILDREN'S INN in *The Washington Post*, *USA TODAY* and *Parade Magazine*. During his time as President, Bill Clinton broadcast one of his weekly radio addresses from the facility. Likewise, various news organizations, such as CNN and Fox News, have broadcast from the facility. The facility was expanded to fifty-nine rooms in 2004, continuing to operate as a family-centered residence on the NIH campus serving pediatric patients and their families traveling to NIH for treatment.

Opposer annually offers more than 1,300 NIH patients and their families temporary housing. Opposer utilizes the following slogan: "When you are sick, there is no place like home. But if you can't be home, there is no place like The Children's Inn at NIH." The typical stay ranges from one to three days, with frequent return trips. The longest stay has been around nineteen months. There is no charge to stay at the facility. In addition to bedrooms, the facility offers common living areas, communal kitchens and dining

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rooms, play rooms, a laundry room, a library, a computer room, an exercise room, a business center, a playground and a garden. Opposer offers activities such as bingo, movie nights, arts and crafts, and birthday parties to enhance mutual support among families. During fourteen years, "6,000 seriously ill children and their families have made almost 40,000 visits to The Inn." (Schools dep., p. 50). Guests have come from all fifty states as well as from fifty-seven foreign countries. Opposer employs a staff of twenty-five, and depends on a volunteer staff of approximately 285.

Opposer operates a website (under the domain names www.childrensinn.com; www.childrensinn.net; and www.childrensinn.org) featuring information about opposer's facility. The mark appears throughout the website.

Opposer is a private, non-profit, charitable entity, which relies on contributions to fund its operations. Since the opening of the facility, opposer has attracted financial contributions from a wide range of corporations, including Microsoft, Intel, General Electric, Bristol-Myers Squibb and The Walt Disney Company. Donors have sponsored advertising for opposer in national publications.

Opposer distributes a newsletter titled "The Children's Inn News" to donors and corporations in an effort to publicize opposer's facility. In 2003, opposer received

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approximately \$4.7 million in contributions. Between 2000-2004, opposer spent about \$2.4 million on its fundraising efforts.

Applicant has not commenced use of his mark. Although applicant, in his brief, made statements regarding his business plans, there is no evidence to support these statements. Accordingly, these statements have no evidentiary value. TBMP §704.06(b) (2d ed. rev. 2004).

Insofar as standing is concerned, the record clearly establishes that opposer is not an intermeddler. Opposer's use of its mark establishes that opposer has a legitimate personal interest in the opposition, and a reasonable basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

As to priority, opposer introduced during its testimony period its Registration No. 2034869, issued February 4, 1997, of the mark CHILDREN'S INN ("INN" disclaimed) for "lodging services for use of children and their families who are patients at NIH." The registration indicates that it issued pursuant to the benefits of Section 2(f). The status and title copy of record is dated January 12, 2005. A check of Office records reveals, however, that this registration was cancelled on November 10, 2007 for failure to renew under Section 9. When a registration owned by a party has been properly made of record in an inter partes proceeding,

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and the status of the registration changes between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by Office records. TBMP §704.03(b)(1)(A) (2d ed. rev. 2004). See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

Accordingly, the expired registration has no probative value. Opposer's expired registration merely constitutes evidence that the registration issued. See, e.g., *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). Further, any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act, were lost when the registration expired. See *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973). Cf. *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) [when opposer establishes that it owns a valid and subsisting registration of its pleaded mark, the issue of priority does not arise]. Opposer's case rests, therefore, on the common law rights established by the evidentiary record.

The record establishes opposer's use of its mark CHILDREN'S INN prior to the earliest date upon which applicant may rely, that is, the filing date of the involved

application (March 10, 1997). As noted earlier, however, the now-expired registration issued under the provisions of Section 2(f), and the word "INN" was disclaimed. Although applicant has not attacked opposer's mark as being merely descriptive,⁶ an opposer's mark must be distinctive, if not inherently, then through use.

Given that opposer's prior mark was registered under the provisions of Section 2(f),⁷ and in view of the commonly understood meanings of "children's" and "inn," we find, for the purposes of this proceeding, that the mark CHILDREN'S INN, for lodging services for the use of children and their families while being patients at NIH, is merely descriptive. Thus, the operative inquiry is whether opposer's mark acquired distinctiveness prior to applicant's filing date. *See Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1138 (TTAB 1992). To reiterate, applicant neither contested opposer's priority nor has it attacked opposer's mark on the basis that it lacks distinctiveness, either inherent or acquired. Because the record shows

⁶ In saying this we realize, of course, that at the time of trial opposer owned a valid and subsisting registration that was over five years old; thus, the registration was not subject to attack on the ground of mere descriptiveness. Applicant, in his brief, stated that opposer's priority "is not questionable." (Brief, p. 5).

⁷ A claim of distinctiveness under Section 2(f) may be construed as a concession that the matter to which it pertains is not inherently distinctive. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). *See also* TMEP §1212.02(b) (2007).

acquired distinctiveness prior to the filing of the involved application, and since opposer's priority was not questioned, we find that opposer has priority.

We now turn to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant *du Pont* factors in the proceeding now before us are discussed below.

We first turn to consider the similarity between the parties' services. We note at the outset that applicant "admits there are some similarit[ies] between the services in question." (Request for Admissions response no. 4).⁸ Applicant's services, as identified in the application, are "hotel and motel services, [and] restaurant services." Normally, when an opposer owns a registration, we consider the identification of goods and/or services as identified in the pleaded registration. In this case, however, because opposer must rely on its common law rights, we consider the

⁸ Applicant appears to backtrack from this statement when he says in his brief that the services "are not related in any meaningful way." (Brief, p. 25). Nonetheless, the record, rather than statements in briefs, controls our determination.

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specific services with which the mark is used. Given the proofs, this distinction is of no moment in the present case, as opposer's common law rights are the same as the rights reflected in the identification of services in the now-expired registration.

The record establishes that opposer uses its mark in connection with lodging services for use of children and their families who are patients at NIH. Thus, these specific services will be compared with applicant's hotel, motel and restaurant services.

Applicant's identification of services is broadly worded and, as such, we must assume that applicant's hotel and motel services encompass all types of these services. These services would necessarily include offering lodging to families that travel to Maryland for treatment at NIH. As broadly worded, applicant's services may be rendered to the same classes of consumers as opposer's services. These consumers would include ordinary consumers who would exercise nothing more than ordinary care in making their decisions regarding nearby lodging in connection with a family's visit to NIH.

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée*

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En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

To state the obvious, the terms "children's" and "kid's" convey identical meanings. The terms "child" and "kid" (or, for that matter, "children" and "kids") are synonyms, and are used interchangeably in everyday English language. This fact is clearly established by opposer's dictionary and thesaurus evidence. The same generic word "inn" follows the terms "children's" or "kid's" in the respective marks. Thus, while the marks differ somewhat in sound and appearance, the marks convey identical meanings, that is, an inn catering to youngsters. The identity in meaning is not disputed by applicant. Given this identity in meaning, we find that the marks engender the same overall commercial impression when used in connection with lodging services. The identities in meaning and commercial impression outweigh the differences in sound and appearance.

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See Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992) [PLAY-DOH and FUN DOUGH held confusingly similar in part because PLAY and FUN "convey a very similar impression"]. *See also Hancock v. American Steel & Wire Co.*, 203 F.2d 737, 97 USPQ 330 (CCPA 1953) [TORNADO and CYCLONE mean the same thing to the ordinary consumer's mind].

Inasmuch as opposer introduced evidence bearing on the fame of its marks, we now turn to consider this du Pont factor. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, supra. Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1694. The relevant consuming public herein comprises the general public.

The record includes testimony and evidence bearing on the publicity surrounding the CHILDREN'S INN, a mark that opposer has used for almost twenty years. In addition to opposer's own efforts to increase public recognition,

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opposer's facility has received widespread media coverage, especially upon its opening attended by the President of the United States. Opposer also has engaged in consistent fundraising activities in an effort to attract donors. Opposer's facility has been mentioned on television and radio, and in national publications.

The record does not persuade us to bestow the exalted status of "famous" on opposer's mark. Nevertheless, we recognize that opposer's mark has garnered a degree of notoriety over two decades of use. Thus, we find that opposer's mark possesses a degree of strength with a corresponding scope of protection that encompasses applicant's similar mark for similar services. While the *du Pont* factor of the strength of the CHILDREN'S INN mark favors opposer, it does not do so to the extent that it would if the mark truly enjoyed extensive public recognition as a famous mark.

Applicant submitted evidence of two third-party uses of "Children's Inn," one being the name of a domestic abuse shelter in North Dakota, and the other being the name of a daycare facility in North Carolina. These uses have no impact on the degree of distinctiveness of opposer's mark. Firstly, the uses are in connection with services different from the types involved herein. Secondly, there is no evidence bearing on the extent of use of these names by the

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third parties. That is to say, there is no information concerning actual revenues under the names or that the public is familiar with such names. Accordingly, the evidence does nothing to diminish the distinctiveness of opposer's mark.

Applicant also introduced six third-party registrations of marks that include the term "INN" ("INN" disclaimed) for hotel, motel and restaurant services; two registrations of marks that include the term "FAMILY" for similar services; and four registrations of marks that include the term "CHILDREN'S" (or "CHILDREN") or "KIDS" for daycare or counseling services. As often stated, third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Thus, while we have considered the third-party registrations to the extent that they act like a dictionary definition showing that a term has a normally understood meaning, they are of limited probative value in deciding this case. *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988). Moreover, this evidence has virtually no effect on the level of distinctiveness of opposer's mark.

In reaching our conclusion, we are aware, of course, of the result reached in the ex parte appeal involving the

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present application. In that appeal, the examining attorney refused registration of the present application under Section 2(d) based on opposer's pleaded registration. The Board concluded that "although there is herein a potential of overlapping lodging services in a legal sense, given the overall differences in these highly suggestive marks and the restrictions placed on registrant's services, we find the chance of confusion in the actual marketplace to be *de minimis*." Thus, the Board reversed the Section 2(d) refusal.

Each case must be decided on its own merits and on the basis of the facts of record. Generally a decision in an *ex parte* appeal is based on a smaller record than in the case of an *inter partes* decision. The present situation is no exception. Suffice it to say, there are additional facts of record in the present case, particularly with respect to the notoriety of opposer's mark, that were not of record in the *ex parte* appeal. Moreover, the earlier *ex parte* appeal decision was marked "not citable as precedent" and, accordingly, this panel is not bound by it. While we have considered the Board's earlier decision, we have found that additional facts introduced by opposer provide a more complete record upon which to make a decision on the likelihood of confusion. These additional facts compel a different result from the one reached earlier.

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We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the arguments with respect thereto (including any arguments not specifically discussed in this opinion), and we conclude that opposer has proven its likelihood of confusion ground of opposition. Inasmuch as applicant is seeking a nationwide registration, we must assume, for purposes of our analysis, that applicant may open a hotel or motel in close proximity to NIH, and that patients' families unable to secure lodging at opposer's facility would look to applicant for accommodations. The record shows that when opposer's facility is filled to capacity, there are patients and their families who still require lodging and, thus, will stay in hotel rooms off the NIH campus. The number of families "bumped" since 1999 has tripled and, in 2003 alone, opposer turned away families on 400 occasions. Although opposer's expansion has alleviated some "bumping," the potential remains.

Given the notoriety of opposer's mark, and the similarity in the parties' marks and services, we conclude that purchasers familiar with opposer's lodging services for use of children and their families who are patients at NIH under the mark CHILDREN'S INN would be likely to believe, upon encountering applicant's mark KID'S INN for hotel, motel and restaurant services, that the services originate

from or are associated with or are somehow sponsored by the same source.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

As noted at the outset of this opinion, opposer also pleaded dilution. In view of our decision to sustain the opposition on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim. In saying this, however, we hasten to add that because we have already determined that opposer's mark is not famous for purposes of likelihood of confusion, and because the requirement for proving fame for dilution is more stringent than the requirement for proving fame for likelihood of confusion, opposer's dilution claim, based on the present record, would fail. *NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003); and *Toro v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.