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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161969
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THE RITZ-CARLTON HOTEL
COMPANY, L.L.C.,

Opposer,

v.

ROBERT B. WILCOX,

Applicant

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INTRODUCTION

The Applicant, Robert Wilcox, acknowledges that the Opposer, The Ritz-Carlton Hotel Company, L.L.C. (“Ritz-Carlton”) is a well known provider of lodging and accommodations. The Registrant also acknowledges that The Ritz-Carlton Hotel Company, L.L.C. (“Ritz-Carlton”) has registered a number of trademarks and service marks primarily connected to providing hotel rooms. The majority of the marks are “Ritz-Carlton” and are accompanied by a Lion’s Head logo. Virtually all of the advertising utilizing the Ritz-Carlton marks is directed to promoting luxury hotel rooms and associated services such as providing food, activities, meeting places and conventions. Most consumers associate Ritz-Carlton and not Ritz along with these services. In fact, Applicant strongly believes that a larger segment of the US population recognizes the mark Ritz in association with snack crackers and retail camera stores.

Many facts bear this out. The main website for the hotel chain is “ritz-carlton.com” and not “ritz.com.” Ritz.com is owned by the Ritz Paris, a wholly unrelated hotel establishment located in Paris France, which is widely advertised in the US via the Internet and other means. Therefore, Applicant does not agree with Opposer when they say that they own the “Ritz” marks, when in reality, what they really own is a family of “Ritz-Carlton” marks. “Ritz” marks are owned by a number of other registrants, also in connection with services distinguished from hotel services. None of these other “Ritz” marks are used in connection with offering fine art for sale, and this includes those marks registered by Opposer for the word “Ritz” alone.

For the foregoing reasons, Applicant believes that the relevant registration numbers at issue in the present opposition are registration numbers 2,934,838, 2,869,095 and 1,535,834, all for the mark “Ritz,” and all registered relatively recently by Opposer (all reviewed below in

greater detail). In examining the present application, the Trademark Examining Attorney would no doubt have encountered these “Ritz” marks along with others, and in seeing that they were directed to very different goods or services, and classified in very different international classes (IC’s), would have come to the conclusion that there was no likelihood of confusion, and pass the mark on to publication. This is exactly what occurred. Wherein the marks may have appeared similar in one respect, that being the use of the word “Ritz” upon further analysis of similarity and nature of the goods and services, the Trademark Examining Attorney rightfully passed the mark on to publication.

Opposer filed this opposition because they disagree with this reasoned application of the du Pont factors in analyzing whether there is a likelihood of confusion, and because they believe that the Ritz-Carlton hotel chain would somehow be damaged by allowing the registration to Applicant. A closer look at their “Ritz” alone registered marks would indicate that those marks were being used primarily for hotel services and not in any way in connection with the sale of fine art through a gallery, either on-line via the Internet, or in the more traditional “brick and mortar” setting.

“In testing for likelihood of confusion under section 2(d) of the Lanham Act, similarity of marks **in their entirety** as to appearance, sound, connotation, and commercial impression must be considered” *In re E.I. du Pont de Nemours & Co.* 177 USPQ 564. “In testing for likelihood of confusion under section 2(d) of Lanham Act, **similarity and nature of goods or services** as described in application or registration or in connection with which prior mark is in use must be considered.” *In re E.I. du Pont de Nemours & Co.* 177 USPQ 564. What follows is a review of the three “Ritz” mark registrations owned by Opposer:

- (1) Reg. No. 2,934,838, for the mark Ritz, is registered in IC 043 for hotel services,

restaurant, catering, bar and 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.

There is no mention of art gallery services in International Class 035 in the recitation of services. Opposer would have us believe that the Ritz-Carlton hotels are “associated with fine art” because they display fine art in all of their hotels. But, they fail to connect the mark with the services of selling fine art in a gallery setting. The fact is, they never use the Ritz-Carlton or the Ritz mark in connection with selling fine art. Instead, they lease out space to art galleries within their hotels, and these galleries operate under their own marks, for example, Hanson Gallery, which is housed within the Ritz-Carlton Hotel in San Francisco.

Therefore, the recitation of services for this “Ritz” mark, Reg. No. 2,934,838, in IC 043 is quite distinguishable from Applicant’s recitation of services for the “Ritz” mark as he intends to use the mark for fine art gallery services in IC 035. The recitation of services is so differing that they are classed in different classes.

(2) Reg. No. 2,869,095 is registered to Ritz-Carlton, L.L.C. for providing gaming services accessed via local and worldwide computer networks, personal digital assistants, and electronic computer databases in IC 041. Again, different services and different IC’s. While this recitation of services relates to use on the Internet, that use, namely on-line gaming, is illegal in the US, and would necessarily have to be an “offshore” enterprise. Gaming services and selling fine art through on-line galleries are very different services and in no way related.

(3) The mark, Ritz, Reg. No. 1,535,834 is registered to Ritz-Carlton, L.L.C. for hotel and restaurant services, including grill rooms, snack bars, bars, cabarets and tea room services in IC 042. This is consistent with prior use of the mark for these services. “In testing for likelihood of

confusion under section 2(d) of Lanham Act, similarity and nature of goods or services as described in application or registration or in connection with which prior mark is in use must be considered.” *In re E.I. du Pont de Nemours & Co.* 177 USPQ 563-564. Opposers entire case is about associating the Ritz mark with fine art. They may be able to show a remote “association” with the exhibition of fine art on the walls of their hotels, but they expressly fail in connecting the services of selling fine art in a gallery setting with the mark. The record includes lists of items offered for sale in the gift shops within the hotels, including a web site for shopping for gift items having the URL ritz-carlton.com. These gift shops sell clothing, watches, Swiss Army knives, stemware, and other common gift-type items, but they do not include fine art for sale and this is certainly not a “gallery” setting. The actual art galleries located within Opposer’s hotels all operate under their own marks, and none are know as a “Ritz” Gallery.

Currently, none of the Ritz-Carlton owned marks are registered in IC 035 and none of the Ritz-Carlton marks include anything remotely related to services similar to fine art gallery services. Applicant, Robert Wilcox seeks to registered the mark, “RITZ” for art galleries offering original and limited edition fine art, namely, paintings, photographs, sculptures and prints in IC 035. The Applicant’s mark, RITZ, is seeking registration in a completely different classification of services from those recited in all of Opposer’s registered trademarks. In testing for likelihood of confusion under section 2(d) of Lanham Act, **similarity and nature of goods or services** as described in application or registration or in connection with which prior mark is in use must be considered (*In re E.I. DU Ponte de Nemours & Co.* 177 U.S.P.Q. 564). This was duly performed by the Trademark Office and the result was approval of the mark for publication.

Individuals that spend upwards of \$500 a night for lodging, and which are likely to spend tens of thousands of dollars for fine art pieces, are typically wealthy, well-educated, sophisticated

consumers. “In testing for likelihood of confusion under section 2(d) of Lanham Act, similarity of **established, likely-to-continue trade channels as well as conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing, must be considered.**” *In re E.I. du Pont de Nemours & Co.* 177 USPQ 564. It is well established trademark law that the more sophisticated and careful a consumer is, there exists a proportionally less likelihood of confusion imparted to those consumers. This is especially true when the goods or services are expensive, “high-end” or can be considered “luxury” items. The record shows that Opposer believes its customers to be in this category of discriminating consumers, and Applicant concurs.

Moreover, Applicant fervently believes that sophisticated and knowledgeable art collectors would be quite discriminating, and therefore, would be able to distinguish between the services of providing luxury lodging and the sales of expensive originals through a fine art gallery. Furthermore, because of the sophistication of the consumers of luxury hotel accommodations and fine art, normally involving large sums of money to procure, there would exist no likelihood of confusion in the marketplace, such that Opposer would be “damaged,” should Applicant’s mark register.

In conclusion, Applicant earnestly believes that none of the Opposer’s marks are in conflict with the proposed mark, “RITZ”, for art gallery services offering fine art for sale, and that there is no likelihood of confusion in the consumers mind which would lead to damage.

THE RECORD

I. OPPOSER RITZ-CARLTON’S EVIDENCE

While Opposer’s evidence is extensive and voluminous, there is nothing on record which would act to support a likelihood of confusion, in fact, there are numerous instances within the

record which would refute that hypothesis. Among the 2700 pages or so website printouts, catalogs, and brochures that represent the “printed publications and official records” most of these are directed to galleries with marks of their own, none of which resemble the proposed “Ritz” mark. What is noticeably missing from the record is the deposition of Robert Wilcox and his wife Jurate Wilcox. In both of those depositions, Applicant made it abundantly clear what his intentions for use of the mark were. This question was asked and answered over and over again.

In both the depositions of Derek Flint Julia Gajcak there are numerous representations which support the use of the Ritz-Carlton marks for gift shop services and selling gifts, but fall short of connecting any of the Ritz or Ritz-Carlton marks with gallery services and the exclusive sale of fine art. Mr. Flint stated that he thought a frame and jewelry could be fine art, and that fine art was on display in the restrooms of some Ritz-Carlton hotels. He did not state whether the art on display in the rest rooms was for sale, but his attorney mentioned on cross examination that “everything was for sale” in all rooms of all hotels under the Ritz-Carlton name, an obviously absurd assertion.

II. APPLICANT WILCOX’S ABSENCE OF EVIDENCE

Wilcox presented no additional evidence for several reasons: (1) Applicant believed that the evidence on record for Opposer was sufficient, that the record speaks for itself, and (2) Opposer’s attorneys engaged in a methodical “delay and discourage” campaign and resisted every effort by Applicant to gather any type of evidence, while at the same time “papered” Applicant with 2700 or so pages of nonsense which did not logically connect to any discovery request.

Applicant requested the names of hotel managers for numerous California facilities, and the names of Gallery owners for galleries located within the confines of Ritz-Carlton hotels.

Opposer then demanded that a Protective Order be signed, and one was, but then refused to

comply with any of Applicants requests for information. When asked if it would be possible to depose Simon Cooper, the CEO of Opposer (and the person that makes final branding decisions), there was no response and when it was further requested, the response was that “that was not going to happen.” Instead we were given two names for possible depositions, Derek Flint, a Director of Rooms, and Julia Gajcak, Vice-President of Marketing and Communications, a Ritz-Carlton employee for less than three years, neither of which were in a position to make branding decisions for Opposer. Upon request for sales figures, sales receipts and other proof of sale of fine art products by agents of RITZ-CARLTON, no evidence was provided. This proof of sales under the Ritz-Carlton mark would lay to rest any assertion that there are significant sales of fine art by Opposer, but would not establish a connection for use of the Ritz mark for fine art sales.

In summary, Applicants evidence is not submitted because every effort to gather evidence was effectively blocked by Opposer, a deliberate despicable act, resulting in an unfortunate outcome.

STATEMENT OF ISSUES

1. The real issue in this case is will there be a likelihood of confusion between the marks with regard to origin of source and reputation of varied services such that Opposer will be somehow be damaged, cause a false connection with Ritz-Carlton hotels, or will Applicant’s mark cause dilution of Ritz-Carlton’s marks.

STATEMENT OF FACTS

I. RITZ-CARLTON’S FAMOUS MARKS

A. Ritz-Carlton Or Its Predecessor-In-Interest Has Been Using Marks

Containing RITZ In the United States Continuously For Over Eighty Years

Applicant accepts Opposer’s assertion that “The Ritz-Carlton LLC” is an upscale global

company and that Ritz-Carlton has long used the mark, RITZ, RITZ-CARLTON with and without a Lion's head logo, and in combination with other words to promote its hotel and related services. Art gallery services have not been a part of this storied past usage.

Applicant also acknowledges that the hotel has often been referred to as simply "Ritz" by the Ritz-Carlton and by third parties when referring to the Ritz-Carlton's lodgings and accommodations. Applicant believes that such dissection of the mark and usage of the "Ritz" by Ritz-Carlton to refer to its hotels, has ultimately led to diminution of the mark and subsequently, during the 80 years of such common usage by the general populace, the "Ritz" name is used not only to refer to the Ritz-Carlton hotels but has acquired usage as a common noun by the general public. For this reason, the word "ritz" alone may very well be generic.

Proof of this generic usage of the term, ritz, is included in the Microsoft Encarta College Dictionary, First Edition, St. Martin's Press, 1251. The definition of "**ritz**" as a noun is "an extravagant or ostentatious show or display of something (informal) [Early 20C. < Back-formation < RITZY.] **put on the ritz** to make a show of wealth and extravagance (dated informal).

B. Ritz-Carlton's Trademark Registrations For Its Family Of RITZ Marks

This only includes marks related to hotel services and the three registrations (detailed above in the Introduction) are for varied services including hotel, gaming, restaurants, etc. None of the registered marks owned by Ritz-Carlton recite art gallery services or the sale of fine art.

C. Ritz-Carlton's Prior Rights

Ritz-Carlton's prior rights are not disputed, but are primarily for its Ritz-Carlton marks and not for the use of Ritz alone, and are directed to hotel services and the like.

D. The RITZ Marks Are Strong And Famous, and the RITZ-CARLTON Brand Has

More Value Than Any Other Luxury Brand In The United States

Applicant avers that the Ritz alone mark may be generic and that the Ritz-Carlton marks are strong and may be famous in the hotel field but no more known by the general populace than Ritz for crackers and Ritz for camera stores. Applicant has no knowledge of its value compared to other luxury brands.

E. Ritz-Carlton's Advertising And Promotional Activities Featuring the RITZ Marks

Ritz-Carlton's advertising features the Ritz-Carlton marks almost exclusively, and there are no instances of advertising for art gallery services anywhere in the voluminous record.

F. Ritz-Carlton's Art-Related Goods And Services

None of the Ritz-Carlton's art related services are associated with the sale of fine art in galleries bearing the name Ritz-Carlton or Ritz alone. Rather they feature gift shops and a web site where gift type items are retailed to the public. Opposer's 8 points are discussed below

1. Ritz-Carlton Offers Fine Art And Art-Related Items For Sale.

Only fine art-like gift items in its gift shops and in some facilities on the walls of hallways, restaurants and/or lobbies. There are no art galleries named Ritz, or Ritz-Carlton.

2. Art Galleries Are Located On The Premises Of RITZ-CARLTON Hotels.

Yes, this is true, but they each have their own unique name and operate under a separate service mark, none use Ritz or Ritz-Carlton as that mark. Same for their web sites, etc.

3. Ritz-Carlton Sponsors And Hosts Art Exhibitions And Auctions Where Art Is Sold.

These are actually hosted and run by the individual galleries within the hotel.

4. Ritz-Carlton Uses The Fine Art Collections Displayed In Its Hotels As A Significant Promotional Tool To Attract Customers.

Again, the marks are used in connection with promoting hotel services and not the sale of fine art through galleries.

5. Ritz-Carlton Offers Tours Of The Art In Its Hotels.

The tours are of local art museums and galleries with their own names and marks outside the hotel facility. This is another way to promote lodging at Ritz-Carlton hotels.

6. Ritz-Carlton Offers Leisure Packages Featuring Art Tours Of Art Galleries.

Another way to promote lodging, there are no “Ritz” Art Galleries to tour.

7. Ritz-Carlton Offers Art Classes, Programs, and Events.

Another way to promote lodging, there are no “Ritz” marks directed to art classes, art programs or art related events.

8. Ritz-Carlton Produces and Distributes Magazines That Feature Articles About And Advertisements For, Fine Art And Art Galleries.

Another way to promote lodging, there are no “Ritz” marks in IC 016 for magazines.

LIKELIHOOD OF CONFUSION

The following cases are presented in support of Applicant’s arguments that (1) the marks in question are not identical, (2) the recited services are very different, (3) Ritz-Carlton’s marks are no longer distinctive or arbitrary, (4) likelihood of confusion is not inevitable, (5) the level of awareness of consumers of luxury hotels and fine art is elevated, and (6) there will be no dilution of Ritz-Carlton’s marks should Applicant’s mark be registered.

In *The Alta Vista Corporation, Ltd., v. Digital Equipment Corporation*, 44 Fed.Supp., 2d Series 72 (1998), the court ruled that “A realistic evaluation of consumer confusion must attempt to recreate the conditions in which buying decisions are made, and the court should try to determine not what it would do, but what a reasonable purchaser in the market conditions would do.” Furthermore, the court reasoned that “A Web user who arrives at Digital’s Alta-Vista search site can easily tell that the service offered is an Internet search service. Likewise, a Web

user who arrives at AVC's site can easily tell that the service offered is that of a literary agency. Therefore, I conclude that in context they are not particularly similar marks."

In the present case, Applicant fervently believes that his mark, RITZ, would easily be distinguished by a sophisticated clientele looking for fine art gallery services from those of Opposer's hotel and accommodation services. In the case above, the marks were identical and here they are not, and for this reason Applicant strongly feels that its proposed mark is registerable and this opposition should not be sustained.

Similarly, in *BigStar Entertainment Inc. v. Next Big Star Inc.*, 54 USPQ2d 1685 (2000), the court held that there was no likelihood of confusion between the marks bigstar.com and nextbigstar.com. The court stated that "the crucial issue in an action for trademark infringement...is whether there is any likelihood that an *appreciable number* of ordinarily *prudent purchasers* are likely to be misled, or indeed simply confused, as to the source of the goods in question." The court went on to state that "a determination of the relevant ordinary prudent purchasers herein introduces some other dimensions and considerations peculiar to disputes arising out of merchandising on the Internet." Furthermore, the court averred that "the price of the products...seems sufficiently high to reduce the buyers' clicking impulse and serve to define more narrowly one segment of the relevant web market to the more interested probable purchasers of the parties' products."

This determination goes to answer the question of the ability of "ordinarily prudent" consumers and that they would be able to readily differentiate the sources of "high end" hotel accommodation services from that of an art gallery and the services it would provide, namely, the sale of fine art pieces.

Opposer's strong and famous mark, if any, is Ritz-Carlton, in combination. Historically,

RITZ alone, has been extensively used in connection with “crackers” and “biscuits”, Reg. No. 1,783,581 and, again with “camera equipment and film processing”, Registration Number, 1,594,588, for quite a long period of time. Another RITZ mark for soft drinks was registered to the Wilson Bottling Corporation (Registration Number 1,533,527). “Soft drinks”, “crackers”, “cameras” and “photographic film” are undoubtably available in all Ritz-Carlton hotels and there is no likelihood of confusion as to the source, origin or reputation of those goods among those consumers who purchase Ritz-Carlton goods or services. The RITZ alone mark, as applied to fine art gallery services has not been a category included in any marks that have been issued to Opposer Ritz-Carlton, LLC or any others, with Ritz Camera being the closest in relation. Ritz Camera did not oppose Applicant’s registration.

Opposer cites *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.* 22USPQ2d at 1453 to support his position. The marks PLAY-DOH and FUNDOUGH are used for practically identical products, with almost identical trade dress, are sold in identical markets, and are inexpensive products. All of these facts point to a very low level of brand loyalty or discrimination by consumers. The court held that “both marks appear on inexpensive products purchased by diverse buyers without exercising much care.”

Such is not the case with the sophistication and brand awareness of those seeking luxury lodging and purchasing expensive fine art. “Under section 2(d) of the Lanham Act, the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of marks of applicant and prior user on their respective goods.” (*In re E. I. Du Pont de Nemours & Co.* at 563). There is no dispute as to the priority of the usage of the mark, Ritz-Carlton for hotel and accommodation services in IC 043. However, the usage of the mark, RITZ alone, for art gallery services in IC 035 has not been registered to date, and rightfully

allowed by the Trademark Office to publication with no finding of a likelihood of confusion.

Due to the fame of the Ritz-Carlton marks for hotel services and the obvious high awareness, sophisticated clientele seeking accommodations from them, there is little likelihood that those sophisticated clientele would be confused as to source or reputation of the Ritz-Carlton branded hotels. Given this awareness, confusion with RITZ fine art galleries is highly unlikely.

Opposer has cited two cases to establish priority of the mark. In both cases (*Royal Hawaiian perfumes, Ltd. v. Diamond Head Prods. Of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB) 1979, and *J.C. Hall Co. v. Hallmark Cards, Inc.*, 144 USPQ 435, 437 (CCPA 1965)

In both cases, the goods were found to be generally sold in the same retail channels to the same general classes of purchasers who would not necessarily be required to exercise high awareness. This is not the case at hand. The relevant purchasers of goods and services of purchasers for both hotel accommodations and fine art are very discriminating and have high customer awareness. Therefore, we must acknowledge that consumer confusion as to source would likely be very low if any. Additionally, there are no similar channels of trade, except for the Internet.

In the case of *House of Blues Brands Corp. v. Sylvia Woods Inc.*, 71 USPQ.2d 1308, goods and services of the two marks are virtually identical and the court found that the two marks in consideration, Applicant's "House of Soul" and Opposer's mark "House of Blues" are similar and would Applicant's mark creates a commercial impression similar to that of Opposer's mark, since Applicant's mark closely resembles Opposer's mark and since purchasers of both parties' services would exercise relatively low level of care and sophistication and would likely confuse marks despite subtle distinctions between "blues" and "soul."

In the case at hand, the marks are not identical, however the distinguishing elements are the very different services offered by the parties, and the level of sophistication of the purchasers.

The TTAB in *R. J. Reynolds Tobacco Company v. R. Seeling & Hille*, 201 USPQ at 857 that the marks “Sir Winston” for teas and “Winston” for cigarettes and tobacco products ruled that “...the record of the present case clearly reveals circumstances and conditions which could and/or do exist, whereby Applicant’s and Opposer’s products could be encountered in a market environment that could give rise to a likelihood of confusion as to source if marketed under the same or similar marks. Both tobacco products and tea are low priced items with a clientele that may not rise to the level of sophistication of a Ritz-Carlton guest or a purchaser of fine art. Hence, confusion with Applicant’s mark, if registered would not be a likely occurrence.

Similarly, in *Time Warner Entertainment Co. v. Jones* 65 USPQ.2d 1662, the court found that the “parties’ respective goods are general consumer items which typically are purchased without a great degree of care or sophisticated thought.” Likewise in *Recot Inc. v. M.C. Becton* 54 USPQ.2d 1899, “when products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” Applicant in the case at hand has shown that the purchaser of his products has a high level of sophisticated thought and takes a great degree of care in purchases of fine art. Additionally, the court in *Recot Inc. v. M.C. Becton* 54 USPQ.2d 1899, held that the opposer’s Section 2(a) “false suggestion of a connection: ground of opposition fails for lack of proof.” Here it is unlikely that consumer will falsely associate Applicant and Opposer.

Again, Opposer, refers to the decision of the Court of Appeals for the Sixth Circuit in the case of *Moseley et al., dba Victor’s Little Secret v. Secret Catalogue, Inc., et al.* 537 U.S. 418 (2003) “Noting that petitioners did not challenge Victoria’s Secret’s claim that its mark is ‘famous,’ the only question it had to decide was whether petitioners’ use of their mark diluted the

quality of respondents' mark." In the case at hand, Applicant does not believe usage of the RITZ mark for fine art would "corrode" a trademark by 'blurring its product (or service) identification or by damaging positive associations that have attached to it.'

As in the case of *Ringling Bros.-Barnum & Bailey Combined Shows, Incorporated, Plaintiff-Appellant, v. Utah Division of Travel Development, Defendant-Appellee*. 170 F.3d 449 (4th Cir. 1999), the court ruled that "(T)o establish trademark dilution by blurring under Lanham Act requires proof of (1) a sufficient similarity between the junior and senior marks to evoke an instinctive mental association of the two by a relevant universe of consumers which (2) has caused (3) actual economic harm to the famous mark's economic value by lessening its former selling power as an advertising agent for its good or services; mere proof that consumers would make mental association between marks is insufficient. The marks at issue were the famous "The Greatest Show on Earth" and Utah's adopted slogan "The Greatest Snow on Earth."

"As the district court in this case rightly observed, "marks can lose their distinctiveness or power to identify goods and services for various reasons other than the use of a junior mark." And, for that reason, the court opined that the junior mark use could not be judicially presumed to be the cause of any actual economic harm to the senior mark that might be proved. *See id.* We agree." The court held, dilution by blurring occurs only where consumers 'mistakenly associate or confuse the marks and the goods or services they seek to identify and distinguish, and this association causes actual harm to the senior mark's capacity to 'identify and distinguish.'" *Id.* at 615-16. Applying this interpretation of "dilution" to Ringling's consumer survey evidence, the court found that the attempted proof by this means failed. *See id.* At 616-18. Ritz-Carlton guests and purchasers of fine art rise to a high level of consumer awareness,

such that their capacity to identify and distinguish would be great, and as a result the degree of dilution would be minimized. Applicant strongly believes that there will be no tarnishment.

In the case of *Century 21 Real Estate Corporation, Appellant, v. Century Life of America, Appellee*, 970 F.2d 874, 23 USPQ.2d 1698, the court found that “Because ‘Century’ is used in a variety of trade names and marks, the Board inferred ‘that the public would not regard CENTURY as such an unusual term in a trade name or mark that they would expect all companies with CENTURY in their marks to emanate from a single source...the relevant inquiry examines the number and nature of similar marks used for services similar to insurance brokerage services.” Our society has had a number of “Ritz” marks around for a long time other than that registered by Opposer. Confusion, blurring, and certainly damage, is not likely.

In the case of *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ.2d 1783, the TTAB found that the “Applicant’s use of the Personal Computer Authority and the PC Authority marks are not likely to cause confusion with Opposer’s mark, “The Sports Authority” and logo, even though Opposer’s marks have achieved some degree of fame, since evidence is not sufficiently strong for fame alone to be a dispositive factor, since parties’ marks create different commercial impressions, even though they both contain same dominant element, since there is no similarity between Opposer’s ‘computer services’ and consultation services, computer software, hardware, and peripherals sold by Applicant, since parties do not employ similar trade channels, since numerous registrations and Internet site uses are probative evidence that marks using suggestive or descriptive term followed by “Authority” often coexist and are distinguished on bases of different terms used in conjunction therewith, since parties have operated in same geographic market for five years without evidence of actual confusion and since extent of potential confusion is de minimus.”

Opposer's registration of four incontestable registrations for AUTHORITY, THE SPORTS AUTHORITY & Design, and THE SKI AUTHORITY, Opposer's "prior adoption, use and registration of use of THE SPORTS AUTHORITY as a trade name, Opposer's prior use of a family of marks dominated by the word "AUTHORITY" and Opposer's numerous registration for marks dominated by the word 'AUTHORITY', 35 of which were set forth in the opposition is the basis of opposition to the PC AUTHORITY and THE PERSONAL COMPUTER AUTHORITY. The court held that all 13 of the duPont factors would be considered in the likelihood of confusion issue. In their analysis of the marks in the case, the court held that "there is no similarity or relatedness whatsoever between applicant's services and the various classes of goods for which THE SPORTS AUTHORITY has been registered.

The Opposer argues that the parties utilize the same trade channels in that both utilize retail stores, each uses the Internet and direct mail and other similar forms of print advertising. Opposer also relies on the fact that both parties sell goods at retail to general consumers. The court found that there is nothing in Applicant's identification that suggests that its retail store services focusing on computer hardware and software would be rendered through a retail store focusing on sporting goods and equipment or vice versa. In sum, merely because both parties provide retail store services and use similar methods of advertising does not mean that their respective services will be offered to consumers under circumstances and through channels of trade which would create a likelihood of confusion.

Such is the case with the usage of RITZ for fine art gallery services verses Ritz-Carlton for hotel accommodations. In fact, there is a higher level of awareness of consumers in the present case than there was in the Sports Authority case, and the goods/services vary.

Similarly, the conditions under which and buyers in the “Authority” marks to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasers, the goods offered by both parties include some items which may be bought on impulse and others that would require a good deal of deliberation. The other services each party provides such as advertising, marketing, importing and exporting, etc require some degree of deliberation before purchase.

As to the fame of the prior mark, the court held that there is little or no evidence that show the level of brand awareness that has resulted from Opposer’s expansion and promotional efforts. “...we find the numerous registrations and web site uses probative evidence that marks using a descriptive or suggestive term followed by the term “Authority” are attractive to many businesses, are adopted to convey the very suggestive connotation that the adopting entity is an expert or authority in the particular field in which it is engaged, and that such marks often co-exist and are distinguished because of the other terms used in conjunction with ‘Authority’”

Such is the case with the usage of “RITZ” for fine art gallery services, and Ritz-Carlton for hotel accommodations, as well as Ritz alone for crackers, soft drinks or camera equipment and supplies sold through retail and on-line sources.

In considering the nature and extent of any actual confusion in the “Ritz” case, there is none, and there is no likelihood of confusion here. The RITZ mark for fine art gallery services was accepted for publication for opposition by the Trademark Examiner, who, by this criteria, found no likelihood of confusion with any prior pending or registered marks. When the potential confusion litmus test is applied to the current case, there is no evidence of potential confusion between the marks, RITZ-CARLTON, or even RITZ alone, for luxury hotel accommodations and RITZ for fine art galleries, as in the “Authority” case above.

The court reasoned in the “Authority” case, “In this case, though the balance initially tips in favor of opposer because of the fame factor, the many other factors that weigh in the balance in favor of applicant are sufficient to overcome the fame factor. Moreover, opposer has produced no evidence that the relevant public, i.e., consumers of diverse retail store services has become accustomed to seeing the same or similar marks in connection with the operation of retail stores in fields as diverse as sports and apparel, on the one hand and computer hardware, software and accessories on the other.”

As in the present case at hand, Opposer has produced no evidence that the relevant public, i.e., consumers of hotel accommodations, has become accustomed to seeing the same or similar marks in connection with operation of retail stores in fields as diverse as fine art galleries and luxury hotels. As in the “Authority” case a majority of the duPont factors support Applicant and tip the balance in Applicant’s favor. The court in the “Authority” case dismissed opposition to the registration of the PERSONAL COMPUTER AUTHORITY and the PC AUTHORITY Logo as to each of Applicant’s involved applications. Applicant earnestly believes that the ruling in this opposition should follow suit in dismissing the opposition based on the same reasoning.

In the case of *Boo Inc. v. Boo.com Group Ltd.*, 62 USPQ.2d 1606, the Defendant, Fashionmall.com, Inc., was granted summary judgement that its “boo.com” Internet domain name does not infringe Plaintiff’s “Boo” trademark even though parties’ marks are identical for purposes of likelihood of confusion analysis. The Court used the following premise to determine likelihood of confusion: “Resolution of the likelihood of confusion issue ‘does not hinge on a single factor, but requires consideration of [all of the] factors to determine whether under all circumstances there is a likelihood of confusion.’” While the court “finds that the marks are identical for the purposes of determining a likelihood of confusion analysis,” they also noted that

“there is no evidence that Fashionmall intended to confuse the public,” and that “the evidence shows that any potential customer of Fashionmall would tend to exercise great care, because such customers pay large fees to be included on the boo.com site. Plaintiff’s customers would likely exercise less care because products offered by the Plaintiff’s were not terribly costly. At best, then, this factor is neutral in the likelihood of confusion analysis.”

On the other hand, here the marks are somewhat similar but the services are quite different, yet potential consumers would exercise great care in making buying decisions between luxury hotel accommodations and fine art purchases.

In the case of *In re Stirbl*, 62 USPQ.2d, 1447, the Applicant’s “UIS” mark is not confusingly similar to registrant’s mark, “UIS Universal Information Systems Inc.,” even though both marks contain or consists of letters “UIS” in stylized form. The court held that in an issue of likelihood of confusion, “our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. The TTAB held that “the services at issue herein, both the registrant’s identified computer programming services and applicant’s computer consultation services, etc., are rather specialized services which likely will be purchased by knowledgeable individuals exercising a degree of care.” When this factor along with the differences in the marks and the fact that services are not identical, the TTAB found that the “Office has not met its burden of proving that confusion is likely.” Therefore, the refusal of registration was reversed.

Similarly, in the present opposition we have non-identical marks and very different services. None of Ritz-Carlton’s “art-related” activities rises to the level of trademark

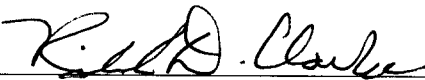
usage such that there is a likelihood of confusion or Opposer's mark will be diluted or Opposer will be damaged, in any way, should Applicant's proposed mark be registered. Based on the foregoing, the TTAB should dismiss this opposition.

CONCLUSION

This opposition should be dismissed because there is no evidence of a likelihood of confusion between any of Opposer's registered trademarks or service marks and Applicant's proposed service mark.

Respectfully submitted,

Date: July 20, 2007

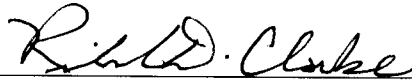
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant's Trial Brief was served upon Opposer's counsel Michael A. Grow, Douglas R. Bush and Jason J. Mazur of ARENT FOX LLP at 1050 Connecticut Ave., NW, Washington, D.C. 20036, by first class mail, postage prepaid, on July 20, 2007.

A handwritten signature in cursive script, reading "Richard D. Clarke", is positioned above a horizontal line.

Richard D. Clarke