

ESTTA Tracking number: **ESTTA203858**

Filing date: **04/09/2008**

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 | Starwood Hotels & Resorts Worldwide, Inc. |
| Granted to Date of previous extension | 04/09/2008 |
| Address | 1111 Westchester Avenue White Plains, NY 10604 UNITED STATES |
| Attorney information | David Donahue Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES ddonahue@frosszelnick.com, dehrlich@frosszelnick.com, bnewman@fzlj.com Phone:212-813-5900 |

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 77236780 | Publication date | 12/11/2007 |
| Opposition Filing Date | 04/09/2008 | Opposition Period Ends | 04/09/2008 |
| Applicant | CROSLAND, LLC 227 WEST TRADE STREET, SUITE 800 CHARLOTTE, NC 28202 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 035. All goods and services in the class are opposed, namely: Real estate sales management, namely, management of sales of leased and developed space for others |
| Class 036. All goods and services in the class are opposed, namely: Renting of shopping center space; leasing of office space; real estate brokerage |
| Class 037. All goods and services in the class are opposed, namely: Real estate development |

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-------------------|---------|------------------|------------|
| U.S. Registration | 2863392 | Application Date | 09/25/2002 |
|-------------------|---------|------------------|------------|

| | | | |
|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | 07/13/2004 | Foreign Priority Date | NONE |
| Word Mark | W | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 036. First use: First Use: 2003/06/30 First Use In Commerce: 2003/06/30 Leasing of real estate, real estate appraisal, real estate brokerage, real estate land acquisition, equity sharing, namely, managing and arranging for co-ownership of real estate, real estate investment, real estate management, real estate time sharing, leasing of real property</p> <p>Class 037. First use: First Use: 2003/06/30 First Use In Commerce: 2003/06/30 Construction services, namely-planning laying out and custom construction of residential and commercial communities; real estate development</p> | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2289607 | Application Date | 04/08/1998 |
| Registration Date | 10/26/1999 | Foreign Priority Date | NONE |
| Word Mark | W | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1998/11/00 First Use In Commerce: 1998/11/00 hotel and restaurant services | | |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3083217 | Application Date | 09/05/2003 |
| Registration Date | 04/18/2006 | Foreign Priority Date | NONE |
| Word Mark | W RESIDENCES | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 036. First use: First Use: 2003/09/00 First Use In Commerce: 2003/09/00 Leasing of real estate, real estate appraisal, real estate brokerage, real estate land acquisition, equity sharing, namely, managing and arranging for co-ownership of real estate, real estate investment, real estate management, real estate time sharing, leasing of real property</p> <p>Class 037. First use: First Use: 2003/09/00 First Use In Commerce: 2003/09/00 Construction services, namely-planning laying out and custom construction of residential and commercial communities; real estate development</p> | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3000219 | Application Date | 07/23/2004 |
| Registration Date | 09/27/2005 | Foreign Priority Date | NONE |
| Word Mark | W | | |
| Design Mark | | | |

| | |
|---------------------|---|
| Description of Mark | NONE |
| Goods/Services | <p>Class 041. First use: First Use: 1998/06/00 First Use In Commerce: 1998/06/00 Health club services, namely providing instruction and equipment in the field of physical exercise; Health clubs providing physical fitness facilities for recreational purposes</p> <p>Class 043. First use: First Use: 1998/06/00 First Use In Commerce: 1998/06/00 Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being</p> <p>Class 044. First use: First Use: 1998/06/00 First Use In Commerce: 1998/06/00 Health spa services for health and wellness of the body and spirit; Beauty salon and health spa services, namely, facials, body massages, mineral baths, cosmetic body care services</p> |

| | |
|-------------|--|
| Attachments | <p>76454944#TMSN.gif (1 page)(bytes) 75464250#TMSN.gif (1 page)(bytes) 76542898#TMSN.gif (1 page)(bytes) 76603724#TMSN.gif (1 page)(bytes) Notice of Oppositio (F0254155).PDF (17 pages)(7579130 bytes)</p> |
|-------------|--|

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 | /ddonahue/ |
| Name | David Donahue |
| Date | 04/09/2008 |

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

Opposer's Ref: STAW 08/00977

In the Matter of Application Serial No. 77/236,780

-----X
Starwood Hotels & Resorts Worldwide, Inc., :
 :
 Opposer, : Opposition No. _____
 :
 - against - :
 :
 Crosland, LLC, :
 :
 Applicant. :
-----X

NOTICE OF OPPOSITION

Opposer Starwood Hotels & Resorts Worldwide, Inc., a Maryland corporation located at 1111 Westchester Avenue, White Plains, NY 10604, believes it would be damaged by the issuance of a registration for the trademark W (and Design) as applied for by Crosland, LLC (“Applicant”) in Serial No. 77/236,780 filed on July 24, 2007 for various services in International Classes 35, 36 and 37, and therefore opposes same. As grounds for its opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. For many years, Opposer has used trademarks consisting of or prominently featuring the letter W (collectively, the “W Mark”) in connection with hotel services, real estate services, and various other related goods and services.
2. Through its years of use and promotion of the W Mark and as a result of its expenditure of significant resources to promote its services under the W Mark, the W Mark

has come to be uniquely associated with Opposer, represents enormous goodwill of Opposer and identifies and distinguishes goods and services provided by Opposer from those of others.

3. In addition to its common law rights in the W Mark, Opposer owns numerous United States Trademark Registrations for its W Mark for hotel services, real estate services and various other related goods and services, including without limitation the following: Reg. No. 2863392; Reg. No. 2289607; Reg. No. 3000219; and Reg. No. 3083217 (collectively, “Opposer’s Registrations”).

4. Opposer’s Registrations are valid, subsisting, and in full force and effect. True and correct copies of printouts from the TARR database of the United States Patent and Trademark Office showing the current status and title of Opposer’s Registrations are attached hereto as Exhibit A.

5. The services in Opposer’s Registrations are identical to and/or closely related to the services claimed in Applicant’s application.

6. Upon information and belief, Opposer’s first use in commerce of its W Mark precedes any priority date upon which Applicant may rely.

7. Use by Applicant of the applied-for mark in connection with the services identified in the application is likely to cause confusion, or to cause mistake or to deceive, and cause consumers to believe that these services emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C., § 1052(d).


8. Opposer will be damaged by the registration of the mark because it will cause confusion and adversely affect Opposer’s valuable goodwill in its W Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained.

Dated: New York, New York
April 9, 2008

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

David Donahue
Betsy Judelson Newman

Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served by First Class mail upon Applicant's attorney of record, Christopher S. Nesbit, Esq., JAYNE C HUNTER C/O HELMS MULLISS & WICKER, 201 North Tryon Street, Box 26, Charlotte, North Carolina 28202, on this 9th day of April, 2008.



David Donahue

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-04-09 19:14:14 ET

Serial Number: 76454944 Assignment Information Trademark Document Retrieval

Registration Number: 2863392

Mark (words only): W

Standard Character claim: No

Current Status: Registered.

Date of Status: 2004-07-13

Filing Date: 2002-09-25

Transformed into a National Application: No

Registration Date: 2004-07-13

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-07-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

I. Starwood Hotels & Resorts Worldwide, Inc.

Address:

Starwood Hotels & Resorts Worldwide, Inc.
1111 Westchester Avenue
White Plains, NY 10604
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Maryland

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

Leasing of real estate, real estate appraisal, real estate brokerage, real estate land acquisition, equity sharing, namely, managing and arranging for co-ownership of real estate, real estate investment, real estate management, real estate time sharing, leasing of real property

Basis: 1(a)

First Use Date: 2003-06-30

First Use in Commerce Date: 2003-06-30

International Class: 037

Class Status: Active

Construction services, namely-planning laying out and custom construction of residential and commercial communities; real estate development

Basis: 1(a)

First Use Date: 2003-06-30

First Use in Commerce Date: 2003-06-30

ADDITIONAL INFORMATION

Prior Registration Number(s):

2289607

2294753

2445778

2694849

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2004-07-13 - Registered - Principal Register

2004-04-28 - Allowed for Registration - Principal Register (SOU accepted)

2004-04-27 - Assigned To Examiner

2004-04-23 - Statement of use processing complete

2004-04-06 - Amendment to Use filed

2004-04-16 - Case File In TICRS

2004-04-08 - PAPER RECEIVED

2003-10-07 - Notice of allowance - mailed

2003-07-15 - Published for opposition

2003-06-25 - Notice of publication

2003-05-14 - Approved for Pub - Principal Register (Initial exam)

2003-04-15 - Communication received from applicant

2003-04-15 - TEAS Response to Office Action Received

2003-04-02 - Non-final action mailed

2003-03-05 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

MARY B SCOTT

Correspondent

MARY B SCOTT

KRAMER LEVIN NAFTALIS & FRANKEL LLP

919 3RD AVE

NEW YORK NY 10022-3852

Phone Number: (212) 716-7648

Fax Number: (212) 715-8000

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-04-09 19:14:55 ET

Serial Number: 75464250 Assignment Information Trademark Document Retrieval

Registration Number: 2289607

Mark (words only): W

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2005-01-21

Filing Date: 1998-04-08

Transformed into a National Application: No

Registration Date: 1999-10-26

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 834 -Post Registration

Date In Location: 2005-01-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Starwood Hotels & Resorts Worldwide, Inc.

Address:

Starwood Hotels & Resorts Worldwide, Inc.
1111 WESTCHESTER AVENUE
WHITE PLAINS, NY 10604
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Maryland

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

hotel and restaurant services

Basis: 1(a)

First Use Date: 1998-11-00

First Use in Commerce Date: 1998-11-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2005-01-21 - Section 8 (6-year) accepted & Section 15 acknowledged

2004-12-15 - Section 8 (6-year) and Section 15 Filed

2004-12-15 - PAPER RECEIVED

1999-10-26 - Registered - Principal Register

1999-08-21 - Allowed for Registration - Principal Register (SOU accepted)

1999-08-19 - Assigned To Examiner

1999-08-16 - Statement of use processing complete

1999-07-02 - Amendment to Use filed

1999-01-05 - Notice of allowance - mailed

1998-10-13 - Published for opposition

1998-09-11 - Notice of publication

1998-07-29 - Approved for Pub - Principal Register (Initial exam)

1998-07-21 - Assigned To Examiner

1998-07-17 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

MARY B. AVERSANO,

Correspondent

PETER A ABRUZZESE

KRAMER LEVIN NAFTALIS & FRANKEL LLP
919 3RD AVE
NEW YORK NY 10022-3852

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-04-09 19:13:15 ET

Serial Number: 76603724 Assignment Information Trademark Document Retrieval

Registration Number: 3000219

Mark

W

(words only): W

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-09-27

Filing Date: 2004-07-23

Transformed into a National Application: No

Registration Date: 2005-09-27

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-09-27

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Starwood Hotels & Resorts Worldwide, Inc.

Address:

Starwood Hotels & Resorts Worldwide, Inc.

1111 Westchester Avenue

White Plains, NY 10604

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Maryland

GOODS AND/OR SERVICES

International Class: 041

Class Status: Active

Health club services, namely providing instruction and equipment in the field of physical exercise; Health clubs providing physical fitness facilities for recreational purposes

Basis: 1(a)

First Use Date: 1998-06-00

First Use in Commerce Date: 1998-06-00

International Class: 043

Class Status: Active

Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being

Basis: 1(a)

First Use Date: 1998-06-00

First Use in Commerce Date: 1998-06-00

International Class: 044

Class Status: Active

Health spa services for health and wellness of the body and spirit; Beauty salon and health spa services, namely, facials, body massages, mineral baths, cosmetic body care services

Basis: 1(a)

First Use Date: 1998-06-00

First Use in Commerce Date: 1998-06-00

ADDITIONAL INFORMATION

Prior Registration Number(s):

2289607

2294753

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2005-09-27 - Registered - Principal Register

2005-07-05 - Published for opposition

2005-06-15 - Notice of publication

2005-03-30 - Law Office Publication Review Completed

2005-03-28 - Assigned To LIE

2005-03-22 - Examiner's amendment mailed

2005-03-22 - Approved for Pub - Principal Register (Initial exam)

2005-03-22 - Examiners Amendment -Written

2005-03-18 - Amendment From Applicant Entered

2005-03-07 - Communication received from applicant

2005-03-07 - TEAS Response to Office Action Received

2005-02-28 - Non-final action mailed

2005-02-26 - Non-Final Action Written

2005-02-26 - Assigned To Examiner

2004-08-05 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mary B. Aversano

Correspondent

MARY B. AVERSANO

KRAMER, LEVIN, NAFTALIS & FRANKEL

919 3RD AVE

NEW YORK NY 10022-3902

Phone Number: (212) 715-9464

Fax Number: (212) 715-8000

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-04-09 19:13:43 ET

Serial Number: 76542898 Assignment Information Trademark Document Retrieval

Registration Number: 3083217

Mark



RESIDENCES

(words only): W RESIDENCES

Standard Character claim: No

Current Status: Registered.

Date of Status: 2006-04-18

Filing Date: 2003-09-05

Transformed into a National Application: No

Registration Date: 2006-04-18

Register: Principal

Law Office Assigned: LAW OFFICE 116

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-03-09

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Starwood Hotels & Resorts Worldwide, Inc.

Address:

Starwood Hotels & Resorts Worldwide, Inc.
1111 Westchester Avenue
White Plains, NY 10604
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Maryland

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

Leasing of real estate, real estate appraisal, real estate brokerage, real estate land acquisition, equity sharing, namely, managing and arranging for co-ownership of real estate, real estate investment, real estate management, real estate time sharing, leasing of real property

Basis: 1(a)

First Use Date: 2003-09-00

First Use in Commerce Date: 2003-09-00

International Class: 037

Class Status: Active

Construction services, namely-planning laying out and custom construction of residential and commercial communities; real estate development

Basis: 1(a)

First Use Date: 2003-09-00

First Use in Commerce Date: 2003-09-00

ADDITIONAL INFORMATION

Disclaimer: RESIDENCES

MADRID PROTOCOL INFORMATION

USPTO Reference Number: A0010407

International Registration Number: (NOT AVAILABLE)

International Registration Date: (DATE NOT AVAILABLE)

Original Filing Date with USPTO: 2007-11-21

International Registration Status: Response To Irregularity Received From Applicant

Date of International Registration Status: 2008-01-07

International Registration Renewal Date: (DATE NOT AVAILABLE)

Irregularity Reply by Date: 2008-03-11

Madrid History:

01-08-2008 - 14:39:23 - Response To Irregularity Reviewed And Rejected

01-07-2008 - 13:41:42 - Irregularity Response Received From Applicant

12-14-2007 - 21:42:00 - Irregularity Notice Received From IB

11-21-2007 - 21:01:01 - IR Certified And Sent To IB

11-21-2007 - 09:51:58 - Automatically Certified

11-21-2007 - 09:51:58 - New Application For IR Received

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-04-18 - Registered - Principal Register

2006-03-08 - Law Office Registration Review Completed
2006-03-03 - Assigned To LIE
2006-02-25 - Allowed for Registration - Principal Register (SOU accepted)
2006-02-19 - Statement of use processing complete
2006-01-31 - Amendment to Use filed
2006-01-31 - TEAS Statement of Use Received
2005-09-03 - Extension 2 granted
2005-08-28 - Extension 2 filed
2005-08-29 - TEAS Extension Received
2005-04-04 - Extension 1 granted
2005-02-28 - Extension 1 filed
2005-02-28 - PAPER RECEIVED
2004-08-31 - Notice of allowance - mailed
2004-06-08 - Published for opposition
2004-05-19 - Notice of publication
2004-03-28 - Approved for Pub - Principal Register (Initial exam)
2004-03-18 - Examiner's amendment mailed
2004-03-16 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mary B. Scott

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