

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

CR License, LLC,)	Cancellation No. 91202705 (parent)
)	92054034
)	
Petitioner,)	
)	Marks: GRAND CANYON RANCH
v.)	GRAND CANYON RANCH
)	AT SPIRIT MOUNTAIN
)	
Grand Canyon Ranch,)	Reg. No. 3,927,500
)	App. No. 77/905,088
)	
Respondent.)	
_____)	

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PETITIONER'S ACR TRIAL BRIEF

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Pursuant to the parties' Stipulation to Participate in ACR, 37 C.F.R. § 2.128 and T.B.M.P. § 801.02, Petitioner, CR License, LLC dba Canyon Ranch ("Canyon Ranch") hereby submits this Brief in Support of its Petition to Cancel United States Trademark No. 3,927,500 and its Opposition to United States Trademark Serial No. 77/905,088 filed and owned by Grand Canyon Ranch, LLC ("GCR").

I. INTRODUCTION

Canyon Ranch submits this Brief in Support of its Petition to Cancel U.S. Trademark Registration Nos. Reg. No. 3,927,500 [Grand Canyon Ranch & Design] and its Oppositions to U.S. Trademark Application Serial No. 77/905,088 [Grand Canyon Ranch at Spirit Mountain & Design]. The following chart identifies the two marks at issue and GCR's own description of its services:

MARK	REG. NO./SER. NO	GCR'S DESCRIPTION OF SERVICES
<p>Grand Canyon Ranch & Design</p> 	<p>3,927,500</p>	<p>cl. 39: Excursion arrangements for tourists.</p> <p>cl. 41: recreational and entertainment services in the nature of horse-drawn wagon rides, horse-back riding and helicopter tours, ATV (all-terrain vehicle) tours, hiking, mountain biking.</p> <p>cl. 43: providing temporary accommodations in the nature of a guest ranch, dude ranch, cabin and resort lodging accommodations, and authentic tipi accommodations; restaurants and bars.</p>
<p>Grand Canyon Ranch at Spirit Mountain & Design</p> 	<p>77/905,088</p>	<p>cl. 39: Excursion arrangements for tourists.</p> <p>cl. 41: Recreational and entertainment services in the nature of horse-drawn wagon rides, horse-back riding and helicopter tours, ATV (all-terrain vehicle) tours, hiking, and mountain biking.</p>

These marks are referred to collectively as the “Disputed Marks.” Canyon Ranch’s petition and opposition is founded on claims of (1) a likelihood of confusion, mistake or deception under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and (2) a likelihood of dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), both arising from Canyon Ranch’s famous and incontestable CANYON RANCH® marks, the federal registrations for which include:

MARK	REG. NO.	GOODS AND SERVICES
CANYON RANCH	1,598,938	39: Transportation of passengers by means of automobile and reservation services for transportation
CANYON RANCH	1,350,012	41: Conducting programs in exercise and physical conditioning 42: Fitness resort and restaurant services
CANYON RANCH	3,172,612	41: Sports and entertainment services, namely, golf; educational services, namely, conducting classes and demonstrations in the fields of physical fitness training
CANYON RANCH	3,178,367	41: Health club services, namely, providing instruction and equipment in the field of physical exercise; physical education services, namely, providing exercise classes to others and conducting classes in exercise and physical conditioning; educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of nutrition, exercise, physical conditioning, conflict management, family health, wellness, prevention of disease, beauty, skin care, physical fitness, physical training, stress management and behavior modification; counseling and consultation services in the fields of exercise and physical conditioning, physical fitness and physical training
CANYON RANCH	3,202,993	43: Health resort services, namely, providing food and lodging that specialize in promoting patrons’ general health and well-being; resort lodging services; providing temporary housing accommodations; providing a database in the field of recipes and cooking information; restaurant services

In particular, the evidence presented in this case and discussed herein demonstrates, that consumers are likely to be confused as to the source, association or sponsorship of GCR’s services as a result of GCR’s use of marks that are confusingly similar to Canyon Ranch’s world-renowned CANYON RANCH mark. In addition, the evidence shows that CANYON RANCH

became famous, as the term is used in 15 U.S.C. § 1125(c)(2)(A), prior to GCR's application to register the Disputed Marks and prior to the alleged date of first use of the Disputed Marks, and that GCR's marks are likely to blur the distinctiveness of the famous CANYON RANCH mark and/or tarnish the CANYON RANCH mark pursuant to 15 U.S.C. § 1125(c)(2)(B), (C).

II. DESCRIPTION OF THE RECORD

A. Canyon Ranch's Evidence

1. *GCR's Trademark Application Files*

The record includes the files of each of the Disputed Marks, GRAND CANYON RANCH AT SPIRIT MOUNTAIN and Design, Ser. No. 77/407,614 and GRAND CANYON RANCH and Design, Reg. No., 3,927,500. 37 C.F.R. 2.122(b); T.B.M.P. § 704.03(a).

2. *The CANYON RANCH Prior Registrations*

The record includes Canyon Ranch's prior federal registrations for the CANYON RANCH mark:

MARK	REG. NO.	GOODS AND SERVICES
CANYON RANCH	1,350,012	41: Conducting programs in exercise and physical conditioning 42: Fitness resort and restaurant services
CANYON RANCH	1,402,143	16: Publications, namely cookbooks
CANYON RANCH	1,409,026	42: Retail store and mail order services in the field of nutrition, exercise and fitness equipment and products
CANYON RANCH	1,411,031	5: Vitamins
CANYON RANCH	1,560,924	18: Traveling bags and luggage
CANYON RANCH	1,594,300	25: Clothing, namely wristbands, sun visors and warm-up suits
CANYON RANCH	1,598,938	39: Transportation of passengers by means of automobile and reservation services for transportation
CANYON RANCH	1,608,449	35: Rendering technical assistance in the establishment and/or operation of health resorts and spas

MARK	REG. NO.	GOODS AND SERVICES
		42: Health resort and spa services
CANYON RANCH	1,635,213	3: Body and hair lotions, toilet soap and hair shampoo
CANYON RANCH	1,989,399	36: Real estate services, namely leasing, listing, managing, brokerage, and time sharing services relating to real estate 37: Real estate services, namely real estate development
CANYON RANCH SPACLUB	2,648,362	41: Educational services, namely, conducting individual and group classes and workshops in the fields of exercise and physical and mental conditioning; developing and conducting classes and workshops in the fields of physical fitness, self-motivated physical training and generation of positive mental attitudes 42: Fitness resort and restaurant services; food nutrition consultation; counseling in the fields of behavior modification and stress management; hair dressing and skin care salon services; manicure and pedicure services
CANYON RANCH	2,911,009	3: cosmetic and skin care products, namely, anti-aging creams, anti-wrinkle creams, cosmetic preparations for skin renewal, body creams, eye creams, face creams, facial cleaners, mist sprays, night creams, skin cleaning creams, skin conditioner, skin emollients, skin lotion, skin toners, sun block
CANYON RANCH	3,076,800	41: recreational camps for children and young adults; sports camps; educational services, namely, conducting programs, workshops and seminars in the field of spirituality; organization of games
CANYON RANCH	3,166,548	44: Medical and therapeutic counseling services relating to behavior modification and stress management; Counseling and consulting services in the fields of nutrition, conflict management relating to psychological counseling, family health, wellness, prevention of disease, beauty, skin care, stress management and behavior modification; hair styling and skin care salon services; Beauty salon services, namely manicure and pedicure services; health spa services, namely, cosmetic body care services; massage; health spa services for health and wellness of the body and spirit offered at a health resort; medical services; maintaining files and records concerning the health and wellness of individuals; operation of sauna facilities; providing information in the fields of nutrition, conflict management relating to psychological counseling, family health, wellness, prevention of disease, beauty, skin care, stress management and behavior modification; medical consultations; medical counseling;

MARK	REG. NO.	GOODS AND SERVICES
		medical assistance consultancy provided by doctors and other specialized medical personnel; medical testing; providing medical information
CANYON RANCH	3,172,612	41: Sports and entertainment services, namely, golf; educational services, namely, conducting classes and demonstrations in the fields of physical fitness training
CANYON RANCH	3,175,613	35: retail store services featuring CD's, DVD's, audio and video cassettes, foods, waters, candles, potpourri, essential oils, gifts and personal accessories, books
CANYON RANCH	3,178,365	45: providing on-line information in the fields of spirituality, self-help, and personal empowerment subject matters; providing of on-line greeting cards
CANYON RANCH	3,178,367	41: Health club services, namely, providing instruction and equipment in the field of physical exercise; physical education services, namely, providing exercise classes to others and conducting classes in exercise and physical conditioning; educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of nutrition, exercise, physical conditioning, conflict management, family health, wellness, prevention of disease, beauty, skin care, physical fitness, physical training, stress management and behavior modification; counseling and consultation services in the fields of exercise and physical conditioning, physical fitness and physical training
CANYON RANCH	3,181,846	9: Pre-recorded DVD's, in the fields of health, healing, exercise, cooking, and dining
CANYON RANCH	3,190,074	25: Clothing, namely, golf shirts, t-shirts, tank tops, [tennis wear], shorts, gym shorts, wind-resistant jackets, [bras, tight,], sweat pants, sweat shorts, sweat suits, jackets, knit shorts, sports shirts, pants, hats, robes, socks.
CANYON RANCH	3,190,073	18: handbags, tote bags, shoulder bags, athletic bags, fanny/waist bags, knapsacks and backpacks
CANYON RANCH	3,190,072	16: gift cards, cookbooks, pens, note paper, calendars, envelopes, guest books, memo pads, stationery
CANYON RANCH	3,202,993	43: Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; resort lodging services; providing temporary housing accommodations; providing a database in the field of recipes and cooking information; restaurant services
CANYON RANCH	3,270,392	5: Dietary supplements
CANYON RANCH	3,408,898	5: medicated skin care preparations; pharmaceutical preparations for treating skin disorders; medicated sun care

MARK	REG. NO.	GOODS AND SERVICES
		preparations
CANYON RANCH	3,613,857	36: Real estate services, namely, rental and management of serviced condominiums
CANYON RANCH	3,604,350	25: clothing, namely, t-shirts, shorts and robes
CANYON RANCH	3,624,678	38: providing on-line electronic bulletin boards for transmission of messages among computer users concerning health, healing, exercise, cooking and dining.
CANYON RANCH	3,644,940	43: wine bars; providing information about wine characteristics; sommelier services, namely, providing advice on wine and wine and food pairing
CANYON RANCH	3,868,724	30: cereal, granola based snack bars
CANYON RANCH	3,851,689	30: granola
CANYON RANCH	4,214,639	9: computer software for wireless download of mobile applications in the field of health, wellness, fitness and spirituality; computer software for mobile phones and other mobile devices
CANYON RANCH	4,328,582	30: spices; cookies; brownies; bread
CANYON RANCH	4,328,581	29: protein based, nutrient dense snack bars
CANYON RANCH	4,338,957	5: herbal products, namely, aroma therapy packs containing herbs used for aroma therapy
CANYON RANCH	4,400,341	32: lemonade, sports drinks

(See Cohen Aff., ¶ 37 & Exh. AA)

3. Affidavit and Supplemental Affidavit of Jerrold L. Cohen

Per the parties' stipulation to proceed via Accelerated Case Resolution ("ACR"), filed November 14, 2013, the parties agreed to submit affidavits in lieu of trial testimony. Canyon Ranch submitted the affidavit of Jerrold L. Cohen and supporting exhibits ("Cohen Aff."). Mr. Cohen is the President of JC Management, Inc., which is the manager of CR License, LLC, which owns the CANYON RANCH trademarks. (Cohen Aff., attached hereto as Exhibit 1, ¶ 1). Mr. Cohen has been employed by Canyon Ranch since its founding in 1979. (*Id.*). Canyon

Ranch also submits a Supplemental Affidavit of Jerrold L. Cohen and supporting exhibits (“Supp. Cohen Aff.”), attached hereto as Exhibit 2.

4. *Affidavit of Sean Garrison*

Canyon Ranch submits the affidavit of Sean Garrison and supporting exhibits (“Garrison Aff.”) pursuant to the parties stipulation to proceed via ACR. Mr. Garrison is an attorney for Canyon Ranch. (Garrison Aff., attached hereto as Exhibit 3, ¶ 1).

B. GCR’s Evidence

1. *Affidavit of Nigel Turner*

GCR submits the affidavit of Nigel Turner (“Turner Aff.”) pursuant to the parties’ stipulation to proceed via ACR. Mr. Turner is the Managing Member of GCR, which owns the GRAND CANYON RANCH & Design mark, Reg. No. 3,927,500, and is the applicant for the mark GRAND CANYON RANCH AT SPIRIT MOUNTAIN & Design mark, Ser. No. 77/905,088. (Turner Aff., attached hereto as Exhibit 4, ¶ 1). Mr. Turner is also the managing member of Grand Canyon Ranch, LLC, an Arizona limited liability company, which operates the property and facility that allegedly use the Disputed Marks. (*Id.*) In addition, Mr. Turner is the owner of the facility. (*Id.*)

III. STATEMENT OF FACTS

A. Canyon Ranch’s Rights in the CANYON RANCH Mark

1. *The Creation and Use of the CANYON RANCH Mark*

In 1979, the original, flagship CANYON RANCH destination spa resort was founded in Tucson, Arizona by Mel Zuckerman, a real estate developer with a dream of creating a community focused on healthy living, and his wife Enid Zuckerman. (Cohen Aff., ¶ 2). The Tucson resort has been continuously operating under the CANYON RANCH mark since 1979. (*Id.*)

Over the next 35 years, Mel and Enid grew Canyon Ranch into a world-renowned family of companies offering healthy lifestyle products and services. The CANYON RANCH mark is not only used with resort, restaurant, and fitness services, but also with such diverse products and services as cookbooks, real estate development, clothing, skin care products, medical services, counseling services, and outdoor excursions. (*Id.*, ¶ 3).

2. *The Growth, Public Recognition and Fame of the CANYON RANCH Mark*

The CANYON RANCH mark and the products and services offered under the mark have developed an enviable nationwide and, in fact, worldwide reputation. This reputation is due in part to and can be evidenced by the continuous unsolicited media attention Canyon Ranch has enjoyed since shortly after its founding in 1979. (*Id.*, ¶ 4).

Since the early 1980s, national publications such as THE NEW YORK TIMES, USA TODAY, and TIME magazine have run articles featuring the CANYON RANCH properties and the services offered under the CANYON RANCH mark. (*Id.*, ¶ 5 & Exh. A). For example, TIME magazine ran a front page story about the CANYON RANCH property in 1982, soon after its opening. In addition, the CANYON RANCH properties and services offered under the CANYON RANCH mark have been featured multiple times in USA TODAY, including

- Anne L. Adams, *Resorts to Keep People Thin are In*, USA TODAY, Sept. 6, 1984.
- *Holiday gift-shopping trend: Spas, cruises*, USA TODAY, Dec. 10, 1997.
- Lynne Sladky, *You'll Moon over these new, and updated, Miami resorts*, USA TODAY, Nov. 20, 2008.
- Lottie L. Joiner, *original Vision Always at Forefront Canyon Ranch Grew with its Consistent Mission*, USA TODAY, Aug. 22, 2011.

Each of these national publications has reached millions of people. They are among the most widely circulated publications in the United States. For example, USA TODAY reaches 1.6 million consumers daily while TIME magazine reaches 3.3 million people per week. (*Id.*, ¶ 6 & Exh. B, C).

Apart from these national publications, over the past 35 years, both general and specialized media outlets have continuously featured unsolicited discussions of the CANYON RANCH properties, the CANYON RANCH mark, and the products and services offered under the marks. (*Id.*, ¶ 7 & Exh. A). These media outlets range from THE WASHINGTON TIMES to GOURMET magazine. (*Id.*) In fact, the CANYON RANCH properties and mark have been featured in financial newspapers like FORBES, THE WALL STREET JOURNAL, THE AUSTRALIAN FINANCIAL REVIEW, CEO TRAVELER, INC. and EXEC DIGITAL, and in popular culture magazines like PEOPLE, ELLE, MEN'S FITNESS, and NEWSWEEK. (*Id.*)

Following the extraordinary success of the Tucson, Arizona location, Canyon Ranch expanded by opening another destination spa resort in the Berkshire Mountains in Lenox, Massachusetts in 1989. The Lenox location has continuously operated under the CANYON RANCH mark since 1989. The location has developed its own reputation and further enhanced the brand recognition enjoyed by the CANYON RANCH mark, as seen by the numerous unsolicited media mentions and the various awards the property has received in print media such as FORBES, NEW YORK DAILY NEWS, INSTYLE, THE NEW YORKER, SHAPE MAGAZINE, THE BOSTON HERALD, TRAVEL + LEISURE, and CONDÉ NAST. (*Id.*, ¶ 8 & Exh. D).

The notoriety of the CANYON RANCH mark is also reflected by the numerous awards the CANYON RANCH Tucson, Arizona and Lenox, Massachusetts, destination health resorts have received. (*Id.*, ¶ 9). For example, the CANYON RANCH properties have been named by CONDÉ NAST TRAVELER MAGAZINE's Reader's Survey as the World's Best Spa an unprecedented eleven times – more than any other spa in the world. Additionally, the CANYON RANCH properties have been named 13-times in TRAVEL + LEISURE's World's Best Spa category. (*Id.* & Exh. E).

In fact, the CANYON RANCH mark is so nationally and internationally renowned that as far back as 1993, media outlets have referred to CANYON RANCH as “famous,” “legendary” and “world-renowned” and continue to do so. Examples include:

- *More than a Fat Farm*, THE ARIZONA DAILY STAR, 1993 (“The internationally renowned resort is consistently rated by magazines as one of the nation’s top spas”)
- *Time out! There’s Nothing like a Spa Break to Help you Unwind this Winter*, AGENDA NEW YORK, 1994 (“No spa article is complete without mention of Canyon Ranch in the Berkshires, sister spa to the famous Arizona facility.”)
- *Canyons Apart*, FINANCIAL REVIEW, 1994 (“Canyon Ranch is probably America’s top spa...”)
- *Desert Blooms*, SAN FRANCISCO EXAMINER, 1994 (“I arrived at the legendary Canyon Ranch in Tucson”)
- *Living Well*, LIVING FIT, July/August 1996 (“Selected winners will also receive a healthy getaway at Canyon Ranch Spa, the world-famous health and fitness resort in Tucson, Arizona.”)
- Karen Glenn, *Luxuriating in Class at Canyon Ranch in the Berkshire*, DIVERSION, June 1998 (“Or so I thought before I found Canyon Ranch in the Berkshires. This spa opened in 1989, the sister of the renowned Canyon Ranch in Tucson.”)
- Lisa Huley, *Meanwhile, back at the ranch. The world-famous Canyon Ranch health Resort in Tucson, Ariz., offers sensible indulgence*, F&B, November 1999.
- *Spas Provide Latest Treatments*, LOS ANGELES TIMES, Jan. 30, 2001 (“The world-renowned, award-winning Canyon Ranch SpaClub recently debuted in Las Vegas at the Venetian Resort Hotel Casino.”)
- *Getting Away from it all. (Holiday Gift Guide 2002)*, HOLLYWOOD REPORTER, November 22, 2002 (“Founded in 1979... Canyon Ranch is now one of the world’s top destination spas.”)
- *Reporter’s Notebook*, CRAIN’S CLEVELAND BUSINESS, Aug. 8, 2005 (“The Cleveland Clinic teaming up with the famed Canyon Ranch spa and resort in Tucson, Ariz...”)
- *Arizona Retreats Elevate Rejuvenation of Mind, Body and Spirit to a Life-changing journey*, AZ, 2007 (noting that Canyon Ranch is “world-renowned”)
- *Eating healthier the Canyon Ranch Spa way The top chef for the world-famous Canyon Ranch chain of spas offers tips for eating and living well*, WebMD (Feb. 7, 2007), <http://www.webmd.com/food-recipes/features/eating-healthier-canyon-ranch-spa-way>
- Lorraine Cademartori, *Lush Life*, FORBES, April 23, 2007 (“With the highest brand-name recognition in the field, Canyon Ranch seems poised to make a smooth segue into real estate.”)
- *Chef Scott Uehlein shows Today’s Amy Robach how to cook up some flavorful and healthy dishes from the world-famous Canyon Ranch Spa*, TODAY MORNING PROGRAM, 2009.
- Cindy K. Goodman, *Canyon Ranch founder practices what he preaches*, MIAMI HERALD, March 22, 2011 (“When Zuckerman opened the now famous Canyon

Ranch in Tucson, Ariz., in 1979, he was an overweight homebuilder and recovering workaholic...”)

- *A Workaholic at Canyon Ranch Spa*, THE VEGAS SOLO (Oct. 6, 2013), <http://vegassolo.com/workaholic-canyon-ranch-spa> (“That being said, I have to admit, I was excited to book a massage at the famous Canyon Ranch. (it had to be famous, since I’d heard of it; I don’t really follow luxury brands all that much.)”)

(*Id.*, ¶ 10 & Exh. F).

In 1999, Canyon Ranch further expanded its operations by moving into the day spa concept with the CANYON RANCH® SPACLUB® at The Venetian®. (*Id.*, ¶ 11). The construction of The Palazzo® in 2007 linked CANYON RANCH® SPACLUB® to a second luxury hotel and casino resort. (*Id.*) The CANYON RANCH® SPACLUB® at The Venetian® and at The Palazzo® has served over a million visitors from all over the globe and introduced the CANYON RANCH mark to an even broader audience. (*Id.*, ¶ 12). The CANYON RANCH® SPACLUB® facility has gained notoriety from published articles detailing services offered there as well as from accolades and awards it has received. (*Id.* & Exh. G).

The world-renowned CANYON RANCH® SPACLUB® experience was introduced to an even larger audience when Canyon Ranch entered into partnerships with several cruise companies, including Cunard, Oceania Cruises and Regent Seven Seas to offer spa and fitness services to guests aboard the ships. (*Id.*, ¶ 13). Through CANYON RANCH® SPACLUB® aboard Oceania Cruises *Marina*, *Nautica*, *Regatta*, and *Riviera* cruise ships, CANYON RANCH branded services are offered to travelers visiting Asia, Africa, South America, Canada, the Caribbean, the Panama Canal, Europe, the Mediterranean and the Greek Isles, Australia, New Zealand, Scandinavia, Russia and India. (*Id.*, ¶ 14). Similarly, through CANYON RANCH® SPACLUB® aboard the *Queen Mary 2*, CANYON RANCH branded services are offered to travelers visiting Europe, the Caribbean, Norway, Iceland, the Canary Islands, the British Isles and the Baltic. (*Id.*). Finally, guests upon the cruise ships of Regent Seven Sea Cruises® are offered CANYON RANCH® SPACLUB® services and dining while visiting South America, Africa, India, the Mediterranean, Asia-Pacific, and the tropics. (*Id.*).

Each cruise company promotes the CANYON RANCH mark to its guests and potential guests through its promotional materials and websites. (*Id.*, ¶ 15). These third-party marketing

materials recognize the fame of the CANYON RANCH mark, noting that CANYON RANCH® SPACLUB® is “world-famous” and that the services provided were “developed by renowned Canyon Ranch health resorts in sunny Tucson, Arizona, and charming Lenox, Massachusetts.” (*Id.* & Exh. H). Moreover, in setting sail, the CANYON RANCH mark received further unsolicited media attention, including articles in NEW YORK MAGAZINE, USA TODAY, NEWSWEEK, and U.S. NEWS WEEKLY, to name a few. (*Id.*, ¶ 17 & Exh. I).

In its most recent expansion, Canyon Ranch launched a luxury hotel, spa and residential complex in Miami Beach in 2008. The Miami location has continuously operated under the CANYON RANCH mark since 2008. This ambitious project brought the CANYON RANCH brand further nationwide recognition, including media mentions in various publications and awards, including SELF MAGAZINE, FORBES TRAVEL GUIDE, SPAFINDER, and the LAS VEGAS REVIEW-JOURNAL. (*Id.*, ¶ 18 & Exh. J).

Since their respective openings, all three CANYON RANCH properties have become known for their excellent customer service and their focus on meeting the needs of each guest. This is shown by the fact that on the popular travel site, TripAdvisor®, CANYON RANCH Tucson is ranked the 2nd best hotel in Tucson, Arizona, while CANYON RANCH Lenox is ranked first in Lenox, Massachusetts. CANYON RANCH Miami Beach is ranked the 11th best hotel in Miami Beach, with an 83% rating. These positive reviews may be seen by more than 260 million unique monthly visitors who visit the TripAdvisor® site. (*Id.*, ¶ 19 & Exh. K).

In fact, because of its renowned customer service, the CANYON RANCH mark is often used in popular media as a short-hand reference to luxury and attention to detail:

- Gayle Fee/Laura Raposa, *Clean Living in the Woods*, THE BOSTON HERALD, September 8, 1993 at 8, (“Backstage at the Walden Woods benefit resembled a Canyon Ranch reunion rather than a rock star retreat.”)
- Patricia McLaughlin, *T-shirt Tastes Change, but Lure of the Exotic Doesn't*, UNIVERSAL PRESS SYNDICATE, August - September 1993, (“... putting Tucson’s ‘Canyon Ranch’ on a t-shirt has equivalent appeal to writing the word ‘Polo’ on one.”)
- Lark Ellen Gould, *Pamper Yourself*, LOS ANGELES TIMES, December 8, 2000, (“The legendary Canyon Ranch, whose spas virtually define the pampering experience . . .”)

- Tom Gliatto, *Who Will Survive?*, PEOPLE WEEKLY, February 5, 2001 at 113, (“... the production crew’s camp seems as lux as the Canyon Ranch spa.”)
- Amy Graves, *Spa vs. Spa*, THE BOSTON GLOBE, January 6, 2002, (“Canyon Ranch. Just those two words side by side are balm to a woman’s weary soul.”)

(*Id.*, ¶ 20 & Exh. L).

The unsolicited media attention CANYON RANCH has received has not been limited to print media, but also includes broadcast media. CANYON RANCH is often mentioned in popular television shows broadcast nationwide and into other countries such as The Oprah Winfrey Show, The Rosie O’Donnell Show, the Martha Stewart Show, Gossip Girl, the Real Housewives of New York, and Monday Night Football. (*Id.*, ¶ 21 & Exh. M). Moreover, CANYON RANCH is mentioned in a variety of media outlets because of its connection with celebrities and other public figures. Examples of such mentions include:

- Susan Mulcahy, *Barbra relaxes at Tucson spa*, SAN ANTONIO EXPRESS, Jan. 17, 1984.
- PEOPLE WEEKLY, July 1, 1991 (“...Julia (temporarily sprung from her duties in Hook) headed for the chic Canyon Ranch Spa in Tucson with some friends...”)
- ALLURE, March 1996, (“Designer Donna Karan flies south (and west) every April after completing her fall collection for a week at Canyon Ranch Spa in Arizona -- a journey she calls ‘mentally and physically grounding.’”)
- Lisbeth Levine, *Final Flings*, IN STYLE, Feb. 1997, (“Remember, Julia Roberts and some friends went to Canyon Ranch in Tucson before her planned wedding to Keifer Sutherland.”)
- Larry Stewart, *Familiar broadcasters at NBC and TNT find themselves looking for new jobs*, LOS ANGELES TIMES, Jan. 14, 1998, (“Al Michaels is simply glad ABC was able to retain the Monday night package. ‘I had some very anxious moments,’ he said from the Canyon Ranch resort in Tucson, where he is vacationing.”)
- *Calista does some figuring with gown*, DAILY NEWS, Sept. 13, 1999, (“Not only was she covered up last night, in a white shirt over a yellow gown designed by Ralph Lauren, but as recently as three weeks ago, Flockhard was seen training hard at the Canyon Ranch in Tucson.”)
- *Last Good...Susan Hampshire, actress*, YOU, April 9, 2000, (“Treat: Canyon Ranch and Spa”)
- *Sightings*, NEW YORK POST, March 28, 2001, (“Carolyne Roehm and Ed Rollins lunching by the pool at the Canyon Ranch Spa in Tucson, Arizona”)
- *New Year’s in Vegas*, PEOPLE, Dec. 2006 (“Ease your pain at the Venetian’s Canyon Ranch, a Kirsten Dunst fave.”)
- *Star-Approved Spas*, OK!, Dec.13, 2010, (“When Eva Longoria and Shakira hit Miami, they head to the glamorous Canyon Ranch Hotel & Spa in Miami Beach”)
- *Suri Cruise campaigns for pierced ears*, NYPOST.COM PAGE SIX, Jan. 3, 2014, (“Katie and Suri were staying with family members at Canyon Ranch Miami Beach with Katie’s extended family during New Year’s.”)

(*Id.*, ¶ 22 & Exh. N).

Not to mention, the CANYON RANCH staff are themselves well known individually in their fields and, as a result, further the recognition of the CANYON RANCH mark. For example, former U.S. Surgeon General Richard Carmona is vice chairman for Canyon Ranch. Dr. Carmona and other staff often have guest appearances on national television shows, which mention their positions at Canyon Ranch, such as the Martha Stewart Show, Fox News, CNN, and The Dr. Oz Show. (*Id.*, ¶ 23 & Exh. O). These television appearances reach millions of viewers. For instance, just the two appearances on the three-time Emmy award-winning The Dr. Oz Show reached over 2 and 3 million viewers respectively. (*Id.*, ¶ 24 & Exh. P).

Equally important, the CANYON RANCH cuisine is well known and has received its own unsolicited media attention and accolades. (*Id.*, ¶ 25 & Exhibit Q). Canyon Ranch's reputation for good food has led to the publication of several cookbooks including, *Canyon Ranch Nourish - Indulgently Healthy Cuisine* (2009), *Canyon Ranch Cooks: More than 200 Delicious, Innovative Recipes from America's Leading Health Resort* (2003), *Canyon Ranch Cooks: More Great Tastes* (2001), *Canyon Ranch Cooking: Bringing the Spa Home* (1998), and *The Canyon Ranch Cookbook* (1988). These cookbooks have sold more than 100,000 copies to date. (*Id.*, ¶ 26).

The celebrity of the CANYON RANCH cuisine has been further enhanced by the appearance of CANYON RANCH chefs on national television shows to discuss ways to cook healthy, delicious meals. CANYON RANCH chefs have appeared multiple times on Access Hollywood Live, on the Today Show, and on news networks. (*Id.*, ¶ 27 & Exh. R). These national television appearances reach millions of people. For example, Chef Uehlein's appearance in 2009 on the Today Show reached around 5.72 million people. At the time, NBC's Today show was the top rated morning news program for 14 years running. (*Id.*, ¶ 28 & Exh. S). Access Hollywood viewership is equally extensive. This show is one of the top syndicated programs, and in 2013 reached 3 million viewers a day. (*Id.*).

Besides offering celebrated cuisine at the CANYON RANCH properties, the CANYON RANCH mark is also used with the offering of a variety of fitness options for clients, including hiking, biking and horse-back riding. (*Id.*, ¶ 29). Canyon Ranch has offered hiking and biking under the CANYON RANCH mark continuously since 1979. (*Id.*) In fact, Canyon Ranch has received media attention based on its world-renowned hiking and biking excursions, including:

- *Spas for the Cosmo Girl*, COSMOPOLITAN, Nov. 1994. (“Canyon Ranch, Tucson, AZ, Canyon Ranch in the Berkshires, Lenox, MA. Candyland for health freaks. Exercise highlights include morning walks, innovative and challenging fitness classes, tennis, basketball, hiking, biking, and canoeing.”)
- *My Favorite Workout*, SHAPE MAGAZINE, Nov. 1994 (“My friend Patti and I are so busy with family and work that we rarely have time for each other. So once a year, we take a week and go cycling together at Canyon Ranch in Tucson, Arizona.”)
- Kevin Cobb, *Health Spas A new path to Total Fitness*, WALKING MAGAZINE, Aug. 1995 (“What had brought this unstoppable group of hikers together in the mountain ranges surrounding Tucson, Ariz.? A special week-long hiking program at Tucson’s Canyon Ranch Health & Fitness Resort held several times a year.”)
- *Stressed Out? Take a hike at Canyon Ranch*, WOMAN TO WOMAN, Spring 1996 (“What’s an ideal antidote to city living? Donna’s answer may surprise you. She hikes. At least twice a year for the past ten years, Donna escapes to Canyon Ranch Fitness and Health Resort in Tucson, AZ, where she spends her days on the beautiful wilderness trails.”)
- Martha Schindler, *Mud, Massage & Mastery More than just a great vacation, a visit to a health spa can change your life*, VEGETARIAN TIMES, Sept. 1998 (“Hiking is a main attraction at both of Canyon Ranch’s locations -- Tucson, Ariz. and Lenox, Mass.-- with guests selecting the duration and difficulty level of their daily outings.”)
- Mark Saylor, *Destination: Arizona Man vs. Spa*, LOS ANGELES TIMES, Jan. 17, 1999 (“Despite my pronated feet, the hiking program was a high point of the Canyon Ranch experience.”)
- Susanne Stoeckeler, *Retreats that help take the pounds off*, SHAPE, July 31, 2002 (“Canyon Ranch: the grand dame of total fitness...Canyon Ranch offers more than 50 fat-blasting and muscle-toning fitness classes daily, plus outdoor sports galore: hiking, mountain biking and tennis.”)
- Philip Sherwell, *State of wellbeing. It’s the ‘Power of possibilities’ Arizona is a land of cowboy legend and machismo to match its rugged terrain*, SUNDAY TELEGRAPH, Jan. 28, 2007 (“A typical day at Canyon Ranch might begin with an early-morning walk, hike or bike ride, and include yoga...”)
- *Hiking’s New Path*, USA TODAY OPEN AIR, March 2006 (“Hiking-obsessed guides at Canyon Ranch Resort in Arizona’s Sonoran Desert organize private and group hikes that cater to each guest’s pace, from a saunter to a sprint.”)
- Michele McIntyre, *Spa and travel review: Canyon Ranch Lenox Day 2*, EXAMINER.COM, May 31, 2013 (“At 9:15, I meet up with a team of Outdoor Sports guides for a hike/canoe trip... The excursion is fantastic offering just the

right level of challenge and elevation change on the two mile hike and just enough beautiful scenery to keep paddling till the end of the two mile canoe trek.”)

(*Id.* & Exh. T).

Canyon Ranch also arranges excursions for guests, including cross-country skiing, snowshoeing, canoeing, kayaking, golf, tennis, hiking, and surfing, depending on the resort. (*Id.*, ¶ 30). Media articles have also focused on the availability of these diverse excursion options. (*Id.* & Exh. U).

Apart from the unsolicited media attention outlined above, the CANYON RANCH mark has become world renowned as a result of Canyon Ranch’s own advertising efforts. (*Id.*, ¶ 31). Canyon Ranch has advertised its CANYON RANCH mark in a broad range of media, including direct mailing, promotional contests, newspapers, trade journals, the internet, social networking media, and broadcast media. (*Id.*; Supp. Cohen Aff., ¶ 3). In its over 35 years of existence, Canyon Ranch has spent millions of dollars in advertising and marketing its CANYON RANCH mark and the products and services offered under that mark. (Cohen Aff. ¶ 31 & Exh. V).

Canyon Ranch has advertised, promoted and marketed its CANYON RANCH mark in every geographic area in the world since at least as early as 1998 on the world wide web at its website www.canyonranch.com. (Supp. Cohen Aff., ¶ 3). In fact, Canyon Ranch’s internet marketing has been quite successful. (Cohen Aff., ¶ 32).

As a result of Canyon Ranch’s marketing and the extensive third-party media attention, hundreds of thousands of guests have visited the various CANYON RANCH locations and in excess of a million CANYON RANCH services have been enjoyed through the CANYON RANCH® SPACLUB® day spa available at the Venetian resort in Las Vegas and on cruise ships, including Cunard’s Queen Mary 2 and the many ships of Oceania Cruises and Regent Seven Seas Cruises. (Supp. Cohen Aff., ¶ 2). Moreover, tens of thousands of products bearing the CANYON RANCH mark have been sold since their introduction. (*Id.*)

Overall, the strength and fame of the CANYON RANCH mark is evident. The CANYON RANCH mark and the products and services offered under the mark have developed an enviable worldwide reputation in the last 35 years. The continuous unsolicited media attention it has received combined with its own marketing efforts and the extensive accolades and awards it has won have made the CANYON RANCH mark renowned. It is therefore no wonder that CANYON RANCH is now readily and exclusively associated with Canyon Ranch in the minds of not only American consumers but consumers worldwide.

3. Canyon Ranch Has Priority

Canyon Ranch has offered its goods and services under the CANYON RANCH mark continuously and exclusively since 1979. (*Id.*, ¶ 2). It's first federal registration was obtained July 16, 1985 [Reg. No. 1,350,012]. (*Id.*, Exh. AA, CR3315-16). In contrast, GCR filed its applications for the Disputed Marks in 2010, with an alleged date of first use of May 2003. As such, Canyon Ranch has priority of use.

4. The Parties' Customers are Overlapping

GCR represents that its target market includes visitors throughout the United States and from numerous foreign countries. (Tuner Aff., ¶ 10). These are the same customers that Canyon Ranch targets. (Cohen Aff., ¶ 31-32; Supp. Cohen Aff., ¶ 3). Moreover, the description of services in both GCR's pending application and registration do not limit the scope of its services to any particular category of customers. Therefore, all potential categories of customers fall within the scope of GCR's services. *See In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981).

B. GCR and its Disputed Marks

1. *The Disputed Marks*

Mr. Turner is the managing member of Grand Canyon Ranch, LLC (“GCR”), a Nevada limited liability company, which owns the application/registration for the Disputed Marks. (Turner Aff., ¶ 1). He is also the managing member of Grand Canyon Ranch, LLC, an Arizona limited liability company, which operates the property and facility that use the Disputed Marks. (*Id.*)

Mr. Turner purchased the property and the facility in or about 2002. (*Id.*, ¶ 2). At the time Mr. Turner purchased the property, it was called Diamond Bar Ranch. (*Id.*) After acquiring the property, Mr. Turner changed the name of the property to “Grand Canyon West Ranch.” (*Id.* ¶ 3). The Hualapai Tribe objected to the new name because they owned a facility called “Grand Canyon West – Hualapai Ranch.” In order to resolve the dispute, Mr. Turner changed the name of the property and facility to “Grand Canyon Ranch.” (*Id.*, ¶ 4). On January 5, 2010, GCR filed the applications to register the Disputed Marks, claiming a date of first use of March 5, 2003.

The mark GRAND CANYON RANCH & Design, Reg. No. 3,927,500 is registered for “excursion arrangements for tourists” in class 39, “recreational and entertainment services in the nature of horse-drawn wagon rides, horse-back riding and helicopter tours, ATV (all-terrain vehicle) tours, hiking, mountain biking” in class 41, and “providing temporary accommodations in the nature of a guest ranch, dude ranch, cabin and resort lodging accommodations, and authentic tipi accommodations; restaurants and bars” in class 43. The application for GRAND CANYON RANCH AT SPIRIT MOUNTAIN & Design, Ser. No. 77/905,088, lists the following goods and services: “Excursion arrangements for tourists” in class 39, and “Recreational and entertainment services in the nature of horse-drawn wagon rides, horse-back

riding and helicopter tours, ATV (all-terrain vehicle) tours, hiking, and mountain biking” in class 41.

Both Disputed Marks feature a desert mountain landscape design, as pictured below.



GRAND CANYON RANCH & Design, Reg. No. 3,927,500



GRAND CANYON RANCH AT SPIRIT MOUNTAIN & Design, Ser. No. 77/905,088

IV. STATEMENT OF THE ISSUES

- 1) Whether GCR's Marks, when used with the goods and services in its Application and Registration, are likely to cause confusion, mistake or deception as to the source or sponsorship of those goods and services; and
- 2) Under the analysis dictated by Trademark Dilution Revision Act, 15 U.S.C. § 1125(c),
 - a) Is Canyon Ranch's CANYON RANCH mark "famous" for purposes of a federal trademark dilution claim, and
 - b) Are GCR's marks likely to cause dilution by blurring and/or tarnishing the distinctive quality of the CANYON RANCH mark?

V. ARGUMENT

A. Canyon Ranch Has Standing

As the prior user and owner of valid and subsisting pleaded registrations for the CANYON RANCH mark (Cohen Aff., ¶ 37 & Exh. AA), Canyon Ranch has standing to challenge applications and registrations of confusingly similar marks. 15 U.S.C. § 1052(d), T.B.M.P. § 309.03(b).

B. Canyon Ranch's Rights in its CANYON RANCH Mark are Superior to any Right GCR can Claim in the Disputed Marks

Because Canyon Ranch's pleaded registrations are of record in this proceeding, with a priority date preceding that date of GCR's application and registration of the Disputed Marks (Cohen Aff., Exh. AA), Canyon Ranch's priority of rights is not an issue here. *See, e.g., Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092, 220 U.S.P.Q. 1017, 1020 (Fed. Cir. 1984); T.B.M.P. § 309.03(c)(A).

Moreover, Canyon Ranch has offered undisputed evidence of its rights in and continuous use of the CANYON RANCH mark for over 35 years (*See* Cohen Aff.), again long before GCR's filing date and claimed first use dates. This evidence of earlier use also establishes Canyon Ranch's priority. *Id.*

Based on these undisputed facts, Canyon Ranch has priority over GCR.

C. Likelihood of Confusion

1. *The DuPont Factors Favor a Finding of Likelihood of Confusion*

Under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), a trademark shall be refused registration if it "so resembles a mark registered in the Patent and Trademark Office, or a mark . . . previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake,

or to deceive” In determining likelihood of confusion, the Board applies the factors in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Different factors may play dominant roles in determining likelihood of confusion in different cases. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1073, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989).

In this case confusion is likely because (1) the CANYON RANCH mark is famous; (2) the marks are similar; (3) both parties offer lodging, recreational and excursion services, offered at least in part in Arizona; (4) the trade channels and customers are similar; and (5) the record contains no evidence of third-party use of similar marks with similar services and Canyon Ranch has policed its mark. Here, an analysis of the relevant *du Pont* factors leads to the inevitable conclusion that GCR’s marks so strongly resemble the famous CANYON RANCH mark as to be likely, when used on or with GCR’s goods and services, to cause confusion, or to cause mistake, or to deceive. Such a conclusion is bolstered by the established principle that when assessing whether a likelihood of confusion exists, all doubts must be resolved in favor of the prior user. *Id.* at 1074; *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993) (“Doubt is resolved against the newcomer...for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so”).

2. *The Fame Factor Dominates the DuPont Analysis Here Because the CANYON RANCH Mark Is Extremely Well Known*

As the Board routinely acknowledges, it is appropriate to first analyze the fifth *DuPont* factor concerning the fame of an opposer’s mark because a finding that an opposer’s mark is famous will have a significant impact on the rest of the *DuPont* analysis. *See, e.g., Bose Corporation v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002). Under controlling precedent, “[a] strong mark . . . casts a long shadow which competitors

must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). As the fame of a mark increases, the degree of similarity between the marks and their goods or services necessary to support a conclusion of likely confusion declines. *See Bose Corp.*, 293 F.3d at 1371, 63 U.S.P.Q.2d at 1305-6; *see also Kenner Parker Toys*, 963 F.2d at 353, 22 U.S.P.Q.2d at 1456 (“[T]he Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.”).

The standard for determining famousness for purposes of the likelihood of confusion analysis differs from that which applies to a federal dilution claim in that the issue is not a binary, yes-or-no determination, but rather an assessment along the continuum of a mark’s commercial strength, looking to whether the mark has garnered recognition in a “significant portion of the relevant consuming public.” *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1375, 73 U.S.P.Q.2d 1689, 1694 (Fed. Cir. 2005) (rejecting a “general public” standard for analysis of the *DuPont* famousness factor). In this regard, the Board looks to a wide variety of indicia of public renown, ranging from indirect evidence concerning sales and extensive media coverage to length of use and direct survey evidence of public recognition. *See, e.g., Bose Corp.*, 293 F.3d at 1372, 63 U.S.P.Q.2d at 1306 (finding ACOUSTIC WAVE famous based on 17 years of use, annual sales over \$50 million, annual advertising in excess of \$5 million, and extensive media coverage).

First, as discussed in detail above, the CANYON RANCH mark is famous as evidenced by the extensive third-party media coverage the mark has received since the first CANYON RANCH property opened more than 35 years ago. Beginning in the early 1980s, national publications such as THE NEW YORK TIMES, USA TODAY, and TIME magazine have run articles featuring the CANYON RANCH properties, the CANYON RANCH mark, and the products and

services offered under the marks. (Cohen Aff., ¶ 5). For example, CANYON RANCH was featured as the front page cover story for TIME magazine in 1982. (*Id.*, Exh. A, CR1799). It similarly made front page news in USA TODAY in 1984 and again in 2000. (*Id.*, CR1797; CR2028). The CANYON RANCH property and mark were featured in the ROBB REPORT in 1990 (*Id.*, CR 1856-1859), in THE WALL STREET JOURNAL in 1996 (*Id.*, CR 1860), in FORTUNE magazine in 1999 (*Id.*, CR1962-65), in INC. magazine in 2007 (*Id.*, CR2103-2111), and in THE NEW YORK TIMES in 2009 (*Id.*, CR2120-2122), just to name a few. Each of these publication reach millions of people. (*Id.*, ¶ 6).

The mark also has been mentioned numerous times in popular culture through references in generalized and specialized media outlets such as entertainment magazines, fitness magazines, and regional newspapers. The CANYON RANCH properties have been featured in such magazines as HARPER'S BAZAR, ALLURE, MORE, FASHION, MEN'S FITNESS, SHAPE, REDBOOK, and GOURMET magazine (*Id.*, Exh. A), and in newspapers like THE BOSTON GLOBE, THE WASHINGTON TIMES, and THE LOS ANGELES TIMES. (*Id.*, ¶ 7 & Exh. A)

With each expansion into new locations and services, the CANYON RANCH properties and mark have received further unsolicited print media attention. The Lenox location, which has been operating under the CANYON RANCH mark since 1989, has been featured in magazines and national newspapers since its opening. (*Id.*, ¶ 8). When Canyon Ranch expanded its operations by moving into the day spa concept, this introduced the CANYON RANCH mark to an even broader audience. (*Id.*, ¶ 11). The CANYON RANCH® SPACLUB® facility in Las Vegas, Nevada has gained notoriety from published articles detailing the CANYON RANCH services in such magazines as CASINO PLAYER MAGAZINE, WHERE LAS VEGAS, SPORTS ILLUSTRATED WOMEN, and FORBES TRAVEL GUIDE. (*Id.*, ¶ 12). In addition, when Canyon Ranch entered into partnership with several cruise companies, including Cunard, Oceania

Cruises and Regent Seven Seas, the CANYON RANCH® SPACLUB® experience was introduced to an even larger audience and further garnered print media coverage. (*Id.*, ¶¶ 13, 17). Finally, with the addition of the CANYON RANCH spa and residential complex in Miami in 2008, the project brought the CANYON RANCH mark further media recognition. (*Id.*, ¶ 18). Such continuous and widespread print media attention shows the fame of the CANYON RANCH mark.

Second, the fame of the CANYON RANCH mark is reflected by the numerous awards the CANYON RANCH properties and day spas have received since their respective openings. (*Id.*, ¶¶ 8, 9, 12). For example, CANYON RANCH has been named by CONDÉ NAST TRAVELER MAGAZINE's Reader's Survey the World's Best Spa an unprecedented 11 times – more than any other spa in the world. Additionally, CANYON RANCH has been named 13 times in TRAVEL + LEISURE's World's Best Awards Reader's Survey under the Best Spa category. Other accolades include being named 10 times in American Airlines' CELEBRATE LIVING MAGAZINE's Readers' Choice Platinum List as the Top U.S. Spa, being named 13 times in SPAFINDER INC.'s Readers' Choice Awards, and being named five times in SPA MAGAZINE's Silver Sage Readers' Choice Awards. (*Id.*, ¶ 12). The fact that so many readers in diverse magazines have voted for CANYON RANCH shows the extensive public recognition and renown of the CANYON RANCH mark.

Third, the fame of the CANYON RANCH mark is further seen in the fact that, as far back as 1993, unsolicited third-party publications have literally referred to CANYON RANCH as “famous.” From THE SAN FRANCISCO EXAMINER to THE LOS ANGELES TIMES, print media have noted that CANYON RANCH is “world-renowned” and “famous.” (*Id.*, ¶ 10). Similarly, third-party marketing materials discussing CANYON RANCH have also noted the fame of the marks. (*Id.*, ¶16). In fact, the fame of the CANYON RANCH mark is most apparent given that

popular media have often used the CANYON RANCH mark as a short-hand reference to luxury and attention to detail. (*Id.*, ¶ 20). These cultural references are probative because they would never be meaningful to their national audiences without pre-existing consumer recognition of the CANYON RANCH mark.

Fourth, the fame of the CANYON RANCH mark is seen by its numerous mentions in various nationally syndicated television shows, from The Oprah Winfrey Show to Monday Night Football. (*Id.*, ¶ 21). The CANYON RANCH properties and mark have been mentioned in such popular TV dramas as the Real Housewives of New York and Gossip Girl, as well as talk shows such as The Rosie O'Donnell Show, the Martha Stewart Show, the Today Show, and The Dr. Oz Show. (*Id.*, ¶¶ 21, 23, 27). Day time talks shows, on which CANYON RANCH staff frequently appear, reach millions of viewers. (*Id.*, ¶¶ 24, 28)

Fifth, the fame of the CANYON RANCH mark is evidenced by the large amounts of advertising expenditures Canyon Ranch has made to promote its marks. In its over 35 years of existence, Canyon Ranch has spent millions of dollars in advertising and marketing its CANYON RANCH mark and the products and services offered under the mark. (*Id.*, ¶ 31). Canyon Ranch has promoted and marketed the CANYON RANCH mark in every geographic area in the world since at least as early as 1998 on the world wide web at its website www.canyonranch.com. (Supp. Cohen Aff., ¶ 3).

Canyon Ranch has also advertised its services in numerous print and electronic media channels, including regular direct mailing campaigns to tens of thousands of people, and promotional contest with OK! MAGAZINE, LUCKY MAGAZINE, SHAPE MAGAZINE, bestselling author Jonathan H. Ellerby, Saks Fifth Avenue, and Jockey International, Inc. (Supp. Cohen Aff., ¶ 3). In addition, the CANYON

RANCH mark has been advertised through social networking media, such as Facebook and YouTube as well as through regular print ads in media channels such as THE NEW YORK TIMES and THE WALL STREET JOURNAL. (*Id.*).

Such advertisements and marketing have been successful, as hundreds of thousands of guests have visited the various CANYON RANCH locations in the past 35 years, in excess of a million CANYON RANCH services have been enjoyed through the CANYON RANCH® SPACLUB® day spas in Las Vegas and on cruise ships, and tens of thousands of products bearing the CANYON RANCH mark have been sold. (*Id.*, ¶ 2; Cohen Aff., ¶ 12).

Given its fame, the CANYON RANCH mark is entitled to the broadest scope of protection. *Kenner Parker Toys, Inc.*, 22 U.S.P.Q.2d at 1456 (“[T]he Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls....”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894,1897 (Fed. Cir. 2000) (“[T]he fame of the mark must always be accorded full weight when determining the likelihood of confusion.”) Thus, the fame of the CANYON RANCH mark weighs heavily in favor of likelihood of confusion.

3. *The Similarity of the Marks Favors a Finding of Likelihood of Confusion*

It is well established that marks need not be identical for a likelihood of confusion to exist. The Board does not make a “side-by-side” comparison. *See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975). Rather, the issue is whether the marks are sufficiently similar in terms of their overall commercial impressions such that confusion as to

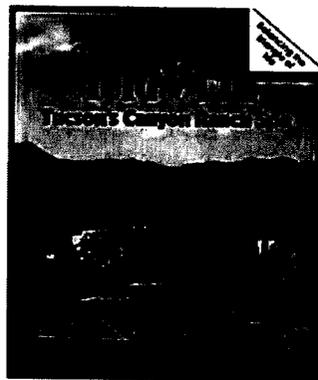
association or affiliation is a likely result. *See San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 685, 196 U.S.P.Q. 1, 3 (C.C.P.A. 1977). The focus is on the recollection of the average consumer, who normally retains a general rather than a specific impression of a trademark. *Sealed Air Corp.*, 190 U.S.P.Q. at 108.

When, as here, the opposer's mark is famous, the degree of similarity between the marks need not be as great as when an opposer's mark is obscure or weak. *See Kenner Parker Toys*, 963 F.2d at 353, 22 U.S.P.Q.2d at 1456. Indeed, although there are specific differences between the marks at issue here, "a purchaser is less likely to *perceive* differences from a famous mark." *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 730, 6 U.S.P.Q.2d 1719, 1722 (Fed. Cir. 1988) (Nies, J., dissenting) (emphasis in original), quoted with approval in *Kenner Parker Toys*, 963 F.2d at 353, 22 U.S.P.Q.2d at 1456.

In addition, the Board is to be guided by the long-standing precedents which teach that slight differences between marks are not enough to avoid a finding of likely confusion, especially when the goods or services traded under the marks are related or competitive, as they are here (discussed below). *See Kenner Parker Toys*, 963 F.3d at 354, 23 U.S.P.Q.2d at 1457 (reversing dismissal of opposition against FUN DOUGH on grounds it was confusingly similar to PLAY-DOH); *Blockbuster Entm't Group v. Laylco, Inc.*, 869 F. Supp. 505, 33 U.S.P.Q.2d 1581 (E.D. Mich. 1994) (granting injunction against BUSTER VIDEO on grounds that it was confusingly similar to BLOCKBUSTER VIDEO);

Despite differences, the marks are nonetheless confusingly similar because the Disputed Marks incorporate the CANYON RANCH mark in their entirety. *See In re Rexel, Inc.*, 223 U.S.P.Q. 830 (T.T.A.B. 1984) (A "subsequent user may not appropriate another's entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it."). Moreover, the Disputed Marks differ only in the addition of the

laudatory word “GRAND,” the geographic designator “AT SPIRIT MOUNTAIN” and a design of a desert mountain scene. These differences only increase the risk of confusion between the Disputed Marks and the CANYON RANCH mark. To the extent that “GRAND” is viewed separately from “CANYON RANCH,” it would be viewed as merely laudatory, perhaps as a larger more elaborate version of the well-known CANYON RANCH properties. To the extent that “GRAND” is viewed as a reference to the “Grand Canyon” that also creates a clear association with the famous flagship CANYON RANCH property, which is known as being located in Arizona—the “Grand Canyon” state. (*See* Cohen Aff., ¶ 34-35 & Exh. Y, Z). The visual elements of the Disputed Marks further drive home this association as it is a desert mountain scene, similar to those featured in Canyon Ranch advertising materials for 35 years (*Id.* & Exh. X) and to those shown in the unsolicited media coverage enjoyed by CANYON RANCH, such as the below TIME magazine cover.



Moreover, the confusing similarity between the Disputed Marks and the CANYON RANCH mark — clear under the typical standard — is overwhelming when viewed under the lower standard for similarity dictated by the fame of the CANYON RANCH mark. *See Kenner Parker*, 22 U.S.P.Q. 2d at 1456 (“[T]he Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls. . . .”). In fact, the addition of the

descriptive word “Grand” to the famous CANYON RANCH mark, increases the likelihood of confusion by suggesting to consumers that the Disputed Marks are a “spin off” of the famous CANYON RANCH mark, a conclusion supported by both parties’ headquarters being located in Arizona. *See Am. Express Co. v. Am. Express Limousine Serv. Ltd.*, 772 F. Supp. 729, 733, 21 U.S.P.Q.2d 1009, 1012 (E.D.N.Y. 1991); *Hewlett-Packard Co. v. Packard Techs.*, 281 F.3d 1261, 1266, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002).

In light of these indisputable facts, this *du Pont* factor strongly suggests a likelihood of confusion between the CANYON RANCH mark and the Disputed Marks, as the commonalities between the CANYON RANCH mark and the Disputed Marks are striking and the differences only increase the risk of confusion.

4. *The Similarity Between GCR’s Services and Canyon Ranch’s Services Favors a Finding of Likelihood of Confusion*

As the Board has often stated, it is a general rule that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. *See, e.g., In re Shell Oil Co.*, 992 F.2d at 1207, 26 U.S.P.Q.2d at 1689. Rather, it is enough that goods or services are “related in some manner” or that “some circumstances surrounding their marketing” are such that they would be likely to be seen by the same persons under circumstances which could give rise to a mistaken belief that they are in some way associated with the same producer or that there is an association between the producers of each parties’ goods or services. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 U.S.P.Q. 1289, 1290 (Fed. Cir. 1984); *Time Warner Entm’t Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (T.T.A.B. 2002).

In making the requisite assessment of the similarity of the goods and services, the Board is necessarily guided by the parties’ descriptions of their goods and services in their respective applications and registrations. *Hewlett-Packard Co.*, 281 F.3d at 1267, 62 U.S.P.Q.2d at 1004.

Here, the evidence demonstrates that the services provided under the Disputed Marks are commercially related to the services provided under the CANYON RANCH mark. First, both of the Disputed Marks are used in connection with “recreational and entertainment services in the nature of horse-drawn wagon rides, horse-back riding and helicopter tours, ATV (all-terrain vehicle) tours, hiking, mountain biking” in class 41. These services are commercially related to services provided under CANYON RANCH, Reg. Nos. 3,172,612, 1,350,012, and 3,178,367, including “conducting programs in exercise and physical conditioning,” “sports and entertainment services”, and “providing instruction and equipment in the field of physical fitness.” These services are broad enough to encompass the recreation and entertainment services cited in the Disputed Marks. In fact, the CANYON RANCH mark is used for some of the exact recreational and entertainment services – hiking, and mountain biking. (Cohen Aff., ¶ 29). Canyon Ranch has offered hiking and biking under the CANYON RANCH® trademarks continuously since 1979. Moreover, it has received extensive media attention based on its world-renowned hiking and biking excursions. (*Id.* & Exh. T).

Similarly, the services offered under the Disputed Marks under class 39, “excursion arrangements for tourists,” are closely related to the services offered under the CANYON RANCH marks, Reg. Nos. 1,598,938, 3,172,612, 1,350,012, and 3,178,367. The services covered under the CANYON RANCH mark encompass arranging excursions, and thus are commercially related to the services identified in the Disputed Marks. Moreover, the CANYON RANCH mark has been used continuously for this service since the first CANYON RANCH property opened. (*Id.*, ¶ 29). Apart from the previously mentioned biking and hiking excursions, the CANYON RANCH mark is used with cross-country skiing, snowshoeing, canoeing, kayaking, golf, tennis, hiking, and surfing excursions, depending on the resort. (*Id.*,

¶ 30). The availability of these diverse excursion options have been the focus of various media articles. (*Id.* & Exh. U).

Finally, the CANYON RANCH mark, Reg. Nos. 1,350,012, 3,202,993, and the GRAND CANYON RANCH & Design mark, Reg. No. 3,927,500, are both used in connection with resort lodging accommodations and restaurant services. These services are identical and will increase the danger that the public will incorrectly assume there is a connection between the providers. Moreover, the relatedness of the service is emphasized by the manner the marks are marketed—with emphasis on each party’s Arizona locations and their desert mountain surroundings.

Overall, given that the services offered under the CANYON RANCH mark, as identified in the registrations, are commercially related to the services identified in the Disputed Marks’ registration and application, this *du Pont* factor weights in favor of a finding of likelihood of confusion.

5. The Parties’ Channels of Trade and Customers Overlap

The Disputed Marks and the CANYON RANCH registrations contain no limitations on the channels of trade. Accordingly, the parties’ goods are presumed to travel through all trade channels. See *Victoria’s Secret Stores Brand Mgmt., Inc. v. Sexy Hair Concepts, LLC*, 91 U.S.P.Q.2d 1671, 1672-73 n.1 (S.D.N.Y. 2009). Thus, the trade channels for the services offered under the Disputed Marks and the CANYON RANCH mark are presumed to overlap as a matter of law.

Moreover, the parties’ goods are in fact offered in the same channels of trade and to the same consumers. GCR admitted that its visitors include people from “throughout the United States and from numerous foreign countries.” (Turner Aff., ¶ 10). Similarly, the visitors to the CANYON RANCH properties come from across the United States and from foreign countries. (Cohen Aff., ¶¶ 12, 14, 31-32). Moreover, the channels of trade overlap in that both companies’

services are reviewed on the popular websites such as TripAdvisor.com. (*Id.*, ¶ 19 & Exh. K; Garrison Aff., ¶ 3).

The channels of trade overlap even further for Canyon Ranch’s original flagship resort and GCR’s facility – both of which are located in Arizona. In fact, both the CANYON RANCH property and the GCR location are well-known to be located in Arizona—which is nicknamed the “Grand Canyon” state. The presumed overlap in channels of trade — and actual overlap in customers seeking an active vacation in Arizona — renders confusion likely.

6. *There Is No Evidence of Third Party Use of Similar Marks on Similar Services*

Under this *du Pont* factor, the Board must consider evidence pertaining to the number and nature of similar marks in use on similar services. GCR has presented no evidence of any similar marks used by third parties in connection with similar services. The only evidence it has presented is a Google search showing results for “grand canyon ranch” in which the search results show multiple references to GCR and one reference to “Phantom Ranch Lodging & Dining.” (Turner Aff., ¶ 14 & Exh. 9). These are not references that show use of similar CANYON RANCH marks by third parties. Moreover Canyon Ranch has vigilantly protected its CANYON RANCH mark by policing third party uses of similar marks. (Cohen Aff., ¶ 46; Supp. Cohen Aff., ¶ 5 & Exh. A). Therefore, this factor weighs in favor of a finding of confusion.

D. GCR’S Activities Dilute The Famous CANYON RANCH Mark

1. *Canyon Ranch has Established the Elements of Dilution by Blurring and/or Tarnishment*

Under Section 13(a) of the Lanham Act, an opposer may challenge an application to register a mark on grounds of dilution under Section 43(c) of the Act. 15 U.S.C. § 1125(c). Under Section 43(c), a plaintiff need not show competition or likelihood of confusion to enjoin a defendant’s dilution of its trademark.

To prevail on a dilution claim, a plaintiff must show that: (1) it owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment. *Graduate Mgmt. Admission Council v. Raju*, 267 F. Supp. 2d 505, 511 (E.D. Va. 2003). The Act defines dilution by blurring as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). Dilution by tarnishment is defined as "an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(2)(C).

As discussed more fully below, the evidence presented establishes each one of these elements.

2. *The CANYON RANCH Mark is Famous*

The CANYON RANCH® mark meets each factor for determining whether a mark is "famous" for purposes of a dilution claim:

(i) The CANYON RANCH mark has been continuously used nationwide for 35 years in connection with a variety of goods and services, including resort, restaurant and fitness services, but also with such diverse products and services as cookbooks, real estate development, clothing, skin care products, medical services, counseling services, and outdoor excursions. Moreover, each of these services has received numerous third-party media mentions throughout the 35 years in addition to the extensive advertisement done by Canyon Ranch itself.

(ii) The CANYON RANCH services are offered in multiple locations to nationwide – and worldwide – customers.

(iii) The CANYON RANCH mark is actually recognized by the public as evidenced by three decades of unsolicited media coverage, a good portion of which refers to CANYON RANCH as “famous,” as well as the numerous awards and accolades the CANYON RANCH properties have received.

(iv) The CANYON RANCH mark is registered in multiple iterations.

15 U.S.C. § 1125(c)(2)(A).

As was more fully discussed *supra*, Part V.C.2, the evidence concerning recognition of the CANYON RANCH mark demonstrates that the mark is widely recognized in the United States as referring to the goods and services offered under the mark. When the general public encounters the CANYON RANCH mark, they associate the term with Canyon Ranch. For example, the CANYON RANCH mark is not only found in third-party print media references that target resort and spa customers but in such diverse publication as financial news and magazines, celebrity magazines, gourmet food magazines, and sports and fitness magazines. In addition, the CANYON RANCH mark is often mentioned in popular television shows that range from day time talk shows to Monday Night Football. Within all of these context the references are clearly to the CANYON RANCH properties and services.

Further, the widespread recognition of the CANYON RANCH mark is seen by the fact that it is often used as shorthand for luxury and attention to detail. For example, in a 2001 PEOPLE WEEKLY article about the television show Survivor II the articles state that “the production crew’s camp seems as lux as the Canyon Ranch spa.” (Cohen Aff., ¶ 20 & Exh. L, CR3514). Similarly, an article in THE BOSTON GLOBE stated: “Canyon Ranch. Just those two words side by side are balm to a woman’s weary soul.” (*Id.*, CR3517-3521). The fact that no context was required in either article to know that the reference was referring to Canyon Ranch shows that the CANYON RANCH mark is a household name.

Moreover, the fame of the CANYON RANCH mark is evidenced by the millions of dollars in advertising expenditures Canyon Ranch has made to promote the mark over the past thirty five years. In addition, the fact that the CANYON RANCH mark has been promoted across the country through both print and electronic media channels, that CANYON RANCH services can be obtained in states across the nation, and that Canyon Ranch has an annual _____, all substantiate the conclusion that the CANYON RANCH mark is famous for purposes of a dilution claim.

3. *The CANYON RANCH Mark Became Famous Prior to GCR's Use of the Disputed Marks*

The vast majority of evidence assembled by Canyon Ranch regarding recognition of its CANYON RANCH mark predates GCR's alleged date of first use of the Disputed Marks—May 2003. In fact, national media outlets started noting that the CANYON RANCH properties and mark were famous as early as 1993 – ten years before GCR's alleged date of first use. (Cohen Aff., ¶ 10). Thus, there can be no dispute that the fame of the CANYON RANCH mark was well-established prior to GCR's use of the Disputed Marks.

4. *The Disputed Marks are Likely to Blur the Distinctiveness of the CANYON RANCH Mark*

Congress has established the following non-exclusive factors for determining the likelihood of blurring in a dilution case:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B).

(i) The Marks are Sufficiently Similar

An important question in a dilution case is whether the marks are “sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *Nat’l Pork Bd. & Nat’l Pork Producers Council*, 96 U.S.P.Q.2d 1479 (T.T.A.B. 2010). As previously discussed, *supra* V.C.3., the marks differ only in the addition of the laudatory word “GRAND,” geographic descriptor “AT SPIRIT MOUNTAIN” and design of a desert mountain landscape. These differences only increase the association between the marks. The Disputed Marks and the CANYON RANCH mark elicit the same mental impression, namely, a location in the desert Southwest. Consumers are likely to conjure up the CANYON RANCH mark when confronted by the Disputed Marks. The words GRAND CANYON RANCH will bring to mind either a “grand” version of “Canyon Ranch” or a location of Canyon Ranch at the Grand Canyon, one of the best known tourist attractions in the Southwest. The visual elements of the Disputed Marks reinforce the connection to CANYON RANCH as consumers are well aware that the flagship CANYON RANCH property is located in the desert Southwest, which is visually depicted in the Disputed Marks. This impression has been further imbedded in the minds of consumers due to the use of desert mountain landscapes by the media when reporting on the CANYON RANCH properties and marks and the use of such landscapes by Canyon Ranch in advertising its mark for the past 35 years. (Cohen Aff. , ¶ 33-35 & Exh. X-Z).

Moreover, in those cases, such as this, where the parties’ marks refer to related services, the degree of similarity necessary to find dilution is less than that which would be required for

entirely unrelated services. *See Perfumebay.com, Inc. v. eBay, Inc.*, 506 F.3d 1165, 1181, 84 USPQ 2d 1865, 1876 (9th Cir. 2007) (finding the marks EBAY® and PERFUMEBAY to be sufficiently similar to support a claim for dilution, in part because of the distinctiveness of the famous mark and the relatedness of the parties' goods and services). Here, both marks are used with lodging, recreation and excursion services, offered at least, in part, in Arizona.

Thus, because consumers would think of CANYON RANCH when confronted with the Disputed Marks, this factor weighs in favor of finding a likelihood of confusion.

(ii) The CANYON RANCH Mark is Inherently Distinctive

The CANYON RANCH mark is not only commercially strong, it is also inherently distinctive. The CANYON RANCH mark is entitled to a legal presumption of inherent distinctiveness in light of its registration under Section 1(a) without any requirement of a Section 2(f) showing of acquired distinctiveness. *See Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1899 (T.T.A.B. 2006). In addition, apart from any legal presumption, as a matter of basic trademark law, the phrase CANYON RANCH is inherently distinctive because it does not describe or even suggest any attributes of the lodging, recreation and excursion services being provided under the mark. It is, instead, an arbitrary term when used with these services.

Thus, because CANYON RANCH is both inherently distinctive and commercially strong, this dilution factor favors Canyon Ranch.

(iii) Canyon Ranch's use of the CANYON RANCH Mark is Substantially Exclusive

As noted *supra*, Part V.C.6, the record here demonstrates that Canyon Ranch's use of the CANYON RANCH mark is substantially exclusive. Canyon Ranch actively polices its mark and takes action against parties using confusingly similar marks. Other than GCR there is no evidence of any party using the same mark or even a similar mark on similar goods and services.

Thus, this factor favors a finding of dilution by blurring.

(iv) The Degree of Recognition of the CANYON RANCH Mark is High

The fourth statutory factor for the blurring analysis requires the Board to assess just how well recognized is the CANYON RANCH mark. Here again, evidence of the fame of the CANYON RANCH mark supports the conclusion that the CANYON RANCH mark is extremely well recognized, *supra* V.C.2. The mark is found in different types of print media, on broadcast media, and on advertising and marketing materials across the United States. This degree of recognition also suggests that dilution by blurring is likely.

(v) Conclusion

In light of the various considerations specified under the statute, the evidence presented here demonstrates that the Disputed Marks are likely to dilute the CANYON RANCH mark by blurring the distinctiveness of this famous mark.

5. *The Disputed Marks are Likely to Tarnish the Reputation of the CANYON RANCH Mark*

Dilution by tarnishment is defined as “an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). As such, tarnishment occurs where the effect of the defendant’s unauthorized use is to degrade positive associations of the mark and thus, to harm the reputation of the mark. 4 MCARTHY ON TRADEMARK AND UNFAIR COMPETITION § 24:89 (4th ed. 2014). Tarnishment “generally arises when the plaintiff’s trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.” *Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39, 43 (2d Cir. 1994). *See also Chemical Corp. v. Anheuser–Busch, Inc.*, 306 F.2d 433, 134 USPQ 524 (5th Cir.1962) (finding that use of exterminator’s slogan “where there’s life, ... there’s Bugs” tarnished the use of beer company’s slogan “where there’s life, ... there’s Bud.”); *Steinway & Sons v. Robert Demars & Friends*, 210 U.S.P.Q. 954 (C.D.Cal.1981) (finding that use of “STEIN–WAY CO.” to sell clip-on beverage

handles tarnished high-end musical instrument company's use of its name of "STEINWAY & SONS").

Here, GCR's use of the Disputed Mark will tarnish the positive reputation of the CANYON RANCH mark because the services offered under the Disputed Marks are of poor quality. The website, TripAdvisor.com, which is a popular travel site that is viewed by more than 260 million unique monthly visitors (Cohen Aff., ¶ 19 & Exh. K), shows that visitors to GCR's facility have provided numerous negative comments about the quality of the lodging, excursions, and food offered under the Disputed Marks, including the following reviews:

- "Worst place EVER," *Reviewed January 7, 2013, Tripadvisor.com* ("We had booked for 4 nights at the end of October but only stayed for 2 because it was so bad...the food was awful...**The ranch is completely rundown** and is [sic] deperate need of refurbishment but it seems that the owner is more interested in the helicopter flight side of the business raht than the ranch.") (emphasis added)
- "Website TOTALLY misrepresents property and experience," *Reviewed August 20, 2012, Tripadvisor.com* ("If they put the time, money and attention into the resort (how can they even use the R word?) that they put into the website, it might actually be a nice place...Room tip: Never even go here- don't even check it out.")
- "Poor experience, not worth the money", *Reviewed April 13, 2012, Tripadvisor.com* ("I took my family here beginning April, the place is hard to find but that really wasn't a problem, what was, was the awful accommodation. **The cabins are so small, the pictures DO NOT show the real sizes, the bedding is awful, really old, thread bare blankets that look and smell unclean. The beds were so uncomfortable which ruined the whole experience...**") (emphasis added).
- "Place from hell, and customer service to match", *Reviewed April 5, 2012, Tripadvisor.com* ("... **The beds were shocking, we were staying in the smith cabin and the beds were so worn that you could literally feel every spring by just lightly running your hand across, the bedding was discusting [sic], the blankets old with wires running through them...I have camped out before and stayed in many places but never one as uncomfortable and dirty as this.** Please don't make the same mistakes as us, avoid at all costs this is not a fun place to stay, and if you have any problems the management are NOT interested in helping you.") (emphasis added).
- "Absolutely appalling experience!", *Reviewed January 10, 2012, Tripadvisor.com* (".. ... **In the meantime our family ate at the restaurant & said it was so bad they couldn't eat the food. ... In addition, the whole place looked run down and very basic and**

people working there had a really negative attitude ... Save your money and the aggravation and do NOT use this company!”)(emphasis added).

- “Do not stop here.” *Reviewed January 5, 2012, Tripadvisor.com* (“We were on a recent trip to the west rim of the Grand Canyon and stopped here to eat on the way out. **All I ordered was a turkey club sandwich. It took almost one hour to arrive, cost \$15 and the bread was stale and dry.** ... Lousy experience that spoiled what was otherwise a great day. **DO NOT STOP HERE!**”)(emphasis added).
- “What a disappointment! What a rip-off!” *Reviewed November 27, 2011, Tripadvisor.com* (“We spent a night at this ranch recently and we were both bitterly disappointed by the whole experience. **Our cabin (thankfully we had booked a cabin) was freezing cold, smelly and far from clean and the facilities left much to be desired.** We found the bed uncomfortable and unwholesome. ... **The food was cold and unappetising [sic] both at dinner and breakfast** ... We travelled over from the East Coast especially to do this trip and it was a bitter disappointment. Save your money and steer clear of this place overnight. (I seem to have clicked the couples trip in error!)”)(emphasis added).
- “TERRIBLE” *Reviewed October 8, 2011, Tripadvisor.com* (“... **The bedding was stained, dirty, and covered in hairs. We spent the night huddled together in bed wearing, jeans, trainers, sweatshirt and fleeces and had very little sleep.**”)(emphasis added).
- “Poor quality service and value for money, *Reviewed July 30, 2011, Tripadvisor.com* (“We booked this as part of a trip from Las Vegas, **Breakfast the next morning was barely edible.** I think what we objected to most of all was the lack of customer care - I felt like just another tourist they were trying to screw money out of and there was no attempt to make sure we were comfortable or had a good time. ... To sum up - go for the helicopter flight but avoid the overnight stay at the ranch like the plague - and bring your own drinks!”)

(Garrison Aff., ¶ 3, Exh. B). The reviews on other sites, including Yelp® and Google+, are equally as negative. (*Id.*). One Yelp® reviewer commented that it was “the worst vacation/anniversary of my entire life.” And noted that even though the Living Social® deal called the lodging a “resort” the facilities were in fact not anywhere near what would be expected in a resort—their cabin bathroom “was reminiscent of one during a trip to Argentina in 2008—very primitive and not pleasant.” (*Id.*, CR2656).

In contrast, the CANYON RANCH mark enjoys a positive reputation among consumers for its world-class luxury accommodations. The numerous awards and accolades received by

CANYON RANCH show that the CANYON RANCH properties and services are considered among the best in the United States, if not the world. For example, the CANYON RANCH properties have been named by CONDÉ NAST TRAVELER MAGAZINE's Reader's Survey the World's Best Spa an unprecedented eleven times – more than any other spa in the world. Additionally, CANYON RANCH has been named 13-times in TRAVEL + LEISURE's World's Best Spa category. (Cohen Aff., ¶ 9 & Exh. E). The CANYON RANCH SPACLUB® at The Venetian® and The Palazzo® has also received a number of accolades and awards. (*Id.*, ¶ 12 & Exh. G). Further, the cuisine offered under the CANYON RANCH mark is well known and has been named in TRAVEL + LEISURE's World's Best Food category and voted the best Spa Cuisine by AMERICAN SPA's. (*Id.*, ¶ 23 & Exh. Q).

As such, given the strong negative connotation that the Disputed Marks have among members of the public, and the strong positive association members of the public have with the CANYON RANCH mark, use of the Disputed Marks by GCR will tarnish the CANYON RANCH mark. Thus, the record clearly demonstrates a likelihood of dilution by tarnishment.

VI. CONCLUSION

For the reasons above, Canyon Ranch requests that the Board sustain its Opposition to United States Trademark Serial No. 77/905,088 and grant its Petition to Cancel United States Trademark No. 3,927,500.

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Respectfully submitted,



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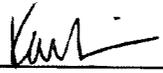
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Petitioner's ACR Trial Brief was served
by U.S. Mail upon the following:

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