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Mailed: August 7, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Shen Manufacturing Company Incorporated v. Ritz Hotel Limited

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Consolidated Opposition Nos. 71,706; 72,817; 72,818; 73,756; 74,517; 74,778; and 75,003

Frank J. Bonini, Jr. of Harding, Earley, Follmer & Frailey for Shen Manufacturing Company Incorporated.

Lile Deinard of Dorsey & Whitney for Ritz Hotel Limited.

Before Simms, Hanak and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

In 1984 and 1985 the Ritz Hotel Limited (applicant) filed seven applications seeking to register marks consisting of or containing the word RITZ for various goods and services.

Thereafter, Shen Manufacturing Company Incorporated (opposer) filed seven Notices of Opposition alleging that applicant's use of its marks in connection with its goods

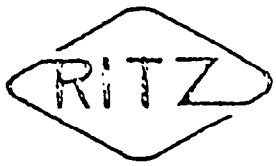
and services would be likely to cause confusion with opposer's mark RITZ and design which it had used continuously since various dates (the earliest being 1892) for various products. Opposer alleged that all of its uses of RITZ and design long predated any first use dates claimed by applicant.

Applicant filed answers which denied that the contemporaneous use of any of its seven marks for their respective goods and services were likely to cause confusion with respect to opposer's mark for its goods. By an order of this Board dated April 25, 2001 the seven oppositions were consolidated. Both parties filed briefs and were present at a hearing held on March 20, 2003.

Applicant has raised numerous evidentiary objections. To a lesser extent, so has opposer. We have reviewed these objections, and have considered only that evidence which is relevant and properly before this Board. However, having said the foregoing, three objections raised by applicant deserve special comment.

First, at pages 15 and 16 of its brief, applicant contends that "Shen [opposer] has offered testimonial deposition testimony and evidence at trial concerning the use of RITZ marks other than those pleaded in the notices of opposition." In its Notices of Opposition, opposer made

specific reference to its RITZ and design mark, as shown below.



During the course of this proceeding, opposer's counsel (as well as applicant's counsel) repeatedly referred to opposer's mark as RITZ per se, without any mention whatsoever of its diamond design element. Thus, we hold that applicant has waived its objections to opposer's uses of RITZ per se.

However, having said the forgoing, we note that our ruling really constitutes a "distinction without a difference." In essence, opposer pled rights in RITZ surrounded by a very simple geometric shape, namely, a diamond. It has long been held that such simple geometric background shapes have no trademark significance in that the public rarely takes notice of them. 1 McCarthy on Trademarks and Unfair Competition, Section 7:29 at page 7-68.7 (4th ed. 2002). An excellent example of this principle

is found in In re Hyper Shoppes, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). In finding a likelihood of confusion between applicant's mark BIGG'S TRUE MINIMUM PRICING surrounded by a rectangle for grocery store services and the cited mark BIGG'S surrounded by an oval for furniture, the Court did not even discuss the presence of the rectangle or the oval. Hence, in our likelihood of confusion analysis, we will assume that opposer's mark is essentially RITZ per se.

Second, there is, as pointed out at pages 15 to 17 of applicant's brief, a dispute as to which goods opposer has established prior trademark rights. However, with one exception - shower curtains, to be discussed later - there is no dispute, as applicant acknowledges at page 16 of its brief, that opposer has established prior trademark rights in RITZ for dish cloths, kitchen towels, bathroom towels, toaster covers, textile placemats, napkins, potholders, barbeque mitts, aprons, and cleaning and polishing cloths. For our various likelihood of confusion considerations, the forgoing admission is sufficient, although we should add that the record reflects that opposer has established prior rights in the mark RITZ for a number of other related products.

Third, at footnote 12 at page 18 of its brief, applicant raises for the first time a defense under Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Not only did applicant fail to plead a Morehouse defense, but said defense was not tried by the explicit or implicit consent of the parties. Hence, we will not consider this defense.

We now turn to the merits of the oppositions. Applicant seeks to register RITZ in typed drawing form for "providing courses of instruction in cooking, meal preparation and wine selection" (Ser. No. 73/499,080, Op. No. 72,818) and for "threads for use in textiles" (Ser. No. 73/549,463, Op. No. 74,778). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1978) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, they are essentially identical. As previously noted, there is no meaningful distinction between RITZ and RITZ enclosed within a simple

geometric shape such as a diamond. Thus, the first Dupont "factor weighs heavily against applicant" because applicant's mark is essentially identical to opposer's mark. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of opposer's goods and applicant's goods and services, we note that because the marks are essentially identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 922 F.2d 1204, 26 USPQ 1687, 1689 (Fed. Cir. 1993).

However, in this case, we find that certain of opposer's goods are clearly related to providing courses of instruction in cooking and meal preparation, and threads for use in textiles. Obviously, in providing cooking courses (applicant's services) it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders. After having prepared the food, one would need napkins and placemats. Accordingly, given the fact that the marks are virtually identical and the services of applicant clearly require the use of certain of opposer's goods, we find that there exists a likelihood of confusion.

As for applicant's RITZ threads for use in textiles, even if we make the assumption (not established by applicant) that such threads are only purchased by professional buyers, nevertheless, we find that such professional buyers who are aware of opposer's RITZ dish cloths, kitchen towels, napkins, cleaning cloths, textile placemats, polishing cloths and bathroom towels would assume that both threads for textiles and the finished products emanated from a common source. We recognize that professional buyers of threads for textiles are sophisticated. However, no degree of sophistication would enable even a professional to distinguish between essentially identical marks. Hence, we find that there exists a likelihood of confusion.

As for applicant's application Ser. No. 73/572,795 (Op. No. 75,003) for THE RITZ KIDS in typed drawing form for, amongst other goods, gloves, we likewise find that there exists a likelihood of confusion with opposer's mark RITZ and simple diamond design. To begin with, we note that applicant's Class 25 application for THE RITZ KIDS includes "gloves" of all types, including ready made and tailored. A "mitt" is defined as a typed of glove. Random House Webster's Dictionary (2001). Because the goods are in part legally identical, "the degree of similarity [of

the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ 1698, 1700 (Fed. Cir. 1992). Whether mitts (some of opposer's goods) are related to other of applicant's Class 25 goods is irrelevant for our likelihood of confusion analysis. Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). In considering applicant's mark THE RITZ KIDS, we note that the word THE is one of those words that has virtually no significance in distinguishing trademarks. In re Packaging Specialists, Inc., 221 USPQ 917, 919 (TTAB 1984). As for the word KIDS, it is clear that this word simply indicates that the particular item of apparel is designed for kids. Accordingly, if a consumer were familiar with opposer's RITZ mitts, we believe that upon encountering applicant's mark THE RITZ KIDS for, among other goods, gloves, he or she would assume that they emanate from a common source. Hence, the opposition is sustained as to applicant's Class 25 goods. Because opposer only opposed the Class 25 goods, it is not sustained as to the other classes. See page 7 of this Board's order of April 25, 2001.

As for applicant's applications to register RITZ PARIS RITZ HOTEL and design shown below for "dinner plates of

porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, household glassware; namely, tumblers, goblets and juice glasses" (Ser. No. 73/518,941, Op. No. 73,756) and for "carpets, rugs, floor mats and matting, linoleum for covering existing floors, wall covering made of vinyl and plastic" (Ser. No. 73/518,946, Op. No. 74,517), we simply note that this mark and opposer's mark are distinctly different in appearance, pronunciation and especially meaning. Put quite simply, applicant's mark conjures up a hotel in Paris, more specifically, the world famous Ritz Hotel. Thus, despite the fact that certain of opposer's goods (cleaning and polishing cloths) and certain of applicant's goods (household sponges and brushes) are very similar in terms of their functions, we nevertheless find that given the significant disparity in the marks, there exists no likelihood of confusion.

We turn now to application Ser. No. 73/514,805 (Op. No. 71,706) for PUTTING ON THE RITZ in typed drawing form for "shower curtains." To begin with, we note that while opposer has now made use of its mark RITZ for shower curtains, said use did not occur prior to applicant's priority date. Hence, the closest goods to shower curtains for which opposer has established priority are bathroom towels. Clearly, bathroom towels and shower curtains are related goods. However, put quite simply, the mark PUTTING ON THE RITZ conjures up images of getting well dressed up, or to older individuals such as myself, the legendary song Puttin' on the Ritz composed by Irving Berlin. We find that the differences in the marks outweigh the similarities in the goods (shower curtains and bathroom towels) such that there is no likelihood of confusion.

Finally, with regard to applicant's application seeking to register CESAR RITZ (Ser. No. 73/499,264, Op. No. 72,817) for "educational services; namely, conducting courses of instruction in cooking," we find that this mark is dissimilar enough from opposer's mark RITZ such that there is no likelihood of confusion. We recognize that

previously we found confusion between opposer's mark RITZ and applicant's mark RITZ for cooking courses. Nevertheless, we find that the presence of CESAR in applicant's mark is sufficient to distinguish it from opposer's mark such that there is no likelihood of confusion. While by no means the dispositive factor, we note that CESAR is the first word in applicant's mark and this is "a matter of some importance since often it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Presto Products v. Nice Pak Products, 9 USPQ2d 1825, 1827 (TTAB 1988).

Decision: The oppositions are sustained with regard to Opposition Nos. 72,818 and 74,778 (RITZ) and Op. No. 75,003 (THE RITZ KIDS). The other four oppositions are dismissed.