THIS DISPOSITION IS
NOT CITABLE AS
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Hearing:
20 May 2004

Mailed:
31 August 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Six Continents Hotels, Inc.
v.
Marriott International, Inc.

Opposition No. 91150006
to application Serial No. 75791896

Albert Robin of Robin, Blecker & Daley for Six Continents Hotels, Inc.

Michael A. Grow of Arent Fox Kinter Plotkin & Kahn, PLLC for Marriott International, Inc.

Before Hohein, Chapman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Marriott International, Inc. (applicant) has applied to register the mark HOW LONG WILL YOU BE STAYING? in typed form on the Principal Register for "hotel services."[1]

Six Continents Hotels, Inc. (opposer) has opposed registration on the grounds that applicant's mark is "merely descriptive of hotel services" and that the term is "a common descriptive phrase used by Opposer and other

[1] Serial No. 75791896, filed on September 3, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

operators and licensors of hotels." Notice of Opposition, ¶¶ 9 and 10. Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; the trial testimony deposition, with exhibits, of Gregory S. Price, opposer's vice president of marketing;[2] the stipulated declaration testimony, with exhibits, of Roberta Kraus, an attorney with opposer's law firm; and the stipulated declaration testimony of Jodi Arlen, a paralegal with applicant's law firm.

Both parties have filed briefs, and an oral hearing was held on May 20, 2004.

Background

Applicant has applied to register the phrase HOW LONG WILL USE BE STAYING? for hotel services. Opposer is in the business of "franchising, and in some cases running hotels." Price dep. at 9. Opposer's brands include Holiday Inn,

[2] Applicant objects to Mr. Price's testimony on the ground that it is "unfounded legal opinion" because his conclusion that opposer would be damaged was based on speculation and an incorrect assumption. Applicant's Brief at 2-3. "The opinion testimony of an officer of a business as to value or projected profits or as to damage to the business, without qualifying the officer as an expert, 'is admitted not because of experience, training or specialized knowledge within the realm of an expert, but because of the particularized knowledge that the witness has by virtue of his or her position in the business.' Fed. R. Evid. 701, advisory committee's note (2000)." Allied Systems, Ltd. v. Teamsters Automobile Transport Chauffeurs, 304 F.3d 785, 792 (8th Cir. 2002). Therefore, we overrule applicant's objection.

Holiday Inn Express, Intercontinental, Crowne Plaza, and Staybridge Suites. Price dep. at 10. Applicant is a competitor of opposer who operates under the brand names of Marriott, Courtyard by Marriott, Fairfield Inns, and Towneplace Suites. Price dep. at 14 and 16. Opposer's witness was asked if he had heard the question, "How long will you be staying." His response was: "Very often, almost every time I check into a hotel. Particularly, with extended stay hotels. But very often also in other hotels." Price dep. at 13. He also testified that the question was asked by desk clerks and reservation center personnel at the following hotels: Holiday Inn, Holiday Inn Express, Intercontinental, Crowne Plaza, and Staybridge Suites. Id. Opposer also submitted Internet printouts showing that others in the lodging field use the expression "How long will you be staying?" on their websites, particularly to determine the length of a potential guest's stay. Kraus Stip. Test. Exhibits.[3] See, e.g., Windsor Hospitality Group ("How long will you be staying?"); Joshua Creek Reservations ("How long will you be staying?"). See also Marriott

[3] Applicant's evidence consisted of the stipulated testimony of its counsel's paralegal (Jodi Arlen) concerning the registration and use of other marks that applicant considered to be similar to its mark. This evidence of the registration of different marks is entitled to little weight. "Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Similarly, the use of

Residence Inn at State College, PA ("How long will you be staying at the Residence Inn?").

Standing

Opposer is a competitor of applicant. Both are in the hotel business.

> It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses… Thus, opposer as a competitor of applicant is a proper party to challenge applicant's right of registration.

Federal Glass Co. v. Corning Glass Works, 162 USPQ 279, 282-83 (TTAB 1969). See also McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:11 ("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business").

Opposer has submitted evidence to indicate that it and others in the trade use applicant's phrase in their

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different slogans is not very relevant to the issue of whether applicant's slogan is entitled to registration.

businesses. Therefore, we find that opposer has standing to oppose the involved application.

Issues

In its notice of opposition, opposer alleges that applicant's mark is "merely descriptive of hotel services." Notice of Opposition, ¶ 9.[4] In its brief, opposer states the issue as follows:

> Since Six Continents franchises and operates hotels where guests stay for varying number of nights and since Six Continents has the need to ascertain how long guests will be staying and the right to use appropriate questions to make the necessary inquiry, Six Continents would seem to have standing to oppose. Thus, the only issue is whether or not the Six Continents hotels have a right to ask their guests "how long will you be staying."

Opposer's Brief at 4-5.

Opposer goes on to argue that "How long will you be staying? is not a service mark." Opposer's Brief at 5. Opposer concludes by arguing that third-party registrations could not overrule:

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[4] Opposer also alleges that applicant's mark is a "common descriptive phrase used by Opposer and other operators and licensors of hotels." Notice of Opposition, ¶ 10. "In 1988 the Lanham Trademark Act was amended to replace the designation 'common descriptive' in Section 14(c) and Section 15(4) (15 U.S.C.A. Section 1064(3) and Section 1065(4) (West Supp. 1993)) with the designation 'generic', in order 'to reflect current usage of the term by the courts and in general language.' S. Rep. No. 515, 100th Cong., 2d Sess. 34, *reprinted in* 1988 U.S.C.C.A.N. 5577, 5597." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Genericness is the ultimate in descriptiveness." Stromgren Supports Inc. v. Bike Athletic Co., 43 USPQ2d 1100, 1107 n.12 (TTAB 1997). If an opposer cannot establish that a term is merely descriptive, it obviously cannot establish that the mark is generic.

> the plain language of Section 2(e)(1) of the Lanham Act and the plain language of the case law that apt descriptive phrases, such as "how long will you be staying," which competitors need to use, are not eligible for registration. While there may be an exception to this rule in certain cases where the mark in question has acquired a secondary meaning and thereby lost its descriptive meaning, such an exception could not exist here since the application at issue is based only upon a bona fide intention to use.

Opposer's Brief at 9.

For its part, applicant denied the salient allegations of the notice of opposition, and in its brief argued that its mark is not merely descriptive of its services.

We conclude that the only issue for us to address is the question of whether applicant's mark is merely descriptive. Whether subject matter functions as a mark is a separate issue from whether the subject matter is merely descriptive of the services. In re Wakefern Food Corp., 222 USPQ 76 (TTAB 1884) (Refusal to register the phrase WHY PAY MORE! on the ground that the phrase does not function as a service mark affirmed while refusal to register on the ground of mere descriptiveness reversed). "Whether the words sought to be registered as a service mark function as such must be determined by reference to the specimens of use and other examples of use made of record by applicant." In re C.R. Anthony Co., 3 USPQ2d 1894, 1895 (TTAB 1987). See also In re European-American Bank & Trust Co., 201 USPQ 788, 790 (TTAB 1979) ("In this regard, we particularly note, as did the Examiner, applicant's use of the phrase 'THINK ABOUT

THIS:' at the top of the ad and the phrase 'THINK ABOUT IT' as part of the regular text of applicant's ad. These usages simply serve to reinforce the ordinary meaning of the phrase 'THINK ABOUT IT.'" Slogan held not to function as a mark). Inasmuch as the involved application is an intent-to-use application and there is no evidence of use by applicant, any challenge to applicant's mark on the ground that it does not function as a service mark at this time would likely be premature even if it was properly pleaded.

However, in its notice of opposition, opposer did not plead that applicant's slogan does not function as a service mark. In addition, the pleadings have not been amended and the issue was not tried by consent. Opposer cannot now raise the issue of whether the term functions as a service mark in its trial brief. Therefore, the issue is not properly before us, and we do not address it on the merits. See TBMP § 314 (2d ed. Rev. 2004) ("A plaintiff may not rely on an unpleaded claim. The plaintiff's pleading must be amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter").

We now turn to the only issue that is before us, which is whether applicant's slogan HOW LONG WILL YOU BE STAYING? is merely descriptive of hotel services. For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, features, or characteristics of

the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Opposer has the burden of establishing by a preponderance of the evidence that applicant's term is merely descriptive of hotel services. Racine Industries, Inc. v. Bane-Clene Corp., 35 USPQ2d 1832, 1837 (TTAB 1994).

Opposer submits that "Applicant's mark does convey the impression of an extended stay hotel." Opposer's Brief at 5. Opposer's witness offered the following explanation: "Q. In what context would it tell you about the quality of the hotel? A. That it is an extended stay hotel." Price dep. at 18. However, opposer's witness also responded to the following question: "So there really isn't anything that would – that how long you would be staying that would describe the hotel services, would it?" by answering: "Once

again, probably not. But it would depend on the context it was being used in." Price dep. at 19.

It is not clear from the record how the slogan "HOW LONG WILL YOU BE STAYING?" is merely descriptive of hotel services. The slogan does not immediately convey information about any quality or characteristic of hotel services. Even if the slogan suggests that applicant's services are extended stay hotel services, "terms may convey information without being merely descriptive." Wakefern, 222 USPQ at 79. Moreover, applicant's slogan must do more than "convey the impression" of an extended stay hotel. To be merely descriptive, the slogan must immediately inform prospective purchasers of a quality, feature, or characteristic of the hotel services. Simply because a term may have some association with the services does not mean that the mark is merely descriptive. See In re Marriott Corp., 517 F.2d 1364, 186 USPQ 218, 222 (CCPA 1975) ("Nor do we view the slogan WE SMILE MORE as descriptive of hotel, restaurant, or convention services… [T]he slogan mark before us would at most suggest the facial expression of persons performing the services. It does not describe the services themselves"); Wakefern, 222 USPQ at 79 ("At most the exclamatory phrase WHY PAY MORE! suggests that the supermarket prices of others are higher and that applicant's are lower").

Opposer's other evidence that the phrase is descriptive is the testimony of Mr. Price that he has heard opposer's employees use the phrase and the stipulated testimony of Roberta Kraus regarding exhibits from an Internet search that show websites for lodgings and other entities using the phrase "How long will you be staying?" in a non-trademark manner. Even if a slogan or phrase is commonly used by others, it does not establish that the slogan or phrase is merely descriptive. Wakefern, 222 USPQ at 78 ("[R]elatively common merchandising slogan does not act or function as a mark" but not merely descriptive).[5] The statute and judicial precedent requires that, to be merely descriptive, the term must inform prospective purchasers of the qualities, features, or characteristics of the services. It is not enough to show that other competitors use the term. Opposer's evidence does not meet its burden of showing that applicant's mark is merely descriptive. Therefore, opposer cannot prevail.

Decision: The opposition is dismissed.

[5] Evidence of widespread use by others of a non-descriptive term would be evidence that the term does not function as a mark. DataNational Corp. v. BellSouth Corp., 18 USPQ2d 1862, 1865 (TTAB 1991)("That is, because the public is accustomed to seeing the walking fingers logo on all classified telephone directories, wherever it may encounter them, it will not regard the logo as a trademark but merely as an informational symbol which denotes yellow pages"). As noted earlier, however, this issue is not before us.