

ESTTA Tracking number: **ESTTA656057**

Filing date: **02/16/2015**

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

Notice of Opposition

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

Opposer Information

Name	Renaissance Hotel Holdings, Inc.
Granted to Date of previous extension	02/18/2015
Address	10400 Fernwood Road Bethesda, MD 20817 UNITED STATES
Attorney information	Paul F. Kilmer HOLLAND & KNIGHT LLP 800 17th Street, NW Suite 1100 Washington, DC 20006 UNITED STATES paul.kilmer@hklaw.com, ptcketing@hklaw.com, laurie.milton@hklaw.com Phone:2029553000

Applicant Information

Application No	79148136	Publication date	10/21/2014
Opposition Filing Date	02/16/2015	Opposition Period Ends	02/18/2015
International Registration No.	1206141	International Registration Date	04/16/2014
Applicant	GLA Head Office 2-18-3, Kaminarimon JAPAN		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Organization and presentation of movies, shows, and plays; presentation of liveshow performances; direction or presentation of plays; presentation of musical performance; educational and instructionservices in the nature of classes and seminars relating to arts, crafts, sportsand general interest knowledge; arranging, conducting and organization of seminars and symposiums; book rental; rental of image-recorded magnetic tapes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1870198	Application Date	02/14/1994
Registration Date	12/27/1994	Foreign Priority Date	NONE
Word Mark	RENAISSANCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 restaurant and night club services		

U.S. Registration No.	2098636	Application Date	09/25/1995
Registration Date	09/23/1997	Foreign Priority Date	NONE
Word Mark	RENAISSANCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 providing facilities for business meetings; providing convention facilities; operation of businesses for others, namely, operation of hotels, resorts, restaurants, night clubs; secretarial and word processing services; photocopying services; franchising, namely offering technical assistance in the establishment and/or operation of hotels, resorts, restaurants, night clubs</p> <p>Class 037. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 real estate development; real estate site selection</p> <p>Class 038. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 facsimile and data transmission services</p> <p>Class 039. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 ground transportation services, namely, bicycle rental, [motorcycle rental,] car rental, and ground transportation of passengers by car, limousine, van or bus</p> <p>Class 041. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 golf club services; health club services; rental of skin diving equipment [; casino services]</p> <p>Class 042. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22 providing general purpose facilities for exhibitions; health resorts; health spas; banquet and social function facilities for special occasions; hotel concierge services; making hotel reservations for others; hotel services for preferred customers; resort hotels; night clubs; rental of rooms; travel agency services, namely, making reservations and booking for temporary lodging</p>		

U.S. Registration No.	1714479	Application Date	09/20/1991
Registration Date	09/08/1992	Foreign Priority Date	NONE
Word Mark	RENAISSANCE CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00		

	hotel and restaurant services		
U.S. Registration No.	3874452	Application Date	07/14/2009
Registration Date	11/09/2010	Foreign Priority Date	NONE
Word Mark	R RENAISSANCE		
Design Mark			
Description of Mark	The mark consists of a stylized "R" above the word "Renaissance".		
Goods/Services	Class 043. First use: First Use: 2009/09/17 First Use In Commerce: 2009/09/17 Hotel services, restaurant, catering, bar and cocktail lounge services; resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation servicesfor hotel accommodations for others		
U.S. Registration No.	4551339	Application Date	10/31/2013
Registration Date	06/17/2014	Foreign Priority Date	NONE
Word Mark	RENAISSANCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1981/03/22 First Use In Commerce: 1981/03/22		

	Providing facilities for business meetings; providing convention facilities for business purposes; operation of businesses for others, namely, operation of hotels, resorts, restaurants, night clubs, bars, spas, recreational and fitness facilities and retail stores; business center services, namely, providing facilities for the use of office equipment and machinery; franchising, namely, offering business management assistance in the establishment and/or operation of hotels, resorts, restaurants, night clubs, bars, spas, recreational and fitness facilities and retail stores; catalog ordering and online retail store services featuring apparel, household goods, linens, bedding products, towels, interior furnishings and personal care products; retail store services, namely, gift shop, souvenir and convenience store services
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U.S. Registration No.	3075544	Application Date	10/27/2003
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	RENAISSANCE HOTELS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2003/06/01 First Use In Commerce: 2003/06/01 Health club services, namely providing instruction and consultation in the field of physical exercise; providing use of exercise equipment; providing fitness and exercise facilities; golf club, golf course and golf instruction services</p> <p>Class 043. First use: First Use: 2003/06/01 First Use In Commerce: 2003/06/01 Hotel services; restaurant, catering, bar and lounge services; resort and lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations</p> <p>Class 044. First use: First Use: 2003/06/01 First Use In Commerce: 2003/06/01 Health spa services, namely, providing facial, hair, skin and body treatments, manicure and pedicure services, massage services, body waxing services and beauty salon services</p>		

U.S. Registration No.	3002828	Application Date	01/30/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	UNIQUELY RENAISSANCE		

Design Mark	<h1>UNIQUELY RENAISSANCE</h1>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2004/02/02 First Use In Commerce: 2004/02/02 hotel services; restaurant, catering, bar and lounge services; resort and lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others		

U.S. Registration No.	4475612	Application Date	12/15/2011
Registration Date	01/28/2014	Foreign Priority Date	NONE

Word Mark	RENAISSANCE HOTELS SIGNATURE COLLECTION		
Design Mark	<h1>RENAISSANCE HOTELS SIGNATURE COLLECTION</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2010/11/00 First Use In Commerce: 2010/11/00 Beverage programs, namely, providing advisory services relating to business management and business operations of bars, restaurants and hotels concerning the selection and promotion of alcoholic beverages and cocktails		

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Certificate of Service

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

Signature	/Paul Kilmer/
Name	Paul F. Kilmer
Date	02/16/2015

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

RENAISSANCE HOTEL HOLDINGS, INC.)	
)	
Opposer)	
)	
v.)	Opp. No. _____
)	
)	(Serial No. 79148136)
GLA Head Office)	
)	
Applicant)	
_____)	

NOTICE OF OPPOSITION

Renaissance Hotel Holdings, Inc. ("Opposer"), a corporation organized and existing under the laws of the State of Delaware, with its principal place of business located at 10400 Fernwood Road, Bethesda, MD 20817, believes that it will be damaged by the registration of the mark GLA RENAISSANCE ART THEATER (sometimes: "Applicant's Mark") claimed in Application Serial No. 79148136 (the "Application") of GLA Head Office ("Applicant") of 2-18-3, Kaminarimon Taito-ku; Tokyo 111-0034, Japan, with a priority date of April 1, 2014, and published in the Official Gazette of October 21, 2014, and hereby opposes registration of same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

On or about November 5, 2014, Opposer timely filed a request for a ninety (90) day extension of time to oppose the subject Application, which was granted by the Trademark Trial and Appeal Board on that same day (expiring February 18, 2015).

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the well-known and famous trademark, service mark and trade name RENAISSANCE, which Opposer and its predecessors in interest (collectively hereinafter "Opposer") have used since at least as early as 1981 in connection with hotel, restaurant, entertainment and educational services, including organization and presentation of entertainment and educational events, such as musical performances and educational seminars and conferences, and sporting and cultural activities, such as health and fitness centers and instruction, sporting facilities, and organizing culinary and arts events, as well as other goods and services, including relevant services in Class 41.

2. In connection with its goods and services, Opposer has used a family of trademarks and names that prominently feature the designation RENAISSANCE, both alone and in combination with other word and design elements (collectively, the "RENAISSANCE Marks"), including the marks RENAISSANCE, COLLECTRENAISSANCE, RENAISSANCE CLUB, UNIQUELY RENAISSANCE, RENAISSANCE HOTELS, R RENAISSANCE, RENAISSANCE CLUBSPORT, and others.

3. Opposer is the owner of the following U.S. trademark and service mark registrations, among others, all of which are valid and subsisting:

Mark	Goods and Services	Registration No.
RENAISSANCE	Restaurant and night club services	1870198
RENAISSANCE	<i>Inter alia:</i> Providing facilities for business meetings; providing convention facilities; operation of businesses for others, namely, operation of hotels, resorts, restaurants, night clubs; providing general purpose facilities for exhibitions; banquet and social function facilities for special occasions; night clubs	2098636
RENAISSANCE CLUB	Hotel and restaurant services	1714479
R RENAISSANCE	Hotel services, restaurant, catering, bar and cocktail lounge services	3874452
RENAISSANCE	<i>Inter alia:</i> Providing facilities for business meetings; providing convention facilities for business purposes; operation of businesses for others, namely, operation of hotels, resorts, restaurants, night clubs, bars, spas, recreational and fitness facilities and retail stores	4551339
RENAISSANCE HOTELS	<i>Inter alia:</i> bar and lounge services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions	3075544
UNIQUELY RENAISSANCE	<i>Inter alia:</i> bar and lounge services; resort and lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions	3002828

RENAISSANCE HOTELS SIGNATURE COLLECTION	Beverage programs, namely, providing advisory services relating to business management and business operations of bars, restaurants and hotels concerning the selection and promotion of alcoholic beverages and cocktails.	4475612
R RENAISSANCE	Hotel services, restaurant, catering, bar and cocktail lounge services; resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others	3874452

4. Opposer's registrations listed above provide evidence of Opposer's ownership of the RENAISSANCE Marks, of the validity of those marks, and of Opposer's exclusive right to use those marks in commerce in connection with the goods and services identified in Opposer's registrations.

5. Opposer has used and is using its RENAISSANCE Marks and names, including various composites thereof, for the services set for in the registrations found on the chart in paragraph 3 of this Notice of Opposition, above.

6. Opposer's RENAISSANCE Marks have been continuously and extensively used, advertised and promoted in interstate commerce in connection with relevant Class 41 services and related services from a date long prior to April 1, 2014, priority date of Applicant's Application hereby opposed.

7. As a result of Opposer's widespread use, advertising, and promotion of its RENAISSANCE Marks in connection with relevant Class 41 services and related services, such marks and names have become well-known and famous as distinctive indicators of the origin of Opposer's services, and Opposer's RENAISSANCE Marks have acquired a highly favorable reputation among relevant members of the purchasing public and have become valuable symbols of Opposer's goodwill.

8. Notwithstanding Opposer's prior rights in the RENAISSANCE Marks, on April 16, 2014, Applicant filed the Application in the United States Patent and Trademark Office for registration of the Applicant's Mark (GLA RENAISSANCE ART THEATER) for "Organization and presentation of movies, shows, and plays; presentation of live show performances; direction or presentation of plays; presentation of musical performance; educational and instruction services in the nature of classes and seminars relating to arts, crafts, sports and general interest knowledge; arranging, conducting and organization of seminars and symposiums; book rental; rental of image-recorded magnetic tapes" in International Class 41 (collectively "Applicant's Services").

9. On information and belief, Applicant knew or had reason to know of Opposer's prior rights in the RENAISSANCE Marks when Applicant filed the Application.

10. Opposer's RENAISSANCE Marks are famous and became famous long prior Applicant's priority date (April 1, 2014) or any date on which Applicant may

have commenced use of its GLA RENAISSANCE ART THEATER mark for Class 41 services.

COUNT I

Likelihood of Confusion - §2(d)

11. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 10, above, as if set forth in their entirety herein.

12. Applicant's Mark (GLA RENAISSANCE ART THEATER) so closely resembles the Opposer's RENAISSANCE Marks in appearance, sound and meaning that the use and registration thereof by Applicant for Applicant's Services are likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's RENAISSANCE Marks.

13. Applicant's Services, if offered under or by reference to Applicant's Mark, are so closely related to services provided by Opposer under and by reference to the RENAISSANCE Marks, including especially Opposer's relevant Class 41 and related services, that consumers and others are likely to be confused, to be deceived, and to assume erroneously that Applicant's Services are those of Opposer or that Applicant is in some way connected with, sponsored by or affiliated with Opposer, all to Opposer's irreparable damage and injury.

14. Likelihood of confusion in this case is enhanced by the fame of Opposer's RENAISSANCE Marks and by the fact that the Applicant's Services are competitive with or closely related to certain of the Class 41 and related services

provided by Opposer under and by reference to its RENAISSANCE Marks, including those set forth in paragraph 3, above.

15. Likelihood of confusion, mistake and deception is enhanced by the fact that certain of Opposer's services offered under and by reference to the RENAISSANCE Marks are offered, provided or intended to be provided to the same classes of prospective customers as are Applicant's Services claimed in the Application, including those Class 41 and related services claimed in Opposer's registrations as set forth in paragraph 3, above.

16. Under the circumstances, registration of the Applicant's Mark is likely to cause Opposer to lose control over the good and valuable reputation represented by and derived from the RENAISSANCE Marks.

17. Registration of the Applicant's Mark, in light of the prior rights of Opposer in its RENAISSANCE Marks, is therefore likely to cause confusion, mistake and/or deception among members of the relevant purchasing public, resulting in damage and injury to Opposer in violation of the provisions of Section 2(d) of the Trademark Act. 15 U.S.C. §1052(d).

COUNT II

Dilution - §43(c)

18. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 17, above, as if set forth in their entirety herein.

19. Use or registration of the Applicant's Mark will cause dilution of the distinctive quality of the Opposer's famous RENAISSANCE Marks.

20. Use or registration of the Applicant's Mark will lessen the capacity of Opposer's famous RENAISSANCE Marks to identify and distinguish Opposer's goods and services from those of others.

21. Use or registration of the Applicant's Mark will deprive Opposer of the ability to protect its reputation, persona, and goodwill, and will tarnish the good and valuable reputation of Opposer and its famous RENAISSANCE Marks.

22. Likelihood of damage to Opposer's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's Services will attribute those defects to Opposer, and this will dilute by blurring and tarnishment Opposer's reputation and goodwill.

23. By reason of the foregoing, Opposer will be damaged by the registration of the Applicant's Mark and registration should be refused pursuant to the provisions of Section 43(c) of the Trademark Act. 15 U.S.C. §1125(c).

The required fee has been provided.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied to the Application.

RENAISSANCE HOTEL HOLDINGS, INC.

Date: 2/16/2015

By: Paul F. Kilmer 
Paul F. Kilmer
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Washington, D.C. 20006
(202) 663-7269
Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing NOTICE OF OPPOSITION was sent by first class mail, postage pre-paid, on this 16th day of February, 2015, to the following (counsel of record for Applicant): James A. Oliff, Oliff PLC, P. O. Box 320850, Alexandria, Virginia 22320-4850 .

Laurie C. Milton