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

Proceeding	91198298
Party	Defendant Alvarez, George
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SERRALLÉS HOTEL, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91198298
	)	
George Alvarez	)	
	)	
	)	
Applicant.	)	
	)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, George Alvarez ("Applicant" or "Alvarez"), by its undersigned counsel, hereby answers the allegations set forth in the Notice of Opposition (the "Opposition") filed by Opposer Serrallés Hotel, Inc. ("Opposer") as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Opposition and, for that reason, denies them.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Opposition and, for that reason, denies them. Applicant notes Opposer's claim in Paragraph 1 of the Opposition that Opposer's Costa Caribe Resort is located in Puerto Rico. Applicant, by contrast, provides travel booking services for a resort located in the Dominican Republic. There is no likelihood of confusion between Applicant's and Opposer's respective marks since, among other factors, there is no overlap between Applicant's and Opposer's respective business territories.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Opposition and, for that reason, denies them.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in the first sentence of Paragraph 4 of the Opposition and, for that reason, denies them. Applicant denies Opposer's allegation that Opposer's registrations "are valid, subsisting in full force and effect." To the contrary, Registration No. 2,851,252 for COSTA CARIBE in Class 24 for Towels was cancelled by the USPTO on January 14, 2011 for Opposer's failure to file a Section 8 Declaration of Continued Use. Applicant further denies Opposer's allegations that "all of" Opposer's registrations are incontestable. To the contrary, Registration No. 2,851,252 has been cancelled, as noted above, and Registration Nos. 3,329,786 (Registered on November 6, 2007) and 3,870,719 (Registered on November 2, 2010) are not even eligible for incontestable status as both have been registered for less than five years. The remaining allegations contained in Paragraph 4 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 4 of the Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Opposition and, for that reason, denies them.

6. Admitted.

7. The allegations contained in Paragraph 7 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 7 of the Opposition.

8. The allegations contained in Paragraph 8 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 8 of the Opposition.

I. As a First Ground for Acceptance of Application Serial No. 77/903,340: The Marks are Not Confusingly Similar and There Is No Likelihood of Confusion

9. Applicant incorporates by reference its responses set forth in Paragraphs 1 through 8 above.

10. The allegations contained in Paragraph 10 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 10 of the Opposition. Applicant's mark and Opposer's mark in their entireties convey significantly different commercial impressions. The dominant element in Applicant's mark is the word "CORAL," which does not appear in Opposer's mark. "CORAL" is an arbitrary and distinctive word used by Applicant in connection with its services.

11. The allegations contained in Paragraph 11 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 11 of the Opposition.

12. The allegations contained in Paragraph 12 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 12 of the Opposition.

II. As a Second Ground for Acceptance of Application Serial No. 77/903,340: There is No Likelihood of Confusion, Mistake or Deception

13. Applicant incorporates by reference its responses set forth in Paragraphs 1 through 12 above.

14. The allegations contained in Paragraph 14 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 14 of the Opposition.

15. The allegations contained in Paragraph 15 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 15 of the Opposition.

16. The allegations contained in Paragraph 16 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 16 of the Opposition.

17. The allegations contained in Paragraph 17 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 17 of the Opposition.

18. The allegations contained in Paragraph 18 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 18 of the Opposition.

III. As a Third Ground for Acceptance of Application Serial No. 77/903,340: Applicant's Mark is a Registrable Mark and Functions as an Indicator of Source or Origin

19. Applicant incorporates by reference its responses set forth in Paragraphs 1 through 18 above.

20. The allegations contained in Paragraph 20 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 20 of the Opposition.

21. The allegations contained in Paragraph 21 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 21 of the Opposition.

22. The allegations contained in Paragraph 22 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 22 of the Opposition.

23. Denied as to the display of Applicant's mark on its website. To the contrary, Applicant's CORALCOSTACARIBE.COM mark appears in large font in white against a dark orange background. The remaining allegations contained in Paragraph 23 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in the remainder of Paragraph 23 of the Opposition.

24. The allegations contained in Paragraph 24 are admitted only in reference to the fact that Applicant's CORALCOSTACARIBE.COM website is dedicated to providing travel services or services for making reservations for lodging at the Coral Costa Caribe resort, which is located in the Dominican Republic. There is no legal requirement that Applicant's website be used to provide services for more than one resort. Opposer states in Paragraph 1 of the Opposition that Opposer's Costa Caribe Resort is a resort located in Ponce, Puerto Rico. Thus, by Opposer's admission, Applicant's CORALCOSTACARIBE.COM mark and Opposer's alleged mark are used in connection with two entirely different resorts located in two different countries, which obviates any likelihood of confusion. The allegations contained in Paragraph 24 of the Opposition are denied as to the description of Applicant's pending application. Applicant seeks registration of its CORALCOSTACARIBE.COM mark for "travel services, namely, making reservations and bookings for temporary lodging; making hotel and lodging

reservations for individuals and groups via a global computer network" in International Class 043. Further, Applicant's mark and Opposer's mark in their entireties convey significantly different commercial impressions. The dominant element in Applicant's mark is the word "CORAL," which does not appear in Opposer's mark. "CORAL" is an arbitrary and distinctive word used by Applicant in connection with its services. By contrast, and by Opposer's admission in its application filings, the Spanish words "COSTA CARIBE" in Opposer's mark translate to "CARIBBEAN COAST" in English. Opposer disclaimed "CARIBE" as descriptive in Registration Nos. 2,802,877; 3,870,719 and 2,811,086 and thus does not have an exclusive right to use CARIBE in connection with the services it alleges that it provides in Classes 36 and 42 as well as the goods it allegedly provides in Class 28. As for the word "COSTA," upon information and belief, Opposer's Costa Caribe resort is literally located on the Caribbean coast. Consumers are unlikely to become confused or believe that Applicant's and Opposer's respective services emanate from a single source. Opposer's reference to the apparent inclusion of restaurants at the resort is unintelligible and not applicable to this Opposition as Applicant does not use and has not applied to use its CORALCOSTACARIBE.COM mark in connection with restaurant services. The remaining allegations contained in Paragraph 24 of the Opposition set forth legal conclusions to which no response is required. Nonetheless, Applicant notes that its specimen was accepted by the USPTO during the examination process as showing proper use of Applicant's mark in commerce. To the extent a response is required, Applicant denies the allegations contained in the remainder of Paragraph 24 of the Opposition.

25. The allegations contained in the first three sentences of Paragraph 25 are Denied. To the contrary, a user can make reservations through Applicant's CoralCostaCaribe.com website. The allegations contained in the remainder of Paragraph 25 set forth legal conclusions

as to which no response is required. To the extent a response is required, Applicant denies the allegations contained in the reminder of Paragraph 25 of the Opposition.

26. The allegations contained in Paragraph 26 of the Opposition set forth legal conclusions to which no response is required. To the extent a response is required, Applicant denies the allegations contained in Paragraph 26 of the Opposition.

AFFIRMATIVE DEFENSES

In further answer to the Opposition, Applicant asserts that:

1. Opposer has failed to state a claim, in whole or in part, upon which relief may be granted.

2. Opposer has failed to allege facts sufficient to establish a likelihood of confusion, mistake or deception between Applicant's mark and the Opposer's asserted marks.

3. There is no likelihood of confusion, mistake, or deception between Applicant's mark and Opposer's asserted marks.

4. A mark's incontestable status is not a relevant factor for consideration in a likelihood of confusion proceeding.

5. Opposer's marks are merely descriptive or generic.

6. Opposer has failed to allege facts sufficient to establish that Applicant's mark misdescribes the nature or origin of Applicant's goods and that any purported misdescription would alter a consumer's decision to purchase Applicant's services.

7. Opposer fails to cite any statutory grounds supporting its allegation that Applicant's mark, as used in the specimen, is not a registrable mark because it does not function as an indicator of source or origin. The USPTO approved Applicant's specimen as showing sufficient use of Applicant's mark in commerce.

8. Applicant's mark accurately describes the nature and origin of Applicant's services.

9. Applicant's mark, as used in the specimen, is a registrable mark and functions as an indicator of source and origin.

10. Opposer has failed to allege facts sufficient to establish that use and registration of Applicant's mark would falsely suggest a connection with Opposer or its asserted marks.

11. Use and registration of Applicant's mark would not falsely suggest a connection between Applicant and Opposer or its asserted marks.

12. Opposer has failed to allege facts sufficient to establish that Opposer's asserted marks are well known or famous.

13. Opposer's asserted marks are not well known or famous.

14. Opposer's legitimate interests will not be damaged in any way by the registration of Applicant's mark.

WHEREFORE, Applicant respectfully requests that the Opposition be dismissed in its entirety, that Applicant's mark be allowed to proceed to registration, and that Applicant be granted such additional relief as the Trademark Trial and Appeal Board may find to be warranted under the circumstances.

Respectfully submitted,

/s/ Sara A. Chandler
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Date: March 4, 2011

Attorneys for Applicant
George Alvarez

CERTIFICATE OF SERVICE

The undersigned herby certifies that a true and correct copy of the foregoing was served this 4th day of March 2011, via first class mail, postage prepaid, upon the following counsel of record:

Roberto C. Quiñones-Rivera
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/s/ Sara A. Chandler