

ESTTA Tracking number: **ESTTA389787**

Filing date: **01/24/2011**

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	SERRALLES HOTEL, INC.
Granted to Date of previous extension	01/22/2011
Address	1150 CARIBE AVENUESUITE 201 PONCE, PR 00731 UNITED STATES

Attorney information	Roberto C. Quinones-Rivera 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	77903340	Publication date	11/23/2010
Opposition Filing Date	01/24/2011	Opposition Period Ends	01/22/2011
Applicant	Alvarez, George 4201 S.W. 11th Street Coral Gables, FL 33134 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2002/09/05 First Use In Commerce: 2002/09/05 All goods and services in the class are opposed, namely: Travel services, namely, making reservations and bookings for temporary lodging; making hotel and lodging reservations for individuals and groups via a global computer network
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	The mark is not a registrable mark because it does not function as an indicator of source or origin

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2802877	Application Date	02/28/2001
Registration Date	01/06/2004	Foreign Priority	NONE

		Date	
Word Mark	COSTA CARIBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/01/01 First Use In Commerce: 2002/01/01 Real estate services, namely, agency, brokerage, leasing, listing, time-sharing, and trustee services for real estate		

U.S. Registration No.	3329786	Application Date	02/28/2001
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	COSTA CARIBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/01/02 First Use In Commerce: 2002/01/02 Sport clothing, namely, caps, sun visors, tennis shirts, tennis shorts, golf shirts, golf shorts, polo shirts and T-shirts		

U.S. Registration No.	3870719	Application Date	05/21/2010
Registration Date	11/02/2010	Foreign Priority Date	NONE
Word Mark	COSTA CARIBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2003/02/01 First Use In Commerce: 2003/02/01 Golf bag tags; Golf bags; Golf balls; Tennis balls		

U.S. Registration	2811086	Application Date	02/28/2001
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No.			
Registration Date	02/03/2004	Foreign Priority Date	NONE
Word Mark	COSTA CARIBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2003/05/12 First Use In Commerce: 2003/05/13 Resort hotel services and restaurants		

U.S. Registration No.	2851252	Application Date	02/28/2001
Registration Date	06/08/2004	Foreign Priority Date	NONE
Word Mark	COSTA CARIBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 2003/11/21 First Use In Commerce: 2003/11/21 Towels		

Attachments	76218400#TMSN.gif (1 page)(bytes) 85044726#TMSN.jpeg (1 page)(bytes) Opposition - coralcostaribe.com.PDF (8 pages)(68297 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 Overnight Courier on this date.

Signature	/Roberto C. Quinones-Rivera/
Name	Roberto C. Quinones-Rivera
Date	01/24/2011

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

In the Matter of Application Serial No. 77903340
Mark: CoralCostaCaribe.com in Class 43

SERRALLÉS HOTEL, INC.

Opposer

v.

Opposition No. _____

George Alvarez

Applicant.

NOTICE OF OPPOSITION

Serrallés Hotel, Inc. (“Serrallés” or “Opposer”), a corporation organized and existing under the laws of the Commonwealth of Puerto Rico, located and doing business at 1150 Caribe Avenue, Suite 201, Ponce, Puerto Rico, believes that it would be damaged by the issuance of a registration for the mark shown in Application Serial No. 77903340, CORALCOSTACARIBE.COM in Class 43, and therefore opposes the same.

As grounds for its opposition, Serrallés states:

1. Serrallés is the master planner/developer of the Costa Caribe Resort, a resort community in Ponce, Puerto Rico, featuring a hotel, 27 holes of championship golf, a clubhouse, a beach club, a tennis club, a casino, multiple dining facilities and residential sites. Serrallés has been engaged in this business since at least as early as January 2002.

2. Since at least as early as 2002, Serrallés adopted the term COSTA CARIBE as its mark. Since then, it has used the mark COSTA CARIBE continuously in interstate, territorial, and international commerce, including advertising and marketing goods and services, through

its website, the Hilton Caribbean website, Puerto Rico and United States publications, and in various local, national, and international tourism forums.

3. The Costa Caribe Resort regularly receives guests from Puerto Rico, the United States and elsewhere, including Europe, Central and South America, Asia and Africa. The hotel offers 253 double occupancy rooms and, on average, accommodates 40,000 guests per year. The Costa Caribe Golf and Country Club also attracts players from Puerto Rico, the United States and foreign countries, with an average of 20,000 rounds of golf played per year. The Costa Caribe Club House comprises two restaurants, a golf shop, locker rooms, Turkish baths, a pool and beach access, and receives at least 200 guests daily.

4. Serrallés is the owner of all right, title, and interest in and to the COSTA CARIBE mark, registered in the U.S. Patent and Trademark Office, as follows:

Mark	Registration No.	Date of First Use	Goods/Services
COSTA CARIBE	2802877	January 1, 2002	<u>Class 36</u> : Real estate services, namely, agency, brokerage, leasing, listing, time-sharing, and trustee services for real estate.
COSTA CARIBE	3329786	January 2, 2002	<u>Class 25</u> : Sport clothing, namely, caps, sun visors, tennis shirts, tennis shorts, golf shirts, golf shorts, polo shirts and T-shirts.
COSTA CARIBE	3870719	February 1, 2003	<u>Class 28</u> : Golf bag tags; Golf bags; Golf balls; Tennis balls.
COSTA CARIBE	2811086	May 13, 2003	<u>Class 42</u> : Resort hotel services and restaurants.
COSTA CARIBE	2851252	November 21, 2003	<u>Class 24</u> : Towels.

These registrations are valid, subsisting and in full force and effect, and constitute prima facie evidence of the validity of the COSTA CARIBE mark and of Opposer's exclusive right to use it in connection with the goods and services identified in the registrations listed above. All of the registrations are incontestable and, therefore, constitute conclusive evidence of Opposer's

exclusive right to use the mark, in accordance with 15 U.S.C. § 1065. In addition, the registrations are proof of the inherent distinctiveness of Opposer's COSTA CARIBE mark.

5. For nearly a decade, the COSTA CARIBE mark has been extensively featured in advertisements in television and print, as well as in Opposer's website and in local, national, and international tourism advertisement efforts. As a result of Serrallés' extensive advertising of, and promotional efforts in connection with, its COSTA CARIBE mark and its use of the mark for nearly a decade in interstate, territorial, and international commerce, the COSTA CARIBE mark has acquired enormous value and has become well-known to the consuming public and trade as identifying and distinguishing the goods and services exclusively from, or authorized by, Serrallés.

6. On December 31, 2009, Applicant applied to register the mark CORALCOSTACARIBE.COM in Class 43 on the basis of use in commerce on or in connection with travel services, namely, making reservations and bookings for temporary lodging; making hotel and lodging reservations for individuals and groups via a global computer network, 15 U.S.C. § 1051(a). This application was assigned Serial No. 77903340.

7. Based on Applicant's filing date and Opposer's prior use of the COSTA CARIBE mark in commerce, Serrallés has priority of use with respect to the COSTA CARIBE mark.

8. The registration of Applicant's mark would be inconsistent with Opposer's prior rights in the COSTA CARIBE mark and would destroy Opposer's investment and goodwill in its mark.

**I. As a First Ground for Denial of Application Serial No. 77903340:
Similarity of Marks is Likely to Cause Confusion**

9. Serrallés incorporates herein by reference the allegations set forth above in paragraphs 1-8.

10. The name CORALCOSTACARIBE.COM so resembles Opposer's registered mark COSTA CARIBE as to be likely to cause confusion or mistake or to deceive. It

incorporates the entirety of Serrallés' COSTA CARIBE mark, adding only two syllables before the mark (cor-al) and the top-level Internet domain name ".com," which serves no source-indicating function.

11. Thus, the proposed mark is substantially similar to Opposer's registered mark. Accordingly, the use and registration of the CORALCOSTACARIBE.COM mark by Applicant in Class 43 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 Serrallés or its COSTA CARIBE mark.

12. The registration of Applicant's mark therefore would violate Sections 32(1)(a) and 45 of the Federal Trademark Act, 15 U.S.C. §§ 1114(1)(a) and 1127. Accordingly, the Application should be denied.

**II. As a Second Ground for Denial of Application Serial No. 77903340:
Likelihood of Confusion for Use of Mark on Related Goods**

13. Serrallés incorporates herein by reference the allegations set forth above in paragraphs 1-12.

14. The goods and services for which Applicant seeks registration of the CORALCOSTACARIBE.COM mark, to wit, travel services, are closely related to the goods and services for which Opposer has registered the COSTA CARIBE mark. Therefore, this will likely result in confusion or mistake, or deceive the public, not only as to source, but also as to sponsorship, affiliation or connection 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).

15. For 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).

16. The Trademark Board has stated that “[a]lthough confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection.” Hilson Research, Inc. v. Society for Human Resource Management, 27 U.S.P.Q.2d 1423, 1993 WL 290669 (T.T.A.B. 1993); 4 McCarthy on Trademarks and Unfair Competition § 23:78 (4th ed.).

17. Applicant's use of CORALCOSTACARIBE.COM for providing travel services and making and booking hotel and lodging reservations would directly compete with Opposer's use of its COSTA CARIBE mark for hotel and resort services, restaurant services, real estate leasing and listing, and time-sharing brokerage. Applicant would be marketing an overlapping product to the same group of consumers using a virtually identical mark. The similarity of the proposed mark and the fact that it allegedly is used to identify a website that offers travel services is likely to suggest to the typical consumer that CORALCOSTACARIBE.COM is affiliated to the Costa Caribe Resort and its COSTA CARIBE mark.

18. For these reasons, Application Serial No. 77903340 should be denied, as it is likely to cause confusion among the consuming public, in violation of Sections 2(d) and 43(a) of the Federal Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(a).

**III. As a Third Ground for Denial of Application Serial No. 77903340:
the Proposed Mark, as Used in the Specimen, Is Not a Registrable Mark
Because it is Does Not Function as an Indicator of Source or Origin**

19. Serrallés incorporates herein by reference the allegations set forth above in paragraphs 1-18.

20. Applicant cannot claim trademark use of the mark CORALCOSTACARIBE.COM because it does not use it in such a way as to make a visual impression that the viewer would see as a symbol of source or origin. Not everything that is recognized or associated with a party is necessarily a registrable trademark. See In re Standard Oil Co., 275 F.2d 945, 947 (C.C.P.A. 1960).

21. A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark must be used in a manner that potential purchasers will perceive as an indicator of source and not merely as the address used to access a website. See In re Roberts, U.S.P.Q. 2d 1474 (TTAB 2008).

22. In order to claim trademark use, the mark must be used in a way that sets apart the word, phrase or pictures that constitute the mark, so that the viewers see it as an indicator of origin.

23. Applicant's use of CORALCOSTACARIBE.COM in its travel services website does not cause the visual impression that would lead consumers to relate it to a source or origin. At best, Applicant's use is purely ornamental or a mere website address. In fact, the words appear in a smaller font size than many other words contained in the website. They are displayed in a pale, non-distinctive color and print. The words only appear once in the main page of the website and are not used repetitively, so as to be perceived as a mark.

24. Further, an application must include a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In this case, Applicant seeks registration of the mark CORALCOSTACARIBE.COM on or in connection with travel services, International Class 43. However, the specimen provided by Applicant consists of a webpage advertising a resort hotel owned by Coral Hospitality Corp., located in the Dominican Republic and known as the Coral Costa Caribe Resort, Spa & Casino. This webpage is not dedicated to providing travel services or services for making reservations for any other hotel or lodging, other than the Coral Costa Caribe Resort. Said resort hotel allegedly contains several restaurants. Therefore, the specimen does not support an application in Class 43 for travel services, namely, making reservations and bookings for temporary lodging.

25. Additionally, in order to make a reservation, the user is redirected to a different website called onlinevacstore.com. That is, on website coralcostaribe.com, the user **cannot actually make reservations**, as Applicant alleges. Instead, the user is redirected to a different

webpage or instructed to call a phone number associated to onlinevacstore.com or travelquotes.com. It is evident that Applicant's mark is not being used consistently or repetitively, in a manner that indicates source or origin for travel services.

26. For the forgoing reasons, Applicant's mark should be denied registration, as the use Applicant gives to CORALCOSTACARIBE.COM does not constitute a protectable trademark use in Class 43.

WHEREFORE, Serrallés requests that its Notice of Opposition be granted and that Application Serial No. 77903340 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: January 24, 2011

Respectfully submitted,

McCONNELL VALDÉS LLC

By: 

Roberto C. Quiñones-Rivera

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CERTIFICATE OF SERVICE

I hereby certify that on this date a true and exact copy of the foregoing Motion to Suspend was sent by e-mail and first class mail to the following attorneys for the Applicant:

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Dated: January 24, 2011