

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Amadeus Marketing, S.A.

v.

Amadeus Salon, Inc.

Opposition No. 91151180 to application Serial No. 76252385
filed on May 7, 2001

David A. Weinstein, Esq. for Amadeus Marketing, S.A.

Seth E. Freilich of Pillsbury Winthrop, LLP for Amadeus Salon,
Inc.

Before Quinn, Hohein and Bottorff, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Amadeus Salon, Inc. has filed an application to register the mark "AMADEUS" for "health spa services, namely, skin care, body care, and hair care treatments."¹

Amadeus Marketing, S.A. has opposed registration on the ground that it "is and has been for many years engaged in the offering, marketing, advertising and sale of hotel reservation and travel agency services as well as promoting travel and tourism worldwide and providing and leasing access to a worldwide

¹ Ser. No. 76252385, filed on May 7, 2001, which alleges a date of first use of the mark anywhere of June 1987 and a date of first use of the mark in commerce of December 1987.

computerized system and data bank in the field of reservations for lodging, hotels, and transportation"; that "[i]n connection therewith Opposer has used in commerce ... the mark AMADEUS ... prior to Applicant's date of first use of the trademark AMADEUS"; that opposer's mark "has not been abandoned"; that opposer "owns United States Patent and Trademark Office Registration Nos. 1,457,753 and 1,802,387 which were granted on September 15, 1987 and November 2, 1993, respectively[,] for the trademark AMADEUS"; that such registrations "are prima facie evidence of Opposer's exclusive right to use Opposer's Trademark in commerce in connection with the services specified in the registrations"; that opposer's services under its mark "have been continuously offered to the public through various channels of trade" and have been advertised under such mark in the United States; that by reason thereof, the public has come to recognize opposer's "AMADEUS" mark "as signifying Opposer and its services"; and that because applicant's "AMADEUS" mark "is confusingly similar to" opposer's "AMADEUS" mark for opposer's services, applicant's use of its mark in connection with applicant's services "is likely to cause confusion, deception, and mistake."

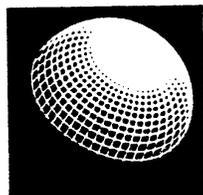
Applicant, in its answer, has expressly admitted that opposer "owns two design marks with Reg. Nos. 1,457,753 and 1,802,387," but has otherwise denied the remaining salient allegations of the notice of opposition.²

² While applicant has also alleged several putative "affirmative defenses," including laches, in its answer, no evidence has been offered with respect thereto and no argument concerning such defenses

The record consists of the pleadings, including the above-noted admission by applicant that opposer is the owner of its two pleaded registrations, and the file of the involved application. Neither party took testimony or otherwise submitted any evidence. Both parties filed briefs, although opposer did not file a reply brief, and an oral hearing was not requested.

It is settled that where an opposer establishes that a pleaded registration is subsisting and is owned by the opposer, priority is not in issue with respect thereto. See, e.g., King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The issues to be decided herein are thus whether, in light of applicant's admission with respect to the registrations pleaded by opposer, priority is in issue and, if such is not the case, whether applicant's "AMADEUS" mark for its "health spa services, namely, skin care, body care, and hair care treatments" so resembles opposer's "AMADEUS" mark for the services in connection with which such mark is registered as to be likely to cause confusion, mistake or deception as to the source or sponsorship of the parties' respective services.

Opposer, in its brief, asserts that it "filed the opposition based on a claim of proprietary rights in the mark AMADEUS (hereafter 'Opposer's Mark')," as reproduced below,



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which "is used in connection with 'providing and leasing access to a worldwide computerized system and data bank in the field of reservations for lodging, hotels and transportation (air, land and sea) and providing and leasing access to a worldwide computerized system and data bank for use by travel agents in connection with travel services for air, land and sea transportation reservations and ticketing, car rentals and tourist packages, organizing trips and excursions, and travelers' guide services and sight seeing tourism services.' (hereafter 'Opposer's Services')." Opposer further maintains that:

Opposer's Mark is the subject of Registration No. 1,802,387 on the Principal Register, which covers Opposer's Services and was issued November 2, 1993, (hereafter "Opposer's Registration"). The United States Patent and Trademark Office ... accepted opposer's Sections 8 & 15 affidavit on July 30, 1999. Accordingly, Opposer's Registration is incontestable.

....

The evidence of record consists solely of Opposer's pleaded registration and the Application.

By means of ... the Answer, Applicant admits opposer's ownership of Opposer's Registration and, therefore, the registration date thereof as an undisputed fact.

Opposer consequently insists that because applicant "does not challenge registration of Opposer's Mark or opposer's rights therein," the question of whether there is a "likelihood of confusion between Applicant's Mark and Opposer's Mark is the principal issue in this proceeding."

Applicant, in response, argues in its brief that while opposer "purports to have a registration for the mark AMADEUS" as claimed in its brief,³ such registration "is not properly in evidence in this proceeding, and should not be considered by the ... Board. The evidence of record therefore consists solely of the Application." Applicant, in support thereof, respectively cites Trademark Rules 2.122(d) and 2.122(b)(1), and correctly notes, in particular, that:

Opposer did not ... take the steps necessary to make its alleged registration evidence of record by any of the three proper methods enumerated ... [in such rule]. Opposer's Notice of Opposition ... did not include two copies of the alleged registration showing the current status and title of the registration. During Opposer's testimony period, Opposer took no testimony and therefore did not identify and introduce its alleged registration through proper testimony. Finally, during Opposer's testimony period, Opposer did not file and serve any Notice of Reliance making its alleged registration evidence of record.

Moreover, as to opposer's argument that its pleaded registration "is of record because Applicant's Answer admits Opposer's ownership" thereof, applicant accurately points out that "[a]n admission of ownership by an applicant is not, however, sufficient to make the registration of record." Thus, according to applicant, opposer has "entirely failed to meet its burden

³ Specifically, in addition to opposer's pleading of ownership of Reg. No. 1,802,387, applicant accurately observes that the notice of opposition "cites a second registration," namely, Reg. No. 1,457,753, which is for the mark "AMADEUS" and, as applicant notes, is "for 'night club services' ... and 'discotheque services'." However, as applicant also correctly points out, opposer's brief "does not purport to rely upon this alleged registration," which applicant insists "is not properly ... of record" for the same reason that opposer's other pleaded registration is not properly part of the evidentiary record.

through its failure to prosecute, and its Opposition should be denied."

We agree with applicant that, contrary to opposer's assertions, neither of opposer's pleaded registrations is properly of record herein. Specifically, besides the failure of opposer to utilize any of the methods provided by Trademark Rule 2.122(d), applicant admits in its answer to the notice of opposition only that opposer is the owner of registrations pleaded by opposer therein. The notice of opposition, however, contains no allegations that opposer's pleaded registrations are valid and subsisting. Moreover, in its answer applicant has specifically denied the allegation of the notice of opposition that such registrations "are prima facie evidence of Opposer's exclusive right to use Opposer's Trademark in commerce in connection with the services specified in the registrations," thereby putting opposer on notice that its claim of proprietary rights therein was being challenged. See, e.g., *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); and TBMP §704.03(b)(1)(A) (2d ed., 1st rev. March 2004).

Accordingly, having failed to make either of its pleaded registrations properly of record, so that there is no showing that such registrations are subsisting in addition to being owned--as applicant admits--by opposer, priority is in issue herein. Furthermore, because there is thus no showing that opposer possesses rights in a mark which are equal to or superior to the earliest date upon which applicant is entitled to rely in

this proceeding, namely, the May 7, 2001 filing date of its involved application, priority lies with applicant rather than opposer. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Opposer, therefore, cannot prevail herein even if a likelihood of confusion were to be shown.

Nonetheless, even if the pleaded registration relied upon by opposer in its brief had been properly made of record,⁴ so that priority was not in issue, the opposition must be dismissed because the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, show that opposer has failed to meet its burden of demonstrating that confusion is likely to occur from the contemporaneous use of the marks at issue in connection with the parties' respective services. In particular, as to the two key considerations in any likelihood of confusion analysis, which as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of

⁴ As noted earlier, opposer's brief makes no mention of Reg. No. 1,457,753, which it also pleaded in the notice of opposition. Instead, opposer relies in its brief solely upon its other pleaded registration, namely, Reg. No. 1,802,387, in support of its contention that there is a likelihood of confusion. Accordingly, Reg. No. 1,457,753 will not be given any further consideration.

the respective marks in their entireties,⁵ it is the case that in the absence of a showing of relatedness with respect to the parties' services, opposer cannot prevail herein even if the marks at issue are considered to be sufficiently similar.

Turning first to the respective marks, opposer contends that because applicant's mark is identical to the term "AMADEUS" in opposer's mark, "the marks look alike, sound alike, as well as have the same meaning and, therefore, can create the same commercial impression." Opposer, in fact, goes so far as to assert that "the applicant's mark is identical to the registrant's mark ... in this case." While we disagree with such assertion since it is plain that, as pointed out by applicant, its "AMADEUS" mark differs from opposer's "AMADEUS" and design mark in that the latter prominently features "a very specific and precise graphic logo," it is still the case that, when considered in their entireties, the marks at issue are substantially similar in sound, appearance, connotation and commercial impression due to the shared--and apparently arbitrary--term "AMADEUS." Consequently, if the marks at issue were to be used in connection with the same or substantially similar services, confusion as to the origin or affiliation of such services would be likely to occur.

Nevertheless, turning to consideration of the respective services, we concur with applicant that opposer "has

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

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made no showing of any substantial amount of similarity" between applicant's "health spa services, namely, skin care, body care, and hair care treatments," and opposer's services, which consist of:

providing and leasing access to a worldwide computerized system and data bank in the field of reservations for lodging, hotels and transportation (air, land and sea) and providing and leasing access to a worldwide computerized system and data bank for use by travel agents in connection with travel services for air, land and sea transportation reservations and ticketing, car rentals and tourist packages, organizing trips and excursions, and travelers' guide services and sight seeing tourism services.

According to opposer, the parties' services are related, and hence confusion is likely, because:

Services like those opposer's mark identifies can direct members of the relevant public and trade to a provider of services of the type the Application covers. Arguably, persons seeking lodging and hotels as well as tourist packages through reservations made by travel agents utilizing Opposer's Services are suitable patrons for Applicant's Services. It is generally known that people who travel and vacation visit health spas and seek skin care, body care, and hair care treatments. Thus, it is not unreasonable to conclude [that] such persons would believe Applicant's Services are related to or in some way part of Opposer's Services simply because the marks are substantially identical. Accordingly, there is a viable relationship between the services here under consideration.

Applicant, in response, contends that the respective services have not been shown to be related, arguing that:

Opposer's services are used by travel agents. Travel agents are sophisticated users who specialize in this relevant area. As such, they are capable of discerning

between marks which may be similar. Further, Applicant's services are offered to the general public. Thus, the channels of trade and relevant purchasers of each parties' goods and services are not substantially similar.

Applicant also observes that opposer "has shown no direct overlap, nor has it suggested that the parties compete with each other."

It is clear that as identified in the involved application and pleaded registration, applicant's services on their face are specifically and distinctly different from opposer's services. Specifically, as to the services by opposer of "providing and leasing access to a worldwide computerized system and data bank for use by travel agents in connection with travel services for air, land and sea transportation reservations and ticketing, car rentals and tourist packages, organizing trips and excursions, and travelers' guide services and sight seeing tourism services," applicant is correct that such services are directed to travel agents rather than, as is the case with applicant's services, to members of the general public. The former therefore would be offered through different channels of trade to different classes of customers. Furthermore, while there is no such limitation in the services by opposer of "providing and leasing access to a worldwide computerized system and data bank in the field of reservations for lodging, hotels and transportation (air, land and sea)," and thus such services may be regarded as being available to members of the general public, the fact remains that applicant's "health spa services,

namely, skin care, body care, and hair care treatments" are rendered through a different channel of trade.

Consequently, in either of the above circumstances, it is incumbent upon opposer, as the party having the burden of proof, to show that the respective services are related in some viable fashion and/or that they are marketed or promoted under circumstances and conditions that could bring them to the attention of the same purchasers or prospective customers in a situation or circumstances that could cause such consumers reasonably to assume, because of the identity or substantial similarity of the parties' marks, that the particular services share a common origin or sponsorship. See, e.g., Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). Here, opposer has basically offered only generalizations and speculative assertions.⁶ In particular, it has not shown that the general public would reasonably expect a provider of a worldwide computerized system and data bank in the field of reservations for lodging, hotels and transportation to also provide health spa services or vice versa. Given the absence, therefore, of any evidence of a viable relationship between the respective services, opposer has failed to meet its burden of

⁶ As our principal reviewing court has repeatedly cautioned, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

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proving that confusion is likely to occur from the contemporaneous use of the marks at issue.

Decision: The opposition is dismissed.