

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
September 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*CR License, LLC*  
*v.*  
*Grand Canyon Ranch*

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Opposition No. 91202705 (Parent)  
Cancellation No. 92054034

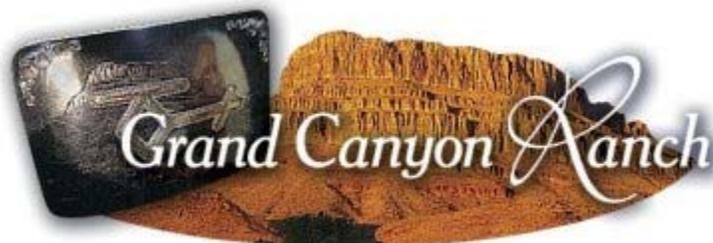
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Jennifer A. Van Kirk of Lewis Roca Rothgerber LLP for CR License, LLC.

Thomas I. Rozsa of Rozsa Law Group LC for Grand Canyon Ranch.

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Before Quinn, Bergsman and Lykos, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Grand Canyon Ranch (“Defendant”) has registered the mark GRAND CANYON RANCH and design, shown below,



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for the following services:

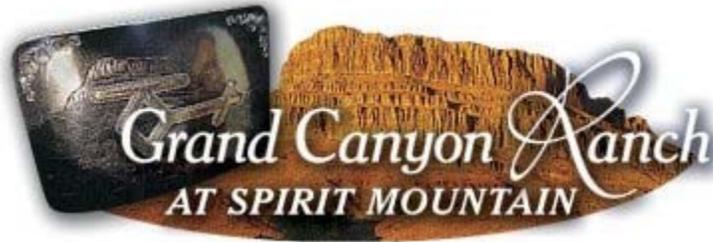
Excursion arrangements for tourists, in Class 39;

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.<sup>1</sup>

Defendant disclaimed the exclusive right to use “Grand Canyon Ranch.”

Defendant also filed a use-based application to register the mark GRAND CANYON RANCH AT SPIRIT MOUNTAIN, shown below,



for the following 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, mountain biking, in Class 41.<sup>2</sup>

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<sup>1</sup> Registration No. 3927500, issued March 8, 2011, based on an application filed January 5, 2010. Defendant claimed as its date of first use anywhere and first use of its mark in commerce for all of the services at least as early May 31, 2003.

<sup>2</sup> Serial No. 77905088, filed January 5, 2010. Defendant claimed as its date of first use anywhere and first use of its mark in commerce for both classes of services at least as early May 31, 2003.

Defendant disclaimed the exclusive right to use “Grand Canyon” and “Spirit Mountain.”

CR License LLC (“Plaintiff”) filed a petition to cancel Defendant’s registration and filed a notice of opposition to the registration of Defendant’s application on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution by blurring and tarnishment pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Plaintiff claimed ownership of the following registrations for the mark CANYON RANCH in typed drawing form and standard character form:<sup>3</sup>

1. Registration No. 1350012 for “conducting programs in exercise and physical conditioning,” in Class 41, and “fitness resort and restaurant services,” in Class 42;<sup>4</sup>

2. Registration No. 1598938 for “transportation of passengers by means of automobile and reservation services for transportation,” in Class 39;<sup>5</sup>

3. Registration No. 3172612 for “sports and entertainment services, namely, golf; educational services, namely, conducting classes and demonstrations in the fields of physical fitness training,” in Class 41;<sup>6</sup>

4. Registration No. 3178367 for “health club services, namely, providing instruction and equipment in the field of physical exercise; physical education

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<sup>3</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings.

<sup>4</sup> Issued July 16, 1985; renewed. Plaintiff disclaimed the exclusive use of the word “Ranch.”

<sup>5</sup> Issued May 29, 1990; second renewal.

<sup>6</sup> Issued November 14, 2006; Sections 8 and 15 affidavits accepted and acknowledged.

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,” in Class 41;<sup>7</sup> and

5. Registration No. 3202993 for “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 Class 43.<sup>8</sup>

In its answers, Defendant denied the salient allegations in the petition for cancellation and the notice of opposition. Proceedings were consolidated in an order dated August 6, 2012.

The parties stipulated to participate in the Board’s Accelerated Case Resolution (ACR) program.<sup>9</sup> The parties agreed “to utilize a cross-motion for

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<sup>7</sup> Issued November 28, 2006; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>8</sup> Issued January 23, 2007; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>9</sup> 27 TTABVue.

summary judgment format and that the Board will be able to resolve any genuine disputes of material fact that are presented by the record.”<sup>10</sup>

The case has been fully briefed.

I. The parties.

A. Plaintiff

In 1979, Plaintiff founded “the original, flagship CANYON RANCH® destination spa resort.”<sup>11</sup> As shown by the evidence discussed below, over the next 35 years, CANYON RANCH became a renowned name in luxury spa resort services, including restaurant and fitness services, cookbooks, real estate development, clothing, skin care products, medical services, counseling services and outdoor excursions.<sup>12</sup> In 1989, Plaintiff opened another destination spa resort in the Berkshire Mountains in Lenox, Massachusetts which has developed its owned reputation and enhanced the brand recognition enjoyed by Plaintiff.<sup>13</sup>

“In 1999 Canyon Ranch® further expanded its operations by moving into the day spa concept with the Canyon Ranch® SpaClub® at The Venetian®. The construction of The Palazzo® in 2007, linked Canyon Ranch® SpaClub® to a second

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<sup>10</sup> 27 TTABVue 3. In an interesting application of the ACR process, the parties stipulated to deadlines for filing summary judgment type affidavits in lieu of a traditional testimony periods and then set deadlines for their briefing periods.

<sup>11</sup> Cohen Affidavit ¶2 (39 TTABVue 3).

<sup>12</sup> Cohen Affidavit ¶3 (39 TTABVue 3-4).

<sup>13</sup> Cohen Affidavit ¶8 (39 TTABVue 5), Exhibit D (41 TTABVue 38-71).

luxury hotel and casino resort.”<sup>14</sup> In 2008, Plaintiff “launched a luxury hotel, spa and residential complex in Miami Beach.”<sup>15</sup>

Plaintiff introduced its Canyon Ranch® SpaClub® spa and fitness services to another audience when it entered partnerships with several cruise companies, including Cunard, Oceania Cruises and Regent Seven Seas.<sup>16</sup>

B. Defendant.

Defendant is “a fully operating ranch located in the west end of the Grand Canyon, near Spirit Mountain.”<sup>17</sup> Defendant’s GRAND CANYON RANCH is “a cattle ranch that gives guests the opportunity to see an operating cattle ranch up close and allows them to experience the vast outdoors and old-fashioned Western hospitality.”<sup>18</sup> Because Defendant’s ranch is on the west rim of the Grand Canyon, Defendant originally called it the GRAND CANYON WEST RANCH.<sup>19</sup> However, a dispute arose with the Hualapai Indians who used the service mark GRAND CANYON WEST – HUALAPAI RANCH, so Defendant changed its name to GRAND CANYON RANCH.<sup>20</sup>

II. Evidentiary Issues

A. Supplemental Affidavit of Jerrold I. Cohen.

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<sup>14</sup> Cohen Affidavit ¶11 (39 TTABVue 9).

<sup>15</sup> Cohen Affidavit ¶18 (39 TTABVue 12).

<sup>16</sup> Cohen Affidavit ¶¶13-14 (39 TTABVue 10).

<sup>17</sup> Turner Affidavit ¶1 (45 TTABVue 32).

<sup>18</sup> Turner Affidavit ¶2 (45 TTABVue 33). *See also* Turner Affidavit ¶¶9-10 (45 TTABVue 36).

<sup>19</sup> Turner Affidavit ¶3 (45 TTABVue 33).

<sup>20</sup> Turner Affidavit ¶4 (45 TTABVue 34).

Under the parties' ACR stipulation, Plaintiff's deadline for serving affidavits was January 31, 2014.<sup>21</sup> However, on April 24, 2014, Plaintiff introduced the Supplemental Affidavit of Jerrold I. Cohen, the President of JC Management, Inc., the manager of CR License, LLC, and the owner of Plaintiff's registrations, as Exhibit 2 to Plaintiff's trial brief.<sup>22</sup> Defendant objects to the introduction of the Supplemental Affidavit of Jerrold I. Cohen on the ground that it was not timely filed.<sup>23</sup>

In response to Defendant's objection, Plaintiff argues that the Supplemental Affidavit should be admitted into evidence because "each statement found in the supplemental affidavit was taken nearly verbatim from [Plaintiff's] interrogatory responses, which were served on June 5, 2012. The supplemental affidavit merely presents this evidence in affidavit form."<sup>24</sup>

Unless properly introduced into evidence during trial through a notice of reliance, discovery responses are not evidence at trial. The parties stipulated that Plaintiff's deadline for serving affidavits was January 31, 2014 and that Defendant's deadline for serving affidavits closed on February 28, 2014. The introduction of Mr. Cohen's Supplemental Affidavit on April 24, 2014 was after the close of Plaintiff's testimony period and, therefore, it was not timely filed. Plaintiff's failure to timely file the Supplemental Affidavit of Mr. Cohen was not a mere

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<sup>21</sup> Stipulation to participate in ACR and joint motion to reopen discovery (27 TTABVue 2).

<sup>22</sup> 31 TTABVue.

<sup>23</sup> Defendant's Brief, p. 7 (45 TTABVue 13).

<sup>24</sup> Petitioner's Reply Brief, p. 2 (46 TTABVue 7).

formality. Because the Supplement Affidavit was filed after the close of Defendant's testimony period, Defendant did not have an opportunity to address that evidence during Defendant's case-in-chief.

Defendant's objection to the introduction of the Supplemental Affidavit of Jerrold I. Cohen is sustained.

B. Foreign newspapers and periodicals.

Plaintiff introduced into evidence numerous articles from foreign newspapers and periodicals. We did not consider the foreign documents because there is no basis for us to assume that they would be encountered by the relevant U.S. consumers. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1552 (TTAB 2009) (striking from evidence excerpts from foreign publications which were not shown to be in general circulation in the United States).

III. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Defendant's application and registration files. In addition, the parties introduced the following testimony and evidence:

A. Plaintiff's testimony and evidence.

1. Affidavit of Jerrold I. Cohen, President of JC Management, Inc., the manager of CR License LLC which owns Plaintiff's pleaded registrations, with attached exhibits. The complete affidavit, including testimony designated as confidential, is filed at 43 TTABVue. The redacted affidavit, without the testimony

designated as confidential, is filed at 39 TTABVue. The exhibits to the Cohen affidavit are filed at 32 – 37, 39-41 and 43 TTABVue;

2. Affidavit of Sean Garrison, an attorney for Plaintiff, with attached exhibits;<sup>25</sup> and

3. In its Amended Notice of Opposition, Plaintiff introduced its pleaded registrations into the record by filing copies of the registrations showing the current status of and current title to the registrations printed from the electronic database records of the USPTO pursuant to 37 CFR § 2.122(d)(1).<sup>26</sup>

B. Defendant's testimony and evidence.

Defendant introduced the Affidavit of Nigel Turner, the Managing Member of Defendant, with attached exhibits.<sup>27</sup>

IV. Standing

Because Plaintiff has properly made of record its pleaded registrations, Plaintiff has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

V. Priority

A. The opposition.

Because Plaintiff has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the marks and the

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<sup>25</sup> 31 TTABVue 143.

<sup>26</sup> 4 TTABVue.

<sup>27</sup> 45 TTABVue 32-202.

services covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. The petition for cancellation.

In order for Plaintiff to prevail on its Section 2(d) claim in the petition for cancellation, it must prove that it has a proprietary interest in its CANYON RANCH mark and that this interest was obtained prior to either the filing date of Defendant's application for registration or Defendant's date of first use, if proved. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).

Mr. Cohen, on behalf of Plaintiff, testified that Plaintiff has been using CANYON RANCH in connection with its resort services since 1979.<sup>28</sup>

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. Our Tucson resort has been continuously operating under the CANYON RANCH® marks since 1979.<sup>29</sup>

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<sup>28</sup> Cohen Affidavit ¶2 (39 TTABVue 3).

<sup>29</sup> *Id.*

Plaintiff also has offered hiking and biking under the CANYON RANCH mark since 1979<sup>30</sup> and arranging excursions for guests since at least as early as 1995.<sup>31</sup>

Defendant filed its application for registration on January 5, 2010. It did not proffer any testimony regarding its first use of the registered mark GRAND CANYON RANCH and design. Therefore, the earliest date first use on which Defendant may rely is January 5, 2010. Nevertheless, Nigel Turner, on behalf of Defendant, testified to the following dates of the first use for “Grand Canyon Ranch” (words only):

[Defendant] – in collaboration with Heli USA – has been offering the following services in connection with Grand Canyon Ranch:

- helicopter flights to the Grand Canyon Ranch from Las Vegas, since 2000;
- restaurant and bar service, since about 2003;
- hay rides, since about 2004;
- rodeos, since about 2009;
- buffalo visits, since about 2004;
- wagon rides, since about 2002;
- horseback riding since about 2000;
- overnight stays in cabins and/or tents, since about 2003.<sup>32</sup>

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<sup>30</sup> *Id.* at ¶29 and Cohen Exhibit T (39 TTABVue 18 and 34 TTABVue 16-119).

<sup>31</sup> Cohen Exhibit U (34 TTABVue 121-205).

<sup>32</sup> Turner Affidavit ¶8 (45 TTABVue 35-36).

No matter what dates of first use Defendant is entitled to claim, Plaintiff has priority of use.

VI. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of Plaintiff's mark.

This *du Pont* factor requires us to consider the fame of Plaintiff's marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and

services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-6 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Plaintiff introduced the evidence below to demonstrate the fame of its mark.

1. Plaintiff has received numerous awards for its health resort services, including, but not limited, to the following:<sup>33</sup>

- a. An 11-time winner of the *Condé Nast Traveler* Best Destination Spa Award;
- b. *Travel & Leisure* Best Spa Award – 13 times;
- c. *Spa Magazine* 15-time award winner;
- d. *Luxury SpaFinder* Reader's Poll Best Brand – 22 times;
- e. *Gourmet Magazine* Best Spa in 2000; and
- f. *Zagat*

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<sup>33</sup> Cohen Affidavit ¶9 (39 TTABVue 7); Cohen Exhibit E (41 TTABVue 73-163).

1. Top Ten Destination Spa in U.S. (2007); and
  2. Top Five Destination Spas in U.S. (2005);
2. Media recognition noting Plaintiff's renown, including, but not limited to the following (emphasis added):<sup>34</sup>

- a. *The Arizona Daily Star*, "More Than A Fat Farm" (August 29, 1993)

Canyon Ranch offers lessons in healthful living

\* \* \*

**The internationally renowned resort** is consistently rated by magazines as one of the nation's top spas.<sup>35</sup>

- b. *San Francisco Examiner Magazine*, "Desert Blooms" (October 16, 1994)

**Tucson's legendary Canyon Ranch** restores you [sic] body & soul through sun & sweat.<sup>36</sup>

- c. **FROMMER'S COMPREHENSIVE TRAVEL GUIDE: ARIZONA '95**

Once a dude ranch, **Canyon Ranch is today one of America's premier health spas**, and offers the

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<sup>34</sup> Cohen Affidavit ¶10 (39 TTABVue 8); Cohen Exhibit F (37 TTABVue 2-269). The documents introduced as evidence of Plaintiff's fame are admissible and probative only for what they show on their face, and not as proof of the matters asserted therein. In other words, if an author wrote that Plaintiff is an internationally renowned resort, it does not mean that Plaintiff is an internationally renowned resort; rather it means that the author described Plaintiff as an internationally renowned resort and that is what the readers of the article read.

<sup>35</sup> 37 TTABVue 3.

<sup>36</sup> 37 TTABVue 9.

sort of complete spa experience that is only available at a few places around the country.<sup>37</sup>

- d. *New York Observer*, “Great Escapes” (November 11, 1996)

**Canyon Ranch is an internationally renowned resort** dedicated to healthy living.<sup>38</sup>

- e. *Casino Player*, “Best of Gaming 2000” (July 2000)

Best Heath Spa ... **Canyon Ranch, easily on of the most famous names in spas**, has been named ‘Best Spa’ by readers of *Condé Nast Traveler* magazine seven times, and **is recognized the world over as a premier destination** for health and well-being. ... **It is quite simply, in a league of its own.**<sup>39</sup>

- f. *USA Today*, “Famous Health Spas of the United States”  
(December 17, 2013)

Spa Magazine named Canyon Ranch its Favorite Medical/Wellness Spa in 2009, and in 2008 Conde Nast Traveler ranked it number two among destination spas. Founded in 1979 at the Double U Ranch in Tucson, by 1980 Time magazine had named it America’s ‘first vacation fitness resort.’<sup>40</sup>

- g. WebMd.com, “Eating Healthier the Canyon Ranch Spa Way”  
(December 17, 2013)

The top chef for **the world-famous Canyon Ranch** chain of spas offers tips for eating and living well.<sup>41</sup>

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<sup>37</sup> 37 TTABVue 25.

<sup>38</sup> 37 TTABVue 38.

<sup>39</sup> 37 TTABVue 426

<sup>40</sup> 37 TTABVue 267.

<sup>41</sup> 37 TTABVue 261.

- h. Boston Globe, “Attention, passengers: The sky’s the limit”  
(October 20, 2013)

Speaking of healthy cooking, Canyon Ranch operates spas on ships for the Oceania Cruises ... and Regent Seven Seas lines ... as well as Cunard’s Queen Mary 2 ... They bring **the famous Canyon Ranch cuisine** – health conscious gourmet food that tastes great – to the seas, an alternative to the buffet line.<sup>42</sup>

and

- i. *Obesity, Fitness & Wellness Week*, “The Homestead And Canyon Ranch Partner To Launch Canyon Ranch SpaClub At The Homestead In Hot Springs, Virginia” (October 13, 2012)

Canyon Ranch SpaClub at The Homestead will combine the finest attributes of the birthplace of southern hospitality and the pioneer of the wellness lifestyle. **A rich sampling of the service that has made Canyon Ranch among the most-renowned names in the spa industry** will now be available to guests of The Homestead.”<sup>43</sup>

3. Plaintiff has received unsolicited media attention in newspapers (*e.g.*, *New York Times*, *Los Angeles Times*, *USA Today*), national magazines (*e.g.*, *Time*, *Men’s Fitness*, *Elle*), broadcast media (*e.g.*, *The Oprah Winfrey Show*, *The Rosie O’Donnell Show*, *the Martha Stewart Show*), and it is often mentioned in connection

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<sup>42</sup> 37 TTABVue 258-259.

<sup>43</sup> 37 TTABVue 249.

with celebrities (e.g., Julia Roberts, Donna Karan, Eva Longoria). The following examples are representative:<sup>44</sup>

- a. *Fashion*, “Rock-A-Bye Baby” (September 2009)

So when I get invited to a sleep-themed Rest & Rejuvenate week at the luxury Canyon Ranch health resort in Tucson, Arizona, I can hardly believe my exhausted little ears. The Ranch is going to save me!<sup>45</sup>

- b. *USA Today*, “Resorts to keep people thin are in” (September 6, 1984), cover story about Plaintiff;<sup>46</sup>

- c. *Vogue*, “For the best in old-world pampering, New Age techniques, tennis, golf, hiking, and more, Wendy Schmid looks at some top spas stateside (December 1994), reviews Plaintiff’s services;<sup>47</sup>

- d. *New York Times*, “TV Sports; Rivers and Michaels Shows Pistons-Like Poise” (June 18, 2004)

[Doc] Rivers and Al Michaels, calling the [NBA] finals for ABC Sports, worked as if they had been a team for six years, not six months. Had they

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<sup>44</sup> Cohen Affidavit ¶¶4-10, 12, 17, 18, 21 -30 (39 TTABVue 4 – 20), Cohen Exhibits A (40 TTABVue), D (41 TTABVue 38-71), E (41 TTABVue 73-163), F (37 TTABVue 2-269), G (37 TTABVue 271-455), H (35 TTABVue 2-148), I (35 TTABVue 150-208), J (35 TTABVue 210-276), L (36 TTABVue 8-20), M (36 TTABVue 22-74), N (36 TTABVue 76- 198), O (33 TTABVue 2-20), Q (33 TTABVue 25-198), R (34 TTABVue 2-6), T (34 TTABVue 16-119), and U (34 TTABVue 121-205).

<sup>45</sup> 40 TTABVue 13.

<sup>46</sup> 40 TTABVue 20.

<sup>47</sup> 40 TTABVue 32.

bonded by exfoliating and taking tandem herbal wraps at the Canyon Ranch?<sup>48</sup>

- e. *Martha upclose & personal* (themarthablog.com) (March 12, 2006)

Canyon Ranch in Arizona

After presenting my speech in Vancouver, I had the inviting pleasure of spending a couple of days at Canyon Ranch in Tucson, AZ. If you're a regular viewer of my television show, you might remember when Dr. Richard Carmona, former United States Surgeon General and now Vice Chairman of the Canyon Ranch was recently a guest. On that episode, everyone in the audience was given 3 days at Canyon Ranch in our attempt to make this their healthiest year ever.<sup>49</sup>

- f. *Access Hollywood* (accesshollywood.com) Plaintiff's chef Scott Uehlein appears in several segments of the television show discussing a healthy diet;<sup>50</sup>

- g. *CNBC: Hardball with Chris Matthews* (transcript) (April 3, 2013), in a discussion with Andrea Mitchell and Howard Fineman, editorial director of the HuffingtonPost Media Group, Chris Matthews says the following:

Hillary Clinton, I thought, should just take a breather. No more awards, no more ceremonies, go to the Canyon Ranch, someplace, and just do what we'd all like to do – we'd all like to do – and we

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<sup>48</sup> 36 TTABVue 23.

<sup>49</sup> 36 TTABVue 25.

<sup>50</sup> 36 TTABVue 47-49.

could all use, just get the wrinkles out, relax, stop worrying, stop sweating.<sup>51</sup>

- h. *W Magazine*, WEYE (April 1995)

SUZY

Alfred's Big Bash • Brad's Savannah Pitt Stop •  
Gianni's New York Digs

*Among those seen slimming down at Canyon Ranch, fat farm to the rich and famous, were Mike Myers and Christian Slater.*

Canyon Ranch, fat farm to the rich and famous, is known for playing host to Hollywood types. Among those seen slimming down recently were pals Mike Myers and Christian Slater.<sup>52</sup>

and

- i. Milwaukee Courier, "Ragenia Graham-Bacon chosen as Oprah's 'Great Mom' winner," (March 27, 1999)

Ragenia was the February winner to Oprah's "Great Moms Getaway." There will be five monthly winners, January to May, selected by a judging panel from thousands of submissions. ... Winners and a companion will be treated to a stay at Canyon Ranch Spa in Tucson, Arizona.<sup>53</sup>

4. With some writers, Plaintiff's service mark has become synonymous with luxury as shown below:<sup>54</sup>

- a. *Boston Herald*, "Inside Track" (September 8, 1993)

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<sup>51</sup> 36 TTABVue 50 at 57.

<sup>52</sup> 36 TTABVue 86.

<sup>53</sup> 36 TTABVue 20.

<sup>54</sup> Cohen Affidavit ¶20 (39 TTABVue 13), Exhibit L (36 TTABVue 8-20).

Clean Living In The Woods

Speaking of Aerosmith, as we're wont to do, the band's clean living ways must be contagious. Backstage at the Walden Woods benefit resembled a Canyon Ranch reunion rather than a rock star retreat.

What happened to sex, drugs and rock 'n' roll?<sup>55</sup>

- b. *Arizona Daily Star* (September 8, 1993), *Tampa Bay Tribune and Times* (August 22, 1993) and *Cleveland Plain Dealer* (August 19, 1993)

"T-shirt tastes change, but lure of the exotic doesn't"

Sam Gerber of Alpha Shirt Co., a Philadelphia shirt distributor says putting Tucson's "Canyon Ranch" on a T-shirt has the equivalent appeal to writing the word "Polo" on one.<sup>56</sup>

- c. *Record Journal* (Meridian, Connecticut), "Expensive baby talk" (July 25, 1995)

It's been estimated that the insurance companies save \$4 billion annually for every day the slice off the average maternity stay. Maternity hospital costs now average \$1,000 per day. We can imagine most new mothers would rather spend that at Canyon Ranch.<sup>57</sup>

- d. *People*, "Behind the scenes with TV's new castaways. Who Will Survive?" (February 5, 2001)

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<sup>55</sup> 36 TTABVue 8.

<sup>56</sup> 36 TTABVue 9.

<sup>57</sup> 36 TTABVue 11.

Half an hour away by dirt road, the production crew's camp seems as luxe as the Canyon Ranch spa.<sup>58</sup>

and

d. *The Boston Globe*, "Spa vs. spa" (January 6, 2002)

Canyon Ranch. Just those two words side by side are balm to a woman's weary sole.

Stress is what's ailing ...

What I need is Canyon Ranch.<sup>59</sup>

5. Plaintiff entered partnerships with several cruise lines, including Cunard, Oceania Cruises, and Regent Seas, to offer spa and fitness services to guests onboard the ships.<sup>60</sup> The cruise companies promote the CANYON RANCH spa services to their guests and potential guests through their marketing efforts, thereby increasing the universe of potential customers for Plaintiff.<sup>61</sup>

6. "In its nearly 35 years of existence, [Plaintiff] has spent millions of dollars in advertising and marketing its CANYON RANCH® marks and the products and services offered that mark."<sup>62</sup>

In view of the foregoing, we find that for purposes of the likelihood of confusion analysis, Plaintiff's mark is famous for "health resort services, namely,

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<sup>58</sup> 36 TTABVue 12.

<sup>59</sup> 36 TTABVue 15.

<sup>60</sup> Cohen Affidavit ¶13 (39 TTABVue 13).

<sup>61</sup> Cohen Affidavit ¶¶15 and 16 (39 TTABVue 10-11), Exhibit H (35 TTABVue 2-148).

<sup>62</sup> Cohen Affidavit ¶31 (39 TTABVue 20).

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providing food and lodging that specialize in promoting patrons' general health and well-being.”

While having established that Plaintiff's mark is famous for purposes of likelihood of confusion, this fact alone is not enough to prove likelihood of confusion. As the Board explained in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), *rev'd on other grounds*, Civil Action No. 05-2037 (D.D.C. April 3, 2008):

If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

The fame of the [plaintiff's] name is insufficient in itself to establish likelihood of confusion under § 2(d). “Likely\* \* \* to cause confusion” means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC § 1052(d).

*See also Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“fame alone cannot overwhelm the other du Pont factors as a matter of law”).

B The similarity or dissimilarity and nature of the services, established, likely-to-continue channels of trade and classes of consumers.

1. Class 43.

Defendant is seeking to register its mark for the following services in Class 43 (emphasis added):

Providing temporary accommodations in the nature of a guest ranch, dude ranch, cabin and **resort lodging accommodations**, and authentic tipi accommodations; **restaurants** and bars.

Plaintiff has registered its mark for the following services in Class 43 (emphasis added):

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 (Registration No. 3202993); and

Fitness resort and **restaurant services** (Registration No. 1350012).

Under this *du Pont* factor, Plaintiff need not prove, and we need not find, similarity as to each and every activity listed in the Class 43 recitation of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the recitation of services in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Both parties render resort lodging and restaurant services. Therefore, the services are in part identical. Because the services described in the application and Plaintiff's pleaded registrations are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Yawata Iron &*

*Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

2. Class 41.

Defendant has registered its mark and is seeking to register its mark for the following services in Class 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.

Plaintiff has registered its mark for the following services in Class 41:

Conducting programs in exercise and physical conditioning (Registration No. 1350012); and

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 (Registration No. 3178367).

Plaintiff's programs in exercise and physical conditioning, physical fitness and physical training are broad enough to encompass hiking and mountain biking. In fact, Plaintiff has offered hiking and biking under the CANYON RANCH mark since 1979.<sup>63</sup> *See also*,

1. *Cosmopolitan*, "Spas for the Cosmo Girl" (November 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.<sup>64</sup>

2. *The Walking Magazine*, "Health Spas and Hiking" (July/August 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.<sup>65</sup>

3. *Investor's Business Daily*, "Scenic Views May Be A Short Hike Away

(May 30, 1995)

Massachusetts: At Canyon Ranch in the Berkshires, staff-guided "Hiking Weeks" will be held June 11-16.<sup>66</sup>

4. *Ladies' Home Journal*, "Walking: The Anytime, Anywhere Exercise"

(May 1996)

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<sup>63</sup> Cohen Affidavit ¶129 (39 TTABVue 18).

<sup>64</sup> 34 TTABVue 16.

<sup>65</sup> 34 TTABVue 23.

<sup>66</sup> 34 TTABVue 26.

The most popular activities at Canyon Ranch are walking and hiking – and the reason isn't only to explore the beauty of the Arizona desert. ...

On the following pages, Canyon Ranch's guidelines for a walking program that will shape up and slim down.<sup>67</sup>

5. *Elle*, "Spa Review: Canyon Ranch, east & west" (April 1996)

At both locations, the hiking is amazing. Tennis, mountain biking, and swimming are also incredible; during the winter in the Berkshires, cross-country skiing and snowshoeing are wonderful.<sup>68</sup>

Accordingly, Plaintiff's Class 41 services and Defendant's Class 41 services are in part legally identical. Because the Class 41 services are in part legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Yawata Iron & Steel Co.*, 159 USPQ at 723; *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d at 1028.

3. Class 39.

Defendant has registered its mark and is seeking to register its mark for the following services in Class 39:

Excursion arrangements for tourists.<sup>69</sup>

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<sup>67</sup> 34 TTABVue 32.

<sup>68</sup> 34 TTABVue 198.

<sup>69</sup> The word "excursion" is defined as "a short trip or outing to some place, usually for a special purpose and with the intention of a prompt return." Dictionary.com based on the **RANDOM HOUSE DICTIONARY** (2014). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Plaintiff has registered its mark for “transportation of passengers by means of automobile and reservation services for transportation” (Registration No. 158938).

Plaintiff’s “transportation of passengers by means of automobile and reservation services for transportation” is broad enough to encompass “excursion arrangements for tourists.” In addition, Mr. Cohen testified that Plaintiff “also arrange[s] for excursions for guests, including cross-country skiing, snowshoeing, canoeing, kayaking, golf, tennis, hiking and surfing depending on the resort.”<sup>70</sup> *See also,*

1. Canyon Ranch “Outdoor Sports: Hiking, Biking & High Ropes Adventure” brochure (undated) advertising Plaintiff’s hiking and biking activities at remote locations such as Sabino Canyon, Mt. Lemmon, and Agua Caliente Park.<sup>71</sup>

2. Canyon Ranch website (canyonranch.com) (undated) advertising Plaintiff’s Golf Performance Center that includes “rounds of golf at nearby Ventana Canyon.”<sup>72</sup>

3. Canyon Ranch website (canyonranch.com) (undated) advertising offsite outdoor activities at its Miami Beach location, including golf (“tee off at one of Miami Beach’s world-class golf courses), tennis (“Canyon Ranch arranges tennis activities for groups or individuals on clay or hard-floor courts throughout the city”),

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<sup>70</sup> Cohen Affidavit ¶30 (39 TTABVue 19).

<sup>71</sup> 34 TTABVue 143-156.

<sup>72</sup> 34 TTABVue 160-163.

kayaking (“Guided kayak tours, private or group tours, full-moon excursions and special events”), and surfing.<sup>73</sup>

4. *Allure*, “Vacation Spas” (December 1994)

Arizona

Canyon Ranch

... and hikes through the southwestern wilderness (ask for assistant hiking director Mark Black) make feasting at the pasta bar at night guilt free.<sup>74</sup>

5. The Senior Advocate, “Pamper yourself to good health at Canyon Ranch” (September 26, 1996)

Every morning at 7, a walk is offered. My companions and I went on a two-hour long hike to a nearby Audubon sanctuary filled with beaver ponds.<sup>75</sup>

In view of the foregoing, we find that the Plaintiff’s Class 39 services and Defendant’s Class 39 services are in part identical and, therefore, move in the same channels of trade and are offered to the same classes of customers.

- C. The number and nature of similar marks in use in connection with similar services.

With the exception of Defendant’s use of GRAND CANYON RANCH, there is no evidence that there are any other users of CANYON RANCH

- D. The nature and extent of any actual confusion.

We note that the issue is likelihood of confusion, not actual confusion. Nevertheless, the absence of any reported instances of confusion is meaningful if

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<sup>73</sup> 34 TTABVue 183.

<sup>74</sup> 34 TTABVue 191-192.

<sup>75</sup> 34 TTABVue 199-200.

the record indicates appreciable and continuous use by Defendant of its mark for a significant period of time in the same markets as those served by Plaintiff under its mark. *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Id.*; *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

As noted above, Defendant did not introduce any testimony or evidence to support a date of first use of its marks. Accordingly, the earliest date of first use on which Defendant may rely is the filing date of its applications (January 5, 2010) for both the pending application and the registration. In its advertising brochure, Defendant’s GRAND CANYON RANCH is referenced in an excerpt from the *Las Vegas Review-Journal* (March 2010).<sup>76</sup> In addition, Defendant’s GRAND CANYON

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<sup>76</sup> Turner Affidavit, Exhibit 7 (45 TTABVue 181). We did not consider the excerpts from foreign publications because there is no evidence that they are read by consumers in the United States.

RANCH services are promoted by Heli USA, a company that offers helicopter tours of the Grand Canyon and other scenic venues.<sup>77</sup> There is no other evidence regarding the extent of Defendant's advertising.

As noted above, Plaintiff has received significant media attention. In addition,

[Plaintiff] has advertised its CANYON RANCH® in a broad range of media, including newspapers, trade journals[,] the internet and broadcast media. In its nearly 35 years of existence, [Plaintiff] has spent millions of dollars in advertising and marketing its CANYON RANCH® marks and the products and services offered under the mark.<sup>78</sup>

Finally, Plaintiff argues that “the parties’ goods [sic] are in fact offered in the same channels of trade and the same consumers” and that its “original flagship resort” is located in Arizona.<sup>79</sup>

In fact, both the CANYON RANCH property and [Defendant's] 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.<sup>80</sup>

Despite the presumption of identical channels of trade and classes of consumers, and the close locations, from at least as early of the filing date of Defendant's applications (January 5, 2010) until the close of testimony (April 24,

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<sup>77</sup> Turner Affidavit ¶¶6 and 7, Exhibits 2-7 (45 TTABVUE 34-35 and 57 – 185). Most of the advertising submitted introduced by Defendant reference GRAND CANYON WEST RANCH, not GRAND CANYON RANCH.

<sup>78</sup> Cohen Affidavit ¶31 (39 TTABVue 20).

<sup>79</sup> Plaintiff's Brief, p. 31-32 (38 TTABVue 37-38).

<sup>80</sup> Plaintiff's Brief, p. 32 (38 TTABVue 38).

2014), there has been at least four years of contemporaneous use of the marks GRAND CANYON RANCH and design and CANYON RANCH without any reported instances of confusion. However as noted above, there is very little evidence regarding the extent of Defendant's advertising and, therefore, the opportunity for confusion to have occurred is somewhat speculative.

In view thereof, this factor weighs slightly in Defendant's favor.

E. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E.I. du Pont De Nemours & Co.*, 177 USPQ at 567. Each of these characteristics of a mark must be considered. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (appearance, sound, meaning and commercial impression are separate factors bearing on the ultimate conclusion of whether marks are, overall, similar). The similarity of the marks in regard to one of these factors can be critical to a finding of similarity. *See TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997) (phonetic similarity may be critical when goods are advertised via radio or when business is done by telephone); *see also In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark"); *but see Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801 (TTAB 1991) ("the

principle that similarity between marks in meaning or commercial significance alone may be sufficient to create a likelihood of confusion is applicable primarily to situations where marks are coined or arbitrary rather than highly suggestive.”) However, the law does not counsel that similarity in one factor alone automatically results in a finding that the marks are similar. *See Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1609 (TTAB 2010), *aff’d* 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

In comparing the marks, we are mindful that where, as here, the services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (citation omitted). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants*

*Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. June 5, 1992).

We note that in the case of marks such as Defendant's marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).<sup>81</sup> In addition, even though the term "Grand Canyon Ranch" is merely descriptive and has been disclaimed, it is the most dominant element of Defendant's marks.<sup>82</sup>

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<sup>81</sup> Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751. We focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

<sup>82</sup> In the GRAND CANYON RANCH AT SPIRIT MOUNTAIN and design mark, the term "AT SPIRIT MOUNTAIN" is primarily geographically descriptive and it is in a much smaller font than GRAND CANYON RANCH. Thus, GRAND CANYON RANCH is the dominant element of that mark.

Defendant's advertising featuring only the word portion of its marks demonstrates the importance of that portion of the marks. For example,

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**Grand Canyon Ranch**  
**Adventure by SUV - 4 for 1**

84

**NEW – IN DEVELOPMENT:**  
**GRAND CANYON RANCH**  
**SPA TREATMENTS**

85



**Grand Canyon Ranch**<sup>TM</sup>  
**Overnight Accommodations**  
Capture the spirit of the American West as you enjoy the  
solitude of a Genuine Pine Cabin or Authentic Indian Tipi

*Cf. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283-84 (Fed. Cir. 1984) (trade dress may provide evidence regarding the commercial impression that a mark projects).

The crux of the issue is whether Defendant's addition of the word "Grand" to "Canyon" to form the term "Grand Canyon," "one of the world's most renowned

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<sup>83</sup> Turner Affidavit Exhibit 2 (45 TTABVue 67).

<sup>84</sup> Turner Affidavit Exhibit 3 (45 TTABVue 97).

<sup>85</sup> Turner Affidavit Exhibit 7 (45 TTABVue 165).

scenic wonders,”<sup>86</sup> in addition to the design elements of Defendant’s marks, are sufficient to distinguish the appearance, sound, meaning and commercial impression of Defendant’s marks comprising the term “Grand Canyon Ranch” from Plaintiff’s mark “Canyon Ranch.”

In considering connotation and overall commercial impression, we consider the nature of the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1609 (TTAB 2010), *aff’d* 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012) (“Plaintiff’s COACH mark, when applied to fashion accessories is clearly either arbitrary or suggestive of carriage or travel accommodations (e.g., stagecoach, train, motor coach, etc.) thereby engendering the commercial impression of a traveling bag (e.g., a coach or carriage bag). On the other hand, Defendant’s COACH marks call to mind a tutor who prepares a student for an examination.”). Unlike *Coach*, the services in these proceedings are in part identical. When we consider the fame of Plaintiff’s mark and the lack of any other third-party users of the term “Canyon Ranch,” we find that a consumer familiar with Plaintiff’s CANYON RANCH in Tucson, Arizona for resort services, upon seeing the GRAND CANYON RANCH for the identical services, could mistakenly believe that Plaintiff has opened a new location at the Grand Canyon. This consumer would mistakenly believe that the

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<sup>86</sup> “Grand Canyon National Park,” **ENCYCLOPAEDIA BRITANNICA** (2014). The Board may take judicial notice of information printed in encyclopedias. *See Productos Lateos Tocombo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011). *See also B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).

identical services originate from or are associated with or sponsored by the same entity.

Accordingly, we find that the similarities of the marks outweigh the dissimilarities.

F. Balancing the factors.

Because Plaintiff's mark is famous, the identity of the services, the presumption that the channels of trade and classes of consumers are the same, the lack of any third-party users, and the similarities of the marks, we find that Defendant's GRAND CANYON RANCH and design marks are likely to cause confusion with Plaintiff's CANYON RANCH mark.

This is a close case. However, our primary reviewing court has cautioned that there is "no excuse for even approaching the well-known trademark of a competitor." *Kenner Parker Toys, Inc., Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Thus, the 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. For this reason, this court emphasizes:

When a Plaintiff's trademark is a strong, famous mark, it can never be "of little consequence". The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

[*Specialty Brands*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984)]; *see also B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 730, 6 USPQ2d 1719, 1722 (Fed.

Cir. 1988) (Nies, J. now C.J., dissenting) (“a purchaser is less likely to perceive differences from a famous mark.”) (emphasis in original). In accord with the same principles, this court states:

[T]here is “no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous. . . .”

[*Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989)] (quoting [*Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)]).

*Id.* at 1456.

While this conclusion is not without doubt, any doubt must be resolved in favor of the prior registrant. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (“This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and the obligation to avoid confusion with existing marks.”); *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 134 USPQ at 511 (“all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer”). A “strong mark . . . casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ2d at 1456).

Because we have found that Defendant’s marks are likely to cause confusion with Plaintiff’s mark, we do not decide the dilution by blurring or tarnishment claims.

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**Decision:** The opposition is sustained and registration to Defendant is refused.

The petition for cancellation is granted and Defendant's registration will be cancelled in due course.