

ESTTA Tracking number: **ESTTA323754**

Filing date: **12/23/2009**

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	Patrick J. Kennedy		
Entity	Individual	Citizenship	UNITED STATES
Address	112 East Pecan Street, Suite 2810 San Antonio, TX 78205 UNITED STATES		

Attorney information	Wendy C. Larson 600 Congress Ave, Suite 2120 Austin, TX 78701 UNITED STATES eolson@pirkeybarber.com, wlarson@pirkeybarber.com, lpirkey@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512-322-5200		
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### Applicant Information

Application No	77644258	Publication date	11/24/2009
Opposition Filing Date	12/23/2009	Opposition Period Ends	12/24/2009
Applicant	Burgess, Sean M. 101 N. Oak Place Broken Arrow, OK 74013 UNITED STATES		

### Goods/Services Affected by Opposition

Class 041. First Use: 2008/03/17 First Use In Commerce: 2008/03/17 All goods and services in the class are opposed, namely: Education services, namely, providing instruction in the use of computer programs for estimating the cost of residential and commercial property repair and replacement and the distribution of course materials in connection therewith
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2067410	Application Date	05/24/1993
Registration Date	06/03/1997	Foreign Priority Date	NONE
Word Mark	WATERMARK		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 042. First use: First Use: 1997/02/09 First Use In Commerce: 1997/02/09 hotel, restaurant and bar services		
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U.S. Registration No.	2970823	Application Date	03/29/1995
Registration Date	07/19/2005	Foreign Priority Date	NONE
Word Mark	WATERMARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/04/22 First Use In Commerce: 2005/04/22 business and quality assurance management services, namely rendering technical aid and assistance to others in the establishment, management, and operation of hotels, restaurants, and bars		

U.S. Registration No.	2856244	Application Date	10/23/2000
Registration Date	06/22/2004	Foreign Priority Date	NONE
Word Mark	WATERMARK HOTEL AND SPA		
Design Mark	<b>WATERMARK HOTEL AND SPA</b>		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Health spa services, beauty salon services and physical fitness consultation		

U.S. Registration No.	2867104	Application Date	10/30/2000
Registration Date	07/27/2004	Foreign Priority Date	NONE
Word Mark	WATERMARK HOTEL AND SPA		
Design Mark	<b>WATERMARK HOTEL AND SPA</b>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Footwear, namely slippers and rubber thong sandals; clothing, namely tennis wear, golf shirts, golf shorts, slacks, polo shirts, warm-up suits, sweat suits, gym		

	shorts, t-shirts, leotards and tights; headwear namely hats, visors and caps; swimwear and bathrobes
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U.S. Registration No.	3009270	Application Date	03/10/2003
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Registration Date	10/25/2005	Foreign Priority Date	NONE
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Word Mark	W WATERMARK SPA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 003. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Hair conditioners, hair shampoo, hand cream, skin moisturizer, and shower gel</p> <p>Class 025. First use: First Use: 2004/03/30 First Use In Commerce: 2004/03/30 Clothing, namely, T-shirts, golf shirts, polo shirts, slippers and sandals, hats, visors and caps, and bathrobes</p> <p>Class 041. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Health club services, namely providing instruction in the field of physical exercise; physical fitness consultation</p> <p>Class 044. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Health spa services, namely, massage, aromatherapy, relaxation therapy, body masks and wraps, skin therapies/care, body exfoliating treatment, hydrotherapy, hair/nail care therapies, facials and reflexology; beauty salon services</p>
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U.S. Registration No.	3104558	Application Date	03/10/2003
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Registration Date	06/13/2006	Foreign Priority Date	NONE
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Word Mark	W WATERMARK HOTEL & SPA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 025. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Clothing, namely, T-shirts, golf shirts, polo shirts, slippers and sandals, hats, visors and caps, bathrobes and swimwear</p> <p>Class 041. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Health club services, namely providing instruction in the field of physical exercise; physical fitness consultation</p> <p>Class 043. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Hotel, restaurant and bar services</p> <p>Class 044. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Health spa services, namely, massage, aromatherapy, relaxation therapy, body masks and wraps, skin therapies/care, body exfoliating treatment, hydrotherapy, hair/nail care therapies, facials and reflexology; beauty salon services</p>
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U.S. Application No.	77025912	Application Date	10/20/2006
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	W WATERMARK
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: Management for others of resorts, hotels, condominiums, time-share resident units, and fractional interest units, office and retail space, gift shops, restaurants, bars, health clubs, country clubs, golf and tennis facilities, and spas; Business and quality assurance management services, namely, rendering technical assistance to others in the establishment, management, and operation of resorts, hotels, condominiums, time-share resident units and fractional interest units, restaurants, bars, office and retail space, health clubs, country clubs, golf and tennis facilities, and spas; business management consulting services in the field of resorts, hotels, condominiums and residential units, office and retail space, restaurants, bars, gift shops, health clubs, country clubs, golf and tennis facilities, and spas</p> <p>Class 036. First use: Real estate services, namely, leasing, rental and brokerage of condominiums and residential units, fee simple ownership resident units, time-share resident units, and fractional interest units, retail and office space</p> <p>Class 037. First use: Consulting in the field of real estate development, namely, the development of resorts, hotels, condominiums and residential units, fee simple ownership resident units, time-share resident units, and fractional interest units, office and retail space, restaurants, bars, health clubs, country clubs, golf and tennis facilities, and spas</p>
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	Class 043. First use: Consulting services in the field of hospitality
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Attachments	76152653#TMSN.gif ( 1 page )( bytes ) 76156728#TMSN.gif ( 1 page )( bytes ) 76977746#TMSN.gif ( 1 page )( bytes ) 76978109#TMSN.gif ( 1 page )( bytes ) 77025912#TMSN.jpeg ( 1 page )( bytes ) KENU197 Notice of Opposition.pdf ( 6 pages )(792781 bytes )
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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	/WCL/
Name	Wendy C. Larson
Date	12/23/2009

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

In Re Serial No. 77644258  
Filed: January 6, 2009  
Mark: **WATERMARK**  
Published: November 24, 2009

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Patrick J. Kennedy,

Opposer,

Opposition No. \_\_\_\_\_

v.

Sean M. Burgess,

Applicant.

**NOTICE OF OPPOSITION**

Patrick J. Kennedy (“Opposer”) believes that he will be damaged by registration of the mark identified above in International Class 41, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer is a United States citizen, having his principal place of business at 112 East Pecan Street, Suite 2810, San Antonio, Texas 78205.
2. Opposer has adopted and has long and continuously used certain trademarks and service marks, including but not limited to the mark WATERMARK and related marks (hereinafter referred to as the “WATERMARK Marks”), in connection with luxury hotel services, and associated real estate development, restaurant, bar, and health spa services, and related goods.

3. Opposer's WATERMARK Marks are inherently distinctive, serving to identify and indicate the source of Opposer's goods and services to the consuming public, and to distinguish Opposer's goods and services from those of others.



4. Additionally, as a result of Opposer's use and promotion of his WATERMARK Marks, the marks have become distinctive and are recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting his WATERMARK Marks and the goods and services sold under those marks, with the result that the purchasing public has come to know, rely on, and recognize the goods and services of Opposer by those marks. Opposer has established valuable goodwill in his WATERMARK Marks.

5. Opposer's WATERMARK Marks are famous pursuant to 15 U.S.C. § 1125.


6. Opposer's WATERMARK Marks became famous prior to Applicant's claimed first use and filing date.

7. In addition to his extensive common law rights, Opposer is the owner of six U.S. Registrations and one pending U.S. Application for his WATERMARK Marks, among others, as shown in the following chart:

<b>Mark</b>	<b>Reg. or Serial No.</b>	<b>Reg. or Filing Date</b>	<b>First Use</b>	<b>Goods &amp; Services</b>
WATERMARK	2067410	June 3, 1997	Feb. 9, 1997	Hotel, restaurant and bar services, in Class 42
WATERMARK	2970823	July 19, 2005	April 22, 2005	Business and quality assurance management services, namely, rendering technical aid and assistance to others in the establishment, management, and operation of hotels, restaurants, and bars, in Class 35
WATERMARK HOTEL AND SPA	2856244	June 22, 2004	Dec. 31,	Health spa services, beauty salon services and physical fitness consultation, in Class 42

Mark	Reg. or Serial No.	Reg. or Filing Date	First Use	Goods & Services
			2003	
WATERMARK HOTEL AND SPA	2867104	July 27, 2004	Jan. 1, 2004	Footwear, namely slippers and rubber thong sandals; clothing, namely tennis wear, golf shirts, golf shorts, slacks, polo shirts, warm-up suits, sweat suits, gym shorts, t-shirts, leotards and tights; headwear namely hats, visors and caps; swimwear and bathrobes, in Class 25
W WATERMARK SPA and design 	3009270	Oct. 25, 2005	Dec. 31, 2003	Hair conditioners, hair shampoo, hand cream, skin moisturizer, and shower gel, in Class 3 Clothing, namely, T-shirts, golf shirts, polo shirts, slippers and sandals, hats, visors and caps, and bathrobes, in Class 25 Health club services, namely providing instruction in the field of physical exercise; physical fitness consultation, in Class 41 Health spa services, namely, massage, aromatherapy, relaxation therapy, body masks and wraps, skin therapies/care, body exfoliating treatment, hydrotherapy, hair/nail care therapies, facials and reflexology; beauty salon services, in Class 44
W WATERMARK HOTEL & SPA and design 	3104558	June 13, 2006	Dec. 31, 2003	Clothing, namely, T-shirts, golf shirts, polo shirts, slippers and sandals, hats, visors and caps, bathrobes and swimwear, in Class 25 Health club services, namely providing instruction in the field of physical exercise; physical fitness consultation, in Class 41 Hotel, restaurant and bar services, in Class 43 Health spa services, namely, massage, aromatherapy, relaxation therapy, body masks and wraps, skin therapies/care, body exfoliating treatment, hydrotherapy, hair/nail care therapies, facials and reflexology; beauty salon services, in Class 44
W WATERMARK and design	77025912	Oct. 20, 2006	Filed as intent-to-use	Management for others of resorts, hotels, condominiums, time-share resident units, and fractional interest units, office and retail space, gift shops, restaurants, bars, health clubs, country clubs, golf and tennis facilities, and spas; Business and quality assurance management services, namely, rendering technical assistance to others in the establishment, management, and operation of



Mark	Reg. or Serial No.	Reg. or Filing Date	First Use	Goods & Services
				<p>resorts, hotels, condominiums, time-share resident units and fractional interest units, restaurants, bars, office and retail space, health clubs, country clubs, golf and tennis facilities, and spas; business management consulting services in the field of resorts, hotels, condominiums and residential units, office and retail space, restaurants, bars, gift shops, health clubs, country clubs, golf and tennis facilities, and spas, in Class 35</p> <p>Real estate services, namely, leasing, rental and brokerage of condominiums and residential units, fee simple ownership resident units, time-share resident units, and fractional interest units, retail and office space, in Class 36</p> <p>Consulting in the field of real estate development, namely, the development of resorts, hotels, condominiums and residential units, fee simple ownership resident units, time-share resident units, and fractional interest units, office and retail space, restaurants, bars, health clubs, country clubs, golf and tennis facilities, and spas, in Class 37</p> <p>Consulting services in the field of hospitality, in Class 43</p>

Each of the registrations listed in the chart above is valid and subsisting, and the first is incontestable pursuant to 15 U.S.C. § 1065.

8. On information and belief, Applicant Sean M. Burgess (“Applicant”) is a resident of Oklahoma, with an address of 101 North Oak Place, Broken Arrow, Oklahoma. Applicant filed Application Serial No. 77644258 (the “Application”) based on use pursuant to 15 U.S.C. § 1051(a) on January 6, 2009 for the mark WATERMARK (hereinafter referred to as “Applicant’s Mark”) for “education services, namely, providing instruction in the use of computer programs for estimating the cost of residential and commercial property repair and replacement and the distribution of course materials in connection therewith,” in Class 41.

9. Opposer has priority based on his prior use, registration and/or filing dates of his WATERMARK Marks in the United States.

10. Applicant's Mark is confusingly similar to Opposer's WATERMARK Marks, and the services in the Application are highly related to the goods and services for which Opposer uses and has registered or applied to register his WATERMARK Marks.

11. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

12. Applicant's Mark so resembles Opposer's WATERMARK Marks as to be likely, when used on or in connection with the identified goods of Applicant, to cause confusion, or to cause mistake, or to deceive. Registration therefore should be refused under 15 U.S.C. § 1052(d).

13. Applicant's Mark is likely to cause dilution by blurring or dilution by tarnishment of Opposer's famous WATERMARK Marks, and registration should also be refused under 15 U.S.C. § 1125(c).


14. Registration of Applicant's Mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, application and common law, and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 77644258 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/KENU:197/LTP, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: 12/23/09

  
Louis T. Pirkey  
Wendy C. Larson  
PIRKEY BARBER LLP  
600 Congress Avenue, Suite 2120  
Austin, Texas 78701  
(512) 322-5200  
ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail on December 23, 2009 upon Applicant's attorney:

Frank J. Catalano  
Gable & Gotwals  
100 West 5th Street, Floor 10  
Tulsa, Oklahoma 74103

