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

Proceeding	91268387
Party	Plaintiff Trademark Holdings SRL
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

TRADEMARK HOLDINGS SRL

Opposition No. 91268387

Opposer,  
v.

AIYARA, LLC

Applicant.

\_\_\_\_\_ /

**AMENDED NOTICE OF OPPOSITION**

Trademark Holdings SRL (“Nayara Trademark Holder”), a società a responsabilità limitata organized under the laws of Costa Rica, believes that it will be damaged by the registration of the mark NAIYARA in International Class 043, as shown in Application Serial Numbers 88/097,958 and 88/097,970 (the “Applications”) filed by AiYaRa, LLC (“Applicant”), and hereby opposes the Applications and requests that the subject registrations be refused.

The grounds for Nayara Trademark Holder’s Opposition are as follows:

1. Nayara Trademark Holder is the owner of internationally registered as well as common law trademark rights for Nayara Resorts, a high-end boutique resort.
2. Nayara Resorts has three luxury resort hotels in Costa Rica; Nayara Springs, Nayara Tented Camp, and the Nayara Resort, Spa, & Gardens. Recently Nayara Resorts expanded its footprint and added two luxury hotels in Chile to its portfolio, the Alto Atacama in the Atacama Desert and the Hangaroa on Easter Island (the Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, & Gardens, Alto Alcama, and Hangaroa shall collectively be referred to as the “Nayara Resorts”).
3. The Nayara Resorts are a critically acclaimed family of resorts that have won awards such as the Reader’s Choice Awards Best Resort in Central America and they are

consistently rated as the top resorts in Central America and the world. The Nayara Resorts have been extensively promoted and advertised and have been the subject of substantial unsolicited publicity for being some of the premier resort destinations in the world.

4. Nayara Resorts has devoted substantial resources, time, and effort to develop, market, and promote its Nayara common law trademark in the United States. Through these efforts, and long before the filing of the Applications, Nayara Resorts built up and established extensive and valuable goodwill in the Nayara common law trademark in the United States. As a result, the public in the United States has come to know, identify, and recognize products and services bearing or marketed in association with the term “Nayara” as originating with or authorized by Nayara Resorts. Furthermore, through Nayara Resorts’ efforts, the Nayara common law trademark became famous prior to the filing of the Applications.

5. Nayara Resorts is affiliated with Nayara Trademark Holder. By agreement, Nayara Trademark Holder allows Nayara Resorts the exclusive use of the Nayara name. At all times Nayara Trademark Holder has direct and indirect control of Nayara Resorts’ use of the Nayara name.

6. Nayara Resorts utilizes the Nayara common law trademark in commerce on an ongoing basis throughout the United States, including in Miami, Florida where Applicant’s restaurant is based, and has done so continuously since at least December 1, 2005.

**Procedural History:**

7. Applicant filed an application for the Naiyara standard character mark on August 29, 2018. The Application Serial Number for the Naiyara standard character mark is 88/097,958 (the “958 Character Mark”).

8. Applicant filed an application for the Nai Ya Ra design mark on August 29, 2018. The Application Serial Number for the Nai Ya Ra design mark is 88/097,970 (the “970 Design Mark”) (the 958 Character Mark and 970 Design Mark shall collectively be referred to as the “Applicant’s Marks”).

9. On December 12, 2018 the United States Patent and Trademark Office issued an Office Action for the 958 Character Mark. The Office Action was a Section 2(d) Refusal based upon the likelihood of confusion with the trademark bearing United States Registration Number 4862508 which was a design mark for Nayara Hotel Spa & Gardens.

10. On December 13, 2018 the United States Patent and Trademark Office issued an Office Action for the 970 Design Mark. The Office Action was a Section 2(d) Refusal based upon the likelihood of confusion with the trademark bearing United States Registration Number 4862508 which was a design mark for Nayara Hotel Spa & Gardens.

11. On June 12, 2019 Applicant filed a Response to the Office Action in connection with the 958 Character Mark. On June 13, 2019 Applicant filed a Response to the Office Action in connection with the 970 Design Mark.

12. On July 1, 2019 the United States Patent and Trademark Office issued a Final Office Action in connection with the 958 Character Mark for a Section 2(d) Refusal based upon the likelihood of confusion with the trademark bearing United States Registration Number 4862508. A Final Office Action in connection with the 970 Design Mark for a Section 2(d) Refusal based upon the likelihood of confusion with the trademark bearing United States Registration Number 4862508 was entered on the same day.

13. Applicant filed a Notice of Appeal in connection with both the 958 Character Mark and the 970 Design Mark on December 31, 2019.

14. After requesting and obtaining a number of extensions to file an appellate brief, on September 28, 2020, Applicant filed a Petition for Cancellation to cancel the trademark bearing United States Registration Number 4862508.

15. The basis for the cancellation was not that Nayara was no longer being utilized in commerce, but instead, that the design for the Nayara Hotel Spa & Gardens logo changed over time, and that Nayara discontinued the use of the design mark which was the subject of United States Registration Number 4862508.

16. Notice of the Petition for Cancellation was not received. As a result, a default was entered and United States Registration Number 4862508 was cancelled on January 15, 2021. Receiving this notice of cancellation was the first notice that Nayara Trademark Holder, Nayara Resorts, or Nayara Gardens received notice of the Petition for Cancellation.

17. Based upon this cancellation, the Appeal was dismissed as moot and the Applicant's Marks were permitted to be published for opposition.

18. However, the cancellation of the trademark bearing United States Registration Number 4862508 does not cure the fact that the Applicant's Marks infringe upon the common law trademark rights of the Nayara name pursuant to 15 U.S.C. §§ 1052(d).

**Nayara's Continued Use of the Nayara Common Law Trademark:**

19. Nayara Resorts utilizes the common law Nayara trademark in commerce on an ongoing basis throughout the United States, including in Miami, Florida where Applicant's restaurant is based, and has done so continuously since at least December 1, 2005.

20. Over the years, Nayara Resorts has spent millions of dollars on traditional media advertisements as well as digital advertisements in the United States which target individuals residing in the United States. These advertising campaigns in the United States have been

successful. Each year, millions of dollars worth of Nayara Resorts' hotel rooms are booked through the [www.nayararesorts.com](http://www.nayararesorts.com) website from the United States.

21. Additionally, millions of dollars of hotel rooms at the Nayara Resorts properties have been booked from the United States through third party websites such as American Express Travel, Expedia, and Hotels.com, amongst others.

22. At all times in the advertisement of Nayara Resorts as well as on the website for Nayara Resorts the name Nayara is prominently displayed.

23. By virtue of Nayara Resorts' first use of the common law trademark on December 1, 2005, and the first booking by an individual in the United States of a hotel room at Nayara Resorts shortly thereafter, the common law trademark was used in commerce in the United States for nearly a decade prior to Applicant's first use on March 27, 2015.

24. In fact, one of the founding owners for Applicant who was the chef at the restaurant - Chef Bee whose legal name is Piyarat Potha Arreeratn - learned of the Nayara name from a family member of the Nayara Resorts' owner prior to Applicant's first use.

25. Given Nayara Trademark Holder's rights to the Nayara trademark, it filed a trademark application with the United States Patent and Trademark Office to protect these rights. The Application Serial Number for the Nayara standard character mark application is 90/601,628 (the "628 Character Mark Application").

26. Although the 628 Character Mark Application covers a number of classes, two of the classes for the application are "Restaurant services" and Bar services" in class International Class 043. Although Applicant seeks to register the Applicant's Marks in the International Class 043 category "Restaurant and bar services", on October 6, 2011 this category was deleted because it is covered by the "Restaurant services" and "Bar services" entries.

**Nayara Will Be Harmed If Applicant's Mark Registers**

27. The Applications were both published in the Official Gazette (Trademarks) of the United States Patent and Trademark Office on February 23, 2021. This Opposition is timely pursuant to 15 U.S.C. § 1063(a).

28. There is no issue of priority, Nayara has consistently been utilizing its common law trademark in commerce since December 1, 2005. On the other hand, the first use of Applicant's Marks was on March 27, 2015.

29. The goods and services set forth in the Applications for International Class 043 are identical, similar, or complementary and related to the products and services marketed by Nayara Resorts.

30. Applicant's use of the Naiyara marks as contemplated in the Applications will inevitably reach the same consumers that Nayara targets with the use of its Nayara common law trademark.

31. Consumers, upon seeing Applicant's Naiyara marks used in connection with Applicant's goods and services are likely to mistakenly believe that Applicant's Marks, and the goods and services provided in connection with them, originated from or are connected with, sponsored by, associated with, or licensed or approved by Nayara.

32. The Nayara common law trademark and the Applicant's Marks share the virtually and phonetically identical element "Nayara." Thus, the Applicant's Marks are substantially similar in sight, sound, and meaning to the Nayara common law trademark.

33. Accordingly, Applicant's Marks are confusingly similar to the previously used Nayara common law trademark, and therefore, if Applicant's Marks were allowed to register for the goods and services covered by the Applications in International Class 043, such registration

would likely cause confusion, mistake, or deception among consumers concerning the origin, source or sponsorship of Applicant's products in violation of 15 U.S.C. §§ 1052(d) and 1125(a).

34. If Applicant's Marks were allowed to register, the confusion with the Nayara common law trademark would result in damage and injury to Trademark Holdings SRL and to the public.

35. Given Nayara Resorts' considerable reputation, registration of Applicant's Marks is likely to cause dilution of the distinctiveness of the Nayara common law trademark.

WHEREFORE, Trademark Holdings SRL requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Dated: June 16, 2021

Respectfully submitted,

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