I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on 6/5/03 Kevin J. McDevitt
Date Signature

Kevin J. McDevitt
Typed or printed name of person signing certificate

ATTORNEY DOCKET NO: 60141.0026

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

EXTENDED STAY AMERICA, INC.	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91155757
	)	
MATRIX LODGING, LLC	)	Ser. No. 78/061,351
	)	
Applicant	)	

COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, VA 22202-3514

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant Matrix Lodging, LLC ("Applicant") hereby answers Opposer Extended Stay America, Inc.'s ("Opposer") "Notice of Opposition" as follows:

Opposer, EXTENDED STAY AMERICA, INC., (hereinafter "Extended Stay" or "Opposer"), a Delaware corporation whose principal place of business is 101 N. Pine Street, Suite 200, Spartanburg, South Carolina 29302, believes that it is or will be damaged by Serial No. 78/061,351 (the "Application") filed by Matrix Lodging, LLC (hereinafter "Applicant") with the U.S. Patent and Trademark Office on May 1, 2001, for the trademark ESUITES HOTELS. The Application seeks federal registration of ESUITES HOTELS in connection with "hotel and motel services" in International Class 42. *See* Exhibit A. Extended Stay hereby opposes said Application.

ANSWER: Applicant admits that it filed an application for registration of the trademark ESUITES HOTELS "hotel and motel services" in International Class 42 and that said application was assigned Serial No. 78/061,351. Applicant denies that Opposer will be damaged by the aforementioned application. In addition, Applicant did not receive a copy of the alleged Exhibit A and, therefore denies that such Exhibit was included with the Notice of Opposition. Applicant lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations listed above and, therefore, denies same.

1. Extended Stay is the owner of a family of well known marks encompassing the lower case letter "e". These marks include the following registrations encompassing the distinctive lower case "e": Registration No. 2,113,800 for the mark EXTENDED STAYAMERICA EFFICIENCY STUDIOS E for "providing temporary housing accommodations services and hotel services," in Class 42; Registration No. 2,157,547 for EXTENDEDSTAYAMERICA EFFICIENCY STUDIOS E for "providing temporary housing accommodations services and hotel services," in Class 42. These marks also include the following with which the lower case "e" is often used: Registration No. 2,457,084 for EXTENDED STAY AMERICA for "providing temporary housing accommodations services and hotel services," in Class 42; Registration No. 2,021,504 for EXTENDED STAY AMERICA for "providing temporary housing accommodations," in Class 42; Registration No. 2,113,801 for EXTENDED STAYAMERICA EFFICIENCY STUDIOS for "providing temporary housing accommodations services and hotel services," in Class 42. *See* Exhibits B and C. The aforesaid Registrations are valid and subsisting, and owned by Extended Stay. Extended Stay owns all of the goodwill represented thereby.

ANSWER: Applicant did not receive a copy of the alleged Exhibits B and C and, therefore denies that such Exhibits were included with the Notice of Opposition. Applicant lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations set forth in Paragraph No. 1 and, therefore, denies same.

2. Since its first use of its "e" marks, Extended Stay has prominently and widely used its distinctive lower case "e" marks and has created a family of marks, expending significant sums in advertising and promoting its marks.

ANSWER: Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations set forth in Paragraph No. 2 and, therefore, denies same.

3. Since its initial use of the aforementioned trademarks, Extended Stay has extensively used, and has advertised, promoted and offered Extended Stay's services under its trademarks in interstate commerce, through various channels of trade. As a result, Extended Stay's customers and others have come to know and recognize Extended Stay's marks, particularly Extended Stay's lower case "e" marks and associate same with Extended Stay, and Extended Stay has thus built up extensive and invaluable goodwill in connection with the sale of its services under its marks.

ANSWER: Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations set forth in Paragraph No. 3 and, therefore, denies same.

4. Notwithstanding Extended Stay's long-prior rights in and to its aforementioned lower case "e" marks, on May 1, 2001, Applicant filed an application for registration of the trademark ESUITES HOTELS "hotel and motel services" in International Class 42. Said Application was assigned Serial No. 78/061,351. There is, therefore, no issue as to priority – Extended Stay enjoys prior rights.

ANSWER: Applicant admits that it filed an application for registration of the trademark ESUITES HOTELS "hotel and motel services" in International Class 42 on May 1, 2001 and that said application was assigned Serial No. 78/061,351. Applicant denies the remaining allegations set forth in Paragraph 4.

5. Applicant's ESUITES HOTELS trademark, as shown in Application No. 78/061,351, encompasses and covers a lower case "e" (as evidenced in part by use of the stylized lower case "e" in Applicant's companion trademark application Serial No. 76/105,518). *See* Exhibit D. Applicant's use of any lowercase "e" is confusingly similar to and a colorable imitation of Extended Stay's lower case "e" marks, and the respective services of the parties are identical and would normally be marketed within the same or similar channels of trade, and to the same class of customers, with the result that Extended Stay's customers, the trade and the public in general are likely to be confused, mistaken or deceived as to the origin and/or sponsorship of Applicant's services under the ESUITES HOTELS mark, and misled into believing that such services are marketed by, or are in some way directly or indirectly

associated with Extended Stay, thus resulting in damage and detriment to Extended Stay and its reputation and goodwill.

ANSWER: Applicant admits that it filed Application Serial Nos. 78/061, 351 and 76/105, 518. To the extent that Paragraph 5 attempts to define Applicant's ESUITES HOTELS trademark, Application Serial No. 78/061,351, or any rights or privileges associated therewith, Applicant states that the ESUITES HOTELS trademark, Application Serial Nos. 78/061,351 and 76/105,518 and any rights or privileges associated therewith speak for themselves. Further, Applicant did not receive a copy of the alleged Exhibit D and, therefore denies that such Exhibit was included with the Notice of Opposition. Applicant denies the remaining allegations set forth in Paragraph 5.

6. That by virtue of the foregoing, if Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Extended Stay will be subjected to great and irreparable damage, and Applicant will enjoy unlawful gain, and advantage to which it is not entitled under the Trademark Act of 1946. Moreover, registration of Applicant's mark would substantially damage Extended Stay's reputation and the goodwill embodied in the Extended Stay Marks.

ANSWER: Denied.

WHEREFORE, Extended Stay believes and avers that it is being, and will continue to be, damaged by registration of the ESUITES HOTELS mark, and prays that said Application Serial No. 78/061,351 be rejected, that no registration be issued thereon to Applicant, and that the Opposition be sustained in favor of Extended Stay.

ANSWER: Applicant denies that Extended Stay is being, and will continue to be, damaged by registration of Applicant's mark. Applicant requests that registration for said mark be issued and that the subject Opposition be dismissed.

FIRST AFFIRMATIVE DEFENSE

1. Opposer fails to state a claim upon which relief may be granted.

WHEREFORE, Applicant prays that the Notice of Opposition be denied in its entirety, and that the Application be allowed to proceed to registration

Respectfully submitted,

Dated: 6/5/03

By: Kevin J. McDevitt

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Attorneys for Applicant
MATRIX LODGING, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that one copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was served upon Counsel for Opposer by first-class mail, postage-prepaid, this 5th day of June, 2003 addressed as follows:

Michael B. Adlin, Esq.
Thomas E. Zutic, Esq.
Piper Marbury Rudnick & Wolfe LLP
1200 Nineteenth Street NW
Washington, D.C. 20036-2412

Kevin J. McDevitt

TMB

06-09-2003

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June 5, 2003

ATTORNEY DOCKET NO.: 60141-026

COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, VA 22202-3514

RE: Applicant's Answer to Notice of Opposition

Dear Sir or Madam:

Enclosed please find Applicant's Answer to Notice of Opposition, filed on behalf of Applicant Matrix Lodging, LLC in connection with Opposition No. 91155757.

If there are any fees associated with this filing, they should be charged to Deposit Account No. 50-0640. A duplicate copy of this letter is attached for charging purposes, if necessary.

Please direct all future communications regarding this Opposition proceeding directly to Applicant's counsel.

Sincerely,

Kevin J. McDevitt

Kevin J. McDevitt
Attorney for Applicant

KJM/alw
Enclosure