

-11742

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 76/184840 for the mark BANYAN TREE & DESIGN, filed December 22, 2000 and published July 6, 2004

THE RITZ-CARLTON HOTEL	)	
COMPANY, L.L.C.,	)	
	)	
Opposer	)	
	)	
v.	)	Opp. No. _____
	)	
TROPICAL RESORTS MANAGEMENT	)	
COMPANY, LTD.,	)	
	)	
Applicant	)	

**NOTICE OF OPPOSITION**

The Ritz-Carlton Hotel Company, L.L.C. (“Opposer”), a limited liability company duly organized and existing under the laws of the State of Delaware, having a place of business at 10400 Fernwood Road, Bethesda, Maryland 20817, believes that it will be damaged by the registration of the mark shown in Application Serial No. 76/184840, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the mark THE BANYAN TREE, which Opposer has used continuously since at least as early as October, 1992 in connection with AAA Four Diamond award-winning restaurant services.

2. The restaurant services offered by Opposer under the mark THE BANYAN TREE are provided at Opposer’s hotel and resort located in Kapalua, Hawaii, which offers services that include fitness center services, health club and health spa services, hotel accommodation and temporary lodging services, hotel catering services, providing facilities for

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exhibitions, cocktail lounge services, cafes, snack bars, canteens, beauty salon services, and other services.

3. Since long prior to the filing date of Applicant's application, and prior to any use of Applicant's alleged mark in the United States, Opposer's mark THE BANYAN TREE has been extensively used, advertised, and promoted in connection with Opposer's services.

4. As a result of said extensive use, advertising, and promotion, Opposer's mark THE BANYAN TREE has become well-known as a distinctive indicator of the origin of Opposer's services, and the mark has become a valuable symbol of Opposer's goodwill.

5. Opposer also uses the mark THE BANYAN TREE in conjunction with a stylized depiction of a banyan tree.

6. Notwithstanding Opposer's prior rights in the mark THE BANYAN TREE, Applicant filed an application with the United States Patent and Trademark Office to register the mark BANYAN TREE & DESIGN that features a stylized depiction of a banyan tree (Ser. No. 76/184840) for hotel and resort services and related services, namely, "health spa services, namely, cosmetic body care services; hotels, providing hotel accommodation, hotel catering, making hotel reservations for others, motels, making reservations for temporary lodging, providing facilities for exhibitions, cocktail lounge services, cafes, snack-bars, canteens, catering, plastic surgery, manicuring, beauty salons, hair dressings salons, sanatoriums, providing public baths for hygiene purposes and Turkish baths," "Fitness center services, health club services, and education services, namely, conducting classes, seminars, conferences and workshops in the fields of health, fitness, diet and well-being," "hotel management for others, and business management of residential suites and full service apartments," and "management of residential suites, management of full service apartments."

7. Upon information and belief, Applicant made no use of its alleged mark in the United States prior to the filing date of its application.

**Likelihood of Confusion - §2(d)**

8. The mark which Applicant seeks to register is identical to or so closely resembles Opposer's mark THE BANYAN TREE that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark.

9. The services of Applicant are so closely related to the services of Opposer that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's services are those of Opposer or that Applicant is in some way connected with or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

10. Likelihood of confusion in this case is enhanced by the fact that consumers associate Opposer's mark with services offered, sold, approved, or endorsed by Opposer; moreover, purchasers of Applicant's services are prospective purchasers of Opposer's services.

**Deception/False Suggestion of Connection - §2(a)**

11. Applicant's alleged mark so closely resembles Opposer's mark THE BANYAN TREE that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the services, and this is likely to materially alter purchasers' decisions to acquire Applicant's services.

12. Applicant's alleged mark so closely resembles Opposer's mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicants' alleged mark points uniquely to Opposer, and purchasers will assume that services

offered under Applicant's alleged mark are connected with Opposer.

13. Applicant's alleged mark is deceptive in that it falsely suggests a connection with or approval by the Opposer.

14. Likelihood of confusion and deception is enhanced by the fact that the parties' services are sold through the same trade channels to the same classes of prospective purchasers.

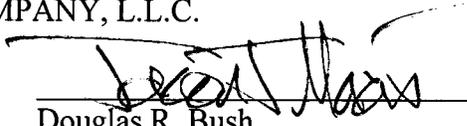
**Invalid 44(e) Basis**

15. On information and belief, Applicant is not entitled to rely on Section 44(e) as a basis for registration because the services listed in the translation of the alleged foreign registrations are materially different in whole or in part from the services listed in the application opposed herein.

16. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark, and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

THE RITZ-CARLTON HOTEL  
COMPANY, L.L.C.

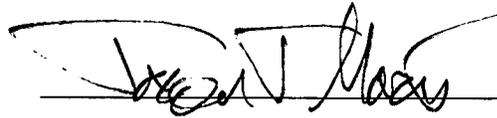
By: 

Douglas R. Bush  
Michael A. Grow  
Jason J. Mazur  
Arent Fox PLLC  
1050 Connecticut Avenue, NW  
Washington, D.C. 20036  
(202) 857-6000

Attorneys for Opposer  
The Ritz-Carlton Hotel Company, L.L.C.

**CERTIFICATE OF MAILING**

It is hereby certified that the attached **Notice of Opposition** (re Application No. 76/184840) is being deposited with the U.S. Postal Service addressed to the Commissioner of Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, this 3 day of January, 2005, marked first class mail, postage prepaid.

A handwritten signature in black ink, appearing to read "W. J. Moore", is written over a horizontal line.

January 3, 2005

**Jason J. Mazur**  
202.715.8409 DIRECT  
202.857.6395 FAX  
mazur.jason@arentfox.com

**BY FIRST CLASS MAIL**

Commissioner of Trademarks  
US Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Re: Notice of Opposition to BANYAN TREE & DESIGN (Serial No. 76/184840)  
in Classes 35, 36, 41, and 42**

Dear Sir/Madam:

Enclosed for filing is a notice of opposition to the above-referenced application in Classes 35, 36, 41, and 42. Please charge the \$1200 to cover the opposition filing fee for the four classes, as well as any other necessary expenses, to our deposit account No. 01-2300.

Please direct any correspondence and questions regarding this notice of opposition to Douglas R. Bush at Arent Fox, PLLC at 1050 Connecticut Avenue, NW, Washington DC 20036. Thank you.

Sincerely,



Jason J. Mazur

Enclosures



01-05-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

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Arent Fox PLLC

1050 Connecticut Avenue, NW

Washington, DC 20036-5339

202.857.6000 PHN

WASHINGTON DC NEW YORK  
202.857.6395 FAX www.arentfox.com