

ESTTA Tracking number: **ESTTA380848**

Filing date: **11/29/2010**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Coco Beach Development Corporation
Granted to Date of previous extension	11/27/2010
Address	Andes St. and 65th Infantry Marginal Rd. San Juan, PR 00928 UNITED STATES

Attorney information	Roberto C. Quinones McConnell Valdes LLC 270 Munoz Rivera Avenue9th Floor San Juan, PR 00918 UNITED STATES rcq@mcvpr.com Phone:787.250.2631
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Applicant Information

Application No	85022638	Publication date	09/28/2010
Opposition Filing Date	11/29/2010	Opposition Period Ends	11/27/2010
Applicant	Chuang, Alexander E 4549 Alamo St Unit B Simi Valley, CA 93063 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. All goods and services in the class are opposed, namely: Tanning salons

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3158354	Application Date	11/22/2005
Registration Date	10/17/2006	Foreign Priority Date	NONE

Word Mark	COCO BEACH
Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1998/03/19 First Use In Commerce: 1998/03/19 Country clubs; Entertainment in the nature of golf tournaments; Golf club services; Golf courses; Golf instruction; Providing golf facilities

Attachments	78758880#TMSN.jpeg (1 page)(bytes) NOTICE OF OPPOSITION COCO BEACH.PDF (5 pages)(46418 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Roberto C. Quinones/
Name	Roberto C. Quinones
Date	11/29/2010

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

In the Matter of Application Serial No. 85022638
Mark: Coco Beach in Class 44

COCO BEACH DEVELOPMENT CORPORATION

Opposer

v.

Opposition No. _____

Alexander E. Chuang

Applicant.

Box TTAB- FEE

NOTICE OF OPPOSITION

Coco Beach Development Corporation (“Coco Beach Development” or “Opposer”), a corporation organized and existing under the laws of the Commonwealth of Puerto Rico, located and doing business at Andes Street and 65th Infantry Marginal Road, San Juan, Puerto Rico, believes that it would be damaged by the issuance of a registration for the mark shown in Application Serial No. 85022638 for the mark COCO BEACH in Class 44 and therefore opposes the same.

As grounds for its opposition, Coco Beach Development alleges the following:

1. Coco Beach Development is the master planner/developer of Coco Beach Resort, a master planned resort community in Río Grande, Puerto Rico featuring two hotels, two eighteen-hole golf courses, clubhouse, beach club and multiple residential sites. Coco Beach Development has been engaged in business since at least as early as February 1998.

2. At least as early as 1998, Coco Beach Development adopted the term COCO BEACH as its mark. Since then, Opposer has used the mark COCO BEACH

continuously in interstate, territorial, and international commerce, including marketing its goods and services in various national and international media and venues.

3. Coco Beach Development is the owner of all right, title, and interest in and to the COCO BEACH mark, registered in the U.S. Patent and Trademark Office, as follows:

Mark	Registration No.	Date of First Use	Goods/Services
COCO BEACH	3,158,354	March 19, 1998	<u>Class 41</u> : country clubs, entertainment in the nature of golf tournaments; golf club services; golf courses; golf instruction; providing golf facilities.

The registration is valid, subsisting and in full force and effect, and constitutes *prima facie* evidence of the validity of the mark and of Opposer's exclusive right to use it on goods and in connection with the services of Coco Beach Development. Moreover, the registration is proof of the inherent distinctiveness of Coco Beach Development's mark.

4. In addition to the goods and services for which Opposer has secured a registration, Opposer has expanded the use of the COCO BEACH mark to two luxury hotels/resorts, a beach club and multiple residential sites.

5. The COCO BEACH mark has been extensively featured in advertisements in television and print, as well as the internet and national and international tourism marketing efforts. As a result of Coco Beach Development's extensive advertising and promotional efforts and use of its COCO BEACH mark for over ten years in interstate, territorial, and international commerce, Coco Beach Development's COCO BEACH mark has acquired enormous value and has become famous and well-known to the consuming public and trade as identifying and

distinguishing the goods and services exclusively from, or authorized by, Coco Beach Development.

6. On March 25, 2010, Applicant applied to register the mark COCO BEACH in Class 44 on the basis of intent to use the mark in commerce on or in connection with the identified goods and/or services, 15 U.S.C. § 1051(b). This application was assigned Serial No. 85022638.

As a First Ground for Denial of Application Serial No. 85022638

7. Coco Beach Development incorporates herein by reference the allegations set forth above in paragraphs 1-6.

8. The name COCO BEACH is identical to Coco Beach Development's mark. The use and registration of the COCO BEACH mark by Applicant in Class 44 would be likely to confuse and deceive consumers into thinking that Applicant's products and services are affiliated, associated or connected with, or sponsored, approved or endorsed by Coco Beach Development or its COCO BEACH mark.

9. Based on Applicant's filing date and Coco Beach Development's prior use of the COCO BEACH mark in commerce, Coco Beach Development has priority of use with respect to the COCO BEACH mark.

10. The registration of Applicant's mark would be inconsistent with Coco Beach Development's prior rights in the COCO BEACH mark and would destroy Coco Beach Development's investment and goodwill in its mark. Accordingly, Applicant's use of the mark is in violation of Sections 2(d) and 43(a) of the Federal Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(a), and the Application should be denied.

As a Second Ground for Denial of Application Serial No. 85022638

11. Coco Beach Development incorporates herein by reference the allegations set forth above in paragraphs 1-10.

12. The services for which Applicant seeks registration of the COCO BEACH mark, to wit, tanning salons, are closely related to the goods and services for which Opposer uses the COCO BEACH mark. Therefore, this will likely result in confusion or mistake, or deceive the public as to the source or origin of Applicant's products, services or commercial activities, in violation of Sections 2(d) and 43(a) of the Federal Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(a).

13. Coco Beach Development's services are sufficiently related to Applicant's services that consumers are likely to confuse the source of origin. See Scarves by Vera, Inc. v. Todo Imports, Ltd., 544 F. 2d 1167 (2d Cir. 1976); James Burrough Limited v. Sign of the Beefeater, Inc., 540 F. 2d 266 (7th Cir. 1976); E. & J. Gallo Winery v. Gallo Cattle, Co., 955 F 2d 1327 (9th Cir. 1992). For trademark likelihood of confusion purposes, "goods are related if they are used in conjunction with one another or are associated together in some way in the minds of the consuming public." Dunhill of London, Inc. v. Kasser Distillers Products Corp., 350 F. Supp. 1341 (E.D. Penn. 1972).

14. Coco Beach Development's and Applicant's respective services all relate to leisure and recreational activities.

15. Moreover, hotels, resorts, country clubs and golf clubs often offer spa services, including tanning salons, among their recreational offerings. Additionally, country clubs and golf clubs have become a "one-stop-shop" for leisure and recreational services such as spa services, and spas often feature tanning salons.

16. In light of the above, it is likely that some consumers confronted with tanning salons bearing the COCO BEACH mark will be confused into thinking that there is a common source of origin, affiliation, connection or sponsorship between said tanning salons and Coco Beach Development's well-known hotels/resorts, golf courses, club house, beach club, and residences.

17. For these reasons, Application Serial No. 85022638 should be denied, as it is likely to cause confusion among the consuming public.

As a Third Ground for Denial of Application Serial No. 85022638

18. Coco Beach Development incorporates herein by reference the allegations set forth above in paragraphs 1-17.

19. Because Opposer's COCO BEACH mark is famous, applicants use and registration of the same mark will dilute the distinctiveness of Coco Beach Development's COCO BEACH mark. Consequently, the present Application should be denied.

WHEREFORE, Coco Beach Development requests that its Notice of Opposition be granted and that Application Serial No. 85022638 be denied.

I hereby certify that this Notice of Opposition is being transmitted via the Electronic System for Trademark Trials and Appeals (ESTTA) on the PTOnet to the United States Patent and Trademark Office on the date shown below.

Dated: November 29, 2010

Respectfully submitted,

McCONNELL VALDÉS LLC

By: s/Roberto C. Quiñones-Rivera/
Roberto C. Quiñones-Rivera

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